

ROADMAP FOR PATENT CREATION

NON-OBVIOUSNESS

LECTURE 09

A very warm welcome in the fourth module of the week 2 of the Course, roadmap for patent creation, titled “Non-obviousness”

In the earlier module we have seen the novelty aspect. In that we have noted that invention should be novel if it has to be considered for patent granting... Now we will concentrate of the second criterion for patent that is non-obviousness Let us check what is the meaning of non obviousness in an Oxford dictionary, As per the dictionary meaning Non-obviousness is Not obvious; not immediately apparent or such as would ordinarily be expected; (specifically in patent law) not disqualified by obviousness from being patentable.

Occasionally as noun meaning of non-obviousness is : that which is not obvious. So it is very clear from the dictionary that non-obviousness is not obvious... Now as per patents Act how it is interpreted by an examiner...

So let us check that....In the last module we have seen the definition of invention Do you remember ? Yes? "invention" means a new product or process involving an inventive step and capable of industrial application; And we have seen the meaning of “new product or process” in detail we also mentioned definition of “inventive step” is the last module What is the meaning of inventive step? Section 2 (ja) defines “Inventive step” as a feature of an invention that involves technical advance as compared to the existing knowledge or having economic significance or both and that invention not obvious to a person skilled in the art So let us see the definition of inventive step in detail.

As per that here there are four points

First “Inventive step” as a feature of an invention involves technical advance as compared to the existing knowledge So technical advancement... Second Invention must have economic significance third it says it can have both technical advance as compared to the existing knowledge and economic significance And fourth it says invention should not be obvious to a person skilled in the art So there are four points mentioned

First three points you can easily appreciate

- technical advance as compared to the existing knowledge
- economic significance
- both technical advance as compared to the existing knowledge and economic significance

the fourth it says invention should not be obvious to a person having ordinary skill in the art so what is meaning of this non obviousness to a person having ordinary skill in the art so can we say Whether the invention is an adequate distance beyond or above the state of the art. Can we say that? That is, state of the art, and the invention under condition must be apart from each other ...there should be some difference that can be either technical or economic or both....

we already know the meaning of state of the art Right and as said earlier it should be non obviousness to a person having ordinary skill in the art Just check this person having ordinary skill in the art take first letter of this every word... we have met him in the first module of first week...

PHOSITA is a fictional person Who have the normal skills and knowledge in a particular technical field He/she is not genius but a person having ordinary skills So NON-OBVIOUSNESS is to accommodate future unforeseeable technological developments. We understood the meaning of nonobviousness however, we should know how examiner will judge the non-obviousness aspect ...how he evaluates the patentability of the particular invention with respect to this aspect? This determination of non-obviousness is very tricky....We will see a few examples...Please see the picture In this picture the architect re- arranged the iron pipes and made it as a bench for the tourists.What you say ...it is obvious or non obvious Remember PHOSITA What ? obvious Yes? Non obvious? Don't you think it is Innovative wayrearrangement to create a bench... Consider you are examinerWhat do you say?...think over....Now check this example....3 clicks

A situation where an inventor combined a cap with the muffler Check this example Umbrella and knife Inventor combined knife and umbrella...so anyone can use umbrella to defend.... Next example 3clicks The inventor changed iron handle of the door with wooden ... What do you think.... Is it patentable.... Check now all these four examples.... Rearrangement of iron pipes Combination of muffler and cap Combination of knife and umbrella Replacing iron rod with wooden rod In all four If we apply PHOSITA and non-obviousness aspect then none of them qualifies for patent as all are obvious to PHOSITA could not get qualified for the grant of the patent as its mere combination or re-arrangements of the existing items or replacement We will check the court perspective...In the case **M/s. Bishwanath Prasad Radhey Shyam v. M/s. Hindustan Metal Industries, supreme court** laid down the importance of assessing non-obviousness

Thus novelty as seen in earlier module concentrates on if the invention is new with respect to prior art while inventive step goes further and determine the quantum of improvement This non obviousness aspect helps to differentiate between real genius inventions from mere workshop improvement For determination of novelty an exact citation in a single document is necessary. Mosaicking of extracts is not allowed However in the case of obviousness many documents can be considered. We see one simple

example from chemistry There was an opposition against one of the Indian patent applications Opposition is one of the process Here as per Indian Patents Act there are two types or you can say stages where opposition can be filed

One is pregrant opposition And second is Post grant opposition Pregrant opposition is filed after the publication and before grant of the patent ND The post grant opposition is filed after grant of the patent...we will not go in details of what is opposition however you should know that there is the provision in the Act as pregrant opposition and post grant opposition so the patent was under opposition This invention was related to a process for extracting of neem oil from neem seeds The process involved was treating crushed neem seeds in a soxhlete solvent extraction The polar solvent is used in this process The temperature range mentioned in the patent was 40-60 degree C

This process leads to formation of oil cake free from bitter and odoriferous constituents After that the oil cake is fried using solvent extraction using hexane Now opponent filed an opposition What was the basis Evidence was prior published documents from the book which disclosed extraction of kernels (seeds) with 70% of alcohol And it is mentioned that this process removes bitter and odiferous compounds It was also mentioned there that hexane can be used for further extraction This will give good quality of oil. Now how the Non-obvious aspect is judged here This argument was based on the evidence of the expert who had worked in the field of extraction for 30 years The invention was held obvious on the basis of the expert opinion as the person skilled in the art use soxhlet apparatus at 40 to 60 degree centigrade and is very common in the oil extraction industry

Based on this expert opinion the patent was not granted and opposition held So before filing a patent along with Novelty aspect, non obvious aspect also must be studied

Here is another example... If a patent relates to a composition of known ingredients, it is likely to be obvious, unless the mixture/combination leads to some new effect, synergistic effect. Now consider this verifying the previous predictions and no substantial addition then we say the inventive step is lacking. It will be obvious Then in some cases If there is combining two or three parts and arranging them in sequence and changing the sequence of arrangement However if this all not giving any additional effect Then obviously this will be "obvious"

Say if three different technologies are known and are used in particular industry commonly and some one comes up with an instrument which is nothing but a mere combining three technologies without any additional effects then on the basis of "obviousness", anyone can challenge this patent ...So now you know what is non-obviousness... Non obvious to person skilled in the art...With this we come to the end of this session. In the next session, "Industrial application", we will check in detail the third criterion of patentability. See you in the next session

thank you!