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Royaume-Uni  
Vereinigtes Königreich

**Report Q.180**

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**Content and relevance of industrial applicability and/or utility as requirements for patentability**

*1. What is the situation in your country?*

*The first part of the Questionnaire will deal with an assessment of the current situation in the various countries. The Groups should give an overview of the legal situation in their respective country and inform about whether there are additional requirements for patentability besides novelty and inventive step.*

*1.1 Does your country know industrial applicability or utility as an additional requirement for patentability besides novelty and inventive step?*

*The Groups are invited to state whether industrial applicability and/or utility are required to make an invention patentable. They should also inform about the legal background and state whether such a requirement, if it exists, comes from statutory law or has been established outside the statutory law by their case law. Some countries may distinguish between the two whereas other countries may follow Art. 27 TRIPS and use both terms as synonyms.*

1.1 Industrial applicability is a requirement for patentability under the UK Patents Act 1977(Section 4) and the EPC (Article 57). UK law is intended to be the same as the EPC in this respect. There is no separate requirement for "utility" or usefulness, although the English Court of Appeal has indicated, in the context of considering industrial application, that "industry does not exist ... to make or use that which is useless for any known purpose" and that "monopoly rights should be confined to that which has some useful purpose" (*Chiron v Murex* [1986] RPC 535 at page 607)

*1.2 How does this comply with TRIPS?*

*This question is of particular interest with regard to those countries whose law does not specifically state industrial applicability or utility as a requirement for patentability. The Groups should state how the system in their country is brought in compliance with TRIPS and how additional requirements for patentability are treated.*

1.2 The provision in UK law complies with TRIPs as it uses essentially the same language. There is not thought to be any distinction between the use of the words "susceptible"(in the EPC) and "capable"(in both TRIPs and the 1977 Act) in this context.

There are no other requirements for patentability, other than that the invention does not fall within certain specific exclusions, which are not expressed as relating to industrial applicability (computer programs “as such” etc). These exclude items which are not deemed to be inventions.

## *2. Industrial applicability*

*The Groups which have listed industrial applicability as a requirement for patentability are invited to describe in more detail what the elements of this requirement are and how this is examined in practice. For those countries which do not know this requirement it might be of interest to answer this part of the question if the Group feels a need to implement this requirement in the future and to express their views on the various aspects.*

### *2.1 How is industrial applicability defined?*

*The Groups could state whether there is a definition of industrial applicability by law or whether it has been developed by their case law. The elements which constitute industrial applicability should be described. This includes a definition of the term "industry" which may differ from country to country. A wide range of definitions is possible from the broadest sense on the one side to a very narrow interpretation on the other side which might limit the term to "old" or "conventional" fields of industry. It will also be of interest how patentable inventions are distinguished from inventions which are industrially inapplicable and to which nature of invention these typically belong, e.g. mechanical, chemical, biotech or software related inventions. Are there differences between process and product claims?*

### *2.2 What is the relevance of industrial applicability and how does it affect granting proceedings?*

*Although industrial applicability may be a prerequisite for patentability its relevance may be limited. The Examination Guidelines of the EPO clearly show that the requirement of industrial applicability only plays a minor role in its examination proceedings and that very few inventions are not patented due to a lack of this requirement. In many cases the examiner may find a different reason for denying the patent, such as insufficient disclosure or lack of inventive step. How is this done in your country and what is the effect on the granting proceedings? What is the ratio compared to other grounds of refusal and what are examples of specific cases? It would also be interesting to hear about whether there are special tools for the examiner to assess a lack of industrial applicability and which standards are applied to this requirement.*

2.1/2.2 In practice, lack of industrial applicability is not used as a ground for refusing patentability except in the following particular situations:

- Methods of medical treatment. [Note: this exception will remain when the revision of the EPC comes into effect, but will be expressed as a specific exception to patentability and not any longer as a deemed lack of industrial applicability];

- Perpetual motion machines and the like; [Note: this exception is of no practical relevance]
- Gene sequences. [Note: Directive 98/44/EC of the European Parliament and of the Council on the Legal Protection of Biotechnological Inventions, requires by Article. 5.3 that the industrial application of a sequence or partial sequence of a gene must be disclosed. The UK Patent Office now requires that patent applications to gene sequences must demonstrate a specific and substantial function and therefore be capable of industrial application. It would appear however that to impose such a requirement in this specific context, separate from any addressed in the context of inventive step and sufficiency, is to discriminate between fields of technology and is in our view unnecessary and undesirable.]

Other than in the above areas the number of cases refused on this ground is negligible. Apart from the above categories, in practice a broad view is taken of the meaning of industrial application: use may be in "any kind of industry, including agriculture". Lack of industrial applicability is not used as a ground for rejecting applications for subject matter in "new" industries, e.g. e-commerce, which may be rejected on other grounds, e.g. lack of inventive step (which is deemed by the EPO to encompass absence of technical effect). Even in the cases mentioned above, it seems possible that other objections could arise, such as insufficiency (perpetual motion machines) and "mere discovery" (gene sequences), such that the requirement of industrial application would be redundant.

### *2.3 How is industrial applicability treated in proceedings concerning the validity of patents?*

*Similar problems can be found in invalidation proceedings, i.e. opposition proceedings or nullity actions. Is the lack of industrial applicability a separate ground for opposition or nullity? What are the requirements for the opposing party to establish such a ground? Again the practical relevance should also be considered as well as the way opposition authorities or nullity courts deal with this.*

2.3 Not being a patentable invention is a ground of revocation of a patent which includes the requirement of industrial applicability. An opposing party would have to establish this ground by evidence. There is little case law in the UK apart from *Chiron v. Murex*. In this case part of a claim was held invalid on the basis that it included within its scope a vast number of compounds which were useless for any known purpose. In similar cases objections have been raised on other grounds, e.g. insufficiency (*Pharmacia v. Merck* ([2002] RPC 41), or, in the EPO, lack of inventive step (*Agrevo / Triazoles* (T 939/92 [1996] OJ EPO 309). We also note the finding of the EPO Opposition Division in ICOS on 22 August 2001, in which the claimed invention was found to lack industrial application, because the specification neither explicitly nor implicitly indicated the involvement of the relevant protein in immunological processes and so did not indicate that the invention was capable of exploitation in relevant industrial applications, but would also note that all the claims were found to lack inventive step and also to be insufficient, although they were found not to relate to a discovery as such. Thus it is not clear that the requirement of industrial applicability serves any useful purpose in practice.

### 3. Utility

*The same aspects have to be assessed with regard to the requirement of utility. Those Groups in whose countries utility is required are invited to comment in detail on the elements of this requirement and the application in practice. Again, those Groups which do not have the requirement of utility are requested to state what their suggestions are if they would like to see utility as a requirement for patentability in the future. The following questions have the same contents as the questions listed above for industrial applicability so that further explanations are not necessary at this point.*

3. There is no separate requirement of “utility” under UK or EPC law. Nor, for the same reason as outlined above in relation to industrial applicability, is it felt that there is any need for such a requirement. Accordingly the remaining questions in this section are not applicable.

#### 3.1 How is utility defined?

*What are the elements which constitute utility? When is an invention considered useful? How are useful inventions distinguished from non-useful inventions? In which fields of technology does this requirement play the most important role?*

#### 3.2 What is the relevance of utility?

*How is utility examined by the patent authorities? How does the lack of utility affect granting proceedings? Does this requirement play a significant role in the number of rejected patent applications? What are examples and how is this requirement combined with other requirements, in particular with the inventive step/non-obviousness of the invention?*

#### 3.3 How is utility treated in proceedings concerning the validity of patents?

*Is the lack of utility a separate ground for invalidity? What are the requirements for the opposing party to establish such a ground? What is the practical relevance of this ground for invalidation?*

### 4. Conclusions

*In this part of the Questionnaire the Groups are invited to express their views as to whether industrial applicability and/or utility should be used as additional requirements for patentability and, if so, what are the reasons and what should be their definition and elements. If the Groups are of the opinion that industrial applicability or utility should not be considered as additional requirements they are requested to give their reasons as well. The Groups should also consider suggestions for the harmonization of both requirements towards each other.*

It is not felt that industrial applicability and/or utility either are, or should, be necessary requirements for patentability. As has been explained, the existing requirement of industrial applicability in UK and EPC law does not in practice add

anything to the requirements of inventive step or sufficiency. It is not felt that there is any need for an additional requirement of “utility” for the same reason.

*The Groups are also invited to make additional comments on any other aspect which they might find relevant in the context of this Question.*

## **Summary**

The existing requirement of industrial applicability in UK and EPC law does not in practice add anything to the requirements of inventive step or sufficiency. For the same reason we do not feel that there is any need for an additional requirement of “utility”. Notwithstanding this, and given that the existing requirement of industrial applicability does not, historically, appear to have caused any problems in practice, we consider that any change to the existing law in this respect should be approached with caution. However we detect, for example in relation to gene sequences, increasing attempts to use industrial applicability as a disguised means of seeking to introduce new exclusions from patentability without exposing to scrutiny their arbitrary and technology specific nature by listing them as express and specific exclusions. We consider such a practice to be undesirable.

## **Zusammenfassung**

Das zur Zeit geltende Erfordernis der gewerblichen Anwendbarkeit im britischen Recht und im EPÜ fügt dem Erfordernis der erfinderischen Tätigkeit und der Offenbarung im Grunde nichts hinzu. Aus diesem Grunde meinen wir, dass keine Notwendigkeit besteht, zusätzlich das Erfordernis des „Nutzens“ einzuführen. Nichtsdestotrotz und angesichts der Tatsache, dass das bereits existierende Erfordernis der gewerblichen Anwendbarkeit bisher in der Praxis offensichtlich keine Probleme verursacht hat, sind wir der Ansicht, dass bei allen etwaigen diesbezüglichen Änderungen des geltenden Rechts Vorsicht geboten ist. Allerdings sind zum Beispiel im Bereich der Genom-Entschlüsselung immer häufiger Versuche zu beobachten, die gewerbliche Anwendbarkeit als ein verstecktes Mittel zu benutzen, neue Ausnahmen von der Patentierbarkeit einzuführen, ohne ihre willkürliche und technisch hochspezifische Art einer Prüfung zu unterziehen, was sehr wohl erfolgen würde, wenn sie als ausdrückliche und spezifische Ausnahmen genannt werden würden. Wir halten derartige Praktiken für unerwünscht.

## **Résumé**

Dans la pratique, les exigences actuelles concernant l'applicabilité industrielle du droit du Royaume Uni et du droit relatif à la CBE, n'ajoutent rien aux exigences liées à l'activité inventive ou à la suffisance. C'est pour cette même raison que nous estimons n'avoir nul besoin d'exigences additionnelles en matière “d'utilité”. Cependant, et du fait qu'historiquement parlant, les exigences actuelles concernant l'applicabilité industrielle semblent n'avoir causé aucun problème dans la pratique, nous considérons que toute modification du droit existant en la matière devrait être considérée avec beaucoup de prudence. Nous détectons toutefois, comme par exemple dans les cas relatifs aux séquences génétiques, des tentatives de plus en plus fréquentes d'utilisation de l'applicabilité industrielle comme moyen détourné pour essayer d'introduire de nouvelles exclusions de la brevetabilité, sans exposer

leur nature arbitraire et spécifiquement technologique à une recherche minutieuse, en les listant en tant qu'exclusions expresses et spécifiques. Nous considérons que ce genre de pratique est indésirable.