

# Intellectual property rights



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## **Intellectual Property Rights**

Intellectual property can be instrumental to the value of any business. The ability to protect a business or an individual's ideas, inventions and original processes is something that is considered essential to many establishments, particularly those that rely on innovative ideas and products as their unique selling point.

Intellectual property rights span a wide range of situations and products, although the most common rights are designs, copyright, patents and trade marks. Each of these intellectual property rights aims to protect a different area of invention. Copyright protects works such as art or music; design protects the physical appearance of a product; trade marks protect the way in which a trader separates himself from his competitors; and patents protect the method by which a product is technically made up and functions.

This latter category of intellectual property right can cause considerable difficulty to those applying for protection and those attempting to enforce existing rights. Technology and the associated functions are changing constantly and often being tweaked or altered to meet a new requirement. At what point does this become patentable and distinct from the original technology? This requirement to be innovative in some way is the subject of much debate. Determining when that extra step results in a new protectable technological item is the key to ensuring that the correct items are offered protection. Courts have grappled with the relevant issues in determining whether or not a patent should be protected and when an attack on validity should be successful. Throughout the years, various tests have been

forwarded by the courts; however, consistency in relation to obviousness and the concept of novelty and invention have proved particularly troublesome and are often hotly debated in court proceedings.

### Elements of Patent Law

Before determining the way in which the courts deal with the issues surrounding obviousness and novelty, it is first important to gain an understanding of what must be established in order to establish a valid patent, successfully.

The basic definition of what is patentable is contained in Section 1(1) of the Patent Act 1977 (the “ Act”). This Act states that in order to be patentable the invention must be new, must involve an inventive step and be capable of industrial application. The Act then goes on to consider each of these requirements, in more detail.

Section 2 deals with the requirement that the invention is new. This requirement is commonly referred to as the “ novelty” requirement. Section 2(1) states that for an invention to be novel or new it must not form “ part of the state of the art”. Section 2(2) goes on to consider what “ state of the art” actually encompasses. It defines state of the art as any matter (i. e. product, process, etc. ) that has previously been made available to the public by either a written or oral description. Simply put, if the invention has already been made available to the public, it is not going to be eligible for patent protection.

When determining whether or not an invention is new or novel, the issue of whether or not it has been made available to the public will become central. The invention, in order to be considered in the public domain, must have been disclosed to at least one member of the public, who could if he wished use the information freely and the disclosure had to be sufficiently enabling. Sufficiently enabling means that the information contained must be such that someone who has a reasonable level of skill in the area to which the invention relates would be able to implement and make use of the disclosure. The disclosure must be in relation to one document (or one document with several others interlinked) and cannot simply be disclosure obtained from a “ mosaic” of documents.

There are exceptions to this rule in relation to disclosure that allow a patent still to be established where the disclosure has been made within six months of the patent application and has been done in confidence.

Pulling these factors together, it is clear that the need for novelty insists on the patent being completely new and innovative. Although, based on the mosaic rule, the collection of previous documents and information to create a new invention will not be barred from receiving patent protection.

### The Issue of Novelty

From looking at the above breakdown of what an individual has to prove in order to establish a valid patent, it is clear to see that the issue of novelty is central to most patent decisions. The Section 2 requirement for novelty contained in the Act is a corresponding provision of Articles 54 and 55 of the European Patents Convention (1973) (“ EPC”).

As a general rule, an invention is not novel if the amalgamation of features has already been anticipated in a previous disclosure. This point was considered in detail in the case of SmithKline Beecham Plc's Patent [2006] RPC 10. In this case, it was held that for there to have been that degree of anticipation, there must firstly have been a disclosure and there must secondly have been the element of enablement. That is, based on the disclosure, the suitably skilled individual receiving the details of the process would have been able to replicate the process disclosed.

Pulling together both of these elements will allow the court to decide whether or not the patent before them is novel or not.

Let us first consider the element of disclosure. When it comes to determining whether or not the specific invention has been previously disclosed, the question is not whether the prior disclosure was for an item of similar utility, i. e. it does not necessarily have to solve exactly the same problem as the current invention. In deciding this matter, courts have stated that in order to be a conflicting patent, the situation previously disclosed must be so close to the new invention that the utility gained by the new invention would be a practical certainty. This suggests that in order to establish a valid objection to a patent application on the basis of a prior disclosure, it would have to be shown that the prior invention was inextricably linked in terms of function to the new invention. Therefore, even if something similar has been previously disclosed, provided it is not close with the degree of inevitability that is required, the patent application will not necessarily fail on the basis of not being novel.

A general disclosure of a possible process does not impact on the novelty of an invention; however, where there is a series of processes, each individual process could be the reason for a future patent application failing, due to lack of novelty.

Secondly, there is the element of enablement. This means that whatever has been disclosed must be sufficient for a person, skilled in the relevant art, to copy or replicate the process or invention. This enablement provision should be thought of separately to the disclosure, as in the case of disclosure the information must be sufficient for a skilled individual to understand the disclosure. For the purpose of enablement, the skilled person must be capable of actually utilising or at least trying to utilise the relevant invention.

When it comes to determining whether or not the invention is novel, therefore, several issues need to be considered. It is not simply a matter of determining if something similar has ever been made public. It must have been made public with sufficient clarity as to allow the invention to have been understood and put into effect by another third party. The patent, therefore, in order to gain protection, must offer a solution to a situation that has not been possible to achieve before and not simply a fanciful possibility of a solution given enough further experimentation. As stated in the case of *General Tire & Rubber Co. v Firestone Tyre & Rubber Co. Ltd*, the disclosure “must contain clear and unmistakable directions to do what the patentee claims to have invented”.

Pharmaceutical Application

The pharmaceutical industry as a whole has been one of the most litigated and dynamic areas in relation to the test of novelty. The recent case of *Actavis UK Limited v Merck & Co. Inc* changed the way in which UK courts look at the test of novelty in relation to medical products. Prior to the *Actavis* case, it was thought that a new dosage or way of taking a particular drug could not be seen as novel; this has now been reversed by the Court of Appeal.

In this case, it was held that a new regime for taking medicine could constitute a novel invention for the purpose of obtaining a valid patent. Furthermore, the court dealt with the issue of obviousness, stating that it had to be obvious at the date of priority, not before or after, to defeat the patent, on this basis.

The leading case of *Merrell Dow v. Norton and Penn*, commonly referred to as the *Terfenadine* decision, held that when looking at a pharmaceutical process the definition of new had to be applied to the actual processes and not to a new result or outcome. In this case, it was held that although Merrell had discovered a new reaction from Terfenadine, it was not novel as the composition had previously been disclosed to the public (albeit not for that specific purpose). This produces an interesting position. Based on this judgment, it would seem that whether or not the process or invention produces a solution for a previously unsolvable issue is irrelevant; the issue is whether the actual matter itself has been disclosed. The focus of the test is on the physical items and not on the resulting outcome.

Bearing this decision in mind and the way in which the courts have chosen to deal with pharmaceutical claims, it would seem impossible to conclude that the issue of patentability is based purely on finding a “ solution for a technical problem that could not be solved before”.

### Obviousness

This leads us on to consider how important the actual resulting process or invention is to the determination of whether or not it is patentable. Aside from the requirement of novelty, the process or invention must involve an innovative step. This has been interpreted to mean that the invention would not be obvious to someone skilled in the art when presented with the relevant matter. One of the ways in which this test has been interpreted is to consider whether or not it fills a gap in the market, thus becoming an immediate business success. If this is the case, it is more likely that the invention would be seen as non-obvious and, therefore, patentable.

The requirement for this inventive step is contained in Section 3 of the Act. Deciding on what exactly is obvious and what is not has been a matter for the courts. In the case of *Windsurfing International Inc. v Tabur Marine (Great Britain) Ltd*, the main test for obviousness was laid down and remains the starting point for judges when deciding whether or not the invention is obvious. It was held that the court should take a four stage approach. Firstly, it should look at the inventive step itself in isolation, i. e. separating it from any supplementary aspects of the invention. Secondly, once the court is clear what the inventive step in question actually is, it should put itself in the position of the common person, skilled in the relevant art with the knowledge



that was available at the date of priority. Thirdly, the court needs to consider the difference between what is known by the common man and what the invention professes to display. Finally, the court needs to determine whether the step between what is known and the invention would have been obvious to the common man.

For example, in the case of *Sabaf SpA v. MFI Furniture Centres Limited and others*, the House of Lords considered the issue of whether the gas burner in question was obvious. In this case, the argument that Sabaf was presenting to the court was that its patent for a gas burner had been infringed. The respondents (MFI and others) claimed that they were using a new invention as it was, in fact, the combination of two inventions that had generated their specific gas burner. The crucial point here was that it was not possible to take two existing inventions and put them together to establish a new invention, where this new invention would be the obvious product of the two original inventions.

The test for being obvious seems to be reasonably wide with the court requiring a definite inventive step and not simply a natural progression, even if the natural progression is novel.

## Conclusions

The area of patent law and, in particular, determining whether or not an invention is novel and / or obvious is by no means clear. The courts take a very individual approach to each case as it is presented to them based on the individual facts. Despite this, it seems that both elements, i. e. novelty and obviousness, remain instrumental. It is not true to say that provided an

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invention is novel it does not matter whether or not it is obvious. The courts have widened their view of obviousness but not so far as to remove it entirely. Therefore, if the patent in front of the court fails the test of obviousness and a person skilled in that specific area could have also established the invention it would fail, regardless of how novel the invention turns out to be.

Both tests must be suitably established in order to gain patent protection. Producing a solution to a problem is highly important to the decision, but it is not the only deciding factor. The issue of obviousness simply cannot be ignored.

#### Bibliography (14 required)

Bagley, Margo A. , Patent First, Ask Questions Later: Morality and Biotechnology in Patent Law, William and Mary Law Review, Vol. 45, 2003

Bainbridge, David I. , Intellectual Property, Pearson Education, 2006, Pages 374 - 407

Colston, Catherine, Principles of Intellectual Property Law, Cavendish Publishing, 1999, Pages 86 - 105

Cornish, William Rodolph, Vaver, D. , Bently, Lionel, Intellectual Property in the New Millennium: Essays in Honour of William R. Cornish, Cambridge University Press, 2004, Pages 91 - 95

Grubb, Philip W. , Patents for Chemicals, Pharmaceuticals, and Biotechnology: Fundamentals of Global Law, Practice, and Strategy, Oxford University Press, 1999

Hodkinson, Keith, Protecting and Exploiting New Technology and Designs, Taylor & Francis, 1988, Pages 32 – 71

Johnston, Josephine, Wasunna, Angela A. , Patents, Biomedical Research. And Treatments: Examining Concerns, Canvassing Solutions, The Hastings Center Report, Vol. 37, 2007

Karet, ‘ Novelty under English Law. Appeal in Merrell Dow v Norton’ 16(5) European Intellectual Property Review 204, 1994

Muir, Ian, Brandi-Dohrn, Matthias, Gruber, Stephan, European Patent Law: Law and Procedure under the EPC and PCT, Oxford University Press, 1999

Patterson, Mark R. , Contractual Expansion of the Scope of Patent Infringement through Field-of-Use Licensing, William and Mary Law Review, Vol. 49, 2007

Pressman, David, Patent It Yourself, Nolo, 2008, Pages 15 – 20

Taylor, Christopher Thomas, Silberston, Aubrey, The Economic Impact of the Patent System: A Study of the British Experience, CUP Archive, 1973, Pages 12 – 23

Thomas, John R. , Litigation beyond the Technological Frontier: Comparative Approaches to Multinational Patent Enforcement, Law and Policy in International Business, Vol. 27, 1996

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White, ' The Novelty-Destroying Disclosure: Some Recent Decisions' 9

European Intellectual Property Review 315, 1987