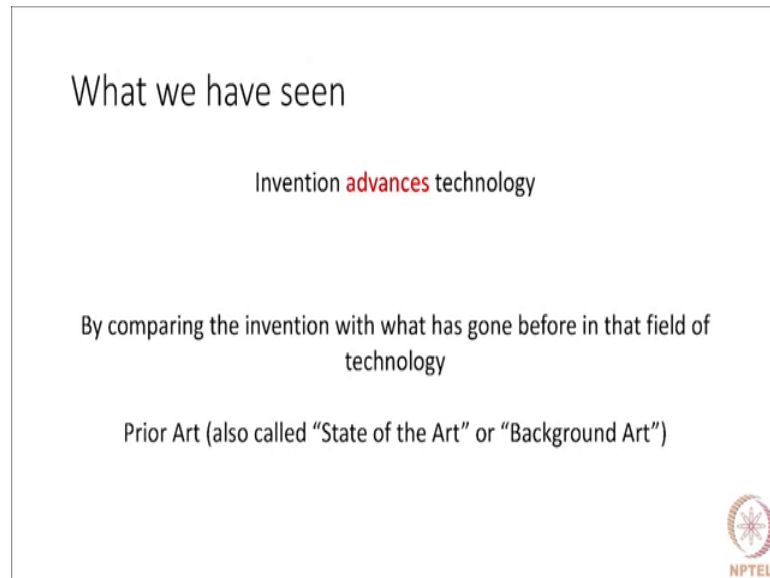


Patent Drafting for Beginners
Prof. Feroz Ali
Department of Humanities and Social Sciences
Indian Institute of Technology, Madras

Lecture - 04
Prior Art

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Prior art, what we have seen so far is the fact that invention advances technology. An invention results in a progress of a technology, technology advances by way of the invention, how do we know this? we know this, when we compare the invention with what has gone before in the field of technology. Now, the knowledge that has gone before in the field of technology, is referred to as prior art alternatively, it is also referred to as state of the art or background art.

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14 (1). "new invention" means any invention or technology which has not been anticipated by publication in any document or used in the country or

SS. 13, 29-34

10 Substituted by the Patents (Amendment) Act, 2005, S. 2(e), for Cl. (i) (w.e.f. 01.01.2005). Prior to its substitution, Cl. (i) read as under:- "(i) "High Court" means, -

- (i) In relation to the "National Capital Territory of Delhi, the High Court of Delhi;
- (ii) "In relation to the State of Arunachal Pradesh and the State of Mizoram, the Gauhati High Court (the High Court of Assam, Nagaland, Meghalaya, Manipur, Tripura, Mizoram, and Arunachal Pradesh);
- (iii) In relation to the Union territory of the Andaman and Nicobar Islands, the High Court of Calcutta;
- (iv) In relation to the Union territory of the Lakshadweep, the High Court of Kerala;
- (v) In relation to the "State of Goa, the Union territory of Daman and Diu and the Union territory of Dadra and Nagar Haveli, the High Court of Bombay;
- (vi) In relation to the Union territory of Pondicherry, the High Court of Madras;
- (vii) In relation to the Union territory of Chandigarh, the High Court of Punjab and Haryana; and
- (viii) In relation to any other state, the High Court for that State;" -> Substituted by Act 38 of 2002, S.3 (w.e.f. 20.05.2003).

11 Inserted by Act 38 of 2002, S.3 (w.e.f. 20.05.2003).


12 Substituted by Act 38 of 2002, S.3, for Cl. (j) (w.e.f. 20.05.2003). Prior to the substitution Cl. (j) read as under:-

"(j) "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,

and includes any new and useful improvement of any of them and an alleged invention."

13 Substituted by the Patents (Amendment) Act, 2005, S. 2(f), for Cl. (ja) (w.e.f. 01.01.2005). Prior to its



Now, you will find that the word prior art figures in the patents act, this is a copy of the patents act and we are in section 2 where, the definition of new invention is mentioned here. A new invention means, an invention or technology which has not been anticipated by publication, in any document or used in the country or elsewhere in the world before the date of filing the patent application, with complete specification that is this is the critical part.

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elsewhere in the world before the date of filing of patent application with complete specification, i.e., the subject matter has not fallen in public domain or that it does not form part of the state of the art;

(la). "Opposition Board" means an Opposition Board constituted under sub-section (4) of section 25; S. 25(3) R. 56

(m). "patent" means a patent for any invention granted under this Act;]

(n). "patent agent" means a person for the time being registered under this Act as a patent agent; SS. 125-132 RR. 108-120 FF. 22, 23, 26

(o). "patented article" and "patented process" mean respectively an article S. 87



The subject matter of the patent, has not fallen in public domain or that it does not form part of the state of the art. So, you find mention of the term state of the art, which we have just mentioned is nothing but prior art in the patents act, the patents act also mentions prior art in the context of multiple priorities, we will come to that later, but prior art or state of the art is, what has gone in that particular field before the invention came into being and. In fact, the invention is constantly covered with the prior art.

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Definition

What is prior art?

Prior art is **any** evidence that your invention is already known.

Prior art does not need to exist physically or be commercially available. It is enough that someone, somewhere, sometime previously has described or shown or made something that contains a use of technology that is very similar to your invention.

A prehistoric cave painting can be prior art. A piece of technology that is centuries old can be prior art. A previously described idea that cannot possibly work can be prior art. **Anything** can be prior art.

See Links Below in Description

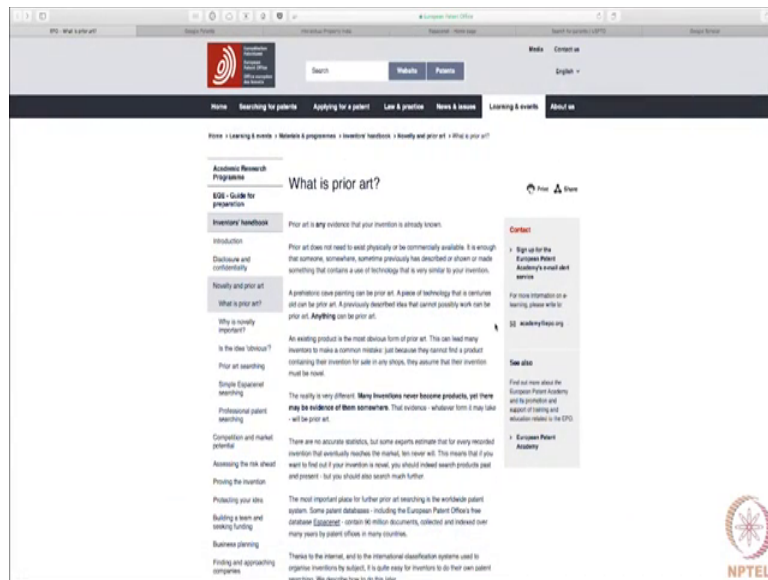
NPTEL

Now, if you look at a definition for prior art, and one definition that is available for us is, the definition in the European patent office website. Now, it defines prior art as any evidence, that your invention is already known, now there is a link to the patent office website European patent office website given below, you can read that in detail later now. So, prior by prior art we meant we are referring to some kind of evidence.

Now, in law an evidence can either broadly fall, within the category of an oral evidence which is what people say and it could be documentary evidence, evidence that is documented. So, prior art in patent law, predominantly we are talking about documentary evidence against your invention, or something which shows that your invention is already known. Now, it does not need that the prior art should physically exist or it should be commercially available in the form of a seal, it is enough that somebody has described it or shown it or use the technology.

Now, you could say there are many things that could amount to prior art, a cave painting can amount to a prior art, instruction manual can amount to a prior art, a theses lying in a library and unpublished theses can amount to a prior art. In fact, anything that has the value of an evidence, can amount to prior art.

(Refer Slide Time: 03:58)



Now, this is the page you can check the page and the links provided below, there is more detail provided there. Now, we find that prior art, at least the documentary part is something that you can search, and you can search for the prior art in various places.

(Refer Slide Time: 04:09)

Where to Search?

Any evidence – published, unpublished, currently used, discontinued

Internet is the best place

Patents

- Google Patents

Patent Office Websites:

- IPO Patent Search
- Espacenet Patent Search
- USPTO

Non-Patent Literature

- Google Scholar

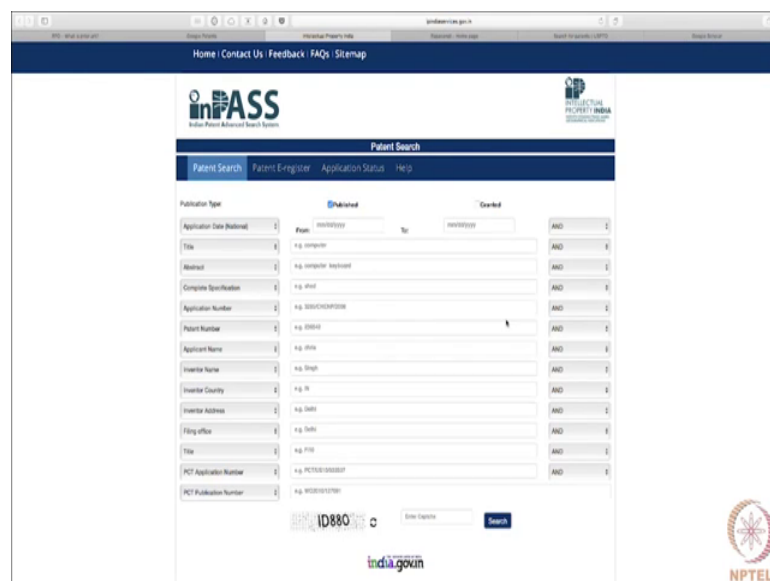
See Links Below
in Description

Now, any evidence which means published unpublished currently use discontinued, if it is in a searchable form, if it is not documented and if it is in a searchable form then that qualifies for prior art.

Now, you will find that the internet is one of the best places where, you can search for prior art and the which includes, if you are looking at patents you you can look at the Google patents website which, which is a repository of many of the patents that have been published. You could also look at patent office websites, like the Indian patent office website, you have a search page where which shows the Indian patent office a patent application can be searched, the Espacenet patent search which is the European patent office website search, or U S P T O which is the United States patent and trademark office search these are and there are other national patent offices, where you could search for patterns.

You could also do a non-patent literature search, in Google scholar or any other non-patent literature database. Now, the links are provided below, now you can see that a Google patents, this is how it looks the the web link and and you could search it is a common word search, you can search any of the terms that you want to look for and you can find it here, it just operates like the normal Google search.

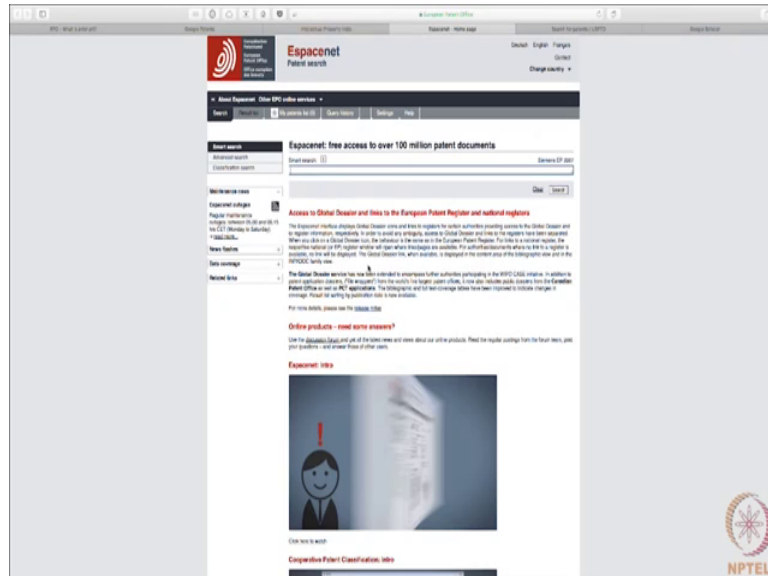
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The intellectual property website of India looks like this. So, you could add any of the you can search by title, by abstract, by complete specification and you can also search by

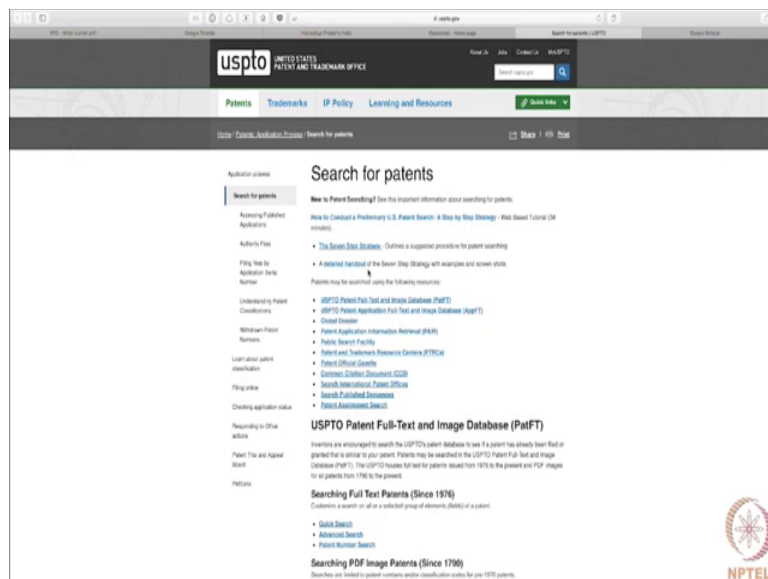
the date, you have an option of choosing published and granted patents, now that is also there.

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So, if you are looking at published pending applications, you could search that and you can find. Now, the European patent office also has a search patent, search is called Espacenet and you have more than 100 million patent documents here.

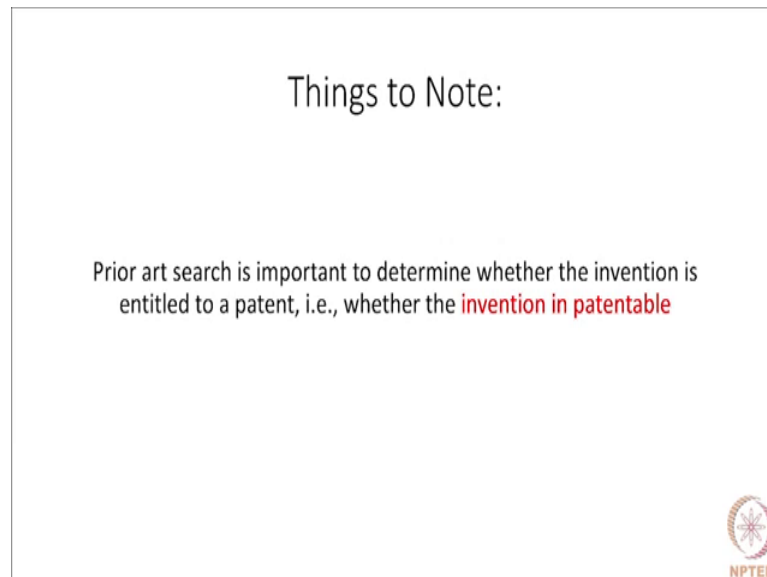
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So, so this provides you the search for that, the us patent office, has it is own search and this is the database the link from here and the us patent office is also important because,

they also provide some search strategies. The 7 steps search strategy, it is an interesting piece of document, you should have a look at that in some detail and for everything else, you have the Google scholar and anything that falls within the public domain.

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Now, this summarizes the search before the various databases. Now, apart from this you could generally do a patent or a non-patent literature search, in any library where these documents are stored, or in any place where you can have access to the hard copies. Now, but knowing the way in which technology has progressed, most of the patents that have been granted dating back to some of the old records to, for instance the patent office in the us United States has searchable records since the since the 1970's.

So, you can go back to the 1970's for offer a free text search. Now, the things to note is that prior art search, is important to determine whether the invention is entitled to a patent. So, to know whether the invention is patentable you need to do a prior art search, and the prior art search will tell you whether your invention is new, that is it satisfy the requirement of novelty which is the requirement for granting a patent, it will also tell you whether your invention involves an inventive step, that is the second requirement it is also called the non-obviousness requirement.