

QUESTION 180

Content and relevance of industrial applicability and/or utility as requirements for patentability

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Q180

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Content and relevance of industrial applicability and/or utility as requirements for patentability

AIPPI

Noting that:

- a) Article 27 TRIPS provides that, subject to certain exceptions, patents shall be available for any invention, whether product or process, in all fields of technology, provided that it is new, involves an inventive step and is capable of industrial application.
- b) According to the footnote relating to Article 27 TRIPS, for the purpose of said article, the term “capable of industrial application” may be deemed by a Member State to be synonymous with the term “useful”.
- c) The Draft SPLT which is currently under discussion at the WIPO contains a provision in Article 12(4) which deals with industrial applicability and/or utility as a third condition of patentability besides novelty and non obviousness.

Considering that:

- d) In its Resolution Q170, which relates to SPLT, the AIPPI reiterated the opinion that it is in the users' interest to adopt a harmonisation treaty on at least some substantive patent aspects at the earliest possible date. Accordingly, it decided to reserve for future discussions, leading to “SPLT2”, the most difficult issues among which is Article 12(4) relating to the third requirement for patentability.
- e) Industrial applicability and utility are not synonymous, although they have some similarities. In particular, industrial applicability and utility are similar in that, in most countries, both criteria exclude the patentability of:
 - abstract concepts, such as unapplied ideas, theories and laws of nature per se;
 - inventions contrary to the laws of nature (e.g. perpetual motion machines);
 - inventions which do not provide the effects or results disclosed in the patent.
- f) The specific feature of the utility criterion lies in the fact that it requires that the invention provides a benefit to the public, which, for example, excludes from patentability a product having no specific, substantial and credible use (while such a product would meet the requirement of industrial application provided it can be manufactured by industry).

- g) In most countries, the specific feature of industrial applicability lies in the fact that it excludes from patentability inventions which can be made and used only in the private or non commercial sphere (like a contraceptive method which can be used only in the private sphere).
- h) In most countries, there are further patentability exclusions or requirements which may result from industrial application or utility requirements, such as:
 - patentability exclusions for fine arts creations or purely ornamental creations;
 - patentability exclusions for inventions contrary to morality or public policy;
 - patentability exclusions for methods for treatment of the human body by surgery or therapy and diagnostic methods practiced on the human or animal body;
 - the requirement of a technical content.
- i) In some countries, the effects of the industrial applicability or utility requirements and the effects of other requirements such as inventive step or sufficiency of disclosure may overlap to a large extent.
- j) In its Resolution Q158, which relates to patentability of business methods, the AIPPI resolved that “Inventions [...] should be entitled to patent protection provided that the invention as defined in the claims has a technical content”.

Notes that:

- 1) There is a need for a harmonized patentability criterion in addition to novelty and inventive step and in replacement of industrial applicability and utility.
- 2) This criterion will be a factor in distinguishing patentable subject matter from non-patentable subject matter.
- 3) This criterion should relate to the applicability of an invention, such as to exclude, for example, abstract ideas, and should not relate to the field of application of the invention.
- 4) The term “practical applicability” may be appropriate to designate this criterion.
- 5) This criterion should not be construed to introduce new patentability requirements which do not exist under the concepts of industrial applicability or utility.
- 6) This criterion is not intended to address any requirement of technical content.
- 7) This criterion should not embrace exclusions based on morality, public order, ethics or the like. Where a country wants to exclude certain subject matter from patentability for such reasons, this should not be done by applying this criterion.

Further studies of AIPPI:

AIPPI should conduct further studies to attempt to further define the content of this criterion.

Resolution



Question Q180

Content and relevance of industrial applicability and/or utility as requirements for patentability

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Q180

AIPPI

Considering that:

Article 27 TRIPS provides that, subject to certain exceptions, patents shall be available for any invention, whether product or process, in all fields of technology, provided that it is new, involves an inventive step and is capable of industrial application.

According to the footnote relating to Article 27 TRIPS, for the purpose of said article, the term “*capable of industrial application*” may be deemed by a Member State to be synonymous with the term “*useful*”.

The Draft SPLT under discussion at the WIPO contains a provision in Article 12(4) which deals with industrial applicability and/or utility as a third criterion of patentability besides novelty and non obviousness.

In its Resolution Q170, which relates to SPLT, the AIPPI reiterated the opinion that it is in the users’ interest to adopt a harmonisation treaty on at least some substantive patent aspects at the earliest possible date. Accordingly, it decided to reserve for future discussions, leading to “SPLT2”, the most difficult issues among which is Article 12(4) relating to the third criterion for patentability.

With Q180, AIPPI decided to consider more thoroughly the similarities and differences of the two current criteria and to study whether it is possible to find a third harmonized criterion.

The Geneva Resolution of 2004 confirmed the need for a third harmonized criterion, set some guidelines and concluded that further studies should be conducted for the purpose of defining the content of said third harmonized criterion.

The Executive Committee in Berlin in 2005 confirmed the possibility and the advantages of a third harmonized criterion.

According to the replies to the questionnaire circulated before the Gothenburg Congress of 2006, inventions without any use are not patentable, but not always on the same ground.

Noting that:

The third criterion at issue is not intended to address any requirement of technical content, or any patentability exclusions based on morality, public order, ethics or the like which may be defined by each country independently from said criterion.

Further studies should be conducted regarding the definition of patent eligible inventions, including the question of technical content.

Resolves:

- 1) Both in patent systems applying the utility criterion and in those applying the industrial applicability criterion, an invention without any use should not be patentable.
- 2) The subject matter of a claim is both useful and industrially applicable if at least one use would be understood by a skilled person in light of the specification at the filing (or priority) date.
- 3) As a result of sections 1) and 2), the third criterion should be based on use.