Patent Law for Engineers and Scientists
Prof. Feroz Ali
Department of Management
Indian Institute of Technology, Madras

Lecture – 07
Patentability of Inventions
What can be Patented?

Patentability of inventions, in this lecture we will look at what can be patented and the acts tells us that for anything to be patented, it has to qualify under the definition of an invention under the act that is section 2 1 j. We will also see; what are the inventions that are not patentable or the excluded subject matter, the subject matter that has been excluded from patentability; we will also look at that. Then we will look at the definition of invention and invention includes three things; the invention has to be new, the fact that it has to be new or novel, it should involve an inventive step and it should be capable of industrial application.

So, we will individually look at the three components of what constitutes a patentable invention; novelty, inventive step and utility or industrial application. So, looking at then definition of invention first; we can see that the definition has three components and the definition itself qualifies an invention that is patentable. Now this is understood, if you read the act no-where does the act says that, what is the patentable invention; rather when the act refers to an invention, it is understood that the acts concern is with regard to patentable inventions.

So, inventions that are patentable or patentable inventions to use an alternative phase refers to the fact that there are certain inventions, which are patentable under the act; which also means that there could be inventions which are beyond the scope of and patent under the act. Now this we referred to as the patentability of inventions or in to use the phrase in our syllabus, patentability of inventions or simply patentability.

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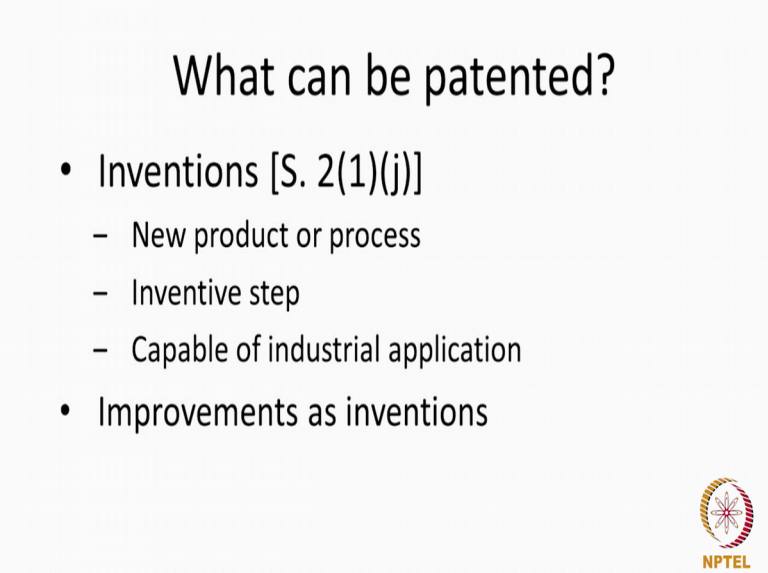

What can be patented? Patents can be granted only for an invention that pertains to a field of technology. So, the field of technology is very important because if there is no field of technology then a patent cannot be granted. Patents are technology specific, in the sense that patents can only be granted for technological inventions. Though the patents act do not describe inventions as technological inventions, it is understood that technology; inventions are inventions that are made in a particular field of technology. In fact, the patent office is designed in a way in which they have group of examiners, who have skills in a particular technology analysing and examining patent applications that come from different fields.

The international patent classification which is a code that is used for classifying patents is again a technology based classification. So, if you file a patent application in biotechnology then it will be examined by group of examiners, whereas if you file a patent application for a pharmaceutical drop, it would be examined by a different set of examiners. So, patent law is technology specific and you have not only experts within the patent office, but also the attorneys who draft these patents would also have some amount of domain knowledge in pertaining to their particular field.

So, inventions under the act can be granted for a new product or a process; the invention

should involve an inventive step and it should also be capable of industrial application. Now this is the definition of invention which is mentioned in section 2; 1 j of the patents act. So, from this we can understand three things for anything to be an invention, the fact that something has to be new is referred to in patent law as the novelty requirement, something has to be novel or the novelty requirement.

The invention should also involve an inventive step, I will explain inventive step in some detail soon and the invention should be capable of industrial application; this is largely call the utility requirement. Inventive step is also called the non-obviousness requirement, the fact that the invention should not be obvious to a person skilled in the other. We will be looking at these definitions in some detail soon, now what is important here is that invention has three requirements; novelty, inventive step and utility.

But for something to be an invention and for something to be captured as a patent, the product or the invention should manifest itself in the form of a product or a process. So, that is why you have the new product or a process mentioned together. So, if the invention cannot be envisage as a product or process then a patent cannot be granted. For instance, somebody envisages an invention as an idea and abstract idea; no product comes out of it, no process of manufacturing or working it is described, it just is an idea. For instance, somebody comes up with the bright idea of making a cycle that you could pedal to the moon. Now that remains an abstract concept, it is not something that can be worked out, it is not something that there can be a product on it, but it is just an idea that you could cycle your way to the moon.

So, abstract ideas cannot be patented, patent should manifest itself on either a product or a process. Invention can also cover improvements to existing inventions, so you have inventions which are new involved and inventive step and are capable of industrial application. The same yardstick can also be applied to improvements to existing inventions, provided those improvements on new; they involve an inventive step and they are capable of industrial application.

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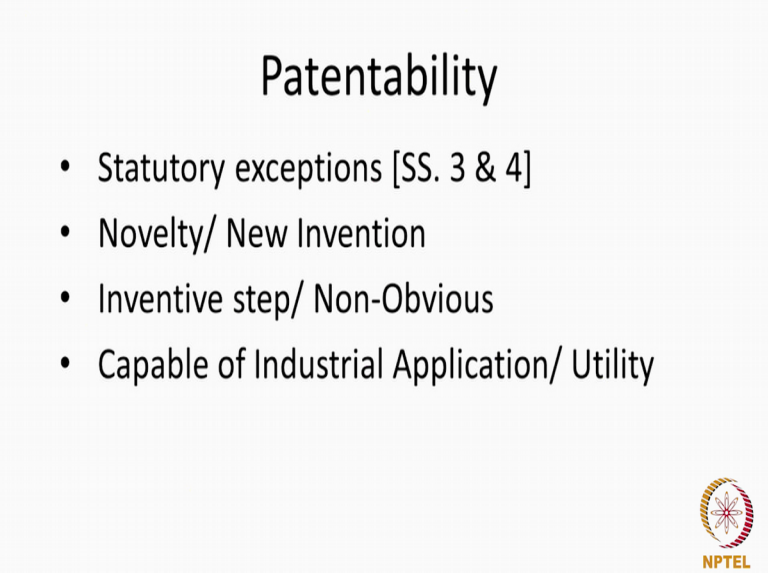

Patentability refers to the ability of an invention to be granted a patent, if an invention is not capable of being granted a patent; then we would not call it a patentable invention, they are normal inventions. For an invention to be patentable, it has to satisfy the requirements of an invention under the act what you saw under the earlier section; section 2 1 j. Not only should it satisfy the requirements of an invention under section 2 1 j, it should also get over the statutory exceptions.

So, we call this as the positive and the negative thing; the positive thing is that it has to show that the invention is new or it involves novelty, it involves an inventive step and it is capable of industrial application or utility, these are the positive things. So, when you file an application for a patent, you have to show that these three things do exist. Apart from satisfying these requirements; you should also ensure that your patent or your application does not fall within the statutory exceptions; the statutory exceptions are detailed in section 3 and 4 of the patents act and the statutory exceptions are applied first. Some of the exceptions in section 3 and 4 are policy based, some of them are domain based, some of them are; but exceptions which you can get over some of them are absolute exceptions, we will come to them in detail.

For instance, section 4 as a bar on granting patents for anything that pertains to atomic

energy. So, the Indian law does not grant patents on things pertaining to atomic energy so that is the blanket ban. So, the statutory exceptions are applied first and once you get over the filter of the statutory exceptions, then you would be required to prove the positive requirement. For instance, novelty or whether the invention is new then you will have to demonstrate that your invention has an inventive step. In US, they call as the non-obviousness and the fact that the invention is capable of industrial application; it involves utility. So, the test of patentability involves getting over the statutory exceptions and proving the ingredients of inventions that is novelty inventive step and utility.