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COUR DE CASSATION

Public hearing of **19 March 2013**

Quashing

Mr ESPEL, Presiding Judge

Decision No. 278 F-D

Appeal No. P 11-27.725

F R E N C H R E P U B L I C

I N T H E N A M E O F T H E F R E N C H P E O P L E

THE *COUR DE CASSATION*, COMMERCIAL, FINANCIAL AND ECONOMIC CHAMBER handed down the following decision:

Ruling on the appeal on points of law lodged by Syngenta Limited, a company governed by the laws of England and Wales, having its registered office at Syngenta European Regional, Centre Priestley Road, Surrey Research Park, Guildford Surrey GU 7YH (United Kingdom),

against the decision handed down on 7 September 2011 by the *cour d'appel de Paris* (division 5, chamber 1), in its dispute with the General Director of the *Institut national de la propriété industrielle* (French patent office), domiciled 26 bis rue de Saint-Petersbourg, 75008 Paris,

respondent in the appeal;

In support of its appeal, the appellant states the single annulment argument attached to this decision;

In light of the information communicated to the Public Prosecutor;

THE COURT, at the public hearing of 12 February 2013, attended by: Mr Espel, Presiding Judge, Ms Mandel, Reporting Judge, Mr Petit, Senior Judge, Ms Arnoux, Court Clerk;

Based on the report by Ms Mandel, Judge, the observations of SCP Hémerly et Thomas-Raquin, attorney-at-law representing Syngenta Limited, of Mr Bertrand, attorney-at-law representing the General Director of the *Institut national de la propriété industrielle*, on the opinion by Mr Mollard, Assistant Advocate General, and after having deliberated in accordance with the law;

On the single argument, taken in its first branch:

Having regard to Article 69 of the Munich Convention and Article L. 613-24 of the French Intellectual Property Code;

According to the challenged decision, Syngenta, which holds European patent No. 90300779 filed on 25 January 1990, granted on 23 March 1994 and entitled "*Fungicides*", submitted on 28 September 2009 to the *Institut national de la propriété industrielle* (INPI; French patent office) a request for limitation of the French designation of this patent; it requested that claim 8 of the patent be defined as a fungicidal composition which, in addition to containing a fungicidally effective amount of a compound according to claim 1 (propenoic acid compound) and a fungicidally acceptable carrier or diluent therefor, contains another compound having a biological activity chosen in a list of defined compounds;

To reject the appeal against the decision handed down by the General Director of the INPI, which dismissed this request, the decision of the *cour d'appel*, based on arguments it put forward and others adopted from the first instance proceedings, holds that the proposed amendment of claim 8 adds 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 is requested nor any other claim mentions a compound containing a second active ingredient;

By so ruling 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, the *cour d'appel* deprived its decision of a legal basis;

ON THESE GROUNDS and without it being necessary to rule on the other head of claim:

QUASHES AND RENDERS NULL AND VOID all the provisions of the decision handed down between the parties by the *cour d'appel de Paris* on 7 September 2011; consequently, places the case and the parties in the position in

which they found themselves before the said appeal decision and, for justice to be dispensed, refers them to the *cour d'appel de Paris* with a change in the composition of the court;

Leaves the *Trésor public* to pay the costs;

Having regard to Article 700 of the French Civil Procedure Code, dismisses the claim;

Holds that the Public Prosecutor of the *Cour de cassation* will forward this decision to the *cour d'appel* so that it might be mentioned in the margin or at the end of the quashed decision;

As drafted and decided by the *Cour de cassation*, commercial, financial and economic chamber, and pronounced by the Presiding Judge at the public hearing on the nineteenth of March two thousand and thirteen.

ARGUMENT ATTACHED TO THIS DECISION

Argument produced by SCP Hémary et Thomas-Raquin, attorney-at-law for Syngenta Limited

The *cour d'appel* is criticised for having dismissed the appeal lodged by Syngenta Limited against the decision handed down by the General Director of the INPI on 6 May 2010 having dismissed its request for a limitation of claim 8 of the French designation of European patent No. 0 382 375 B1;

On the grounds that “*Syngenta, the holder of European patent No. 90300779 filed on 25 January 1990 and granted on 23 March 1994 entitled “Fungicides”, submitted on 28 September 2009 a request for limitation of the scope of claim 8 of the French designation of this patent; according to the appealed decision, the requesting party wishes, through the requested limitation, “to add to claim 8 the indication according to which the claimed composition contains additionally a second active ingredient chosen in an extensive list of compounds having most varied natures and functions”; the General Director of the INPI deduced therefrom that this request does not constitute a limitation of the claims of the patent, but relates to a different product that does not fall within the scope of the prior claims; the text of claim 8 as worded in the patent reads as follows: “A fungicidal composition comprising a fungicidally effective amount of a compound according to claim 1 and a fungicidally acceptable carrier or diluent therefor”; this claim according to the requested amendment would be in the following terms: “A fungicidal composition comprising a fungicidally effective amount of a compound according to claim 1, the said composition containing another compound having a biological activity chosen in the group composed of: a fungicidal compound chosen in the group composed of: (RS)-1-aminopropylphosphonic acid, (RS)-4-(4-chlorophenyl)-2-phenyl-2-(1H-1,2,4-triazol-1-ylmethyl)butyronitrile, (RS)-4-chloro-N-(cyano-(ethoxy)methyl)benzamide, (Z)-N-but-2-enyloxymethyl-2-chloro-2',6'-diethylacetanilide, 1-(2-cyano-2-methoxyiminoacetyl)-3-ethyl urea, 1-[(2RS,4RS;2RS,4RS)-4-bromo-2-(2,4-dichlorophenyl)tetrahydrofurfuryl]-1H-1,2,4-triazole, 3-(2,4-dichlorophenyl)-2-(1H-1,2,4-triazol-1-yl)quinazolin-4(3H)-one, 3-chloro-4-[4-methyl-2-(1H-1,2,4-triazol-1-methyl)-1,3-dioxolan-2-yl]phenyl-4-chlorophenyl ether, 4-bromo-2-cyano-N,N-dimethyl-6-trifluoromethylbenzimidazole-1-sulphonamide, 4-chlorobenzyl N-(2,4-dichlorophenyl)-2-(1H-1,2,4-triazol-1-yl)-thioacetamidate, 5-ethyl-5,8-dihydro-8-oxo(1,3-dioxolo(4,5-g)quinoline-7-carboxylic acid, alpha-[N-(3-chloro-2,6-xylyl)-2-methoxyacetamido]-gamma-butyrolactone, anilazine, benalaxyl, benomyl, biloxazol, binapacryl, bitertanol, blasticidin S, bupirimate, buthiobate, captafol, captan, carbendazim, carboxin, chlorbenzthiazone, chloroneb, chlorothalonil,*

chlorozolinate, copper containing compounds such as copper oxychloride, copper sulphate and Bordeaux mixture, cycloheximide, cymoxanil, cyproconazole, cyprofuram, di-2-pyridyl disulphide 1,1'-dioxide, dichlofluanid, dichlone, diclobutrazol, diclomezine, dicloran, dimethamorph, dimethirimol, diniconazole, dinocap, ditalimfos, dithianon, dodemorph, dodine, edifenphos, etaconazole, ethirimol, ethyl (Z)-N-benzyl-N-([methyl(methylthioethylideneamino-oxycarbonyl)amino]thio)-beta-alaninate, etridiazole, fenapanil, fenarimol, fenfuram, fencpiclonil, fenpropidin, fenpropimorph, fentin acetate, fentin hydroxide, flutolanil, flutriafol, fluzilazole, folpet, fosetyl-aluminium, fuberidazole, furalaxyl, furconazole-cis, guazatine, hexaconazole, hydroxyisoxazole, imazalil, iprobenfos, iprodione, isoprothiolane, kasugamycin, mancozeb, maneb, mepronil, metalaxyl, methfuroxam, metsulfovax, myclobutanil, N-(4-methyl-6-prop-1-ynylpyrimidin-2-yl)aniline, neoasozin, nickel dimethyldithiocarbamate, nitrothal-isopropyl, nuarimol, ofurace, organomercury compounds, oxadixyl, oxycarboxin, pefurazoate, penconazole, pencycuron, phenazin oxide, phthalide, polyoxin D, polyram, probenazole, prochloraz, procymidone, propamocarb, propiconazole, propineb, prothiocarb, pyrazophos, pyrifenoxy, pyroquilon, pyroxyfur, pyrrolnitrin, quinomethionate, quintozone, streptomycin, sulphur, techlofthalam, tecnazene, tebuconazole, tetraconazole, thiabendazole, thiophanate-methyl, thiram, tolclofos-methyl, triacetate salt of 1,1'-iminodi(octamethylene)diguanidine, triadimefon, triadimenol, triazbutyl, tricyclazole, tridemorph, triforine, validamycin A, vinclozolin and zineb;

an insecticide chosen in the group composed of: buprofezin, carbaryl, carbofuran, carbosulfan, chlorpyrifos, cycloprothrin, demeton-s-methyl, diazinon, dimethoate, ethofenprox, fenitrothion, fenobucarb, fenthion, formothion, isoprocarb, isoxathion, monocrotophos, phenthoate, pirimicarb, propaphos and XMC;

a plant growth regulating compound chosen in the group composed of: 3,6-dichloropicolinic acid, 1-(4-chlorophenyl)-4,6-dimethyl-2-oxo-1,2-dihydropyridine-3-carboxylic acid, methyl-3,6-dichloroanisate, abscisic acid, asulam, benzoylpropethyl, carbetamide, daminozide, difenzoquat, dikegulac, ethephon, fenpentezol, fluoridamid, glyphosate, glyphosine, hydroxybenzotriles (e.g. bromoxynil), inabenfide, isopyrimol, long chain fatty alcohols and acids, maleic hydrazide, mefluidide, morphactins (e.g. chlorfluoroecol), paclobutrazol, phenoxyacetic acids (e.g. 2,4-D or MCPA), substituted benzoic acid (e.g. triiodobenzoic acid), substituted quaternary ammonium and phosphonium compounds (e.g. chloromequat, chlorphonium or mepiquatchloride), tecnazene, the auxins (e.g. indoleacetic acid, indolebutyric acid, naphthylacetic acid or naphthoxyacetic acid), the cytokinins (e.g. benzimidazole, benzyladenine, benzylaminopurine, diphenylurea or kinetin), the gibberellins (e.g. GA₃, GA₄ or GA₇) and triapenthenol;

and a fungicidally acceptable carrier or diluent therefor”;

Syngenta argues in support of its appeal that the fungicidal composition mentioned in the initial wording of independent claim 8 is not limited to a mere combination of the active ingredient of formula (I) with a carrier or a diluent and does not exclude other ingredients, but can, on the contrary, include a second active ingredient in the composition so that the indication of the restrictive list of the other active ingredients, among which the one that will be combined with the first one can be chosen, a list that is to be added to the text of claim 8 by the requested amendment, constitutes a limitation thereof pursuant to Article L. 613-24 of the French Intellectual Property Code insofar as it reduces the scope of the possible infringements; however, by a correct analysis of the scope of the requested amendment, the General Director of the INPI rightly pointed out that the consequence of the 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; he relevantly observes that 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; it results from the above that the appealed decision is justified and the appeal will consequently be dismissed”;

First, the claims are interpreted in light of the description and the drawings; 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 order to judge that the requested amendment of claim 8 of the French designation of European patent No. 0 382 375 B1 did not constitute a limitation of the scope of the patent, the *cour d'appel* limited itself to pointing out that the addition of a second active ingredient was not mentioned in any of the claims of the granted patent; it did not explain, as it was invited to, the fact that the description indicated that “*the compositions of this invention may contain other compounds having biological activity*” and already mentioned the list of these compounds that may be included in the claimed fungicidal composition; this list is precisely reiterated in the new wording of claim 8 proposed by Syngenta Limited in its limitation request; consequently, the *cour d'appel* deprived its decision of a legal basis having regard to Article 69 of the Munich Convention and Article L. 613-24 of the French Intellectual Property Code.

Second, 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; by deciding, in the present case, that the addition by Syngenta to claim 8, which relates to a fungicidal composition containing “*a compound according to claim 1*” and a carrier or diluent, of the mention of a “*new active ingredient chosen in a long list*” would lead to an extension and not a limitation of the scope of this claim by “*offering a broad scope of new possible combinations*”, the *cour d’appel* violated Article 69 of the Munich Convention of 5 October 1973 on the Grant of European Patents and Article L. 613-24 of the French Intellectual Property Code.