

Challenges in Examination of Paris and PCT Patent Applications in Kenya

Brief by:

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Paper Objective(s)

- This paper aims at highlighting:
 - **the specific challenges of substantive examination, in particular PCT national phase entries or Paris convention applications.**
- It may not be exhaustive, but aims at creating an understanding of the situation by the facilitators and trainees in order to facilitate discussion on the same, including:
 - in the last session of the workshop on challenges and options for the national phase of PCT applications; and
 - With the experts during the exercises or health breaks, etc.

Paper Focus

- Patent Examination Statistics.
- Usage of External Examination Results.
- Timelines on Examination of International Applications
- Access to Examination Results of other IP Offices.
- Major Patent Examination Challenges and Way Forward.

Paper Outline: Slides

- 1-5: Preamble
- 6-8: Patent Examination Statistics
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Patent Examination Statistics: Applications

- [WIPO-JPO PCT Kenya Statistics 241113-2.docx](#)

Year	2000	2001	2002	2003	2004	2005	2006	2007	2008	2009	2010	2011	2012
National	23	16	23	22	31	34	41	41	63	48	77	135	123
Paris	0	1	3	3	3	6	2	6	0	6	2	1	8
PCT	28	44	46	70	50	53	39	85	89	117	118	121	128
Total	51	61	72	95	84	93	82	132	97	171	197	257	259

Patent Examination Statistics: Grants

- [WIPO-JPO PCT Kenya Statistics 241113-2.docx](#)

Year	2000	2001	2002	2003	2004	2005	2006	2007	2008	2009	2010	2011	2012
National	0	4	0	6	8	8	5	4	5	6	4	4	4
Paris	4	0	0	2	0	24	6	1	4	5	3	0	0
PCT	14	11	7	12	7	16	18	12	33	76	47	55	72
Total	18	15	7	20	15	48	29	17	42	87	54	59	76

Patent Examination Statistics: Services

- Examination Timelines are set in Service Charter.
- Pendency of applications, i.e. time till first action (report/grant/rejection) = **18 Months upon request.**
- Number of Patent Examiners (Formality / Substantive) = **12**
 - Physical Sciences = 3
 - Natural Sciences = 6 (3-trainees)
 - Engineering = 3

Patent Law and International Application Information

- Sources:
 - Filing of Application;
 - Submission by Applicant (Section 38 of Patent Law): Search, Examination, Grants, Rejection, Invalidation – Enforcement?;
 - Searches by examiner (mainly WIPO, EPO, USPTO, IP-AU databases) or by WIPO service.
- Usage: Regularly for substantive examination.
- Obligation: International examination reports are no binding on the patent examiner.

Patent Examination Challenges: Internal

- Inadequate search capacity (examiners and resources):
 - especially in relation to certain specialised fields such as chemical structures and gene sequences.

Patent Examination Challenges: External

- Unsearched claims: one or more necessitating re-search & hence delay.
- Amendments after Paris filing or PCT national phase entry:
 - not easily identified/accessible; and
 - May be different in different countries.
- Huge backlog in some major IP offices: thus their examination results are not readily available.

References

- Industrial Property Act, 2001 (2001). Nairobi: Government Printer.

End of Presentation

- Imbuya Mono
- Asante Sana
- Thanks
- Muchas Gracias
- Merci Beaucoup
- Arigato Gosaimasu