FUNDAMENTALS OF PATENT LAW

INTERPRETATION AND SCOPE OF PROTECTION

Matthew Fisher

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Fundamentals of Patent Law

Interpretation and Scope of Protection

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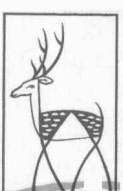

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FUNDAMENTALS OF PATENT LAW

This new book provides a comprehensive overview of the topic of patent claim interpretation in the UK and in three other select jurisdictions. It explores territory that has great commercial significance and yet is severely under-explored in existing works. The twin issues of the function of patent law and interpretational analysis of the scope of protection have been recently reconsidered by the House of Lords, and this work not only reviews their recent cases but also looks at how the US, German and Japanese patent systems deal with the complex problems presented in this area.

The book provides a balanced approach between practical, academic and theoretical approaches to claim interpretation. In doing so it provides more than a simple case analysis, as it enables the reader to consider the shape that the law should take rather than simply recounting the current position. Its novelty therefore lies in bringing the theoretical elements of the discussion together with the view of the profession charged with creating the patent documentation in the first place and then viewing this in the light of the detailed comparative studies. It is only by considering all of these elements that we begin to see a pathway for the development of the law in this area.

This is a work that will be an important source of reference for academics and practitioners working in the field of patent law.

To Kate, without whose support,
none of this would have been possible.

PREFACE

Mark Twain once famously observed that a country without a good patent system 'is like a crab that can't travel any way but sideways or backways'. Yet detailed academic analysis of the patent system in the UK is a relatively rare occurrence. My objective in writing this book was therefore to provide academic comment on an area of the law that has great commercial significance and yet is severely under-explored in critical writing. The following text aims to provide the reader with an overview of the status and development of the process of claim interpretation in the UK, and also to explore significant practical, academic and theoretical aspects of this vital subject. Its novelty lies in bringing the theoretical elements of the discussion together with the view of the profession charged with creating the patent documentation in the first place, and then examining this in the light of comparative studies recounting the position adopted elsewhere. It is only by considering all of the elements that we have before us that we begin to see a pathway for the development of the law in this area.

The story of the creation of this book begins with an application submitted in the spring of 1999 for entry onto the PhD programme at the University of Bristol. At this point in time, towards the end of my undergraduate degree, I thought it would be 'quite nice' to do a bit more studying (and to avoid paying council tax for another year or three). I therefore decided to apply for a PhD on purely mercenary grounds – added to the aforementioned council tax avoidance, you could get funding—and had settled upon IP as the topic of choice. I had narrowed my proposed field of investigation down to either an exploration of patent claim interpretation or an examination of plant variety rights. For better or worse I chose the former, and found that I actually quite liked what I was doing. Therefore, eight years, several scores of sleepless nights, much blood, sweat and tears later, that original application has metamorphosed, via a PhD thesis, into this book. It has been a long time in gestation, and is, needless to say, far changed from that original script, not least due to the House of Lords tinkering with claim interpretation in *Kirin-Amgen*. But it is here, and it is my hope that it makes a contribution to the literature that was worth the effort. I should add that versions of chapters three and eight have already appeared in *Intellectual Property Quarterly*, as [2005] IPQ 1, and [2004] IPQ 85 respectively.

So now on to the thanks.

Thanks must go first to my PhD supervisor, Helen Norman, for all the advice and support in the early days of my PhD – all those little things that supervisors do to put you on the straight and narrow. To the Faculty of Law, as it was, at the University of Bristol for the scholarship it gave me to pursue my PhD. To my examiners Margaret

Llewellyn and Andrew Charlesworth for their helpful comments and, let's face it, for not asking me to make any amendments. Thanks must also go to Richard Hart for caring less about the details than he might (length, deadlines, etc), and to all that worked with him, in the preparation of this book, especially my editor Mel Hamill, for making this author's relations with his publisher so unproblematic.

I would also like to thank the anonymous patent attorneys who, by recounting their tales of patent drafting procedure and problems, assisted a very green PhD student on the road to his doctorate. I learned a great deal from these informal discussions. Some of those who kindly gave up their time were very encouraging, and some were not quite so positive (one notably telling me that I should give up on this line of enquiry and do a PhD on selection patents instead – needless to say, I did not), but all were helpful in their own way and provided ample food for comment.

There are many other people that, whilst not directly involved in the process of creation, have supported me throughout completion of this book. I thank them all; with special mention going to Kate, to whom this work is dedicated and who was turned into a library widow in the months leading up to submission of the manuscript, but who was still there when I came home. And to my parents for their eternal support. To my little-sister Lucy for not hating me forever for bundling her up in a duvet and locking her in the wardrobe when we were small (yes, I'm sorry) and her daughter Isabella (if you ever read this, your name is in full because at the time of writing you seemed to flit between 'Izzy' and 'Bella' more frequently than most people change socks – but I suppose that's one of the perks of being eighteen months old) for lightening the tone on so many occasions. To Sarah for putting up with me for all those years we shared a flat together. To Mark for his companionship, dry sense of humour, fine taste in alcohol (although Pimms is not to be recommended neat) and of course for the interminable, indescribable, 'Belsey stories'. And last, but not least, to Henri for years of friendship and for offering me a closing line for the book when I was close to the end of my tether. I didn't use it there, but will use it here instead:

And with that, Charles closed the book, returned it to the shelf, and left the library ...

M Fisher
June 2007

Let's not be tyrannized by words. Let's try to hang on for dear life to the little advances in the art of thinking about patent law that we are able to make in our lifetimes

Rich, 'Escaping the Tyranny of Words—Is Evolution in Legal Thinking Impossible?' Reprinted in (2004) 14 *Federal Circuit Bar Journal* 193, at 216.

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