

Breaking News: Board of Appeal finds that Acetic Acid is no Inorganic Acid.

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Okay, this result, which was recently reached by TBA 3.3.04 in decision T 394/11 (in German language), may perhaps not come as a big surprise to you, since we all learnt in school that acetic acid is a classic example of an organic acid as opposed to an inorganic acid. Yet it raises two interesting questions: Firstly, why did a Board of Appeal (have to) decide this at all? And secondly, would it theoretically be possible that acetic acid could be subsumed under the genus "inorganic acid" in a patent document? Let us take the two questions in turn. (Amended) claim 1 of the main request (MR) presented in opposition appeal proceedings relating to EP-B-0941121 read as follows:

A stable lyophilized pharmaceutical preparation of mono- or polyclonal antibodies, containing a sugar or an amino sugar, arginine, lysine, histidine or ornithine as amino acids, a polysorbate or a PEO-PPO-polymer as a surfactant and an inorganic acid or a salt thereof.

Conversely, auxiliary request II read as follows (amendments vis à vis the MR highlighted):

*A stable lyophilized pharmaceutical preparation of mono- or polyclonal antibodies, containing a sugar or an amino sugar, a **single, basic** amino acid, a surfactant and an inorganic acid, **acetic acid** or a salt thereof.*

The patent proprietor argued that the feature "an inorganic acid, acetic acid or a salt thereof" is to be understood as "an inorganic acid, namely acetic acid, or a salt thereof", since the application would define on page 9, lines 17-19 that "acetic acid" is an inorganic acid. In this passage it is stated: "[...] by addition of a suitable physiologically acceptable buffer substance such as e.g. an inorganic acid, in particular phosphoric acid, sulphuric acid, acetic acid, formic acid or a salt thereof".

Yet the Board of Appeal did not follow patentee's interpretation, arguing as follows (translation of paragraph 40 of the decision):

For the Board, however, it is beyond doubt that a skilled person would classify acetic acid as an organic rather than as an inorganic acid. On page 11, lines 25-28 of the application itself it is disclosed, in accordance with the expert's common general knowledge: "Physiologically acceptable inorganic or organic acids can be used, such as hydrochloric acid, phosphoric acid, acetic acid, citric acid [...]"

Now that we know that, let us turn to the second question: Would it at all have been possible to define acetic acid as an inorganic acid in a patent? The Board's answer is a clear "yes, but", as can be taken from paragraphs 41 and 42:

It is true that according to established case law of the Boards of Appeal a patent document may represent its own dictionary, i.e. it can be defined that a term that is known in the state of the art to define a specific subject-matter, designates a different subject-matter. However, this must be done explicitly (cf. Case Law of the Boards of Appeal, 7th Ed. 2013, II.6.3.3). Since such a case is not given here, the Board is unable to follow the interpretation of appellant I.

In the Board's view, the feature "an inorganic acid, acetic acid, or a salt thereof" is thus to be understood as an enumeration of alternatives: "an inorganic acid, or acetic acid, or a salt thereof".

Therefore, it appears that the Board might have even accepted that acetic acid is an inorganic acid, had that been unequivocally so defined in the application as filed. In full accordance with Shakespeare, by the way:

*Fair is foul, and foul is fair:
Hover through the fog and filthy air.*

(The Witches in Macbeth I.I.)

Yet one wonders how far this "dictionary" approach can be taken and whether or where there could be limits to it. For example, is it acceptable to define: "A halogen within the meaning of this patent can also be a noble gas, nitrogen or oxygen"? Or even "an organic compound can also be metallic sodium", is this possible? How about "A car within the meaning of this patent can also be an aeroplane or a submarine."? "An even number within the meaning of this invention is e.g. 3, 7.5, 200 and pi"? It is easy to see that texts can quickly get pretty absurd or unintelligible if one generously permits redefinitions and expansions of well-defined technical terms *ad libitum*. Therefore, in a sense it is perhaps fortunate that T 394/11 did not find basis for an explicit definition in the original application that acetic acid is an inorganic acid, revoked the patent for added matter and thus just about avoided the much more sensational headline:

Breaking News - Technical Board of Appeal of the EPO finds that Acetic Acid IS an Inorganic Acid.