

The PATENTS ACT, 1970 (As amended)
Section 15

In the matter of an Application for Patent
Number **4668/DELNP/2007** filed on **18/06/2007**
Applicant: **Standard Innovation Corporation**

DECISION

This application was examined and First Examination Report (FER) was issued on 04th April 2014. Agents to the applicant had filed reply to FER on 18th March 2015. On consideration of the reply filed for the FER objections, further outstanding objections as given below found.

In accordance with Section 14, before proceeding to dispose of the application in accordance with the provisions hereinafter appearing in Section 15, and on request from applicant for being given an opportunity to be officially heard by the Controller before any adverse order on the application is passed.

Accordingly, a hearing was fixed on 06th April 2017 at 11:00 AM under section 14 of the Act with regard to the following objection:

Outstanding objections remaining as follows:

Objection 1:

Para 1 objection of FER is not met.

The subject matter claimed in the instant application relates to "sexual stimulating vibrator" and its intended use or commercial exploitation could be contrary to "public order" or "morality" and falls under section 3(b) of the Patents Act (as amended) and is not allowable. Importing and selling sex toys, considered as an 'obscene' object and hence illegal in India. Under Section 292 of the Indian Penal Code which defines the term 'obscene' and provides for punishment for distributing any such object. Section 292 (1) defines 'obscene' as follows: "a book, pamphlet, paper, writing, drawing, painting, representation, figure or any other object, shall be deemed to be obscene if it is lascivious or appeals to the prurient interest. Offences are punishable by a maximum of two years for the first conviction and five years in the event of a second or subsequent conviction. What is 'obscene'? Now the question is whether or not a sex toy is an 'obscene' object. The dictionary meaning of 'obscene' is "dealing with sexual matters in an offensive or disgusting way by accepted standards of morality and decency". Obscenity and law In the legal context, 'obscurity' is used to describe expressions which offend the prevalent standards of public decency and morality. The Supreme Court has attempted to devise a test for this. Accordingly, every Judge is required to examine whether the matter is so gross and its obscenity is so decided that it is likely to deprave or corrupt those whose minds are open to influence of this sort and into whose hands the matter is likely to fall. In doing so, the Judge should factor in the overall view of the

obscene matter in the setting of the whole work, interests of society, influence of the obscene matter, contemporary mores and standards and preponderating social purpose of the obscene matter. (Ajay Goswami vs Union of India, 2007 (1) SCC 143; Samaresh Bose v. Amal Mitra, (1985) 4 SCC 289; K.A. Abbas v. Union of India, (1970) 2 SCC 780) Further the Article 377 bans any sort of sexual intercourse that is termed to be unnatural biologically. Therefore sex toys (sexual stimulation device), also known as adult toys are banned on the premises that they lead to obscenity and moral deprivation of individuals. These are toys that are not considered useful or productive. Mostly these are considered to be morally degrading by the law. The law views sex toys negatively and has never engaged positively with the notion of sexual pleasure. The instant application's corresponding Japanese national phase Application for patent no. 2007-545799 is refused on the ground of affecting public order and morality as follows "It means that a woman uses the invention concerning the Claims 1-18 of an application concerned for either the object for autoerotism assistance or sexual intercourse, sexuality is stimulated in vain, and being a thing with a possibility that it may be used as the ** implement which produces ** of abuse, or a self-** implement is admitted. Therefore, an invention concerning Claims 1-18 of an application concerned is an invention with a possibility of injuring health of public order, good customs, or the public. Regulation of Article 32 of Japanese Patent Law cannot receive a patent."

Objection 2:

Para 3 objection of FER is still not met.

Reference is made to the following documents; the numbering will be adhered to in the rest of the procedure. D1-EP 1477149 A1 (= US2004/230093 A1 cited in the description), D2 - US 2004/186344 A1, D3-US 6183426 B1, D4-US 5690603 A. Novelty and inventive step. The problem with the present invention is the fact that its distinguishing features depend on relative dimensions, i.e. they depend on the anatomy of the users. Especially the device of D1 appears to be suitable for the purpose mentioned in claim 1: The distal end (5) is destined to stimulate the G-spot (see abstract) just like the tear-drop shaped pad (2) of the present application (see description p. 4, I. 13-16). Although the connection (8) in D1 is of a thickness similar to the one of the inner and outer arms it may still fulfil the requirements of the characterising portion of claim 1 depending on the anatomy of the users. This also applies to the devices known from D2 and D4 (col. 3, I. 57-61). The device of D4 even has a narrow connection portion (26,128,228). Consequently, the subject-matter of claim 1 is not novel in respect of D1, D2 and D4.

Objection 3:

Claim 2: The inner and outer arms (1) do not taper from their extremity to the connecting portion (3), since their largest dimensions are somewhere in the middle of each of the arms. This especially applies to the embodiments shown in figs. 1-10 (for the inner arm) and 4-10 (for the outer arm). For the embodiment of figs. 1-5 this feature only applies to the outer arm for the cross section as shown in fig. 3. In fig. 4 it is clearly visible that the outer arms first widens from its extremity towards the connection portion and then narrows. Thus, although this feature has been disclosed for the outer arm, it does not apply to any of the arms of the embodiments in all directions.

Objection 4:

The characterising portion attempts to define the subject-matter in terms of the result to be achieved. In this instance, however, such a formulation is not allowable because it appears possible to define the subject-matter in more concrete terms, viz. in terms of how the effect is to be achieved. The tapering of both arms toward the connection portion and the narrow connection portion (p.4, L.26-28) contribute towards the result as defined in the characterising portion. It seems that an amended claim with the additional technical features needed to obtain the defined result while observing the objection raised in respect of claim 2 could meet the requirements of novelty and inventive step. These features are not known in combination from D1 (no tapering, only slightly thinner connection portion), D2 (no tapering, no thin connection portion) and D4 (tapering inner arm, thin connection portion, no tapering of outer arm).

Objection 5:

The complete specification i.e. description, drawings and claims have been amended to a larger extent and is difficult to determine the scope of amended specification with that of original disclosure filed. Therefore the scope of amendments with respect to the original disclosure should be explained properly and the amendments carried out should be indicated and to be shown as separate marked up copy. Also no form 13 filed for the voluntary amendments carried out.

Applicant or applicant's agent neither appeared for the hearing on the scheduled date nor filed any written submission in response to the hearing notice. Therefore, in view of the outstanding objections as above, this application no. 4668/DELNP/2007 is hereby refused under section 15 of the Patents Act.

Dated this 17th April 2017

(M. BUCHI BABU)
Assistant Controller of Patents & Designs