

## RAISING THE BAR FOR A TEST OF OBVIOUSNESS

ANGIOTECH VS CONOR

The House of Lords have upheld the UK designation of Angiotech's European Patent 706376B relating to a taxol coated stent. In doing so, they have reversed the original judgement of the Patents Court from 2006 and that of the Court of Appeal from early 2007 and agreed with the decision from the District Court of the Hague concerning the corresponding Dutch Patent. The House of Lords Decision while not providing any new clear direction on the assessment of obviousness, has laid to rest the concept of "obvious to try" previously used successfully in challenges to patentability.

### HISTORY

The patent was based on the observation that taxol possessed anti-angiogenic properties as assessed by the CAM assay. Although the application as originally filed embraced a broad concept encompassing the anti-angiogenic effect of taxol in the treatment of cancer, claims directed to such a use were excluded during Opposition Proceedings before the European Patent Office. The claim before the UK Court related to a stent coated with taxol "for treating or preventing recurrent stenosis".

In addition to their experts, Angiotech were able to rely upon a prior art review article stating that in spite of fifteen years of research into the prevention of restenosis, a satisfactory result had not yet been achieved. The article went on to suggest new approaches but these did not include the use of anti-proliferative

agents. Against this background, the experts differed as to whether taxol was a prospective candidate for the prevention of restenosis.

### THE TEST FOR OBVIOUSNESS

The case had succeeded before the Patents Court as the judge agreed with Conor's arguments that the invention was no more than a proposal that taxol was worth trying. This argument went as far as to state that they did not actually have to demonstrate that it was actually obvious to use taxol to treat restenosis because the patent itself failed to provide such teaching. The argument was criticised by Lord Hoffman as being "an illegitimate amalgam of the requirements of inventiveness and either sufficiency or support or both." His preference was to assess whether it was obvious to use a taxol-coated stent for the purpose of treating restenosis and, provided that the specification made this plausible, the Patentee may be entitled to such a claim.

In his analysis, Lord Hoffmann acknowledged that "it is true that the specification said very little about the details of how or why taxol would be efficacious in preventing restenosis. It clearly saw the solution for restenosis in terms of preventing angiogenesis, but offered no proof that this was right" (paragraph 22).

Conor had put this issue to the experts before the Patents Court. Under cross-examination, Angiotech's experts agreed that the patent specification did

not provide any demonstration that taxol or any of the other compounds would actually work to prevent or treat restenosis, or that

knowledge of the compound possessed anti-angiogenic properties would be of any advantage in concluding whether a compound would be useful in the treatment or prevention of angiogenic restenosis.

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## EDITORIAL

Welcome to the latest edition of our Patent Newsletter. The typically quiet months of July and August were livened up by the issue of the House of Lords judgement in *Conor Medsystems v Angiotech Pharmaceuticals*. This decision issued just after the printing of our last Patent Newsletter. An article of the decision is included in this edition.

D Young & Co continues to thrive with Kit Wong (Chemistry and Biotechnology Sciences Group) and Jonathan Jackson (Electronics and Mechanical Engineering Group) being appointed partners.

Since our last edition, the Legal 500 have also issued their annual results. D Young & Co have again been recommended with both patent and trade mark groups in the firm being ranked as 'top tier'. Further details of the basis for this ranking are included in this issue.

Just as we go to press we have an update on the computer technology cases reported in our June and August newsletters (available to view online at [www.dyoung.com/resources/newsletters.htm](http://www.dyoung.com/resources/newsletters.htm)). The Court of Appeal has issued a judgement dismissing the Appeal by the UK IPO against the *Symbian* Decision. See page 6 of this newsletter for further details.

We hope that you enjoy the articles in this issue and welcome any feedback that you may have.

DAVID ALCOCK

Conor thus succeeded before the Patents Court and Court of Appeal on the basis that *taxol* was an obvious candidate to try in an effort to identify a compound to treat or prevent restenosis on the assumption that this reached the legal threshold for demonstrating or for proving that an invention was obvious.

In reversing the decisions of the lower courts, Lord Hoffmann has somewhat raised the threshold for a successful obviousness attack.

Thus, looking at the claim, Lord Hoffmann understood that *"it is absolutely clear that the teaching of the specification, so far as it supported claim 12, is that a taxol coated stent would prevent or treat restenosis."* - this teaching being supported by the successful demonstration of *taxol* in the CAM assay.

Lord Hoffman continued in (paragraph 28) *"The question was whether that was obvious and not whether it was obvious that taxol (among many other products) might have this effect. It is hard to see how the notion that something is worth trying or might have some effect can be described as an invention in respect of which anyone would be entitled to a monopoly. It is therefore perhaps not surprising that the test for obviousness which Pumfrey J devised for such an "invention" was whether it was obvious to try it without any expectation of success. This oxymoronic concept has, so far as I know, no precedent in the law of patents."*

In raising the bar for a test of obviousness, many see this as bringing the UK assessment into line with that used at the EPO that it is not sufficient to succeed in an obvious attack to demonstrate a concept may be *"obvious to try"* but there must be *"a reasonable expectation of success"*.

This combination of the specification rendering the invention plausible in being sufficient to support a realistic functional outcome is further emphasised in paragraph 37 where Lord Hoffmann stated *"but there is in my opinion no reason as a matter of principle why, if a specification passes the threshold test of disclosing enough to make the invention plausible, the question of obviousness*

*should be subject to a different test according to the amount of evidence which the patentee presents to justify a conclusion that his patent will work."*

In essence, the different approach taken by Lord Hoffmann to that taken in the lower Courts can be understood to lie in the weight given to the data present in the patent specification in contrast to what was known at the priority date. According to Lord Hoffmann, as long as the invention is rendered plausible, this may be considered sufficient to support the claim and to justify an inventive step. The lower courts did not appear to be convinced that the patent achieved the stated aim and therefore the claimed use remained merely an obvious suggestion.

Upon reflection, the decision makes sense. If the patentee has presented sufficient data to support an inventive step – *"plausible"* in Lord Hoffman's words, the claim will be considered inventive unless the prior art provides an appropriate level of teaching that the skilled person would arrive at such an invention with a *"reasonable expectation of success"*.

Clearly, although a possible change in the threshold for obviousness, each case is going to be judged on its merits and the state of the art at the priority date. It is possible that on conducting such analysis, other aspects of the UK approach to obviousness may have to be adjusted. For example, while the UK Courts are reluctant to combine prior art teaching with anything more than what has been established as common general knowledge, there may now be an inclination to consider alternative supporting documents the person skilled in the art may have realistically considered in deciding what constituted an obvious step from a primary prior art reference.

Within the research community, this decision is likely to be considered as strengthening their position and providing further support for the early filing of patent applications based upon basic justification of an inventive concept and, provided this draws the invention far enough away from the prior art, an inventive step may be acknowledged.

NEIL NACHSHEN

# DOUBLE PATENTING ISSUES WITH DIVISIONAL APPLICATIONS

Patent offices around the world are becoming increasingly concerned about the number of divisional and continuation applications that are being filed by applicants. In part, these concerns arise from the increased workload that many of the major patent offices are experiencing. Concerns have also been expressed that the filing of multiple divisional and continuation applications may be viewed as an abuse of the patent system. These concerns led the US Patent and Trademark Office (USPTO) to attempt to introduce new rules in November 2007 to restrict the number of continuation applications that could be filed. However, an injunction was obtained to prevent these rules from coming into effect in the US and, currently, an appeal seeking to lift the injunction is pending.

In some jurisdictions divisional or continuation applications are routinely filed as a result of applicants taking a pragmatic approach to the protection that they can obtain. For example, patent offices sometimes indicate that claims with a restricted scope would be considered allowable. In reply, applicants often decide to limit the claims of the initial application to this restricted scope to obtain a granted patent, even though they do not agree with the patent office regarding what is allowable. At the same time, applicants may file a divisional or continuation application to argue for the scope of claim which they believe is allowable. In the past, the European Patent Office (EPO) tended not to raise any policy-based objections to such an approach. Instead, the EPO examined such divisional applications on the normal grounds for patentability set out in the European Patent Convention. However, more recently there appears to be a trend for the EPO to raise a policy-based double patenting objection to such an approach. Thus, it appears that the EPO, like the USPTO, is using the procedures available to it to solve workload issues and to address perceived abuses of the patent system.

The European Patent Convention does not have any provision that explicitly deals with the issue of double patenting. However, the basis for raising a double patenting objection, and the justification for it, may be found in the Guidelines for Examination in the EPO. These Guidelines state at section C-IV, 7.4 that *"it is an accepted principle in most patent systems that two or more patents cannot be granted to the same applicant for one invention"*. Hence, if the EPO believes there is a double patenting situation, the applicant is requested to either amend one or more of the conflicting applications so they do not claim the same invention, or to choose which one of those applications to proceed with.

One possible way of overcoming a double patenting objection is to add a disclaimer to the independent claims of an application to exclude the subject-matter claimed in the conflicting application. The EPO Boards of Appeal Decision T1139/00 (relating to European Application No. 89118420.2) confirmed that such a disclaimer, which is not disclosed in the application as filed, is allowable to overcome a double patenting objection. However, in some circumstances such disclaimers can lead to other objections. For example, in subsequent opposition proceedings the claims containing a disclaimer that were considered allowable in Decision T1139/00 were deemed not to be sufficiently enabled. This was because all of the examples in the specification used the disclaimed method and it was considered by the Opposition Division that the information contained in the patent, along with common general knowledge,

was not sufficient to enable a skilled person to carry out the invention. This decision is currently under appeal.

A key consideration for dealing with double patenting objections is whether or not the alleged conflicting applications relate to one invention. In Decision T0587/98 the Board of Appeal stated that there is no provision of the European Patent Convention that prohibits the claims of a parent application from including all of the features of the claims of a divisional application combined with an additional feature, even if this additional feature is an obvious variant. Hence, a possible alternative way of overcoming a double patenting objection is to argue that one of the applications has an additional feature and that the applications claim different inventions.

In conclusion, given the current trend of the EPO, when drafting the claims for a divisional application in Europe, consideration should be given to the possibility of double patenting objections and how they may be overcome.

MICHAEL  
SIMCOX





# NEW D YOUNG & CO PARTNER PROFILES



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Chartered Patent Attorney  
European Patent Attorney  
European Design Attorney

## SPECIALIST FIELDS

Pharmaceuticals/formulations, chemical synthesis, chemical processes and petrochemicals.

## TECHNICAL BACKGROUND

- BSc(Hons) in Chemistry, King's College London.
- PhD in Pharmaceutical Chemistry (design and synthesis of novel 5-HT1A receptor agents), University College London.
- Member of the Society of Chemical Industry.
- Certificate in Intellectual Property Law, Queen Mary & Westfield College, University of London.
- Chartered Patent Attorney 2002. European Patent Attorney 2002.

## PROFESSIONAL EXPERIENCE

- Experience in private practice since 1997.
- Joined D Young & Co in 2004.
- Experience in drafting and prosecuting EP and national patent applications, EPO oppositions and appeals.
- Experience in providing infringement opinions for generics companies.



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- MEng Electronic Engineering (Communications), University of Sheffield. Specialised in both telecommunications and solid state devices.
- Awarded the Sir Frederick Mappin Scholarship.
- Member of the Institution of Electrical Engineers.
- Certificate in Intellectual Property, Queen Mary & Westfield College, University of London.
- Chartered Patent Attorney 2005. European Patent Attorney 2005.

## PROFESSIONAL EXPERIENCE

- Worked in private practice and the Intellectual Property Department of a large Japanese multinational company since 1999.
- Joined D Young & Co in 2006.
- Extensive experience of drafting and prosecuting patent applications in many jurisdictions around the world as well as advising on Intellectual Property issues in a commercial environment.

## LEGAL 500 RESULTS

We are delighted to announce that D Young & Co has again been recommended by the Legal 500 as a top tier UK patent and trade mark practice.

The Legal 500 provides an annual assessment of UK law firms and advisors in order to provide independent advice to clients seeking the best firm for their work. In arriving at their recommendation of D Young & Co the Legal 500 (*source Editorial, The Legal500 2008 Edition*) considered a number of criteria, including:

- Most prestigious clients
- Individuals with the contacts at, and credibility with, the top clients
- In-depth capability
- Strength of technical ability available for the most complex work
- Capacity for substantial transactions/cases
- Market share
- Historical track record on top deals/cases
- Clear investment for the future in particular practice areas
- Progress made acquiring new clients/marketshare
- Strength in associated areas
- Reputation for handling complex, innovative deals
- Capacity to handle all client requirements
- Commitment to IT and the use of IT to improve client services
- Perception in the market

**We would like to thank our clients and associates for their positive comments and contributions to this year's Legal 500 review.**

## OUT AND ABOUT

### MOBILE REFERENCE DESIGNS CONFERENCE, BRUSSELS, BELGIUM 4-5 NOVEMBER 2008

Jonathan DeVile will be giving a presentation on 'Unlocking the Patent Debate - Examining the Changing Landscape & Adjusting to Change'.

### BIO EUROPE, MANNHEIM, GERMANY 17-19 NOVEMBER 2008

Aylsa Williams and Simon O'Brien will be attending the BIO Europe 2008 conference.

### CIPA BIOTECHNOLOGY CONFERENCE, NOTTINGHAM, UK 27-29 NOVEMBER 2008

Aylsa Williams, Louise Holliday and Robert Dempster will be attending the CIPA Biotechnology Conference.

### FICPI JAPAN SYMPOSIUM, YOKOHAMA, JAPAN 4-5 DECEMBER 2008

Jonathan Jackson will be attending the FICPI Japan Symposium.

# TO AMEND, OR NOT TO AMEND?

Picture the scene. You have received a Communication issued under Rule 71(3) EPC telling you that the European Patent Office (EPO) intend to grant a patent. You are initially excited; you spent a lot of effort crafting a set of claims and arguments, of which you should be proud. You open the Communication. Wait a moment, the Examining Division have written all over the claims...

In some cases, the EPO propose amendments to the claims in the Communication issued under Rule 71(3) EPC. This is becoming increasingly common. Sometimes these are minor and are not particularly limiting. Other times, they are quite restrictive and do not meet with your requirements. A recent decision, T1093/05, has been issued by the EPO Board of Appeal which relates to when an applicant disapproves of the amendments proposed by the Examining Division.

In this particular case, the only amendments made to the application papers were those suggested by the EPO in a Rule 71(3) EPC Communication (which, at the time, was a Rule 51(4) EPC Communication). The applicant did not agree with those suggestions. Therefore, the applicant asked that the patent be granted on the basis of the original unamended claims and the

translations of the original un-amended claims were filed on 4 November 2003. The Applicant also paid the appropriate fees.

The Decision to Grant document subsequently issued by the EPO included the phrase *"The modifications subsequently requested by the Applicant and received at the EPO on 00.00.00 have been taken into account"*. The patent was published without the amendments requested by the applicant.

At this stage the applicant contacted the Examining Division and asked that the Decision to Grant be corrected under former Rule 89 EPC (now Rule 140 EPC). This Rule allows for errors in decisions of the EPO to be corrected. However, this Rule is expressly limited to the correction of linguistic errors, errors in transcription and obvious mistakes. The Division refused the request for correction because it said that it had not seen the amendments made by the applicant and so on the day of the Decision, the Division had intended to grant the patent on the basis of the text of the Rule 51(4) EPC Communication. The Division did acknowledge that there was a procedural error (in that the Division should have seen the amendments proposed by the applicant), but that this was not correctable using former Rule 89 EPC.

The applicant appealed and argued that the Decision to Grant, which included the phrase *"The modifications subsequently requested by the applicant and received at the EPO on 00.00.00 have been taken into account"* should have read *"The modifications subsequently requested by the Applicant and received at the EPO on 04.11.03 have been taken into account"*. The applicant argued that this was an obvious mistake because the only amendments ever filed by the applicant on this case were those filed on 4 November 2003.

The Board of Appeal did not

agree with the applicant. The Board felt that the applicant could not assume that the Division had agreed to the amendments provided by the applicant. Instead the Board felt that it was apparent that a mistake had been made by the EPO; namely that either the amendments were taken into account without changing the date on the Decision to Grant or that the amendments had not been noted. Either way, it the applicant should have looked into the mistake. The Board went on to say that because the text had not been approved, then a procedural violation of Art. 97(2)(a) EPC had taken place and if the applicant wanted this to be set aside, the applicant should have filed an Appeal on this ground. As the Division was bound by the Decision (even if this was a procedural violation), the only way that can be set aside is by the applicant filing an admissible, allowable appeal against the Decision. However, the applicant did not do this in this case.

So, what can be taken from this Board of Appeal Decision?

If the Examining Division do propose amendments in the Rule 71(3) EPC Communication that are not to your satisfaction as applicant, you should inform us as soon as possible. It should be possible to discuss satisfactory claims with the Division before we need to file translations. This would ensure that the Division were at least aware that you were not happy with their proposals.

Also, the Board did mention in the Decision (in paragraph 13), that the Examining Division should make only such amendments in a Rule 71(3) EPC Communication as it can reasonably expect the applicant to accept. Although this is vague, it is a step in the right direction. Previously, this phrase was only in the Guidelines which the Examiners use as guidance rather than in law to which the Examiners should abide. This means that Examiners should now refrain from proposing unreasonable amendments. We will have to see if this happens.

JONATHAN JACKSON

# APPEAL OF UK IPO AGAINST SYMBIAN DECISION DISMISSED

A judgement of the Court of Appeal issued on 8 October 2008 dismissed the Appeal by the UK Intellectual Property Office (UKIPO) against a Decision of Mr Justice Patten. Mr Justice Patten, in the High Court, had allowed an appeal by Symbian Ltd against the UK IPO's decision to refuse UK Patent Application No GB 0325145.1. The application had been refused on the ground that the invention was excluded from patentability under Section 1(2) of the UK Patents Act 1977 as being a program for a computer.

The invention at issue relates to mapping dynamic link libraries (DLLs) in a computing device. DLLs were already known as a means of storing functions common to a number of different applications. The problem related to difficulties encountered when parties add further functionality to a DLL (for example by an upgrade of the operating system and by an additional piece of hardware) independently of each other. The claimed solution splits a DLL into two parts, the first part being effectively a fixed part and a second, extension, part enabling the addition of further functions at further locations.

The Court of Appeal reviewed past decision of the UK Courts and the EPO Boards of Appeal in reaching its decision and held [at § 58]:

"Therefore, it must mean, consistently with Vicom and the two IBM Corp. cases, that a technical innovation, whether within (as in the last-mentioned cases) or outside the computer will normally suffice to ensure patentability (subject of course to the claimed invention not falling foul of the other exclusions in art 52(2))."

The full decision is published at  
[www.bailii.org/ew/cases/EWCA/Civ/2008/1066.html](http://www.bailii.org/ew/cases/EWCA/Civ/2008/1066.html).

IAN HARRIS

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To subscribe to the D Young & Co patent newsletter please contact Mrs Rachel Daniels, Business Development Manager, at our Southampton office address (see details, left), or by email at [rjd@dyoung.co.uk](mailto:rjd@dyoung.co.uk)

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