

PATENT REJECTION BASED ON WHAT IS NOT EXPRESSLY PRESENT IN PRIOR ART

Introduction

Among various requirements of patentability, novelty and non-obviousness/inventive step requirements are judged based on prior art. A claim of a patent application is considered to be novel if the claim is not anticipated by a prior art reference. A prior art reference may make express, implicit and inherent disclosure, which may be used for judging whether the prior art reference anticipates a claim. The article deals with nuances in using inherent disclosure made by a prior art reference to judge whether the prior art reference anticipates a claim.

Inherent disclosure

It is important to recognise what can be considered inherent disclosure to understand how prior can be applied to reject claims based on anticipation. Some of the important forms of inherent disclosure and key considerations while dealing with rejection based on inherent disclosure are listed below.

1. Inherent disclosure of a function by prior art
2. Inherent disclosure of a property or a characteristic by prior art
3. Inherent disclosure of a process by prior art
4. Burden of proof
5. Recognition of inherent disclosure by person of ordinary skill in the art
6. Patent on new use

Inherent disclosure of a function by prior art

A subject matter may have been claimed in terms of its function. A prior art reference may disclose a product, process, composition or an article of manufacture as claimed, while being silent on the claimed function. Such a reference may be considered to be inherently disclosing the claimed function if the natural result flowing from the operation as taught by the reference would result in the performance of the questioned function.

A function is not inherently disclosed by prior art reference if the questioned function may result from optimization of conditions, and not necessarily by what is disclosed by the prior art reference.

As an example, reference is made to the decision laid down in Schering Corp. v. Geneva Pharms. Schering was granted two patents, viz. US4282233 (earlier) and US4659716 (later). US4282233 relates to antihistamine loratadine, an active ingredient of the pharmaceutical drug CLARITIN (Brand name). US4659716 on the other hand relates to a metabolite of loratadine called descarboethoxyloratadine (DCL).

The patent at issue was US4659716. The prior art reference, US4282233, did not expressly disclose DCL or refer to metabolites of loratadine. However, it is a well known fact that the inevitable consequence of administering loratadine is formation of DCL. Hence, some of the claims of US4659716, which covered formation of DCL within the human body, were held to be anticipated by US4282233.

Inherent disclosure of a property or a characteristic by prior art

A claim might recite a property or a characteristic along other limitations. A prior art reference might teach a product or a composition, which is claimed, while not expressly disclosing the property. In such circumstances, the prior art reference may be considered to be inherently disclosing the property. The logic for arriving at such conclusion is that, product/chemical composition and its properties are not separable; hence, if a claimed product and the product taught by the prior art reference are identical, then they must have the same properties, and therefore the prior art reference inherently discloses the property.

As an example, reference is made to the decision laid down in Titanium Metals Corp.v. Banner. In this case, the difference between the claim of a patent application in question and the prior art reference (Russian article) was that the claim recited a property, viz, “good corrosion resistance”, of an alloy, and said property was not expressly disclosed by the prior art reference, but the alloy was disclosed. The court decided against grant of patent even though the property included in the claim was not expressly disclosed by the prior art reference.

From the above case law, it can be concluded that claiming a product which discloses a new property of the prior art product does not constitute the claim novel. The range of titanium, nickel, and molybdenum in the prior art fall within the range disclosed by “The Titanium Metals Corp”. Therefore, it may be construed that the properties of the alloy claimed by “The Titanium Metals Corp” may be inherently present in the alloy disclosed in the Russian article. If the composition of the product in the prior art is similar to the claimed product, it is therefore obvious that the properties of the products will be same.

Inherent disclosure of a process by prior art

A claim might recite process steps, which might have not been expressly disclosed by a prior art reference. However, the prior art reference might have disclosed a device/system, which in its normal and usual operation performs the claimed process steps. In such circumstances, the prior art reference may be considered to be inherently disclosing the claimed process steps.

As an example, In re William J. KING, claims of a patent application were directed to a method of enhancing colour effects produced by ambient light. The corresponding specification disclosed an article of manufacture to carry out the claimed method. The article of manufacture disclosed in the patent application was also taught by a prior art reference (Donley patent), while being silent on some on the process steps of the claim. However, it was held that the prior art reference inherently discloses and anticipates the process steps since the article of manufacture taught by the prior art reference performs the claimed process steps its normal and usual operation.

Burden of proof

A patent examiner using a prior art reference to allege that a limitation of a claim is inherently present in the prior art reference has an initial burden to explain as to why the limitation is inherent in the prior art reference. “The examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art.”

Once the examiner presents reasoning (not necessarily absolute proof; prima facie case suffices) tending to show inherency, the burden shifts to the patent applicant to show that the

subject matter of the prior art reference does not inherently disclose/possess the limitation of the claim under contention.

Recognition of inherent disclosure by person of ordinary skill in the art

A person of ordinary skill in the art need not have recognised the inherent feature of the prior art reference at the time of the invention in order to assert that the prior art reference anticipates a limitation of a claim. Hence, the fact that the limitation of the claim is inherently present in the prior art reference is sufficient to allege that claimed limitation is inherently disclosed in the prior art reference.

Patent on new use

Mere recitation of a newly discovered property of a compound/property/system/process in a claim may be anticipated by a prior reference that inherently discloses the newly discovered property. However, a claim directed to a new use for an old compound / property / system / process based on unknown properties (now discovered) of the old compound / property / system / process might be patentable. It is important that “a new use” does not mean newly recognized result or outcome of a prior art.

As an example, a prior art might disclose an alloy, and the prior art might be silent on the corrosion resistance of the alloy. In case the corrosion resistance of the alloy is later discovered, and a patent application is filed by merely reciting that the alloy is corrosion resistant (newly recognized result or outcome of the prior art), then the claim might be anticipated by prior art. On the other hand, in light of the newly discovered property of corrosion resistance of the alloy, if a new use, such as a process of using the alloy in a high corrosive environment (new use) is claimed, then the claim might not be anticipated by the prior art reference.

Conclusion

Prosecuting patent applications requires thorough understanding of the grounds that can be used by patent examiners for rejecting claims and recourse patent applicants can take to deal with such rejections. Understanding requirements of rejection based on inherency can go a long way in deciding claim drafting strategy and can also be used for challenging validity of asserted claims during litigation.



I hope you found this article helpful.

Please feel free check our [patent services](#) page to find out if we can cater to your patent requirements. You can also [contact us](#) to explore the option of working together.

Best regards – Team InvnTree

This work is licensed under a [Creative Commons Attribution-NonCommercial 3.0 Unported License](#)