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
Thai Patent Act (1979)

- Sec. 5: “new, involve an inventive step and capable of industrial application “
- Sec. 6, 7 and 8: further definitions for novelty, inventive step and industrial applicability
- Sec. 9: exclusions to patentability
Exceptions to Patentability

- Depends on national or regional law!

- Discovery, Scientific theories, mathematical methods

- Aesthetic creations

- Inventions contrary to morality or public order

- Therapeutic and diagnostic methods

- Plant or animal varieties

- Plants or animals (other than microorganisms)
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, 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! (NB: US law more specific)
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 through 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 patentability!
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
- But: maybe different if surprising effect
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
- Description of preferred embodiments
- 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 patent protection
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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