Guidance on answering the discussion questions in the book

Para 11.25

To complete fully the novelty tests, notably those in *General Tire* and in *Synthon* there is the question of the scope of the invention. This is explored in more depth in Chapter 12 from the infringement perspective. Be aware, however, that approaching this exercise from just a question of novelty (or indeed obviousness) or infringement can be risky. A wide interpretation of the claim may catch an infringer; but this could lead to a finding of anticipation when viewed against the prior art. Such a situation has been termed the horns of a dilemma. Can you find the case where this term came from? And can you devise a scenario involving such horns?

Hint: Use your independent research skills. *Gilette* might come into it somewhere. Does this exercise change your view on whether a narrow or wide approach should be taken to the scope of the power conferred and how easy/hard it should be to get a patent?

Para 11.41

Look back at the definitions of the 'therapy' and 'surgery' in the previous section on method exclusions and in particular consider what we said about cosmetic methods of treatment. Are they 'therapeutic'? How does this affect the application of section 4A(3)? What about cosmetic surgery?

Hint: This is another opportunity to interrogate the case law.

Para 11.63

How many different factors can you think of that might influence market success?

Hint: This could be a long list! Consider also the extent to which a factor might have influence**.**

Para 11.98

The European Parliament felt it necessary to issue a Resolution in October 2001 calling on the EPO to reconsider the grant of patents to Myriad Genetics over the BRCA1 and BRCA2 ('breast cancer') genes (4 October 2001, B5–0633, 0641, 0651, and 0663/2001), www.europarl.europa.eu/sides/getDoc.do?pubRef=-//EP//TEXT+TA+P5-TA-2001-0523+0+DOC+XML+V0//EN&language=HU. In 2002, the Nuffield Council on Bioethics pointed out that because of the breadth of the patents as they were originally granted, 'there are currently no other methods of diagnosing the presence of the breast cancer susceptibility gene BRCA1 that can be used without infringing the patents'.[1] As the Nuffield Council itself has asked: is it in the public interest that there is only one diagnostic test available for a particular disease? Will patents such as those that assert rights over BRCA1 inhibit further research, even in the context of other diseases? Or does the prospect of a strong reward act as a stronger incentive to innovate? Reflect on the Nuffield Council's proposals. You may find this of interest: K Liddell et al, 'Patents as incentives for translational and evaluative research: the case of genetic tests and their improved clinical performance' [2008] 3 IPQ 286.

[1] Nuffield Council on Bioethics, *The Ethics of Patenting DNA* (2002), para 5.4.

Hint: Consider this discussion also in light of other discussion points in this book on the nature of monopolies. Does this field throw up any particular issues?

Para 11.101

The *ITS Rubber Ltd* case was decided under the 1949 Act. Do you think it would face any additional problems under the current legislation?

Hint: Consider the ways in which the legislation has changed over the year, e.g. method of manufacture is now no longer relevant.

Para 11.145

Does the previous comment about the exclusion of a method for digitally filtering data mean that such a claim could never succeed? Can you envisage examples where such a claim might be important to a prospective patentee? How might such a claim be successfully framed?

Hint: Bear this question in mind as you read through the rest of this chapter. There are some examples that come close to 'digitally filtering data' – consider how they are or might be differentiated from the example here.

Para 11.69 *Discussion Point 1*

The breadth of the law now means that it is no longer necessary to claim the software and the hardware, but is it ever expedient to do so? Might there be any advantages in

doing so?

Hint: Think about the nature of the monopoly that this would give you.

Para 11.186

What is the underlying rationale for excluding computer programs in Europe, especially when they are patentable in most other legal systems? Does the role of copyright in software protection make a difference? Can this approach be sustained? You may find it useful to reflect on the fact that the *Gowers Review of Intellectual Property* (HM Treasury, 2006), para 4.114,[2] recommended that the UK should maintain its policy of not extending patent rights beyond their current limits. The Review found mixed evidence of the success of 'pure' software patents, particularly from the United States, where the evidence actually seems to indicate that the software industry grew exponentially in the *absence* of patent protection. Other evidence suggests that where protection is available it is used negatively to restrict competitors rather than positively to encourage further innovation.

Again, go back to first principles. But equally, are there any practical or policy considerations of particular relevance in this field?

2 https://assets.publishing.service.gov.uk/government/uploads/system/uploads/attachment_data/file/228849/0118404830.pdf.

Para 11.232

What would the position be in respect of breast augmentation surgery or correction of the shape of the nose? Are these always and necessarily 'cosmetic'?

Interrogate the case law here, i.e. break down each of the decisions to determine which kinds of factors are relevant in deciding a case one way or another, then apply this to these examples.