



Contents

Practice Guidelines

Patents

- **Methods of Medical Treatment of Humans**

The decisions of the Court of Appeal in the case of Pfizer Inc v Commissioner of Patents (CA22/03) issued on 28 June 2004. All three judgments of the Court conclude that “in terms of the present law, methods of medical treatment are not patentable” on the ground that it is generally inconvenient to protect them with letters patent or grants of privilege.

The Court maintained that reform of this area of law is best undertaken through the Parliamentary process that would enable full consultation with any interested parties. The Court accordingly upheld the decision of Ellis J in the High Court and dismissed Pfizer’s appeal.

Implications for new and pending applications containing claims for methods of medical treatment

The decision of the Court is that methods of medical treatment are not patentable, and accordingly those patent applications containing claims for methods of medical treatment that have been held in abeyance pending the outcome of the Pfizer proceedings may now be rejected.

These applications will be rejected on the ground that methods of medical treatment of humans are not patentable inventions under section 2 of the Patents Act 1953 (incorporating by reference section 6 of the Statute of Monopolies). The process that IPONZ will follow to reject these applications is as follows:

1. Applications will be taken out of abeyance at the rate of approximately 80-100 a week. Applications will be reviewed in numerical order.
2. A patent advisor will review each file and all applications will be issued with an Examination Report reiterating any outstanding objections. Claims for methods of medical treatment will be objected to on the ground that methods of medical treatment are not patentable inventions under section 2 of the Patents Act 1953.

3. Applicants will be given the greater of:
 - three months; or
 - any time remaining under section 19 of the Patents Act to respond to the Office. Any applications that are not in order for acceptance after this time will be voided.
4. A number of requests for a Hearing were received in respect of issues surrounding method of medical treatment claims. IPONZ considers that the matters raised by these requests have been clarified by the Court of Appeal decision in Pfizer. All applications where such a Hearing request was made will be processed as per paragraph 2 above.
5. New patent applications received that include method of medical treatment claims will be objected to under section 2. This includes any applications that have been divided out of other applications.

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