

EIP

10x Genomics patent revoked

NanoString Technologies Europe Limited v. President and Fellows of Harvard College
(UPC 252/2023)

Decision of 17 October, 2024 (ORD_598480/2023[1])

This decision from the Central Division in Munich relates to EP2794928 belonging to President and Fellows of Harvard College, of which 10x Genomics is the licensee. 10x Genomics was refused a provisional injunction against NanoString on the basis of this patent (reported here[2]) – the Munich local division had doubts about the validity of the patent at least according to the claims as granted, and was not convinced that it was actually infringed.

NanoString Technologies Europe Limited filed a revocation action against the patent at the UPC at the Munich Central Division on 27 July 2023. There was already pending a national revocation action in Germany related to the same patent, filed on 29 July 2022 by NanoString Technologies Germany GmbH.

Lis Pendens

The patent proprietor objected to the action on the basis of the lis pendens rules with respect to the prior German action. This objection was withdrawn at the oral hearing, but the Court considered that it was under obligation to nevertheless examine its international jurisdiction of its own motion since this was required under the Brussels I recast Regulation. Since the claimants in the UPC and German actions were not the same company, the Court considered that the situation did not fall under Article 29 of the Brussels I recast Regulation, which would require a mandatory stay. Instead, the case fell under the “related actions” provisions of Article 30 of the Brussels I recast Regulation, in which a stay is discretionary. The Court exercised its discretion to proceed with the action

and not order a stay, because it had been requested to do so by the parties who stated their wish to have legal certainty as soon as possible. Moreover, the proceedings were at an advanced stage and the case was ready for a decision, so the procedural benefit of a stay at this stage would be limited, while a decision from the German Bundesgerichtshof was not expected for at least a year. In addition, a stay would cause delay in respect of the countries covered by the patent other than Germany; while it would be possible in principle to stay only the German part of the UPC action, this would have little benefit in terms of procedural economy.

Validity

The Court construed the claim more broadly than contended for by the proprietor, and on that basis it considered that the claims as granted lacked novelty over the prior art of Göransson. This is a similar conclusion to that in the provisional injunction proceedings. In particular, the Court construed the term “sample” broadly according to the description of the patent. It rejected the proprietor’s argument that Göransson does not disclose the detection of analytes “in a sample” because the sample is genomic DNA and in Göransson it is not this genomic DNA that is fixed on the slides, but only laboratory-amplified fragments derived from the genomic DNA (termed ASMs) – the Court considered that the term “sample” in the claims was broad enough to include ASMs prepared from genomic DNA and fixed on a microscopic slide as disclosed by Göransson.

The Court consider eight auxiliary requests lodged with the defence to revocation, but declined to admit the further auxiliary requests filed later. Each of the eight auxiliary requests considered were acknowledged to be novel with regard to Göransson, but were considered to lack inventive step. The UPC noted that it had come to same conclusion as the Bundespatentgericht on essentially similar grounds. It was also noted that the conclusion was substantively in line with the findings of the UPC Court of Appeal in the NanoString/10x Genomics appeal which dealt with similar issues in respect of a related patent.[3]

Accordingly, the Court ordered that the patent be revoked in its entirety.

[1] <https://www.unified-patent-court.org/en/node/1200>

[2]

https://eip.com//knowledge hub/article/10x_genomics_not_successful_second_time_around/

[3]

<https://eipamar.com/en/knowledge hub/article/why did the court of appeal reverse the local division>