

Topic 9: Patents B: Validity

Is it a novel?

- Section 18 Patents Act 1990
- Where an invention has been anticipated (i.e. in some way foreshadowed or revealed) it will no longer be considered to be novel and hence patentable.
 - In deciding whether there has been an anticipation you follow through the various tests for novelty as laid down in the Act.
- Where a person has only done what was obvious, that person has not been inventive and the 'invention' will not be patentable.
- Integers are features of the invention, e.g. the fact that a spring is coiled clockwise rather than anticlockwise.
 - Making the distinction between essential and inessential integers is central to making judgments about patentability and also infringement.
- Workshop improvements come about through ordinary methods of trial and error.
- Combination patents are patents for inventions which are comprised of integers, some or all of which are known but which in combination produce a new and better result through the interaction of the integers.
 - If the integers do not interact in this way but simply continue to perform their known functions the result will be called a mere collocation of known integers and denied registration.
 - Williams v Nye (1890) 7 RPC 62
- The time, prior to which there must have been no anticipation of the claim, is its priority date.
 - Advanced Building Systems Pty Ltd v Ramset Fasteners (Aust) Pty Ltd (1993) 26 IPR 171
- Only if all the essential integers of a claimed new invention are anticipated will it be bad for want of novelty.
 - If the invention and the anticipation differ only in ways which do not involve essential integers of either of them, there will have been an anticipation.
- A prior publication does not invalidate a patent unless it supplies sufficient information to enable a person of ordinary skill to produce the product subsequently claimed.
 - Acme Bedstead Company Limited v Newlands Brothers Limited [1937] HCA 63
- Something less than the full description of the invention allegedly anticipated may be sufficient to invalidate it for want of novelty.
- If the prior art information is made available in two or more related documents or two or more related acts there may be an anticipation if the relationship between the documents or acts is such that a person skilled in the relevant art in the patent area would treat them as a single source of that information.
 - Nicaro Holdings Pty Ltd v Martin Engineering Co (1990) 16 IPR 545
- The information, whether it be in documentary form or some other form of exposure, must have been publicly available before the priority date.
 - Dennison Manufacturing Co v Monarch Marking Systems Inc (1983) 1 IPR 431

- It is not relevant whether or not an anticipatory document has been catalogued and identified in a way that would enable it to be easily found.
 - **Merck & Co Inc v Arrow Pharmaceuticals Limited [2006] FCAFC 91**
- Use of an invention before the priority date can amount to making it publicly available.
 - Information may not be considered public if there is an agreement or other legal requirement that it should not go beyond the person to whom it is disclosed.
 - The use must be informative in the sense that it reveals all necessary information about the invention.
 - **Hope v Heggies Bulkhaul Ltd (1996) 34 IPR 584**
 - **Insta Image Pty Ltd v KD Kanopy Australasia Pty Ltd [2008] FCAFC 139**
- Anticipation in action:
 - **MJA Scientifics International Pty Ltd v SC Johnson & Son (1998) 43 IPR 287**
- Publications or uses of the invention will potentially not defeat novelty and inventive step if they are made e.g. during a recognised exhibition, in a paper read before a learned society or where the invention is used for the purposes of reasonable and necessary trial.
 - **Section 24 Patents Act 1990**
 - This allows inventors to publicise the inventions in advance of lodging the patent application, as long as the complete application is lodged within 12 months.
- With both documents and acts, it is of no consequence whether they are published inside or outside of Australia.
- The prior art base will include information contained in a published complete specification if the priority date of this specification is earlier than that under consideration, but its publication is later, as long as the information in question was in the specification when it was filed.

Is it an inventive step? – Obviousness

- Conceptually inventiveness and anticipation are quite different but the same factual subject matter gives rise to both considerations.
- **Elconnex Pty Ltd v Gerard Industries Pty Ltd (1993) 25 IPR 173**
- The hypothetical person skilled in the art, but un inventive, may not necessarily be imagined as an individual.
 - **Grenentech v The Wellcome Foundation Ltd (1989) 15 IPR 423**
 - **Root Quality Pty Ltd v Root Control Technologies Pty Ltd (2000) 49 IPR 225**
- The legislation pivots on the concept of the hypothetical skilled person having a certain body of common general knowledge.
 - **Minnesota Mining & Manufacturing Co v Beiersdorf (Australia) Ltd (1980) 144 CLR 253**
- Would the person skilled in the art at the relevant date, in all the circumstances, directly be led, as a matter of course, to try the step that the patentee claims in inventive in the expectation that it might well produce a useful outcome or improvement.
 - **Aktiebolaget Hassle v Alphapharm Pty Ltd (2002) 212 CLR 411**
 - If the answer to this question is yes then there is no inventive step.
- Certain types of publication of an invention will not stand in the way of it being held to be sufficiently inventive by being counted as part of the prior art base.

Is it useful?

- An invention must be useful in order to be patentable.
 - Section 18(1)(c) Patents Act 1990
 - If not it will be said to be bad for inutility.
- To be useful, the invention must attain the result that the inventor had promised.
 - Rehm Pty Ltd v Websters Security Systems (International) Pty Ltd (1988) 11 IPR 289
- What is not important to the question of utility is whether the apparatus would be commercially viable.
 - Rescare v Anaesthetic Supplies (1992) 25 IPR 119

Has it been secretly used by the patentee?

- If an invention has been secretly used by the patentee before the priority date it may forfeit its right to protection.
 - Section 18(1)(d) Patents Act 1990
- The rationale behind this prohibition was to prevent a patentee from gaining a longer monopoly than the statutory period by enjoying a de facto monopoly through secret use without meeting the corresponding obligation of public disclosure.
 - Azuko Pty Ltd v Old Digger Pty Ltd [2001] FCA 1079
- The Act contains a reasonably generous list of acts which are not to be taken to be instances of secret use.
 - Section 9 Patents Act 1990
 - Longworth v Emerton (1951) 83 CLR 539

Other requirements

- The specification should identify the technical field of the invention.
- It should state the technical features which the applicant considers to be essential to the invention.
 - It should then list preferred or optional features.
 - After this the specification should set out the best way/s of putting the invention into effect.
- A claim(s) will accompany the rest of the specification in a standard patent application.
- A claim should be written as a single sentence and define clearly what the patent protection is being sought for.
- It must be clear from the words of the claim how the invention is distinguishable from prior knowledge.
- All the technical features of the invention should be set out consistently with the description given in the body of the specification.
- An independent claim, of which there may be several, does not refer to any other claim.
- A dependent claim makes explicit reference to previous claims, but is nevertheless a claim in its own right and to be judged like any other claim.
 - Dependent claims can be used as back-up claims if the broadly drafted independent claim turns out to be invalid on the basis of anticipation.
- Section 40 Patents Act 1990
- Both complete and provisional specifications must describe the invention clearly and completely.

- This is so as to enable the public, after the expiration of the patent, to use the specification successfully for their own purposes.
- Therefore the standard of completeness is enough for the invention to be performed by a person skilled in the relevant art.
 - No-Fume Ltd v Pitchford (1935) 52 RPC 231
 - Samuel Taylor P/L v SA Brush Co Ltd (1950) 83 CLR 617
- Insufficiency of description (failing to disclose the invention clearly enough) is different from inutility.
 - Tetra Molectric Ltd's Application [1976] FSR 424
- Claims must be clear and succinct; they must not be ambiguous.
 - This is not because of the possibility of misleading the public but rather because otherwise the claims will not be able clearly to establish the parameters of the invention.
 - Elconnex Pty Ltd v Gerard Industries Pty Ltd (1991) 22 IPR 551
- A patent will be void if the terms of the specification are so ambiguous that its proper construction must always be doubtful.
 - This will also be the case if the specification contains statements calculated to mislead those who in the future might want to make use of it so that they would be unable, without trial and experiment, to see how the patented object was intended to work.
- The claims define the invention and are to be construed according to ordinary rules.
 - They are not to be expanded or narrowed by anything which is not either expressly or by inference in the claims themselves.
- The specification is to be given a purposive construction.
 - The only requirement of the body of the specification are that it be comprehensible and not misleading.
 - Décor Corporation Pty Ltd v Dart Industries Inc (1988) 13 IPR 385
- There must be a unity between the claims and the specification.
 - Such support is necessary to ensure that the claims are not seeking to establish a wider monopoly than the specification would justify.
- A patent obtained by fraud, false suggestion or misrepresentation may be revoked.
 - Section 138(3)(d) Patents Act 1990