

Conclusion

Where does this leave us in the UK? I would summarise it this way. Recent attempts by trial judges in *Lundbeck* and *Conor* to limit the scope of monopolies or deny them altogether in the light of the judges' assessment of the technical contributions made by inventors have not met with favour on appeal. Certainly there is no room to distinguish between goals which are obvious and those which are not. A person who finds a way of making a product which is an obvious goal is entitled to a claim to the product and not just his way of making it. And the first person to make a new product and propose a plausible use for it appears to be in a strong position to contend for a monopoly which covers all uses, whatever the technology.

The benefit of this approach is that it provides certainty. But does it do so at the expense of fairness?

References

- 1 A Judge of the High Court, Chancery Division and Senior Judge of the Patents Court
- 2 [2007] RPC 729 (Pat); [2008] RPC 437 (CA); [2009] UKHL 12
- 3 [2006] RPC 28 (Pat); [2007] EWCA Civ 5 (CA); [2008] UKHL 49
- 4 [2008] RPC 29 (Pat)
- 5 [1997] RPC 1
- 6 [1994] OJEPO 653
- 7 *Kirin-Amgen* [2005] RPC 169 at paras 88-91
- 8 Interestingly, **Lord Mance** also observed at [45] of his speech in *Lundbeck* that the concepts of inventive step and technical contribution appear to have been treated by **Lord Hoffmann** in *Biogen* as effectively synonymous.

Note from Alan White (Honorary Member)

This lecture is a very interesting and valuable addition to the debate whether 'over-broad' claims may be attacked, and if so how. It greatly supplements several other articles in recent issues of this *Journal*.

From the depths of my memory, I recall that, when the EPC was being drafted in the mid-1970s I noted that the provision for patent revocation on the ground of lack of fair basis for the claim (as contained in the UK Acts since 1932) was not included in the draft EPC. I understood that the UK delegation raised this point, but that it was dismissed (by the German delegation?) as 'unnecessary because no examiner would ever grant an over-broad claim'. Consequently, granted claims which may be over-broad must now be attacked for other reasons, particularly lack of novelty, obviousness and/or insufficiency – and perhaps in the future more simply for lack of statutory invention, as variously illustrated by the cases discussed in this *Kitchin* lecture. and see also the article by **Daniel Brook** and **Florian Gerhardt** (June [2009] *CIPA* 396) on differing decisions – although currently under appeal – on the same facts by different EPC courts.

This is a debate which will no doubt continue with the advantage that readers of this *Journal* will still be able to find its contents thought-provoking and interesting, although more difficult to predict to clients what the courts are likely to decide in a particular situation.

Oh I do like to be beside the seaside – or somewhere beyond the sea there's sun, sand and JEB exams



By **Professor Ruth Soetendorp***

'It was always going to be a challenge to impart so much information with so little contact time. But the format of the [Bournemouth] course provided ample structure to plan home study around for those who were motivated. I was impressed by the quality of the guest speakers and enjoyed taking part in some of the optional activities such as the debate on Digital Britain. The course did an excellent job of 'jump starting' my career in the patent profession. It was a stimulating and usefully comprehensive overview of intellectual property law and some of the current issues surrounding it.' **Simon J. Mitchell** PhD, Schlich & Co.

Close your eyes, think 'Bournemouth' and what do you imagine? Sea, sand and surfing? Or political party conferences and zimmer frames? You are less likely to picture one of the UK's top new universities¹. And probably even less likely to imagine Bournemouth as the well-established provider of intellectual property postgraduate education, accredited by CIPA and the JEB, and home to the internationally renowned² Centre for Intellectual Property Policy & Management (CIPPM).

Anyone wanting to benefit from CIPPM inspired postgraduate IP programmes had to be committed to a year of full-time study by the seaside. But all that has changed in the last couple of years. Thanks are due to the serendipitous conjunction of two unrelated developments.

CIPA took a long hard look at foundation level education for patent attorneys. The Sherr report³ identified the need for CIPA to expand provision, and to improve quality of the

product on offer to trainees. The key aim of the report was to 'determine ways of increasing the numbers of qualified professionals whilst maintaining the standards and rigour of current selection techniques'. At the same time higher education institutions were exploring the potential of blending face-to-face education with online and distributed learning.

CIPA and Bournemouth established a dialogue with a view to designing a programme that would enable trainee patent attorneys to study for and achieve success at the Foundation stage of training – without having to spend a year away from the office, albeit enjoying the delights of sandcastles and the pier.

The process began with a close and critical examination by CIPA/JEB of Bournemouth's postgraduate provision in the field of IP. The LLM IP had been running since 2000 and alumni had progressed to successful careers as patent attorneys, trade mark attorneys, technology transfer managers, and legal IP specialists. Bournemouth received CIPA/JEB accreditation in 2005.

In 2006, the CIPPM team began to look critically at an uncomfortable statistic. However, well received and successful our programme, we were not convincing significant numbers to make the journey South and West.

Our findings are that the trainee patent attorney is a young adult who has achieved a first and second degree, and often completed their PhD, through full-time study. They have work and possibly family commitments. The Foundation level of training is an important stage in achieving their chosen career goal. But it does not have to be embedded in an LLM, nor does it have to be full-time.

In 2007, the first cohort signed up for the Post Graduate Certificate in IP at Bournemouth. Designed to run from January to April, with assignments and examination taking the study period through to June, 25 students signed up for a programme in which design had been radically revised, whilst content and quality remained at the same high level.

Students now learn from a combination of online learning, face-to-face lectures by CIPPM faculty, expert break lectures from practice and industry, and master-classes from practitioners of high repute.⁴ **Gwilym Roberts**, of Kilburn & Strode, said after his master class on professional patent practice:

What a lively and engaged group of students. This is a very effective combination of distance and direct teaching, and I feel the students appreciated being able to bring examples from their current work experience to reinforce their classroom learning.

Attendance in Bournemouth is required over three weekends, from Thursday afternoon until Saturday evening.

In between the block periods, the students engage in 'e-tivities'. These are online learning exercises in which the students learn from their own preparation and from sharing with colleagues, much as they might from traditional seminar participation. The e-tivity model, devised by **Prof Gilly**

Salmon⁵, inspired the format used by the CIPPM team. Along with essays and examination papers, the e-tivity postings are available for scrutiny by CIPA as part of its quality assurance processes. Recent graduates share their experience of this style of learning:

'Approached with the respect it deserves, the steep learning curve turns out to be a positive challenge, even fun in places. Have no doubt, to begin with, the volume and complexity of the subject will take your breath away. As the weeks pass though, the numerous e-activities and intensive study weekends build, layer upon layer, to form that lasting understanding of IP that you will draw upon and develop.' **Amanda Fasola** (PGDip IP 2009 cohort), Senior Intellectual Property Officer, States of Guernsey.

'Anyone contemplating taking the course would need to be prepared to work hard, be prepared to be challenged, be prepared to think for yourself, be prepared for some fun and new friends too.' **Matthew Rose** PhD, Inverness Medical International.

We are delighted to report that the course was oversubscribed for this year's (2008/09) cohort. Students came from all corners of the UK, including Cornwall and the Scottish Highlands.⁶ Employers have a number of reasons for choosing Bournemouth for their trainees. **John Ogier**, Registrar of Intellectual Property for the States of Guernsey comments:

The learning experiences and tools provided by Bournemouth University add considerable value to the

References

- 1 The Guardian University Guide 2009 & 2010: www.guardian.co.uk/education/table/2009/may/12/university-league-table
- 2 The Centre for Intellectual Property Policy & Management (CIPPM), www.cippm.org.uk, has received grants from Economic & Social Research Council (ESRC), Art & Humanities Research Council (AHRC), Arts Council, Leverhulme Trust, the European Commission, UK-IPO, EPO. In 2005, CIPPM won the Informa IP World leaders award for best contribution to IP education. It is consistently ranked among the top three intellectual property centres in the UK.
- 3 **Sherr A**, and **Harding R** 'Where science meets law' Report of the Education, Training and Examinations for the Chartered Institute of Patent Agents and the Institute of Trade Mark Attorneys, 2002
- 4 Tutors and contributing experts in spring 2009 included: **Professor Martin Kretschmer**, **Professor Ruth Soetendorp**, **Professor Ruth Towse**, **Christine Rinik JD** (all Bournemouth University), **Dr Ian Hartwell** (Maguire Boss), **Professor Paul Cole** (Lucas & Co.), **Alice Gould** (Wedlake Bell), **Mr Justice Arnold**, **Tim Frain** (Director of IPR, Regulatory Affairs, Nokia), **Richard Howson** (Kilburn & Strode), **Gwilym Roberts** (Kilburn & Strode), **Neville Walker** (IPconsult), **Dr Rosie Stoakes** (Head, European Intellectual Property Department, Sony).
- 5 **Professor Gilly Salmon** (Professor of e-learning and learning technologies, University of Leicester www.atimod.com/profile/gsalmon.shtml)
- 6 The 2007/08 and 2008/09 cohorts included 11 students (out of a total of 50) with doctorates. Sponsoring employers included: AstraZeneca, N.J. Akers & Co, D. Young & Co, Environment Agency, Franks & Co, GlaxoSmithKline, Johnson & Johnson, Leeds University, Marks & Clerk, JP Morgan, Nokia, Oxford University, Schlich & Co, Scott & York, States of Guernsey, 3M UK, Unilever
- 7 <http://onlineservices.bournemouth.ac.uk/Courses/Course.aspx?course=437&code=LLMIP>

achievement of the Post Graduate Certificate in Intellectual Property through this centre. Expert sessions, practitioner tuition and insights give a significant commercial edge to the qualification. *myBU* (the online student virtual learning environment) is more than a means of communication. It also drives students to actively seek and drill out electronic information for research and support purposes. Both of these aspects to the course are important factors for employers when considering the Post Graduate Certificate in Intellectual Property through Bournemouth University. The successful students, their colleagues and senior team members, should all expect to enjoy the benefits of this intensive course of study.

You may now be thinking that the Bournemouth programme is the right one for your trainees. You will want more information. Programme details for spring 2010 are available on the BU website.⁷ Further information about the Centre for Intellectual Property Policy & Management is available at www.cippm.org.uk. Contact e-mail: askBUenquiries@bournemouth.ac.uk for further information, or to arrange a discussion with **Prof Martin Kretschmer**, Director of CIPPM, and programme leader.

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Secondary indicia



By **Nicholas Macfarlane**
(Associate)*

Over the years there has been a pendulum swing this way and that as to how to treat what is known as secondary indicia in relation to inventive step. Secondary indicia is the fancy term for the invention story and the reaction to it when it was disclosed; it encompasses the effort of others and commercial success. In the *Mölnlycke AB v Procter & Gamble*¹ case, **Nicholls VC** told us that secondary evidence had to be kept in its place. A clear signal that primary evidence should be listened to and given greater weight than the secondary indicia. After all, the law is plain in **section 3 of the Patents Act 1977** where it says 'an invention shall be taken to involve an inventive step if it is not obvious to a person skilled in the art having regard to any matter which forms part of the state of the art...'. Assessing the inventive step is the job of the judge, but this is via the assistance of a legal construct, the skilled addressee which in turn relies on the evidence of a hired expert. It is a theoretical process rather than one which relies on hard evidence.

However, at the other end of the pendulum swing we have **Whitford J** in *Lucas v Gaedor*² saying 'In all these cases I am, for my part, of the opinion that the question of obviousness is probably best tested, if this is possible, by the guidance given by contemporaneous events'.

The expert's evidence in court

The problem comes when you have to find the person who is ordinarily skilled in the art to come and testify in court. These people may be ordinarily skilled in the art (and quite often they are rather more skilled than 'ordinarily' skilled) but they have probably never addressed the problem that is being addressed in the patent. They are being asked to put themselves back into a position when the invention was made (more properly the priority date) and asked whether an invention is obvious or not in the light of certain prior art that has been dug out by lawyers and technicians which is then said to be relevant prior art.

Where inventive step is an issue each expert witness will be saying the opposite to each other, which is hardly surprising. Often patent

cases become mere battles of the experts. Of course they are cross-examined and the judge can assess the expert witnesses and their credibility and most importantly the reason for their views. However, there is an almost inevitability as to what each will say, given the fact that they are on opposite sides. Given that this is the case, it is difficult to see why secondary indicia have recently been relegated in importance. The criticism is that secondary indicia do not necessarily indicate invention because the relevant prior art may not have been before the various people involved in generating the evidence around the invention story. The skilled addressee is taken to have seen the cited prior art and so evidence of contemporaneous reaction is of less relevance where the reaction is that of a person who has not seen the cited art. Accordingly, the **Nicholls** approach, whilst strictly correct, does not necessarily get to the truth of the matter because the experts in the case themselves are tainted. The experts have seen the patent and have had the prior art presented to them. All of which brings in **hindsight**. They know what