

Existing Knowledge, Skilled Person and Inventive Step under Indian Patent Law and the Problem of Borrowings

Victor Vaibhav Tandon¹ and Ashwini Siwal^{2†}

¹Saikrishna & Associates, New Delhi — 110 003, India

²Faculty of Law, University of Delhi, Delhi — 110 007, India

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Assessment of inventive step is difficult, with several tests being laid down for the same in different jurisdictions. However, borrowing such tests, e.g. the Windsurfing test, the TSM test, or the concept of PHOSITA from U.S. Law, into Indian jurisprudence must be done with caution. As we argue here, Indian Law has certain peculiarities- (i) it requires something more than a mere difference from prior art; it requires technical advance compared to existing knowledge, and (ii) the person judging such technical advance for existence of obviousness is not ordinary, not average nor super-skilled but a capable skilled person. Any interpretation or borrowing which loses sight of this statutory requirements can result in interpreting the skilled person as less capable than what the Indian Act/ legislature expected it to be. This can result in lowering the inventive step standard. This can have repercussions on the quality of granted patents, since it is the quality of innovation and not merely the quantum thereof which ought to matter.

Keywords: Inventive Step, Person Skilled in the Art, Prior Art, Inventiveness

Indian Law grants a patent for “*any invention*” under the Patents Act, 1970 (hereinafter, Patents Act)¹ and defines an invention as a “*new product or process involving an inventive step and capable of industrial application*”², thus laying down the oft-quoted three tests of patentability- new/novel, inventive step and industrial application. Section 3 provides for “*what are not inventions*” and along with Section 4, establishes a subject matter or patent-eligibility bar (a fundamental parameter for patent Law since if you are not eligible, your ability is irrelevant). A fifth parameter is the disclosure requirement³ which requires disclosure of invention to be sufficient and enabling- the *quid pro quo* for grant of patent by the state. These five requirements form the basis for grant of a patent in India, and are basic to understanding much of the edifice of patent Law.

Amongst the five criteria noted above, inventive step remains one of the universal, and often troublesome, criterion for securing grant of a patent for an invention. The universality of the criterion as well as the subtle differences in how each jurisdiction has crafted its definition of inventive step is perhaps best demonstrated by the definitions for inventive step/ obviousness as they exist within Indian Law, U.S.

Law, U.K. Law and European Patent Convention, 2000 (hereinafter, EPC) along with reference to the inventive step/ obviousness assessment within TRIPS (Trade-Related Aspects of Intellectual Property Rights) as provided below,

TRIPS, Article 27.1	“... patents shall be available for any inventions, whether products or processes, in all fields of technology, provided that they are new, involve an inventive step and are capable of industrial application...” Footnote to Art. 27.1 says: For the purposes of this Article, the terms “inventive step” and “capable of industrial application” may be deemed by a Member to be synonymous with the terms “non-obvious” and “useful” respectively.
India Section 2(1)(j) of Patents Act, 1970	inventive step means a feature of invention that involves technical advance as compared to the existing knowledge or having economic significance or both AND that makes the invention not obvious to a person skilled in the art
USA Section 103 of the US Patents Act (35 US Code § 103,	“A patent for a claimed invention may not be obtained, notwithstanding that the claimed invention is not identically disclosed as set forth in Section 102, if the differences between the claimed

†Corresponding author: Email: asiwal@Law.du.ac.in

post America Invents Act text)	<i>invention and the prior art are such that the claimed invention as a whole would have been obvious before the effective filing date of the claimed invention to a person having ordinary skill in the art to which the claimed invention pertains. Patentability shall not be negated by the manner in which the invention was made”</i>
European Patent Convention (EPC, 2000), Article 56	<i>“An invention shall be considered as involving an inventive step if, having regard to the state of the art, it is not obvious to a person skilled in the art...”</i>
UK The Patents Act, 1977 Section 3	<i>“An invention shall be taken to involve an inventive step if it is not obvious to a person skilled in the art, having regard to any matter which forms part of the state of the art by virtue only of Section 2(2) above (and disregarding Section 2(3) above).”</i> Section 2(2) relates to prior art <i>“which has at any time before the priority date of that invention been made available to the public (whether in the United Kingdom or elsewhere) by written or oral description, by use or in any other way”</i> . However, prior-claiming, which is taken into account for determining novelty (Section 2(3)), is not taken into account for determining inventive step. The position is the same in India, i.e., prior-claiming is not taken into account for determination of inventive step.

(underline/ emphasis provided by authors)

The following is evident from the above,

- (i) Inventive step, or obviousness, is a fundamental criterion for grant of patents.
- (ii) The terms- inventive step and obviousness- may be used as synonyms, but as we explore next, this may not always be true, and there are sufficient differences in the provisions as they exist in India and other jurisdictions to merit a deeper understanding of what is expected under Indian Law.
- (iii) The determination of inventive step/ obviousness requires, *inter-alia*, understanding of two other concepts: (i) the imaginary/ hypothetical person skilled in the relevant art or field of technology (called in different jurisdictions as, PSA, PSITA, PHOSITA etc.) and (ii) existing knowledge (in India) or state of the art/ prior art (U.K., EPC and U.S.), which is the state of technology as it existed immediately prior to the priority date of the claim/claims been assessed for existence of inventive step.

The Problem of Synonymous Use & Borrowings

TRIPS permits member states to consider ‘inventive step’ as synonymous with the expression ‘non-obvious’ but does not define either of the terms. A commentator has consequently opined that, *“there is ample room for Members to establish the level of non-obviousness/inventive step, according to the policies they opt to apply. They may apply for a strict standard aimed at rewarding substantive departures from the prior art”*.⁴ As we demonstrate below, perhaps Indian Law, with its overarching commitment to social welfare, requires substantive departures from prior art and in doing so differs from jurisdictions like U.S.A where a more permissive patent culture exists, led by the credo *‘anything under the Sun that is made by man’*.⁵

A More Nuanced Inventive Step Requirement?

The tendency visible in Indian judgments is, often, to (i) consider the two terms- inventive step and obviousness as synonymous and (ii) to borrow heavily from U.S. and U.K. jurisprudence to evolve tests for determination of inventive step. This is in spite of the fact that Indian Law apparently has a more nuanced definition of inventive step. Firstly, Indian Law requires a feature of invention that involves *‘technical advance over existing knowledge’* or *‘economic significance’* or *‘both’*, and secondly, the feature must be such *‘that makes the invention not obvious’* to a PSA or person skilled in the art. These requirements of Indian statute stand acknowledged by the Indian Supreme Court and, more recently, by the Madras High Court.⁶

U.S. Law, on the other hand, talks of differences (not technical advance) between the claimed invention and the prior art, and such differences must be such as to make the claimed invention as a whole non-obvious/ obvious to a person having ordinary skill in the art (PHOSITA/ POSITA). Again, Indian Law does not qualify its PSA as ordinary. Under U.K. Law and EPC, inventive step test is satisfied if invention is not obvious to PSA *“having regard to”* matter forming part of state of the art. The English statute or the treaty text of EPC do not require ‘technical advance’ or economic significance’ nor lay down the kind of twin-step test as existing in India.

It is interesting to ask, whether all non-obvious differences over prior art (as required under say U.S. Law) contribute to technical advance/ economic significance? If they do not, then does Indian Law

require a higher inventive step standard by requiring only those differences that present or demonstrate a technical advance? Quite obviously (oh well!)- that which is different need not always be a technical advance or economically significant- especially to a (non-ordinary) skilled person in the art. But what exactly is this ‘technical advance’ or ‘economic significance’? An issue with interpreting the definition of inventive step in India is that the statute does not define “*technical advance*” or what exactly would be “*economic significance*”.

The Indian Supreme Court, in *Novartis*, understood technical to be “1. of or relating to a particular subject, art, or craft or its technique. 2. of, involving, or concerned with applied or industrial sciences”.⁷ Relying on dictionary definitions, as the Supreme Court did, “*Advance*” can be understood as “*move forwards*”/ “*make or cause to make progress*”/ “*a forward movement*” “*a development or improvement*”.⁸ Therefore, “*technical advance*” would imply something which takes a particular technique or craft forward in the sense of making progress or development therein. “*Difference*”, on the other hand, means “*a way in which people or things are different*”.⁸ It is important to note another observation of the Indian Supreme Court in *Novartis*, i.e., “*A manipulative step may or may not be an inventive step, which is the requirement under Indian Law*”.⁹ Arguably, a mere difference- which may result from such a manipulative or difference inducing step- may or may not be technical advance as required under Indian Law.

What Difference does a Phrase Make?

Looked at from the above perspective, in case of genus-species patent disputes, for example, a specie might be different from the prior published genus and may very well be non-obvious to someone with ordinary skill in the art, but the same specie may not represent any technical advance to a skilled person- in the sense of demonstrating progress or a move forward in technology (the technology being the genus which, as the patentees argue in India: covers the specie, but does not disclose it). Therefore, while specie patents might be the norm in U.S., they should definitely require a more thorough investigation under Indian Law for the simple reason that, even in respect of a universal criterion like inventive step, the statutory requirements are different. Interestingly, a division bench of Delhi High Court went as far as to suggest that in such disputes, where the inventor of

the genus and specie is the same, the test of inventive step has to be from the prism of a “*person in the know*” to determine “*whether the inventor, while writing the first patent, knew of the invention claimed in the second patent*”.¹⁰ While the said approach might be perceived as quite radical and extra-statutory in the sense of changing the requirement of person skilled in the art to a ‘person in the know’, perhaps it will be of some assistance if the bench and the bar bears in mind the different definitions in different jurisdictions and realize that not every difference from prior art (which would entitle one to a patent in the US) will be a technical advance for a skilled person or even a “*person in the know*” in India, thus leading to rejection of a patent in India for an invention that might be protected elsewhere.

As we see later, it is not clear if these nuances have consistently informed the decisions/choices of Indian courts while borrowing heavily from U.S. and U.K. jurisprudence, especially in context of the tests of inventive step and how the same is applied in India.

The Meaning of ‘Person Skilled in the Art’

The use of terms PSA and PHOSITA is interesting as well- what is the level of this hypothetical skilled person- should this person be an expert or someone of ordinary skill (Indian Patents Act does not use ‘ordinary’ skilled person in context of inventive step anywhere in the Act). More on this aspect is discussed later. It is worth noting again that the Indian statute does not define ‘Person Skilled in the Art’. But before we deal with tests of inventive step and the meaning of ‘Person Skilled in the Art’, it is relevant to look at the concept of “*existing knowledge*”- which remains undefined in the Indian Patents Act.

The Meaning of ‘Existing Knowledge’

The definition of inventive step under Indian Law uses the term “*existing knowledge*” compared to which the invention’s feature must have technical advance. The definition does not use the terms ‘prior art’ or ‘state of the art’. Those terms, in context of inventive step, emerge from U.S. and U.K. Laws. It is not clear why the Indian legislature would do so, particularly when in context of ‘new invention’, Indian Patents Act states that the subject matter, in order to be new, should not have “*fallen in public domain or that it does not form part of the state of the art*”.¹¹ Hence, while new-ness of an invention is judged based on the metric of state of the art/ public domain, technical advance must emerge from a

comparison with existing knowledge. One must note that technology which is off-patent or never-patented lies, strictly speaking, in public domain- free for all to use, whereas state of the art or prior art can also include published patent applications and granted patents, apart from including non-patent or off-patent literature/knowledge. One way to look at 'existing knowledge' under Section 2(1)(ja) is to understand it as state of art- encompassing patented knowledge, off-patent knowledge, never-patented knowledge (articles, books, treatises, videos, and the like), and pending-but-published patent applications.

State of the art, a term which is present in the European Patent Convention is defined under Article 54(2) thereof as, "*The state of the art shall be held to comprise everything made available to the public by means of a written or oral description, by use, or in any other way, before the date of filing of the European patent application*". UK Law has a similar definition for state of the art.¹²

In a similar vein, the Indian Supreme Court, quoting from Encyclopaedia Britannica and dealing with the erstwhile Patents Act (as it then existed), noted that,

*"Whether an alleged invention involves novelty and an 'inventive step', is a mixed question of Law and fact, depending largely on the circumstances of the case. Although no absolute test uniformly applicable in all circumstances can be devised, certain broad criteria can be indicated. Whether the "manner of manufacture" patented, was publicly known, used and practised in the country before or at the date of the patent? If the answer to this question is 'yes', it will negative novelty or 'subject matter'. Prior public knowledge of the alleged invention which would disqualify the grant of a patent can be by word of mouth or by publication through books or other media. "If the public once becomes possessed of an invention", says Hindmarch on Patents (quoted with approval by Fry L. J. in *Humpherson v Syer*, "by any means whatsoever, no subsequent patent for it can be granted either to the true or first inventor himself or any other person; for the public cannot be deprived of the right to use the invention.....the public already possessing everything that he could give."*¹³

Therefore, the knowledge which can disentitle one from a patent can be oral or documented in any manner and can arise from prior use as well. At least in this context alone, there is no reason why this basic understanding under the older Law will not be applicable to the current definition of inventive step in India.

In its inventor's handbook, European Patent Organisation succinctly explains prior art-

*"Prior art is any evidence that your invention is already known. Prior art does not need to exist physically or be commercially available. It is enough that someone, somewhere, sometime previously has described or shown or made something that contains a use of technology that is very similar to your invention. A prehistoric cave painting can be prior art. A piece of technology that is centuries old can be prior art. A previously described idea that cannot possibly work can be prior art. Anything can be prior art. An existing product is the most obvious form of prior art. This can lead many inventors to make a common mistake: just because they cannot find a product containing their invention for sale in any shops, they assume that their invention must be novel. The reality is very different. Many inventions never become products, yet there may be evidence of them somewhere. That evidence - whatever form it may take - will be prior art."*¹⁴

The United States Patent and Trade Mark Office (USPTO)'s Manual of Patent Examining procedure, relying on U.S. judgements, echoes the same sentiment:

*"drawings and pictures can anticipate claims if they clearly show the structure which is claimed... However, the picture must show all the claimed structural features and how they are put together... The origin of the drawing is immaterial. For instance, drawings in a design patent can anticipate or make obvious the claimed invention as can drawings in utility patents..."*¹⁵

Quite naturally, for anything to be prior art/ state of the art/ existing knowledge, it must have been existing immediately before, or prior to, the priority date/filing date of the relevant claim of the patent application. As we noted above, such existing knowledge, in context of determination of inventive step, can be oral or published or may come from prior use, and it is immaterial if the same is from patented knowledge, off-patented knowledge, never-patented knowledge, or from a published patent application in respect of which a patent may or may not be granted. In fact, even traditional knowledge is prior art (quite apart from the fact that such traditional knowledge by itself is not patent eligible under Section 3).

Prior Arts/ Existing Knowledge Relating to Same Field

But this 'existing knowledge', quite logically, must relate to the same field as that of the invention which is

being assessed for existence of inventive step. For example, a Person Skilled in the Art of pharmaceutical technology and assessing an invention relating purely to xenotransplants, will not look at a prior art from the field of thermodynamics or optics (unless the invention under assessment related to application of some principle of another field to xenotransplantation). Since the life of Law is also precedents, the Madras High Court noted as much when it stated that

“Since the two prior arts... are in the same field as the claimed invention... publication dates of prior arts... are prior to the priority date of the claimed invention... these qualify as analogous prior art documents”.¹⁶

How does the Person Skilled in the Art deal with or combine/mosaic these prior arts or the analogous prior arts? Before that, we now turn our gaze to the what exactly is a person skilled in the art and is such person different from the ordinary skilled person of U.S. Law?

The Person Skilled in the Art & Impact of Language

Under English Law, the expression ‘Person Skilled in the Art’ is used. *Windsurfer Tabur*¹⁷, describes the characteristics of a PSA under English Law as,

“The hypothetical skilled man is no doubt, (together with his cousins the reasonable man and the officious bystander) a useful concept as setting a standard and, in the instant case, as providing the touchstone by which the question of obviousness may be judged... The question of whether the alleged invention was obvious has to be answered objectively by reference to whether, at the material time (that is, immediately, prior to the priority date), the allegedly inventive step or concept would have been obvious to the skilled addressee.”

Such “skilled man” or “skilled addressee” is “unimaginative” and yet “well acquainted with workshop technique and as having carefully read the relevant literature”.¹⁸

In 2015, a Division Bench of High Court of Delhi¹⁹ (hereinafter, Roche DB), dealing with inventive step, described Ordinary Person Skilled in Art (POSA) as,

*“To test obviousness, the first test required to be applied is to see who is an ordinary person skilled in art (POSA) and what are its characteristics, The features of a person skilled in the art are that of a person who practices in the field of endeavour, belongs to the same industry as the invention, possesses average knowledge and ability and is aware of what was common general knowledge at the relevant date.”*²⁰

As noted above, Indian Patents Act itself does not use the expression ordinary person skilled in art/ POSA nor does it require the knowledge and ability of the PSA to be average. The concept of ordinary skilled person (Person Having Ordinary Skill in the Art or PHOSITA/ POSITA) comes from U.S. Law and has no parallel under Indian Law- a fact recently recognized by the Madras High Court. The Madras High Court noted that

“definition of inventive step in the Patents Act is closer to that in the UK Patents Act because both statutes use the expression “person skilled in the art” unlike the US Patents Act which uses the expression “person having ordinary skilled in the art”.”²¹

Therefore, any use of the expression ‘ordinary skilled person’ or PHOSITA is simply an unfortunate borrowing not merited in terms of the statutory language of Indian Patents Act. There could be a tendency to brush aside the differences between PSA and PHOSITA as being irrelevant, but then why would the legislature choose not to use the word ‘ordinary’ in Section 2(1)(ja) when it clearly had the benefit of looking at the U.S. requirement, and when it clearly qualified the skilled person in context of enablement in Section 64(1)(h)?

In this context, a 2013 judgement²² of the erstwhile Intellectual Property Appellate Board (IPAB)²³ might be noteworthy, where the bench was dealing with the question of who is a person skilled in art and noted that,

“27 ... it is definitely not necessary or proper for us to dumb down the Person Skilled in the Art nor make him so ignorant of anything that is happening elsewhere or presume he does not know even common text books unless proved otherwise. In fact this hypothetical person is presumed to know all the prior arts as on that date, even non-patent prior art in theory available to public. He has knowledge of the technical advancement as on that date, and the skill to perform experiments with the knowledge of state of the art.

28. There is nothing in the Act which limits the person skilled in the art and defines him as possessing certain qualities...

30 In fact it is clear that in the context of enablement, the person to whom the complete specification are addressed is a person who has average skill and average knowledge. Neither of these attributes has been assigned by the Act to the person to whom the invention should be non-obvious... we do not intend to visualise a person who has super skills,

but we do not think we should make this person skilled in the art to be incapable of carrying out anything but basic instructions. The Act makes distinction between the person skilled in the art (the obviousness person) and the person who has average skill (enablement man)...

32. ... The Act does not say in 2(1)(ja) that the inventive step should be non-obvious to a person with average skill and average knowledge”

(emphasis supplied by authors)

Relying on the said IPAB judgment, and perhaps influenced by the same, the Madras High Court went on to note (for its sheer criticality, the passages merit being captured in full here)¹⁶,

“24. The person skilled in the art is a hypothetical person created by the Law...

27. Section 2(1)(ja) uses the word “skilled” as an adjective qualifying the noun “person”. Most standard dictionaries define the adjective “skilled” as referring to a person having the ability to do a job, task or activity well... By reckoning that such skilled person could be from a range of disciplines depending on the field of invention, I ask myself what level of ability comes to mind if a person were to be described in any of the following ways: skilled medical doctor; skilled automobile engineer; skilled physicist; skilled carpenter; or skilled immunologist. In each case, the straightforward answer is a person possessing the necessary attributes to do the job well. I bear in mind statutory context, i.e. the absence of the qualifier “average” in Section 2(1)(ja) in contrast to its use in Section 64(1)(h). I recognise that the statute neither uses words that indicate enhanced levels of skill such as “highly”, “outstandingly” or “extraordinarily” nor words that indicate a low or average level of skill such as “low” or “ordinary” or “average” to further qualify the “skilled” person. By taking into account all of the above, on balance, in my view, the “person skilled in the art” as per Section 2(1)(ja) is a person whose skill level is good/greater than average. Because most disciplines/arts require a range of skills or skill set, this person should possess the skill set to do the job well. These aspects were considered in a judgment dated 12.06.2013 of the Intellectual Property Appellate Tribunal (the IPAB) in *Enercon (India) Ltd. v Aloys Wobben (Enercon)*, ORA/08/2009/PT/CH. In *Enercon*, the IPAB, speaking through Mrs. Justice Prabha Sridevan, held as under in two memorable paragraphs:

“35. It is true that the Roche extract is specifically with regard to the obviousness issue, but the Novartis

extract is not. But it is clear from both the judgments that we should understand the concepts based on the Sections as they are in our Act, and also contextualize it in our country. *Roche v Cipla* also speaks of a person skilled in the art and not a person with ordinary skill in the art or average skill in the art. The respondent wants us to imagine a person of ordinary skill, conservative, unimaginative, will not go against established prejudice, and is in India. The Law has not used the word ordinary. It had the Laws of other jurisdictions before it and yet it eschewed the word “ordinary”. So it is very important for us while deciding obviousness not to conjure up a dullard or a moron. Why should we proceed as if “ordinariness” is inherent in the hypothetical person? If it makes the obviousness bar a bit higher, we must bear that in mind, for this is Our Law.”

“37. In this case the art is wind energy. Since this obviousness test is the most frequently debated issue in patent litigations, it may be better if in the future, the pleadings or evidence tells us who this person is. This person is skilled in the art. This person is presumed to know the state of that art at that time, and to have the knowledge that is publicly available. The Act is quite clear and free from ambiguity. The person is skilled in the art and has more than average knowledge of the state of the art and also has common sense. Indian Law expects the non-obviousness to be tested against this person and not the person who is the touchstone in U.S. Law. She is Ms. P. Sita (Person Skilled in the Art) and not Mr. Phosita or Mr. Posita who are both ordinary by definition.”

(emphasis supplied by authors)

As we have noted earlier, given the different language of the statutory provisions, borrowings from other jurisdictions must be done with utmost care. The reason will be explained after we note the observations of the Madras High Court in relation to attributes of the PSA. The Court noted the following attributes²⁴,

(i) Depending on the art, educational/ academic or vocational qualifications are likely to be required.

(ii) Work experience would certainly be required because one does not ordinarily describe a person with the requisite educational qualifications but no work experience as skilled in the art.

(iii) Such person would also be “adept at using tools of the trade”.

(iv) The hypothetical PSA is imputed with “a level of knowledge that a real person skilled in the art is unlikely to possess”.

(v) *Such imputation of knowledge is not, however, unqualified and is restricted to matters previously known in the art in which such person or team of persons is skilled.*

(vi) Further, legislative intent is not that the PSA should be omniscient. Nor is it required or mandated that *“this person should be forgetful of other prior art once she identifies the closest prior art... although it is necessary to be mindful of the risk of hindsight-based mosaicing”*.

(vii) *Imagination is an inherent human quality and the underlying public policy of fostering inventiveness does not justify banishing imagination in the notional person.*

(viii) *if obviousness is examined from the perspective of a skilled person with ingenuity and inventive capacity, every patent application would fail as would the public policy of fostering genuine invention. Indeed, even de hors the public policy justification, the expression “person skilled in the art” does not ordinarily connote a person with inventive capability.*

(ix) *Thus, except to the extent that statutory prescription or the underlying public policy call for a departure from the characteristics of a real person skilled in the art, the notional person should, in my view, mirror a real person as closely as possible. Adopting such approach has the benefit of enhancing the quality of obviousness analysis by ensuring that it remains rooted in the real world.*

The Madras High Court further inquired if it is *“always necessary for the adjudicator to identify the person skilled in the art”?* and answered in the following terms,

“If the patent applicant and the relevant patent office agree on the person skilled in the art, identification by the adjudicator is not necessary. By contrast, whenever there is disagreement, the adjudicator has to identify the person skilled in the art. Where does one begin? The obvious starting point is the field of the claimed invention. Sometimes the person skilled in the art can be readily identified from the field of invention. By way of illustration, if the claimed invention is a pure automobile patent, the person skilled in the art would be an automobile engineer. The identification process could get more complicated - and, the person skilled could even be a team of persons with requisite skills - if the claimed invention also embraces a customised software embedded in a system/hardware. Depending on the nature of the claimed invention, the person, or team of

persons, skilled in the art could be from a specific industry or industries or be proficient in technology with use cases in multiple industries.”²⁵

The Dangers of Borrowing an Ordinary Skilled Person into Indian Law

The course-correction and the seminal views of the Madras High Court impart a degree of clarity to what is a person skilled in the art in the Indian context. Whenever the Indian patent office or the court contextualise a skilled person as ordinary, there occurs a problematic ‘dumbing down’ (as the IPAB had put it) of the PSA. This can introduce a sub-conscious bias owing to the use of the word ordinary. While the ordinary PSA can only combine prior arts or reach a species from a genus when there are near-express instructions to do so, a normal PSA would at least have some imaginative faculty to put things together. Perhaps such a normal PSA can be equated to an expert- imaginative, well-read, capable but not inventive (as one of us likes to put it- there can be Ph.Ds. in Physics or Engineers with years of experience- the non-average and non-ordinary skilled persons, but not all of them would be a Nikola Tesla!). Such a PSA may not require a high degree of help/assistance or specific pointers to combine prior arts or to reach a specie patent from the combinations possible in the genus, unlike its simpler U.S. counterpart who has ordinary skill.

The basic arguments are these- (i) Indian Law requires something more than a mere difference from prior art, it requires technical advance compared to existing knowledge, and (ii) the person judging such technical advance for existence of obviousness is not ordinary, not average nor super-skilled but a capable skilled person. Any interpretation or borrowing from foreign jurisprudence, which loses sight of this statutory difference in Indian Law can result in interpreting the skilled person as less capable than what the Indian Act/ legislature expected it to be and in lowering the inventive step standard. This can lead to grant of patents, or even grant of injunction in favour of patentees, for inventions which ought not to be patented under the more nuanced Indian Law- since the quality of innovation and not merely the quantity thereof ought to matter.

Characteristics of PSA under Indian Law

In our view, the Indian PSA ought to be just one notch below the inventor- lacking the creative spark but imaginative and capable, just like the Madras

High Court envisioned it to be. The PSA is still an expert, not of ordinary or average skill- a person who has (i) read the relevant literature, (ii) is aware of usages in the relevant field of technology and (iii) possess experience and knowledge of the relevant field/art; definitely this PSA is not restricted by barriers of language or jurisdictions and is not average skilled person who would find combining relevant prior arts overly arduous unless the prior arts screamed out pointers for combining them. Any interpretation to the contrary or any attempt to make the PSA of Indian patent Law ordinary or dumb, would perhaps run afoul of the Patents Act and the legislative intent.

Tests of “Inventive Step”: Borrowings from other Jurisdictions

Tests of obviousness (U.S. Law) and of inventive step (English Law) have influenced the evolution of inventive step assessment in India. We begin with English jurisprudence.

Jurisprudence in U K

Here, inventive step implies something “*so obvious that it would at once occur to anyone acquainted with the subject, and desirous of accomplishing the end*”.²⁶ The Court of Appeal laid down the following 4-step Windsurfing Test for assessing inventive step¹⁷ (for a recent incarnation of the Windsurfing Test, See, the Pozzoli Test²⁷),

“*The first is to identify the inventive concept embodied in the patent in suit. Thereafter, the court has to assume the mantle of the normally skilled but unimaginative addressee in the art at the priority date and to impute to him, what was, at that date, common general knowledge in the art in question. The third step is to identify what, if any, differences exist between the matter cited as being known or used and the alleged invention. Finally, the court has to ask itself whether, viewed without any knowledge of the alleged invention, those differences constitute steps which would have been obvious to the skilled man or whether they require any degree of invention.*” (emphasis added)

Mosaicing/ Combining Prior Arts

Under English Law (and other jurisdictions as well) for determination of inventive step, mosaicing or combining prior arts is also permissible,

“*When dealing with obviousness, unlike novelty, it is permissible to make a mosaic out of the relevant documents, but it must be a mosaic which can be put*

together by an unimaginative man with no inventive capacity.”²⁸

The Indian Patent office, in its practice manual, also states that mosaicing of multiple prior art documents is permissible for assessment of obviousness by a PSA.²⁹ A similar view has been taken by Indian courts as well.³⁰ This appears to be logical- the PSA is assumed to have read all the existing literature. There wouldn’t be any need to make such an assumption if such PSA did not have the ability to combine what s/he has read or known- the prior arts, common general knowledge or the literature the PSA is assumed to have read.

The Hindsight Bias

In the final step of the Windsurfing test, the Court also points to a rather important aspect of inventive step analysis- avoiding hindsight bias. It mentions that the differences between the known matter and the alleged invention must be “*viewed without any knowledge of the alleged invention*”.

The patent office or the Court will test inventive step of a given claim/set of claims once the same has/ have been filed or granted. In looking at the invention from the prism of a hypothetical skilled person, the determining authority will be looking back after the event of invention has occurred and will ask whether at the point just prior to existence of the claim/ claims, would the hypothetical skilled person have been able to arrive at the same based on the existing art? If yes, then there isn’t any inventive step in the invention. However, everything can be routine or non-inventive in hindsight and this is exactly the bias that patent examiners and courts have to avoid. The avoidance of hindsight analysis is recognized in U.S. and India³¹ as well.

The Problem of Borrowing

The Windsurfing Test or its later incarnations in the U.K. present two problems. Firstly, unlike the requirement of technical advance or economic significance in India, the U.K. test inquires if “*differences exist between the matter cited as being known or used and the alleged invention*”. Secondly, as per Windsurfing Test, the PSA has to be “*normally skilled but unimaginative addressee*” which directly runs afoul of what the Madras High Court held- “*imagination is an inherent human quality*” and the same cannot be banished in the notional person. These differences must guide any subsequent borrowing of the test into Indian jurisprudence.

U S Jurisprudence

The U.S. Supreme Court, in *Graham*³², surveyed the history and evolution of the obviousness requirement under U.S. Law and laid the Graham analysis for determination of obviousness- an analysis which bears an uncanny similarity to the Windsurfing Test that came more than a decade later,

“Under § 103, the scope and content of the prior art are to be determined; differences between the prior art and the claims at issue are to be ascertained; and the level of ordinary skill in the pertinent art resolved. Against this background, the obviousness or nonobviousness of the subject matter is determined. Such secondary considerations as commercial success, long felt but unsolved needs, failure of others, etc., might be utilized to give light to the circumstances surrounding the origin of the subject matter sought to be patented. As indicia of obviousness or non obviousness, these inquiries may have relevancy.”

The problems we identified in relation to borrowing of Windsurfing Test apply with more force to the U.S. test which is laid down in background of a very different statutory provision in a country with very different ethos, as we have noted above.

The place of Teaching Suggestion Motivation Test- a mere Helpful Insight

The U.S. Supreme Court, in *KSR*³³, reiterated its commitment to the Graham analysis and made some interesting observations regarding the much-vaunted Teaching Suggestion Motivation (TSM) test- a test that has been rather consistently pushed into service by Indian patent office and Indian courts. Given the relevance of why the TSM approach could be dangerous and what the U.S. Supreme Court notes in respect thereof, the following extracts are produced in full,

“Seeking to resolve the question of obviousness with more uniformity and consistency, the Court of Appeals for the Federal Circuit has employed an approach referred to by the parties as the “teaching, suggestion, or motivation” test (TSM test), under which a patent claim is only proved obvious if “some motivation or suggestion to combine the prior art teachings” can be found in the prior art, the nature of the problem, or the knowledge of a person having ordinary skill in the art. See, e. g., Al-Site Corp. v VSI Int’l, Inc., 74 F. 3d 1308, 1323-1324 (CA Fed. 1999). KSR challenges that test, or at least its application in this case. See 119 Fed. Appx. 282, 286-290 (CA Fed.

2005). Because the Court of Appeals addressed the question of obviousness in a manner contrary to § 103 and our precedents, we granted certiorari... We now reverse.

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When it first established the requirement of demonstrating a teaching, suggestion, or motivation to combine known elements in order to show that the combination is obvious, the Court of Customs and Patent Appeals captured a helpful insight. See Application of Bergel, 292 F. 2d 955, 956-957 (1961). As is clear from cases such as Adams, a patent composed of several elements is not proved obvious merely by demonstrating that each of its elements was, independently, known in the prior art. Although common sense directs one to look with care at a patent application that claims as innovation the combination of two known devices according to their established functions, it can be important to identify a reason that would have prompted a person of ordinary skill in the relevant field to combine the elements in the way the claimed new invention does. This is so because inventions in most, if not all, instances rely upon building blocks long since uncovered, and claimed discoveries almost of necessity will be combinations of what, in some sense, is already known.

Helpful insights, however, need not become rigid and mandatory formulas; and when it is so applied, the TSM test is incompatible with our precedents. The obviousness analysis cannot be confined by a formalistic conception of the words teaching, suggestion, and motivation, or by overemphasis on the importance of published articles and the explicit content of issued patents. The diversity of inventive pursuits and of modern technology counsels against limiting the analysis in this way. In many fields it may be that there is little discussion of obvious techniques or combinations, and it often may be the case that market demand, rather than scientific literature, will drive design trends. Granting patent protection to advances that would occur in the ordinary course without real innovation retards progress and may, in the case of patents combining previously known elements, deprive prior inventions of their value or utility. In the years since the Court of Customs and Patent Appeals set forth the essence of the TSM test, the Court of Appeals no doubt has applied the test in accord with these principles in many cases. There is no necessary inconsistency between the idea

underlying the TSM test and the Graham analysis. But when a court transforms the general principle into a rigid rule that limits the obviousness inquiry, as the Court of Appeals did here, it errs.

The flaws in the analysis of the Court of Appeals relate for the most part to the court's narrow conception of the obviousness inquiry reflected in its application of the TSM test. In determining whether the subject matter of a patent claim is obvious, neither the particular motivation nor the avowed purpose of the patentee controls. What matters is the objective reach of the claim. If the claim extends to what is obvious, it is invalid under § 103. One of the ways in which a patent's subject matter can be proved obvious is by noting that there existed at the time of invention a known problem for which there was an obvious solution encompassed by the patent's claims."

(emphasis added by authors)

At present, the U.S.P.T.O. maintains that,

*"The Supreme Court in KSR reaffirmed the familiar framework for determining obviousness as set for in Graham v John Deere Co."... "but stated that the Federal Circuit had erred by applying the teaching-suggestion-motivation (TSM) test in an overly rigid and formalistic way."*³⁴

One should hope that the U.S. Supreme Court's words of caution regarding the TSM test (that owes its origin to U.S. jurisprudence) guide the stakeholders in India as well.³⁵ We have opined above that, unlike the ordinary skilled person of U.S. Law, the skilled addressee in India does not need the prior arts to near-expressly show (or teach, suggest and motivate) how they have to be combined or mosaiced.

Indian Jurisprudence

The Indian Supreme Court³⁶, while dealing with the old Act (Patents and Designs Act, 1911) noted that,

"... in order to be patentable an improvement on something known before or a combination of different matters already known, should be something more than a mere workshop improvement; and must independently satisfy the test of invention or an inventive step."

Observing that any craftsman would have the knowledge and ability to "vary his methods to meet the task before him... any monopoly that would interfere with the craftsman's use of his skill and knowledge would be intolerable", the Court opined that determination of novelty and inventive step "is a mixed question of Law and fact, depending largely on

the circumstances of the case". Importantly, the Supreme Court perhaps understood that the skilled person or skilled craftsman would have knowledge and ability to "vary his methods" and would not be so plain or naïve as to need specific pointers in existing art without which the skilled person won't be able to tinker with or combine the arts in any manner. It is this understanding that must inform assessment of inventive step or any application of the TSM test in India. After all, a skilled person will not always need an express teaching and can freely tinker with the known art and tools to understand what is or is not inventive.

In context of inventive step, the Supreme Court has further stated in *Bishwanath Prasad*,

"... 'obviousness' has to be strictly and objectively judged. For this determination several forms of the question have been suggested. The one suggested by Salmond L. J. in Rado v John Tye & Son Ltd. is apposite. It is: "Whether the alleged discovery lies so much out of the Track of what was known before as not naturally to suggest itself to a person thinking on the subject, it must not be the obvious or natural suggestion of what was previously known."

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"Had the document been placed in the hands of a competent craftsman (or engineer as distinguished from a mere artisan), endowed with the common general knowledge at the 'priority date', who was faced with the problem solved by the patentee but without knowledge of the patented invention, would he have said, "this gives me what I want?"... To put it in another form: "Was it for practical purposes obvious to a skilled worker, in the field concerned, in the state of knowledge existing at the date of the patent to be found in the literature then available to him, that he would or should make the invention the subject of the claim concerned?"

Apart from the judgment in *Avery Dennison*³⁷, in context of inventive step, a single judge of Delhi High Court has further laid down the following,

"24. In the opinion of this Court, while rejecting an invention for lack of inventive step, the Controller has to consider three elements-

- the invention disclosed in the prior art,*
- the invention disclosed in the application under consideration, and*
- the manner in which subject invention would be obvious to a person skilled in the art.*

25. Without a discussion on these three elements, arriving at a bare conclusion that the subject invention is lacking inventive step would not be permissible, unless it is a case where the same is absolutely clear...

26. Thus, the Controller has to analyse as to what is the existing knowledge and how the person skilled in the art would move from the existing knowledge to the subject invention, captured in the application under consideration. Without such an analysis, the rejection of the patent application under Section 2(1)(ja) of the Act would be contrary to the provision itself.”³⁸

Another judge of the Delhi High Court has observed that³⁹,

“5. The pivotal issue at hand pertains to the inventive step, which is indeed a fundamental criterion for deciding the question of patentability. This necessitates a rigorous examination of the application, beyond mere surface analysis. The Manual for Patent Office Practice and Procedure dated 26th November, 2019 (“Patent Manual”), stipulates the determination of an inventive step requires an assessment rooted in non-obviousness relative to the state of the art. An invention demonstrates an inventive step if it eludes the predictable pathways of a skilled practitioner in the relevant field, thereby achieving a distinction that elevates it beyond mere incremental advancements. This inquiry propels us to consider whether the invention demands an exertion of skill or acumen exceeding the normative expectations of a person skilled in the art.

6. The Patent Manual advises against fragmentary analysis of claims or inventive parts, advocating for a holistic view to truly gauge the inventive step. Notably, the determination of non-obviousness should not rest on the mere presence of individual components within the claims that are known or might appear obvious when considered in isolation. The essence of the invention must be viewed in its entirety to truly gauge its inventive merit. Further contemplation is guided by the four-step framework delineated in the landmark case of *Windsurfing International v Tabur Marine...*”

The Madras High Court, relying on judgments of Delhi High Court and U.K. courts, has noted that,

“The precedents on record suggest that the inventive step inquiry should be carried out in the following manner: (1) identify the person skilled in

the art; (2) identify the common general knowledge to be imputed to the person skilled in the art; (3) identify the inventive concept embodied in the claimed invention; (4) identify the differences between the prior arts and the claimed invention; and (5) decide whether those differences would be obvious to a person skilled in the art.”⁴⁰

The two-step test of Madras High Court in *Microsoft Licensing* has already been noted above⁴¹ wherein the Court has spoken in terms of ‘technical advance’ and two-step assessment.

The Position of Roche Test on Inventive Step

Interestingly, the Roche DB (High Court of Delhi, 2015)¹⁹ after surveying the tests/ analysis applied elsewhere, laid down the following mechanism for determination of inventive step,

“To determine the obviousness/ lack of inventive steps the following inquiries are required to be conducted:

Step No. 1: To identify an ordinary person skilled in the art,

Step No. 2: To identify the inventive concept embodied in the patent,

Step No. 3: To impute to a normal skilled but unimaginative ordinary person skilled in the art what was common general knowledge in the art at the priority date,

Step No. 4: To identify the differences, if any, between the matter cited and the alleged invention and ascertain whether the differences are ordinary application of Law or involve various different steps requiring multiple, theoretical and practical applications,

Step No. 5: To decide whether those differences, viewed in the knowledge of the alleged invention, constituted steps which would have been obvious to the ordinary person skilled in the art and rule out a hideshow approach.”

The Court also stated that “the burden to prove is on the party which alleges however after the party which alleges makes out a prima facie case of invalidity on the ground of obviousness, the burden shifts on the inventor to disprove obviousness.”¹⁹

The Problems with Roche DB Test

It is interesting to note the choice of words in the above test, notably the existence of “ordinary” skilled person and the existence of “differences”- not of technical advance between prior art and claimed

invention. Given what has been said by the Indian statute, the Supreme Court and the Madras High Court as well as what the authors have stated above, one may ask: Does the test enunciated in this manner by the Roche DB sit comfortably with statutory language or does it in any way dilute the rigour mandated by Indian Law? If words have specific roles and meanings, and such words are chosen by the legislature carefully, then a borrowing without context might be troublesome.

Conclusion

We reiterate that the concept of inventive step and meaning of person skilled in the art might have a bearing on the quality and substantive merit of granted patents- as Carlos Correa had alluded to in his commentary on TRIPS. We have noted above that a concept/test which takes into account the nuances of Indian statutory definition can prove to be useful in applying the test of inventive step in Indian jurisprudence as well as in infringement actions involving, *inter-alia*, genus-specie disputes. Even though several tests of inventive step have been surveyed above, determination of inventive step remains a daunting task. This is true for assessment of patentability as well as assessment of infringement/invalidity actions.⁴² Avoiding hindsight analysis, assuming mantle of a hypothetical skilled person and reading the relevant prior arts to ascertain if the technical advance between invention and prior knowledge could be within reach of a skilled person can be excruciating for the most trained of minds. Such determination would naturally depend on the facts and the invention under consideration. Further borrowings and guidance from other jurisdictions must be done with care- so that our rigid reliance on precedents does not lead to diluting statutory requirements and plain logic. In this context, as we noted above, the Roche DB test of Delhi High Court sits rather uncomfortable in Indian patent jurisprudence. Perhaps as Indian patent Law matures, it will become imperative to view Indian Law and its unique terms and provisions, from a distinctly Indian prism, grounded in our realities and goals, and not based on indiscriminate borrowings from U.S. and other jurisdictions.

References

1 Section 2(1) m, Patents Act, 1970 (hereinafter, Patents Act): “*patent means a patent for any invention granted under this Act*”.

- 2 Section 2(1)(j), Patents Act.
 3 Sections 7 and 10 of the Patents Act.
 4 Correa C M, Trade Related Aspects of Intellectual Property Rights: A Commentary on the TRIPS Agreement, *OUP, New York*, (2007) 276.
 5 This fundamental credo of U.S. jurisprudence comes from the U.S. Supreme Court decision in *Diamond v Chakrabarty*, 447 U.S. 303 (1980).
 6 In the seminal case on evergreening, *Novartis AG v Union of India & Ors.*, (2013) 6 SCC 1, the Indian Supreme Court stated that “*Inventive step is separately defined in Section 2(ja)... To paraphrase, the invention that creates the product must have a feature that involves technical advance as compared to the existing knowledge or having economic significance or both and this feature should be such as to make the invention not obvious to a person skilled in the art*”. Likewise, the Madras High Court, in *Microsoft Technology Licensing LLC v Assistant Controller of Patents and Designs*, 2024: MHC: 1009 stated that, “*From the plain language of the Section, it follows that the assessment of inventive step of a claimed invention is to be made by a two-step process: (i) identification of feature(s), if any, that involve technical advancement over prior knowledge or having economic significance or both; and (ii) determination of whether the technical advance or economic significance or both of said feature(s) makes the invention not obvious to a person skilled in the art*”.
 7 *Novartis AG v Union of India & Ors.*, (2013) 6 SCC 1.
 8 Concise Oxford Dictionary, 10th Edition, Oxford University Press, 7th Impression, 2001.
 9 *Novartis AG v Union of India & Ors.*, (2013) 6 SCC 1. the footnote accompanying the discussion in context of U.S. Board of Patent Appeals which had “*held that the teaching in the Zimmerman patent did not go beyond Imatinib Mesylate and did not extend to beta crystalline form of Imatinib Mesylate, which represented a manipulative step in a method of treating tumour disease in a patient*”.
 10 *AstraZeneca AB & Anr. v Intas Pharmaceuticals Ltd.*, 2021: DHC: 2116-DB, para 30 (the DB judgment in Dapagliflozin dispute).
 11 Section 2(1)(l), Patents Act.
 12 Section 2(2), The Patents Act, 1977, UK: “*The state of the art in the case of an invention shall be taken to comprise all matter (whether a product, a process, information about either, or anything else) which has at any time before the priority date of that invention been made available to the public (whether in the United Kingdom or elsewhere) by written or oral description, by use or in any other way*”.
 13 *M/s Bishwanath Prasad Radhey Shyam v Hindustan Metal Industries* (1979) 2 SCC 511 at 518.
 14 <https://www.epo.org/learning/materials/inventors-handbook/novelty/prior-art.html#:~:text=Prior%20art%20is%20any%20evidence,ver y%20similar%20to%20your%20inventio>(accessed on 29 March 2024).
 15 <https://www.uspto.gov/web/offices/pac/mpep/s2125.html> (accessed on 29 March 2024).
 16 *Rhodia Operations v Assistant Controller of Patents and Designs*, 2024: MHC: 6024, para 39.
 17 *Windsurfing International Inc. v Tabur Marine Ltd.* [1985] R.P.C. 59 (CA).

- 18 *Windsurfing International Inc. v Tabur Marine Ltd.* [1985] R.P.C. 72 (CA).
- 19 *F. Hoffmann-La Roche Ltd. & Anr. v Cipla Ltd.*, 225 (2015) DLT 391(DB).
- 20 *F. Hoffmann-La Roche Ltd. & Anr. v Cipla Ltd.*, 225 (2015) DLT 438(DB)
- 21 *Rhodia Operations v Assistant Controller of Patents and Designs*, 2024: MHC: 6024, para26.
- 22 *Enercon (India) Ltd. v Aloys Wobben*, 2013 SCCOnline IPAB 91
- 23 The IPAB stands abolished in terms of the Tribunal Reforms Act, 2021.
- 24 *Rhodia Operations v Assistant Controller of Patents and Designs*, 2024: MHC: 6024, para 28 to para 29.
- 25 *IRhodia Operations v Assistant Controller of Patents and Designs*, 2024: MHC: 6024, para 30.
- 26 *Siddell v Vickers, Sons & Co. Ltd.* [1890] 7 R.P.C. 292, 304.
- 27 *Pozzoli SPA v BDMO SA & Anr.* 2007 EWCA Civ 588.
- 28 *Technograph v Mills & Rockley* [1972] RPC 346, 355.
- 29 Manual of Patent Office Practice and Procedure, ver. 3.0, 26 November 2019.
- 30 The Calcutta High Court has noted that “*While mosaicing in patents is permissible, the reasons for doing so must be clearly spelt out*” (*Guangdong Oppo Mobile Telecommunications Corp., Ltd. v The Controller of Patents and Designs*, AID No. 20 of 2022, dated 13 June 2023, para 11). A similar view has been taken by the Delhi High Court in *Bristol-Myers Squibb Holdings v BDR Pharmaceuticals International*, 2020 SCC Online Del 1700.
- 31 *Bristol-Myers Squibb Holdings v BDR Pharmaceuticals International*, 2020 SCC Online Del 1700 and *Avery Dennison Corporation v Controller of Patents and Designs*, 2022/ DHC/ 004697. In *Avery Dennison*, the Court surveyed the Law on inventive step in India, U.S. and U.K. and opined that,
- a. “*The above approaches, tests and steps laid down by various courts and authorities – all seek to formulate the manner in which prior arts are to be analysed and a patent application is to be tested on the anvil of inventive step. None of the above approaches and tests are to be adopted in a straightjacketed manner. Each patent application, depending on the field of technology and the nature of the prior arts may require different approaches or tests to be followed or applied. In some situations, the Court may even adopt an approach of combining more than one test as was done by the UK Supreme Court in Actavis v. ICOS, [2019] UKSC 15. In the ultimate analysis, the examiner in the patent office or the Court adjudicating the issue would need to identify the elements in the prior art and compare the same with the claims in question from the point of view of a person skilled in the art, as was done by the ld. Division Bench of this Court in 3M Innovative Properties Ltd. If the same demonstrates a technical advancement over the prior art on the priority date of the application, then the patent would be liable to be granted. Unlike the test of novelty or anticipation which is easier to determine by a straight comparison with the prior art, in the case of obviousness, the attempt of the Court is conjectural – making it a rather difficult exercise.*”
- b. (emphasis by the authors)
- 32 *Graham et. al. v John Deere Co.* 383 U.S. 1 (S.C., 1966).
- 33 *KSR Intl'n Co. v Teleflex Inc.*, 127 S.Ct. 1727 (2007).
- 34 <https://www.uspto.gov/web/offices/pac/mpep/s2141.html> (assessed on 29 March 2024).
- 35 The Delhi High Court in *Avery Dennison*, *Supra* at 34, has indeed noted in context of TSM test that “*the application of this test ought not to be done in a narrow manner as held by the US Supreme Court in the case of KSR International...*”.
- 36 *Bishwanath Prasad Radhey Shyam v Hindustan Metal Industries* (1979) 2 SCC 511.
- 37 *Bristol-Myers Squibb Holdings v BDR Pharmaceuticals International*, 2020 SCC.
- 38 *Agriboard International LLC v Deputy Controller of Patents and Designs*, 2022:DHC:1206.
- 39 *NHK Spring Co Ltd v Controller of Patents and Designs*, C.A. (Comm. IPD-PAT) 296 of 2022, order dated 08 February 2024.
- 40 *Rhodia Operations v Assistant Controller of Patents and Designs*, 2024: MHC: 6024, Para 21.
- 41 *Novartis AG v Union of India & Ors.*, (2013) 6 SCC 1.
- 42 A Division Bench of Delhi High Court while dealing with interpretation of product-by-process claims in *Vifor (International) Limited & Anr v MSN Laboratories Pvt Ltd & Anr.*, 2024: DHC: 878-DB, held that,
- a. “*J. ... We fail to discern any logic in recognizing distinct tests of novelty being applicable at the stage of patentability and those that may be relevant for deciding a question of infringement. It is pertinent to observe that both at the stage of grant as well as while considering an allegation of infringement the terms and the language of the claim remain unaltered. Claims and specifications do not change hues but remains static. We thus principally find ourselves unable to countenance the submission that separate or distinct tests of novelty should apply between the grant of a patent and the examination of an allegation of infringement.*”
- b. *K. Since the terms and the language of the claim remain unaltered and consistent both at the stage of grant as well as while considering an allegation of infringement, separate or distinct tests of novelty should not apply between the grant of a patent and the evaluation of an infringement allegation...*
- c. *L. There is no justification to hold or recognise the Law to be that while an inventive characteristic of a product sets it apart from the prior art, the same should be disregarded when it comes to infringement analysis. Acceptance of the proposition that the patentability and novelty of a product becoming triable based upon two separate and distinct set of rules would invariably result in the creation of an incongruous and anomalous situation...*”
- Quite naturally the yardstick for determination of inventive step also remains the same both while considering grant of patent and while considering infringement.