



PROPOSAL FOR THE EU PATENT

The Commissioner for the Internal Market has made a new proposal for a EU Patent Regulation. According to this proposal, English, French and German would be the official languages, and patent claims would only be translated into these languages. The controversy is still far from ending, since Spanish and Italian are not taken into consideration and this has already earned disapproval from the Italian government. The Spanish government has not yet made a statement on the matter.

The language regime and the jurisdictional system are the two main obstacles for advancing towards a EU patent, a process that requires unanimity of the member states. In fact, the European Court of Justice is currently analyzing the unified jurisdictional system contained in this proposal, because it does not acknowledge in a clear manner the superiority of the community regulation.

ISRAEL JOINS THE MADRID PROTOCOL

On September 1, 2010, Israel became a member of the International Trademark System. The accession of Israel offers companies a cost-effective and streamlined means of protecting their interests in this market on the basis of a new or already registered trademark.

Thus with the accession of Israel, the total tally of countries that can be designated by means of a single International Trademark application is 85.

THE ACB RECOVERS THE DOMAIN ACB.ES

The domain name "acb.es" was registered by a third party without the consent of the owner of the well-known trademark ACB. The registration and use of this domain implied taking advantage of the ACB's good standing and a damage to the distinctive character and reputation of its trademark. Oficina Ponti brought the case before the Arbitration and Mediation Centre of the World Intellectual Property Organization (WIPO), and the defendant accepted transferring the domain name "acb.es" to its legitimate owner.



OFICINA PONTI'S 75TH ANNIVERSARY

On June 16, 2010, Oficina Ponti celebrated its 75th anniversary. Several colleague firms from all over the world participated in a warm event at the main office courtyard in Barcelona.

The guests tasted a wide assortment of Catalan products such as pa amb tomàquet i pernil (bread with tomato and cured ham), cheeses and different kinds of wines and cava.

4TH CONFERENCE ON INDUSTRIAL APPLICATIONS IN NANOTECHNOLOGY

Oficina Ponti participated in the 4th IAN Conference held last June 9 at the Casa Llotja del Mar (Barcelona). This event was organized jointly by Nanoaracat and the Leitat Technological Centre.

COLLABORATION WITH ACTec ASSOCIATED CENTRES

Oficina Ponti will collaborate as Intellectual Property specialist with the centres associated to ACTec (Catalan Association of Technology) and the members of Tecnio (a network comprising the main technology transfer agents and centres in Catalonia).

AGENDA / EVENTS:

15.10.2010 / Asian Patent Attorneys Association, Jeju. South Korea

27.11.2010 / Inter-american Intellectual Property Association – Santiago de Chile. Chile

IN RE BILSKI:

Last June, the US Supreme Court passed one of the most long-awaited decisions regarding patent law: the Bilski case.

This anticipation can be explained by the impact that such a decision could have on the always-controversial protection of business methods and software.

The Bilski case is not so well known in the general public as other previous conflicts such as Amazon's "1-Click" patent or Ebay's online auction systems, but all of them have put the limits of Patent Law to the test; a regulation from the industrial revolution age that has both encountered new technological paradigms and a new context dominated by the information age and the Internet.

The main US doctrine in the 90's stated that inventions should have a useful, concrete and specific effect. Relying on this generous and broad criterion, industry rushed to protect all kinds of businesses and software. The Bilski case started in 1997 when two individuals filed patent application 08/833892 before the USPTO to protect a method for limiting the fluctuation risk in the prices of energy markets. The procedure as such was integrated by a mathematical formula and a software that made it possible for the different energy operators to predict price fluctuations at an international level.

The patent was rejected by the USPTO, which considered it a purely mathematic and abstract method with no technical effect. The Federal Court of Appeal confirmed the decision but introduced some clarifications by stating that the patent had not passed the so-called "Machine or Transformation Test". This test, developed by American practice, requires the accomplishment of two alternative determinants so that these innovations can be protected by patent law: they must form part of a machine or device, or they must transform an object into a different state or thing.

Now the whole issue was in the hands of the Supreme Court, and there was much at stake: the possibility of redefining the patentability standards for such a diffuse subject as business methods and software, impossible or hard to protect in Europe, but which had enjoyed



Joan Salvà
Operations Manager.
Lawyer. Intellectual Property Agent

a certain permissiveness on the other side of the Atlantic. There was also great expectation with regard to the effects that such a decision could have on several pending cases.

Finally, the last court instance of the US confirmed the decision by the Federal Court and the USPTO by rejecting the patent. However, it has limited its decision to criticize and comment on the criteria and lines of argument used by the lower instances with particular votes of some of its Justices.

As expected, the Court strays from the "useful, concrete and specific effect" criterion. And goes beyond that by relativizing the enforcement of the "Machine or Transformation test" criterion by the Court of Appeal. The Supreme Court considers it a remnant of the industrial revolution age and calls it no more than useless for the inventions of the current information age.

The Bilski case has meant a setback for this kind of patents in the US, but in no way should this be understood as a definitive no if we take into account their different perception of what an invention is. It seems to be a negative under these circumstances, but it shows the inconsistency of the criteria used to evaluate innovation coming from the new post-industrial revolutions.

Where Europe is concerned, this decision will not have a big impact, since there are more restrictive rules as to what can be patented. Business methods and software with no technical effect are not considered inventions.

Over the last years, Europe has experimented its own controversy due to the big influence of movements against private software. This ended in 2005, when the proposal by the Parliament to regulate the patentability of software was widely rejected. Thus, it seems that software will still be protected within the scope of copyright, and, for the time being, will not enjoy a "patent suit".

Be as it may, it is somehow premonitory how this new kind of "financial" patents have followed a parallel road, encouraged by the evolution of the speculative economy of the last decade. Are we facing the end of subprime patents?

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Barcelona: +34 93 487 49 36 / ponti@oficinaponti.com

Madrid: +34 91 457 93 11 / pontimadrid@oficinaponti.com

Alicante: +34 96 520 26 95 / raulgutierrez@oficinaponti.com

Suggestions and subscriptions: newsletter@oficinaponti.com

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