The Modern Law of Patents

Second Edition

Consultant Editor:
His Honour Judge Fysh QC, SC

General Editors:
Ashley Roughton
Phillip Johnson
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Foreword

Some five years after its first publication, it is a particular pleasure to be invited to write the foreword to the second edition of the Modern Law of Patents, for the publication of a second edition implies the creation of new work of enduring quality.

The intervening years have witnessed determined efforts to reform the structure of the patent system to make it easier to use, more consistent and less costly, all of which are recognised to be of particular importance to small and medium-sized enterprises.

At the international level, the EU Council, with the support of the EPO, has now agreed a draft Regulation on the EU patent – formerly known as the Community patent before the entry into force of the Lisbon Treaty – and on the establishment of a European and EU Patent's Court. The key elements of this latter proposal are a court system with exclusive jurisdiction in respect of infringement and validity issues concerning European and EU patents and a Court of First Instance with a central division and local and regional divisions in the various contracting states to the agreement. It is a proposal which has the particular support of the European patent judges, for we see time and time again the oppression and uncertainty caused by parties having to fight the same battles in many jurisdictions, often at the same time. Not surprisingly, many hurdles remain, notably language, composition of the panels and the notion of technical judges, and we await the opinion of the ECJ on the compatibility of the proposed agreement with the EU Treaties. We must now wait and see if the political will is there to carry it through.

At the national level, we can be much more confident that change is imminent. Proposals for the reform of the Patents County Court by the Intellectual Property Court Users Committee have been accepted by Jackson LJ in his final report and it is anticipated they will be implemented this year. The aim in relation to the simpler cases is to eliminate disclosure, experiments and experts' reports, to cut down the length of trials to a maximum of two days and, perhaps most importantly, to limit recoverable costs.

The desire to reduce complexity and increase consistency has also been reflected in many decisions of our courts. The *Improver* questions are now of no more than historical interest as we seek to discern what the person skilled

in the art would have understood the patentee intended the language of the claim to mean. Of course there are wrinkles – for example, the extent to which the skilled person should be taken to understand the law and drafting conventions – but gone are the days when the parties would carry out experiments on Question 1 and experts would struggle with Questions 2 and 3. We can only hope that as the Court of Justice now explores the protection conferred on biotech inventions it will not introduce the degree of confusion it has in the field of trade marks.

Many of the grounds of invalidity have received considerable judicial attention here too. In the light of the decision of the House of Lords in *Lundbeck*, a party can no longer attack a product claim on the basis that it extends beyond the technical contribution made by the inventor because it covers ways in which the invention may be used which owe nothing to any teaching in the specification – though whether this retreat from *Biogen* introduces certainty at the expense of fairness has been the subject of much debate. In similar vein, the House of Lords has emphasised in *Conor* that it is not permissible for a judge to determine the question of obviousness by reference to his own assessment of the contribution made by the patentee – what matters is what is claimed. Nor do we consider there to be any substantive difference between the *Pozzoli* questions and the problem–solution approach, although, of course, particular care must be taken in formulating the technical problem. That is not to say that no difficulties remain – of course they do – and one does not have to look very far to find them. The exclusions of Art 52 EPC provide many examples, from inventions which are not susceptible to industrial application to programs for computers. But we may anticipate that the trend to clarify and simplify wherever possible will continue.

How then have the authors of the Modern Law of Patents addressed these developments? I would say with considerable success. They have retained the characteristics that made the first edition so attractive, notably the team of authors from a range of backgrounds, each having a particular expertise, and an accessible text which identifies the key provisions and authorities relevant to each topic and explains them in simple and clear terms. But the authors have made substantial improvements too. Much of the text has been re-organised and re-written and there is a useful and entirely new chapter on arbitration. Overall, this is a book that will be of value to all those with an interest in the law of patents.

Mr Justice Kitchin
Senior Patents Judge of the High Court of England and Wales

May 2010

Preface

After a considerable amount of work and many emails, we have emerged with a work which is closer to a new book than a Second Edition. It has been completely restructured and largely re-written since the first edition not only because of the significant changes to patent law but also because we have become more ambitious in what we would like to include. The writing has mainly been undertaken by the editorial team, which has been possible in no small measure due to the inclusion of Phillip Johnson. Sadly, we lost Michael Spence as an editor, but we are able to forgive him as he is now running a large university in Australia. We wish him well and assure him that his seat will be kept warm lest he should wish to return.

This new edition now includes a discussion of the substantive law of patentability under the European Patent Convention as it is applied by the European Patent Office itself, by which we mean rather than simply integrating decisions of the Boards of Appeal to fill in the gaps in domestic law we have examined the two separately and explained where the approach or practice overlaps. This will hopefully make the book more useful to a wider range of readers. Another way in which we have expanded the scope of the book is to include arbitration of patent disputes as well as three appendices discussing the history of patent law, the theory of patent law and possible future developments of patent law. Such future developments may (or may not) have come about before the next edition of this book.

The present trend of the Enlarged Board of Appeal at the European Patent Office and commentators to refer to the *Travaux Préparatoires* has been taken into account and we therefore have examined this extensive documentation to try and provide an insight into provisions of the European Patent Convention and Patent Cooperation Treaty where the cases still fail us. However, more unusually we have also spent many hours searching through Parliamentary Counsel's papers, in particular for the Patents Act 1977, which we hope has provided us with some unique insights to the thinking behind certain provisions of the Act.

It remains difficult to say too much about the question of computer software patents and in particular where the line is to be drawn between a claim to the art of computer programming and anything else – which is what we contend is the effect of the words 'as such'. Not only has the question perplexed judicial minds, but it transpires that the provision's origins were shrouded in uncertainty and imprecision and was a fudge brought about because those

negotiating the European Patent Convention could not navigate a way through a political and technical impasse at a time when computers still ran on punch cards. Unfortunately, the recent decision of the Enlarged Board of Appeal in G 3/08 *Computer Programs* has only given us some of the answers for which we have hoped. This coupled with its other recent decisions, in relation to dosage regimes and second medical uses (G 2/08 *Dosage regime/ ABBOTT RESPIRATORY*) and surgical methods of treatment (G 1/07 *Treatment by surgery/MEDI-PHYSICS*) mean that the coming years will lead to more, not fewer, questions being asked.

There has also been movement once again on the notion of a Community patent and a Community Patent Court. It may be that by the next edition the Community Patent Court will finally get off the ground (third, or is it, fourth time lucky) and should this be the case this may be the last edition which looks at patent law (and patent construction and infringement in particular) as a matter of national law. What such a regime will mean to practice is a question that has been asked since the 1970s. Would it follow the slow moving, intellectually rigorous but expensive British system, the two speed and pro proprietor Germans or the radical thinking and fast moving Dutch? A Community Patent Court may have wider constitutional implications both here and elsewhere as it may become the first plank in the creation of a truly federal jurisdiction within the European Union. The creation of the Community patent may also affect the real cost and value of patents both to proprietors and to society as a whole. But it is questionable whether the users of the patent system (on both sides) have ever positively indicated that they want this project despite it being nearly 50 years in the making.

Since the first edition we have had to say goodbye to three notable patent lawyers and adieu to another. Sir Douglas Falconer, Sir Nicholas Pumfrey and Professor Sir Hugh Laddie QC died within a relatively short time of each other and their bonhomie and judgments are missed by all in the patent world. Lord Hoffmann, who remains very much alive, has hung up his spurs at the House of Lords (but avoided having to walk over the road to the new Supreme Court), and thankfully continues to provide his usual insight into difficult questions of patent law through his association with Queen Mary, University of London. On a personal note, the editors would also like to commemorate Ian Judge, a solicitor and partner at Bristows, who sadly died in January 2007. Ian was a formidable, yet kind and mild mannered man who was always somewhere involved in any patent which was worth litigating. He usually knew better than those around him, but never wore his intellectual abilities on his sleeve. He is sorely missed.

We thank and acknowledge the authors of the first edition upon whose work we have built, in particular Robert Anderson, Benet Brandreth, James Cross, Nick Gardner, Neil Jenkins, Jo Oliver, Aidan Robson, David Rose, Vicki Salmon, Nicholas Saunders and Roger Wyand. We also thank the additional authors of this work who have brought it greater insight. We have done much work on each of the chapters and, as a result, we believe that it would not be quite accurate to give attribution to any one author for any of the chapters but their work has made this text much richer.

In addition we would like to thank James Porter, Hazel Craven, Nick Smith and Sarah Barker, all from the Legal Section at the Intellectual Property Office who gave us comments on an earlier draft of the chapters on Prosecution before the Intellectual Property Office and under the Patent Cooperation Treaty. We would also like to thank David Musker of Jenkins who gave comments on a draft of the chapter on Prosecution before the European Patent Office. Our gratitude also extends to the Office of the Parliamentary Counsel, in particular Linda Fraser and Andrew Cole, who made the papers relating to the Patents Act 1977, amongst others, available to us.

Any errors and omissions that remain are ours. We have stated as the law as we believe it to be on 19 April 2010 although we have been able to give some limited consideration to G 3/08 *Computer Programs* and one or two other developments since that date.

AWR
PJ
TC

Table of Cases

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