Reach-Through Claims in Patents for Research Tools and Reach-Through Obligations in Agreements Licensing the Use or Exploitation of Such Tools

1. Introduction

Under the patent laws of most countries, particularly in Europe, Japan and USA, reach-through claims were deemed deficient for want of industrial application (utility) or sufficiency or both. If no specific function was assigned to the claimed subject matter, a reach-through claim to a genus of compounds would lack industrial application. Even if a specific function was assigned, the claim would be invalid for insufficiency if it encompassed a genus of compounds, but did not define the relationship between the structural features of the member compounds and the specific function. Yet the likelihood of invalidity has not deterred patent applicants from seeking and patent offices from allowing such reach-through claims. Techniques, such as X-ray crystallography, might enable potential patent applicants to satisfy the written description requirements. Thus a claim that would be disallowed now could be unobjectionable in a few years' time.

2. Reach-Through Claims in Patents

Most reach-through claims encompassing a future or as-yet unidentified compound or genus of compounds were unlikely at present to satisfy these requirements – although it should be noted that even a potentially invalid claim might not be entirely worthless in commercial negotiations. Unless the claims were declared by a court to be invalid, their worth might be realised in preliminary legal proceedings to delay the entry of imports to the patent jurisdiction.

The owner of a patented research tool, seeking to gain the maximum benefit from its use, would want to reach through, whether by agreement or through patent infringement damages, to commercial products or services which, but for the other's use of the tool, would not have been made nor be provided. If the patented tool included a reach-through claim, for example in the general form of "an isolated and purified X identified by the method of claim Y", the claim of the patent could be attacked for invalidity if the patent owner of the research tool wished to enforce it. The owner would argue that the defendant to an infringement action was importing a product obtained directly by means of the patented method.

3. Reach-Through Obligations

Although the patent laws have yet to be interpreted by the courts in the context of patented research tools, it should not be assumed that a product obtained from a patented research tool would be excluded from the reach-through claims of the research tool, and whether the product thereby obtained lost its identity during further processing was a different issue. It would be reasonable to obtain a licence to use the method and to pay a royalty rather than risked the loss of a significant investment in research & development even though the research tool was not patented in the jurisdiction where it was being used. A negotiated royalty could be less costly than a judicial award of compensatory damages.

4. Conclusion

Through the understanding and application of the reach-through concept, the use or exploitation of patented research tools could represent a significant threat and opportunity for the biomedical sciences industry if applied to good tactical effect. Hence, professionals in this industry responsible for managing Intellectual Property (IP) assets should be aware of the legitimate uses of these assets including the tactical deployment of IP and to keep abreast of the relevant IP developments.

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