

# Kluwer Patent Blog

## Obviousness and lack of technical merit/effect

Brian Cordery (Bristows) · Tuesday, July 31st, 2012

The classic English approach for determining whether a claimed invention is obvious is to compare the prior art and the claimed invention, to identify the differences between the two and to ask whether those differences, viewed without knowledge of the claimed invention, were obvious or required any degree of invention\*. This is often contrasted with the problem and solution approach adopted by the EPO and patents courts in many other EPC member states, which requires, in part, the identification of a technical effect or problem that the patent claims to have solved. However, the English Courts have been applying a similar gloss to the traditional approach on obviousness, in particular with selection inventions, requiring the identification of a plausible technical contribution\*\*. The recent case of *Generics [UK] v Yeda [2012] EWHC 1848 Pat* raised two new issues on this point not previously dealt with in the authorities.

The claimant sought revocation of a patent relating to copaxone, a medicament whose API is glatiramer acetate, a random polymer composed of four amino acids. Revocation was sought both pursuant to a traditional obviousness attack but also on the basis that the product claims in question were obvious as the claimed molecular weight characteristics of the synthetic polypeptide in question were an arbitrary selection with no technical merit. The two novel points raised in this case were:

1. Where the burden of proof lay for demonstrating plausibility where obviousness was alleged on this basis, in particular whether post-filed data could be used to shift the burden from the applicant for revocation to the patentee; and
2. Whether post-filed data could be relied on by either party to support or attack the plausibility of the alleged technical contribution.

Dealing with the second point first, the judge Arnold J, accepting the parties' agreed position, held that where the patent (when read with the skilled person's common general knowledge) did not disclose enough to make the invention plausible, i.e. plausible that the invention solved the technical problem, post-filed data could not be used to demonstrate the technical effect. However, the dispute lay where the patent did make the invention plausible, and whether post-filed data could be used to cast doubt on that. The judge ruled that just as post-filed evidence could not be used to support inventiveness, it could not be used to support a claim for obviousness. Whether a claimed invention was obvious or not had to be judged as at the priority or application date. The judge thought that it would be bizarre "*if a patent which at the time it was applied for disclosed what everyone thought was a good invention could be revoked 20 years later because subsequent*

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*advances in science had revealed that in fact he invention did not solve the technical problem”.*

The only role for post-filed data, based on authorities from the EPO and the *Sandvik* case, was to confirm that the disclosure in the patent either does or does not make it plausible that the invention solves the technical problem. With regard to the burden of proof, if the specification did make it plausible that the invention solved the technical problem, the judge was of the view that, having held that post-filed evidence could not cast doubt on that conclusion then it could not place an evidential burden on the patentee to demonstrate affirmatively that the invention did solve the technical problem.

In summary, the English Courts often require the identification of a plausible technical contribution when determining whether a patent involves an inventive step. That must be determined solely on the basis of the disclosure in the patent when read with the common general knowledge. The only role for post-filed data is to confirm whether that initial analysis is correct, i.e. it cannot cast doubt on the plausibility or lack thereof of the alleged technical contribution.

\* The structured Windsurfing/Pozzoli test, see *Pozzoli v BDMO* [2007] EWCA Civ 588

\*\* See, for example, *Sandvik v Kennametal* [2011] EWHC 3311 (Pat)

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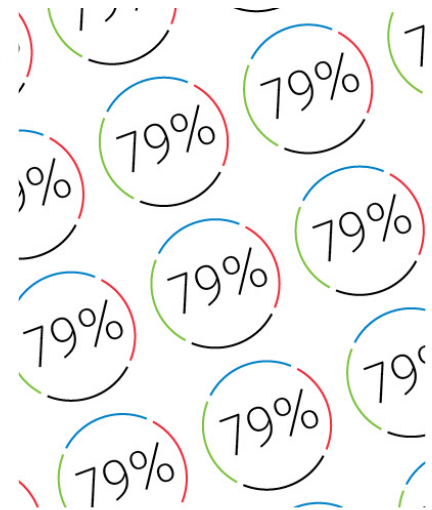
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