

EIP

A Year in Patents - Part 3/4: The Procedures of International Patent Prosecution

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A mulberry tree near my current home reminds me of my childhood. The smell, texture, and taste of mulberries (मलबेरी in Hindi, pronounced ~~shad~~-toot) evoke some of my earliest memories from the Himalayan region of Jammu & Kashmir. I have lived in the UK for long enough to feel at home, yet, when I find myself missing India, that mulberry tree becomes my source of solace. Only a small minority of patent professionals in the UK are of South Asian heritage. Thankfully, the lack of diversity in the field has been recognised: the professional network IP Inclusive, for instance, supports initiatives such as "IP & ME," a campaign that assists and inspires ethnic minorities to enter and practice within IP professions. It gives me joy and pride to see individuals of South Asian and other minority backgrounds in leadership positions in my own firm.

In addition to the geographies that shape people's lives, the mulberry tree makes me think of the geographies of intellectual property protection. The influence that the geographical features of a given region have on the quality of a final product sometimes directly inform the product's IP protection. Various international treaties define Geographical Indications (GIs) as a category of protection to products with a specified geographical origin and with qualities or a reputation linked to that origin. In India, traditional sarees made from mulberry silk often have geographically specific weaving patterns, brocades, and motifs, such as those in the Kanchipuram or Banarasi style, and are protected by GIs. Interestingly, trademarks are not the appropriate registration for

geographically specific products, because trademarks need to be, among other things, non-descriptive; place names, obvious indicators of geographic origin, are considered descriptive. Thus, products such as champagne, from Champagne, France, or parmesan cheese, from Parma and Reggio Emilia in Italy, are not protected under trademark law but as Products of Designated Origin, a type of Geographical Indication of the European Union.

At the end of the British mulberry season, in September, I will begin studying for a Postgraduate Certificate (PGCert) in Intellectual Property Law at the Queen Mary University (QM) in London. The course is designed to provide trainees with robust basic knowledge on legal topics ranging from fundamental concepts in English law to specialist topics relating to patents and other aspects of intellectual property law. The QM course is one of several routes by which trainees to progress to the UK Final Exams set by the Patent Examination Board (PEB). Alternative routes include other PEB-accredited courses such as those run by Brunel University and Bournemouth University, and a set of Foundation Exams set by the PEB itself. The QM course is a popular choice for trainees based in London, and most candidates enrol on the course a year or so into their traineeship. It has become common practice for firms to sponsor trainees' attendance of the course, which runs from September to Christmas, with exams soon after, in January.

I am often asked whether training as a patent attorney in London restricts me to practice in the UK. The impacts of Brexit have certainly not left the legal sphere unaffected, but a comforting fact is that the UK remains a signatory of the European Patent Convention (EPC). Membership of the EPC means that the UK remains a state where patents granted by the European Patent Office can be validated. It is standard practice to qualify as both a Chartered (UK) Patent Attorney and a European Patent Attorney in parallel. Although the routes to qualification are separate, there is overlap in the curriculum: candidates who have passed certain European exams are exempt from taking the corresponding UK Final Exams. In recent years, the format of the European exams has been debated frequently. What should the exams test exactly? Should the examined content pertain more to historical and theoretical knowledge in the field, or to scenarios related to day-to-day practice? Notwithstanding its continuing membership of the EPC, as a non-member of the EU, Britain has had to withdraw its membership of the Unified Patent Court (UPC), the transnational court which opened in June this year. Maintaining branch offices—or at least collaborations with partners—in EU countries allows UK-headquartered firms like mine to participate in litigating cases at the UPC.

Qualifying as a dual UK and European patent attorney is valuable, as both jurisdictions are important commercial markets for innovative companies around the world. While various international treaties such as the Paris Convention and the Patent Cooperation

Treaty (PCT) have considerably harmonised patent laws around the world, they have not diminished the value of specialised qualified patent attorneys, whose expertise is crucial in navigating the significant jurisdictional differences in the rules and procedures of patent prosecution in various places. On the one hand, a UK patent firm may assist in prosecuting patents entering the UK and Europe after being drafted in another country, and on the other hand may instruct the filing and prosecution of patents internationally for inventions originating in the UK. My firm, EIP, specialises in direct client work, meaning that we have direct contact with inventors and/or their employers, who may be based in the UK, Europe, or the US, which is made possible by the firm having branches in the US, UK, Germany, and Sweden.

The close-knit nature of British and European patent statutes and conventions means that patent attorneys in one region a close watch over movements in the other. For instance, as a trainee working on mathematical and software inventions in London, I frequently study and analyse trends in the decisions made by the EPO. I have found that understanding trends in appeals is particularly valuable for forecasting future patterns of examination and decision-making. At the EPO, appeals against decisions of technical merit are passed to the Technical Boards of Appeal, each consisting of a group of reviewers specialised in the technical field of the invention. For cases with particularly important legal implications, the Technical Boards may raise questions to the Enlarged Board of Appeal, the highest level of authority within the EPO. One recent decision on an appeal concerned an area related to my own research expertise, setting a precedent for the patentability of computer simulations. Not unlike science, law also evolves through the repeated application of established principles, until a disruptive case comes along to challenge prior understanding and thereby motivates novel interpretations.

Of the various jurisdictions in the world, Europe is considered by many to be one of the most challenging to patent in. The reputation stems from the fact that the EPO applies strict criteria as to the type of innovation that is patentable, and that which is not. These criteria frame prosecution work, that is, the process of preparing responses to objections raised by the examiner. Prosecution often involves several rounds of back and forth between attorney and examiner, with arguments drawing from combinations of legal interpretation, logical reasoning, and scientific understanding. In a recent case I worked on, the patent examiner identified a pure mathematical paper which appeared to dispute the patentability of the application that had been filed. My task, then, was to dig deep into the concepts and proofs explained in the paper, in order to prepare a counterargument and overcome the objections raised by the examiner. The task was hugely enjoyable given my longstanding fascination with pure mathematics. Previously, as an academic working on astrophysical fluid dynamics, pure mathematical problems were limited to fleeting

conversations over tea with colleagues; now, as a trainee patent attorney, I enjoy the challenge of engaging with them head-on.

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Another difference between the academic researcher and the patent attorney working on prosecution is that the latter is fungible. Cases are regularly passed on between attorneys for reasons ranging from workload management to the expertise demanded by a given case at a given time. For the workflow to be seamless between cases, a record of prosecution history must be carefully maintained. Symphonic collaboration between IT staff and the records management teams is essential to ensure both that information flows freely and reliably across the firm and that it remains secure. The contributions of paralegals, whose many tasks include assisting patent attorneys in maintaining records of their current cases and imminent deadlines, are also hugely valuable. For instance, paralegals manage much of the correspondence with foreign attorneys and clients; a patent attorney's day-to-day work is simply unimaginable without the support of paralegals.

Too bad paralegals can't assist trainees with their qualifying examinations—otherwise, I look forward to beginning my studies at QM next month.