

Inspire

December 2016



phillips ormonde fitzpatrick
intellectual property

Merry
inventions
of the silly
season

I know what it
says, but what
does it mean?
The complexities
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Alright for
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the spreads

**Pharmacies go head-to-head in a colourful
battle of red, yellow and blue.**

Editorial

2016 has been another busy year for intellectual property practice in Australia, with changes to the law as well as how the profession itself is structured. Phillips Ormonde Fitzpatrick remains committed to being your IP partner for business success and wish you Season's Greetings and a very happy new year.

In the final edition of *Inspire* for 2016, we look at two recent patent cases dealing with claim construction. Neil Ireland analyses the Full Federal Court's decision in *Otsuka Pharmaceutical v Generic Health*, in which it was held that certain features recited in a claim were inessential with significant consequences for its novelty and inventiveness. In a separate judgement, one of member of the Court commented that the claims had been infected with 'parametritis' involving an attempt to re-patent the prior art by limiting the claims by reference to a series of parameters not mentioned in the prior art (page 4).

In *Actavis v Orion*, the Full Court found that while a definition of the word 'comprises' found in the specification had to be borne in mind when construing the claims, it could not be used to contort the claim into something substantively different to how it would otherwise be understood (page 11).

Magda Bramante reviews the battle between two discount pharmacies over the appearance of their store fronts. The decision in *Verrocchi v Direct Chemist Outlet* highlights the difficulties in establishing the existence of a reputation in a colour or even a combination of colours, particularly when they can be considered to have a functional purpose (page 3).

By contrast, Anita Brown's discussion of *Dick Smith Investments v Ramsey* illustrates how little use is required to defeat a trade mark non-use removal application. Indeed the trade mark owner was able to demonstrate sufficient use despite there being no product available for sale until a year after the alleged non-use period (page 6).

Natasha Marshall sorts through the broken crockery of a dispute over the naming of Greek restaurants in Brisbane (page 8), and Mark Wickham examines the impact of the Arrowhead decision on patent eligible subject matter (page 9). We also welcome Kathy Baker back to the firm (page 7), and Mark Williams peeks into the stocking of Christmas inventions (page 12).

We hope you enjoy this edition of *Inspire*, and look forward to working with you in 2017.



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POF Partner, Karen Spark, appointed to judging panel in the Adelaide to Zero Carbon Challenge

POF Partner, Karen Spark, recently served as an expert judge for South Australia's Low Carbon Entrepreneur Prize. This competition was open worldwide to those with a low carbon entrepreneurial idea to reduce the city of Adelaide's carbon emissions in the key areas of energy, transport, waste and liveability.

As part of the judging panel, Karen reviewed all of the submissions for the Low Carbon Entrepreneur Prize. Eleven finalists, including a wildcard participant, were selected from 150 local, national and international entries.

Enecon Pty Ltd was awarded first prize and received \$100,000 for their electricity generation project using carbon-neutral fuels. In collaboration with the University of Adelaide, Enecon proposes to implement large-scale trigeneration (the production of electricity, heat and cooling in one process) with pyrolysis oil at the University's North Terrace campus. Pyrolysis oil will fuel modified conventional turbines, stationary engines and generators to create electricity, heating and cooling for the University campus. Pyrolysis oil can be generated from sustainable biomass residues, for example from the logging industry, which currently end up in land fill or are destroyed by incineration.



The second prize of \$50,000 was awarded to EcoCart Pty Ltd, an innovative system using electric powered tricycles to deliver parcels and passengers across the Adelaide central business district. EcoCart seeks to remove delivery vans from within the CBD, reducing noise, traffic congestion and related carbon emissions.

We congratulate all of the finalists and the prize winners for their efforts in addressing carbon emissions through their innovative projects.

Pharmacies go head-to-head in a colourful battle of red, yellow and blue.

In the recent decision of *Verrocchi v Direct Chemist Outlet Pty Ltd* [2016] FCAFC 104, the Full Federal Court confirmed that Chemist Warehouse could not stop Direct Chemist Outlet from using the colour combination of yellow, red and blue, despite their concerns that use of these colours could cause confusion among their customers.

The appellants, who trade as Chemist Warehouse, alleged that Direct Chemist Outlet engaged in passing off and misleading or deceptive conduct in breach of the *Australian Consumer Law* by the use of certain colours and 'get-up' in its pharmacy store fronts.

As at May 2006, Chemist Warehouse had 38 pharmacies throughout Australia. Chemist Warehouse argued that customers were able to identify its pharmacies by their distinctive external visual appearance, which included a predominantly yellow storefront with the lesser use of red and blue. The signage also contained a red logo with white text stating 'Chemist Warehouse' and slogans such as 'Is This Australia's Cheapest Chemist?'

The second respondent, Mr Tauman, was aware of Chemist Warehouse and its use of a yellow, blue and red colour scheme. In 2005, he decided to rebrand his pharmacies to a discount chemist format. This resulted in the group of pharmacies that operate under the brand Direct Chemist Outlet.

The Direct Chemist Outlet stores mostly used the same primary colour palette of yellow, red and blue, and some had a yellow background. One of the key features of the visual appearance was the use of a red sunburst logo with the words 'Direct Chemist Outlet' in blue and white text. The signage also included use of the slogan 'Who is Australia's Cheapest Chemist?'

Chemist Warehouse argued that Direct Chemist Outlet had copied elements of its visual appearance and used the same colour palette, such that the branding created a perceived association between Direct Chemist Outlet and Chemist Warehouse.

The Full Federal Court disagreed. It considered that the primary colour palette used by Chemist Warehouse was *not* distinctive for the following reasons:

1. There was considerable variability in the nature of the Chemist Warehouse get-up at each store. At best, there was only some consistency in the use of bright and primary colours including yellow, and the red 'Chemist Warehouse' logo.
2. The colours had a functional aspect. Discount retailers use the colours yellow, red and blue to draw attention. The colour yellow was used to take advantage of the attributes of visibility and association with discount value. It could therefore not be said that Chemist Warehouse's use of yellow denoted trade origin.

The Full Court was also of the opinion that the visual appearance of the Direct Chemist Outlet stores was sufficiently different to the Chemist Warehouse stores, and that Direct Chemist Outlet had developed its own brand recognition by reference to its logo.

The case highlights that it can be difficult to obtain rights in colours which serve a functional purpose. It also highlights the importance of having a consistent visual appearance throughout all stores, product ranges and promotional material, as this can assist the organisation in developing a strong reputation in the mind of its consumers.



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I know what it says, but what does it mean? The complexities of claim construction.

‘Words are free. It’s how you use them that may cost you.’ KushandWizdom (Tumblr.com)

The above quote was not originally intended to relate to the protection of intellectual property, but it is particularly applicable in relation to patent law. The protection afforded by any patent is determined by the wording of the claims and how those words are understood by a Court. Loose language or a poor choice of words in a claim can have disastrous consequences for the patent owner.

In any contentious patent matter, an initial consideration of the decision maker is to arrive at a construction of the patent claims so that issues of novelty, inventive step and infringement can be determined. Although there are well set-out principles to guide claim construction, in certain circumstances the choice of words in the claims may not achieve the patentee’s intended meaning. For example, a Judge may decide, based on the wording of a claim, that a feature is not essential to the invention and thus read the claim as though that feature was not present. Alternatively, the wording of the claim may lead a Judge to impose one or more limitations on the claim that were not intended by the patentee.

Unfortunately for the patentee, in the Full Federal Court decision in *Otsuka Pharmaceutical Co. Ltd v Generic Health Pty Ltd (No 2)* [2016] FCAFC 111, the court affirmed the trial Judge’s opinion that the claims at issue fell into both of these potential traps.

The patent in question related to the treatment of certain medical conditions using a known compound.

The method claim read as follows:

A method for treating a patient suffering from disorders of the central nervous system associated with [the] 5 HT_{1A} receptor sub-type, which disorder (i) [is] selected from cognitive impairment caused by treatment-resistant schizophrenia, cognitive impairment caused by inveterate schizophrenia, or cognitive impairment caused by chronic schizophrenia, and (ii) fails to [respond] to antipsychotic drugs selected from chlorpromazine, haloperidol, sulpiride, fluphenazine, perphenazine, thioridazine, pimozone, zotepine, risperidone, olanzapine, quetiapine, or amisulpride, comprising administering to said patient a therapeutically effective amount of a carbostyryl compound of [the given structural formula] ... or a pharmaceutically acceptable salt or solvate thereof.

There were two main construction issues. The first was the feature in the claim that described the named disorders as associated with [the] 5 HT_{1A} receptor subtype – the association feature. The second issue was the feature in the claims which referred to the failure to respond to antipsychotic drugs selected from the drugs named in the claims – the failure to respond feature. In both instances, the court construed the claim in a way that was adverse to the patentee.



The association feature

At trial, the patentee argued that the association feature was essential as it distinguished between two distinct types of disorders, namely (i) those associated with the receptor, and (ii) those that were not. The Judge was of the opinion that the patentee took this view as it would make it harder for the other side to prove its case on invalidity.

In construing the phrase ‘disorders of the central nervous system associated with [the] 5 HT_{1A} receptor subtype’, the Judge at first instance was of the opinion that this did not define an essential feature that meaningfully added to the identification of the disorders to be treated. This finding was based on the fact that the patent specification did not support the patentee’s contention that there were, in fact, distinct types of disorder. Rather, the receptor played an important role in the disorders claimed. Accordingly, the trial Judge found that the named disorders and the association with the receptor defined a single essential integer and were to be read together. This finding was affirmed on appeal, with the effect that the claims lacked novelty and inventive step, notwithstanding that the prior art did not specifically mention the ‘association of the disorders with [the] 5 HT_{1A} receptor subtype’. The patentee’s own words from the patent specification came back to haunt them.

The failure to respond feature

The issue was whether this was an essential feature, and if so, what was meant by the selected wording. The parties disputed whether the limitation referred to a second line treatment (where only one other drug had failed) or whether it referred to a third and later line treatments (failure of two or more treatments). Due to the wording of the specification and claims, the Judge construed the feature as relating to third or later line treatments. This decision was driven by the use of the plural ‘drugs’ rather than the singular ‘drug’ in the claim, as well as the examples that referred to the failure to respond to numerous drugs. While it was not relevant given the findings on novelty and inventive step, this construction had the potential to make it very difficult to enforce the claim on any potential infringer.

In determining whether the feature was essential, the Judge was of the opinion that it constituted an arbitrary limitation. Consequently, he gave it little weight in the assessment of novelty and inventive step, and therefore treated it almost as an inessential feature.

On appeal, the trial Judge’s construction of this feature was upheld, with particular emphasis placed on the examples which related to a failure to respond to multiple drugs.

Parameteritis

In a minority judgement, while agreeing with the majority on the outcome, Beach J made reference to how the claims were affected with “parameteritis”. This occurs where a patent claim includes reference to one or more parameters not mentioned in the prior art which appear on their face to be limitations. In many instances, they are merely an attempt to re-patent the prior art. As such, the Judge found that to inject the parameter ‘associated with [the] 5 HT_{1A} receptor subtype’ added nothing to the invention. The Judge then proceeded to state that ‘the artificiality of such a result and the nebulous verbiage of the claim language gives me confidence that the phrase disorders of the central nervous system associated with [the] 5 HT_{1A} receptor subtype is not a separate and essential integer.’

Implications

This case reinforces the principal that the wording of both the patent specification and the claims are crucial in determining the construction that will be afforded to the claims. Following this judgment, it is clear that the presence of inherent or arbitrary limitations in a claim will not necessarily be given significant weight in claim construction, and ultimately in the assessment of novelty, inventive step and infringement.

“This case reinforces the principal that the wording of both the patent specification and the claims are crucial in determining the construction that will be afforded to the claims.”



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Alright for OZEMITE in the battle of the spreads

Despite taking more than a decade to put his OZEMITE product on supermarket shelves, entrepreneur Dick Smith has successfully defended his rights to his Australian trade mark.

In 1999, the well-known Australian adventurer, philanthropist and businessman proposed a product, OZEMITE to rival Vegemite, an iconic yeast spread that was made in Australia, but owned at the time by the US company, Kraft Foods Limited.

Less than two years later, Roger Ramsey, launched a yeast spread called AUSSIE MITE which kicked off a long-running, bitter feud over rights to the AUSSIE MITE/OZEMITE marks.

In the latest face-off between the pair, Ramsey tried to remove the OZEMITE mark from the Trade Marks Register on the grounds that it had not been used between 1 May 2008 and 1 May 2011. In fact, there had been no sales of the OZEMITE spread until 2012. Under Australian trade mark law, a mark that has not been used during the relevant non-use period will be removed from the Register unless certain circumstances apply.

During the hearing in the Federal Court, Katzmann J heard evidence of the difficulties Smith had faced in developing a yeast spread with all-Australian ingredients that also met his stringent requirement to 'capture the taste and texture of the Vegemite he had known as a child'. During the 10-plus year product development period, Smith endured a shortage of brewer's yeast, a key ingredient which had largely been tied up by Kraft. He also had trouble finding an all-Australian company with the expertise to develop the product to his exacting standards.

However, despite the lack of sales, there was no lack of publicity surrounding OZEMITE during the non-use period. Smith, a champion of Australian products and business, had regularly appeared in the media spruiking his goods including OZEMITE.

To rebut the non-use allegations, Smith relied on just two instances of 'pre-launch publicity'. He claimed that

the first 'use of the trade mark' was an appearance on the satirical news and current affairs show, *The Chaser*, in August 2010 during a 30-second skit where he wore a t-shirt with the OZEMITE trade mark. The second 'use' was during a radio interview in March 2011 where Smith, in less than 30 seconds, spoke of his commitment to releasing OZEMITE:

SMITH: We've got ... I've been talking to Spring Gully down in Adelaide, they are a fantastic manufacturer, they have been manufacturing for us in the past. We're also looking ... you remember we were going to bring out Ozemite?

ANNOUNCER: Yes.

SMITH: The Ozemite, to compete with Vegemite, because Vegemite should be called Yankeemite because it's owned in America, you know they try and make out it's Australian ... no, it's American, and I've been trying to work on Ozemite well I am now committed, we are going to bring out Ozemite because, see, Vegemite has now changed; they've got Cheesy-Bite, ... they're making all these changes, well I want to go back to the original taste.

The Court found Smith had an 'objectively ascertainable commitment' to produce a 'vendible' product that would carry the OZEMITE trade mark. Smith's two media appearances were found to be a use of the mark in 'association with the goods in the course of their production and preparation for the market and were uses of the mark in connection with the goods in the course of trade'. Considerable funds had been expended and Katzmann J was satisfied the product remained under development during the non-use period:

'I find that at the time of the broadcasts Mr Smith (the controlling mind and will of DSI, the then owner of the mark) had a genuine expectation that his intentions would shortly be realised. It just took longer than he predicted.'

Currently, the OZEMITE mark remains on the Register and the spread on supermarket shelves. For the moment at least, Smith is a happy Vegemite!

HISTORY OF A MITEY STOUGH

July 1999: Dick Smith announces the launch of OZEMITE spread, an Australian made substitute for Vegemite.

October 1999: Dick Smith's company files a trade mark application for OZEMITE.

January 2001: Roger Ramsey commences sales of AUSSIE MITE yeast product.

May 2001: Roger Ramsey files a trade mark application for AUSSIE MITE.

March 2002: The OZEMITE application is opposed by Roger Ramsey.

October 2003: The OZEMITE mark is registered after Roger Ramsey withdraws opposition.

October 2003: Dick Smith's company opposes AUSSIE MITE application.

November 2006: The AUSSIE MITE mark is registered after Dick Smith company's opposition fails.

June 2011: Roger Ramsey files an application for removal for non-use against the OZEMITE mark.

Mid-2012: OZEMITE spread becomes commercially available for the first time.

February 2014: A Delegate of the Registrar of Trade Marks rules that the non-use application against OZEMITE is successful.

March 2014: Dick Smith appeals the Delegate's decision and brings rectification proceedings against the AUSSIE MITE registration.

Roger Ramsey files rectification proceedings in a cross-claim seeking to have the OZEMITE trade mark removed.

August 2016: On Appeal, the Federal Court exercises its discretion not to remove the OZEMITE trade mark from the Register.



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Welcome back to POF, Kathy Baker

We are pleased to announce that Kathy Baker has recently re-joined POF. Kathy has returned to our Adelaide office as a patent attorney in our Electronics, Physics and IT team after previously being with the firm for nearly five years.

Kathy's technical background is in computer science. She has experience in drafting and prosecuting patent applications for a variety of technologies, including electronics, software, telecommunications, mechanical devices and computer implemented inventions. She has assisted local and foreign clients to obtain IP protection in Australia and overseas.

Prior to returning to POF, Kathy spent three years working as an IP manager at an Australian R&D company, where she managed the IP portfolios of two electronics start-ups.

We warmly welcome Kathy back to the firm and look forward to working with her again.



Season's Greetings

from the Partners and staff of
Phillips Ormonde Fitzpatrick

A 'little' Greek food for thought

In *3 Florinians Pty Ltd v PYT Enterprise Pty Ltd* [2016] FCA 1077, the owner of popular Greek restaurant, Little Greek Taverna, obtained an interlocutory injunction to stop two other restaurants from using the word 'little' along with the words 'Greek Cuzina', pending trial or earlier orders.

A *little* confused? Shouldn't a trader be able to describe their restaurant as 'little', and by the cuisine they serve?

The Applicant, 3 Florinians Pty Ltd (Florinians), is the registered owner of the trade mark shown in Figure 1 which covers class 43 services 'providing food and drink' and other food services, as well as various advertising services in class 35.

The Florinians have run a family restaurant business in the West End of Brisbane since September 2009. Evidence showed that their restaurant had acquired a significant reputation in the 'Little Greek Taverna' trade mark. The evidence included numerous restaurant reviews describing the 'Little Greek Taverna' as 'a staple of West End and loved by all who like Greek food', 'one of Brisbane's favourite Greek restaurants' and 'constantly alive and bustling with diners'.

PYT Enterprises Pty Ltd (PYT) began operating a Greek restaurant called 'Little Greek Cuzina' in June 2015 in Graceville, and used the trade marks in Figure 2. The trade marks were licensed by Adamaris Pty Ltd (Adamaris) for a restaurant that began trading in Bulimba in June 2016.

The Florinians became aware of PYT using the trade mark 'Little Greek Cuzina' in about June 2015, and of Adamaris using 'Little Greek Cuzina' in about June 2016. The Florinians relied on evidence of confusion, including examples of:

- acquaintances such as their bank manager, mistakenly believing that they ran the 'Little Greek Cuzina'



Figure 1 No. 1327799



Figure 2

- a supplier of Greek food mistakenly giving Florinians' order for food to PYT as they had 'similar names'
- people telephoning 'Little Greek Taverna' to book at 'Little Greek Cuzina'
- the quality of the Respondent's food being questioned, but wrongly connected to the Florinians.



(Some) nucleic acids patentable in Australia

The Florinians sought an interlocutory injunction for trade mark infringement, contravention of the *Australian Consumer Law*, and the common law tort of passing off. Justice Greenwood only dealt with the trade mark infringement issue in granting the injunction.

PYT explained that they had adopted their trade mark in good faith because their restaurant had limited seating, and was a 'little' restaurant. They reasoned that the word 'little' was often used in the restaurant industry to describe a small restaurant serving a style of food, for example, 'Little India' and 'Little Italy'.

Furthermore, the word 'Greek' conveyed the style of food served at their restaurant; and the word 'cuzina' was a made up derivation of the Greek word for kitchen, 'kouzina'. PYT argued that it is common for Greek restaurants in Australia to use phrases such as 'little Greek', 'little Greece' and 'Greek Taverna' in their names, and provided searches of restaurant websites, from the Australian Business Register and the ASIC database in support of this proposition. Justice Greenwood, however, found that the searches did not show that it was 'very common' for restaurants to be referred to as 'Little Greek' as an identifier in a trade name, followed by the word Tavern or Taverna.

On the issue of deceptive similarity, Justice Greenwood held that the words 'Little Greek Taverna' were the distinguishing characteristics of the Florinian's logo, and that the words 'Little Greek' were distinctive of the Taverna operated by them. Justice Greenwood reasoned that people who knew 'Little Greek Taverna' would be prompted to wonder whether the Respondents' 'Little Greek Cuzina' was a restaurant run by the Florinians, particularly given the oral similarities of the marks and the potential for mistaken identity during oral communication of the two restaurants.

This case is a useful reminder to take care when using descriptive words in trade marks, particularly when products or services are likely to be identified orally over the counter, in a restaurant, or over the telephone.

In the recent case of *Arrowhead Research Corporation* [2016] APO 70 (Arrowhead), the Australian Patent Office has held that claims to compositions comprising an interfering RNA are patent eligible subject matter. This decision contrasts with recent examination practice following last year's High Court decision in *D'Arcy v Myriad Genetics Inc.* [2015] HCA 35 (Myriad).

In 2015, the High Court of Australia held that claims to isolated nucleic acids were not patentable subject matter. The Court considered the substance of the invention related to the genetic information in the nucleotides of the claims, rather than the isolated nucleotides being a tangible product per se, and led to the conclusion that the claims were not for a 'manner of manufacture' (patent eligible subject matter).

In Arrowhead, the Applicant requested to be heard in relation to the Patent Office's objection to claims directed to interfering RNAs, on the basis that those claims were not for a manner of manufacture. The Examiner argued that the way the invention works was solely dependent on the sequence of nucleotides in the iRNA, that the utility lay in the sequence itself, and that the substance of the product was information.

The Delegate considered the substance of the invention, analysing the description and how the invention worked. Importantly, the Delegate gave consideration to the structural properties of RNA as well as the mechanism and requirements for RNA inhibition, which are also of significance to the working of the invention. The Delegate considered the manner in which the invention worked was not solely dependent on the sequence of nucleotides in the inhibitory RNA, with the informational, structural and chemical content of the dsRNA molecules all being essential elements of the invention. As a result, the substance of the invention was considered to encompass each of these elements, not merely the genetic information conveyed by the molecule.

On this basis, the substance of the claimed invention was considered to be a product, not the genetic information contained in the composition, and to meet the requirements of manner of manufacture and therefore be patentable in Australia.

This decision means that the Myriad decision will be given a more narrow interpretation than had been applied by Examiners to date. The decision also highlights the importance of presenting material to the Patent Office in relation to the mechanism of action of the composition, as it relates to the substance of the invention.



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New year's resolutions: cleaning up your trade mark portfolio.

Whether you're an established or up-and-coming business, particularly in the fast moving consumer goods industry, your brand is often your most valuable asset. It's the hallmark of your product's quality, origin and value proposition. It's what sets you apart from the many other products in the marketplace.

The coming of the new year is a timely reminder to set new goals for 2017. A useful resolution to add to your list is to review your trade mark portfolio. Here are some tips to successfully kick off the new year:

1. Review all trade marks used in your business and divide into three piles: 'keep', 'review' or 'throw away'.
2. For those trade marks in your 'keep' pile:
 - > Check whether the mark is the subject of a trade mark application or registration on the IP Australia website, www.ipaustralia.gov.au. If it is, ensure your registration is valid or your application is alive and note any deadlines for renewal or other action.
 - > Ensure the application/registration is in the name of the correct person or company (not a former owner or company name).
 - > Conduct a sweep of the Internet and other relevant places (such as the weekend markets) for any unauthorised use of your trade mark by third parties. Seek legal advice if any unauthorised use is found.
 - > If you've had issues with counterfeit products, consider lodging a Notice of Objection with the Australian Border Force (Customs).
 - > Ensure your marks are used consistently throughout your business. If your logo has changed, seek advice on obtaining a new trade mark registration.

- > Make sure your marks are always used as an adjective and not a noun or a verb in marketing or advertising materials.
 - > If the mark isn't registered or it is the subject of a trade mark application, seek advice on registering your trade mark both in Australia and/or overseas.
 - > If your mark is the subject of a licence, ensure the licensee is complying with its obligations under the licence agreement.
3. For those trade marks in your 'review' pile, consider the mark's value and whether it remains a good fit for your business. Does it generate revenue, provide a competitive advantage, attract investment or add to the sale value of your business?
 4. For those trade marks in your 'throw away' pile, consider whether there is any prospect of selling them to a third party. If not, remove them from your trade mark records.

Contact us if you require further information, or you would like to arrange a free consultation to discuss your trade mark portfolio resolutions.



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Full court decision potentially limits definition of ‘comprises’

The Full Court decision in *Actavis Pty Ltd v Orion Corporation* [2016] FCAFC 121 potentially limits the effectiveness of a definition of ‘comprises’ in a specification.

In many jurisdictions, the word ‘comprises’ when used in a patent claim is understood to be inclusive, such that a claim to a compound comprising A, B and C will not usually be understood to exclude the presence of D. In Australia however, a number of Court decisions mean that the term is usually construed as being exclusive. It is therefore common practice to include in a specification a definition of the term stating that it is used inclusively.

In *Actavis Pty Ltd v Orion Corporation*, claim 17 of the patent defined:

A method for preparing an oral solid composition comprising entacapone, levodopa, and carbidopa, or a pharmaceutically acceptable salt or hydrate thereof, wherein the method comprises:

- a. mixing pharmacologically effective amounts of **entacapone** and **levodopa**, or a pharmaceutically acceptable salt or hydrate thereof, with at least one pharmaceutically acceptable excipient and a disintegrant to obtain a first mixture;
- b. granulating the first mixture to obtain a granule batch;
- c. adding a pharmacologically effective amount of **carbidopa**, or a pharmaceutically acceptable salt or hydrate thereof, optionally a lubricant, and optionally one or more pharmaceutically acceptable excipients to the granule batch to obtain a second mixture;
- d. formulating the second mixture into a plurality of dosage forms.

For the purpose of determining infringement, the Court needed to decide whether claim 17 included a process in which the amount of levodopa added in step a) could be a low, but nevertheless pharmacologically effective, dose and a further

amount of levodopa added in a later step, such as step c), provided that the addition, at the later step, did not compromise the pharmacological effectiveness of the overall composition. The trial judge had held such a process to be within the scope of the claim.

The Full Court considered that the plain reading of claim 17 suggests that the process is one in which there is an intended pharmacologically effective amount of each active agent and that this pharmacologically effective amount is added at the designated process step specified in the claim. The only reason to read the claim otherwise was based on a definition of the word ‘comprises’ in the specification – namely, that its use in the description and claims ‘is not intended to exclude other additives, components, integers or steps’.

It was held that this indication in the specification must be borne in mind when construing claim 17, but that it could not contort the claimed process into a substantively different process. It could not give the word ‘comprise’ and its variants an unbridled operation, when the relevant description and claims themselves specify, with appropriate precision, the step or steps to be taken that will provide the promised advantage. Accordingly, the better reading of claim 17 was that the word ‘comprises’ must yield to the direction that the intended pharmacologically effective amounts of each active agent must be added at the step in the process that is specified for that addition.



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Merry inventions of the silly season!

Christmas is a time for giving, spending time with loved ones and relaxation. It is also a time for searing pain as one steps on newly acquired blocks of Lego in the middle of the night, arguing with said loved ones, and for Australians, wondering why we are eating a hot turkey on a 40 degree Celsius day.

Also, as any patent attorney will tell you, it is a time for innovation. January can be a busy month for patent attorneys with inventors rejuvenated and excited about their new innovations. Post-holidays, many companies look to protect their yuletide innovations. The inventions are endless, from improved assemblies for Christmas trees, to ornaments that double as smoke detectors. Here are some of our favourites.

The naughty or nice meter

As any child will know, the months leading up to Christmas are a risky period in which bad behaviour can result in little to no Christmas presents. Infractions in January are largely forgotten, but the danger period has always been October onwards. This is where the naughty or nice meter comes in (Figure 1) – a meter calibrated into percent ranges to determine if you are naughty or nice. You'd better watch out!

The hopeless romantic

The holiday season can also be a time of romance, but why leave it to fate to decide if your beloved will stand in the doorway for a kiss? This 1984 patent (Figure 2) for a headband device dangles a fresh piece of mistletoe in front of its wearer's head.

The re-gifter

The term 're-gift' was made popular in the television comedy *Seinfeld*, where Dr Tim Whatley re-gifts an unwanted label maker to Jerry, which Elaine gave to Tim the previous Christmas. Amazon have provided a solution to the unwanted gift problem, so you can

automatically convert the gift into something else *before* the gift is given to you. Convert your unwanted socks into a *Seinfeld* DVD and sleep peacefully knowing you won't be caught out.

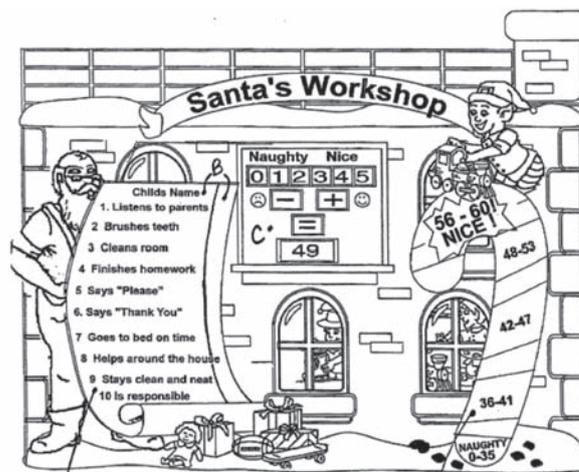


Figure 1 Naughty or nice meter – US 20080299533 A1

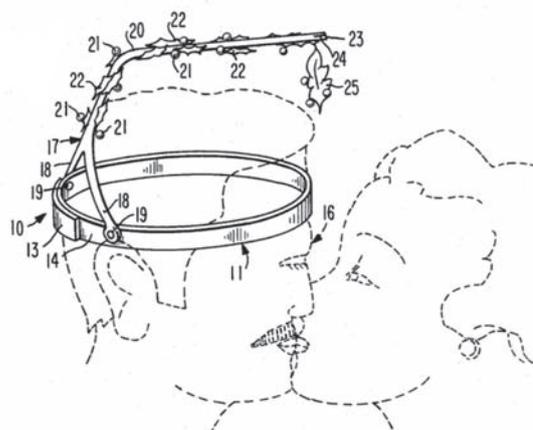


Figure 2 Mistletoe supporting headband – US 4488316 A



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