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PATENTS

Infringement

LT Biotechnology; Claim construction; European patents; France; HIV testing; Infringement

Institut Pasteur v Chiron Blood Testing, Chiron Healthcare Ireland Ltd
Cour d'Appel of Paris
Case No.07/08437
March 4, 2009

On March 4, 2009, the Cour d'Appel of Paris affirmed the decision issued by the Tribunal de Grande Instance of Paris on February 7, 2007 which dismissed the action for patent infringement initiated by the French research organisation Institut Pasteur against the French and Irish subsidiaries of the US company Chiron (now known as Novartis Vaccines and Diagnostics).

Facts: Institut Pasteur alleged that certain kits for the in vitro detection of HIV in blood samples, marketed by Chiron in France, fell within the scope of its European patent No.178 978 relating to "cloned DNA sequences, hybridizable with genomic RNA of the LAV" (HIV). Institut Pasteur requested €8.000.000 as an interim payment on account of damages.

Institut Pasteur relied on two claims of its patent:

- claim 8 regarding a method for the in vitro detection of viral infection due to HIV;
- claim 11 regarding purified RNA of HIV.

Held: The Cour d'Appel stated that the extent of protection conferred by a patent shall be determined by the terms of the claims and that this rule applies even in relation to a pioneer patent; the Cour d'Appel implicitly refers to a previous decision in which it held that the claims of a pioneer patent may be drafted in general terms despite a limited description but it adds that, if the claims are drafted narrowly, the patent, even a pioneer one, has a limited scope.

It indicated further that patent claims, which have been amended during prosecution or opposition proceedings before the European Patent Office, cannot, under the pretext of interpretation, be given the scope of claims, which the patentee renounced, as this would prejudice legal certainty for third parties.

The Cour d'appel thus held that:

- claim 8 could not cover a general method for detecting HIV, but only a specific method characterised by the use of the probes of claim 7 consisting of the specific cloned DNA sequences of claims 1 to 6, characterised by their restriction sites, their position on the genome and their correspondence to the DNA contained in the deposited clone;
- claim 11 could not cover any purified RNA of HIV, but only a specific purified RNA corresponding to the fragment of the complementary DNA contained in the deposited clone.

The Cour d'Appel dismissed the claims for infringement of claim 8 covering a detection method, on the ground that Institut Pasteur had not proved that the kit in question would use the specific claimed probes nor the other characteristics of claim 8 and mentioned that it cannot rely on the doctrine of equivalents because claim 8 does not cover a new general means for the detection of the HIV, but only a specific method.

The Cour d'Appel then dismissed the claims for contributory infringement of claim 11 covering purified DNA.

To dismiss the claims for infringement of claim 11, the Cour d'appel considered whether the specific conditions for contributory infringement are met and on that occasion stated that:

- the means supplied must be related to an essential element of the invention, which implies that it must contribute to the result of the invention; the Cour d'appel seemed to follow the argument of the defendant that the means supplied did not even relate to an element of the claim since it did not correspond to an integer of the claim;
- the means supplied must be suited for putting the invention into effect; the Cour d'Appel clearly noted that the use of the detection kits in question was not suited to obtaining the RNA subject matter of claim 11 because the isolated RNA differed from the specific fragment of claim 11.

Comment: This decision is the first decision ever issued by a French Court of Appeal regarding infringement of a molecular biology patent.

The parties' arguments mainly concentrated on claim construction and the scope of the patent claims. The validity of the patent was not challenged as such but only as

a secondary argument (namely, should the patent be given a broad scope, it would be invalid).

The *Cour d'Appel* issued a detailed decision and relied on ordinary rules of claim construction, based on the wording of the claims and on the patent description. But the *Cour d'appel* also explicitly refers to the changes made by the patent owner in the prosecution and opposition proceedings before the European Patent Office, in relation to claim construction, not so much to recognise a prosecution estoppel, but on the basis of requirement for legal certainty for third parties and the general obligation of fairness in court proceedings.

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