

29 August 2000

Information for Clients, No.12

This Information for Clients notice confirms Office procedure concerning Patent Applications containing Swiss-type and/or Method of Medical Treatment Claims

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

The following is an addendum to the note headed, “Patent Applications containing Swiss-type and/or Method of Medical Treatment Claims” in the Information for Clients dated 23 March 2000:

Patent applications containing only method of medical treatment claims

Patent applications involving only method of medical treatment claims are currently held in abeyance by the Intellectual Property Office. The Office will commence processing these applications using the following approach:

1. *For applications received prior to 1 October 2000*

The Office will provide applicants with an opportunity to amend the method of medical treatment claims to an acceptable form, for example a Swiss-type claim. 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. Please refer to the article from the Information for Clients dated 23 March 2000.

2. *For applications received on or after 1 October 2000*

Unless in the circumstances of the particular application it would be unfair or unreasonable to do so, applications involving only method of medical treatment claims of the form which were considered in *Wellcome Foundation Ltd v Commissioner of Patents* will be refused on the basis that the use of such an invention is excluded from patentability on policy (moral) grounds.

Patent applications containing Swiss-type claims

For applications involving Swiss-type claims only, or a combination of Swiss-type and method of medical treatment claims, the process as outlined in the *Information for Clients* dated 23 March 2000 will apply. The Office will start to process these applications on 1 October 2000.

Patent Applications containing Swiss-type and/or Method of Medical Treatment Claims (23 March 2000)

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.



Neville Harris
Commissioner of Patents, Trade Marks and Designs