

not enough motivation for a skilled person to carry it out. Therefore, the invention was not obvious.

## (2) *The House of Lords Decision*

Since attack based on obviousness failed in both courts below, it was not a big issue before the House of Lords. On the other hand, Lord Neuberger summarized basic knowledge about enantiomers which had long been known as follows: i) two enantiomers could have different properties from each other; ii) a racemate's therapeutic effect might be mainly dependent on one enantiomer; iii) the other enantiomer might have toxic or side-effects; iv) the only way to tell which one had which effect was to separate one from another and to compare; iv) however, above was not possible to predict yet.<sup>140</sup> He continued that the notion to obtain a pure therapeutic form from a racemate is obvious, but to obtain a pure form is not obvious, and it was particularly difficult to separate (S)-citalopram from the racemate.<sup>141</sup> Thus it seems that Lord Neuberger weighted the difficulty of separation of racemates to determine obviousness.

## 4. Summary

These decisions show that the courts share and consider various factors to determine obviousness, such as level of knowledge of persons skilled in the art, structural similarity, motivation to carry it out, unexpected beneficial properties (a real technical advance), teach-away, previous failures, hindsight issue, reasonable expectation of success (arbitrariness), and so on. For example, similar to the 'obvious-to-try' doctrine, Jacob LJ stated that enough motivation and a simple statement that the experiment would have been short and simple was not sufficient. Also as Jacob LJ tried to warn against the hindsight bias, the German Federal Court of Justice stated that only from a retrospective view, one could be sure what was the closest prior art. However, regarding whether there was enough motivation to separate the enantiomer, the U.S. Federal Circuit seemed to have a different view from the German Federal Court of Justice, and this issue will be discussed further at IV.B.

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140 Generics, the House of Lords, *supra* note 98, at para 61.

141 *Id.*, paras 61-65.

## D. Summary and Conclusion

In Germany, a broad genus claim or even a genus with two species disclosure in prior art cannot prevent the species be patented per se., which could be regarded as what applies in other jurisdictions. In the U.K., there is no longer a need to prove the selection has a substantial advantage over the wider group where the selection was made<sup>142</sup> and even a known product can be patented as a product per se depending how difficult it is to make it available. In the U.S., the much-disputed KSR decision does not seem to influence enough at least on *Escitalopram* decision. As a brief conclusion, it would be fair to say that it gets to be more difficult to challenge the selection inventions, and easier to get patents on them. These series of changes on patentability will be further analysed in the following section.

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142 Fitt, *supra* note 85, at 20.