STRATAGEM
INTELLECTUAL PROPERTY MANAGEMENT

NEWSLETTER

IN THIS ISSUE:

Welcome to our first newsletter of 2023. In this edition, we introduce our new CEO and the Chair of the Board. Read up about a new patent system coming into play this June, what designs can offer for your IP portfolio and the unique aspects of pharmaceutical trade marks.

We hope you enjoy the contents of this newsletter. If you have any questions, please do not hesitate to get in touch.

DO I NEED IP PROTECTION?

OUR SERVICES

CONTACT US

STRATAGEM
INTELLECTUAL PROPERTY MANAGEMENT

Head Office. Stratagem Intellectual Property Management Limited, Meridian Court, Comberton Road, Toft, Cambridge, CB23 2RY UK
Website. www.stratagemipm.co.uk
Tel. 01223 550740
Email. mail@stratagemipm.co.uk

STRATAGEM IPM
INTELLECTUAL PROPERTY MANAGEMENT

INTRODUCING...

THE CHIEF EXECUTIVE OFFICER

Sarah is by background a Biochemist, having graduated from the University of Oxford with a Master's degree in Molecular and Cellular Biochemistry and particularly enjoys working on the cutting-edge technologies in her field. After training with a well-established Private Practice Patent Attorney firm in London on a varied portfolio, Sarah spent 5 years working on commercialising inventions from NHS clinicians, specialising in education, invention harvesting, protection and building a platform from which to spin out new businesses. It is the true value of intellectual property that motivates Sarah to develop IP strategies for new and emerging companies that will help them to leverage their innovations, regardless of their technical field.

Sarah has been working at Stratagem since 2011 and has assumed various roles, culminating in becoming CEO in May 2022. She encourages the adoption of the values of Stratagem in all aspects of both client-facing and internal work within Stratagem, centred on putting the client's success at the heart of everything we do.

THE CHAIR OF THE BOARD

Rob graduated with a law degree from University College London in 1983 and qualified as a solicitor at Greenwoods in Peterborough in 1986. He spent his career as an employment lawyer before becoming Greenwoods' Managing Partner in 2009. Rob led Greenwoods on its mergers with Walker Wallis in Cambridge in 2012 and with central London firm, GRM Law, in 2018 to create Greenwoods Legal where Rob is now Managing Partner.

Rob is passionate about leadership and the firm's values of respect, excellence, freedom and fun.

Rob worships at St Peter's Church, Oundle. He is a keen runner and season ticket holder at Peterborough United.

In 2019 Rob became a Trustee of CBM UK, a charity which transform the lives of people with disability, their families and communities in the poorest places of the world.

STRATAGEM IPM
INTELLECTUAL PROPERTY MANAGEMENT

SUMMER 2023 IN EUROPE WILL BRING A BRIGHT NEW PATENT SYSTEM!

SIPM welcomes the new Unified Patent Court (**UPC**), which opens on **1 June 2023**.

The practical challenges in the period leading up to this change ("sunrise") are certainly keeping our dedicated team busy with preparation! While it has taken considerable effort to come into being, ultimately, this patent framework is a very positive step and will provide users with new features, benefits, and flexibility.

Of particular note is the Unitary Patent (**UP**), a new group designation made available upon the grant of a European Patent (**EP**), which will have a single validation and renewal procedure for all UP member states (currently 17). What's more, a UP can be combined with the present system for good effect; in many cases providing inherently improved geographic coverage in Europe and which is comparatively better value, particularly over the life of the patent.

Importantly, the UPC provides Europe with a central patent litigation system with exclusive jurisdiction over the new UP. However, the introduction of a blanket outcome from a single court (effective in all UP member states), whether it be a transfer, lapse or a more complex action of infringement, limitation and/or revocation, will create both opportunity and risk for parties involved.

Assertive applicants may positively designate the UP and thereafter exploit the central UPC system to facilitate far swifter and more cost-effective enforcement than has ever been available in Europe, especially for robust assets. Conversely, patentees must be mindful that unless opted out from the UPC, a granted EP will automatically fall under its jurisdiction, giving a renewed chance (post-opposition) for a competitor to revoke that right in all UP members with a single attack (where previously the expense and burden of a court action in each UP member would be necessary and without a uniform outcome). It will take time for the UPC to build both competency and trust in the wider community; for many, the option to opt out of important EPs and dissolve litigation risk before UPC commencement will be an attractive one.

We are currently helping clients understand the risks and rewards of the new system and are developing tailored solutions; much is dependent on the relative strength and status of a given asset, the contractual, commercial and/or financial considerations relating thereto, as well as general attitude to risk.

Written By
Annabel Hampshire
Head of Patent Practice

STRATAGEM IPM
INTELLECTUAL PROPERTY MANAGEMENT

HAVE YOU CONSIDERED DESIGNS AS PART OF YOUR IP PORTFOLIO?

In addition to protecting an invention with a patent or branding with trade mark rights, the appearance of a product is often vital to its success.

A design, in the context of intellectual property, is often described as the shape or ornamentation applied to a 'product'.

Examples of designs rights include products, sets of products, parts of products, packaging, get-up, typefaces, and ornamentation.

The good news is that some design protection is automatically created upon creation. This is referred to as an 'unregistered design right' in the UK. These offer some protection against parties who set out to make identical copies but are often ineffective against 'look-alike' products, which can often be damaging and stir up confusion amongst consumers.

Registered designs generally offer a broader scope of protection, as they can be used to stop anybody creating similar goods which impart the same 'overall impression'.

To be registrable, a design simply needs to possess individual character (i.e. cannot be confused for another design) and be novel.

Novelty for designs is not assessed the same way it is for patents, either. Territories like the UK and EU accept design applications for products that have been on the market for less than a year, meaning that a launched product may still be accepted for design registration.

Compared to patents and trade marks, the design registration is often much cheaper and the process can be a quick as a few weeks or months, with registration lasting up to 25 years, with renewal fees due at five-yearly intervals.

For more information about designs, a detailed introductory factsheet is available and we are happy to discuss and guide you through the registration process. Please email us at mail@stratagemipm.co.uk.

Written By
Jamie Sala
Trade Marks & Copyright Attorney

STRATAGEM IPM
INTELLECTUAL PROPERTY MANAGEMENT

ASPECTS OF PHARMACEUTICAL TRADE MARKS

After choosing potential names for a new pharmaceutical product and conducting global trade mark searches, pharmaceutical trade marks must secure both regulatory and legal approval.

This is an extremely challenging process, which is time-consuming and expensive.

Pharmaceutical trade marks require regulatory approval before the product can be sold under the name. The relevant agency in the UK is the Medicines and Healthcare products Regulatory Agency (MHRA). The MHRA is concerned with protecting patients since brand confusion in this sector presents potential health risks. The test for whether a name can be approved by the relevant agency is whether (i) it will cause confusion with the name of an existing medicine; (ii) it is misleading as to the composition of the product or use; or (iii) it is otherwise unsafe.

The regulatory assessment is entirely independent of the examination undertaken by the UKIPO as to whether a trade mark is acceptable for trade mark registration. The UKIPO will reject a trade mark application if it considers the mark descriptive or non-distinctive. Once accepted, the mark is published for opposition by third parties, and so care must be taken with pre-filing searches in order to avoid conflict with earlier trade marks.

Top Tips

- Begin the naming process as early as possible, preferably at the start of phase II clinical trials, with the objective of having a distinctive, invented brand name capable of global protection. It is not unusual to have 200+ names for pre-screening in order to produce one trade mark plus two backup marks. Screening searches should knock out marks which face clear obstacles in key territories. Those that survive will then undergo full legal availability searches, including 'pharma in use' searches in all territories where commercialisation of the product is likely.

- Apply to register your candidate trade marks at the UKIPO when you are reasonably sure that clinical trials will be concluded. Ideally, trade mark applications should be filed prior to the submission of marketing authorisations.

- Secure approval of the candidate names by the appropriate body regulating medicines in the relevant country, i.e. the MHRA in the UK (EMA in the EU and FDA in the US). Marketing authorisations are usually applied for during phase III clinical trials. Since the rejection rate of candidate names is typically around 50%, it is vital to have one or two backup names to fall back on.

Written By
Addy Bridger
Trade Marks & Copyright Managing Attorney