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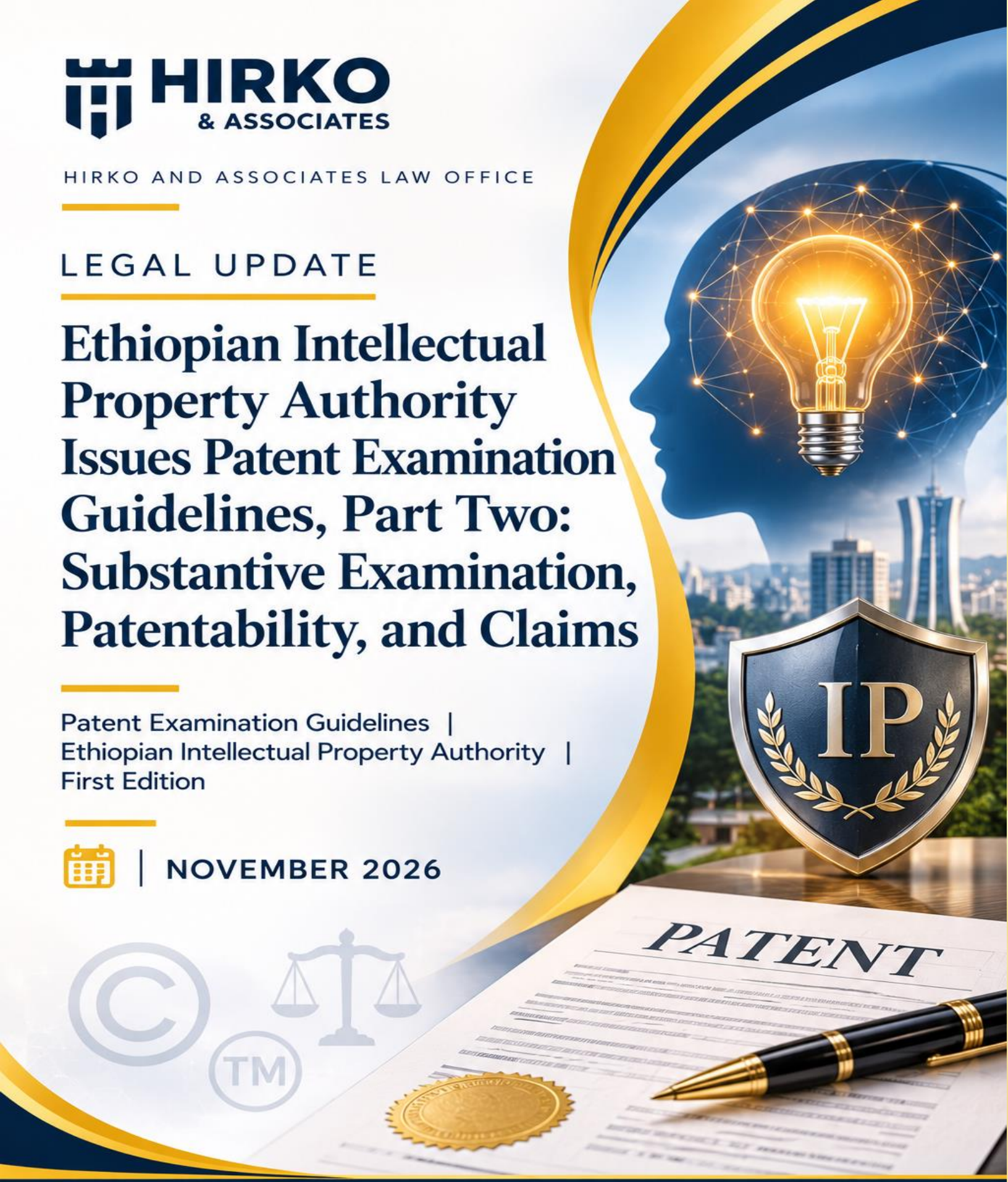
HIRKO AND ASSOCIATES LAW OFFICE

LEGAL UPDATE

Ethiopian Intellectual Property Authority Issues Patent Examination Guidelines, Part Two: Substantive Examination, Patentability, and Claims

Patent Examination Guidelines | Ethiopian Intellectual Property Authority | First Edition

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1. Introduction

This is the second of a three-part series on the Patent Examination Guidelines issued by the Ethiopian Intellectual Property Authority. Part One examined the role of patents, the filing process, and formality examination. Part Two examines the search and substantive examination of patent applications, the criteria of patentability, the categories of non-patentable inventions, and the rules on claims, unity of invention, and double patenting.

The substantive stage is where the scope of protection is determined and where the quality of the patent grant is secured. The Guidelines are detailed at this stage. They describe the search methodology, the tests for novelty and inventive step, the exclusions from patentability, and the drafting requirements for claims. For applicants and their advisers, this is the part of the Guidelines that most directly shapes the prospects of a successful grant.

2. Search and Substantive Examination

The purpose of search and substantive examination is to ensure that the application satisfies the requirements of patentability. The examiner searches for a prior art document that closely relates to the subject matter of the application, or for a conflicting document that may lead to double patenting, and determines whether the subject matter is novel and involves an inventive step. The search is carried out in patent documents of various countries, supplemented by non-patent literature. The total collection of documents is referred to as the search file.

During substantive examination the application is classified, a search for prior art is performed, and the invention is examined to ensure that it does not fall under subject matter excluded from patentability, that it is new, that it involves an inventive step, and that it is industrially applicable. The examination also ensures that the application has been sufficiently disclosed and that the claims are concise and supported by the description.

The Guidelines state that the search is made on the basis of the claims, with due regard to the description and drawings. The examiner ascertains the technical solution presented in the independent claim as the subject of the search, followed by a search for the further technical solutions provided by the dependent claims. Where the subject matter of the independent claim is a combination of elements X, Y, and Z, the examiner searches on the combination X + Y + Z, and where no relevant document is found, the examiner searches further on the combinations X + Y, X + Z, and Y + Z.

The searchable documents include applications filed with the Authority before the priority date or filing date of the examined application and laid open to public inspection, published patent documents of various countries in electronic form, and non-patent literature including scientific journals, technological and other books, periodicals, and manuals. The search is conducted using the International Patent Classification and computer searchable databases. The Guidelines also state that the Authority shall, to the maximum extent practicable, use the previous work results of corresponding foreign patent applications, in particular with the European Patent Office, as well as other intellectual property offices and documents of related applications furnished by the applicant.

The applicant is informed of the findings of the search by way of an examiner's report, which sets out a list of the documents located during the search and the claims that should be compared with each of those documents. The report may also indicate the scope of the search, including the type of documents searched, the time span covered, and the specific areas of technology searched. The search does not extend to disclosures other than publications, and in particular does not seek to determine whether disclosure has taken place by public use.

3. Patentability of Inventions

An invention must meet several criteria to be eligible for patent protection. These are that the invention must consist of patentable subject matter, that it must be new, that it must exhibit a sufficient inventive step, that it must be industrially applicable, and that the disclosure in the application must meet the required standards. The Guidelines describe each of these criteria in detail.

3.1 Novelty

An invention is considered to be new if it does not form part of the state of the art, that is, everything made available to the public by means of publication or oral description, by use, or in any other way before the date of filing or the priority date. Publication in tangible form requires a physical carrier for the information and that the document has been made available to the public. Publications include issued patents or published patent applications, writings, pictures, recordings, and publications on the Internet.

A patent application should be filed before the invention has been disclosed to the public, otherwise the disclosure becomes part of the prior art. However, there are two conditions in which material disclosed within twelve months preceding the filing date or priority date is not taken into account when assessing novelty. The first is where the information was obtained unlawfully or disclosed as a result of a breach of confidence. The second is where the disclosure occurred due to the invention being displayed at an exhibition, which may be international, regional, or national. The applicant may request in writing that such disclosures be disregarded, and where the disclosure was made at

an exhibition, a duly authenticated certificate issued by the authority responsible for the exhibition must be filed.

The Guidelines state the principles applied in determining novelty. An invention is considered new if it is not anticipated by prior art. A prior art is considered anticipatory if all the essential technical features of the invention under examination are present in the selected closest prior art. Prior disclosure can be implicit or explicit, but simple collocation or arrangement or listing of technical features may not destroy novelty. Generic disclosure does not usually take away the novelty of a specific work falling within the terms of that disclosure, but a specific disclosure does take away the novelty of a generic claim embracing that disclosure.

The procedure to determine novelty requires two distinct steps. First, the current state of technology must be assessed as a basis for comparison, and the closest prior art must be determined. Second, the examiner must identify which document among those identified as closest prior art actually anticipates the claimed invention. The standard of anticipation is precise and strict: each and every technical feature in the claimed invention must be disclosed in a single prior art document, and the disclosure must enable a person skilled in the art to make the anticipating subject matter.

3.2 Inventive Step

Once the invention is examined for novelty, the next step is to ascertain whether it meets the criterion of inventive step or non-obviousness. Inventive step measures the level of technical advancement that deserves the grant of a patent. Even if an invention is novel and has industrial utility, it does not deserve a patent if it is a mere or trivial continuation of past work. There must be an outstanding leap forward.

Novelty and inventive step are different criteria. Novelty exists if there is any difference between the invention and the prior art. The expression inventive step conveys the idea that it is not enough that the claimed invention is new, but that the difference must be inventive and must be a step, that is, it must be noticeable. An invention is considered as involving an inventive step if, taking into consideration the state of the art, it is not obvious to a person having ordinary skill in the art.

The Guidelines adopt the problem-solution approach developed by the European Patent Office. The approach consists of three steps: determining the closest prior art, determining the objective technical problem to be solved, and determining the non-obviousness of the claimed solution in regard to the prior art. When using the approach, the examiner identifies the closest prior art, determines the distinguishing technical features and the technical effects they achieve, formulates the technical problem to be solved by those distinguishing features, and then considers whether the claimed invention, starting from the closest prior art and the objective technical problem, would have been obvious to the skilled person.

The relevant prior art for inventive step is generally the same as that for novelty, but in contrast to the novelty requirement of using a single document as the anticipatory document, multiple prior art disclosures can be combined to check whether the invention possesses inventive step from the perspective of the person skilled in the art.

3.3 Industrial Applicability

An invention must be capable of industrial application. This reflects the view that patent protection should not be available for purely abstract intellectual creations. If the invention is intended to be a product or part of a product, it should be possible to make that product; if it is intended to be a process or part of a process, it should be possible to carry that process out or use it in practice.

Industry is understood in its broad sense as including any physical activity of technical character, and it applies to activities such as transport, agriculture, hunting, public administration, and health care. Methods of testing are generally regarded as inventions susceptible of industrial application if the test is applicable to the improvement or control of a product, apparatus, or process which is itself susceptible of industrial application. Processes or articles alleged to operate in a manner clearly contrary to well-established physical laws, such as perpetual motion machines, are regarded as not having industrial application.

4. Non-Patentable Inventions

The Guidelines set out the categories of subject matter that are excluded from patent protection under Article 4 of the Proclamation. These are discoveries, scientific theories and mathematical methods; inventions contrary to public order or morality; plant or animal varieties and essentially biological processes for the production of plants or animals; schemes, rules or methods for playing games or performing commercial and industrial activities and computer programs; and methods for treatment of the human or animal body by surgery or therapy, as well as diagnostic methods practised on the human or animal body.

4.1 Discoveries, Scientific Theories and Mathematical Methods

A discovery is the act of searching and exploring something that already exists in nature or the environment but was never recognised before. Such works are not patentable because they have no technical effect and do not fulfil the criteria of patentability. Scientific theories are not patentable regardless of how radical their insights may be, because they are the basic tools of innovative work. Mathematical methods are purely abstract and acts of mental skill, and methods of calculation, formulation of equations, and similar techniques are not patentable. However, patents are granted to a product or a process which incorporates such a theory to bring out an innovative solution to a problem.

4.2 Inventions Contrary to Public Order or Morality

Public order expresses concerns about matters threatening the social structures which tie a society together, and it refers to the protection of public security, the physical integrity of individuals, and the environment. Morality is the degree of conformity to what society considers right and acceptable. In Ethiopia, inventions that contravene the social norms, ethics, rules, and behaviours recognised by the people as right and acceptable are considered contrary to public order or morality. Examples include processes of biotechnology such as cloning human beings or modifying the germ line genetic identity of human beings, machines or methods for counterfeiting currency notes, inventions for the adulteration of food products, and anti-personnel mines. A patent application falling under this category is not published in the Official Gazette and is denied patent protection.

4.3 Plant or Animal Varieties and Essentially Biological Processes

Article 4(1)(b) of the Proclamation excludes plant and animal varieties and essentially biological processes for the production of plants or animals from patentability. A process for the production of plants or animals is essentially biological if it consists entirely of natural phenomena such as crossing or selection. New plant varieties are protected in Ethiopia under the plant breeders' rights regime rather than the patent system.

4.4 Schemes, Rules or Methods and Computer Programs

Schemes, rules and methods for playing games are not protected by patents, and the exclusion applies both to traditional games and to contemporary forms of game play. Game rules are abstract and purely mental in nature and are meaningful only in the gaming context. The exclusion also applies to inventions of a financial, administrative, or organisational nature which are regarded as schemes, rules, and methods for doing business.

Computer programs as such are excluded from patent protection because they are forms of writing or intellectual works traditionally protected by copyright. However, the exclusion does not mean that inventions that embody or utilise computer programs are necessarily excluded. A computer program is not excluded from patentability if the program, when running on a computer or loaded into a computer, brings about, or is capable of bringing about, a technical effect.

4.5 Methods of Treatment and Diagnostic Methods

Any medical treatment of a disease, ailment, injury, or disability, as well as prophylactic treatments such as vaccination and inoculation, is regarded as therapy. Surgery is a technique to treat diseases, injuries, or other medical conditions by cutting open the body and removing or repairing the damaged part. Diagnosis is the identification of the nature of a medical illness, usually by investigating its history and symptoms and by applying tests. The exclusion of medical methods from patentability is justified on the basis that doctors should be able to choose the best medical treatment for the patient without

being restricted by exclusive patent rights. However, products for use in any of these methods are patentable, and patents may be obtained for surgical, therapeutic, or diagnostic instruments or apparatuses.

5. Patent Claims

The claims determine the scope of protection conferred for an invention and set out the scope of the patent monopoly sought. A patent application must contain one or more claims which define the matter for which protection is sought in terms of the technical features of the invention, and the claims must pertain to either a product or a process. The claims are the legal basis of the invention, and whether an invention fulfils the patentability criteria is determined by examining the claims.

The claims must be clear and concise and supported by the description. A claim must contain all of the essential technical features that differentiate the invention from the closest prior art. The number of claims must be reasonable taking into account the nature of the invention.

The Guidelines describe the form and content of claims. Each claim should be a single sentence, drafted in terms of the technical features of the invention, and the technical terminology used in the claims must be consistent with that used in the description. The claims may contain chemical or mathematical formulae but not drawings, and they should not contain statements relating to commercial advantages or other non-technical matters. The claims must not rely on references to the description or drawings to explain the technical features of the invention.

A claim is generally written in three parts: the preamble, which identifies the category of the invention protected by the claim; the transitional phrase, which dictates whether the claim is open or closed; and the body, which recites the elements and limitations of the claim and explains how the elements exist in relation to one another. The Guidelines distinguish between product claims and process claims, and between independent and dependent claims. Each claim set begins with an independent claim, and each independent claim may be followed by one or more dependent claims that relate to more specific embodiments. A dependent claim must refer back to at least one previous claim and cannot refer forward to a subsequent claim, and it cannot extend the scope of protection of the invention defined in the corresponding independent claim.

The Guidelines also address clarity and interpretation of claims, inconsistencies between the description and the claims, and claims defined by a result to be achieved. As a general rule, claims which attempt to define the invention by a result to be achieved are not allowed, but they may be allowed if the invention can only be defined in such terms or cannot otherwise be defined more precisely without unduly restricting the scope, and if the result can be directly and positively verified by tests or procedures adequately specified in the description.

6. Unity of Invention and Double Patenting

When the application is examined for novelty and inventive step, the examiner also checks whether it meets the requirement of unity of invention, that is, that it relates to one invention or to a group of inventions which form a single inventive concept. When two or more inventions are claimed in one application, the application fails to comply with the requirement of unity unless the inventions are so linked as to form a single general inventive concept. The link must be a technical relationship which finds expression in the claims in terms of the same or corresponding special technical features.

If the examiner determines that the claims lack unity of invention, the applicant is required to elect certain claims and cancel or remove the others. The applicant is typically allowed to file another divisional application for the unelected claims. In practice, this means that failing to meet the requirement has time and cost consequences for the applicant.

The Guidelines also address double patenting. There are two kinds of double patenting which are not allowed. The first prohibits an inventor from having two patents with the same claim, or with claims that are effectively identical. The second prohibits an inventor from having a patent with a claim that is obvious over a claim in another of the inventor's patents. The principle behind the second prohibition is that an inventor should not be able to extend the life of a first patent by obtaining a second patent with a claim to an obvious variation of the invention claimed in the first patent.

The Guidelines also address objections, amendments, and the correction of errors. If the application is deficient or contains points which are not clear, the applicant is notified with a written communication indicating the reasons for the objection and is invited to remedy the deficiency within a specified time limit. The applicant may amend the application up to the time when it is in order for grant, provided that the amendment does not go beyond the disclosure of the initial application. Before issuing a negative decision, the Authority notifies the applicant of the possibility of a hearing, and a hearing may be conducted orally, by written submission, or by remote hearing using available technologies. A party aggrieved by the decision of the Authority may appeal to the court.

7. What Part Two Signals

For applicants and their advisers, Part Two of the Guidelines signals that the substantive stage is where the application is tested against the prior art and where the scope of protection is settled. Claims drafted without regard to the description, or without a clear technical feature, are exposed to objection. The problem-solution approach, the strict standard of anticipation, and the requirement of a single inventive concept should be considered at the drafting stage, not only at the examination stage. Applicants should also consider the exclusions before filing, and they should use the possibility of amendment and the hearing procedure where objections are raised.

Part Three of this series will address grant and publication, duration and extension, limitation and surrender, and patents of introduction.

Disclaimer

This legal update is provided for general informational purposes only and does not constitute legal advice. The application of the Guidelines may depend on the specific circumstances of an applicant, invention, or application, and on the practice of the Ethiopian Intellectual Property Authority. The Guidelines do not have the force of law, and the Proclamation and Regulations prevail in the event of inconsistency. Professional legal advice should be sought before relying on this update or taking any action.

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