

KENYA INDUSTRIAL PROPERTY INSTITUTE (KIPI) **Patent Examination System in Kenya**

By

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KENYA INDUSTRIAL PROPERTY INSTITUTE (KIPI)

Originally founded in 1990 as KIPO, a department of Ministry of Trade & Industry.

Transformed into a semi- autonomous body in 2007 under Industrial Property Act,

2001

FUNCTIONS OF KIPI

- a. Consider applications for and **grant** industrial property rights (Patents, Trademarks and Industrial Designs).
- b. **Screen technology transfer** agreements and licenses.
- c. Provide to the public, industrial property **information** for technological and economic development.
- d. **Promote inventiveness** and innovativeness in Kenya.
- e. In carrying functions under paragraphs (c) and (d) above, the Institute shall:
 - i. Organise and conduct **training** relating to industrial property matters and
 - ii. Organise competitions, contests, trophies and awards.

Staffing at KIPI

– Patent Examiners

NO.	Academic Background	Field of Examination
2	BSc. Biochemistry	Pharmaceutical & Biomedical Sciences
3	BSc. Biological Sciences	Natural & Food Sciences
2	BSc. Chemistry	Chemical Sciences
1	BSc. Mechanical Engineering	Mechanical Sciences
1	BSc. Civil Engineering	Civil and Housing Technology
1	BSc. Electrical Engineering	Electrical and ICT
1	BSc. Physics	Physical Sciences

STATISTICS ON PATENT APPLICATIONS

S.No	Patent Application Category	Approx No.	%
1	Applications per year	1,120	
2	Foreign Appl	1,070	75%
2	PCT National Phase	70	90% of Foreign Appl
3	Priority Appl	50	80% of Foreign Appl
4	Appl without Priority	20	20%

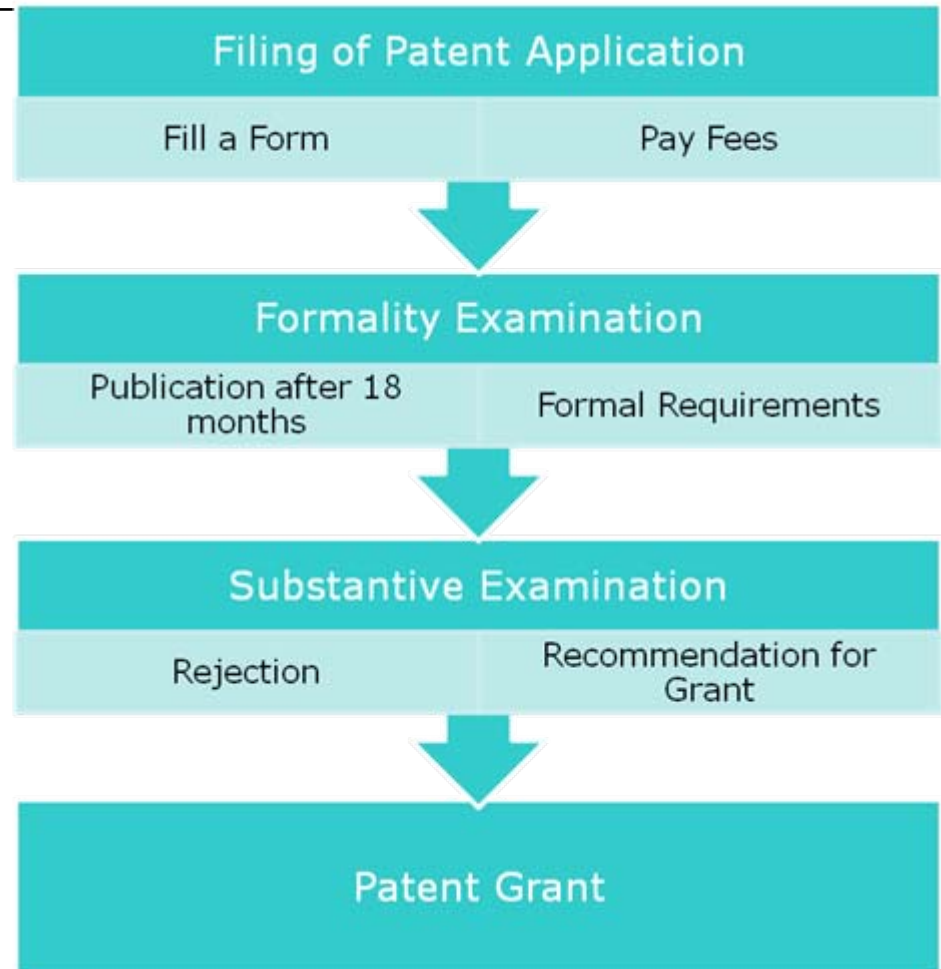
Patent Application Statistics Cont.

5	Pending Applications	50	70% awaiting reports etc
6	Granted Applications	30	30% of entire Application
7	Withdrawals	10	10%
8	Rejections	8	8%
9	ARIPO Applications	1,000	95% granted
10	UK Expired Application	4,000	In Archives
	Total Active Appl	1,600	30% of total appli

EXAMINATION GUIDELINES

1. Industrial Property Act, 2001 – Patent Law
2. Industrial Property Regulations, 2002
3. Guidelines for the Examination of Patents, Utility Models and Industrial Designs

○ PATENT EXAMINATION PROCEDURE





Formal Patent Application

- A request form
- Abstract – up to 150 words
- Description
 - Title – up to 15 words
 - Technical Field
 - Background Information
 - Summary of Invention
 - Detailed Description of Invention
 - Best method of working out the invention
 - Industrial applicability
- Claims – to cover the scope of invention
- Figures/Diagrams

Substantive Examination Requirements for a Patent

The invention must :

1. **Be new**

The invention must be novel over prior art i.e. must never have been made public in any way, anywhere in the world, before the date on which an application for a patent is filed.

In Kenyan IP Law, defines **prior art** as everything made available to the public anywhere in the world by means of written disclosure (including drawings and other illustrations) or, by oral disclosure, use, exhibition or other non-written means including **TK**, unless if it was done twelve months before the filing date.

2. **Involve an inventive step**

An invention involves an inventive step if, when compared with what is already known, it would not be obvious to a person with a good knowledge and experience of the subject.

3. **Be capable of industrial application**

An invention must be capable of being made or used in some kind of industry.

UTILITY MODELS

- These are certificates issued to protect minor or petty patents such as handicrafts, **herbal concoctions**, improved cooking stove (Jikos)
- They are issued to innovations that do not require to involve an inventive step i.e. those that appear to be obvious to a person skilled in the art.

CASE LAW

- There was a dispute where case law was applied in 2009.
- An applicant had made an application tea leaf dryer but was opposed immediately upon publication on ground of lack of novelty
- A section of IP Act on novelty was invoked and application was withdrawn

Examination & Other Requirements

- Kenyan patent law allows deferment of applications up to 3 years from date of application
- The law allows examiners to request for any information or documents to assist in examination
- But the law does not allow examiners to grant a patent based on claims granted by other patent offices
- Examiners refer to other resources such as WIPO-PatentScope, USPTO, Espacenet, EPO for examination results

Official Patent Timelines

To Comply with
Formality Examination
Requirements

- 90 days
- 60 days extension

To respond to
Substantive
Examination Opinion

- 60 days
- 90 days extension

Maintenance of
application or Renewal
of Patent

- Annually
- Grace period of 6 months
- Restoration within 6 months after grace period

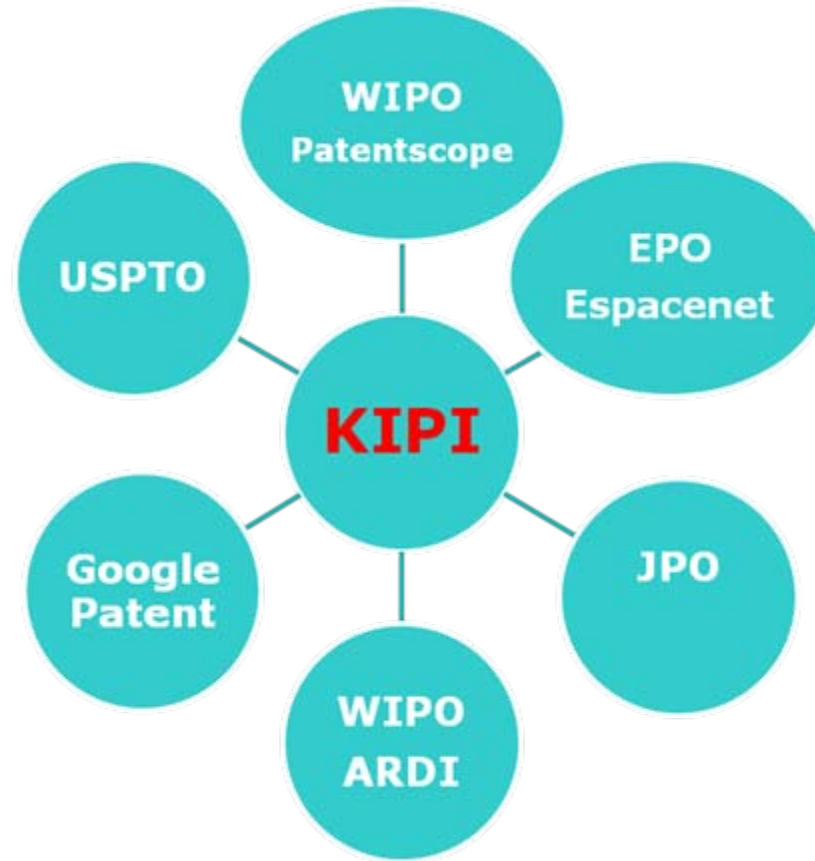
Hearing, Patent Claims & Support

- The Law provides for hearing with applicants conducted by the Industrial Property Tribunal during dispute
- All types of claims are admissible under the law including markush claims
- Claims relating to perpetual motion, treatment or diagnosis of human and animal body are not admissible
- The Regulations allows up to a maximum of 10 dependent and or independent claims
- Applicants are penalized USD 20 per claim in excess of ten.
- KIPI provides advisory and support services to clients including drafting of patent applications and claims

Challenges & Suggestions

NO	CHALLENGE	SUGGESTION
1	Access to all prior art documents	Centralized prior art database
2	Inadequate skills in emerging technologies e.g. ICT, Biotech and Nanotech	Continuous Training of Patent Examiners
3	Inadequate mechanisms for information sharing	Develop incentives that can promote information exchange
4	Inadequate exposure by examiners to modern examination strategies	Internship and attachment of examiners to ISAs, IPEAs, WIPO, IPOs etc
5	Inadequate Examination Facilities e.g. PCs, IP Administrative Systems, Databases	Increase support for national patent offices

Prior Art Databases





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THANK YOU