

# **PATENTABILITY ASSESSMENT**

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# PATENT

A property right granted by the Government to an inventor “to exclude others from *making, using, offering for sale, or selling the invention or importing the invention*” for a *limited time* in exchange for public disclosure of the invention when the patent is granted.

# Patentability criteria

- Novelty
- Utility
- Non obviousness or Inventive step

# Invention - Indian Patent Act-1970

"invention" means any new and useful-

- (i) art, process, method or manner of manufacture;
- (ii) machine, apparatus or other article;
- (iii) substance produced by manufacture,

# Amended IPA

**‘(j) “invention” means a new product or process involving an inventive step and capable of industrial application;**

**(ja) “inventive step” means a feature that makes the invention not obvious to a person skilled in the art;’;**

**(ac) “capable of industrial application”, in relation to an invention, means that the invention is capable of being made or used in an industry;’;**

# Inventive step

- (ja) "inventive step" means a feature of an invention that involves technical advance as compared to the existing knowledge or having economic significance or both and that makes the invention not obvious to a person skilled in the art;'

# US Patent Act

- **35 U.S.C. 101 Inventions patentable.**
- Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

# Novelty-EU

An invention shall be considered to be new if it does not form part of the state of the art.

(2) The state of the art shall be held to comprise everything made available to the public by means of a written or oral description, by use, or in any other way, before the date of filing of the European patent application

# US- Nonobviousness

- **35 U.S.C. 103 Conditions for patentability; non-obvious subject matter.**
- (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, 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.

# Inventive step

- Unanticipated
- Surprising, unexpected, unpredictable
- Long felt, but unresolved need
- Problem in the art hitherto unsolved
- Advantages-Cost, Yield, Conversion

# Determination

- ❑ Novelty destroyed only if one/single document discloses all elements of the invention
- ❑ Inventiveness affected by a collage/collection of documents such that they suggest, teach or motivate person with ordinary skill in the art

# Inventiveness

- Adequately supported by examples
- Documentary support
- Support by comparative examples
- Combination of prior arts leading to predictable results

# Inventions not patentable

- Section 3 of Indian Patent Act

# Assessment Report

- Key words searched
- Databases searched
- Statement on novelty
- Details of citations with relevant portions /parts
- Statement on non obviousness
- Statement on utility
- Data to be generated where required

- THANK YOU