

National Patent Drafting Course

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Legal Requirements to Patentability in Malaysia and Abroad

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Patentable inventions

- An invention is patentable if it is new, involves an inventive step and is industrially applicable
- Section 11

Patentability and novelty

- Section 11
- New.

Novelty/new

- An invention is new if it is not anticipated by prior art.
- What does anticipated mean.
- Other country uses the word such as “ an invention is new if it is not part of prior art.
- EPC
- An invention shall be considered to be new if it
- does not form part of the state of the art.
- (2) The state of the art shall be held to comprise

Meaning of novelty

- Section 14
- New if not anticipated by prior art
- What is prior art?
- What is the date to test prior art?

Prior art

- Section 14(2a)
- Everything disclosed to the public
- Anywhere in the world
- Whole world content
- Written publication
- Oral disclosure
- Use

Prior art

- Whole world content

- Patent document
- Non patent document
- Prior to the priority date
 - - first filing the date of filing
 - - claiming priority will be the priority date

Novelty = 2
question to
be ask?

- Whether any particular document or act can be relied on against the validity of a claim having a later priority date.
- Whether the contents of the documents or acts invalidate the claim due to lack of novelty.

Cases on lack of novelty

- MADE AVAILABLE TO THE PUBLIC
- P.L.G research Ltd. Ardan International Ltd. 1993 FSR 197
- “ made available to the public ” should be given the same meaning as the word “published”.
- Genentech Inc.’s Patent 1989 RPC 147
- “ to form part of the state of the art, the information given by the user must have been made available at least to one member of the public who was free in law and equity to use it.”

Types of making available

- 1. making available by oral disclosure
- Case: *Humpherson v Syer* 1887 4 RPC 407
- 2. Making available by documents.
- - written disclosure.
- - *Lang v Gisborne* 1862
- Exhibition sending it to bookseller.
- Copies received at patent office
- Case *Harris v Rothwell* 1887 4 RPC 225

Making available by prior use

- Bristol- Myers Co. Application 1975, 36 RPC 127.
- “ there was a use of an antibiotic, the subject of the invention by its sale as part of of a mixture of compounds even though its presence was not detected’
- Stahlwerk Becker AG 1919 36 RPC
- Steel was manufactured and used before patent application.
- Samples or free gift
- Fomento v Mentmare 1956 RPC 87

Prior used

- Selling the product
- Carpenter v Smith 1841 1 WPC at pg 43
- Lock was used for 16 years before patent application.
- Taylor's Patent 1896. 13 RPC 483
- Patent for fire grate . Used in private house with no secrecy.
- Offer to sell

Secret use

- Bristol- Myers case “ secret meant done with the intention of being concealed; clandestinely.”
- The test is objective “ secret = concealed in fact”

Experiments and trials

- Experiments in the course of making the invention is not prior use.
- Case : Housefill Co. v Neilson 1843 1.WPC 673

The Sign Post Test

- Whether the client has something new or not new
- Case: General Tire & Rubber v Firestone Tyre and Rubber Co.Ltd(1972) RPC.

Exception to
prior used/
disclosure
are
disregarded

- Section 14(3a)
- -disclosure within 1 year by applicant from date of application
- “ if such disclosure occurred within one year preceding the date of the patent application and if such disclosure was by reason or in consequences of acts committed by the applicant or his predecessor in title
- Grace period provision
- Section 14(3b)
- - abused of right

Exception section 14 (3b)

- Disclosure due to abuse of rights
- “if such disclosure occurred within one year preceding the date of the patent application and if such disclosure was by reason or in consequences of any abuse of the rights of the applicant or his predecessor in title

Section 14(3c)

- If such disclosure is by way of a pending application to register the patent in the United Kingdom Patent Office as at the date of coming into force of this Act

14(3C)

- No longer applicable
- 31 years.

2nd use of substance/ composition

- Section 14(4)
- Does not exclude patentability of substance or composition comprised in prior art for use in method referred 13(1d), if its use in any such method is not comprised in the prior art.

Section 13 (1d)

- Does not allow patent for methods for the treatment of human or animal body by surgery or therapy, and diagnostic methods practised on the human or animal body : provided that this paragraph shall not apply to products used in any such methods
- - compound ,substance etc

Second medicinal use

- ever-greening

Application of grace period in other country

- United Kingdom
- 6 months
- EPC
- 6 months
- USA
- 1 year

- For the application of Article 54, a disclosure of
- the invention shall not be taken into consideration if it
- occurred no earlier than six months preceding the
- filing of the European patent application and if it was
- due to, or in consequence of:

EPC

- a) an evident abuse in relation to the applicant or
- his legal predecessor, or

- (b) the fact that the applicant or his legal predecessor
- has displayed the invention at an official, or
- officially recognised, international exhibition falling
- within the terms of the Convention on international

2nd element

- Section 11
- Involved an inventive steps
- Section 15

Meaning of invention

- Section 11.
- New, involve inventive step
- Industrially applicable

Inventive step Section 15

- An invention shall be considered as involving inventive step if having regard to matter forming part of prior art under section 14 (2a) such inventive step would not be obvious to a person having ordinary skill in the Art.

Prior art

- Section 14(2a)
- Everything disclosed to the public
- Anywhere in the world
- Whole world content
- Written publication
- Oral disclosure
- Use

To Test Prior art against KASTA

- Section 14 (2)
- Same meaning.
- But must test it against the KASTA person.
- (knowledgeable average skill technician in the art)
- Meaning of obviousness :- even if something is new but if it is obvious it will fails as an invention.
- Whether obvious or not would depend on the novelty.

3 step approach

- What is the state of the ART
- Who is the man skill in Art against whom the test is to be applied.
- Is the invention obvious or not.?
- “ test is against the skill addressee.

Question to asked

- Would it be obvious to put different document together
- Must the document be all in the same field.
- How many document to combine together?
- Would it be obvious to put different document from different field?

Indication of inventive steps

- Does the invention overcome a technical difficulty. (problem solving)
- Does the invention satisfy a long felt want?
- Does the invention adopt something that people have missed, does it go against a technical prejudice.
- Is the invention an unexpected breakthrough.

Cases

- John-s Mansville Patent 1967 rpc (filtration process)
- Claims was for the production of asbestos. This process used a known agent in a new way. There was 2 prior publication on the known agent. 1) sale pamphlet which gave particulars of the agent for used in the mining industry.
- 2. an article in another journal in the pulp and paper manufacturing industry

Cases;

- Case : Olin Matieson Chemical Corp v Biorex Laboratories 1970 RPC
- ICI's Pointers Application 1977 FSR 434,

Third element Industrial application

- Much more easier
- An invention shall be considered industrially applicable if it can be made or used in any kind of industry.

Industrial application

- Section 11
- Section 16
- - made or used in any kind of industry
- IPC
- - international patent classification
- - microorganism

Industrial application EPC

- An invention shall be considered as susceptible of
- industrial application if it can be made or used in any kind of industry, including agriculture