

ISSN: 2582-6433



INTERNATIONAL JOURNAL FOR LEGAL RESEARCH AND ANALYSIS

Open Access, Refereed Journal Multi Disciplinary
Peer Reviewed 6th Edition

VOLUME 2 ISSUE 7

www.ijlra.com

DISCLAIMER

No part of this publication may be reproduced or copied in any form by any means without prior written permission of Managing Editor of IJLRA. The views expressed in this publication are purely personal opinions of the authors and do not reflect the views of the Editorial Team of IJLRA.

Though every effort has been made to ensure that the information in Volume 2 Issue 7 is accurate and appropriately cited/referenced, neither the Editorial Board nor IJLRA shall be held liable or responsible in any manner whatsoever for any consequences for any action taken by anyone on the basis of information in the Journal.

Copyright © International Journal for Legal Research & Analysis

IJLRA

EDITORIAL TEAM

EDITORS

Megha Middha



Megha Middha, Assistant Professor of Law in Mody University of Science and Technology, Lakshmanagarh, Sikar

Megha Middha, is working as an Assistant Professor of Law in Mody University of Science and Technology, Lakshmanagarh, Sikar (Rajasthan). She has an experience in the teaching of almost 3 years. She has completed her graduation in BBA LL.B (H) from Amity University, Rajasthan (Gold Medalist) and did her post-graduation (LL.M in Business Laws) from NLSIU, Bengaluru. Currently, she is enrolled in a Ph.D. course in the Department of Law at Mohanlal Sukhadia University, Udaipur (Rajasthan). She wishes to excel in academics and research and contribute as much as she can to society.

Through her interactions with the students, she tries to inculcate a sense of deep thinking power in her students and enlighten and guide them to the fact how they can bring a change to the society

Dr. Samrat Datta

Dr. Samrat Datta Seedling School of Law and Governance, Jaipur National University, Jaipur. Dr. Samrat Datta is currently associated with Seedling School of Law and Governance, Jaipur National University, Jaipur. Dr. Datta has completed his graduation i.e., B.A.LL.B. from Law College Dehradun, Hemvati Nandan Bahuguna Garhwal University, Srinagar, Uttarakhand. He is an alumnus of KIIT University, Bhubaneswar where he pursued his post-graduation (LL.M.) in Criminal Law and subsequently completed his Ph.D. in Police Law and Information Technology from the Pacific Academy of Higher Education and Research University, Udaipur in 2020. His area of interest and research is Criminal and Police Law. Dr. Datta has a teaching experience of 7 years in various law schools across North India and has held administrative positions like Academic Coordinator, Centre Superintendent for Examinations, Deputy Controller of Examinations, Member of the Proctorial Board



Dr. Namita Jain

Head & Associate Professor



School of Law, JECRC University, Jaipur Ph.D. (Commercial Law) LL.M., UGC -NET Post Graduation Diploma in Taxation law and Practice, Bachelor of Commerce.

Teaching Experience: 12 years, AWARDS AND RECOGNITION of Dr. Namita Jain are - ICF Global Excellence Award 2020 in the category of educationalist by I Can Foundation, India. India Women Empowerment Award in the category of "Emerging Excellence in Academics by Prime Time & Utkrisht Bharat Foundation, New Delhi.(2020). Conferred in FL Book of Top 21 Record Holders in the category of education by Fashion Lifestyle Magazine, New Delhi. (2020). Certificate of Appreciation for organizing and managing the Professional Development Training Program on IPR in Collaboration with Trade Innovations Services, Jaipur on March 14th, 2019

Mrs.S.Kalpna

Assistant professor of Law

Mrs.S.Kalpna, presently Assistant professor of Law, VelTech Rangarajan Dr. Sagunthala R & D Institute of Science and Technology, Avadi. Formerly Assistant professor of Law, Vels University in the year 2019 to 2020, Worked as Guest Faculty, Chennai Dr.Ambedkar Law College, Pudupakkam. Published one book. Published 8Articles in various reputed Law Journals. Conducted 1Moot court competition and participated in nearly 80 National and International seminars and webinars conducted on various subjects of Law. Did ML in Criminal Law and Criminal Justice Administration. 10 paper presentations in various National and International seminars. Attended more than 10 FDP programs. Ph.D. in Law pursuing.



Avinash Kumar



Avinash Kumar has completed his Ph.D. in International Investment Law from the Dept. of Law & Governance, Central University of South Bihar. His research work is on "International Investment Agreement and State's right to regulate Foreign Investment." He qualified UGC-NET and has been selected for the prestigious ICSSR Doctoral Fellowship. He is an alumnus of the Faculty of Law, University of Delhi. Formerly he has been elected as Students Union President of Law Centre-1, University of Delhi. Moreover, he completed his LL.M. from the University of Delhi (2014-16), dissertation on "Cross-border Merger & Acquisition"; LL.B. from the University of Delhi (2011-14), and B.A. (Hons.) from Maharaja Agrasen College, University of Delhi. He has also obtained P.G. Diploma in IPR from the Indian Society of International Law, New Delhi. He has qualified UGC – NET examination and has been awarded ICSSR – Doctoral Fellowship. He has published six-plus articles and presented 9 plus papers in national and international seminars/conferences. He participated in several workshops on research methodology and teaching and learning.

ABOUT US

INTERNATIONAL JOURNAL FOR LEGAL RESEARCH & ANALYSIS ISSN 2582-6433 is an Online Journal is Monthly, Peer Review, Academic Journal, Published online, that seeks to provide an interactive platform for the publication of Short Articles, Long Articles, Book Review, Case Comments, Research Papers, Essay in the field of Law & Multidisciplinary issue. Our aim is to upgrade the level of interaction and discourse about contemporary issues of law. We are eager to become a highly cited academic publication, through quality contributions from students, academics, professionals from the industry, the bar and the bench. INTERNATIONAL JOURNAL FOR LEGAL RESEARCH & ANALYSIS ISSN 2582-6433 welcomes contributions from all legal branches, as long as the work is original, unpublished and is in consonance with the submission guidelines.

MAKING A CASE IN FAVOUR OF ASSESSMENT OF GLOBAL NOVELTY OF INVENTIONS

AUTHORED BY - NAKUL SINGH *

* B.A. LL.B. (Hons.),

West Bengal National University of Juridical Sciences (NUJS), Kolkata

Conflict of interest: The author declared “No conflict of interest”

Funding: Nil

Abstract

The Aim of this paper is to demonstrate how the assessment of the novelty of an invention on a global scale or how assessment of global novelty is in public interest and furthers genuine and ingenuity in comparison to when assessment of novelty is merely done on a territorial scale. The paper will additionally elaborate on the concepts of what is understood by novelty of an invention and why is the assessment of novelty necessary. It is pertinent to note that Indian Patent regime is based on the assessment of novelty of an invention on a global scale, a paradigm which the author supports however, unlike India, there are many states which carry out the assessment of novelty in their jurisdictions merely on a territorial scale. The course of this paper will highlight the problems with this approach and why there is a need for change.

Key words: Invention, Assessment, Novelty

Introduction

Understanding Novelty:

Novelty is a crucial factor in determining whether an invention may be protected by a patent. It is evaluated in comparison to ‘prior art’ which is to say that the invention must be in stark contrast and unprecedented from the point of view of all the ‘prior art’ or previously published works, well-known processes, and commercial goods [1].

Anticipation of the invention is detrimental to novelty. Anticipation of an invention stands done when there is sufficient description, mention or disclosure of the invention in either patent or non-patent literature or there has been any prior use or commercial use either by the inventor themselves or any other person [2].

For an invention to be anticipated that is detrimental to novelty, it is also necessary that the disclosure must have been made in such a manner that by the aid of which, the invention can be successfully worked out, in other words, the disclosure of the invention or of the necessary elements must be an enabling disclosure [3].

Why is assessment of Novelty necessary?

Across jurisdictions, the dynamics of a patent grant is that in exchange for disclosing the innovation to the general public in order to advance the corpus of knowhow and technical knowledge in the public discourse, the patent system grants the patentee the exclusive right to restrict others from commercially utilising the invention [4]. The essential goal of the patent system is to ensure that nothing that already belongs to society gets alienated from it. In fact, awarding a patent on an innovation that is already well known would impose restrictions on society's use of existing knowledge without providing any compensation or benefit. The concept of novelty plays a significant role in defining what belongs to society and what may be withheld. As a result, one of the most significant and widely accepted concepts of patent law is the necessity for innovation or novelty in the proposed invention [5].

The assessment of novelty is also key in deciding which inventions should be accorded protection and which should not. It avoids a scenario in which two identical solutions would both get protection. It also serves as a defending argument in the hands of those who believe that an existing innovation is not worthy of protection. The simplest method to demonstrate why a solution should not be protected is to call into question its novelty. This makes it a crucial factor that should be adequately considered while determining how to safeguard one's own solution.

Additionally, the basic tenet of patent law is that only inventions equipped with utility and novelty are eligible for patent protection. A patent must be the inventor's original discovery in order to be

accorded protection, rather than just a confirmation of what was previously known at the time the patent was applied for [6].

A patent confers monopoly on commercially exploiting an invention in exchange for disclosing it to the public, the patent system aims to promote innovation. There is no benefit that is accrued to the public from re-disclosing an invention if it is previously known.

With a concept that is devoid of novelty it is also doubtful that you will be able to get any valuable intellectual property rights. This is primarily because if the concept is not novel or devoid of utility, it will typically have little to no economic or commercial value as well.

In the Indian scenario, when patent is a territorial right, why is assessment of Novelty done on a global scale?

While the applicant can simultaneously file an application for the same invention in a convention country or under the PCT [7] in the Indian framework, the grant and protection with respect to the invention is territorial in nature and only effective within the territory of India [8].

A question thus arises for consideration is that when the protective rights are territorial in nature, why should the assessment of novelty be done on a global scale?

It is pertinent to note that as far as the recommendations of The Patents Enquiry Committee¹ are concerned, it was recommended and affirmed by the committee that for determining anticipation public knowledge and public use only in India should be taken into account which is to basically imply that the standard of novelty should be territorially limited and should not be that of global novelty [9].

This recommendation and view were however modified by the Ayyangar committee Report on patents [10]. The Ayyangar committee held that, the situation with respect to the availability of books and literature in public libraries is different in India than it is in the United Kingdom. Public libraries are few in India and the majority of them lack enough resources for scientific literature, which is published in large quantities in the world's most industrialised nations like the United Kingdom. It is pertinent to note that a regulation like the one in the United Kingdom would allow someone to get a valid patent in this country for an invention about which information was already published abroad

before the date of the application, it would be clear that such a rule would be unjust and detrimental to public interest [11].

The report also noted how the world has significantly shrunk as a result of faster and improved forms of communication, and that those who travel to other nations or learn about inventions in other countries through foreign periodicals will have an unfair advantage or will have an unfair edge in obtaining patents in India on the pretext that the invention is "novel" in this country [12].

The Methodology for Determining Novelty

In order to determine whether the invention has been anticipated or not, the examiner searches the patent and non-patent literature for references to prior publications and prior claims in relation to the invention's claimed subject matter in order to determine whether the invention has been anticipated by prior publications and prior claims in order to establish the novelty of the invention [13].

For the purposes of ascertaining or determining novelty, the following documents are taken into consideration.

All Indian Patent Applications that claim the same subject matter but were filed before the date of filing the complete specification and published on or after that date. Moreover, the Examiner may take into account papers that have already been printed in an academic journal, special periodicals of learned societies and all documents comprising of patent and non-patent literature which potentially disclose the subject matter and can anticipate the invention [14].

The examiner also bears in mind that a prior art only anticipates an invention provided all the elements and features of the invention are present in the relevant prior art. Secondly, the disclosure of the invention by the prior art can either be explicit or implicit. Thirdly, for determining novelty, mosaicking of prior art documents should not be done. Fourthly, the novelty of a specific and precise disclosure is not necessarily taken away by a general disclosure but the novelty of a generic disclosure can be taken away by a specific disclosure [15].

In case the citation of prior art is to be rebutted on any of the grounds enumerated in sections 29-34, the onus of doing the same is on the applicant.

Are there any Jurisdictions where there is a geographical limitation of the protecting country on the assessment of Novelty

As far as the impact of anticipatory patent and non-patent literature in the form of prior art is concerned, the various patent regimes have chosen to take different methods. These strategies are not arbitrarily selected options; rather, they represent various patent cultures and societal goals, including the pertinent contexts in which invention is commercially exploited and utilized.

Globally however, there has been significant debate over the definition of "prior art". One argument is that what is solely known or disclosed or available in the public domain in the country providing protection should be taken into consideration when determining prior art. Even if the information was already accessible outside at the time the invention was made, it would not be included if it was not brought into the nation before the invention was made [16].

Another point of view is the assessment of global novelty, according to which an enabling disclosure already present or made in any form of patent or non-patent literature, anywhere globally is sufficient to be counted as prior art and accordingly anticipate the invention and destroy novelty [17].

Majority of jurisdictions across the global, have opted for the standard of global novelty. However, the jurisdictions of the United Kingdom (prior to 1977) and the even the United States Patent law have had geographical limitations on what constitutes prior art for the purposes of determining anticipation.

It is pertinent to note that scholars have for long argued for declaring the US patent law, 35 U.S.C. § 102 unconstitutional as it categorically excluded evidence of knowledge in public domain or use in foreign or developing countries, from being relevant or being considered for granting U.S. patents under the U.S. law. Be it knowledge in the public domain or prior use, both parameters were excluded in the determination of novelty and non-obviousness [18].

According to framers, the rationale for the geographical limitation was that, a technology known or used in countries abroad, if patented in the US would further the progress and growth of technology in the US by giving its citizens the access to the technology and its products which, otherwise they would not have had.

Prior to 1977, the position was similar in the United Kingdom, in the sense that publications or prior use outside the united kingdom was not detrimental to the grant of the patent in the United Kingdom, provided the information or technology was new in the united kingdom. The renowned case of Darcy v. Allein stated the objective of this limitation was to encourage the bringing and the development of industries in the commonwealth [19].

References

1. Mondaq, Novelty criteria in Patent application, available at <https://www.mondaq.com/india/patent/1192098/novelty-criteria-in-patent-application>
2. Mondaq, Novelty an Indian Perspective, available at <https://www.mondaq.com/india/patent/655226/novelty-an-indian-perspective>
3. Mondaq, Novelty an Indian Perspective, available at <https://www.mondaq.com/india/patent/655226/novelty-an-indian-perspective>
4. World Intellectual Property Organisation, what is a Patent? available at <https://www.wipo.int/patents/en/>.
5. World Intellectual Property Organisation, Intellectual Property Handbook, 2nd Ed. P.17.
6. Sean Seymore, Rethinking Novelty in Patent Law, Duke Law Journal, 2011, Vol.60(4).
7. IP India, Frequently Asked Questions, available at https://ipindia.gov.in/writereaddata/Portal/Images/pdf/Final_FREQUENTLY_ASKED_QUESTIONS-PATENT.pdf
8. IP India, Frequently Asked Questions, available at https://ipindia.gov.in/writereaddata/Portal/Images/pdf/Final_FREQUENTLY_ASKED_QUESTIONS-PATENT.pdf
9. Report of The Patents Enquiry Committee (1948-1950).
10. Report on the Revision of Patents Law, 1959.
11. Report on the Revision of Patents Law, 1959, P.40.
12. Report on the Revision of Patents Law, 1959, P.41.
13. IP India, Manual of Patent Office Practise and Procedure, 3rd Ed, 2019.
14. IP India, Manual of Patent Office Practise and Procedure, 3rd Ed, 2019, P.82.

15. IP India, Manual of Patent Office Practise and Procedure, 3rd Ed, 2019, P.82.
16. World Intellectual Property Organisation, Intellectual Property Handbook, 2nd Ed. P.27.
17. World Intellectual Property Organisation, Intellectual Property Handbook, 2nd Ed. P.27.
18. Margo Bagley, Patently Unconstitutional, The Geographical Limitation on Prior Art in a Small World, Minnesota Law Review, 2003.
19. Report on the Revision of Patents Law, 1959, P.43.

