

GAMBRO PTY LIMITED v FRESENIUS MEDICAL CARE SOUTH EAST

ASIA PTY LTD

[2000] FCA 1044

4 August 2000

This application for leave to appeal before the Full Court of the Federal Court involved the considerations to be taken into account in litigation involving patents, in particular with respect to amendments to the claims of a patent in suit.

The invention, which was the subject of the patent, was designed to overcome difficulties associated with the preparation of dialysis fluids used in procedures for the treatment of patients' blood externally to the patient.

Background

Gambro had commenced infringement proceedings against Fresenius in relation to its Australian patent no. 595423. Fresenius denied infringement and cross-claimed seeking revocation for invalidity on the grounds of lack of novelty and inventive step. After the proceedings had commenced Gambro sought pursuant to s 105 of the *Patents Act* 1990 (Cth) (the "Act") a direction by order from the court to amend the claims of the patent.

The issue of amendment was by consent dealt with separately from the infringement action. After argument Tamberlin J allowed the amendments. The applicant sought leave to appeal the decision of the primary judge and argued that the amendments

would claim matter not in substance disclosed in the original specification within the meaning of s102 of the Act and further that the amended claims would not:

- (a) define the invention;
- (b) be clear and succinct; and
- (c) be fairly based,

within the meaning of ss 40(2) and 40(3) of the Act.

Decision

The various amendments are set out fully in the judgement. After a consideration of these and having heard full argument the Full Court dismissed the application for leave on the ground that an appeal would have no prospect of success.

Relevantly, the Full Court held that the requirements of s 102 of the Act should be given a liberal construction because of strong public interest to encourage innovation.¹ With this consideration in mind and after reviewing the amendments the Court found that the amendments:

- (a) did not broaden the claims;
- (b) involved matter already in substance disclosed in the claims in suit; or
- (c) were mere surplusage.

The Court also noted that the applicant did not provide any practical detail as to why the amendments would cause harm to Fresenius and its activities.

¹ *Ethyl Corporation's Patent* [1972] RPC 169.

Summary

A helpful decision for those conducting patent litigation as to the considerations surrounding the exercise of the court's power under s105 of the Act to direct amendments to patents in suit.

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