



DOMINICAN REPUBLIC
Ministry of Industry and Trade
NATIONAL INDUSTRIAL OFFICE PROPERTY
“Year of Integral Attention to Early Childhood”

Report to the International Bureau on inventive step and sufficient disclosure requirements

Inventive Step

- (i) **Definition of skill in the art**: in the legislation of the Dominican Republic, there is the concept of a **specialist or a person skilled in the art**; however this concept is not defined, only referred to in the definition of inventive step in Article 6 of Law No. 20-00 on Industrial Property:

An invention has an inventive step if, for a specialist or person skilled in the relevant technical field, the invention is neither obvious nor obviously derived from the state of the relevant art.

- (ii) **Methods used to evaluate inventive step**: the methodology for assessing inventive step is problem-solution. See: Examiner’s Manual (Manual for the Organization and Examination of Patent Applications of the Industrial Property Offices of countries of Central America and the Dominican Republic), pages 64-75.

- (iii) **Inventive step (Evidence)**: To analyze the inventive step of an application we focus on inventive evidence cited in the Examiner’s Manual (page 69), which are:

- unexpected character of the result
- the fact of having overcome a previous technical prejudice
- the surprising simplicity of the proposed solution
- the fact of having overcome real technical difficulties
- the originality of the solution, which departs from the beaten path and opens a new path
- that the invention meets a long-standing, permanent and as yet unsatisfied need



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Exception: For utility model patents, on the grounds that Utility Models are granted for technical inventions whose inventiveness is less than that required for inventions but prove beneficial to technological work, and that the inventive step requirement provided for in Law No. 20-00 on Industrial

Property states that the invention should be neither obvious nor obviously derived from the state of the relevant art, the National Industrial Property Office issued **Resolution # 62 of August 8, 2006**, which stipulates that when conducting the substantive examination of a patent application for a Utility Model inventive step is **not** examined using the same strict criteria as for Patents.

Definition of prior art: in accordance with national legislation, we refer to Article 5 of Law 20-00 on Industrial Property:

Article 5. Novelty.

- 1. An invention has novelty when it does not already exist in the prior art.*
- 2. **Prior art** shall comprise everything that has been disclosed or made accessible to the public, anywhere in the world, by publication in tangible form, oral disclosure, marketing, use or any other means, before the filing date of the patent application in the Dominican Republic or, where appropriate, before the filing date of the foreign application whose priority is claimed under Article 135. Also falling within the prior art is the content of an application pending before the National Industrial Property Office, whose filing date or, where appropriate, priority predated the application being examined, but only to the extent that such contents are included in the predated application when it was published.*
- 3. **Determination of prior art** shall not take into account any disclosure within the year preceding the date of filing of the application in the Dominican Republic, where such disclosure is a direct or indirect result of acts performed by the inventor or his successor in title, or a breach of trust, breach of contract or unlawful act committed against any of them.*
- 4. Disclosure resulting from a publication by an Intellectual Property Office as part of the procedure for granting a patent does not fall within the exception to the foregoing, save where the application was filed by a person not entitled to the patent, or that the publication had been done improperly effected.*



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Sufficiency of disclosure

(i/ii) The enabling disclosure requirements and the support requirement are contained in **Articles 13 and 14** (quoted below), governing description, of Law No. 20-00 on Industrial Property Law on the description:

Article 13

The description shall disclose the invention in a sufficiently clear and complete manner to be evaluated and for a person skilled in the relevant technical subject can execute.

- (2) *the description of the invention shall state the name of the invention and include the following information:*
 - (a) *the technological, agricultural, scientific or other sector to which the invention relates or applies;*
 - (b) *the prior art known to the applicant that may be considered useful for understanding and examining the invention, and references to documents and previous publications that discuss the technology;*
 - (c) *description of the invention in terms that allow understanding of the technical problem and the solution provided by the invention and show the advantages it may have over the prior art;*
 - (d) *brief description of the drawings, if any;*
 - (e) *the best mode known to the applicant to execute or implement the invention using examples and references to drawings;*
 - (f) *how the invention is susceptible of industrial application except where this is obvious from the description or nature of the invention.*
- (3) *When the invention relates to biological material that cannot be described so that the invention may be performed by a person skilled in the art, and such material is not available to the public, the description shall be supplemented by the deposit of the material in a depositary institution previously designated by the National Industrial Property Office.*
- (4) *When a deposit of biological material is made to complement the description, this should be stated in the description together with the name and address of the depositary institution, the date of the deposit and the number issued by the institution*



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after the deposit is made. The nature and characteristics of the deposited material shall also be described, where this is relevant to the disclosure of the invention.

Article 14

It is essential to submit drawings when such are necessary to understand, evaluate or execute the invention.

(ii) Other supporting documents to meet the **disclosure requirement**. The substantive examination is supported by the Examiner’s Manual (Manual for the Organization and Review of Patent Applications of the Industrial Property Offices of the Countries of Central America and the Dominican Republic) **at pages 32-34 and 45-46**, from which we provide a few basic points:

- An explanation of the invention allowing an understanding of the technical problem posed, the solution thereto it and the advantages of said solution;
- The detailed description of at least one embodiment of the invention, which may be illustrated by examples.
- The indication of the industrial application of the invention, if not obvious. The description of the drawings, plans, figures or graphics, if any.
- Units and formulas: the metric system of weights and measures must be used or, if another system is used, also expressed values in metric units. Similarly, temperatures are expressed in degrees Celsius, or also in degrees Celsius if first expressed differently. For other physical values (that is, those whose units are not directly derived from measurements of length, mass, time and temperature), units recognized in international practice must be used.

(iii) **Written description requirements.** They are contained in the Guide to Patents and Utility Models (pages 24-30; 40-43; 51-53) and the Guidelines of the Department of Inventions (pages 4-7).

It should contain the following key aspects:

- Sufficient information so that a person skilled in the technical field can put it into practiced, that is, reproduce the invention.
- Terminology known in the technical field.
- The general headings, such as: title of the invention, technology sector, known prior art, description of the invention, a brief description of the drawings, embodiments of the invention, claims and abstract.



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- For areas such as chemicals and pharmaceuticals, specific representative examples of the invention, chemical compounds (chemical synthesis from the general to the particular chemical structure and chemical name, identification data and physical-chemical separation, biological activity data, etc.) compositions, formulations, procedures should be provided.
- Formatting requirements, such as Arial font size 12, page 8 ½ * 11, consecutively numbered pages and 5 by 5 paragraphs lines, with headings highlighted in bold, and correct spelling.