

**LOOKING AT REFERENCES: CONSTRUING PATENT CLAIMS IN  
HOFFMANN-LAROCHE LTD. v. MAYNE PHARMA (CANADA) INC.**

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In the summer of 2005, the Federal Court of Canada rendered a decision on the interpretation of claim references in *Hoffmann-LaRoche Ltd. v. Mayne Pharma (Canada) Inc.*, 2005 FC 814. Mayne alleged that the medicine ceftriaxone, a cephem derivative, was not covered by LaRoche's patent. The Court considered whether product claims that make reference to a part of a previous process claim should be considered of the product-by-process type or product type *per se*. Construing the pertinent claims, the Court found that the claims at issue refer only to the compounds defined within the process claim, and thus cover the product *per se*.

**Claim references in the context of patent practice**

The intellectual property right conferred on a patentee is defined by the claims in the patent. There are two types of claims: independent and dependent claims. The independent claims establish the invention in terms of its essential elements and thus fence off the monopoly in its widest scope. Dependent claims are also built-in. Dependent claims add features in addition to those defined in the claims on which they depend. In fact, according to Section 87(3) of the *Patent Rules*:

*“Any dependent claim shall be understood as including all the limitations contained in the claim to which it refers (...)”*

In the field of chemistry, a dependent claim may for example specify an advantageous temperature range, particular catalyst, or preferred R-subgroup.

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To further characterize and strengthen the property right, claims of numerous categories—product, process, use, etc.—are often integrated within a same patent application. As a general rule of thumb, dependent claims refer to preceding claims of the same category. Thus, dependent product claims refer to product claims; process claims to process claims; use claims to use claims. However, in order to avoid repeating lengthy definitions, such as complicated molecular drawings and long lists of constituents, claims can refer to parts of preceding claims of the same or of another category. These claims do not contain all the limitations of the claims to which they refer, and thus are not “dependent.” Nevertheless, the references in such claims should be clear and unambiguous in order to establish an effective meaning.

### **The LaRoche case**

The Federal Court looked at claim references in *Hoffmann-LaRoche Ltd. v. Mayne Pharma (Canada) Inc.* In this case, the applicant (LaRoche) had a licence for the production of the medicine ceftriaxone, which is the subject of a number of claims in the Canadian patent 1,259,606 (hereafter called the 606 patent). The defendant (Mayne) applied for a Notice of Compliance (NOC) to market the medicine and served LaRoche with a Notice of Allegation (NOA) alleging non-infringement of the 606 patent. LaRoche sought an order prohibiting the issuance of the NOC to Mayne until the expiry of the 606 patent, submitting that the patent covers the medicine. LaRoche had the burden of proving that the NOA was not justified in its claim of non-infringement.

With regards to the 606 patent itself, independent claims 1 and 2 claim a process for the production of general compounds that encompass the medicine ceftriaxone. Despite being process claims, they provide, in the first portion of the claim, definitions of a compound of general formula I. Independent claims 45, 64 and 65 claim general compounds and refer to process claims 1 and 2 for the definition of the compounds. Claims 45, 64 and 65 are the claims at issue and read as follows:

“45. A cephem derivative of the general formula I as defined in claim 1.”

“64. A cephem derivative of the general formula I as defined in claim 2.”

“65. A pharmaceutical composition containing compounds of the formula I as defined in claim 1, or a pharmaceutically acceptable salt thereof, in admixture with one or more pharmaceutically acceptable auxiliaries, carriers, diluents or excipients, for use in the treatment of microbial infections.”

The Court looked into the following question: should these product claims include the process limitations of claims 1 or 2, and thus be seen as product-by-process claims, or are the claims product claims *per se*?

In interpreting the claims at issue, the Court had to interpret claims 1 and 2. As previously mentioned, claims 1 and 2 relate to a process for the preparation of a cephem derivative. These claims were construed as clearly including two components: a compound component and a process component. The first portion of the claims defines the cephem derivative (the compound component). The second portion of the claims defines the process by which the cephem derivatives are made (the process component). These two portions are separated by the transitional expression “in which.”

Turning back to claim 45, the Court came to the conclusion that the wording of this claim only referred to the “compound component” of claim 1. Otherwise, to capture both concepts included in claim 1, that is the compound component and the process component, claim 45 should not only have made reference to the process component but the following words should also have been included: “and made by the process of claim 1.” The same reasoning applies to claims 64 and 65.

Therefore, in order to conclude that claims 45, 64 and 65 contain all of the limitations (compound and process) of claims 1 and 2, the wording of claims 45, 64 and 65 must clearly indicate reference to both portions of claim 1 or 2.

The Court's manner of construing the references of the claims particularly shows that the doctrine of “purposive construction” in juridical proceedings extends beyond the elements of an invention, and even to the textual structure and formal references of the claims. Claims must be clear to fulfill their disclosure and public notice functions. In order to avoid potential litigation, sometimes lengthy definitions should be repeated rather than referred to. Moreover, not only do the elements of an invention need to be mindfully described and interrelated, but the textual order and claim references must also be approached with acute awareness of their eventual interpretation—in order to write clear and unambiguous claims to establish a stalwart intellectual property right.

