

# Bird & Bird & IP and IT Law Bytes

*First published in the July 2014 issue of PLC Magazine and reproduced with the kind permission of the publishers. Subscription enquiries 020 7202 1200.*

## Trade marks: likelihood of confusion

### Summary

The European Court of Justice (ECJ) has held that there was a likelihood of confusion between BIMBO DOUGHNUTS, applied for as a Community trade mark (CTM), and the earlier Spanish word mark DOGHNUTS.

### Background

A trade mark will not be registered if, among other things, because of its identity with or similarity to an earlier trade mark, and the identity or similarity of the goods or services covered by the trade marks, there exists a likelihood of confusion on the part of the public in the territory in which an earlier trade mark is protected (Article 8(1)(b), CTM Regulation (207/2009/EC)) (Article 8(1)(b)).

In *Medion AG v Thomson Multimedia Sales Germany & Austrial GmbH*, the ECJ held that, where goods or services are identical, confusion may be likely if the offending sign consists of a company name in combination with a third party's registered mark of normal distinctiveness that has an independent and distinctive role in the sign, without necessarily constituting the dominant element ([www.practicallaw.com/o-201-4769](http://www.practicallaw.com/o-201-4769)). In such cases, the public might be led to believe that the goods or services derived from companies that were, at the very least, linked economically, which would be sufficient to establish a likelihood of confusion.

### Facts

B applied to register BIMBO DOUGHNUTS as a CTM for "pastry and bakery products, specifically doughnuts" in class 30. P opposed the application based on its earlier Spanish word mark DOGHNUTS, registered for "pastry products and preparations" and "round-shaped dough biscuits" in class 30, relying on Article 8(1)(b).

The Office for Harmonisation in the Internal Market (OHIM) Opposition Division and the OHIM Board of Appeal upheld the opposition. The OHIM Board of Appeal concluded that, for the average non-English-speaking Spanish consumer, the word "doughnut" did not describe the goods nor their qualities, but would be perceived as a foreign or fantasy term. On appeal, the EU General Court also upheld the opposition, concluding that there was a likelihood of confusion. B appealed to the ECJ.

### Decision

The ECJ dismissed the appeal. The likelihood of confusion on the part of the public must be assessed globally, based on the overall impression given by the marks, taking account, in particular, of their distinctive and dominant components. The assessment of the similarity between two marks had to be made by examining each of the marks in question as a whole, not taking just one component of a composite trade mark and comparing it with another mark.

The overall impression conveyed to the relevant public by a composite trade mark could, in certain circumstances, be dominated by one or more of its components. However, it was only if all the other components of the mark were negligible that the assessment of the similarity could be carried out solely on the basis of the dominant element.

A composite sign that included the name of a company might retain an independent distinctive role in the composite sign, so that the public attributes the origin of the goods or services covered by the composite sign to the owner of that mark. However, a component of a composite sign did not retain "an independent distinctive role" if, together

with the other component or components, that component formed a unit having a different meaning as compared with the meaning of those components taken separately.

ECJ case law after *Medion* had confirmed that there was no derogation in that judgment from the general principles governing the assessment of the likelihood of confusion.

The ECJ rejected B's argument that the General Court had automatically inferred a likelihood of confusion from the fact that the "doughnuts" element had "an independent distinctive role", without taking into account other factors, such as the fact that BIMBO was a trade mark with a wide reputation in Spain for the relevant goods. Its reasoning showed that it had carried out a global assessment of the likelihood of confusion and that it took into account the factors specific to the case.

B argued that the strength of a widely known trade mark, which formed the first element of a composite mark, normally served to prevent the overall impression produced by the composite mark from being perceived by the relevant public as attributing the origin of the goods to the owner of the earlier mark or to economically linked undertakings. The ECJ rejected this argument, saying that it was based on a misinterpretation of the case law.

The ECJ also rejected B's argument that, in assessing the likelihood of confusion, the General Court did not properly take account of the fact that (in contrast to common practice in the commercial sector concerned in *Medion*) it would be very unusual, in the bakery sector, to enter into commercial agreements or associations for the purposes of offering goods.

## Comment

The decision puts the concept of an "independent distinctive role" in composite marks in perspective, making clear that the purpose of examining whether components in a sign have such a role is to assess how they will be perceived by the relevant public, in order to determine which components contribute to the overall impression made by the sign on that public. This exercise is undertaken before the global assessment of confusion of the signs, which is based on the overall impression the signs produce, and therefore does not involve an exception to the general rule that a consumer normally perceives a mark as a whole.

A finding that Spanish consumers will be likely to confuse BIMBO DOUGHNUTS with DOUGHNUTS may be surprising to English speakers. Under proposals to reform EU trade mark law, signs that are descriptive in an EU Member State will not be registrable in any member state ([www.practicallaw.com/3-526-6192](http://www.practicallaw.com/3-526-6192)). Under the new rules, therefore, a descriptive term such as MATRATZEN (German for mattress) would not be registrable in Spain (or any other member state) for mattresses.

*Case: Bimbo SA v OHIM C-591/12 P.*

## Copyright: website-blocking injunctions

### Summary

The European Court of Justice (ECJ) has ruled on a question of jurisdiction under the Brussels Regulation (44/2001/EC) in proceedings for copyright infringement.

The High Court has ordered several major film studios to block access to four film and television programme streaming websites, under section 97A of the Copyright, Designs and Patents Act 1988 (CDPA) (section 97A).

### Background

Section 20 of the CDPA, implementing Article 3 of the Copyright Directive (2001/29/EC) (Article 3), provides that the communication to the public of a copyright work is an act restricted by the copyright in a literary, dramatic, musical or artistic work, a sound recording, film or broadcast. Communication to the public means a communication to the public by electronic transmission and includes broadcasting the work, and making the work available to the public by electronic transmission so that the public may access it from a place and at a time individually chosen by them (section 20(2), CDPA).

If the four jurisdictional requirements for section 97A are satisfied, an injunction can be obtained against an internet service provider (ISP). These are that: the defendants are ISPs; the users or the operators of the websites infringed copyright; the users or the operators of the websites used the defendants' services to infringe; and the defendants had actual knowledge of the infringement.

In *Paramount Home Entertainment International Ltd and others v British Sky Broadcasting Ltd and others*, the High Court ordered the six main UK ISPs to block access to two television and film streaming websites ([2013] EWHC 3479).

In *Svensson and others v Retriever Sverige AB*, the European Court of Justice established that the mere provision of access by a hyperlink would normally amount to a communication within the meaning of Article 3, and (if the relevant content was not authorised by the rights owner to be freely available on the internet) would normally amount to a communication to the public (see *News brief "Linking and framing copyright material: guidance at last"*, [www.practicallaw.com/4-558-3665](http://www.practicallaw.com/4-558-3665)).

## Facts

Several major film studios, P, applied for website-blocking orders under section 97A. The defendants, B, were the six main ISPs in the UK. The targets of the application were four websites that provided access to streams of a large range of films and television programmes without the consent of the relevant copyright owners (the websites).

The websites did not host the content, but provided a database that could be searched by users, who would then click on a link to get to the content, which was hosted by third parties. The websites categorised, moderated and provided other editorial oversight over the content. The websites were directed at users in the UK, among other places.

## Decision

The court ordered B to block access to the websites as the four jurisdictional requirements for section 97A were satisfied. B had actual knowledge of the infringement because they had been given advance notice of P's application by email.

In deciding whether the website operators had infringed copyright, the court referred to previous decisions that had widely interpreted the meaning of a communication to the public. The court noted that, where there is a communication:

- That does not use a different technical means to that of the original communication, the communication must be to a new public; that is, a public that was not considered by the authors concerned when they authorised the original communication.
- That uses a different technical means to that of the original communication, it is not necessary to consider whether the communication is to a new public.

At the time of the earlier decision in *Paramount*, it was not certain if the mere provision of a hyperlink would constitute a communication within the meaning of Article 3. The ECJ had resolved this issue in *Svensson*.

Whether the provision of hyperlinks will constitute a communication to the public (when the means of communication is not a different technical means) will depend on whether there is a new public, which, in turn, will depend on precisely what was authorised by the copyright owner at the stage of the initial communication. In this case, the court had already held that the website operators had intervened in a highly material way to make the copyright works available to a new audience.

Referring to evidence about the popularity of the websites in the UK, as advertisements were aimed at the UK market, and English was the default language of each website, the court held that the websites had targeted a sufficient section of the public in the UK.

After considering proportionality and discretion, the balance of the respective rights between the relevant parties came down in favour of granting the injunction.

## Comment

This latest decision in the relatively recent line of cases in which copyright owners have sought website-blocking injunctions under section 97A clearly illustrates the requirements that a copyright owner has to meet to succeed in its application.

*Case: Paramount Home Entertainment International Ltd and others v British Sky Broadcasting Ltd and others [2014] EWHC 937 (Ch).*

## Patents: employee compensation

### Summary

The High Court has rejected an employee inventor's claim for compensation for an invention assigned to his employer, on the ground that the patent had not been of outstanding benefit to the employer.

### Background

For patents applied for before 1 January 2005, section 40(1) of the Patents Act 1977 (1977 Act) (section 40(1)) allows an employee to be awarded compensation where he has made an invention belonging to the employer for which a patent has been granted and the patent is (having regard, among other things, to the size and nature of the employer's undertaking) of outstanding benefit to the employer.

Section 41 of the 1977 Act (section 41) provides that an award of compensation to an employee under section 40(1) in relation to a patent for an invention must secure for the employee a fair share (having regard to all the circumstances) of the benefit that the employer has derived, or may reasonably be expected to derive, from the patent.

### Facts

S was employed by a company within the U group, and was responsible for an invention in a series of related patents (the patents), which was used in blood glucose testing kits. The patents were transferred to an associated company for nominal consideration. That company was later sold to a third party for £103 million. The sale agreement provided for the buyer to receive expected licence payments of £2.9 million.

In 2006, S began proceedings in the Intellectual Property Office (IPO) claiming compensation under sections 40 and 41. Following a number of interim proceedings and an appeal to the Court of Appeal, the IPO concluded that although the benefit to U from the patents was £24.5 million, it was not outstanding. It said that if, contrary to its conclusion, the patents were of outstanding benefit, a fair share of the benefit for S would be 5%. S and U appealed.

### Decision

The court dismissed the appeals, upholding the IPO's decision that the patents were not of outstanding benefit to U, and therefore S was not entitled to compensation under section 40(1).

The court rejected S's argument that the IPO had decided that the benefit that U obtained from the patents was not outstanding because of the large profits that U ordinarily made in the course of its business. The IPO had undertaken a multi-factorial assessment, which included a consideration of the benefit received by U, and the disparity in that benefit from the benefit S received, in the context of the size and nature of U's undertaking.

The court also held that:

- The mere fact that U received a benefit from the patents in a manner and amount that was unusual for it (by licensing and selling the patents rather than by manufacturing) was not, in itself, an indication that the benefit was outstanding.

- Although U had obtained a benefit from the patents with very little commercial risk and at a very high rate of return, the IPO had taken this factor (in S's favour) into account in reaching its overall conclusion.
- The fact that S had gone beyond his brief (although not beyond his contractual duties) was not relevant to whether the benefit to U was outstanding.
- Although U had failed to establish the value of any of its other patents, and so could not rely on this evidence to show that the patents were not of outstanding benefit, it did not necessarily follow that the patents were of outstanding benefit.
- The fact that the patents were among the top 5% of patents generally in terms of revenue generated was not of assistance. A patent might be of outstanding benefit in the context of an employer's undertaking even if it did not stand out among patents generally, and vice versa.
- The IPO had taken the importance of the patents to the sale of U's business into account.

As the appeals were dismissed, the court did not have to make a decision on fair share. However, the court commented that, in the circumstances of this case, the benefit derived by U from the patents would be the benefit net of tax.

The court also said that the "time value of money", which S had argued should be taken into account as U had use of the money until the date of the decision, was not a benefit derived from the patents and so would not have increased the amount of the benefit of which S might have received a fair share. The costs incurred by S in bringing his claim for compensation were also not part of the benefit that U derived from the patents.

The court noted that S had not created a new product for his employer as U never produced a blood glucose test. Nor did S produce a new income stream without any substantial input from his employer. Although S made the invention, the income stream was largely generated by U's licensing department with little input from S.

## Comment

Few claims of this kind have succeeded in recent years. Section 40(1) was amended by the Patents Act 2004 to make compensation payable when the invention, and not just the patent, has been of outstanding benefit. However, the amendments only affect patents applied for after 1 January 2005 and were not relevant in this case. It is uncertain whether the outcome would have been different under the amended section.

The court commented that it was clearly undesirable that a claim of this nature should take seven years to reach a first instance determination. Although the interim proceedings were one factor, the IPO should attempt to ensure that such claims are determined within a reasonable time.

Lawyers or patent agents taking on a claim for employee compensation on a conditional fee agreement basis may prefer to bring the claim in the IPO, where the costs to be paid out if the claim fails are much smaller than if the claim is brought in the High Court. However, the costs awarded if the claim does succeed will also be very much less than the amount expended by the employee, particularly as these cases involve expert accounting evidence.

*Case: Ian Alexander Shanks v Unilever plc and others [2014] EWHC 1647 (Pat).*

## Trade marks: two-dimensional figurative marks

### Summary

The European Court of Justice (ECJ) has held that a figurative mark consisting of a two-dimensional representation of a locking device was invalid for lack of distinctive character in relation to goods such as spectacles cases, luggage and jewellery.

### Background

Article 7(1)(b) of the Community Trade Mark Regulation (2007/2009/EC) (CTM Regulation) (Article 7(1)(b)) prohibits the registration of trade marks that, among other things, are devoid of any distinctive character.

## Facts

L registered a two-dimensional figurative sign depicting a locking device as a trade mark for goods in classes 9, 14, 18 and 25, such as optical apparatus, jewellery, horological equipment, bags and clothing. F applied for a declaration that the mark was invalid because it was devoid of distinctive character, contrary to Article 7(1)(b). The Office for Harmonisation in the Internal Market (OHIM) rejected the application, and F appealed to the OHIM Board of Appeal, which reversed the initial decision and declared the entire registration invalid.

L appealed in relation to the goods in classes 9, 14 and 18. The EU General Court partially allowed the appeal, reinstating the registration in respect of some of the goods at issue in classes 14 and 18 that did not seem likely to incorporate a locking device, such as candlesticks, nutcrackers and leather.

L appealed to the ECJ, asking it to set aside the General Court's dismissal of its appeal in relation to the remaining goods, and to annul the OHIM Board of Appeal's decision to declare the mark invalid. OHIM cross-appealed to have the General Court's decision set aside to the extent that it had annulled OHIM's declaration of invalidity.

## Decision

The ECJ dismissed L's appeal and OHIM's cross-appeal.

The ECJ confirmed that the criteria for assessing the distinctive character of three-dimensional marks consisting of the appearance of the product were the same as those applicable to other categories of trade mark. However, average consumers were not in the habit of making assumptions as to the origin of products on the basis of their shape or the shape of their packaging in the absence of any graphic or word element, and it might therefore prove more difficult to establish distinctiveness in relation to a three-dimensional mark than in relation to a word or figurative mark. Only a mark that departed significantly from the norm or customs of the sector (and so fulfilled its essential function of indicating origin) could have distinctive character for the purposes of Article 7(1)(b).

The General Court had been right to apply the case law relating to three-dimensional marks even in circumstances where (as here) the mark was two-dimensional and represented only part of the product. Just as a figurative mark representing an entire product was not a sign that was independent of the product's appearance, neither was a sign representing only part of a product. If that sign was perceived by the relevant public, immediately and without particular thought, as a representation of a particularly interesting or attractive detail of the product in question (rather than as an indication of its commercial origin) then it would be devoid of distinctive character.

The General Court had correctly assessed whether the sign had distinctive character by applying the test established by case law, taking account of all the evidence in order to consider the overall impression given by the sign, and its capacity to denote commercial origin, when it concluded that the shape did not depart significantly from the norm or customs of the sector concerned.

## Comment

The more closely a mark resembles the shape most likely to be taken by a product, or a part of a product, the less likely it is that it will have distinctive character for the purposes of Article 7(1)(b). The same test (of considering whether the shape departs from the norm) applies to all marks, regardless of whether they are three-dimensional shapes or two-dimensional drawings or photographs of the entire product, or part of it. Where the sign is a three-dimensional shape of a product, objections relating specifically to the shape of products or packaging, can also be raised (*Article 7(1)(e), CTM Regulation*).

As the ECJ pointed out, if an applicant claims that a trade mark is distinctive, despite OHIM's analysis to the contrary, the burden of proof is on it to show that the mark either has intrinsic distinctive character or distinctiveness acquired through use. However, it will be an uphill struggle to show that a commonplace shape, such as a locking device, which is associated with, for example, luggage and bags, will be perceived by consumers as a logo indicating commercial origin, rather than as merely depicting an integral part of the product.

*Case: Louis Vuitton Malletier v OHIM C-97/1 P.*

# Trade marks: refusal to stay UK proceedings

## Comment

In post-judgment proceedings relating to the BETTY BOOP trade marks, the High Court has given summary judgment rejecting claims for a declaration of invalidity based on bad faith, and has declined to stay the UK action in favour of Italian proceedings.

## Background

Where proceedings involving the same cause of action and between the same parties are brought in the courts of different EU member states, any court other than the court first seised must stay its proceedings until the jurisdiction of the court first seised is established (*Article 27, Brussels Regulation (44/2001/EC)*). Where related actions are pending in the courts of different member states, any court other than the court first seised has discretion to stay its proceedings (*Article 28, Brussels Regulation*).

A Community trade mark (CTM) will be declared invalid where the applicant was acting in bad faith when it filed the application for the trade mark (*Article 51(1)(b), Community Trade Mark Regulation (40/94/EC)*) (CTM Regulation).

A CTM court hearing an infringement action will, unless there are special grounds for continuing the hearing, stay the proceedings where the validity of the CTM is already in issue before another CTM court or before the Office for Harmonisation in the Internal Market (*Article 104(1), CTM Regulation*).

Where actions for infringement involving the same cause of action and between the same parties are brought in the courts of different EU member states, one seised on the basis of a CTM and the other seised on the basis of a national trade mark:

- The court that is not first seised should decline jurisdiction where the trade marks concerned are identical and valid for identical goods or services.
- The court that is not first seised may stay its proceedings where the trade marks concerned are identical and valid for similar goods or services or where the trade marks concerned are similar and valid for identical or similar goods or services

(*Article 109, CTM Regulation*).

## Facts

In previous proceedings, the High Court held that A's use of Betty Boop imagery amounted to passing off and trade mark infringement of H's trade marks ([www.practicallaw.com/1-561-9005](http://www.practicallaw.com/1-561-9005)).

A claimed that H's registered trade marks were invalid on bad faith grounds because they represented an illegitimate attempt to obtain monopoly rights in the well-known Betty Boop character and name, and H had "no rights" in that character. H applied for summary judgment.

A then applied for a stay of the proceedings in favour of Italian proceedings that pre-dated the UK proceedings and concerned Betty Boop merchandise, Community trade marks and several Italian trade mark registrations for the same BETTY BOOP image, and issues relating to infringement and validity. A relied on Articles 104 and 109 of the CTM Regulation, and Article 28 of the Brussels Regulation.

## Decision

The court granted H's application for summary judgment regarding invalidity and rejected A's application for a stay of the proceedings.

In its earlier judgment, the court had found that, at the relevant dates, the trade marks were distinctive as the result of the efforts of H and their licensees. It could not be said that H had "no rights" since they had been found to have

rights in passing off; that is, goodwill and a reputation in the UK. H therefore had unregistered trade mark rights at the relevant dates and so A's allegations of bad faith had no prospect of success.

The court found that "cause of action" in Article 109 of the CTM Regulation had the same meaning as in Article 27 of the Brussels Regulation, which required the proceedings in different jurisdictions to: be based on the same facts; depend on the same rule of law; have the same end in view; and involve the same parties. The court held that Article 109 of the CTM Regulation did not apply in this case. The Italian proceedings involved different defendants selling different goods, with different images of Betty Boop. Although the acts were said to infringe the same law and the cases included the same parties, the facts were different.

The court said that the policy behind Article 104 of the CTM Regulation is the avoidance of inconsistent decisions. Where it applies, a stay should be granted unless there were "special grounds" for continuing the hearing in the UK, and it would be a rare and exceptional case where there were special grounds. However, since the UK court had already given judgment both on infringement and on the validity of the CTMs, making an application for a stay at this point in the proceedings was wholly unprecedented and was, indeed, rare and exceptional. The court also declined to exercise its discretion to stay the proceedings under Article 28 of the Brussels Convention.

## Comment

The court criticised both parties for failing to draw the Italian proceedings to its attention until after judgment had been given in the UK proceedings. It inferred that it had suited both parties not to bring the matter to the court's attention because they wanted the English court to rule on the matter, but noted that this did not excuse their failure to do so.

After losing in the UK, A had then changed its mind and decided to raise the Italian proceedings as a way of trying to salvage matters. Since the policy behind the relevant provisions of the Brussels Regulation and the CTM Regulation was to avoid irreconcilable judgments, this would be wholly defeated if parties only took the point after a judgment in the court second seised had been given. Where, as here, an irreconcilable result could no longer be avoided or reduced by staying the UK proceedings, the application to stay would be refused.

*Case: Hearst Holdings Inc and another v A.V.E.L.A. Inc and others [2014] EWHC 439 (Ch).*

## Patents: declarations of non-infringement

### Summary

The High Court has granted declarations of non-infringement for French, Italian, Spanish and UK versions of a European patent.

### Background

France, Germany, Italy, Spain and the UK are parties to the European Patent Convention (EPC). Article 69(1) of the EPC, and the Protocol on the Interpretation of Article 69, provides that the extent of the protection conferred by a European patent or application is determined by the claims. However, the description and drawings may be used to interpret the claims. For the purpose of determining the extent of protection conferred by a European patent, account may be taken of any element that is equivalent to an element specified in the claims.

The relevant provisions of the Rome II Regulation on the law applicable to non-contractual regulations (864/2007/EC) apply to the existence, nature and assessment of damage or the remedy claimed, but do not apply to evidence and procedure.

### Facts

Pemetrexed, a cancer treatment marketed by L, a US company, was protected by a basic patent extended by supplementary protection certificates (SPCs) expiring in December 2015. L also owned a patent for the use of pemetrexed disodium in combination with vitamin B12, which would not expire until June 2021 (the patent).



A wished to enter the market on expiry of the basic patent with a generic pemetrexed product. L was concerned that this product would infringe the patent. A wanted resolution of this issue in a single trial and in good time to enter the market on expiry of the SPCs with respect to the French, German, Italian, Spanish and UK designations of the patent.

A sought declarations of non-infringement (DNIs) of each of those designations of the patent in the High Court. A did not challenge the validity of the patent in these proceedings. L applied for declarations that the High Court did not have jurisdiction in respect of the French, German, Italian and Spanish designations of the patent.

The High Court held that, where there was no challenge to the validity of the patent concerned, the English court had jurisdiction to try an action claiming DNIs of counterparts in other European countries, as well as claiming a DNI of the UK European patent. This decision was upheld by the Court of Appeal ([2013] EWCA Civ 517). A discontinued the proceedings relating to the German designation after a German court held that the use of pemetrexed dispotassium would infringe the designation of the patent on the basis of the doctrine of equivalents.

## Decision

The court granted DNIs for French, Italian and Spanish versions of the patent, as well as for the UK version. The court considered the application of the doctrine of equivalents in all four countries and held that, in each case, the claims that required the disodium salt of pemetrexed did not cover other pemetrexed compounds. There was neither direct nor indirect infringement of those designations.

The law applicable to the question of whether A's proposed acts would infringe each non-UK designation of the patent was the substantive patent law of the relevant country. However, the rules applicable to the grant of a DNI are those of the law of the forum; in this case, English law. Even if that were wrong, the court found that the national rules of France, Italy and Spain would permit the grant of a DNI for each jurisdiction.

Applying English law, the court granted DNIs in respect of those designations under its inherent jurisdiction because A had clearly demonstrated that it had a real commercial interest in obtaining the declarations and they would serve a useful purpose.

The court disagreed with the German Court's decision on the doctrine of equivalents, noting that it had considered the matter solely from the perspective of the oncologist (and not also of a chemist) and did not have regard to the prosecution history (which limited the claims in this case).

The court also said that, while there is no doctrine of prosecution history estoppel in the UK, where the prosecution history shows clearly why the claims are expressed in the manner in which they are to be found in the granted patent rather than in some broader manner, consideration of the prosecution file may assist in ensuring that patentees do not abuse the system by accepting narrow claims during prosecution and then arguing for a broad construction of those claims for the purpose of infringement. Here, the prosecution history shed light on the correct interpretation of the claims as L had deliberately limited the claims by amendment to pemetrexed disodium to meet the examiner's objections.

## Comment

This is the first time that the UK High Court has exercised cross-border jurisdiction in relation to foreign designations of a European patent. It paves the way for parties to bring proceedings in relation to multiple designations of European patents in a single court, provided that validity is not in issue.

The decision also demonstrates how different decisions can result from different procedures; in particular, from the lack of oral evidence and cross-examination in Germany, and from the lack of consideration of how a construction derived in infringement proceedings would impact on validity, a result of the bifurcation of these issues in the German system.

The court undertook a detailed consideration of the laws and rules of France, Italy and Spain on the grant of a DNI. In that respect, the case foreshadows the Unified Patent Court system which, when it is in operation, will likewise necessitate consideration of the patent laws and procedural rules of more than one country.

This long judgment sets out clearly the current state of patent law on several areas and develops it in relation, for example, to prosecution history as an aid to construction. English courts have been reluctant to consider this in construing claims, and, while the UK, unlike the USA, still has no formal doctrine of file history estoppel, in suitable cases, the prosecution history may assist in claim construction.

*Case: Actavis UK Ltd and others v Eli Lilly & Co [2014] EWHC 1511 (Pat).*