Freehills
Patent Attorneys

INHERENT DISCLOSURE AND NOVELTY IN PATENT RE-EXAMINATION: ALZA CORPORATION [2012] APO 70

Date: 2012-07-12
Author: Tom Gumley

Like most patent offices, the Australian Patent Office is not well placed to reject patent claims in examination proceedings for lack of novelty based on inherent disclosure. Of concern are those claims that contain functional limitations that are not clearly read from a prior art document, and that require laboratory testing of the prior art to establish whether the relevant limitation is disclosed. So what opportunity is there to have a patent revoked based on inherent disclosure in post grant re-examination proceedings where the only information that can be considered is a prior art document? According to this decision: a significant opportunity!

The decision

The claim under consideration defined a device containing the following features:

(i) a backing layer
(ii) a drug reservoir layer containing nicotine
(iii) an adhesive layer
(iv) an opacity index of less than 48.6%
(v) the natural skin colour of the patient is visible through the device; and
(vi) the nicotine is not substantially degraded by exposure to light.

It was understood that features (i) to (iii) of the claimed device were expressly disclosed in the relevant prior art document. At issue was whether the document inherently disclosed a device that also had the functional limitations defined by features (iv) to (vi).

Inherent disclosure test

According to the Delegate, to establish lack of novelty based on an inherent disclosure it is necessary to show "that the devices of the citation would posses the properties specified in the claim, and that it would have been apparent, to a practical standard, that they would possess those properties". Further, a matter could be disclosed to a practical standard without being explicitly stated: "if it would have been apparent to a skilled worker, without difficulty, had they turned their mind to the issue".

Application of expert evidence

The Delegate, perhaps recognising that it would not be possible to know whether something had been "disclosed to a practical standard" without the knowledge of the skilled worker, found it appropriate to consider a declaration of an expert witness to understand whether the claimed device was inherently disclosed.

On this point, the Delegate rejected the patentee's argument that he should not be entitled to consider the declaration. That argument was based on a previous legal authority which had established that the Patent Office "should consider issues of validity by reference to primary material and not additional material which might indicate the view others took in broadly

analogous circumstances". In this instance, the Delegate considered that the declaration was evidence, and something more than opinion arising from what another Patent Office did in similar circumstances.

The outcome was that, in light of the declaration, the prior art document was said to inherently disclose features (iv) to (vi) of certain claims, and having considered that the patentee had been given opportunity to rectify the issue by amendment prior to the hearing, the relevant claims were revoked.

Key message

We think this decision shows a willingness, and perhaps an intention of the Patent Office to scrutinise patent claims much more closely during post grant re-examination proceedings than can be done during ordinary, pre-grant examination. Given this decision, it will be critical for both the party seeking revocation, and the patentee to adduce this evidence where there is some doubt as to whether the relevant prior art expressly discloses all features of the claims. Further, there seems to be no reason why the same should not apply where the ground is lack of inventive step.

Please see this link for a copy of the decision:
http://www.austlii.edu.au/au/cases/cth/APO/2012/70.html

CONTACT

Tom Gumley

BSc(Hons), PhD(Medicine)

+61 3 9288 1479
Contact | **View profile**
Follow me on LinkedIn