KENYA INDUSTRIAL PROPERTY INSTITUTE

Guideline for the examination of Patents, Utility Models, and Industrial Designs

Nairobi 2007

Foreword

Guidelines for the examination of patents, Utility models, and Industrial Designs are intentioned to provide guidance in the practice and procedure to be followed in processing industrial property applications for the grant and registration of patents, utility models and industrial designs in accordance with the Industrial Property Act 2001(the Act) and the Industrial Property Regulations 2002 (the Regulations).

The Guidelines are not intended to, and cannot, add to or subtract from the provisions of the Act or the Regulations. They are meant to assist the examiners and other Patent Division Staff to consistently apply the Act and the Regulations. However, they cannot be expected to cover all possible situations. The Guidelines are in essence the first step on the long journey of continuous improvement and towards establishment of standards for processing industrial property rights applications in the Institute. The Guidelines will be adapted where necessary to reflect the results of a learning process. More so decisions made by the Managing Director, Industrial Property Tribunal and High Court as provided for in the Industrial Property Act and the Regulations may serve to elaborate and enrich these guidelines.

Further, it needs to be noted that the realms of industrial property covered in these guidelines is quite dynamic and therefore changes in the provisions of the Act and the regulations are expected. Such changes will need to be reflected in the guidelines in order to maintain their relevance for day to day use in the Institute.

Any comments on these Guidelines and any subsequent changes will always be welcome. Such comments should be directed to:

The Managing Director
Kenya Industrial Property Institute,
P. O. Box 51648 – 00200,
Nairobi.
Tel: 254-2-602210/1
Email: kipi@swiftkenya.com

Acknowledgement

Preparation of Guidelines for the examination of Patents, Utility Models and Industrial Designs was inspired and driven by the desire of the patent Division's Staff to standardize and improve on the procedures for processing applications for patents, utility models and industrial designs. Consequently the staff contributed greatly to the development of these guidelines. I wish to recognize the efforts of all who were involved in one way or another. On behalf of the committee tasked to come up with the Guidelines, I am grateful for the cooperation and support that was received from other members of staff. I recognize the efforts of those who found time and made efforts to avail their comments and constructive criticism formally and informally for they helped shape this document.

Special acknowledgement goes to the team that dedicatedly worked on the final draft to ensure that it was ready and specifically recognize the efforts of Mr. Paul M. Chege (Senior Trademarks Examiner), Mr. Fredrick O. Omiti (Senior Patent Examiner), Mrs Eunice W. Njuguna (Chief Legal Officer), Mr. David N. Njuguna (Patent Examiner) and Mr. Reuben Langat (Senior Patent Examiner) for they went beyond the call of their duty to pursue the finalization of this document.

The Managing Director, Prof. James Otieno Odek, in a special way contributed to the formulation of this document. He continually encouraged the committee to finalize the compilation of the document. Most of all he provided the required resources for the completion of this work.

Mr. Joseph M. Mbeva
Chief Patent Examiner
(For and on behalf of the committee responsible
for the preparation of the Guidelines)

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ACRONYMS

KIPI	-	Kenya Industrial Property Institute
PCT	-	Patent Cooperation Treaty
ARIPO	-	African Regional Intellectual Property Organization
WIPO	-	World Intellectual Property Organisation
TRIPs	-	Trade Related Intellectual Property Agreements
WTO	-	World Trade Organization
IPR	-	Intellectual Property Rights
IPEA	-	International Preliminary Examining Authority
ISA	-	International Search Authority
IPER	-	International Preliminary Examination Report

Part I: GENERAL INFORMATION

1.1 Introduction

These guidelines give instructions as to the practice and procedure to be followed in the various aspects of processing industrial property applications and more specifically to grant and registration of patents, utility models and industrial designs in accordance with the Industrial Property Act 2001(the Act) and the Industrial Property Regulations 2002 (the Regulations). However, adherence to the Patent Cooperation Treaty, the rules made and the administrative instructions issued thereunder are to be observed in dealing with international patent applications as far as the same are given effect under the Industrial Property Act 2001 and any amendments thereafter. The same also applies to Harare Protocol with respect to regional applications.

The Guidelines are not intended to, and cannot, add to or subtract from the provisions of the Act or the Regulations. They are meant to assist the examiners to consistently apply the Act and the Regulations to the examination procedure, but they cannot be expected to cover all possible situations. The Institute and the users of the system understand that for all concerned there will be a learning process. The Guidelines will be adapted where necessary to reflect the results of that learning process.

Reference in these guidelines to a section, followed by a number, is to be construed as reference to the Act and reference to a regulation will be construed as reference to the Regulations.

1.2 Contacts of the Institute

The Institute is located in Nairobi South "C", Popo Road, off Mombasa Road, Weights and Measures premises, P. O. Box 51648 - 00200, Nairobi, Telephone No. 602210/602211. Fax: 606312. Email: kipi@swiftkenya.com or info@kipi.go.ke. Website:

1.3 Business hours

The Registry is open to the public from 9.00 am to 1.00pm and 2.00 pm to 4.00 pm each day from Monday to Friday. If the last day for filing a document falls on a Saturday, a Sunday or on a public holiday, the document may be filed on the next day following the Saturday, Sunday or the public holiday.

1.4 International conventions and treaties

Kenya is a member of a number of international treaties and conventions in the field of intellectual property. Such instruments have a direct bearing on the procedures and standards adopted in dealing with industrial property matters. The treaties and conventions include:-

1.4.1 Paris convention

The Paris Convention for the Protection of Industrial Property contains provisions in regard to national treatment and right of priority which are domesticated in the Act.

1.4.2 Trade Related Aspects of Intellectual Property Rights (TRIPS) Agreement

This is part of the multilateral trade agreements made under the general agreements in tariffs and trade (referred to as the GATT Agreement). It covers a wide range of intellectual

property aspects and sets out the minimum standards of protection to be provided by each member of the World Trade Organisation (WTO).

1.4.3 Patent Co-operation Treaty (PCT)

Patent Co-operation Treaty (PCT) is a system for filing international patent applications. It is administered by the World Intellectual Property Organization (WIPO). Under the PCT, an applicant can file a patent application in all the member countries through a single application.

1.4.4 Harare Protocol

The Harare Protocol is administered by the African Regional Intellectual Property Organization (ARIPO). The protocol empowers ARIPO to grant patents and register industrial designs and utility models on behalf of the contracting states. 1.5 IP Forms

The prescribed forms for requesting any office actions are provided for in the First Schedule to the Regulations.

1.6 Fees

The Act and the Regulations prescribe a schedule of fees payable to the Institute for various services. The prescribed fees are set out in the Second Schedule to the Regulations. Fees must be paid in Kenya Shillings by local applicants and US$ by foreign applicants. Payments made in other currencies will not be accepted. The fees should be remitted to the Institute either by cash or cheque.

1.7 Filing of documents.

Documents may be sent by post or filed in person. Where documents are sent by post the date of receipt at the Institute shall be deemed to be the date that the Institute receives the document. Once documents are properly received and stamped, they become part of the file kept by the Institute and may not be returned unless they were submitted by error.

1.8 Industrial Property Journal

The Industrial Property Journal (the Journal), is a statutory monthly publication of the Institute for the purpose of advertising industrial property applications and for publishing other matters required to be published under the Act;

1.9 Representation before the Institute (Sec. 34(2))

Natural or legal persons not having either their domicile or their principal place of business or a real and effective industrial or commercial establishment in Kenya must appoint an agent to act for them in all proceedings. If an application is made in these circumstances and an agent has not been appointed, the applicant will be requested in the examination report to do so.

A representative shall be appointed through IP Form No. 39 for each application filed; and a payment of the requisite fees.

PART II: PATENTS AND UTILITY MODELS

Chapter 1: Filing of documents and filing date examination

1.1 Persons entitled to file an application

An application for the grant and registration of a Kenyan patent, utility model, or industrial design may be filed by the inventor or any other person to whom she has transferred the right. It is presumed that a legal entity does not have the ability to invent or create but rather it is the natural persons working for the legal entity. It is on this basis that it is necessary when a legal entity is filing the application, the application be accompanied by a statement justifying the applicants right to a patent (S34 (3); R12 (8)). Such statement shall be furnished on Form IP 4 or assignment documents.

1.2 Reception of documents

All documents relating to patents, utility models and designs are received at the front office of the patent registry and the date of receipt is stamped upon receipt of the documents. The date of receipt should be applied as not to obliterate any part of the document or make them unsuitable for direct reproduction.

Upon capturing the receipt of any application, the computer system generates the application number automatically. The application is then forwarded to the accounts section for reception of the applicable fees. From the accounts section the application is taken back to the front office for data capture. The application is then forwarded to the registry where a physical file is opened and the file is assigned to an examiner in the relevant field.

All pages of any document received in respect of a new application should be marked with the application number. In addition, copies of all correspondence issued by the Institute should be included in the file, filed in chronological order in which the correspondence is sent to the applicant.

1.3 Filing date

The first task for the examiner is to determine whether the application meets the requirements for according the filing date. These requirements are prescribed under section 41 of the Act as the name of the applicant, description, claims and drawings where necessary.

The documents referred to above should be in English but do not have to meet any particular requirements as to form or presentation. It is essential however they be sufficiently legible to enable the information to be discerned. The applicant should be considered sufficiently identified whenever it is possible to establish the identity of the applicant beyond reasonable doubt on the basis of all data contained in the documents filed. Where there is more than one applicant each applicant must be similarly identified. No objection should be raised at this stage with regard to the status of the applicant or his entitlement to apply. The contents of the description and claims do not require close scrutiny. It will be sufficient to identify a document which appears to include description and one or more claims.

If the application does not fulfil these requirements the examiner is required to invite the applicant, within 14 days from the date of the examination, to submit the required correction. The invitation should indicate that the applicant has 60 days to comply. If the

applicant does not comply with the invitation and, as a result, the examiner treats the application as if it had not been filed, the examiner should, within fourteen days, inform the applicant in writing.

Where an application meets the aforementioned requirements, the receiving date becomes the filing date and the same must be so communicated to the applicant in writing.

Chapter II: Formalities procedure for patent applications

(Sec. 41(7) Regulation 24 (4))

2.0 Introduction

Before the application is accepted to proceed for search and substantive examination, the examiner will carry out formality examination to determine whether the application complies with the provisions of the Act and the Regulations as detailed below. The purpose of formality examination is to ascertain conformity of the application to the physical requirements. These physical requirements are necessary to facilitate easy storage, search, retrieval and reproduction of the patent documents and comprehension of the subject matter of the application. (isn't this part of substantive examination?)

2.1 Request (IP Form 3) sec. 34

The examiner should check whether the request complies with the following:-

- The request for grant is based on a provisional or a final specification denoted by marking the appropriate boxes on the form. If it is a provisional specification, the examiner should inform the applicant that the final specification is due within one year from the filing date and that the Institute will not process the application until the final specification is filed.
- It states the name, address, nationality and country of residence of the applicant,
- It states the name and address of the inventor
- It states the name and address of the agent where necessary.
- If there is more than one applicant, the request should set out, in addition to an address for each applicant, a single address at which all the applicants can be contacted.
- For each inventor, the request should be accompanied by an extra copy of the statement if there is more than one inventor

2.2 Title of the invention

With regard to the title of the invention it should be checked to ascertain whether it is short and precise, as required under section 34(3) of the Act.

Form IP 3 must also contain the title of the invention. The title must clearly and concisely state the technical designation of the invention and must exclude all fancy names. The examiner should take the following into account:

- personal names, fancy names, the word "patent" or similar terms of a non-technical nature which do not serve to identify the invention should not be used;
- the abbreviation "etc.", being vague, should not be used and should be replaced by an indication of what it is intended to cover;
- titles such as "Method", "Apparatus", "Chemical Compounds" alone o7 r similar vague titles do not meet the requirement that the title must clearly state the technical designation of the invention;
- trade names and trade marks should also not be used; the examiner, however, need only intervene when names are used which, according to common general knowledge, are trade names or trade marks.

2.3 Description

With regard to description of the invention, it should be ascertained that it

a) states the title of the invention;
b) specifies the technical field to which the invention relates;

c) indicates the background art which, as far as it is known to the applicant, can be regarded as useful for the understanding, searching and examination of the invention; and
d) indicates how the invention is industrially applicable.

2.4 Claims

With respect to claims, they should be checked to find out whether they set out:-

a) the technical features that are necessary to define the subject matter of the invention but that are part of the prior art (the preamble); and
b) the technical features that, in combination with the features referred to in subparagraph (a), define that for which protection is sought (the body).

It should be noted that the features set out in the claim under paragraph (b) above should be preceded by an appropriate transition. Such transitions may be words such as "characterized in that", "characterized by", "wherein the improvement comprises" or any other words to the same effect.

If the application contains more than ten claims, the applicant should be requested to pay excess claims fee.

2.5 Form and content of claims

a) Technical features

The claims must be drafted in terms of the "technical features of the invention". This means that claims should not contain any statements relating, for example, to commercial advantages or other non-technical matters, but statements of purpose should be allowed if they assist in defining the invention.

b) Two-part format

A claim should be drafted in two part format. The first part (normally called the preamble) should contain a statement indicating the designation of the subject-matter of the invention i.e. the general technical class of apparatus, process, etc. to which the invention relates, followed by a statement of those technical features which are necessary for the definition of the claimed subject-matter but which, in combination, are part of the prior art.

This statement of prior-art features is applicable only to independent claims and not to dependent claims. It is clear that it is necessary only to refer to those prior art features which are relevant to the invention. For example, if the invention relates to a photographic camera but the inventive step relates entirely to the shutter, it would be sufficient for the first part of the claim to read: "A photographic camera including a focal plane shutter" and there is no need to refer also to the other known features of a camera such as the lens and view-finder.

The second part or "characterising portion" should state the features which the invention adds to the prior art, i.e. the technical features for which, in combination with the features stated in sub-paragraph (a) (the first part), protection is sought.

c) Categories

There are different "categories" of claim ("products, process, apparatus or use"). For many inventions, claims in more than one category are needed for full protection. In fact, there are only two basic kinds of claim, viz. claims to a physical entity (product, apparatus) and claims

to an activity (process, use). The first basic kind of claim ("product claim") includes a substance or compositions (e.g. chemical compound or a mixture of compounds) as well as any physical entity (e.g. object, article, apparatus, machine, or system of co-operating apparatus) which is produced by a person's technical skill. Examples are: "a steering mechanism incorporating an automatic feed-back circuit ..."; "a woven garment comprising ..."; "an insecticide consisting of X, Y, Z"; or "a communication system comprising a plurality of transmitting and receiving stations". The second basic kind of claim ("process claim") is applicable to all kinds of activities in which the use of some material product for effecting the process is implied; the activity may be exercised upon material products, upon energy, upon other processes (as in control processes) or upon living things.

d) Independent and dependent claims

All applications will contain one or more "independent" claims directed to the essential features of the invention. Any such claim may be followed by one or more claims concerning "particular embodiments" of that invention.

Any claim which includes all the features of any other claim is termed a "dependent claim". Such a claim must contain, if possible at the beginning, a reference to the other claim, all features of which it includes. Since a dependent claim does not by itself define all the characterising features of the subject-matter which it claims, expressions such as "characterised in that" or "characterised by" are not necessary in such a claim but are nevertheless permissible. A claim defining further particulars of an invention may include all the features of another dependent claim and should then refer back to that claim. Also, in some cases, a dependent claim may define a particular feature or features which may appropriately be added to more than one previous claim (independent or dependent). It follows that there are several possibilities: a dependent claim may refer back to one or more independent claims, to one or more dependent claims, or to both independent and dependent claims.

e) Arrangement of claims

All dependent claims referring back to a single previous claim and those referring back to several previous claims must be grouped together to the extent and in the most appropriate way possible. The arrangement must therefore be one which enables the association of related claims to be readily determined and their meaning in association to be readily construed.

2.6 Drawings

If the specification contains drawings, the examiner should ascertain that they comply with the following —

a) that they are not coloured;
b) that the lines of the drawings are be black, durable, uniformly thick and well-defined.
c) that the drawings are such that all details can be distinguished without difficulty when the drawings are reproduced photographically at two thirds their actual size;
d) that all numbers, letters and other references signs are at least .32 centimetres high and are circled or within brackets or inverted commas;
e) that all features shown in the drawings are disclosed in the description and vice versa.
f) that the different figures in the drawings are numbered consecutively in Arabic numerals.
g) that the drawings do not include text.

Where the application refers to drawings which are not included in the application, the examiner should invite the applicant to furnish the missing drawings, and, if the applicant complies with the invitation, the filing date should re-dated to the date of receipt of the missing drawings. If the applicant does not comply with the invitation any reference to the drawings should be treated as non-existent.

2.7 Abstract.

The examiner is to ascertain that the application contains an abstract. If the abstract is present the examiner should check whether it starts on a new page and whether it includes —

(a) the title of the invention;

(b) a summary of the disclosure included in the description.

The summary should indicate the technical field to which the invention relates and the principal use or uses of the invention. The abstract should not include statements about the merits or value of the invention or about uses that are speculative. It should not contain more than one hundred and fifty words. It should try as much as possible to capture the most relevant terms defining the invention.

2.8 General requirements

The examiner should check to make sure that the application meets the following general requirements;

1) That the application is in triplicate.
2) That each of the following is numbered as a separate series, using Arabic numerals with the numbers centred at the top of the sheets but not in the top margin —
   a) the request;
   b) the description, claims and abstract; and
   c) the drawings.
3) That every fifth line of the description and the claims is numbered with the number appearing to the left of the line but not in the margin.
4) That all parts of the application are prepared so that they are legible when they are photocopied or otherwise reproduced.
5) That the form of appointment of agent is filed (form IP 39) and the fee is paid.
6) That there is statement justifying applicant's right to patent if the applicant is not the inventor (form IP 4).

2.9 Additional formalities requirements for applications relating to living matter.

If an application relates to a micro-biological process or the product thereof and involves the use of a micro-organism which is not available to the public and which cannot be described in the patent application in such a manner as to enable the invention to be carried out by a person skilled in the art, the examiner should ascertain that a deposit has been made to either KEMRI or KARI which are the recognized depository institutions for the purpose of patenting in Kenya by the date of filing the application.

The examiner should check whether the application provides the name of the depository institution and the file number of the culture deposit. Where the details of the deposited culture are not available at the time of filing, the applicant may submit the missing details within sixteen months from the date of filing or priority.

If the application has defects the examiner should invite the applicant to remedy the defects within 90 days from the date of the invitation. The applicant may apply for extension of this

time by filing form IP 7 and paying the requisite fee. Such extension should not exceed 60 days. If the applicant does not comply with the invitation, the application should be rejected.

2.10 Publication of the patent application (Sec. 42)

The purpose of the publication is to inform the public of the pending patent application before the Institute. The patent application should be published after the expiration of eighteen months from the filing date or, where priority is claimed, the date of priority. In case of patent applications claiming priority, the term of eighteen months is construed from the original filing date and in the case of patent applications with two or more priority claims, the period is construed from the earliest priority dates.

Before the application is published the applicant should be invited to pay the publication fee. The Industrial Property Journal should be published monthly at the end of each calendar month. The technical preparation for the publication of the IP Journal is considered terminated on or before the 20th day of every month. Therefore, for any matter that has to appear in the Journal in a particular month, the payment should be received by the Institute before the termination of the technical preparation.

2.11 Withdrawal of application or priority claim

If after termination of the technical preparation the patent application is withdrawn to avoid publication, non-publication cannot be guaranteed. To avoid publication of the application applicants should at least withdraw their application before the 18th Month from the filing date or where applicable the priority date. In the case of patent applications claiming priority, the term of eighteen months is construed from the earliest priority date. If the applicant abandons the priority claim, then the publication is deferred provided the notification of the abandonment is received by the Institute before the termination of the technical preparation for publication.

Chapter III: Search and Substantive Examination

3.1 Request for substantive examination

After the application meets all formal requirements, the examiner should invite the applicant to request for substantive examination by filing form IP8 upon payment of the prescribed fee. Where no request is made within the prescribed period of three years, the application shall be deemed to be abandoned and the applicant should be informed in writing and the fact should be published in the Journal.

3.2 Procedure after request

The Purpose of examination is to ensure that the application and the invention to which it relates meet the requirements set out in the relevant sections of the Act and the Regulations. This chapter deals with search and examination following a request by the applicant for the application to be examined as to substance.

3.3 Search

The objective of the search is to discover the prior art relevant for the purpose of determining whether and if so to what extent, the invention to which the application relates is new and involves an inventive step pursuant to sections 22, 23 and 24 of the Act.

The examination procedure and the preparation of the search opinion depend on the search for the knowledge of the state of the art on which assessment of the patentability of the invention is based. The search must, therefore, be as complete and effective as possible, within the limitations necessarily imposed by issues such as unity of invention and other considerations.

The search is carried out in in-house or external collections of documents or databases, the contents of which are systematically accessible, e.g. by means of words, classification symbols or indexing codes. These are primarily patent documents of various countries, supplemented by a number of articles from periodicals and other non-patent literature.

A report should be prepared containing the results of the search, in particular by identifying the documents constituting the relevant state of the art.

The search report serves to provide information on the relevant state of the art. it must be realized that in a search, 100% completeness cannot always be obtained, because of such factors as the inevitable imperfections of any information retrieval system and its implementation, and may not be economically justified if the cost is to be kept within reasonable bounds.

For applications claiming priority, the examiner should request the applicant, under section 38 (2), to submit copies of any communication received by the applicant concerning the results of any search or examination carried out in respect of the priority application.

The examiner should for reasons of economy exercise his judgement, based on his knowledge of the technology in question and of the available information retrieval systems, to omit sections of the documentation in which the likelihood of finding any documents relevant to the search is negligible, for example documents falling within a period preceding the time when the area of technology in question began to develop.

3.4 Search in analogous fields

The search is carried out in collections of documents or databases which may contain material in all those technical fields pertinent to the invention.

The search strategy should determine the sections of the documentation to be consulted covering all directly relevant technical fields, and may then have to be extended to sections of the documentation covering analogous fields, but the need for this must be judged by the examiner in each individual case, taking into account the outcome of the search in the sections of the documentation initially consulted.

The decision to extend the search to fields not mentioned in the application must be left to the judgement of the examiner, who should not put himself in the place of the inventor and try to imagine all the kinds of applications of the invention possible. The overriding principle in determining the extension of the search in analogous fields should be whether it is probable that a reasonable objection of lack of inventive step could be established on the basis of what is likely to be found by the search in these fields

3.5 The subject of the search

Basis for the search
The search should be made on the basis of the claims, with due regard to the description and drawings (if any). The claims determine the extent of the protection which will be conferred by the patent if granted.

3.6 Interpretation of claims

The search should on the one hand not be restricted to the literal wording of the claims, but on the other hand should not be broadened to include everything that might be derived by a person skilled in the art from a consideration of the description and drawings. The objective of the search is to discover prior art which is relevant to novelty and/or inventive step . The search should be directed to what appear to be the essential features of the invention and take into account any changes in the (objective) technical problem underlying the invention which may occur during the search as a result of the retrieved prior art. In this regard it should be noted that although explicit references in the claims to features elucidated in the description are only permissible where "absolutely necessary". Claims containing such references should still be searched if these technical features are unambiguously defined by specific parts of the description.

When interpreting claims for the purpose of the search, the search will also take into consideration prior art incorporating technical features which are well known equivalents to the technical features of the claimed invention, which may undermine inventive step.

3.7 Amended claims

Where an application derives from an international application, the applicant may have amended the international application in the international phase, either after receipt of the international search report (Art.19(1) PCT) or during international preliminary examination (Art. 34(2)(b) PCT). The applicant may then specify that he wishes to enter the phase with these or otherwise amended application documents (including claims) according.

3.8 Abandonment of claims

For applications, claims that are deemed to have been abandoned for non-payment of fees must be excluded from the search. This applies both to searches to be carried out in respect of directly-filed applications and to supplementary searches to be carried out in respect of PCT applications entering the national phase.

3.9 Anticipation of amendments to claims

In principle, and insofar as possible and reasonable, the search should cover the entire subject-matter to which the claims are directed or to which they might reasonably be expected to be directed after they have been amended .

For example, where an application relating to an electric circuit contains one or more claims only directed to the function and manner of operation, and the description and drawings include an example with a detailed non-trivial transistor circuit, the search should include this circuit.

3.10 Broad claims

No special search effort need be made for searching unduly wide or speculative claims, beyond the extent to which they relate to matter which is sufficiently disclosed in the application, and are supported by the description (Art. 84). If, for example, in an application relating to and describing in detail an automatic telephone exchange, the claims are directed to an automatic communication switching centre, the search should not be extended to automatic telegraph exchanges, data switching centres etc. merely because of the broad wording of the claim, but only if it is probable that such an extended search could produce a document on the basis of which a reasonable objection as regards lack of novelty or inventive step could be established.

Likewise, if a claim is directed to a process for manufacturing an "impedance element" but the description and drawings relate only to the manufacture of a resistor element, and give no indication as to how other types of impedance element could be manufactured by the process of the invention, extension of the search to embrace, say, manufacture of capacitors would not normally be justified.

If the main claim relates to the chemical treatment of a substrate, whereas it appears from the description or all the examples that the problem to be solved is solely dependent on the nature of natural leather, it is clear that the search should not be extended to the fields of plastics, fabrics or glass.

Similarly, if the description and drawings are directed to a lock with a safety cylinder whereas the claims refer to a device allowing the indexation of the angular position of a first element with respect to two other rotating elements, then the search should be limited to locks. In cases where the lack of disclosure or support is such as to render a meaningful search over the whole of the scope of the claim(s) impossible, a partial search or a declaration taking the place of a search report.

3.11 Independent and dependent claims

The search carried out in sections of the documentation to be consulted for the independent claim(s) must include all dependent claims. Dependent claims should be interpreted as being restricted by all features of the claim(s) upon which they depend. Therefore, where the subject-matter of an independent claim is novel that of its dependent claims will also be

novel. When the patentability of the subject-matter of the independent claim is not questioned as a result of the search, there is no need to make a further search or cite documents in respect of the subject-matter of the dependent claims as such.

For example, in an application relating to cathode ray oscilloscope tubes, in which the independent claim is directed to specific means along the edge of the front of the tube for illuminating the screen and a dependent claim is directed to a specific connection between the front and the main part of the tube, the examiner should, in the sections of the documentation he consults for searching the illumination means, also search for the connecting means whether in combination with the illumination means or not.

If, after this search, the patentability of the illuminating means is not questioned, the examiner should not extend his search for the connecting means to further sections of the documentation which are likely to contain material pertinent to or specifically provided for these connections.

If in an application dealing with a pharmaceutical composition for treating nail infections the patentability of the subject-matter of the independent claim relating to specific combinations of the active ingredients is not questioned as a result of the search, there is no need to continue the search for dependent claims dealing with the use of a specific volatile organic solvent as a carrier in the composition.

3.12 Search on dependent claims

However, where the patentability of the subject-matter of the independent claim is questioned, it may be necessary for assessing whether the subject-matter of the dependent claim as such is novel and involves an inventive step to continue the search in other sections of the documentation, e.g. in one or more additional classification units. No such special search should be made for features that are trivial or generally known in the art. However, if a handbook or other document showing that a feature is generally known can be found rapidly, it should be cited. When the dependent claim adds a further feature (rather than providing more detail of an element figuring already in the independent claim), the dependent claim is to be considered in combination with the features in the independent claim and should be dealt with accordingly.

3.13 Combination of elements in a claim

For claims characterised by a combination of elements (e.g. A, B and C) the search should be directed towards the combination. However, when searching sections of the documentation for this purpose, sub-combinations, including the elements individually (e.g. A and B, A and C, B and C, and also A, B and C separately) should be searched in those sections at the same time. A search in additional sections of the documentation either for sub-combinations or for individual elements of the combination should only be performed if this is still necessary for establishing the novelty of the element in order to assess the inventive step of the combination.

3.14 Different categories

When the application contains claims of different categories, all these must be included in the search. However, if a product claim clearly seems to be both new and non-obvious, the examiner should make no special effort to search claims for a process which inevitably results in the manufacture of that product or for use of the product. When the application contains only claims of one category, it may be desirable to include other categories in the

search. For example, generally, i.e. except when the application contains indications to the contrary, one may assume that in a claim directed to a chemical process, the starting products form part of the state of the art and need not be searched; the intermediate products are only searched when they form the subject of one or more claims; but the final products will always have to be searched, except when they are evidently known.

3.15 Subject-matter excluded from search

The examiner may exclude certain subject-matter from his search. These exclusions may result from certain subject-matter not complying with the provisions of the Act relating to exclusions from patentability or to susceptibility to industrial application. They may also arise where the application does not comply with the provisions of the Act to such an extent that a meaningful search is impossible for some or all of the claims, or for a part of a claim, for other reasons.

3.16 Lack of unity

Also, when the claims of the application do not relate to one invention only, nor to a group of inventions linked so as to form a single general inventive concept, the search will normally be restricted to the invention or the linked group of inventions first mentioned in the claims.

3.17 Technological background

In certain circumstances it may be desirable to extend the subject-matter of the search to include the "technological background" of the invention.
This would include:

- the preamble to the first claim, i.e. the part preceding the expression "characterised by" or "characterised in that";
- the state of the art which in the introduction of the description of the application is said to be known, but not identified by specific citations;
- the general technological background of the invention (often called "general state of the art").

Chapter IV: Search Procedure and Strategy

4.1 Procedure prior to searching

Analysis of the application when taking up an application to be searched, the examiner should first consider the application in order to determine the subject of the claimed invention. For this purpose he should make a critical analysis of the claims in the light of the description and drawings. He should in particular consider the content of the claims, description and drawings sufficiently to identify the problem underlying the invention, the inventive concept leading to its solution, the features essential to the solution as found in the claims and the results and effects obtained.

Furthermore, where technical features which are not present in the claims are indicated in the description as essential for the solution of the stated problem, these features should be included in the search.

4.2 Formal deficiencies

If the examiner notices any formal shortcomings which have been overlooked during formality examination, he may invite the applicant to remedy these deficiencies. Such deficiencies which the examiner might notice include:

1) physical deficiencies of the application, including:
   a) incorrect sequence and/or positioning of page numbering and/or failure to use Arabic numerals in page numbering
   b) presence of drawings in the description and/or claims
   c) presence of erasures and/or alterations in the application documents, such that the authenticity of the content and/other requirements for good reproduction are jeopardized
2) presence of prohibited matter in the application:
   a) which is contrary to public order.
   b) constituting disparaging statements.
3) failure to comply with the provisions relating to the deposition of biological material, in particular with regard to the correct identification in the application of the depository institution and culture deposit number of the biological material assigned to the deposited material by the depository institution.

4.3 Documents cited in the application

Documents cited in the application under consideration should be examined if they are cited as the starting point of the invention, as showing the state of the art, or as giving alternative solutions to the problem concerned, or when they are necessary for a correct understanding of the application.

However, when such citations clearly relate only to details not directly relevant to the claimed invention, they may be disregarded. In the exceptional case that the application cites a document that is not published or otherwise not accessible to the examiner and the document appears essential to a correct understanding of the invention to the extent that a meaningful search would not be possible without knowledge of the content of that document, the Examiner should postpone the search and request the applicant to provide a copy of the document.

If no copy of the document is received, an attempt is made to carry out the search and then, if necessary, a partial search report or, where applicable, a declaration replacing the search report is prepared.

This partial search report or declaration will be issued giving the following grounds:

(i) the non-availability of the document rendered the invention insufficiently disclosed within the meaning of section 34(5); and

(ii) the insufficient disclosure mentioned in (i) existed to such a degree that a meaningful search was not possible on at least part of the claimed invention.

It should also be noted that where the applicant furnishes the document after the search report and the search opinion (if applicable, have been prepared, an additional search on that subject-matter originally excluded from the search may be carried out due to the correction of the deficiency which led to the partial search.

4.4 Abstract; official classification; title of the invention; publication

The examiner should then consider the abstract (together with the title of the invention and the figure, if any, of the drawings to be published with the abstract) in relation to the requirements laid down in the Regulations. Since the abstract should relate to the application as filed, the examiner should consider it and determine its definitive content before carrying out the search, in order to avoid being inadvertently influenced by the results of the search. If publication of the application is due before the search report is drawn up, the examiner has to establish the official classification of the application much earlier before he carries out the search; he examines then at the same time the abstract for the purpose of publication.

This examination of the abstract does not go beyond ensuring that it relates to the application concerned and that no conflict exists with the title of the invention or with the classification of the application. Information in relation to the abstract, the title of the invention and the figure, if any, of the drawings to be published with the abstract should transmitted to the applicant in the communication accompanying the search report.

4.5 Search strategy

4.5.1 Subject of the search; restrictions

Having determined the subject of the invention as outlined above it may be desirable for the examiner to prepare first a search statement, defining the subject of his search as precisely as possible. In many instances one or more of the claims may themselves serve this purpose, but they may have to be generalised in order to cover all aspects and embodiments of the invention.

At this time, the considerations relating to subjects excluded from patentability and to lack of unity of invention should be borne in mind. The examiner may also have to restrict the search because the requirements of the Act are not met to such an extent that a meaningful search is impossible. Any such restrictions to the search must be indicated in the partial search or declaration taking the place of the search report.

4.5.2 Formulating a search strategy

Next the examiner should start the search process by formulating a search strategy, i.e. a plan consisting of a series of search statements expressing the subject of the search, resulting in sections of the documentation to be consulted for the search. In its initial phase, a search strategy will contain one or more combinations of the basic components mentioned above. The search process should be interactive and iterative in the sense that the examiner should reformulate his initial search statement(s) according to the usefulness of the information retrieved. When using classification units, the examiner should select the

classification units to be consulted for the search, both in all directly relevant fields and in analogous fields. The selection of the classification units in related fields should be limited to:

(i) higher subdivisions allowing searching by abstraction (generalisation) inasmuch as this is justified from a technical viewpoint; and

(ii) parallel subdivisions, bearing in mind the fact that the fields in question will become increasingly unrelated.

When the examiner is in doubt about the appropriate fields in which to conduct his search, he may request advice from the appropriate supervisor.

Usually various search strategies are possible, and the examiner should exercise his judgement, based on his experience and knowledge of the available search tools, to select the search strategy most appropriate to the case in hand. He should give precedence to search strategies yielding sections of the documentation in which the probability of finding relevant documents is highest. Usually the main technical field of the application will be given precedence, starting with the basic components most relevant to the specific example(s) and preferred embodiments of the claimed invention.

4.5.3 Carrying out the search; types of documents

The examiner should then carry out the search, directing his attention to documents relevant for novelty and inventive step. He should also note any documents that may be of importance for other reasons, such as:

(i) conflicting applications which are:

(a) published applications

(b) published international applications

When published within the priority interval of the application under search, these applications are cited in the search report as "P" documents; when published after the national or international filing date, they are cited in the search report as "E" documents ;

(ii) documents putting doubt upon the validity of any priority claimed, which are cited in the search report as "L" documents

(iii) documents contributing to a better or more correct understanding of the claimed invention, which are cited in the search report as "T" documents;

(iv) documents illustrating the technological background, which are cited in the search report as "A" documents, where these documents do not constitute the closest state of the art ; and

(v) patent applications having the same filing or priority date as the application in respect of which the search is carried out, from the same applicant and relating to the same invention and therefore relevant to the issue of double patenting, which are cited in the search report as "L" documents, but he should not spend a significant amount of time in searching for these documents, nor in the consideration of such matters unless there is a special reason for doing so in a particular case..

The examiner should concentrate his search efforts on the use of search strategies yielding sections of the documentation in which the probability of finding highly relevant documents is greatest, and, in considering whether to extend the search to other less relevant sections of the documentation, he should always take account of the search results already obtained.

4.5.4 Reformulation of the subject of the search

The examiner should continuously evaluate the results of his search, and if necessary reformulate the subject of the search accordingly. For example, the selection of the classification units to be searched or the order of searching them may also require alteration during the search as a consequence of intermediate results obtained. The examiner should also use his judgement, taking into account results obtained, in deciding at any time during the systematic search whether he should approach the search documentation in some different manner, e.g. by consulting:

(i) documents cited in relevant documents produced by the search, for example cited in the description or search report of a patent document; or

(ii) documents citing a relevant document produced by the search, or whether he should turn to documentation outside that which is available to the Examiner.

When searching external document collections for material in relation to unpublished subject-matter using other than secure connections, like the Internet, the examiner should be extremely careful when formulating search strategies so as not to unwittingly reveal confidential material – i.e. any part of the unpublished patent application.

4.5.5 Closest prior art and its effects on the search

It may happen that the examiner does not find any documents published before the earliest priority date which prejudices the novelty or the inventive step of the claimed invention. In such cases, the examiner should, whenever possible, cite in the search report at least that prior art found in the course of search which discloses a solution to the same problem as that underlying the claimed invention (wherein this problem may change depending on the prior art retrieved and wherein the known solution is technically the closest to the claimed solution ("closest prior art"). Such prior art is to be cited as an "A" document in the search report.

If such a document cannot be found, the examiner should cite as the closest prior art a document which solves a problem closely related to the problem underlying the claimed invention and wherein the solution is technically most similar to that of the application under search.

Where the examiner retrieves documents which are incidentally prejudicial to the novelty of the claimed invention but which do not affect the inventive step thereof after appropriate amendment of the application, and does not retrieve any other documents prejudicing inventive step, the examiner should also proceed as above.

In the case of an national application derived from an international application and being subjected to a supplementary search after entering the national phase , it is possible that the examiner does not uncover any further relevant prior-art documents in the search over and above the documents already cited in the international search report by the International Searching Authority. In such cases, it is permissible to have no further relevant documents in the supplementary search report.

4.5.6 End of search

Reasons of economy dictate that the examiner use his judgement to end his search when the probability of discovering further relevant prior art becomes very low in relation to the effort needed. The search may also be stopped when documents have been found clearly demonstrating lack of novelty in the entire subject-matter of the claimed invention and its elaborations in the description, apart from features which are trivial or common general knowledge in the field under examination, application of which features would not involve

inventive step. The search for conflicting applications should, however, always be completed to the extent that these are present in the available documentation.

4.5.7 Preparation of the search report

After completion of the search, the examiner should select from the documents retrieved the ones to be cited in the report. These should always include the most relevant documents (which will be specially characterised in the report. Less relevant documents should only be cited when they concern aspects or details of the claimed invention not found in the documents already selected for citation. To avoid increasing costs unnecessarily, the examiner should not cite more documents than is necessary and therefore, when there are several documents of equal relevance, the search report should not normally cite more than one of them. Subsequently, the examiner prepares the search report.

4.5.8 Documents discovered after completion of the search

It may happen occasionally, that after completion of a search report, the Examiner discovers further relevant documents (e.g. in a later search for a related application). These documents should be added to the search report up to the time that preparations for its publication are completed. Up to the filing of a request for examination, such later discovered documents should be communicated to the applicant. Thereafter, such documents may be used in examination.

4.5.9 Errors in the search report

When a material error is found to be present in a search report prior to publication thereof, a new search report will be drawn up which supersedes the preceding one. Where the search report has already been sent to the applicant, the error should immediately be notified to the applicant. When a serious error is noted following publication of the application, a corrigendum is published in the Journal. If the error comprises the transmission of an incorrect document as a citation, the correct document should be sent.

4.6 Classification of Patent Applications

The official classification of the patent application is performed by the examiner, using the classification symbols contained in the rules of the IPC for the inventions as claimed ("Obligatory Classification"). He can also assign appropriate classification symbols and/or indexing codes to any additional information ("Non-Obligatory Classification") as defined in the Guide to the IPC in force at the time.

4.6.1 Pre-classification (routing)

The level of classification at this stage should be as general as practicable on the basis of a quick and cursory scrutiny of the document (e.g. the title and independent claim or claims). On the other hand, the level should be specific enough to avoid the need for any intermediate stage of preclassification before allocation to the competent section.

The preclassification required for this first allocation should be made on the basis of the independent claims. If this results in preclassification in more than one sub-class, then whichever of these seems to be the most relevant to the claimed invention (or the invention first claimed, if there is lack of unity of invention) should be selected. In most cases no further classification is required to enable applications to be allotted to the Examiner but,

where it is necessary, it falls within the authority of the examiner in charge of the field to arrange for such allotment in an expedient manner.

4.6.2 Incorrect preclassification

If, on reaching the section, an application has been found to be incorrectly preclassified and thus inappropriately allocated, it is reclassified and re-allocated by the section receiving it, the indication on the dossier being appropriately amended.

4.6.3 Classification of the application

The classification of the patent application is performed by the examiner as described above. Preferably, this should be done when he has studied the content of the application in order to carry out the search. However, if publication of the application is due before the search report is drawn up, it is necessary for the examiner to study the application sufficiently to determine the official classification at this earlier stage.

If the classification of the application is in more than one sub-class, or more than one main ("00") group within a sub-class, then all such classifications should be assigned. The classification of the invention as claimed should be distinguished from any additional classification and/or indexing code.

In addition, where it is necessary to assign more than one symbol for the invention itself, the symbol which in the examiner's opinion most adequately identifies it, or, when this presents difficulties, the symbol which identifies the invention for which most information is given, should be indicated first, e.g. in order to facilitate subsequent allocation of the applications.

The classification should be determined without taking into consideration the probable content of the application after any amendment, since this classification should relate to the disclosure in the published application, i.e. the application as filed. If, however, the examiner's understanding of the invention, or of the content of the application as filed, alters significantly as a result of the search (e.g. as a result of prior art found or because of clarification of apparent obscurities), he should amend the classification accordingly, if the preparations for publication have not at that stage been completed.

4.6.4 Classification when the scope of the invention is not clear (e.g. a partial search)

When the scope of the invention is not clear, the classification has to be based on what appears to be the invention insofar as this can be understood. It is then necessary to amend it if obscurities are removed by the search.

Classification in cases of a lack of unity of invention
Where objection of lack of unity of invention arises, all inventions must be classified, since all will be disclosed in the published application.

Verification of official classification
As a general rule, applications will not be systematically scrutinised after leaving the Examiner in order to verify the correctness of the official classification assigned by the examiner.

Chapter V: The State of the Art

5.1 State of the art – oral disclosure, etc.

According to section 23(2), oral disclosure, use, exhibition, etc. are recognized as prior art. However, the examiner, in carrying out a search, should cite an oral description, etc. as prior art only if he has available a written confirmation or is otherwise convinced that the facts can be proved. Such references to oral disclosure, prior public use, disclosure by sale, etc. are more usually brought up by opponents in invalidation/ revocation proceedings.

5.2 Priority

If the claimed priority dates cannot be verified at this stage, uncertainty will exist as regards their validity and the search for conflicting applications should be extended so as to cover all published applications with an earliest claimed priority date up to the filing date (not the claimed priority date(s)) of the application under consideration.

5.3 Conflicting applications

Potentially conflicting national and international applications
Generally, where the search is concluded less than eighteen months after the national or international filing date of the application (the filing date according to Art. 80 and not its claimed priority date(s)), it will not be possible at the time of the search to make a complete search for potentially conflicting national and international applications.

5.4 Date of reference for documents cited in the search report; filing and priority date

5.4.1 Verification of claimed priority date(s)

Where the validity of the priority claim cannot be verified at the search stage, the basic reference date for the search must be taken as the date of filing of the application as accorded.

5.4.2 Intermediate documents

The Examiner takes into account documents published between the earliest priority date and the filing date of the application under consideration, and these documents are identified as such in the search report. For identifying these documents when an application has more than one priority date, the oldest date is to be applied.

When deciding which documents to select for citing in the search report, the examiner refers to these dates and should preferably choose any published before the date of priority. Thus, for example, where there are two documents, one published before the date of priority and the other after that date but before the date of filing, but otherwise equally relevant, he should choose the former.

5.5 Doubts as to the validity of the priority claim; extension of the Search

It is the responsibility of the Examiner to check whether and to what extent the priority claim is justified. However, where intervening state of the art or potential state of the art is revealed in the search, the Examiner should, if possible, check the validity of the priority claim. Furthermore, documents showing that a priority claim might not be justified (e.g. an earlier application or patent from the same applicant indicating that the application from which priority is claimed may not be the first application for the invention concerned) should be cited in the search report. However, no special search effort should normally be made for this purpose, except when there is a special reason to do so, e.g. when the priority application is a "continuation-in-part" of an earlier application from which no priority is claimed.

Sometimes the fact that the country of residence of the applicant is different from the country of the priority application may also be an indication that it is not a first filing, justifying a certain extension of the search.

When the search is extended for this purpose, it should be directed to:
(i) published patent documents filed earlier than the claimed priority date.
(ii) published patent documents which claim priority from an application filed earlier than the priority date of the application being searched.

5.6 Documents published after the filing date

The search does not normally take into consideration documents published after the filing date of the application. However, some extension is necessary for specific purposes, and certain other situations may occur in which a document published after the filing date is relevant; examples are a later document containing the principle or theory underlying the invention, which may be useful for a better understanding of the invention, or a later document showing that the reasoning or the facts underlying the invention are incorrect. The search should not be extended for this purpose, but documents of this nature known to the examiner could be selected for citation in the report.

5.7 Non-prejudicial disclosures

Disclosures of the invention should not be taken into consideration if they occurred no earlier than six months preceding the filing of the patent application and if they were due to an evident abuse in relation to the applicant or his legal predecessor, or due to display at an official, or officially recognised, international exhibition. The Examiner should, nevertheless, cite in the search report any documents he has reason to believe is relevant. In this case too the reference date for the search will be the filing date of the application.

5.8 Contents of Prior-art Disclosures

5.8.1 General remark

As a general rule, the Examiner selects for citation only documents which are present in the search documentation or which it has access to in some other manner. In that way, no doubt exists about the contents of the documents cited, since the examiner generally has physically inspected each document cited.

5.8.2 Citation of documents corresponding to documents not available English.

Under certain circumstances a document whose contents have not been verified may be cited, provided there is justification for the assumption that there is identity of content with another document which the examiner has inspected; both documents should then be mentioned in the search report. For example, instead of the document published before the filing date in a language other than English and selected for citation, the examiner may have inspected a corresponding document (e.g. another member of the same patent family, or a translation of an article) in English and possibly published after the filing date. Also it may be assumed that, in the absence of explicit indications to the contrary, the contents of an abstract are contained in the original document. Further, it should be assumed that the contents of a report of an oral presentation are in agreement with that presentation.

5.9 Unity of Invention

5.9.1 General remarks

If the Examiner considers that the application does not comply with the requirement of unity of invention, he must search it, and draw up the partial search report, for those parts of the application which relate to the invention (or group of inventions forming unity) first mentioned in the claims. The partial search report is supplemented with a specification of the separate inventions.

With regard to the search opinion in cases of a lack of unity of invention, when determining which invention is the invention or unitary group of inventions first mentioned in the claims, the examiner takes account of the content of the dependent claims, disregarding trivial claims.

5.9.2 Decision with respect to unity of invention

The examiner should not raise an objection of lack of unity merely because the inventions claimed are classified in separate classification units, or merely for the purpose of restricting the search to certain sections of the documentation, for example, certain classification units.

5.10 Subject – matter to be Excluded from the Search

5.11 General remarks

In relation to searches, the subject-matter listed in section 21(3) may be considered under the Act as either not to be industrially applicable or, to the extent that the patent application relates to that subject matter as such, to be excluded from patentability, or to constitute an exception to patentability under section 26, the claims are not searched in as far as they relate to such subject matter.

The Examiner has thus to consider the requirements for patentability other than novelty and inventive step. The above-mentioned situations may also occur for only some of the claims or for part of a claim. In these cases, this will be indicated in the search or the declaration taking the place of the search report.

Methods for treatment of the human or animal body; diagnostic methods
With regard to methods for treatment of the human or animal body by surgery or therapy, or diagnostic methods practised on the human or animal body, it should be noted that products, in particular substances or compositions, for use in any of these methods, are not excluded from patentability, provided that the use of the product for any such method is not

comprised in the state of the art. It should be noted that a claim in the form "Use of a substance or composition X for the manufacture of a medicament for therapeutic application Z" may be allowable for either a first or "subsequent" such application.

Even if a claim is drafted as a method of medical treatment and is for this reason not directed to patentable subject-matter, a meaningful search may be possible if the determining technical feature is the effect of the substance, which can be searched. If, however, specific method features are present (e.g. dosing instructions for the user, combination of pharmaceutical with physical treatment), a meaningful search may not be possible. In cases of doubt the Examiner should carry out the search to the extent that this is possible in the available documentation.
However, regardless of whether such claims are searched or not, the applicant's attention should be drawn on the search opinion (if applicable, to the exclusion of such subject matter from industrial application.

5.12 No meaningful search possible

A limitation of the search may also result from the application not meeting the relevant requirements of the Act to such an extent that a meaningful search of the claims, or of some of the claims, or of part of a claim, is impossible. In such cases, the Examiner should make a meaningful search to the extent that this is possible. What is or is not "meaningful" is a question of fact for the Examiner to determine. The exercise of the discretion of the Examiner will depend upon the facts of the case. There are clearly cases where a search is rendered de facto impossible by the failure to meet the prescribed requirements of the Act. But these are not the only circumstances under which Rule 45 may be invoked. The word "meaningful" should be construed reasonably.

On the one hand, the word "meaningful" should not be construed in such a way that it is invoked simply because a search is difficult. On the other hand, it may be the case that a given claim could, theoretically, be searched completely, but that nevertheless, the Examiner comes to the conclusion, under a proper consideration of the relevant provisions of the Act, that it would not be meaningful to do so, in the sense that it would not serve any useful purpose to do so having regard, for example, to any possible future prosecution of the application.

In other cases, it may be that the results of the search themselves would be quite meaningless. A number of non-limiting examples illustrated below:

(i) Claims lacking support; insufficient disclosure

One example would be the case of a broad or speculative claim supported by only a limited disclosure covering a small part of the scope of the claim. If the broadness of the claim is such as to render a meaningful search over the whole of the claim impossible, the Examiner will carry out the search on the basis of the narrower, disclosed invention. This may mean a search of the specific examples. In such a case, it will often be de facto impossible to do a complete search of the whole of the claim at all, because of the broad drafting style. In other cases, a search of the whole of the claim would serve no useful purpose, as the claim would not be defensible in any subsequent examination phase. Accordingly, the search will be limited. Here, the requirements underlying the limitation would be those of sufficiency of disclosure and support set out in section 34(5) and section 53(2).

(ii) Claims lacking conciseness

An example would be where there are so many claims, or so many possibilities within a claim, that it becomes unduly burdensome to determine the matter for which protection is

sought. A complete search (or any search at all) may de facto be impossible, or alternatively may serve no useful purpose as the claim or claim set would be indefensible in any subsequent examination phase. Again, a partial search or a declaration of no search at all may be appropriate, on the grounds that the lack of conciseness of the claim(s) is such as to render a meaningful search impossible.

(iii) Claims lacking clarity

An example would be where the applicant's choice of parameter to define his invention renders a meaningful comparison with the prior art impossible, perhaps because the prior art has not employed the same parameter, or has employed no parameter at all. In such a case, the parameter chosen by the applicant may lack clarity. It may be that the lack of clarity of the parameter is such as to render a meaningful search of the claims or of a claim or of a part of a claim impossible, because the results of any search would be meaningless, the choice of parameter rendering a sensible comparison of the claimed invention with the prior art impossible. If so, a partial search will be appropriate, the search possibly being restricted to the worked examples, as far as they can be understood, or to the way in which the desired parameter is obtained.

These examples are not exhaustive. The basic principle is that there should be clarity and openness both for the applicant and for third parties as to what has and what has not been searched. Exceptionally, the Examiner may, at his own discretion, where he thinks it appropriate, ask the applicant informally for clarification before deciding whether or not to limit the search in respect of some or all of the claims, or for part of a claim or issue a declaration replacing the search report.

If the deficiencies which rendered a meaningful search impossible are subsequently corrected by amendment or if their existence is successfully refuted by the applicant during the substantive phase of examination, then an additional search may be carried out in the examination procedure.

5.13 Search report

General

The results of the search will be recorded in a search report. A number of different possible limitations of the scope of the search report exist. These are:
(i) where claims are deemed abandoned for non-payment of claims fees;
(ii) a declaration replacing the search report
(iii) a partial search report according;
(iv) a partial search report due to a finding of a lack of unity of invention.

A search report must contain no matter, in particular no expressions of opinion, reasoning, arguments or explanations, other than that required as in the search form.

Form

The search report should be prepared by the examiner and should contains a main page to be used for all searches for recording the important features of the search, such as:
(i) the application number;
(ii) the classification of the application;
(iii) the fields searched;
(iv) the relevant documents revealed by the search; and
(v) the name of the examiner who executed the search, as well as supplemental sheet.

Supplemental sheet is to be used for indicating approval or modifications of the title, the abstract as submitted by the applicant, and the figure to be published with the abstract.
The supplemental sheet is also to be completed where there are restrictions on the search, i.e. when claims incurring fees are not searched due to non-payment of claims fees, when unity of invention is lacking, or when a meaningful search is not possible such that the search report is a partial one or is completely replaced by a declaration that no meaningful search can be conducted.

Chapter VI: Substantive Examination

6.1 Introduction

The Purpose of examination is to ensure that the application and the invention to which it relates meet the requirements set out in the relevant sections of the Act and the Regulations. The prime task of the Examiner at this stage is to deal with the substantive requirements however there he should ensure that formality requirement have been complied with. In the event that there are deficiencies of formal requirements the applicants should be invited to remedy the deficiencies.

During substantive examination main areas of focus for the examiner include:

(i) Sufficiency of disclosure
(ii) Claims supported by description (enabled)
(iii) Unity invention
(iv) Novelty
(v) Inventive step
(vi) Industrial applicability
(vii) Matters excluded from patentability
(viii) Matters prejudicial to public order, morality, safety and environment

6.2 Sufficiency of disclosure

A detailed description of at least one way of carrying out the invention must be given. Since the application is addressed to the person skilled in the art, it is neither necessary nor desirable that details of well-known ancillary features should be given, but the description must disclose any feature essential for carrying out the invention in sufficient detail to render it apparent to the skilled person how to put the invention into practice. A single example may suffice, but where the claims cover a broad field, the application should not usually be regarded as satisfying the requirements of section 34(5) unless the description gives a number of examples or describes alternative embodiments or variations extending over the area protected by the claims.

There are some instances where even a very broad field is sufficiently exemplified by a limited number of examples or even one example. In these latter cases the application must contain, in addition to the examples, sufficient information to allow the person skilled in the art, using his common general knowledge, to perform the invention over the whole area claimed without undue burden and without needing inventive skill. If the Examiner is able to make out a reasoned case that the application lacks sufficient disclosure, the onus of establishing that the invention may be performed and repeated over substantially the whole of the claimed range lies with the applicant. it is necessary that the invention is described not only in terms of its structure but also in terms of its function, unless the functions of the various parts are immediately apparent. Indeed in some technical fields (e.g. computers), a clear description of function may be much more appropriate than an over-detailed description of structure.

It is the responsibility of the applicant to ensure that he supplies, on filing his application, a sufficient disclosure, i.e. one that meets the requirements of Section 34(5) in respect of the invention as claimed in all of the claims. If the claims define the invention, or a feature thereof, in terms of parameters, the application as filed must include a clear description of the methods used to determine the parameter values, unless a person skilled in the art would know what method to use or unless all methods would yield the same result. If the disclosure is seriously insufficient, such a deficiency cannot be cured subsequently by adding further examples or features without offending against Section 36(1), which requires that amendments may not result in the introduction of subject-matter which extends beyond the content of the application as filed. Therefore, in such circumstances, the application must normally be refused. If, however, the deficiency arises only in respect of some embodiments of the invention and not others, it could be remedied by restricting the claims to correspond to the sufficiently described embodiments only, the description of the remaining embodiments being deleted.

6.3 Insufficient disclosure

Occasionally applications are filed in which there is a fundamental insufficiency in the invention in the sense that it cannot be carried out by a person skilled in the art; there is then a failure to satisfy the requirements of Section 34(5) which is essentially irreparable. Two instances deserve special mention. The first is where the successful performance of the invention is dependent on chance. That is to say, the skilled person, in following the instructions for carrying out the invention, finds either that the alleged results of the invention are unrepeatable or that success in obtaining these results is achieved in a totally unreliable way. An example where this may arise is a microbiological process involving mutations. Such a case should be distinguished from one where repeated success is assured even though accompanied by a proportion of failures, as can arise e.g. in the manufacture of small magnetic cores or electronic components. In this latter case, provided the satisfactory parts can be readily sorted by a non-destructive testing procedure, no objection arises under Section 34(5). The second instance is where successful performance of the invention is inherently impossible because it would be contrary to well-established physical laws – this applies e.g. to a perpetual motion machine. If the claims for such a machine are directed to its function, and not merely to its structure, an objection arises not only under Section 34(5) but also under section 25 in that the invention is not industrially applicable.

6.4 Industrial application

The description should indicate explicitly the way in which the invention is capable of exploitation in industry, if this is not obvious from the description or from the nature of the invention. it is to be expected that, in most cases, the way in which the invention can be exploited in industry will be self-evident, so that no more explicit description on this point will be required; but there may be a few instances, e.g. in relation to methods of testing, where the manner of industrial exploitation is not apparent and must therefore be explicitly indicated.
Also, in relation to certain biotechnological inventions, i.e. sequences and partial sequences of genes, the industrial application is not self-evident.
The industrial application of such sequences must be disclosed in the patent application.

6.5 Manner and order of presentation

The manner and order of presentation of the description should be that specified in Regulation 13(2) unless, because of the nature of the invention, a different manner or a different order would afford a better understanding and a more economic presentation.

Since the responsibility for clearly and completely describing the invention lies with the applicant, the examiner should not object to the presentation unless satisfied that such an

objection would be a proper exercise of his discretion. Some departure from the requirements of Regulation 13(2) is acceptable, provided the description is clear and orderly and all the requisite information is present. Certain technically simple inventions may be fully comprehensible with the minimum of description and only slight reference to prior art.

6.6 Terminology

Although the description should be clear and straightforward with avoidance of unnecessary technical jargon, the use of recognised terms of art is acceptable, and will often be desirable. Little-known or specially formulated technical terms may be allowed provided that they are adequately defined and that there is no generally recognised equivalent.

This discretion may be extended to foreign terms when there is no equivalent in the language of the proceedings. Terms already having an established meaning should not be allowed to be used to mean something different if this is likely to cause confusion. There may, however, be circumstances where a term may legitimately be borrowed from an analogous Art. Terminology and signs must be consistent throughout the application.

6.7 Computer programs

In the particular case of inventions in the computer field, program listings in programming languages cannot be relied on as the sole disclosure of the invention. The description, as in other technical fields, should be written substantially in normal language, possibly accompanied by flow diagrams or other aids to understanding, so that the invention may be understood by those skilled in the art who are deemed not to be programming specialists. Short excerpts from programs written in commonly used programming languages can be accepted if they serve to illustrate an embodiment of the invention.

6.8 Physical values, units

When the properties of a material are referred to, the relevant units should be specified if quantitative considerations are involved. If this is done by reference to a published standard (e.g. a standard of sieve sizes) and such standard is referred to by a set of initials or similar abbreviation, it should be adequately identified in the description.

Physical values must be expressed in the units recognised in international practice, which is generally in the metric system, using SI units. Any values not meeting this requirement must also be expressed in the units recognised in international practice (Regulation 17(20). Values in the inch/pound system, in general, do not meet the criterion "recognised in international practice".

For mathematical formulae the symbols in general use must be employed. For chemical formulae, the symbols, atomic weights and molecular formulae in general use must be employed. In general, use should be made of the technical terms, signs and symbols generally accepted in the field in question.

6.9 Proper names, trademarks and trade names

The use of proper names, trademarks or trade names or similar words to refer to materials or articles is undesirable insofar as such words merely denote origin or where they may relate to a range of different products. If such a word is used, then, where it is necessary in order to satisfy the requirements of Section 34(5), the product must be sufficiently identified, without reliance upon the word, to enable the invention to be carried out by the skilled person at the date of filing. However, where such words have become internationally accepted as standard descriptive terms and have acquired a precise meaning (e.g. "Bowden" cable, "Belleville" washer, "Panhard" rod, "teflon" layer, "caterpillar" belt) they may be allowed without further identification of the product to which they relate.

6.10 Registered trademarks

It is the applicant's responsibility to ensure that registered trademarks are acknowledged as such in the description.

6.11 Reference documents

References to other documents may relate either to the background art or to part of the disclosure of the invention. Where the reference document relates to the background art, it may be in the application as originally filed or introduced at a later date.

Where the reference document relates directly to the disclosure of the invention (e.g. details of one of the components of a claimed apparatus), then the examiner should first consider whether knowing what is in the reference document is in fact essential for carrying out the invention as meant by Section 34(5): If not essential, the usual expression "which is hereby incorporated by reference", or any expression of the same kind, should be deleted from the description.

If matter in the document referred to is essential to satisfy the requirements of Section 34(5), the examiner should require the deletion of the above-mentioned expression and that, instead, the matter is expressly incorporated into the description, because the patent specification should, regarding the essential features of the invention, be self-contained, i.e. capable of being understood without reference to any other document.

6.12 Drawings

6.12.1 Form and content

The requirements relating to the form and content of drawings are set down in Regulation 15. The only question likely to cause difficulty is whether the textual matter included on the drawings is absolutely indispensable. In the case of circuit diagrams, block schematics and flow sheets, identifying catchwords for functional integers of complex systems (e.g. "magnetic core store", "speed integrator") may be regarded as indispensable from a practical point of view if they are necessary to enable a diagram to be interpreted rapidly and clearly.

6.12.2 Printing quality

The examiner has also to check whether the drawings are suitable for reproduction.

6.12.3 Photographs

The Act makes no express provision for photographs. They are nevertheless allowed where it is impossible to present in a drawing what is to be shown and provided that they are in black and white, directly reproducible and fulfil the applicable requirements for drawings (e.g. paper size, margins, etc.). Colour photographs are not accepted.

6.13 Inventions relating to biological material

6.13.1 Biological material

Applications relating to biological material are subject to the special provisions set out in Regulation 11. The term "self-replicable matter" means any material containing genetic information and capable of reproducing itself or being reproduced in a biological system. If an invention involves the use of or concerns biological material which is not available to the public and which cannot be described in the patent application in such a manner as to enable the invention to be carried out by a person skilled in the art, the disclosure is not considered to have satisfied the requirements of Section 34(5) unless the requirements of Regulation 11 have been met.

6.13.2 Public availability of biological material

The examiner must form an opinion as to whether or not the biological material is available to the public. There are several possibilities. The biological material may be known to be readily available to those skilled in the art, e.g. baker's yeast or Bacillus natto, which is commercially available, it may be a standard preserved strain, or other biological material which the examiner knows to have been preserved in a recognised depository and to be available to the public. Alternatively, the applicant may have given in the description sufficient information as to the identifying characteristics of the biological material and as to the prior availability in a depositary institution recognised for the purposes of Regulation 11 to satisfy the examiner. In any of these cases no further action is called for. If, however, the applicant has given no or insufficient information on public availability and the biological material is a particular strain not falling within the known categories such as those already mentioned, then the examiner must assume that the biological material is not available to the public. He must also examine whether the biological material could be described in the patent application in such a manner as to enable the invention to be carried out by a person skilled in the art.

6.13.4 Deposit of biological material

If the biological material is not available to the public and if it cannot be described in the application in such a manner as to enable the invention to be carried out by a person skilled in the art, the examiner must check:
(i) whether the application as filed gives such relevant information as is available to the applicant on the characteristics of the biological material. The relevant information under this provision concerns the classification of the biological material and significant differences from known biological material. For this purpose, the applicant must, to the extent available to him, indicate morphological and biochemical characteristics and the proposed taxonomic description.

The information on the biological material in question which is generally known to the skilled person on the date of filing is as a rule presumed to be available to the applicant and must therefore be provided by him. If necessary, it has to be provided through experiments in accordance with the relevant standard literature.

Against this background, information should then be given on every further specific morphological or physiological characteristic relevant for recognition and propagation of the biological material, e.g. suitable media (composition of ingredients), in particular where the latter are modified.

Abbreviations for biological material or media are often less well known than the applicant assumes and should therefore be avoided or written in full at least once.

If biological material is deposited that cannot replicate itself but must be replicated in a biological system (e.g. viruses, bacteriophages, plasmids, vectors or free DNA or RNA), the above-mentioned information is also required for such biological system. If, for example, other biological material is required, such as host cells or helper viruses, that cannot be sufficiently described or is not available to the public, this material must also be deposited and characterised accordingly. In addition, the process for producing the biological material within this biological system must be indicated.

In many cases the above required information will already have been given to the depositary institution.

6.14 Claims

(section 34 (6))
The application must contain "one or more claims". The claims must:
(i) "define the matter for which protection is sought";
(ii) "be clear and concise"; and
(iii) "be supported by the description".

Since the extent of the protection conferred by a patent or application is determined by the terms of the claims (interpreted with the help of the description and the drawings), clarity of claim is of the utmost importance.

6.14 Form and content of claims

a) Technical features

The claims must be drafted in terms of the "technical features of the invention". This means that claims should not contain any statements relating, for example, to commercial advantages or other non-technical matters, but statements of purpose should be allowed if they assist in defining the invention. It is not necessary that every feature should be expressed in terms of a structural limitation. Functional features may be included provided that a skilled person would have no difficulty in providing some means of performing this function without exercising inventive skill. Claims to the use of the invention, in the sense of the technical application thereof, are allowable.

b) Two-part form

Regulation 14(2) and (3) define the two-part form which a claim should have. The first part should contain a statement indicating "the designation of the subject-matter of the invention" i.e. the general technical class of apparatus, process, etc. to which the invention relates, followed by a statement of "those technical features which are necessary for the definition of the claimed subject-matter but which, in combination, are part of the prior art". This statement of prior-art features is applicable only to independent claims and not to dependent claims.

It is clear from the wording of Regulation 14 that it is necessary only to refer to those prior-art features which are relevant to the invention. For example, if the invention relates to a photographic camera but the inventive step relates entirely to the shutter, it would be sufficient for the first part of the claim to read: "A photographic camera including a focal plane shutter" and there is no need to refer also to the other known features of a camera such as the lens and view-finder. The second part or "characterising portion" should state the features which the invention adds to the prior art, i.e. the technical features for which, in combination with the features stated in sub-paragraph (a) (the first part), protection is sought.

If a single document in the state of the art cited in the search report, reveals that one or more features in the second part of the claim were already known in combination with all the features in the first part of the claim and in that combination have the same effect as they have in the full combination according to the invention, the examiner should require that such feature or features be transferred to the first part. Where, however, a claim relates to a novel combination, and where the division of the features of the claim between the prior-art part and the characterising part could be made in more than one way without inaccuracy, the applicant should not be pressed, unless there are very substantial reasons, to adopt a different division of the features from that which he has chosen, if his version is not incorrect.

c) Formulae and tables

The claims, as well as the description, may contain chemical or mathematical formulae but not drawings.

6.15 Kinds of claim

a) Categories

The Act refers to different "categories" of claim (products, process or new use). For many inventions, claims in more than one category are needed for full protection. In fact, there are only two basic kinds of claim, viz. claims to a physical entity (product, apparatus) and claims to an activity (process, use). The first basic kind of claim ("product claim") includes a substance or compositions (e.g. chemical compound or a mixture of compounds) as well as any physical entity (e.g. object, article, apparatus, machine, or system of co-operating apparatus) which is produced by a person's technical skill. Examples are: "a steering mechanism incorporating an automatic feed-back circuit ..."; "a woven garment comprising ..."; "an insecticide consisting of X, Y, Z"; or "a communication system comprising a plurality of transmitting and receiving stations".

The second basic kind of claim ("process claim") is applicable to all kinds of activities in which the use of some material product for effecting the process is implied; the activity may be exercised upon material products, upon energy, upon other processes (as in control processes) or upon living things.

b) Number of independent claims

The number of independent claims is not limited but the independent claims must relate to a single product or a single process.

The following are examples of typical situations falling within the scope of the exceptions from the principle of one independent claim per category:

(i) examples of a plurality of inter-related products
- – plug and socket;
- – transmitter – receiver;
- – intermediate(s) and final chemical product;
- – gene – gene construct – host – protein – medicament;

(ii) example of a plurality of different inventive uses of a product or device:
- – second or further medical uses in the claim format of a "second medical use"-type claim;

(iii) examples of alternative solutions to a particular problem:
- – a group of chemical compounds;
- – two or more processes for the manufacture of such compounds.

c) Independent and dependent claims

All applications will contain one or more independent claims directed to the essential features of the invention. Any such claim may be followed by one or more claims concerning particular embodiments of that invention. It is evident that any claim relating to a particular embodiment must effectively include also the essential features of the invention, and hence must include all the features of at least one independent claim. The term "particular embodiment" should be construed broadly as meaning any more specific disclosure of the invention than that set out in the independent claim or claims.

Any claim which includes all the features of any other claim is termed a "dependent claim". Such a claim must contain, if possible at the beginning, a reference to the other claim, all features of which it includes. Since a dependent claim does not by itself define all the characterising features of the subject-matter which it claims, expressions such as "characterised in that" or "characterised by" are not necessary in such a claim but are nevertheless permissible. A claim defining further particulars of an invention may include all the features of another dependent claim and should then refer back to that claim. Also, in some cases, a dependent claim may define a particular feature or features which may appropriately be added to more than one previous claim (independent or dependent). It follows that there are several possibilities: a dependent claim may refer back to one or more independent claims, to one or more dependent claims, or to both independent and dependent claims.

d) Arrangement of claims

All dependent claims referring back to a single previous claim and those referring back to several previous claims must be grouped together to the extent and in the most appropriate way possible. The arrangement must therefore be one which enables the association of related claims to be readily determined and their meaning in association to be readily construed. The examiner should object if the arrangement of claims is such as to create obscurity in the definition of the subject-matter to be protected. In general, however, when the corresponding independent claim is allowable, the examiner should not concern himself unduly with the subject-matter of dependent claims, provided he is satisfied that they are truly dependent and thus in no way extend the scope of protection of the invention defined in the corresponding independent claim.

e) Subject-matter of a dependent claim

If the two-part form is used for the independent claim(s), dependent claims may relate to further details of features not only of the characterising portion but also of the preamble.

f) Alternatives in a claim

A claim, whether independent or dependent, may refer to alternatives, provided that the number and presentation of alternatives in a single claim does not make the claim obscure or difficult to construe and provided that the claim meets the requirements of unity. In case of a claim defining (chemical or non-chemical) alternatives, i.e. a so-called "Markush-grouping", unity of invention should be considered to be present if the alternatives are of a similar nature and can fairly be substituted for one another.

g) Independent claims containing a reference to another claim

A claim may also contain a reference to another claim even if it is not a dependent claim. One example of this is a claim referring to a claim of a different category (e.g. "Apparatus for carrying out the process of claim 1 ...", or "Process for the manufacture of the product of claim 1 ..."). Similarly, in a situation like the plug and socket example above , a claim to the one part referring to the other co-operating part (e.g. "plug for co-operation with the socket of claim 1 ...") is not a dependent claim. In all these examples, the examiner should carefully consider the extent to which the claim containing the reference necessarily involves the features of the claim referred to and the extent to which it does not.

In the case of a claim for a process which results in the product of a product claim, if the product claim is patentable then no separate examination for the novelty and non-obviousness of the process claim is necessary, provided that all features of the product as

defined in the product claim inevitably result from the claimed process. This also applies in the case of a claim for the use of a product, when the product is patentable and is used with its features as claimed. In all other instances, the patentability of the claim referred to does not necessarily imply the patentability of the independent claim containing the reference. It should also be noted that if the process, product and/or use claims have different effective dates, a separate examination may still be necessary in view of intermediate documents.

6.16 Clarity and interpretation of claims

a) Clarity

The requirement that the claims must be clear applies to individual claims and also to the claims as a whole. The clarity of the claims is of the utmost importance in view of their function in defining the matter for which protection is sought. Therefore, the meaning of the terms of a claim should, as far as possible, be clear for the person skilled in the art from the wording of the claim alone. In view of the differences in the scope of protection which may be attached to the various categories of claims, the examiner should ensure that the wording of a claim leaves no doubt as to its category.

b) Interpretation

Each claim should be read giving the words the meaning and scope which they normally have in the relevant art, unless in particular cases the description gives the words a special meaning, by explicit definition or otherwise. Moreover, if such a special meaning applies, the examiner should, so far as possible, require the claim to be amended whereby the meaning is clear from the wording of the claim alone. The claim should also be read with an attempt to make technical sense out of it. Such a reading may involve a departure from the strict literal meaning of the wording of the claims.

c) Inconsistencies

Any inconsistency between the description and the claims should be avoided if it may throw doubt on the extent of protection and therefore render the claim unclear or unsupported or alternatively, render the claim objectionable. Such inconsistency can be of the following kinds:

(i) Simple verbal inconsistency

For example, there is a statement in the description which suggests that the invention is limited to a particular feature but the claims are not thus limited; also, the description places no particular emphasis on this feature and there is no reason for believing that the feature is essential for the performance of the invention. In such a case, the inconsistency can be removed either by broadening the description or by limiting the claims.
Similarly, if the claims are more limited than the description, the claims may be broadened or the description may be limited.

(ii) Inconsistency regarding apparently essential features

For example, it may appear, either from general technical knowledge or from what is stated or implied in the description, that a certain described technical feature not mentioned in an independent claim is essential to the performance of the invention, or, in other words, is necessary for the solution of the problem to which the invention relates. The examiner may draw the attention of the applicant to the inconsistency. If, in response, the applicant shows convincingly, e.g. by means of additional documents or other evidence, that the feature is in fact not essential, he may be allowed to retain the unamended claim and, where necessary, to amend the description instead. The opposite situation in which an independent claim

includes features which do not seem essential for the performance of the invention is not objectionable. This is a matter of the applicant's choice. The examiner should therefore not suggest that a claim be broadened by the omission of apparently inessential features;

(iii) part of the subject-matter of the description and/or drawings is not covered by the claims

For example, the claims all specify an electric circuit employing semiconductor devices but one of the embodiments in the description and drawings employs electronic tubes instead. In such a case, the inconsistency can normally be removed either by broadening the claims (assuming that the description and drawings as a whole provide adequate support for such broadening) or by removing the "excess" subject-matter from the description and drawings. However, if examples in the description and/or drawings which are not covered by the claims are presented not as embodiments of the invention but as background art or examples which are useful for understanding the invention, the retention of these examples may be allowed.

d) General statements, "spirit" of invention

General statements in the description which imply that the extent of protection may be expanded in some vague and not precisely defined way should be objected to. In particular, objection should be raised to any statement which refers to the extent of protection being expanded to cover the "spirit" of the invention. Objection should likewise be raised, in the case where the claims are directed to a combination of features, to any statement which seems to imply that protection is nevertheless sought not only for the combination as a whole but also for individual features or sub-combinations thereof.

e) Essential features

An independent claim should specify explicitly all of the essential features needed to define the invention except insofar as such features are implied by the generic terms used, e.g. a claim to a "bicycle" does not need to mention the presence of wheels.

If a claim is to a process for producing the product of the invention, then the process as claimed should be one which, when carried out in a manner which would seem reasonable to a person skilled in the art, necessarily has as its end result that particular product; otherwise there is an internal inconsistency and therefore lack of clarity in the claim.

In the case of a product claim, if the product is of a well-known kind and the invention lies in modifying it in certain respects, it is sufficient that the claim clearly identifies the product and specifies what is modified and in what way. Similar considerations apply to claims for an apparatus. Where patentability depends on a technical effect, the claims must be so drafted as to include all the technical features of the invention which are essential for the technical effect.

f) Relative terms

It is preferable not to use a relative or similar term such as "thin", "wide" or "strong" in a claim unless the term has a well-recognised meaning in the particular art, e.g. "high-frequency" in relation to an amplifier, and this is the meaning intended. Where the term has no well-recognised meaning it should, if possible, be replaced by a more precise wording found elsewhere in the original disclosure. Where there is no basis in the disclosure for a clear definition and the term is not essential having regard to the invention, it should normally be retained in the claim, because to excise it would generally lead to an extension of the subject-matter beyond the content of the application as filed. However, an unclear term cannot be allowed in a claim if the term is essential having regard to the invention.

Equally, an unclear term cannot be used by the applicant to distinguish his invention from the prior art.

g) Terms like "about" and "approximately"

Particular attention is required whenever the word "about" or similar terms such as "approximately" are used. Such a word may be applied, for example, to a particular value (e.g. "about 200C") or to a range (e.g."about x to about y"). In each case, the examiner should use his judgment as to whether the meaning is sufficiently clear in the context of the application read as a whole. However, the word can only be permitted if its presence does not prevent the invention from being unambiguously distinguished from the prior art with respect to novelty and inventive step.

h) Trademarks

The use of trade marks and similar expressions in claims should not be allowed as it may not be guaranteed that the product or feature referred to is not modified while maintaining its name during the term of the patent. They may be allowed exceptionally if their use is unavoidable and they are generally recognised as having a precise meaning.

i) Optional features

Expressions like "preferably", "for example", "such as" or "more particularly" should be looked at carefully to ensure that they do not introduce ambiguity. Expressions of this kind have no limiting effect on the scope of a claim; that is to say, the feature following any such expression is to be regarded as entirely optional.

j) Result to be achieved

The area defined by the claims must be as precise as the invention allows. As a general Regulation, claims which attempt to define the invention by a result to be achieved should not be allowed, in particular if they only amount to claiming the underlying technical problem. However, they may be allowed if the invention either can only be defined in such terms or
cannot otherwise be defined more precisely without unduly restricting the scope of the claims and if the result is one which can be directly and positively verified by tests or procedures adequately specified in the description or known to the person skilled in the art and which do not require undue experimentation For example, the invention may relate to an ashtray in which a smouldering cigarette end will be automatically extinguished due to the shape and relative dimensions of the ashtray. The latter may vary considerably in a manner difficult to define whilst still providing the desired effect. So long as the claim specifies the construction and shape of the ashtray as clearly as possible, it may define the relative dimensions by reference to the result to be achieved, provided that the specification includes adequate directions to enable the reader to determine the required dimensions by routine test procedures. It should be noted that the above-mentioned requirements for allowing a definition of subject-matter in terms of a result to be achieved differ from those for allowing a definition of subject-matter in terms of functional features.

6.17 Parameters

Where the invention relates to a product, it may be defined in a claim in various ways, viz. as a chemical product by its chemical formula, as a product of a process (if no clearer definition is possible) or, exceptionally, by its parameters. Parameters are characteristic

values, which may be values of directly measurable properties (e.g. the melting point of a substance, the flexural strength of steel, the resistance of an electrical conductor) or may be defined as more or less complicated mathematical combinations of several variables in the form of formulae. Characterisation of a product mainly by its parameters should only be allowed in those cases where the invention cannot be adequately defined in any other way, provided that those parameters can be clearly and reliably determined either by indications in the description or by objective procedures which are usual in the art. The same applies to a process-related feature which is defined by parameters. Cases in which unusual parameters are employed or a non-accessible apparatus for measuring the parameter(s) is used are prima facie objectionable on grounds of lack of clarity, as no meaningful comparison with the prior art can be made. Such cases might also disguise lack of novelty. Whether the method of and the means for measurement of the parameters need also be in the claim.

6.18 Product-by-process claim

Claims for products defined in terms of a process of manufacture are allowable only if the products as such fulfil the requirements for patentability, i.e. inter alia that they are new and inventive. A product is not rendered novel merely by the fact that it is produced by means of a new process. A claim defining a product in terms of a process is to be construed as a claim to the product as such.

The claim may for instance take the form "Product X obtainable by process Y". Irrespective of whether the term "obtainable", "obtained", "directly obtained" or an equivalent wording is used in the product-by process claim, it is still directed to the product per se and confers absolute protection upon the product.

If the subject-matter of a patent is a process, the protection conferred by the patent extends to the products directly obtained by such process. The provisions of the Act are understood to apply to processes producing products completely different from the starting materials as well as to the processes producing only superficial changes (e.g. painting, polishing).

6.19 "Apparatus for ...", "Method for ...", etc.

If a claim commences with such words as: "Apparatus for carrying out the process etc..." this must be construed as meaning merely apparatus suitable for carrying out the process. Apparatus which otherwise possesses all of the features specified in the claims but which would be unsuitable for the stated purpose or would require modification to enable it to be so used, should normally not be considered as anticipating the claim.

Similar considerations apply to a claim for a product for a particular use. For example, if a claim refers to a "mould for molten steel", this implies certain limitations for the mould. Therefore, a plastic ice cube tray with a melting point much lower than that of steel would not come within the claim. Similarly, a claim to a substance or composition for a particular use should be construed as meaning a substance or composition which is in fact suitable for the stated use; a known product which prima facie is the same as the substance or composition defined in the claim, but which is in a form which would render it unsuitable for the stated use, would not deprive the claim of novelty. However, if the known product is in a form in which it is in fact suitable for the stated use, though it has never been described for that use, it would deprive the claim of novelty. An exception to this general principle of interpretation is where the claim is to a known substance or composition for use in a surgical, therapeutic or diagnostic method.

In contrast to an apparatus or product claim, in case of a method claim commencing with such words as: "Method for remelting galvanic layers" the part "for remelting ..." should not be understood as meaning that the process is merely suitable for remelting galvanic layers, but rather as a functional feature concerning the remelting of galvanic layers and, hence, defining one of the method steps of the claimed method

6.20 Definition by reference to use or another entity

Where a claim in respect of a physical entity (product, apparatus) seeks to define the invention by reference to features relating to the entity's use, a lack of clarity can result. This is particularly the case where the claim not only defines the entity itself but also specifies its relationship to a second entity which is not part of the claimed entity (for example, a cylinder head for an engine, where the former is defined by features of its location in the latter).
Before considering a restriction to the combination of the two entities, if should always be remembered that the applicant is normally entitled to independent protection of the first entity per se, even if it was initially defined by its relationship to the second entity.

Since the first entity can often be produced and marketed independently of the second entity, it will usually be possible to obtain independent protection by wording the claims appropriately (for example, by substituting "connectable" for "connected"). If it is not possible to give a clear definition of the first entity per se, then the claim should be directed to a combination of the first and second entities (for example, "engine with a cylinder head" or "engine comprising a cylinder head").

It may also be allowable to define the dimensions and/or shape of a first entity in an independent claim by general reference to the dimensions and/or corresponding shape of a second entity which is not part of the claimed first entity but is related to it through use. This particularly applies where the size of the second entity is in some way standardized (for example, in the case of a mounting bracket for a vehicle number plate, where the bracket frame and fixing elements are defined in relation to the outer shape of the number-plate). However, references to second entities which cannot be seen as subject to standardization may also be sufficiently clear in cases where the skilled person would have little difficulty in inferring the resultant restriction of the scope of protection for the first entity (for example, in the case of a covering sheet for an agricultural round bale, where the length and breadth of the covering sheet and how it is folded are defined by reference to the bale's circumference, width and diameter.

It is neither necessary for such claims to contain the exact dimensions of the second entity, nor do they have to refer to a combination of the first and second entities. Specifying the length, width and/or height of the first entity without reference to the second would lead to an unwarranted restriction of the scope of protection.

6.21 The expression "in"

To avoid ambiguity, particular care should be exercised when assessing claims which employ the word "in" to define a relationship between different physical entities (product, apparatus), or between entities and activities (process, use), or between different activities. Examples of claims worded in this way include the following:

(i) Cylinder head in a four-stroke engine;

(ii) In a telephone apparatus with an automatic dialler, dial tone detector and feature controller, the dial tone detector comprising...;

(iii) In a process using an electrode feeding means of an arc-welding apparatus, a method for controlling the arc welding current and voltage comprising the following steps: ...; and

(iv) In a process/system/apparatus etc. ... the improvement consisting of...

In examples (i) to (iii) the emphasis is on the fully functioning sub-units (cylinder head, dial tone detector, method for controlling the arc welding current and voltage) rather than the complete unit within which the subunit is contained (four-stroke engine, telephone, process).

This can make it unclear whether the protection sought is limited to the sub-unit per se, or whether the unit as a whole is to be protected. For the sake of clarity, claims of this kind should be directed either to "a unit with (or comprising) a sub-unit" (e.g. "four-stroke engine with a cylinder head"), or to the subunit per se, specifying its purpose (for example, "cylinder head for a four stroke engine"). With claims of the type indicated by example (iv), the use of the word "in" sometimes makes it unclear whether protection is sought for the improvement only or for all the features defined in the claim. Here, too, it is essential to ensure that the wording is clear.

However, claims such as "use of a substance ... as an anticorrosive ingredient in a paint or lacquer composition" are acceptable on the basis of second non-medical use

6.22 Use claims

For the purposes of examination, a "use" claim in a form such as "the use of substance X as an insecticide" should be regarded as equivalent to a "process" claim of the form "a process of killing insects using substance X". Thus a claim in the form indicated should not be interpreted as directed to the substance X recognisable (e.g. by further additives) as intended for use as an insecticide.

Similarly, a claim for "the use of a transistor in an amplifying circuit" would be equivalent to a process claim for the process of amplifying using a circuit containing the transistor and should not be interpreted as being directed to "an amplifying circuit in which the transistor is used", nor to "the process of using the transistor in building such a circuit".

6.23 References to the description or drawings

The claims must not, in respect of the technical features of the invention, rely on references to the description or drawings "except where absolutely necessary". In particular they must not normally rely on such references as "as described in part ... of the description", or "as illustrated in Figure 2 of the drawings". The emphatic wording of the excepting clause should be noted. The onus is upon the applicant to show that it is "absolutely necessary" to rely on reference to the description or drawings in appropriate cases. An example of an allowable exception would be that in which the invention involves some peculiar shape, illustrated in the drawings, but which cannot be readily defined either in words or by a simple mathematical formula.

6.24 Method of and means for measuring parameters referred to in claims

A further special case is where the invention is characterised by parameters. Provided that the conditions for defining the invention in this way are met, the definition of the invention should appear completely in the claim itself whenever this is reasonably practicable. In principle the method of measurement is necessary for the unambiguous definition of the parameter. The method of and means for measurement of the parameter values need not however be in the claims when:

(i) the description of the method is so long that its inclusion would make the claim unclear through lack of conciseness or difficult to understand; in that case the claim should include a reference to the description;
(ii) a person skilled in the art would know which method to employ, e.g. because there is only one method, or because a particular method is commonly used; or
(iii) all known methods yield the same result (within the limits of measurement accuracy).

However, in all other cases the method of and means for measurement should be included in the claims as the claims define the matter for which protection is sought.

6.25 Reference signs

If the application contains drawings, and the comprehension of the claims would be improved by establishing the connection between the features mentioned in the claims and the corresponding reference signs in the drawings, then appropriate reference signs should be placed in parentheses after the features mentioned in the claims. If there is a large number of different embodiments, only the reference signs of the most important embodiments need be incorporated in the independent claim(s).

Where claims are drafted in the two-part form set out in, the reference signs should be inserted not only in the characterising part but also in the preamble of the claims. Reference signs should not however be seen as limiting the extent of the matter protected by the claims; their sole function is to make claims easier to understand.
If text is added to reference signs in parentheses in the claims, lack of clarity can arise. 84). Expressions such as "securing means (screw 13, nail 14)" or "valve assembly (valve seat 23, valve element 27, valve seat 28)" are not reference signs but are special features, that are not applicable. A lack of clarity can also arise with bracketed expressions that do not include reference signs, e.g. "(concrete) moulded brick".

In contrast, bracketed expressions with a generally accepted meaning are allowable, e.g. "(meth)acrylate" which is known as an abbreviation for "acrylate and methacrylate". The use of brackets in chemical or mathematical formulae is also unobjectionable.

6.26 Negative limitations (e.g. disclaimers)

A claim's subject-matter is normally defined in terms of positive features indicating that certain technical elements are present. Exceptionally, however, the subject-matter may be restricted using a negative limitation expressly stating that particular features are absent. This may be done e.g. to remove non-patentable embodiments disclosed in the application as filed or if the absence of a feature can be deduced from the application as filed.

Negative limitations such as disclaimers may be used only if adding positive features to the claim either would not define more clearly and concisely the subject-matter still protectable or would unduly limit the scope of the claim.

On the other hand, if a claim for a chemical compound refers to it as "consisting of components A, B and C" by their proportions expressed in percentages, the presence of any additional component is excluded and therefore the percentages should add up to 100%.

6.27 Conciseness, number of claims

The requirement that the claims must be concise refers to the claims in their entirety as well as to the individual claims. The number of claims must be considered in relation to the nature of the invention the applicant seeks to protect. Undue repetition of wording, e.g. between one claim and another, should be avoided by the use of the dependent form.

As for dependent claims, while there is no objection to a reasonable number of such claims directed to particular preferred features of the invention, the examiner should object to a multiplicity of claims of a trivial nature. What is or what is not a reasonable number of claims depends on the facts and circumstances of each particular case.

The interests of the relevant public must also be borne in mind. The presentation of the claims should not make it unduly burdensome to determine the matter for which protection is sought. Objection may also arise where there is a multiplicity of alternatives within a single claim, if
this renders it unduly burdensome to determine the matter for which protection is sought.

6.28 Support in Description

6.28.1 General remarks

The claims must be supported by the description. This means that there must be a basis in the description for the subject-matter of every claim and that the scope of the claims must not be broader than is justified by the extent of the description and drawings and also the contribution to the art.

Most claims are generalisations from one or more particular examples. The extent of generalisation permissible is a matter which the examiner must judge in each particular case in the light of the relevant prior art.

Thus an invention which opens up a whole new field is entitled to more generality in the claims than one which is concerned with advances in a known technology. A fair statement of claim is one which is not so broad that it goes beyond the invention nor yet so narrow as to deprive the applicant of a just reward for the disclosure of his invention. The applicant should be allowed to cover all obvious modifications of, equivalents to and uses of that which he has described. In particular, if it is reasonable to predict that all the variants covered by the claims have the properties or uses the applicant ascribes to them in the description, he should be allowed to draw his claims accordingly.

As a general rule, a claim should be regarded as supported by the description unless there are well-founded reasons for believing that the skilled person would be unable, on the basis of the information given in the application as filed, to extend the particular teaching of the description to the whole of the field claimed by using routine methods of experimentation or analysis. Support must, however, be of a technical character; vague statements or assertions having no technical content provide no basis.

The examiner should raise an objection of lack of support only if he has well-founded reasons. Once the examiner has set out a reasoned case that, for example, a broad claim is not supported over the whole of its breadth, the onus of demonstrating that the claim is fully supported lies with the applicant.

Where objection is raised, the reasons should, where possible, be supported specifically by a published document. A claim in generic form, i.e. relating to a whole class, e.g. of materials or machines, may be acceptable even if of broad scope, if there is fair support in the description and there is no reason to suppose that the invention cannot be worked through the whole of the field claimed. Where the information given appears insufficient to enable a person skilled in the art to extend the teaching of the description to parts of the field claimed but not explicitly described by using routine methods of experimentation or analysis, the examiner should raise a reasoned objection, and invite the applicant to establish, by suitable response, that the invention can in fact be readily applied on the basis of the information given over the whole field claimed or, failing this, to restrict the claim accordingly.

6.28.2 Lack of support vs. insufficient disclosure

It should be noted that, although an objection of lack of support is an objection, it can often, also be considered as an objection of insufficient disclosure of the invention the objection being that the disclosure is insufficient to enable the skilled person to carry out the "invention" over the whole of the broad field claimed (although sufficient in respect of a narrow "invention"). Both requirements are designed to reflect the principle that the terms of a claim should be commensurate with, or be justified by, the invention.

Whether the objection is raised as lack of support or as insufficiency is unimportant in examination proceedings; but it is important in opposition proceedings since there only the latter ground is available.

6.28.3 Support for dependent claims

Where certain subject-matter is clearly disclosed in a claim of the application as filed, but is not mentioned anywhere in the description, it is permissible to amend the description so that it includes this subject-matter. Where the claim is dependent, it may suffice if it is mentioned in the description that the claim sets out a particular embodiment of the invention.

6.29 Unity of invention

6.29.1 General remarks

A patent application must "relate to one invention only or to a group of inventions so linked as to form a single general inventive concept". The second of these alternatives, i.e. the single-concept linked group, may give rise to a plurality of independent claims in the same category.

6.29.2 Special technical features

The link between the inventions must be a technical relationship which finds expression in the claims in terms of the same or corresponding special technical features. The expression "special technical features" means, in any one claim, the particular technical feature or features that define a contribution that the claimed invention considered as a whole makes over the prior art. Once the special technical features of each invention have been identified, one must determine whether or not there is a technical relationship between the inventions and, furthermore, whether or not this relationship involves these special technical features. It is not necessary that the special technical features in each invention be the same.

6.29.3 Intermediate and final products

Unity of invention should be considered to be present in the context of intermediate and final products where:
(i) the intermediate and final products have the same essential structural element, i.e. their basic chemical structures are the same or their chemical structures are technically closely interrelated, the intermediate incorporating an essential structural element into the final product, and
(ii) the intermediate and final products are technically inter-related, i.e. the final product is manufactured directly from the intermediate or is separated from it by a small number of intermediates all containing the same essential structural element. Unity of invention may also be present between intermediate and final products of which the structures are not known – for example, as between an intermediate having a known structure and a final product with unknown structure or as between an intermediate of unknown structure and a final product of unknown structure.

In such cases, there should be sufficient evidence to lead one to conclude that the intermediate and final products are technically closely interrelated as, for example, when the intermediate contains the same essential element as the final product or incorporates an essential element into the final product. Different intermediate products used in different processes for the preparation of the final product may be claimed provided that they have the same essential structural element. The intermediate and final products should not be separated, in the process leading from one to the other, by an intermediate which is not new. Where different intermediates for different structural parts of the final product are claimed, unity should not be regarded as being present between the intermediates.

If the intermediate and final products are families of compounds, each intermediate compound should correspond to a compound claimed in the family of the final products. However, some of the final products may have no corresponding compound in the family of the intermediate products, so the two families need not be absolutely congruent. The mere fact that, besides the ability to be used to produce final products, the intermediates also exhibit other possible effects or activities should not prejudice unity of invention.

6.29.4 Markush grouping

Where a single claim defines (chemical or non-chemical) alternatives, i.e. a so-called "Markush grouping", unity of invention should be considered to be present if the alternatives are of a similar nature. When the Markush grouping is for alternatives of chemical compounds, they should be regarded as being of a similar nature where:

(i) all alternatives have a common property or activity; and
(ii) a common structure is present, i.e. a significant structural element is shared by all of the alternatives, or all alternatives belong to a recognised class of chemical compounds in the art to which the invention pertains.

A "significant structural element is shared by all of the alternatives" where the compounds share a common chemical structure which occupies a large portion of their structures, or, in case the compounds have in common only a small portion of their structures, the commonly shared structure constitutes a structurally distinctive portion in view of existing prior art. The structural element may be a single component or a combination of individual components linked together. The alternatives belong to a "recognised class of chemical compounds" if there is an expectation from the knowledge in the art that members of the class will behave in the same way in the context of the claimed invention, i.e. that each member could be substituted one for the other, with the expectation that the same intended result would be achieved. If it can be shown that at least one Markush alternative is not novel, unity of invention should be reconsidered.

6.29.5 Individual features in a claim

Objection of lack of unity does not arise because of one claim containing a number of individual features, where these features do not present a technical inter-relationship (i.e. a combination), but merely a juxtaposition

6.29.6 Dependent claims

No objection on account of lack of unity a is justified in respect of a dependent claim and the claim on which it depends, on the ground that the general concept they have in common is the subject-matter of the independent claim, which is also contained in the dependent claim. For example, suppose claim 1 claims a turbine rotor blade shaped in a specified manner, while claim 2 is for a "turbine rotor blade as claimed in claim 1 and produced from alloy Z". The common general concept linking the dependent with the independent claim is "turbine rotor blade shaped in a specified manner".

If, however, the independent claim appears not to be patentable, then the question whether there is still an inventive link between all the claims dependent on that claim needs to be carefully considered non-unity. It may be that the "special technical features" of one claim dependent on this non-patentable independent claim are not present in the same or corresponding form in another claim dependent on that claim.

6.30 Unity invention

Lack of unity during substantive examination

The final responsibility for establishing whether the application meets the requirement of unity of invention ultimately rests with the Examiner. The Examiner will normally initially uphold the position taken in the search opinion and will then require deletion of all the inventions other than that which has been searched. If the Examiner is convinced, e.g. by arguments from the applicant, that the opinion on unity at the search stage was incorrect, then an additional search is performed for that part of the subject-matter which is judged to be unitary with an invention which was searched and the examination is carried out on those claims which comply with the requirement of unity of invention.

If the applicant has taken the opportunity to have other inventions searched, then he may determine that the application is to proceed on the basis of any of these, the other(s) being deleted. If the applicant has not yet done so, the examiner should at the beginning of substantive examination, if he maintains the objection of lack of unity, invite the applicant to state on which invention the prosecution of the application should be based and to limit the application accordingly by excising those parts belonging to the other inventions.

Whether or not the question of unity of invention has been raised by the Search Division, it must always be considered by the Examiner. Whenever unity is found to be lacking, the applicant should be required to limit his claims in such a way as to overcome the objection. Excision or amendment of parts of the description may also be necessary. One or more divisional applications, covering matter removed to meet this objection, may be filed.

6.31 Novelty

6.31.1 General remarks

The Act provides that an invention is new if it is not anticipated by prior art. Everything made available to the public anywhere in, the world by means of written disclosure (including drawings and other illustrations) or, by oral disclosure, use, exhibition or other non-written means shall be considered prior art provided that such disclosure occurred

before the date of filing of the application or, if priority is claimed, before the priority date validly claimed in respect thereof.

An invention is considered to be new if it does not form part of the state of the art. It should be noted that in considering novelty, it is not permissible to combine separate items of prior art together. It is also not permissible to combine separate items belonging to different embodiments described in one and the same document, unless such combination has specifically been suggested. However, if a document (the "primary" document) refers explicitly to another document as providing more detailed information on certain features, the teaching of the latter is to be regarded as incorporated into the document containing the reference, if the document referred to was available to the public on the publication date of the document containing the reference. The relevant date for novelty purposes, however, is always the date of the primary document. It is further permissible to use a dictionary or similar document of reference in order to interpret a special term used in a document.

6.31.2 Implicit features or well-known equivalents

A document takes away the novelty of any claimed subject-matter derivable directly and unambiguously from that document including any features implicit to a person skilled in the art in what is expressly mentioned in the document, e.g. a disclosure of the use of rubber in circumstances where clearly its elastic properties are used even if this is not explicitly stated takes away the novelty of the use of an elastic material. The limitation to subject-matter "derivable directly and unambiguously" from the document is important. Thus, when considering novelty, it is not correct to interpret the teaching of a document as embracing well-known equivalents which are not disclosed in the documents; this is a matter of obviousness.

6.31.3 Relevant date of a prior document

In determining novelty, a prior document should be read as it would have been read by a person skilled in the art on the relevant date of the document. By "relevant" date is meant the publication date in the case of a previously published document and the date of filing (or priority date, where appropriate) in the case of a document.

6.31.4 Enabling disclosure of a prior document

Subject-matter described in a document can only be regarded as having been made available to the public, and therefore as comprised in the state if the information given therein to the skilled person is sufficient to enable him, at the relevant date of the document, to practice the technical teaching which is the subject of the document, taking into account also the general knowledge at that time in the field to be expected of him and not published. Similarly, it should be noted that a chemical compound, the name or formula of which is mentioned in a prior-art document, is not thereby considered as known, unless the information in the document, together, where appropriate, with knowledge generally available on the relevant date of the document, enables it to be prepared and separated or, for instance in the case of a product of nature, only to be separated.

6.31.5 Generic disclosure and specific examples

In considering novelty, it should be borne in mind that a generic disclosure does not usually take away the novelty of any specific example falling within the terms of that disclosure, but that a specific disclosure does take away the novelty of a generic claim embracing that disclosure, e.g. a disclosure of copper takes away the novelty of metal as a generic concept, but not the novelty of any metal other than copper, and one of rivets takes away the novelty of fastening means as a generic concept, but not the novelty of any fastening other than rivets.

6.31.7 Implicit disclosure and parameters

In the case of a prior document, the lack of novelty may be apparent from what is explicitly stated in the document itself. Alternatively, it may be implicit in the sense that, in carrying out the teaching of the prior document, the skilled person would inevitably arrive at a result falling within the terms of the claim. An objection of lack of novelty of this kind should be raised by the examiner only where there can be no reasonable doubt as to the practical effect of the prior teaching (for a second nonmedical use.

Situations of this kind may also occur when the claims define the invention, or a feature thereof, by parameters. It may happen that in the relevant prior art a different parameter, or no parameter at all, is mentioned. If the known and the claimed products are identical in all other respects (which is to be expected if, for example, the starting products and the manufacturing processes are identical), then in the first place an objection of lack of novelty arises. If the applicant is able to show, e.g. by appropriate comparison tests, that differences do exist with respect to the parameters, it is questionable whether the application discloses all the features essential to manufacture products having the parameters specified in the claims.

6.31.8 Examination of novelty

In determining novelty of the subject-matter of claims, the examiner should remember that, particularly for claims directed to a physical entity, non-distinctive characteristics of a particular intended use should be disregarded. For example, a claim to a substance X for use as a catalyst would not be considered to be novel over the same substance known as a dye, unless the use referred to implies a particular form of the substance (e.g. the presence of certain additives) which distinguishes it from the known form of the substance. That is to say, characteristics not explicitly stated, but implied by the particular use, should be taken into account.

It should further be borne in mind that a claim to the use of a known compound for a particular purpose (second non-medical use) which is based on a technical effect should be interpreted as including that technical effect as a functional technical feature, and is accordingly not open to objection, provided that such technical feature has not previously been made available to the public.

6.31.9 Selection inventions

Selection inventions deal with the selection of individual elements, subsets, or sub-ranges, which have not been explicitly mentioned, within a larger known set or range.

i) In determining the novelty of a selection, it has to be decided, whether the selected elements are disclosed in an individualized (concrete) form in the prior art. A selection from a single list of specifically disclosed elements does not confer novelty. However, if a selection from two or more lists of a certain length has to be made in order to arrive at a specific combination of features then the resulting combination of features, not specifically disclosed in the prior art, confers novelty (the "two lists principle"). Examples of such selections from two or more lists are the selection of:
    (a) individual chemical compounds from a known generic formula whereby the compound selected results from the selection of specific substituents from two or more "lists" of substituents given in the known generic formula. The same applies to specific mixtures resulting from the selection of individual components from lists of components making up the prior art mixture;
    (b) starting materials for the manufacture of a final product;
    (c) sub-ranges of several parameters from corresponding known ranges.

(ii) A sub-range selected from a broader numerical range of the prior art is considered novel, if each of the following three criteria is satisfied:
   a) the selected sub-range is narrow compared to the known range;
   b) the selected sub-range is sufficiently far removed from any specific examples disclosed in the prior art and from the endpoints of the known range;
   c) the selected range is not an arbitrary specimen of the prior art, i.e. not a mere embodiment of the prior art, but another invention (purposive selection, new technical teaching).

An effect occurring only in the claimed sub-range cannot in itself confer novelty on that sub-range. However, such a technical effect occurring in the selected sub-range, but not in the whole of the known range, can confirm that criterion c) is met, i.e. that the invention is novel and not merely a specimen of the prior art. The meaning of "narrow" and "sufficiently far removed" has to be decided on a case-by-case basis. The new technical effect occurring within the selected range may also be the same effect as that attained with the broader known range, but to a greater extent.

(iii) In the case of overlapping ranges (e.g. numerical ranges, chemical formulae) of claimed subject-matter and the prior art the same principles apply for the assessment of novelty as in other cases, e.g. selection inventions.

It has to be decided which subject-matter has been made available to the public by a prior art disclosure and thus forms part of the state of the art. In this context, it is not only examples, but the whole content of the prior art document which has to be taken into consideration. As to overlapping ranges or numerical ranges of physical parameters, novelty is destroyed by an explicitly mentioned end-point of the known range, explicitly mentioned intermediate values or a specific example of the prior art in the overlap. It is not sufficient to exclude specific novelty destroying values known from the prior art range, it must also be considered whether the skilled person, in the light of the technical facts and taking into account the general knowledge in the field to be expected from him, would seriously contemplate applying the technical teaching of the prior art document in the range of overlap. If it can be fairly assumed that he would do so, it must be concluded that no novelty exists.

The criteria mentioned in (ii) above can be applied analogously for assessing the novelty of overlapping numerical ranges. As far as overlapping chemical formulae are concerned, novelty is acknowledged if the claimed subject-matter is distinguished from the prior art in the range of overlap by a new technical element (new technical teaching), of the reasons, not published for example a specifically selected chemical residue which is covered in general terms by the prior art in the overlapping area, but which is not individualised in the prior art document. If this is not the case, then it must be considered whether the skilled person would seriously contemplate working in the range of overlap and/or would accept that the area of overlap is directly and unambiguously disclosed in an implicit manner in the prior art, not published. If the answer is yes, then novelty is lacking.

6.32 Non-Prejudicial Disclosures

6.32.1 General Remark

There are two specific instances (and these are the only two) in which a prior disclosure of the invention is not taken into consideration as part of the state of the art, viz. where the disclosure was due to, or in consequence of:

(i) an evident abuse in relation to the applicant or his legal predecessor – e.g. the invention was derived from the applicant and disclosed against his wish (Section 23(4)(a)); or

(ii) the display of the invention by the applicant or his legal predecessor at an officially recognized international exhibition as defined in Section 23(4)(b) of .

6.32.2 Time limit

An essential condition, in both instances (i) and (ii), is that the disclosure in point must have taken place not earlier than twelve months preceding the filing of the application. For calculating the twelve-month period the relevant date is that of the actual filing date of the patent application (Section 23(4)).

6.32.3 Evident abuse

Regarding instance (i), the disclosure might be made in a published document or in any other way. As a particular instance, the disclosure might be made in a European application of earlier priority date. Thus, for example, a person B who has been told of A's invention in confidence, might himself apply for a patent for this invention. If so, the disclosure resulting from the publication of B's application will not prejudice A's rights provided that A has already made an application, or applies within twelve months of such publication. B may not be entitled to proceed with his application. For "evident abuse" to be established, there must be, on the part of the person disclosing the invention, either actual intent to cause harm or actual or constructive knowledge that harm would or could ensue from this disclosure.

6.32.4 International exhibition

In instance (ii), the application must be filed within twelve months of the disclosure of the invention at the exhibition if the display is not to prejudice the application. Furthermore, the applicant must state, at the time of filing the application, that the invention has been so displayed, and must also file a supporting certificate.

6.33 Inventive Step (Section 24)

6.33.1 General

An invention is considered as involving an inventive step if, having regard to the state of the art, it is not obvious to a person skilled in the art. Novelty and inventive step are different criteria. Novelty exists if there is any difference between the invention and the known art. The question – "is there inventive step?" – only arises if there is novelty.

6.33.2 State of the art; date of filing

The "state of the art" for the purposes of considering inventive step does not include later published patent applications. Date of filing - means date of priority where appropriate.

6.33.3 Person skilled in the art

The "person skilled in the art" should be presumed to be an ordinary practitioner aware of what was common general knowledge in the art at the relevant date. He should also be presumed to have had access to everything in the "state of the art", in particular the documents cited in the search report, and to have had at his disposal the normal means and capacity for routine work and experimentation. If the problem prompts the person skilled in the art to seek its solution in another technical field, the specialist in that field is the person qualified to solve the problem. The assessment of whether the solution involves an inventive step must therefore be based on that specialist's knowledge and ability. There may be instances where it is more appropriate to think in terms of a group of persons, e.g. a research or production team, than a single person. This may apply, for example, in certain advanced technologies such as computers or telephone systems and in highly specialized processes such as the commercial production of integrated circuits or of complex chemical substances. (definition should be considered further)

6.33.4 Obviousness

Thus the question to consider, in relation to any claim defining the invention, is whether before the filing or priority date valid for that claim, having regard to the art known at the time, it would have been obvious to the person skilled in the art to arrive at something falling within the terms of the claim. If so, the claim is not allowable for lack of inventive step. The term "obvious" means that which does not go beyond the normal progress of technology but merely follows plainly or logically from the prior art, i.e. something which does not involve the exercise of any skill or ability beyond that to be expected of the person skilled in the art. In considering inventive step, as distinct from novelty, it is fair to construe any published document in the light of subsequent knowledge and to have regard to all the knowledge generally available to the person skilled in the art the day before the filing or priority date valid for the claimed invention.

6.33.5 Combination vs. juxtaposition or aggregation

The invention claimed must normally be considered as a whole. When a claim consists of a "combination of features", it is not correct to argue that the separate features of the combination taken by themselves are known or obvious and that "therefore" the whole subject-matter claimed is obvious. However, where the claim is merely an "aggregation or juxtaposition of features" and not a true combination, it is enough to show that the individual features are obvious to prove that the aggregation of features does not involve an inventive step.

A set of technical features is regarded as a combination of features if the functional interaction between the features achieves a combined technical effect which is different, e.g. greater than the sum of the technical effects of the individual features. In other words, the interactions of the individual features must produce a synergistic effect. If no such synergistic effect exists, there is no more than a mere aggregation of features. For example, the technical effect of an individual transistor is essentially that of an electronic switch. However, transistors interconnected to form a microprocessor synergically interact to achieve technical effects, such as data processing, which are over and above the sum of their respective individual technical effects.

6.33.6 Origin of an invention

While the claim should in each case be directed to technical features (and not, for example, merely to an idea), in order to assess whether an inventive step is present it is important for the examiner to bear in mind that there are various ways in which the skilled person may arrive at an invention. An invention may, for example, be based on the following:

(i) The formulation of a new idea or of a yet unrecognised problem to be solved (the solution being obvious once the problem is clearly stated);

Example: Appropriate tests by the applicant revealed that the effect of a known chemical formulation was no longer satisfactory after prolonged storage, the claimed solution being retrospectively trivial and in itself obvious.

(ii) The devising of a solution to a known problem;

Example: the problem of permanently marking farm animals such as cows without causing pain to the animals or damage to the hide has existed since farming began. The solution ("freeze-branding") consists in applying the discovery that the hide can be permanently depigmented by freezing.

(iii) The arrival at an insight into the cause of an observed phenomenon (the practical use of this phenomenon then being obvious);

Example: the agreeable flavour of butter is found to be caused by minute quantities of a particular compound. As soon as this insight has been arrived at, the technical application comprising adding this compound to margarine is immediately obvious. Many inventions are

of course based on a combination of the above possibilities - e.g. the arrival at an insight and the technical application of that insight may both involve the use of the inventive faculty.

6.33.7 Problem-and –Solution Approach

In practice, in order to assess inventive step in an objective and predictable manner, the examiner should normally apply the so-called "problem-and-solution approach". In the problem-and-solution approach, there are three main stages:

(i) determining the "closest prior art",
(ii) establishing the "objective technical problem" to be solved, and
(iii) considering whether or not the claimed invention, starting from the closest prior art and the objective technical problem, would have been obvious to the skilled person.

6.33.8 Determination of the closest prior art

The closest prior art is that combination of features, disclosed in one single reference, which constitutes the most promising starting point for an obvious development leading to the invention. In selecting the closest prior art, the first consideration is that it should be directed to a similar purpose or effect as the invention or at least belong to the same or a closely related technical field as the claimed invention. In practice, the closest prior art is generally that which corresponds to a similar use and requires the minimum of structural and functional modifications to arrive at the claimed invention.
The closest prior art must be assessed from the skilled person's point of view on the day before the filing or priority date valid for the claimed invention. In identifying the closest prior art, account should be taken of what the applicant himself acknowledges in his description and claims to be known. Any such acknowledgement of known art should be regarded by the examiner as being correct, unless the applicant states he has made a mistake.

6.33.9 Formulation of the objective technical problem

In the second stage, one establishes in an objective way the technical problem to be solved. To do this one studies the application (or the patent), the closest prior art and the difference (also called "the distinguishing feature(s)" of the invention) in terms of features (either structural or functional) between the invention and the closest prior art and then formulates the technical problem. Features which cannot be seen to make any contribution, either independently or in combination with other features, to the solution of a technical problem are not relevant for assessing inventive step. Such a situation can occur for instance if a feature only contributes to the solution of a non-technical problem, for instance a problem in a field excluded from patentability. In the context of the problem-and-solution approach, the technical problem means the aim and task of modifying or adapting the closest prior art to provide the technical effects that the invention provides over the closest prior art. The technical problem thus defined is often referred to as the "objective technical problem".

The objective technical problem derived in this way may not be what the applicant presented as "the problem" in his application. The latter may require reformulation, since the objective technical problem is based on objectively established facts, in particular appearing in the prior art revealed in the course of the proceedings, which may be different from the prior art of which the applicant was actually aware at the time the application was filed. In particular, the prior art cited in the search report may put the invention in an entirely different perspective from that apparent from reading the application only. The extent to which such reformulation of the technical problem is possible has to be assessed on the merits of each particular case. As a matter of principle any effect provided by the invention may be used as a basis for the reformulation of the technical problem, as long as said effect is derivable from the application as filed. It is also possible to rely on new effects submitted subsequently

during the proceedings by the applicant, provided that the skilled person would recognise these effects as implied by or related to the technical problem initially suggested.

It is noted that the objective technical problem must be so formulated as not to contain pointers to the solution, since including part of a solution offered by an invention in the statement of the problem must, when the state of the art is assessed in terms of that problem, necessarily result in an ex post facto view being taken of inventive activity. The expression "technical problem" should be interpreted broadly; it does not necessarily imply that the solution is a technical improvement over the prior art. Thus the problem could be simply to seek an alternative to a known device or process providing the same or similar effects or which is more cost-effective. Sometimes, the objective technical problem must be regarded as an aggregation of a plurality of "partial problems". This is the case where there is no technical effect achieved by all the distinguishing features taken in combination, but rather a plurality of partial problems is independently solved by different sets of distinguishing features.

6.33.10 Could-would approach

In the third stage the question to be answered is whether there is any teaching in the prior art as a whole that would (not simply could, but would) have prompted the skilled person, faced with the objective technical problem, to modify or adapt the closest prior art while taking account of that teaching, thereby arriving at something falling within the terms of the claims, and thus achieving what the invention achieves. In other words, the point is not whether the skilled person could have arrived at the invention by adapting or modifying the closest prior art, but whether he would have done so because the prior art incited him to do so in the hope of solving the objective technical problem or in expectation of some improvement or advantage. This must have been the case for the skilled person before the filing or priority date valid for the claim under examination.

6.33.11 Combining prior-art documents

It is permissible to combine the disclosure of one or more documents, parts of documents or other pieces of prior art (e.g. a public prior use) with the closest prior art. However, the fact that more than one disclosure must be combined with the closest prior art in order to arrive at a combination of features may be the sign of the presence of an inventive step. A different situation occurs where the invention is a solution to a plurality of independent "partial problems". Indeed, in such a case it is necessary to separately assess, for each partial problem, whether the combination of features solving the partial problem is obviously derivable from the prior art. Hence, a different document can be combined with the closest prior art for each partial problem. For the subject-matter of the claim to be inventive, it suffices however that one of these combinations of features involves an inventive step. In determining whether it would be obvious to combine two or more distinct disclosures, the examiner should also have regard in particular to the following:

(i) whether the content of the disclosures (e.g. documents) is such as to make it likely or unlikely that the person skilled in the art, when faced with the problem solved by the invention, would combine them - for example, if two disclosures considered as a whole could not in practice be readily combined because of inherent incompatibility in disclosed features essential to the invention, the combining of these disclosures should not normally be regarded as obvious;

(ii) whether the disclosures, e.g. documents, come from similar, neighbouring or remote technical fields;

(iii) the combining of two or more parts of the same document would be obvious if there is a reasonable basis for the skilled person to associate these parts with one another. It would normally be obvious to combine with a prior-art document a well-known textbook or standard dictionary; this is only a special case of the general proposition that it is obvious to combine the teaching of one or more

documents with the common general knowledge in the art. It would, generally speaking, also be obvious to combine two documents one of which contains a clear and unmistakable reference to the other. In determining whether it is permissible to combine a document with an item of prior art made public in some other way, e.g. by use, similar considerations apply.

6.33.12 Indicators

Predictable disadvantage; non-functional modification; arbitrary choice It should be noted that if the invention is the result of a foreseeable disadvantageous modification of the closest prior art, which the skilled person could clearly predict and correctly assess, and if this predictable disadvantage is not accompanied by an unexpected technical advantage, then the claimed invention does not involve an inventive step. In other words, a mere foreseeable worsening of the prior art does not involve an inventive step. However, if this worsening is accompanied by an unexpected technical advantage, an inventive step might be present. Similar considerations apply to the case where an invention is merely the result of an arbitrary non-functional modification of a prior-art device or of a mere arbitrary choice from a host of possible solutions.

It should be remembered that an invention which at first sight appears obvious might in fact involve an inventive step. Once a new idea has been formulated it can often be shown theoretically how it might be arrived at, starting from something known, by a series of apparently easy steps. The examiner should be wary of ex post facto analysis of this kind. He should always bear in mind that the documents produced in the search have, of necessity, been obtained with foreknowledge of what matter constitutes the alleged invention. In all cases he should attempt to visualise the overall state of the art confronting the skilled person before the applicant's contribution and he should seek to make a "real-life" assessment of this and other relevant factors. He should take into account all that is known concerning the background of the invention and give fair weight to relevant arguments or evidence submitted by the applicant. If, for example, an invention is shown to be of considerable technical value, and particularly if it provides a technical advantage which is new and surprising and which is not merely achieved as a bonus effect in a "one-way street" situation, and this technical advantage can convincingly be related to one or more of the features included in the claim defining the invention, the examiner should be hesitant in pursuing an objection that such a claim lacks inventive step.

6.33.13 Unexpected technical effect; bonus effect

An unexpected technical effect may be regarded as an indication of inventive step. However, if, having regard to the state of the art, it would already have been obvious for a skilled person to arrive at something falling within the terms of a claim, for example due to a lack of alternatives thereby creating a "one-way street" situation, the unexpected effect is merely a bonus effect which does not confer inventiveness on the claimed subject-matter.

6.33.14 Long-felt need; commercial success

Where the invention solves a technical problem which workers in the art have been attempting to solve for a long time, or otherwise fulfils a long-felt need, this may be regarded as an indication of inventive step. Commercial success alone is not to be regarded as indicative of inventive step, but evidence of immediate commercial success when coupled with evidence of a long-felt want is of relevance provided the examiner is satisfied that the success derives from the technical features of the invention and not from other influences (e.g. selling techniques or advertising).

6.33.15 Arguments and evidence submitted by the applicant

The relevant arguments and evidence to be considered by the examiner for assessing inventive step may either be taken from the originally-filed patent application or submitted by the applicant during the subsequent proceedings. Care must be taken, however, whenever new effects in support of inventive step are referred to. Such new effects can only be taken into account if they are implied by or at least related to the technical problem initially suggested in the originally filed application. Example of such a new effect: The invention as filed relates to a pharmaceutical composition having a specific activity. At first sight, having regard to the relevant prior art, it would appear that there is a lack of inventive step. Subsequently, the applicant submits new evidence which shows that the claimed composition exhibits an unexpected advantage in terms of low toxicity. In this case, it is allowable to reformulate the technical problem by including the aspect of toxicity, since pharmaceutical activity and toxicity are related in the sense that the skilled person would always contemplate the two aspects together. The reformulation of the technical problem may or may not give rise to amendment or insertion of the statement of the technical problem in the description. Any such amendment is only allowable if it satisfies the set out conditions. In the above example of a pharmaceutical composition, neither the reformulated problem nor the information on toxicity could be introduced into the description without infringing.

6.33.16 Selection inventions

The subject-matter of selection inventions differs from the closest prior art in that it represents selected sub-sets or sub-ranges. If this selection is connected to a particular technical effect, and if no hints exist leading the skilled person to the selection, then an inventive step is accepted (this technical effect occurring within the selected range may also be the same effect as attained with the broader known range, but to an unexpected degree). The criterion of "seriously contemplating" mentioned in connection with the test for novelty of overlapping ranges should not be confused with the assessment of inventive step. For inventive step, it has to be considered whether the skilled person would have made the selection or would have chosen the overlapping range in the hope of solving the underlying technical problem or in expectation of some improvement or advantage. If the answer is negative, then the claimed matter involves an inventive step.

6.33.17 Dependent claims; claims in different categories

If an independent claim is new and non-obvious, there is no need to investigate the novelty and the non-obviousness of any claims dependent thereon, except in situations where the subject-matter of a dependent claim has a later effective date than the independent claim and intermediate documents are to be considered. Similarly, if a claim to a product is new and non-obvious there is no need to investigate the novelty and non-obviousness of any claims for a process which inevitably results in the manufacture of that product or of any claims for a use of that product. In particular, analogy processes, i.e. processes which themselves would otherwise not involve an inventive step, are nevertheless patentable insofar as they provide a novel and inventive product. It should, however, be noted that in cases where the product, process and use claims have different effective dates, a separate examination as to novelty and inventive step may still be necessary in view of intermediate documents.

Examples of circumstances where an invention may be regarded as obvious or where it may involve an inventive step:
These examples are for illustrative purposes and that the applicable principle in each case is "was it obvious to a person skilled in the art?". Examiners should avoid attempts to fit a

particular case into one of these examples if it is not clearly applicable. Also, the list is not exhaustive.

Examples Relating to the Requirement of Inventive Step-Indicators

1. Application of known measures?

1.1 Inventions involving the application of known measures in an obvious way and in respect of which an inventive step is therefore to be ruled out:

(i) the teaching of a prior document is incomplete and at least one of the possible ways of "filling the gap" which would naturally or readily occur to the skilled person results in the invention;
Example: The invention relates to a building structure made from aluminium. A prior document discloses the same structure and says that it is of light-weight material but fails to mention the use of aluminium.
(ii) the invention differs from the known art merely in the use of well-known equivalents (mechanical, electrical or chemical);
Example: The invention relates to a pump which differs from a known pump solely in that its motive power is provided by a hydraulic motor instead of an electric motor.
(iii) the invention consists merely in a new use of a well-known material employing the known properties of that material; (is it this simple?)
Example: Washing composition containing as detergent a known compound having the known property of lowering the surface tension of water, this property being known to be an essential one for detergents.
(iv) the invention consists in the substitution in a known device of a recently developed material whose properties make it plainly suitable for that use ("analogous substitution");
Example: An electric cable comprises a polyethylene sheath bonded to a metallic shield by an adhesive. The invention lies in the use of a particular newly developed adhesive known to be suitable for polymer-metal bonding.
(v) the invention consists merely in the use of a known technique in a closely analogous situation ("analogous use").
Example: The invention resides in the application of a pulse control technique to the electric motor driving the auxiliary mechanisms of an industrial truck, such as a fork-lift truck, the use of this technique to control the electric propulsion motor of the truck being already known.

1.2 Inventions involving the application of known measures in a non-obvious way and in respect of which an inventive step is therefore to be recognised:

(i) a known working method or means when used for a different purpose involves a new, surprising effect;
Example: It is known that high-frequency power can be used in inductive butt welding. It should therefore be obvious that high-frequency power could also be used in conductive butt welding with similar effect. However, if high-frequency power were used for the continuous conductive butt welding of coiled strip but without removing scale (such scale removal normally being necessary during conductive welding in order to avoid arcing between the welding contact and the strip), there is the unexpected additional effect that scale removal is found to be unnecessary because at high frequency the current is supplied in a

predominantly capacitive manner via the scale which forms a dielectric. In that case, an inventive step would exist.
(ii) a new use of a known device or material involves overcoming technical difficulties not resolvable by routine techniques.
Example: The invention relates to a device for supporting and controlling the rise and fall of gas holders, enabling the previously employed external guiding framework to be dispensed with. A similar device was known for supporting floating docks or pontoons but practical difficulties not encountered in the known applications needed to be overcome in applying the device to a gas holder.

2. Obvious combination of features?

2.1 Obvious and consequently non-inventive combination of features:

The invention consists merely in the juxtaposition or association of known devices or processes functioning in their normal way and not producing any non-obvious working inter-relationship.
Example: Machine for producing sausages consists of a known mincing machine and a known filling machine disposed side by side.

2.2 Not obvious and consequently inventive combination of features:

The combined features mutually support each other in their effects to such an extent that a new technical result is achieved. It is irrelevant whether each individual feature is fully or partly known by itself. However, if the combination of features is a bonus effect, e.g. as the result of a "one-way street" situation, the combination might lack an inventive step.
Example: A mixture of medicines consists of a painkiller (analgesic) and a tranquillizer (sedative). It was found that through the addition of the tranquillizer, which intrinsically appeared to have no painkilling effect, the analgesic effect of the painkiller was intensified in a way which could not have been predicted from the known properties of the active substances.

3. Obvious selection?

3.1 Obvious and consequently non-inventive selection among a number of known possibilities:

(i) the invention consists merely in choosing from a number of equally likely alternatives;
Example: The invention relates to a known chemical process in which it is known to supply heat electrically to the reaction mixture. There are a number of well-known alternative ways of so supplying the heat, and the invention resides merely in the choice of one alternative.

(ii) the invention resides in the choice of particular dimensions, temperature ranges or other parameters from a limited range of possibilities, and it is clear that these parameters could be arrived at by routine trial and error or by the application of normal design procedures;
Example: The invention relates to a process for carrying out a known reaction and is characterized by a specified rate of flow of an inert gas. The prescribed rates are merely those which would necessarily be arrived at by the skilled practitioner.

(iii) the invention can be arrived at merely by a simple extrapolation in a straightforward way from the known art;
Example: The invention is characterised by the use of a specified minimum content of a substance X in a preparation Y in order to improve its thermal stability, and this characterizing feature can be derived merely by extrapolation on a straightline graph, obtainable from the known art, relating thermal stability to the content of substance X.

(iv) the invention consists merely in selecting particular chemical compounds or compositions (including alloys) from a broad field:
Example: The prior art includes disclosure of a chemical compound characterized by a specified structure including a substituent group designated "R". This substituent "R" is defined so as to embrace entire ranges of broadly-defined radical groups such as all alkyl or aryl radicals either unsubstituted or substituted by halogen and/or hydroxy, although for practical reasons only a very small number of specific examples are given. The invention consists in the selection of a particular radical or particular group of radicals from amongst those referred to as the substituent "R" (the selected radical or group of radicals not being specifically disclosed in the prior-art document since the question would then be one of lack of novelty rather than obviousness). The resulting compounds:
(a) are neither described as having nor shown to possess any advantageous properties not possessed by the prior art examples; or
(b) are described as possessing advantageous properties compared with the compounds specifically referred to in the prior art, but these properties are ones which the person skilled in the art would expect such compounds to possess, so that he is likely to be led to make this selection.

3.2 Not obvious and consequently inventive selection among a number of known possibilities:

(i) the invention involves special selection in a process of particular operating conditions (e.g. temperature and pressure) within a known range, such selection producing unexpected effects in the operation of the process or the properties of the resulting product;
Example: In a process where substance A and substance B are transformed at high temperature into substance C, it was known that there is in general a constantly increased yield of substance C as the temperature increases in the range between 50 and 130 °C. It is now found that in the temperature range from 63 to 65 °C, which previously had not been explored, the yield of substance C was considerably higher than expected.

(ii) the invention consists in selecting particular chemical compounds or compositions (including alloys) from a broad field, such compounds or compositions having unexpected advantages.
Example: In the example of a substituted chemical compound given at (iv) under 3.1 above, the invention again resides in the selection of the substituent radical "R" from the total field of possibilities defined in the prior disclosure. In this case, however, not only does the selection embrace a particular area of the possible field, and result in compounds that can be shown to possess advantageous properties (see IV, 9.11 and VI, 5.3.5) but there are no indications which would lead the person skilled in the art to this particular selection rather than any other in order to achieve the advantageous properties.

4. Overcoming a technical prejudice?

As a general rule, there is an inventive step if the prior art leads the person skilled in the art away from the procedure proposed by the invention. This applies in particular when the skilled person would not even consider carrying out experiments to determine whether these were alternatives to the known way of overcoming a real or imagined technical obstacle.

6.34 Industrial application

Under section 25 of the Act, an invention shall be considered industrially applicable if it can be made or used in any kind of industry, including agriculture, medicine, fisheries and other services.

"Industry" should be understood in its broad sense as including any physical activity of "technical character", that is an activity which belongs to the useful or practical arts as distinct from the aesthetic arts; it does not necessarily imply the use of a machine or the manufacture of an article and could cover e.g. a process for dispersing fog or for converting energy from one form to another.

Section 25 excludes from patentability very few "inventions" which are not already excluded by the list in section 21(3). One further class of "invention" which would be excluded, however, would be articles or processes alleged to operate in a manner clearly contrary to well-established physical laws, e.g. a perpetual motion machine.

Objection could arise under section 25 only insofar as the claim specifies the intended function or purpose of the invention, but if, say, a perpetual motion machine is claimed merely as an article having a particular specified construction then objection should be made under Art.83.

6.34.1 Surgery, therapy and diagnostic methods

Methods for treatment of the human or animal body by surgery or therapy and diagnostic methods practised on the human or animal body shall not be regarded as inventions which are industrially applicable. This provision shall not apply to products, in particular substances or compositions, for use in any of these methods. Hence, patents may be obtained for surgical, therapeutic or diagnostic instruments or apparatuses for use in such methods. The manufacture of prostheses or artificial limbs could be patentable. For instance, a method of manufacturing insoles in order to correct the posture or a method of manufacturing an artificial limb should be patentable. In both cases, taking the imprint of the footplate or a moulding of the stump on which an artificial limb is fitted is clearly not of a surgical nature and does not require the presence of a medically qualified person. Furthermore, the insoles as well as the artificial limb are manufactured outside the body. However, a method of manufacturing an endoprosthesis outside the body, but requiring a surgical step to be carried out for taking measurements, would be excluded from patentability.

Patents may also be obtained for new products for use in methods of treatment or diagnosis, particularly substances or compositions. However, in the case of a known substance or composition, this may only be patented for use in methods if the known substance or composition was not previously disclosed for use in surgery, therapy or diagnostic methods practised on the human or animal body ("first medical use").

The same substance or composition cannot subsequently be patented for any other use of that kind. A claim to a known substance or composition for the first use in surgical, therapeutic and/or diagnostic methods should be in a form such as: "Substance or composition X" followed by the indication of the use, for instance "... for use as a medicament", "... as an antibacterial agent " or "... for curing disease Y".

These types of claims will be regarded as restricted to the substance or composition when presented or packaged for the use. However, this does not mean that product claims for first medical use need not fulfil all other requirements of patentability, especially that of inventive step.

A claim in the form "Use of substance or composition X for the treatment of disease Y ..." will be regarded as relating to a method for treatment explicitly excluded from patentability by Section 21(3)(c) and therefore will not be accepted.
If an application discloses for the first time a number of distinct surgical, therapeutic or diagnostic uses for a known substance or composition, normally in the one application

independent claims each directed to the substance or composition for one of the various uses may be allowed; that is an a priori objection of lack of unity of invention should not, as a general rule, be raised.

A claim in the form "Use of a substance or composition X for the manufacture of a medicament for therapeutic application Z" is allowable for either a first or "subsequent" (second or further) such application ("second medical use"-type of claim or "Swiss-type" claim), if this application is new and inventive. The same applies to claims in the form "Method for manufacturing a medicament intended for therapeutic application Z, characterised in that the substance X is used" or the substantive equivalents thereof. In cases where an applicant simultaneously discloses more than one "subsequent" therapeutic use, claims of the above type directed to these different uses are allowable in the one application, but only if they form a single general inventive concept. Regarding use or method claims of the above type, it should also be noted that a mere pharmaceutical effect does not necessarily imply a therapeutical application.

For instance, the selective occupation of a specific receptor by a given substance cannot be considered in itself as a therapeutic application; indeed, the discovery that a substance selectively binds a receptor, even if representing an important piece of scientific knowledge, still needs to find an application in the form of a defined, real treatment of a pathological condition in order to make a technical contribution to the art and to be considered as an invention eligible for patent protection.

Limitations of exclusion under Section 21(3)(c)

It should be noted that Section 21(3)(c) excludes only methods of treatment by surgery or therapy and diagnostic methods. It follows that other methods of treatment of live human beings or animals (e.g. treatment of a sheep in order to promote growth, to improve the quality of mutton or to increase the yield of wool) or other methods of measuring or recording characteristics of the human or animal body are patentable provided that (as would probably be the case) such methods are of a technical and not essentially biological character and are industrially applicable. The latter proviso is particularly important in the case of human beings. For example, an application with a claim for a method of contraception, which is to be applied in the private and personal sphere of a human being, is not industrially applicable. However, an application containing claims directed to the purely cosmetic treatment of a human by administration of a chemical product is considered industrially applicable. A cosmetic treatment involving surgery or therapy would, however, not be patentable.

In order to be excluded, a treatment or diagnostic method must actually be carried out on the living human or animal body. A treatment of or diagnostic method practised on a dead human or animal body would therefore not be excluded from patentability by virtue of Section 21(3)(c).
Treatment of body tissues or fluids after they have been removed from the human or animal body, or diagnostic methods applied thereon, are not excluded from patentability insofar as these tissues or fluids are not returned to the same body. Thus the treatment of blood for storage in a blood bank or diagnostic testing of blood samples is not excluded, whereas a treatment of blood by dialysis with the blood being returned to the same body would be excluded.

Regarding methods which are carried out on or in relation to the living human or animal body, it should be borne in mind that the intention of Section 21(3)(c) is only to free from restraint non-commercial and non-industrial medical and veterinary activities. Interpretation of the provision should avoid the exclusions from going beyond their proper limits.

However, in contrast to the subject-matter referred to in Art. 52(2) and (3) which is only excluded from patentability if claimed as such, a method claim is not allowable under Section 21(3)(c) if it includes at least one feature defining a physical activity or action that constitutes a method step for treatment of the human or animal body by surgery or therapy or a diagnostic method step to be exercised on the human or animal body. In that case, whether or not the claim includes or consists of features directed to a technical operation performed on a technical object is legally irrelevant to the application of Section 21(3)(c).

Taking the three exclusions in turn:
Surgery defines the nature of the treatment rather than its purpose. Thus, for example, a method of treatment by surgery for cosmetic purposes or for embryo transfer is excluded, as well as surgical treatment for therapeutic purposes.

Therapy implies the curing of a disease or malfunction of the body and covers prophylactic treatment, e.g. immunisation against a certain disease or the removal of plaque. A method for therapeutic purposes concerning the functioning of an apparatus associated with a living human or animal body is not excluded if no functional relationship exists between the steps related to the apparatus and the therapeutic effect of the apparatus on the body.

Diagnostic methods likewise do not cover all methods related to diagnosis. Methods for obtaining information (data, physical quantities) from the living human or animal body are not excluded by Section 21(3)(c), if the information obtained merely provides intermediate results which, on their own, do not enable a decision to be made on the treatment necessary.

Generally such methods include X-ray investigations, NMR studies, and blood pressure measurements.

6.34.2 Method of testing

Methods of testing generally should be regarded as inventions industrially applicable and therefore patentable if the test is applicable to the improvement or control of a product, apparatus or process which is itself industrially applicable. In particular, the utilisation of test animals for test purposes in industry, e.g. for testing industrial products (for example for ascertaining the absence of pyrogenetic or allergic effects) or phenomena (for example for determining water or air pollution) would be patentable.

6.34.3 Industrial application vs. exclusion under Sec. 21(3)

It should be noted that " industrial application" is not a requirement that overrides the restriction of Sec. 21(3), e.g. an administrative method of stock control is not patentable, having regard to Sec. 21(3)(c), even though it could be applied to the factory store-room for spare parts. On the other hand, although an invention must be "industrially applicable" and the description must indicate, where this is not apparent, the way in which the invention is thus industrially applicable, the claims need not necessarily be restricted to the industrial application(s).

6.35 Matters excluded from patentability

Section 21(3) sets out a list of exclusions from patentability, namely:

2l(3)(a) - a discovery, scientific theory or mathematical method;
Note. The fact that a known material has an unknown property is a discovery and as such is not itself patentable, but an application or use of that material may be patentable eg in a

particular process. Similarly, finding a new substance or micro-organism occurring in nature is a discovery, but the process of isolating and extracting it, and the material so obtained, could be patentable.

21(3)(b) - a scheme, rule or method for performing a mental act, playing a game or doing business;

What is the position in regard to patents on computer programs?

Note:

(i) although rules for games cannot be patented (again they are covered by copyright), apparatus for playing a particular game (eg comprising board, pieces and rules) may be patentable

(ii) "methods of doing business" is an exclusion of importance. Methods of book keeping, trading stocks and shares etc are generally not patentable

21(3)(c) - diagnostic, therapeutic and surgical methods for the treatment of humans and animals.

Note: Another exclusion of major importance. Pharmaceutical products are patentable, as are methods of making them. Equipment for use in medicine and surgery (eg scalpels, operating tables) is also patentable.

21(3)(d) - the presentation of information

Note: This exclusion relates to simple non-technical devices such as credit card voucher or a bus ticket. A camera with a new way of presenting information in the viewfinder to assist the photographer would however be patentable.

21(3)(e) - public health related methods of use or uses of any molecule or other substance whatsoever used for the prevention or treatment of any disease which the minister responsible for matters relating to health may designate as a serious health hazard or as a life threatening disease.

Note: This provision was included in the Industrial Property Act, 2001 following the declaration of AIDS as a national disaster by the President of the Republic of Kenya.

26(a) - Plant varieties as provided for in the Seeds and Plant Varieties Act Cap 326 but not parts thereof or products of biotechnological processes, and

26(b) - Inventions contrary to public order, morality, public health and safety, principles of humanity and environmental conservation.

Probably the most important exclusions, as indicated above, are business methods and methods of medically treating humans and animals. It is particularly important to note that such methods may be patentable in some other countries, including the United States, so IPERs drawn up by USPTO and US equivalent patents should be checked carefully to ensure that they do not cover claims to business methods or to diagnostic, therapeutic or surgical methods for the treatment of humans or animals.

Equally it important to note that sections 21(3) and 26 does not exclude computer programmes.

6.36 Matters prejudicial to public order, morality, safety and environment

Section 26(b) excludes from patentability inventions of which the commercial exploitation would be contrary to public order or morality, or prejudicial to humans, animals or plant life or health, or to the environment. What is excluded here will probably be decided by government policy, for instance, land mines, mantraps and letter bombs might be excluded here, or methods for cloning human beings. It is important for patent examiners to be aware of this section, although the occasions when this section is invoked are in practice likely to be rare.

6.37 Recommendation to grant

If the examiner considers that the application satisfies the requirements of the Act and is thus in order to proceed to grant, he should make a brief written report on his findings. These should be a summary of the search and examination report.

6.38 Recommendation to refuse

When making a report for an application which is not in order for grant of a patent, the examiner should set out the points at issue, the case history to the extent necessary to enable a quick grasp of the essential facts, and recommend the action to be taken, e.g. refusal, or grant conditional upon certain further amendments.

If, on the other hand, the examiner is satisfied that the applicant has had sufficient opportunity to amend and that all the requirements are still not met, she should issue a decision to refuse the application. The grounds of refusal must be stated and full reasons must be given.
Refusal may be based only on grounds on which the applicant has had an opportunity to put forward comments. In addition, the applicant's attention must be directed to the provisions for appeal laid down in section 47.

Chapter VII: Grant and publication

7.0 Grant of Patent

If the applicant has fulfilled the requirements of the Act, a patent is granted, provided that maintenance, grant and publication fees have been paid. Every patent granted shall be registered, and published in the Journal. A certificate of grant of a patent in Form IP 10 should be issued and accompanied with a copy of the patent documents (abstract, disclosure and claims) as at the time of grant.

7.1 Registers of patent applications and grants

The register is kept as a permanent record of the summary particulars of the patent applications and grant. The summary particulars mainly comprise of bibiliographic. The record items to be entered in the register with respect to patent applications are laid down in Regulation 30(2) and should include:

a) The application number
b) The filing date;
c) The name and address of the applicant;
d) The title of the invention;
e) The name and address of the inventor (except where inventor is not to be named as provided under Section 33 of the Act);
f) If priority is claimed, the priority date and the name of the state in which or for which the earlier application was filed;
g) The date of the request for an examination submitted under section 44(2) of the Act;
h) The publication date of the application;
i) The address for service of the applicant;
j) A notice of every document effecting a change in ownership of the application or purporting to give the application or an interest in it as security;
k) If the applicant dies, a notice of that fact; and
l) Any other information required under the Act or these Regulations or that the Managing Director considers appropriate.

For granted patents the information above should be included and in addition:-

a) The number of the patent;
b) The name and address of the owner of the patent;
c) The date of the grant of the patent;
d) The address for service of the owner;
e) A notice of every document effecting a change in
f) ownership of the patent or purporting to give the patent or an interest in it as security:
g) A notice of every document effecting a change in
h) ownership of a licence or purporting to give a licence or an interest in it as security;
i) If the owner of the patent dies, a notice of that
j) fact; and
k) Any other information required under the Act or the Regulations or that the Managing Director considers appropriate.

A person who wishes to obtain an extract from the patent register should make a request in Form IP 11 for a certified copy or in Form IP 12 for an uncertified copy.

Chapter VIII: Regional and International Applications

8.0 Introduction

The Institute acts as a receiving Office for regional applications under the Harare Protocol and for international applications filed under the Patent cooperation Treaty. Where the Institute acts as a receiving Office the following documents must be filed in triplicate: -

- the request,
- the description,
- the claims,
- the abstract; and
- the drawings where applicable.

An application for which the Institute is chosen by the applicant as the receiving Office must be filed directly with the Institute.

The initial processing and formal examination of international applications are carried out by the receiving Office and the International Bureau of the World Intellectual Property Organization (WIPO) in accordance with the provisions of the PCT. When the Institute is acting as a receiving Office, the formality checks will be done in accordance with the PCT Receiving Office Guidelines.

With regard to deadlines and procedural steps before the Institute as a receiving Office, examiners should use the guidelines for receiving office issued by the WIPO.

8.1 National Phase

Where an applicant is desirous of obtaining a patent in respect of Kenya through the PCT route, he must seek entry into the national phase by the 30th month from the international filing date. Where priority is claimed entry into the national phase should be sought by the 30th month from the priority date.

To enter the national phase the applicant should file the request on Form IP 13 and accompany with a copy of the patent application as published by the WIPO. During entry into the national phase it is the duty of the applicant to do the following:-

- if the applicant is non resident, must be represented by a registered patent Agent who should submit form IP 39 upon payment of the prescribed fee.
- Provide a translation of the specification if the international application was not published in English.
- Pay the application fee.
- Request for national processing of the application preferably by submitting a duly completed Form IP 13.

If any amendments have been filed and they are not in English, then under Regulation 79 the applicant should be invited to file the required translation within two months. Any amendment which remains not translated should be ignored.

8.2 Substantive Examination of PCT Applications

Ordinarily, PCT applications will be accompanied by the opinion of the international search examiner and/or the IPEA's examiner as to the presence of novelty, inventive step and

industrial applicability. Depending on the opinion of the IPER, applications will fall into one of the following three categories, which will determine course of substantive examination:

(i) PCT applications with a wholly favourable IPER

If the IPER is wholly favourable then the major requirements of section 44(3) can be taken as met. However the exclusions listed in sections 21(3) and 26 should be checked since methods for treating people and animals, methods for doing business etc. cannot be patented in Kenya but may be patentable elsewhere. If there is an objection under sections 21(3) and 26, a proposal to reject the application should be made stating the grounds of such refusal.

Where no objection under sections 21(3) and 26 a substantive examination report generated as well as an examiner's internal recommendation to grant forwarded to the Managing Director.

Upon approval by the Managing Director, the grant and publication procedure outlined earlier with regard to national applications should apply apply.

(ii) PCT applications with an IPER which is favourable in respect of novelty, inventive step and industrial application but where other defects or observations are noted

(iii) PCT applications with an IPER which is unfavourable in respect of one or more of novelty, inventive step and industrial application or with another major objection outstanding;

For this case there are basically two possibilities:

(a) the defects or observations are not at variance with the requirements of the Act or the Regulations therefore no valid objections can be raised. For instance, PCT rule 6.4(a) has provision different from the Act. In such cases, after checking the requirements of sections 21(3) and 26, the procedure set out in the case where the examiner internally recommends the application for grant above applies.

(b) the defects or observations are such that it is clear what constitutes a valid response.

ALL OTHER APPLICATIONS, ie

(III) PCT application with an IPER which is unfavourable in respect of one or more of novelty, inventive step and industrial application, or with another major objection outstanding.

(VI) PCT applications without an IPER;

The applicant may be requested to provide, in respect of any application for a patent (or other title of protection) for the same invention:

(1) the date and number of that application

(2) a copy of:
  (a) any search or examination report,
  (b) the patent (or other title),
  (c) any final decision refusing the application, and
  (d) any final decision invalidating the patent or other title.

(3) a verified translation of any of the above if not in English

Such documents may be used only for facilitating the evaluation of the novelty and Inventive step, ie such documents do not themselves provide the applicant with any rights in Kenya and the applicant too may be invited to comment on any of the documents he has furnished.

If a suitable equivalent patent i.e. one granted by an appropriate Industrial Property Office (or an equivalent application) has been noted by the applicant or found in the Patent Registry, e.g. by an online search, then a response should be issued suggesting amendment in accordance with the foreign patent. If the application has not yet been granted, the letter should be amended accordingly. The requirements of sections 21(3) and 26 should also be checked.

If a suitable equivalent has not been found, then the applicant should be invited to submit details of equivalent patents (or patent applications).

If Kenya is an elected Office then applicants cannot be required to furnish information or documents in respect of the same international application being examined in any other elected Office. The requirements of sections 21(3) and 26 should also be checked. Once a suitable granted patent in English - or a verified translation thereof filed under Regulation 79 - has been received, then the procedure set out for substantive examination of national applications is applied.

8.3 ARIPO Patents Utility Models designs designating Kenya

The examiner shall carefully scrutinize all patents and utility models applications designating Kenya with a view of ensuring that the provisions of the Act are fully complied with and that the requisite communications under the said sections are sent to the ARIPO Secretariat within six months from the date of the notification by ARIPO.

Chapter IX: Annual fees

Under section 61 in order to keep alive a patent application or a granted patent, an annual fee is annually due in advance by or before the anniversary of the filing date, starting one year after the filing date. However, the fee is payable within a grace period of six months provided that the applicant pays the prescribed surcharge.

If the application has not come through the PCT route, then the filing date will be that determined under section 41. If the application has come through the PCT route, then the filing date will be the international filing date.

Failure to pay annual or maintenance fee will result in the application or patent being deemed to be withdrawn or lapsed. Under section 38(7)(d)(ii) the lapse of a patent is required to be entered in the register and published in Industrial Property Journal or in the Gazette.

In the case of PCT applications, annual fees need not be paid until the application enters the national phase.

PART II: INDUSTRIAL DESIGNS

1.0 Introduction

These Guidelines are structured to follow the sequence of the examination process with each section and sub-section constituting a step in the registration proceedings from the receipt of the application up to registration and publication. The General Principles (see below) should be kept in mind throughout the whole examination process.

2.0 General Principles

2.1 Registration

The Industrial Property Act requires the creation and maintenance of a Register of designs in which the particulars of the registrations will be entered (Sec 45, Reg. 45).

2.3 Scope of Examination

The registration procedure involves examination of compliance with the requirements of the Act and the Regulations. However, there are three substantive grounds for refusing an application:
where the subject-matter of the application does not correspond to the definition of a design as set forth in Sec. 84 ; or

- where the design is contrary to public policy or accepted principles of morality. (Sec. 86 (4))
- where the design is not new as required by Sec. 86 of the Act.

(what about design copyright overlap?)

Where one of these three grounds is applicable, the examiner notifies the applicant accordingly in the examination report. The applicant will be given the opportunity of withdrawing or amending (Reg. 50) the application or of submitting his/her observations before the examiner takes a decision. The meanings of "design" and "public policy or accepted principles of morality" are explained in section 5 below.

2.5 Time Limits (Reg. 76)

The general rules for the calculation of time limits given in the Act, the Reg. (47(11) and 24(2,3)) and the 2nd Schedule are specified in these Guidelines. If a request for extension of a time limit is made before its expiry and reasons are given by the applicant, then a further period will be allowed. Additional extensions will be granted in exceptional cases only.

2.6 Decisions (Reg. 50)

In all cases where an examiner takes a decision adverse to the applicant the grounds for the decision must be given. Such decision is communicated via a standard letter, containing language that will be adapted to each particular case, which refers to the relevant provisions of the Regulations and explains the reason(s) for the decision.

2.7 Appeal (Sec. 112, Reg. 74, 75)

Applicants have a right to appeal against any decision of the Managing Director to the Industrial Property Tribunal.

2.8 Receipt of Application

Date of Receipt and File Number (Sec.87)

The application shall be presented by the applicant or agent to the Institute. The application will then be assigned a file number and receiving date then captured in IPAS upon payment of the filing fees; after which the application will be transmitted to the patent registry for further processing. In each case the pages of the document making up the application are marked with the date of receipt and the file number of the application.

2.9 Allocation of Filing Date

Minimum Requirements (Sec. 87(6))

In order to allocate a filing date to an application for a registered design the examiner checks whether the application contains at least:-

a) a request for registration of a design (IP. Form 27), and information identifying the applicant, and
b) a graphic representation of the article embodying the industrial design or a specimen. (sec 87(2) –specific on specimen requirement)
c) Application fees
d) Identification of the Applicant (Sec. 87(7))

The requirement under paragraph 4.1.(b) for according a filing date does not mean that the information identifying the applicant has to comprise all the details set out in paragraph 11.1. It has to be clear from that information who the applicant is, i.e. natural persons have to indicate at least their family name and given names(s); legal entities need to state their usual designation.

2.10 Representation of the Design (Sec. 87(7))

Since the representation is the means to specify the features of the design for which protection is sought, it is of utmost importance that it is clear and complete and that nothing regarding the design is left to conjecture.

Drawings, photographs (except slides), computer-made representations or any other graphical representation are accepted provided they are suitable for reproduction.

For the purpose of allocating a filing date, a representation is considered suitable for reproduction when it meets the requirement that the design must be reproduced on a neutral background and must not be retouched with ink or correcting fluid. It must be of a quality permitting all the details of the matter for which protection is sought to be clearly distinguished and permitting it to be reduced or enlarged to a size not more than 8 cm by 16 cm per view for entry in the Register and for direct publishing in the Industrial Property Journal referred to in Sec. 91. A background is considered neutral as long as the design is clearly discernible on it. It is acceptable to present graphic representations in colour-e.g. photographs mounted on paper.

The Institute accepts all representations of designs that meet the formal requirements of Reg.15. It is the responsibility of the applicant to ensure that the representation of the design is of a quality allowing all the details for which protection is sought to be clearly distinguished.

3.0 Filing date

The first task for the examiner is to determine whether the application meets the requirement for according the filing date. These requirements are prescribed under section 87(6) as listed in paragraph above.

The documents referred to above should be in English but do not have to meet any particular requirements as to form or presentation. It is essential however they be sufficiently legible to enable the information to be discerned. The applicant should be considered sufficiently identified whenever it is possible to establish the identity of the applicant beyond reasonable doubt on the basis of all data contained in the documents filed. Where there is more than one applicant each applicant must be similarly identified. No objection should be raised at this stage with regard to the status of the applicant or his entitlement to apply.

If the application does not fulfil these requirements the examiner is required to invite the applicant, within 14 days from the date of the examination, to submit the required correction. The invitation should indicate that the applicant has 60 days to comply. If the applicant does not comply with the invitation and, as a result, the examiner treats the application as if it had not been filed, the examiner should, within fourteen days, inform the applicant in writing.

Where an application meets the aforementioned requirements, the receiving date becomes the filing date and the same must be so communicated to the applicant in writing.

4.0 Formal Requirements

4.1 Details of the applicant (Sec. 87)

The applicant must state his/her name, address, nationality and the State in which he/she is domiciled or has his/her seat or establishment. Names of natural persons must be indicated by the person's family name and given name(s). In addition to their names, companies, firms and other legal entities must indicate their form of incorporation, which may be abbreviated (e.g. Ltd., Inc., PLC, S.A.), and indicate the law of the State governing them.

The names of legal entities should be given in full and only their form of incorporation may be abbreviated. The address should contain, if possible, the street, street number, city or county, postal code and country. The applicant should indicate only one address, but if there are several, the first one mentioned will be recorded by the examiner as the address for service, unless the applicant specifically designates another one as an address for service. The telephone numbers as well as fax numbers and details of other data communication links, such as electronic mail, may be given by the applicant.

4.2 Citation of Creator(s) (Sec. 85,33)

The application shall include a citation of the creator(s) or an indication that the creator(s) has/have waived the right to be cited. The citation and the waiver or the absences of any indication regarding the creator(s) are not subject to examination. Where neither a creator is cited nor a waiver of the right to be cited is indicated, an objection will be raised by the examiner.

In cases where the applicant is not the designer, a statement justifying the applicant’s right to the design-an assignment-shall also be filed.

4.4 Format of the Representation of the Design (Reg. 47)

The graphic representation of the design must consist of a graphic or photographic reproduction of a single design in black and white or in colour. It must fulfil the following requirements:

a) the representation must be filed on separate sheets of paper or reproduced on the page provided in the form made available by the Institute;
b) in case of separate sheets of paper, the design must be reproduced on white and opaque paper either pasted or printed directly on it. Only one copy must be filed and the sheets of paper must not be folded or stapled;
c) the size of the separate sheet must be A4 size (29.7 cm high, 21 cm wide) and the space used for the reproduction must not be larger than 26.2 cm x 17 cm. A margin of at least 2.5 cm must be left on the left-hand side; the sheets of paper must also indicate on the top the number of views and, in case of a multiple application, the consecutive number of the design; they must not contain any explanatory text, wording or symbols other than the indication or the name or address of the applicant;
d) the design must be reproduced on a neutral background and must not be retouched with ink or correcting fluid. It must be of a quality permitting all the details of the matter for which protection is sought to be clearly distinguished and permitting it to be reduced or enlarged to a size not more than 8 cm by 16 cm per view for entry in the Register and for direct publishing in the Journal. The Institute will accept colour representations. Where the representation is in colour, the registration and the publication will also be in colour.

It is the applicant's interest and responsibility to submit a suitable representation including a sufficient number of views to specify all the features of the design for which protection is sought. The examiner will not check whether the design might have other features which are not shown in the views as submitted.

The representation should include a sufficient number of different views of the design to enable the examiner conceptualize the features of the design for which protection is sought. Where the examiner is of the opinion that the number of views presented is not sufficient, he may ask for more. The views may be plain, elevation, section, or perspective views. Detail views of portions of the design on an enlarged scale may be used as well. The alternate positions of a design, or of a feature of the design, must be shown in separate views. Each of the representations must be labelled by the applicant in to indicate the views they represent. Where more than one view is presented, and the applicant has not indicated which view should accompany the publication, the examiner should select one representative view for publication.

The examiner should check whether the views relate to the same design. The representation of a design should be limited to the features for which protection is sought.

However, the representations may comprise other elements that help to identify the features of a design for which protection is sought. In an application for registration of a design the following identifiers will be allowed:-

a. Dotted lines may be used in a view either to indicate the elements for which no protection is sought or to indicate portions of the design which are not visible in that particular view, i.e. non-visible lines. Therefore, dotted lines identify elements which are not part of the view in which they are used.
b. Boundaries may be used to surround features of the design for which protection is sought.
c. Colouring may be used on a black and white drawing to highlight the features of the design for which protection is sought only. Where the design concerns ornamentation,

a product to which it is applied may be identified by dotted lines or the ornamentation may be surrounded by boundaries.

It is the applicant's responsibility to use the dotted lines, boundaries and colouring in such a way to make clear for which features protection is sought and for which not, since the examiner will not conduct any examination other than verifying the suitability of the reproduction for publication.

4.5 Repetitive Patterns

Where the registration of a design consisting in a repeating surface pattern is applied for, the representation of the design must show the complete pattern and a sufficient portion of the repeating surface.

4.6 Typographic Typefaces

Where registration for a design consisting of a typographic typeface is applied for, the representation of the design must consist of a representation of a string of all the letters of the alphabet, upper case and lower case, and of all the Arabic numerals, as well as of a text of five lines produced with the typographic typefaces, all being in the size pitch 16.

4.7 Signature

The application has to be signed by the applicant or his/her representative

4.8 Treating Deficiencies (Sec. 41(2, 3))

If there is any deficiency regarding one of the above requirements, the examiner notifies the applicant accordingly in the examination report.

5.0 Indication of Products

5.1 Clear Indication

The application must further contain an indication of the products in which the design is intended to be incorporated or to which it is intended to be applied. The applicant has to word the products in such a way as to indicate clearly the nature of the products and to allow each of them to be classified in only one class of the Locarno Classification. It should be noted that the indication of products does not affect as such the scope of protection of a design.

The examiner may invite the applicant to amend the wording used by the applicant in order to indicate a product with an equivalent term belonging to the Locarno Classification. Straightforward examples are synonyms American/English such as jewelry – jewellery, trunk – boot, sidewalk - pavement, nightshifts – nightshirts, garbage – rubbish etc. However, the examiner should refrain from replacing the applicant's wording with a more specific term.

5.2 Preferred Form

In order to speed up and simplify the registration procedure, it is highly recommended that applicants indicate the products by using the terms listed in the Locarno Classification which is accessible on-line at www.wipo.int.

5.3 Treating Deficiencies

In case the application does not contain an indication of products the examiner notifies the applicant of the deficiency in the examination report.

6.0 Transmission of the application to ARIPO (Reg. 31)

Where the applicant chooses to file his/her application at the Institute the date of receipt of the application by the Institute will become the date of filing, provided that the application meets all the formal requirements under the Harare Protocol. The Institute will prepare and transmit the application immediately the applicant pays the transmittal fee together with the actual cost of mailing.

7.0 Treating Deficiencies

Where a priority is claimed, the examiner should check whether:

a) the file number of the earlier application is indicated;
b) the filing date of the application for a registered design falls within the period of six months of the claimed priority date;
c) the previous application(s) has/have been filed in or for a State on the Paris Convention list or the WTO list;
d) the time limit to file a declaration of priority is complied with.

The examiner will examine whether the subject-matter of the priority application and the present application are the same. He will raise an objection only where a clear discrepancy is found.

Where a deficiency has been found, the examiner will invite the applicant to remedy the deficiencies in the examination report. If the deficiencies cannot be remedied, the right of priority will be lost.

Where the examiner finds that the applicant has lost a right to claim a priority, he/she notifies the applicant accordingly.

8.0 Examination: Grounds for Non- Registrability.

The examiner will refuse the application where he/she finds that the subject-matter of the application does not correspond to the definition of a design as set forth in Sec. 84 ; or is not novel as required by Sec. 86 , or is contrary to public policy or to accepted principles or morality.

8.1 Definition of "design" (Sec. 84a).

An "industrial design" means any composition of lines or colours or any three dimensional form, whether or not associated with lines or colours; Provided that such composition or form gives a special appearance to a product of industry or handicraft and can serve as a pattern for a product of industry or handicraft.

A "product" means any industrial or handicraft item, including packaging, get-up, graphic symbols or typographic typefaces, but excluding computer programs.

Compliance with the definition of a design is subject to examination. Failure to comply with the definition constitutes a ground for non-registrability.

Where the application concerns the design of a product composed of multiple components, the representation of the design must include at least one view showing the product as a whole, i.e. all components assembled, otherwise the representation is considered as comprising multiple designs. A representation comprising multiple designs constitutes a deficiency in the format of the representation (see paragraph 11.4).

Where a representation comprises a set of articles, the representation will not be considered as representing a design in the meaning of Sec. 84 except where it is clear from the

representation that protection is sought for a design resulting from the combination of the features of the articles. Such a combination may arise e.g. where the articles of the set are so closely related that they can be considered as forming a single product. For example, where forks, spoons and knives show common features, they will be considered as set of articles. At least one view has to show the set of articles together.

Whether the product indicated is actually made or used, or can be made or used, in an industrial or handicraft manner, shall not be examined.

8.2 Public Policy and Morality (Sec. 86(4))

The examiner rejects an application if the design is contrary to public order or accepted principles of morality. There is no legal definition of "public order" and "morality" in the Act. Any refusal on that ground has to be reasoned by reference to the perception of the public within Kenya. By way of example, designs that contain racist messages or images are not acceptable. Poor taste manifested in a design is not a ground for non-registrability.

8.3 Treating Deficiencies (Sec. 87(7); Reg. 50)

Where a ground for non-registrability is found, the examiner will notify the applicant in the examination report along with other deficiencies, if any. A time limit of sixty days will be set for the applicant to submit his/her observations, request for a hearing, withdraw the application or amend it by submitting an amended representation of the design, provided that the identity of the design is retained. The application will be rejected if the applicant fails to overcome the ground for non-registrability.

9.0 Classification

9.1 Purpose (Sec. 87 (4))

The examiner has to bear in mind that the classification of products serves exclusively administrative purposes. It does not affect as such the scope of protection of a design.

9.2 Locarno Classification

The most recent version of the Classification under the Locarno Agreement applies. The Locarno Agreement contains a List of Classes and an Alphabetical List giving a general indication of fields to which the products belong. The Alphabetical List should be consulted for the classification of each specific product.

9.3 Classification by the Applicant

The applicant may submit with the application a classification of products indicating the class(es) and sub-class(es) according to the Locarno Classification.

If the applicant provides a classification, the products must be grouped according to the classes of the Locarno Classification, each group being preceded by the number of the relevant class and presented in the order of the classes and sub-classes.

The applicant's failure to submit a classification or failure to group or sort the products as required does not constitute a deficiency. The examiner is bound to confirm the applicant's classification or re-classify the application according to the current Locarno Classification.

9.4 Classification by the Examiner

Where the applicant has not submitted a classification, it will be produced by the examiner.

Where the applicant has submitted a classification, but the classification being incorrect, the examiner will substitute the classification of the applicant by his classification.

If a product cannot be classified in accordance with the List of Classes or the Alphabetical List, the examiner may either request the applicant to specify the nature and purpose of the designated product, or classify the product in class 99 of the Locarno Classification (i.e. "Miscellaneous") on condition that the product will be removed from this class as soon as a suitable class is determined.

10.0 Multiple Design Applications

Two or more industrial designs may not be the subject of the same application (multiple design application). The Act has no provision for filing of multiple designs in a single application. Such a filing constitutes a deficiency.

11.0 Priority

Previous Application(s) (Sec. 37)

Priority may be claimed on the basis of a previous (first) application of a design filed in or for a State which is party to the Paris Convention or a member of the WTO. Priority can only be claimed where the application for a design is filed within six months from the date of filing of the first application(s).

Where priority claim is declared for an application, the applicant must indicate the file number of the previous application(s) and file a copy thereof or the registration certificate issued by the competent authority shall be demanded by the Institute after three months from the date of making the declaration. Such a demand must be complied with within 90 days from the date of invitation.

12.0 Publication and opposition Period (Reg. 48 and 49)

For all applications recommended for registration, the Managing Director shall publish a notice of an application to register an industrial design in the Kenya Gazette or in the Industrial Property Journal. Before the notice is published, the applicant shall pay the publication fee. Within 60 days after the notice of the application is published a person may oppose the application by giving a notice of opposition in Form IP 23 in duplicate to the Managing Director.

The notice of opposition shall set out the grounds for opposing the application. The Managing Director shall give one copy of the notice of opposition to the applicant. Within 42 days after receiving the notice of opposition, the applicant shall give a counter-statement in Form IP 28 in duplicate to the Managing Director. The counter-statement shall set out the grounds the applicant relies upon to support the application and shall set out any facts alleged in the notice of opposition that the applicant admits.

The Managing Director shall give one copy of the counter-statement to the person opposing the application. Within 42 days after receiving the counter-statement, the person opposing the application shall give to the Managing Director and to the applicant a statutory declaration or affidavit supporting the opposition to the application.

Within 42 days after receiving the statutory declaration or affidavit of the person opposing the application, the applicant shall give to the Managing Director and to the person opposing the application a statutory declaration or affidavit supporting the application.

Within one month after receiving the statutory declaration or affidavit of the applicant, the person opposing the application may give to the Managing Director and to the applicant a statutory declaration or affidavit replying to the applicant's statutory declaration or affidavit.

A statutory declaration or affidavit replying to the applicant's statutory declaration or affidavit shall be confined to matters strictly in reply. If the applicant fails to provide a counter-statement or a statutory declaration or affidavit, the application shall be deemed to have been withdrawn.

If the person opposing the application fails to provide a statutory declaration or affidavit, the opposition to the application shall be deemed to have been withdrawn.

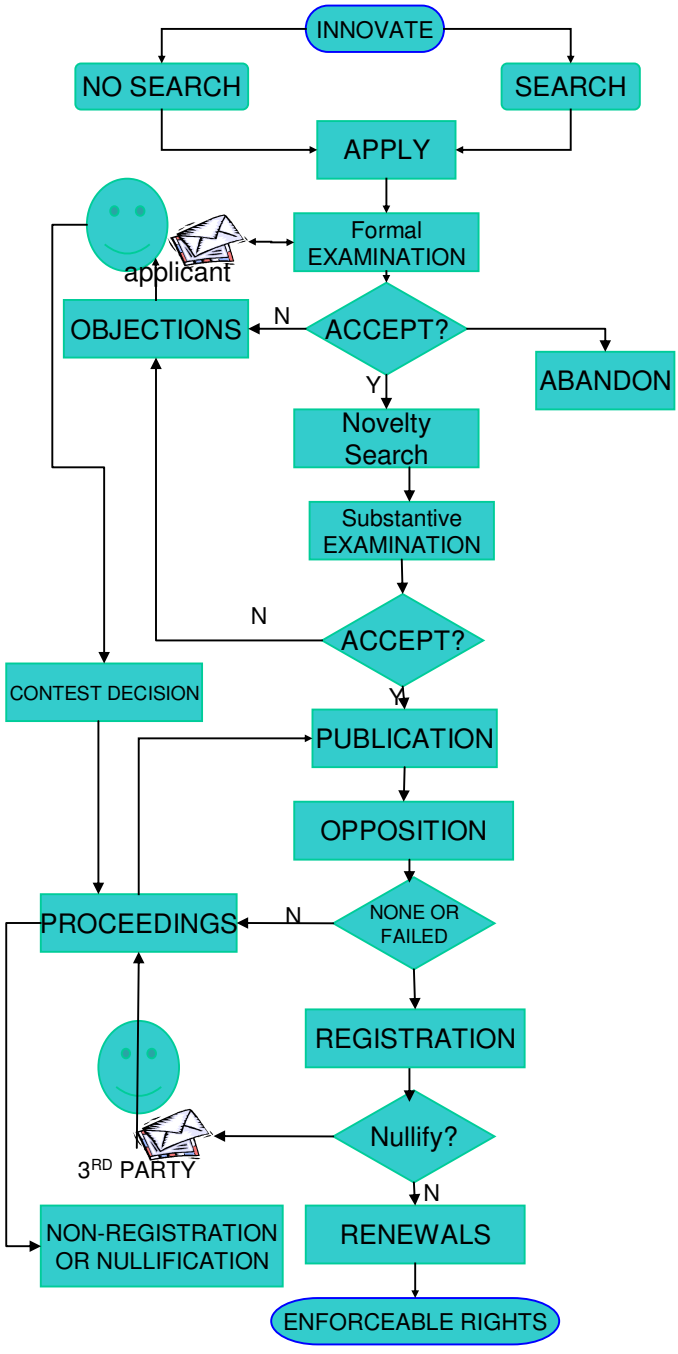
After all documents have been provided the Managing Director shall conduct a hearing of the matter. The Managing Director shall give at least 14 days notice of the hearing to each party. A party may be heard at the hearing only if the party provides the Managing Director with a notice in Form IP 29 at least seven days before the date of the hearing. At the hearing no evidence other than the evidence provided by statutory declaration or affidavit may be introduced without the leave of the Managing Director. The Managing Director shall give each party a written notice of his decision together with written reasons. If there is more than one person opposing the application the Managing Director may provide for the objections to be dealt with at the same hearing.

A party may appeal the Managing Director's decision to the Tribunal within ninety days after the date of the notification of the decision.

13.0 Registration and Issuance of Certificate(Regulation 52)

A registration certificate is issued after expiry of sixty days from publication of the design application without any opposition.

INDUSTRIAL DESIGN PROCESSING PROCEDURE



OFFICE ACTION & TIMELINE

Search report within 14 days

Checklist D1-Reception
Acknowledgement within 7 days

Checklist D2-Formality Examiner
Examination Report within 14 days of finding (Reg.47(11), 24(2))

Invite Corrections-F. Examiner
Allow 60 days for corrections (Reg.47(11), 24(2)
or consider abandoned

Search Report within 14 days (see search procedures)

Checklist D3-Sub. Examiner
Examination Report within 14 days of finding (Reg.47(11), 24(2)
Allow 60 days for corrections (Reg.47(11), 24(2); and respond to Request for written reasons within 45 Days (Reg. 50)
or consider abandoned

Checklist D4-CPE
Publication Fee within 60 days of notice (Reg.47(11), 24(2))

Opposition Period-CPE/MD
Allow 60 days for opposition

Checklist D5-CPE
Preparation of Certificate-CPE
Registration-Registrar

9 month Period-IPT
CPE/MD-Defend Decision

14.0 References

1. Industrial Property Act 2001
2. Industrial Property Regulations, 2002
3. Guidelines for Examination in the European Patent Office.
4. PCT Guidelines
5. USPTO Examination Manual