



00891/OAPI/DG/DGA/DPI

Yaounde, 16 March 2015

Mr. Francis Gurry
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Your ref: C.B-403

Re: Criteria for inventive step and sufficient disclosure

Dear Mr. Director General,

I am writing in response to your letter, C.B-403, of 15 December 2014, to the African Intellectual Property Organization (OAPI) and its Member States regarding the above-mentioned information. In my opinion, it seemed more resourceful for me to write to you on behalf of OAPI's Member States, given that they share common, uniform legislation.

Inventive step

Pursuant to the Bangui Agreement, an invention shall be considered as involving an inventive step if, to a person skilled in the art, the invention does not obviously derive from the prior art.

There is no inventive step where, working with only knowledge of the state of the art and employing only his professional skills, a person skilled in the art could achieve the technical solution leading to the invention.

For an invention to involve an inventive step, it must lie outside current knowledge and beyond what is obvious.

The main difficulty for assessing the inventive step lies in identifying the person skilled in the art and the art in which he must be skilled.

Equally, there is the issue of identifying the content of the state of the art available to the person skilled in the art.

One of the conditions for the patentability of an invention is the sufficiency of the description through the search for the inventive step, within the meaning of non-obviousness under the Bangui Agreement. This is assessed in relation to the unit of measure, the person skilled in the art, who is active in the relevant field of technology.

In terms of examination, the Organization has yet to verify this criterion.

Person skilled in the art

OAPI understands "a person skilled in the art" to be a person with ordinary knowledge and average ability; his level depends on the very nature of the relevant technology; he is abreast of all of the prior art; his knowledge of the state of the art is only what is expected of an average professional knowledge; he also knows the state of the art specified in the patent. Where an invention encompasses multiple areas of technology, a person skilled in the art is a person who has ordinary knowledge in each of the relevant areas of technology.

It can be noted that the chosen expression refers to a person skilled in the art and not a person skilled in art. This plausibly demonstrates the will to place the specialization of a person skilled in the art within the field of technology relevant to the invention.

For this reason, the Bangui Agreement states that “the description must set out the invention clearly and completely so that a person with ordinary knowledge and skill in the art could carry it out”.

The description must contain everything necessary not only to understand the invention but also to execute or apply it; it is not enough for the description to be complete; it has to be clear, i.e. there can be no vagueness or ambiguity.

Sufficiency of disclosure

The description shall be considered sufficiently complete and clear where a person skilled in the art can carry it out. In this way, a description is sufficient if it includes the components of the invention and indications enough to allow a person skilled in the art to execute the invention using his knowledge and skills.

Nevertheless, the description need only present the means necessary for carrying out the invention; there is no requirement for the description to reveal those indications for the practical execution of the invention, i.e. execution know-how. There must be no confusion between the invention, pertaining to the patent, and its execution, pertaining to industrial know-how.

Sufficiency of disclosure must be assessed in the light of the knowledge and skills of a person skilled in the art on the filing date of the patent application, or the date on which priority was claimed. For priority to be granted, it is sufficient that the subject of the claims is contained in the priority document. National criteria for determining sufficiency of disclosure can only be applied to the descriptions filed in a given country, and not for priority documents.

The description has a relatively uniform structure. The following rules may be applied to the description:

- i. The invention must be described relative to the state of the art. To do this, the description must indicate: the title of the invention, i.e. its technical designation; the relevant field of technology; and the prior art, to the extent necessary to understand the scope of the invention.
- ii. The description must define the invention. The invention is first defined in general terms referring to the problem at hand and the solution provided. It must then go into detail, including the means necessary and the specific modalities for executing it. In general, there is no requirement to list the advantages of the invention, except where information on the advantages gives meaning to the solution achieved by the invention. Finally, at least one embodiment should usually be included.
- iii. There is no requirement for the description to provide the best solution for producing the invention; in fact, it is often impossible to determine the best method of production, and, at any rate, this is specific to neither the invention nor the patent, but to the technology used to carry out the invention;
- iv. Finally, there is no requirement for the description to indicate any possible or potential harm caused by the invention; such indications, regardless of their merits with regard to



environmental protection, do not relate to the patent either but solely to exploitation controls.

- v. It is desirable for the drawings to constitute an integral part of the description and to be protected by patent in their own right. Besides rectifying purely manifest errors, modifications of the description of the invention can also be performed during the grant procedure under the supervision of the examiner, and only on the condition that the modification does not add any new inventive material to the description.
- vi. No claim shall be granted except where it is based on the description.

The regional system for the protection of intellectual property of the African Intellectual Property Organization (OAPI) is enshrined in the Bangui Agreement of 24 February 1999 with its 10 annexes, including Annex I on Patents. This uniform Convention constitutes national law in each of the 17 States of the OAPI, namely:

Benin, Burkina Faso, Cameroon, Central African Republic, Comoros, Congo, Côte d'Ivoire, Gabon, Guinea, Guinea Bissau, Equatorial Guinea, Mali, Mauritania, Niger, Senegal, Chad and Togo.

Patent examinations are conducted pursuant to the provisions of the Bangui Agreement and its implementing regulations, together with administrative instructions.

Yours sincerely,

for the Director General of OAPI

[signed]
Juliette Ayite
Deputy Director General