

# English Patents Court disapproving of EPO's approach to assessment of novelty: Lundbeck v Norpharma and Infosint

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As previously discussed, the English Court of Appeal has clearly stated its support for judicial collaboration facilitating *de facto* harmonisation of patent law in Europe (*Grimme Landmaschinenfabrik GmbH v Scott* [2010] EWCA Civ 1110). However, in a recent decision in the English Patents Court (*Lundbeck v Norpharma and Infosint* [2011] EWHC 907), Floyd J. expressed disapproval of the way in which the EPO had assessed novelty (Article 54 EPC) in *Unilever* case T 666/89. On the facts, however, Floyd J. did not find it necessary to reach a concluded view on the correctness of the EPO decision.

The English case in question (*Lundbeck v Norpharma and Infosint* [2011] EWHC 907) concerned Lundbeck's challenge to the validity of the Norpharma/Infosint patent in suit, which claimed a process for the preparation of 5-carboxyphthalide. The process of claim 1 involved "...fuming sulphuric acid containing 20-33% by weight of SO<sub>3</sub>...". Lundbeck alleged that the claim lacked novelty over a Danish patent application. The Danish application did not disclose any specific percentage of SO<sub>3</sub> in sulphuric acid, but Norpharma/Infosint submitted that concentrations of SO<sub>3</sub> from 1 to 99% were disclosed by implication.

Floyd J. referred to the leading case on novelty from the House of Lords, *Synthon's Patent* ([2006] RPC 10), according to which there are two requirements for a claim to be anticipated by a prior document: disclosure and enablement. As to disclosure, Floyd J. cited extracts from Lord Hoffmann's judgment in *Synthon*, approving the Court of Appeal's judgment in *General Tire and Rubber v Firestone Tyre and Rubber* [1972] RPC 457:

"If the prior inventor's publication contains a clear description of, or clear instructions to do or make, something that would infringe the patentee's claim if carried out after the grant of the patentee's patent, the patentee's claim will be shown to lack the necessary novelty";

"...whether or not it would be apparent to anyone at the time, whenever subject-matter described in the prior disclosure is capable of being performed and is such that if performed, it must result in the patent being infringed, the disclosure condition is satisfied..."

Considering Lord Hoffmann's statements, Floyd J. expressed the following view:

"It follows from the above that a generic disclosure will not normally take away the novelty of a subsequent claim to a member of the class. For example, disclosure of "fixing means" is not a disclosure of a nail."

Lundbeck, however, submitted that different considerations applied when the prior disclosure was of a broad range overlapping the range claimed in the patent. They relied in support on the EPO's decision in T 666/89. In that case the Board commented:

"...the Board's jurisprudence has generated certain general principles and broadly applicable concepts sometimes (erroneously) referred to as "tests". Thus it is clear...that matter that is hidden, not in the sense of being deliberately concealed but rather in the sense of being reconditely submerged in a document, will not have been made available in the above sense. In the case of overlapping ranges of physical parameters between a claim and a prior art disclosure, what will often help to determine what is "hidden" as opposed to what has been made available, is whether or not a skilled person would find it difficult to carry out the prior art teaching in the range of overlap (T124/87, OJ EPO 1989 495 para 3.4). A similar approach adopted by a Board of Appeal (cf. T 26/85 OJ EPO 1990, 22) for assessing the novelty of a claim in a case where overlapping numerical ranges of certain parameters exist between a claim and a prior art document, is to consider whether a person skilled in the art would, in the light of all the technical facts at his disposal, seriously contemplate applying the technical teaching of the prior art document in the range of overlap. Provided the information in the prior art document, in combination with the skilled person's common general knowledge, is sufficient to enable him to practice the technical teaching, and if it can reasonably be assumed that he would do so, then the claim in question will lack novelty.

In the Board's view, there is no fundamental difference between examining novelty in situations of so-called "overlap" or "selection", and in doing so in other situations, although it may be helpful, in order to verify a preliminary conclusion of a novelty examination in cases of overlap, to investigate whether or not a particular technical effect is associated with the narrow range in question. It needs to be stressed, however, that such a particular effect is neither a prerequisite for novelty nor can it as such confer novelty: its existence can merely serve to confirm a finding of novelty already achieved (following T 198/84 OJ EPO 1985, 209, para 7).

The above concept of "seriously contemplating" moving from a broad to a narrow (overlapping) range, while seemingly akin to one of the concepts used by the Boards for assessing inventive step, namely, whether the notional addressee "would have tried, with reasonable expectation of success" to bridge the technical gap between a particular piece of prior art and a claim whose inventiveness is in question, is fundamentally different from this "inventive-step concept" because in order to establish anticipation there cannot be a gap of the above kind.

In summary...under the EPC novelty must be decided by reference to the total information content of a cited prior document, and in assessing the content for the purpose of deciding whether or not a claim is novel, the Board may employ legal concepts that are similar to those used by them in deciding issues of obviousness, without, however, thereby confusing or blurring the distinction between these two separate statutory grounds of objection."

Floyd J. made some general observations of guidance derived from the EPO's decision: that the term "available" went beyond the strict literal meaning and included what was implicit as well; that matter might be contained in a document but so submerged in it as not to be available; and that novelty in the case of overlapping ranges was no difficult from novelty in other circumstances. However, he found it more difficult to follow the notion that it might be legitimate to find lack of novelty because the skilled person would "seriously contemplate" moving from a broad range to a narrow range:

"Merely by stating the proposition in that way one can see that it is inconsistent with the approach approved by the House of Lords in *Synthon*. There is no disclosure of the narrower range. Moreover, assuming no specific individual value is disclosed, there are no clear directions to use a value within the narrower range. A person carrying out the disclosure of the prior range will not inevitably fall within the claim of the later patent. If the "serious contemplation" approach is indeed the correct approach in the case of overlapping ranges, then overlapping ranges are a special case in the law of novelty, a proposition which is inconsistent with the third proposition derived from T 666/89 itself."

Floyd J. noted that decisions of an expert tribunal such as the Technical Board of Appeal of the EPO are entitled to respect, but that on the other hand the court was not bound to follow such a decision. Referring to the Court of Appeal's decision in *Actavis v Merck* [2008] EWCA Civ 444 Floyd J repeated Jacob LJ's observation:

"In the unlikely event that we are convinced that the commodore is steering the convoy towards the rocks we can steer our ship away."

This colourful statement was repeated by Jacob LJ in *Eli Lilly v HGS* [2010] EWCA Civ. 33.

Having made clear his disinclination to follow the EPO's approach, Floyd J turned to the facts. He commented that the Danish application was "silent" on the concentration of SO<sub>3</sub> used and that "[o]ne simply cannot convert an absence of disclosure into the disclosure of a range of concentrations". It was not "implicit" that the Danish application was referring to a range from 1 to 99% either. Floyd J. therefore concluded that it was not necessary for him to decide whether to follow the EPO's approach, nor to reach a concluded view on whether the EPO's T 666/89 decision was correct. So resolution awaits another court on another day.

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