

REF: C.8403

GHANA PATENT OFFICE
REQUIREMENTS FOR INVENTIVE STEP AND SUFFICIENCY OF DISCLOSURE

INVENTIVE STEP

(i) Definition of a Person Skilled in the Art;

Section 3(5) of the Ghana Patent Act, 2003 (Act 657), provides for a person who has ordinary skill in the art.

It states as follows:

"An invention shall be considered as involving an inventive step if, having regard to the prior art relevant to the application claiming the invention and as defined in subsection (3), it would not have been obvious to a person having ordinary skill in the art".

(ii) Methodologies Employed for Evaluating Inventive Step;

The Ghana Patent Office does not carry out substantive examination of patent applications. All such examinations are out-sourced to an external search and an examination authority, particularly to the appropriate ISAs or to ARIPO. The relevant provision of the law is Section 9 of the Ghana Patent Act, 2003 (Act 657), which provides for filing date and examination. It states as follows:

9. Filing date; examination

(6) "The Registrar, after according the filing date, shall examine whether the application complies with the requirements of section 5 subsections (1), (2), (3) and (4), and the other requirements designated as formal requirements and whether information requested under section 8, has been provided". (Section 8 refers to information concerning corresponding foreign applications and patents).

(7) "Where the Registrar is of the opinion that the application complies with the requirements indicated in subsection (6), the Registrar shall **cause the application to be examined** as to whether the requirements of sections 1(2) and (3), 2, 3, 5(5), (6), (7), (8), and 6 have been complied with.

(8) For the purposes of subsection (7), the Registrar shall take into account

- (a) the results of any international search report and any international preliminary examination report established under the Treaty in relation to the application; or
- (b) a search and an examination report submitted under section 8(2)(a) which relates to a corresponding foreign application; or
- (c) a final decision submitted under section 8(2)(c) on refusal to grant a patent on a corresponding foreign application; or
- (d) a search and an examination report which was carried out upon the request of the Registrar by an external search and an examination authority.

(iii) **Having Regard to Prior Art, the Level of Inventiveness (Obviousness) to Meet the Inventive Step Requirement.**

The Level of Inventiveness as indicated in Section 3(5) of Act 657, is one that would not have been obvious to a person having ordinary skill in the art.

SUFFICIENCY OF DISCLOSURE

(i) **Enabling Disclosure Requirement:**

The enabling Disclosure Requirement has been provided in Section 5 of the Ghana Patent Act, 2003 (Act 657) and Regulation 7 of the Ghana Patent Regulations, 1996 (L.I.1616).

Section 5(1) of the Act states that, "An application for the registration of a patent shall be filed with the Registrar and shall contain a request, a **description**, one or more claims, one or more drawings where required, and an abstract".

Section 5(5) states that, "the description shall disclose the invention in a manner sufficiently clear and complete for the invention to be carried out by a person having ordinary skill in the art, and shall, in particular, indicate, at least, one mode known to the applicant for carrying out the invention".

Regulation 7(1)(e) of Ghana Patent Regulations, 1996 (L.I.1616) also states that, the application should, "state the best mode known to the applicant for carrying out the invention by the inventor at the filing date or, where priority is claimed, the priority date of the application, this shall be done in terms of examples where appropriate and with reference to the drawings if any".

(ii) **Support Requirement:**

Other support requirements can be found in the remaining subsections of Section 5 of Act 657.

Section 5(2) "The applicant shall be subject to the payment of the prescribed application fee."

5(3) "The request shall contain a petition to the effect that a patent be granted, the name of and other prescribed data concerning the applicant, the inventor and the agent, if any, and the title of the invention".

5(4) "Where the applicant is not the inventor, the request shall be submitted with a statement justifying the applicant's right to the patent".

5(6) "The claim or claims shall define the matter for which protection is sought".

5(7) "Claims shall be clear and concise and shall be fully supported by the description".

5(8) "Drawings shall be required when they are necessary for the understanding of the invention".

5(9) "The abstract shall merely serve the purpose of technical information; in particular, it shall not be taken into account for the purpose of interpreting the scope of the protection".

Where the invention relates to microorganisms, regulation 8 of L.I. 1616 is also applicable.

Regulation 8(1): "Where the content of an application for a Microorganisms patent discloses an invention which requires for its performance the use of a microorganisms which is not available to the public at its date of filing, its contents shall be treated as disclosing the invention in a manner which is clear and complete enough for the invention to be performed by a person skilled in the art if the following conditions are satisfied

(a) a culture of the microorganism has been deposited in a culture collection not later than the date of filing the application.

(b) the application as filed gives the relevant information when as is available to the applicant on the characteristics of the microorganism; and

(c) the name of the culture collection, the date when the culture was deposited and the accession number of the deposit are given in the description of the application.

(2) Where the information is given as specified in sub-regulation (1) that information shall be considered as constituting the unreserved and irrevocable consent of the applicant to the culture deposited being made available to any person who, on or after the date of the publication of the application, makes a valid request for the culture collection with which the microorganism is deposited.

(3) A request for the information shall be valid if it is accompanied by the Registrar's certificate authorizing the release of the sample to that person. An application for such a certificate shall be submitted to the Registrar, accompanied by the prescribed fee, on Form No. 3 in the First Schedule together with-

- (a) an undertaking not to make culture available to any person until the application for the patent is refused or withdrawn or been considered to be withdrawn or, if a patent is granted, until it cease to have effect without the possibility of renewal or restoration; and
- (b) an undertaking to use the culture for experimental purposes only until the application is refused or withdrawn or deemed to be withdrawn or until the date of publication in the Gazette that the patent has been granted.

(3) The Registrar shall send a copy of Form No. 3 in the Second Schedule to the applicant or owner of the patent.

(iii) Written Description Requirement:

Written description is provided in Section 5(1) and (5) of Act 657 and regulation 7 of L.I.1616, as indicated above.

Regulation 7 of L.I.1616 states as follows:

7. (1) The description shall, after stating the title of the invention -

- (a) specify the technical field to which the invention relates;
- (b) indicate the background art which, as far as the applicant knows, can be regarded as useful for the understanding, searching and examination of the invention, and, preferably, cite the documents reflecting the background art;

(c) disclose the invention as claimed so that the technical problem and its solution can be understood and state the advantageous effects of the invention with reference to the background art;

(d) briefly describe the figures in the drawings, if any;

(e) state the best mode known to the applicant for carrying out the invention by the inventor at the filing date or, where priority is claimed, the priority date of the application, this shall be done in terms of examples where appropriate and with reference to the drawings if any; and

(f) indicate explicitly, when it is not otherwise obvious from the description or nature of the invention, the way in which the invention is capable of industrial application or of other use.

(2) The contents of the description of the invention shall be presented in the order in which the contents are listed in sub-regulation (1), unless, because of the nature of the invention, a different order affords a better understanding and a more economical presentation.