Federal Courts Reports
Recueil des décisions des Cours fédérales

PATENTS

Appeal from Federal Court decision (2019 FC 1355) granting application by respondents pursuant to *Patented Medicines (Notice of Compliance) Regulations*, SOR/93-133 (Regulations), s. 6(1) — Decision prohibiting Minister of Health from granting marketing authorization (notice of compliance, or NOC) to appellant for its APO-ABIRATERONE product — APO-ABIRATERONE appellant's version of respondents' drug product marketed under name ZYTIGA, listed as Canadian Patent no. 2,661,422 ('422 patent) — Appellant required to address '422 patent before obtaining NOC for APO-ABIRATERONE — Alleging that '422 patent invalid for lack of patentable subject matter, obviousness, inutility — Federal Court finding in favour of respondents on all of these issues — Second decision following amendments to Regulations finding '422 patent invalid for obviousness — Minister issuing NOC for APO-ABIRATERONE — Since decision under appeal merely prohibiting Minister from doing so, present appeal moot — However, appellant noting Court's decision herein relevant to its right under Regulations, s. 8 to make claim against respondents for losses appellant suffered because of delay in obtaining NOC — Appellant noting correctly that invention obvious if person of ordinary skill in art finding it obvious to try, that being more or less self-evident that what is being tried ought to work merely factor to be considered, not requirement — This point addressed in *Hospira Healthcare Corporation v. Kennedy Trust for Rheumatology Research*, 2020 FCA 30, 316 A.C.W.S. (3d) 537 —Court noting in *Hospira* that, whereas being "more or less self-evident to try to obtain the invention" requirement for obviousness to try, being "more or less self-evident that what is being tried ought to work" (per *Apotex Inc. v. Sanofi-Synthelabo Canada Inc.*, 2008 SCC 61, [2008] 3 S.C.R. 265) not requirement but merely factor to be considered — Appellant arguing Federal Court making same error in present case as it did in *Hospira* regarding obviousness to try test — Whether Federal Court making reviewable error in its obviousness to try analysis — Federal Court not erring — Case herein distinguishable from *Hospira* — In *Hospira*, Federal Court treating "more or less self-evident that what is being tried ought to work" as requirement, its consideration of at least one of other factors inadequate — Here, Federal Court considering each of factors relevant to obviousness to try, reaching conclusion based on that consideration — Federal Court can be forgiven for its lack of clarity as to whether "more or less self-evident that it ought to work" should be considered factor in obviousness to try analysis, or requirement — Supreme Court itself giving mixed signals on this point — Court here maintaining view that "more or less self-evident that it ought to work" should be treated as factor in obviousness to try analysis, not as requirement — This appearing to be more consistent with Supreme Court's intention — Federal Court not erring in its analysis of patentable subject matter, inutility, infringement — Appeal dismissed.

APOTEX INC. V. JANSSEN INC. (A-437-19, 2021 FCA 45, Locke J.A., reasons for judgment dated March 4, 2021, 24 pp.)