It can be understood that the decisions discussed here are possibly based on the policy reason that we need at least these incremental innovations. However, it is time to reconsider whether this policy may lead to innovative companies concentrating their research on these fields rather than on drug discovery which is entirely new, and therefore preventing the development of innovative medications in the future.

### 4. Conclusion

The determination of nonobviousness is a rather complicated and difficult task. In addition, the test for nonobviousness depends more on the difference between the facts of the cases than the test for novelty. Regarding the nonobviousness of enantiomer patents in particular, it was argued that the decisions of the Federal Circuit on this issue have been mixed although they may not be regarded as necessarily inconsistent with each other, considering different evidentiary records to determine the existence of a motivation for the person skilled in the art to separate enantiomers with a reasonable expectation of success, the teaching in the prior art, the existence of superior properties of isolated enantiomers, and so on.[231, 232] As Eisenberg said, it is not easy to find a meaningful guideline for the question of obviousness[233] in this regard. In line with these issues, the particularity of the pharmaceutical industry in terms of low predictability and the level of skill of a person skilled in the art also need to be considered.

## C. Impact of Lowering the Bar for the Patentability of Selection Inventions

Based on the enablement issue in anticipation, novelty at least is not a tough hurdle for a selected species from a disclosed broad Markush type claim or an enantiomer from a disclosed mixture of two enantiomers. This may increase the number of newly granted selection patents. The possible impact of patentability of selection inventions after grant is discussed below.

231 *See* Rebecca S. Eisenberg, *Pharma's Nonobvious Problem,* 12 Lewis & Clark L. Rev. 375, 424-427 (2008).

232 *See also* Rochelle Cooper Dreyfuss, *Nonobviousness: A Comment on Three Learned Papers,* 12 Lewis & Clark L. Rev. 431, 441 (2008) (noting that the Federal Circuit's view on nonobviousness of enantiomer patents seems to be remarkably flexible).

233 Eisenberg, *supra* note 231, at 427.