

Nicaragua: inventive step and disclosure (13-04-2015)

Inventive step:

- PSITA

A person skilled in the art is a person skilled in the technology to which the invention relates. His skill level is higher than the level of knowledge of the general public, but does not exceed that expected from a duly qualified person. He is a person with average skills, but not specialized (Manual for the Organization and Review of Patent Applications of the Industrial Property Offices of the Countries of Central America and the Dominican Republic, p. 33).

Methodology employed to evaluate inventive step

- Generalities (Manual for the Organization and Review of Patent Applications of the Industrial Property Offices of the Countries of Central America and the Dominican Republic, p. 18):

a) study the documentation file;

b) assign the corresponding International Patent Classification (IPC);

c) review and analyze the documentation submitted by the applicant in compliance with a requirement formulated in formal and/or substantive examination, or has been presented to supplement the information initially submitted in order to determine its admissibility as part of the file.

d) develop new documentation requirements, if necessary;

e) request the division of the application if lack of unity is observed ;

f) recommend changing the type of protection if necessary;

g) conduct prior art search;

h) examination of patentability;

i) preparation of technical reports; and

j) guidance and communication to the user regarding compliance with the relevant technical requirements

- Methodology (Manual for the Organization and Review of Patent Applications of the Industrial Property Offices of the Countries of Central America and the Dominican Republic, p. 19):

The examiner will take the following steps in conducting substantive examination:

a) study the description, claims and drawings, plans, figures or graphics (if any) and any amendments to these, sent by the applicant initially;

b) prepare a report which recorded all necessary objections, which may be formal (clear, concise, etc.), concerning non patentable subject-matter, lack of novelty, inventive step,

industrial application and unity of invention. It must be indicated for each objection, the part of the application which is deficient, the legal requirement not met and the reasons behind the objection. For example, when determining the state of the art, some claims may be affected in terms of novelty, inventive step or industrial application, while others lack unity of invention. The examiner should clearly indicate whether the claims are affected with regard to novelty, level of inventiveness, industrial application and unity of invention, justifying each cases; and

iv. identify the dependent claims;

v. determine the clarity, the content and scope of the claims;

vi. determine the unity of invention "a priori";

vii. identify whether all matter contained in the claims can be considered an invention according to the concept of invention under national legislation, if applicable; and

viii. identify, within the claims, the inventions that are not patentable.

3.2.4 Analysis of the description (Manual for the Organization and Review of Patent Applications of the Industrial Property Offices of the Countries of Central America and the Dominican Republic, pp. 20-21)

The substantive examiner must:

i . verify that the description contains complete, clear information and with the appropriate structure, according to the legal provisions or regulations of each country (Art. 21 of Law on Patents No. 354 of 2000 and Art. 12 of the Regulation of the Law on Patents No. 354);

ii . verify that the units are in the international system of units;

iii . verify that the description of the drawings is directly related to the description;

iv . verify that the technical terms used are recognized in the relevant technical field. If the terms are barely recognized, they must be properly defined;

v . identify the technical features of the invention;

vi. verify that the claimed subject matter is contained in the description;

vii. in the case of applications in the biotechnology field that relate to nucleotide or amino acid sequences, verify that the application contains a list of these, which shall be presented in a way separately from the description and bear the heading "Sequence Listing".

viii. in the case of biological material, verify whether a certificate of deposit is required to support the description.

3.2.5 Analysis of the drawings (Manual for the Organization and Review of Patent Applications of the Industrial Property Offices of the Countries of Central America and the Dominican Republic, p. 21)

The drawings, plans, figures and graphics are intended to contribute to a better understanding and disclosure of the invention.

- They must be presented in numbered sheets following the claims.
- Drawings should be numbered consecutively in Arabic numerals (Fig.1).
- They must not contain any text and must bear reference signs only if contained in the description or in the drawings, and in such case, the same references must be used throughout the specification.

3.2.6 Comments or objections by third parties (Manual for the Organization and Review of Patent Applications of the Industrial Property Offices of the Countries of Central America and the Dominican Republic, p. 21)

Analyze the arguments and evidence submitted, and verify the validity of its effect on the patentability requirement as regards the technical part, taking into account that any evidence presented must be prior to the filing date of the application under examination or the claimed priority date (Art. 33 of the Law on Patents No. 354 deals with third party observations).

iv . assess whether there is any indication in another document that suggests to the ordinary person skilled the possibility of combining the teaching from one document with a second document to reach the proposed solution; and

v . the assessment of the unity of invention is carried out after determining the state of the art (see details in Chapter IV).

3.2.10 Evaluation of the industrial application (Manual for the Organization and Review of Patent Applications of the Industrial Property Offices of the Countries of Central America and the Dominican Republic, p. 23) (Art. 13 of the Law on Patents No. 354)

The examiner should identify the industrial application, that is, see whether the claimed object can be manufactured or utilized in any kind of industry, including agriculture. An invention is susceptible of industrial application if it has an specific, substantial and credible utility.

4. ACTIONS AFTER EXAMINATION (Manual for the Organization and Review of Patent Applications of the Industrial Property Offices of the Countries of Central America and the Dominican Republic, p. 23)

Once done the substantive examination of the application, the examiner will prepare the corresponding technical reports. If after analyzing the description, claims and/or drawings, plans, figures or graphics, the examiner finds that the application is not patentable or does not comply with the requirements under national legislation, the examiner shall draft a notice to the applicant to file his arguments or amendments, if any.

The report must contain:

1. The applicant's name and/or representative;
2. the number of the application and if applicable, the number of proceeding, event, diligence, oficio and page number;
3. Motivation of the technical-legal concept, which must contain at least the following aspects:

- i. an indication of the parts of the file on which the examination was based, noting the pages relevant pages;
- ii. the subject of the invention;
- iii. clarity of the invention;
- iv. the evaluation of the invention
- v. indication of whether there is an invention (exclusions)
- vi. unity of invention;
- vii. exceptions to patentability;
- viii. use claims;
- ix. claims not included in the examination (for complete lack of clarity or being subject matter excluded from patentability);
- x. determination of the state of the art;
- xi. assessment of compliance with the requirements of patentability (novelty, inventive step and industrial applicability); and
- xii . indication of the legal grounds, citing the source of reference and the normative basis.

The information described above is established in the Law on Patents No. 354, the Regulation of the Law No. 354, and the Manual for the Organization and Review of Patent Applications of the Industrial Property Offices of the Countries of Central America and the Dominican Republic.

The relevant provisions are (text obtained from WIPO lex):

Law No. 354:

Art. 7: Patent protection shall not be granted for:

- (a) the registration of animals;
- (b) therapeutic, surgical or diagnostic methods applicable to human beings or animals;
- (c) inventions the commercial exploitation of which has to be prohibited for the upholding of public policy or morality;
- (d) the protection of human, animal or plant health or life or the preservation of the environment; for these purposes the exclusion of patenting shall not be considered applicable only on account of exploitation being prohibited, restricted or made subject to conditions by any legal or administrative provision.

Art. 8: Inventions that are novel, involve an inventive step and are capable of industrial application shall be patentable.

Art. 9: An invention shall be considered novel if it is not anticipated by the current state of the art. The current state of the art shall comprise everything that has been disclosed or made accessible to the public in any form, anywhere in the world, prior to the filing date of the patent application in Nicaragua, or prior to the recognized priority date where priority is claimed. For the sole purposes of determining novelty, the current state of the art shall also include the contents of another pending patent application whose filing or priority date, as the case may be, is earlier than that of the application under consideration, but only to the extent that the contents were included in the earlier-dated application when it was published.

Art. 12: An invention shall be regarded as involving an inventive step if it is not obvious to a person skilled in the corresponding technical field or could not obviously have been deduced from the current state of the art.

Art. 13: An invention shall be considered industrially applicable where its subject matter can be produced or used in any kind of industry or productive activity. For these purposes industry shall be understood in the broad sense that includes among other things crafts, agriculture, animal husbandry, manufacturing, construction, mining, fishing and services.

Art. 21: The description of an invention shall be clear and complete so that a person skilled in the corresponding technical field may understand it and carry it out. The description shall specify:

1. the technological sector to which the invention refers or relates;
2. the prior art known to the applicant that may be useful for the understanding and examination of the invention, and a reference to earlier documents and publications concerning the same technology;
3. a description of the invention in terms that permit the technical problem and the solution provided by the invention to be understood, with an explanation of the differences and possible advantages in relation to the earlier technology;
4. an explanation of the drawings, if any have been filed;
5. a description of the best method known to the applicant of carrying out the invention, which shall make use of examples and references to the drawings, if any have been filed;
6. a description of the manner in which the invention is industrially applicable, if it is not obvious from the description or nature of the invention.

Art. 22: Where the invention relates to a product or process concerning biological material that is not available to the public, and the invention cannot be described in such a way as to be understood and carried out by a person trained in the technical field concerned, the description shall be supported by the deposit of a sample of that material. The deposit of the material shall be made with an institution inside or outside the country that is recognized by the Intellectual Property Registry. The deposit shall take place no later than on the filing date of the application in Nicaragua or on the priority date where applicable. If the deposit has been made, it shall be mentioned in the description together with the name and address of the depositary institution, and the deposit date and number assigned to it by that institution.

Art. 23: The deposit of biological material shall be valid for the grant of a patent only if it takes place under conditions that enable any interested party to obtain samples of the material not later than on the publication date of the corresponding patent application, without prejudice to any other conditions that may be specified in the regulations under this Law.

Art. 31: The patent application shall be laid open to the public for information on the completion of a period of 18 months counted from the filing date of the said application within the country, or, where a right of priority has been claimed, from the relevant priority date. The Intellectual Property Registry shall order ex officio that it be published in the form of a single insertion of a notice in the official journal La Gaceta, or in another major newspaper, at the expense of the person concerned. The applicant may at any time before the expiry of the period specified in the foregoing paragraph ask the Registry to publish the application, which shall be ordered immediately. Within the 15 working days from the issue of the order to publish, the applicant shall submit proof of payment for publication of the notice to the Intellectual Property Registry, failing which the application shall lapse as of right and the record of the proceedings shall be shelved. The interested party shall within the three months following publication file with the Intellectual Property Registry a copy of the page of the printed journal in which the notice appeared, or a photocopy thereof. Where this is not submitted within the period specified, the application shall lapse as of right and the file shall be shelved ex officio. Where the publication order has been given as provided in the second paragraph of this Article, the period specified for submission of proof of payment shall be counted as from the end of that specified in the first paragraph of this Article.

Art. 33: At any stage in the proceedings, before the final decision on the application, any comments or documents that may be relevant to the decision on whether or not the patent application is acceptable may be submitted to the Intellectual Property Registry. The Intellectual Property Registry shall inform the applicant of comments received. The applicant may submit such comments or documents of his own that may be relevant to the comments conveyed to him. The Intellectual Property Registry shall not rule on the application before two months have elapsed from the date on which comments were conveyed to the applicant, except where, before that period expires, the applicant files his comments or documents or asks for processing to continue. The submission of comments shall not stay the processing of the application. Comments shall not give rise to litigation, and the person who makes them shall not thereby become party to the procedure.

Art. 34: The applicant shall prove payment of the amount payable for the substantive examination of the patent application within a period of six months counted from the publication date of the notice of application. Where that period expires without the amount having been paid, the application shall be considered abandoned and the file shelved ex officio. Where any of the requirements or conditions for the patenting of the invention are not complied with, the Intellectual Property Registry shall notify the applicant so that, within a period of three months, he may complete the documentation, correct, amend or divide the application or make such comments in support of it as he sees fit. Should the opposite be the case, the application shall be rejected in a decision with a statement of reasons. The examination may be conducted by the Intellectual Property Registry direct or through the agency of independent experts or public or private bodies, either national or foreign, or under regional or international agreements. Where applicable, the examination shall be conducted on the basis of documents supplied by the applicant relating to novelty or patentability examinations conducted by other intellectual property offices or under the procedure provided for in the Patent Cooperation Treaty (PCT) that relate to the same subject matter as is claimed in the application under examination. The Intellectual Property Registry may recognize the

findings of such examinations as being sufficient to prove compliance with the conditions of patentability of the invention. The examination shall be conducted by the Intellectual Property Registry according to the procedure laid down in the regulations under this Law.

Art. 94: Without prejudice to the procedures provided for in this Law, the Intellectual Property Registry may not refuse or reject any application or request without first having notified the applicant or requester of the reasons for the refusal or rejection. In that case the applicant shall have a period of two months from the notification in which to make such statements as he sees fit.

Regulation of Law No. 354:

Art. 12: Description of the invention

The description of the invention shall comply with the order indicated in Article 21 of the Law, unless owing to the nature of the invention a different order would allow better understanding of the invention and a briefer presentation of its description.