

## Changes to the Manual of Patent Practice: October 2011

Please find details below of the main changes which have been incorporated into the October 2011 version of the Manual of Patent Practice.

All such changes are indicated in the Manual by a sidebar, with any new text coloured red. All previous red text has been removed from the Manual so that any red text indicates a change since the July 2011 version. All paragraphs which have changed since the January 2011 update are indicated by a sidebar.

| <b>Paragraph</b>                                    | <b>Update</b>  |
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| 1.31.1  | Discussion of the patentability of signal claims, with reference to <i>BBC/Colour television signal</i> (T163/85).   |
| 2.07  | Discussion of implicit disclosure updated in light of <i>H.Lundbeck v Norpharma</i> [2011] RPC 23.   |
| 3.30.2  | Discussion of common general knowledge updated in light of <i>Apimed Medical Honey v Brightwake</i> .  |
| 14.126  | Practice in relation to disclaimers clarified.   |
| 14.171.1  | Updated in light of <i>Abbott Laboratories v Medinol</i> - the applicant cannot rely on matter contained solely in an abstract for the purposes of claiming priority.  |
| 17.05.1 and 18.07                                   | Practice clarified in relation to accepting acceleration requests by electronic filing routes.   |
| 18.07.1   | Clarification of the earliest date a s.89 PCT application may be granted.  |
| 18.47   | List of common OPTICS processing statuses included.  |
| 18.63.3   | New paragraph setting out UK practice with respect to auxiliary sets of claims.  |
| 18.79   | Further details provided about arranging hearings.   |
| 60.24   | Discussion of <i>CoreValve v Edwards Lifesciences</i> [2009] EWHC 6 (Pat) included (exemptions from infringement: acts done for experimental purposes)   |
| 68.06, 68.07, 68.08                                 | New paragraphs in light of <i>H.Lundbeck v Norpharma</i> and <i>Schütz v Werit</i> [2011] EWCA Civ 927 (awarding of costs for infringement proceedings where a transaction, instrument or event has not been registered promptly). |
| 73.03.1   | Procedure clarified for the situation when post-grant amendments overcome a s.2(3) citation.   |
| 73.10   | Clarified that amendment of conflicting EP(UK) patent under s.27 is one way to avoid revocation under s.73(2); and that when centrally limiting at the EPO the time periods specified by the comptroller will still apply.         |
| s.118A  | New section 118A (Copyright in documents made available electronically for inspection under s.118(1)).   |
| 123.33.1 and ss.5, 20A, 89A, 89B, 118, 123 and 125A | Updated in light of the Patents (Amendment) Rules 2011 (SI 2011/2052) regarding the calculation of time periods prescribed in the Rules.   |
| 123.36.8  | Clarification of who can allow a discretionary extension   |

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|                | under r.108(3), e.g. to the compliance period.   |
| 130.05         | New Authority to Act schedule included.  |
| SPC section    | Updated in light of <i>Novartis vs Actavis</i> (C-442/11), <i>Generics (UK) Ltd v Synaptech Inc</i> (C-427/09), <i>Synthon BV v Merz Pharma GmbH &amp; Co KG</i> (C-195/09) and BL O/252/11. |
| Table of cases | Updated accordingly.   |