

Practice Notice on Obviousness

November 2, 2009

Overview

On November 6, 2008, the Supreme Court released its judgement in the case *Apotex Inc. v. Sanofi-Synthelabo Canada, Inc.* [2008 SCC 61].

In its reasons, the Court commented on the approach to obviousness in Canada, concluding that the inquiry into obviousness is not well served by attempting to rigidly apply any one test in all circumstances.

The Court considered recent jurisprudence in both the US and UK, and concluded that the approach known in the UK as *Windsurfing/Pozzoli* will be useful for framing an obviousness inquiry. [The approach is so-named for having been introduced in *Windsurfing International Inc. v. Tabur Marine (Great Britain) Ltd.* [1985] R.P.C. 59 (C.A.) and refined in *Pozzoli SPA v. BDMO SA* [2007] EWCA Civ 588.]

The four-step approach to obviousness adopted by the Court is as follows:

- (1) (a) Identify the notional “person skilled in the art”;
(b) Identify the relevant common general knowledge of that person;
- (2) Identify the inventive concept of the claim in question or if that cannot readily be done, construe it;
- (3) Identify what, if any, difference exists between the matter cited as forming part of the “state of the art” and the inventive concept of the claim or the claim as construed;
- (4) 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?

Steps (1) to (3) establish the context within which, at step (4), the question of whether or not the claimed invention is obvious is asked. The Court’s comment regarding attempting to rigidly apply any one test refers to the analysis performed at step (4). Whatever test is applied, if the claimed subject-matter is found to be the result of any degree of ingenuity, it will not be considered obvious.

The Court further indicated that, under certain circumstances, the question of obviousness can be considered by asking, in step (4), whether it would have been “obvious to try” a certain line of inquiry that would inevitably lead to the claimed invention (see part B of this notice).

Impact on examination

A - Framing the obviousness inquiry

In analysing whether claimed subject-matter satisfies the requirement in section 28.3 of the *Patent Act*, Canadian examiners will henceforth be guided by the four-step approach enumerated above. During examination, however, the steps need not be explicitly addressed unless doing so is relevant to the objection in suit. Depending on the fact circumstances of the case, certain steps may require little or no explicit consideration. Where the course of prosecution dictates a need, a more rigorous consideration of each step may be developed. Where an impasse appears to be developing between the examiner and applicant, it is important that all the points of disagreement be identified and considered prior to the writing of a final action.

Examiners will adhere to the following guidance regarding the steps set out by the Court (the numbering provided refers to that used in enumerating the steps in the approach, above):

- (1)(a) Where necessary, examiners will identify the person skilled in the art by reference to the field or fields relevant to the invention, and where applicable by reference to attributes such as their proclivity for engaging in research or experimentation (see part B, below). In circumstances where the nature of the person skilled in the art does not appear to be debatable or where it does not appear that their nature will impact the obviousness analysis, it may not be necessary to explicitly address this step.
- (1)(b) Examiners, in formulating objections, may refer to information they believe to have been common general knowledge as of the claim date. Unless it becomes evident through the applicant's comments that the nature of the common general knowledge is not common ground and is reasonably in dispute, an examiner need not identify documents establishing the common general knowledge.
- (2) The identification of the inventive concept is performed on a claim-by-claim basis, recognising that the specific inventive concept of each claim can (and should) be a refinement of the single general inventive concept that must link the claims as a whole in order to satisfy section 36 of the *Patent Rules*. The relevant inventive concept is that of the claim under examination, and not a generalised inventive concept derived from the specification as a whole.

The inventive concept of a claim, at this step of the inquiry, is identified without regard to the prior art. It is the essence of the claimed invention and can generally be identified by approaching the matter of the claim as a solution to whatever problem the inventors have set out to address, and relates to those elements of the claim that were described, or which would be recognised by the

person skilled in the art, as providing the solution to a given problem. In identifying the problem that the inventors set out to address, and the solution proposed through the invention, guidance will generally be found in the description, in accordance with paragraph 80(1)(d) of the *Patent Rules*.

The concept of “solving a problem” should be understood in the context of “achieving the objects of the invention” and “fulfilling the purpose of the invention”. It is worth reiterating that identifying the problem being addressed is done in the context provided by the description, and not by reference to the closest prior art. This exercise is not to be confused with the “problem and solution” approach to obviousness used by the European Patent Office, which frames the problem in view of the closest prior art.

The inventive concept may be clear from the language of the claim itself, where the purpose of the claimed matter is explicitly defined. This would be particularly likely in the case of a claim presented in the European or Jepson format. Where it is not clear from the language of the claim itself what problem is being solved by the claimed matter, the remainder of the specification is consulted to assist in identifying the inventive concept of that claim.

- (3) At this step, the inventive concept (the solution in the claim) identified in step (2) is compared to the state of the art to determine whether, or to what extent, an equivalent or similar inventive concept (solution) was known at the claim date. The term “state of the art” refers to the information available to the person skilled in the art in accordance with section 28.3 of the *Patent Act*, and generally will be identified by reference to specific prior art documents.
- (4) Where differences exist between the inventive concept embodied in the claim and the state of the art, it must be determined if these differences would have been obvious as of the claim date. This must be done without presupposing that the specific problem addressed by the inventors was recognized in the prior art. This is important to avoid adopting an improper “hindsight” perspective; where the existence or nature of a problem was unobvious, identifying the problem can contribute to the necessary inventive step. Note that should no difference be identified between the inventive concept and the state of the art, the claim is most likely defective.

At step (4) it must be determined whether the subject-matter of the claim is obvious or is the result of ingenuity. Various tests have been articulated in the jurisprudence in order to answer this question, and the Supreme Court has cautioned that no single expression of this test is likely to apply to all circumstances. Although the test question may be framed taking into account the nature of the specific case in question, one must never lose sight that its purpose is to evaluate the statutory requirement of section 28.3 of the *Patent Act* and care should be taken to ensure the question is not phrased in such a way that a different standard is applied. The test articulated in *Beloit Canada*

Ltd. v. Valmet Oy [(1986), 8 C.P.R. (3rd), 289 (F.C.A.)], for example, is not to be viewed as mandatory although it may be relevant in certain situations.

The Office considers the guidance affirmed by the Federal Court of Appeal in *Novopharm Limited v. Janssen-Ortho Inc.* [2007 FCA 217] to remain relevant in view of the guidance of the Supreme Court in *Sanofi-Synthelabo*. Particularly, the obviousness inquiry should be framed in the context of:

- (i) the climate in the relevant field at the time the alleged invention was made, including not only knowledge and information available but also attitudes, trends, prejudices and expectations that would define the person skilled in the art; and
- (ii) any motivation in existence at the time of the alleged invention to solve a recognized problem in the field of the invention.

B - “Obvious to try” considerations

The Supreme Court noted that, in “areas of endeavour where advances are often won by experimentation”, it may be appropriate to ask whether the claimed subject-matter is obvious because the route to the invention would have been “obvious to try”. Patent examiners will henceforth consider whether “obvious to try” is a relevant consideration in determining the obviousness of claimed subject-matter.

The Court provided several factors as being applicable, depending on the nature of the specific case under consideration, in determining whether the matter of a claim would have been “obvious to try”. The factors set out by the Court, with the caution that the list is not exhaustive, included:

- (A) Is it more or less self-evident that what is being tried ought to work? Are there a finite number of identified predictable solutions known to the person skilled in the art?
- (B) What is the extent, nature and amount of effort required to achieve the invention? Are routine trials carried out or is the experimentation prolonged and arduous, such that the trials would not be considered routine?
- (C) Is there a motive provided in the prior art to find the solution the patent addresses?

Where the questions (A) and (C) can be answered in the affirmative, and the conclusion at item (B) is that the matter of the claim would be arrived at by routine trials that were not prolonged and arduous, it can be concluded that the subject-matter of the claim is obvious since it would have been “obvious to try” to identify the claimed matter from among a finite number of likely solutions one of which more or less self-evidently ought to work.

Little guidance exists as to which areas of endeavour are those in which advances are often won by experimentation. In cases where “obvious to try” considerations are not

appropriate, it is extremely unlikely that the various factors of the approach could be satisfied. Where there are a finite number of identified, predictable solutions known to the person skilled in the art and a motivation provided in the prior art to find the solution the application addresses, it can be presumed that one is in an area of endeavour where advances are often won by experimentation. The “threshold” question of whether “obvious to try” is applicable is considered to be inherently addressed when the factors of the test itself are considered.

Where an “obvious to try” approach is deemed appropriate, the Court provided several factors that should be considered, with the caution that the list is not exhaustive. Framed as questions to be asked when assessing compliance with section 28.3 of the *Patent Act*, these are:

- (A) Is the person skilled in the art aware, in view of the prior art and their common general knowledge, that a limited number of predictable and identifiable solutions exist to the same or a similar problem, such that they would believe that one of those solutions more or less self-evidently ought to work to solve the problem being addressed?

It is not necessary that it be obvious which of the limited number of solutions would solve the problem, nor which is best suited to this purpose, but if the claimed solution is unrelated to this limited number of predictable and identifiable solutions a conclusion of “obvious to try” is unlikely to be warranted.

- (B) Could the person skilled in the art be expected to arrive specifically at the solution claimed, starting from the limited number of solutions conceptually identified in step (A), without inventive step or undue burden? That is, would the solution be arrived at by routine and predictable methods, and without requiring prolonged and arduous effort.
- (C) Does the person skilled in the art, in view of the prior art, have a motive to find the solution the patent addresses?

While the existence of motivation, in the broadest sense, to solve problems in the area of endeavour through scientific inquiry may be enough to justify an “obvious to try” inquiry, a more specific motivation to work along similar lines to the inventor is necessary to sustain a conclusion that the claimed invention was “obvious to try”. The person skilled in the art must have been motivated to conduct experiments in the area of the invention, aimed at solving the same or a similar problem to that addressed by the inventor by identifying a solution such as that defined in the claim under consideration.

As noted above, the attitudes, prejudices and expectations of the person skilled in the art, and their awareness of the trends in their field, are relevant factors to consider in this regard, and are assessed in light of the state of the prior art.

It should be remembered that “obvious to try” considerations are used to determine whether the subject-matter of a claim is the result of ingenuity and, by consequence, is unobvious. Factors (A) to (C) might be thought of as asking whether it was obvious to search for a solution to the problem addressed by the inventors (the motivation factor) and whether the route to the claimed subject-matter was also obvious. If there was no invention in either conceiving of the solution nor reducing it to a practical form, the claimed subject-matter is not the result of an inventive step and is therefore obvious.

The Office considers that assessing whether the route to the invention was “prolonged and arduous” must be evaluated objectively by the examiner, taking into account the nature of the person skilled in the art and the knowledge and climate in the relevant field or fields existing at the claim date. The subjective experience of the inventors will not be considered relevant unless it can be established that it reflects that expected of the hypothetical person skilled in the art.

C - Impact on cases under prosecution

Examiners will henceforth assess obviousness in view of the guidance set forth herein, and will present obviousness objections where necessary, regardless of the prior prosecution of the application. Examiners will not, however, systematically review cases that have been approved for allowance or allowed prior to the date of this notice.

Where the present guidance on obviousness applies to an application that has been the subject of a Final Action, a revised obviousness defect may be raised in a “Supplementary Summary of Reasons” to which the applicant will be given an opportunity to respond. The particulars of such cases will be managed by the Patent Appeal Board, such as to introduce the least inconvenience and disruption into the process before the Board.