



Test of Novelty under Indian Patent Law: A Critical Analysis

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ABSTRACT

Patent is the exclusive right of the inventor to make, use, and sell or distribute an invention for a specified number of years. But an invention to qualify for patent depends upon three basic tests- novelty, non-obviousness and industrial applicability. All the three concepts overlap each other. The element of novelty (newness) in an invention is dependent upon state of 'prior art', prior publication, prior knowledge etc. The judicial approaches towards the test of novelty have been based upon the person skilled in art. So, the test of novelty forms the one of the essential requirements of patentability which has been universally accepted.

KEYWORDS :

Introduction:-

Patent is an intellectual property right granted to the inventor with respect to that invention which is disclosed to the public in a consideration of exercising monopoly over his own creation. So, Patent, is a legal document granted by the government conferring an inventor the exclusive right to make, use, and sell or distribute an invention for a specified number of years. The goal of the patent system is to encourage inventors to advance the state of technology by awarding them special rights to benefit from their inventions. 'The object of the patent law is to encourage scientific research, new technology and industrial progress. The grant of exclusive privilege to own, use sell the method or the product patented for a limited period, stimulates the new invention of the commercial utility. The price of grant of monopoly is the disclosure of the invention at the patent office, which after the expiry of the fixed period of the monopoly, passes into the public domain.'

India being the member of the TRIPs Agreement has amended its own patent law. An invention to be patented, must qualify three basic tests. First, it must be new, which means the invention did not exist previously. Second, the invention must be non-obvious, which means that the invention must be a significant improvement to existing technology. Mere changes to known devices do not comprise a patentable invention. Finally, the proposed invention must be useful and must have industrial application. No patent will be granted for inventions that can only be used for an illegal or immoral purpose. In order to be patentable, an improvement on something known before or a combination of different matters already known should be something more than a mere workshop improvement; and must independently assure the test of invention or an 'inventive step'. To be patentable, the improvement or the combination must produce a new result, or a new article or a better or cheaper article than before. A combination of old known integers may be so combined that by their working inter-relation, they produce a new process or an improved result. Mere collocation of more than one integers or things, not involving the exercise of any inventive faculty, does not qualify for the grant of a patent.

Test of Novelty: -

Patent law centers round the concept of novelty and inventive step or lack of obviousness. The element of novelty (newness) in an invention is dependent upon state of 'prior art' which means existing knowledge and similar inventions already known in the particular field. An invention is said to involve an inventive step if, in the light of what is already known to the public, it is not obvious to a so-called skilled person, i.e. someone with good knowledge and experience of the field. An invention to be new must be considered in the light of the Section 2(1) (j), 13, 29, 30, 31, 32, 33, 34 of the Indian patent Act, 1970. An invention is considered as new if it is not anticipated by prior publication, prior use or prior public knowledge. An invention is new (novel) if it has not been disclosed in the prior art, where the prior art means everything that has been published, presented or other-

wise disclosed to the public before the date of filing of complete specification. However, the phrase 'state of art' is not defined in the Indian Patent Act. In such a situation it has to be ascertained from the interpretation given to the term by the court. Under the English Law it has been defined as: "the state of art in the case of an invention shall be taken to comprise all matter (whether a product, process, information about either, or anything else) which has at any time before the priority date of that invention been made available to the public (whether in U.K. or elsewhere) by written or oral description, by use or in any way." So the concept of 'state of art' which is nowhere defined under the Indian patent Act, 1970 may result in bringing in the European/English standards of novelty into the Indian law.

For the purpose of determining novelty, an application for Patent filed at the Indian Patent Office before the date of filing of complete specification of a later filed application but published after the same is considered for the purposes of prior claiming. While ascertaining novelty, the Examiner of the patent takes into consideration, the important documents i.e. Specification (Provisional of Complete Specification). Where the provisional specification is filed, complete specification must be filed within one year and the later application must have the priority. A prior art will be considered as anticipatory if all the features of the invention under examination are present in the cited prior art. The prior art should disclose the invention either in explicit or implicit manner. In a case where a prior art is cited as an anticipation in the Examination Report, which is not deemed to be an anticipation by reason on Section 29-34, the onus of proving is on the applicant. The following has been indicated as 'prior art' under the Act: (a) anticipation by publication before the date of the filing of the application in any of the specification filed in pursuance of application for patent in India on or after the 1st day of January 1912; (b) anticipation by publication made before the date of filing of the application in any of the documents in any country; (c) claim in any claim of any other complete specification filed in India which is filed before the application but published after said application; (d) anticipation having regard to the knowledge, oral or otherwise, available within any local or indigenous community in India or elsewhere.

Judicial approach: -

In order to be patentable, the new product or process must involve invention over the old process or product. It is not essential that the invention should be anything complex or complicated. It must merely be of such nature that it involves a technical advance as compared to the existing knowledge. It has been observed, 'To be new in the patent sense, the novelty must be shown in the invention. It is not enough that the purpose is new or that there is novelty in the application, so that the article produced is in that sense new. There must be novelty in the mode of application.'

Mere combination of two known substances does not result into patent. But if those substances give a new result, it is a question of fact of patentability. A patentable combination is one in which the component elements are so combined as to produce a new result or arrive at an old result in a better or more expeditious or more economical

manner. If the result produced by the combination is either a new article or a better or cheaper article than before, the combination may afford subject-matter of a patent.

An invention is not considered 'new' if the claimed invention is publicly known or publicly used in India before the priority date. As has been observed by the Supreme Court in *Monsanto v. Corommandal* that 'Publicly known does not mean that it must be published in a document, although not found in a book, it may form a part of the common knowledge among the public concerned. It also does not mean that it should be widely used to the knowledge of the consumer. It is sufficient if it is known to persons who are engaged in the pursuit of knowledge of the patented product or process, either as men of science or men of commerce or as consumers.'

The novelty and non-obviousness must be determined according to the person 'skilled in art'. A skilled person would be a person who 'has experience of the field in question and he may be one who have available assistants who would carry out tests'. In order to pass the test of obviousness, the prior art referred above must be of such nature as to inform the skilled person as to how the invention derived from the prior art is to be performed. In other words, the person skilled in the art must have the necessary information (through the prior art) to take the inventive step in question. Although no absolutely uniform test for determination of inventive step and non-obviousness which is interrelated to the concept of 'novelty' can be formulated, certain broad criteria can be indicated, whether the invention was publicly known, used or practiced before or at the date of the patent? If the answer is positive, it shall negate inventive step. An ordered approach to determine obviousness consisting of four steps was expounded in *Windsurfing International v Tabur Marine*: 'identification of inventive steps; a person having general knowledge of the concerned art at the priority date; to identify the difference between known matter and alleged invention by the skilled person; and to consider whether the differences would see to the aforesaid skilled person such as leading obviously to the alleged invention or that a degree of invention would be necessary to obtain the invention.' These test have been reiterated by the apex court in *Bishwanth Prasad's case*,

Any person who invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent, subject to the conditions and requirements of the law. *Novartis v. Union of India & Others* was held by the Supreme Court that the substance that Novartis sought to patent was indeed a modification of a known drug and that therefore the patent application was properly rejected by the patent office and lower courts. When examination of Novartis' patent application began in 2005, it was opposed by the opponents the generic companies that they were already selling Gleevec in India and it is generic which is known. The application was rejected by the patent office and by an appeal board. The key basis for the rejection was the part of Indian patent law that was created by amendment in 2005, describing the patentability of new uses for known drugs and modifications of known drugs. Although the court ruled narrowly, and took care to note that the subject application was filed during a time of transition in Indian patent law, the decision was appreciated globally and reignited debates on balancing public good with monopolistic pricing and innovation with affordability. Had Novartis won and gotten its patent, it could not have prevented generics companies in India from continuing to sell generic Gliaive, which would have hampered public interest in India.

Conclusion:-

An invention cannot be patented if the invention was known or used by others in India, or patented or described in a printed publication in India or a foreign country, before the applicant's priority date. Someone else has made the same invention as other did. The invention was patented or described in a printed publication in India or in a foreign country or in public use or on sale in this country more than one year prior to the application for patent in India. Therefore, the test of novelty, especially, forms the one of the essential requirements of patentability. This has been universally accepted as the essential prerequisite of patentability.

REFERENCES

- Bishwanath Prasad Radhey Shyam v. Hindustan Metal Industries, (1979) 2 SCC 511. | Ibid | Section 2(2) of the British Patent Act, 1977 | These provisions may be found in Chapter IV of the Act containing provisions for publication and examination of applications for patent and Chapter V of the Act dealing with opposition to grant of a patent. | *Blakey & Co. v. Latham & Co* [1889] 6 RPC 184 (CA) | *Lallubhai Chakubhai Vs. Chimanlal and Co.* (AIR 1936 Bom 99. | S. 64(1)(e) | AIR 1986 SC 712, 717 | *PLG Research v Ardon* 1993 FSR 197, 207 | *Hallen v Barbantia* 1991 RPC 195, 212 | *Windsurfing International v Tabur Marine* 1985 RPC 59 | (1979) 2 SCC 511. | April, 2013, available www.indiankanoon.org/doc/165776436/ |