

US patent law adapts to the rest of the world

After numerous failed attempts over the past decade at harmonizing US patent law with patent law abroad, the Leahy-Smith America Invents Act was finally signed into law by President Obama on 16 September 2011.

The changes include making it easier to oppose granted patents and applications and the playing field for US domestic and foreign players has been leveled in a number of respects.

Important changes in the Leahy-Smith America Invents Act include:

- In principle, with important exceptions, the right to the invention goes to the first inventor to file his patent application ("First-to-File") and not to the first one to invent and reduce to practice as previously ("First-to-Invent").



- The invention must not have been made available to the public (e.g. by public use, sale, publication etc.) before the first priority filing (even foreign filing). But there is a one year grace period before the first priority filing for disclosures directly or indirectly from the inventor. Grace Period should normally NOT be relied on. International companies will continue to observe the absolute novelty requirement which applies in Europe and keep the

invention secret until a first patent application has been filed.

- National boundaries for citable prior art (e.g. public use, offers for sale, lectures etc.) have been removed. Previously only sale or use in the US could be cited against US applications and patents.
- A US application published after the priority date of another's application will now be citable as prior art against that application as of its priority date, even if it is a foreign priority. The need for non-US companies to file numerous US Provisional Patent Applications will thus be reduced, now that foreign priority is given the same standing as US priority for prior art effect. I.e.. in re. Hilmer vanishes.

For an overview of other important changes, please [click here](#).

Happy Pills remain happy

On appeal, too, the courts have ruled that Happy Pills do not infringe the Red Cross logo.

In 2009, the Red Cross filed an appeal against the Happy Pills trademark application. This concerned a combined brand name and image mark of a red cross with the words HAPPY PILLS above it.

The Happy Pills brand name is used for sweets in packaging resembling that of medicines, which are also sold in retail outlets somewhat reminiscent of hospitals. The Red Cross feared a risk of confusion.

No confusion

The Spanish court, Court of Appeal of Barcelona, found, however, that there was no risk of confusion between the two characters – primarily because Happy Pills uses a different type of cross (with rounded edges) and a second color, begin pink rather than red.

This has recently been confirmed on appeal. Furthermore, although the shape of its cross was formerly the same as that of the Red Cross, Happy Pills has since



Left: old logo
Right: new logo (no confusion)

modified the shape. The court now sees no danger of confusion.

.fr rules eased

The rules for registering a .fr domain name have been eased since 6 December 2011.

Previously, it was only possible for local French companies to register this domain. Now, anyone residing in the European Union can register a .fr domain name.

Approximately 250.000 .fr domains are registered every year. In view of the eased rules, this number is expected to grow.

Don't forget to block

Earlier this autumn owners of registered trademarks had the opportunity to block their trademarks from use as .xxx domain names.

On December 6, 2011, ICM Registry opened up the registration of all the remaining .xxx domains which means that companies with unregistered trademarks, companies that want to register variations of their trademarks and companies that did not register during the earlier period now have the opportunity to register .xxx domain names on a first-come, first-served basis.

[Click here](#) for more information.

Can old state symbols be registered?

The world's oldest international intellectual property convention (the 1883 Paris Convention for the Protection of Industrial Property) already prohibited the inclusion of state symbols and national flags in a trademark. The same applies in Benelux legislation and the European Trademark Directive. But what is the position of flags and symbols of countries that no longer exist?

In December 2006, the Couture Tech Ltd filed a Community Trade Mark application for a coat of arms of the former USSR (see picture). The Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM) rejected the application, but not

because the trademark infringed the regulations on state emblems.

The OHIM took the view that the trademark was offensive to public decency and public order, particularly in former Eastern bloc countries such as Hungary, the Czech Republic and Latvia.



Symbol of the avant-garde

The applicant appealed against this decision. In its view, the former Soviet coat of arms had 'left behind' its former significance and had become a 'symbol of the avant garde' in the countries concerned.

Symbol of despotism

The appeal was rejected by the OHIM and the European Court. The European Court found that in countries where people had lived under the Soviet yoke, the old Soviet symbol still had a highly negative association and was seen as a symbol of despotism. The monopolisation of such a symbol through a European trademark registration is therefore not permitted.

MIP ranks Europe's largest patent firms

The European publication **Managing Intellectual Property (MIP)** has published its yearly ranking of Europe's largest IP firms. The ranking, which is based on filed PCT applications, places Zacco as number two in Europe.

There has been an upward trend in the amount of filed patent applications during the last years with the exception of 2009 when the number of patent applications was

temporarily down in the wake of the financial crisis.

Half-yearly figures from WIPO, World Intellectual Property Organization, on WIPO's Patent Cooperation Treaty (PCT) for 2011 show a solid growth so far and if continued at the same pace for the rest of the year, the amount of PCT applications will exceed 170 000.

**Managing
Intellectual
Property**

Zacco second largest in Europe

Every year Managing Intellectual Property ranks the largest patent firms in Europe. The ranking is done on the 17 largest markets and is based on the amount of filed PCT applications. In the latest ranking, which is published in the October issue of the publication, Zacco takes second place in Europe and 18th place worldwide.

Stem cells in Europe – Court of Justice has taken decision

In Zacco's September Newsletter we reported on the concerns regarding the patentability of human embryonic stem cells. A decision has since been taken by the Court of Justice of the European Union (CJEU). Our analysis of this issue is presented below.

Decision

On 18 October 2011, the CJEU finally handed down its long-awaited decision. The Court firstly confirmed the Advocate General's view on the 'concept of the human embryo' in that any human ovum after fertilization, any non-fertilized human ovum into which the cell nucleus from a mature human cell has been transplanted and any non-fertilized human ovum whose division and further development have been stimulated by parthenogenesis constitutes a 'human embryo'.

Totipotency

Moreover, based on the observation of the referring court that the hES cells which served as base material for the patented processes of dispute are not all totipotent, some being only pluripotent cells obtained from the blastocyst, the CJEU gave the clear order that the question of whether this definition includes stem cells obtained from human embryos at the blastocyst stage depends on whether the stem cell is capable of developing into a human being, which is a question for the national/ referring court to decide.

Thus, it can be concluded that a pluripotent stem cell which does not have the capacity

to develop into a human being is not regarded a 'human embryo' and, therefore, may form the basis of a patentable invention. This interpretation is also in line with the Advocate General's earlier opinion.

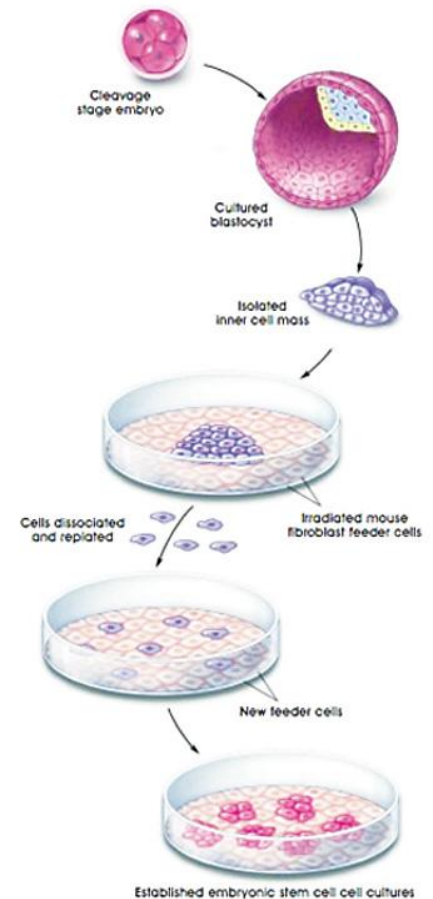
Destruction of human embryo

Secondly, the court came to the conclusion that an invention is excluded from patentability pursuant to Article 6(2)(c) of the Biotech Directive, if the implementation of the invention necessitates the prior destruction of human embryos or their use as base material. This conclusion is in line with the view taken by the Enlarged Board of Appeal of the European Patent Office in its G2/06 decision. However, compared to G2/06, the CJEU seems to have taken a stricter approach, stating that it is not relevant to the question of exclusion whether that destruction occurred at a stage long before the implementation of the invention.

Summary

In summary, based on the court's decision and the various statements, it can be concluded that two criteria must be fulfilled in order for an invention to avoid exclusion from patentability pursuant to Article 6(2)(c) of the Directive: the human embryonic stem cell used as base material must not be totipotent and must be obtained by a technique which, at the time when the patent application is filed, does not result in the destruction of a human embryo.

For more information: [click here](#).



About Zacco

Zacco is a leading Intellectual Property Consultancy firm in Europe, with offices in Denmark, Germany, Norway, the Netherlands and Sweden (Albihns.Zacco). In addition to assistance in protecting intellectual property rights, Zacco also offers its clients strategic advice aimed at increasing their competitive edge through a professional exploitation of these rights. Visit www.zacco.com for further information.

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