

Routine rejection: Is the EPO's approach to antibody and polymorph claims correct, balanced and justified?

The Journal of Intellectual Property Law & Practice has published an article in which partner Darren Smyth and Stephen Ingham, Assistant General Patent Counsel, Eli Lilly & Company, discuss the EPO's approach to antibody and polymorph claims.

In this article, the assessment of inventive step, in particular by the European Patent Office (EPO), is considered. In relation to certain types of claim, namely claims directed to structurally defined antibodies, or crystal forms, the terms of the claims are frequently not sufficiently considered, and inventive step denied. In these fields, lack inventive step is often alleged on the basis that it would be obvious to arrive at something functionally equivalent to the claimed result/solution, even if not the actual features which are claimed.

The authors consider that this practice is not justified by reference to the approach taken by the EPO to inventive step generally or; by public policy considerations. The practice does not accord with usual practice in relation to small molecules, and is out of step with practice in the USA.

The authors also draw on recent UK and EPO jurisprudence in relation to antibody patenting to offer insights into the effects of this practice in a wider context. They further consider that over-dependence upon surprising effects in support of inventive step is not desirable, and this view is supported by UK jurisprudence.

The views expressed in this article are put forward by the authors for the purposes of

debate. They do not represent positions taken by Eli Lilly or by EIP.

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