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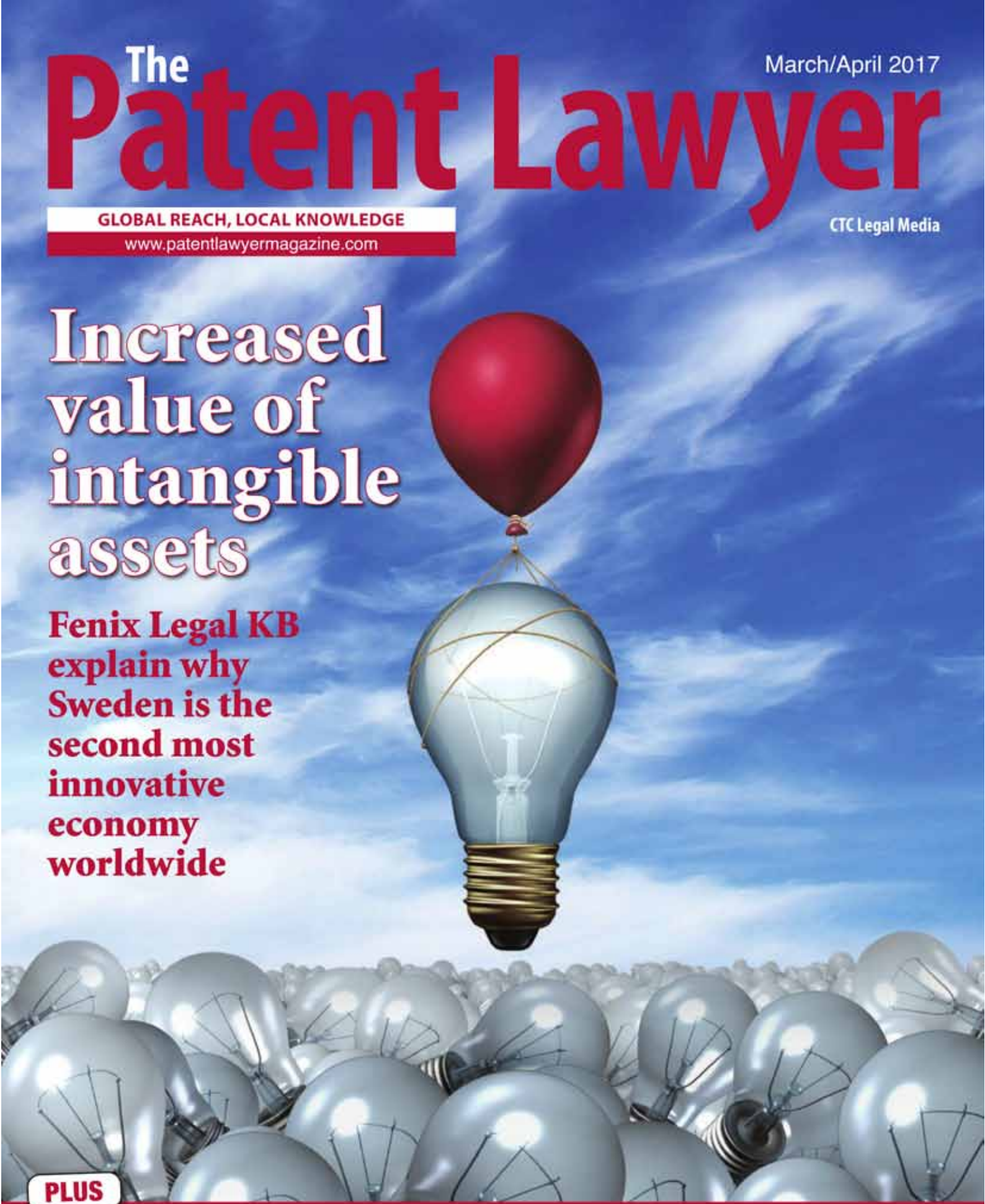

PLUS

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Rajeev Kumar

Pankaj Musyuni

Skilled person for determination of non-obviousness under the Indian patent system

Rajeev Kumar and Pankaj Musyuni from LexOrbis explore the Indian patent system, thinking specifically about the determination of non-obviousness by looking at a selection of past cases as examples.

Patent prosecution plays a crucial role in determining the legitimacy of a patent, and there is a never-ending debate on what exactly comprises an inventive step. More specifically, the question still remains unanswered about the steps for determination of obviousness, even for a person skilled in the art. As per statistics drawn from the decisions rendered by the Indian Patent Office, it appears that lack of inventive step is a major ground for rejection of patent applications. This concept is also important while determining the grounds for invalidating a claim in a patent litigation with a question on the inventive step of the claim.

In 2005, The Indian Patents Act, 1970 (the Act hereinafter) was amended to redefine inventive steps in order to make it consistent with the fundamental principle of patent law. Now, Section 2(1)(a) of the Act defines an 'inventive step' to mean "a feature of an 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". The philosophy behind the doctrine of obviousness emphasized the fact that the invention must not be merely an extension of what is already known to the public and modification or incremental innovation by a person skilled in the art.

Upon reviewing the Act, it appears that the concept of a person skilled in the art is imaginary and not defined. The Manual of Patent Practice and Procedure, and Guidelines for Examination of Patent Applications in the Field of Pharmaceuticals (October 2014) mandates an examiner to search and analyze the concept of obviousness and person skilled in the art with reference to a) common general knowledge in the art at the relevant date; b) average skill; and c) state of the art. While assessing whether an invention is obvious or not, one of the important factors is determining the "person skilled in the art". The Indian tribunals and Courts have provided some interpretations on this aspect.

Judicial interpretation

One of the most famous cases dealing with tests of obviousness was decided by the Hon'ble Supreme Court is *M/s. Bishwanath Prasad Radhey Shyam v. M/s. Hindustan Metel Industries,* wherein the Court clarified the test for "obvious to try" and laid down the following principle:

"Had the document been placed in the hands of a competent draftsman (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 patent invention, would have arrived at the invention."

The Bishwanath case (supra) provided guidance for both aspects, i.e., "obvious to try" and "a competent draftsman endowed with the common general knowledge", i.e., a skilled person in the art. Hence, the obviousness has to be seen through the eyes of a person skilled in the art.

However, as the need was felt to further define the "skilled person in the art", efforts have been made in said direction. At times, the "skilled person in the art" has

Résumés

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been looked as a "skilled worker". In 2010, in *Ideal Cures Private Limited v. M/S. Colorcon Ltd;* ORA/4/2008/PT/DEL; while determining inventive step, the Intellectual Property Appellate Board (IPAB) cited Halsbury Laws of England, indicating "was it for practical purposes obvious to the skilled worker, in the field concerned, …" and also considered such skilled worker to have a non-inventive mind.

However, the qualification of the "skilled person in the art" developed from having 'a non-inventive mind' to 'a person of ordinary creativity' in 2012. The IPAB in *Sankalp Rehabilitation Trust v. F.Hoffmann-La Roche AG;* (OA/8/2009/PT/CH) considered this issue once again and defined a skilled person as follows:

"We must remember that this ordinary man has skill in this art. He is not ignorant of its basics, nor is he ignorant of the activities in the particular field. He is also not ignorant of the demand on this art. "He is just an average man... Well... just an ordinary man." But he is no dullard. He has read the prior art and knows how to proceed in the normal course of research with what he knows of the state of the art. He does not need to by guided along step-by-step. He can work his way through. He reads the prior arts as a whole and allows himself to be taught by what is contained therein. He is neither picking out the" teaching towards passages" like the challenger nor is he seeking out the "teaching away passages" like the defender."

In 2013, *Enercon (India) Limited v. Aloys Wobben;* (ORA/08/2009/PT/CH), the IPAB once again looked at this issue as to who is the person skilled in the art and distinguished between the skill of a person when addressing enablement, and the skill of a person when addressing obviousness. The IPAB clearly directed for not attaching the word "ordinary" with the "skilled person in the art", citing the judgment of *F. Hoffmann-La Roche Ltd & Anr. v. Cipla Ltd.* 2012 (52) PTC 1 (DEL). The IPAB also clarified that "… 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 this hypothetical person? If it makes the obviousness bar a bit higher, we must bear that in mind, for This Is Our Law.", and reconfirmed the definition held in Sankalp (supra).

> *"The philosophy behind the doctrine of obviousness emphasized the fact that the invention must not be merely an extension of what is already known to the public."*

Methodology versus practice

While dealing with the criteria of patentability with respect to the determination of inventive step, the determination of "skilled person in the art" has to be done based on the particular invention and the general state of the art for that field of invention. Further, while determining the person skilled in the art, important issues need to be resolved in terms of level or qualification or skills of the person *vis-à-vis* the nature or scope of knowledge in the concerned field. However, obviousness should be determined with regard to the knowledge of the person skilled in the art in view of the state of the art. The interpretation of 'person skilled in the art' as discussed above appears to have a relevant impact on legal proceedings wherein an invention is rejected for failure to establish an inventive step.

In 2015, in *F. Hoffmann-LA Roche Ltd. & ANR. v. Cipla Ltd.* RFA (OS) Nos. 92/2012 & 103/2012, the Delhi High Court has discussed various judgments for determination of skilled person and determination of inventive step. The patent under consideration in this judgment related to Erlotinib hydrochloride, which is for use in cancer including non-small cell lung cancer (NSLC). The court considered the expert evidence of the defendant and observed that "DW-3 (expert) was not an ordinary person skilled in the art being a professor of the Chemistry and not a medicinal Chemist." The Court also observed that "He had not worked in drug discovery and developmental stages himself and had read about the above aspects in the freely available literature." Although the Court was assessing the expert evidence, these observations can indeed help in determining a skilled person in the art. These

observations indicate that the skilled person, most likely, should be from the same field of invention as to the alleged invention. Also, the specific technology being considered for making the invention should be considered while considering whether a person is suitable for qualifying as skilled person in the art.

Conclusion

It would be unfair if the interpretation of judgment is criticized as the concept is peculiar and very subjective in nature, which is decided on a case by case basis. However, in view of recent developments, it would be interesting to see how the newly recruited Indian examiners will adopt the concept with understanding from the technicality of the subject matter. As in many cases, the Indian courts still have relied on the decisions from the major patent jurisdictions, it would be again interesting to see if asked, how the IPO will clarify the principles to be followed for assessment of inventive step in view of a skilled person in the art.

Indeed, there is need to understand the concept of a person skilled in the art to make the test of non-obviousness more meaningful. The expertise, experience, and skill of the inventors should be taken into account while conducting the determination of test for inventive step in prosecution with the help of declaration or in form of an affidavit by the inventor.

> *"Obviousness should be determined with regard to the knowledge of the person skilled in the art in view of the state of the art."*

While it can be understood that the assessment of a person skilled in the art subjects a rich assessment between the claimed invention and the prior art, various elements such as nature of the skilled person, attributes and personal competencies of the skilled person and knowledge of the skilled person should be carefully examined while analyzing any tests for inventive step.