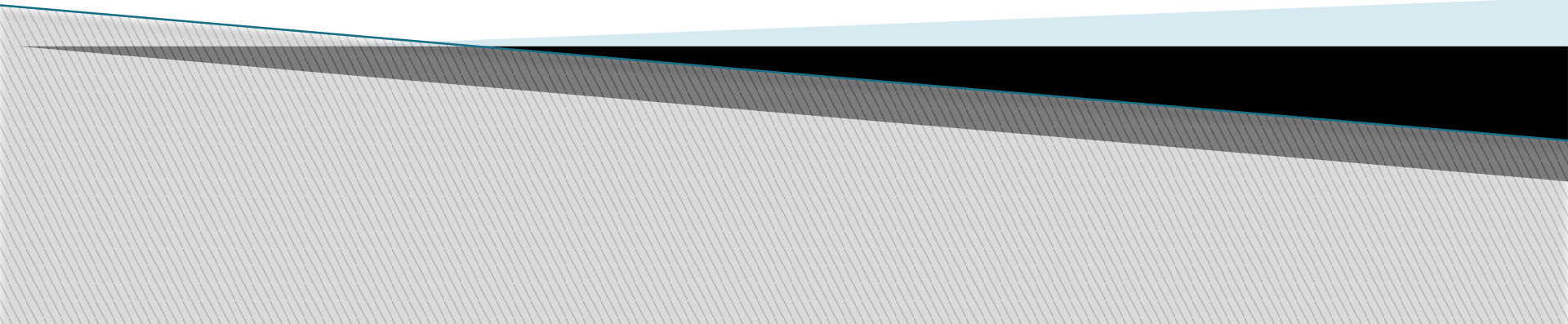


Chapter Three

Patent Law

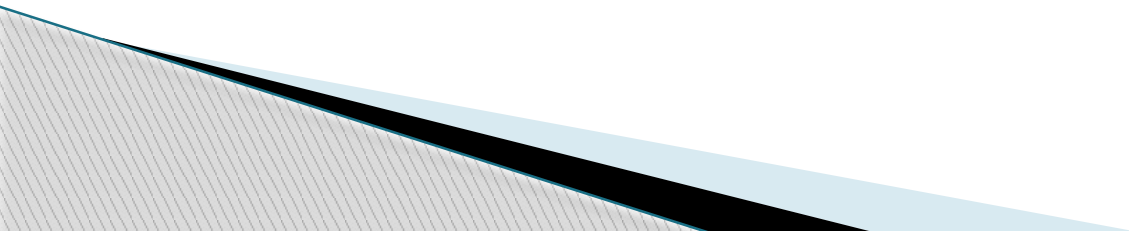


1. Objectives of the chapter

□ After going through the Unit, you will be able to:

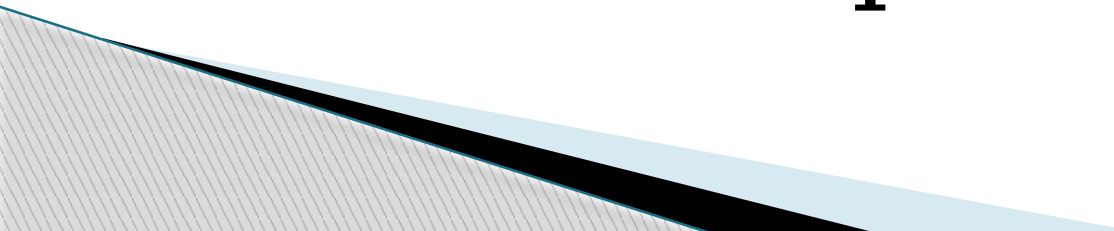
1. Grasp the basic notions of patent and the related right
 2. Explain the requirements for grant of patent right
 3. Analyze and determine the scope of patent right
- 

4. Discuss issues related to infringement and enforcement of patent right



2. Definition of patent

The heart of patent system lies on disclosure of invention and the entitlements to exclusive right to use, make and exploit the invention over a certain period of time.

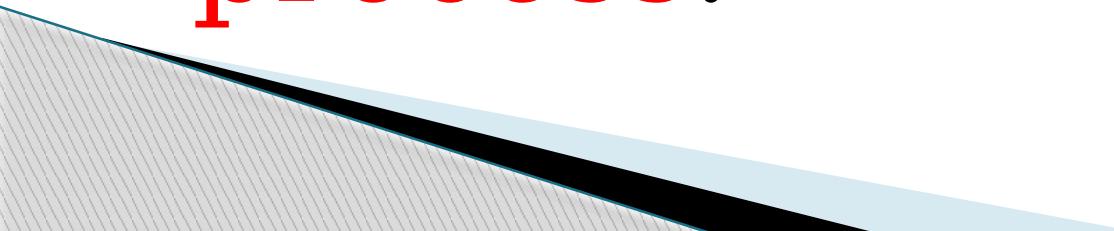


The United States patent office as the most comprehensive definition of patent.

- ❑ A statutory right to exclude others from making, using, offering for sale, or selling the invention in the United States, and if the invention is the process,... the right to exclude others from using, offering for sale or selling throughout the United States, or importing into the United State, products made by that process.

Art 2(5) of Ethiopian
Proclamation no 123/1995
define “patent”

“ The title granted to
protect **inventions**, the
inventions may related
to a **product** or a
process.”

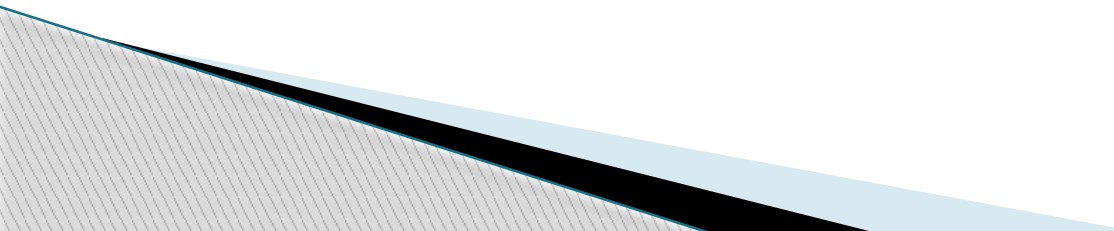


- ❑ From The definition it is difficult to ascertain the inventor or owner of the patent has the rights to the patent confers up on.
- ❑ It does not even state that patent guarantees exclusive right to use, make or otherwise exploit in a manner that the patent

□ The FDRE constitution provides the power to “**patent inventions** and protect copy right” (Art 51 (19))

AND

□ **HPR** is empowered to enact **specific laws** on patents and copyrights.



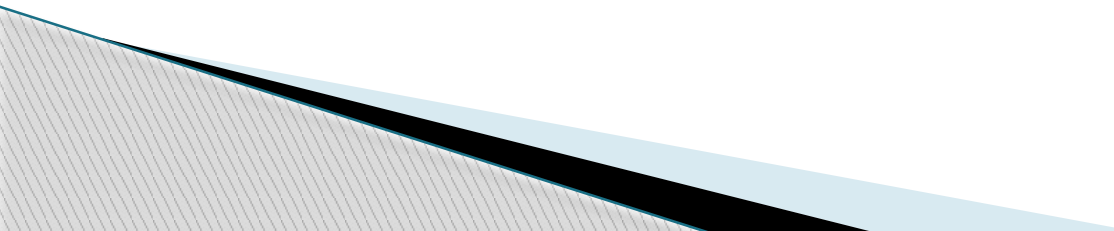
3. Justifications for patent protections

Economic
rationale

Philosoph
ical
perspectiv
es

3.1 Economic rationale

.In favor of patents are called
“**consequentiality**”
theories.



✓ Consequentiality theory
justifications on the basis
of the “good”
consequences flowing
from their recognition,
i.e. advancement in
knowledge, industrial
progress and economic
efficiency.

```
graph TD; A[ ] --> B[Utilitarianism]; A --> C[Teleology];
```

“consequentiality”

Utilitarianism
Teleology

Utilitarianism

- measures the good in terms of satisfaction of human preferences, without any judgment on their content

Teleology

- focus on the evaluation of what should be identified as good in the prospective of the proper purpose of human life.

- ▶ Nowadays utilitarianism represents the **dominant perspective**: intellectual property rights in general deserve special protection if the **benefits to the society** exceed **their costs**.

□ This view has been developed in the last century in different and specific theories, which coincide with the main advantages of patents: the “incentive – to invent”, the “incentive – to – disclose”, the “incentive – to – innovate” and the

3.2 Philosophical perspectives

Some fundamental arguments in favor of patents deal with philosophy and are commonly known as the “natural law” or the “moral rights” theory: the inventor is rewarded for the idea incorporated in his invention because it is an expression of his natural rights. belongs to him

Applications of Philosophical Theory can be Determined

“Lockean labor theory

- considers the inventor's property right as the reward for the difficulties and the efforts due to the labor

“Hegelian personality theory”

- connects the patent right to an expression of the human personality

4. In Ethiopia Proclamation No 123/1995 the objectives are provided (Preamble)

- ❑ to create favorable conditions to encourage local invention and related activities, there by building up technological capability.
- ❑ To encourage the transfer and adaptation of foreign technology by creating conducive environment to assist the national development effort of the country

- ❑ The task of fulfilling the nation's multidimensional demand for a harmonious scientific and technological progress, to be used for the public benefits, shall be most effectively served when there exists an appropriate legal framework.

5. Subject matter protected

Art 5. patentable invention

- subject matter protected is invention.
- Invention:- “means an. **idea of an inventor** which permits in practice the **solution to a specific problem** in the field of **technology** (Art 2 (3))

6. Subject matter not protected

Art 4- non patentable inventions

- a) Inventions contrary to public order on morality**
- b) Plant or animal varieties or essentially biological process for the production of plants or animals**

c) Schemes, rules or methods for playing games or performing commercial and industrial activities and computer programs.

d) Discoveries, scientific theories and mathematical methods.

e) Methods for treatment of the human or animal body by surgery or therapy, as well as diagnostic methods practiced on

2) Sub (e) is not applicable for products

7. Conditions for patentability

Grounds that determine the patentability of an invention.

➤ These are that the invention:

- **New (Novel)**
- **Involves an inventive step (Non-obviousness)**
- **Is industrially applicable, and**
- **consists of a subject matter that is patentable**

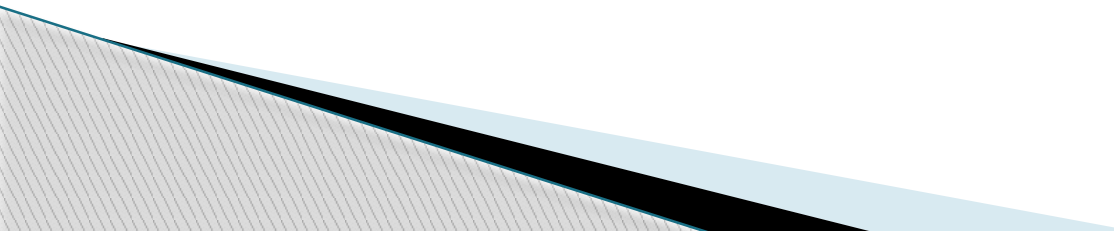
I. New (Novelty)

- An invention shall be considered new if it is not **anticipated by prior art**.
- **Prior art** shall consist of **everything disclosed to the public**, any where in the world, **by publication in tangible form** or by **oral disclosure**, by use or in any other way, prior to the filing or, where appropriate" the priority date, of the application claiming the invention. **(Art 3 (2))**

- ❑ There is a time dimension to disclosure.
- ❑ In order for the invention to be considered as new, it should not have been disclosed before the filing date or the priority date, when applicable.

- ❖ Art 3(3) Notwithstanding the provisions of sub-article (2) of this article the disclosure to the public of the invention shall not be taken into consideration if it occurred within 12 months preceding the filing date or where applicable, the priority date, of the application. and if it was by reason or in consequence of acts committed by the applicant or his predecessor in title or an abuse committed by third party with regard to the applicant or his predecessor ill title

II. Inventive step

- The **inventive step** and **non-obviousness** refer to the same general patentability requirement present in most patent laws, according to which an invention should be sufficiently inventive — i.e., non-obvious — in order to be patented.
- 

- The invention is deemed to involve an inventive step if it would not have been obvious to a person having ordinary skill in the art having regard to the prior art relevant to the application.

- ❑ Even if the invention is new it may not still be patented if its technical teaching would or could have been discovered in due course by a person with average skill in the respective field.

- ▶ Inventive step requires a significant addition to the state of the art to be determined taking in to account the common knowledge of a person of ordinary skill working in the relevant field.
- ▶ There is no inventive step when invention is obvious to a person with average skill.
- ▶ In most cases, inventive step may be assessed under three headings
 - The problem to be solved
 - The solution to the problem; and
 - The advantageous effect, if any, of the invention with reference with back ground.

III. Industrial Applicability

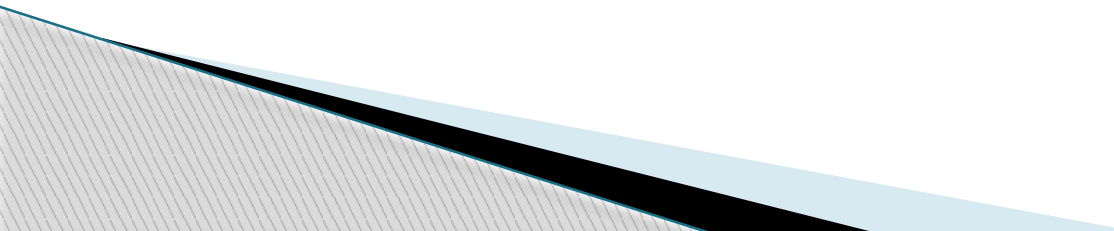
- ❑ Must be of a kind which can be applied for practical purpose.
- ❑ The term industry defined in broader sense (Art 3.5)

8. Ownership and transfer of patent

8.1. Who is entitled to the patent? (Ownership of patent)

Art 7.

A) Art 7(1) The inventor - it is obvious that the patent right shall belongs to the inventor



- B) Art 7(2) joint inventors - where two or more persons invent an invention they all become the joint owner of the patent right.**
- C) Art 7 (3) - invention made in the course of Employment or service of contract- to the employer or to the person having commissioned the work.**
- 

- Since an employee or the commissioned inventor use the employer's or the commissioner's resources, data, means, materials or equipment in the course of execution of works the ownership of the invention is belongs to the employer or the commissioner.
- However by agreement it is possible to set the contrary. Art 7(3)

D) Unless otherwise the employee or commissioned one use **resources**, **data**, **means**, **materials** or **equipment** of the employer or the commissioner and **with out any relation** with the employer or the commissioner the ownership is remain with the employee or commissioned one. **Art 7 (4)**

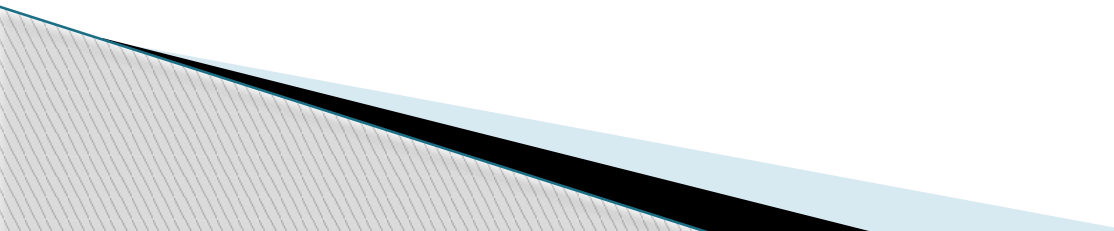


**E) Joint equal share b/n
employee/person commissioned and
employer/ commissioner Art 7(5)**

- ❑ Personal contribution of employee/commissioner + resources, data, means, materials or equipment of the employer or the commissioner = joint equal share owner ship.
- ❑ Express term can make the owner ship to one of them

8. 2. Transfer of owner ship

Art 6

- Any patent or application for a patent may be transferred by sale or inheritance or in any other means by law.**
 - The transfer shall be recorded with the commission up on payment of fee.**
- 

3. have foreign nationals equal right with Ethiopian?

- With the principle of reciprocity or**
- in accordance with treaty the Ethiopian may be the party**

**Foreign nationals shall have
equal right**

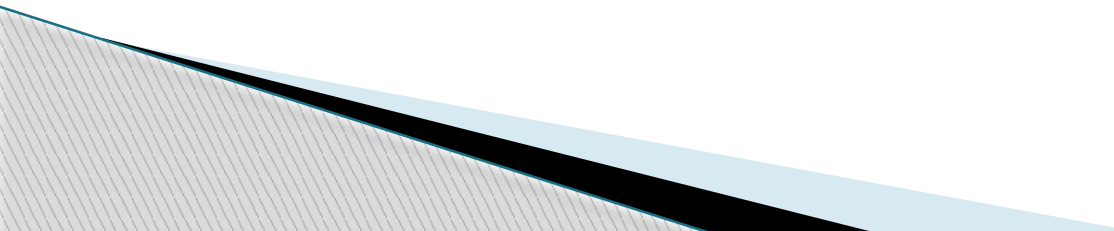
9. Application and Examination of patent

9.1 Application

- ❑ It is possible to apply for granting of patent to EIPO up on payment of fee (Art 9(1)) _
- ❑ Application should be in writing (Art 9(2))
- ❑ The application consists of **four mandatorily** and the **fifth one with necessity** elements

- a) Request for the grant of patent
- b) Description of invention
- c) Claim (s)
- d) An abstract and
- e) Drawing (where necessary)

Art 9(3)



- ❖ The request should contain the name and other relevant information about the applicant, the inventor and the agent and specific request for the patent protection and the title of the invention. (Art 9 (4) (a))

- ❑ The description shall disclose the invention in the manner **sufficiently clear** and **complete** for the invention to be carried out by a person **having ordinary skill** in the art and shall in particular, indicate at least one mode known to the applicant for carrying out the invention. (**Art 9 (4) (b)**)

- ▶ The claim or claims shall in clear terms and in concise manner **define** the matter for which protection is sought. And the claims shall be supported by full description (as provided under sub (b)).
Art 9(4) (c))

- ▶ An abstract is summary of technical information about the invention. And it is not useful for interpretation for the purpose of interpreting the scope of protection.

Art 9(4) (d)

❑ **The principle for one application should be made only for one invention. Art 9 (2)**

❑ **Why?**

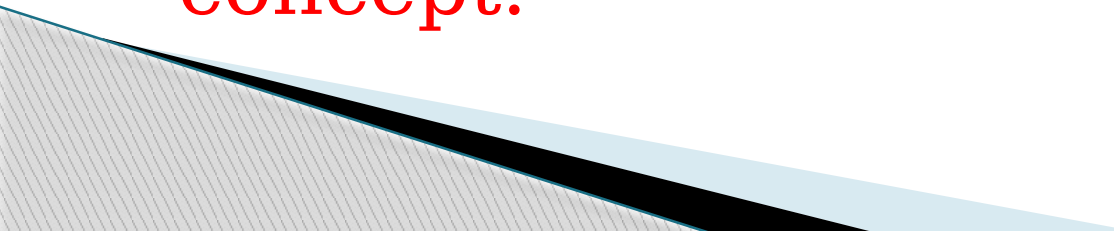
➤ **1. 1st different inventions in a single application may complicate the process of examination and search process and may create problems identifying the pertinent examiner for the multiple inventions in single applications.**



2. The applicant may avoid payment of the application fee for each of inventions.

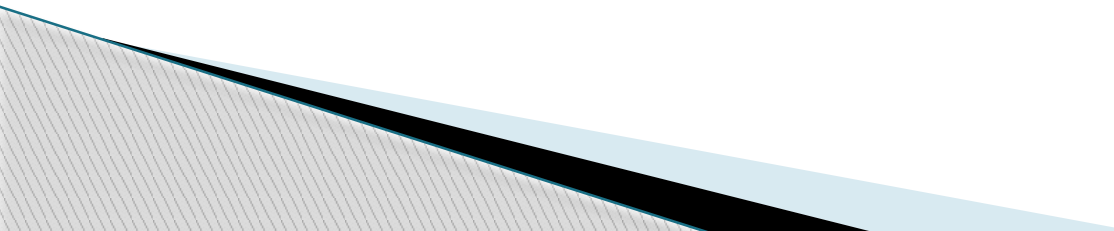
□ There may be situations where several inventions are linked to one inventive concepts in which case all may be included in a single application. [Art 9\(2\)](#)

□ It is up to the applicant to establish that the different inventions in a single applications are linked to one inventive concept.



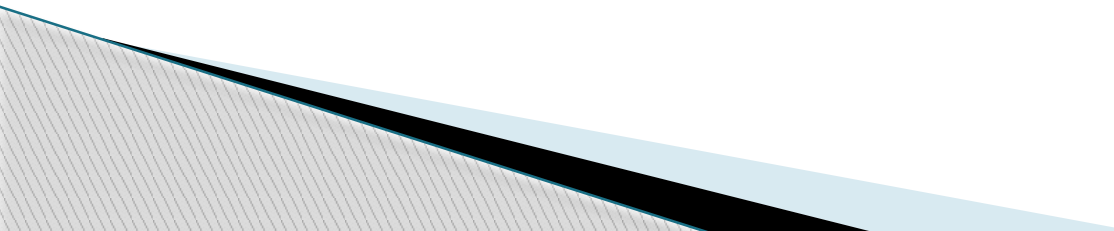
10. Filing date, first to file and priority

The filing date is relevant

- **It establish the duration of patent;**
 - **Prior date of subsequent applications in other countries and**
 - **The evaluation of novelty and inventive steps and entitlement to the patent in the event of several applications filed in respect of the same invention.**
- 

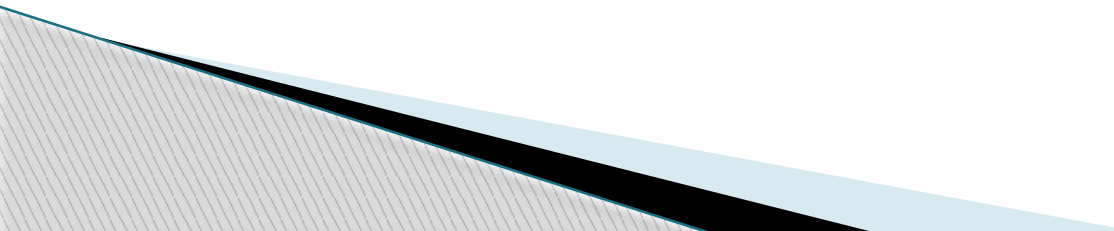
- ❑ The **date of receipt** of the application by the **EIPO** is considered as **the filing date**, in principle. **Art 12 (1)**
- ❑ The application contain
 - ✓ **An express or implicit indication of the granting of patent is sought (a)**
 - ✓ **Indication allowing the identity of the applicant to be established (b)**
 - ✓ **Something on face value is description of an invention. (c)**

□ First to file and priority

- If two or more persons independently have the same invention, entitlement to priority arises.
 - Only in **few countries** jurisdiction **first to invent** rule followed. (like US)
 - **First to invent** gives priority to the true inventor, the one who has introduced his invention in practice prior to others.
- 

- ❑ As to Fikremarkos book, **putting the invention into practice** does not mean using it in **the actual process of production of goods and services** but rather reducing it to **some discernable** or **physical form**.
- ❑ It has the effect of **encouraging inventors** in to **practice** prior to application for a patent.

❖ Additional argument is that the **first inventor** needs to have some time to **experiment** and **develop the invention** and **it is unfair to deny protection for the first inventor simply because he/she did not apply for a patent before others.** **(Fikremarkos)**



- The majority of jurisdictions apply the **“first to file”** rule where the first person who filed the application would be granted a patent in preference to all other subsequent applicants. The Ethiopian proclamation follow the same rule. **(Art 11 (1))**

- A policy argument for this rule is the need to encourage disclosure of inventions as soon as practicable as disclosure plays a very important role in disseminating information on mode of use of invention.

❑ Foreign applicant Art 11(2)

- ❑ When foreign applicant files application in Ethiopia within **12 months** from the date which he first filed an application was first filed in another country may be taken as the date of filing in Ethiopia, provided that the claim is on the **same invention**, **based on the same reciprocity**, or **in accordance with treaty**.

- The **date of priority** offers **great advantage** to an applicant who seeks protection in one or more other countries.

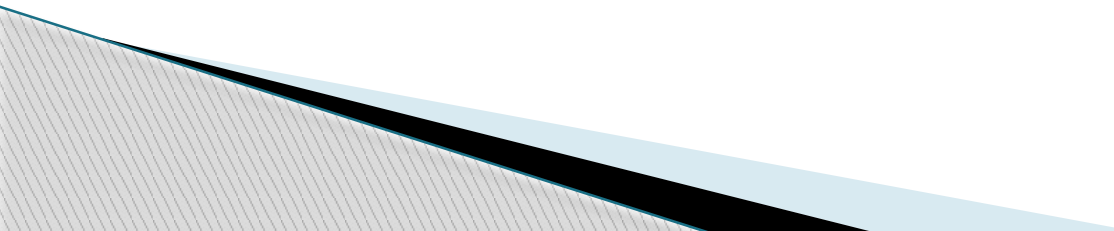
11. Examination of application

- on receipt of the application, the application is examined **formally** and **substantively** by the **EIPO**.
(Art 13(1) and (3)) _

- ❑ If the application doesn't conform formal requirement it shall be amended in **two months**, otherwise the application is considered as **with drawn**. **Art 13(2)**

12. Grant and publication

- ❑ **A Patent shall be granted to the applicant up on fulfillment of the requirements. **Art 14 (1)****

- ▶ When the patent is granted, it shall be
 1. publish a reference to the grant of the patent in official Gazette (a)
 2. Issue certificate of patent and a copy of patent (b)
 3. Record the patent (c)
 4. Make available copies of the patent (d)
- 

Contents of a patent (Art 15)

- ▮ Exclusive right

Duration of a patent (Art 16)

- ▮ 15 years, from the date of filing with possible extension of 5 years with in proof of the invention proper working in Ethiopia.

13. Patent of introduction (Art 18-21)

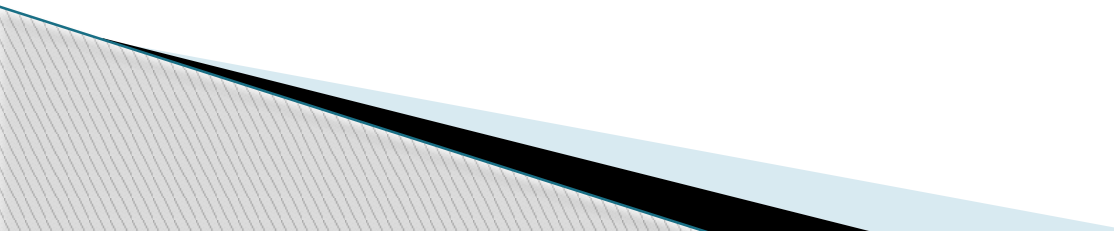
- an invention already patented abroad
- ▮ The protection is not expired
- ▮ But not patented in Ethiopia

Any interested party who take full responsibility can request the patent **(Art 18)**

Requirements and conditions(Art 19

- ❑ the same with patent Art 19 (1)
and **it shall indicate other
information Art 19 (2)**
- ❑ Duration of patent of introduction
-can be extended up to **10 years**,
provided that the prove of its
working situation **each years**, after
3 years of its grant.

14. Exclusive rights of a patent owner (Art 22)

- ❑ A patentee shall have the exclusive right to **make, use or otherwise exploit** the patented invention.
 - ❑ Third parties excluded from exploiting the patented invention without the consent of patentee.
- 

15.Limitation of rights (Art 25)

- ❑ Patent right is not absolute/limitless
- ❑ Limitations/restrictions/exceptions that limits the monopolistic power of the patentee.
- ✓ Acts done for non commercial purpose (a)
- ✓ Use solely for the purpose of scientific research and experimentation (b)
- ✓ Put the patented article to the market by the owner or with his consent (c). & Art 22(2) denial of import monopoly right (Doctrine of exhaustion)
 - Doctrine of exhaustion:- the patentee is unable to rely on the patent to prevent to prevent the resale of his patented product where he freely disposed them to the market

- Doctrine of exhaustion takes two form: absolute exhaustion and national exhaustion (Domestic exhaustion).

- ▶ The use of patented article on aircraft, land vehicle or vessels of other countries which temporarily or accidentally enter in to Ethiopia. (d)

Government use of the patent Art 25

(2)

- ❑ in account of public interest in particular
 - ✓ national security
 - ✓ Nutrition
 - ✓ Health
 - ✓ Or **the development of other vital sectors** of the national economy

The government or third person designated can be decided to exploit the patent save to equitable remuneration.

Prior users (Art 26)

- ❑ who use the invention prior to filing date or priority has the right to continue use it. (it should be in good faith)

Duties of patentee Art 27

- ❑ The patentee shall have duties to work the patented invention or to authorize other persons to do the same in Ethiopia.
- ❑ The patentee shall work the invention in a scale which is adequate and reasonable in circumstances. Art 27 (2)

Compulsory license (Section 7)

two grounds for compulsory license

- 1. If an invention can not be worked with out **the invention patented earlier,**
Or when an **earlier invention** can not be worked with out **later invention** Art 29 (1), (2)
(Dependant patent)**

2. **The second ground** for granting a compulsory license is **when the patentee fails to exploited** invention in Ethiopia with in a period of **three years from the date of the grant of patent**, or **four years from the date of the patent application**, whichever expires last. (Art 29 (3))

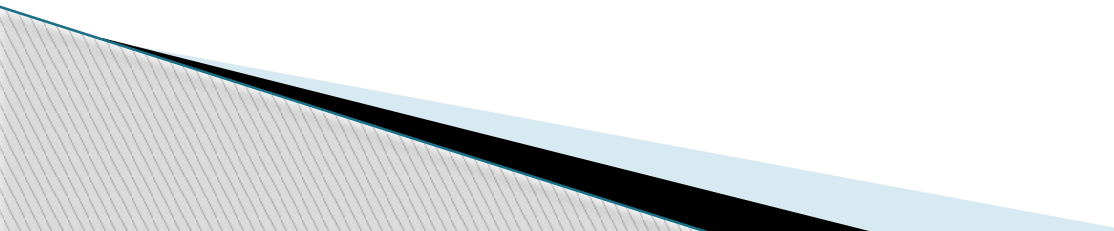
16. Infringement and enforcement measures

Infringement

- Infringement occurs when a person **makes, use of or exploits in any manner** a subject matter of a valid patent **without the permission of the patentee.**

Here

- The judgment of infringement requires the determination of patent scope and the comparison between the patented invention and the accused product or process.

- ❑ Ethiopian patent law protects the patentee against unauthorized make, use or exploitation of his invention.
 - ❑ According to Art.24 a patentee has recourse where his patent right is infringed by a third party.
 - ❑ However, nowhere under our patent law is found a standard that indicates how infringement occurs.
- 

Methods of infringement

- Literal Infringement**
- The Pith and Marrow
Doctrine**
- Doctrine of
equivalence**

Literal Infringement

- This is sometimes called the **literal overlap** or **all element rules**.
- It requires that **each** and **every element** of the claim must be present in the alleged infringement.

- ❑ It presumes that **each** and **every element** of the claim is material and essential
- ❑ The literal infringement is the oldest mechanical rule in the patent jurisprudence.

- ❑ Although it laid down the basis for proof of infringement; it has little or no acceptance in our days.
 - ❑ As such it has been vehemently criticized in that it encourages clever copies to make use of the patented invention by changing its shape, size and configuration.
 - ❑ It is also defeated as it allows others to make use of the patented invention by omitting even an immaterial or non essential part of the patented invention.
- 

The Pith and Marrow Doctrine

- pith and marrow doctrine is the Doctrine that takes into account only the **essential elements** of the patented invention to determine if they exist under the alleged infringement.

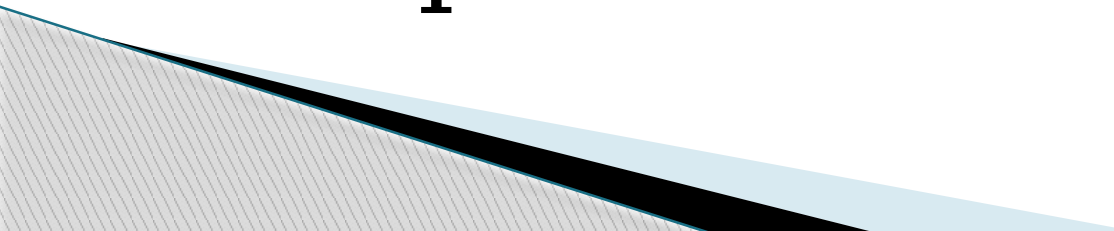
- According to this doctrine, an article can infringe a claim, even though all of the elements of the claim do not read on elements of the article, provided the differences between the article and the claim are only immaterial variations, or omission of non-essential

- ❑ the fact that a defendant fails to take an immaterial or non-essential part of the patented invention will not allow them to escape liability for infringement.

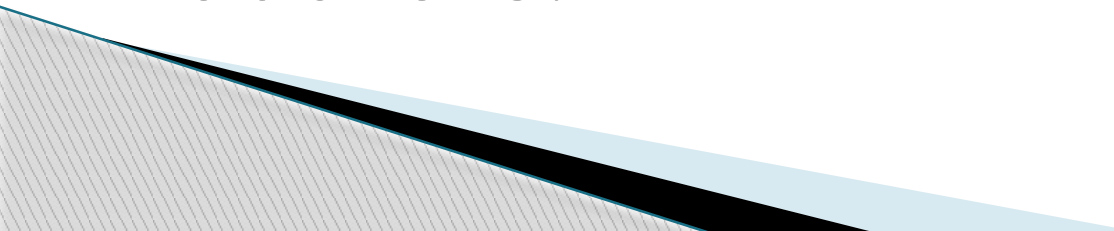
Doctrine of equivalence

- Both the literal and the pith and marrow doctrine focus on the **material identity** of the patented invention with the defendant's product or process.
- They do not cover cases where the defendant substitutes a material element of an invention with something that is **functionally equivalent**.

□ Quite beyond the literal language of the patent claims, the doctrine of equivalent holds that infringement occurs where the defendant's device are functionally equivalence to the patented invention.



- ❑ Specifically, a patentee can invoke this theory against the producer of a device, if it performs substantially the same function in substantially the same way to obtain the same result.
- ❑ The equivalence in **function**, **way** and **result** is also known as the **triple identity**.

- ❑ The Doctrine of equivalence is clearly an expansive doctrine in the sense that it extends the scope of the patent beyond its literal meaning.
 - ❑ Its influences on patent scope and consequently on the economic value of the patent has attracted scholarly debate among different authors.
- 

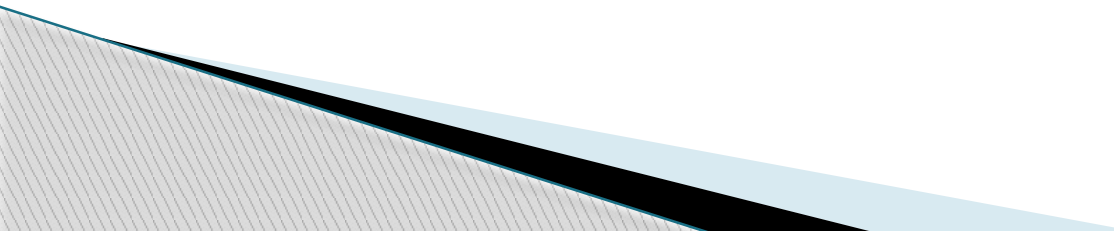
- ❑ Some authors view the Doctrine of equivalence as an incentive for substantial improvement on a basic technology.
- ❑ Whereas quite many authors reject it on the ground that it may retard or inhibit **new technology**, others also criticize the doctrine of equivalence **as obscure and unpredictable**

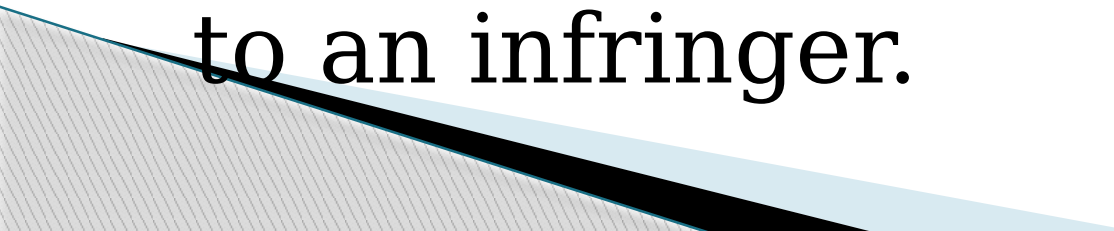
Type of infringing activities

- Art 24 envisages the right of recourse against infringement without indicating **how infringement could occur and how to implicate liability to infringers** for different infringing activities.

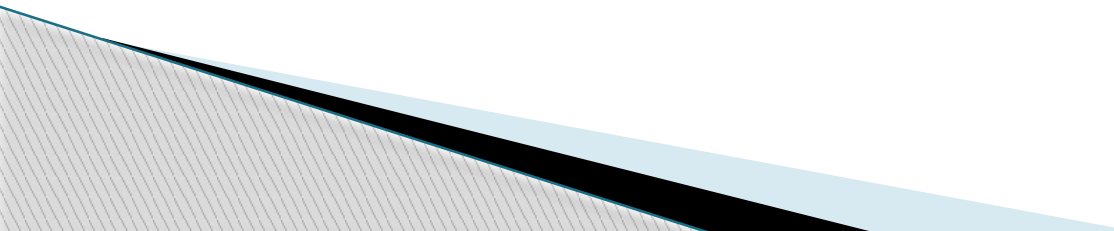
- ❑ As the course of events signifies, however, patent infringement could take place in different ways. The most common type of infringing activities takes the character of **direct**, **indirect**, or **contributory infringement**.

Direct infringement

- ❑ Direct infringement occurs if a person **makes**, **uses** or **sales** the patented invention without permission.
 - ❑ Direct infringement involves immediate engagement with the patented product or process.
- 

- ❑ It occurs irrespective of the knowledge of the infringer.
 - ❑ Infringement does not allow for any defense based on good faith or ignorance.
 - ❑ However, to request damage the patentee must have marked his product invention with notice of the patent or give actual notice to an infringer.
- 

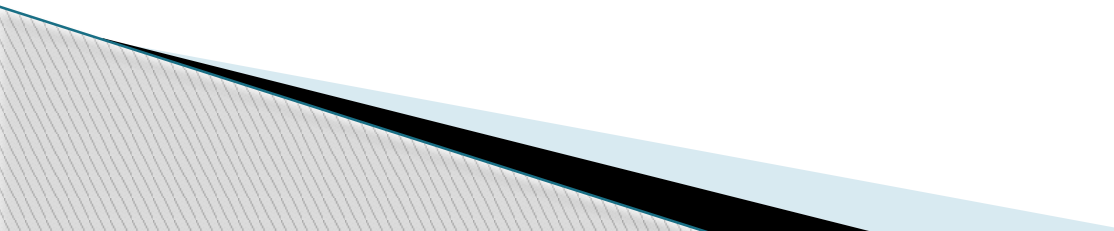
Indirect infringement

- Indirect infringement applies where a person facilitates the act of infringement
 - If a person encourages another to **make, use** or **sell** the invention without permission, the person who induces would be liable for indirect infringement.
- 

- ❑ For indirect infringement to take place, **two elements** need to be met:
- ❑ First the patentee must establish that the means supplied by the defendant relates to an **essential element of the invention**.

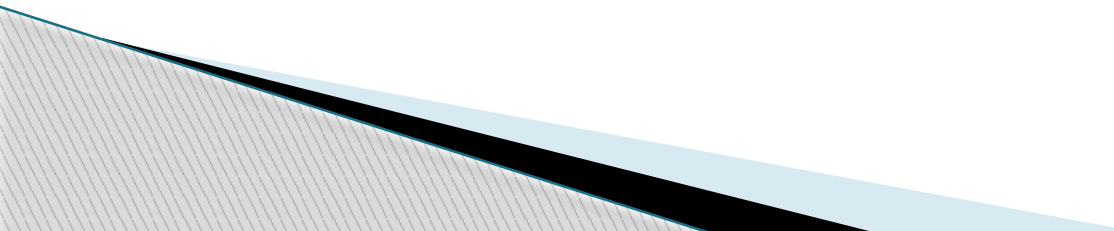
- ❑ Secondly, the supplier must know or it must be obvious to a reasonable person in the circumstances that the means are both “suitable” for and “intended” to be used in putting the invention into effect.

□ The imposition of a knowledge requirement ensures that parties who do not knowingly benefit from the misuse of a patent are not caught as indirect infringers



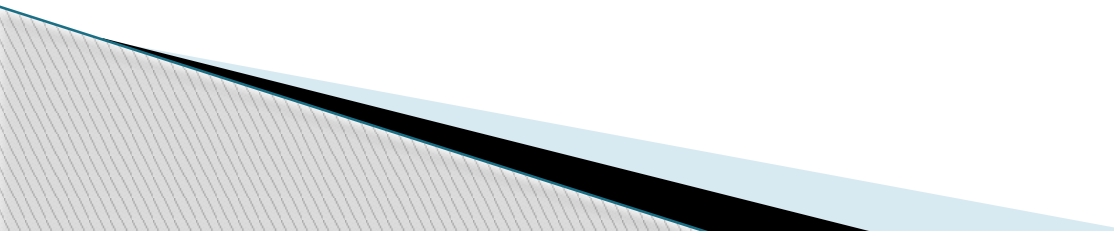
Contributory infringement

- ❑ Contributory infringement is a recent concept that is regarded as a broader version of indirect infringement.
- ❑ It occurs only in connection with a sale of a component knowing it to be specially made or adapted for use in a patented device or process and the component is not a staple article suitable for

- ❑ Although good faith or ignorance is defense for direct infringement, that is not the case with contributory infringement.
 - ❑ Don't have a knowledge is defense here.
- 

Legal remedies to infringement

- ❑ In general, the remedies could be **civil or criminal**.
 - ❑ Most often than not, the successful plaintiff in an infringement suit chooses damages or an accounting of the defendant's profit.
 - ❑ In view of this, Art 24-of the patent proclamation provides that the patentee has a right of recourse against patent infringement.
- 

- ❑ However, from this provision one cannot succinctly tell the specific types of remedies that a patentee might seek.
 - ❑ Thus, to suggest the appropriate remedies, we should invariably resort to the civil code, civil procedure code and the new revised criminal code.
- 

□ According to Art 1674 of the civil code, the patentee can seek the following remedies:

A. Relief of injunction

B. Damage

C. Destruction of the infringing devices

- ▶ The other available legal remedy pertains to criminal sanction. In line with this, Art 720(2) of the new revised criminal code provides:
- ▶ “Whoever unlawfully so acts with respect to intellectual property rights, particularly industrial designs, models, or patented inventions, duly registered and protected by existing law or agreements, national or international, shall be punishable by a rigorous imprisonment not exceeding ten years”