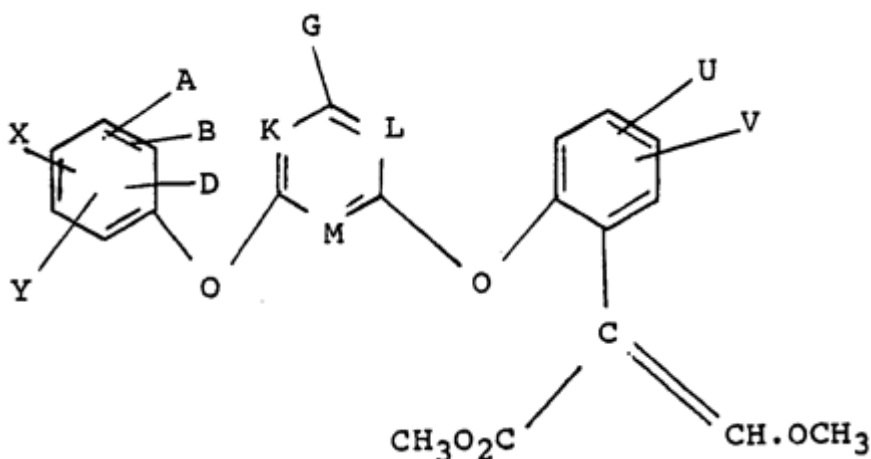


Kluwer Patent Blog

Adding is limiting

Pierre Véron (Véron & Associés) · Wednesday, April 17th, 2013

Syngenta Limited (hereinafter referred to as “Syngenta”), a company governed by the laws of England and Wales, is the holder of European patent No. 0 382 375 entitled “Fungicides”. On 28 September 2009, it submitted to the *Institut national de la propriété industrielle* (INPI; French Industrial Property Office) a request for limitation of a claim of the French designation of this patent (pursuant to Art. L. 613-24 of the French Intellectual Property Code; this voluntary limitation procedure independently of any litigation is possible in French law since 1st January 2009 and the entry into force of the [French Act No. 2008-776](#) dated 4 August 2008).



More precisely, Syngenta sought to add to the compounds of the fungicidal composition defined in claim 8 – fungicidal composition containing a fungicidally effective amount of a compound according to claim 1 (propenoic acid compound) and a fungicidally acceptable carrier or diluent therefor – another compound having a biological activity chosen in a list of defined compounds.

The General Director of the INPI and then, on appeal, the *cour d'appel de Paris* both came up against the apparent paradox which is to pretend to limit a claim by adding an new element (furthermore presented in the form of an extensive list of various possible chemicals compounds).

The General Director of the INPI deduced therefrom that the request did not constitute a limitation of the claim of the patent, but related to a different product that did not fall within the scope of the prior claims. Consequently, he dismissed the said request for limitation.

In turn, the *cour d'appel de Paris* rejected the appeal against this dismissal decision using again the analysis of the General Director of the INPI: “the consequence of the [requested] amendment was

not to specify the composition of the product as mentioned in the initial version of claim 8 by limiting it to a list of possible combinations, but resulted, on the contrary, in adding to this product a new active ingredient chosen from a long list, offering in reality a large scope of new possible combinations; (...) the proposed amendment, with the carrier or diluent according to claim 1 referred to in the initial text, adds another compound to the original compound while neither the claim whose amendment is requested nor any other claim mentions a compound containing a second active ingredient”.

The proposed amendment added and withdrew nothing; therefore, it could not be, according to the court, a limitation. It opened “*a large scope of new possible combinations*“. It added to the claimed compounds a new one which previously appeared nowhere in the claims. Clearly, the *cour d’appel* did conceive the limitation only as deletion of an element already present in the claim (or other claims) and refused this qualification to the addition of a new element in the claim. The General Director of the INPI and the *cour d’appel* only reasoned with a purely arithmetical logic: limitation could only be the subtraction and not the addition of an element in the claim.

These two authorities did not perceive the necessary distinction between claiming an additional subject-matter, which is an extension and not a limitation of the claim, and specifying the claimed subject-matter thanks to an additional element, which is not an extension but a limitation of the claim. They also disregarded the principle that limitation can be achieved as long as it finds support in the patent description and there is no obligation to refer only to claims to assess the relevance of that limitation.

A patent is the legal appropriation of the subject-matter described in the claim. The more you bring elements of identification of the subject-matter, the more this appropriated subject-matter is restricted, limited. So, in this perspective, it is certainly apparently paradoxical but quite correct to state that “*adding is limiting*“.

In the present case, the claimed subject-matter was not different chemical compounds taken individually but the composition resulting from their combination. The claimed subject-matter was a fungicidal composition obtained by combining different chemical compounds. And it is obvious that the composition containing three elements A+B+C (an amount of the compound according to claim 1 + a carrier or diluent + a compound having a biological activity chosen in a list of defined compounds) is more precise and narrow than the composition comprising only the first two elements, A + B. And it is completely irrelevant in this regard that the compound C is a compound specifically identified or any compound chosen from an even very long list of possible compounds.

A patent covering A+B enables its holder to assert it against any producer of the composition A+B+C since this composition already contains A+B. It was therefore wrong to assert, as did the *cour d’appel*, that the proposed amendment was offering “*in reality a large scope of new possible combinations*“. A patent covering the combination A+B actually covers a larger scope of possible combinations (A+B, but also A+B+C, A+B+D) than the combination A+B+C, which is more precise and confers no rights against the combination A+B or A+B+D.

And precisely the contrary is not true: the patent covering A+B+C is not effective against the producer of the composition A+B because it lacks C.

By adding this final specifying element in the definition of the claimed subject-matter, Syngenta then requested a true limitation rather than an extension of its claim. An effective limitation being

thus requested, it was still necessary to verify that this limitation by adding a new chemical compound within the composition could find support in the patent description (and not only in the claims, as the *cour d'appel* seemed to suggest).

Therefore, Syngenta has produced before the *Cour de cassation* a single annulment argument with two branches.

In the first branch, Syngenta stated that it is not necessary, for the addition of a feature in the text of a claim to constitute a limitation of the scope of the patent, that this feature be expressly claimed in the granted patent; it suffices that this feature was simply described therein.

In the second branch, Syngenta stated that a claim relating to a combination of means only enables the patent holder to assert it against the combined reproduction of all the means composing it and not against the reproduction of one of these means taken individually or a part of them; consequently, adding in a claim protecting a combination of means the mention of a means that was already described in the text of the granted patent without being expressly claimed therein results necessarily in a limitation of the scope of this claim.

If the *Chambre commerciale* of the *Cour de cassation* actually quashes on 19 March 2013 the decision of the *cour d'appel*, unfortunately, it only makes use of the first branch and declares unnecessary to rule on the other head of claim *i.e.* the second branch. The decision of the *cour d'appel* is then declared null and void in all its provisions but on a simply formal ground. The *cour d'appel* has deprived its decision of a legal basis (violating Article 69 of the European Patent Convention and Article L. 613-24 IPC) by rejecting the appeal against the decision handed down by the General Director of the INPI, which dismissed the limitation request, on the ground that the proposed amendment of claim 8 added another compound to the composition containing a compound according to claim 1 and a carrier or diluent referred to in the initial text while neither the claim whose amendment was requested nor any other claim mentioned a compound containing a second active ingredient, without ascertaining whether or not the subject-matter of the amended claim had been disclosed directly and without ambiguity in the description of the patent as granted.

One may regret that the *Cour de cassation* only rely on such a ground and did not take the opportunity to clearly underline that a limitation may also result from the addition of a new element specifying the claim's subject-matter.

[Original French decision.](#)

[English translation .](#)

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Article L. 613-24 of the French Intellectual Property Code:

“The owner of a patent may at any time surrender either the entire patent or one or more claims, or limit the scope of the patent by amending one or more claims.

The request for surrender or limitation shall be submitted to the Institut national de la propriété industrielle in accordance with the conditions laid down by regulation.

The Director of the Institut national de la propriété industrielle shall examine the request for its compliance with the regulations referred to in the foregoing paragraph.

The effect of the surrender or limitation shall be retroactive from the filing date of the patent application.

The second and third paragraphs of this Article shall apply to the limitations made under Articles L. 613-25 and L. 614-12”

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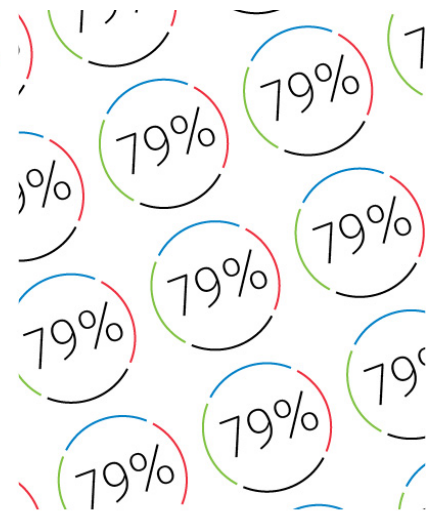
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