Three Tests of Patentability

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Introduction

Like any other laws, Patent laws too are different in different countries. This makes the patentability criteria vary from country to country although the underlying concept is not very different. United States patent law prescribes three major criteria of patentability, viz, novelty, usefulness and non-obviousness. These “three tests of patentability” are quite important for any person who intends to work on patents. The details of the three test are described below.

1. Test-1: Novelty

“Novelty” is one of the three legal criteria by which patent applications are assessed. It requires that the claims in a patent must be totally new, i.e. for an invention that was previously unknown and unavailable to the public when the patent application is filed.

According this criteria the invention must be demonstrably different from the prior art. Prior art includes the knowledge and practice not only in US but anywhere in the world. If the subject matter defined by a claim in an application is disclosed completely in a single prior art reference, it is considered to be anticipated by the reference. In such a case the invention lacks novelty.

However, novelty does not mean that every aspect of an invention must be novel. If any part of the invention is new compared to the prior art, for example, new uses of known processes, machines etc. then it is considered as novel. Incremental improvements of the known processes are also considered novel and hence patentable.
When two or more inventors invent the same thing, priority is given to the inventor who has claimed first. In such cases claim date is important to decide the novelty of simultaneous inventions. If first inventor has explained about his invention first, but has not reduced it to practice, then the second inventor, who has not only explained about the invention, but also reduced it to practice, will be entitled to get the patent. If both the inventors have reduced the invention into the practice, but the second inventor has got better idea that works faster, the first inventor will be assigned the patent.

Novelty is a fundamental criteria prescribed by USPTO, WIPO (World Intellectual Property Organization), EPO (European Patent Office) and patent authorities of other countries. No system grants patents for inventions which are already known to the world.

2. Test-2: Utility

“Utility” is second criteria of the USPTO to assess the patentability. According to this criteria, an invention must be useful in order to be patented. The invention must have some application or utility. If the invention has no use then it lacks patentability.

The US law have relied on three types of utility to decide on the patentability of an invention. They are, general utility, specific utility and beneficial or moral utility. To fulfill general utility, the invention should be capable of doing something. To fulfill specific utility, the invention should solve the problem it is designated to solve. To fulfill beneficial or moral utility the invention should have some minimum social benefit, and atleast should not be harmful to the society and mankind.

A similar criteria is there in EPO and WIPO which is called “industrial applicability”. However, “industrial applicability” has a narrow application to “utility”. Many inventions may be “useful” even without having immediate “industrial applicability”.

3. Test-3: Non-Obviousness

“Non-obviousness” is the third legal USPTO criteria to assess the patent applications. Non-Obviousness means, the invention cannot be obvious to a person of "ordinary skill" in the field. The invention should show something surprising and unexpected in order to be non-obvious.

However, testing the non-obviousness is very difficult. The criteria of says the invention should not be obvious to a person of ordinary skill in that art or science, as on the claim date. If the invention could have been done by the person with ordinary intelligence and skill, then it is considered as obvious and hence rejected.
There should be some difference between the claims and the prior art. If there is even minor similarity between the claims and the disclosure of the prior art, the claim may be considered as obvious.

It has been held by the courts to be obvious to do any of the following:

- To merely substitute superior for inferior materials, in the manufacture of one or more or all of the parts of a machine or manufacture.
- To merely change the size or dimensions of an object.
- To omit one or more of the parts of a machine or manufacture with a corresponding omission of function, unless that omission causes a new mode of operation of the parts retained.
- To change a process, machine, manufacture or composition of matter, by substituting an equivalent for any of its parts, unless the new part not only performs the function of the part for which it was substituted, but also performs another function, by another mode of operation, or develops new uses and properties of the article formed.
- To merely use an old process, machine or manufacture for a new but analogous purpose.
- To change the form or proportions of a machine or manufacture, unless a new mode of operation or function results.
- To produce an article which differs from an older article only in excellence of workmanship.
- To duplicate one or more of the parts of a machine or manufacture unless the duplication causes a new mode of operation, or produces a new unitary result.
- To combine old devices into a new machine or manufacture, without producing any new mode of operation.

The European Patent Office and WIPO have similar requirement which is known as “Inventive Step”. The criteria of inventive step is considered to be equivalent to non-obviousness.

**Conclusion**

The “three tests of patentability” are fundamentals of behind issue of any patent from USPTO. The people who file patents must check these three criteria in order to ensure their patents are not rejected by the United States Patent Office.

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