this rejection ground through the amendment of claims,[183] he may only obtain his exclusivity for the claims directed to 10 individual embodiments out of at most 100 times compounds in the extreme, because of the same reason as above. Assume that there were only 3 individual embodiments in the priority application – it is a very typical case in which the applicant prepares more embodiments during a 12 month period -, can even 10 individual embodiments enjoy the claiming of priority?

It would be interesting to see whether the Federal Court of Justice will uniformly apply this concept of disclosure in terms of novelty to other areas of disclosure, and if not, to what extent it would do so.

4. Conclusion

It is acknowledged that determination of the patentability of selection inventions is a more difficult issue,[184] and is considered case by case, specifically different from other inventions.[185]

The *Olanzapine* and the *Escitalopram* decisions lowered the bar for patentability, especially for the novelty requirement with respect to selection inventions. On the one hand, it is understood that society wants to motivate companies to research these areas, and thus more selection inventions become available. However, on the other hand, it is hard to find a justification for the fact that selection inventions are treated differently from basic inventions.

Floyd J said in the *Olanzapine* decision that the above discussed extension of the exclusivity term could not alter the principles to be applied when deciding whether the patent's teaching was novel or non-obvious over the basic patent.[186] In his opinion, this situation should not be treated differently from when the basic patent is owned by a party other than the patentee, or when the prior part is not a patent document.[187] It may be difficult to understand why the same reasoning should not be applied to the treatment of selection inventions and basic inventions. The possible impact of this enablement requirement, i.e. a possible extension of exclusivity, will be considered in further depth in IV.C.

183 *See e.g.,* Heiko Sendrowski, *"Olanzapine" – eine Offenbarung? (Olanzapine – a disclosure?)* GRUR 797, 801 (2009).
184 Chisum, *supra* note 106, at § 3.02[2][b].
185 *See also* MPEP *supra* note 157, § 2131.03 (When the prior art discloses a range which touches, overlaps or is within the claimed range, but no specific examples falling within the claimed range are disclosed, a case by case determination must be made as to anticipation).
186 *See* Dr Reddy's Lab, Patent Court*, supra* note 86.
187 *Id.*

B. Obviousness

As stated in the statues, the invention should not be obvious to the person skilled in the art. The concept of the person skilled in the art is important to determine obviousness. He is a hypothetical person and has a level of skill which is determined within the art in general but which does not specifically match the level of skill of the inventors.[188]

In determining obviousness, the U.S. patent system uses a special procedural tool called '*prima facie* obviousness'. Namely, once it is established, the burden of proof is shifted to the applicant, and he could overcome this rejection ground by rebutting.[189] Not all other jurisdictions use this concept; however, it is used as a basis to discuss relevant issues of obviousness of selection inventions below.

1. Prima Facie Obviousness

a) Size of the Genus

It is well established that a genus not explicitly disclosing a later species does not anticipate the later species claim.[190] In addition, the mere fact that the claimed compound in the later invention is covered by the prior art generic formula is in itself not yet regarded as rendering the claimed compound obvious over the prior art.[191] However, in general, if the genus or generic formula in the prior art discloses only a small number of substituents, it is more likely that the species from the genus would be found obvious, specifically *prima facie* obvious.[192] The opposite situation is also true.[193] In other words, the chance that a selection of a species is not obvious

188 *See e.g.,* Spenner, *supra* note 116, at 483.
189 *See* Darrow, *supra* note 124, para 44.
190 *See* Chisum, *supra* note 106, at § 3.02[2][b]; *see also* Metabolite Laboratories, Inc. v. Laboratory Corporation of America Holdings, 370 F.3d 1354, 1367-71 (Fed. Cir. 2004) (holding that a prior art reference that discloses a genus still does not inherently disclose all species within that broad category); *See also* Meier-Beck, *supra* note 60, at 985.
191 *See In re* Jones, 958 F.2d 347, 350, (Fed.Cir.1992) (holding that the fact that a claimed compound may be encompassed by a disclosed generic formula does not by itself render that compound obvious); *see also, e.g., In re* Baird, 16 F.3d, 383 (holding that three claimed compounds out of a prior art genus containing more than 100 million species would be found as non-obvious).
192 *See* Jerome Rosenstock, The Law of Chemical and Pharmaceutical Invention, Patent and Nonpatent Protection § 8.02[D] (2d ed. Supp. 2008). This would be more the case under the U.S. practice, so-called 'finite obvious-to-try argument'; *but see also* Darrow, *supra* note 124, para 26 (2007) (However, it is not clear how many species must be included in the prior art genus to make the claimed species non-obvious, and the case law has not provided enough data points regarding this issue).
193 *Id.*