



## Topic 9: **Specific requirements for patentability**

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# Requirements of patentability

## ■ Examination has to check

■ Technical nature

■ Unity

■ No case of exclusion

■ Industrial applicability

■ Novelty

■ Inventive step

■ Sufficient disclosure

■ Legal certainty of claims (clarity)

■ Additions to initial disclosure

Should be  
checked before  
prior art search

Requires prior art search

# Differences of national legislations

- Basic categories of requirements are the same in most jurisdictions (unity, novelty, inventive step, technical nature)
- Some differences exist in how the term "invention" or "patentable invention" is defined (positively, negatively)
- Differences, however exist mostly in terms of exclusions, e.g.
  - US do grant business methods, software patents,..
  - DE/EP grants new use of known compound, PK does not
  - Islamic countries exclude, e.g., inventions related to pork
- For analysis, see e.g. SCP studies on WIPO website:  
[http://www.wipo.int/edocs/mdocs/scp/en/scp\\_13/scp\\_13\\_3.pdf](http://www.wipo.int/edocs/mdocs/scp/en/scp_13/scp_13_3.pdf)

# Differences of national legislations

- Paris convention and PCT treaty do not address exclusions from patentability
  - PCT permits ISA to exclude certain subject matter from search
- TRIPS permits exclusions of certain subject matter
- Further important differences exist in case law, e.g.
  - Technical nature of software related patents
  - Inventive step
- Further important differences exist with respect to limitations of the rights of the owner of a granted patent (not relevant for this workshop), e.g. the research privilege