

# SCP QUESTIONNAIRE ZIMBABWE RESPOINSE

## Standing Committee on the Law of Patents (SCP)

### The Prior use exception

(i). The Prior use exception is provided for under Section 19 of the Zimbabwe Patents Act Chapter 26:03. The section provides that “Prior knowledge or publication of invention excused in certain circumstances:

(1) A patent shall not be refused or held to be invalid by reason only of the fact that the invention in respect of which the patent is applied for or was granted or any part thereof was published, used or known prior to the effective date of the application if the applicant or the patentee, as the case may be, proves—

(a) that the knowledge was acquired or the publication or use was made without his knowledge or consent; and

(b) that the knowledge acquired or the matter published or used was derived or obtained from him; and

(c) if he learned of the disclosure, use or knowledge before the effective date of his application for the patent, that he applied for and obtained protection for his invention with all reasonable diligence after learning of the disclosure:

Provided that the protection afforded by this subsection shall not extend to an applicant for a patent or a patentee who has or whose predecessors in title have commercially worked the invention in Zimbabwe, otherwise than for the purpose of reasonable technical trial thereof, prior to the effective date of the application.

**Relevant court cases-** No decided case as of this date

### Challenges faced in implementing the prior use exception

If a third party files for the same invention before the original owner the rightful owner might lose because of the first to file aspect.

**Results of implementation of prior use exception** is promotion and encouragement of creativity and investment since the exception helps to avoid unfairness that may arise from the fact that the entities or individuals who have invested human and material resources in the

creation of the invention may not be able to exploit their own intellectual achievements just because they have not filed any patent applications beforehand.

## **ii. Patent law provisions and practices that contributed to effective transfer of technology**

- Section 9 (3) of the Patents Act requires that the complete specification shall fully describe the invention and the manner in which it is performed and also to disclose the best method of performing the invention known to the applicant at the time when the specification is lodged.
- The law also provides for the license of rights under Section 29 of the Patents Act, this contributes to effective technology transfer.
- The Zimbabwe National Intellectual Property Policy and Implementation Strategy (ZNIPPIS) provides for establishing a system for IP management at tertiary institutions and the private sector, institutionalise a mechanism for licensing control and establish a model national licensing system, and to establish Technology and Innovation Support Centers (TISC).

## **Additional information**

### **i. Certain aspects of the applicable national patent law**

**Prior Art-** Section 9 of the Patents Act provides that ‘an invention is new if it is not anticipated by prior art. Everything made available to the public anywhere in the world by means of written disclosure (including drawings and other illustrations) or by use or exhibition shall be considered prior art provided that such making available occurred before the date of filing of the application or, if priority is claimed, before the priority date validly claimed in respect thereof and further provided that a disclosure of the invention at an official or officially recognized exhibition shall not be taken into consideration if it occurred not more than six months before the date of filing of the application or, if priority is claimed, before the priority date validity claimed in respect thereof’.

**Novelty-** Section 9 - ‘an invention is new if it is not anticipated by prior art.

**Inventive step-** Invention 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;

**Grace period-** Under Section 19 (2) it is provided that exhibition at an industrial or international exhibition certified as such by the Minister of an invention or the publication subsequently of any description of the invention so exhibited by any person without the privity

or consent of the inventor or the reading of a paper by the inventor before a learned society or the publication of such paper shall not prejudice the right of the inventor to apply for or obtain a patent in respect of the invention or the validity of any patent granted on the application if—  
(a) the application for a patent is made not later than six months from the date of the opening of the exhibition or the reading or publication of that paper, as the case may be.

**Sufficiency of disclosure-** Disclosure is provided for under Section 9 (3)

- (a) that a complete specification shall fully describe the invention and the manner in which it is performed and;
- (b) Disclose the best method of performing the invention known to the applicant at the time when the specification is lodged.

**Exclusions from patentable subject matter-** Provided under Section 2A

Inventions for which patent may not be granted

A patent shall not be granted under this Act for:

- (a) Diagnostic, therapeutic or surgical methods for the treatment of human beings or animals;
- or
- (b) Plants and animals, other than micro-organisms; or
- (c) Essentially biological processes for the production of plants or animals, other than microbiological processes.

**Exceptions and limitations of the rights**

**Section 34 Use of patented inventions for service of the State**

-the Minister may make, use or exercise any invention disclosed in any specification lodged at the Patent Office for the service of the State in accordance with this section.

**Section 35 Special provisions as to State use during emergency**

(1) During any period of emergency the powers exercisable in relation to an invention by a department of the State or a person authorized by the Minister under section *thirty-four* shall include power to make, use, exercise and vend the invention for any purpose which appears to the Minister necessary or expedient—

- (a) for the efficient prosecution of any war in which Zimbabwe may be engaged; or
- (b) for the maintenance of supplies and services essential to the life of the community; or
- (c) for securing a sufficiency of supplies and services essential to the well-being of the community; or
- (d) for promoting the productivity of industry, commerce or agriculture; or

(e) for fostering and directing exports and reducing imports or imports of any classes, from all or any

countries and for redressing the balance of trade; or

(f) generally, for ensuring that the whole resources of the community are available for use, and are used, in

a manner best calculated to serve the interests of the community; or

(g) for assisting the relief of suffering and the restoration and distribution of essential supplies and services in any part of Zimbabwe or any foreign country that is in grave distress as the result of war;

### **Section 24A Parallel importation of patented products etc.**

A patented product which has been put on the market in another country by a patentee may be imported into Zimbabwe, without the consent of the patentee, if the cost of importing such product is less than the cost of purchasing from the patentee.

### **Section 24B Test batches of patented products**

(1) Test batches of a patented product may be produced without the consent of the patentee six months before the expiry of the patent: Provided that the test batches shall not be put on the market before the expiry date of the patent.

### **Compulsory licenses**

Section 30A Compulsory licence in respect of dependent patents

Section 31 Compulsory licence in case of abuse or insufficient use of patent rights

Section 32 Inventions relating to food or certain other commodities

(a) A substance capable of being used as food or medicine or in the production of food or medicine; or

(b) A process for producing a substance referred to in paragraph (a); or

(c) Any invention capable of being used as or as part of a surgical or curative device or in protection of the environment;

(d) Any invention capable of substantially improving the technological, social and economic development of the country.

### **Section 81 – Use of vessels, aircraft and land vehicle.**

(ii) Laws on opposition systems and other administrative revocation, and invalidation mechanisms

## **Opposition**

Section 17 of the Act provides that a notice of opposition may be given within 3 months from the date of advertisement of acceptance or at any time before sealing of the patent by the objector on the applicant for the patent. If the applicant wishes to contest the opposition, he shall, within such time as is prescribed or such further time as the registrar of the Tribunal may allow, lodge with him a counter-statement setting out particulars of the grounds upon which the opposition is to be contested.

After receiving a notice of opposition under subsection (1) and compliance with any other provisions of this section which are applicable the registrar of the Tribunal shall arrange for the matter to be heard by the Tribunal in the manner prescribed and the Tribunal may make such order therein as it considers just:

## **Revocation of patents**

Section 45 provides that application for revocation may be made to the High court or the Tribunal by any interested person including the state upon any one or more grounds on which the grant of a patent might be opposed.

## **Grounds of revocation**

- (a) a patent is revoked on the ground of fraud; or
- (b) a patent fraudulently obtained has been surrendered and revoked; or
- (c) The grant of a patent has been refused under the provisions of section 17

## **Invalidation**

49 Relief for infringement of partially valid specification

(1) Where, in any action for the infringement of a patent, the Court finds that any claim in the specification in respect of which the infringement is alleged is valid, but that any other claim there under is invalid, then, notwithstanding the provisions of section *forty-eight*, the following provisions shall apply—

(a) unless the Court is satisfied that the invalid claim was not framed in good faith and with reasonable skill and knowledge, the Court shall, subject to its discretion as to costs and as to the date from which damages should be reckoned and to such terms as to amendment of the specification as it may deem desirable, grant relief in respect of any valid claim which is or has been infringed, without regard to the validity of any other claim in the specification, and in

exercising such discretion the Court may take into consideration the conduct of the patentee in inserting the invalid claim in the specification or permitting that claim to remain there;

(b) if the Court is satisfied that the invalid claim was not framed in good faith and with reasonable skill and knowledge, the Court shall not grant any relief by way of damages or costs, but may grant such other relief in respect of any valid claim which is or has been infringed as to it seems just and may impose such terms as to amendment of the specification as a condition of granting any such relief as it may deem desirable;

### **(iii) International work sharing and collaborative activities for search and examination of patent applications**

#### **Cooperation on the Use of Search and Examination Capacity**

Section 82 provides that The Office shall undertake, or arrange for, the substantive examination of the patent application. If need arises the office seeks for substantive examination from the regional office (ARIPO).

### **(iv) Compilation of laws and practices regarding the scope of client attorney privilege**

The privileged status of lawyer-client communication is time honoured and enshrined in common law and in Section 8 of the Civil Evidence Act [Chapter 8:01]. However there are no specific provisions regarding the scope of client attorney privilege in the Patents Act.