TRYING TO DEFINE CRITERIA FOR INVENTIVENESS OF A PATENT: IT IS NOT AN OBVIOUS TASK

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The Federal Court of Appeal of Canada had to recently evaluate the level of inventiveness required to make an invention patentable. More particularly, in *Novopharm Limited* v. *Janssen-Ortho Inc.*(2007 FCA 217), the Court had to examine the validity of a patent in the pharmaceutical field. The validity of the patent was under attack for several reasons, including lack of inventiveness, by the defendant Novopharm accused of patent infringement.

Such a question is important for an inventor during the evaluation of a patent filing strategy in different countries when the invention is considered to have a "questionable" level of inventiveness. The inventor would maybe avoid filing a patent application for such an invention in countries where the level of inventiveness required for obtaining a patent is high.

The present case concentrated on the evaluation of the inventiveness of the use of a subdivision (called enantiomer) of a chemical molecule, when the basic molecule and its properties are known. Novopharm argued that such an enantiomer was obvious in view of the known molecule and that well-known techniques could be used to extract the subdivision from the basic molecule.

Justice Hughes in the lower court maintained that the claimed subdivision and patent was valid since the use of the enantiomer was non-obvious in view of what was known about the basic molecule. After carrying out a review of Canadian, American and English caselaw, Justice Hughes produced a list of factors to consider when evaluating the inventiveness of a patent. Novopharm appealed the use of this list of factors in the evaluation of the non-obviousness of the invention.

The Court of Appeal reiterated that the only accepted test of non-obviousness in Canada comes from the case *Beloit Canada Ltd. et al.* v. *Valmet OY* :

> [Would a skilled technician] in the light of the state of the art and of common general knowledge at the claimed date of invention, have

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come directly and without difficulty to the solution taught by the patent?

The Court emphasized that the *Beloit* test must be factual, functional and guided by expert testimony on the level of skill and knowledge of the person of ordinary skill in the field of the invention. The credibility and reliability of the expert testimony must be evaluated.

However, the Court also stated that there is no single question, nor series of questions that could be used to evaluate the inventiveness of an invention and that could be applied to all situations. Consequently, the Court refused to replace the established test of *Beloit* with the new list of factors proposed by Justice Hughes.

Nevertheless, the Court of Appeal found that Justice Hughes' factors represent a useful tool in evaluating inventiveness that must be carried out during the factual analysis of the more general *Beloit* test. The Court thus presented a list of factors representing an edited version of Justice Hughes' list and including the following elements:

<u>Principal Factors</u>

1. The invention
2. The skills possessed by the hypothetical person of ordinary skill in the art.
3. The body of knowledge of the person of ordinary skill in the art
4. The climate in the relevant field at the time the alleged invention was made
5. The motivation in existence at the time the alleged invention to solve a recognized problem
6. The time and effort involved in the invention

<u>Secondary Factors</u>

7. Commercial success
8. Meritorious awards the invention received

The Court then considered these factors and other arguments submitted by the Appellant to finally reject the appeal.

Consequently, an inventor now has a list of factors that allow a better evaluation of the inventiveness of a patent. However, although this list now exists, determining with certainty whether an invention is inventive or not in Canada remains an exercise that is far from being obvious to solve…

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