



THE OPERANDI OF NOVELTY UNDER THE PATENTS ACT, 1970

‘Unravelling the notion of Prior Art’*

ABSTRACT

Inventors, who are alien to the Patent procedure, do innocent unimpeachable acts in incomprehension that may subvert their own invention. *The belief of Novelty in the Patent Law exemplifies the proposition that only authentic new-born inventions earn the protection and immunity of a Patent.* Novelty is ‘the uniqueness of the data that is generally unexploited or unknown’. A patent incarnates a *quid pro quo*. Patent is the sole dedicated prerogative of the inventor to form, manoeuvre, and sell or distribute an invention for a defined number of years. The three cardinal barometers of Novelty, Inventive Step & Industrial Utility have to be acclaimed for an invention to be chartered for a Patent. These notions imbricate each other. The stratagem of the test of novelty has been rooted upon the Person Skilled in Art. The State of art encompasses all thesis made accessible to the public at large before the priority date of the invention by oral or written rendition. There is a 12-month grace period authorized in India when a person has forged a claim for a patent in a convention country and if the concerned person or his legal representative constructs an application in regard to the same invention in India. The present paper endeavours to explore in the light of landmark judgements, the fundamental notion of the rudiment of Novelty under the Patent Act, 1970 which also realises the specific anticipation clauses that interdicts public display or public use and prior publication. The thesis also puts forward the 35 U.S. Code into the limelight to discern the conditions of Patentability.

FOREWORD

The conception of novelty is laid down in the jurisprudence of Intellectual Property, it depicts what is new at the time of the application filing for a patent to be patentable and the essence of novelty is of core value. Along with fulfilling other requirements, if the subject matter is non obvious and novel, it will be regarded as a patent eligible subject matter. In the case of Pope Appliance Corpn. V. Spanish River Pulp and Paper Mills Ltd¹, an elaboration on the definition of an invention was interpreted upon as ‘An Invention is finding out something which has not been found out by other people’. The definition was further embellished upon in the Raj Prakash case², where it is held that “An Invention, as is well known, is to find or discover something not found or discovered by anyone before”. It is not mandatory that the invention

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¹ Pope Appliance Corpn. V. Spanish River Pulp and Paper Mills Ltd, (1928) SCR 20 (Canada).

² Raj Prakash v. Mangat Ram Choudhary, A.I.R 1978 Del (India).

should be something perplexed in nature. The vital thing is that the inventor is the first one to affirm it. The postulate, therefore, is that every simple invention that is claimed, so long as it is something which is novel or new, it would be regarded as an Invention.

Novelty should be of such a genre that it embraces a technical advance as compared to the existing knowledge.³ It is not enough that the impetus is new or that there is novelty in the application, so that the article produced is in that sense new. There must be novelty in the mode of application.⁴ An invention must relate to a Process or a Product or Both in order to be a Patentable Subject Matter.

Before the date of filing of the application with the complete specification⁵, any Invention which has not been anticipated by publication in any document or used in the country or elsewhere in the world is a New Invention. For a patent represents a quid pro quo, it does not thwart the one who first applies and gets a patent from having a good patent.⁶

The belief of Novelty in respect of CRIs is the same as of other fields of Invention. The norm of novelty is to be assessed under the stratagem laid down in Chapter 08.03.02 of the Manual.⁷

THE PATENT COOPERATION TREATY

A PCT International Application is an international application laid in conformity with the 'Patent Cooperation Treaty'⁸. The title, description, drawings, abstract, and claim filed with the application are taken as intact specifications⁹ for the scheme of the Patent Act, in case of an International Application labelling India.

The intent of Patent law is to foster Scientific research, New technology and Industrial progress. The chief requirements of Novelty, Inventive Step and Utility as enumerated therein in order to diagnose the patentability of an invention have been elected by India as a signatory to TRIPS.¹⁰

Article 33 of the Patent Cooperation Treaty discusses the International Preliminary Examination. It puts a light on; The grail of the International Preliminary Examination is to devise a preliminary and non-binding outlook on the questions whether the claimed invention surfaces to be Novel, to involve an Inventive Step, and to be Industrially Applicable.

For the function of the international preliminary examination, an invention shall be accredited as novel if it is not anticipated by the prior art as specified in the Regulations.

An additional or distinct criteria may be applied by any Contracting State for the role of determining whether, in that State, the claimed invention is patentable or not.

All the documents adduced in the International Search Report shall be taken into effect and consideration for the purposes of the International Preliminary Examination. It may take into cogitation any additional documents considered to be apposite in the concerned case.

³ Mariappan v. A.R Safiullah, (2008) 38 PTC 341 (Mad.).

⁴ Fomento v. Mentomore, (1956) 87 RPC.

⁵ The Patents Act, 1970, S. 2(1); Indian Patents Act (Amendment Act), 2005, S.2(g) (India).

⁶ *Supra* Note 2.

⁷ Manual of Patent Office Practice and Procedure, Chapter 08.03.02.

⁸ The Patents Act, 1970, Section 2(1) (ia) (India).

⁹ The Patents Act, 1970, Section 10(4A) (India).

¹⁰ Bishawanath Prasad RadheyShyam v. Hindustan Metal Industries, A.I.R 1982 S.C 1444.

COMPREHENSION OF PRIOR ART

The discovered information should not be found and accessible in the Prior Art, for an invention to be regarded as Novel. This means that there should not be any prior revelation of any data embodied in the application for patent, anywhere in the domain of public, either written or in any other form, or in any language.¹¹

The following has been designated as Prior Art vide the Act¹²;

(A) Anticipation by dissemination made before the date of filing of the application in any of the documents in any country;

(B) Anticipation having regard to the knowledge, oral or otherwise, obtainable within any restricted particular or indigenous community in India or elsewhere.

The reference of Prior Art yields an enabling disclosure and thus anticipates a claimed invention to entitles a Person of Ordinary skill in the art to carry out the claimed Invention.¹³

The state of the art shall be held to incorporate everything made accessible to the public by means of a written or oral description, or by use.¹⁴

Prior Art are the references i.e. printed documents, which encompasses of Patents and published domestic and foreign Patent Applications and other Printed Publications i.e. non-patent literature, such as magazine, newspaper articles, electronic publication, which includes an on-line databases, websites, or Internet issuances.¹⁵

To become a composite of Prior Art, the disclosure of an invention should take place in the manner namely: - by an illustration of the invention in a published writing form or publication in any other form; - by an illustration of the invention in words spoken which are uttered in public, the same being called an oral disclosure; - by the utilization of the invention in the public sphere, or by setting the public in a such a position that allows any member of the public to use it, the same being a “disclosure by use¹⁶.”

There must be some corporal transporter for the information, a document in the wider meaning of the term, and that concerned document must have been published, that is to say, made accessible to the public in any mode such as by contributing for sale or deposit in a public collection for a publication to be in a tangible form. Published patent applications, writings, pictures which encompasses of photographs, recording, and drawings, not taking account of whether they be discs or tapes in either spoken or coded language comprise of Publications.

Oral revelation, as the expression advocates, intimates that the words or form of the revelation are not certainly registered as such and comprises of lectures and radio broadcasts. A public, visual revelation such as by sale, display, unrecorded television broadcasts and actual public use forms a part of Disclosure by use.

Thus, a coordinated review of prior art materials procurable from sources (Public) is referred to as a Prior Art which is required to assess patentability of an invention. For due diligence for an acquisition or investment, searches can be made a composite. Potential economic value,

¹¹ The Patents Act, 1970; S.13; S-29-34.

¹² *Id.*

¹³ *Impax Labs. Inc. v. Aventis Pham. Inc.*, 468 F.3d 1366, (2006) (U.S.).

¹⁴ European Patent Convention, 1973, Article 54(2).

¹⁵ *Sue A. Purvis, Novelty 35 USC 102 Obviousness 35 USC 103*, NEW YORK CITY REGION, https://www.uspto.gov/sites/default/files/about/offices/ous/Cooper_Union_20130610.pdf.

¹⁶ *Fields of Intellectual Property Protection, WIPO Intellectual Property Handbook: Policy, Law and Use*, <http://www.wipo.int/export/sites/www/about-ip/en/iprm/pdf/ch2.pdf>

rendering of exclusive rights, identifying competition at an early stage, sharing information on the legal status of patent applications, licensing and commercialization are some of the key features of the Prior Art.¹⁷

The Biographic Data¹⁸ which is given while determining the 'Prior Art';

- (1) Application Number
- (2) Application date
- (3) Publication Number
- (4) Publication date
- (5) Patent Classification
- (6) Priority Number
- (7) Priority date
- (8) Priority Country
- (9) Applicant Inventor
- (10) Designated States
- (11) Title of Inventions
- (12) Abstract
- (13) Drawings

IPOs, Scientific researchers, University/ R&D Institution managers, Potential inventors and applicants, Companies, practitioners are the users of Prior Art.

It is a settled proposition under the Patent Law that a patent shall not be afforded to something which is well known and used by others already. The Indian Patents Act provides a ground for an opposition of a patent; that publication on or after the priority date of the applicants' claim filed in pursuance of an application for a patent in India, being a claim of which the priority date is earlier than that of the applicants' claim.

A patent may be rescinded if the invention so far as claimed in any claim of the complete specification is not new, in pursuance to what was known in public or used publicly in India before the date of the claim etc. according to S. 64(e) of the Patents Act, 1970.

The Supreme Court in the landmark case of Monsanto Company v. CoramandalIndag Products (p) Ltd.¹⁹ reiterated this provision and considered the appeal on this ground and held that 'It is sufficient if it is known to the persons who are inquisitive in the pursuit of knowledge and it is not necessary that it should be widely used to the knowledge of the consumer public.'

An Invention shall be deemed to have been publicly known or used in India before the priority date of the claim if a product made by that process had already been imported into India before that date except where such importation has been for the purpose of reasonable trial is an invention relating to a process for which a patent is granted.²⁰

STANDARD OF ANTICIPATION

Anticipation is deadly but requires the accuracy of a sniper, not the firing of a 12- gauge shotgun.²¹

¹⁷ Yumiko Hamano, *Use of Patent Information Patent Information (Prior Art) (Prior Art) for Technology for Technology Management*, WORLD INTELLECTUAL PROPERTY ORGANISATION (WIPO), http://www.wipo.int/edocs/mdocs/aspac/en/wipo_ip_cm_09/wipo_ip_cm_09_topic7_01.pdf.

¹⁸ *Id.*

¹⁹ Monsanto Company v. CoramandalIndag Products (p) Ltd., A.I.R 1986 S.C 712.

²⁰ The Patents Act, 1970, S. 25 (1)(d), S. 25(2) (d) (India).

²¹ Apotex Pty Ltd. v. Sanofi-Aventis (2008) FCA 1194.

The reference of Prior Art²² accords an enabling disclosure and thus anticipates a claimed invention to enable a person of Ordinary Skill in the Art to fulfil the claimed Invention.²³ Anticipation is a two - step exploration:

The first step calls for construction of the claims of the patents at issue. In the second step, the claims are juxtapositioned with the prior art.²⁴

An item must disclose each and every element of the claimed invention to be an anticipating reference. If another invention already known or used is identical in substance, then only an invention is said to be anticipated.²⁵ The prior publication must contain clear and unmistakable directions to do what the patentee claims to have invented in order to anticipate the claim of the patentee²⁶. The patent must have been granted in India alone, for an invention to be anticipated by the strength of a patent.²⁷

Thus, novelty deals to shelter the right of the public to revel and take benefit from what it already possesses.²⁸

There should be sufficient adequate information which would allow one to comprehend the innovation. It is not necessary that it discloses how to make an invention. The prior art is an enabling disclosure or not is the criteria employed for judging whether an invention fulfils the prerequisite of novelty.²⁹

A two-part test for anticipation was endorsed.³ In order to be anticipatory, a single piece of prior art must both³⁰:

- (a) reveal the invention of the patent that has been arisen in the question; and
- (b) allow a skilled reader to make the invention using the common knowledge, permitting some trial and error experimentation to make it work and prior art reference.³¹

In the case of *Beloit Canada Ltd. v. Valmet Oy*, the test for anticipation by publication was set out:

It will be recollected that anticipation, or the dearth of novelty, propounds that the invention has been made familiar to the public prior to the relevant time. The inquiry is pointed to the very invention in suit and not, as in the case of the state of the art, obviousness and to common general knowledge. Also, as it emerges from the passage of the statute recited above, anticipation must be based in a specific patent or other published document; it is not enough to pick bits and pieces from a diversity of prior publications and to interblend them together so as to crop up with the claimed invention. One must, in corollary, be able to see the prior, single publication and discover in it all the information which is needed to yield the claimed invention without the exercise of any inventive skill for the practical purposes. The prior publication must encompass so clear a direction that a skilled person reading and following it would be led to the claimed invention, in every case and without the possibility of error.³²

²² *Standipack Pvt. Ltd. v. Oswal Trading Co. Ltd.*, AIR 2000 Del 23.

²³ *Supra* Note 13.

²⁴ *SSIH Equipment S.A v. United States International Trade Commission*, 218 USPQ (Fed. Cir.) 678 (1983).

²⁵ *Schroeder v. Owens - Corning Fiberglas Corp.*, 185 (USPQ) (9th Cir.) 723 (1975).

²⁶ *General Tyre & Rubber Co. v Firestone Tyre and Rubber Co. Ltd.*, (1972) 457, 485 RPC.

²⁷ The Patents Act, 1970, S. 13(1); S. 25(1)(b)(i); S.25(1)(c); S.27(a); S.64(1)(a) (India).

²⁸ *Kimberly-Clark Corp. v. Johnson & Johnson*, 745 F.2d 1437, 1453-54 (Fed. Cir. 1984).

²⁹ *Van De Lely v. Bamfords*, (1963) 71 RPC.

³⁰ *Apotex Inc. v. Sanofi-Synthelabo Canada Inc.*, (2008) SCC 61 (Canada).

³¹ *Beloit Canada Ltd. v. Valmet OY*, (1986), 8 C.P.R. (3d) 289.

³² *Id.*

With the approval by the Supreme Court of Canada in *Free World Trust v. Électro Santé Inc.*³³, the test for anticipation by publication in *Beloit*, was cited.

OBVIOUSNESS & PERSON SKILLED IN ART

An invention may be obvious even though it is not identically revealed earlier. Obviousness has to be decided at the time of the invention. To hold a claim on obviousness, it is not necessary that there should be an actual predictability of success, but reasonable probability of success works.

The purposed evidence that might be taken into deliberations in order to arrive at non-obviousness or obviousness of an invention might take into account;

If there is any long felt need of such an invention
The Industrial Applicability and the success of the invention commercially
Initial delivery of belief or disbelief by the experts
If there has been any infringement or copying
Failure of the art prior to the invention by others
Licenses held under the Patent

A Person Skilled in Art³⁴ should be postulated to be a hypothetical person having ordinary skill and expertise in the art and being conscious of what was common general knowledge in the art at the relevant date. Also, it is suitable to be aware that the hypothetical addressee is not a person of an extraordinary skill and knowledge and he is not required to implement any invention nor any prolonged inquiry, experiment or research.³⁵

Was it for empirical reasons obvious to the skilled worker, in the area concerned, in the state of knowledge prevailing at the date of the patent to be built in the literature then accessible to him, that he should make the invention the theme of the claim concerned. In other words, the question to be answered in deducing whether there is an inventive step is “Would a non-inventive mind have contemplated of the alleged invention?”³⁶ If it’s a negative answer, then the invention is non-obvious in nature. In consideration with the state of the art, it is established whether the alleged inventive step would have been known and obvious to a person skilled in the art.³⁷

The court has the function of settling whether it would be apparent to a notional skilled but un inventive person³⁸ in the art at the priority date to construct or do something falling within the purview of the patent. The defendant spots on particular pieces of prior art and maintains obviousness of the patent over them when seen in the light of relevant local general knowledge in the industry or art involved.³⁹

The commercial success of the invention is the secondary consideration of Obviousness that can be adjudged by the court before reaching a diagnosis on Obviousness. These secondary consideration encompasses within itself, but are not restrictive to the commercial success of the

³³ *Free World Trust v. Électro Santé Inc.*, (2000) 2 S.C.R. 1024.

³⁴ PCT International Search and Preliminary Examination Guidelines, Para 13.11 (2015).

³⁵ *Dyson Appliances Ltd. v. Hoover Ltd.* 2 (2001) 54 RPC; *Beloit Technologies Inc. v. Valmet Paper Machinery Inc.* (1997) 489, 494 RPC; *Environmental Designs Ltd. v. Union Oil Co.*, (1984) 464 US 1043.

³⁶ *Valensi v. British Radio Corpn. Ltd.*, (1973) 337 RPC (CA).

³⁷ *Molnlycke A.B. v. Procter and Gamble*, (1994) 49 RPC.

³⁸ *Hallen v. Barbantia*, (1991) 195, 212 RPC.

³⁹ *Hoechst Celanese Corpn v. BP Chemicals Ltd.*, (1998) FS 586.

invention.⁴⁰ Where a patent has attained commercial success, evidence of prior use demands a careful scanning of the same.⁴¹

CONDITIONS FOR PATENTABILITY (NOVELTY) UNDER 35 U.S. Code § 102

(i) Eligibility

A person shall be sanctioned to a patent unless—

- (1) the claimed invention was made accessible to the public at large before the effective and efficient filing date of the claimed invention or patented, which described in a printed publication, or in public use, on sale; or
- (2) the claimed invention was described in a patent issued under **S.151**, or in an application for patent published or deemed published under **S. 122(b)**, in which an another inventor was named in the patent or application and was effectively and efficiently filed before the effective filing date of the claimed invention.

(ii) Exceptions

(1) A claimed invention shall not be considered to be a ‘Prior Art’ under **subsection (a) (1)**⁴² when the disclosure is made 1 year or less before the effective filing date if—

(A) the inventor or joint inventor or an another person who obtained the subject matter exhibited directly or indirectly from the inventor or a joint inventor, made the disclosure; or

(B) the inventor or a joint inventor or an another person who obtained the subject matter disclosed directly or indirectly from the inventor or a joint inventor have publicly disclosed the subject matter before such disclosure.

(2) A disclosure shall not be considered as a ‘Prior Art’ to a claimed invention under subsection (a)(2) if—

(A) the inventor or a joint inventor disclose the subject matter directly or indirectly;

(B) the inventor or a joint inventor or an another person who obtained the subject matter disclosed directly or indirectly from the inventor or a joint inventor have publicly disclosed the subject matter before such subject matter was effectively filed under **subsection (a) (2)**; or

(C) the subject matter disclosed and the claimed invention, not later than the effective filing date of the claimed invention, were possessed by the same person or in pursuance to an obligation and the responsibility of assignment to the same person.

(3) the subject matter disclosed and a claimed invention shall be deemed to have been owned by the same person or subject to an obligation of assignment to the same person in applying the provisions of **subsection (b)(2)(C)**⁴³ if—

(A) the subject matter disclosed was broadened and the claimed invention was prepared by, or on behalf of, one or more parties to a joint combined research agreement that was in effect on or before the effective filing date of the claimed invention;

(B) the claimed invention was prepared as a result of activities undertaken within the scope of the joint research agreement; and

(C) the application for patent for the claimed invention divulged or is amended to divulge the names of the parties to the joint research agreement.

(4) For purposes of assessing whether a patent or application for patent is prior art to a claimed invention under **subsection (a)(2)** of the Code, such patent or application shall be adjudged to

⁴⁰ Panduit Corpn. v Dennison Mfg. Co., 810 F2d 1561 (Fed. Cir. 1987).

⁴¹ Boyce v. Morriss Motors Ltd., 44 (1927) 105 RPC.

⁴² 35 U.S. Code, § 102 (1952).

⁴³ *Id.*

have been effectively filed, in pursuance to any subject matter described in the patent or application—

(A) if paragraph (2) does not pertain, as of the actual filing date of the patent or the application for patent; or

(B) if the patent or application for patent is sanctioned to claim a right of priority under section 119, 365(a), 365(b), 386(a), or 386(b) of the Code, or to claim the benefit of an earlier filing date under section 120, 121, 365(c), or 386(c) of the Code, based upon one or more prior filed applications for patent, as of the filing date of the earliest such application that describes the subject matter.

(iii) Admissions- Prior Art

(A) A statement by applicant during prosecution discerning the work of another person as “prior art” is an admission that that work is accessible as prior art against applicant’s claims, regardless of whether admitted prior art would otherwise be licensed as prior art under statutory categories of 35 U.S.C. 102.

(B) When material is designated as the “prior art”, the examiner must intuit whether the subject matter seen as “prior art” is applicant’s own work, or the work of another.⁴⁴

(iv) Claims as a whole

In assessing the distinction between the prior art and the claims, the issue under 35 U.S.C. 103 is not whether the differences themselves would have been obvious, but whether the claimed invention as a whole would have been overt.⁴⁵

(v) PHOSITA

A hypothetical person having an ordinary skill in the art. It depends upon the technical field of the invention. The level of skill that a PHOSITA will possess may not be the same as of a normal ordinary person.⁴⁶

(i) The Enablement Question

Anticipation entails:

- (1) Strict identity between the previously revealed and the now-claimed subject matter;
- (2) An enabling disclosure.⁴⁷

Although gauging enablement is not that easy, examining for strict identity often is. This last point is particularly significant as the issue whether the public already owns the claimed subject matter often diminishes to the matter of enablement.⁴⁸

Defining the Standard.

In two contexts in the Patent Law, enablement questions typically usually arise. Section 112, ¶ 1, of the Patent Act⁴⁹ pushes the applicant of a patent to offer a written description that entitles a PHOSITA to make and utilise the scope of the claimed invention without undue experimentation. This “statutory” model of enablement plants an outer limit on the scope of the

⁴⁴ Sue A. Purvis, *Novelty 35 USC 102 Obviousness 35 USC 103*, NEW YORK CITY REGION, https://www.uspto.gov/sites/default/files/about/offices/ous/Cooper_Union_20130610.pdf.

⁴⁵ *Stratoflex Inc. v. Aeroquip Corp.*, 713 F.2d 1530, 218 USPQ 871 (Fed Cir. 1983) (U.S.).

⁴⁶ *Supra* note 36.

⁴⁷ *Seymour v. Osborne*, 78 U.S. (11 Wall.) 516 (1870).

⁴⁸ *Spectra-Physics, Inc. v. Coherent, Inc.*, 827 F.2d 1524, 1532 (Fed. Cir. 1987).

⁴⁹ 35 U.S.C. § 112 (2006).

claims.⁵⁰ The model concerning to prior art references is referred to as “anticipatory” enablement, as it is used to indicate that to make an invention, a PHOSITA could permit and use pre-existing knowledge.

Anticipatory enablement as compared to its’ statutory cousin is a narrower doctrine.⁵¹ Utility need not be demonstrated by a prior art reference in pursuance to anticipation.⁵² What falls squarely within the scope of the claim-at-issue should only be enabled by an anticipatory reference.⁵³ An enabling representation, by comparison, for patent-supporting purposes must entitle the full scope of the claimed subject matter. These dissenting requirements disclose a curious asymmetry: an ample description to anticipate a claim for patent-defeating purposes might be scant to entitle a claim for the purposes of patent-support.⁵⁴

Technical Difficulties

Technology holds an importance in patent law, especially in the enablement context.⁵⁵ What remains a fact intensive inquiry here is whether the reference is enabling and to ascertain whether undue experimentation is vital to make what is exhibited in the prior art.⁵⁶

The key interrelated technical issues have been explored:

- (1) Whether the alleged prior art reference incorporates a description of the invention or working examples of the invention;
- (2) The PHOSITA’s cognition at the time of publication, and
- (3) The essence of the technology.

It stands to the apprehension that the exploration of enablement should be straightforward if the prior art reference uncovers working examples.

35 USC §103 (OBVIOUSNESS)

The ultimate conclusion of the issue ‘whether an invention is or is not obvious is a legal deduction rooted on latent factual inquiries’

In the 1966 Supreme Court case of *Graham v. John Deere Co.*⁵⁷, articulation of various factors that were considered when analysing prior art under 35 USC 103.

*Graham v. John Deere*⁵⁸ Inquiries

In the concerned case above, various inquiries were made;

What is the horizon and content of the prior art?

What is the distinction between the prior art and the claims at issue?

What is the extent of the ordinary skill in the relevant art at the time the invention was made?

Does any object evidence of non-obviousness prevail?

Establishing a Prima Facie Case of Obviousness

The formula for assisting any rebuff under 35 USC §103 is the clear expression of the logic or reasons why the asserted invention would have been obvious.

⁵⁰ *Nat’l Recovery Techs., Inc. v. Magnetic Separation Sys., Inc.*, 166 F.3d 1190, 1196 (Fed. Cir. 1999).

⁵¹ *Verizon Servs. Corp. v. Cox Fibernet Va., Inc.*, 602 F.3d 1325, 1337 (Fed. Cir. 2010).

⁵² *Re Gleave*, 560 F.3d 1331, 1335 (Fed. Cir. 2009).

⁵³ *Schering Corp. v. Geneva Pharm., Inc.*, 339 F.3d 1373, 1381 (Fed. Cir. 2003).

⁵⁴ *Vas-Cath Inc. v. Mahurkar*, 935 F.2d 1555, 1562 (Fed. Cir. 1991).

⁵⁵ DAN L. BURK & MARK A. LEMLEY, *THE PATENT CRISIS AND HOW THE COURTS CAN SOLVE IT* 59–65 (2009).

⁵⁶ *Amgen Inc. v. Hoechst Marion Roussel, Inc.*, 457 F.3d 1293, 1306–07 (Fed. Cir. 2006).

⁵⁷ *Graham v. John Deere Co.*, 838 U.S. 1, 17-18, 148 USPQ 459, 467 (1966).

⁵⁸ *Id.*

Mere deducted statements are not enough to support a rejection or refusal under 35 USC §103. There must be some segmented reason with some logical underpinning to aid the legal deduction of obviousness.⁵⁹

A prima facie case of obviousness cannot be established, if the propounded reconstruction of a prior art invention would leave the invention being redesigned inoperable or undesirable for its intended purpose because there is no tinge or motivation to do the reconstruction.

If the propounded reconstruction of a prior art invention would adjust the theory of operation of the invention, then a prima facie case of obviousness cannot be entrenched. In order to make out a prima facie case of obviousness, a reasonable supposition of success is entailed.

ANALOGOUS PRIOR ART

Any requirement or an issue persisting and familiar in the area of endeavour at the time of invention and inscribed by the patent can provide a rationale for amalgamating the components in the mode claimed. Examiners are not restricted to use only prior art from an applicants' area of endeavour. Examiners can use sources from areas of domain which rationally would have advanced themselves to an inventor's observation bearing in mind the invention as a whole. Therefore, Analogous art encompasses within itself references that would have been identified by those having an ordinary skill in the art as useful for the impetus of the applicant and is not restricted to the references in the area of endeavour.

THE PARADOX OF NOVELTY

The deduction is that if the subject matter uncovered in the referral is analogous to that which is later asserted by the subsequent inventor, the analysis essentially tapers to the issue of enablement. The question of law is whether a Prior Art reference underlies on factual inquiries.⁶⁰ On appeal, the question of whether a referral is enabling is examined de novo, and the things which are reviewed differently are the underlying factual inquiries.⁶¹ The question of fact being whether a reference anticipates or not.⁶²

The U.S. Court of Customs and Patent Appeals⁶³ divulged a burden-shifting framework to administer the issues of anticipatory enablement which arise during patent examination.⁶⁴ At the time of filing, as a starting point, § 102 grants the applicant a presumption of novelty as the statute prescribes that unless one of the statutory exclusions is shown, "a person shall be authorised to a patent".

The applicant must refute the presumption that the asserted third- party patent is non- enabling through an argument which is persuasive or proof by a preponderance of the evidence⁶⁵. Moreover, the burden of production may persist to shift whenever each side presents a new evidence; however, the examiner undertakes the ultimate burden of persuasion.⁶⁶

⁵⁹ Re Kahn, 78 USPQ 2d 1329, 1336.

⁶⁰ Impax Labs., Inc. v. Aventis Pharm. Inc., 545 F.3d 1312, 1315 (Fed. Cir. 2008).

⁶¹ Re Gartside, 203 F.3d 1305, 1316 (Fed. Cir. 2000).

⁶² Re Hyatt, 211 F.3d 1367, 1371 (Fed. Cir. 2000).

⁶³ Re Sasse, 629 F.2d 675, 681–82 (C.C.P.A. 1980).

⁶⁴ Re Jacobs, 318 F.2d 743, 745 (C.C.P.A. 1963).

⁶⁵ Amgen Inc. v. Hoechst Marion Roussel, Inc., 314 F.3d 1313, 1355 (Fed. Cir. 2003).

⁶⁶ Re Warner, 379 F.2d 1011, 1016 (C.C.P.A. 1967).

In *Amgen Inc. v. Hoechst Marion Roussel, Inc.*,⁶⁷ the court held that the latent presumption of enablement includes both claimed and unclaimed subject matter in the third-party patent. As an aid for its holding, the court decided that the examiner should not carry the burden of examining enablement every time there is a challenge to an alleged anticipating third party patent.

CONCLUSION

The novelty specification seeks to protect that a patent will not get furnished if the public already owns the invention. There are two types of Inventions that are persistent and can be categorized as improvement or pioneering. Improvement is generally attained through 'working around' a pioneer one. It is observed that the pioneering applications are importantly original and they do not face any hardship in the challenges of validity or while applying in a Patent Office. Applications on improvement on the other hand are scanned very closely in regard to obviousness and the criterion of novelty. For this, special care should be exercised and an assiduous exercise of prior art should be done. Each and every document of the prior art must be analysed with the elements that make up the whole invention. Although the current doctrine of novelty is enough to measure the possession for inventions in the concerned technologies, it wanes for those in uncertain areas like chemistry. It thus yields paradoxical outcomes at odds with fundamental proposition of patent law. The propounded patent examination skeleton will settle these complications and enhance the quality of both issued patents and the literature of the patent, by shifting burden of proofs and presumptions. As the applications of patent in nascent technologies extends to advance, the propounded framework will flash more charm in probing how patent law and policy should unroll to attune such technologies.

⁶⁷ *Amgen Inc. v. Hoechst Marion Roussel, Inc.*, 314 F.3d 1313 (Fed. Cir. 2003).