

Patentable subject matter in New Zealand: new uses or combinations of known technology

JAMES & WELLS
**CHAMPIONS
OF INNOVATION.**

As is understood by most patentees and patent applicants, for a product or process to be patentable it must be novel and have an inventive feature. A product/process is only considered novel if it contains a feature not previously known to the public, and a product/process is considered inventive if it provides non-obvious advantages over similar technology.

Therefore, when a product or process is developed that uses components or steps which are previously known, it is often dismissed as being unpatentable. However, under certain circumstances some aspects of a known product or process can be patented. This information sheet explores three ways such protection can be obtained.

Selection invention

A selection invention is one where the invention is based on the discovery that one or more members of a class of known items (usually a smaller subset or range) have some special advantage over other items in the same class when used for a particular purpose.

Many chemical patents are selection inventions. By selecting and identifying a ratio or range of key compounds in a composition which make the composition perform unexpectedly well, patent protection can be obtained.

But simply knowing what works well is not enough. The inventor needs to be able to

demonstrate the boundaries of what works and what does not work with experimental evidence. This information is required not only to support the claim to a selection invention in the patent, but also to prompt the inventor to consider other potentially useful materials or parameters. This may lead to broadening the inventive parameters or to greater improvements in the selection.

New combinations

Merely putting two known components, processes or products together where each performs its own function independently of the other is not patentable. However, if it can be shown that a synergy exists between the constituent parts, or that combining them produces a new or unexpected result, then the combination can be patentable.

New combinations are often patented in the chemistry field. For example, a potentially patentable combination could be an anti-cancer agent combined with aspirin (an analgesic known to relieve minor aches and pains which also has an anti-platelet effect for prevention of blood clots) if the combination reduces the size of a solid cancer tumour while the aspirin unexpectedly prevents drug side effects associated with the anti-cancer agent.

Again, experimental tests are required to prove that the combination is more effective than the individual components separately.

Second medical use

The second medical use of a known compound may also be patentable. That is, if it is found during research that a known drug is also effective against a second condition, then it is possible to patent the drug for use in preparations designed to treat that second condition. Using the previous example of aspirin above, a second medical use of aspirin was held patentable for its use as an anti-clotting agent when administered in low doses (in addition to its known analgesic properties).

Conclusion

When a new product or process is developed that uses something which is previously known, it should not be immediately dismissed as unpatentable. This information sheet has identified some examples of ways in which such improvements may be protected.

Our IP professionals can assist you in determining whether your new product or process is capable of protection and if so the best way to go about seeking protection. It is essential that you speak to us to maximise your available options prior to disclosure.

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