

5.6. IPONZ to Implement New Practice Guidelines – Claims Directed to Methods of Medical Treatment of Humans & Swiss-style Claims

On 16 November 2005, IPONZ issued the proposed “Guidelines for Examination of Methods of Medical Treatment of Humans” and “Guidelines for the Examination of Swiss-style Claims”.

We have since received and reviewed submissions from patent attorneys in New Zealand and Australia, the New Zealand Institute of Patent Attorneys and other interested parties. The Guidelines have been amended based on these submissions and are now in their final form.

Swiss-type claims that are distinguished from the prior art by the way in which the medicament is administered rather than the purpose of administration, have been considered by different Assistant Commissioners of Patents in *Abbott Laboratories* (P16/2003) and *Merck & Co v Arrow Pharmaceuticals* (P3/2006).

The resulting decisions are conflicting – the *Abbott Laboratories* decision approves the UK case *Bristol-Myers Squibb v Baker Norton Pharmaceuticals* [2001] RPC 1 (Taxol) and the *Merck* decision approves a contrary European case *Genentech Inc* (T1020/03).

Therefore, the current position relating to Swiss-type claims, where the novelty and inventiveness resides in a new method, time, frequency or dosage, is that the UK Court of Appeal's principles in *Bristol-Myers* have been adopted and rejected by different Assistant Commissioners in New Zealand.

Consequently, until the different approaches of Assistant Commissioners in *Abbott Laboratories* and *Merck* are resolved, either by being fully considered in a future decision of an Assistant Commissioner or by the Court, we consider that neither decision is necessarily and unequivocally binding on IPONZ examiners.

IPONZ has given careful consideration to this matter and we have determined that we will proceed to implement the practice as proposed in the “Guideline on Applications Relating to Swiss-type Claims” published on 16 November 2005, notwithstanding that parts of this guideline may be inconsistent with the views expressed by the Assistant Commissioner in the *Merck* decision.

On the information currently available to IPONZ, and after considering independent legal advice on the issue, it is considered that the Swiss-type claims guideline represents the correct position in relation to Swiss-type claims, where the novelty and inventiveness resides in a new method, time, frequency or dosage.

We note that the Swiss-type claims guideline merely offers examiners and hearings officers guidance, and does not constrain their exercise of judgement and discretion to make appropriate determinations in any particular circumstances.

A full version of the guidelines are available on the IPONZ website in the Patents section of the site.

If you have any questions relating to the “Guidelines for Examination of Claims Directed to Methods of Medical Treatment of Humans” or the “Guidelines for the Examination of Swiss-style Claims”, please contact Mark Pritchard – mark.pritchard@iponz.govt.nz, ph: (04) 978 3665.

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