

Practice Notice on Obviousness
(for public consultation)

May 14, 2009

Overview

On November 6, 2008, the Supreme Court released its judgement in the case *Apotex Inc. v. Sanofi-Synthelabo Canada, Inc.* [2008 SCC 61].

In its reasons, the Court commented on the approach to obviousness in Canada, concluding that the inquiry into obviousness is not well served by attempting to rigidly apply any one test in all circumstances.

The Court considered recent jurisprudence in both the US and UK, and concluded that the approach known in the UK as *Windsurfing/Pozzoli* will be useful to conducting an obviousness inquiry. [This approach having been introduced in *Windsurfing International Inc. v. Tabur Marine (Great Britain) Ltd.* [1985] R.P.C. 59 (C.A.) and refined in *Pozzoli SPA v. BDMO SA* [2007] EWCA Civ 588.]

The four-step approach to obviousness adopted by the Court is as follows:

- (1) (a) Identify the notional “person skilled in the art”;
(b) Identify the relevant common general knowledge of that person;
- (2) Identify the inventive concept of the claim in question or if that cannot readily be done, construe it;
- (3) Identify what, if any, difference exists between the matter cited as forming part of the “state of the art” and the inventive concept of the claim or the claim as construed;
- (4) Viewed without any knowledge of the alleged invention as claimed, do those differences constitute steps which would have been obvious to the person skilled in the art or do they require any degree of invention?

The Court further indicated that, under certain circumstances, the question of obviousness can be considered by asking, in step (4), whether it would have been “obvious to try” a certain line of inquiry that would inevitably lead to the claimed invention.

The Court provided several factors as being applicable, depending on the nature of the specific case under consideration, in determining whether the matter of a claim would have been “obvious to try”. The factors set out by the Court, with the caution that the list is not exhaustive, are:

- (A) Is there a motive provided in the prior art to find the solution the patent addresses?

- (B) Is it more or less self-evident that what is being tried ought to work? Are there a finite number of identified predictable solutions known to the person skilled in the art?
- (C) What is the extent, nature and amount of effort required to achieve the invention? Are routine trials carried out or is the experimentation prolonged and arduous, such that the trials would not be considered routine?

Where the questions (A) and (B) can be answered in the affirmative, and the conclusion at item (C) is that the matter of the claim would be arrived at by routine trials that were not prolonged and arduous, it can be concluded that the subject-matter of the claim is obvious since it would have been “obvious to try” to identify the claimed matter from among a finite number of likely solutions one of which more or less self-evidently ought to work.

Impact on examination

A - Framing the obviousness inquiry

In view of this guidance and direction of the Supreme Court, Canadian examiners will henceforth consider whether “obvious to try” is a relevant consideration in determining the obviousness of claimed subject-matter.

Further, in presenting obviousness objections, examiners will be guided by the four-step approach the Supreme Court has indicated will be useful in structuring obviousness inquiries. During examination, however, the steps need not be explicitly addressed unless doing so is relevant to the objection in suit.

Examiners will adhere to the following guidance regarding the steps set out by the Court (the numbering provided refers to the steps in the approach):

- (1)(a) Where necessary, examiners will identify the person skilled in the art by reference to the field or fields relevant to the invention, and where applicable by reference to attributes such as their proclivity for engaging in research or experimentation.
- (1)(b) Examiners, in formulating objections, may refer to information they believe to be common general knowledge. Unless it becomes evident through the applicant’s comments that the nature of the common general knowledge is not common ground and is reasonably in dispute, an examiner need not identify documents establishing the common general knowledge.
- (2) The identification of the inventive concept is performed on a claim-by-claim basis, recognising that the specific inventive concept of each claim can (and should) be a refinement of the single general inventive concept that must link the claims as a whole in order to satisfy section 36 of the *Patent Rules*. The relevant

inventive concept is that of the claim under examination, and not a generalised inventive concept derived from the specification as a whole.

The inventive concept of a claim, at this step of the inquiry, is identified without regard to the prior art. It is the essence of the claimed invention and can generally be identified by approaching the matter of the claim as a solution to whatever problem the inventors have set out to address, and relates to those elements of the claim that were described, or which would be recognised by the person skilled in the art, as providing the solution to a given problem. In identifying the problem that the inventors set out to address, and the solution proposed through the invention, guidance will generally be found in the description, in accordance with paragraph 80(1)(d) of the *Patent Rules*.

The concept of “solving a problem” should be understood in the context of “achieving the objects of the invention” and “fulfilling the purpose of the invention”. It is worth reiterating that identifying the problem being addressed is done in the context provided by the description, and not by reference to the closest prior art.

The inventive concept may be clear from the language of the claim itself, where the purpose of the claimed matter is explicitly defined. This would be particularly true in the case of a claim presented in the European or Jepson format. Where it is not clear from the language of the claim itself what problem is being solved by the claimed matter, the remainder of the specification is consulted to assist in identifying the inventive concept of that claim.

- (3) At this step, the inventive concept (solution) identified in step (2) is compared to the state of the art to determine whether, or to what extent, an equivalent or similar inventive concept (solution) was known at the claim date.
- (4) Where differences exist between the inventive concept embodied in the claim and the state of the art, it must be determined if these differences would have been obvious as of the claim date. This must be done without presupposing that it was recognized in the art that the problem to be solved formed part of the state of the art. This is important to avoid adopting an improper “hindsight” perspective; where the existence or nature of a problem was unobvious, identifying the problem can contribute to the necessary inventive step.

In reaching a conclusion at step (4) of the approach, the question of obviousness must be framed taking into account the context of the specific case in question. The correct test can be framed in more than one way, and no single expression of this test is likely to apply to all circumstances. The test articulated in *Beloit Canada Ltd. v. Valmet Oy* [(1986), 8 C.P.R. (3rd), 289 (F.C.A.)], for example, is not to be viewed as mandatory.

The Office considers the guidance affirmed by the Federal Court of Appeal in

Novopharm Limited v. Janssen-Ortho Inc. [2007 FCA 217] to remain relevant in view of the guidance of the Supreme Court in *Sanofi-Synthelabo*. Particularly, the obviousness inquiry should be framed in the context of:

- (i) the climate in the relevant field at the time the alleged invention was made, including not only knowledge and information available but also attitudes, trends, prejudices and expectations that would define the person skilled in the art; and
- (ii) any motivation in existence at the time of the alleged invention to solve a recognized problem in the field of the invention.

Where it can be reasonably concluded that the person skilled in the art would have been motivated to solve a recognized problem, the criterion set out in item (A) of the *Sanofi-Synthelabo* “obvious to try” considerations is satisfied.

In determining whether, in view of this motivation, the solution defined in the claim lacks invention (i.e. is obvious), relevant considerations are:

- (B) Is the person skilled in the art aware, in view of the prior art and their common general knowledge, that a limited number of predictable and identifiable solutions exist to the same or a similar problem, such that they would believe that one of those solutions ought to work to solve the problem being addressed?
- (C) Could the person skilled in the art be expected to arrive specifically at the solution claimed, starting from the limited number of solutions conceptually identified in step (B), without inventive step or undue burden? That is, would the solution be arrived at by routine and predictable methods.

It must be noted that many inventions are arrived at by trial and error experimentation, the inventors being motivated by the possibility, or even likelihood, that a solution to some problem might be discovered through these experiments. The Office considers that the “obvious to try” test is not applicable merely because a motivation exists, in the broadest sense, to solve problems through scientific inquiry. Rather, a specific motivation must exist to identify a solution to a specific problem, from among a limited number of possible solutions one of which ought reasonably to work.

The Office considers that the “undue burden” aspect of the test must be evaluated objectively by the examiner, taking into account the nature of the person skilled in the art and the knowledge and climate in the relevant field or fields existing at the claim date. The subjective experience of the inventors, generally, will not be determinative during examination, since no practical mechanism exists for an examiner to fully ascertain the appropriateness of the inventors’ line of inquiry nor whether the inventor should be treated as the relevant person skilled in the art.

B - Impact on cases under prosecution

All examination will henceforth assess obviousness in view of the guidance set forth herein. Applicants may consequently find that claims will be found defective for obviousness where they had not previously been objected to on this ground, or where an earlier obviousness objection had been withdrawn.

Examiners will raise obviousness objections in view of the current guidance where necessary, regardless of the prior prosecution of the application.

Where the present guidance on obviousness applies to an application that has been the subject of a Final Action, the correct obviousness defect may be raised in a "Supplementary Summary of Reasons" to which the applicant will be given an opportunity to respond. The particulars of such cases will be managed by the Patent Appeal Board, such as to introduce the least inconvenience and disruption into the process before the Board.