

ROADMAP FOR PATENT CREATION

PATENTABILITY TOOL

LECTURE 17

A very warm welcome in the second module of week 4 of the Course, roadmap for patent creation, titled “Patentability tool” Through the patentability tool one can predict whether the invention under consideration is patentable or not. The steps to be followed are-

Step I. Check whether invention or the invention disclosure under consideration falls under discovery.

As for the Patent Act discoveries cannot be patented. Discovery is exploring the existing knowledge or discovering the natural phenomenon. Example. If a microorganism/ planet/ element is discovered which were already present in the nature then these will not be patentable. The name of the discoverer can be given to that microorganism/planet. Something which already exists is just being explored through research and hence cannot be patented. However genetically modified microorganisms can be patentable provided certain conditions are fulfilled. Human intervention component is important when considering such genetically modified.

Step II. Maintaining Confidentiality.

Following questions shall be asked to Judge the Confidentiality aspect :-

- Whether the invention is known to public
- Discussion of invention in some meeting/ colleagues
- If the information is spread among colleagues/ community
- Publication in the research paper
- Presentation of the paper in the conference
- Presentation of invention in any program/ exhibition/ trade related exhibition/ Poster presentation
- Lecture or session given describing the invention
- Presentation of ideas or research in the contest

Many times due to ignorance or excitement or due to the very promising results researcher may share that research outcome with someone and that will result in the spread of the invention because

of which the invention enters into the public domain and then it will not follow the criteria of the patent. Many organizers offer big prizes for idea generation related contests. Participants are allured to share their ideas or research in exchange to prize money. Thus the inventor himself/ herself hampers one's invention and you will not be able to patent that invention because of the first-to-file rule. So it is advisable to avoid any kind of that activity which makes the invention available in to the public before filing the patent at least the provisional patent, then one can publish or make it available into the public domain.

Step III. Check whether invention under consideration follows the 3 criteria which are- novelty, non-obviousness and industrial application. Also the stability & efficiency of invention shall be checked.

Industrial Application - If some machine or nice process or product is designed but is not having an industrial application then it cannot be considered for patent. So it should be something which will be helpful to the industry to develop some output/process/product. Once the industrial applicability criterion is fulfilled then one shall find out the core industrial sector in which the invention falls. Whether it is a food industry, automobile industry, pharmaceutical industry, chemical industry, construction which falls in the category of civil engineering etc. should be identified. Next is to identify the focus area within that sector and narrowing down to the specific area/ domain. Such clarity of industrial application is very important.

Non-obviousness – check the inventive step. It should not be obvious to the person who is skilled in the art, i.e. PHOSITA. If the person who is skilled in the art feels that the invention is obvious then this criteria is not fulfilled. Also economic importance and technical advancement shall be fulfilled. If there is any change in the economic importance and if that could be mentioned or the technical advancement or both then non-obviousness criteria is fulfilled.

Stability - Invention shall give a stable/ same result every time it performs that particular activity. Example. Suppose one is working with microorganisms (patentable if there is any human intervention and fulfillment of certain conditions as in Patent Act) that culture has to be deposited in the depository. To understand the stability one has to check if that culture exhibits same property every time which

means that characteristic is stable for which the inventor is seeking patent. So if that microorganism is giving the

product (hormone, enzyme) and if anybody takes that micro organism from the depository with and tries to develop that enzyme or hormone then that person should be able to get that product or fulfill that purpose as specified in patent document. Similarly if there is any process/ machine is developed, it should give the stable output. Performance should be constant every time. Whatever outcome comes from first and then the tenth, the result must be the same. This is one of the criteria but industrial application, non-obviousness and novelty are the primary important criteria.

Novelty – It is checked through a thorough literature and patent search. Literature will include books research, papers and articles. Once gone through all the books, research papers, newspaper articles and any other resources which are available then have to check with the traditional knowledge if anything related to traditional knowledge is not incorporated in the invention under consideration. Also anything which is a practice in the community should be thoroughly investigated if the invention falls into it. It is expected to check in the community from one generation to other generation if that information is passed and there is a possibility that that information is not recorded to confirm the novelty aspect. For patent literatures, free databases can be checked. Free databases maybe Google patent database, IPO, USPTO, Espacenet etc. There are paid databases also like Derwent innovation, Questel- Orbit etc.

Efficiency - Invention shall increase the efficiency of the operation **substantially**. As per the Patent Act invention should give a substantial output/ change in the efficiency along with technical advancement. Example. Suppose there is a 60% increase or 70% increase from whatever that current output is. If prior art shows output X, and output because of your invented process is 60% more than X (i.e. 60% more output than output given by prior art). Hence the invention can be considered far better. Inventor may have just changed the process or arrangement in the machine minutely it can still be thought of patentable due to the substantial increase in efficiency. Hence one should not think in a way that a minor change whether will not be considered for patent.

Step IV. Invention must follow Section 3 and Section 4 of Indian Patent Act.

Section 3 of Indian Patent Act is about the inventions which are not patentable.

Section 4 is related to secrecy directions. Invention shall not violate any of the section.

Thus, when these steps mentioned in the patentability tool are systematically followed the inventor will be sure that his/her invention can be considered for the patent application. With this we come to end of this session. See you in the next session.

Thank you