

**EIP**

## Merck v Teva: Time to be obvious

A recent judgment made by the Chancellor of the UK High Court in a patent dispute has highlighted that the test for obviousness (i.e. inventive step) of the subject matter of a patent does not involve any time limit. The only element of time to consider in relation to obviousness is the state of the art at the priority date. It does not matter that it may take time after the priority date to complete development of the prior art into the invention.

The judgment related to patent revocation proceedings between Merck Sharp & Dohme Corp (Merck) and Teva UK Ltd (Teva), where Merck was appealing against an earlier decision made by the UK Patents Court to revoke their patent for lack of inventive step.

Merck's patent related to a process for obtaining an ophthalmic solution consisting of a combination of two drugs, timolol and dorzolamide, for use in the treatment of glaucoma. However a research paper, which was published six days before the priority date of Merck's patent application, presented experimental research indicating that consecutive administration of the two drugs reduced intraocular pressure in the eye (this being one of the symptoms of glaucoma). In the UK Patent's Court proceedings Merck's patent was therefore revoked on the grounds that it was not inventive over this research paper.

Merck appealed against the revocation decision on a number of grounds; however all of these grounds, apart from those relating to claim 18 of the patent, were rejected by the Chancellor of the High Court.

The remaining grounds related to whether an approach proposed by Teva for taking the disclosure of the research paper and developing it would result in the invention claimed in claim 18. If this was the case claim 18 would be considered obvious as the approach proposed by Teva did not involve any inventive steps, and could be applied to the state of

the art at the priority date.

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Although Merck agreed that the steps involved in Teva's proposed approach were a matter of trial and error and therefore did not involve any inventive step, Merck countered that the six days between the publication of the research paper and the filing of Merck's patent application was too short a time to allow the proposed approach to be completed. Thus it was claimed that the judge had incorrectly applied hindsight in determining that the invention of claim 18 was obvious, as the approach proposed by Teva would in reality take a substantial amount of time to complete, and could not have been completed by the priority date of Merck's patent.

In the end, although the Chancellor agreed that the approach proposed by Teva could not be completed in the six days between the publication of the research paper and the priority date of the patent application, he rejected Merck's argument because, as stated above, it does not matter that it may take time after the priority date to complete development of the prior art into the invention. The fact that the approach proposed by Teva could be applied at the priority date to develop the invention from the prior art without any inventive steps was sufficient to make the claimed invention obvious, regardless of how long the proposed approach would take.