PATENTS ACT 1977

IN THE MATTER OF
Patent Applications GB9412950.9;
GB9507929.9; GB9822734.1 and
GB9822737.4 in the name of
Kenneth F Prendergast.

DECISION

1. The applications in suit comprise (a) parent application GB9412950.9 of priority date 28 June 1994 and its divisional GB9822734.1 and (b) parent application GB9507929.9 of the same priority date and its divisional GB9822737.4. In order to comply with the section 20 period all four applications must therefore be marked as "in order" for grant by 29 December 1998 (28 December 1998 being a Bank Holiday and therefore an excluded day for the purposes of section 120 of the Act).

2. Briefly, for the purposes of this decision, all four applications relate to new uses of one of the known pharmaceutical compounds ondansetron and granisetron. Claims in the applications to these new uses are in the "Swiss-type" format, which those familiar with pharmaceutical patents in the United Kingdom and Europe will recognise as being available to applicants who have found a new pharmaceutical use for compounds that have previously been recognised as having a different pharmaceutical use. In the applications the new uses claimed for ondansetron and granisetron are in the areas of the treatment of battle fatigue, combat stress reaction, post traumatic stress disorder in civilian and military emergency situations, neurological symptoms associated with chemical warfare and nausea associated with chemical or biological warfare.

3. There is as I understand it no argument about the format of the claims, however, there has

for some time been a dispute between the Examiner in the case and the Applicant about whether the claims are supported by the description which is a requirement of section 14(5)(c) of the Act. As a result of this ongoing dispute the matter came before me to decide at a Hearing on 8 December 1998 where Dr Prendergast appeared in person and Mr John Jenkins appeared as the Examiner on behalf of the Office.

4. At the hearing Dr Prendergast presented a very full argument, based on a prepared written submission, as to why in his opinion the descriptions of all the applications were supportive of the fact that the inventions defined in the "Swiss-type" claims had in fact actually been made rather than just being a matter of some speculation, which was Mr Jenkins' case. In support of his position Dr.Prendergast sought to distinguish the situation in his applications from those forming the background to the decisions made in Hoerrmann's Application [1996] RPC, 341, Consultant Suppliers Ltd's Application [1996] RPC, 348 and McManus's Application [1994] FSR, 558. He also quoted other decisions in order to set out what he considered should be the approach of the Office to "Swiss-type" claims.

5. At the conclusion of the hearing I pointed out to Dr Prendergast that I would need time to carefully consider his arguments alongside those of the Office. Moreover, because I was aware of having to give a decision before the 29 December 1998, the final date of the section 20 period, the Christmas period intervening, I told him that it was more than likely that I would have to issue a brief decision which would then be followed by a Statement of Reasons setting out the arguments behind my findings. This decision is therefore of the brief nature that I had previously envisaged.

6. Having considered all the arguments I have come to the conclusion that I am not satisfied that the claims in all the four applications in suit are supported by the respective descriptions as required by section 14(5)(c). I can see no way in which the Applicant can remedy this situation and therefore I decline to allow the applications to proceed to grant.

7. I will follow this decision with a Statement of Reasons in as short a time as reasonably possible.

8. Since this decision is on a matter which is other than procedural the Applicant has a period of 6 weeks from the date of the decision in which to appeal. Should it be that when he gets my Statement of Reasons he considers he has insufficient time left within that 6 weeks to reasonably consider whether he should appeal he may apply to the Comptroller for an extension. Any application for an extension must be made prior to expiry of the 6 week period I have just set. Only one period of extension can be granted by the Office.

Dated this 17th day of December 1998

D L WOOD

Superintending Examiner, acting for the comptroller

THE PATENT OFFICE