

From Susan Rancourt;

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Subject practice note on obviousness;

Message With respect to the discussion of the "obvious to try" analysis, I don't think that it accurately reflects the analysis that the SCC laid out.

If I understand the guidelines, an examiner will ask first if there is motivation (A) in order to establish whether the "obvious to try" test applies, and if yes, then questions (B) and (C) in assessing whether an invention is obvious to try.

This process goes against the SCC explicitly mandating a "flexible" approach rather than a rigid approach to obviousness- see para. 61, 63. The approach laid out in the guidelines - If "A", then go to "B" and "C" is rigid.

Also, the approach, if "A", then go to "B" and "C" is actually not what the SCC mandated, or what the court did in assessing obviousness. The SCC was very clear that A, B and C were "factors" to be considered, and that this list was not exclusive.

The SCC actually dealt with "A" after it considered B and C - so A did not lead into B and C. Further, all of A, B and C (and D) were considered together in assessing whether the invention was "obvious to try" - see para. 92.

While it is difficult to know exactly when the "obvious to try" test is appropriate, I think that the office should adopt a "flexible approach" - thus, no rules as to whether it applies and take it on a case-by-case basis. It is clearly appropriate in situations where experimentation is needed to know whether an invention is actually useful- such as in the pharmaceutical sciences and by extension chemical sciences probably, medical sciences, any situation where it is not clear, on paper, that an invention will have utility.

Just my thoughts. Sue Rancourt

