

CLARITY, NOVELTY AND INVENTIVENESS: KEYS TO PATENTABILITY

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To obtain patent protection, patent owners are obligated to publicly disclose certain information about the invention. The specification must be explicitly disclosed in a manner sufficiently clear and complete in order to enable a person skilled in the art to understand how to implement and carry out the invention.

In 1999, Thai patent application No. 048605 was filed with the Thai Patent Office by a researcher at Chulalongkorn University. The application covered the process of manufacturing a product from *Butea superba* for food, beverage, medicament, and/or cosmetics for male sexual malfunction and therapeutic pharmaceuticals for erectile dysfunction. *Butea superba* Roxb. (also known as Red Kwao Krua) is a plant in the family of Leguminosae (Papilionaceae) growing in mixed deciduous forest in Thailand and

Myanmar. For more than a hundred years, the herb Kwao Krua has been mainly known for its cosmetic and revitalizing qualities. It has also recently come to be known and promoted as the "Herbal" or "Natural" Viagra because of its positive effects on male sexual capabilities.

During the pre-grant opposition period, one of our clients filed an opposition on the basis that the patent lacked novelty and did not include an inventive step or sufficient disclosure. In addition, Mathana Phanit Chiangmai Co., Ltd. filed another opposition against the registration of this invention on the same basis. In considering the opposition, the Director-General of the Department of Intellectual Property ruled that the application had novelty and an inventive step on the grounds of

calcium addition and the heating method for toxicity reduction. The opposition was thus rejected.

The opponents then filed an appeal petition with the Board of Patents, which dismissed the Director-General's decision on December 13, 2006.

The Board considered that the scope of the rights of a patented invention shall be determined by the claims, while the characteristics of the invention are indicated in the description and the drawings, which are employed to resolve any ambiguity found in the claims.

Claim 1 of the application states that "*the manufacturing process of Butea superba product which is improved from the*

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prior patent (patent application No. 046779, application date October 27, 1998) wherein 0.1-90 w/w% or v/v% of the synthetic calcium, for example, calcium bicarbonate or other edible calcium composition or calcium derived from plant or animal is added." Thai patent application No. 046779, also filed by the same applicant, discloses a heating method for toxicity reduction.

The problem was that the subject application referred to a prior application without disclosing and describing the heating method explicitly in its claims. Therefore, the scope of the application

was only focused on the addition of calcium.

In the absence of more detailed information, the Board considered that the process of adding calcium to pharmacopeia has already been used as a vehicle as well as a pharmaceutical composition for the pharmacopoeia of *Butea superba*. For instance, evidence of the prior art of Kwao Krua published in the Thai medical literature has been uncovered dating back to 1931. Moreover, the method of toxicity reduction referred to in the application is the traditional method used for Thai herbs from time immemorial. Therefore, the Board

considered that the invention was known and obvious to a person ordinarily skilled in the subject. Neither novelty nor an inventive step was present in the application. In addition, the application did not contain a detailed description of the invention in such full, concise and clear, and exact terms as to enable any person ordinarily skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the invention. As such, the Board of Patents held that the invention was not patentable. ♦