

While citing the *Sanofi-Aventis*<sup>286</sup> case, the Supreme Court held that even though only the racemate of R-trans-heptanoic acid and S-trans-heptanoic acid was disclosed, considering that a carboxamide compound of formula I was acknowledged as separate 4 enantiomers and not as a mixture, a person skilled in the art could have acknowledged formula I's open-ring form, namely, R-trans-heptanoic acid and S-trans-heptanoic acid, as separate enantiomers, too, and thus that the prior art disclosed the R-trans-heptanoic acid.<sup>287</sup> The Court restated that the selection invention was recognized as separate enantiomers, not as a mixture, and it was not necessary to disclose the method of separation or the possibility of separation of the enantiomer from racemates unless the invention was directed to the method of separating the dextrorotatory enantiomer.

The Court also found it obvious since even under the consideration of hygroscopicity or solubility, which were argued by the patentee, there was no special disclosure in the specification which could show any qualitatively different or qualitatively same but quantitatively superior effects.<sup>288</sup>

## 2. Selection Inventions in Japan

It is rather clearly defined in Japan what a selection invention is; namely, where an invention with a generic concept is expressed in a cited reference, an invention with a more specific concept selected from the generic concept is called a "selection invention".<sup>289</sup> The Japanese Examination guidelines show how to determine the novelty of a selection invention as follows:

"... if a chemical substance is expressed merely by its name or its chemical formula in a publication, and if it is not clear that a person skilled in the art can produce the chemical substance on the basis of the description in the publication, *even in the light of the common general knowledge as of the filing*, the chemical substance does not fall under "an invention described in a publication" under Article 29(1)(iii)." <sup>290</sup>

The guidelines further state that the prior art disclosure of a generic concept neither implies nor suggests an invention unless the specific concept can be directly derived from the generic invention *considering the common general knowledge*.<sup>291</sup>

It is not certain whether the above 'common general knowledge' corresponds to the 'disclosure' requirement or 'enablement' requirement when determining an-

286 *Sanofi-Aventis*, *supra* note 276.

287 *Warner Lambert*, *supra* note 284, at para 1.Na..

288 *Id.*, at para 2. Na..

289 See Japanese Examination Guidelines, *supra* note 181, at 2.5.3.(3)(1).

290 *Id.*, at 1.5.3.(3)(2).

291 *Id.*, at 1.5.3.(4)(2).

ticipation. If a person skilled in the art can produce the chemical substance *based on the common general knowledge* at the time of application, however, a publication disclosing a chemical formula could be a novelty-destroying prior art reference.

Regarding the assessment of obviousness of selection inventions, the court held that it may be regarded as nonobvious when it provides an advantageous effect which is not disclosed in the prior art, *qualitatively different or qualitatively same but quantitatively prominent* compared to an invention with a generic concept, neither of the effect being foreseeable with the eye of a person skilled in the art.<sup>292</sup>

### 3. Summary and Conclusion

According to the Korean Supreme Court, a document which discloses clearly all elements of an invention can certainly be an anticipating prior art reference. In addition, in case that expressions regarding the invention are not sufficient or there is a deficiency of disclosure, a document can be an anticipating prior art reference if a person skilled in the art can easily acknowledge the content of the invention based on the common knowledge or rule of thumb.<sup>293</sup> Different from U.S. or European practice, it does not seem that the disclosure and enablement requirements are clearly distinguished in determining anticipation.<sup>294</sup> Although it seems as if insufficiency of disclosure can be augmented by the knowledge of a person skilled in the art under Korean practice, it would be desirable that the Supreme Court would clarify its view on this issue. Further it would also be interesting to see how the Japanese High Court rules on this issue.

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292 Tōkyō Kōtō Saibansho [Tokyo High Ct.] Oct. 31, 1963, Sho 34 (Gyo Na) No. 13 (Japan); Tōkyō Kōtō Saibansho [Tokyo High Ct.] Mar. 30 1978, Sho 51 (Gyo Ke) No. 19 (Japan); Tōkyō Kōtō Saibansho [Tokyo High Ct.] Sho 51 (Gyo Ke) 19 (Japan); Tōkyō Kōtō Saibansho [Tokyo High Ct.] Jul. 30, 1983, Sho 53 (Gyo Ke) No. 20 (Japan); Tōkyō Kōtō Saibansho [Tokyo High Ct.] Sept. 8, 1985, Sho 60 (Gyo Ke) No. 51 (Japan).

293 *In re University of Florida Research Foundation, Inc.*, Supreme Court Decision [S. Ct.], 2004Hu2307, Mar. 24, 2006 (S. Kor.).

294 Chaho Chung, et al., *Seontaekbalmyoungin Geoulsang Eesungilchae Balmyoungui Shingyuseoung Pandan [Novelty Determination of Enantiomer Invention as a Selection Invention]*, 49 Seoul National University The Law, 355, 399 (2008)(S. Kor.).