

Inventive Concept

By James Wagner

When conducting an obviousness inquiry the framing of the inventive concept may drive the result. Canadian law post *Apotex Inc. v. Sanofi-Synthelabo Canada Inc.*, 2008 SCC 61 requires that the inventive concept is to be identified from the claim itself, and where that cannot be done, construed (from the patent as a whole). In practice judges appear to enjoy the ‘shortcut’ of construing a single inventive concept for the entire patent. This approach makes sense, as while patentability of each claim is distinct (S. 58) each patent should contain one invention (S. 36(1)).

If a Judge is construing a single inventive concept for the patent, the natural temptation will be to look not at the claim language but to the specification, and in particular the abstract.

Drafters may thus be encouraged to describe the inventive concept in a manner which both identifies the significance of the advance achieved by the patent, and highlights the difficulty involved (in terms of unexpected results, challenge to previous assumptions etc.)

This encouragement must be tempered though, so as to avoid manufacturing an inventive concept that doesn’t correspond to the historical reality of what the inventor(s) actually set out to achieve (or discovered). Both Canadian and UK Courts and the Patent Office have recently demonstrated that they will look into whether the identified inventive concept was a solution to a real problem, or a ‘sham’ problem.

Sanofi-Aventis has set up a “straw man” as the prior art never taught that povidone and poloxamer should be used with HCTZ. There is nothing inventive in finding a solution to a problem that never existed or where the solution was taught in the prior art (*SmithKline Beecham Pharma Inc. v. Apotex Inc.*, 2002 FCA 216 (CanLII), 2002 FCA 216).

Phelan J. at para 87, *Sanofi-aventis Canada Inc. v. Rathipharm Inc.* 2010 FC 230

There is no need and it would be wrong to re-formulate the problem as suggested by Mr Meade. This is not a case where some prior art unknown to the patentee has turned up. Nor is it right to reformulate the problem as one of looking for better medical effects when that was not the problem as seen by the patentee or to reformulate the solution as having found such effects when the patentee has not promised any.

Lord Justice Jacob at para 64, *Actavis UK Ltd v. Novartis AG*, [2010] EWCA Civ 82 at 54-66)

In Patent Appeal Board 1304 (June 17, 2010) the examiner argued that the inventive problem identified in the application was artificial. The Board found that while the problem proposed by

the Applicant did not rise to the level of a ‘sham’, the ‘problem’ was that it was not an ‘inventive concept’ in nature. Driving this analysis was the conclusion that the problem was not a technically challenging one, (which was easily solved by one skilled in the art once identified)’.

The Board made this determination in part due to the limited disclosure by the applicant on how to solve the problem. A simple sounding problem, with a solution left primarily to one skilled in the art, suggested a lack of invention.

The Board recognized that sometimes identifying the problem is itself inventive (citing *Bayer AG v. Novopharm Ltd.*, 2006 FC 379) but emphasized that this requires a factual inquiry. In the instant case, the Board found that the problem had not been identified more for lack of interest than ingenuity (as the facts suggested it was a minor ‘workshop improvement’ in an area that was not of interest to other inventors in the field, likely due to regulatory restraints’).