The first step towards patentability law european essay

Law

INTELLECTUAL PROPERTY RIGHTS-IIPROJECT ON "A CRITICAL STUDY OF SUBSTANTIVEPATENT LAW IN INDIAN CONTEXT"SUBMITTED BY:-GROUP 8 B. B. A LL. BANSHUL AGRAWAL2010/B. B. A L. L. B (H)/009ARBAAZ HUSSAIN2010/B. B. A LL. B(H)/012TABLE OF CONTENTSPATENTABILITY- AN INNOVATIVE APPROACH ..... 41. NOVELTY- THE FIRST STEP TOWARDS PATENTABILITY ..... 61. 1. What are the criteria of "Novelty"? ..... 61. 1. 1. "State of the Art"- The Basic test of Novelty ..... 61. 1. 2 "Anticipation" of the invention- The Subsequent Test ..... 81. 1. 3. "Prior Publication"- Was it already available? ..... 91. 1. 4. "Prior User" - Has someone already used it? ..... 101. 2. Novelty "Provisions" in India- Are they adequate enough?..... 102. INVENTIVE STEP- THE SECOND TEST TOWARDS PATENTABILITY ..... 112. 1. What is "inventive step"?..... 112. 2. Criteria for judging the "inventive step" ..... 112. 2. 1. Is the invention "obvious" in nature?..... 132. 3. Inventive step "Provisions" in India- Are they adequate enough? ..... 153. UTILITY / INDUSTRIAL APPLICATION- ANOTHER CRITERION TO JUDGE PATENTABILITY OF ANINVENTION .....

The word

�Patent. signifies a monopoly right to the inventor in respect of the invention. 1 Apatent is an exclusive right granted to the person who is the inventor of an article or process or animprover of the existing article. 2 A patent was earlier referred to as an �Industrial Property. which is modernly called as �Intellectual Property.. The owner of such property is the sole dealerof the whole or part of such property. He may also authorize others to use or commerciallyexploit it. 31 35, Halsbury Laws of England, �303. (4th ed.). 2 P. Narayanan, Patent Law, 1 (4th ed. 2006). 3 31, Andrew Evans, Taming the Counterfeit Dragon: The WTO, TRIPS and Chinese Amendments

to IntellectualProperty Laws, GA. J. INT'L & COMP L. 587 at 597 (2003). 4 History of Indian Patent System, INTELL. PROP. India, available at http://www. ipindia. nic. in/ipr/PatentHistory. htm (last visited Feb. 10, 2012). 5 World Trade Organization, Intellectual Property, Overview: the TRIPS Agreement, available athttp://www. wto. org/english/tratope/trips-e/intel2_e. htm (last visited Mar. 2, 2012). 6 P. Narayanan, Patent Law, 2-3 (4th ed. 2006). 7 Biswanath Prasad Radhey Shyam v. Hindustan Metal Industries, (1979) 2 SCC 511 at 517. The philosophical argument behind patent law is the desirability of public interest that industrialtechniques should be improved and in order to encourage the improvements and the disclosure ofimprovements in a manufactured article, 4 or in machinery or in methods of production, patentlaw was devised in order to give monopoly to the person creating it for a period of twenty yearsand after the completion of these twenty years it passes into the public domain. 5 Furthermore, thegiving of monopoly is a motivating factor for the inventor as it is the only way by which he canearn profit by putting it into practice by using it himself or by deriving an advantage over hiscompetitors by its use. 6Patent Law is objected towards the encouragement of scientific research, new technology andindustrial progress. Exclusive privilege is granted for a limited period for using or selling aproduct or method to stimulate new inventions of commercial utility. 7 The fundamental principle of Patent Law is that a patent is granted only for an inventionwhich must be new and useful. That is to say, it must have novelty and utility. It is essentialfor the validity of a patent that it must be the inventor's own discovery as opposed to mereverification of what was, already known before the date of the

patent.88 Id. 9 Karnika Seth, History and Evolution of Patent Law – International & National Perspectives, Seth Associates, available at http://www. sethassociates. com/wp-content/uploads/history-and-evolution-of-patents. pdf. 10 S. 1, The Patents Act (1970). 11 S. 3, The Patents Act (1970). 12 S. 2 (j), The Patents Act (1970). 13 AIR 1978 Del 1. Patent Law in India owes its existence to the two committees headed by the Justice Bakshi TekChand and N. Rajagopala Ayengar. On 20th April 1972 Indian Patents Act, 1970 came into forcewhich was later amended thrice in 1999, 2002 and 2005. These amendments were made in orderto bring the Indian Act in consonance with the TRIPS agreement. 9A patent law is barred to have an extra territorial application. A domestic law of one countrycannot give effect to the enforcement of the patent rights in another country unless the patent isregistered under the domestic law of other country. For instance, Indian patent law is alsoapplicable only to the extent of the territorial limits of India. 10Under Indian Law, Substantive Patent Law is the "inventive matter" which is competent of grantof patent through passing the various tests of Novelty, Inventive Step and Industrial Application. But also, not every matter qualifying these qualities is patentable and also certain matters/articlesare treated as non-patentable due to their special characteristics. 11 This inventive matter referredhere, is the "invention" under Indian Patent law and is defined as:"A new product or process involving an inventive step and capable of industrialapplication." 12In Raj Parkash v. Mangat Ram Choudhary, 13 it was held that"Invention as is well known is to find out something which is not found by anyonebefore" it is not necessary that the invention should be anything complicated. Theessential thing is that the

inventor was the first to adopt it. The principle, therefore, is thatevery simple invention that is claimed so long as it is something which is novel or new, itwould be an invention...�This paper tends to focus on the substantive aspects of patent law in Indian Context. Throughthis paper, we will be analyzing the major provisions under the Indian Patents Act, 1970. Ourmain focus will be on the criteria for patentability and we will attempt to give the technicalaspects of the same. We will be focusing on various case laws in Indian context and thesettled law regarding various tests to judge patentability. Also, a critical aspect will beflowing with every criteria and this will be particularly in regard to the Indian Patents Act, 1970. Lastly, we will be focusing on the non-patentable subject matter i. e. on S. 3 & 4 of theAct. Through this we will be covering the much debated issued of S. 3(d) with reference topharmaceutical sector and MNC. s. The research methodology followed in the entire paper issecondary in nature. 1. NOVELTY- THE FIRST STEP TOWARDS PATENTABILITY1. 1. What are the criteria of �Novelty�? �Novelty� is the fundamental requirement for invention to secure a valid patent. It isinteresting to note here that novelty cannot be proved or established rather its absence has tobe proved or established. The reason being it makes no sense to grant someone a legal righton a particular thing which is already established or is in public domain. 14 Therefore, a patentis granted on something which is novel (unless statutorily prohibited or new). 14 12, Nathan Stacy, The Efficacy and Fairness of Current Sanctions in Effecting Stronger Patent Rights inDeveloping Countries, TULSA J. COMP. & INT'L. L. 263, 279-80 (2004). 15 Robert H. Hu, Research Guide to Chinese Patent Law and Practice, at app. 3 (2002). 1. 1. 1. �State of the Art�- The

Basic test of NoveltyNovelty has to be determined considering the knowledge available anywhere in the world onthe date of filing of the patent application. 15 The basic definition of novelty depends on thequestion of what matter to be regarded as not forming the "state of the art".The state of the art in the case of an invention shall be taken to comprise all matter(whether a product, a process, information about either, or anything else) which has at anytime before the priority date of the invention been made available to the public (anywherein the world) by written or oral description, by use or any other way."1616 S. 2(2), UK Patents Act (1977). 17 P. Narayanan, Patent Law, 372 (4th ed. 2006). 18 Merell Dow v. Norton, [1994] RPC 1 at 10, 13. 19 N. R. Subbaram, Patent Law Practices & Procedures, 41 (2nd ed. 2007). 20 Id at 42. 21 Manual of Patent Practice and Procedure, The Patent Office, India, 7 (2005), available athttp://www. patentoffice. nic. in/ipr/patent/manual-2052005. pdf. 22 P. Narayanan, Intellectual Property Law, 79 (3rd ed. 2011). 23 AIR 1953 Nag 154. The term "matter" used in the above quoted definition, must consist of clear, unequivocal andunmistakable directions which enable the public to produce the claimed product. 17 The factthat the public is not aware about the existence of such matter is irrelevant in such cases as ithad still formed the part of the state of the art. 18State of the art and prior art are treated synonymously as prior art denotes the totalcomprehensive knowledge that existed prior to the filing of or priority date of the patentapplication on the relevant subject. 19 The knowledge of an invention in order to be consideredas relevant prior art should satisfy anyone of the following conditions: 20i. The description of invention should be published in writing or

document or in anyother tangible form. ii. The description of the invention should be publicly spoken, such a disclosure isknown as oral disclosure. iii. By using the invention in public or by putting it in such a manner that it isaccessible to public at large. 21The importation into India of a product made abroad by a patented process will constituteknowledge or use in India of the invention on the date of importation except where suchimportation was made for the purpose of reasonable trial or experiment. 22It was held in Bombay Agarwal Co. v. Ramchand Diwanchand23 that subject-matter of patent, means the exact advance upon the existing knowledge which the patentee claims. The patentcan be defeated if it is not a new manufacture or improvement, thereby indicating that quamanufacture it was being indulged in by others prior to the date of this patent.2424 Id at 8. 25 S. 23, Indian Patents (Amendment) Act (2005). 26 General Tire & Rubber Co. v. Firestone Tyre & Rubber Co., [1972] RPC 457 at 485. 27 Schroeder v. Owens-Corning Fibeglas Corpn., 185 USPQ 723 (9th Cir 1975). 28 Shanklin Corpn. v. Springfield Photo Mount Co., 521 F 2d 609. 29 Stahlwerk Becker. s Patent, [1919] 36 RPC 13. 30 [1963] RPC 61. 31 Fomento Industrial SA Biro Swan Ltd. v. Mentmore Manufacturing Co., [1956] RPC 87. 32 Quantel Ltd. v. Spaceward Microsystems Ltd., [1990] RPC 83. S. 64 of the Indian patent act talks about the revocation of the patent on the grounds of itbeing not novel. The Indian Patents (Amendment) Act 2005, states that after an applicationfor a patent has been published and before the grant of a patent, the grant of patent may beopposed on the ground of novelty. 251. 1. 2 Anticipation of the invention- The Subsequent Test Anticipation. is the word commonly used to assess the impact of the prior state of the art onthe later invention in

order to determine that whether the operation of the prior product orprocess forestalls the later patent. 26 To anticipate a claim for patent, a single prior source mustcontain all its essential elements. An invention is said to be anticipated only if anotherinvention already known or used is identical in substance. 27 A prior art reference mustdisclose all the elements of the claimed inventions or their equivalents functioning inessentially the same manner. 28 Prior use can demolish novelty if it discharges information inthe same manner that a publication would do- that is, a skilled worker must be able to realizeand reproduce the invention through observation and analysis of the use. 29 In Van Der Lily(C) NV v. Bamfords30, a photograph of hay rake machine was sufficient enough to reveal theintention of the photographed object to an informed person and thus it was held that suchphotograph anticipated the patent application for a hay rake machine. It is a settled law that relatively minor acts are sufficient to anticipate, but more may beneeded because the anticipation has to be of the invention itself. 31 Moreover, anticipationrequires enabling disclosure and this enabling disclosure had to provide clear andunmistakable directions to its addressee. 32 For there to be anticipation, the common generalknowledge should allow the skilled person to select or secure the starting material or to makeintermediate products. 33 Anticipation cannot be avoided merely because an element isundisclosed in a prior art reference. 3433 Asahi Kasei Kogyo KK. s Application, [1991] RPC 485, see also Biogen Inc. v. Medeva plc, [1997] RPC 1. 34 Schering Corpn. v. Geneva Pharmaceuticals Inc., 339 F 3d 137 (Fed Cir 2003). 35 Glaverbd v. British Coal Corp., [1994] RPC 443 at 504-506. 36 P. Narayanan, Intellectual Property Law, 79 (3rd ed. 2011). 37

Genentech. s Patent, [1989] RPC 147 at 204. 38 AIR 1986 SC 712 at ¿5. 39 Id at ¿6. 1. 1. 3. ¿Prior Publication¿- Was it already available? A comparison between the claims made by the patentee and prior publication should be donein order to check whether the information provided in the prior document is equal in practiceto that imparted in patentee. s claim. 35 Mere publication is not sufficient to establish publicknowledge. Rather it is important that a thing must be publicly known even though notpublished in a document. The publication must be such that the person to whom theinformation is communicated must be free to use it as they please which includes freedom tocommunicate the information to others. 36 The ¿public. here refers to the workmen ordinarilyskilled in the particular art. It is the class of the persons to whom the specification isaddressed. Publication does not depend either upon anything in the nature of a dedication to the public orupon the degree of dissemination of the information alleged to have been published. It issufficient if the information is made available to the public. The information must have beenavailable to atleast one member of the public who was free in law and equity, to use it. 37In the case of Monsanto Co. v. Coramandal Indag Products (P) Ltd., 38 it was held that tosatisfy the requirement of being publicly known it is not necessary that it should be widelyused to be knowledge of the consumer public. As per the court it is sufficient if it is known tothe persons who are engaged in the pursuit of knowledge of the patented product or process, either as man of science or man of commerce, consumers. 39In the present law, publication for the invention not only in India but anywhere in the worldmay be considered for determining novelty. 40 But, a mosaic of publications from which

heinvention could be extracted by studying, collating and applying a number of facts spreadover various publications would not be sufficient to invalidate a patent. 4140 P. Narayanan, Intellectual Property Law, 81 (3rd ed. 2011). 41 J. Mitra and Co. Pvt. Ltd. v. Kesar Medicaments and Anr., 2008 (36) PTC 568 Del. 42 Kalyan C. Kankanala, Arun K. Narasani & Vinita Radhakrishnan, Indian Patent Law and Practice, OxfordPublications, 32 (2010). 43 M. B. Rao & Manjula Guru, Patent Law in India, Wolters Kluwer, 71 (2010). 44 Id. Novelty of an invention is determined in the light of a single prior art, reference and variousprior art references cannot be combined for analyzing novelty. In order to anticipate aninvention all element of the invention must be present in a single prior art reference. Thoughthe elements are not directly present, they may be inherently present in the prior art reference. Novelty analysis must be made by comparing elements in the prior art with that of theinvention, element by element. 421. 1. 4. &#65533;Prior User&#65533; - Has someone already used it? The novelty requirement in patent grant ensures that a patented invention has not been donebefore, i. e. the invention is not covered by prior art. It predicates that the public is not alreadyin possession of the invention. As long as the whole invention is not found in a single deviceor described in a single publication in existence before the invention. s creation, the inventionis considered novel. 43Patent protection is granted only if the public is not already in the knowledge of the invention. However, novelty does not concern itself with how much of an advance over the current arethe invention embodies. Whether the invention involves any significant scientific advance is amatter dependent on other criteria of patentability. Whether the invention is obvious and thatis different while

considering whether there is novelty in the invention. 441. 2. Novelty
�Provisions� in India- Are they adequate enough? Earlier the Patents Act,
involved determining if an invention is anticipated or not by way of
priorpublication, prior public knowledge or prior working. While these tests
are still continuing, anew definition was introduced in 2005 defining a �new
invention.. This definition makes thenovelty condition absolute and not
relative in the Indian Territory with regard to anticipation byprior public
working. In addition, the phrase ? ?the subject matter has not fallen in the
publicdomain or that it does not form part of the state of the art? aims at
applying the maximumpossible standard of novelty to an invention for which
a patent application is filed. The definition of patent uses the term
?invention. 45, as opposed to a ?new invention. 46, thusamounting to
disparagement between the two legal provisions, resulting in widening the
ambit ofcriteria of patentability. Therefore, this addition of new definition
through the 2005 amendmentdefeats the object and purpose of the term
?invention.. 4745 S. 2 (1) (j), Patents Act (1970). 46 S. 2(1) (l), Patents Act
(1970). 47 Elizabeth Engdahl, India Alters Patent Views: The New Law Looks
More Innovation Friendly and Mostly TRIPS-Compliant, LEGAL TIMES 56 at 58
(11th July 2005). 48 D. K. Nauriyal, TRIPS-Compliant New Patents Act and
Indian Pharmaceutical Sector: Directions in Strategyand R & D, INDIANJ.
ECON. & Bus., 189 (2006). 2. INVENTIVE STEP- THE SECOND TEST TOWARDS
PATENTABILITY2. 1. What is ?inventive step?? Inventive step is considered
to be the toughest and ambiguous criteria for qualification ofpatentability. An
invention is required to possess an inventive step in order to be eligible
forgrant of patent. Under s. 2 (1) (ja), two conditions are needed to be

satisfied to qualify as beinginvolving an inventive step. Firstly, the invention should be technically advanced in the light ofthe prior art or should have economic significance or both. And secondly, the invention shouldbe non-obvious to a person having ordinary skill in the art in the light of prior art. 48 Whereas, theAct is silent as to what will constitute "technical advancement or economic significance. and alsodo not provide any guidelines so as to determine the non obviousness of the invention from thepoint of view of the ordinarily skilled person in the art. 2. 2. Criteria for judging the "inventive step"Determination of novelty and an inventive step is a mixed question of law and fact. 49 Theapplication of an old device to an invention will be novel if it results in removal of earlierdifficulty if such an adoption involved ingenuity. 50 In India the following steps are followedto analyse or determine the inventive step: 49 Biswahanath Prasad Radhey Shyam v. Hindustan Metal Industries, (1979) 2 SCC 511 at "69. 50 Bajaj Auto Ltd. v. TVS motor Co. Ltd., CIVIL APPEAL No. 6309 of 2009 (Arising out of S. L. P.(C) No. 13933 of2009). 51 Draft Manual of Patent Practice and Procedure, The Patent Office, India, "3. 14. 1 (2008). 52 Biswahanath Prasad Radhey Shyam v. Hindustan Metal Industries, (1979) 2 SCC 511 at "21. 53 Id at "27. 54 Garware Wall Ropes Ltd. v. Mr. Anant Kanoi and Ors., 2006 (TLS) 216. 55 Bilcare ltd. v. Amartara Pvt. Ltd., MIPR 2007 (2) 42 at "55. a. Determining scope and content of the prior art to which the invention pertains; b. Assessing the technical result (or effect) and economic value achieved by theclaimed invention; c. Assessing differences between the relevant prior art and the claimed inventiond. Defining the technical problem to be solved as the object of the invention toachieve the result. e. Final determination of

non-obviousness, which is made by deciding whether aperson of ordinary skill could bridge the differences between the relevant prior artand the claims at issue. 51It is a settled law that the improvement or the combination must produce a new result or a newarticle or a better article than what already existed, to be patented. 52 It has also been laid downthat an invention must not be the obvious or natural suggestion of what was previously knownand if a person was able to make the invention based on the knowledge existing on the prioritydate, the invention would lack inventive step. 53An invention should be more than a workshop improvement and should be outside theprobability of a craftsman in order to have an inventive step. 54 If the invention is the nearcombination of various elements existing in different prior art references and such a combinationdoes not require any exercise of inventive faculty, it is not novel and will lack inventive step. 552. 2. 1. Is the invention obvious in nature? The word obvious. is an ordinary English word and does not have in patent law any technicalmeaning. It means something which lies in the way, and is used in its normal sense ofsomething which is plain or open to the eye or mind, something which is perfectly evident toa person thinking on the subject. Not everything that is new is inventive, 56 and a thing may beold without being obvious. 5756 Gadd and Mason v. Manchester Corp. (1892) 67 LT 569 at 578. 57 Sacharin Corp. Ltd. v. Anglo Continental Chemical Works, [1900] 17 RPC 307 at 315. 58 PLG Research Ltd. v. Ardon International Ltd,, [1995] RPC 116 (CA). 59 General Tyre v. Firestone Tyre, [1972] RPC 457. 60 Press Metal Corp. Ltd. v. Noshir Sorabji Poch Khanawalla, AIR 1983 Bom 144. 61 Farbewerke Hoechst v. Unichem Laboratories, AIR 1969 Bom 255. 62 F.

Hoffmen La Roche ltd. and Anr. v. Cipla Ltd., 2009(40)PTC125(Del). The philosophy behind the doctrine of obviousness is that the public must not be preventedfrom doing anything which was merely an obvious extension or workshop, variation of whatwas already known at the priority date. 58 Obviousness must not be assessed in the light ofcarefully selected pieces of prior art alone. 59The test is whether what is claimed is so obvious that it could at once occur to anyoneacquainted with the subject and desirous of accomplishing the end. To determine non-obviousness of an invention the prior art references may be combined from the point of viewof the person skilled in the art. 60 If a person skilled in the art can combine prior art referencesto make the invention without exercising any inventive faculty or imagination, then theinvention would be obvious. If the problem solved by such invention is obvious to the personskilled in the art then invention will tend to become obvious. To answer the question of obviousness it has to be determined that "whether for practicalpurposes, it was obvious to a skilled worker, in the field concerned in the state of knowledgeexisting at the date of the patent to be found in the literature then available to him, that hewould or should make the invention the subject of the claim concerned?"61In the case of F. Hoffmen La Roche62 the court laid down the test of obviousness as to determinewhether in the light of prior art, it was possible for a normal but unimaginative person skilled inthe art to discern the inventive step of the invention on the basis of general common knowledgeof the art at the priority date and also whether the differences between the prior art would, without knowledge of the alleged invention, constitute steps which could have been obvious tothe skilled man or whether they required any degree of invention.

63 The court further stated thatthe inventive step should be something that could not have been discernable to the unimaginativeperson skilled in the art and not something which was published in the prior art. 6463 Id at ¶24. 64 Id at ¶25. 65 P. Narayanan, Intellectual Property Law, 84 (3rd ed. 2011). 66 383 U. S. 1, 17-18 (1966). 67 43 F. 2d 588 (7th Cir. 1976). An inventor may well arrive at his invention by a flash of genius which causes him nodifficulty or concentrated thought at all, but the invention may still be a most brilliant onewhich would never have occurred to the notional skilled reader in the art at all or afterprolonged investigation and the concentrated exercise of his, perhaps lesser, inventive faculty. In such a case, though it is in a sense obvious to the inventor, nevertheless the invention maybe worthy of patent protection. 65The question of obviousness is ultimately one for the court and not for the witnesses thoughundoubtedly the evidence of the witnesses may help the court to arrive at its decision. It mustbe decided objectively by taking into account all the relevant circumstances of the case. 2. 2. 1. 1 Graham. s Test - To judge the obviousnessTo determine the basic standards of obviousness the U. S. Supreme Court, in Graham v. JohnDeere Co66, laid down a four pronged test (Graham test) which are the following:¶ The scope and content of the prior art.¶ The structural similarity between the prior art and the claimed invention.¶ Indication of non-obviousness and commercial success.¶ The level of ordinary skill in the pertinent art. This test later resulted in the synergism of the existing product thereby produced a synergisticeffect effect in the Burland v. Trippe Manufacturing Co. 67 but later this test was affirmed by theSupreme Court. Graham¶s test still holds valid and is also applicable in India to determine non-obviousness. 6868 K. D.

Raju, Interpretation Of Section 3(D) In The Indian Patents Act 2005: A Case Study Of Novartis, [2008]INJlIPLaw 2, also available at http://www. commonlii. org/in/journals/INJlIPLaw/2008/2. html. 69 China's WTO Achievements Recognized, CHINA DAILY, (15th Dec. 2005). 70See http://www. european-patent-office. org/ legal/gui_lines/e/c_iv_9_10_4. htm. 71 11, Louis Sorell, A Comparative Analysis of Selected Aspects of Patent Law in China and the United States, PAc. RIM. L. & POL'Y J. 319 at 336 (2002). 72 40. 16, A Confusing Patent Law for India, Economic and Political Weekly, 1576-1579 (Apr. 16-22, 2005). 2. 3. Inventive step Provisions in India- Are they adequate enough? It is not settled if the classical test of inventive step will have preference over the newlyintroduced test of economic significance.. The examiner of patents cannot be prevented fromconducting first the economic significance enquiry and then proceeding to ascertain if theinvention passes the test of non-obviousness. The other aspect of the definition - technicaladvance as compared to the existing knowledge. and its application in an inventive step enquiryis yet to be explained in the context of examination of a patent application or a judicial scrutinyof the validity of a granted patent. More significantly, the 2005 amendment changed the definition of 'inventive step', from thecommonly accepted definition of " not obvious to a person skilled in the art" by adding that afeature of the invention that involves either a technical advance or having economic significanceor both also meets the standard of inventive step. It is quiet unlikely that economic significanceis a factor included in any other patent legislation and moreover, is also contentious in manyjurisdictions. 69 A perusal of the detailed guidelines of the European

Patent Office for patentexaminers, available on its web site, 70 makes it clear that commercial success can be used as anindicator of inventive step only where such success is attributable to the technical features of theinvention. 71 These definitions of novelty and inventive step appear to go in favor of patentapplicants who would like the bar on patentability to be lowered so that even inventions that arenot truly novel or inventive can slip past the patent examination process. 723. UTILITY / INDUSTRIAL APPLICATION- ANOTHER CRITERION TO JUDGEPATENTABILITY OF AN INVENTION3. 1. Is the invention "useful"? One of the essential requirements of patentability is the condition that it should be useful innature but the criteria to determine the usefulness of any invention has not been defined. S. 2(1) (j) of the Patent Act says that a new product or process which involves an inventive stepif is capable of industrial application then it can be considered as invention. Now, at thisjuncture it is necessary to identify what kind of inventions would be considered to be capableof industrial application. S. 4 (1) of the U. K. Patents Act, 1977 states that "An invention shallbe taken to be capable of industrial application if it can be made or used in any kind ofindustry""3. 2. Criteria for judging "utility"? The criteria of "utility. should be judged with reference to state of things at the date of thepatent. Utility is a portion of degree, and always has reference to some object. "Utility forwhat. is a question which must be always asked, and the answer must be useful for purposesindicated by the patentee. It is important to note here that commercial success or failure hasno relevance in judging the question of utility of a patent. The recognized rule is that theutility of an invention depends upon whether, by following the directions

of the patentee, theresult professed to be produced may in fact be produced. 7373 Terrel on the law of Patents, 98 ¿248 (11th ed.). 74 Edison and Swan Electric Light v. Holland, [1889] 6 RPC 243 at 283. 75 Farbwerke Hoechst AG Meister Lucius & Bruning Corp. v. Unichem Laboratories, AIR 1969 Bom 255; See alsoLaxmi Dutt v. Nankau, AIR 1964 All 27 at 33. Subsequent improvements rendering the invention obsolete or commercially of no value, cannot be considered as useless if on the date of the patent the invention was useful. 74 Thepractical usefulness or commercial utility of the invention does not matter, nor does it matterwhether the invention is of any real benefit to the public, or particularly suitable for thepurposes suggested. It is the only failure to produce the results promised that will invalidatethe patent, not misstatements as to the purposes to which such result might be applied. 75 Theremay be cases in which the result which the patentee claims to have produced can in fact beproduced, but the result produced cannot be applied to one or more of the purposes for whichthe patentee claims that it can be applied. In such a case the patent may not necessarily bevoid. 7676 29, Halsbury. s Laws of England, 59 ¿123 (3rd ed.). 77 AIR 1926 Cal 152. 78 AIR 1943 Lah 247. 79 Lane-Fox v. Kensington & Knightsbridge, [1892] 9 RPC 413 at 417. In the case of Indian Vaccum Brake Co. Ltd. v. E. S. Luard, 77 it was held that the term 'utility'used in the Act has been used in a special sense. Mere usefulness is not sufficient to supportthe patent. In the case of Vidya Prakash v. Shah Charan Singh78 the Lahore High Court heldthat the points which are to be considered in the case of an infringement of a patent arewhether the invention had utility, whether it was or was not a new invention and whether theinvention was properly described in the

specification. The utility of an alleged invention depends not on whether by following the directions in thecomplete specification all the results necessary for commercial success can be obtained, buton whether by such directions the effects which the patentee profess to produce could beproduced. To judge the utility, the directions in the specifications must be followed and if theresult is that the object sought to be attained by the patentee can be attained, and is practicallyuseful at the time at which the patent is granted, the test of utility. is satisfied. 793. 3. Industrial Application in India- a grey test of patentabilityThe amount of industrial application required to support a patent is very less. What kind ofinvention can be applied industrially has not been defined anywhere in the statute whichmakes it quite subjective to decide the utility of the patent. S. 2 (j) of the Patent Act only saysabout the invention which can be industrially applied and is silent about how it can beindustrially applied which as a result is making it much more difficult to determine theapplicability of this test. 4. THOUGH INVENTIONS: STILL NOT PATENTABLE !! It is not always the criteria that the inventions satisfying the criteria of patentability, i. e., novelty, inventive step and utility, are always patentable. In India sections 3 and 4 of the Actstipulates those inventions for which patents cannot be secured though they fulfill all theessential criteria of patentability. According to Art. 27 of the TRIPS the member countries arenot required to grant patents, if the commercial exploitation of such invention, is necessary toprotect public order (ordre public) or morality including to protect human, animal or plant lifeor health or to avoid serious prejudice to environment. 80 The implications of ordre publicwere considered by courts in the case of Harvard Oncomouse. 81 Furthermore, patent is notrequired to be

granted for following inventions: 80 Commission on Intellectual Property Task Force on TRIPS, Dept. of Policy and Business Practices, Initial Viewson the Post-Doha Agenda of the Council for TRIPS, (June 24, 2012), available athttp://www. wto. orgenglish/forums-e/ngo-e/icc-trips-e. do. 81 1991 EPOR 525. 82 S. 3 (a), Patents Act (1970). 83 AIR 1926 Cal 152. 84 S. 3 (b), Patents Act (1970). 85 Art. 53 (a), The European Patent Convention (1973). i. Diagnostic, therapeutic and surgical methods for the treatment of humans andanimals. ii. Plants and animals other than micro-organisms and essentially biological processesfor the production of plants and animals other than non-biological processes. 4. 1. Frivolous inventions: Not patentableFrivolous inventions and inventions which are in contravention to the natural laws are notpatentable. 82 In the case of Indian Vacuum Break Co. Ltd. v. E. S. Luard83 it was held thatpatent for making one piece articles which were formally prepared in two or more piecescould not be called to be a valid patent and was frivolous. 4. 2. Contrary to "ordre public" or morality: Not patentableThe inventions which are contrary to public order and morality are also non patentable. 84 TheEPC states:"Inventions, the commercial exploitation of which would be contrary to ordre public ormorality, such exploitation shall not be deemed to be so contrary nearly because it isprohibited by law or regulation in some or all of the contracting states."854. 3. "Discovery": Not patentableA mere discovery is not a subject matter of the patent. Discovery adds to human knowledge, but it does so only by lifting the veil and describing something which before had been unseenor hazily seen. 86 On the other hand inventions not only add to human knowledge but alsodisclose something new which necessarily

involves a suggestion of an act to be done. Therefore, the mere discovery of a scientific principle or formulation of an abstract theory ordiscovery of any living or non-living thing is not patentable. 87 It is the practical conversion ofthe idea or discovery which leads to patentable inventions and in order to convert thediscovery into patentable inventions the person must do something new intellectually which ismore than a mere finding. 8886 Renolds v. Hebert Smith, [1903] 20 RPC 123 at 126. 87 S. 3 (c), Patents Act (1970). 88 N. R. Subbaram, Patent Law Practices & Procedures, 78-79 (2nd ed. 2007). 89 S. 3 (d), Patents Act (1970). 90 97, Amy Kapczynski, Harmonization and Its Discontents: A Case Study of TRIPS Implementation in India'sPharmaceutical Sector, CAL. L. REV., 1571 at 1579 (2009). 91 2. 2, Rochelle Chodock, TRIPS: Transformation of the Indian Patent System and Its Effect on the IndianPharmaceutical Sector, ABA ScITECH L. 4 (2005). 92 Lionel Bentley & Brad Sherman, Intellectual Property Law, Oxford University Press, 379 (2001). 4. 4. Sec. 3(d): No efficacy, Not patentableThe mere discovery of a new form of known substance which does not result in theenhancement of the known efficacy is not patentable. 89 The finding out of a new property or amere new use of a known substance is not patentable. Similarly, finding a new use of a knowndevice or apparatus without any additional inventive ingenuity in the said machine orapparatus is also not patentable invention. The ﷺexplanation. given to s. 3 (d) of the Act signifies that if one desires to secure patent on aderivative then it should contain detail substantiating information about the enhanced efficacyof such derivative as compared to the original substance. 90 In other words, the specificationshould contain comparative data of the efficacies of the known

substance and the derivativeconcerned and established without any doubt the unexpected and unique characteristics of thederivatives as compared to the original compound. 91If a person finds a new property of known material or article and puts the property to apractical use the invention may be patentable. 92 A new use of an old product unless there isinvention in the adaptation of the old product to the new use, is not patentable. 93 Also, mereinstruction on the pack containing only old material cannot make the contents in the containera manner of new manufacture and hence not patentable. 9493 Acetylene Illuminating Co. Ltd. v. United Alkali Co. Ltd., [1904] 22 RPC 145 at 147. 94 Id at 149. 95 Sanjeev Chowdhary, Remember the Mashelkar Panel Report, The Economic Times, 6 (27th July 2006). 96 S. 3 (e), Patents Act (1970). 97 N. R. Subbaram, Patent Law Practices & Procedures, 82 (2nd ed. 2007). 98 S. 3 (f), Patents Act (1970). 99 N. R. Subbaram, Patent Law Practices & Procedures, 83 (2nd ed. 2007). There was seen to be a considerable pressure on the government especially by MNCs toenlarge the scope of patentability u/s 3 (d). Also the Mashelkar report suggested a finding ofthe ambit of what constitute patentable pharmaceutical substance, by allowing patent of slewof structural and physical modification, incremental innovations, which the country. s patentlaw currently denies. 954. 5. Composition having sum properties: Not patentableA composition containing atleast two ingredients in which the ingredients interact one onotherresulting in a composition, having the sum properties of each of the ingredients is notpatentable. 96 On the other hand, if their combination results in a composition havingsynergistic effect namely, resulting in a composition having different and/or unexpectedproperties as

compared to the individual ingredients employed, such composition ispatentable. This is because; it is not known hitherto that such a combination has saidproperty. 974. 6. Juxtaposition of features: Not patentableA mere juxtaposition of features of an already known device which has already been chosenfrom among the number of different combination does not constitute a patentable invention. 98Similarly, when two or more features of an apparatus or a device are known and they arejuxtaposed without any interdependence of their functioning of the apparatus or device, it issupposed to be already known and consequently has no inventive step and therefore notpatentable. 994. 7. Method of treatment: Not patentableMethod of treatment of a human body by surgery, curative or other methods is not aninvention and therefore is not patentable. 100 Similarly a method of improving or changing theappearance of human body or parts of it is also not a patentable invention. 101 However, theinvention relating to the processes of synergistic medicine/drug/fertilizer or a advice forperforming the operation are patentable if they satisfy the three essential criteria as has beendealt earlier in this paper. 100 S. 3 (i), Patents Act (1970). 101 Art. 27 (a), Trade Related Aspects of Intellectual Property (1995). 102 Elizabeth Verkey, Law of Patents, Eastern Book Company (2nd ed. 2012). 103 S. 3 (j), Patents Act (1970). 104 Rajkumar Dubey, Making it TRIPS Way - India's New Patent Regime, MONDAQ Bus. BRIEFING, (18th July2005) available at 2005 WLNR 11268677. 105 447 U. S. 303 1980. A method therefore does not become non- patentable if there is no functional link and nophysical causality between its constituent steps carried out in relation to therapy advice andthe therapeutic effect produced on the body by that

device. 1024. 8. No patent on plants, animals, etc. but micro-organisms No patents can be granted for the plants or animals, parts of the plants or animals, seeds, plantvarieties, species and for essentially biological processes for the production or propagation ofanimals or plants. 103 It may be recalled here that TRIPS provisions mandates all the membercountries to provide protection for new micro-organisms. Accordingly s. 3(g) is inconsonance with the TRIPS provisions but the term micro-organisms has not been definedanywhere in the act. 104 The decision of the Supreme Court in Diamond v. Chakraborty105 heldthat micro-organisms produced by genetic engineering are not excluded from patentprotection. 4. 9. Atomic Energy: Not patentableS. 4 of the Patent Act stipulates that no patent shall be granted in respect of an inventionrelated to atomic energy falling within sub section (1) of s. 20 of the Atomic Energy Act, 1962. The question as to whether or not an invention relates to atomic energy or not will bedecided by the Central Govt. It has been held that the question whether the opinion of theCentral Govt. under s. 20 (1) of the Atomic Energy Act was properly arrived at or not, cannotbe the subject matter of an appeal under the act. 4. 10. Non-patentable subject-matter provisions in India- Are they adequateenough? In case of pharmaceutical substances the most pertinent question is related to the increase,efficacy. rather than the new substance. 106 The standard of efficacy. is nowhere defined inthe Patent Act or the Rules. This is in a way harmful for a country which is vigorouslyallowing more and more Foreign Direct Investment in the pharmaceutical sector107 with anincreasing level of patent protection. 108106 29, Merri C. Moken, Fake Pharmaceuticals: How They and Relevant Legislation or Lack Thereof

Contribute toConsistently High and Increasing Drug Prices, Am. J. L. & MED. 525, 525 (2003). 107 Tushar Poddar, Goldman Sachs & Eva Yi, India's Rising Growth Potential, Global Economics Paper, 4 (2007), available at http://www. usindiafriendship. net/viewpointsl/IndiasRisingGrowthPotential. pdf. 108 India Set For Solid Growth in Pharmaceutical Industry, PwC Report, (1st Aug. 2005), available at 2005 WLNR12162024. 109 Eric Bellman, India Senses Patent Appeal; Local Companies Envision Benefits in Stronger Protection, WALLST. J. (Eastern Ed.) (11th Apr. 2005)110 99, Frederick M. Abbott, The WTO Medicines Decision: World Pharmaceutical Trade and the Protection ofPublic Health, AM. J. INT'L. L. 317, 320 (2005). 111 41, Rajarshi Sen & Adarsh Ramanujan, Pruning the Evergreen Tree or Tripping up Over TRIPS?- Section 3(d)of the Indian Patents Act, 1970, INT'L REV. INTELL. PROP. & COMPETITION L., 170 at 18(2010). The object behind the amendment in 2005 was with the sole intention to wider the ambit orscope of patenting. The legislator. s intention was to include discovery of a known substancewhich has greater efficacy than the known substance. 109 S. 3 (d) permits patenting of not onlythe pharmaceutical products but also the new forms of known substances provided that theyhave a higher standard of efficacy. Moreover, International law is silent on the definition ofefficacy. 110 Also, the intention of the legislature can be construed as being preventing MNCsfrom ever greening. their patents through recombination of the known substances. 111CONCLUSIONTen years time was given to India to comply with the provisions of TRIPS, almost 17 years havebeen passed but still India is struggling to match up with the provisions of TRIPS. This is wherea developing country like India which is considered to be one of the

fastest growing economiesstands in respect of Intellectual Property. The entire discussion in this paper starting throughnovelty till non-patentable subject matter shows only one thing which is the broad nature of theprovisions to determine patentability. This is what we call the substantive patent law of India, onthe basis of which patentability criteria of any invention is determined. Through this paperauthors have realized that there are certain flaws in the law which is needed to be tackled quicklyin order to match up with the Patent laws of other nations. Firstly, the definition of "NewInvention" which was introduced in 2005 has further increased the ambit of criteria ofpatentability making it more difficult to determine the novel character of an invention. Secondly, the only provision which defines "Inventive Step" in the Patents Act has not given a clear cutdefinition and has thereby left it again upon the judges to decide on the basis of facts andcircumstances of the case. Thirdly, the test of industrial application or utility to determinepatentability is silent in terms of how an invention can be applied industrially and thus making itvery difficult to assess patentability. Lastly, since the standard of "efficacy. as related topharmaceutical substances has not been defined in the statute the main purpose of nonpatentability of certain inventions is losing its purpose as increasing level of protection is beinggiven to pharmaceutical substances.