BUTTERWORTHS
INTELLECTUAL PROPERTY LAW
HANDBOOK

Ninth edition

Consultant Editor
JEREMY PHILLIPS

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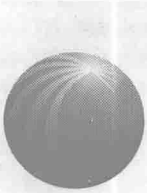

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PREFACE

Two years have passed since I wrote a preface for the eighth edition of this *Handbook*. Those two years have seen an extraordinary degree of debate and upheaval within the world of intellectual property, in a sequence of events which has so far made little mark on existing legislation at either national or international level. Foremost among the most seismic of events have been: (i) the decline and fall of The Pirate Bay and the phoenix-like ascent from its ashes of the Pirate Parties, now represented in the European Parliament; (ii) the apparently unstoppable advance of Google Book, which seems to be mopping up three hundred years of copyright in the printed word as it eliminates all opposition; (iii) the equally irresistible encroachment of Google Search and AdWords upon the ability of the trade mark owner to control the use and indeed the destiny of his trade marks online; (iv) the use of reverse payments and standard-setting cartels by patent owners as a means of dictating the terms on which generic pharmaceutical and electronic goods enter the market; (v) the composition by UNCITRAL of a set of norms which national governments are to be encouraged to observe when protecting the interests of lenders who advance money on the security of intellectual property rights; and (vi) the emergence of access to the internet as a human right, this being a right that may be both capable and worthy of protecting against the claim of copyright owners to prevent the unauthorised sharing of files containing recorded cinematographic and music works. Whether these events will resolve into legislation that will find its way into the statute books is anyone's guess.

Meanwhile, my prediction in 2007 that the next big thing in intellectual property would be the wiki has proved woefully wide of the mark. The wider issue of control and ownership of, and liability for, user-generated content has continued to fascinate and enthral the IP community—and the wiki occupies just one small corner of the stage on which the limelight continues to be held by Facebook, MySpace, blogs and Twitter.

Within Europe, while these major debates have taken place we have seen a legislative output that consists almost entirely of irritating legislative distractions. Back in the early 1990s provisions permitting the reverse engineering of computer software and the making of back-up copies were greeted with apoplexy by some software houses who confidently predicted that the Software Directive would mean the end of software as we knew it. Nothing of the sort happened. The Directive is about as sleepy a backwater as one can imagine. Yet the Directive has been repealed and reissued because it has fulfilled the conditions for automatic tidying-up that Brussels has imposed for Community legislation. Not many people are likely to be affected by this—though the exact opposite effect has been achieved by the repeal and consolidation of the Council Regulation on the Community trade mark and the First Council Directive on the approximation of trade mark law, which have been inconveniently renumbered despite the vigorous pleas of all users of the system to leave the situation alone until the time to consider reform arises.

But enough of the law for now; let's turn to the production of this Handbook. As Consultant Editor I should like to pay tribute to the admirable professionalism of the members of the LexisNexis team with whom I worked, who have kept me on my toes, keeping one eye on the production timetable and another on the quality of the product. I also owe grateful thanks to my colleagues at Olswang. These include the triumvirate of partners Michael Burdon, Clivè Gringras and Nigel Swycher, whose encouragement and guidance both kindles my enthusiasm and keeps its flames within manageable boundaries, and the patient, efficient Claire Walker whose nominations of materials for inclusion, each accompanied by the appropriate disclaimer, have enriched my own suggestions of items for inclusion both in this and in its shortly-to-be-published companion, the *Butterworths E-Commerce and IT Law Handbook*.

Jeremy Phillips
High Holborn
September 2009

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(1977 c 37)

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An Act to establish a new law of patents applicable to future patents and applications for patents; to amend the law of patents applicable to existing patents and applications for patents; to give effect to certain international conventions on patents; and for connected purposes

[29 July 1977]

PART I
NEW DOMESTIC LAW

Patentability

1 Patentable inventions

(1) A patent may be granted only for an invention in respect of which the following conditions are satisfied, that is to say—

(a) the invention is new;
(b) it involves an inventive step;
(c) it is capable of industrial application;
(d) the grant of a patent for it is not excluded by subsections (2) and (3) [or section 4A] below;

and references in this Act to a patentable invention shall be construed accordingly.

(2) It is hereby declared that the following (among other things) are not inventions for the purposes of this Act, that is to say, anything which consists of—

(a) a discovery, scientific theory or mathematical method;
(b) a literary, dramatic, musical or artistic work or any other aesthetic creation whatsoever;
(c) a scheme, rule or method for performing a mental act, playing a game or doing business, or a program for a computer;
(d) the presentation of information;

but the foregoing provision shall prevent anything from being treated as an invention for the purposes of this Act only to the extent that a patent or application for a patent relates to that thing as such.

[(3) A patent shall not be granted for an invention the commercial exploitation of which would be contrary to public policy or morality.

(4) For the purposes of subsection (3) above exploitation shall not be regarded as contrary to public policy or morality only because it is prohibited by any law in force in the United Kingdom or any part of it.]

(5) The Secretary of State may by order vary the provisions of subsection (2) above for the purpose of maintaining them in conformity with developments in science and technology; and no such order shall be made unless a draft of the order has been laid before, and approved by resolution of, each House of Parliament.

[1]

NOTES

Sub-s (1): words in square brackets inserted by the Patents Act 2004, s 16(1), Sch 2, paras 1, 2.

Sub-ss (3), (4): substituted by the Patents Regulations 2000, SI 2000/2037, regs 2, 3, in relation to applications for patents made on or after 28 July 2000.

2 Novelty

(1) An invention shall be taken to be new if it does not form part of the state of the art.

(2) The state of the art in the case of an invention shall be taken to comprise all matter (whether a product, a process, information about either, or anything else) which has at any time before the priority date of that invention been made available to the public (whether in the United Kingdom or elsewhere) by written or oral description, by use or in any other way.

(3) The state of the art in the case of an invention to which an application for a patent or a patent relates shall be taken also to comprise matter contained in an application for another patent which was published on or after the priority date of that invention, if the following conditions are satisfied, that is to say—

(a) that matter was contained in the application for that other patent both as filed and as published; and

(b) the priority date of that matter is earlier than that of the invention.

(4) For the purposes of this section the disclosure of matter constituting an invention shall be disregarded in the case of a patent or an application for a patent if occurring later than the beginning of the period of six months immediately preceding the date of filing the application for the patent and either—

(a) the disclosure was due to, or made in consequence of, the matter having been obtained unlawfully or in breach of confidence by any person—

(i) from the inventor or from any other person to whom the matter was made available in confidence by the inventor or who obtained it from the inventor because he or the inventor believed that he was entitled to obtain it; or

(ii) from any other person to whom the matter was made available in confidence by any person mentioned in sub-paragraph (i) above or in this sub-paragraph or who obtained it from any person so mentioned because he or the person from whom he obtained it believed that he was entitled to obtain it;

(b) the disclosure was made in breach of confidence by any person who obtained the matter in confidence from the inventor or from any other person to whom it was made available, or who obtained it, from the inventor; or

(c) the disclosure was due to, or made in consequence of the inventor displaying the invention at an international exhibition and the applicant states, on filing the application, that the invention has been so displayed and also, within the prescribed period, files written evidence in support of the statement complying with any prescribed conditions.

(5) In this section references to the inventor include references to any proprietor of the invention for the time being.

(6) ...

[2]

NOTES

Sub-s (6): repealed by the Patents Act 2004, s 16(1), (2), Sch 2, paras 1, 3, Sch 3.

3 Inventive step

An invention shall be taken to involve an inventive step if it is not obvious to a person skilled in the art, having regard to any matter which forms part of the state of the art by virtue only of section 2(2) above (and disregarding section 2(3) above).

[3]

4 Industrial application

(1) ... an invention shall be taken to be capable of industrial application if it can be made or used in any kind of industry, including agriculture.

(2), (3) ...

[4]

NOTES

Sub-s (1): words omitted repealed by the Patents Act 2004, s 16(1), (2), Sch 2, paras 1, 4(a), Sch 3.

Sub-ss (2), (3): repealed by the Patents Act 2004, s 16(1), (2), Sch 2, paras 1, 4(b), Sch 3.

[4A Methods of treatment or diagnosis

(1) A patent shall not be granted for the invention of—

(a) a method of treatment of the human or animal body by surgery or therapy, or

(b) a method of diagnosis practised on the human or animal body.

(2) Subsection (1) above does not apply to an invention consisting of a substance or composition for use in any such method.

(3) In the case of an invention consisting of a substance or composition for use in any such method, the fact that the substance or composition forms part of the state of the art shall not prevent the invention from being taken to be new if the use of the substance or composition in any such method does not form part of the state of the art.

(4) In the case of an invention consisting of a substance or composition for a specific use in any such method, the fact that the substance or composition forms part of the state of the art shall not prevent the invention from being taken to be new if that specific use does not form part of the state of the art.]

[5]

NOTES
Commencement: 13 December 2007.
Inserted by the Patents Act 2004, s 1.

5 Priority date

(1) For the purposes of this Act the priority date of an invention to which an application for a patent relates and also of any matter (whether or not the same as the invention) contained in any such application is, except as provided by the following provisions of this Act, the date of filing the application.

(2) If in or in connection with an application for a patent (the application in suit) a declaration is made, whether by the applicant or any predecessor in title of his, complying with the relevant requirements of rules and specifying one or more earlier relevant applications for the purposes of this section made by the applicant or a predecessor in title of his and [the application in suit has a date of filing during the period allowed under subsection (2A)(a) or (b) below], then—

(a) if an invention to which the application in suit relates is supported by matter disclosed in the earlier relevant application or applications, the priority date of that invention shall instead of being the date of filing the application in suit be the date of filing the relevant application in which that matter was disclosed or, if it was disclosed in more than one relevant application, the earliest of them;

(b) the priority date of any matter contained in the application in suit which was also disclosed in the earlier relevant application or applications shall be the date of filing the relevant application in which that matter was disclosed or, if it was disclosed in more than one relevant application, the earliest of them.

[(2A) The periods are—

(a) the period of twelve months immediately following the date of filing of the earlier specified relevant application, or if there is more than one, of the earliest of them; and

(b) where the comptroller has given permission under subsection (2B) below for a late declaration to be made under subsection (2) above, the period commencing immediately after the end of the period allowed under paragraph (a) above and ending at the end of the prescribed period.

(2B) The applicant may make a request to the comptroller for permission to make a late declaration under subsection (2) above.

(2C) The comptroller shall grant a request made under subsection (2B) above if, and only if—

(a) the request complies with the relevant requirements of rules; and

(b) the comptroller is satisfied that the applicant's failure to file the application in suit within the period allowed under subsection (2A)(a) above was unintentional.]

(3) Where an invention or other matter contained in the application in suit was also disclosed in two earlier relevant applications filed by the same applicant as in the case of the application in suit or a predecessor in title of his and the second of those relevant applications was specified in or in connection with the application in suit, the second of those relevant applications shall, so far as concerns that invention or matter, be disregarded unless—

(a) it was filed in or in respect of the same country as the first; and

(b) not later than the date of filing the second, the first (whether or not so specified) was unconditionally withdrawn, or was abandoned or refused, without—

(i) having been made available to the public (whether in the United Kingdom or elsewhere);

(ii) leaving any rights outstanding; and

(iii) having served to establish a priority date in relation to another application, wherever made.

(4) The foregoing provisions of this section shall apply for determining the priority date of an invention for which a patent has been granted as they apply for determining the priority date of an invention to which an application for that patent relates.

(5) In this section "relevant application" means any of the following applications which has a date of filing, namely—

(a) an application for a patent under this Act;

(b) an application in or for a convention country (specified under section 90 below) for protection in respect of an invention or an application which, in accordance with the law of a convention country or a treaty or international convention to which a convention country is a party, is equivalent to such an application.