

THE HIGH COURT

COMMERCIAL

2008 10436 P

BETWEEN

MEDINOL LIMITED

PLAINTIFF

AND

ABBOTT IRELAND AND ABBOTT VASCULAR INTERNATIONAL BVBA AND

ABBOTT CARDIO VASCULAR SYSTEMS INC.

AND

ABBOTT VASCULAR DEVICES HOLLAND B.V.

AND

ABBOTT LABORATORIES INCORPORATED

DEFENDANTS

JUDGMENT of Mr. Justice Brian J. McGovern delivered on the 27th day of May, 2011

1. On 10th March, 2011, I delivered judgment on the issue of infringement in this case. The parties had agreed to leave over the question of whether or not there was "added matter" in the Patent in suit. In this judgment, I consider that issue.

2. The defendants maintain that there is added matter because the Application did not disclose stents with in-phase first meander patterns, whereas the Patent in suit does. The test for added matter has been set out in a number of UK authorities. In *Bonzel v. Intervention Ltd.* (No. 3) [1991] R.P.C. 553 at 574, Aldous J. said:

"The decision as to whether there was an extension of disclosure must be made on a comparison of the two documents read through the eyes of a skilled addressee. The task of the court is threefold:

(1) To ascertain, through the eyes of the skilled addressee, what is disclosed, both explicitly and implicitly in the application.

(2) To do the same in respect of the patent [as proposed to be amended].

(3) To compare the two disclosures and decide whether any subject matter relevant to the invention has been added, whether by deletion or addition. The comparison is strict in the sense that subject matter will be added unless such matter is clearly and unambiguously disclosed in the application either explicitly or implicitly."

3. In *Vector Corp. v. Glatt Air Techniques Ltd.* [2007] E.W.C.A. Civ. 805, [2008] R.P.C. 10, Jacob L.J. stated:

"4. In *Richardson-Vicks' Patent* [1995] R.P.C. 568 at 561, I summarised the rule in a single sentence: 'I think the test of added matter is whether a skilled man would, upon looking at the amended specification, learn anything about the invention which he could not learn from the un-amended specification'."

4. It is important to also consider the approach of the European Patent Office (EPO). Ireland is a signatory to the European Patent Convention and the EPO has a Board of Appeal, which interprets points of law relating to the Convention, and seeks to ensure uniform application of the law.

5. The underlying reason for the rule on "added matter" was explained by the enlarged Board of Appeal of the EPO in G1/93 Advanced Semiconductor Products/Limiting feature [1995] E.P.O.R. 97 at [Reasons 9]:

"With regard to Article 123(2) EPC, the underlying idea is clearly that an applicant shall not be allowed to improve his position by adding subject-matter not disclosed in the application as filed, which would give him an unwarranted advantage and could be damaging to the legal security of third parties relying upon the content of the original application."

6. Article 123 of the Convention provides, *inter alia*, that a patent may not be amended in such a way that it contains subject-matter which extends beyond the content of the application as filed. A European patent may not be amended in such a way as to extend the protection it confers. In his decision given on 26th June, 2009, Charleton J., in *In Re Glaxo Group's Patent* [2009] I.E.H.C. 277, approved the observations of Kitchin J. in *European Central Bank v. Document Security Systems* [2007] E.W.H.C. 600 (PAT) (26th March, 2007), where the learned judge set out the steps to be taken by a court in looking at added matter and determining whether an amendment should be made. I also agree with the approach adopted by Kitchin J. in that case.

7. It is important that the courts apply the rule of comity to decisions of other courts which have applied the European Patent Convention, and also to decisions of the Board of Appeal of the EPO, in order to ensure that there is consistency and uniformity in the

construction of patents throughout the territories covered by the Convention. In *Dr. Reddy's v. Eli Lilly* [2010] R.P.C. 9 at paragraph 92, Neuberger L.J., in the English Court of Appeal said:

"It is plainly desirable that there is, so far as possible, a consistency of approach when it comes to matters of principle between the domestic courts of the signatory states to the EPC, both among themselves and with the European Patent Office ("the EPO"). This proposition is supported by a number of recent decisions of and dicta in the House of Lords and this court."

The Application

8. The application for the Patent states that an object of the invention is to provide a flexible stent which minimally shrinks, in the longitudinal direction, during expansion. The summary also contains the following:

"In accordance with one embodiment of the present invention, the first meander patterns are formed into even and odd first meander patterns. The even and odd first meander patterns are 180° out-of-phase with each other and the odd patterns occur between every two even patterns. The second meander patterns can also be formed of even and odd patterns."

(Underlining added)

In the Patent in suit, the summary of the invention states, at paragraph [0009]:

"In accordance with one embodiment of the present invention, the first meander patterns are formed into even and odd first meander patterns. The even and odd first meander patterns can be 180° out-of-phase with each other and the odd patterns can occur between every two even patterns. The second meander patterns can also be formed of even and odd patterns."

(Underlining added)

The Arguments

9. The defendants argue that the application for the Patent indicated that the invention necessarily involved an out-of-phase arrangement of first meander patterns. The claims of the application claimed only out-of-phase arrangement and it is argued the invention was described solely in terms of out-of-phase arrangement. The defendants argue that the application made clear that this was an essential feature. In the Patent, however, the claims were redrafted to remove the reference to out-of-phase arrangement so that Claim 1 of the Patent also covers an in-phase arrangement such as can be found in the Abbott stents. The description was also altered to change the wording of Paragraph [0009] to, ". . . first meander patterns can be 180° out-of-phase with each other . . .". The defendants argue that this is a clear case of added matter.

10. The plaintiff argues that the defendants are wrong in claiming that the teaching of the application was limited to odd/even/odd out-of-phase first meander patterns. They maintain that the defendants' fundamental objection is that the Patent only discloses stents with out-of-phase meander patterns, whereas the claims cover in-phase patterns. The plaintiff claims that the defendants are incorrect in asserting that the teaching of the application is limited as it says, and places reliance on the words, "in accordance with one embodiment of the present invention . . ." at line 23 of the summary of the invention contained in the application. It also places reliance on the following words to be found at lines 31-34 on page 7 of the application:

"It will be appreciated that the present invention encompasses all stents manufactured with a pattern formed of two meander patterns, orthogonal or otherwise."

11. The plaintiff accepts that there are odd and even first meander patterns in the stents illustrated in the figures in the abstract contained in the application and described in the section '*Detailed Description of Preferred Embodiments*' which are 180° out-of-phase, but emphasises that these stents are merely preferred embodiments. In its submissions, the plaintiff says, "Merely because a patentee chooses to illustrate his invention by reference to a particular embodiment of his invention does not mean that he is limited to claiming only that embodiment".

Conclusion

12. I have compared the application with the Patent in suit and sought to read both documents through the eyes of a skilled addressee, as required by the legal authorities which have been opened to me and which I accept. In considering the matter, I have tried to avoid hindsight and have looked at the disclosure in the application through the eyes of a skilled person who has not seen the amended specification in the Patent and, consequently, does not know what he is looking for. After considering that, I then looked at the two documents.

13. The approach of the EPO Board of Appeal on the issue of the removal of a feature was set out by Arnold J. in his judgment in the Courts of England and Wales in the dispute between these parties. He referred to the case law of the Boards of Appeal of the European Patent Office (6th Ed. 2010 at pp. 346-355) and, in particular, the test stated in T331/87 *Houdaille/Removal of Feature* [1991] E.P.O.R. 194, which, he says, was regularly applied subsequently when considering an amendment which concerns the deletion or replacement of a feature from a claim. He said, at para. 254 of his judgment:

"... deletion or replacement is permitted if, but only if, the skilled person would directly and unambiguously recognise that:

(i) the feature was not explained as essential in the disclosure;

(ii) it was not, as such, indispensable for the function of the invention in the light of the technical problem it served to solve, and

(iii) the deletion or replacement required no real modification or other features to compensate for this change."

I approach the issue of added matter in this case on that basis. The Defendants argue that the EPO approach inescapably leads to the conclusion that removing the out-of-phase restriction is added matter, and that any claim that covers in-phase arrangements is an extension of the subject matter of the application.

14. I accept that submission. It seems to me that this change introduced, for the first time, a teaching that the feature of even and odd first meander patterns being 180° out-of-phase with each other was not an essential feature.

15. I therefore conclude that these changes in the Patent in suit do amount to added matter as they broaden the claims for the Patent.

16. One further matter needs to be decided. The defendants claim that the addition of the words "unitary tube" into Claim 1 of the Patent was not present in the application and they raise a further "added matter" objection arising out of the addition of the word "unitary". This point was not argued with any vigour in the course of the hearing. The evidence of Professor McHugh on this point was rather inconclusive and he accepted that unitary, in the context of the Patent, meant one piece. It appears to me that there is no substance to the defendants' claim that the use of the word "unitary" amounts to added matter.

17. I therefore reject the defendants' argument on that point.