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Another Fine Mess! – Confusion about New Matter in Europe, and Beware of Amendments suggested by the EPO!

It is well known that, in Europe, patent applicants must resist the temptation to change the wording when introducing an amendment from the description into the claims. Any amendment which adds information that was not clearly and unambiguously derivable, either explicitly or implicitly, from the application as filed will add “new matter”. Where the basis for the amendment is the original drawings, additional problems can arise through trying to reformulate the information content of the drawings into claim wording.

Importantly, even if the European Patent Office (EPO) or other examining Patent Office does not object, the presence of the “new matter” provides a permanent ground of invalidity, which can be impossible for the patentee to cure.

The recent decision of the English Court of Appeal in the case of **European Central Bank v Document Security Systems Inc.** (Case A3/2007/0879), although not in the chemical and life sciences area, provides a useful illustration of the difficulties for patentees caught in this situation. It also shows that opposite decisions can still arise in multiple parallel patent litigation in different European countries.

The patent (EP(UK) 0455750) relates to the printing of documents, for example bank notes, in ways that cannot be photocopied. In the claimed method, the printable image is an original image overlain with a grid pattern of parallel lines that have a pitch difference slightly different from the pitch difference of the scanning lines of a photocopier.

This feature of claim 1 had been inserted at the suggestion of the EPO Board of Appeal, based on the drawings of the application. The Court held that the fact that the EPO had suggested the amendments did not stop them from being new matter (Judgement of Jacob LJ, paragraph 13).

The patentee argued that drawings, which showed an image overlain by a grid pattern of parallel lines, provided the necessary implicit basis. However, the Court held that the “implicit” information derivable from the drawings had to be understood by their verbal description in the application. When that was done, it was clear that the illustration was showing the moiré-type interference that *would* happen when the scanning lines of a *photocopier* are overlain on an (unadjusted) image. It did not illustrate adjusting an image for printing (Judgement of Jacob LJ, paragraphs 30-36). The new matter occurred in claim 1, and it was impossible for the patentee to delete it in a curative amendment. That would impermissibly broaden the scope of protection after grant.

In parallel litigation in Germany, France and Netherlands, the French court has held – like the English court - that new matter had been added, whereas the German and Netherlands courts have held that new matter had **not** been added. As Jacob LJ pointed out (Judgement, paragraph 5), this divergence of opinion between national courts illustrates “yet again” why a unitary system of patent litigation is required in Europe.

Our comment is that this case also clearly illustrates that formulating an amendment, especially in claim 1 or where the basis for the amendment is a *drawing* or some other *implicit teaching* from the original application, requires extreme care.

→ <http://www.bailii.org/ew/cases/EWCA/Civ/2008/192.html>

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English Court Considers Infringement of Claims to “Isolated” DNA

The recent case of **Monsanto Technology LLC v Cargill International SA**, (Case HC06C00585), now under appeal, was the first English litigation on a genetically modified (GM) crops patent. We provide here a summary of the first-instance decision and will report when the appeal judgement is issued.

The Court in the first-instance decision held that the patent (EP(UK) 0546090) – which relates to genetic modifications which provide a soya plant with resistance to glyphosate weedkiller – is valid but not infringed by Cargill’s importation of GM soybean meal.

The claims of the patent, which were amended in the litigation, specified isolated DNA sequences, a promoter/structural DNA/non-translated-region DNA molecule, plant cells comprising the DNA molecule and a method of producing GM crops by inserting the DNA molecule into the genome of a plant cell and then regenerating the crop plant.

Non-infringement was found on the basis of (i) the imported soybean meal containing only trace amounts of DNA, which in any event was not “isolated” (separated-out) from other DNA or plant material, (ii) a narrow interpretation of the claimed feature of the DNA encoding a “Class II” EPSP synthase, and (iii) the imported soybean meal being not the “direct product” of the claimed method of producing GM crops, but at best only a lineal descendant of an ancestor transformed laboratory soya plant.

→ <http://www.bailii.org/ew/cases/EWHC/Patents/2007/2257.html>

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Strict EPO Test for Priority Confirmed in Biotech Case

In the recent EPO Technical Board of Appeal decision T1213/05, Board 3.3.04 under the chairmanship of Kinkeldey held that priority is lost where the claimed DNA sequence does not correspond exactly to the sequence of the priority document but deviates from it "within the limits of experimental certainty" (Reasons, paragraph 29).

→ <http://legal.european-patent-office.org/dg3/pdf/t051213eu1.pdf>

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Introduced Disclaimer Not Available Where Prior Art is Unclear

In the recent EPO Technical Board of Appeal decision T286/06, Board 3.3.06 held that a disclaimer is not available where the prior art disclosure is unclear (here: "biodegradable", a relative and hence objectively unclear concept), as the availability of introduced disclaimers does not override the normal requirement that the claims of a European patent must be clear (Reasons, paragraph 2.1.4)

→ <http://legal.european-patent-office.org/dg3/pdf/t060286eu1.pdf>

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Recombining Parts of a More Complex Definition of a Composition Adds New Matter

In EPO Technical Board of Appeal decision T794/05, Board 3.3.02 held that an amended claim to a pharmaceutical composition "comprising components A and B together" adds new matter where the original application defined a medicament "containing, separately or together, A and/or a physiologically acceptable salt and/or solvate thereof and B for simultaneous, sequential or separate administration". The amendment contained too much picking-apart and recombination of features, and the end position was not clearly derivable from the original definition (Reasons, paragraph 3.1.1).

→ <http://legal.european-patent-office.org/dg3/pdf/t050794eu1.pdf>

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