

**IN THE MATTER OF AN APPLICATION FOR REVOCATION UNDER SECTION 80 OF THE
PATENTS ACT (CAP. 221)**

BETWEEN

**CARGILL INTERNATIONAL TRADING PTE LTD
(Applicant for Revocation of the Patent P-No. 42669, the “Applicant”)**

And

**MARTEK BIOSCIENCES CORPORATION
(Proprietors of the Patent, the “Patentee”)**

*Before Deputy Registrar of Patents Danielle Yeow
and Principal Assistant Registrar Isabel Chng
9 – 12 February 2009*

Patents – Application for revocation – whether patent is patentable - novelty and inventive step – Section 14(1), 14(2), 15, 80(1)(a) of the Patents Act (Cap 221, 2005 Rev Ed)

Patents –foreign corresponding decisions – extent of reliance

Patents – role of expert witnesses – explaining words or terms of science or art appearing in documents – matters within exclusive domain of court on questions of fact or law or interpretation of a document

Patents - independence of expert witnesses – current or former employees of Patentee – not precluded from giving evidence - evidence to be scrutinized with greater care - consideration limited to technical and scientific aspects of invention

Patents - construction of claims – “for [a particular use]” – not limited to that use - dimensional limitation to claim

Patents – novelty – guiding principles – prior art must unequivocally point to the invention - enabling disclosure

Patents – inventive step – permitted to combine documents or “mosaic” prior art - test to be applied in inventive step assessment

Procedure— Submission of evidence after close of proceedings – Submission of evidence without leave or statutory declaration

Words and Phrases – “novelty” –“inventive step” – Patentability – Section 14(1), 14(2), 15, 80(1)(a) of the Patents Act (Cap 221, 2005 Rev Ed)

Facts

The Applicant applied to revoke Patent P-No. 42669 entitled “Arachidonic Acid and Methods for the production and use thereof”, with the filing date of 3 Jan 1995. The Applicant alleged the patent claims are not patentable and that the patent specification does not disclose the invention clearly and completely for it to be performed by a person skilled in the art, pursuant to sections 80(1)(a) and 80(1)(c) of the Patents Act respectively. The latter ground was subsequently not pursued by the Applicant before the Hearing Officers.

The patent states that the present invention relates to processes for the production of arachidonic acid containing oils, which preferably are free of eicosapentanoic acid. This invention also relates to compositions containing oils of very high amounts of arachidonic acid in triglyceride form, and to uses of such oils. In a preferred embodiment, *Mortierella alpina* is cultivated using conditions which yield triglyceride oil having particularly high levels of arachidonic acid residues, biomass is harvested and the oil is extracted, recovered, and used as an additive for infant formula.

The Applicant contends that the Patent is not patentable and some of the claims lacked novelty and all the claims lacked inventive step.

To support their case, the Applicant relied on corresponding foreign decisions from the US and European Patent Offices (USPTO and EPO) where similar patents belonging to the Patentee were being challenged. However, the Patentee pointed out that the foreign decisions have not been finalised and that the facts surrounding these decisions are different from those before the case in Singapore.

During the Hearing, expert witnesses were called upon by both parties to testify. The testimonies of the witnesses Pua and Nga were for the Applicant, while those from the witnesses Barclay and Kyle were for the Patentee.

On quite a few occasions when Pua took the stand, he himself would admit that he is not a lipid, yeast or fungi expert when probed to clarify or explain his responses. As for Nga, he admitted during cross-examination that his evidence and conclusion were made with the benefit of hindsight after reading the Patent. As for Barclay and Kyle, they were in one way or another associated with the Patentee. Barclay was one of the founders and is a current employee of the Patentee while Kyle is the sole inventor to this Patent and a former employee of the Patentee.

An issue was also raised over the interpretation of Claim 1. *Claim 1 reads "A composition for enteral or parenteral administration to a human comprising ..."*. The patentee argued that the use of the terminology "for" requires that a composition be "suitable for" the stated purpose. However, the applicant was of the view that a claim to a material or composition for a particular purpose is regarded as a claim to the material or composition per se. They contend that the word "for" in the preamble of the claim is not limited to enteral or parenteral administration, but merely that the composition be "suitable for" enteral or parenteral administration.

After the proceedings were closed, the Applicant submitted a fresh document and, in reliance on that document, made an assertion in relation to the Patentee's commercial success. At no time did the Applicant seek any leave to tender additional evidence after the proceedings had already closed. Further, the document was not accompanied by any statutory declaration. The patentee objected to this but nonetheless proceeded to rebut the applicant's assertions.

Held, allowing the Applicant's request to revoke the Patent

1. The Applicant succeeded in its application to revoke the Patent under sections 80(1)(a) of the Patents Act. Notwithstanding some findings of novelty in some of the claims, the Hearing Officers found that the main claims 1, 2, 20 and 35 lacked inventive step. Further, all the dependent claims failed as such and the invention in the subject Patent was found not patentable. The features in the dependent claims were also considered separately and the Hearing Officers arrived at the conclusion that they are obvious and not inventive: at [215, 216].
2. On the foreign corresponding USPTO and EPO decisions, much caution was exercised in relying on them in this case: *First Currency Choice Pte Ltd v Main-Line Corporate Holdings Ltd* and *Another Appeal* [2007] SGCA 50 at [2]. An adjudication on patent rights is predicated upon not only the applicable regulatory framework and practices, but also the evidence presented as well as the submissions made to the tribunal concerned. Furthermore, the matter has not yet been finally concluded in those jurisdictions: at [10] – [12].
3. It is for the Hearing Officers to read the language of the agreement or document, to analyse the facts and apply the law to the facts. While an expert can provide expert assistance, inter alia, by explaining words or terms of science or art appearing in documents which have to be construed, his role stops there: *Abdul Razak Valibhoy v Keppel Investment Management Ltd* [2002] SGHC 236; *Main-Line Corporate Holdings Ltd v United Overseas Bank Ltd* and *Another* [2007] 1 SLR 1021; 2006 SGHC 233 *Armchair Passenger Transport Limited v Helical Bar PLC et al.* [2003] EWHC 367 (QB). The expert cannot transgress into matters which are within the exclusive domain of the court on questions of fact or law such as the question whether the claimed patent meets the criteria of patentability; or the interpretation of a document: at [27] – [31].
4. Officers were unable to draw much assistance from Pua's evidence. As for the Applicant's other expert witness, Nga, the Hearing Officers treaded with caution in relying on his evidence, as he himself had admitted during the cross-examination that his evidence and conclusion were made with the benefit of hindsight after reading the Patent in question: at [37], [43].
5. As for the Patentee's expert witness, Barclay, by virtue of his relation with the Patentee, he is considered an expert with an interest in the proceedings. However that does not itself preclude Barclay from giving evidence though it meant that his evidence had to be scrutinized with greater care. The expert can, inter alia, explain words or terms of science or art appearing in the documents which have to be construed by

the Court, to give expert assistance to the court. However, his role stops there. Accordingly, Hearing Officers limited their consideration of Barclay's testimony to the technical and scientific aspects of the invention as such. As for the Patentee's other expert witness, Kyle, his clear explanations on the technical and scientific aspects of the technical field surrounding this invention were acknowledged. These are factual statements. While it is true that there is no basis or support for the Applicant to allege that Kyle has an existing close relationship with the Patentee, the Hearing Officers limited their consideration of Kyle's testimony to the technical and scientific aspects as such: at [48], [54].

6. Although a claim stating that a product is "for a particular use" does not limit the article to that use, the stated purpose may import a dimensional limitation to the claim, thereby saving it from being anticipated by a prior disclosure of a similar article designed for a different purpose. In the present case, the terminology "for" in claim 1 requires that a composition be "suitable for" the stated purpose where the stated purpose imports a dimensional limitation to the claim: at [64] – [69].
7. In deciding the issue of novelty, the guiding principles are as set out in *Trek Technology (Singapore) Pte Ltd v FE Global Electronics Pte Ltd (No. 2)* [2005] 3 SLR 389. To destroy novelty, the prior art must unequivocally point to the invention and must not merely be a signpost on the path to discovering the invention. The disclosure must be "enabling" ie sufficient so as to enable the skilled addressee to put the invention into practice. For a prior publication to anticipate the patent, it must be established that following the teachings in the prior publication would inevitably lead to the invention covered by the patent. The prior disclosure must not only identify the subject matter of the claim in the later patent, it must do so in a way that enables the skilled man to make or obtain it : at [71] – [73].
8. It is permissible to combine documents or "mosaicing" to determine whether inventive step is lacking. However it must be likely that the skilled person would have considered those teachings together : at [76]. The test to be applied to assist in the inventive step assessment is the Windsurfing test: *First Currency Choice Pte Ltd v Main-Line Corporate Holdings Ltd* [2008] 1 SLR 335; *Muhlbauer AG v Manufacturing Integration Technology Ltd* [2009] SGHC 45. Step (1) in Windsurfing ie identification of the inventive concept embodied in the patent, also refers to identification of the inventive concept of the claim in question : at [77] – [82].
9. On the issue of costs, the Hearing Officers found the late submission of the letter by the Applicant to be irregular. At no time did the Applicant seek any leave to tender additional evidence after the proceedings had already closed. Neither was the document attached to the letter accompanied by any statutory declaration. The Hearing Officers thus ordered the Patentee to pay the Applicant's costs of this proceeding to be taxed or agreed, save for the costs arising out of and in relation to the Applicant's letter of 17 Mar 2009: at [216] – [219].

Provisions of Legislation discussed:

- Patents Act (Cap 221, 2005 Rev Ed), ss 14(1), 14(2), 15, 80(1)(a)
- UK Manual of Patent Practice (Version dated Apr 2009) Chartered Institute of Patent Attorney, C.I.P.A. Guide to the Patents Act (Sweet & Maxwell, 6th Ed, 2009)
- European Guidelines for Examination
- Singapore Civil Procedure 2007

Cases referred to:

- *Adhesive Dry Mounting Co Ltd v Trapp and Co.*, 27 RPC 341
- *Abdul Razak Valibhoy v Keppel Investment Management Ltd* [2002] SGHC 236
- *Angiotech Pharmaceuticals v Conor Medsystems Inc* [2007] EWCA Civ 5
- *Armchair Passenger Transport Limited v Helical Bar PLC et anor.* [2003] EWHC 367 (QB)
- *Dyson Appliances Ltd v Hoover Ltd* [2001] RPC 26
- *FE Global Electronics Pte Ltd and others v Trek Technology (Singapore) Pte Ltd and another appeal* [2005] SGCA 55
- *First Currency Choice Pte Ltd v Main-Line Corporate Holdings Ltd and another Appeal* [2007] SCGA 50
- *First Currency Choice Pte Ltd v Main-Line Corporate Holdings Ltd* [2008] 1 SLR 335
- *G.E.C's Application*, 60 RPC
- *Genelabs Diagnostics Pte Ltd v Institut Pasteur* [2001] 1 SLR 121
- *General Tire and Rubber Co v Firestone Tyre and Rubber Co* [1972] RPC 457
- *Generics (UK) Limited and others (Appellants) v H Lundbeck A/S (Respondents)* [2009] UKHL 12
- *Herschel Smith Lecture* [1996] E.I.P.R. 480
- *Hickman v Andrews* [1983] R.P.C. 147
- *Howley v Dronsfield* BL CC/40/95

- Kirin-Amgen Inc v Hoechst Marion Roussel Ltd [2005] R.P.C. 9
- L'Air Liquide Societe's Application 49 RPC 428
- Lux Traffic Controls Limited v Pike Signals Limited [1993] RPC 107
- Main-Line Corporate Holdings Ltd v United Overseas Bank Ltd and Another [2007] 1 SLR 1021; 2006 SGHC 233
- McGhan Medical UK Limited v Nagor Limited Case No CH 1999 1720
- Merck & Co Inc v Pharmaforte Singapore Pte Ltd [2000] 3 SLR 717
- Merrell Dow v Norton [1994] R.P.C. 1; [1995] R.P.C. 233 CA and [1996] R.P.C. 77 HL
- MOBIL II/Friction reducing additive T 59/87 OJ EPO 1988, 347; [1989] E.P.O.R. 80,
- MOBIL III/Friction reducing additive G 2/88
- Muhlbauer AG v Manufacturing Integration Technology Ltd [2009] SGHC 45
- Ng Kok Cheng v Chua Say Tiong [2001] 3 SLR 487
- Pfizer Ltd's Patent [2001] FSR 16
- PLG Research Ltd v Ardon International Ltd [1995] RPC 287
- Pozzoli SPA v BDMO SA et anor. [2007] EWCA Civ 588
- SmithKline Beecham Plc's (Paroxetine Methanesulfonate) Patent [2006] R.P.C. 10
- South Africa G.I. Marketing v Fraser-Johnston [South Africa] [1996] E.I.P.R.D-75
- Technograph Printed Circuits Limited v Mills & Rockley (Electronic) Limited [1972] RPC 346
- Trek Technology (Singapore) Pte Ltd v FE Global Electronics Pte Ltd (No. 2) [2005] 3 SLR 389
- Vickers, Sons And Co. Limited v Siddell (1890) 7 RPC 292
- Wheatley v Drillsafe Ltd [2001] RPC 7
- Windsurfing International Inc v Tabur Marine (Great Britain) Ltd [1985] RPC 59

Representation:

- Mr. Kristian Robinson, Mr. Soh Kah Liang, Dr Soo Ee Lin (Ella Cheong Spruson and Ferguson (Singapore) Pte Ltd) for the Applicant
- Dr Stanley Lai, Mr Vignesh Vaerhn, Ms Eunice Lim (Allen & Gledhill LLP) for the Patentee