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A lack of time does not make an invention non-obvious

Brian Cordery (Bristows) · Friday, May 20th, 2011

In the recent case of Merck v Teva (decision of 8 April [2011] EWCA Civ 382), the English Court of Appeal confirmed that when considering the question of inventive step in light of prior art, it did not matter that the prior art was published only a few days before the priority date of a patent.

The patent in question belonged to Merck and was for an ophthalmic composition containing two particular drugs for the treatment of glaucoma. Merck appealed against the decision of the English High Court in favour of Teva that the patent was invalid for lack of an inventive step (decision of Floyd J. dated 20 November [2009] EWHC 2952 (Pat)).

The case was unusual in that the prior art relied on by Teva had been published only six days before the priority date of the patent. Although Merck conceded that the adjustments necessary to the teaching in the prior art were a matter or trial and error and did not involve an inventive step, it contended that the skilled team would have been unable to perform those adjustments in the short time available to them (i.e. six days).

Merck also argued that the judge had wrongly applied hindsight in concluding that the skilled team starting with the prior art would end up with a formulation falling within the relevant claim of the patent. It submitted that if a step was obvious it would not be taken because no patent protection would arise at the end.

The Court held that the test of obviousness did not have an additional time requirement. If by reference to a relevant state of the art the invention was obvious then it did not matter that it might take time to perform the necessary routine tests. It was a matter of simple comparison between the relevant art and the claimed invention.

The Court also dismissed the claims that impermissible hindsight had crept in. It rejected outright the submission that obvious steps would not be taken because no protection would arise at the end, stating that the true test for obviousness was whether the improvement involves an inventive step, not a commercially attractive one.

Accordingly, the decision of the High Court to revoke the patent was upheld.

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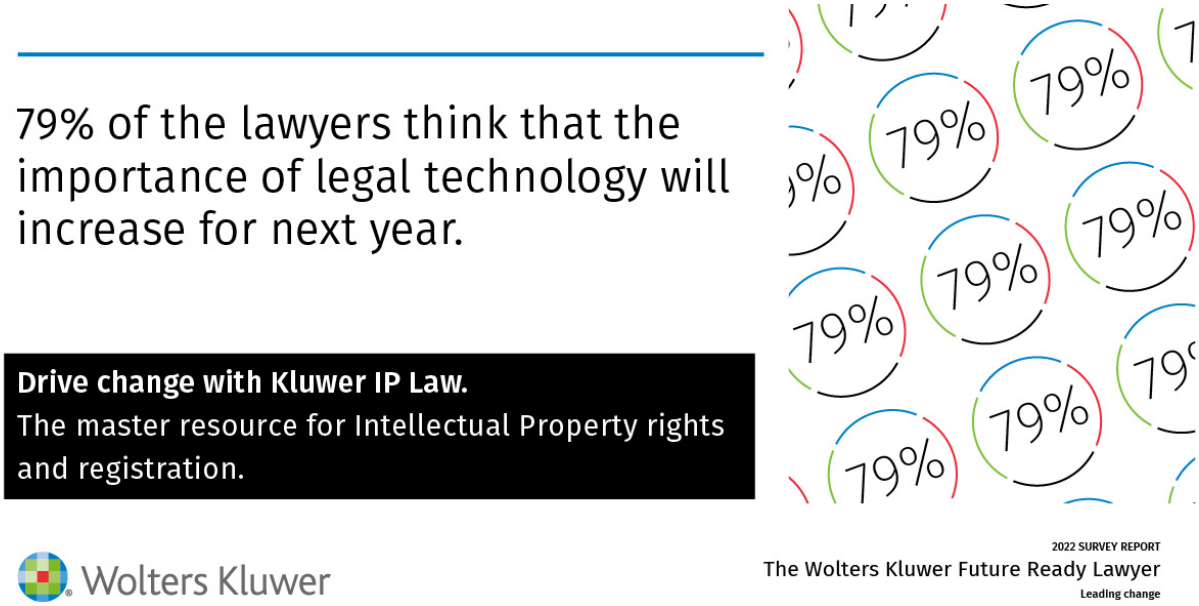

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