

Court The Hague 22 August 2007 (Ajinomoto/GBT)

On 22 August 2007 the Court rendered judgment in a major biochemical patent litigation between a Japanese claimant (Ajinomoto) and a Chinese defendant (GBT) and their European distributors. Three patents were in dispute (infringement and validity) all of which concern genetic manipulation of the DNA of a bacterium in order to have said bacterium produce more of the amino acid L-lysine by means of a fermentation process. Amino acids are the building blocks of proteins. Because animals need proteins in order to be able to grow, they also need to get sufficient amino acids in their feed. The amino acid L-lysine is normally present in insufficient supply in animal feed and for that reason it is added to animal feed. No wonder that the interests on the Dutch cattle breeding market, one of the largest cattle breeding markets of the world, led parties to the Court in The Hague.

Because the *full* continuous DNA sequence of the used bacterium was not present in the end product, it was not as easy for claimant Ajinomoto to prove infringement of their patents. Said evidence was furnished by means of gene sequence analyses of DNA remainder that were still present in the found L-lysine. The Court ignores the defense of GBT that this evidence would not be conclusive because this would not show the fully claimed (modified) gene sequence. The evidence supplied makes all of this rather plausible and an explanation to the contrary is absent:

“Nor does the reproach hold that Global et al. blame Ajinomoto for that the evidence would not be conclusive that the dapA sequence (coding for DDPS according to SEQ ID NO: 3, whereby the histidine on place 118 is substituted by a tyrosine). The TNO experiments submitted by Ajinomoto (experiment 2) and Hitachi (Exh. 14 Ajinomoto, experiments 1-4) make all of this very plausible, whereas Global et al. have failed to offer sufficient substantiation that and why said results with accompanying conclusions would be incorrect, nor have they submitted a report to the contrary.”
(ground for the decision 5.28)

and:

“Although these experiments do not directly show the presence of the pntAB-gene on the chromosome and on plasmid 2 (they only show a specific DNA fragment that is situated next to the pntAB gene), Global et al. have again failed to show how the presence of said DNA fragments can be explained if there would be no case of chromosomal pntAB-DNA and of pntAB-DNA situated on plasmid 2.”
(ground for the decision 5.57)

The argument of one of the European distributors that it would have been elicited to a once-off delivery in The Netherlands and that the patent owner would therefore have no interest in an injunction, is dismissed by the court. Unless an unambiguous and unconditional commitment to refrain has been given, there is still a case of likelihood of unlawful act according to the court (ground for the decision 5.2).

In respect of the validity of the patents relied on, the court considers inter alia (grounds for the decision 5.22 en 5.52) that an additional indication for the inventive step of the inventions can be found in the very considerable lapse of time between the

date of the closest prior art (1972) and the priority date of two of the three patents (1993). That is striking because such indications were usually given little interest in prior judgments in fact-finding instances.

Also, it is striking that according to the court the knowledge of an expert cannot always be equated with the knowledge of the person with average skill in the pertinent art:

“Rydström’s knowledge of the art, who is employed as a professor in biochemistry at the University of Göteborg, in particular in the field of transhydrogenase, cannot be compared in this case with that of the person with average skill in the art who is looking for an increase of the production of L-amino acids. That Rydström could draw a specific conclusion from a publication, does therefore not necessarily mean that the average skilled person would do the same and that this should be obvious to the latter, just like to Rydström.” (ground for the decision 5.50)

The patent owner has limited the claims of one of its patents of its own free will during the proceedings. The court confirms its position known from prior case law that withdrawal to dependent claims must be considered to be in line with the criteria formulated by the Supreme Court in the *Spiro vs. Flamco* decision (ground for the decision 5.40-41).

On the basis of two of the three patents relied on, both of which are considered valid, an infringement injunction is given. The court stays its decision in respect of the third patent, as long as no *irrevocable* decision has been taken on this in opposition before the EPO (ground for the decision 5.60-61).

Although it might seem strange that a patent owner may thus be excluded from the patent protection to which it is entitled, said consequences will turn out better in casu than anticipated, because an injunction has already been given on the basis of the other patents relied on. It is for that matter remarkable that the decision is also stayed with respect to the claimed full legal costs. This means after all that the victorious patent owner would still have to wait for years for compensation of his (considerable) lawyer and patent attorney fees.

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Please note that the author is one of the attorneys who acted for Ajinomoto