C.I.P.A. GUIDE TO THE PATENTS ACT 1977

by

THE CHARTERED INSTITUTE
OF PATENT AGENTS

THIRD CUMULATIVE SUPPLEMENT
Up to date to September 1, 1981

LONDON
SWEET & MAXWELL
1982

C.I.P.A. GUIDE TO THE PATENTS ACT 1977

by

THE CHARTERED INSTITUTE
OF PATENT AGENTS

THIRD CUMULATIVE SUPPLEMENT
Up to date to September 1, 1981

LONDON
SWEET & MAXWELL
1982

C.I.P.A. GUIDE TO THE PATENTS ACT 1977

First Edition 1980

Published by
Sweet & Maxwell Limited of
11 New Fetter Lane, London.
Printed in Great Britain by
Page Bros. (Norwich) Ltd.

ISBN Main Work 0 421 26260 5
ISBN Third Cumulative Supplement 0 421 29530 9

Table of Cases

(incorporating cases cited in the Main Work)

Cases are listed according to the pages of the Main Work to which they refer, as supplemented by the contents of this Supplement wherein the corresponding pages of the Main Work are indicated in bold type in the margin. Where the supplementary commentary for a particular page of the Main Work is extensive, references to the sub-headings used in this Supplement are included after the page number. However, cases cited in the Appendix (which deals with cases decided since 1978 under the 1949 Act) are referred to by reference to the relevant section number of that Act prefixed by "A" *and followed by the suffix* "C" *or* "P" *according to whether the case relates to the* "Commentary" *or* "Practice" *divisions for that section of the 1949 Act.*

An asterisk against a case listed in the Table indicates that that case is cited in the Main Work. At present no such case is also cited in this Supplement.

Unreported judgments are cited with reference to the collection of judgments maintained in the Science Reference Library (Holborn Branch), the reference number used in this collection being cited prefaced by "SRL"; *and also, where possible, with reference to the extracts of such decisions contained in the EIPR and IPD publications.*

Abbreviations are used as indicated on p. xii of the Main Work as amplified with respect thereto in this Supplement.

C.I.P.A. Guide to the Patents Act 1977

Third Supplement

INTRODUCTION

This Supplement mainly comments on cases reported and other sources published after April 1, 1979, when the text of the Main Work was finalised, up to September 1, 1981 including [1981] RPC No. 20 and FSR and EIPR for August 1981. Additional matter omitted from the Main Work is also incorporated as this has come to light or where reference to older cases is appropriate by way of comment or contrast.

Readers are reminded that *Patent Law of the United Kingdom ("PLUK")* by the Chartered Institute of Patent Agents (published in 1975 by Sweet & Maxwell), together with its cumulative supplements, reviews cases decided under the Patents Act 1949. The present work is concerned with the Patents Act 1977, but many cases decided under the 49 Act also have relevance to practice under the 77 Act. Accordingly *PLUK* and its Fifth Cumulative Supplement, which reviewed such cases published up to January 1, 1979, should be consulted as appropriate. Cases decided under the 49 Act and published since January 1, 1979, are included in the main text of this Supplement where they have relevance to practice under the 77 Act.

An additional Index has been introduced into this Supplement. This should be read in conjunction with the Index in the Main Work. Both indexes refer to pages of the Main Work as each paragraph of this Supplement has a marginal reference in bold type to the page of the Main Work to which it relates. Thus both the relevant page of the Main Work and the corresponding paragraphs in this Supplement should be studied in relation to any particular index reference. Matter included in the Supplement for the first time is indicated by a marginal asterisk.

Cases published since January 1, 1979, which relate *solely* to practice under the 49 Act are discussed in Appendix A hereto. This Appendix is thus to be read in conjunction with *PLUK* and its Fifth Cumulative Supplement and is in effect a further supplement thereto. A separate index has been provided for this Appendix.

The Table of Cases indexes all cases referred to in the text of this Supplement (including Appendix A). For maximum convenience this Table includes all cases cited in the Main Work.

The Main Work was prepared by the Book Committee of the Chartered Institute of Patent Agents under the aegis of C. W. Morle and J. H. Dunlop with contributions also from J. L. Beton, A. N. Devereux, G. H. Edmunds, M. J. Hoolahan, C. Jones, R. P. Lloyd, H. Mock, R. C. Petersen, C. P. Tootal, C. P. Wain, W. Weston, A. W. White and C. G.

Wickham. This Book Committee remains responsible for the annual cumulative supplements. The present members of the Book Committee are J. H. Dunlop (Chairman), G. H. Edmunds, R. P. Lloyd, C. W. Morle and A. W. White. Contributions to the present Supplement have also been made by A. N. Devereux, M. J. Hoolahan, C. Jones, H. Mock, R. C. Petersen and W. Weston.

Readers who perceive in the Main Work or in this Supplement any inaccuracy or omission are warmly invited to write to the Chairman of the Book Committee, The Chartered Institute of Patent Agents, Staple Inn Buildings, London, WC1V 7PZ, in order that the Work can comprehensively and accurately fulfil the promise of its title. The Committee would particularly like to hear from readers who encounter unusual points of patent practice so that the profession as a whole can benefit from their experience.

* **vi** The *Implementing Regulations to the European Patent Convention* and the *Implementing Regulations to the Patent Co-operation Treaty* have been amended in several respects from the original versions, as also have the *Guidelines for Examination in the European Patent Office*. The up-to-date versions of each of these can be found in the *European Patents Handbook* (1978, with subsequent looseleaf releases, Chartered Institute of Patent Agents, London: Oyez Publishing).

* **vii** The present Supplement is the Third Supplement cumulative and up-to-date to September 1, 1981. The First and Second Supplements may be destroyed.

TABLE OF ABBREVIATIONS

xii The following additional abbreviations should be added to the Table in the Main Work:—

*	AC	—	Appeal Cases
	All ER	—	All England Law Reports
	CB	—	Common Bench Reports
*	EPI	—	Institute of Professional Representatives before the European Patent Office
	ER	—	English Reports
*	IPD	—	Intellectual Property Decisions
	JBL	—	Journal of Business Law
*	NLJ	—	New Law Journal
*	NZLR	—	New Zealand Law Reports
*	p.	—	page
	QB	—	Queen's Bench Division Reports
	RSC	—	Rules of the Supreme Court
	SI	—	Statutory Instrument
	USPQ	—	United States Patents Quarterly
	WLR	—	Weekly Law Reports

Amendments to Patents Act 1977

1 The Patents Act 1977 has been amended by the following enactments:–

	Year	*Enactment*	*Sections affected*
	1978	National Health Service (Scotland) Act (c.29) [Sched. 16, para. 48]	56
*	1978	Interpretaton Act (c.30) [s.25(2)]	41
	1978	Scotland Act (c.51) [Sched. 16, para. 53]	55–59
	1978	Wales Act (c.52) [Sched. 11, para. 55]	55–59
*	1978	Patents Act 1977 (Isle of Man) Order (SI 1978: 621)	41, 52, 58, 85, 88, 93, 107, 114, 130
*	1979	Perjury (NI) Order (SI 1979: 1714) [Sched. 1, para. 28]	92
	1980	Competition Act (c.21) [s.14]	51
*	1981	Supreme Court Act (c.54) [ss.6, 54(9), 62(1), 70(3)(4), Sched. 7]	96, 97, Sched. 2
*	1981	Armed Forces Act (c.55) [s.22]	42, 130

Commentary on Section 1

* **9** The extent of the exclusion from patentability under s.1(2)(*c*) of computer programs is a matter of debate. Some of the factors are discussed by A. S. Marland (CIPA, May 1980, p. 386) with subsequent comment (CIPA, October 1980, p. 24 and March 1981, pp. 307–310). Generally the position taken by the Patent Office appears to be little different from that applied under the 49 Act, see the discussion following the paper "Computer Programs—Art or Science?" by L. Perry (CIPA, December 1980, p. 97), the paper by M. G. Harman (CIPA, May 1981, p. 383) and further comment by A. J. A. Bubb (CIPA, June 1981, p. 461).

10 The Comptroller has apparently suggested that, where a specification refers to a substance the use of which would be a contravention of the Carcinogenic Substances Regulations 1967, reference to such substance might be required to be deleted under s.1(3), even though no objection would arise under s.1(4). If such use were an essential integer of the invention claimed, the Comptroller has apparently said that no patent could then be granted (CIPA, February 1980, p. 256).

* **11** It now seems clear that claims to micro-organisms *per se* and other products producible by genetic engineering techniques will be allowed,

whether or not such micro-organisms are naturally occurring, see the paper by R. S. Crespi ([1981] EIPR 134). This paper also discusses the difficulty of defining products of this type and of describing their essential characteristics and how the invention may be practised.

COMMENTARY ON SECTION 2

* **13** Besides the sections mentioned in the first paragraph of the Main Work, s.2 is also referred to in ss.3 and 79. Although the Main Work states that a mosaic may not be made of separate items of prior art, this may be justified when one document contains a reference to the other so that the two would naturally be read as one.

14 In *Beecham Group's (Amoxycillin) Application* ([1980] RPC 261) it was held, under s.14 of the 49 Act, that an amended claim requiring a particular chemical compound to be comprised in "a pharmaceutical composition adapted for oral administration to human beings" was not anticipated by a prior disclosure which hinted at both the compound in question and the possibility of formulation of the disclosed compounds for oral administration. It was held that the cited document did not contain clear and specific directions to make up the particular composition as claimed in the amended claim. For comment and explanation of this case, see P. G. Cole ([1979] EIPR 316).

* **14** In the corresponding case in New Zealand (*Beecham Group* v. *Bristol-Myers* [*Amoxycillin*] *(No. 2)* [*New Zealand*] [1980] 1 NZLR 192), the claim was to a compound in the form of an epimer. It was held (also in opposition proceedings) that this claim was not anticipated by a prior disclosure of a *d,l*-mixture containing the epimer as 50 per cent. thereof in the absence of specific instructions to make the pure epimer, the court following a similar decision in the USA (*Re May and Eddy*, 197 USPQ 601 (1978)). However a contrary view has been taken in Australia where the court refused to extend the term of a patent of addition on a finding that its claims lacked novelty over, or were prior claimed by, the parent patent in a case which also involved the subsequent isolation and commercialisation of a particular isomer initially prepared as part of a mixture of isomers. (*ICI's Australian Patent Extensions* [*Australia*] [1981] RPC 163.)

* **14** In *Du Pont's (Witsiepe's) Application* ([1981] FSR 377) the Patents Court and the Court of Appeal each held that a claim requiring the use of a glycol having 4 carbon atoms was not necessarily devoid of novelty in view of an earlier patent requiring in the same process the generic use of a glycol having from 1 to 10 carbon atoms, even though the 4 carbon glycol was specifically mentioned in the earlier patent though not in any example and only in the context of prior art thereto. Accordingly an opposition under s.14 of the 49 Act failed as invalidity had not been established beyond doubt. In upholding this decision the Court of Appeal stated that the

novelty of a claim was only destroyed by a clear disclosure and that a pointer was not sufficient, citing *General Tire* v. *Firestone* referred to on p. 13 of the Main Work. The Court of Appeal then stated that there was no clear instruction in the prior document to use the specific glycol in question and the fact that this was mentioned by name in a list therein was an irrelevance. Disclosure of a class was not disclosure of each member thereof. The Court of Appeal also stated that a chemical compound is not "known" if it has never been prepared and, if it is not "known" for the purposes of s.32 of the 49 Act, it cannot have been "published" for the purposes of s.14 thereof. Thus the principle of selection inventions has been firmly upheld and, moreover, the patentability of selection from a list, as well as from a group, has been recognised. The Court of Appeal granted leave to appeal to the House of Lords. These decisions would appear to be equally applicable to the question of novelty arising under s.2. This *Du Pont* case has been commented on by A. W. White (CIPA, March 1980, p. 303 and March 1981, p. 311).

* **14** Under s.2 novelty is determined according to whether the invention has been made available to the public. It is a matter for debate whether novelty is destroyed in the circumstances which prevailed in *Bristol-Myers' (Johnson's) Application* ([1975] RPC 127) where a chemical compound was held to be the subject of prior public use, though at the time the manufacturer was not aware that the product he had sold was of the nature specified in the later patent claim. In his letter, P. R. Lambert (CIPA, February 1981, p. 246) suggests that the decision in that case would be different under the present s.2. Clearly the question awaits resolution, but, against the arguments put forward by Mr. Lambert, it should be noted that in the *Bristol-Myers'* case the claimed *product* had been made available to the public and the public had had the benefit of it: what had not been made available was only the knowledge that the product was of the character claimed. If it is not necessary for any person actually to have gained knowledge from a prior publication before novelty is destroyed, should the position be any different in the case of a prior use? In other words to destroy novelty must the invention be made available to the public *qua* invention, or does the maxim continue to hold good that "what would infringe if later, anticipates if earlier"? The answer awaits judicial evaluation.

* **14** In *Netherlands Patent Office Appeals Decision No. 14633 [Netherlands]* ([1981] FSR 356) it was held that, in judging the novelty of a later application under the Dutch equivalent of s.2(3), account must be taken not only of the literal text of the earlier application but also of anything which an average person skilled in the art, interpreting what he had read, would have regarded as part of the earlier application. However, in that case, there was no advantage alleged for the species (specific numerical range of proportions of mixture components) over the genus of the earlier

application (mixture of same components in broad range of proportions) and the applicant was given an opportunity to show that his claim implied more than an arbitrary selection.

* **14** Under s.2(3) an ordinary application under the Act obviously remains in the state of the art if it is withdrawn or refused after publication, because there is nothing in the Act to suggest otherwise. It would therefore be thought that a European application (or the UK designation) withdrawn after publication, or an international application withdrawn after entry into the UK phase, would likewise remain in the state of the art under s.2(3). However the effect of s.78(5) on s.78(2) seems to be that s.2(3) ceases to be applicable to a European application (or the UK designation) when this is withdrawn. It is interesting that the original Patents Bill contained a further provision in the clause which is now s.78(5) that "where the application is refused or withdrawn or deemed to be withdrawn, or its designation as aforesaid is withdrawn or deemed to be withdrawn, after the publication of the application, it shall continue to be treated as forming part of the state of the art by virtue of section 2(3)." However this provision was removed by a Government amendment on the basis that the provision was unnecessary (*Hansard,* March 15, 1977, col. 1544), but in doing so the ultimate law may not be what was the obvious intention of the Legislature, unless the operation of s.78(5) is considered not to be in any way retrospective. This apparent anomaly has led to much debate and in a second paper C. Jones (CIPA, May 1981, p. 383) argues cogently that, once an application of any kind has been published so that it has effect under s.2(3), it cannot thereafter cease to have such effect. However the matter is not likely to be resolved without a decision of the court. There is less difficulty in the case of an international application for, as pointed out in the commentary on s.89 in this Supplement, s.89(8) appears to be inapplicable after entry into the UK phase, which is when the prior art effect under s.2(3) commences. However, even this point is open to some doubt.

14 In the case of an international application for a European patent (UK), the provisions of s.79(2) prevent that application being considered as prior art under s.2(3) until the European filing fee has been paid and a copy of the international application in English, French or German has been filed at the EPO. Similarly, in the case of an international application for a patent (UK), subss.89(1)(*a*) and 89(4) ensure that the s.2(3) effect does not commence until the UK filing fee has been paid and a copy of the international application in English has reached the UK Office.

* **14** The priority date of matter forming part of the state of the art under s.2(3) is discussed in the commentary on s.5 in this Supplement. The importance of determining whether a citation under s.2(3) is truly entitled to its own priority date, and the conditions under which the "whole contents" effect of patent applications of prior date is to be taken into

account is the subject of the first paper by C. Jones (CIPA, October 1980, p. 11).

* **14** The Comptroller has power under s.73(1) to raise objection after the grant of a patent that the invention claimed in any claim is not new having regard to matter forming part of the state of the art under s.2(3).

* **15** The six month grace period under s.2(4) is reckoned from before the actual filing date of the application in suit and not from before any priority date, whether foreign or domestic. R.111(4), which is set out in this Supplement in relation to p. 384 of the Main Work, has been introduced to deal with calculation of this grace period in cases which involve excluded days under s.120 or r.111(1).

Practice Under Section 2

15 In order to prevent self-collision with subject matter contained in an earlier application, it may not be sufficient to delete the subject matter in question from the earlier application before this is published under s.16. As suggested in CIPA, February 1980, p.247, it would appear more prudent to file a divisional application on the earlier application before this is published under s.16. The divisional application can omit the offending subject matter and the original application can be abandoned before publication.

Commentary on Section 3

19 Although decided under the 49 Act, *American Cyanamid* v. *Ethicon* ([1979] RPC 215) is instructive on the general question whether "obvious to try" is a valid test of inventive step. It was here held that a material could not be an obvious one to try if, at the relevant date, it was neither on the market nor had been suggested as having value. It was also here pointed out that commercial success could only be discounted if, as a practical matter, the successful commercial product owed nothing to the original invention.

19 Interesting questions arise as to the nature of the "persons skilled in the art." In *American Cyanamid* v. *Ethicon (supra)* it was held that in that case this should be a multi-disciplinary team of workers rather than any single individual. Also should such a person be one resident in the UK? Prima facie, because the validity of a patent for the UK is at stake, this would seem to be so, but the Australian case of *Lucas* v. *Chloride* ([1979] FSR 322) may go too far in excluding evidence to be given of certain activities carried out in Sweden. It may be noted that in the parallel UK case of *Lucas* v. *Gaedor* ([1978] RPC 297) similar evidence was considered to support a plea of obviousness, albeit in each country when a law of local novelty was in force. Nevertheless, if evidence had been given in the Australian case that the articles in question were sometimes imported into

Australia from Sweden, the events in that latter country ought to have been relevant to the question of obviousness in Australia. When relying on evidence of events abroad to support a pleas of obviousness, it would be prudent to establish some connection or relevance between the pertinent art in the two countries. This will probably automatically be the case when the countries concerned are both members of EPC in view of the terms of s.130(7).

19 The terms of s.130(7) may also affect the literal working of s.3. This is because s.3 refers to non-obviousness "having regard to any matter which forms part of the state of the art," whereas EPC a.56 merely refers to "having regard to the state of the art." This difference of wording could be of importance because the EPC wording, which by virtue of s.130(7) ought to prevail, would seem to require non-obviousness to be judged against the background of the whole state of the art and not merely against a document considered in isolation as the literal wording of s.3 would seem to suggest. The EPC standard would seem to be in accord with cases decided under the 49 Act and reviewed on pp. 23–24 and 47–48 of the Fifth Supplement to *PLUK* where allegations of obviousness were not upheld having regard to the cited document being of obscure origin, language or of limited circulation so that it was considered that the document was not a true base against which to judge whether an inventive step had been made. This would seem to be an equitable approach, but only time will show whether this is to be continued under the present s.3.

19 A case which may show up these two approaches in sharp contrast to each other is *Beecham Group's (Amoxycillin) Application* ([1980] RPC 361) where there was a strongly fought opposition under s.14 of the 49 Act. The Comptroller and the majority of the Court of Appeal can be said to have found the allegation of obviousness not sufficiently proven for the purposes of s.14 of the 49 Act on a subjective approach finding that, although the step taken from a particular prior art document was extremely small—in fact non-existent acording to one Lord Justice of Appeal—nevertheless it was not one which it was apparently obvious to the applicant company (who had made many other discoveries in the same field) to take, nor apparently at the time obvious to the opponents either, and the great commercial success that had resulted was not predictable. The Patents Court and one Lord Justice of Appeal took, *per contra,* what may be called the objective approach and held that discovery of the invention required only routine testing of the compounds disclosed in the applicant's earlier patent so that no inventive step had been made and these judges would therefore have refused the application. Clearly, there is here much controversy as to what constitutes "an inventive step" (as required by s.3). Could such a step be the flash of genius that selects a particular prior art document as the jumping-off point for future research work? If so, is there an invention when the routine testing of chemical

compounds, at least hinted at in the selected prior art document but not then prepared, leads to results which could not be predicted and which lead to the availability and commercial success of a new antibiotic drug? Because the *Beecham* case was decided under the 49 Act, it serves only to highlight the possible different approaches to the concept of obviousness: it remains to be seen which approach will prevail under the 77 Act. The case is the subject of explanation and comment by P. G. Cole ([1979] EIPR 317). The corresponding decision in New Zealand (also under the opposition criteria of the 49 Act) also went in favour of Beecham. In a lengthy decision (*Beecham Group* v. *Bristol-Myers* [*Amoxycillin*] *(No. 2)* [*New Zealand*] [1980] 1 NZLR 192) the facts were more fully canvassed than in the UK decision. The judge indicated that a fundamental question was "should the notional researcher have had the spotlight shine upon the cited prior art patent?"

* **19** The circumstances in which publication had occurred were considered by the Comptroller in *Konishiroku Photo's Patent* (*unrep.*, SRL 0/118/80 and 0/63/81) where the prior publication was a German specification which by the relevant date had only been received in the UK by Derwent Publications. While accepting that such receipt constituted publication though the specification would not by then have come to the attention of a skilled photographic chemist, obviousness was found on the basis of what would immediately be appreciated by a more general reader capable of understanding the document. Thus it would seem that the nature of the step to be taken from the prior art to reach the alleged invention has to be considered in relation to the skill of the readers who would at the relevant date have been likely to have seen it.

Commentary on Section 4

* **20** The comments made in *Blendax-Werke's Application* ([1980] RPC 491), as reported in the commentary on s.101 of the 49 Act in Appendix A to this Supplement, may be of value in enabling patents to be obtained for novel packs or other articles where the inventive step is a method of medical treatment of the human or animal body not patentable as such by virtue of s.4(2). Such packs will have industrial applicability and, if novel, may not be obvious in the absence of any public knowledge of the newly discovered method of treatment. Nevertheless, there must, apparently, be novelty over and above that provided by printed instructions (*Wellcome Foundation's Australian Application* [*Australia*] [1981] FSR 72).

Section 5: Relevant Rules

* **22** R.6(3) has been amended by substituting "period prescribed" for "period specified"; and in the proviso to r.6(6) "26 months" has been substituted for "25 months."