Patent Law for Engineers and Scientists
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Lecture – 09
Patentability of Inventions
Novelty

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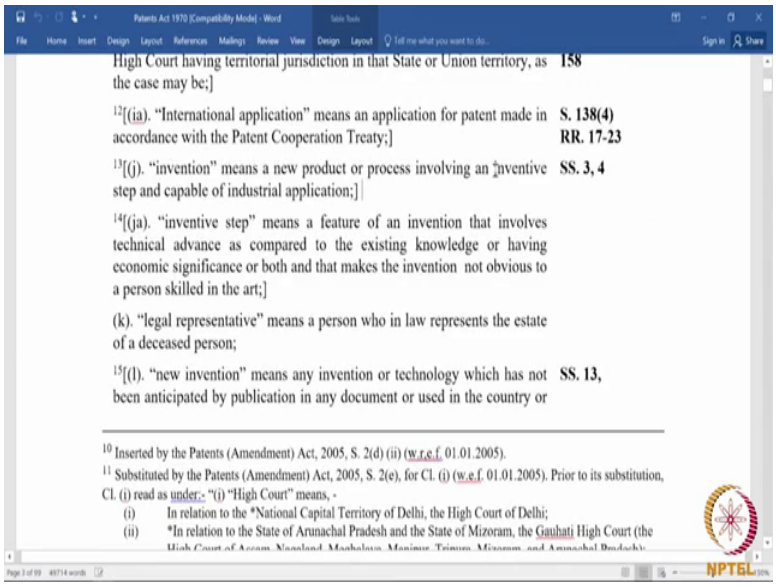

We had seen the definition of invention under section 2 1 j, invention means a new product or process involving in inventive step and capable of industrial application. We can see the 3 components of what constitutes an invention or the 3 requirements of an invention or to put in another way, the 3 ingredients of an invention, the ingredients that have to be satisfied for an invention to be patentable. Namely novelty the fact that the product or the process for which a patent is claimed is new and you will find new mentioned in the definition and the fact that the product or process should involve an inventive step that is a second requirement and third requirement that it should be capable of industrial application.

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Novelty

Now, let us look at the first part of the definition the fact that an invention has to be new novelty or newness of an invention. The act does not define novelty per se there is no definition of a novelty. But the act does gives you instances on how you can understand a new invention we are already mentioned that the definition of new invention under the act under section 2 1 l, new invention means any invention or technology.

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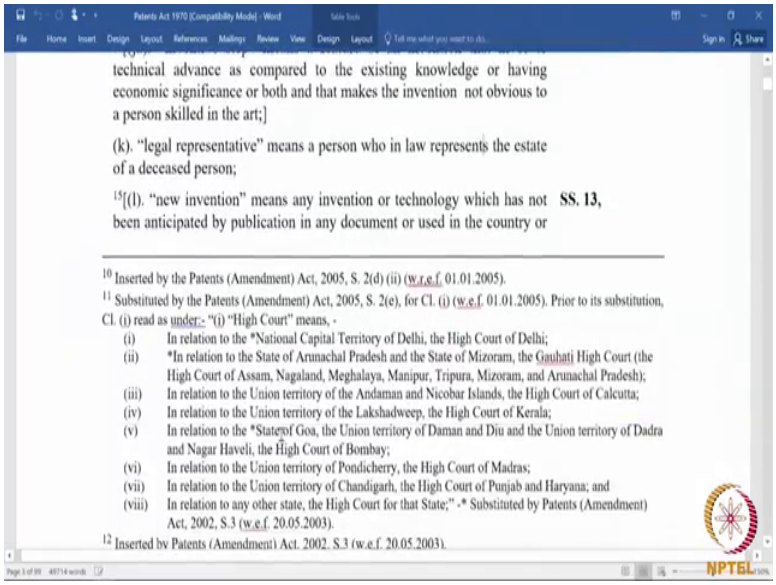

Now the definition is important is the fact that though novelty or the fact that newness is not defined under the act there is a definition of new invention under the act. So, we understand this definition new invention as defining the new part in section 2 1 j. So, this new is defined by this phrase new invention and this we understand because what is contained in this definition is the requirement of novelty; novelty is conveyed in this definition.

Now, let us take a look at this, means any invention or technology which has not been anticipated. Now invention has to pertain to a technology or it could also be an invention per se now we understand invention to pertaining only to technology because in practice patent law has evolved only by granting patterns for technology there is no other field for which patents can be granted. So, if there is no technology or if there is no technical effect produced by an invention we do not regard that is patentable.

So, any invention or technology which has not been anticipated now this is phrase that you need to understand it is a word that you need to understand. Anticipation is discussed in detail in chapter 6 of the patents act, section 29 to 34. There, anticipation contains all the exceptions to anticipation what are the instances that do not amount to anticipation. So, here we understand this statement as something if an invention or technology has not been anticipated then it is regarded as new, now anticipation can happen in multiple ways anticipation can happen by publication in any document or buy used in a country or elsewhere before the date of in a country or elsewhere.

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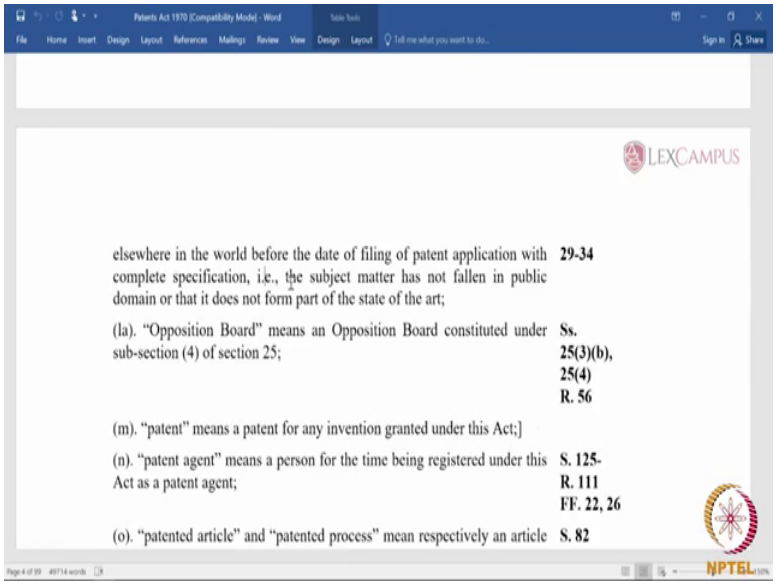

So, that gives us the standard of anticipation is a global standard regardless of whether the invention was anticipated in a particular country, as long as it is anticipated in any part of the world it could still affect the novelty of an invention. Meaning which if you file a patent application in India, they could be a disclosure by publication in scientific journal in the united states and even if you assume for moment that particular journal is not available in India still the standard of novelty which is an absolute standard which takes the notary requirement is determined by looking at the prior art all over the world still the invention would stand anticipated.

Now, we will in a moment; will come to what we understand by anticipation now here from the statement we can conclude that anticipation can be broadly by 2 ways it can be by publication in a document or used in any country. So, these are the 2 ways in which an invention can be anticipated. Publication is easy to understand because publication of the invention discloses the invention to the world at large in a verifiable manner that is the advantage of a publication. Publication would record the invention and it is verifiable say if it is published in an earlier patent application then it is there as a record which can be verified and that earlier patent application could become what we call a prior art for the present application the application for which a novelty determination is being done.

So, publication by a document any document means that it is published which means it is disclosed to the public or in patent law we use the word made available to the public and it is in such a way that the publication is in a verifiable manner. So, if someone is filing an application for a particular invention that application as it discloses an invention can be checked for novelty or for lack of it in a published document which has been published before the date of application. So, the prior art is always the date before which the priority for that particular application accrues. So, publication by any document is in easier way of ascertaining anticipation because published documents allow you to verify whether a document that has a disclosure of an invention actually anticipates a patent application.

The second type of anticipation is a bit more difficult to ascertain because use in a country could be use that is an recorded could be use that is not documented. So, when the use itself is there, but it is not recorded or documented then it becomes difficult though not impossible to prove anticipation for instance, under section 13 which is cross referenced here the examiner has to file a report on novelty that is whether the invention has been anticipated. So, when the examiner does a report on anticipation he is essentially looking at data bases which means he is looking at documents that have been published before if there is a use in the same country in where the examiner is examining the patent. And for a moment let us assume that that use has not been documented it becomes difficult to prove which means if the issue of novelty is to be raised then the issue of novelty will be reached before either a court of law or an appellate body or the patent office in such a manner that the use will now be shown by evidence adduced by a person because whatever is not recorded or whatever is not documented can still be adduced as evidence provided there is a testimony.

So, for instance if there was use of an invention then the way in which we will understand that use is by people who have witnessed the use filing an affidavit and swearing a statement that they actually witness the use now. It is difficult to prove used by an affidavit filed by a person because that would; obviously, involve examination of the person and if somebody is disputing that as a piece of evidence that person also has to be cross examined, now examination cross examination are legal procedures involved when a person deposes as a witness. So, use which is not documented though it is

relevant for understanding anticipation it is more difficult or harder to prove then the other aspect of anticipation which can be proved by publication of any document.

So, world over largely anticipation or the lack of novelty the fact that an invention does not have novelty is proved predominantly by publication of documents and if you see the report of any of the patent office on anticipation they would largely rely on documents to show that there is no anticipation. If you look at the report by the p c t preliminary report the x category which says that the invention is not novel again they would rely on published documents to say that there is no novelty of for the invention. So, novelty under the act is defined by the definition new invention this is under section 2 1 l and we had seen that anticipation can be by 2 means publication and by use.

Now we had also mentioned that it is a global standard and the fact that it should be before the filing of the patent application with the complete specification. Now the date that is that brings us to another important aspect of determining novelty. First we saw that there is a subject matter category there has to be an invention or a technology. So, unless the patent pertains to an invention or a technology then only such subject matters are capable of being patented.

For instance section 3 excludes literary and artistic works. So, in the fact that something from this with the domain of copyright law cannot be subject matter of patent, it has to be an invention as defined under the act or it has to pertain it to a field of technology which is not been anticipated by publication anticipation is the fact that it has been disclosed before now and when we talked about the fact that the disclosure has happened there are 2 kinds of disclosure.

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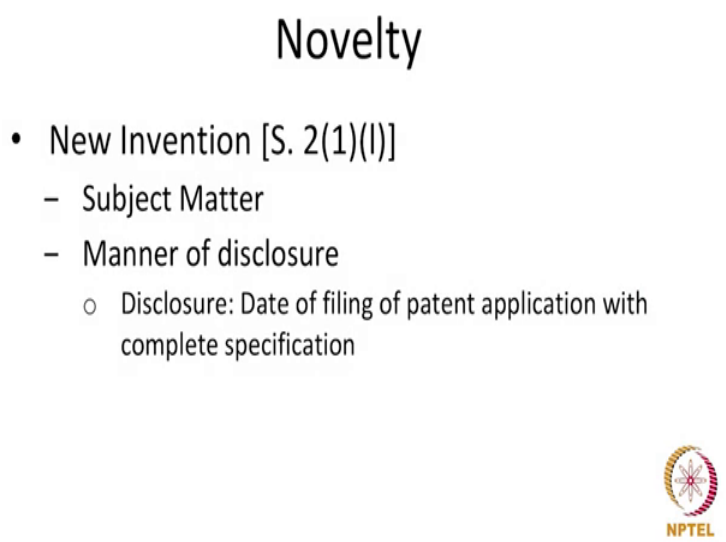

So, the first key thing in understanding novelty is that it should pertain to an invention or a technology that is a subject matter. Second that it should be disclosed either by an document published in any document or buy use that is the manner of disclosure the first one was subject matter in anticipation the second element was the manner of disclosure it could either be in a document or in a use and use has to be proved by evidence adduced to demonstrate that use. The third important element of novelty or the fact that an invention is new is that it should be the disclosure or the thing that anticipates should have happened before the date of filing the patent application with complete specification. So, this is the date by which we determine the novelty of an invention.

If the disclosure or if the anticipating material happened before the date of filing the patent application with complete specification then it is at that point we are going to look at the prior art the prior art for determining novelty will be the prior art before the date of filing the patent application with the complete specification. Now anticipation is defined here what do we mean by anticipation? By anticipation we mean that the subject matter has not fallen in the public domain or it is does not form a part of the state of the art now. If it is fallen into the public domain and if it is not protected by secrecy and secrecy something which you will see that there are certain measures even if it falls within the public domain it will still be a protected disclosure because there was a breach of certain

contraction obligations. So, if it is not protected by secrecy and it falls into the public domain we would say that the matter is anticipated or it does not form a part of the state of the art.

Now, if something does not form a part of the state of the art then it is new if the subject matter has not fallen into the public domain then again it is new or it satisfies novelty. So, when we frees it in the negative if something has fallen into the public domain then it lacks novelty or if something forms a part of the state of the art it again lacks novelty. So, anticipation is the key ingredient for determining novelty and anticipation is done the method by which it is done is either by looking at published documents or by looking at use in a particular country or the world at large.

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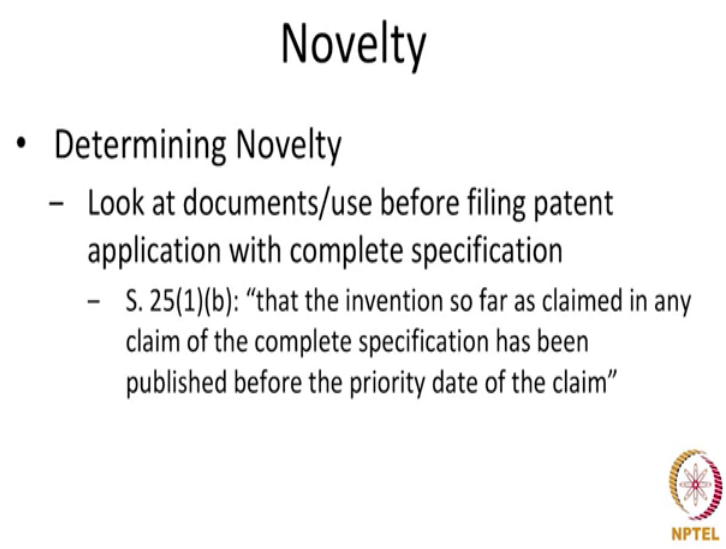

In determining novelty there are certain steps the patent office or the court would take the first thing what we had already mentioned is contained in the definition itself the definition states that for the purposes of determining novelty you should look at the documents or the use before the date of filing the patent application with the complete specification.

Now you may ask why is it that we cannot look at the date of filing of the provisional

application because provisional is done before the complete in cases where provision is filed then why is not a novelty determination done from the date of the provision. It is difficult to make a novelty determination from the date of the provisional because the professional does not have a claim. And if you see all the grounds challenging novelty or attacks on the claim an instance would be if you would take section 25 1 you will find that section 25 1 b and c pertain to grounds challenging the novelty of an invention - b states that that an invention so far as claimed in any claim has been published before the priority date and c says the invention so far as claimed in any claim is claimed in claim of a complete specification published on or before on or after the priority date.

Now, invention so far as claimed in any claim of a complete specification means that a pre requirement for a novelty analysis is that there has to be a claim. So, that is why you find that the definition refers to the date of filing the patent application with the complete specification. So, the novelty analysis requires a date on which the patent application will be analysed. So, the date of filing the patent application with the complete specification is the date for determining priority. So, this much is clear the date for determining novelty is the date of filing of the patent application with the complete specification.

Now, any document that was published before this date will be relevant for a novelty analysis similarly any use before the date of filing of the patent application with the complete specification will again be useful for determining novelty of an application. It does not mean that just because there is a disclosure that predates the patent application that it would anticipate.

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Novelty

- Disclosure
  - Made available to Public
- Anticipation
  - Disclosure falls within the ambit of what is claimed in the complete specification
  - Construction of prior art

Disclosure is one thing and anticipation is another thing these are 2 different concepts. Disclosure nearly means that something has been disclosed it has been made available to the public. Anticipation means that the disclosure falls within the ambit of what is been claimed in the complete specification. So, anticipation involves multiple steps it involves constructing the prior art the first step will be to construe the prior art or to construct the prior art and the construction of the prior art is done from the viewpoint of a person skilled in the art. So, the prior art is first identified and it is done from the viewpoint of a person skilled in the art.

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Novelty

- New Invention [S. 2(1)(l)]
  - What would be new?
    - Public domain
    - State of the art
  - Technical features of invention
  - Certain circumstances excluded from anticipation analysis: SS. 29-34

In explaining new invention the definition brings out 2 aspects of what would be new or the newness of an invention is to be compared with either the public domain that is one criteria for understanding whether something is new or what is defined as the state of the art. The public domain is easy to understand because if something is available to the public then we will understand that has the public domain now public domain does not mean it is it has to be available freely. So, they could be subscription websites where a piece of disclosure is published, but it is not available to the public unless a person pays the subscription fee that would still amount to the public domain.

The fact that something is behind the wall, behind the pay wall and it requires payment of money will not take it away from the public domain that would never the less be the public domain, but it would still be a protected space, but nevertheless it is the public domain and the fact that something has to be in the public domain is not equated to something being available free of cost. So, that is a critical point be noted the public domain could also include subscription websites or material that is been posted behind the pay wall.

State of the art means the state of technology rather than the state of art in commerce of business. So, whenever we talk about the state of art, art refers to the technology. So, when we talk about novelty or for that matter even inventive step we are only concerned about the technical features we are not concerned about any other feature of an invention there may be some features and inventions in which the customers like or which helps in spreading the word about the invention or there could be some social features which people find interesting, but when we are talking about an invention we are specifically looking at the technical features. So, novelty just like an inventive step is determined using looking at the technical features of the invention.

Now, the question of novelty involves when did the prior art disclose invention the point at which the disclosure happened and when they did anticipate what which means the document or the use that actually anticipated it and under what circumstances was it made available to the public, so 3 things. One is a when the second is what and the third one under which circumstances it was made available to the public. Now under which circumstances would include certain circumstances which are exempted from an

anticipation analysis or a novelty analysis? Section 29 to 34 s lists category of disclosures or circumstances which are excluded for the purpose of an novelty analysis. The definition refers to the subject matter has not fallen in public domain.

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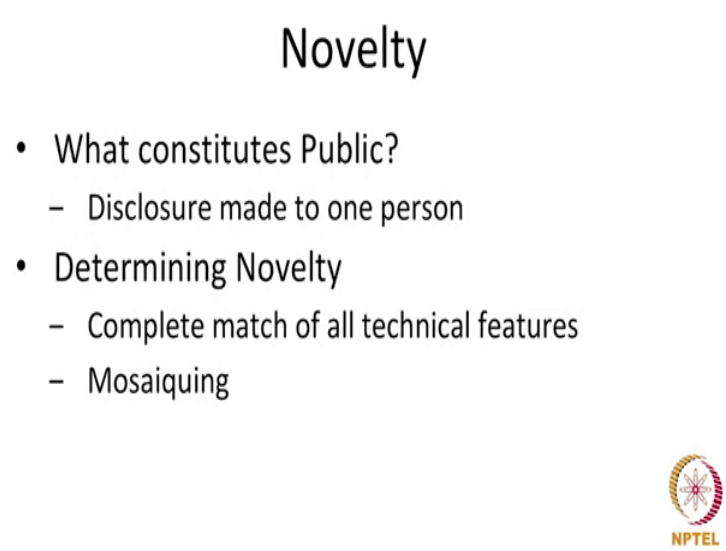

Now, what constitutes public, is it a large group of people or is a disclosure to one person a disclosure to the public. There are case laws which says that in determining novelty analysis even if the disclosure is made to one person that would amount to killing the novelty of an invention which means that even a disclosure made to one person if the person is not bound by any contract or secrecy obligations for instance there was no non disclosure agreement with that person or the person was not under the employment of a company where he was bound by the terms and conditions of his employment not to disclose the invention, if such a person even if he is one person if a disclosure is made to him that would amount to a novelty killing disclosure. So, it is not when we use the word public in public domain even a disclosure made to one person will be regarded as a disclosure made to the public and it will be regarded that it was made available to the public.

Now, in determining novelty the general rule is that an invention lacks novelty where there is complete correspondence between all of the technical features of the application

and the item of prior art. Now there has to be a complete match of all the technical features as disclosed in the application and as compared to the prior art. It is not sufficient that just the essential features are common in the prior art and the application rather all the technical features have to be disclosed.

So, novelty analysis would require a claim to be mapped exactly in all its technical features on to the prior art. So, the subject matter will not be anticipated if some features in a claim are mapped onto a disclosure in the prior art where as there are other technical features which do not have which are not disclosed in that prior art. Now what happens when the prior art disclosure affecting novelty is not in a single document? Say there are 2 different documents and the 2 different documents disclose all the technical features put together of the application, in other words the application has a set of technical features which can be map to prior art a, it also has a set of other technical features in the claim which can be map to prior art b. So, how does a person look at a novelty analysis when the disclosure is in different documents?

Now the rule in determining novelty is that mosaiquing or comparing different documents is not permissible for the purposes of determining novelty. So, there must be individual and separate comparison between the claimed in initial and the prior art. So, the comparison is going to be individual and it is going to be separate a person will not be allowed to do a mosaiquing; a mosaiquing is comparing different documents reading them together. So, where as mosaiquing is allowed to be done when it is a determination of lack of inventive step which is the second requirement of patentability.

In some cases you will find that the documents because it is not permissible to read them together or it is not permissible to mosaic them the documents will not disclose or will not be the disclosures in a document cannot prove lack of novelty because the disclosures are in different places. But the same documents could be used for determining lack of inventive step and in that case mosaiquing is permitted. Now we will look at how that happens when we discuss inventive step.

So, when you are looking at a novelty analysis you would also keep the inventive step analysis at the back of your mind because the same documents can be used for

determining lack of inventive step. So, what distinguishes the novelty requirement from an inventive step requirement is the fact that the invention in an inventive step analysis is seen as whether it was obvious to a person skilled in the art. So, that brings the knowledge of the person skilled in the art what we call the mental element which is absent in a novelty analysis. In a novelty analysis your soul concern is whether the invention as disclosed in the patent application has been anticipated before by publication or by use. And, in anticipation you are going to look for a complete matching of the invention in the prior art. So, it does not give the disclosure that you find in the prior art should be a complete disclosure which maps all the technical features that have been claimed in a patent application.