



BL O/074/06

20th March 2006

PATENTS ACT 1977

APPLICANT Kaizen Matsumoto

ISSUE Whether patent application number GB
0426489.1 complies with section 1(1)(b)

HEARING OFFICER C L Davies

DECISION

REDACTED VERSION: OPEN TO PUBLIC INSPECTION
This version omits certain text, which has been replaced by asterisks(*)

Background

- 1 Patent application GB0426489.1 (the Application), entitled “Carcinogen solvents in reducing the carcinogen concentration of cells”, was filed by Mr Kaizen Matsumoto (the Applicant) on 2nd December 2004.
- 2 The application relates to the *****.
- 3 Combined search and examination (accelerated) was requested at the time of filing and a report under Section 17 and 18(3) was issued to the applicant on 26th January 2005.
- 4 Dr Simon Grand (the Examiner) cited 5 X category documents against the original claims and in his examination report, raised novelty, inventive step, support & clarity objections. He also brought to the Applicant’s attention the accepted format for second medical use claims. The Examiner cited inter alia ***** (the Citation), ***** , to demonstrate that the claims lacked an inventive step.
- 5 In response (letter dated 15th April 2005), the Applicant addressed the Examiner’s objections and filed a set of amended claims 1-11.
- 6 The Examiner, in a further examination report (18th May 2005) objected to amended claims 1-11 as lacking an inventive step, again citing the Citation.
- 7 In a letter dated 13th July 2005, the Applicant presented arguments against the Examiner’s inventive step objection and queried how he should proceed if these arguments were not accepted. The Examiner, in a further report (7th

September 2005), suggested an interview/video conference meeting with the Applicant but maintained the inventive step objection. The Examiner indicated matter which could possibly form the subject of a claim. The Applicant, in yet a further response (8th September 2005), presented further arguments against the inventive step objection and indicated that he would like a formal hearing on the matter.

- 8 In letters (pre-hearing reports) dated 12th October & 29th November 2005, the Examiner clearly set out the issue of inventive step to be addressed at a hearing. A hearing date was set for 30th November 2005.

The Issue

- 9 The issue of whether claims 1-11 as filed on 15th April 2005 satisfied Section 1(1)(b) of the Patents Act 1977 came before me to decide at a hearing on 30th November 2005. The Applicant represented himself and was accompanied by Mrs Josephine Matsumoto (mother) and Mr Isao Matsumoto (brother).

The Claims

- 10 Amended claim 1 reads:

“*****”

Claims 2 and 3 respectively, refer to *****.

- 11 *****

The Hearing

- 12 At the hearing, the Examiner presented the outstanding issue of inventive step as set out in the pre-hearing report dated 29th November 2005 and which addressed the points which the Applicant had made in his correspondence with the Office. The Applicant was then given the opportunity to respond.
- 13 The Applicant questioned the Examiner’s application of the 4 step test for inventive step according to *Windsurfer International Inc v Tabur Marine* [1985] RPC 59. In particular, he questioned what constituted the common general knowledge of a man skilled in the art at the priority date of the Application.
- 14 The Applicant asserted that the “theory” set out in ***** (the Citation) ie. ***** , goes against what the skilled person in the art would recognize ie. that ***** . He asserted that a person skilled in the art, on reading the Citation, would dismiss it on the basis that its teachings in respect of ***** would contradict what is accepted as common general knowledge. He pointed out that there exists a prejudice between what is known in the Citation and in the present Application compared with what is accepted as the common general knowledge of a skilled person. He asserted therefore that the Citation could not possibly render the present Application obvious. The Applicant proceeded to refer to references and to an e-mail communication from ***** , which he claimed demonstrated the common general knowledge surrounding ***** . The Applicant had not made

these references available to the Examiner for consideration prior to the hearing.

- 15 This line of argument was presented at the hearing for the first time and it was clear to me that the references on which the Applicant was now relying would need to be given full consideration by the Examiner in his assessment of the inventiveness of the Application. I queried with the Applicant how many references he had to support his argument and following his indication that there were quite a few, it was apparent to me that I could not simply adjourn the hearing briefly for these to be considered. I advised the Applicant that I would confirm with him the admissibility of the references to which he was referring and I drew the hearing to a close.

Conclusions

- 16 I am not able to reach a decision on inventive step on the basis of the facts heard. I allow the applicant to file references which he considers to support his argument. The e-mail from ***** however is not admissible as evidence as it stands and the Applicant, if he wishes to rely on this, will need to provide this in the form of a witness statement pertaining to the issue of the common general knowledge in the art at the priority date of the Application. These references and witness statement, once filed, will be forwarded to the Examiner for further consideration in respect of the issue of inventive step. In the event that the Examiner maintains his inventive step objection, the Applicant will be given the opportunity to respond and if necessary, to request a further hearing. I allow the Applicant until 12th February 2006 to file the references/witness statement but given that the Application is being processed as a combined search and examination, the Applicant has until 4th December 2006, the date for response to the first section 18(3) examination report, to file all the information which he requires the Examiner to consider.

Appeal

- 17 Under the Practice Direction to Part 52 of the Civil Procedure Rules, any appeal must be lodged within 28 days.

C L Davies

Deputy Director acting for the Comptroller