Chapter 6
Exclusions on Patentability:
A Study

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ABSTRACT

Exclusion of patentability finds its justification in philanthropy and public welfare. Time and again this approach has been endorsed and upheld by the eminent jurists. However, the “US Supreme Court in the case of Diamond v. Chakrabarty” endorsed a controversial view holding that “anything under the sun made by man” is patentable, but the situation was however rectified subsequently in “Diamond v. Dier.” The Boards have gone a step forward in being very selective while granting patents excluding “Plant and Animal varieties” and also other immoral procedures, for example the process of cloning human beings etc. from the scope of patentability. The chapter will take up the study relating to the provisions of exclusions in patentability in international and national regime. The chapter will further highlight the emerging grey areas on the exclusions of patentability.

DEVELOPMENT OF EXCLUSIONS

The exclusions pertaining to subject matter patentability has an interminable tale to narrate. It goes way back to 1844 where the French law excluded the pharmaceutical compositions of a kind and also the schemes relating to credit and finance from the scope of patentability. Following the trail, In August 1852, the Austrian law excluded
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‘methods of food preparations, “beverages, and medicines”, scientific principles or purely scientific theorems, inventions or improvements”, and discoveries, for the reason of being antithetical to the interest of the state in compliance with the existing regulations or in conflict with Public health, morals or safety. Later in 1864 Article 6 of the Italian Patent law further strengthened this position.

In the common-law countries, a very general criteria for patentability was being followed, with regard to the “manner of new manufacture”, pertaining to the scope of patentability. This had originated from the famous “Statute of Monopolies of 1623”, which was one of the first acts relating to patents in the world. Through the years, statutes of monopoly have been interpreted in such a way that patents which are inconvenient or are opposed to public policy were specifically excluded from the scope of patentability.

The “United States of America” had deviated from the above stated general rule by advocating marginally a different model for a while but again confined itself to the general prevailing principle. “The Patent Act of 1793”, had marginally deviated from the “Patent Act of 1870”by offering patents to “any person who has invented or discovered any new and useful art, machine, manufacture or composition of matter, or any new and useful improvement thereof…” By assuring its general compliance with the prevailing principle, it has particularly excluded aspects of the “natural world”, “discoveries”, “unembodied inventions”, “handiwork of nature”, “medical inventions, and business methods.” This view also found support by the judicial pronouncements as the “US Supreme Court” had vouched this view in its 2010 Bilski decision. (Bently et al., n. d.).

Now according to Bently et al. (n. d.). It has become a more like a tradition in the United States to restrict to the three basic exclusions, namely:

- “Laws of Nature”
- “Physical phenomena”
- “Abstract Ideas”

In 2006, in “Lab Corp v. Metabolite”, the US Supreme court rejected the grant of patent to an invention by stating that, “the patent was simply an attempt to gain a monopoly over a law of Nature”. Later, in 2007 the “Federal circuit court in the case of re Comiskey”, the court found that “a purely mental process was outside the scope of patentability”.

The exclusion of the above stated group of inventions had found justification in the rulings of courts primarily on two lines of reasoning that reinforces the policy intents of “promoting the progress of useful arts.”
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