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The final word on obvious to try?

Brian Cordery (Bristows) · Tuesday, October 30th, 2012

On 10 October 2012, the Court of Appeal handed down its judgment in the case of MedImmune v Novartis*. This was the first of what is expected to be a series of decisions from the Court of Appeal over the next few months which will address how the question of obviousness should be tackled by the English Courts. Forthcoming appeal cases include Regeneron v Genentech, Teva v AstraZeneca and Novartis v Mylan**.

In brief, the MedImmune case concerned a product called ranibizumab which is used for the treatment of wet age-related macular degeneration of the eye. At first instance, Arnold J., in a mammoth judgment, had held the patent invalid and not infringed.

On appeal, the panel of three judges (Kitchin, Moore-Bick and Lewison LJJ) unanimously came to the conclusion that the trial judge had not erred in his assessment of obviousness and dismissed the appeal.

Kitchin LJ provided the main reasoning of the Court. He considered that Arnold J's analysis of obviousness using the Pozzoli questions and noted the judge's conclusion that "*the skilled team would have had a reasonable expectation that they would succeed in a reasonable period of time*". In Kitchin LJ's view no error of principle had been made; indeed he believed Arnold J had come to the right conclusion. Notably, in relation to the "obvious to try" doctrine, Kitchin LJ held (at paragraphs 90 and 91 of the decision).

"One of the matters which it may be appropriate to take into account is whether it was obvious to try a particular route to an improved product or process. There may be no certainty of success but the skilled person might nevertheless assess the prospects of success as being sufficient to warrant a trial. In some circumstances this may be sufficient to render an invention obvious. On the other hand, there are areas of technology such as pharmaceuticals and biotechnology which are heavily dependent on research, and where workers are faced with many possible avenues to explore but have little idea if any one of them will prove fruitful. Nevertheless they do pursue them in the hope that they will find new and useful products. They plainly would not carry out this work if the prospects of success were so low as not to make them worthwhile. But denial of patent protection in all such cases would act as a significant deterrent to research.

For these reasons, the judgments of the courts in England and Wales and of the Boards of Appeal of the EPO often reveal an enquiry by the tribunal into whether it was obvious to pursue a particular approach with a reasonable or fair expectation of success as opposed to a hope to succeed. Whether a route has a reasonable or fair prospect of success will depend upon all the circumstances including an ability rationally to predict a successful outcome, how long the project may take, the extent to which the field is unexplored, the complexity or otherwise of any necessary experiments, whether such experiments can be performed by routine means and whether the skilled person will have to make a series of correct decisions along the way. Lord Hoffmann summarised the position in this way in Conor at [42]:

"*In the Court of Appeal, Jacob LJ dealt comprehensively with the question of when an invention could be considered obvious on the ground that it was obvious to try. He correctly summarised the authorities, starting with the judgment of Diplock LJ in Johns-Manville Corporation's Patent [1967] RPC 479, by saying that the notion of something being obvious to try was useful only in a case where there was a fair expectation of success. How much of an expectation would be needed depended on the particular facts of the case*".

Lewison LJ (who was not a full time patent practitioner before becoming a judge but who has nevertheless acquired lots of experience of patent cases since coming to the bench) gave a short judgment agreeing with Kitchin LJ but stepping back from the "obvious to try" doctrine. Concerned that the questions of the degree of expectation of success and the length of time thought to be needed to undertake a trial "*have taken on lives of their own*", he stated "*It cannot be said too often that the statutory test is: "was the invention obvious at the priority date? It is not "was it obvious to try"…we should stick to the statutory question, which has to be applied in all sorts of circumstances and in all sorts of different fields of endeavour*".

The decision suggests that the "obvious to try" doctrine is likely to remain a useful one in appropriate cases, but that parties should always remember to frame arguments in the context of the statutory test. Despite the commendable observations of Lewison LJ, the author doubts that this will be the final word on the question of obvious to try since it is often a crucial issue in high value cases. Going forward, it seems that the English Courts will usually continue to apply the Windsurfing/Pozzoli questions with regard to the observations of Kitchin J in Lundbeck v Generics which were endorsed by the Supreme Court***. It remains to be seen whether paragraph 90 and 91 of the Medimmune decision will come to be so highly regarded and frequently cited.

* [2012] EWCA Civ 1234
** It is understood that the appeal of the first instance judgment in Omnipharm v Merial which contained some important observations from Floyd J on the issue of obvious to try will not be the subject of an appeal decision in respect of obviousness.
*** "The question of obviousness must be considered on the facts of each case. The court must consider the weight to be attached to any particular factor in the light of all the relevant circumstances. These may include such matters as the motive to find a solution to the problem the patent addresses, the number and extent of the possible avenues of research, the effort involved in pursuing them and the expectation of success."

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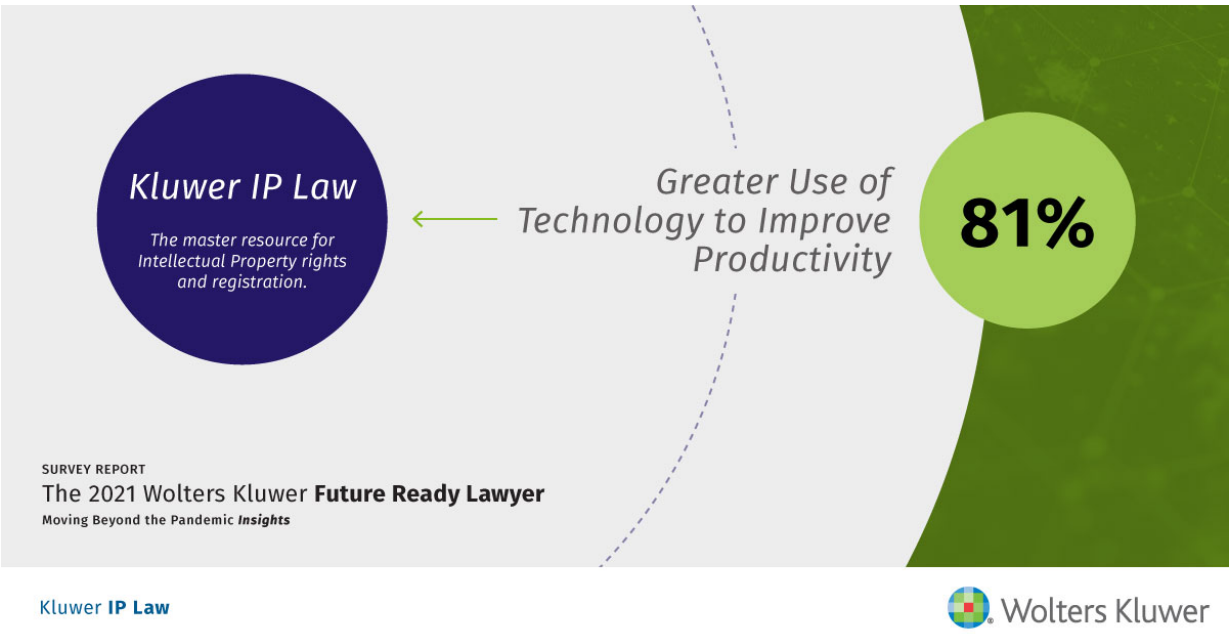

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