

Smells like inherent novelty: Novartis AG v Bayer Animal Health GmbH [2011] APO 67

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In brief

- | The Australian Patent Office rejects key claims in an allowed Australian patent application where claimed features, although not expressly disclosed, were found to be inherent in the prior art.
- | The relevant test was whether:
 - | the skilled person understands the disclosure of the prior publication to include a missing feature, or
 - | the document contains a direction to use a process that would inexorably or inevitably result in something within the claim.

It is not often that we see the Australian Patent Office reject a claim for lack of novelty over an inherent disclosure of information in the prior art, and that is why this decision¹ should be of interest to opponents and applicants alike.

The decision

The patent application in question contained claims directed to pharmaceutical presentations for oral administration to animals. The gist of the invention was to use an aroma in a meat-free product that would increase the likelihood of consumption, and therefore oral administration of the presentation. The patent claims were found to cover starch-based extruded articles comprising specific aromas, bodying agents and pharmaceutically active compounds, and in contrast to the applicant's position—meat.

The opponent relied on several prior art documents in support of a lack of novelty attack. One of the documents described starch-based, extruded dog biscuits containing creatine to enhance physical performance. At issue was whether that document described biscuits comprising specific aromas and bodying agents.

The patent applicant submitted that there was no indication that any of the ingredients possessed an aroma and, in addition, that the prior art document failed to disclose an ingredient functioning as a bodying agent.

An example in the prior art document included 41% poultry meat. An expert for the opponent testified that he understood the poultry meat to have an aroma that is attractive to dogs and other carnivorous animals. In light of this, the hearing officer concluded that:

Prima facie poultry meat, whether raw or processed, would have an aroma attractive to dogs. I am satisfied that GB'103 discloses an article comprising a specific aroma, as required by opposed claim 1.

Here we see the Office apply the first arm of the inherent novelty test, namely, whether the skilled reader understands the disclosure of the prior publication (in this case, of meat) to include a missing integer (in this case, meat aroma).

The same expert testified to his understanding that other ingredients in the dog biscuits (yeast, fat, rice gluten and sugar beet) were bodying agents in the exemplified biscuit. There was no evidence from the applicant on this point, which left the hearing officer in the position where he was satisfied that the dog biscuits of the prior art also comprised bodying agents within the meaning of the claim, thereby destroying the novelty of the relevant claims.

Interestingly, the relevant question here—whether the document contained a process that inexorably or inevitably resulted in something within the claim—was answered in the applicant's favour on a number of separate prior art documents where the applicant provided evidence that an alleged prior art direction in relation to a relevantly claimed feature would not be at least likely to be carried out as required by the claim. One example was prior art mention of a flavour, which the Australian Patent Office found could be said to refer to enhancing any of six sensory attributes, only one of which was smell.

Implications

What should become clear from this decision is that in its deliberation, the Australian Patent Office will continue to look beyond express disclosure to understand the meaning that a skilled worker would draw from prior art. So the decision should serve as a reminder to prospective opponents of opportunity that may be available where at face value the prior art seems to provide none. For patent applicants, the decision underscores the importance of answering each point of the opponent's evidence, not only on the interpretation of prior art, but also on the likelihood that relevant directions in the art must inexorably or inevitably result in claimed feature said to be expressly missing from the art. The latter may be where the opportunity may lie for the applicant.

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Endnotes

1. *Novartis AG v Bayer Animal Health GmbH* [2011] APO 67 (29 August 2011)

More information

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