

Suggested Answers to the Questions in Chapter 17

1. Think back to the problem in Chapter 15 (introduction to patents). Could you give more detailed advice now that you know more about the criteria for patentability?

The good answer will:

- Demonstrate, following on from the conclusion of Chapter 15, an advanced understanding of the Chapter 15 problem in line with the criteria for patentability – the five core elements: three positive and two negative.
- Note that in terms of the positive requirements, for an invention to be patentable, it must possess novelty (it must be new), inventive step (it must possess something that is not obvious in the field of technology), and industrial applicability (it must have some practical usefulness). Regarding the negative criteria, the invention must not consist of excluded subject matter—it must not be a mere discovery; an aesthetic creation; a scheme, rule or method for performing a mental act, playing a game or doing business, or a program for a computer; or a presentation of information. It also must not fall foul of any of the exceptions to patentability: (i) morality, (ii) plant/animal varieties and biological processes, and (iii) methods of treatment.
- Looking again at the facts of the problem at the beginning of Chapter 15 – John’s invention – the question is whether his invention is patentable or not. Key would be the skilled addressee’s view of his invention in the context of the prior art.
- Regarding the negative criteria, there does not seem to be any reason to suggest that his invention covers excluded subject matter – and neither is there any moral objection.
- Turning to the positive criteria, is this truly a ‘new’ invention? Is John really the first person to have invented skateboard braces for using a board on grass? Does the fact that he tests the invention have a potential impact on novelty i.e. has it been anticipated? Anticipation occurs where the prior art contains an enabling disclosure. This comprises two separate issues which must be dealt with sequentially, namely disclosure and enablement: *Synthon BV v Smithkline Beecham plc*. John, with his patent attorney, will need to engage in a prior art search. He must search prior documentation (*Van der Lely v Bamfords Ltd*; *Lang v Gisbourne*; *Bristol Myers Application*). The invention will also need to be novel in terms of prior use (*Windsurfing International Inc v Tabur Marine*) - and it is here that John may face difficulties because he tested the invention in public – did that cause anticipation? If John is confident that neither this display, nor any other prior art, would have taught the ‘skilled addressee’ (*Lux Traffic Controls v Pike Signals*) the invention, the application would proceed to inventive step.
- Would the skilled addressee think it merely an obvious thing to do? Inventiveness

covers the contribution to the state of the art—whether it is qualitatively different from what has been done before, or merely an obvious step. Inventiveness is a question of fact to be decided objectively and without hindsight (*Lilly Icos Ltd v Pfizer Ltd*; *SEB SA v De'Longhi SpA*). Following on from *Windsurfing International v Tabur Marine*, the traditional test was established in *Pozzoli SpA v BDMO SA*. The court should:

- (i) identify the notional person skilled in the art and their common general knowledge;
- (ii) identify the inventive concept of the claim in question, or if that cannot readily be done, construe it;
- (iii) identify the differences between the matter cited as forming part of the state of the art and the inventive concept;
- (iv) consider, when viewed without any knowledge of the alleged invention as claimed, do those differences constitute steps which would have been obvious to the person skilled in the art or do they require any degree of invention?

We can note that this was modified somewhat in *Teva*, and also contrast it with the EPO's problem/solution approach, though note that the same result will occur in most cases. At present, we do not have access to all of the prior art, nor are we a skilled addressee, but the indications are that John's creation could possess an inventive step. There's nothing in the facts of the problem to indicate that what he has done is obvious. Nor is there any reason to think sufficiency could be a problem.

- Finally, we can advise John that his invention is likely to possess industrial applicability. His invention is not merely speculative (*Duckworth*) and recent UKSC case law (*Eli Lilly v Human Genome Sciences*) indicates that this criterion should be interpreted broadly.

Suggested Answers to the Questions in Chapter 17

2. Why is there such an emphasis on an invention being 'new' under patent law?

The good answer will:

- Begin by noting the justifications for patents – what are the key theories that justify why we grant patents? How does e.g. the economic theory explain why only new inventions should be protected?
- Demonstrate knowledge of the theories that justify patent protection and their relationship novelty. There is a 'moral' justification based on the assertion that there is a natural property right in (new) ideas. Appropriation of such ideas is therefore tantamount to stealing (Lockean theory). The second argument is that justice and fairness demand that there should be a reward for the provision of new services useful to society – this justifies a temporary monopoly for the patentee (Adam Smith, John Stuart Mill and Jeremy Bentham). The third argument is that patents are necessary to secure economic development - the incentive of patent protection is necessary to ensure that new inventions are created. The fourth justification is the 'exchange for secrets' theory – new inventions are published via the patent system.
- Engage with the academic commentary (Lemley, Thambisetty, Merges and Neson, etc.) and the question of whether new inventions should be protected and how this occurs through the law.
- Refer to the novelty requirement and case law (*Synthon BV v Smithkline Beecham plc.*; *Van der Lely v Bamfords Ltd*; *Lang v Gisbourne*; *Bristol Myers Application*; *Windsurfing International Inc v Tabur Marine*; *Lux Traffic Controls v Pike Signals*) in assessing the importance of 'newness' in patent law.
- Conclude by summarising why new inventions are incentivised by the patent system.

Suggested Answers to the Questions in Chapter 17

3. Is it time to move away from the Pozzoli test entirely and embrace the EPO view on inventive step?

The good answer will:

- Focus on inventiveness as one of the criteria of patentability – covering the contribution of the invention to the state of the art— i.e. whether it is qualitatively different from what has been done before, or merely an obvious step.
- Explain that inventiveness is a question of fact to be decided objectively and without hindsight (*Lilly Icos Ltd v Pfizer Ltd*; *SEB SA v De'Longhi SpA*). Following on from *Windsurfing International v Tabur Marine*, the traditional test was established in *Pozzoli SpA v BDMO SA*. The court should:
 - (i) identify the notional person skilled in the art and their common general knowledge;
 - (ii) identify the inventive concept of the claim in question, or if that cannot readily be done, construe it;
 - (iii) identify the differences between the matter cited as forming part of the state of the art and the inventive concept;
 - (iv) consider, when viewed without any knowledge of the alleged invention as claimed, do those differences constitute steps which would have been obvious to the person skilled in the art or do they require any degree of invention? We can note that this was modified somewhat in *Teva*.
- Contrast this UK text with the EPO's problem/solution approach, which has benefit of greater clarity of expression, though note that the same result will occur in most cases. Engage with academic commentary e.g. Vaver.
- Conclude by restating your argument in clear terms and answering the following question – should the UK merely follow the EPO approach or is this ultimately unnecessary?