

European Patent Law Update

By Blair Hesp

As New Zealand is a relatively small country, a large proportion of any returns on intellectual property investment are likely to be derived from large markets such as Europe and the US. Many of the 32 member states of the European Patent Convention (EPC) are likely to rank highly on the list of countries in which a New Zealand patent applicant will want to obtain protection. Therefore, it is worth keeping up to date with European patent law to appropriately tailor your IP strategy for that market, especially with the EPC 2000 coming into force in December 2007.

Post-grant Amendment Of European Applications

For many reasons a patent owner may decide that it is necessary to amend a patent specification after the patent has been granted. For example, patent examination and grant may occur at different times in different jurisdictions. If any issues affecting the validity of a patent arise during the examination of an application in one jurisdiction, it may be desirable to amend any corresponding patents which have already been granted.

Previously the owner was required to request an amendment to a granted European patent in each state where the patent is in force. Under EPC 2000 this process has been streamlined. Now it will be possible to file amendments to a granted European patent centrally at the European Patent Office, rather than in each individual state. This should reduce the costs and inconvenience associated with requesting amendments after grant in up to 32 countries.

European Incentives For Drug Development

There are also two provisions for extending pharmaceutical patent terms in Europe which may not be well known. It is well known that a number of years may pass between the grant of a patent for a pharmaceutical compound, and approval for sale. Because of this delay many jurisdictions, including Europe, offer drug development incentives, such as extensions beyond the standard 20 year patent term. However, it is also possible to gain additional extensions for particular classes of pharmaceuticals.

Firstly, an additional extension of up to two years may be granted for "orphan drugs". Orphan drugs are developed to combat relatively rare diseases. Given the low prevalence of some diseases, and therefore the limited potential return on any investment in drug development, an extended patent term is offered as an incentive to develop orphan drugs.

Secondly, European Regulation No. 1902/2006 has introduced an alternative additional extension of up to six months for pharmaceuticals, provided that data supplied in conjunction with the request for European drug marketing approval includes data gathered using an approved paediatric investigation plan. This provides an incentive to perform paediatric investigations during clinical trials, and to develop drugs for childhood diseases. However, this extension may not be

granted in addition to an orphan drug extension.

Second Medical Use Claims

The original EPC was drafted over 30 years ago, and did not contemplate the introduction of "Swiss style" claims as an alternative to claims directed to methods of medical treatment of humans.

In Europe, claims for a new non-medical industrial use of a known compound can be drafted as follows:

A compound X for use in process Y.

While a similar claim format could also be used for a first medical use of a compound, the introduction of EPC 2000 has resulted in this claim format being considered to be acceptable for subsequent novel medical uses, as well as novel non-medical uses of known compounds. With this claim format being considered to be allowable for claims directed to medical uses of known compounds, "Swiss style" claims may effectively become redundant in Europe.

New Addition To The Epc Countries

As of 1 January 2008 Norway will become the 33rd country to be included within the bounds of the EPC. Norway has been a party to the EPC since its inception in 1973, but has only recently decided to fully accede to the convention. For patent applicants wanting to file in Norway this is likely to result in significant cost savings because of the streamlined regional examination and grant procedures associated with the EPC.

When planning an intellectual property protection strategy it is important to keep up to date with the changes in potential markets. An intellectual property strategy should be tailored to each jurisdiction in which you want to gain protection, as well. This also demonstrates that professional intellectual property advice should be sought early in order to realise all options for the commercialisation of intellectual property.

A reminder: if you have any queries regarding patents, or indeed any form of intellectual property, please direct them to:

Patent Proze
Baldwins
PO Box 852, Wellington

Email: email@baldwins.com



Blair Hesp of Baldwins specialises in chemistry and biotechnology patents. Blair joined Baldwins in 2006. He has a PhD in pharmacology from the University of Otago as well as a NZDipBus with a management focus. Blair is currently studying towards a law degree and registration as a patent attorney.