

Changes to the Manual of Patent Practice: July 2010

Please find details below of the main changes which have been incorporated into the July 2010 version of the Manual of Patent Practice.

All such changes are indicated in the Manual by a sidebar, with any new text coloured red. Please note that all previous red text has been removed from the Manual such that any red text indicates a change since the April 2010 version. All paragraphs changed in either the April or July 2010 updates are indicated by a sidebar; all sidebars marking earlier changes have been removed from the Manual.

| Paragraph | Update |
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| 1.14 | Updated in light of <i>Tate & Lyle Technology v Roquette Frères</i> (discovery of underlying mechanism behind known process) |
| 1.29.5 | Guidance on technical contribution updated in light of <i>AT&T Knowledge Ventures' Application and CVON Innovations Ltd's Application</i> . |
| 1.29.6 | Commentary on Enlarged Board's decision in G 03/08 that referral on computer programs was inadmissible. |
| 1.29.7 | Current Office practice on computer programs confirmed; effect of UK and EPO case law discussed. |
| 1.32.3 | Guidance on presentation of information from <i>Gemstar-TV Guide International Inc v Virgin Media Limited</i> . |
| 2.14.1 | Discussion of novelty based on technical effect updated in light of <i>Tate & Lyle Technology v Roquette Frères</i> . |
| 2.19, 3.89-3.90 | Selection inventions practice updated in light of <i>Dr Reddy's Laboratories (UK) Ltd v Eli Lilly & Co Ltd</i> . |
| 3.33.1 | Discussion of common general knowledge updated in light of <i>Maxluck Biotechnology's Application and Ratiopharm GmbH v Napp Pharmaceutical Holdings</i> . |
| 3.69, 4.05.1-4.05.2, 14.79, 18.09.2 | Practice on standard of proof for questions of fact updated in light of <i>Blacklight Power Inc. v The Comptroller-General of Patents</i> . |
| 4.05.1-4.05.2, 14.79 | Practice on industrial application and sufficiency of inventions contrary to physical laws updated following <i>Blacklight Power Inc. v The Comptroller-General of Patents, Blacklight Power Inc.'s Application and Robinson's Application</i> . |
| 4A.03.3 | Practice on claims encompassing medical and non-medical treatments clarified. |
| 4A.06-4A.07 | Practice and EPO case law on diagnosis clarified. |
| 4A.09 | Practice on surgical methods updated in light of T 383/03, G 01/07 and <i>Virulite Ltd's Application</i> . |
| 4A.10 | General guidance on medical exclusions and role of practitioner clarified. |
| 4A.20, 4A.26-4A.28 | Extensive update of practice on second medical use |

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| | claims in light of G 02/08 and subsequent Practice Notice. |
| 4A.28.1-4A.28.2 | Update and further explanation of dosage regime practice in view of G 02/08 and <i>Actavis v Merck</i> . |
| 14.190 | Procedure on figures/formulae in abstract set out. |
| 15.28 | Practice on time limits for requesting substantive examination of divisionals clarified. |
| 15.40 | Practice on provisional allowance of ante-dating clarified. |
| 15.46 | “Foreshadowing” of a divisional defined, following <i>Irwin Industrial Tool Company’s Application</i> . |
| 17.05.1, 18.07 | Green Channel practice set out. |
| 17.104.1 | Practice on machine translations of citations updated. |
| 18.09.3-18.09.5 | Guidance on establishing date of internet citations updated and expanded, in light of T 1134/06 and EPO guidelines, <i>HSBC France’s Application</i> (and <i>Kavanagh Balloons Pty Ltd v Cameron Balloons Ltd</i>) and <i>Ranger Services Application</i> . |
| 18.10, 18.64.3 | Guidance on file inspection of equivalents updated. |
| 18.69, 18.69.1, 76.27 | Further guidance on limiting amendments which add matter in view of post-grant effect. |
| 19.26 | Practice on trade marks in CS&Es clarified. |
| 20A.11.1 | Procedure clarified on reinstatement after expiry of the compliance period. |
| 41.04 | Discussion of <i>Shanks v Unilever</i> (definition of “that person” in s.41(2)). |
| 76.26 | Practice on further post-grant amendments clarified. |
| 89.03, 89B.10 | Clarification on PCT Chapter I and Chapter II processing in international phase |
| 89A.14.2 | Procedure for incorrect PCT abstract set out. |
| 89B.08, 89B.12 | Clarification on search fees where supplementary search needed on PCT cases. |
| 89B.17.1 | PCT(UK) Fast Track practice set out. |
| SPC sections: SPM3.02.1 SPM3.05.1 SPM13.05 | Updated in light of: <i>Imclone Systems Inc. Ltd & Aventis Holdings Inc</i> (Articles 3(a) and 3(b); <i>Neurim Pharmaceuticals (1991) Limited v Comptroller General of Patents</i> – Office decision upheld at Patents Court and appealed further; and Reference to ECJ noted in <i>Merck & Co Inc v Deutsche Patent- und Markenamt</i> . |
| Table of cases | Updated accordingly. |
| Relevant notices | Practice notices on withdrawing patent applications with no rights outstanding, second medical use claims and PCT(UK) Fast Track added. |