(1) *Rhone-Poulenc Rorer International Holdings Inc*
(2) *ImClone Systems Inc*
vs
Yeda Research and Development Co Ltd

Michael Edenborough
Monday, 9th November 2009
Royal Society of Chemistry

serle court

References

- **High Court**
  - **Lewison J**
  - **[2006] EWHC 160 (Ch), 16th February 2006; [2006] RPC 24, 605**

- **Court of Appeal**
  - **Sir Anthony Clarke MR, Keene and Jacob LJJ**
  - **[2006] EWCA Civ 1094, 31st July 2006; [2007] RPC 9, 167**

- **House of Lords**
  - **Lord Hoffmann, Lord Phillips CJ, Lord Walker, Lord Mance and Lord Neuberger**
  - **[2007] UKHL 43, 24th October 2007; *The Times*, 30th October 2007; [2008] RPC 1**

Basic Facts

- **EP UK 0 667 165 concerning monoclonal antibodies combined with anti-neoplastic drugs**
- **granted 27th March 2002**
- **RPRI was the proprietor, ImClone was exclusive Lee**
- **Yeda was applicant in post-grant entitlement proceedings**
- **Comptroller-General of Patents intervened in the appeals to the HCt, CA and the HLs**

PA 1977 section 37
Post-Grant Entitlement Proceedings

- **s 37(1): who is/are the true proprietor(s)?**
- **C-G shall determine the question, and then make such order as he thinks fit to give effect to that determination**
- **s 37(5): unless "bad faith" is alleged, then proceedings must be brought within 2 years of the grant**
- **s 37(5) based on CPC Article 23 (not in force)**

The Central Allegation

- **Originally, Yeda sought joint entitlement in proceedings commenced on the 26th March 2004**
- **(1st interim application for a stay, pending other disputes, *e.g.* in the USA and Germany)**
- **However, on the 29th June 2005, sought to amend to seek, in the alternative, sole entitlement**
- **In the interim, *Markem* had been decided by CA**
- **Yeda, in essence, now expressly pleaded a breach of confidence "cause of action" as required by *Markem*, and added a new allegation that the inventors were its employees at the relevant time**

Patent Office Decision

- **Mr Kennell's decision dated the 20th October 2005**
- **Held that the CPR Part 17.4 did not apply to PO proceedings, but if it had applied, then it was not satisfied**
- **However, based upon the exercise of his discretion (in essence, so as to have the whole dispute before him) he allowed the amendments**

High Court Judgment

- **PO had to decided a formulated dispute as pleaded in the PR 1995 r 54 statement: no roving inquiry**
- **s 37(5) was a limitation period, based upon CPC Art 23, which forbade an application outside the two-years period (to ensure legal certainty)**
- **the CPR did not apply to PO proceedings, but could be used for guidance**
- **PR 1995 r 100, gave the PO an unfettered discretion to allow amendments, but no inherent power**
- **amendments took effect when ordered, and did not relate back to the original pleading**
- **going from joint to sole entitlement introduced a new cause of action (note the different effects upon third parties such as licensees)**
- **appeal allowed, amendments refused**

Court of Appeal Judgment

- **the CPC applied as if in force**
- **legal certainty was most important for the Ptee, not TPs**
- **a claim for sole ownership included a claim for joint: the greater included the lesser, but not *vice versa*; so the amendment sought the introduction of a new cause of action**
- ***obiter*, the amendments were barred as the LA 1980 applied to the underlying cause of action**
- **appeal refused, so amendments still refused**

House of Lords Opinions

- **PO has a wide discretion**
- **once properly commenced, the entitlement reference is before the tribunal**
- **sole and joint entitlement are not different causes of action**
- **appeal allowed, and so amendments allowed (*i.e.* HO's originally decision restored)**

Markem

- ***Markem Corp v Zipher Ltd*** **[2005] RPC 31: need a "cause of action" to found an entitlement claim**
- **expressly overturned by HLs**
- **entitlement is based upon PA 1977 s 7, not the presence of an independent cause of action**
- **applicant needs to show its entitlement (and the current Ptee's lack of entitlement if ousting – s 7(4) presumption)**

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- **All areas of IP law and practice, in particular patents, trade marks, copyright and designs. Over 70 reported cases since 2000, of which two thirds were appeals or JRs. Appeared often before the CFI/ECJ (over 25 times) and in the EPO (*e.g.* Legal and Technical BoA). Acted for the Comptroller-General of Patents (*Yeda*, HLs, CA, PatCt), the Registrar of Trade Marks (*General Cigars* and *Land Securities*, both appeals to the ChD) and the UK government (*adidas*, ECJ). Extensive copyright and design practice (both registered and unregistered, UK and Community)**