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IN THE HOUSE OF LORDS
ON APPEAL FROM HER MAJESTY'S COURT OF APPEAL
(ENGLAND)

House of Lords
Tuesday, 13th July 2004

Before:
LORD HOFFMANN
LORD HOPE
LORD RODGER
LORD WALKER
LORD BROWN

BETWEEN:

KIRIN-AMGEN INC. and Others
Appellants
and

HOECHST MARION ROUSSEL LIMITED and Others
Respondents
and

BETWEEN:

HOECHST MARION ROUSSEL LIMITED and Others
Appellants
and

KIRIN-AMGEN INC. and Others
Respondents

(Computer-aided transcript of the Stenograph Notes of
Marten Walsh Cherer Limited, Midway House
27/29 Cursitor Street, London EC4A 1LT
Telephone Number 0207 405 5010. Fax Number 0207 405 5026)

MR. ANTONY WATSON QC and MR. ANDREW WAUGH QC and
MR. COLIN BIRSS (instructed by Messrs. Taylor Wessing)
appeared on behalf of Kirin-Amgen & Others.

MR. DAVID KITCHIN QC and MR. RICHARD MEADE and MISS LINDSAY LANE
(instructed by Messrs. Bird & Bird) appeared on behalf of the
HMR/TKT parties.

PROCEEDINGS
DAY 6

01 WAUGH
02 that it is OK even if it is identical to the DNA in the cell.
03 LORD HOFFMANN: Clinically identical, yes, I understand, but you
04 cannot surely estop somebody from simply using the DNA which
05 is already in the cell.
06 MR. WAUGH: The DNA already in the cell, I am going to come on,
07 if I can, to address this in the context of the novelty
08 argument, it is said that claim 1 is lacking in novelty
09 because it, as we contend on our construction, would cover
10 DNA resident in the kidney cell. You cannot have that. The
11 short answer which we will come to see also in the context of
12 the mere discovery point is the fact that in fact it is the
13 suitability of the DNA sequence as written which gives it its
14 patentability. Can I come on to that? It is obviously an
15 important aspect.
16 What we have said here, just to encapsulate it, what
17 the invention then is, in the light of what this contribution
18 has been declared to be, the invention here is the DNA of
19 EPO, manipulated or engineered, otherwise made suitable,
20 however you want to make it suitable, in such a way that it
21 will express EPO in a host cell when it would not
22 otherwise ----
23 LORD RODGER: Can you say that again?
24 MR. WAUGH: DNA manipulated or engineered in such a way that it
25 will express EPO in a host cell when it would not otherwise