

23 March 2000

Information for Clients. No 10

This Information for Clients notice contains two parts:

- Part A covers policy decisions made by the Office and confirmation of proposed procedures after consultation with clients
- Part B covers proposed changes to procedures.

The Intellectual Property Office is considering the introduction of the practices contained in Part B. The proposals are being issued at this time to practitioners and other interested parties for comment by 30 April 2000.

Please address all feedback to Alan Hook, Acting Team Leader Client Services, at the Intellectual Property Office (email – alan.hook@iponz.govt.nz).

General Notice

The next issue of the Information for Clients will be the last to be printed in hard copy form. Subsequent issues will be published electronically, posted on our Internet site and delivered by email in Word format.

If you haven't already done so, please join our email database to ensure you continue to receive the Information for Clients in future. Email iponz@iponz.govt.nz to register your interest.

Contents

This document contains the following subjects:

Part A

- Patent Applications containing Swiss-type and/or Method of Medical Treatment Claims
- Definition of 'Resident' for the purposes of section 25(5) of the Patents Act 1953 and section 9(4) of the Designs Act 1953
- Restoration of an application under section 37 of the Patents Act 1953 where the complete specification has not been accepted

Part B

- Endorsement of Deeds of Assignment for Designs, Patents and Trade Marks

PART A

Patent Applications containing Swiss-type and/or Method of Medical Treatment Claims

The principal findings of the Court of Appeal in *Pharmaceutical Management Agency Limited v Commissioner of Patents and Ors* can be summarised as follows:

1. Swiss-type claims are patentable providing all the prerequisite requirements for acceptance, such as novelty, are met. The Commissioner's practice note dated 7 January 1997 remains applicable;
2. Claims relating to method of medical treatment are excluded from patentability on policy (moral) grounds upon the basis of the decision in *Wellcome Foundation Limited v Commissioner of Patents*.

Patent applications involving the above types of claims are currently held in abeyance by the Intellectual Property Office. The Office intends to start processing these applications during April 2000 using the following approach:

1. All applications previously accepted and advertised, and where the three month opposition period has passed without an opposition being lodged, will proceed through to grant. No further notification of this will be given to applicants.
2. Applications will be taken out of abeyance at the rate of approximately 30 – 50 a week. Applications will be reviewed on the basis of their application date with the oldest applications being processed first.
3. Each file will be reviewed by a patent advisor and, where all requirements for acceptance have been met, any:
 - a. application involving Swiss-type claims and no claims to methods of medical treatment will be accepted. Applicants will receive notification to that effect and the application will proceed through to advertisement.
 - b. application involving both Swiss-type and method of medical treatment claims will have an objection raised against the medical treatment claims. Applicants will be required to delete the method of medical treatment claims if they wish their application to be accepted.

Applicants will be given the greater of two months, or any time remaining under section 19 of the Patents Act, to reply to the Office. Any applications that are not in order for acceptance after this time will be voided.

- c. application involving only method of medical treatment claims will be refused on the basis that the use of such an invention (ie the exclusion of others from using the treatment) is contrary to morality (section 17 of the Patents Act) and, in the alternative, on the basis that such an invention is excluded from patentability on policy (moral) grounds (as per the decision in *Wellcome Foundation Ltd v Commissioner of Patents*).

4. A number of requests for a Hearing were received in respect of issues surrounding Swiss-type and method of medical treatment claims. The Office considers, in general, that the matters raised by these requests have been clarified by the Court of Appeal decision. All applications where such a Hearing request was made will be processed as per paragraph 3 above. Any fees paid where a Hearing was not held will be refunded.
 5. New patent applications received which involve only method of medical treatment claims will be refused as above. This includes any applications which have been divided out of other applications.
 6. The Office will continue its current practice to allow claims to methods for the treatment of humans except where the treatment identified relates to the treatment of illness or disease. Details of this practice were outlined in the October 1998 *Information for Clients* notice.
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Definition of 'Resident' for the purposes of section 25(5) of the Patents Act 1953 and section 9(4) of the Designs Act 1953

The test for determining whether a person is resident in New Zealand in terms of section 25(5) of the Patents Act 1953 and section 9(4) of the Designs Act 1953 is whether that person has a permanent place of abode in New Zealand, whether or not that person also has a permanent place of abode outside New Zealand. If it remains unclear whether a person falls within this definition a broader rather than narrower interpretation will be applied.

Restoration of an application under section 37 of the Patents Act 1953 where the complete specification has not been accepted.

Where an application is made under section 37 for restoration and an order is issued restoring that application, the applicant will be provided with three months, or less if requested, from the date of the order to comply with the legislative requirements imposed on them.

PART B – PROPOSED PRACTICE

Comments relating to this proposed practice are invited. All comments should be addressed to Alan Hook, Acting Team Leader Client Services (Email – alan.hook@iponz.govt.nz) by 30 April 2000.

Endorsement of Deeds of Assignment for Designs, Patents and Trade Marks

Proposal

The Office practice of endorsing the original Deeds of Assignment prior to returning those deeds to the applicant/attorney is to be discontinued.

Rational

There is no legal requirement for the Office to endorse the original Deeds of Assignment and the endorsement appears to serve no purpose.



Neville Harris
Commissioner of Patents, Trade Marks and Designs