

Patenting new uses of known technologies

As technologies progress, it is becoming more common for people and companies to look for solutions within the realms of available knowledge, rather than developing new technologies from scratch. Often a known technology from one field when used in a completely different area can deliver surprising results. With those surprising results often come new patents.

In the medical industry, the second pharmaceutical use of a known compound or medicament is well documented. These types of patents have been around for a number of years, and are often referred to as having “swiss-type“ claims. One of the classic examples of this is the new use of Aspirin™ as an anticoagulant and anti-inflammatory treatment. This was considered a new medical use over and above the traditional known use for alleviating headaches. As such, patents were awarded for the new use of the known drug, Aspirin™.

Outside the medical profession, similar situations arise, but across a broad spectrum of technologies. The question becomes where to draw the line between what would be an expected use of a known technology and what would be a use that is different enough to be entitled to a monopoly of twenty years?

A recent decision in Europe provides some guidance as to how such a decision can be made. The general criteria in such a situation is a patent for a new use of a known technology would not be allowable if it is “obvious to a person skilled in the art” to combine those two technologies.

The decision above refers to the case of *Schlumberger Holdings Ltd v Electromagnetic Geoservices AS* (EMGS) [2010] EWCA Civ 819, which questioned the validity of European Patent EP 1309887.

EP 1309887 was held by EMGS and covered the use of controlled source electromagnetics (CSEM) to determine the difference between oil and water in a deep water geological formation. While CSEM was a well known technique, it had never before been applied to the use of deep water oil exploration. Revocation of the patent was sought on the grounds that the combination of these two separate skills was obvious to “a person skilled in the art” and therefore unpatentable.

In making his decision Lord Justice Jacob pointed out that the person skilled in the art for obviousness is not the same person skilled in the art for performing the invention once it has been made. Specifically, he stated that;

"I think the flaw in [assuming that the skilled person is the same in each case] is to assume that “the art” is necessarily the same both before and after the invention is made. The assumption may be correct in most cases, but some inventions are themselves art changing. If a patentee says “marry the skills of two different arts to solve a problem,” marrying may be obvious or it may not. If it is not, and doing so results in a real technical advance then the patentee deserves and ought to have, a patent. His vision is out of the ordinary.

In the case of obviousness in view of the state of the art, a key question is generally “what problem was the patentee trying to solve?” That leads one in turn to consider the art in which the problem in fact lay. It is the notional team in that art which is the relevant team making up the person skilled in the art. If it would be obvious to that team to bring in different expertise, then the invention will nonetheless be obvious. Likewise if the possessor of the “extra expertise” would himself know of the other team’s problem.

But if it would not be obvious to either of the notional persons or teams alone and not obvious to either sort of team to bring in the other, then the invention cannot fairly be said to be obvious. As it was put in argument before us the possessors of the different skills need to be in the same room and the team with the problem must have some reason for telling the team who could solve it what the problem is."

Following these comments, it was found that the patent was valid and not obvious, as before the priority date of the patent it had not occurred to either industries to marry their skills together.

In New Zealand obviousness is currently not assessed when the acceptance of a patent is decided. However, it is a valid reason for either opposing or revoking a patent and therefore should still be considered when submitting a new patent application.

The Draft Patents Bill proposes to introduce an assessment of obviousness during the examination stage of all new patent applications. This will fall within the requirement for all applications to be "inventive", that is non-obvious.

This decision, while not a binding precedent in New Zealand, provides a useful guideline as to what may or may not be considered obvious when assessing the patentability of two known technologies for a new use.

For those in the natural products industry, this decision is a useful guideline in determining whether a new concept may end up being patentable. Natural products by their very nature are known ingredients, and inventiveness may lie in applying those products in areas where their usefulness has previously been unknown. Thinking outside the box of where your products are traditionally utilised may result in some lucrative and rewarding results.

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