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Further Success for HGS in the English Courts

Brian Cordery (Bristows) · Monday, September 17th, 2012

August and September are traditionally vacation months in the English Courts although the Patents Court can and often does sit in September. As a result of this, not many judgments are handed down in these months.

However on 5th September 2012, the Court of Appeal handed down an important and very interesting decision in the continuing dispute between Eli Lilly v HGS*.

In this judgment the Court of Appeal considered the issues from the first instance decision of Kitchin J that were not determined by the previous appeals which culminated in the Supreme Court decision in November 2011. These outstanding issues related to the sufficiency of certain claims and whether the amendment of one particular claim impermissibly extended its scope of protection.

It had previously been decided by the Supreme Court that all the claims in HGS' patent, a patent drafted at a very high level of generality concerning neutrokine-alpha, a new protein discovered by bioinformatics, were capable of industrial application and that certain claims were sufficiently disclosed. The Court of Appeal in this decision again acknowledged "*the very general high level nature of this invention*" and this appears to be a significant factor in their reasoning.

One of the claims at issue was claim 13 for a class of antibodies that bind to the neutrokine-alpha protein. The Court described this as being commercially a very important claim. The claim was no more specific than as described above and in particular did not require any binding antibody to be "useful". Largely on this basis, Lilly's objection of insufficiency, that it would require undue effort to find out which of the millions of antibodies would be useful, was dismissed. It assisted HGS' case that the first instance judge had decided as a matter of fact that all the antibodies falling within claim 13 could be made. Furthermore, the fact that the Supreme Court had already held the claim to be capable of industrial application – having the utility only of binding to the protein – was helpful; Lewison LJ noted that the Supreme Court's (Lord Neuberger's) view that there is a close connection ("indeed overlap") between susceptibility of industrial application and sufficiency meant that a finding on one led to a similar finding on the other.

Lilly also raised the point that amendments made to claim 13 resulted in its scope of protection being impermissibly broadened. This was rejected. It is notable that in considering the issue, Sir Robin Jacob observed that, in contrast to Germany and the Netherlands, there is still no decided law in the UK on the question of file wrapper estoppel. This is interesting as most UK practitioners would have tended to opine, if pressed, that no such doctrine existed in this country.

It was agreed that the sufficiency of claims 18 and 19, to a pharmaceutical composition and a diagnostic composition, respectively, stood or fell together. Lilly's objection of insufficiency was dismissed. Again, the high level of generality of the invention did not require that the compositions should show any particular effect. It was acknowledged that they were instead merely a way of "packaging" the active ingredient. Accordingly, the claims were also held to be sufficient.

It is not yet known if Lilly intend to petition the Supreme Court for permission to appeal to the UK's highest court.

*[2012] EWCA Civ 1185

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