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**HASELTINE LAKE**   
EUROPEAN PATENT & TRADE MARK ATTORNEYS

### Gowers Review of IP in the United Kingdom Published

The Government review of the UK intellectual property system under Andrew Gowers (the Gowers Review) was published on 6 December 2006.

In the area of Chem/Pharma/Bio patenting, particular Recommendations to note are:

- 1 - calling for clarification of the law exempting "experimental use" from patent infringement;
- 7 - calling for the UK to encourage other countries to ratify the amendment of TRIPS permitting the compulsory licensing of pharmaceutical patents by developing countries to supply the market by importation - see [http://www.wto.org/English/tratop\\_e/trips\\_e/health\\_background\\_e.htm](http://www.wto.org/English/tratop_e/trips_e/health_background_e.htm);
- 17 - calling for the current provisions on patenting of genes to be maintained;
- 18 to 25a - calling for increased cooperation between Patent Offices and for the UK to support initiatives to reduce patenting costs;
- 35 to 45 - calling for various measures to improve enforcement of IP rights, especially in the digital environment but also including a centralised European patent litigation system;
- 50 - calling for less cross-subsidising of UK Patent Office examination costs from renewal fee income;
- 53 - calling for changing the name of the UK Patent Office to the UK Intellectual Property Office.

We will keep you informed on the extent to which the recommendations are taken up into legislation.

→ [http://www.hm-treasury.gov.uk/media/583/91/pbr06\\_gowers\\_report\\_755.pdf](http://www.hm-treasury.gov.uk/media/583/91/pbr06_gowers_report_755.pdf)

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### Clarity of Relative Expressions in EPO Claims

In Decision T378/02, EPO Technical Board of Appeal 3.3.4 recently had the opportunity to review the case law on the use of relative expressions in claims.

The term "smooth" - referring to a glass surface - was held to be clear in its context. The description and examples showed that the glass surface had to be **smoother than a reference surface** of controlled pore glass, and that an ordinary microscope slide had the desired smoothness. Therefore, the boundaries of "smooth" could be established and the term was clear.

The decision also provides a list of precedents (Paragraph 5.1 of the Reasons): The following were held to be clear in their context: "water-soluble" (T860/03); "long period of time" (T860/95), "transparent" (T649/97), "thin plate" (T1041/98) and "thin film composite" (T193/01). The following was held to be unclear in its context: "substantially pure" (T728/98).

→ <http://legal.european-patent-office.org/dg3/pdf/t020378eu1.pdf>

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### Two More Salutory Parameter Decisions from the EPO

In the October 2005 issue of this Newsletter we highlighted a group of EPO Board of Appeal decisions showing the risks of using poorly explained parameters to claim an invention.

We report here two further instructive examples recently decided by EPO Boards of Appeal.

In Decision **T751/03**, which was an examination – rather than opposition – appeal, a viscosity parameter caused trouble and proved fatal to the application. An emulsion composition was defined in the claims by reference to a parameter called "delivered viscosity", which meant a viscosity resulting from 30 day storage under a defined temperature-time profile. There was no information as to how quickly the viscosity needed to be measured after the storage period, and at what temperature. The application was refused.

In Decision **T908/04**, the patent was revoked after opposition in view of its failure to define the heating and

cooling rate to be applied when measuring the claimed parameter of polymer crystallinity using differential scanning calorimetry. The Board acknowledged that “some level of uncertainty can be permissible when it comes to sufficiency of disclosure...[provided that] this uncertainty does not jeopardize the validity of the measured parameter for the solution of the technical problem” (Reasons, paragraph 5.8). However, the heating/cooling rate information was critical, and its absence meant that the patent did not sufficiently disclose the invention.

→ <http://legal.european-patent-office.org/dg3/pdf/t030751eu1.pdf>

<http://legal.european-patent-office.org/dg3/pdf/t040908eu1.pdf>

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## A “Method of Diagnostic Imaging” is Patentable If the Diagnostic Step is Not Specified

In Decision T9/04, EPO Technical Board of Appeal 3.2.2 recently had the opportunity to consider the application of the Enlarged Board of Appeal Decision G1/04 concerning the patentability of diagnostic methods practised on the human or animal body (see the February 2006 issue of this Newsletter).

The claim defined “a method of diagnostic imaging an object” involving steps using multiple imaging apparatus, object handling equipment and data storage/processing equipment. It was clear that the “object” covered a patient or a sample obtained from a patient, and that the patient could undergo prior medical or surgical intervention. The claim neither stated nor implied the deductive step of using the resultant images to make a diagnosis by comparing the images with a standard (Reasons, paragraphs 5.1 to 5.3).

Such a deductive step was held in G1/04 to be an **essential requirement** of a diagnostic method practised on the human or animal body. Therefore, its omission meant that the claim was patentable.

Similarly, the claim did not define an unpatentable therapeutic or surgical method merely because of the possibility of an associated medical or surgical intervention.

→ <http://legal.european-patent-office.org/dg3/pdf/t040009eu1.pdf>

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