Freehills

Australian patent invalidity – lack of fair basis not cured by consistory clause

30 August 2011

In brief

- The Australian Patent Office (Office) rejects key claims in an allowed Australian patent application on non prior art grounds.
- The use of consistory clauses in the patent specification by the patent applicant was not sufficient to avoid this outcome.

This decision[1] should be of interest to Australian patent applicants and opponents alike. Specifically, it outlines IP Australia's view that consistory clauses and like statements in a patent specification are not a panacea for all fair basis issues. It also makes it quite clear that the Office will continue to reject patent claims on non prior art validity grounds.

The decision

The patent application in question contained claims directed to compounds and their uses in treatment of various conditions, including inhibition of unwanted hair growth and treatment of cancer.

At issue was whether the claims directed to the treatment of cancer and unwanted hair growth lacked fair basis, insofar as the description only contained a real and reasonably clear disclosure of the treatment of growth states resulting from activation of the hedgehog signalling pathway, such as hedgehog gain-of-function phenotype.

According to the opponent, the claims to the use of the compounds for any hair or cancer treatment travelled beyond the patent description which described treatment of conditions arising from the relevant pathway.

The patent applicant's position was that the 'consistory clauses' (statements in the patent description that mirror the claims) that it had inserted in the specification inter alia meant that the claims must be valid.

According to the Australian hearing officer, the correct position is that:

> … a claim based on what has been cast in the form of a consistory clause is not fairly based if the other parts of the matter in the specification show that the invention is narrower than that consistory clause.

Having found from his review of the patent specification as originally filed and amended during Australian prosecution, and also the priority documents, that there was no disclosure of non-hedgehog pathway-related treatments, nor any suggestion that the invention extended to treatments of conditions arising from non-hedgehog pathways, the hearing officer concluded that the requirements for fair basis had not been satisfied.

Implications

It is not expected that this decision will change the general practice of incorporating consistory clauses or statements into an Australian patent specification, especially where patent claims are amended during prosecution. However, it should raise awareness that this practice alone may not be sufficient to rescue a claim that is otherwise invalid for lack of fair basis.

What should be required from patent applicants prior to opposition or litigation proceedings is to carefully consider whether the whole of the specification (not just the consistory clauses) provides a real and reasonably clear disclosure for what is then claimed in the patent claims. Likewise, prospective opponents would be well advised to consider whether in spite of consistory clauses, the patent description provides the requisite disclosure for the claims.

This is article was written by Adam Denley, Patent Attorney and Tom Gumley, Partner, Freehills Patent & Trade Mark Attorneys.

Endnotes

1. *Cytokinetic, Incorporated v Curis, Inc.* [2011] APO 66

More information

For information regarding possible implications for your business, contact

Tom Gumley
Partner, Sydney
Direct +61 2 9225 5465
tom.gumley@freehills.com