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Actavis UK Ltd v Novartis AG, Court of Appeal, 17 February 2010

Brian Cordery (Bristows) · Friday, April 23rd, 2010 · Landmark European Patent Cases

The English Court of Appeal dismissed Novartis' appeal against the finding of the Patents Court that Novartis' patent for a sustained release formulation of fluvastatin was invalid for obviousness. The Court of Appeal discussed the correct approach to the question of obviousness in English law, by reference to both the problem and solution approach developed by the European Patent Office and the established four-step approach developed by the English Courts in *Windsurfing v Tabur Marine* and *Pozzoli v BDMO* .

Lord Justice Jacob, who gave judgment on behalf of the Court, considered that the reformulation of the problem was the weakest part of the problem and solution approach. In the Court's view, where there is no need to reformulate the problem or where the reformulation is not controversial the problem and solution approach is apt to work very well. However, in other cases the approach has its limitations, in particular in relation to the danger of hindsight when the Court artificially creates a problem which is supposed to be solved by the invention, or where the invention involves perceiving that there is a problem or in appreciating that a known problem can be solved. In those cases, the Court considered it more appropriate to apply the fourth step of the *Windsurfing/Pozzoli* test, which involves asking whether the differences between the state of the art and the inventive concept of the claim, viewed without any knowledge of the alleged invention as claimed, would have been obvious to the person skilled in the art or whether they would require any degree of invention.

The Court of Appeal therefore continues to prefer the English approach although some commentators have suggested that this preference stems from a fundamental misunderstanding of the problem and solution approach on the part of English lawyers (including the judges). It is true that there are many areas of substantive patent law where the English Courts have aligned national law with that developed by the EPO Technical Boards of Appeal. However, the correct approach to the question of obviousness has long been an area of stark contrast to this general rapprochement. This has been the second occasion in recent months, along with the decision in *Generics v Daiichi*, where the Court of Appeal has reviewed the two approaches. Despite the suggestion by Lord Justice Jacob in the *Daiichi* case that the problem and solution approach applies during the fourth step of the *Windsurfing/Pozzoli* test, the latest pronouncement (where the issue was placed before the Court in greater detail) suggests that the English approach is here to stay unless the matter is referred to the Supreme Court in this, or a subsequent, case. Of course, if different national courts apply different tests when assessing the central issue of obviousness, this will inevitably lead to different conclusions regarding the validity of a European patent in the various European Patent

Convention member states, despite the member states' best efforts to align national patent laws through implementation of the EPC.

See: http://www.bailii.org/ew/cases/EWCA/Civ/2010/82.html

Windsurfing v Tabur Marine [1985] RPC 59

Pozzoli v BDMO [2007] FSR 37
Generics v Daiichi [2009] EWCA Civ 646

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