Kluwer Patent Blog

Barcelona Court of Appeal seeks to clarify scope of "product-by-process" claims

Miquel Montañá (Clifford Chance) · Tuesday, May 17th, 2016

In a recent judgment of 2 February 2016, the Barcelona Court of Appeal (Section 15) was called on to interpret the scope of protection of what are known as "product-by-process" claims. One of the issues discussed by the parties was whether the scope of protection of claim 1 of patent EP 731.646 B1, which claims a cereal suspension, was limited by the process set out in the claim. For the readers' benefit, the text of claim 1 is transcribed below:

"*1. A homogeneous and stable cereal suspension having the taste and aroma of natural oats, comprising intact ?-glucans from the starting material, and having a viscosity below 0.5 Pas at room temperature, obtainable by*

1. *dry- or wet-grinding rolled oats or otherwise heat- and water-treated oats to meal*
2. *suspending the oatmeal in water, if the meal has been produced by dry grinding,*
3. *optionally centrifuging or decanting the suspension in order to remove coarse fibre particles,*
4. *treating the suspension with ?-amylase, which specifically generates maltose units and has no glucanase and proteinase effect, to a viscosity of 3-0.1 Pas in the shear rate range of 10-100 s^{-1}*
5. *treating the suspension with ?-amylase which specifically generates maltose units and has no glucanase and proteinase effect, to a viscosity of <0.5 Pas in the shear rate range of 10-100s^{-1}*
6. *preferably homogenising the enzyme-treated suspension, and*
7. *subjecting the suspension to UHT treatment (UHT=Ultra high Temperature) in order to obtain a sterile product while inactivating the enzymes added*."

According to the patentee, once granted, the scope of protection of the claim would comprise any product having the characteristics mentioned in the claim, regardless of the process used to obtain it. Otherwise, the claim would have the same scope of protection as a classic "process" claim. In contrast, the defendants alleged that the process set out in the claim was part of the context necessary to determine the claim's scope of protection. More specifically, the defendants argued that, for the purpose of interpreting the meaning of the word "intact ? glucans" in the claim, it was legitimate to have recourse to the process set out in the claim, and even to the interpretation made by the patent applicant during the prosecution of the patent before the European Patent Office ("EPO").

In its judgment, the Barcelona Court of Appeal (Section 15) found that, in principle, "product-by-process" claims fall within the category of "product" claims. In particular, the Court noted that if

the EPO treats them as “product” claims from the perspective of examining validity, it is reasonable to also construe them as “product” claims when it comes to examining “infringement.” In this regard, the Court cited EPO Decisions T 20/94, T 411/89, T 423/89 and T 728/98, two precedents from the Dusseldorf patent courts and the judgment of 21 October 2004 from the House of Lords in *Kirim-Amgen*. However, according to the Court, the fact that a “product-by-process” claim falls within the category of “product” claims does not necessarily mean that the process recited in the claim cannot be taken into account, particularly in a case like this, where the meaning of one of the terms used to characterise the product (i.e. “intact”) was central to the discussion. In particular, the Court noted that the purpose of taking the process into account was not to “limit” the scope of protection of the claim, but to “interpret” its scope of protection.

Against this background, the Court rejected the concept of “intact” defended by the patentee because, according to the Court, it was incompatible with obtaining the product using the process recited in the claim. According to the Court, “intact” should be construed as not using enzymes such as ?-glucanases or other enzymes with the same effect (i.e. “cutting” the chains of ?-glucans), which, according to the Court, is what the process was about. It added that, reading the specifications, the person skilled in the art would understand “intact ?-glucans” to mean those which have not been degraded by the use of enzymes with glucanase effect, that is, enzymes whose use entails the chemical breach of the ?-glucan chains. It also added that this interpretation was consistent with the interpretation defended by the patent applicant for the purpose of overcoming novelty objections during the prosecution of the patent before the EPO.

All in all, the teaching of this judgment is that although “product-by-process” claims fall within the category of “product” claims, there might be specific circumstances – in particular, when the meaning of a specific term used in the claim is not clear – where the characteristics of the process may be used to try to dispel the meaning of that term.

This entry was posted on Tuesday, May 17th, 2016 at 5:41 pm and is filed under Scope of protection, Spain
You can follow any responses to this entry through the Comments (RSS) feed. Both comments and pings are currently closed.