

■ Topic 3: Legal Requirements for Patentability and typical Parts of a Patent Application

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Overview

- National Law
- Exceptions to Patentability
- Novelty
- Inventive Step
- Industrial Applicability

National Law

- Sri Lanka Intellectual Property Act 2003
 - Sec. 63 „novel, inventive step and industrially applicable“

Exceptions to Patentability

- **Depends on national law!**
- Discovery, Scientific theories, mathematical methods
- Aesthetic creations
- Inventions contrary to morality or public order
- Therapeutic and diagnostic methods
- Plant or animal varieties

Exceptions to Patentability

■ Software!

- However, software implemented inventions might be patentable
- i.e. invention involving an apparatus or process which makes use of a software, e.g. a specific computer chip with a software stored on it

Novelty

An invention is **new/novel** if

it was **not know to the public** before the date of filing of the patent application or the priority date claimed.

→ Prior art should not be patented again!

Novelty

- Absolute Novelty
 - No publication of the invention anywhere in the world
 - by means of **written** or **oral** description, **by use**, or **in any other way**
 - Also know as strict novelty requirement
 - Each feature of the invention in general in one single reference

Novelty

- Some national laws have a grace period
 - e.g. USA, Japan, Sri Lanka, etc.
 - But not European countries!

- Making available to the public within certain period before the date of filing not novelty destroying (e.g. USA, Sri Lanka)
 - = 12 months but only limited to acts by the applicant or his predecessor → **no protection against publication by third party!**

Novelty

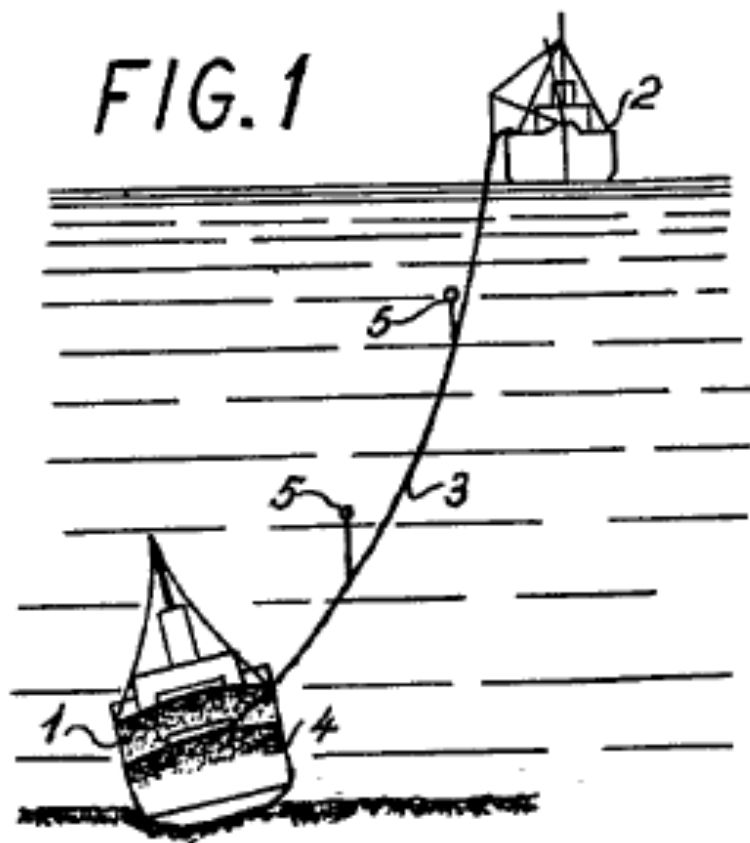
Examples:

- Presentation at a conference
- Publication in any kind of magazine
- Making use of the invention in a public place

Novelty

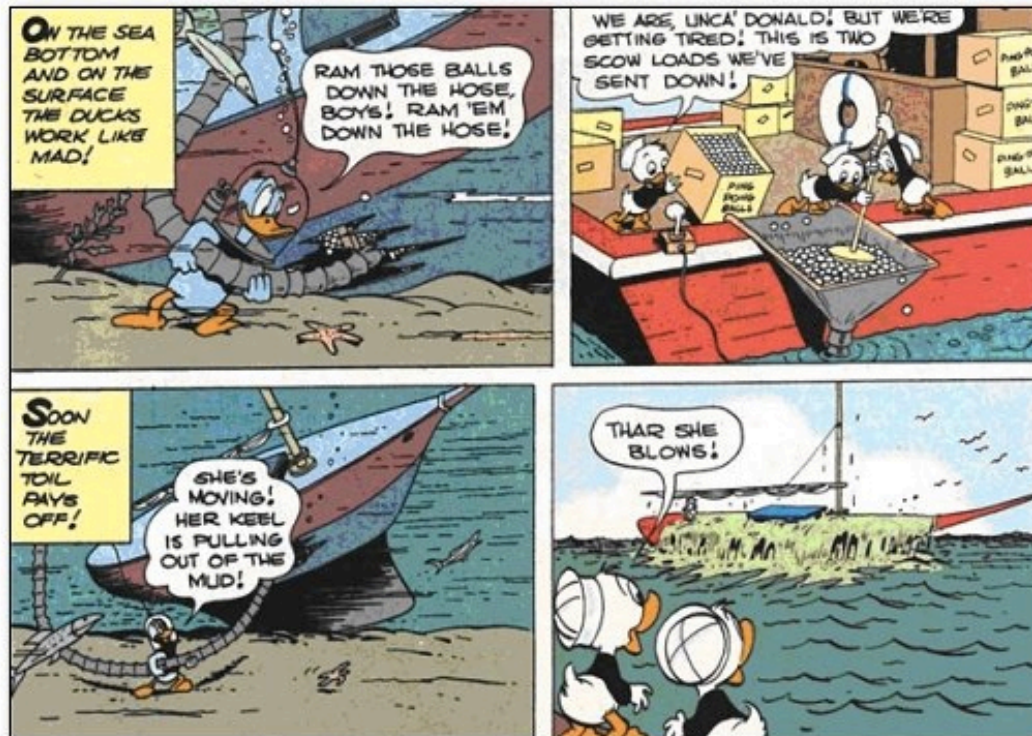
- The Donald Duck case:
- Mr Karl Kroyer: invention of a method to raise a sunken ship by filling it with buoyant bodies fed trough a tube
→ NL patent application not granted but GB and DE
- 1964: He lifted a sunken boat in Kuwait's harbor by filling the boat with 27 million plastic balls

Novelty



Novelty

- 1949: Donald Duck comic published by Carl Barks
- Shows Donald and nephews raising a ship by filling it with ping pong balls shoved through a tube



Novelty

- Prior art must contain all features of the patented invention

- Example:
 - Invention = wooden chair with seat and four legs with two rails (a rocking chair)
 - Reference X: wooden chair with seat and four legs
 - Reference Y: chair with four legs with two rails

→ Is Invention novel?

Novelty

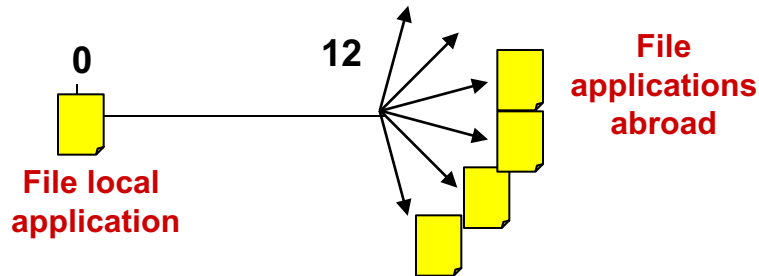
- Invention is novel
- Why?
- References X and Y do only disclose features of the invention together!
 - But invention may be obvious!

Novelty

- Date of filing important for prior art
- Any publication after the date of filing not novelty destroying
- Claiming of priority date possible
 - = date of filing of an earlier application in another country/region
 - Priority = 12 months
 - **No requirement to file subsequent applications within 12 months but advantageous in regard to novelty!**

Novelty

■ Priority example



- Filing date: December 1, 2016
- 12 months priority ends on: December 1, 2017
- For each filing within 12 months date for determining prior art = December 1, 2016

Inventive Step

- Invention should not be obvious to a person skilled in the art
- Person skilled in the art = Technician having all knowledge of the technical field of the invention
 - But no imagination or creativity!

Inventive Step

- Obvious?

- Any invention which does not go beyond the normal progress of technology so that a person skilled in the art would derive with the invention by looking at the prior art

- Invention Step = different interpretations in national laws!
 - Consultation of the national case law necessary!

Inventive Step

- Example:
 - Invention = wooden chair with seat and four legs with two rails (a rocking chair)
 - Reference X: wooden chair with seat and four legs
 - Reference Y: chair with four legs with two rails

- Invention most likely regarded as obvious
- Combination of references X + Y logical as both are chairs

Industrial Applicability

- Invention needs to be able to be used or made in any kind of industry
 - No industrial application if only able to be used in private or personal sphere!
 - E.g. method of contraception

- Invention does not need to be better than existing products or processes

Main parts of a patent application

- Title
- Introduction
- Background Art
- Short description of the invention
- Short description of the figures
- Detailed description
- Claims
- Drawings

Title

■ Very general

■ Broad

■ Neutral

■ Generic

Introduction

- Setting out the general technical field
- Very broad
- Very short

Background Art

- Description of the prior art already known in this field of technology
- Sets the scene and explains the problems with known devices, methods or systems

Description of the invention

- Brief description of the invention
- Often corresponds to the wording of the main claim
- Describes the advantages of the invention

Description of the figures

- Brief descriptions of what the drawings show if any are included within the patent application

Detailed description

- Details of the invention
- Typically references to drawings
- Preferred way of putting invention into practice
- Content very important for prosecution and opposition proceedings

Claims

- Heart of the patent
- Defines the scope of the claimed invention

Drawings

- Illustrate one or more preferred embodiments of the invention
- Do not limit the invention as defined in the claims

Thank you very much!

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