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Obviousness / Inventive Step : UK

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The general test for obviousness applied by the English Courts derives from the four stage test set out by the Court of Appeal in the *Windsurfing International v Tabur Marine* case more than twenty years ago. The courts have found the test effective and durable, making only minor adjustments to the test in 2007 in *Pozzoli SPA v BDMA SA* [2007] EWCA Civ 588. The test now stands as:

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, differences exist 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 constitue steps which would have been obvious to the person skilled in the art or do they require any degree of invention?

Whilst the general test has remained now mainly unaltered for over twenty years, interesting cases are general developments continue:

A. In 2008, the House of Lords, the ultimate court in the UK, considered obviousness in *Connor v Angiotech* [2008]RPC 28, although not the details of the *Pozzoli* test but rather on identifying the inventive concept. In particular the House of Lords stressed the need to identify the invention set out in the claims and not generalise it based on the extent of what was set out in the specification - because there was limited information in the specification that the invention would work, the party challenging the patent had argued that the inventiveness should be based at the level of was it obvious to try. The argument received short shrift from the House of Lords, who focussed on whether the invention set out in the claims was obvious. For an obvious to try argument to succeed in the UK, there must be an likelihood of success sufficient to warrant an actual trial.

B. Whether an invention is obvious or not is heavily dependent on step 1 – who is the skilled person and what is their common general knowledge. Whilst the skilled person can usually be assessed acurately in advance, problems often arise in determining the level of common general knowledge (and hence assessing the prospects on obviousness). In recent years, there has been some uncertainty about the extent of common general knowledge, in particular as to information obtained before working on a problem. Greater clarity on this was obtained last year from Kitchin J in *Generics v Daiichi* [2008] EWHC 2413 when he held that for information to be part of the common general knowledge it must form part of the stock of knowledge may inform or guide the skilled person's approach from the outset. Such knowledge could affect the steps it would be obvious for him to take, including the nature

and extent of any literature search. This was later reaffirmed by Floyd J in *Ratiopharm v Napp* [2008] EWHC 3070.