

**EIP**

# Advanced Bionics v Med- El – Court of Appeal upholds invalidity of patent

This case concerns European Patent EP 3138605, relating to a cochlear implant, modified to allow the wearer to undergo MRI scanning. A cochlear implant is a small electronic device that assists a person who is profoundly deaf to perceive sound, and is in part surgically implanted under the skin. The implant contains a magnet, which experiences torque when subjected to the strong magnetic field of an MRI machine, which could cause tissue damage to the patient.

The claimed modification to enable a cochlear implant to be compatible with MRI involved a disk-shaped diametric magnet in a particular orientation. A diametric magnet is one where the poles of the magnet are at opposed edges of a disk, whereas in an axially magnetised magnet the poles are at opposed faces. The magnet is rotatable, so that it can align with the magnetic field of an MRI machine and so avoid experiencing the torque. The type and orientation of the magnet in the device according to the invention differed from that in the prior art document, Zimmerling.

At first instance, the Deputy High Court Judge Campbell Forsyth found that the patent lacked inventive step over Zimmerling, considering that it would have been obvious to the skilled person to modify Zimmerling by employing a disk-shaped diametric magnet as claimed. The patentee appealed and raised a number of criticisms of the judge's reasoning, but Lord Justice Arnold, with whom the other two appeal judges agreed, found none of these criticisms to be justified.

In the meantime, the Board of Appeal of the European Patent Office had held that the patent was NOT obvious having regard to Zimmerling. Arnold LJ rejected the suggestion that this meant that the first instance judgment must be incorrect, stating:

“It often possible for two tribunals faced with a finely-balanced issue as to obviousness to reach opposing conclusions without either tribunal making an error. In the present case, the Board of Appeal did not have the evidence of the expert witnesses as to the common general knowledge which was before the judge. For example, there is no mention in the Board’s decision of the fact that it was common general knowledge that a diametrically magnetised magnet can be rotated by an external magnetic field. Nor is there any discussion of the reasons accepted by the judge as to why, based on their common general knowledge, the skilled team would want, if possible, to retain the conventional disc-shaped internal magnet. Thus the fact that the Board reached a different conclusion is more than sufficiently explained by the fact that it did not have the same evidence as the judge.”

Darren Smyth, Head of Knowledge