

Mosaic of Patent¹

Abstract

This paper deals with non-obviousness requirement of patent to focus promptly on mosaic of patent. Only analogous² art can be used for the inquiry of non-obviousness. The analogous art can only be used for judging non-obviousness, not for judging novelty. The examiner, while patent prosecution, can only argue that an application is obvious if the reference, which made is analogous to the claimed invention.

I. Introduction

Patent is a branch of an umbrella term called as intellectual property. Intellectual property can be any work, which is a creation of human mind that needs expertise of a person to be finished. The creation must be original and fixed into a tangible medium. Patent is a grant, which is given by the government to the holder of an invention to exclude others to make, use, sell, import and offer to sell the invention. Simply putting, invention means a new product or a process which involves an inventive step, (also known as non-obviousness), and capable of industrial application, (also known as utility of an invention). Therefore we can divide the prerequisite of patent into three parts:

1. New or Novel: The invention must be apparently different from publicly known product or process (also known as “prior art”). This statement does not mean that each and every aspect of the invention must be new or novel. New uses of known substance are patentable. Incremental improvements in product or process can also be patentable.
2. Inventive Step or Non-Obviousness: The product or process should not be known or obvious to a person “ordinarily skilled” in that art. The claimed invention should have shown some unexpected or unusual result. Or in other words we can say that results which are new and original to that field.

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² Analogous means similar or equivalent.

3. **Industrial Application or Utility:** It means that the claimed product or a process for patent should have some industrial use or capable or being used in an industry. Simply putting the claimed invention can be used in industry or has capability for being used in an industry.

If these three criteria are furnished then a claimed invention can be patented. The reason behind these three tests is to develop the ideas and encourage experimentation in the field. Furthermore it gives recognition and security to creator or inventor. The patent gives conditional monopoly to the patent holder. Patent is a liberty, not a power. It gives right to make, use, sell, import and offers to sell the invention to patent holder but at the same time it also empowers government to issue a compulsory license. This license is like a check and balance over patentee's monopoly. Moreover government may impose such conditions as it deems fit. That is why this monopoly is not absolute, it is restrictive in nature.

The inventor has to face the opposition (if opposed) also. Here mosaic plays a very crucial role. The applicant for opposition trial forms prior art reference from multiple sources of same or different field. These sources may have nothing to do with the claimed invention or its field, yet they were put to form a prior art. Later, courts decided that the reference forming prior art or part of prior art should be from single source of same field.

II. In re Klein: Explaining Mosaic

In a recent case of *In re Klein*³ the Court of Appeal for the Federal Circuit (CAFC) held that a prior art reference is analogous only if it addresses the entire problem solved by the patent at issue.

In rejecting Klein's application, the Patent Office made five separate obviousness rejections, each relying on one of five cited prior art references. The Patent Office concluded that the cited references were citable as they were reasonably pertinent to the problem addressed by Klein. Klein argued that the obviousness rejections were improper, because none of the five cited references were analogous art to the claimed invention.

The CAFC then considered if any of the five cited prior art references were analogous to the claimed invention. Two separate tests define the scope of analogous citable prior art:

³ 98 USPQ2d 1991

1. Whether the art is from the same field of endeavor, regardless of the problem addressed; and
2. If the reference is not within the field of the inventor's endeavour, whether the reference is still reasonably pertinent to the particular problem with which the inventor is involved.

Under the second test, a reference may be reasonably pertinent if it "logically would have commended itself to an inventor's attention in considering his problem;" for example if it has the same purpose as the claimed invention and relates to the same problem.

In re Klein illustrates that identifying a problem to be solved by an invention may help to exclude art references as being non-analogous. However, applicants should take note that too narrow a "problem" may limit the claim scope and restrict access to the doctrine of equivalents.⁴

When considering whether a patent claim is obvious, a trier of fact will determine the scope and content of the prior art.⁵ An inventor is charged with "full knowledge. of the prior art in the field of his endeavor . . . and knowledge from those arts . . . reasonably pertinent to his particular problem."⁶

However, not all art is considered in making a determination of obviousness. The doctrine of analogous art may be used to demonstrate that prior art relates to an entirely different field.⁷ This diversion is known as mosaic of patent where the prior art is collected from different fields other than of the invention or same but having different references. Law allows that the reference should be a single prior art otherwise it is impossible for an inventor to check the entire prior art reference in every field. Under those circumstances, an inventor cannot be charged with that field's knowledge, and may overcome an assertion that the subject matter of the patent claim is obvious, and hence, unpatentable.⁸ Technically, all public knowledge, by definition, is available

⁴ <http://www.bereskinparr.com/Article/id27/?srch=Kevin%20Shiple>

⁵ *Graham v. John Deere Co.*, 383 U.S. 1 (1966). The Graham court cited other factors in determining obviousness: differences between the prior art and the claims at issue, the level of ordinary skill in the pertinent art, commercial success, long felt but unsolved needs, and failure of others.

⁶ *In re Antle*, 444 F.2d 1168, 1171-72, 170 U.S.P.Q. 285, 287-88 (C.C.P.A. 1971).

⁷ See Ronald B. Hildreth, *Patent Law: A Practitioner's Guide* 96 (1988).

⁸ See *In re Pagliaro*, 657 F.2d 1219, 1224-25, 210 U.S.P.Q. 888, 892 (C.C.P.A. 1981) (cited reference not considered as it did not relate to the inventor's problem or field of endeavor).

to an inventor.⁹ Mosaic of patent recognizes that to expect a party to be aware of every teaching in every art is unrealistic.¹⁰ It is an attempt to readjust an obviousness analysis to reflect that reality. The relevance of certain prior art is not denied; for public policy reasons, an inventor is just not charged with certain knowledge. This doctrine was introduced by the United States Supreme Court in 1895.¹¹ In Potts the Court stated that "if the relations between two uses is remote, and especially if the use of old devices produced a new result, it may at least involve an exercise of inventive faculty."

In summary, a court must first define the inventor's field of endeavor. Full knowledge by the inventor of all prior art in the field of his endeavor is presumed.¹² If the reference falls within this defined field, the reference is analogous. If not, a court must then define the problem that the inventor addressed. A reference is reasonably pertinent to the problem the invention attempts to solve if both the inventor and the cited reference have the same aim.

Statutory Recognition

Section 103 of U.S Patent Law recognizes requirement of non-obviousness. The US courts have given decision on Mosaic of patent under the heading of section 103. Indian Patent Act, 1970 also talks about non-obviousness as inventive step under section 2 (1) (ja). Indian patent Act is in fragments. For complete understanding of the concept non-obviousness, it is mandatory to read the relevant provision with the definition and Interpretation clause of the Act i.e. Section 2. Further Chapter VI of Indian Patent Act, 1970 that deals with anticipation based on doctrine of analogous art. The whole reading of this chapter clarifies the doubt that the reference should be a single prior art reference by any enumerated means.

⁹ See *Geo. J. Meyer Mfg. Co. v. San Marino Elec. Corp.*, 422 F.2d 1285, 1288, 165 U.S.P.Q. 23, 25-26 (9th Cir.1970) (reasoning existence of modern overlapping fields requires broad interpretation of what constitutes available knowledge).

¹⁰ *Union Carbide Corp. v. American Can Co.*, 724 F.2d 1567, 1572, 220 U.S.P.Q. 584, 588 (Fed.Cir.1984); *In re Pagliaro*, 657 F.2d 1219, 1224, 210 U.S.P.Q. 888, 892 (C.C.P.A. 1981); *In re Wood*, 599 F.2d 1032, 1036, 202 U.S.P.Q. 171, 174 (C.C.P.A. 1979).

¹¹ See *Potts v. Craeger*, 155 U.S. 597, 602-03 (1895) (holding revolving cylinder used for disintegration was not analogous to cylinders used for crushing or grinding).

¹² *In re Antle*, 444 F.2d 1168, 1171-72, 170 U.S.P.Q. 285, 287-88 (C.C.P.A. 1971).

Conclusion

With this understanding, it can be concluded that mosaic of patent encourages and supports single prior art reference and discourages different sources of prior art as providing proof for non-obviousness. Different sources can be taken into account only when these sources directly or ultimately relates or effects to the claims of a patent application but not otherwise. Further, the references should be in a series. It should not be fragmented references. Every prior art reference should have nexus with the other reference and reference as a whole should have nexus ultimately to the claims. Burden of proof lay on the opponent to prove that the reference produced is a single prior art or otherwise relate to the claims. This doctrine, somehow, protects the applicant from unnecessary oppositions and prior art teachings that can be confused with prior art references. Therefore, it will be apt to say that **mosaic of patent is like a weapon in the hands of applicant at the time of trial of opposition.** (its weapon in the hand of person opposing)