

Patentability requirements in India

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Introduction

This article aims to provide an introduction to patentability requirements and concepts relating to evaluation of inventive step as per the Patents Act, 1970, of India. Corresponding statutory provisions in India and other major patent jurisdictions of the world will also be discussed briefly along with a few case laws which helped define the judicial provisions for patentability and inventive step.

Patentability and inventive step

The Patents Act, 1970 (hereafter referred as ‘the Act’) of India specifies the provisions that are used by the Indian Patent Office and the courts to determine whether a product or a process is worthy of a patent in India. The Act, vide Section 2(1)(m), provides that a patent may be granted for an “invention”. Further, the definition of “invention” is provided under Section 2(1)(j) of the Act as a new product or process involving an inventive step and capable of industrial application.

The three terms ‘new’, ‘inventive step’ and ‘industrial application’, provide the three main criteria for patentability. Accordingly, before applying for a patent, applicants must ensure that their inventions, prima facie, are novel, involve an inventive step, and can be used in or by the industry. Additionally, the Act, under Section 3, also provides a list of inventions that are specifically barred from being patentable even if they meet the aforementioned criteria and so, it is important that the applicants also ensure that their inventions do not fall under Section 3. The criteria related to novelty and industrial applicability are generally regarded as being well defined and understood based on the Act. However, the patent office, practitioners, courts and patentees often grapple with the concept of inventive step.

The Act defines the term ‘inventive step’ under Section 2 (1)(ja) as “a feature of an invention that involves technical advance as compared to the existing knowledge or having economic significance or both and that makes the invention not obvious to a person skilled in the art”. Apart from the presence of an inventive step being a necessary condition for patentability, a lack of inventive step is a valid ground for opposition under Sections 25(1)(e) and 25(2)(e), and for revocation under Section 64(1)(f) of the Act.

As per the definition of inventive step as set out under Section 2(1)(ja), a feature of an invention can be considered to possess an inventive step if it satisfies two conditions: (i) the feature either adds to existing technical knowledge, i.e., the prior art, or is substantially better

in terms of commercial viability; and (ii) it makes the invention non-obvious to a person skilled in the art.

Assessment of obviousness or deficiency of inventive step

In practice, obviousness is generally assessed using certain thumb rules that have been laid down by various cases in different patent jurisdictions. For example, the European Union utilizes the 'could-would' approach, where instead of only determining if a person normally skilled in the relevant field could perform the invention, it is determined whether he would arrive at the invention given the relevant teaching and technology at the time of the invention. In the United States on the other hand, the 'Graham factors' as laid down in *Graham et al. v. John Deere Co.* [383 U.S. 1 (1966)] are used as guidelines for assessing obviousness of an invention. The Graham factors involve objectively comparing the claimed differences between the alleged invention and the closest prior art while keeping in mind, the level of ordinary skill in the art.

The approach to assessing non-obviousness in India is not well defined at present since the instances of cases addressing the issue are few. Hence, in the Indian practice, an approach similar to those used in other major jurisdictions, as mentioned above, is used.

Case law interpretation of inventive step in India

Judicial interpretations of obviousness and inventive step in India may be considered to be at a relative stage of infancy. Except certain cases, such as *Bishwanath Prasad Radhey Shyam v Hindustan Metal Industries* [AIR 1982 SC 1444], and ratio from case laws of other jurisdictions, the interpretation of obviousness and inventive step is open for debate in India.

In *Bishwanath Prasad Radhey Shyam supra*, the Supreme Court (SC) addressed improvements and combination patents, where the importance of assessing inventive step in these cases was outlined. The SC held that in order for subject matter to constitute an inventive step, the alleged invention should be more than a mere workshop improvement. Furthermore, in the case of an improvement patent, the improvement must itself constitute an inventive step. If the alleged invention constitutes known elements or a combination of known elements, the result must be new, or result in an article substantially cheaper or better than what existed.

It is to be noted that the considerations of cost or economic significance, which are usually secondary considerations in other jurisdictions, are in-built as primary considerations both in the Act under the definition of inventive step and in the above mentioned case.

In another landmark case *Bajaj v. TVS* [Manupatra MIPR 2009 (2) 139], which is still pending, the High Court leaned towards understanding the technology entailed in the concerned patents with respect to the closest prior arts to judge whether or not the inventions possessed a technical advance. Furthermore, the prior arts cited in the International Search

Report (ISR) for Bajaj's application was used by the court in understanding the invention as well as judging the inventive step.

Further, in the patent cases of *Enercon (India) Limited v. Alloys Wobben*, the Intellectual Property Appellate Board (IPAB) dealt with the interpretation of inventive step as a part of the proceedings. Specifically, in order number 240/2010¹, which corresponds to one of the 12 cases of the Enercon litigation, the IPAB analyzed the claims of the impugned patent for obviousness or lack of inventive step based on the closest prior arts available at the time of the invention. For this, the IPAB relied upon Halsbury Laws of England, which stated the test for inventive step as: 'was it for practical purposes obvious to the skilled worker, in the field concerned, in the state of knowledge existing at the date of the patent to be found in the literature then available to him, that he should or would make the invention the subject of the claim concerned.'

The IPAB then went on to define the inventive step analyses as: 'would a non-inventive mind have thought of the alleged invention? If the answer is 'no', then the invention is non-obvious. If the patent claimed merely includes the development of some existing trade, in the sense that it is a development as would suggest itself to an ordinary person skilled in the art, it would fail the test of non-obviousness'.

Recent developments and future outlook

The Controller General of Patents, Designs and Trade Marks of India, has recently issued a Circular titled "Examination of Patent Applications and consideration of Report of Examiner by the Controller"² to streamline the patent examination procedure. The circular outlines various practices adopted by Examiners and Controllers of the Indian Patent Office (IPO) and the manner in which they are to further develop and improve their practices in order to provide the best possible patent protection with due diligence. With regard to grounds for rejection, the circular states "The Examiner shall raise objections on novelty and/or inventive step with reasons only. Frivolous objections without any reason/explanation cause delay in prosecution of an application. Further, raising an objection without justifying the same in the report is violative of the principles of natural justice."

It would be interesting to see if future office actions from the IPO adhere to the guidelines proposed in the latest circular. This will prove to be beneficial for understanding how the patent office and examiners deal with the issue of inventive step. Specific reasoning, if given, will also be useful during litigation, as courts can be then asked to clarify the principles to be followed for assessment of inventive step.

At present, due to the lack of Indian cases dealing with obviousness and inventive step in Indian Jurisprudence, the Indian Patent Office and the courts have relied on case laws of other major patent jurisdictions. Differences, if any, between the statute and practice would only be resolved by active intervention and interpretation of the statutory requirements by the

Indian courts. Going forward, one can expect clarity and gradual solidarity on the assessment of inventive step, as the number of cases filed and decided in this regard increase.

References

1. <http://www.ipab.tn.nic.in/orders/240-2010.htm>
2. Circular No. 4 of 2011 (No. CG/PG/Circular(Patents)/2011/468), Intellectual Property Office, India

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