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ISSN: 2582-6433

NON – OBVIOUSNESS UNDER PATENT LAW – ANALYZE WITH TEACH TEST

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ABSTRACT

The first patents were issued in the 15th century in England by Queen Elizabeth I, who granted exclusive rights to business owners and manufacturers. The history of patent law was kicked off by **Darcy v. Allin,** often known as "The Lawsuit of Monopolies," which was the first case involving a patent. Patents were first introduced into the British province of India under Act VI in the year 1852. Patents provide exclusive rights to novel ideas that are not easily predictable and have practical applications in industry.

"This project only addresses patentability based on non-obviousness."

SYNOPSIS

Objective of the study:

The objective of the study is to discuss and analyse the non-obvious ness of patents under patent law in India with case laws.

Scope of the study:

I will restrict my scope of the study to

1. non obvious ness of patents
2. obvious ness of patent
3. differences between obvious and non-obvious ness of patent
4. teach test of non-obvious ness

Significance of the study:

This study will help us to understand and gain knowledge about patent law which mainly focuses on obvious and non-obviousness of patents and test to determine the nonobvious ness.

Research methodology:

This project is purely doctrinal study which involves the analytical and descriptive study of retributive theory based on primary and secondary sources such as websites, books, journals, and internet-based information sources.

INTRODUCTION

Inventions may result in the issuance of patents. There is just a little amount of factual data to support the idea that the Patent System stimulates innovation in light of the technology that is available today. Patent applications are no longer a reliable predictor of levels of innovation since the existing legal system encourages creativity without assigning any value to the product of that creation. In order for the innovation to be eligible for patent protection, it is necessary for it to fulfil the requirements of not just TRIPS but also the local Patent Act.

An invention has to be novel, have some aspect that makes it non-obvious, and be useful to some sector of industry in order to be considered for a patent. The conditions for non-obviousness are meant to reach a middle ground between the societal cost and the incentive for the patentee. On the other hand, non-obviousness is decided by a variety of distinct factors, some of which include prior work, a person who is knowledgeable in the art, the relevant date, knowledge, a jury trial, objective review, and secondary consideration. Evaluating the non-obviousness criterion is difficult for a number of different reasons, including those listed above.

OBVIOUSNESS UNDER INDIAN PATENT LAW

Although the obviousness test was just added to the Patent Act in 2003, the Graham criteria and the Indian Perspective on the Obviousness norm are very comparable to one another. However, due to the fact that the obviousness test was just recently included in the Patent Act, the jurisprudence surrounding it is limited. The word "inventive step" does not have a definition under the 1970 Patent Act, despite the fact that it constitutes a reason for objection and revocation under Section 25(1) (e) and Section 64(1) (f), respectively. The only phrase that even comes close to being comparable is "innovation," which can refer to anything from a novel and beneficial manufacturing technique, process, method, or style to any machine, equipment, or other thing, as well as any created substance. Innovation is the only phrase that even comes close to being comparable.

There was no investigation into the significance of the "inventive step" since this concept was not included in the "innovation" framework. Therefore, the person who sought to acquire a patent on their invention was the one who had to prove that it did not involve any innovative steps in order to do so.

The definition of the word "innovation" as it is commonly understood today was established in 2003, when it was defined as a new product or technique that featured an innovative step and had a practical use in industry. The "inventive step" word was provided with a meaning and transformed into a factor that is considered throughout the process of examining patent applications as a result of the 2003 Amendment. The phrase "inventive step" comes from the Patents Act, which defines it as "a characteristic that renders the invention not evident to a person versed in the art." This definition is available in subsection 1 of section 2. (ja).

By way of the 2005 Amendment Act, the obviousness criteria was included into the Patent Act in a manner that was consistent with previous iterations. In Section 2(1)(ja), the definition of "inventive step" was altered to mean a characteristic of an invention that involves technological progress relative to existing knowledge or economic importance or both and makes the invention not evident to a person knowledgeable in the art. This change was made in order to comply with the requirements of the America Invents Act. The America Invents Act (AIA) states that an invention must be innovative, non-obvious, and useful before it can be protected by a patent. This modification was made in order to comply with the standards of the AIA. In contrast to the Amending Act of 2003, the definition of "inventive step" has been expanded, and one of the prerequisites for patentability is now the presence of economic importance. On the other hand, the use of "or" shows that economic importance is on par with technical development and that both elements need to be understood in terms of how artists think. This is because the usage of "or" is followed by a conjunction.

The Indian Patent Office's patent practise and procedure handbook explains its "inventive step" assessment. The draught manual assesses uniqueness and "inventive step" together. Section 3.14 of the handbook, "Determination of Inventive Step," lists the stages.

a) Determining the scope and content of the prior art to which the invention pertains;
b) Assessing the technical result (or effect) and economic value achieved by the claimed invention;
c) Assessing differences between the relevant prior art and the claimed invention;

ISSN: 2582-6433

d) Defining the technical problem to be solved as the object of the invention to achieve the result; and

e) Final determination of non-obviousness, which is made by deciding whether a person of

Thus, Person Ordinarily Skilled in the Art defines the "inventive phase." This hypothetical individual would next determine the previous art's breadth and substance, technical result relevance, and the invention's difference from it. Section 3.15 clarifies Person Ordinarily Skilled in the Art. The hypothetical construct should know these.

BISHWANATH PRASAD RADHEY SHYAM v. HINDUSTAN METAL INDUSTRIES [AIR 1982 SC 1444]

Provisions –

1. **Designs Act (16 of 2000), S. (10), S. (4), S.2(8), S.26(1)**
2. **Patents Act (39 of 1970), S.2(j), S.64**

Reasoning:

Patents are only given for novel and beneficial inventions. It must be original and useful. A patent must be the inventor's discovery, not a certification of prior knowledge. The Act of 1911 does not define "innovation" as beneficial, unlike the Patents Act, 1970. However, courts have always considered a patentable invention to be beneficial as well as novel. S. 26 (1) (f) of the 1911 Act allows patent revocation for lack of usefulness, which supports this judicious reading. An improvement on something known or a combination of things known must be more than a workshop improvement and independently fulfil the test of invention or a "inventive step" to be patented. The improvement or combination must provide a novel result, item, or better or cheaper product to be patentable. Old integers may be joined to create a new procedure or better outcome. Patents cannot be granted for collections of integers or other non-inventive items.

In the instant case, the patent described as "Method of and means for mounting metallic utensils or the like on lathe for turning them before polishing," which was patented by M/s. Hindustan Metal Industries, was neither a manner of new manufacture nor a distinctive improvement on the old contrivance, involving any novelty or inventive step having regard to what was already known and practised in the country for a long time before its alleged date of invention. There was little inventiveness or innovation. No research, independent thinking, originality, or talent went into the patented machine. When a partner of the business seeking patents was believed

ISSN: 2582-6433

to have devised the new procedure, his non-examination before the trial Court may infer lack of originality.

An invention's uniqueness and "inventive step" are mixed questions of law and fact, depending on the instance. The "manner of manufacturing" patented was publicly known, utilised, and practised in the nation before or at the patent date? Yes, will negate uniqueness or subject matter. Word-of-mouth or publishing may invalidate a patent (1887) 4 RPC 407, Rel. on (Para 24) "Does not entail any innovative stop" and "obvious" have specific meaning under Patent Law. Judge "obviousness" objectively.

The Controller's patent award does not imply patent validity. In revocation or infringement actions, the High Court may question the patent's validity, which is not guaranteed by the grant and sealing of the patent or the Controller's judgement in opposition. S. 13 (4) of the Patents Act, 1970 explicitly states that a patent award does not ensure its validity.

The correct approach to interpret a specification is to read the description first and then the claims, as the patentee cannot claim more than he wants to patent. The specification and claims must be interpreted together to give each claim an effective meaning.

Held:

The first Indian Supreme Court "inventive step" ruling. The Court cancelled Hindustan Metal's patent on a utensil holder because it lacked innovation and creative step. The Court said that a small adjustment to the claimed invention would make it apparent to any competent worker based on knowledge at the patent date. The Supreme Court's "inventive step" guidelines are as follows.

“For the determination several forms of the question have been suggested... ‘Whether the alleged discovery lies so much out of the track of what was known before as not naturally to suggest itself to a person thinking on the subject, it must not be the obvious or natural suggestion of what was previously known.'

... ‘Had the document been placed in the hands of a competent draughtsman or engineer as distinguished from a mere artisan, endowed with the common general knowledge at the ‘priority date', who was faced with the problem solved by the patentee but without knowledge of the patent invention, would have arrived at the invention”. The Supreme Court reworded the "obvious to attempt" criteria to find the patent lacked inventive step.

ISSN: 2582-6433

F. HOFFMANN-LA ROCHE LTD. V. CIPLA LTD

The Delhi High Court used the "obvious to try" test in the Bishwanath Prasad Case and stated that "the same (person ordinarily skilled in the art) cannot be read to mean that there has to exist other qualities in the said person like un-imaginary nature of the person or any other kind of person having distinct qualities..." **In Hoechst v. Unichem Laboratories and Ors.,** the Bombay High Court stated that "... an invention usually involves three stages,

(1) **the definition of the problem to be solved, or the difficulty to be overcome,**
(2) **the choice of the general principle to be applied in solving the problem overcoming the difficulty; and**
(3) **the choice of the particular means to be used...** merit in any one of these stages, or in the whole combined, may support the invention." The Graham Case and Bombay High Court phases are similar.

PRESS METAL CORPORATION LIMITED V. NOSHIR SORABJI POCHKHANAWALLA AND ANR [AIR1983BOM144]

Provisions –

1. **Patents Act (39 of 1970), S.25(1)(b), S.29, S.25(1)(e), S.25(1)(f), S.25(1)(g), S.15, S.16, S.18, S.19, S.57, S.59, S.78.**

Held:

Application for registration of Patent for invention relating to "Improvement in or relating to Mufflers or Exhaust Silencers for Internal Combustion Engines" - Objection on prior publication - Held, objection must be sustained as description of exhaust system and muffler was not materially different from that published in books. Workshop modification, not innovation.

Application for patent registration - Objection on grounds of obviousness of invention - Held, innovation was obvious and lacking in creative step due to previous publication.

Patentable inventions must be novel and valuable manufacturing methods under the Patents Act. Is it a manufacturing process and novel and useful? Both requirements must be met for an inventor to get a patent. Manufacture usually means creating physical products by hand or machine. If S.2(1) "new's and useful mode of manufacturing" were confined to the creation of new items without regard to patent and improved technique, the law's incentive to the inventor would be relatively narrow. "Manufacture" encompasses manufacturing innovations and

process modifications. "Manufacture" might also refer to a new procedure using existing tools. The best innovative manufacturing approach is subjective. "New and helpful technique or way of manufacturing" may be any physical phenomena in which the result, whether it creation or simple change, can be detected.

If the subject matter is evident, the inventor's claim may not be an invention. A good artist determines obviousness. Held, purported innovation was workshop modification, not invention. It was clear, so no inventiveness.

Patentees must fully define their claims. No patent may be awarded if the patentee's wording is unclear and confusing, regardless of design, carelessness, or expertise. The language chosen to describe an invention depends on the art-savvy people who will utilise the specifications.

"The matter of obviousness is to be judged by reference to the state of the art in the light of all that was previously known by persons versed in that art derived from experience of what was practically employed, as well as from the contents of previous writing, specification textbooks and other documents," the Bombay High Court ruled in another case. "The essential issue to be examined in a situation like this is: if the asserted discovery lies so far out of the track of what was known before as not neutrally to suggest itself a person's thinking on the topic it must not be the obvious or natural suggestion of what was previously known."

Reasoning:

Section 3 subject matter exclusions and obviousness standards are commonly interpreted together. The Supreme Court ruling in **Bishwanath Prasad Radhey Shyam v. Hindustan Metal Industries** interpreted Section 3(j), exclusion based on simple arrangement and rearrangement, together with Section 2. (ja). The Madras High Court read Section 3(d) of the Patent Act in **Novartis AG v. UOI** and examined the selection patent and its requirements. In foreign countries, the Obviousness Standard includes selection patents. The Canadian Federal Court of Appeal said in **Eli Lilly Canada Inc. v. Novopharm Limited** that the inventive step of a selection patent is whether the chosen compound has benefits over the other compounds in the genus. In **Sinclair & Carroll Co. v. Interchemical Corp.,** the US Supreme Court ruled that any sign that implies a compound or structure is a prima facie instance of obviousness. Thus, the subject matter exclusions in Section 3 of the Patent Act must be considered when applying the Obviousness test to India. As noted above, the authors of the Indian Patent Act included a greater burden of evidence in specific situations in the legislation, unlike other countries, which have done so via case law. To evaluate obviousness, several rulings analyse relevant previous art on patent date.

ISSN: 2582-6433

NON-OBVIOUSNESS UNDER PATENT LAW

The factors a court will look at when determining obviousness and non-obviousness are:

1. the scope and content of the prior art;
2. the level of ordinary skill in the art;
3. the differences between the claimed invention and the prior art; and
4. objective evidence of non-obviousness.

The legal conclusion as to whether a given product or process was obvious at the time of invention to one of ordinary skill in the pertinent art who had knowledge of all relevant prior art is a path fraught with pitfalls, including especially the inherent difficulty of making such a hypothetical judgement and the tendency to use even subconsciously "hindsight" and the inventor's own work to determine obviousness," according to the authority. In infringement proceedings, competing parties often provide contradicting expert evidence, failing to inform the decision maker. Thus, the courts use objective guideposts—what Judge Learned Hand dubbed the "history of the art" in his many insightful opinions to help them.

The importance of objective indicia of non-obviousness has long been recognised, including by the US Supreme Court in Graham v. John Deere, where the court stated that such objective indicia or "secondary considerations" as:

1. commercial success,
2. long felt but unresolved needs,
3. failure of others, etc. may be used to shed light on the invention's origin and may be relevant as indicia of non-obviousness.

The Intellectual Property Appellate Board in India has ruled that secondary factors are inadmissible under Indian law, notwithstanding their relevance in the US. "According to our Act, the patent is cancelled if the innovation is evident," the Board ruled in **Ajanta Pharma Ltd. v. Allergan Inc.** Secondary factors cannot affect that. Thus, secondary objective evidence does not affect legal non-obviousness. It is unclear whether India will use supplementary elements to determine obviousness.

TEACH TEST

Since the beginning of patent law, the idea of "teaching away" has been acknowledged. According to this theory, an invention is considered to be non-obvious if the previous art "teaches away" or otherwise discourages a person of ordinary competence in the art from following the route selected by the inventor. This idea is explained in a clear and concise

 ISSN: 2582-6433

manner in the Pozzoli case, in which the court came to the conclusion that: "Patentability is justified because the prior idea which was thought not to work must, as a piece of prior art, be taken as it would be understood by the person skilled in the art." He will read it with the bias that one of those people would have. Therefore, what is considered to be a component of the current state of the art is essentially a mixture of two things: the concept and the presumption that it would not be successful or would be unworkable. A patentee has proven anything new if he or she is able to demonstrate that, in contrast to the incorrect presumption, the invention will work or is practicable. He demonstrated that what seemed to be a "lion in the road" was really nothing more than a paper tiger. Therefore, his contribution is original, he has avoided apparent mistakes, and he is entitled to a patent.

DETERMINATION OF NON – OBVIOUSNESS

Obviousness is judged based on the hypothetical construct of a "person of ordinary skill in the art". The person of ordinary skill in the art must:

1. Be on the field.
2. Consider his risk-taking mentality while reviewing the preceding work.
3. Know that even a tiny structural modification in a product or technique may cause major functional changes.

The average artist should be given the issue and asked to fix it. "Hindsight Element" describes this. Obviousness is not shown by connecting the answer to the issue or explaining how the inventor achieved it. It is not allowed to look at the invention, figure out its logic, and then search for previous art materials that support such reasoning. Thus, the person of average competence in the art would continually be conditioned by the past art and carefully consider each conceivable alteration, change, or adjustment against the existing knowledge before acting.

CONCLUSION

The purpose of a patent is to foster scientific research, the development of new technologies, and the advancement of industry, and in exchange for that purpose, an exclusive privilege is awarded. In the same way, in order to qualify for a patent, an invention has to be unique, it needs to entail an inventive step, and it needs to have industrial use. All of these requirements need to be met before a patent can be granted. Before a patent could be issued for any innovation, these prerequisites would need to be satisfied in an absolutely flawless manner.

ISSN: 2582-6433

Because the Supreme Court of India has not issued a ruling on the problem, the Indian patent office is responsible for providing its own interpretation of what constitutes obviousness in patent applications. In the lack of authorities, the examiner's interpretation will vary from case to case and will require the exercise of discretionary authority. In recent years, there has been a rise in the number of patent infringement cases in India. In the years to come, we may probably look forward to considerably more precise tests for identifying whether or not innovations include an innovative step.

BIBILOGRAPHY

1. ALL INDIA REPORTER ONLINE SOFTWARE
2. INDIAN KANOON
3. WIPO Conversation on IP and AI, second session, Draft issue paper on Intellectual Property and Artificial Intelligence
4. BENJAMIN NATHAN CARDOZO, SELECTED WRITINGS OF BENJAMIN NATHAN CARDOZO