



Patents and Patentability.

Introduction

There is no universally accepted definition of a patent. In fact most of the attempts to define patents focus more on the rights conferred upon owners of patents rather than what it is. One such definition is that a patent for an invention is granted by the government to the inventor, giving the inventor the right to stop others, for a limited period, from making, using or selling the invention without their permission.¹ Another definition is that a patent is a right granted to an inventor by the government that allows the inventor to exclude others from making, selling or suing the invention for a period of time. The World Intellectual Property Organization (WIPO) defines a patent as an exclusive right granted for an invention, which is a product or a process that provides, in general, a new way of doing things or offers a new technical solution to a problem.²

Although it may not be entirely possible to decipher what exactly a patent is from the definitions advanced above, it is possible to see a common theme that running across all of them, and that is, a patent **must** first and foremost be an **invention**. The invention may be a product or a process which offers a new way of doing things or is a solution to an existing problem.

Patents and the patent registration systems are designed to encourage inventions that are unique and useful to society as well as promote innovativeness and reward

¹ British Library, Business and I.P Centre, available at <https://www.bl.uk/business-and-ip-centre/articles/what-is-a-patent>

² Available at <https://www.wipo.int/patents/en/>

inventors.³ This is because when patent protection is granted, the invention becomes the property of the inventor, which like any other form of property (eg Land) or business asset (cars, office furniture and shares) can be bought, sold or hired.⁴ The inventor is granted exclusive rights to the invention by the government for a certain period of time, usually twenty years.

In Kenya, patents and patent registration is governed by the Industrial Property Act.⁵ The Act does not define what a patent is but it provides for what is patentable by stating that an invention is patentable if it is new, constitutes an inventive step and is industrially applicable.⁶ This provision gives one more insight as to what a patent is by giving more criteria for identifying a patent.

Therefore, it is proper to say that in addition to a patent being an invention, it must be:-

1. New;
2. Is an Inventive step; and
3. Capable of industrial application.

New/novel

This requirement for patentability demands that one cannot patent something that is already known or is public knowledge.⁷ This is because it would be unfair to confer benefits of a patent to a person in relation to something that is already known.⁸ This brings in the concept of novelty which is the state of being new, original or unusual.⁹ Therefore, in the event you wish to disclose your inventive product, process to someone before it is registered, it is important that you sign a confidentiality agreement beforehand.¹⁰

Inventive step

This requirement of an inventive step relates to the 'obviousness' of the new product, process or invention. If it is 'obvious' to a skilled person, it is not patentable.¹¹ This means that the invention should not be obvious to someone with good knowledge and experience of the subject when compared with what is already known.¹²

³ What is a Patent available at <https://smallbusiness.findlaw.com/intellectual-property/what-is-a-patent.html>

⁴ Supra N.1

⁵ 2001, Laws of Kenya.

⁶ Ibid Section 22

⁷ Available at <https://www.business.qld.gov.au/running-business/protecting-business/ip-kit/browse-ip-topics/new-products,-processes-and-inventions-patents/five-requirements>

⁸ Ibid

⁹ Ibid

¹⁰ Ibid

¹¹ Ibid

¹² Supra N. 3

Capable of industrial application

This requirement does not relate to whether the new product, process or invention is 'useful' in terms of whether or not someone would buy it. Instead, it relates to whether the invention is capable of being made or used in some kind of industry. This means that the invention must take the practical form of an apparatus or device, a product such as some new material or an industrial process or method of operation.¹³

Inventions that are not patentable¹⁴

It is important to note that although some inventions meet the test of patentability, not all of them are patentable. Below is a list of a few inventions which are not patentable in Kenya and in the world:-

- A discovery;
- A scientific theory or mathematical method;
- An aesthetic creation, literary, dramatic or artistic work;
- A scheme or method for performing a mental act, playing a game or doing business;
- The presentation of information or a computer program;
- A plant variety;
- A method of treatment of the human or animal body by surgery; and
- Therapy or a method of diagnosis.

Utility models vis-à-vis Patent

Section 2 of the Industrial Property Act, 2001 defines a Utility model as:-

“means any form, configuration or disposition of element of some appliance, utensil, tool, electrical and electronic circuitry, instrument, handicraft mechanism or other object or any part of the same allowing a better or different functioning, use, or manufacture of the subject matter or that gives some utility, advantage, environmental benefit, saving or technical effect not available in Kenya before and includes micro-organisms or other self-replicable material, products of genetic resources, herbal as well as nutritional formulations which give new effects.”

An invention qualifies for a utility model certificate if it is new and industrially applicable.¹⁵ You will note that there is no requirement for a Utility model to be an invention and in certain spheres, it has been referred to as “a lesser patent”. Most times than not, people confuse patents with Utility models but the standards set for a patent are higher. Actually, most applications which do not qualify for grant of a patent almost always end up being registered as Utility Models.

¹³ Supra N. 3

¹⁴ Section 83 of the Industrial Property Act, 2001

¹⁵ Ibid Section 82(1)

This is why the Act allows at any time before the grant or refusal of a patent, an applicant for a patent may, convert his application into an application for a utility model certificate, which shall be accorded the filing date of the initial application.¹⁶ Once registered, the applicant is issued with a utility model certificate. The certificate shall expire at the end of the tenth year after the date of the grant of the utility model, and shall not be renewable.¹⁷

Industrial design vis-a-vis Patent

Section 84(1) of the Industrial property Act, 2001 defines an industrial design as:-

“any composition of lines or colours or any three dimensional form whether or not associated with lines or colours, provided that such composition or form gives a special appearance to a product of industry or handicraft and can serve as pattern for a product of industry or handicraft” .

Therefore, it is proper to say that industrial designs are concerned only with the outward appearance of articles as defined by their shape, configuration, pattern or ornament.¹⁸ The reasoning behind this is because visual appeal is one of the considerations that influence the decision of consumers to prefer one product over another, particularly in areas where a range of products performing the same function is available in the market.¹⁹

The legal protection of industrial designs, thus, serves the purpose of protecting one of the distinctive elements by which manufacturers achieve market success.²⁰ It is however important to know that a right conferred for an industrial design does not extend to protect the method of construction or the function of the article.²¹

Conclusion

It is always crucial that before you embark on the process of registration of a patent, you establish that your product is patentable. This is because the process of registering a patent is rigorous, long and expensive. Ensure that your invention meets all the requirements set out in this discussion before you start the registration process. If in doubt, always seek advice from legal practitioners who are patent agents.

¹⁶ Ibid section 84

¹⁷ Ibid Section 82 (3)

¹⁸ Utility models available at <https://www.kipi.go.ke/index.php/industrial-design>

¹⁹ Ibid

²⁰ Ibid

²¹ Ibid