Anderson Law LLP training contract 2014 answers.

Question 1 - Unitary Patent and Unified Patent Court

Answers

Question 1

(What follows here is no more than a simplistic outline.)

- A national patent in the United Kingdom, under the Patents Act 1977 and under the national law of each country which the inventor wishes to make an application;

- A set of national patents (called a 'European Patent') following an application under the European Patent Convention. The application is made to the European Patent Office in Munich, who handle all stages of the patent application through to grant. The inventor specifies in the application which countries she wishes the European Patent to be granted in. On grant, the inventor will have, in effect, a national patent for each country she specified in her application;

- A set of national patents following an application under the Patent Co-operation treat. The application is made to the World Intellectual Property Organisation in Geneva, which processes the application through its initial stages, and then the application is transferred to national patent offices for further processing through to grant.

Question 2

- It is an extension/development of one of the methods described in the answer to question 1: the European Patent under the European Patent Convention. That is it is necessary for the inventor first to apply and obtain an European patent (see e.g. Regulation 1257/2012, articles 2(a), 9(a)), and then specify she wishes to obtain a Unitary Patent;

- But it is also a new type of patent protection, as it is not a collection of national patents (subject to national laws as to legal effect and operation). The Unitary Patent operates under its own legal regime, and benefits from the same protection throughout the EU (see e.g. Regulation 1257/2012, recital (7));

Question 3

There are two legislative measures:

- Regulation (EU) No 1257/2012 of the European Parliament and of the Council of 17 December 2012 implementing enhanced cooperation in the area of the creation of Unitary Patent protection; and

- Council Regulation (EU) No 1260/2012 of 17 December 2012 implementing enhanced cooperation in the area of the creation of Unitary Patent protection with regard to the applicable translation arrangements.

The first Regulation deals with the creation of the Unitary Patent, while the second deals with translation requirements.

Question 4

- The European Union/Commission does not grant the Unitary Patent.

- The European Patent Office grants the Unitary Patent. As mentioned above, the first step is for the EPO to grant an European Patent, and then if the applicant for the patent wishes, for the EPO to grant/register the Unitary Patent (see Regulation 1257/2012).

Question 5

It is established by an 'Agreement on a Unified Patent Court' dated 19 February 2013. Ie not by a directive, regulation etc of the EU.

Question 6

- It is not in force yet.

- In order for the agreement to be force (see Article 89 of the Agreement), one of the following need to occur (whichever is the latest):

  - On 1 January 2014;

  - When the 13th member state has ratified the agreement; or

  - by accession (in accordance with Article 84 of the Agreement);

- There are other conditions too, such as three of the states ratifying/acceding need to have the highest number of European patents in the year preceding signature of the agreement, etc.

- Currently 4 members states have ratified the agreement.

- To see which member states have ratified the Agreement on a Unified Patent Court visit: http://ec.europa.eu/internal_market/indprop/patent/ratification/index_en.htm.

Question 7

- Unless the Agreement on a Unified Patent Court comes into force then Regulation 1257/2012 will not apply (see Regulation 1257/2012 art 18(2)).

- The other condition in Regulation 1257/2012 art 18(2) no longer applies.

Question 8

- The Intellectual Property Act 2014.

- Section 17 of the 2014 Act inserts sections 88A and 88B into the Patents Act 1977.

Answers

General point: the following are *some* of the points that can be made, not all of them.

Question 1

- The student is not right. A contract is not necessary so that the app developers have to keep secret (i.e. confidential) information about iShared that she has provided to them. An obligation to keep information secret (i.e. confidential) can be inferred from the circumstances in which her information was provided to the app developers.

- An obligation confidentiality can be imposed as long:

    o information about iShared is not publicly known;
    o the information was imparted in circumstances which give rise to an obligation of confidentiality; and
    o the student would suffer (financial) harm if an app developer (mis-)used her information;

- [*Coco* v. *AN Clark Engineers Ltd* [1969] RPC]

- As long 2.1 and 2.3 are true, then we need to look at the circumstances in which her information was provided to the app developers to see whether an obligation arises.

- *Argument(s) in favour of the app developers being under an obligation to keep information about iShared secret*:

    - principally that her email/conversation states that the app developers should not tell anyone else about information about iShared (and an app developer would be aware of that requirement by reading the email from the student); and

    - of lesser of importance she makes it clear that the use of the information about iShared is only for a particular purpose ('buy the right to use them').

- *Arguments against the app developers being under an obligation to keep information about iShared secret*:

    - if there was no form of communication prior to her email then the email may amount to an unsolicited communication - that may make it less likely that an app developer would be obliged to keep information about iShared secret.

- More generally, without a contract, an obligation of confidentiality can arise as described in 2. above, and is one of the two ways an obligation can arise - as an equitable obligation (the other being by express agreement).

- *Other discussion points* The amount of information that the student has given (or which is available) is not large and it is not possible to give a definite answer, but:

    - if an app developer has responded to the email from the student and the app developer and the student have subsequently entered into negotiations for the app developer to get a

licence to use iShared then it is more likely that the app developer will be subject to an obligation to keep information about iShared confidential;

- practically the student should not be disclosing any further information about iShared until has entered into a confidentiality agreement with any other app developers she wishes to contact; and

- also practically, with any app developers she has already contacted do come back to her, then before discussing anything further with them, she should entered into a confidentiality agreement with them.

Question 2

- The fact that iShared contains or is based on some publicly available techniques is not enough, by itself, for confidentiality to be destroyed;

- If iShared does contain or is based on some publicly available techniques she will need to haves used her skill as well as (considerable intellectual) effort to create iShared (together with the publicly available techniques) for it to amount to confidential information;

- Another way of looking at it would be if someone else who had access to the publicly available techniques. Would they need to carry out the same amount of effort in understanding the iPhone's operating system and have knowledge of programming techniques etc to the same extent as the student and be able to use them together with the publicly available techniques in order to create iShared? If the answer is 'yes', then the likely result is iShared will be classified as confidential information.

- However, if another person only had to simply spend a lot of time compiling or combining various publicly available techniques without any particularly skill or knowledge then iShared may not be confidential.

[*Coco* v. *AN Clark Engineers Ltd* [1969] RPC, *Saltman Engineering Co Ltd v. Campbell Engineering Co Ltd* [1963] 3 All ER 413; *Ocular Sciences Ltd* v. *Aspect Vision Care Ltd* [1997] RPC 289]

Question 3

- Any disclosure of information about iShared other than under obligations of confidentiality is likely to be destroy its 'novelty' (one of the essential requirements being that an invention is 'new' in order to obtain a patent). A disclosure makes it part of the 'state of the art'. The 'state of the art', in crude terms, is information made available to the public. Often any disclosure is sufficient to destroy 'novelty' (even if the disclosure is only to one person).

- The only way that she can disclose information about iShared is under an obligation of confidentiality. Preferably a written confidentiality agreement. If she does make a patent application and there is subsequently a challenge from someone else that iShared is not new because she has disclosed information about before making her patent application, then the onus is on her to show that she has done so under obligations of confidentiality. Written confidentiality agreements can be useful evidence.

- There are many cases concerning what information regarding an invention has to be disclosed before novelty is destroyed (i.e. if some information is disclosed which, very crudely, is not

sufficient for 'someone skilled in the art' to recreate iShared, then novelty may not be lost and therefore the ability to obtain an patent may not be lost)). [Section 2, Patents Act 1977]

- Generally: Just because information about iShared is secret is not sufficient to make it patentable.

Question 4

- There are a number of things she should consider doing:

  - As stated in the answer to Question 1, a contract is not necessary for an app developer to be under an obligation to keep secret the information about iShared. However it is the best way of protecting the secrecy, as a contract can explicitly state what the obligations are on app developer (as to what the app developer can and cannot do with the information as well as getting the app developer's explicit agreement to keep the information secret).

  - Therefore, before revealing any substantive details about iShared she should always enter into a confidentiality agreement. (If she is serious by obtaining a patent for iShared, she should consider not revealing any information about iShared until an application for a patent is made.)

  - A confidentiality agreement does not need to be lengthy or too detailed but at a minimum should always contain the following:

    - to require that the app developer keep information about iShared secret and confidential; and

    - to require the app developer to use the information about iShared only for a specific purpose (which should be specifically stated, i.e. for the purpose of negotiating a further agreement, the right to use iShared); and

    - to require the app developer not disclose the information about iShared to any other person.

  - Also of critical importance before providing any information about iShared the student should have in her possession the copy of the confidentiality agreement signed by an app developer.

  - Other things she should consider before entering into a confidentiality agreement:

    - she should only reveal limited information about iShared, ie with no technical details or information about how it works etc; and

    - she should carry out some due diligence on the person/company who wishes to see the information about iShared.

  - Lastly, it should be pointed out to her, that even with a confidentiality agreement in place, the the secrecy of iShared is not guaranteed. If an app developer publicly reveals information about iShared etc then the onus would be on her taking legal action, and quickly. She should also bear in mind, even if she has a contract in place with the app developer concerned, any remedy by a court is discretionary. Such legal action is likely to be

vary expensive in England, and if the app developer is located in another country than may be procedurally difficult to undertake (and even more expensive). She may also wish to consider whether there are technical solutions so that sufficient details are provided about iShared but not the core code or concept or details of the central idea behind iShared.