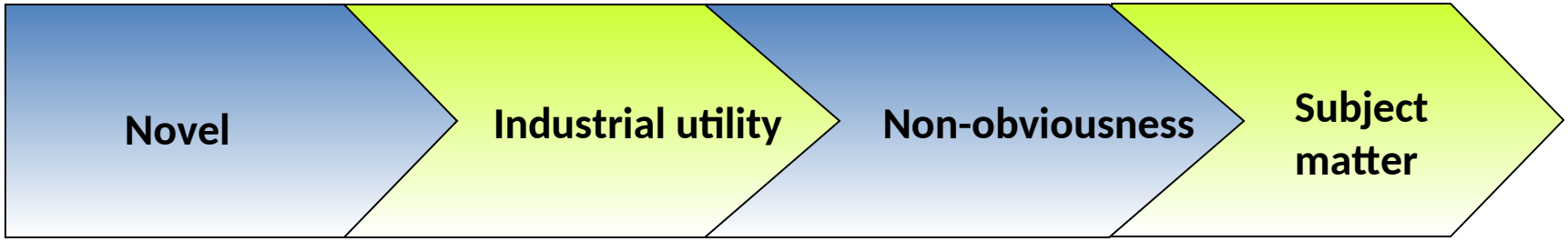
What Can Be Patented

- **Process or Method**
- **Machine or Apparatus**
- **Article of Manufacture**
- **Composition of Matter**
  - **Chemical Compounds**
  - **Physical Mixtures**
- **Improvements of Any of the Above**

Patentability Criteria



No prior use/claim/ publication

Capable of being made or used in industry & reproduced with the same characteristics as many times as necessary

Should be non-obvious to a person skilled in the art

-Technical advancement

-Economic significance

Subject matter used

"Any thing under the sun cannot be patentable"

Novelty

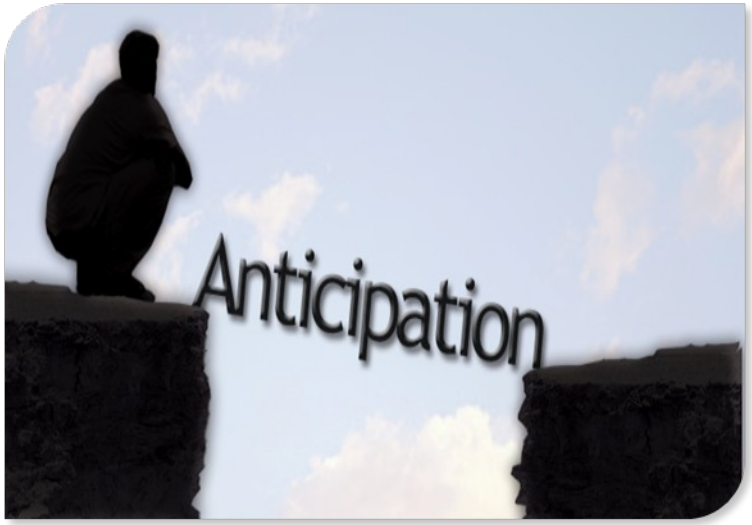
- Novelty mean that the subject matter **SHOULD NOT BE**
  - PUBLISHED IN **ANYWHERE IN THE WORLD** PRIOR TO THE PATENT APPLICANT INVENTING IT
  - IN **PRIOR PUBLIC KNOWLEDGE OR PRIOR PUBLIC**, BUT NOT NECESSARILY PATENTED OR PUBLISHED
  - USE, SALE, MANUFACTURE, & DEVELOPED **ANYWHERE IN THE WORLD**
  - CLAIMED BEFORE IN A PATENT SPECIFICATION **ANYWHERE IN THE WORLD**

A Novel subject is not part of state of the art.

(state of the art comprise product, process, or information in public domain)

Novelty Search

- Novelty is determined before inventive step (or Non-obviousness) because the creative contribution of the inventor can be assessed only by knowing the novel elements of the invention
- The Novelty Search is conducted to see whether the invention is **anticipated** by any prior art



What are Anticipations

Anticipation

Dictionary Meaning:

- A prior action that takes into account or forestalls a later action
- Visualization of a future event or state

Meaning w.r.t. to Patents:

- Any description of the invention which destroys the element of novelty of the invention

Anticipation criteria to determine novelty

- If it was available publicly before the priority date
- Planting the flag test
  - Prior publication shall have clear and unmistakable direction to do what patentee claims to have invented
  - Sign post to invention is not enough
  - Prior inventor must be clearly shown to have planted his flag at precise destination and before the patentee

Doctrine of anticipation to determine novelty

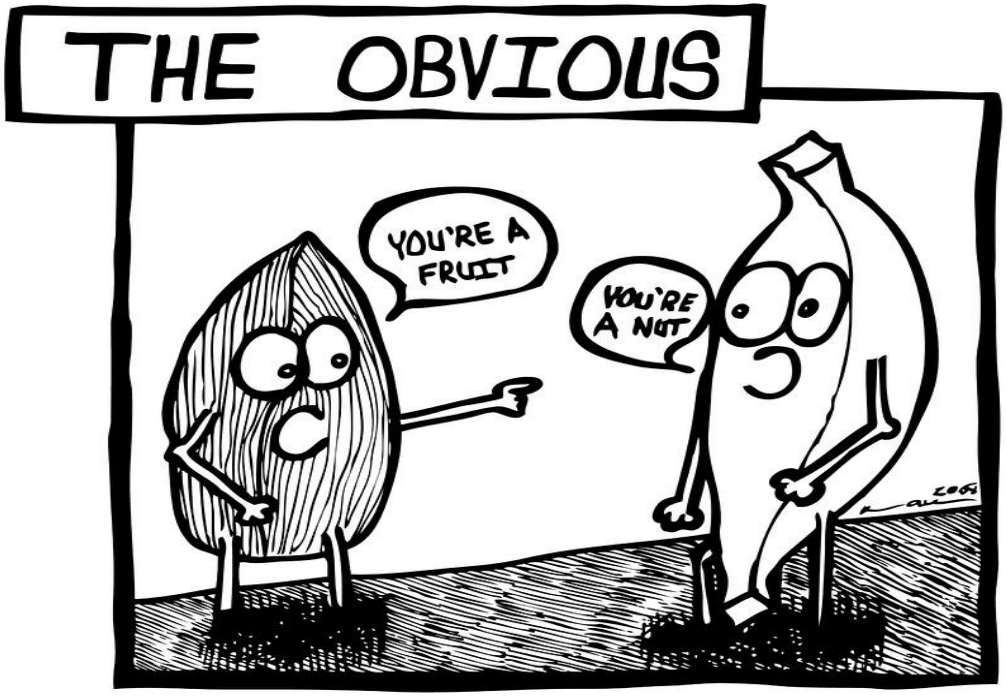
- 35 U.S.C. 102 sets forth the doctrine of anticipation by requiring novelty of invention.

- **Doctrine of anticipation**

"A claim is said to be "anticipated" if comparison of the claimed invention with a prior art reference reveals that each and every element in the claim under attack is shown or described, organized, and functioning in substantially the same manner as in the prior art reference"

The Non-obviousness Requirement

- Even if the invention demonstrate patentable subject matter, utility and novelty, the patent will not issue if the invention is **obvious**



"Obviousness is the next step in the road to patentability, and a significant hurdle"

The Non-obviousness Requirement

- What is **obviousness?**

  "An invention is obvious if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains."

- Not exactly but rather known if one were to combine several references.

- Obviousness defines predictable and non-unique combination of what multiple references teach would yield your invention.

The Non-obviousness Requirement

Example:

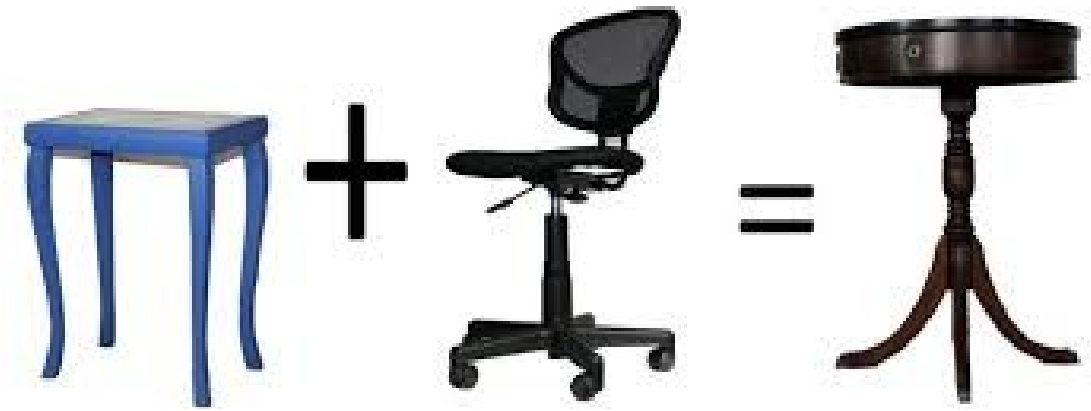
When you have invented A+B.

A is known in the prior art, and B is known in the prior art.

Upon looking at A and then looking at B, would someone of skill in the art consider A+B to be already known?

If the answer is yes, then A+B is obvious.

If the answer is no, then A+B is not obvious.



Some more rules to determine obviousness

- The differences between the prior art and challenged claims;
- The level of ordinary skill in the field of the pertinent art at the time of plaintiff's invention;
- What one possessing that level of skill would have deemed to be obvious from the prior art reference;
- Objective evidence of obviousness or non-obviousness;

Objective evidence includes: (1) the commercial success of the invention; (2) whether the invention satisfied a long felt need in the industry; (3) failure of others to find a solution to the problem at hand; and (4) unexpected results.

Determining what would have been obvious to a person of ordinary skill in the art

The decision maker may examine the following factors:

1. Type of problems encountered in the art;
2. Prior art solutions to those problem;
3. Rapidity with which innovations are made;
4. Sophistication of the technology;
5. Educational level of the inventor; and
6. Educational level of active workers in the field.

Subject Matter

- The patents Act 1970 doesn't define the category of the inventions that can be patented

- But provides a list of inventions that cannot be patented.

- Idea behind preventing certain inventions from patentability is to prevent monopoly over inventions which are injurious to health, environment, morality, national defense & security.

Brief glace on different types of searches

- Novelty Search
- Patentability Analysis
- Freedom to Operate Analysis
- **Landscape Analysis**
- Infringement Analysis
- Validity/Invalidity Search

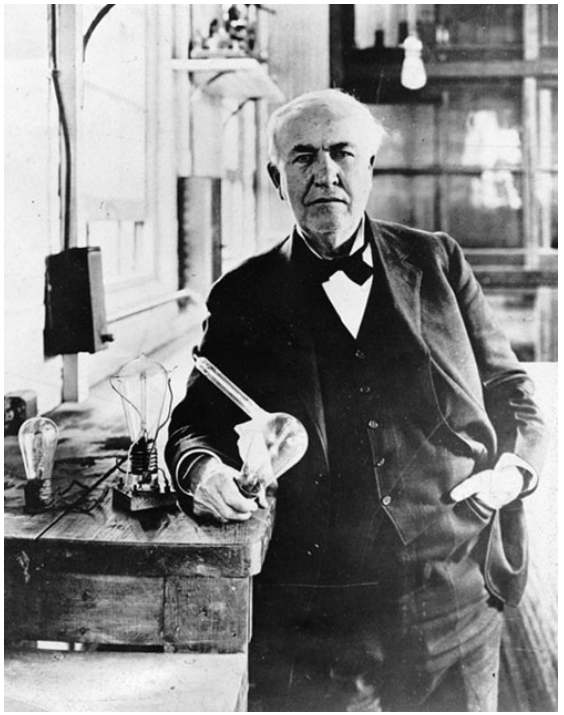
Application for patents

Who can file a patent?

Section 6: Persons entitled to apply for patents

- *True and first inventor of the invention*
- *Assignee of true and first inventor*
- *Legal Representative of a deceased person who immediately before his death was entitled to make such application*

Application submitted either alone or jointly with other person.



INTELLECTUAL PROPERTY INDIA

Types of Applications

- Ordinary Applications
- Convention Application
- Patent of Addition Application
- Divisional Applications
- PCT International Phase Application
- PCT National Phase Application

Documents required for filing of A Patent Application

1. **Application for Grant of Patent in Form 1 in duplicate**
2. **Complete/Provisional specification in Form 2 in duplicate**
3. **Statement and Undertaking in Form 3.**
4. **Power of Attorney in Form 26 (in original) ; (if filed through attorney)**
5. **Declaration of Inventor-ship in Form 5**
6. **Requisite Statutory fees (copy of the Priority cheque / DD).**
7. **Covering letter- indicating the list of documents**

Contents of Specification

- Title of the invention
- Field of the invention
- Background of the invention (PRIOR ART)
- Object of the invention
- Summary of the invention
- Brief description of drawings, if any
- Detailed description of the invention
- Examples
- Claims- not required in provisional
- Abstract- not required in provisional

Types of Application

Provisional application

1) Get early priority
2) Not expensive
3) Quick
4) Title/Description
5) No claims
6) Cannot be filed in case of conventional/PCT/Divisional application
7) Filing provisional application is an optional but an advisable step

Types of Application

Complete specifications

1) Where an application for a patent is accompanied by a provisional specification, a complete specification shall be filed within twelve months from the date of filing of the application,. E.g.

Example

Provisional application: 01-12-2008

Complete specification: 01-12-2009

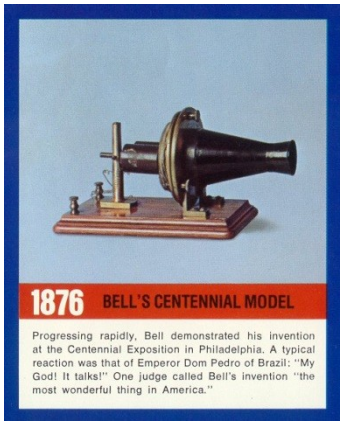
Types of Application

Section 10: Contents of specifications

1) *Every specification shall start with a title sufficiently indicating* ***subject matter***.

2) *Drawings*

3) *Model or sample illustrating the invention but such model or sample shall not be deemed to form part of the specification*



Types of Application

Section 10: Contents of specifications (contd.)

4) Every complete specification shall—

i. fully and particularly describe the invention and its operation or use and the method by which it is to be performed;

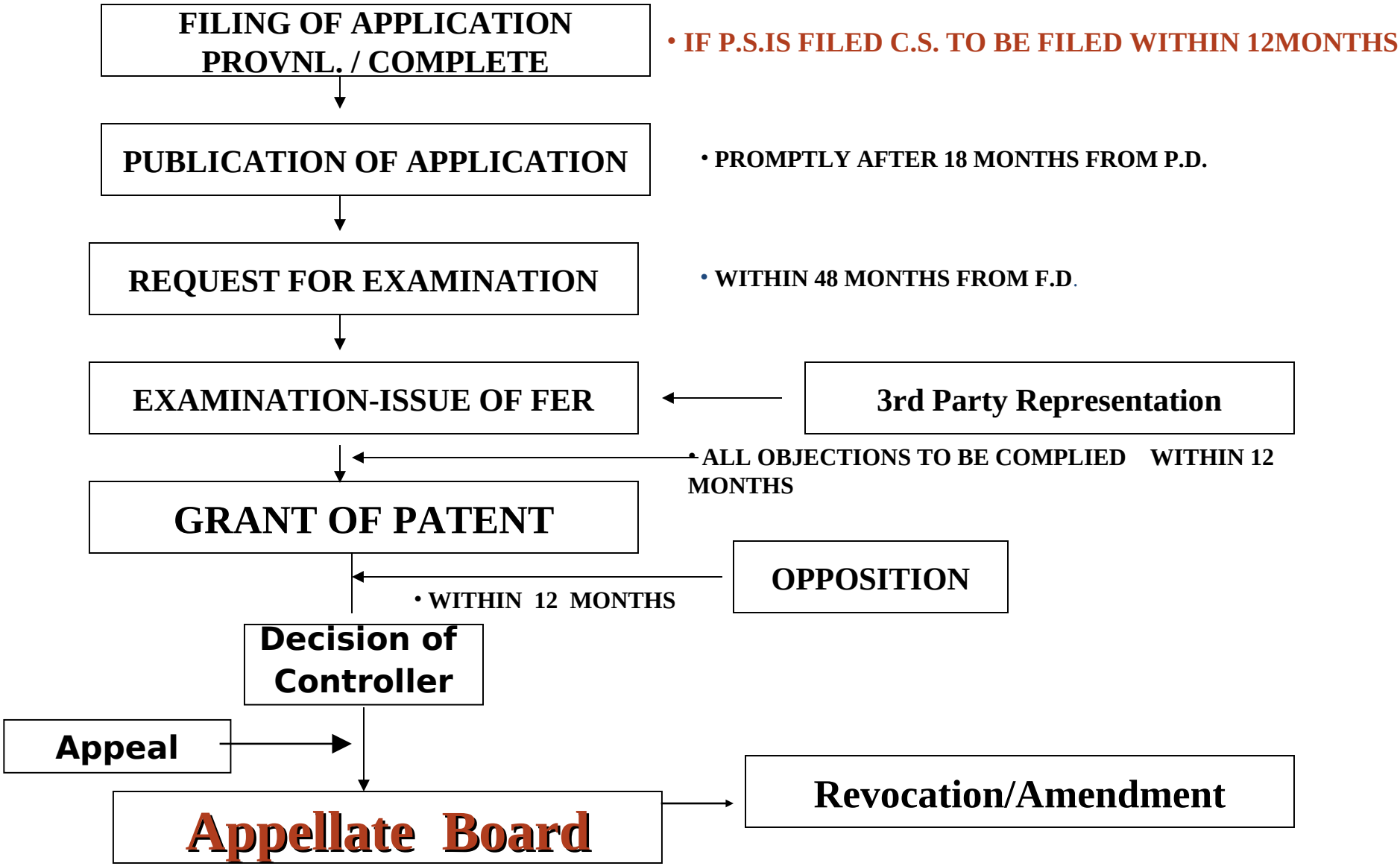
ii. disclose the best method of performing the invention which is known to the applicant and for which he is entitled to claim protection; and

*iii. end with a **claim** or claims defining the **scope** of the invention for which protection is claimed;*

*iv. be accompanied by an **abstract** to provide **technical information** on the invention.*

Stages from filing to grant of a patent

STAGES - FILING TO GRANT OF PATENT



Publication and Examination

Section 11 A: Publication of Applications

1) *No application shall be available to the public till 18 months of date of priority or date of filing whichever is earlier.*

2) *Applicant may request the controller for early using appropriate form and fees. The controller shall publish such application as soon as possible.*

Section 11 B: Request for examination

1) *Patent applications will not be examined **unless requested** in a prescribed manner*

Publication and Examination

Rule 24-B: Examination of application

1) The request for examination of **divisional application** shall be made within **48 months** from the date of filing of the application or from the date of priority of the first mentioned application or within 6 months from the date of filing of the further application, whichever is later.
2) Controller shall refer document to Examiner within **1 month** from date of publication or date of receiving the request for examination, which ever is earlier.
3) Examiner shall prepare **report** in **one month** but not exceeding 3 months from date of reference of application to him by Controller.