

INFORMATION PURSUANT TO THE DECISION OF THE STANDING COMMITTEE ON THE LAW OF PATENTS (SCP), AT ITS TWENTY-FIRST SESSION - DOCUMENT SCP/21/11 REV. IN RELATION TO THE ZAMBIA NATIONAL LAW

The law that provides for protection of inventions in Zambia is the Patents Act, Chapter 400 of the laws of Zambia and therefore, the comments made are mainly based on this piece of legislation.

1. INVENTIVE STEP

The term “inventive step” is used as “not obvious” in section 2 of the Act, which provides that:

*"invention" means any new and useful art (whether producing a physical effect or not), process, machine, manufacture or composition of matter which is **not obvious**, or any new and useful improvement thereof which is **not obvious**, capable of being used or applied in trade or industry and includes an alleged invention"*

(i) The definition of a person skilled in the art.

The current Patent Act, Cap 400 of the Laws of Zambia does not provide for this the definition of the term “person skilled in the art”. In this regard, the phrase should be given the ordinary grammatical meaning as provides for under the **Patent Cooperation Treaty Guidelines**. The proposed Bill to amend this piece of legislation has not incorporated this term or phrase and therefore it will not be part in the new law to be enacted.

(ii) Methodologies employed for evaluating the inventive step

The current Patent Act does not expressly provide for methodologies employed in evaluating the inventive step. You may wish to note that the office does not carry out substantive examination although the Act provides for such. Instead we rely on the examination reports from ARIPO and in case of PCT applications, the accompanying search report including the methodologies employed for evaluating therein. Further, we send search request to either Austrian Patent office or Swedish Patent Office in cases where we act as a receiving Office for PCT application. The methodologies for evaluating the inventive step have not been provided for even in the proposed bill to amend the Act to be enacted.

The methodology used by ARIPO is Problem -Solution – Approach (PSA), which involves the following three main stages/levels:-
(i) determining the "closest prior art", (prior art document is document that is generally of similar use to the claimed invention and has most common technical features to the claimed invention and, that the said prior art document must have been published before the filing date of the claimed invention);
(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.

(iii) Having regard to the prior art, the inventive step requirement

The current Patent Act does not expressly provide for the inventive step requirements employed in evaluating the inventive step. However, the proposed Bill to amend this piece of legislation has incorporated the requirements to employ in determining inventive step and therefore will be part of the new law to be enacted. The section in the proposed Bill reads:

“(1) An invention shall be considered as involving an inventive step if, having regard to the prior art relevant to the patent application claiming the invention, it would not have been obvious to a person ordinarily skilled in the art to which the invention pertains on the date of the filing of the application or, if priority is claimed, on the priority date in respect thereof.

(2) In relation to subsection (1) of this section, the prior art shall be considered as a whole, including not only individual elements of the prior art, or parts of elements taken separately, but also combinations of such elements or parts of elements where such combinations are obvious to a person skilled in the art.

(3) The state of the art in case of an invention to which an application for a patent relates shall also comprise matter contained in an application for another patent which was published or became open to public inspection on or after the priority date of that invention, if -

(a) that matter was contained in that application for that other patent both as filed and as published or open to public inspection; and

(b) the priority date of that matter is earlier than that of the invention”.

2. SUFFICIENCY OF DISCLOSURE

The current Patent Act expressly provide for disclosure requirement in order to meet the application requirements. In the regard, the relevant sections are provided for under sections 12, 13, 14 and 16 of the Act.

(i) **Enabling disclosure requirement**

This requirement is covered under section 14 of the Act, which provides that:

(1) Every specification shall indicate whether it is a provisional or a complete specification and shall commence with a title sufficiently indicating the subject to which the relevant invention relates.

(2) A provisional specification shall fairly describe the invention.

(3) A complete specification shall—

(a) fully describe the invention and the manner in which it is to be performed;

(b) disclose the best method of performing the invention known to the applicant at the time when the specification is lodged at the Agency; and

(c) end with a claim or claims defining the subject-matter for which protection is claimed.

(4) The claim or claims of a complete specification must relate to a single invention, must be clear and succinct, and must be fairly based on the matter disclosed in the specification.

(5) Every specification shall be accompanied by drawings if required by the Registrar, and such drawings shall be deemed to be part of the specification, but if drawings which accompanied a provisional specification are sufficient for the purpose of a complete specification, it shall suffice if that complete specification refers to such drawings.....

(ii) **Support requirement**

This requirement is covered under Regulation 7 of the Act, as evidence in support of the convention application. The provision states that:

(1) In addition to the specification lodged with every convention application, there shall be lodged with the application, or within six months thereafter, a copy of the specification and drawings or documents lodged in respect of the relevant first application or applications for protection in a convention country, duly certified by the official chief or head of the patent office of the convention country, or otherwise verified to the satisfaction of the Registrar.

(2) If any specification or other documents relating to the application is in a foreign language, it shall be accompanied by a translation thereof in the English language verified to the satisfaction of the Registrar.

(iii) **Written description requirement**

The Act provides that the application must be in the prescribed form and manner, according to section 12 (1) (a) and (b) to be read together with sections 13 and 14 above. A written description is what is covered, or envisaged by section 14 above. Section 12 provides that:

(1) Every application for a patent shall—

(a) be made in the prescribed form, which must be signed by the applicant or by a person authorised to sign on his behalf;

(b) be lodged at the Agency in the prescribed manner.....

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 and, this is the current law operating in Zambia. You may wish to note that examiners rely only on this piece of legislation in prosecuting patent applications received either directly or indirectly through regional agreement (ARIPO). In this context, it is important to state that every application has to comply with the national law for it to have effect or be granted in Zambia, as provided for under sections **8** and **10A** (2) and (3) of the Act.

Further, let me state that the Office has no written patent examination manual and guidelines. In this regard, I would state that it is something that is worth considering by the Office and implement in the near future.