

# ■ **Topic 3: Legal Requirements for Patentability and typical Parts of a Patent Application**

**Chiang Mai,  
October 2, 2017**

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# Overview

- National Law
- Exceptions to Patentability
- Novelty
- Inventive Step
- Industrial Applicability

# National Law

- Thai Patent Act (1979)
  - Sec. 5 : „new, involve an inventive step and capable of industrial application “
  - Sec. 6, 7 and 8: further definitions for novelty, inventive step and industrial applicability
  - Sec. 9: exclusions to patentability

# Exceptions to Patentability

- **Depends on national or regional law!**
- Discovery, Scientific theories, mathematical methods
- Aesthetic creations
- Inventions contrary to morality or public order
- Therapeutic and diagnostic methods
- Plant or animal varieties
- Plants or animals (other than microorganisms)

# Exceptions to Patentability

## ■ Software!

- However, software implemented inventions might be patentable
- i.e. invention involving an apparatus or process which makes use of a software, e.g. a specific computer chip with a software stored on it

# Novelty

An invention is **new/novel** if

it was **not know to the public** before the date of filing of the patent application or the priority date claimed.

→ Prior art should not be patented again!

# Novelty

- Absolute Novelty
  - No publication of the invention anywhere in the world
    - by means of **written** or **oral** description, **by use**, or **in any other way**
  - Also know as strict novelty requirement
  - Each feature of the invention in general in one single reference

# Novelty

- Some national laws have a grace period
  - e.g. USA, Japan, etc.
  - But not European countries!
- Making available to the public within certain period before the date of filing not novelty destroying (e.g. USA, Sri Lanka
  - = 12 months but only limited to acts by the applicant or his predecessor → **no protection against publication by third party! (NB: US law more specific)**



# Novelty

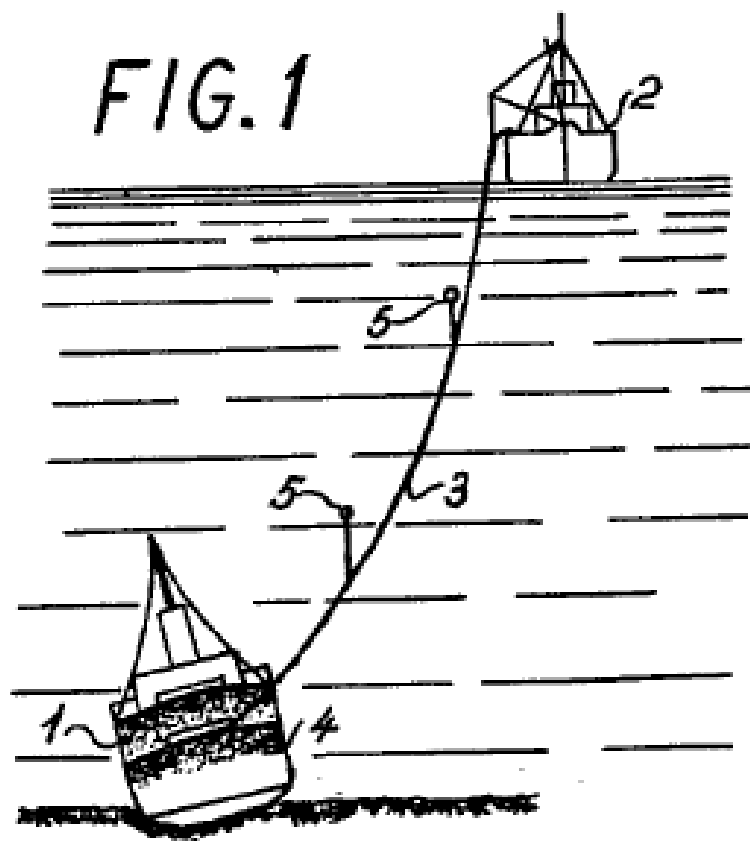
Examples:

- Presentation at a conference
- Publication in any kind of magazine
- Making use of the invention in a public place

# Novelty

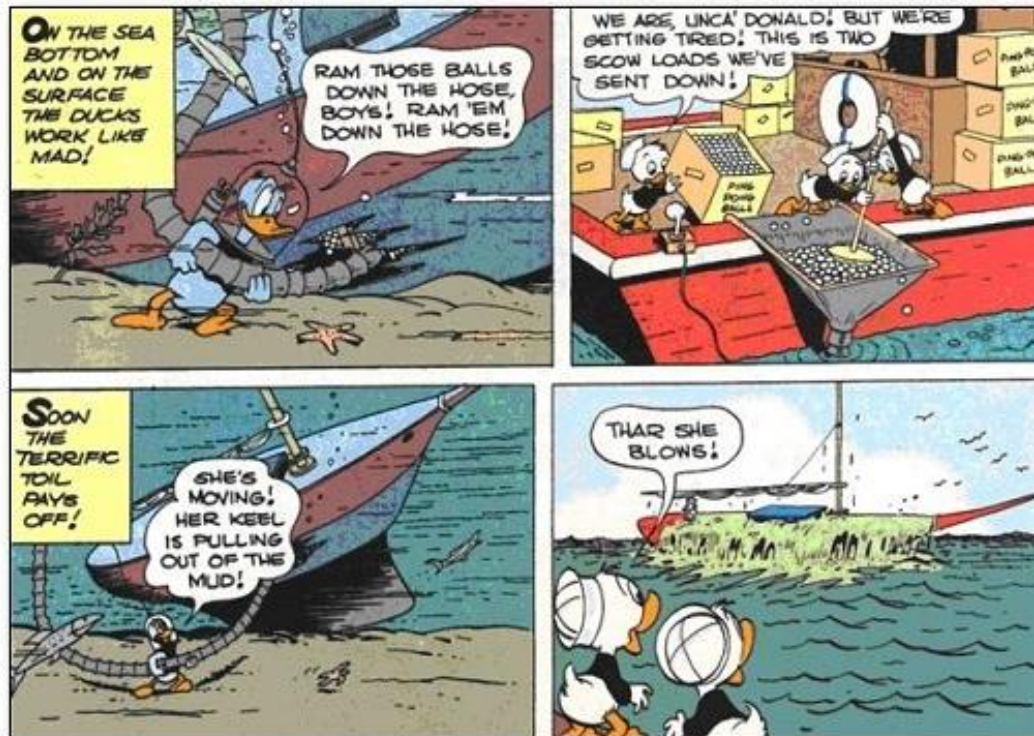
- The Donald Duck case:
- Mr Karl Kroyer: invention of a method to raise a sunken ship by filling it with buoyant bodies fed trough a tube  
→ NL patent application not granted but GB and DE
- 1964: He lifted a sunken boat in Kuwait's harbor by filling the boat with 27 million plastic balls

# Novelty



# Novelty

- 1949: Donald Duck comic published by Carl Barks
- Shows Donald and nephews raising a ship by filling it with ping pong balls shoved through a tube



# Novelty

- Prior art must contain all features of the patented invention
- Example:
  - Invention = wooden chair with seat and four legs with two rails (a rocking chair)
  - Reference X: wooden chair with seat and four legs
  - Reference Y: chair with four legs with two rails

→ Is Invention novel?

# Novelty

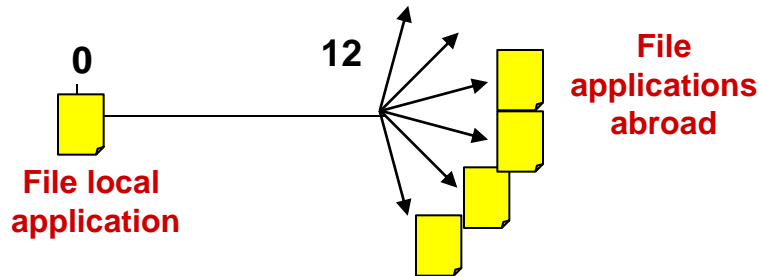
- Invention is novel
- Why?
- References X and Y do only disclose features of the invention together!
  - But invention may be obvious!

# Novelty

- Date of filing important for prior art
- Any publication after the date of filing not novelty destroying
- Claiming of priority date possible
  - = date of filing of an earlier application in another country/region
  - Priority = 12 months
  - **No requirement to file subsequent applications within 12 months but advantageous in regard to patentability!**

# Novelty

## ■ Priority example



- Filing date: December 1, 2016
- 12 months priority ends on: December 1, 2017
- For each filing within 12 months date for determining prior art = December 1, 2016



# Inventive Step

- Invention should not be obvious to a person skilled in the art
- Person skilled in the art = Technician having all knowledge of the technical field of the invention
  - But no imagination or creativity!

# Inventive Step

- Obvious?
  
- Any invention which does not go beyond the normal progress of technology so that a person skilled in the art would derive with the invention by looking at the prior art
  
- Invention Step = different interpretations in national laws!
  - Consultation of the national case law necessary!

# Inventive Step

- Example:
  - Invention = wooden chair with seat and four legs with two rails (a rocking chair)
  - Reference X: wooden chair with seat and four legs
  - Reference Y: chair with four legs with two rails
  
- Invention most likely regarded as obvious
- Combination of references X + Y logical as both are chairs
- But: maybe different if surprising effect

# Industrial Applicability

- Invention needs to be able to be used or made in any kind of industry
  - No industrial application if only able to be used in private or personal sphere!
  - E.g. method of contraception
  
- Invention does not need to be better than existing products or processes

# Main parts of a patent application

- Title
- Introduction
- Background Art
- Short description of the invention
- Short description of the figures
- Detailed description
- Claims
- Drawings

# Title

■ Very general

■ Broad

■ Neutral

■ Generic

# Introduction

- Setting out the general technical field
- Very broad
- Very short

# Background Art

- Description of the prior art already known in this field of technology
- Sets the scene and explains the problems with known devices, methods or systems



# Description of the invention

- Brief description of the invention
- Often corresponds to the wording of the main claim
- Describes the advantages of the invention

# Description of the figures

- Brief descriptions of what the drawings show, if any are included within the patent application

# Detailed description

- Details of the invention
- Description of preferred embodiments
- Typically references to drawings
- Preferred way of putting invention into practice
- Content very important for prosecution and opposition proceedings

# Claims

- Heart of the patent
- Defines the scope of patent protection

# Drawings

- Illustrate one or more preferred embodiments of the invention
- Do not limit the invention as defined in the claims

# Thank you very much!

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