

ZAMBIA

INFORMATION PURSUANT TO THE DECISION OF THE STANDING COMMITTEE ON THE LAW OF PATENTS (SCP), AT ITS TWENTY-FOURTH SESSION - DOCUMENT SCP/24/5, PARAGRAPH 17 IN RELATION TO THE ZAMBIA NATIONAL LAW

In Zambia, the history of Industrial Property protection for patents, traces its origins to the United Kingdom which had colonized Zambia. The first Act was the Patent Act of 1958, which was adopted at independence. This law was last amended in 1994, thus the Patents Act, Cap. 400 of the Laws of Zambia. This is the principle law operating in Zambia and therefore, the comments made are mainly based on this piece of legislation.

(i) Practical experiences on the effectiveness of, and challenges associated to exceptions and limitations to patent rights.

The Patents Act precludes from Patentability the following: diagnostic, therapeutic and surgical methods for treatment of humans or animals, plants and animals other than micro-organisms, discoveries, scientific theory or mathematical method; a scheme, rule or method for performing a mental act, playing games or doing business or computer programme; literary and artistic work and presentation of information.

Implementation of this provision has been a challenge in the sense that the Office receives a lot of inquiries pertaining to inventions relating to diagnostic, therapeutic and surgical methods for treatment of humans or animals, plants and animals other than micro-organisms. Potential inventors are turned away based on this practice.

(ii) Court cases with respect to client-patent advisor privilege

The client-attorney privilege refers to the right to resist request from authorities or other parties, e.g. courts, arbitration proceedings and administration bodies to disclose IP advice rendered by patent attorneys to their clients in their professional capacity. The rationale behind this is to ensure the enforcement of IP rights by owner and third parties so that they are able to communicate freely with IP advisers on matters pertaining to patent applications.

As a country, we have the law, Chapter 30 -Legal Practitioners Act, which governs the client-attorney privileges and rights. This is notwithstanding the fact that there are certain common rules that apply or recognized in any legal system. Part X of the Patents Act is very elaborate regarding this issue. This law provides for who is entitled to practice, privileges, restrictions and offences in connection with practice. Further, it provides for the Patent Agent and their function, qualifications, privileges of legal practitioners as well as entitlement to practice as patent agent. One important element critical and which is clear and must be noted is that a

person wishing to practice in Zambia as an attorney must be a resident and registered in accordance with the Legal Practitioners Act.

In view of the above, my country notes that there is no universally applied system on the issue of cross-border aspect of confidentiality of communication between clients and patent advisors. The issue has divergence approaches depending on national legislation of the country and as such it is an aspect which borders on the national sovereignty. For instance, in some countries privileges apply only to lawyers and not IP professionals, while in other jurisdictions the privilege is extended to non-lawyer IP advisers who are officially recognized. That being the case, setting minimum standards on this issue may not work in the sense that the subject cuts across IP issues. Therefore the issue can well be handled by an individual country depending on their type of legal system.

(iii) Certain aspects of national/regional patent laws

This part relates to Revised Annex II of document SCP/12/3 Rev. 2: Report on the International Patent System. We wish to report that no new developments have taken place to change the current status appearing on the website provided.

(iv) Opposition system and other administrative revocation and invalidation mechanisms

Opposition System:

The Act provides for a pre-grant mechanism of opposition under section 22 of the Act. Section 22 of the Act provides that:

“Any person interested, including the State, may, within three months from the date of the advertisement of the sealing of the patent, oppose the grant of a patent in accordance with the provisions of this section by giving written notice to the Registrar of opposition to such grant on the following grounds:

- (a) that the applicant is not a person entitled under section eleven to make the application;*
- (b) that the application is in fraud of the rights of the person giving such notice or of any persons under or through whom he claims;*
- (c) that the invention does not relate to an art (whether producing a physical effect or not), process, machine, manufacture or composition of matter, which is capable of being applied in trade or industry;*
- (d) subject to the provisions of section thirty-one, that the invention is obvious in that it involves no inventive step*

- having regard to what was common knowledge in the art at the effective date of the application;*
- (e) *that the invention is not useful;*
 - (f) *that the complete specification does not fully describe and ascertain the invention and the manner in which it is to be performed;*
 - (g) *that the claims of the complete specification do not sufficiently and clearly define the subject-matter for which protection is claimed;*
 - (h) *that the complete specification does not disclose the best method of performing the invention known to the applicant at the time when the specification was lodged at the Patent Office;*
 - (i) *that the application contains a material misrepresentation;*
 - (j) *that the invention described or claimed in the complete specification is not the same as that described in the provisional specification, and-*
 - (i) *in so far as it is not described in the provisional specification, was not new at the date when the complete specification was lodged at the Patent Office;*
 - or
 - (ii) *forms the subject of a pending application made in Zambia for a patent the effective date of which is prior to the date on which the complete specification was lodged at the Patent Office;*
 - (k) *in the case of a convention application, that the specification describes or claims an invention other than that for which protection has been applied for in the convention country and that such other invention either-*
 - (i) *forms the subject of an application for a patent in Zambia which, if granted, would bear a date in the interval between the lodging of the application in the convention country and the effective date of the application in Zambia; or*
 - (ii) *is not an invention as defined in this Act;*
 - (l) *that the invention was not new at the effective date of the application;*
 - (m) *that the specification includes claims which, in terms of subsection (1) of section eighteen, should have been refused”.*

Revocation:

The Act provides for revocation mechanism of a granted patent under section 50 of the Act. The circumstances under which this provision can be invoked are all covered by the Act. Section 50 of the Act provides that:

“Application for revocation of a patent may be made to the High Court by any person interested, including the State, upon any one or more of the grounds on which the grant of a patent might have been opposed, but subject to the provisions of subsection (2), of proviso (ii) to paragraph (b) of subsection (7) of section eight, and of paragraph (b) of subsection (1) of section ten, on no other grounds”.

(v) *International work-sharing and collaborative activities for search and examination of patent applications*

This issue borders on the mechanism employed by the national IP office in prosecuting patent applications. It is imperative to state from the onset that most patents granted in the office are foreign applications including PCT applications, and as such, they come with search reports from the convention country. In carrying out patent search and examination, the office utilizes search and examination reports prepared by other offices and patent prosecution information of corresponding foreign applications and patents. The office also utilizes various frameworks, mechanisms and tools that have been developed such as, TISC, regional agreement and bilateral agreement which constitute work-sharing during search and examination work products. On the regional level, the office is part of the regional grouping, ARIPO, which grants patent on behalf of member states. Section 10A of the Patents Act provides for the mechanism of effecting patents granted by the regional body. In case of international applications proceeding under the PCT system, the office has bilateral agreements with Austria and Swedish Patent Offices to undertake the responsibility of conducting prior art searches and examination of applications. All these mechanisms are aimed at granting quality patents.

In a nutshell, the spirit of work-sharing programs among patent offices and the utilization of external information for search and examination and use of various external databases for retrieving information relevant to search and examination, such as prior art from foreign applications is very progressive as long as it does not lead to norm setting because each country has its national laws to follow.