

# Kluwer Patent Blog

## Is it obvious how to apply “obvious to try”?

Brian Cordery (Bristows) · Tuesday, January 24th, 2012

Although a number of issues were raised as to the validity of two patents in the recent [Omnipharm v Merial](#)[2001] EWHC 3393 (Pat) case, the most interesting feature of the case was the judge’s approach to the question of inventive step. The case focussed in particular on the role of the doctrine of “obvious to try”, which over the years has become a feature of the English patent landscape. The leading authority on “obvious to try” had for many years been the Court of Appeal judgment in [Johns-Manville Corporations’ Patent](#)[1967], in which Diplock LJ characterised a successful “obvious to try” attack as follows: “it is enough that the person versed in the art would assess the likelihood of success as sufficient to warrant actual trial”. In a more recent decision of the Court of Appeal in [St Gobain v Fusion Provida](#)[2005], Jacob LJ had said that the “obvious to try” test really only works where it is more-or-less self evident that what is being tested ought to work”.

The House of Lords (now the Supreme Court) recently considered the doctrine in the leading case on obviousness of [Conor v Angiotech](#) [2008]. In that case Lord Hoffmann stated that “the notion of something being obvious to try was useful only in a case in which there was a fair expectation of success. How much of an expectation would be needed depended on the particular facts of the case.”

In this case, the patent in question claimed an anti-parasite composition (in particular a flea lotion) for treating pets. The composition was designed for localised, or “spot-on”, application to the animal’s coat, after which the composition spreads over the animal’s whole body by non-systemic mechanisms, although these were poorly understood at the priority date. The prior art described an anti-parasitic composition with the same active ingredient but in spray form, to be sprayed all over the animal’s coat.

The party seeking revocation argued that it was obvious to decide to try to develop the spot-on formulation once the efficacy and success of the spray were known. Given that the spray functioned non-systemically, it was obvious to try formulating a non-systemic spot-on and a formulator would be able to come up with a formulation falling within the claim of the patent. The patentee argued that the available spot-ons for pets at the priority date were not perceived as good products; that even if the person skilled in the art had thought to try a spot-on product that it would be worse than the spray; and that there was no scientific basis for supposing that the spot on formulation would distribute non-systemically from the ‘spot’ of application.

Following the line of authorities listed above, Floyd J set out his view on the correct approach to

the question of inventive step in a case like this:

*“(i) There is but one statutory question: was the invention obvious? It is to be answered by reference to the non-exhaustive list of factors identified by Kitchin J in Generics v Lundbeck , including whether it was obvious to try the invention as a solution to a technical problem, as well as the nature of the invention itself.*

*ii) “Obvious to try” is not an independent ground of invalidating a patent under the statute, but one of a variety of factors considered in an overall assessment of inventive step. It must be coupled with a fair expectation of success, the degree of success necessary depending on the other factors present in the individual case.*

iii) Where an invention is claimed plausibly in terms that it would achieve a technical effect, it is correct to ask whether it was obvious that the invention would achieve that effect, and wrong to ask whether the invention might achieve that effect.”

Floyd J held that the question for the person skilled in the art to consider was whether the spot-on formulation would distribute from the point of application over the surface of the skin. That person would only consider a spot-on formulation worth trying if they had a fair expectation of success. In the absence of any common general knowledge theory as to how non-systemic spot-ons worked, the person skilled in the art would not have a sufficient expectation of success to render the invention obvious as there was *“no basis for predicting that that result [the spreading of the parasiticide over the animal’s coat] could be achieved”*. This was even though other anti-parasitic compounds had worked in spot-ons. So despite the fact that patentee had not encountered any difficulties in formulating the spot-on composition, the patent was upheld as involving an inventive step.

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This entry was posted on Tuesday, January 24th, 2012 at 6:00 pm and is filed under [Inventive step](#), [Revocation](#), [United Kingdom](#)

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