

FOLLOW THE CHEMISTRY

Nufarm Australia Limited v Corteva Agriscience [2022] APO 46 (6 July 2022)

In Australia the law relating to lack of novelty dictates that to anticipate a patentee's claim a prior disclosure must provide clear and unmistakable directions to do what the patentee claims to have invented. A signpost, however clear, upon the road to the patentee's claims will not suffice. The prior inventor must be clearly shown to have planted his flag at the precise destination before the patentee¹. Anticipation is deadly and requires the accuracy of a sniper, not the firing of a 12-gauge shotgun². It follows that to establish an anticipation, specificity of the prior disclosure is important. In carrying out the directions in the prior art leads inevitably to doing something within the claim in suit, there will be lack of novelty.

Arcadia Intellectual Property has acted for Nufarm Australia Limited in long running patent litigation against Corteva Agriscience LLC (formerly known as Dow Agriscience LLC) in relation to Australian patent application 2008219657 (withdrawn) and numerous divisional patent applications derived therefrom including AU 2017261483 which is the subject of this decision. AU 2017261483 is directed to the reaction product of a herbicidal carboxylic acid and a tetraalkylammonium hydroxide (including the reaction product 2,4-D choline). Among several prior art disclosures Nufarm relied on a Japanese patent application JP 51-106728 relating to herbicides comprising phenoxy-based herbicides (including 2,4-D) and cholines prepared by mixing the relevant phenoxy compound, choline, surfactant and water. It was not in dispute by either party that choline hydroxide is within the scope of the (tetraalkyl)ammonium hydroxide and when reacted with 2,4-D the claims would be infringed. What was in dispute was whether the "choline" in JP51-106728 was choline hydroxide noting the choline on its own is a cation so it must have a counter ion of some kind. Corteva contended that D2 did not provide clear unmistakable directions to use choline hydroxide.

Following the chemistry, the delegate found claims 1 to 4, 7, 8 and 10 to 12 of AU 2017261483 to be not novel and not inventive in light of the prior Japanese patent application because it is clear that in the Japanese patent application an acid base reaction is taking place between the phenoxy acid and whatever choline is being used and this would only be the case if the choline is choline hydroxide. The delegate also noted that the molar ratios in JP 51-106728 point to the use of choline hydroxide and that if a different choline salt was used it would be necessary to start with a salt of 2,4-D. The delegate concluded that the clear and unmistakable directions in JP 51-106728 are to use choline hydroxide in the practical embodiment and react it with 2,4-D.

This is indeed a fantastic and well-deserved win for Nufarm Australia Limited and follows on from its win in Europe following an appeal to the Enlarged Board of Appeal of the EPO.

*Authored by Ruth Clarkson of counsel
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¹ *General Fire & Rubber Co v Firestone Tyre and Rubber Co Ltd.* [1972] RPC 457 at 485-486

² *Apotex Pty Ltd and Another v Sanofi-Aventis and Another* [2008] FCA 1194; (2008) 78 IPR 285