

RESEARCH WORKERS AND THE PATENT SYSTEM*

II. WHAT IS PATENTABLE?

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“ORIGINALITY” may be said to be a *sine qua non* for enjoying protection under the patent system. But every achievement of human effort where originality has been displayed is not capable of being protected by means of patents. Patents are granted for ‘inventions’ only, and the term ‘invention’ may be defined as ‘any manner of new manufacture’. It is obvious from this definition that patentable subject-matter should possess ‘novelty’ and should be essentially a ‘manufacture’. It has, however, been held by the courts that anything which is a ‘manufacture’ and which has ‘novelty’ is not necessarily a ‘manner of new manufacture’ and that in order to fall within the scope of the latter expression the subject-matter should necessarily be the outcome of ‘inventive ingenuity’.

In this article, an attempt is made to give concrete ideas underlying the expressions ‘novelty’, ‘manufacture’, and ‘inventive ingenuity’, as they are understood in patent law.

(i) What is ‘novelty’?

The significance of the expression ‘novelty’ will now be considered. In patent law ‘novelty’ is not understood in its strict etymological sense, and does not imply the state of being never known before. The patent laws of various countries have laid down different standards of novelty requisite for the grant of patents within their jurisdiction. The scope of this article, however, will be confined to the requirements of the British Patent System, on which the patent laws of this country are based.

The ‘novelty’ of an invention is invariably considered with reference to what constitutes ‘public knowledge within the realm’. It has therefore to be judged from the territorial as well as the “public knowledge” aspects.

The origin of the territorial aspect of ‘novelty’ may be traced to the early days of the patent system, when artificers from abroad were encouraged to settle down in England and introduce new manufacture within the realm, by the grant to them of monopolies in respect of such manufactures. Due to this territorial aspect of ‘novelty’, it is now possible to obtain patents for inventions which, though already in existence abroad, are new within the realm.

The real significance of the ‘public knowledge’ aspect seems to have been not fully appreciated by those engaged in research, as, in many cases, inventors have failed to enjoy patent protection on account of their utter disregard of the principles underlying it. The subject therefore deserves more than a passing reference, and will be dealt with at some length in this article.

Now, one of the cardinal principles of the modern patent system is that under no circumstances must a patent interfere with the rights of an individual to make use of any manufacturing processes or apparatus which has come to his knowledge, unless the right to the exclusive use of such process or apparatus has been previously reserved by someone else. In the ordinary course, he may obtain this knowledge by seeing the process or apparatus actually at work in a factory or in a show-room, or at a demonstration or at an exhibition; or he may obtain it by reading a description of the process or apparatus in a publication, or by hearing an account thereof by way of lectures. The information which is thus made available to the public before it is

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protected by applying for a patent for it, is taken as being unconditionally dedicated for general public use, and as such, cannot thereafter be monopolised by anyone, including the author of the information. This principle, however, is completely disregarded by many scientific workers in various ways, some of which are briefly referred to in the succeeding paragraphs.

For example, a large class of inventors are under an impression that for establishing their prior claim to inventorship, they should publish an account of their researches in scientific journals, at the earliest possible opportunity. They seem to forget for the time being that the patent system not only provides them with an equally well recognised means of establishing their priority, but has the added advantage of retaining their proprietary rights over their inventions. By rushing to the press in the first instance, they lose once for all their proprietary rights over the invention published, because the moment an invention is published without applying for a patent for it, it becomes the property of the public. Inventors of this class should therefore remember that even if they are anxious to establish their priority of inventorship, it is advisable for them to file their patent applications at least simultaneously with the publication of their inventions in the scientific journals, if not before such publication.

These remarks apply with equal force to the publication of inventions that takes place through the reading of papers before learned societies, or through the delivering of popular lectures, or through demonstrations at exhibitions. Wherever such publication takes place before steps are taken for the protection of the inventions concerned, the said inventions become thereafter a part of the stock of public knowledge and even the inventors will not be allowed to interfere with the rights of free use of the invention by the public.

It is recognised, however, that considerable time will be taken up for making a proper application for a patent and that the exigencies of the circumstances may demand an immediate publication of the inventions made by scientific research workers. To meet such a situation, a special provision is made in the Indian Patents and Designs Act, *vide* Section 40, by which

inventors are allowed to publish their inventions at exhibitions or before learned societies, even before making a proper application for a patent, provided they pay a small fee of Rs. 5 and send a brief description of their invention to the Patent Office. By adopting this simple course, inventors could proceed with early publication of their invention at exhibitions or before learned societies, without prejudicing their right for filing a proper application for a patent after such publication.

Some inventors who are in need of financial backing for the exploitation of their inventions often find it necessary to explain the working of their inventions to the potential financiers, and very often they do so without enjoining any promise of secrecy. These inventors ignore that the financiers who come into the possession of the full knowledge of such inventions in such circumstances, can, if they choose, make use of the inventions without any recompense to the original inventors. Even where such a disclosure takes place in a confidential manner, the inventors very often find it extremely difficult to establish that the disclosure was made confidentially. It is therefore best not to disclose the invention to others except after filing an application for a patent; but where this is unavoidable, inventors should take particular care to have at least some documentary evidence of the secret nature of the disclosure made to the financiers.

The same precaution should be taken where, at the experimental stage, it becomes necessary to disclose the invention to mechanics and technicians whose services may be engaged for completing the invention.

Another danger to the novelty of an invention may arise from the fact that it was developed in a workshop or a factory where other employees who are not bound to secrecy had ample opportunities to obtain a knowledge of the invention. In such cases, these other employees would be at liberty to disclose the invention to rival manufacturers or to make use of the invention for their own benefit to such an extent as to constitute a bar to the grant of the patent to the inventor. The only safeguard against this danger is either to work out the experiments secretly or to adopt a system of binding all employees to a bond of secrecy.

The foregoing paragraphs illustrate how owing to a lack of proper appreciation of the "public knowledge" aspect of "novelty", the inventors themselves destroy the novelty of their inventions. Cases in which the responsibility for the public knowledge of the invention does not fall on the inventors, are also deserving notice, because an invention which has become publicly known, whether through the inventor or through any other source, would be thereafter not "novel". In this connection, it should be noted that an important source of public knowledge of inventions in this country is the patent literature available at the Patent Office at Calcutta.

Abridgements of thousands of specifications of patents granted in the United Kingdom, U.S.A. and Australia, and also the publications of the Indian Patent Office, are available for inspection in the public room of the Patent Office, and any invention which is described in any of these documents is deemed to have lost its novelty. Applicants for patents very often argue that their inventions were made by them independently, or that what is described in the aforesaid patent literature, is not actually "in practical use" in British India, and that the mere fact that a paper anticipation of the invention was available at the Patent Office, should not be a valid ground for refusing the grant of a patent for their invention. It is therefore worthwhile to repeat here that individual inventive merit involved in an invention is not the sole criterion for the grant of a patent, but the novelty of the invention with reference to what already constitutes 'public knowledge' has an equally important bearing on the question.

It is also noticed that research workers realise only too late that the ordinary technical literature which is consulted by them in connection with their researches contains but a small fraction of the inventions disclosed to the public through the patent literature mentioned above. The importance of consulting the patent literature before undertaking elaborate investigations cannot therefore be overemphasised,

as, the omission to do so might lead merely to the rediscovery of what was previously invented by others.

It is also necessary to refer here to the special case whereby even the secret use of an invention imposes a disability on the inventor as regards its patentability. This is contained in Section 38 of the Indian Patents and Designs Act which provides that an invention shall not be deemed a new invention if the inventor has not by secret or experimental user made substantial profits from his invention. Due to this provision an inventor cannot, by resorting to secrecy in the first instance, hope to enjoy a monopoly for his invention for a period over and above that which would be available to anyone who comes for a legal protection under the patent system. This serves also as an additional inducement to the inventor to apply for his patent as soon as he completes his invention, without keeping it back from the public with a view to work it in secrecy.

The practical aspects of "novelty" may therefore be summed up as follows:—

- (1) before undertaking researches of practical utility, research workers should in the first instance, study the patent literature available on the subject;
- (2) as far as possible, the results of researches should not be disclosed to others before taking proper steps to protect the inventor's right;
- (3) if, however, it becomes absolutely necessary to disclose the inventions to contractors, capitalists or co-workers, even before applying for the patent, care should be taken to enjoin secrecy; and where possible, evidence should be created of the confidential nature of the disclosure; and
- (4) if there is an idea of patenting an invention, the invention should not be worked for profit before applying for a patent therefor.