

What you say may be used against you

Issues with the use of comparative examples



You are not obliged to include comparative examples, but any comparative examples you include may be used against you!

It is common in patent specifications to include detailed examples of products that incorporate the invention that is claimed, and sometimes other examples are included for comparison purposes. A recent decision of the Federal Court of Australia (*Nufarm Ltd v Jurox Pty Ltd* [2008] FCA 178, 29 February 2008) has demonstrated the potential hazards of including comparative examples in a patent specification.

The case concerned infringement proceedings in connection with a certain innovation patent that claimed oral veterinary compositions including three active ingredients together with an emulsifying agent, and consisting of two liquid phases which either existed in an emulsion or could be shaken or agitated to form one. The patent specification included eighteen specific examples of compositions, the first four of which were indicated in the specification to have deficiencies. The composition of the alleged infringement resembled Examples 1-4 in that it contained no vegetable oil or other water-immiscible liquid. Nevertheless, the patentee alleged that this product infringed its patent.

At the heart of the question of infringement were the meanings of “emulsion” and “phase”, which the evidence showed were not unambiguous words. The alleged infringer argued that the word “emulsions” as used in the claims of the patent should be construed to cover only macroemulsions (large droplets of one liquid suspended in another) and to exclude micellar solutions (small droplet size) which described its product. The patentee argued that Examples 1-4 of the patent illustrated formulations that were claimed in the patent, and so the alleged infringement was also claimed.

Faced with the task of construing the meaning of “emulsion”, Middleton J turned to the patent specification for assistance, and in particular to the discussion of Examples 1-4. The specification describes these formulations as “completely aqueous formulations” and said that work on this type of formulation was “abandoned”. Middleton J considered that by these statements the specification was indicating that these formulations were disclaimed, and that Examples 1-4 had been included not as illustrations of the invention but to show how the final formula was arrived at and to illustrate the inventive step or steps undertaken. Middleton J accordingly found that the allegedly infringing formulation did not infringe the claims of the patent.

It may be that if Examples 1-4 had not been included in the specification the outcome of the case would still have been the same, but it is evident that the patentee was faced with additional difficulty as a result of the presence of these examples and the discussion of them in the specification.



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