Kluwer Patent Blog

Illumina illuminated in the twilight of Birss J's Patents Court career – Part II

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As reported in last week's post, on 20 January 2021 Birss J handed down what may be his last first instance decision before his elevation to the Court of Appeal. The first post on the judgment considered the issues of identifying the skilled person, insufficiency and infringement. This second part considers the decision relating to the law of collocation – an issue which has received occasional judicial consideration for well over a century since the celebrated "Sausage Machine Case" of Williams v Nye.[1]

'415 patent – Collocation validity analysis

As described in the first part of this case summary, the majority of the judgment relates to three "modified nucleotide" patents. A fourth patent, EP (UK) 1 828 412 "Improved Method of Nucleotide Detection" was found to be obvious. This left EP (UK) 2 021 415 "Dye Compounds and the use of their Labelled Conjugates" which survived a challenge of lack of technical contribution as against prior art known as "Milton" but was then subject an unusual collocation attack based on Milton and a second prior art citation "Arnost".

Before considering the authorities on collocation, it is worth emphasising English law does not generally permit a "mosaic" challenge based on two or more pieces of prior art in relation to an allegation of anticipation or obviousness. In other words a patent cannot usually be found obvious over the amalgamation of two pieces of prior art. However, there is authority for the proposition that a patent is invalid where it does no more than combine separate inventions that were disclosed before the priority date in circumstances where there is no additional (and inventive) benefit from making this combination. At paragraph 462 Birss J quoted Lord Hoffmann's explanation of this principle (known as collocation) from *Sabaf**[2]*:

"*Two inventions do not become one invention because they are included in the same hardware. A compact motor car may contain many inventions, each operating independently of each other but all designed to contribute to the overall goal of having a compact car. That does not make the car a single invention.*"

However, Birss J also made clear that the combination of known elements to provide a novel benefit can be a valid (single) invention, but the "*new or improved result has to be the result of the relationship between the parts of the combination*"[3] (emphasis added).

The ‘415 patent was directed towards the novel dye compounds used to label nucleotides in the DNA sequencing process (thereby helping to identify those nucleotides). The Defendants contended that the patent merely co-located separate building blocks: (i) a form of dye combined with (ii) a type of nucleotide molecule and that these blocks were disclosed in the prior art documents Milton and Arnost. Further to the legal principles outlined above, Birss J disagreed. At paragraph 510 he found “*As a matter of fact the claimed thing is a single molecule. The evidence is clear that these two aspects of that molecule are capable of interacting with one another. There is a potential for interaction between these aspects which the skilled person must always take into consideration. The fact the interaction would be one which is unhelpful does not mean it is not relevant. Moreover in this, essentially empirical, field the skilled person will not know whether or not there is in fact an interaction until a test is done.*” (emphasis added)

Then at paragraph 512 the judge explained “*The skilled person would hope the molecule worked satisfactorily because the two elements did not interact but they would need that to be demonstrated by an experiment testing the combination as a whole. That means that the collocation principle does not apply.*”

This is an interesting consideration of the law of collocation as it appears the judge found there to be invention in performing the tests necessary to confirm there would be no interaction between the separate building blocks of the patent given that there was a possibility that the elements would interact in an adverse way. As the judge noted at paragraph 510, this case was distinguishable from *Sabaf* since the “*two aspects in Sabaf simply do not interact with one another. The skilled person did not have to test them to find out. A vice in MGI’s case is that it seeks to mix together considerations about things being obvious to try with the collocation principle*”. Ultimately therefore, it appears that it is the empirical nature of the chemistry involved in creating these novel molecules which prevented a successful challenge based on collocation.

The law regarding collocation makes occasional but nevertheless infrequent appearances in the case law of the English Patents Courts. Birss J’s analysis gives further guidance to practitioners outside of the context of mechanical inventions and in this respect is to be welcomed. It is not known if the parties will appeal this decision but if they do, the author suspects that the Court of Appeal will be unlikely to disagree with at least this aspect of the decision.

[1] (1890) 7 RPC 62 – this case involved a patent bringing together two machines which had previously been used separately – a mincing apparatus and a filling apparatus. As neither apparatus did more as part of a composite machine than it had as a separate component, it was held there was no invention.

[2] Sabaf v MFI [2004] UKHL 45

[3] Paragraph 465

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