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Australia's Full Federal Court takes a narrow view of omnibus claims

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On 24 June 2016, the Full Federal Court of Australia upheld an appeal from a first instance decision which gave a broad construction to an omnibus claim in the case of *GlaxoSmithKline Australia Pty Ltd v Reckitt Benckiser Healthcare (UK) Ltd* [2016] FCAFC 90.

Reckitt's claim against GSK included allegations of infringement of various claims (including an omnibus claim) of a patent for an apparatus for dispensing a liquid pain medication to children, and a method for using it. The Full Court's judgment found that an omnibus claim cannot be construed to extend the scope of the monopoly more broadly than as described in the body of the specification.

Omnibus claims in Australia

The utility of omnibus claims in Australia has been significantly reduced since the 2013 'Raising the Bar' amendments to the *Patents Act 1990*. Omnibus claims are now only permitted when they are "absolutely necessary" to define an invention. Nevertheless, omnibus claims in respect of which examination was requested prior to those legislative amendments (such as Reckitt's) continue to be allowable. Omnibus claims appear in many pre-'Raising the Bar' patents, and will continue to be litigated in the Australian Courts for many years to come.

Does taking the 'substantial idea' constitute infringement?

Claim 9 of the Reckitt patent sought a monopoly over "*a liquid dispensing apparatus, substantially as described with reference to the drawings and/or examples*" in the specification.

The lower court decision construed the words "*substantially as described*" in claim 9 quite broadly. The Judge found that the words extended to the "*substantial idea*" disclosed by the specification and shown in the drawings/examples. The product did not have to replicate the "*exact expression or illustration*" of the idea in order to infringe the patent. In the circumstances, GSK's flat-nosed syringe had exactly the same functions and "*substantial configuration*" of Reckitt's product which, consequently, was found to infringe Reckitt's omnibus claim.

The Full Court disallowed such a construction of the omnibus claim. It found that the word 'substantially' "*provides no warrant for departing from what the specification itself mandates to be the essential features of the invention*". This meant that drawings and examples given of an invention could not generate a monopoly that was wider in scope than that provided by the

essential features of the invention. The Court said that the use of the word "*substantially*" in the omnibus claim "*cannot transform a feature made essential by the description of the invention into one which is now inessential*". Put another way, the Court found that an embodiment that did not possess each of the essential features of the invention as identified in the body of the specification could not be one that is "*substantially as described*".

As the GSK product in question did not embody at least one of those essential features, it did not infringe the omnibus claim.

Fair Basis

Having adopted the omnibus claim construction identified above, the Full Court also made the (relatively obvious) observation that it is difficult to see how an omnibus claim could ever lack fair basis if it simply refers to an invention as described in the drawings and/or examples.

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