

## New Edition of C.I.P.A. Guide to Patent Acts Published

Article By:

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This “Guide” is a 1528 page book published by the Chartered Institute of Patent Attorneys via Thomson Reuters, and edited by Paul Cole and Richard Davis. Of course, it mostly focused on UK patent law, but draws upon a variety of sources, including decisions of the Boards of Appeal of the EPO, other EP contracting state and “even the USA.” This is the 9<sup>th</sup> Edition that is referred to by practitioners as the “Black Book.”

I can’t attempt to review this tome, but it comes with a 268 page index that comprises more than 120 Sections. The index is very well-organized. Of course, I turned first to Section 4A – “Methods of Treatment or Diagnosis” and then to Section 4A.07 – “The meaning of diagnosis”. This is taken from that Section:

“As indicated above, the position in the US differs significantly from that in the UK or before the EPO, and claims specifying methods of diagnosis without downstream patient treatment features are unlikely to be held valid.”

This section goes on to compare 8 U.S. decisions, such as Myriad, Meriel, Cleveland Clinic and Athena with the outcomes in Australia, Canada and, of course, the EPO. It is worth reading, or magnifying then reading, the fine print in this section. (The Guide was published just prior to the Supreme Court’s denial of cert. in Athena.) I also got drawn into “Patents for the first medical indication” (A4.08), at least until my eyes got worn out, but it was difficult to resist Sections like “The meaning of ‘therapy’” or “The meaning of ‘surgery’”. There is also a new Section 76A – “Biotechnological inventions”.

This Guide should be on every attorney’s desk. Although you may never need to reference many of the Sections, the Guide will help you to second-guess your European associates as well as to help you to answer otherwise potentially embarrassing questions about the case law and Rules of the UK/EP, asked by your associates or your clients. I did not find a notice that the Guide can be obtained for online use, but that would be a good idea. Perhaps one of the 28 editors could answer this question.

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