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Inventions- patentable and non-patentable

WISE CRACKS !!!

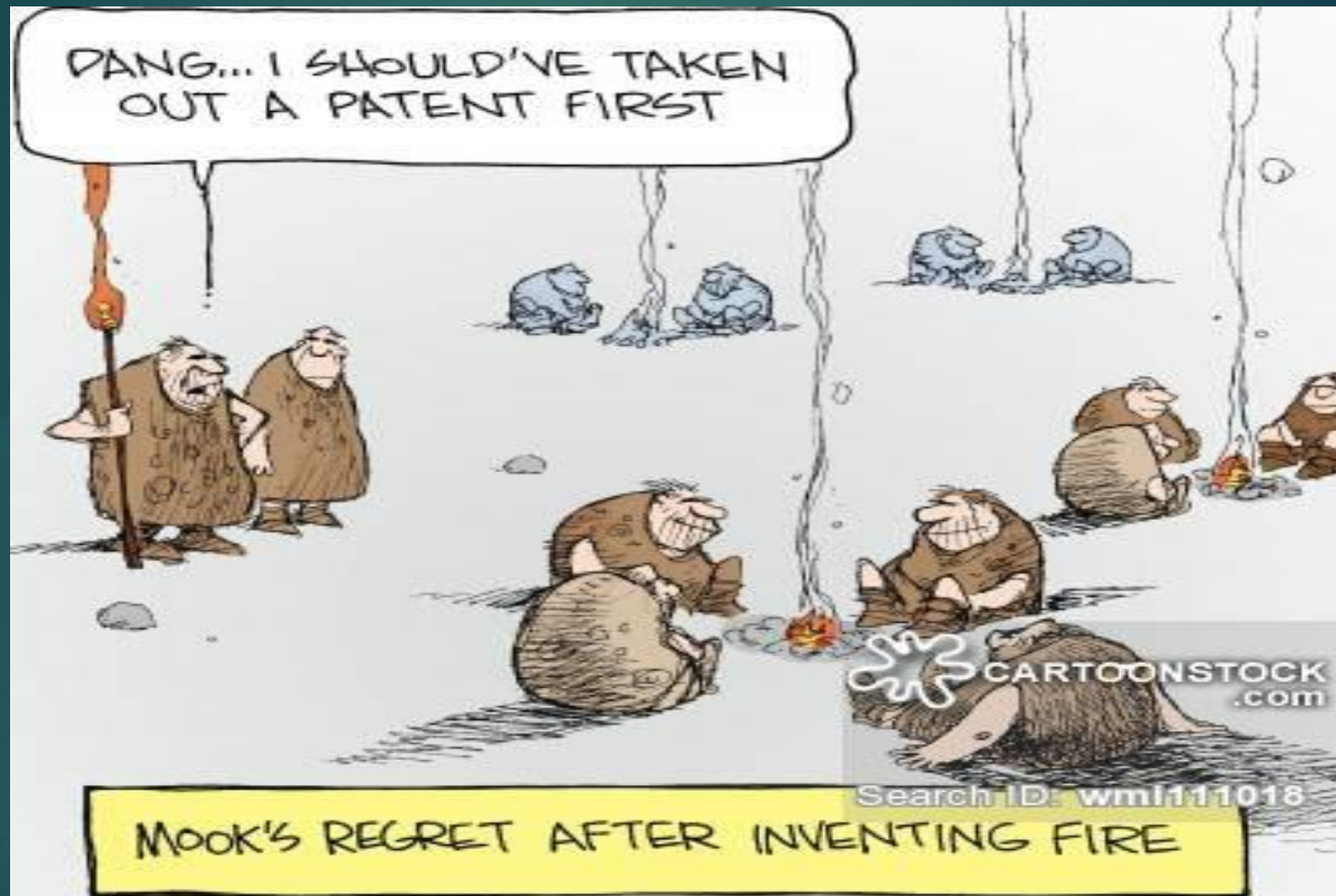
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Murli
26th April
2016

- 1) Where the knowledge is free, into the heaven of freedom, My Father ! Let country awake R. N. Tagore
- 2) Patent is a License to a Law suit !T.A. Edison
- 3) Owning a patent is like owning an elephant -- Guess who – (Y.S)

Modern-day patent

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Modern-day patent

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What is the criteria for patentability?

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The NUNS TEST.

- ▶ Novelty (New) Requirement
- ▶ Utility (Industrial Applicability)
- ▶ Non-Obviousness (Inventive Step)
- ▶ Statutory Subject Matter (Not falling within Section 3 of The Patents Act, 1970)

Understanding 'novelty'

- ▶ Novelty can be ascertained by “prior art search”.
- ▶ A good prior art search should examine the following aspects
 - ▶ Prior claiming
 - ▶ Prior publication
 - ▶ Prior public use.

Understanding 'utility'

- ▶ An Invention is useful when it is capable of Industrial Application.
- ▶ Capability of Industrial Application refers to the invention being made or used in an industry.
- ▶ Industrial Application should essentially produce the same results every time subject to NTP/STP.

‘Inventive step or non-obviousness’

- ▶ Non-obviousness means that it must have “*technical advance*” or economic significance or both. Sec(2(j)(a)
- ▶ Inventive Step also involves having a feature which is not obvious to a “*person skilled in the art*”.
- ▶ *The expression person skilled in the art means a person with an University degree in the relevant discipline and with about 3 years of industrial experience.*

Understanding 'non-obviousness'/ 'Inventive step'

- ▶ The Complexity or Simplicity of an inventive step does not have any bearing on the grant of the Patent.

Example: The Invention of Coffee Collar or the Coffee Sleeve can be classified as having inventive step and should not be confused with a frivolous invention.



ILLUSTRATION

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Tea pot 1



Tea pot 2



Tea pot 3



Is it an invention?

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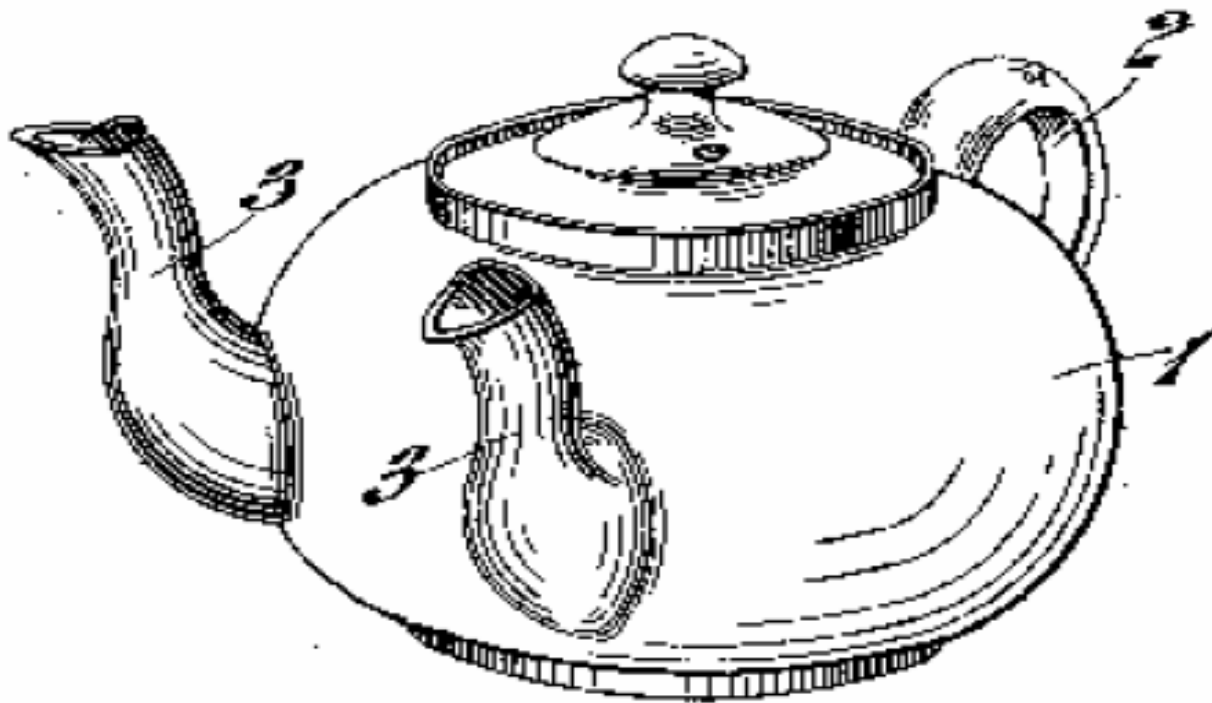


Fig. 1.

Is there inventive step in this?

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Statutory subject matter

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- ▶ An invention falls within the Statutory Subject Matter if it is not covered by Section 3 of the Patents Act, 1970.
- ▶ Section 3 lists the Inventions which are not Inventions within the meaning of the Act, even if they meet the triple requirement of NUN.

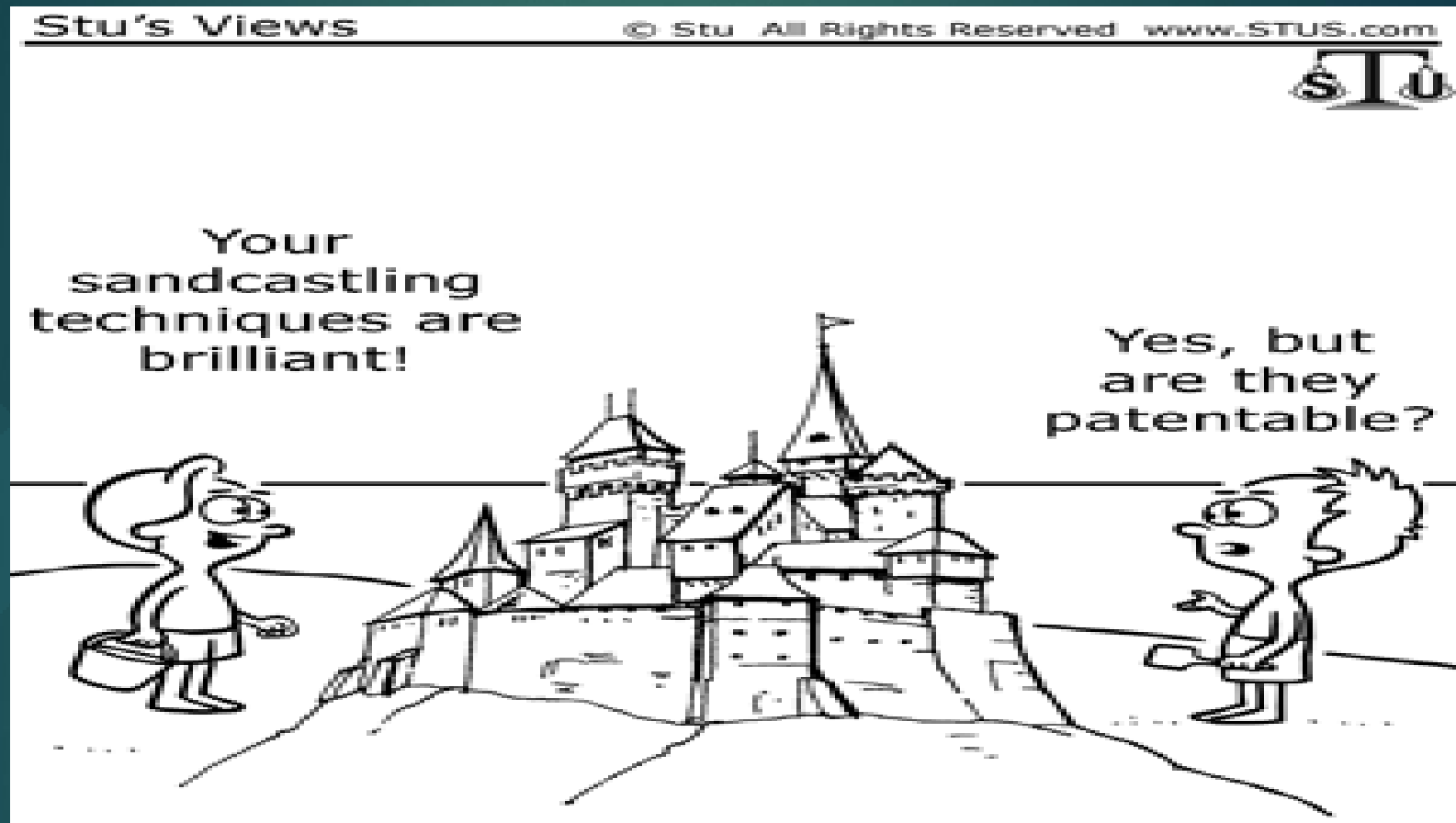
Sec-3 What is not an invention?

The following are not Inventions within the meaning of this Act:-

(a) An invention which is frivolous or which claims anything obviously contrary to well established natural laws;

What is not an invention?

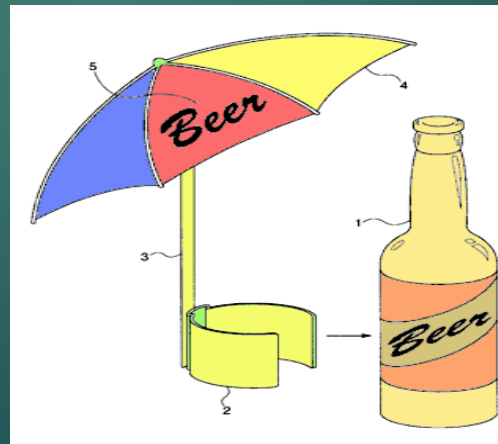
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Is this Patentable?

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Beerbrella: A small removable umbrella approximately five to seven inches in diameter, attached to a beverage container in order to shade the beverage container from the direct rays of the sun.



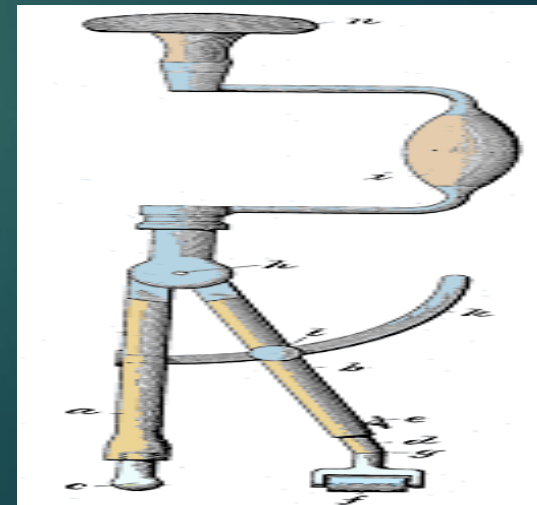
Beerbrella (Cont.)

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- ▶ Suitable advertising and/or logos may be applied to the umbrella surface for promotional purposes. The umbrella may be attached to the beverage container by any one of a number of means, including clip, strap, cup, foam insulator, or as a coaster or the like.
- ▶ The umbrella shaft may be provided with a pivot to allow the umbrella to be suitably angled to shield the sun or for aesthetic purposes. to allow the umbrella to pivot out of the way when the user drinks from the container.

Getting a dimple is not as easy as getting a pimple !

Dimple Drill: An inventor in the year 1986 invented the Dimple Drill. His claim was that people who were unhappy because they were not born with dimples could use this apparatus and get the dimples they always wanted.



Getting a dimple is not as easy as getting a pimple !

- ▶ This dimple producing device has a rounded tip made of either ivory, marble or India rubber.
- ▶ To produce the dimple, simply press the Dimple Drill's tip on the desired dimple lacking area and turn the knob, rotating the dull tip on your face, like a drill. The inventor says it may also be used to nurture and maintain already existing dimples.

Sec-3 What is not an invention?

- ▶ (b) An invention, the primary or intended use or commercial exploitation of which would be contrary to public order or morality or which causes serious prejudice to human, animal or plant life or health or to the environment;

Examples of immoral inventions

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- ▶ For Example, Currency Copier used to defraud people is contrary to public order and falls within the ambit of this Section.
- ▶ Also some invention which enables private assassination or something which poisons people or some invention which promotes debauchery is immoral and is covered by this Act.



Sec-3 What is not an invention?

(c) the mere discovery of a scientific principle or the formulation of an abstract theory or discovery of any living thing or non-living substance occurring in nature.

The Landmark Case ascertaining that a discovery of nature is not patentable was the US case of **Funk Bros. Seed Co Vs Kalo Inoculants Co.** 75 USPQ 280 (1948)

Funk Bros. Seed Co Vs Kalo Inoculants Co

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- ▶ In this case the product claimed in the Patent was a composite mixture of six strains of bacteria packaged to be used to inoculate leguminous plants. The Supreme Court held that the mixture of the already existing bacteria is not patentable but a mere discovery of nature



Sec-3 What is not an invention?

(d) the mere discovery of a new form of a known substance, which does not result in the enhancement of the known efficacy of that substance or the mere discovery of any new property or new use for a known substance or mere use of a known process, machine or apparatus unless such known process results in a new product or employs at least one new reactant.

Sec-3 What is not an invention?



Explanation to section 3 clause (d)

For the purposes of this clause, salts, esters, ethers, poly-morphs, metabolites, pure form, particle size, isomers, mixtures of isomers, complexes, combinations and other derivatives of known substance shall be considered to be the same substance, unless they differ significantly in properties with regard to efficacy. (With Effect from 01.01.2005)

Novartis case

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- ▶ In the present case the Swiss pharmaceutical company Novartis filed a patent application for an anti-cancer drug — beta crystalline form of Imatinib Mesylate.
- ▶ Gleevec is a blockbuster drug for Novartis prescribed for blood cancer patients. It was earlier known that Imatinib can treat different forms of cancer and had in fact received Regulatory Approval.
- ▶ Novartis contented that administering Imatinib in a beta crystalline form increases the bioavailability of the drug to the patients by about 30%. This increase in bioavailability according to them constitutes a significant improvement in efficacy within the meaning of the explanation Sec 3(d)

Novartis case

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- ▶ The office of the controller of patent Chennai held that the Novartis claim to priority under Paris convention on industrial convention 1883 is incorrect as they claimed priority from their corresponding Switzerland patent application. Since Switzerland is not a member of the Paris convention, Novartis cannot validly claim priority. Furthermore there were sufficient indications that the application in question is hit Sec 3(d) and its explanation. (25.01.2006)
- ▶ Novartis challenged the order before IPAB. Justice Ms Prabha Sreedevan specifically rejected the contention that even 30% increase in bioavailability would not be an improvement in its efficacy because the word efficacy there means clinical or pharmaceutical efficacy meaning the ability of a molecule to cure a particular disease or disability. In this case the Hon'ble Judge preferred to adopt the expert's understanding rather than following the common man's understanding namely the dictionary meaning of the word. In other words the Learned Judge chose to adopt mischief rule in interpretation of statutes than following the golden rule. (26.06.2009)
- ▶ The Supreme court upheld the orders of the IPAB and hence this remains a binding precedent which will be tested again during the future. (01.04.2013)

Sec-3 What is not an invention?

(e) a substance obtained by a mere admixture resulting only in the aggregation of the properties of the components thereof or a process for producing such substance.

Ex. Oral Rehydrating Solution containing Glucose, Sodium chloride, sodium bicarbonate, and potassium chloride.

Sec.3:- What are not inventions?

- (f) The mere arrangement or re-arrangement or duplication of known devices each functioning independently of one another in a known way;

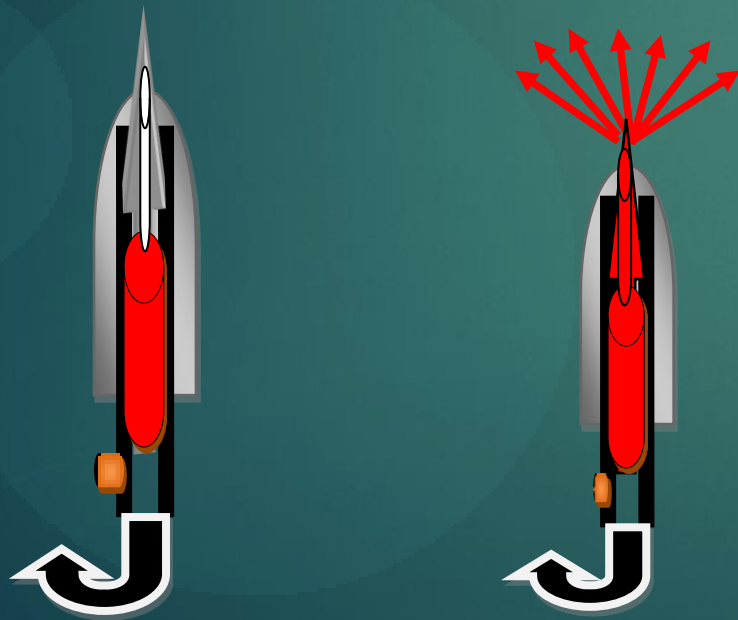
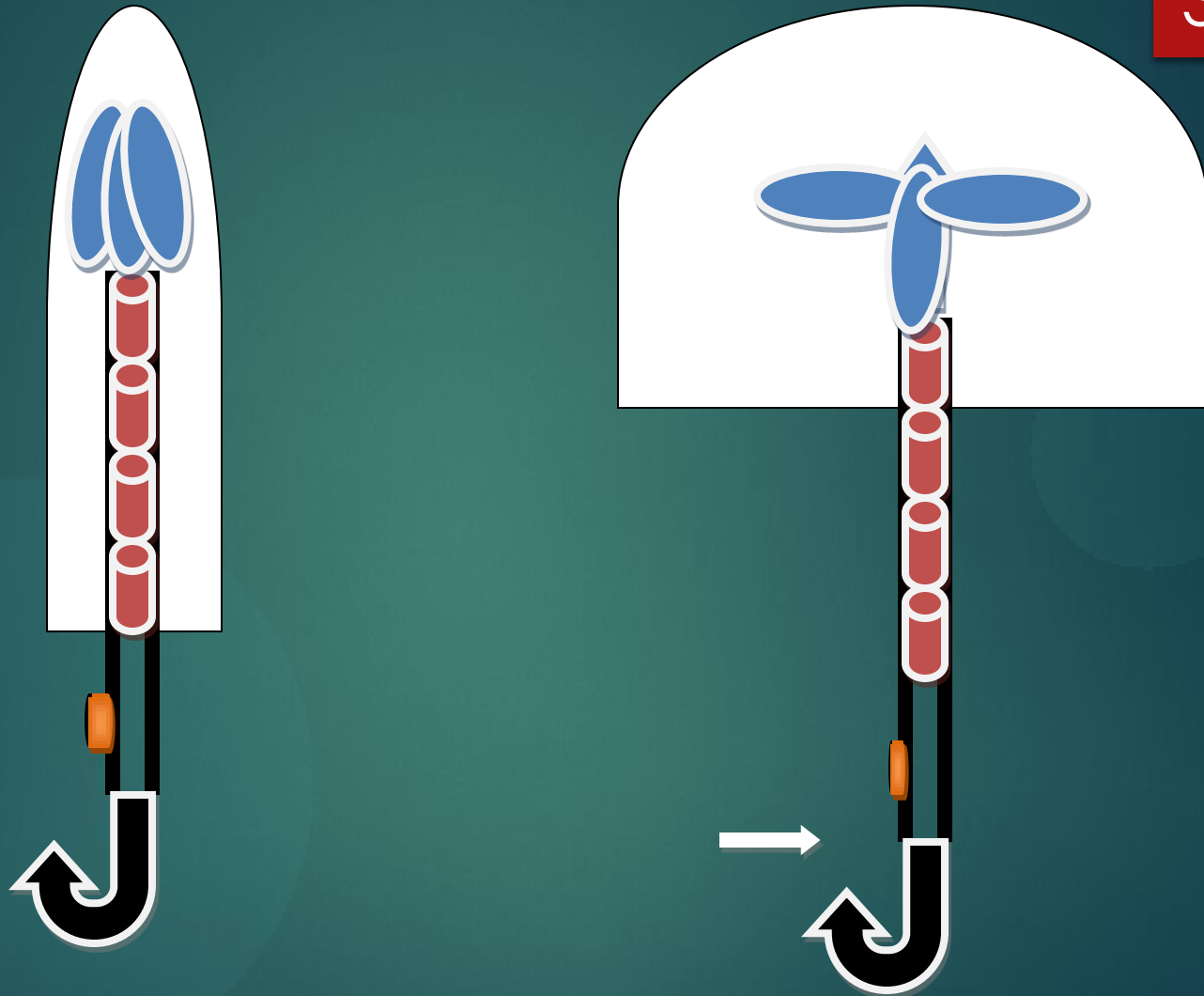


ILLUSTRATION : 1

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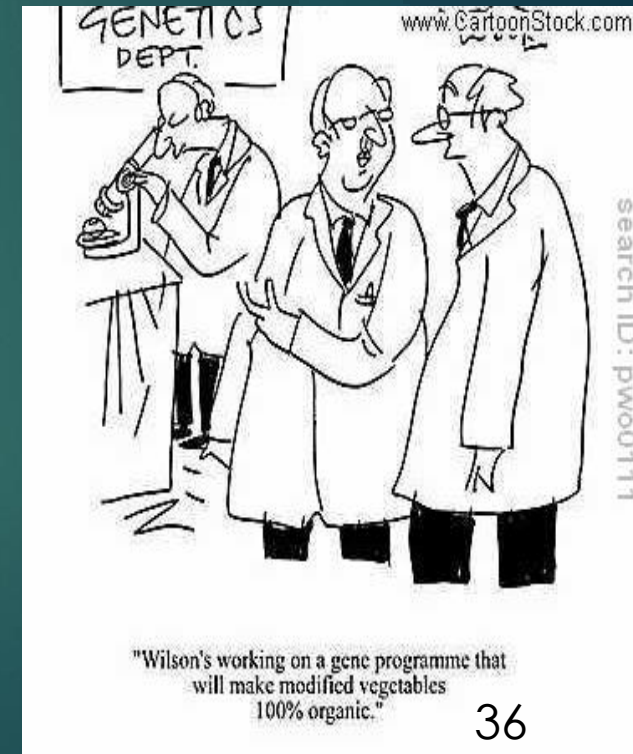
3/20/2010



A Battery operated fan enclosed within an Umbrella

Sec.3:- What are not inventions?

- (h) a method of agriculture or horticulture.
- (i) any process for the medicinal, surgical, curative, prophylactic [*diagnostic, therapeutic*] or other treatment of human beings or any process for a similar treatment of animals to render them free of disease or to increase their economic value or that of their products;



Sec.3:- What are not inventions?

- (j) plants and animals in whole or any part thereof other than micro organisms but including seeds, varieties and species and essentially biological processes for production or propagation of plants and animals;



Speaking Roses International Inc. vs Controller-General Of Patents And Anr.

- ▶ Speaking Roses international Inc., had on September 19, 2002, applied for a patent for “providing an image on an Organic Product, being a flower or a fruit”. Subsequently, they were given the First Examination Report (FER) as well as the Second Examination Report (SER), both of which they had replied to and complied with.

However, by an order dated April 19, 2006, the Respondent had rejected said application on the following 5 major grounds.

The first ground of rejection consisted of the allegation that the application was in contravention of Section 3(j) of the Patents Act, 1970.

Speaking Roses International Inc. vs Controller-General Of Patents And Anr.

- ▶ The aforesaid section, in its sub-clauses (a) to (p), enumerates what cannot be considered as inventions and as per sub-clause (j), such exclusion extends to “Plants and animals in whole or any part thereof other than micro-organisms but including seeds, varieties and species and essentially biological processes for production or propagation of plants and animals.” This sub-clause thus does not allow grant of patent for plants or for any biological processes for production or propagation of plants.



Speaking Roses International Inc. vs Controller-General Of Patents And Anr.

- ▶ However, Justice Ms Dalvi held that from the very application of the Petitioners, it became apparent that the patent sought was not for any flowers or organic products, but for providing an Image on an organic product. Hence it was not a plant that was being sought to be patented. Furthermore, such image was to be created by a mechanical process and not a biological one. Therefore, the claim did not fall within the scope of the aforesaid Section 3(j).



Sec.3:- What are not inventions?

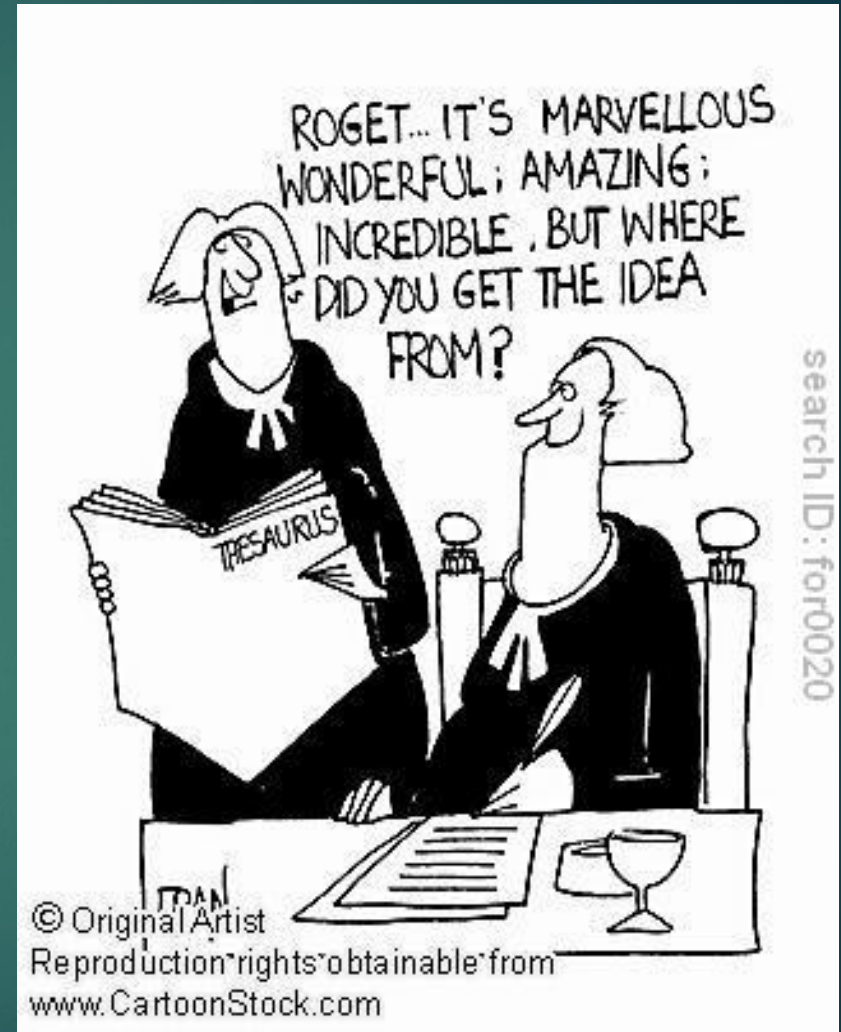
(k) a mathematical or business method or a computer program *per se* or algorithms;



Sec.3:- What are not inventions?

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(I) a literary, dramatic, musical or artistic work or any other aesthetic creation whatsoever including cinematographic works and television productions;



Sec.3:- What are not inventions?

(m) a mere scheme or rule or method of performing mental act or method of playing game;



Sec.3:- What are not inventions?

- (n) a presentation of information;
- (o) topography of integrated circuits;



Sec.3:- What are not inventions?

(p)an invention which, in effect, is traditional knowledge of which is an aggregation or duplication of known properties of additionally known component or components.





"Sometimes, you have to rely on your business acumen to advise clients against pursuing bad ideas."

ACKNOWLEDGEMENTS

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1. WIPO website
2. Indian Central Statistics Office website.
3. Online Economic Times
4. Swapna Chandramouli (Bombay Law College)& Adv. Anupama S Pillai & Adv Santosh Kumar B.C
5. Wikipedia website
6. www.ipindia.nic
7. www.globinmed.com

“No duty is more urgent than
that of returning thanks.”⁴⁹

