

INVESTMENT PROMOTION AUTHORITY
Intellectual Property Office of Papua New Guinea



Intellectual Property Office
Papua New Guinea

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Tuesday, 03 March 2015

Director General
World Intellectual Property Organisation (WIPO)
34, Chemin Des Colombettes
1211 Geneva 20
Switzerland

Attention: Standing Committee on the Law of Patents

Dear Director General,

**SUBJECT: IPOPNG RESPONSE TO INVENTIVE STEP AND
SUFFICIENCY OF DISCLOSURE UNDER CIRCULAR NO: C8403**

We write in response to your circular no: 8403 dated 15 December 2014 relating to your invitation to submit information to the International Bureau on the requirements of inventive step and sufficiency of disclosure for purpose of the SCP secretariat to prepare a working document for submission in the twenty-second session of the SCP to be held in Geneva on the 27 - 31 July 2015.

The Intellectual Property Office of Papua New Guinea is a designated office under the PCT currently and is yet to perform the functions required of a Receiving Office under the said treaty. The office presently does not perform substantive examination; however, it currently has an existing cooperation agreement with IP Australia to perform substantive examination on PNG national applications.

The criteria for assessment of patentability is derived from Section 12 of the patent and Industrial Design Act 2000, which makes further references to subsequent sections 13, 14 and 15 disclosing requirements for purpose of determining newness, inventive step and industrial applicability of an invention.

12. PATENTABLE INVENTIONS.

- (1) An invention is patentable if it -
(a) is new in accordance with Section 13; and



(c) is industrially applicable in accordance with Section 15.

- (2) An inventions, the commercial exploitation of which would –
- (a) be contrary to public order or morality; or
 - (b) seriously prejudice the environment,

is not patentable.

13. NEW INVENTION.

(1) An invention is new where it is not anticipated by prior art.

(2) For the purposes of this section, prior art shall consist of everything disclosed to the public, anywhere in the world, by -

- (a) tangible form; or
- (b) oral disclosure; or
- (c) use; or
- (d) any other way,

prior to the filing, or, where appropriate, the priority date of the application claiming the invention.

(3) For the purposes of Subsection (2), disclosure to the public of the invention shall not be taken into consideration where -

- (a) it occurred within 12 months preceding the filing date, or, where applicable, the priority date of the application; and
- (b) it was by reason or in consequence of acts committed by the applicant or his predecessor in title, or of an abuse committed by a third party without regard the applicant or his predecessor in title.

14. INVENTION INVOLVING AN INVENTIVE STEP.

An invention involves an inventive step where, having regard to the prior art relevant to the application claiming the invention as defined in Section 13 (2), it would not have been obvious to a person skilled in the relevant act in the light of the common general knowledge as it existed prior to the filing, or, where appropriate, the priority date of the application claiming the invention.

15. INVENTION INDUSTRIALLY APPLICABLE.

(1) An invention is industrially applicable where it can be made or used in any kind of industry.

(2) For the purposes of Subsection (1), “industry” is to be construed in its broadest sense and in particular, without prejudice to the foregoing, is to include handicrafts, agriculture, fishery and services.

For purpose of this survey conducted by the Standing Committee on the Law of Patents the following responses are provided.

Inventive Step:

i. The definition of a person skilled in the art

The existing legislation on patent does not define “a person skilled in the art” per se and is therefore, for purpose of interpretation, taken as is disclosed in the act under Section 14. Examiners and anyone reviewing the legislation is therefore at liberty to interpret the meaning of the statement “a person skilled in the art”.

ii. Methodologies employed for evaluating the inventive step

Because Section 24 of the Patent and Industrial Design Regulation 2002 states that examination should be conducted as to form, the regulation is silent as to the determination of inventive step. The office therefore relies on the determination of invention step of an invention through the use of corresponding applications as allowed under Section 24 of the relevant act including the use of search and preliminary examination reports issued by international authorities.

24. INFORMATION CONCERNING CORRESPONDING FOREIGN APPLICATIONS AND PATENTS.

Where the Registrar so requests, an applicant under Section 19 (1) shall, within a time limit specified by the Registrar -

- (a) provide such information as is requested by the Registrar, including but not limited to, the date and number of any application for a patent filed by the applicant in another country or jurisdiction (in this section referred to as "foreign application"), relating to the same or essentially the same invention as that claimed in the application filed with the Registrar; and*
- (b) furnish to the Registrar the following documents relating to any foreign application: -*
 - (i) a copy of any communication received by the applicant concerning the results of any search or examination carried out in respect of the foreign application;*
 - (ii) a copy of any patent granted on the basis of the foreign application;*
 - (iii) a copy of any final decision rejecting the foreign application or refusing the grant requested in the foreign application; or*
 - (iv) a copy of any final decision invalidating the patent granted on the basis of the foreign application.*

Under the corporation agreement with IP Australia, Section 12 is observed and the methodology used for assessment of patentability, particularly in relation to inventive step, is based on the Australian examination guidelines or manual.

- iii. Having regard to the prior art, the level of inventiveness (obviousness) to meet the inventive step requirement

In respect of Section 14 of the relevant act, the level of inventiveness is again not addressed in the regulation however as generally referenced to Section 13(2) on prior art, implying that the technical features as claimed in the invention in question should not be anticipated in part or when combined together by the prior art. The said prior art having been disclosed through tangible form; or orally; or through use; or any other way before the filing of the priority application and/or the application before the respective IP office.

Sufficiency of Disclosure:

Section 13(2) describes the nature of disclosure which for the purpose of assessing patentability can be considered as part of prior art subject to the timing of disclosure being before the priority date or filing date, whichever applies, of the application in question.

- i. Enabling disclosure requirement:

Sufficiency of Disclosure:

Section 13(2) describes the nature of disclosure which for the purpose of assessing patentability can be considered as part of prior art subject to the timing of disclosure being before the priority date or filing date, whichever applies, of the application in question.

i. Enabling disclosure requirement:

Section 13(2) and (3) of the relevant act providing the determination of a prior art;

(2) For the purposes of this section, prior art shall consist of everything disclosed to the public, anywhere in the world, by -

- (a) tangible form; or
- (b) oral disclosure; or
- (e) use; or
- (f) any other way,

prior to the filing, or, where appropriate, the priority date of the application claiming the invention.

(3) For the purposes of Subsection (2), disclosure to the public of the invention shall not be taken into consideration where -

- (a) it occurred within 12 months preceding the filing date, or, where applicable, the priority date of the application; and
- (b) it was by reason or in consequence of acts committed by the applicant or his predecessor in title, or of an abuse committed by a third party without regard the applicant or his predecessor in title.

ii. Support requirement:

N/A

iii. Written description requirement

N/A

Should you have further queries relating to this matter, you can contact our officer Mrs. Zenerdine Chee-Gagau for more information.

Yours faithfully,


AMELIA NA'ARU
REGISTRAR OF PATENTS