

## The UK Moves Obviously Closer To Europe

Success for Forresters as the House of Lords upholds the appeal in *Conor vs. Angiotech*

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### **Summary**

On 9 July 2008, the House of Lords overturned the first and second instances finding of obviousness in European Patent (UK) number 0706376. In doing so, they have moved the principles for assessing inventive step in the UK closer to those applied by the European Patent Office. Forresters are delighted to have been part of the legal team representing the patentees in this landmark decision.

### **A bit of background**

Coronary heart disease is caused by a narrowing or blocking of the coronary arteries, called a stenosis. If not treated, the stenosis can result in complete blockage of the artery leading to a heart attack. By the late '80s a common way to treat this problem was to push the artery open by inflating it with a balloon, and then holding it open with a metal scaffold called a stent. Unfortunately, in many cases the stent triggered an exaggerated healing response by the walls of the artery, which grew back through the stent and blocked the artery again. This condition is known as restenosis.

### **The Patent**

European patent (UK) number 0706376 (to Angiotech Pharmaceuticals Inc and the University of British Columbia) claimed a stent which eluted paclitaxel to prevent restenosis. The patent teaches that restenosis can be prevented by preventing the growth of local blood vessels (angiogenesis). The inventors had discovered, in experiments, that paclitaxel, a recently discovered cancer drug, had remarkable anti-angiogenic properties. They concluded from this that it could prevent restenosis when delivered from a stent. The claimed stent is sold as the "Taxus" stent. It is a great commercial success.

### **The Case**

The European patent (UK) was challenged in the UK Patents Court by Conor Medsystems Incorporated. The only ground of alleged invalidity was that the claimed stent was obvious.

## **The Judgements of the UK Patents Court and Court of Appeal.**

Conor argued that the patent did not teach that the stent actually worked in preventing restenosis. They argued that, because of this, the test for obviousness was not whether the worker in the field would find it obvious that taxol on a stent would treat restenosis, but whether that worker would find it obvious to test the combination, without any expectation of success.

The Patents Court accepted Conor's argument. The Judge agreed that, because the application did not actually show that paclitaxel would prevent restenosis, there was no need to decide if one might expect it to succeed.

The Court of Appeal agreed with the judge in the Patents Court and upheld his decision.

Angiotech were allowed to appeal to the House of Lords. The House of Lords is the highest court in the UK, and so the supreme court of appeal. It decides on points of law rather than the facts of an individual case and its decisions are binding on all courts below it.

## **The House of Lords**

The House of Lords upheld Angiotech's appeal, and found that the claimed stent was inventive, using the proper test for obviousness. A number of important findings on the law of obviousness come from the decision. The overall tenor of the decision moves the UK law closer to the practice of the European Patent Office in assessing obviousness.

The Lords confirmed that inventive step must be decided on the claimed invention and the disclosure in the application has nothing to do with this assessment. In other words, the court must decide whether the subject matter of the claims is obvious, and the content, or otherwise, should not affect this decision.

However, the Lords also followed recent practice of the European Patent Office, as exemplified by [T 1329/04](#).

They confirmed that, before considering inventive step, the patent must pass a "threshold test" of plausibility. In that test, the court reviews the whole specification and decides whether, on the basis of the specification alone, it is plausible that the invention will work. The Lords found it plausible that the claimed invention would work to treat restenosis, based on the data and teaching in the specification.

Finally, the Lords confirmed that the court must assess the obviousness of the claimed invention in the light of the purpose for which it is intended. The court should also take into account the expectation of success that the skilled person would have of achieving that purpose with the invention. Both of these principles are followed by the European Patent Office. The Netherlands court also applied them in parallel proceedings, which was noted with approval by the Lords. Lord Hoffman described the idea of assessing whether something is obvious to try without an expectation of success (the test applied in the Patents Court) as an "oxymoronic concept", with no precedent in patent law.

The Lords held that the claimed stent was inventive, in that a skilled person would not have tried it with any reasonable expectation that it would be effective to treat restenosis. In doing so, they have moved the UK approach to obviousness significantly closer to that taken by the European Patent Office.

You can read the text of the full decision [here](#).

*Forresters (Jon Gowshall and Ross Walker) were the patent attorneys in the team that took the European Patent (UK) through the courts to the successful conclusion at the House of Lords. Jon was also the representative who took the patent to grant at the EPO and Jon and Ross successfully appealed the first opposition and maintained the patent in the second opposition proceedings. Please do not hesitate to contact Jon ([jgowshall@forresters.co.uk](mailto:jgowshall@forresters.co.uk)) or Ross ([rwalker@forresters.co.uk](mailto:rwalker@forresters.co.uk)) if you have any questions concerning the impact of this landmark decision.*