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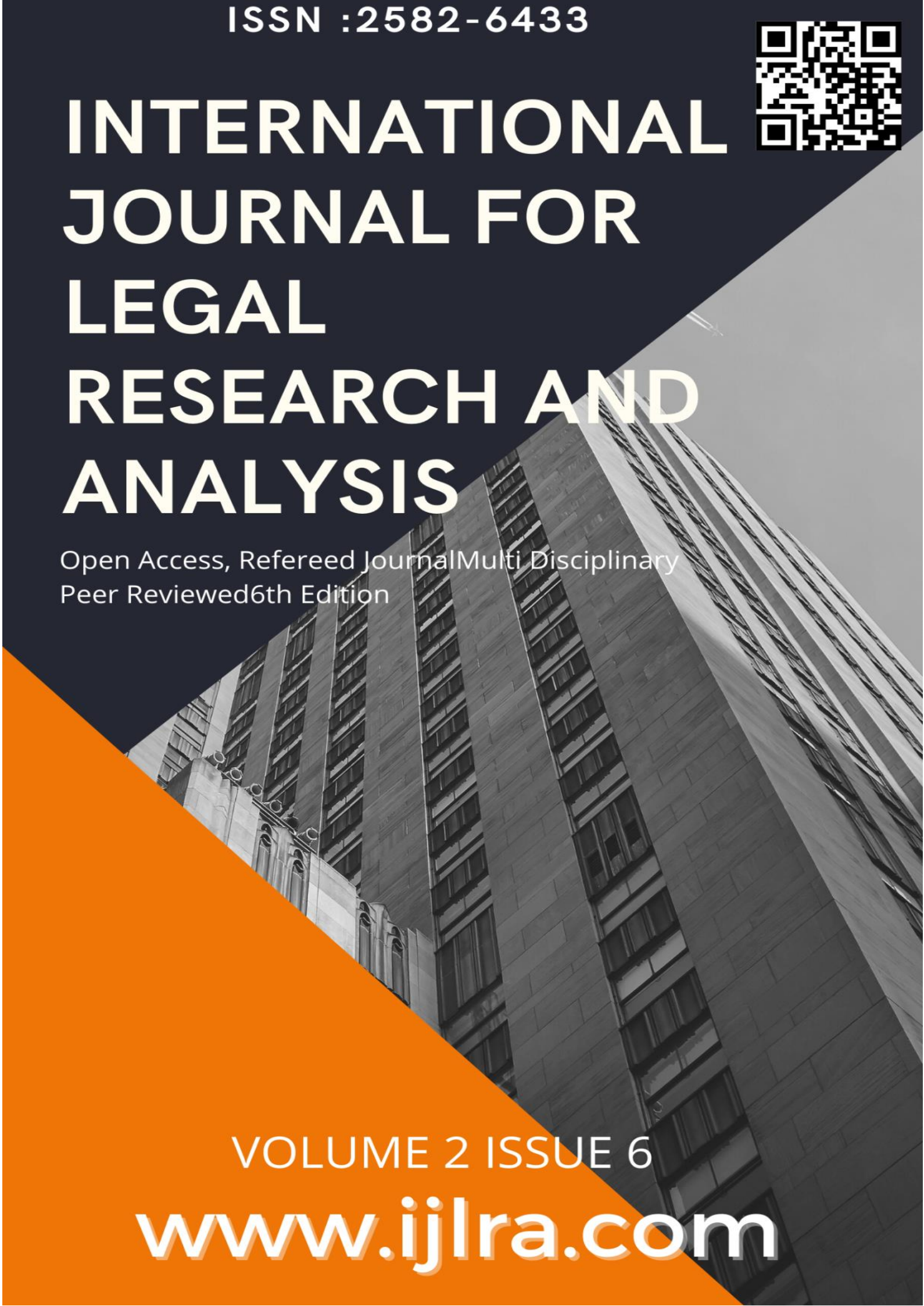

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Avinash Kumar has completed his Ph.D. in International Investment Law from the Dept. of Law & Governance, Central University of South Bihar. His research work is on "International Investment Agreement and State's right to regulate Foreign Investment." 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

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AN EVALUATION OF PERSON HAVING ORDINARY SKILL IN THE ART IN US PATENT ACT

Authored By- Reshmi Viju
LLM STUDENT (ONE YEAR LLM)
Inter University Centre For IPR Studies, Cochin University Of Science And Technology

Abstact

Intellectual Property is an emerging field of law in India, as we all know that the past few years, we witnessed a wide variety of inventions and the progress which was achieved by humans with the help of such inventions. According to the studies and research, the progress and development of a nation can be traced by the way of the number of indigenous patents which were filed by their peoples. This means the future of a nation is in the hand of inventors. When we trace the development and progress of United States economy, we can trace that the inventions and its development made them become a strong economy with advanced and finest technologies in the world.

This is happening only because of the innovation process and policies which is adopted by the American economy and especially in the field of their Intellectual Property laws. When we evaluate the Patent policies and its developments, we can trace their roots of progress. The way they give protection to a patentable invention and the rules which they followed during the patent examination process encourages their subjects as well as foreign companies to invent an invention or useful art and to file a patent on that invention.

By evaluating the origin of skill standard followed by the US Patent Law we can trace the meaning and evolution of hypothetical Person Having Ordinary Skill in the Art.

Introduction

Person having ordinary skill in the art is a hypothetical person which is widely used to find out the Non obviousness standard. As per the US Patent Act in order to grand a patent for an invention that invention should pass the patentability criteria.

Person having ordinary skill in the art (PHOSITA) is not a legal person but it's a hypothetical person which is interpreted by the judiciary by many judicial pronouncements in the matter of non-obviousness. When we traces the history of the non-obviousness concept we can observe that PHOSIA is possessing a key role in the determination of the Concept non obviousness.

The main aim of this paper is to trace the importance and evolution of the hypothetical concept PHOSITA.

1. Evolution Of Person Having Ordinary Skill In The Art (PHOSITA)

It is well evident that in order to grant a patent the invention must have to pass the three required standard fixed by the law. That is

a. Novelty
b. Usefulness
c. Non obviousness[1]

In order to get patent in USAthe claimed invention should be pass the patentability requirements. Those requirements are listed above. To analyze the inventive step the invention should be non-obvious to an ordinary skilled person or artisan. Here a question arise that who is the person having ordinary skilled in the art.

To find the answer have to trace the evolution of obviousness because in USA the person having ordinary skilled in the art was considered as a hypothetical person. And there is no separate section which talks about person having ordinary skilled in the art.

When we trace the roots of PHOSITA in USA we can found its implied presence in late 1851 that is in Hotchkiss decision. Hotchkiss v. Greenwood considered as the land mark judgement in the history of patent law. This case pawed the way for the hypothetical person that is person having ordinary skill in the art.

From the judgement itself we can see a sentence that is "an ordinary mechanic acquainted with the business"[2] which means an ordinary mechanic or a mechanic in that relevant filed of business or the ordinary skilled mechanic in the relevant filed.

The US Patent Act of 1952 is considered to be the era of changes and interpretations. In this Act the hypothetical concept Person having ordinary skill in the art (PHOSITA) can be found. The concept of PHOSITA was considered to evaluate the non-obviousness standard.

So, in shot we can observe that the hypothetical concept PHOSITA is impliedly present in the non-obviousness standard.

[1]USPTO 35 U.S.C. §101.
[2]Hotchkiss v. Greenwood 52 U.S. 248 (1851)

Tracing The Hypothetical Notion; Person Having Ordinary Skill In The Art

It is well known that in order to get the patent the invention should pass the patentability criteria. Whenever we analyse about patentability the first ever criteria or step is novelty. In order to get patent an invention should be new; which means such invention should be new in all its filed or new in the filed of such invention/ area of invention.

So, the novelty is considered as the prime step towards patentability of an invention. So whatsoever was existed in the public knowledge cannot be patented. Such knowledge will consider as common general knowledge.

A new change or alteration to an already existing invention is not eligible for patent; it is patentable only when such change of alteration brings or boosts its performance and such performance brings any substantial change in the existing invention, such invention is patentable even if it passes the patentability criteria. Substantial change means a mere change of a new invention when if it is compared to the older one or invention which is already existed. So, the process behind such invention is entitled to get patentability.

In short "The claimed invention must possess substantial novelty when compared to what already existed". This should be considered as a turning point of the US Patent history ever.

According to US Patent Act of 1790 in order to grant patent the invention must be

a. Novel
b. Usefulness

Here we can see that there is no separate condition for non-obviousness. The non- obviousness concept was within the inner area of novelty.

Tracing The Concept Phosita Through Non- Obviousness In Patent Act Of 1790 And Patent Act Of 1793

The Patent Act of 1790 was the first patent statute which passed by the federal government of USA. According to the US Patent Act of 1790 the condition for granting patent were; "any useful art, manufacture, engine, machine, or device or any improvement there on not before known or used" [3] "The sole and exclusive right and liberty of making, constructing using and vending to others to be used".[4] This was considered as the subject matter of US Patent Act of 1790.

The primary reason behind the amendment was the delay and strict examination which followed by the US patent examination office. So, during that period usefulness was givenmoreinevitable element for patent eligibility. Here in the word useful art, we can impliedly see the hidden presence of a skilled artisan in the relevant filed of invention. The word useful art also contributed a quantity of future interpretation of non-obviousness.

Later the US Patent Act of 1790 Act was amended by the congress.

PHOSITA In Us Patent Act Of 1793

After the amendment of US Patent Act of 1790, the patent law become more compactable and liberal. And the delay in granting patent was decreased. In Earle v. Sawyer we can trace the roots of obviousness. This case was considered as the landmark case which was challenges before the court on the ground if obviousness. In this case Justice Storey held that "The Act only requires that an invention be new and useful and nothing more was needed. A useful combination would be patentable if it has not been produced before". [5]

The decision by Justice Story was considered as a landmark and notable judicial pronouncement by the court in the case of obviousness.

While evaluating the origin of PHOSITA we can found its roots in the Hotchkiss judicial decision . That's why Hotchkiss case was considered as the landmark case which was challenged before the court on the ground of obviousness. In this case we can trace the primary establishment of the hypothetical person that is Person having ordinary skill in the art.

In Hotchkiss v. Greenwood the claim was regarding by the plaintiff was his invention was an improvement of clay/ porcelain knobs, such as door knobs.

[3] The US Patent system celebrates 212 years' The US Patent and Trademark office. 9 April 2002.
[4]Patent Act of 1790. Ch .7, 1 stat. 109- 112 (April 10, 1790) The First United States Patent Statute CHAP. VII. --An Act to promote the progress of useful Arts. Archived July 22, 2011, at the Wayback Machine(a)
[5]8 F. Cass. 254 (C.C.D. Mass. 1825) (No. 4,247).

Here the plaintiff filed an action of infringement against defendants alleging that later infringed the patent of the plaintiff's right for new and useful improvement in making door knob and other knobs of all kinds of clay used in pottery and of porcelain [6].

The issue raised was whether the plaintiff's action for "a new and useful improvement in making door and other knobs of all kind of clay used in pottery" was valid or not?

Here the court held that "for unless more ingenuity and skill in applying the old ingenuity and skill in applying the old method of fastening the shank and the knob were required in the application of it to be clay or porcelain knob that were possessed by an **ordinary mechanic acquired with the business**, there was n absence of that degree of skill and ingenuity which constitute essential elements of every invention."[7]So thus the patent was held invalid.

In this judgement the term ordinary mechanic acquired with the business is a implied term for skilled artisan in the relevant filed of art that is person having ordinary skill in the relevant field of invention. Person having ordinary skill in the art can be seen in the judgement in the word ordinary mechanic. The first form of PHOSITA was found its place in the aforementioned case in the year 1851.

After the Hotchkiss development the standard set by the concept on non-obviousness was started transforming. And it got developed.

In Cuno Engineering Corp. v. Automotive devices corp.[8] Justice story held that he agreesthat the use of the well known thermostatically controlled heating circuit which exemplified by Copeland is defining a substitution for manually controlled circuit but this is obvious to a person having ordinary skill in the art. It is also can be developed by a mechanic who is working in that relevant filed of art or invention.

The court held that in order to get patent, the invention shouldn't be a product of flash of creative genius. Here the court set flash of creative genius principle as a base for granting patent. And by delivering this judicial pronouncement the skill standard of a PHOSITA became higher than that of Hotchkiss case. That is in order to get patented the invention should not be the result of asudden flash of thought i.e., flash of creative genius.

From the above judgement the judiciary put PHOSITA at higher level or higher standard by stating the term flash or creative genius. Here we can observe that the evolution and growth of person having ordinary skill in the art was shifted from ordinary mechanic to inventive genius. Person having ordinary skill in the art should not be the product of flash of creative genius.

[6]Hotchkiss v. Greenwood 52 US 248 (1851)
[7]Ibid
[8]Cuno Engineering Corp. v. Automotive devices corp 314 US. 84 (1914)

With view ofdetermining and granting patent to an invention more easily and avoid the complexity in the skill standard of artisan congress took the matter in its own hand and enacted Patent Act of 1952 32 U.S.C Section 103. That is "A patent for a claimed invention may not be obtained, notwithstanding that the claimed invention is not identically disclosed as set forth in section **102**, if the differences between the claimed invention and the prior art are such that the claimed invention as a whole would have been obvious before the effective filing date of the claimed invention to a person having ordinary skill in the art to which the claimed invention pertains. Patentability shall not be negated by the manner in which the invention was made".[9]

Phosita In Graham's Development

In the decision of Cuno Engineering, we can see that the concept person having ordinary skill in the art was fixed at higher standard, there we can trace the roots of PHOSITA.

Person having ordinary skill in the art was the first ever showed its presence in the decision of Graham v. Jhon Deere. Technically speaking Graham's case was considered as the first case in all other jurisdictions which mentioned about the hypothetical person that is person having ordinary skill in the art (PHOSITA). Judicial decision in Graham's case were put forward three steps for finding the non-obviousness standard.

The court laid down the guidelines to be followed when assessing the non-obviousness standard and they are as following: -

1. The scope and content of prior art must be determined or identified
2. The differences between the prior art and the claims at issue are to be ascertained.
3. Determined whether those differences have been obvious to a person having ordinary skill in the Art.[10]

The person having ordinary skilled in the art was adopted to asserting the non-obviousness standard. It is well evident in the final step of grahams case which technically paved the way for the visible judicial interpretation of the term PHOSITA to determine the non-obviousness standard. In order to get a patent for an invention, the previous art in that invention must be determined by the patent examination office and the difference between prior art and the present art should be sorted and finally the board will examine that the sorted differences in the claimed invention is obvious to a person who having ordinary skill in the relevant area of invention.

The court invalidated the patent because on the ground that if failed the in the three step test.

And this case was also paved the way for interpreting secondary considerations for granting

[9]USPTO 32 USC §103
[10] 35 USC §§ 103 (a) 1952

patent on the ground of non-obviousness.

Environmental Designs v. Union oil corporation the court laid down six factors for the determination of skill standard or level of PHOSITA and they are as follows:

- The educational level of the inventor;
- Type of problems encountered in the art;
- Prior art solutions to those problems;
- Rapidly with which inventions are made;
- Sophistication of the technology
- Education level of active workers in the field[11]

Here the court laid down the above six factors for the identification person having ordinary skill in the relevant filed of invention. In these factors the education level of the inventor became conservatory in that period but it is made clear in the sixth factor; that is the education level of the inventor means the level of education of an active artisan or inventor in that relevant area of work or invention was made.

Here we can observe the skill standard of an active worker was evolved with the education or knowledge level of an inventor in the active filed of technology.

The skill standard of a person having ordinary skill in the art again become very high level. In order to get patent to an invention a person skilled in the art that is active worker should be non-obvious about such invention.

In KSR International Co. V. Teleflex Inc. Teleflex filed a lawsuit against KSR International, alleging that one of KSR's products violated Teleflex's patent on linking an adjustable vehicle control pedal to an electronic throttle control. KSR contended that the combination of the two parts was evident, and hence the claim was not patentable. The district court found in favor of KSR, but the Federal Circuit Court of Appeals reversed in January 2005.

The issue raised on appeal was the Federal Circuit correct in holding that an invention cannot be held "obvious", and thus unpatentable, without a finding of some "teaching, suggestion, or motivation" that would have led a "person of ordinary skill in the art" to the invention by combining previously-existing ideas?[12]

While evaluating this case the court held that **a person of ordinary skill in the art is also a**

[11]Environmental Designs v. Union oil corporation 713 F.2d 693 (Fed. Cir. 1983)
[12]KSR International Co. V. Teleflex Inc. Teleflex 550 U.S. 398, 421 (2007)

person of ordinary creativity, not an automaton[13]. And the supreme court also held that Court acknowledged that his description of a person having ordinary skill in the art (PHOSITA) does not necessarily conflict with Federal Circuit cases that described a PHOSITA as having "common sense" and who could find motivation "implicitly in the prior art. [14]

During the evolution process of the hypothetical person; PHOSITA from the very beginning it was considered as an ordinary mechanic to inventive genius then to an ordinary creativity.

In this case the court considers the TSM Test to find the skill standard of a person having ordinary skill in the art. Here the court took secondary measures to evaluate the skill standard of a person having ordinary skill in the art.

In Apotex Inc v. Daiichi sankyo Co. the federal circuit held that the district court examined the patent for obviousness and determined that a person with ordinary skill in the art pertaining to the patent would have a medical degree, experience treating ear infections, some knowledge of the pharmacological use of antibiotics, and be a pediatrician or general practitioner[15]

The hypothetical concept PHOSITA was started from ordinary mechanic to ordinary designer and finally in ordinary researcher. As according to the situation, the hypothetical person that is PHOSITA is still developing and interpreted as according to different kinds of technologies.

[13] Ibid
[14] Ibid
[15] Apotex Inc v. Daiichi sankyo Co781 F.3d 1356 (Fed. Cir. 2015)

Conclusion

From this paper we can observe that person having ordinary skill in the art is a hypothetical person and which is constantly used in US Patent office during the patent examination process in order to find the non-obviousness criteria.

While evaluating those case laws which was decided by the US Judiciary and we can observe that person having ordinary skill in the art plays a crucial role during the examination process.

When we look into the case laws the jurisdictional aspect of PHOSITA is keep moving and flexible; that means in some judicial pronouncements we can found that PHOSITA was set in higher standard and in some aspects and new interpretation its keep moving or its standard is changing.