



# The House of Lords clarifies "inventive step": *Conor Medsystems Inc v Angiotech Pharmaceuticals Inc*

On 9 July the House of Lords gave judgment on one of the fundamental issues in UK patent law, namely, when can it be said that the concept set out in a patent contains the necessary inventive step for it to deserve a patent.

## RESTATING THE LAW ON "INVENTIVE STEP"

When exactly does the concept described in a patent contain the necessary inventive step for it to deserve a patent? The answer to this question determines whether the underlying invention is obvious. It would be thought that this seemingly simple question could be answered equally simply, yet it has caused much difficulty in practice in the patent offices and courts across Europe.

In this case the English Court of Appeal and Patents Court had both reached a different result to the Dutch District Court of The Hague on the same patent for a taxol-coated stent. The English Courts had revoked the patent as being obvious, whereas the Dutch Court had upheld it as having the necessary inventive step to be patentable. This difference in opinion arose because of differences in the approaches adopted by the two sets of Courts on the question of obviousness.

The House of Lords said that it was desirable that the European Patent Office and national courts in Europe (including the UK) should, so far as possible, all interpret the European Patent Convention the same way - subject of course to different procedural and evidential rules between countries.

The House of Lords held that correct identification of a patent's inventive concept is crucial, and preferred the Dutch approach to this. Angiotech's patent was therefore upheld as valid.

## IDENTIFYING THE INVENTIVE CONCEPT

Angiotech's patent was for a taxol-coated stent for the treatment of restenosis. This is a condition where there is further post-operative narrowing of arteries and blood vessels after insertion of a stent, caused by excessive cell growth).

### Ask a question

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The Court of Appeal had held the patent invalid as being obvious. It held that the inventive concept was no more than a proposal that taxol could usefully be used to prevent restenosis, and criticised the patent as containing no proper supporting experimental data. This was therefore obvious as it was an insufficient advance over what had been done before.

The House of Lords criticised this as the wrong approach. It was wrong to describe the patent's inventive concept in terms of a vague paraphrase based upon the extent of the disclosure in the patent's description. Had the Court of Appeal approached the matter properly, it should have seen that (fairly construed as a legal document) the specification did indeed put forward a taxol-coated stent as the answer.

The correct approach was to look at the claim to determine what the inventive concept was, as the claims defined the invention. The House of Lords said that the correct inventive concept was a taxol-coated stent for the treatment of restenosis. The patent was not obvious, as in fact the prior art taught away from the use of taxol.

The House of Lords held that there is no requirement that the specification must demonstrate by experiment that the invention will work or explain why it will work.

## PRACTICAL LESSONS

- The House of Lords has rescued the test for inventive step from the perils of analytical oversophistication, and restored it to first principles. Its test is clear and simple. This should lead to the UK Courts adopting a more patent-friendly approach on obviousness.
- This decision is another step by the House of Lords to align the UK approach to that of the EPO. It is notable that the approach taken by the Dutch District Court of The Hague was preferred to that of the English Court of Appeal.