TABLE OF CONTENTS

CHAPTER 1
INTRODUCTION AND OVERVIEW

PURPOSE AND USE OF THIS MANUAL

1.01 This Manual provides guidance and instructions as to the practice to be followed by the Egyptian Patent Office during the search and examination procedures before that Office. The Manual is intended to implement the legal and technical examination and appeal procedures of the Egyptian Law (Law 82/2002 on the Protection of Intellectual Property Rights) and this law's implementing Regulations (Regulations 1366/2003). It is to a large degree based on the newly revised PCT International Search and Preliminary Examination Guidelines (revised March 2004). The use of the PCT Guidelines as the basis of much of the substance of the Manual is for two reasons. The first reason is that many of the patent applications processed by the Patent Office come through the PCT system and have undergone search and examination under the provisions of the PCT Guidelines, and therefore by using these guidelines for all applications, the treatment for Egyptian and non-Egyptian applicants will be similar and in accordance with internationally accepted search and examination practices. Second, Egypt is looking to become a PCT Search and Preliminary Examination Authority and therefore the practices that the Patent Office would follow would be to a large degree the same for the work it does as a PCT Authority and the work it does as a national patent Office. Use of this Manual, based on the PCT Guidelines, will also aid the technical examiners' understanding of the PCT International Preliminary Reports on Patentability (IPRP) as prepared by the International Authorities as they relate to the examiner's conclusion as to novelty, inventive step (non-obviousness) and industrial applicability.

1.02 Though the Manual is primarily for the legal and technical examiners at the Patent Office, it will also be of assistance to applicants and patent practitioners by providing for a common basis for the preparation and examination of patent applications. This should work to the advantage of applicants and practitioners as well as the Patent Office, since the applicants and patent practitioners will know the requirements and the procedures of the Office and thus will be better able to prepare applications and respond to Office notifications and letters consistent with the requirements of the Patent Office. This should reduce errors and misunderstandings, thereby ensuring high quality, expedient patent application processing.

1.03 The Manual is intended to be used for the Patent Office's processing of nationally filed applications as well as applications first filed in other countries and seeking patent protection in Egypt either under the provisions of the Convention for the Protection of Industrial Property (Paris Convention) or under the Patent Cooperation Treaty (PCT).

1.04 Though the Manual is based on the PCT Guidelines, it is the Protection of Intellectual Property Rights law of Egypt which governs the decision as to whether or not to grant a patent in Egypt.

1.05 The Manual is intended to cover typical situations but it is understood that there will be situations which will arise where there is no guidance in the manual as to how the examiner should proceed. In these exceptional situations, the examiner should seek guidance from Patent Office management

1.06 This Manual can be revised from time to time to reflect changes in the law, decisions of the Appeals Committee, court decisions, Patent Office practice, and other changes affecting the search and examination of patent applications in Egypt.

ARRANGEMENT OF THE MANUAL

1.07 The Manual is set forth in chapters, sub-chapters and paragraphs. The chapters and paragraphs are number sequentially, while the headings of the sub-chapters are in bold typeface but are unnumbered. The numbering of the paragraphs follows the chapter number e.g., this paragraph number (1.07) indicates that it is the seventh paragraph in Chapter 1. Currently there are 14 chapters completed (1 to 7, and 9 to 15). The numbering of most of the Chapters and paragraphs are the same as in the PCT Guidelines to allow, to the greatest extent possible, concordance between the PCT Guidelines and the Egyptian Manual. This will allow for easy updating of this Manual if the PCT Guidelines change and at the same time will ease the work of examiners by having one numbering scheme for both their national Manual and for the PCT Guidelines. There are several chapters in the PCT Guidelines, which are not included in this manual since they relate to the administrative processing of PCT international applications before the International Authority and are not germane to the work of the Patent Office at this time.

DEFINITIONS

1.08 Law or Egyptian Law on the Protection of Intellectual Property Rights refers to Law 82/2002

1.09 Regulations or Implementing Regulations refers to Regulations 1366/2003

1.10 PCT refers to the Patent Cooperation Treaty, an international Treaty administered by the World Intellectual Property Organization (WIPO)

1.11 Paris or Paris Convention for the Protection of Industrial Property refers to a WIPO administered convention

1.12 TRIPS refers to Trade Related Aspects of Intellectual Property as part of the General Agreement on Tariffs and Trade (GATT), administered by the World Trade Organization (WTO)

1.13 The term “technical examiner,” refers to the Patent Office examiner responsible for the technical search and examination of patent.

1.14 The term “legal examiner” refers to the Patent Office examiner responsible for the legal examination of patent applications.

1.15 The word “reserved” is used to denote chapters or paragraphs which are not used at this time but may be used at a later date.

1.16 The term “International Application” refers to any application deposited in accordance with the PCT provisions

1.17 The term “Receiving Office” refers to the national office or the government’s international organization with which international applications are deposited

1.18 The term “Designated Office” refers to the national office of any country as designated by the applicant in accordance with Chapter I of the PCT, or any other office working for this country

1.19 The term “Elected Office” refers to the national office of any country as elected by the applicant in accordance with Chapter II of the PCT or any other office working for this country

1.20 The term “International Searching Authority” refers to a national office or an intergovernmental organization whose tasks include the establishing of documentary search reports on prior art with respect to inventions which are the subject of applications. Each receiving office must determine the authority(s) concerned with searching the international applications it receives.

1.21 The term “International Preliminary Report on Patentability by the International Searching Authority” refers to the report issued by the international office on behalf of the International Search Authority so long as no international preliminary examination report is made

1.22 The term “International Publication” refers to the publication of international applications by the international office after the lapse of the 18-month period as of the priority date

1.23 The term “International Preliminary Examination Authority” refers to the authority(s) concerned with the international preliminary examination procedures of deposited applications. Receiving offices of countries which abide by the provisions of Chapter II of the PCT must inform the international office of such authority(s)

1.24 The term “International Preliminary Examination Report” refers to the nonbinding opinion of the authority on novelty, inventive step, and industrial applicability.

CHAPTER 2
LEGAL EXAMINATIONS

INTRODUCTION

2.01 There are two types of examinations of patent applications at the Egyptian Patent Office. The first is an examination by a Legal Examiner and includes an examination as to the completeness of the application at the time of the initial filing of the application. (The Legal Examiner is also responsible for completing the letter to the applicant explaining the position taken by the technical examiner.) The second is an examination by the Technical Examiner to determine if the invention in the application is patentable. This chapter relates only to the work of the Legal examiner which takes place at the time of filing of the patent application.

2.02 When a patent application is filed at the Patent Office, the applicant or the agent representing the applicant meets with a Legal Examiner so that a determination can be made as to whether the application can be filed and given a filing date or whether there are additional requirements which must be completed by the applicant before filing. The Legal Examiner can also determine that the application may be filed but that there are still certain requirements which applicant must complete within certain time limits.

2.03 The documents and information needed for filing of a patent application in Egypt differs according to the type of filing. That is, a regular national filing, a Paris Convention filing and a PCT national phase entry each have different requirements. The Legal Examiner must know the specific requirements for each type of filing.

2.04 For a national filing or a Paris Convention filing, the applicant must provide all the elements required by Law Article 13 and Regulation Article 3 set forth here:

Law Article 13

The patent application shall be accompanied by a detailed description of the invention, including a full statement of the subject matter and of the best way to enable an person of expertise to execute it, and of each product or method for which protection is sought.

The description shall also include in a clear manner the new claims for which the applicant seeks protection accompanied, where necessary, by an illustrative drawing of the invention.

Where the invention involves biological, plant or animal product, or traditional medicinal, agricultural, industrial or handicraft knowledge, cultural or environmental heritage, the inventor should have acquired the sources in a legitimate manner.

Where the invention involves microorganisms, the applicant shall disclose the identity of such organisms and deposit a live culture thereof with the authority designated in the Regulations.

Without prejudice to the provisions of Article 38 of this Law, the applicant shall, in all cases, provide full data and information on any applications relating to the

same invention or its subject matter, that he previously filed abroad, as well as the outcome of such applications.

The Regulations shall determine the required annexes to be attached to the patent application, the time limits for their submission and as well as the conditions justifying its refusal.

Regulation Article 3.

The patent application shall be accompanied by

1. A fully detailed description, in Arabic, of the invention or utility model, prepared in a clear manner, using correct technical terms, including a statement on prior art and shortcomings therein, the novel element in the invention or utility model and the best way known by the inventor, to enable a person of expertise to execute it, showing also, in a precise and clear manner, the new claims for which protection is sought, and indicating any chemical equations or formulae or illustrative drawings.

   The applicant shall furnish, on the form established to that effect, full data and information on applications filed abroad for the same invention or utility model or any relevant information, the fate of such applications, and resulting decisions.

2. An abstract describing the invention or utility model in the Arabic and English languages, with chemical formulae, if any, using the form established to that effect.

3. Where the application relates to an invention or utility model involving plant or animal biological material, traditional medicinal, agricultural, industrial or handicraft knowledge, or cultural or environmental heritage, it shall be accompanied by documentation proving that the inventor has accessed the source from which the material was obtained in a legitimate manner, according to the legislation applicable in the Arab Republic of Egypt.

4. Where the invention involves microorganisms, the applicant shall disclose such organisms according to conventional scientific rules, including all necessary information for the identification of the nature, characteristics and uses of such organisms, shall deposit a live culture thereof with a laboratory authorized by decision of the competent minister for scientific research affairs, and shall furnish a certificate to the effect that such deposit was made.

5. Where the applicant is a legal entity, an extract from the commercial register or an official copy of the constitution act or decision shall be furnished.

6. Documentation establishing the quality of the applicant.

7. Documentation establishing, where applicable, the

assignment by the right holder of the invention or utility model.

8. Certificate of temporary protection for the invention or utility model, if any.
9. Receipt of payment of the application fees.

2.05 Article 4 of the Regulations allows certain documents to be furnished after the filing of the patent application and if the documents are furnished within the time limit set by the Patent Office, then there is no effect on the filing date of the patent application. However, if the requirements are not satisfied within the time limit fixed by the Patent Office, the application will be considered to be abandoned. Article 4 of the Regulations is set forth here:

> **Regulation Article 4.**
> Documentation mentioned under items 3, 4, 5, 6 and 7 of Article 3 of these Regulations may be furnished within four months from the filing date of the application. The Arabic translation of the document provided for by item 1 of the same Article, where furnished with the application in a foreign language, may be furnished within six months from the same date.
>
> If the documents provided for by the first paragraph are not furnished in due time, as the case may be, the application shall be considered as non-existent.

2.06 When the application includes chemical formulae or drawings provided by applicant they must be submitted as required by Regulation Articles 9 to 13 as reproduced here.

> **Regulation Article 9.**
> The description of the invention or utility model shall contain only such chemical equations or the like as necessary.
>
> Where required for the clarity of the description of the invention or utility model, an illustrative drawing shall be made on a sheet in accordance with the following Articles and shall accompany that description.
>
> **Regulation Article 10.**
> The drawing of the invention or utility model shall be executed on clear, white, strong and smooth drawing sheets, of good quality and medium thickness, without any coloring and capable of being clearly reproduced by photography or the like.
>
> **Regulation Article 11.**
> The size of the sheets used shall be 21 cm x 29.5 cm, and all margins shall be 2.5 cm.
>
> Consecutive numbers shall be allotted to different figures of the drawing of the invention, and sufficient space shall separate a figure from another.
>
> If necessary, more than one sheet may be used for the drawing of the invention.
>
> **Regulation Article 12.**

In the execution of the drawings of the invention or utility model, the following rules shall be complied with:

1. Dark black ink shall be used for the lines of the drawing.
2. Lines shall be apparent and uniformly thick.
3. A minimum of hatching and shade lines shall be used without any interlineations or overlapping that would cause confusion.
4. The thickness of the shade lines shall not be significantly different from that of the main lines.
5. Parts or shades of the drawing shall not be emphasized in bold or by colorings.
6. The scale of the drawing shall be sufficient to show the invention or utility model in a clear manner; the drawing shall show such parts of the invention or utility model that would accomplish such purpose; The scale of the drawing of the invention or utility model shall be determined in numbers.
7. The title of the invention or utility model or parts thereof shall not appear in the drawing itself.
8. Figures shall be executed in an upright position with respect to the drawing sheet.
9. Letters and numbers used to indicate parts of the drawing shall be placed in a clear manner; their height shall not be less than 3 mm; the same letters and numbers shall be used in the different positions of the drawing; thin arrows shall be used to connect any letters or numbers appearing outside the drawing to the corresponding parts of the drawing.

   Such letters and numbers shall be identical to those used in the detailed description of the invention or utility model.
10. The drawing sheet shall not be folded; it shall be free from creases and cracks so as to admit reproduction by photography or the like.

Regulation Article 13.
The following data shall be indicated on the drawing sheet:

1. Word "original".
2. Name of the applicant.
3. Number of sheets containing the drawing and the consecutive number of each sheet.
4. Serial number and date and time of receipt, of the application.
5. The signature of the applicant or agent.

such data shall be presented, according to their order of succession, in a table to the bottom right of the drawing sheet.

2.07 If samples accompany the application they must be submitted as required by Regulation Articles 14 to 17.

> **Regulation Article 14.**
> When necessary, the Office may require that the applicant furnishes, as the case may be, two samples or models of the invention or utility model.
>
> **Regulation Article 15.**
> The Office may require that the applicant for a patent for an invention or utility model for chemical products relating to foodstuff, pharmaceuticals and agriculture furnishes two samples of such products.
>
> The applicant shall establish a list of the samples and their nature, which shall be included in or attached to, the detailed description.
>
> The applicant shall indicate, at the top of the detailed description of the invention or utility model, that such samples are furnished. The Office shall include such indication in the publication of the acceptance of the application, in the Gazette.
>
> **Regulation Article 16.**
> Samples referred to under Article 15 of these Regulations shall be furnished in flasks of a maximum height of 8 cm and external diameter 4 cm. The flasks shall be tightly sealed with red wax and labeled with a card indicating the relationship between the sample and production referred to in the description of the invention. Such card shall be affixed to or suspended on the flask; in which case, it shall have a length not exceeding 10 cm and width 8 cm.
>
> **Regulation Article 17.**
> If the invention relates to a colorant, a sample thereof shall be furnished in accordance with Articles 15 and 16 of these Regulations. Such sample shall be accompanied by specimens of products printed or colored by that colorant. Such specimens shall have, to the extent possible, an even surface, and shall be fixed on cards of 33 cm x 21 cm. Such cards shall contain a detailed statement describing the printing or dying process and, particularly, the composition of various solutions, degree of concentration, temperature, time required for each process, and capacity of color absorption by the dye. The said cards shall also indicate the percentage of colorant fixed in the dyed material, the composition of the printing paste, and a statement indicating the relation between the colorant used for printing or dyeing, and the relevant particulars in the description of the invention or utility model.
>
> Where the sample contains toxic, caustic, explosive or inflammable substance, an indication to that effect shall be made on the label.

2.08 When the application being filed is a PCT application entering the national phase in Egypt some of the requirements are fulfilled by documents furnished to the Egyptian Patent Office by the International Bureau of WIPO. See Chapter 3 for details on the PCT and the documents furnished by the International Bureau.

2.09 The PCT also prescribes certain limitations on what may be required of applicants entering the National Phase. Therefore, the requirements for PCT applications can differ from those set forth in the Egyptian Law and Regulations which govern the filing of regular national patent applications and Paris Conventional filings in Egypt. PCT Articles 27 and 28 which govern this are set forth here:

PCT Article 27
National Requirements

(1) No national law shall require compliance with requirements relating to the form or contents of the international application different from or additional to those which are provided for in this Treaty and the Regulations.

(2) The provisions of paragraph (1) neither affect the application of the provisions of Article 7(2) nor preclude any national law from requiring, once the processing of the international application has started in the designated Office, the furnishing:

(i) when the applicant is a legal entity, of the name of an officer entitled to represent such legal entity,

(ii) of documents not part of the international application but which constitute proof of allegations or statements made in that application, including the confirmation of the international application by the signature of the applicant when that application, as filed, was signed by his representative or agent.

(3) Where the applicant, for the purposes of any designated State, is not qualified according to the national law of that State to file a national application because he is not the inventor, the international application may be rejected by the designated Office.

(4) Where the national law provides, in respect of the form or contents of national applications, for requirements which, from the viewpoint of applicants, are more favorable than the requirements provided for by this Treaty and the Regulations in respect of international applications, the national Office, the courts and any other competent organs of or acting for the designated State may apply the former requirements, instead of the latter requirements, to international applications, except where the applicant insists that the requirements provided for by this Treaty and the Regulations be applied to his international application.

(5) **Nothing in this Treaty and the Regulations is intended to be construed as prescribing anything that would limit the freedom of each Contracting State to prescribe such substantive conditions of patentability as it desires.** In particular, any provision in this Treaty and the Regulations concerning the definition of prior art is exclusively for the purposes of the international procedure and, consequently, any Contracting State is free to apply, when determining the patentability of an invention claimed in an international application, the criteria of its national law in respect of prior

art and other conditions of patentability not constituting requirements as to the form and contents of applications.

(6) The national law may require that the applicant furnish evidence in respect of any substantive condition of patentability prescribed by such law.

(7) Any receiving Office or, once the processing of the international application has started in the designated Office, that Office may apply the national law as far as it relates to any requirement that the applicant be represented by an agent having the right to represent applicants before the said Office and/or that the applicant have an address in the designated State for the purpose of receiving notifications.

(8) Nothing in this Treaty and the Regulations is intended to be construed as limiting the freedom of any Contracting State to apply measures deemed necessary for the preservation of its national security or to limit, for the protection of the general economic interests of that State, the right of its own residents or nationals to file international applications.

PCT Article 28
Amendment of the Claims, the Description, and the Drawings, before Designated Offices

(1) The applicant shall be given the opportunity to amend the claims, the description, and the drawings, before each designated Office within the prescribed time limit. No designated Office shall grant a patent, or refuse the grant of a patent, before such time limit has expired except with the express consent of the applicant.

(2) The amendments shall not go beyond the disclosure in the international application as filed unless the national law of the designated State permits them to go beyond the said disclosure.

(3) The amendments shall be in accordance with the national law of the designated State in all respects not provided for in this Treaty and the Regulations.

(4) Where the designated Office requires a translation of the international application, the amendments shall be in the language of the translation.

2.10 There are other rules of the PCT effecting the national phase in Egypt that are set forth with explanations in the PCT Applicants Guide which be found at http://www.wipo.int/pct/guide/en/. Note particularly the pages in the Guide which are specific to Egypt.

2.11 Law Article 11 and Regulation Article 2 require that a fee accompanies the filing of each patent application. Once the Legal Examiner has determined that there are sufficient documents accompanying the patent application to allow for the filing of the application, the applicant must pay the required fee at the time of filing of the application. Such fee must be paid in cash at the Patent Office. Law Article 11 and Regulation Article 2 are reproduced here:

Law Article 11

A fee shall be paid on filing a patent application. A progressive annual fee shall also be paid as of the second year until the expiration of the patent protection period.

Cases for the reduction or waiver of these fees shall also be prescribed in the Regulations.

The amount of such fees, to be determined in the Regulations, shall not exceed 2,000 pounds for the initial application or 1,000 pounds for the annual fee.

The patent applicant shall pay the fees of experts called upon by the Patent Office as well as examination costs.

Regulation Article 2.
Applications for patents and utility models shall be filed with the Patent Office on the form established to that effect.

On filing an application, a fee shall be payable as indicated under the corresponding category of the schedule attached to these Regulations.

Applications filed by students registered with educational institutes, regardless of the grade level of the institute, shall be exempt from such fee.

2.12 After the application has been filed at the Patent Office, the application is given a serial number as set forth in Regulation Article 6.

Regulation Article 6.
Applications for patents and utility models shall be allotted serial numbers according to the date and time of receipt, starting from the first of January of each year. The applicant shall be given a receipt indicating the serial number of the application, which shall be, together with annexes, sealed with the seal of the Office; the serial number and date and time of receipt shall be marked on the application.

2.13 The Patent Office will maintain a record of all applications including all the information as required by Regulation Article 7.

Regulation Article 7.
applications shall be recorded in the patent register which shall contain the following data:

1. Serial number of the application.
2. Date and time of receipt of the application.
3. Name of the inventor.
4. Name, surname and address of the applicant, or, if the applicant is a legal entity, name and address of that entity, and an address for service.
5. Name and surname of the agent, if any.
6. Where the application for a patent or utility model was filed according to the provisions of Article 38 of the Law, name of the foreign entity or country with which the

application was filed and the filing date of the application.

7. Acts relating to the patent application.
8. Date at which the decision granting the patent for the invention or utility model, was issued, the patent number, and the name of the right holder.
9. Acts and procedures relating to the ownership or right of exploitation, of the patent.
10. Actions of seizure carried out in relation with the patent.

2.14 There shall also be an alphabetical index prepared for applications as required by Regulation Article 8.

Regulation Article 8.
An alphabetical index of the applications received by the Office shall be established and shall contain an indication of the name of the applicant, name of the inventor, title of the invention or utility model, serial number of the application and date and time of receipt. The confidentiality of the application and its annexes shall be maintained until the acceptance of the application is published after, at least, one year from the date of receipt. The index shall be made available to the public at the Library of the Patent Office.

CHAPTER 3
OVERVIEW OF SUBSTANTIVE EXAMINATIONS

3.01 This Chapter gives an overview of the technical search and examination process for patent applications processed at the Patent Office. It should be stressed that this is only an overview and that the details of the processing will be found in later chapters where individual topics treated in detail.

3.02 Since many of the applications being processed by the Patent Office will come through the Patent Cooperation Treaty (PCT) system, it is useful to first explain that system and how applications processed through the PCT will be filed at the Patent Office. Afterwards, the process at the Egyptian Patent Office will be explained.

PCT APPLICATION PROCEDURE

3.03 The procedure through which an international patent application under the Patent Cooperation Treaty (PCT) proceeds from the filing of the application to the granting of a patent (or the refusal thereof) comprises two main stages, commonly referred to as the "international phase" and the "national phase.

3.04 It is important to view this process in two ways. The first way is as an Egyptian applicant filing a PCT application in Egypt allowing the applicant to request patent protection in other countries that are party to the PCT. The second way is for applicants which have filed PCT international applications in or for countries which are party to the PCT, but wish to gain patent protection in Egypt. Since this manual relates to the processing of national patent application in Egypt, this second way of viewing the following PCT procedure should be kept in mind.

THE PCT INTERNATIONAL PHASE

3.05 The international phase begins when the PCT international patent application is filed following the requirements of the PCT. During this phase, there is a search of the prior art with a written opinion on patentability, international publication and (optionally) a preliminary examination.

3.06 When the international application is filed all the PCT countries party to the Treaty (127 – September 2005) on the day of filing of the application are automatically "designated". This type of designation should be looked at as leaving open the option for an applicant to seek patent protection in any or all the PCT member countries. After filing and at applicant's option, applications for the granting of national patent applications based on the PCT international application can be filed in any or all designated PCT member countries at any time up until 30 months from the priority date. (Note: Certain countries allow for more than 30 months and a very few countries only allow 20 months). Check the PCT Applicants Guide on the WIPO website (http://www.wipo.int/pct/guide/en/ for the latest information on this)

3.07 Filing of the international application must be done at an appropriate receiving Office. In Egypt, the receiving Office is part of the Patent Office. All applicants also have the option of filing a PCT international application with the receiving Office of the International Bureau of WIPO in Geneva, Switzerland.

3.08 After filing, certain procedural checks are carried out, an international filing date is given by the receiving office and copies of the application are sent to the International Bureau of WIPO (the record copy) and the International Searching Authority (the search copy);

3.09 An international search report and written opinion is established by an International Searching Authority (currently there are 12 such authorities). This includes: 1) a search for earlier disclosures relevant to the novelty and inventive step of the claimed invention; and 2) the establishment of an international search report and a written opinion on novelty, inventive step and industrial applicability, normally at 16 months from the priority date. Different country's receiving Offices can choose different International Searching Authorities. The PCT Applicants Guide (http://www.wipo.int/pct/guide/en/) sets forth the available International Searching Authorities for each receiving Office. For PCT international applications filed at the Egyptian Patent Office in its capacity as PCT receiving Office, the available authorities are: The Austrian Patent Office, The European Patent Office; and the U.S. Patent and Trademark Office.

3.10 An "international preliminary report on patentability" (IPRP Chapter I) is issued by the International Bureau on behalf of the International Searching Authority if the applicant does not file a demand (see paragraph 3.12) requesting examination of the international application in response to the written opinion as established by the International Searching Authority; the international preliminary report on patentability (IPRP Chapter I) has the same content as the written opinion established by the International Searching Authority.

3.11 International Publication of the international application, the international search report portion of the IPRP Chapter I, and any amendments to the application received by the International Bureau of WIPO, in conformance with the Treaty, takes place at 18 months from the priority date. The Publication is on paper, on DVD and is also available on the WIPO website

3.12 Optionally, at the request of the applicant by filing a "demand" (Chapter II of the PCT), an international preliminary examination conducted by a International Preliminary Examining Authority (for Egyptian applicants, the available authorities are same as the International Searching Authorities mentioned above), in which the examiner at the authority further considers the issues of novelty, inventive step and industrial application, taking into account any comments or amendments allowed during the PCT process from the applicant; this concludes with the establishment of an international preliminary examination report, which is entitled "International Preliminary Report on Patentability (IPRP Chapter II)" Though Chapter II of the PCT was used by more than 80% of PCT applicants in the past, today it is used by only about 10% of applicants since changes to the PCT regulations came into effect at the start of 2003 making the use of Chapter II much less interesting to most applicants;

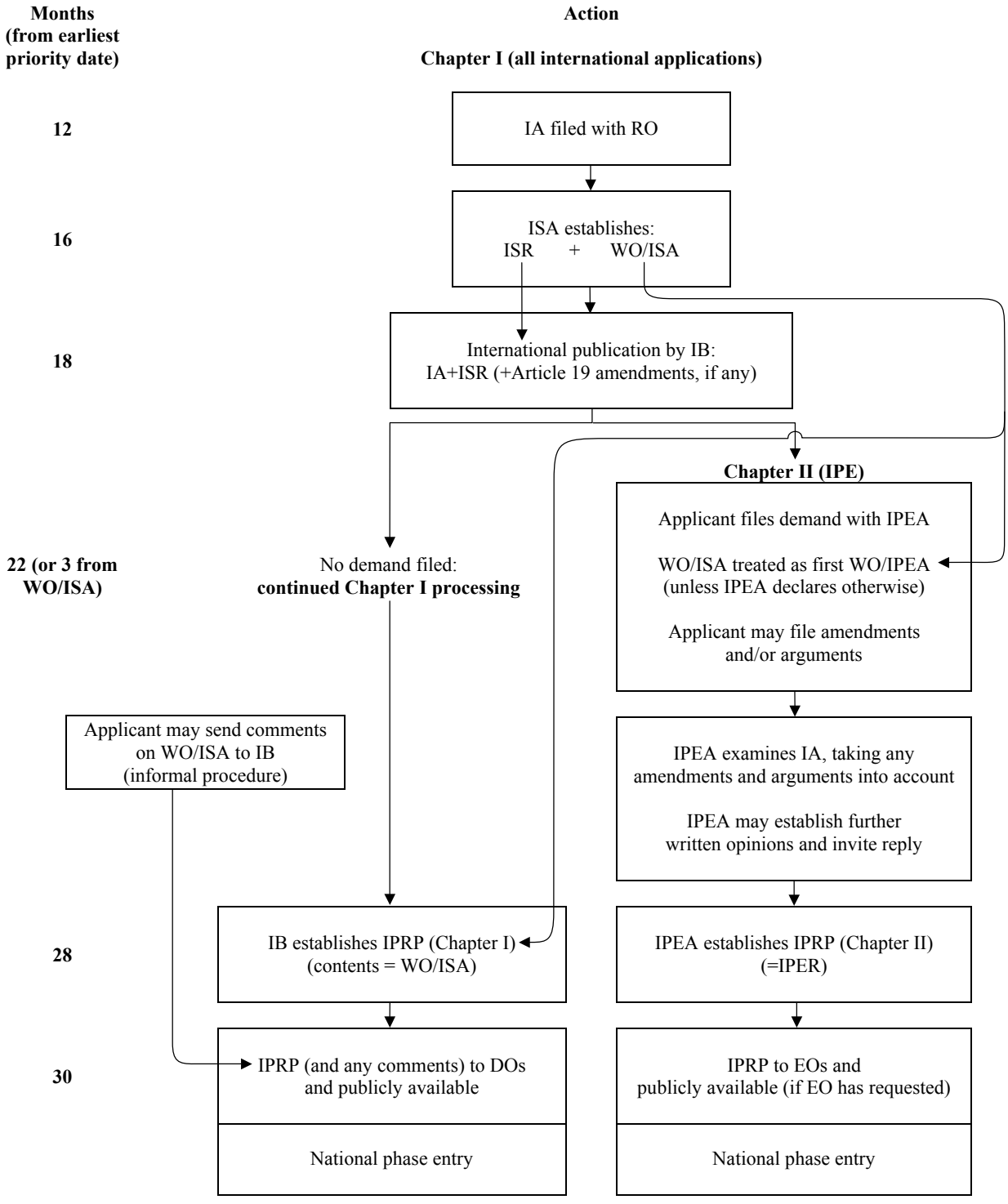
THE PCT NATIONAL PHASE

3.13 After 30 months (the time limit in Egypt, though other countries can have different periods – see Note above in paragraph 3.06) from the priority date of the application, the national phase processing in any or all designated Offices may (at applicants option) begin. This is the procedure which actually leads to the grant, or refusal, of a patent according to the relevant national law or regional arrangement. While the national and regional Offices may not make further requirements beyond those of the Treaty and Regulations in respect of matters of form and contents, they are not bound by the Treaty to follow the results of any international search or examination which has been performed when the application is examined during the national phase in Egypt.

3.14 Upon request by a designated national patent Office (for example, the Egyptian Patent Office), the International Bureau of WIPO distributes documents to that Office to support the examination process. These would include copies of the application, any amendments which have been filed and an international preliminary report on patentability, comprising either the contents of the written opinion by the International Searching Authority (IPRP Chapter I) or, where established, the international preliminary examination report (IPRP Chapter II).

3.15 The above process is only a summary of the PCT with special emphasis on Egypt. The PCT is a process which allows for much flexibility and there applicants and potential applicants wishing to use the PCT system should look into it in greater detail. For more information on the PCT procedure see the PCT portal of the WIPO website: http://www.wipo.int/pct/en/

3.16 A Summary of the PCT Process as it applies to Egypt is shown in the following diagram:



RO	receiving Office
IB	International Bureau
ISA	International Searching Authority
IPEA	International Preliminary Examining Authority
DO	designated Office
EO	elected Office

IA	international application
ISR	international search report
WO/ISA	written opinion of the ISA
WO/IPEA	written opinion of the IPEA
IPE	international preliminary examination
IPRP	international preliminary report on patentability
IPER	international preliminary examination report

PATENT APPLICATION PROCESSING BEFORE THE EGYPTIAN PATENT OFFICE

3.17 This section of the chapter gives an overview of the search and examination activities of the Egyptian Patent Office. Details of these activities are set forth in the chapters of this manual and should be referred to for more complete explanations.

3.18 There are three different methods for filing of patent applications at the Patent Office. The first is a national application filed directly with the Egyptian Patent Office where there is no priority claimed to an earlier application filed in another country (i.e. no Paris Convention priority) nor has it been processed through the PCT international phase as described above. These applications are mostly filed by Egyptian applicants. A description of the required content of the applications is set forth in Chapter 4 of this manual

3.19 The second, and most common method of filing patent applications at the Egyptian Patent Office is by the PCT national phase entry procedure (see above) since Egypt became a party to the PCT (on September 6, 2003). This is not true just of Egypt but for most countries in the world since the number of PCT international application filed worldwide is reaching new record numbers almost every year. The PCT has become the preferred method of most applicants for filing patent applications when patent protection is sought in multiple countries.

3.20 The third method of filing application in Egypt is in accordance with the Paris Convention. This convention allows applicants one year from the date they filed a first application to file other applications for the same subject matter in other Paris Convention member countries and these later filed applications will be accorded the same “effective filing date” in the second country as in the first filed country. Details on priority and its importance are set forth in Chapter 6 of this Manual.

3.21 In any event, when the application is filed at the Egyptian Patent Office by any of these three methods, it is the Protection of Intellectual Property Rights Law and regulations of Egypt which dictate whether an applicant is entitled to patent protection in Egypt. Since Egypt is party to numerous international treaties, conventions and agreements, the Patent Office is at times governed by these.

3.22 The first step after the filing of the patent application in Egypt is the legal examination of the application. This ensures that the application is complete and the formalities are in order before the application is passed to the technical examiners. The details of this are set forth in Chapter 2 of this Manual.

3.23 Applications will sit in queues (called dockets) until they come up for action before the technical patent examiner. The amount of time the applications sit in these queues varies based on a variety of factors including the filing date in Egypt, the technology it is assigned and the number of technical examiners available to work on particular technologies. It is a goal of the Patent Office to add resources to reduce the amount of time an applicant must await a decision on patentability to the minimum amount possible. Egyptian Law however does set a period of at least one year before publication of patent applications acceptance (Law Article 19). The Patent Office is free to examine applications before this year period has expired, but not publish the acceptance of the application until expiration of the year. For PCT applications entering the national phase in Egypt, this one year period begins as of the date of filing of the PCT international application. Therefore, in most instances the one year period has expired before the national phase entry in Egypt and therefore the Patent Office can at any time begin the legal and technical examination processes.

3.24 Egyptian Patent law allows for two types of patent protection. The first is a patent of invention having a 20 year term from the filing date in Egypt and the second is a Utility Model which has a 7 year term. The difference between the two is that an invention patent requires that the invention be novel (Chapter 12), have inventive step (Chapter 13), and be industrially applicable (Chapter 14), while a Utility model need only have novelty and to be industrially applicable.

3.25 The process the technical examiner follows is to:

1) Read and understand the technical disclosure (both the written specification and any drawings) of the application to be able to fully understand what applicant intends as his invention;
2) Determine that the disclosure is adequate to allow one of ordinary skill in the art to which the invention pertains or most closely relates to make and use the invention
3) Read and ascertain the scope of the claims. This is most important since the patent application claims define the scope of the patent coverage of any patent.
4) Determine if the claims actually set forth an invention and if there is an invention whether it is excluded from patentability in Egypt. (Even if an invention received a search and preliminary examination by a PCT Authority or in another country's patent office, it is still Egyptian Law, consistent with TRIPS, which controls whether applicant is entitled to have patent protection in Egypt)
5) Determine if there is more than one invention in the application (i.e. is there unity of invention).
6) Review the cited prior art references to help ascertain the field of invention, or the closest field of invention, to which the invention relates.
7) Outline the field of search. That is, using the International Patent Classification (IPC) determine which patent classifications relate to the claimed invention and where the examiner could reasonably expect to find prior art which relates closely to the claimed invention
8) Conduct a search of the prior art to determine which references relate closely to the claimed invention and can be used by the examiner to decide if the claimed invention is novel and involves inventive step
9) Review the references found in the search, cited by the applicant in his statement of the prior art in the application, or were part of a PCT or any other search report brought to the attention of the office, to deicide which prior art references should be used to either reject the claims or to show that the claims define a patentable invention
10) Write a reasoned report as to novelty, inventive step (patents of invention only) and industrial applicability.
11) Pass the opinion to the legal examiners for preparation of the letter to the applicant.

3.26 After this point the process can diverge depending on the findings of the examiner and the needs of the applicant. If the examiner finds all of the claims to be patentable, the application is accepted and notification of this acceptance is published giving the public time to oppose the grant of a patent. If one or more of the claims is rejected by the examiner, the applicant may choose to amend the application to put it condition for possible acceptance, or appeal from the examiner's decision to the Appeals Committee. Details on the processing of applications can be found in Chapters 16 and 20.

3.27 The Internet Website of the Egyptian Patent Office (www.egypo.gov.eg/) sets forth information on the filing of patent applications in Egypt.

CHAPTER 4
CONTENT OF THE APPLICATION

GENERAL

4.01 The content of an application necessary for the filing of an application are set forth in Article 13 of the Law and Article 3 of the Regulations. These are set forth here

Law Article 13.

The patent application shall be accompanied by a detailed description of the invention, including a full statement of the subject matter and of the best way to enable a person of expertise to execute it, and of each product or method for which protection is sought.

The description shall also include in a clear manner the new claims for which the applicant seeks protection accompanied, where necessary, by an illustrative drawing of the invention.

Where the invention involves biological, plant or animal product, or traditional medicinal, agricultural, industrial or handicraft knowledge, cultural or environmental heritage, the inventor should have acquired the sources in a legitimate manner.

Where the invention involves micro-organisms, the applicant shall disclose the identity of such organisms and deposit a live culture thereof with the authority designated in the Regulations.

Without prejudice to the provisions of Article 38 of this Law, the applicant shall, in all cases, provide full data and information on any applications relating to the same invention or its subject matter, that he previously filed abroad, as well as the outcome of such applications.

The Regulations shall determine the required annexes to be attached to the patent application, the time limits for their submission and as well as the conditions justifying its refusal.

Regulations Article 3.
The patent application shall be accompanied by:

1. A fully detailed description, in Arabic, of the invention or utility model, prepared in a clear manner, using correct technical terms, including a statement on prior art and shortcomings therein, the novel element in the invention or utility model and the best way known by the inventor, to enable a person of expertise to execute it, showing also, in a precise and clear manner, the new claims for which protection is sought, and indicating any chemical equations or formulae or illustrative drawings.

   The applicant shall furnish, on the form established to that effect, full data and information on applications filed abroad for the same invention or utility model or any relevant information, the fate of such applications, and resulting decisions.

2. An abstract describing the invention or utility model in the Arabic and English languages, with chemical formulae, if any, using the form established to that effect.

3. Where the application relates to an invention or utility model involving plant or animal biological material, traditional medicinal, agricultural, industrial or handicraft knowledge, or cultural or environmental heritage, it shall be accompanied by documentation proving that the inventor has accessed the source from which the material was obtained in a legitimate manner, according to the legislation applicable in the Arab Republic of Egypt.
4. Where the invention involves microorganisms, the applicant shall disclose such organisms according to conventional scientific rules, including all necessary information for the identification of the nature, characteristics and uses of such organisms, shall deposit a live culture thereof with a laboratory authorized by decision of the competent minister for scientific research affairs, and shall furnish a certificate to the effect that such deposit was made.
5. Where the applicant is a legal entity, an extract from the commercial register or an official copy of the constitution act or decision shall be furnished.
6. Documentation establishing the quality of the applicant.
7. Documentation establishing, where applicable, the assignment by the right holder of the invention or utility model.
8. Certificate of temporary protection for the invention or utility model, if any.
9. Receipt of payment of the application fees.

DESCRIPTION

4.02 The application must include a full detailed description of the invention explained in an explicit manner…. which enables a person of expertise to execute it. The meaning of "person of expertise" is the same as a "person of skill in the art" as discussed in paragraph 13.11. This requirement of disclosure should be met by the description with the aid of drawings, if any. The purposes of these provisions are:

(i) to ensure that the application contains all the technical information required to enable a skilled person to put the invention into practice; and

(ii) to enable the reader to understand the contribution to the art which the inventor has made.

4.03 Reserved.

TECHNICAL FIELD

4.04 The application should specify the technical field to which it relates.

PRIOR ART

4.05 The description should also mention any background prior art of which the applicant is aware, and which can be regarded as useful for understanding the invention and its

relationship to the prior art; identification of documents reflecting such art, especially patent specifications, should preferably be included. This applies in particular to the background art corresponding to those technical features of the invention which are necessary for the definition of the claimed subject matter but which, in combination, are part of the prior art (see paragraph 5.05).

DISCLOSURE OF INVENTION

4.06 The invention as claimed should be disclosed in such a way that the technical problem, or problems, with which it deals can be appreciated and the solution can be understood. To meet this requirement, only such details should be included as are necessary for clearly explaining the invention. Where the invention lies in realizing what the problem is (see chapter 13), this should be apparent, and, where the means of solving the problem (once realized) are obvious, the details given of its solution may, in practice, be minimal.

4.07 When there is doubt, however, as to whether certain details are necessary, the examiner should not require their deletion. It is not necessary, moreover, that the invention be presented explicitly in problem and solution form. Any advantageous effects which the applicant considers the invention to have in relation to the prior art should be stated, but this must not be done in such a way as to disparage any particular prior product or process. The prior art nor the applicant's invention cannot be referred to in a manner likely to mislead. This might be done, for example, by an ambiguous presentation which gives the impression that the prior art had solved less of the problem than was actually the case.

BRIEF DESCRIPTION OF DRAWINGS

4.08 If drawings are included they should first be briefly described, in a manner such as: "Figure 1 is a plan view of the transformer housing; Figure 2 is a side elevation of the housing; Figure 3 is an end elevation looking in the direction of the arrow 'X' of Figure 2; Figure 4 is a cross-section taken through AA of Figure 1." When it is necessary to refer in the description to elements of the drawings, the name of the element should be referred to as well as its number, that is, the reference should not be in the form "3 is connected to 5 via 4" but "resistor 3 is connected to capacitor 5 via switch 4."

4.09 The description and drawings should be consistent with one another, especially in the matter of reference numbers and other signs (see paragraph 4.28). However, where, as a result of amendments to the description, whole passages are deleted, it may be tedious to delete all superfluous references from the drawings and in such a case the examiner need not pursue too rigorously the consistent use of reference signs as between the description and the drawings. The reverse situation should not occur, that is, all reference numbers or signs used in the description or claims should also appear on the drawings.

PREFERRED EXECUTION METHOD

4.10 The application should set forth at least the preferred method for executing the invention (sometimes known as best mode) contemplated by the applicant as required by Law Article 13, paragraph 1; this should be done in terms of examples, where appropriate, and with reference to the drawings, if any. The applicant need not point out which of their embodiments or examples they consider to be the best mode. The examiner should assume that the best mode is disclosed in the application, unless evidence is presented that is inconsistent with that assumption. It is therefore extremely rare that an objection based upon a lack of best mode would be made. For example, in an

application where there are many chemical compounds disclosed, each with a broad useful range, but no indication of preferred narrow ranges, this might indicate a lack of disclosure of a best mode. In such a case, the examiner might send a letter requesting clarification.

4.11 Reserved

SUFFICIENCY

4.12 It is the responsibility of the applicant to ensure that he supplies, when he first files his application, a sufficient disclosure, that is, one that meets the requirements of Law Article 13 in respect of the invention, as claimed in all of the claims (see paragraphs 5.43 to 5.53). If the disclosure is seriously insufficient, such a deficiency normally cannot be cured subsequently without adding new matter, that is, it cannot be cured by adding further examples or features without affecting the substance (i.e., adding new matter) as prohibited by Law Article 15. "New matter" is any information that was not included in the application as originally filed (including the description, drawings, claims, sequence listings, or any other information attached to the application as originally filed). Where the disclosure is insufficient to enable a person skilled in the art to carry out the claimed invention, the claim may also be too broad to be supported by the description and drawings. Therefore, in that case, there may be non-compliance with both the requirement concerning sufficiency under this paragraph and the requirement of support of the claims (see paragraphs 5.54 to 5.58).

4.13 Occasionally applications are filed in which there is a fundamental insufficiency in the invention in the sense that it cannot be carried out by a person skilled in the art; there is then a failure to satisfy the requirements of Law Article 13 which is essentially irreparable. Two instances thereof deserve special mention:

(a) The first is where the successful performance of the invention is dependent on chance. That is to say, a person skilled in the art, in following the instructions for carrying out the invention, finds either that the alleged results of the invention are not reproducible or that success in obtaining these results is achieved in a totally unreliable way. An example where this may arise is a microbiological process involving mutations. Such a case should be distinguished from one where repeated success is assured even though accompanied by a proportion of failures as can arise, for example, in the manufacture of small magnetic cores or electronic components; in this latter case, provided the satisfactory parts can be readily sorted by a nondestructive testing procedure, no objection necessarily arises.

(b) The second instance is where successful performance of the invention is inherently impossible because it would be contrary to well-established physical laws. This applies, for example, to a perpetual motion machine (see paragraph 14.06).

INDUSTRIAL APPLICABILITY

4.14 Refer to chapter 14 for discussion of the industrial applicability of the invention.

NUCLEOTIDE AND/OR AMINO ACID SEQUENCE LISTINGS

4.15 Where the application contains disclosure of one or more nucleotide and/or amino acid sequences, the description should contain a separate sequence listing part complying with the standard provided for in WIPO Standard 25. The sequence listing must be in

written form and optionally in computer readable form, both forms complying with WIPO Standard 25. (See Chapter 9 for information on subject matter determined by Egypt to be excludable from patenting.)

DEPOSIT OF BIOLOGICAL MATERIAL

4.16 The term "biological material" means any material containing genetic information and capable of reproducing itself or of being reproduced in a biological system. Where the application refers to biological material which cannot otherwise be described in the application to meet the sufficiency of disclosure requirements, the deposit of such material is taken into consideration when determining whether those requirements have been met. The deposit must be made in accordance with Regulations Article 3(4).

4.17 The deposit is considered part of the description to the extent that the requirements regarding sufficiency of disclosure cannot otherwise be complied with; thus the deposit would be taken into account in determining compliance with such requirements. Therefore, mere reference to the deposited material in an application may not be sufficient to replace the explicit disclosure of such material in the application in order to comply with the sufficiency of disclosure requirements. It should be noted, however, that a reference to the deposit in the application would not create the presumption that the deposit is necessary or required to comply with those requirements.

4.18 The deposit of the microbiological material for all applicants must be made in Egypt in accordance with the requirements of Regulation Article 3(4) and

> **Ministerial Decree no. (36) of 2005**
> **"Ministry of Higher Education and State for Scientific Research"**
> **February 20th, 2005**
> **Article (1)**
> Depositing a viable culture for a patent application subject related to microorganisms with any of the equipped laboratories at universities, or research institutes or centers affiliated with the Minister of State for Scientific Research; or at research institutes, centers or organizations under the Ministry of Health or the Ministry of Agriculture. A certificate for depository shall be submitted to the Patent Office and the applicant shall incur all the related costs.

One such depository is: the Microbiological Laboratory, Faculty of Agriculture, Ain Shams University.

4.19 Reserved.

4.20 Reserved.

GENERAL

4.21 Since the responsibility for a clear and complete description of the invention lies with the applicant, the examiner should exercise his discretion as to whether to object to the presentation. Also certain technically simple inventions may be fully comprehensible with the minimum of description and but slight reference to prior art.

4.22 The description should be clear and straightforward with avoidance of unnecessary technical jargon. In general, only such technical terms, signs and symbols should be used as are generally accepted in the art. Little known or specially formulated technical

terms may be allowed, provided that they are adequately defined and that there is no generally recognized equivalent. This discretion may be extended to foreign terms when there is no equivalent in Arabic. Terms already having an established meaning must not be used to mean something different, as this is likely to cause confusion. There may be circumstances where a term may legitimately be borrowed from an analogous art. Terminology and signs should be consistent throughout the application.

4.23 In the particular case of inventions in the computer field, program listings in programming languages cannot be relied on as the sole disclosure of the invention. The description, as in other technical fields, should be written substantially in normal language, possibly accompanied by flow diagrams or other aids to understanding, so that the invention may be understood by those skilled in the art. Short excerpts from programs written in commonly used programming languages can be accepted if they serve to illustrate an embodiment of the invention.

4.24 When the properties of a material are referred to, the relevant units should be specified if quantitative considerations are involved. If this is done by reference to a published standard (for example, a standard of sieve sizes), and such standard is referred to by a set of initials or similar abbreviation, it should be adequately identified in the description. The metric system of units of weight and measures should be used or, if another system is used, the units should additionally be expressed in the metric system. Similarly, temperature should be expressed in degrees Celsius or also expressed in degrees Celsius if first expressed in a different manner. Other physical values (that is, other than those having units directly derivable from length, mass, time and temperature) should be expressed in the units recognized in international practice; for example, for electric units the MKSA (Meter, Kilogram, Second, Ampere) or SI (Système International) systems should be used. Chemical and mathematical symbols, atomic weights and molecular formulae should be those in general use, and technical terms, signs and symbols should be those “generally accepted in the art.” In particular, if there are any agreed international standards in the art in question, these should be adopted wherever practicable.

4.25 The use of proper names or similar words to refer to materials or articles is undesirable insofar as such words merely denote origin or where they relate to a range of different products. If such a word is used, the product should normally be sufficiently identified, without reliance upon the word, to enable the invention to be carried out by a person skilled in the art. However, where such words have become internationally accepted as standard descriptive terms and have acquired a precise meaning (for example, “Bowden” cable, “Bellville” washer), they may be allowed without further identification of the product to which they relate.

4.26 References in applications to other documents may relate either to the background art or to a part of the disclosure of the invention. Where the reference relates to the background art, it may be in the application as originally filed or introduced at a later date. Where the reference relates directly to the disclosure of the invention (for example, details of one of the components of a claimed apparatus) then, if it is to be taken into account, it must be in the application as originally filed and clearly identify the document referred to in such a manner that the document can be easily retrieved. If matter in the document referred to is essential to understanding the invention, this matter should be incorporated into the description, because the patent specification should, regarding the essential features of the invention, be self-contained, that is, capable of being understood without reference to any other document.

4.27 Reserved

DRAWINGS

4.28 The requirements for drawings are set forth in Regulations Articles 9-13

> **Regulations Article 9.**
> The description of the invention or utility model shall contain only such chemical equations or the like as necessary.
> Where required for the clarity of the description of the invention or utility model, an illustrative drawing shall be made on a sheet in accordance with the following Articles and shall accompany that description.

The first sentence of Regulations Article 9 should be interpreted in view of the entire article, that is, a drawing is "necessary" for purposes of the first sentence if it contributes to the clarity of the description and therefore is necessary to aid in understanding the invention.

> **Regulations Article 10.**
> The drawing of the invention or utility model shall be executed on clear, white, strong and smooth drawing sheets, of good quality and medium thickness, without any coloring and capable of being clearly reproduced by photography or the like.
>
> **Regulations Article 11.**
> The size of the sheets used shall be 21 cm x 29.5 cm, and all margins shall be 2.5 cm.
>
> Consecutive numbers shall be allotted to different figures of the drawing of the invention, and sufficient space shall separate a figure from another.
>
> If necessary, more than one sheet may be used for the drawing of the invention.
>
> **Regulations Article 12.**
> In the execution of the drawings of the invention or utility model, the following rules shall be complied with:
>
> 1. Dark black ink shall be used for the lines of the drawing.
> 2. Lines shall be apparent and uniformly thick.
> 3. A minimum of hatching and shade lines shall be used without any interlineations or overlapping that would cause confusion.
> 4. The thickness of the shade lines shall not be significantly different from that of the main lines.
> 5. Parts or shades of the drawing shall not be emphasized in bold or by colorings.
> 6. The scale of the drawing shall be sufficient to show the invention or utility model in a clear manner; the drawing shall show such parts of the invention or utility model that would accomplish such purpose; The scale of the drawing of the invention or utility model shall be determined in numbers.
> 7. The title of the invention or utility model or parts thereof shall not appear in the drawing itself.

8. Figures shall be executed in an upright position with respect to the drawing sheet.

9. Letters and numbers used to indicate parts of the drawing shall be placed in a clear manner; their height shall not be less than 3 mm; the same letters and numbers shall be used in the different positions of the drawing; thin arrows shall be used to connect any letters or numbers appearing outside the drawing to the corresponding parts of the drawing.

   Such letters and numbers shall be identical to those used in the detailed description of the invention or utility model.

10. The drawing sheet shall not be folded; it shall be free from creases and cracks so as to admit reproduction by photography or the like.

Regulations Article 13.
The following data shall be indicated on the drawing sheet:

1. Word "original".
2. Name of the applicant.
3. Number of sheets containing the drawing and the consecutive number of each sheet.
4. Serial number and date and time of receipt, of the application.
5. The signature of the applicant or agent.

Such data shall be presented, according to their order of succession, in a table to the bottom right of the drawing sheet.

OTHER REQUIREMENTS

4.29 See Regulations Articles 15-18, for other requirements.

Regulations Article 15.
The Office may require that the applicant for a patent for an invention or utility model for chemical products relating to foodstuff, pharmaceuticals and agriculture furnishes two samples of such products.

The applicant shall establish a list of the samples and their nature, which shall be included in or attached to, the detailed description.

The applicant shall indicate, at the top of the detailed description of the invention or utility model, that such samples are furnished. The Office shall include such indication in the publication of the acceptance of the application, in the Gazette.

Regulations Article 16.
Samples referred to under Article 15 of these Regulations shall be furnished in flasks of a maximum height of 8 cm and external diameter 4 cm. The flasks shall be tightly sealed with red wax and labeled with a card indicating the relationship between the sample and production referred to in the description of the invention. Such card shall be affixed to or suspended on the flask; in which case, it shall have a length not exceeding 10 cm and width 8 cm.

Regulations Article 17.
If the invention relates to a colorant, a sample thereof shall be furnished in accordance with Articles 15 and 16 of these Regulations. Such sample shall be accompanied by specimens of products printed or colored by that colorant. Such specimens shall have, to the extent possible, an even surface, and shall be fixed on cards of 33 cm x 21 cm. Such cards shall contain a detailed statement describing the printing or dying process and, particularly, the composition of various solutions, degree of concentration, temperature, time required for each process, and capacity of color absorption by the dye. The said cards shall also indicate the percentage of colorant fixed in the dyed material, the composition of the printing paste, and a statement indicating the relation between the colorant used for printing or dyeing, and the relevant particulars in the description of the invention or utility model.

Where the sample contains toxic, caustic, explosive or inflammable substance, an indication to that effect shall be made on the label.

Regulations Article 18.
If the Patent Office finds that the invention or utility model can be exploited in a prejudicial manner to national security, in contradiction with public order or morality, or in causing serious damage to the environment or damage to the life or health of humans, animals or plants, the decision by the Office to accept the application shall be subject to a waiver by the person concerned to use the invention in any such sort of exploitation.

CHAPTER 5
CLAIMS

GENERAL

5.01 The patent application must contain one or more claims as required by Regulation Article 3(1).

The claims must:

define the matter for which protection is sought;
be clear and concise; and
be fully supported by the description.

This chapter sets out the appropriate form and content of the claims, together with how they should be interpreted for the purposes of assessing the novelty and inventive step of the inventions which they define, and searching for prior art which may be relevant to making that determination.

FORM AND CONTENT OF CLAIMS

5.02 The claims must be drafted in terms of the technical features of the invention. This means that claims should not contain any statements relating, for example, to commercial advantages or other non-technical matters, but statements of purpose should be allowed if they assist in defining the invention. It is not necessary that every feature should be expressed in terms of a structural limitation. The examiner should normally not object to the inclusion of functional limitations in a claim provided that a person skilled in the art would have no difficulty in providing some means of performing this function without exercising inventive skill or that such means are fully disclosed in the application concerned. A functional limitation must be evaluated and considered, just like any other limitation of the claim, for what it fairly conveys to a person skilled in the art in the context in which it is used. Claims to the use of the invention in the sense of the technical application thereof are permissible. See paragraph 5.21.

5.03 The claims should be in two-part form whenever appropriate.

The first part should contain a statement indicating the designation of the subject matter of the invention, that is, the general technical class of apparatus, process, etc., to which the claimed invention relates, followed by a statement of those technical features which are necessary for the definition of the claimed subject matter but which, in combination, are part of the prior art. It is clear from this wording that it is necessary only to refer to those prior art features which are relevant to the invention. For example, if the invention relates to a photographic camera but the claimed inventive step relates entirely to the shutter, it would be sufficient for the first part of the claim to read: “A photographic camera including a focal plane shutter having...” (here recite the known combination of features which is utilized) and there is no need to refer also to the other known features of a camera such as the lens and viewfinder.

The second part or “characterizing portion” should state the technical features which, in combination with the features stated under the first part, it is desired to protect, that is, the features which the invention adds to the prior art. If the search results, or any additional documents considered to be relevant, reveal that any feature in the second part of the claim was, in fact, already known in combination with all the features in the first part of the

claim and in that combination have the same effect as they have in the full combination according to the claimed invention, the examiner may invite the applicant to transfer such feature or features to the first part. Where, however, a claim relates to a novel combination, and where the division of the features of the claim between the prior art part and the characterizing part could be made in more than one way without being inaccurate and if the division of the features is chosen by the applicant, the examiner should not require the applicant to rewrite the claims in the two-part format.

5.04 The applicant may be invited to follow the above two-part formulation where, for example, it is clear that the applicant's invention resides in a distinct improvement in an old combination of parts or steps. However, if the nature of the invention is such that this form of claim is unsuitable, for example, because it would give a distorted or misleading picture of the invention or the prior art, then its use should not be required.

Examples of the kind of invention which may require a different presentation are:

(i) the combination of known elements or steps of equal status, wherein the inventive step lies solely in the combination;
(ii) the modification of, as distinct from addition to, a known chemical process, for example, by omitting one substance or substituting one substance for another; and
(iii) a complex system of functionally interrelated parts, the inventive step concerning changes in several of these parts or in their interrelationships.

5.05 In examples (i) and (ii), the two-part form of claim may be artificial and inappropriate, whereas, in example (iii), it might lead to an inordinately lengthy and involved claim. Another example in which the two-part form of claim may sometimes be inappropriate is where the claimed invention is a new chemical compound or group of compounds that does not fall within a known class. It is also likely that other cases will arise in which it will be appropriate to formulate the claim in a different form.

5.06 When determining whether or not to invite the applicant to put a claim in the two-part form, it is important to assess whether this form is "appropriate." In this respect, it should be borne in mind that the purpose of the two-part form of claim is to allow the reader to see clearly which features necessary for the definition of the claimed subject matter are, in combination, part of the prior art. If this is sufficiently clear from the indication of prior art provided in the description, to meet this requirement, it is appropriate to present the claim in a form other than the two-part form.

5.07 The claim, as well as the description, may contain chemical or mathematical formulae but not drawings. Any claim may contain tables but only if the subject matter of the claim makes the use of tables desirable. In view of the use of the word "desirable," the examiner should not object to the use of tables in claims where this form is convenient.

5.08 The claims must not, in respect of the technical features of the invention, rely on references to the description or drawings except where absolutely necessary. In particular, they must not normally rely on references such as: "as described in part ... of the description" or "as illustrated in Figure 2 of the drawings." Thus, the applicant should be invited to delete the reference or show that it is absolutely necessary to rely on reference to the description or drawings in appropriate cases. An example of an exception would be that in which the invention as claimed involved some peculiar shape illustrated in the drawings but which could not be readily defined either in words or by a simple mathematical formula. Another special case is that in which the invention relates to chemical products whose features can be defined only by means of graphs or diagrams.

5.09 If there are drawings and the technical features of the claims would be rendered more intelligible by relating those features to the corresponding features of the drawings, this

should preferably be done by placing the appropriate reference signs in parentheses () after the features in the claims. These reference signs are not, however, to be construed as limiting the scope of a claim, but merely as aids to an easier understanding of the defined subject matter.

KINDS OF CLAIM

CATEGORIES

5.10 There are two basic kinds of claim, that is., claims to a physical entity (product or apparatus) and claims to an activity (process of making or using a product or apparatus). The first basic kind of claim ("product claim") includes a substance or composition (for example, chemical compound or a mixture of compounds) as well as any physical entity (for example, object, article, apparatus, machine, or system of cooperating apparatus) which is produced by a person's technical skill. Examples are "steering mechanism incorporating an automatic feedback circuit...;" "a woven garment comprising ...;" "an insecticide consisting of X, Y, Z;" or "a communications system comprising a plurality of transmitting and receiving stations." The second basic kind of claim ("process claim") is applicable to all kinds of activities in which the use of some material product for effecting the process is implied; the activity may be exercised upon material products, upon energy, upon other processes (as in control processes) or upon living things (see, however, paragraphs 9.04 to 9.15 which relate to subjects that may be excluded from search and examination).

5.11 It should be noted that claims which are worded differently may, in reality, fall within the same category and have effectively the same scope. For example, a claim referring to a "system" and a claim referring to "apparatus" may both be in the "apparatus" category. It should be further noted that it is permitted to include in the same application claims of the said different categories provided that they comply with the requirement of having unity of invention. The examiner should bear in mind that the presence of such different claims may assist an applicant in later obtaining full protection for the invention. Consequently, while the examiner should draw attention to an unnecessary proliferation of independent claims (see paragraph 5.42), he should not adopt an over-academic or rigid approach to the presence of a number of claims which are differently worded but apparently of similar effect.

5.12 The determination whether a group of inventions is so linked as to form a single general inventive concept shall be made without regard to whether the inventions are claimed in separate claims or as alternatives within a single claim. This means that while the examiner should take exception to an unnecessary proliferation of independent claims, the examiner should not take exception to two or more independent claims in the same category, provided that there is a unifying inventive concept and that the claims as a whole satisfy the requirement that they should be concise (see paragraph 5.42). In applying this principle, the examiner should have regard to the remarks made in paragraph 5.13 concerning claims of apparently similar scope. However there are other circumstances where it may not be appropriate to cover the subject matter of an invention by a single independent claim in a particular category, for example,

(1) Where the invention relates to an improvement in two separate but interrelated articles, which may be sold separately, such as an electric plug and socket or transmitter and receiver,

(2) Where an invention is concerned with electrical bridge-rectifier circuits, it might be necessary to include separate independent claims to a single-phase and to poly-

phase arrangements incorporating such circuits since the number of circuits needed per phase is different in the two arrangements,

(3) Where the invention resides in a group of new chemical compounds and there are a number of processes for the manufacture of such compounds.

INDEPENDENT AND DEPENDENT CLAIMS

5.13 All patent applications will contain one or more independent main claims directed to the essential features of the invention. Any such claim may be followed by one or more claims concerning specific forms of that invention. It is evident that any claim relating to a specific form must effectively include also the essential features of the invention, and hence must include all the features of at least one independent claim. The specific forms should be construed broadly as meaning any more specific definition or specifically different embodiments of the invention than that set out in the main claim or claims. It should be noted that it is permitted to include a reasonable number of dependent claims claiming specific forms of the claimed invention in the independent claim, even where the features of any dependent claim could be considered as constituting in themselves an invention.

5.14 Any dependent claim must include a reference to the claim from which it depends, and must be construed as including all the limitations contained in the claim to which it refers. A multiple dependent claim includes all the limitations contained in the particular claim in relation to which it is considered. A dependent claim which refers to more than one other claim should refer to them only alternatively. Multiple dependent claims cannot form a basis for other multiple dependent claims.

5.15 All dependent claims, however referred back, should be grouped together to the extent and in the most practical way possible. The arrangement must therefore be one which enables the association of related claims to be readily determined and their meaning in association to be readily construed. The examiner should invite the applicant to submit a suitable amendment if the arrangement of claims is such that it creates obscurity in the definition of the subject matter to be protected.

5.16 A claim, whether independent or dependent, can contain alternatives, provided those alternatives are of a similar nature and can fairly be substituted one for another, and provided also that the number and presentation of alternatives in a single claim does not make the claim obscure or difficult to construe (see also paragraphs 10.09 and 10.17).

5.17 A claim may also contain a reference to another claim even if it is not a dependent claim. One example of this is a claim referring to a claim of a different category (for example, “Apparatus for carrying out the process of Claim 1 ...,” or “Process for the manufacture of the product of Claim 1 ...”). Similarly, in a situation like a plug and socket example, a claim to the one part referring to the other cooperating part, for example, “plug for cooperation with the socket of Claim 1 ...,” is not a dependent claim as it does not expressly contain the limitations of the earlier claim from which it depends; rather, it only has a functional relationship to that earlier claim.

INTERPRETATION OF CLAIMS

5.18 Claims should be interpreted the same way for both search and examination purposes. Each claim should be read giving the words the ordinary meaning and scope which would be attributed to them by a person skilled in the relevant art, unless in particular cases the description gives the words a special meaning, by explicit definition or otherwise The claim should also be read with an attempt to make technical sense out of it. Such a reading may involve a departure from the strict literal meaning of the wording of the claims.

"USE" CLAIMS

5.19 A claim to a new substance or composition for a particular use should generally be construed as meaning a substance or composition which is in fact suitable for the stated use. This should be differentiated from a claim which sets forth definite process steps for using the substance or composition. If the examiner discovers prior art wherein the substance or composition is the same as the claimed invention and it only differs as to the intended use of the substance or composition, the examiner may reject the claim indicating to the applicant that the intended use of the claim is given no patentable weight. However, the examiner must ensure that the claimed substance or composition is the same as that of the prior art and such analysis includes not just the chemical structures but also other characteristics of the substance or composition. These other characteristics include the state (for example, liquid or gas), the stability, the viscosity and other factors such as whether it is crystalline or powder. See also paragraph 5.22.

INTRODUCTION (PREAMBLE) TO THE CLAIM

5.20 A claim often has an introduction, or preamble, that signals to the reader the subject matter being claimed. The effect of the introduction on the evaluation of the elements of a claim for search and examination purposes should be determined on a case by case basis in light of the facts in each case. During search and examination, statements in the introduction reciting the purpose or intended use of the claimed invention must be evaluated to determine whether the recited purpose or intended use results in a structural difference (or, in the case of process claims, a difference in process steps) between the claimed invention and the prior art. If so, the recitation serves to limit the claim. In two-part claims, the introduction is regarded as a limitation on the scope of the claim.

5.21 If a claim commences with such words as "Apparatus for carrying out the process, etc., ..." this must be construed as meaning merely apparatus suitable for carrying out the process. An apparatus which otherwise possesses all of the features specified in the claim, but which would be unsuitable for the stated purpose or which would require modification to enable it to be so used, should not be used to reject the claim for lack of novelty. For example, a claim recites a machine for cutting meat comprising apparatus limitations. The claim language "machine for cutting meat" sets forth only the function of the apparatus (that is, for cutting meat) without any positive structural limitations. Such language would not be given any weight in assessing novelty and inventive step as long as the prior art cutting machine was capable of cutting meat. In this case, one should treat the words "for cutting meat" merely as limiting the claim to a machine adapted to cut meat. Thus, one would look to the prior art to see whether the cutting machine would be inherently capable of cutting the meat, whether or not the prior art description specified what material is cut by the machine. Similar considerations apply to a claim for a product for a particular use. For example, if a claim refers to "mold for molten steel," this implies certain limitations for the mold. Therefore, a plastic ice cube tray with a melting point much lower than that of steel would not be suitable for use as a mold for molten steel and could not be used to reject the claim for lack of novelty.

OPEN AND CLOSED CLAIMS

5.22 In evaluating novelty or inventive step, the examiner should take note of which type of the transition phrase, such as "consisting of," "comprising," "characterized by," or "consisting essentially of" is used in the claims. The subject matter to be searched depends on the type of transition phrase used.

(a) Where a claim is drafted using a "closed" type of transition phrase (for example, "consisting of"), the claim cannot be construed as including products or processes that include structural elements or process steps other than those set forth in the claim. For example, if a claim recites "a product consisting only of A, B and C," it cannot be construed as including, and is novel over, prior art that discloses a product having A, B, C and D, or any other additional feature or elements.

(b) Where a claim is drafted using an "open" type of transition phrase (for example, "comprising", "including", "containing", "characterized by"), it can be construed as including products or processes that include non-recited components or process steps, respectively. For example, if a claim recites "a product comprising A, B and C," it can be construed as including, and lacks novelty over, prior art that discloses a product having A, B, C and D, as well as any additional feature or element.

(c) Where a claim is drafted using "consisting essentially of" or "composed of" as the transition phrase, the claim occupies a middle ground between closed claims that are written in a closed format and fully open claims. These transitional phrases limit the scope of a claim to the specified materials or steps and those that do not materially affect the basic and novel characteristic(s) of the claimed invention. For the purposes of search and examination, absent a clear indication in the description or claims of what the basic and novel characteristics actually are, these transitional phrases will be construed as equivalent to open (for example, "comprising") language.

MEANS PLUS FUNCTION CLAIMS

5.23 Where a limitation in the claim defines a means or a step in terms of its function or characteristics without specifying the structure or material or act in support thereof, such a limitation should be construed as defining any structure or material or act which is capable of performing the defined function or which has the defined characteristics, unless the means are further specified in the claim. If the means are further specified, the claim would be interpreted to include those further specified limitations. For example, if a claim recites valve means for restricting the flow of fluid, it would be interpreted by the examiner to include the further specified limitation of a valve means rather than any means for restricting flow of fluid. As another example, a claim aimed at "a building material incorporating a layer which insulates heat" should be interpreted as a building material incorporating any "product" that is "a layer which insulates heat." It should be noted, however, that the issues of whether such means-plus-function claims are clear and concise and whether the disclosure of the claimed invention is sufficient for a person skilled in the art should be determined separately.

PRODUCT BY PROCESS CLAIMS

5.24 Where a claim defines a product in terms of the process by which the product is made, the claim should be construed as a claim to the product by itself and that product possesses the characteristics derived from the manufacturing process stated in the claim. Therefore, the patentability of a product defined by a product-by-process claim does not depend on its method of production. A product is not rendered novel merely by the fact that it is produced by means of a new process. If the product in such a claim is the same as, or obvious from, a product described in an item of prior art, the claim is unpatentable even though the product described in the item of prior art was made by a different process.

5.25 Where a product can only be defined by the process steps by which the product is made, or where the manufacturing process would be expected to impart distinctive characteristics on the final product, the examiner would consider the process steps in determining the subject of the search and assessing patentability over the prior art. For example, a claim recites "a two-layer structured panel which is made by welding together an iron sub-panel and a nickel sub-panel." In this case, the process of "welding" would be considered by the examiner in determining the subject of the search and in assessing patentability over the prior art since the process of welding produces physical properties in the end product which are different from those produced by processes other than welding; that is, the product can only be defined by the process step. Novelty of the claim is not brought into question unless an identical two-layer structural panel made by means of welding is discovered in the prior art.

PRODUCT AND APPARATUS LIMITATIONS IN PROCESS CLAIMS

5.26 Product and apparatus limitations that appear in process claims must be taken into account for search and examination purposes. See paragraph 5.22 for the effect of the introductory phrase on claim interpretation.

INCONSISTENCY BETWEEN CLAIMS AND DESCRIPTION

5.27 Where there is any serious inconsistency between claims and description, amendments to remove this should be invited from the applicant. For example, the description may state, or may imply, that a certain technical feature not mentioned in the claims is essential to the performance of the invention. In such a case, the examiner should invite amendment of the claims to include this feature. However, if the applicant can show convincingly by way of response that it would be clear to a person skilled in the art that the description was incorrect in suggesting that the feature in question was essential, amendment of the description should be invited instead. Another form of inconsistency is that in which the description and drawings include one or more embodiments of the invention which appear to fall outside the subject matter covered by the claims (for example, the claims all specify an electric circuit employing electronic tubes and one of the embodiments employs semiconductors as an alternative). Here again the applicant should be invited to amend the claim or the description and drawings to remove the inconsistency and thus avoid any possible uncertainty which could arise later as to the meaning of the claims. However, inconsistencies which do not cause doubt as to the meaning of the claims may be overlooked.

5.28 General statements in the description which imply that the extent of protection may be expanded in some vague and not precisely defined way should be objected to. In particular, objection should be raised to any statement which refers to the extent of protection being expanded to cover the "spirit" of the invention. Where the claims are directed to a combination of features only, any statement in the description which seems to imply that protection is nevertheless sought not only for the combination as a whole but also for individual features or sub-combinations thereof should be objected to.

CLARITY

5.29 The requirement that the claims should be clear applies to individual claims and also to the claims as a whole. The clarity of the claims is of the highest importance for the purposes of formulating an opinion on the questions of whether the claimed invention appears to be novel, to involve an inventive step and to be industrially applicable in view of their function in defining the matter for which protection is sought. Therefore the meaning of the terms of

a claim should, as far as possible, be clear for the person skilled in the art from the wording of the claim alone (see also paragraph 5.20).

5.30 Each claim must set forth the scope of the invention sought to be protected with a reasonable degree of clarity. Clarity of claim language must be analyzed in light of the content of the particular application disclosure, the teachings of the prior art, and the claim interpretation that would be given by the person skilled in the art at the time the invention was made. If a person skilled in the art can determine the boundaries of the claimed invention with a reasonable degree of certainty, the claim complies with the requirement for clarity. If the scope of the subject matter embraced by the claims is clear, and if the applicant has not otherwise indicated that he intends the invention to be of a scope different from that defined in the claims, then the claims comply with the requirement for clarity.

5.31 An independent claim should clearly specify all of the essential features needed to define the invention except insofar as such features are implied by the generic terms used, for example, a claim to a “bicycle” does not need to mention the presence of wheels. If a claim is to a process for producing the product of the invention, then the process as claimed should be one which, when carried out in a manner which would seem reasonable to a person skilled in the art, necessarily has as its end result that particular product; otherwise, there is an internal inconsistency and therefore lack of clarity in the claim. In the case of a product claim, if the product is of a well-known kind and the invention lies in modifying it in a certain respect, it is sufficient if the claim clearly identifies the product and specifies what is modified and in what way. Similar considerations apply to claims for an apparatus.

CLARITY OF RELATIVE TERMS

5.32 A claim that includes vague or equivocal forms of wording which leave the reader in doubt as to the scope of a feature should be objected to for lack of clarity. A claim should not use a relative or similar term such as “thin”, “wide” or “strong” unless the term has a well-recognized meaning in the particular art, for example “high-frequency” in relation to an amplifier, and this is the meaning intended. If a term of degree (for example, terms related to amount, quantity, level) appears in a claim, the examiner should determine whether one skilled in the art would understand the meaning of the term either by a disclosure of a standard for measuring that degree in the description or in view of the prior art and state of the art. It may be appropriate to invite the applicant either to define or eliminate the term if he could do so without extending the subject matter beyond the content of the application as filed. An applicant cannot rely on an unclear term to distinguish the claimed invention from the prior art.

5.33 The area defined by the claims must be as precise as the invention allows. As a general rule, claims which attempt to define the invention, or a feature thereof, by a result to be achieved should be objected to as lacking clarity. Objection may also be raised under lack of support where the claimed scope is broader than what the description enables. However, no objection should be raised if the invention can only be defined in such terms and if the result is one which can be achieved without undue experimentation (see paragraph 5.46), for example, directly and positively verified by tests or procedures adequately specified in the description and involving nothing more than trial and error. For example, the invention may relate to an ashtray in which a smoldering cigarette end will be automatically extinguished due to the shape and relative dimensions of the ashtray. The latter may vary considerably in a manner difficult to define while still providing the desired effect. So long as the claim specifies the construction and shape of the ashtray as clearly as possible, it may define the relative dimensions by reference to the result to be achieved without being objected to for lack of clarity; provided that the description includes adequate

directions to enable the reader to determine the required dimensions by routine test procedures.

5.34 Where the invention relates to a product, it may be defined in a claim in various ways, for example., by a chemical formula, as a product of a process, or by its parameters. Definition of a product solely by its parameters may be appropriate in those cases where the invention cannot be adequately defined in any other way, provided that those parameters can be clearly and reliably determined either by indications in the description or by objective procedures which are recognized in the art. The same applies to a process related feature which is defined by parameters. This can arise, for example, in the case of macromolecular chains. Cases, in which non-art recognized parameters are employed, or a non-accessible apparatus for measuring the parameters is used, may be objectionable on grounds of lack of clarity. The examiner should be aware of the possibility that applicants may attempt to employ unusual parameters to disguise lack of novelty (see paragraph 12.04).

5.35 Where a claim for an apparatus or a product seeks to define the invention by reference to features of the use to which the apparatus or product is to be put, a lack of clarity can result. This is particularly the case where the claim not only defines the product itself but also specifies its relationship to a second product which is not part of the claimed invention (for example, a cylinder head for an engine, where the former is defined by features of where it is connected in the latter). Such a claim must either set forth a clear definition of the individual product being claimed by wording the claims appropriately (for example, by substituting “connectable” for “connected”), or be directed to a combination of the first and second products (for example, “engine with a cylinder head” or “engine comprising a cylinder head

5.36 Particular attention is required whenever the word “about” or similar terms, such as “approximately,” are used. Such a word may be applied, for example, to a particular value (for example, “about 200°C”) or to a range (for example, “about X to about Y”). In each case, the examiner should exercise judgment as to whether the meaning is sufficiently clear in the context of the application read as a whole. Moreover, if such words as “about” prevent the invention from being unambiguously distinguished from the prior art, a rejection should be raised as to lack of novelty or inventive step.

CLARITY OF OTHER TERMS

5.37 Trademarks and similar expressions characterize the commercial origin of goods, rather than the properties of the goods (which may change from time to time) relevant to the invention. Therefore the examiner should invite the applicant to remove trademarks and similar expressions in claims, unless their use is unavoidable; they may be allowed exceptionally if they are generally recognized as having a precise meaning (see also paragraph 5.34).

5.38 Expressions like “preferably,” “for example,” “such as” or “more particularly” should be looked at carefully to ensure that they do not introduce ambiguity. The examiner should regard expressions of this kind as having no limiting effect on the scope of a claim; that is to say, the feature following any such expression should be regarded as entirely optional.

5.39 Generally, the subject matter of a claim is defined by means of positive features. However, the extent of a claim may be limited by means of a “disclaimer,” a “negative limitation,” or an “exclusion;” in other words, an element clearly defined by technical features may be expressly excluded from the protection claimed, for example in order to meet the requirement of novelty. A claim may also include a negative limitation or language that

defines subject matter that is not present in the claimed invention (for example, “wherein the composition is free of water”).

There is nothing necessarily ambiguous or uncertain about a negative limitation. A negative limitation renders the claim unclear where it is an attempt to claim the invention by excluding what the applicant did not invent rather than clearly and concisely reciting what he did invent. A claim which recites the limitation “said homopolymer being free from the proteins, soaps, resins, and sugars present in natural Hevea rubber” in order to exclude the characteristics of the prior art product, is considered to be clear where each recited limitation is clear. In addition, the negative limitation “incapable of forming a dye with said oxidized developing agent” is clear because the boundaries of the patent protection sought are clear. If alternative elements are positively recited in the description, they may be explicitly excluded in the claims. The mere absence of a positive recitation is not basis for exclusion of the limitation from consideration by the examiner.

CONCISENESS, NUMBER OF CLAIMS

5.40 Claims may be objected to as lacking conciseness when they are unduly multiplied or duplicative. Claims are unduly multiplied where, in view of the nature and scope of the invention, an unreasonable number of claims are presented which are repetitious and multiplied, the net result of which is to confuse rather than to clarify. The claims should not be unduly multiplied so as to obscure the definition of the claimed invention in a maze of confusion. However, if the claims differ from one another and there is no difficulty in understanding the scope of protection, an objection on this basis generally should not be applied. In addition, claims should differ from one another. If claims are presented in the same application that are identical or else are so close in content that they both cover the same thing, despite a slight difference in wording, an objection on the basis of conciseness may be proper. However, such an objection should not be applied if the change in wording results even in a small difference in scope between the two claims. Individual claims may be objected to as lacking conciseness only when they contain such long recitations or unimportant details that the scope of the claimed invention is thereby rendered indefinite.

SUPPORT IN DESCRIPTION

5.41 The claims shall be fully supported by the description. Therefore, there must be a basis in the description for the subject matter of every claim and that the scope of the claims must not be broader than is justified by the description and drawings. If a limitation is found in a claim, but not in the description, the applicant should be required to include the limitation in the description, subject to the requirement not to introduce new matter, or to cancel it from the claims. See section 4.12.

5.42 As a general rule, a claim is regarded as supported by the description unless, exceptionally, there are well-founded reasons for believing that the person skilled in the art would be unable, on the basis of the information given in the application as filed, to extend the particular teaching of the description to the whole of the field claimed by using routine methods of experimentation or analysis. Support must, however, relate to the features of the claimed invention; vague statements or assertions having no technical or other relevant content provide no basis for a claim. The examiner should raise an objection of lack of support only if there are well-founded reasons. Where an objection is raised, the reasons, where possible, should be supported specifically by a published document.

CLEAR AND COMPLETE DISCLOSURE OF CLAIMED INVENTION

5.43 The subject matter of each claim must be supported by the description and drawings in a manner sufficiently clear and complete for the invention to be carried out by a person skilled in the art. The disclosure of the claimed invention is considered sufficiently clear and complete if it provides information which is sufficient to allow the invention to be carried out by a person skilled in the art as of the filing date (or the priority date, if priority is validly claimed to an earlier application), without undue experimentation.

5.44 The disclosure is aimed at a person skilled in the art (see paragraph 13.11). This person is considered, if necessary, to use the general knowledge which would be possessed by such a person to supplement the information contained in the application. The disclosure must be sufficient to carry out the invention on the basis of the knowledge of a person skilled in the art at the time of the filing date, not at the time of the search and examination. Although a reasonable amount of trial and error is permissible, a person skilled in the art must, on the basis of the disclosure of the claimed invention and the general knowledge, be able to carry out the invention without "undue experimentation." This is applicable particularly in the field of unexplored technologies.

5.45 Factors to be considered in determining whether undue experimentation is needed to carry out the claimed invention include:

(i) the breadth of the claims;

(ii) the nature of the invention;

(iii) the general knowledge of a person skilled in the art;

(iv) the level of predictability in the art;

(v) the amount of direction (i.e. information on how the invention is made or used) provided in the application, including references to prior art; and

(vi) the amount of experimentation required to carry out the claimed invention on the basis of the disclosure.

5.46 The breadth of the claims is relevant to the determination of undue experimentation, since a person skilled in the art must be able to carry out the entire scope of the claimed invention. For example, the applicant is not entitled to claim everything within the scope of the invention, if the application only discloses how to carry out part of the claimed invention. However, even in unpredictable arts, it is not necessary to provide examples covering every possible variation within the scope of a claim. Representative examples together with an explanation of how these can be applied to the scope of the claim as a whole will ordinarily be sufficient if a person skilled in the art could carry out the claimed invention without undue experimentation.

5.47 The subject matter to which the claimed invention pertains is essential to determine the general knowledge of a person skilled in the art and the state of the art. For example, if the selection of the values for various parameters is a matter of routine for a person skilled in the art, such a selection may not be considered as requiring undue experimentation.

5.48 "The amount of direction provided in the application" refers to the information explicitly or implicitly contained in the description, claims and drawings, including working examples and references to other applications or documents. The more that is known in the prior art by a person skilled in the art about the nature of the invention and the more the art is predictable, the less information in the application itself is needed in order to carry out the claimed invention. For example, there is predictability in the art if a person skilled in the art can readily anticipate the effect of a feature of the claimed invention.

5.49 In addition to the time and expenses needed for carrying out the experimentation, the character of the experimentation, for example, whether it constitutes merely routine work or goes beyond such routine, should also be considered.

SUFFICIENCY COMMENSURATE WITH THE CLAIMS

5.50 Most claims are generalizations from one or more particular examples. The extent of generalization permissible is a matter which the examiner must judge in each particular case in the light of the relevant prior art. An appropriate claim is one which is not so broad that it goes beyond the invention nor yet so narrow as to deprive the applicant of a just reward for the disclosure of the invention. Obvious modifications and uses of and equivalents to that which the applicant has described should not be questioned. In particular, if it is reasonable to predict that all the variants covered by the claims have the properties or uses the applicant ascribes to them in the description, it is proper for the applicant to draft the claims accordingly.

5.51 A claim in generic form that is relating to a whole class of technology, (for example, materials or machines) may be acceptable even if of broad scope, if there is fair support in the description and there is no reason to suppose that the invention cannot be carried out through the whole of the field claimed. Where the information given appears insufficient to enable a person skilled in the art to extend the teaching of the description to parts of the field claimed but not explicitly described, by using routine methods of experimentation or analysis, the examiner should invite the applicant to establish, by suitable response, that the invention can in fact be readily applied on the basis of the information given over the whole field claimed or, failing this, to restrict the claim to accord with the description. An example of this might be a claim to a specified method of treating “synthetic resin moulding” to obtain certain changes in physical characteristics. If all of the examples described related to thermoplastic resins, and the method was such as to appear inappropriate to thermosetting resins, then limitation of the claims to thermoplastic resins might be necessary to comply with the sufficiency requirement.

RELATIONSHIP OF CLAIMS TO DISCLOSURE

5.52 The claimed invention must be fully supported by the description and drawings, thereby showing that the applicant only claims subject matter which he had recognized and described on the filing date (or the priority date, if priority is validly claimed to an earlier application).

5.53 The claims are not consistent and not commensurate with the description and drawings if, after reading the application, the claimed invention is still not capable of being carried out by a person skilled in the art, because an essential element for the function or operation of the invention is missing from the claim. For example, consider a claim that relates to improved fuel oil compositions which have a given desired property. The description provides support for one way of obtaining fuel oils having this property, which is by the presence of defined amounts of a certain additive. No other ways of obtaining fuel oils having the desired property are disclosed. If the claim makes no mention of the additive, the claim is not fully supported by the description. Another example would consist in the claim not being consistent with the disclosure, for instance, due to contradictions between the elements contained in the claims and the description. One other example would be that, having regard to the description and the drawings, the scope of the claims covers an area which was not recognized by the applicant, for example, mere speculation of possibilities that have not been explored yet.

5.54 A claim may broadly define a feature in terms of its function, even where only one example of the feature has been given in the description, if the person skilled in the art would appreciate other means that could be used for the same function. For example, “terminal position detecting means” in a claim might be supported by a single example comprising a limit switch, it being apparent to the person skilled in the art that, for example, a photoelectric cell or a strain gauge could be used instead. In general, however, if the entire contents of the application are such as to convey the impression that a function is to be carried out in a particular way, with no intimation that alternative means are envisaged, and a claim is formulated in such a way as to embrace other means, or all means, of performing the function, then the claim does not comply with the requirement that the claim language have support in the description. Furthermore, it may not be sufficient if the description merely states in vague terms that other means may be adopted, if it is not reasonably clear what they might be or how they might be used.

5.55 Characterization of a chemical compound solely by its parameters may be appropriate in certain cases (see paragraph 5.36). Characterization of a chemical compound by its parameters is fully supported by the description only when the invention is described by sufficient relevant identifying characteristics which provide evidence that the applicant recognized and described the claimed invention at the time of filing, such as by a description of partial structure, physical and/or chemical properties, functional characteristics when coupled with a known or disclosed correlation between structure and function, or a combination of these characteristics.

5.56 Compliance with the sufficiency requirement and the requirement for support for the claims in the disclosure are determined independently. In some cases, where the claim is too broad to be supported by the description and drawings, the disclosure may also be insufficient to enable a person skilled in the art to carry out the claimed invention. Thus there may be non-compliance with both the requirement concerning the relationship of the claims to the disclosure and the sufficiency requirement. See paragraph 4.12.

CHAPTER 6
PRIORITY

THE RIGHT TO PRIORITY

6.01 **Based on a PCT International Application:** An international application is accorded as its international filing date the date on which it satisfies the requirements of PCT Article 11. The international filing date may be the only effective date of the international application. It will be of importance for fixing the expiration of certain time limits and for determining the state of the art relevant for the purposes of the international search and examination. PCT Article 11 provides as follows:

> **PCT ARTICLE 11**
> **FILING DATE AND EFFECTS OF THE INTERNATIONAL APPLICATION**
>
> (1) The receiving Office shall accord as the international filing date the date of receipt of the international application, provided that that Office has found that, at the time of receipt:
>
> (i) the applicant does not obviously lack, for reasons of residence or nationality, the right to file an international application with the receiving Office,
>
> (ii) the international application is in the prescribed language,
>
> (iii) the international application contains at least the following elements:
>
> (a) an indication that it is intended as an international application,
>
> (b) the designation of at least one Contracting State,
>
> (c) the name of the applicant, as prescribed,
>
> (d) a part which on the face of it appears to be a description,
>
> (e) a part which on the face of it appears to be a claim or claims.
>
> (2) (a) If the receiving Office finds that the international application did not, at the time of receipt, fulfill the requirements listed in paragraph (1), it shall, as provided in the Regulations, invite the applicant to file the required correction.
>
> (b) If the applicant complies with the invitation, as provided in the Regulations, the receiving Office shall accord as the international filing date the date of receipt of the required correction.
>
> (3) Subject to Article 64(4), any international application fulfilling the requirements listed in items (i) to (iii) of paragraph (1) and accorded an international filing date shall have the effect of a regular national application in each designated State as of the international filing date, which date shall be

considered to be the actual filing date in each designated State.

(4) Any international application fulfilling the requirements listed in items (i) to (iii) of paragraph (1) shall be equivalent to a regular national filing within the meaning of the Paris Convention for the Protection of Industrial Property.

6.02 However, in many cases, an international application will claim the right of priority of the date of filing of an earlier application. In this case, it is the priority date (that is, the filing date of the earlier application) which will be used to calculate certain time limits.

ALL PRIORITY CLAIMS

6.03 For a valid claim for priority to be effective in Egypt, several conditions must be satisfied:

The earlier application whose priority is claimed must have been made by the applicant or his predecessor in title,

It must have been filed not more than 12 months before either the filing date of the PCT international application, or the filing of a national patent application in Egypt.

It must have been filed in or for any country party to the Paris Convention for the Protection of Industrial Property or in or for any Member of the World Trade Organization that is not party to that Convention (Law Article 38).

The words “in or for” any country or Member mean that the earlier application, the priority of which is claimed, may be an earlier national, regional or international application. The earlier application may be for a patent for invention or utility model or for an inventor’s certificate. So long as the contents of the earlier application were sufficient to establish a filing date, it can be used to create a priority date, no matter what the final disposition of the earlier application may later be; for example, even if the earlier application is subsequently be withdrawn or held withdrawn.

Other conditions to be satisfied for a valid claim of priority are mentioned in paragraphs 6.04 and 6.11 to 6.17.

6.04 Normally, the application for which the priority of filing date is claimed must be the first application that has been filed for the invention. However, a subsequent application for the same subject matter as the previous first application filed in or for the same State will be considered as the first application for priority purposes if, when this subsequent application was filed, the first application had been withdrawn, abandoned or refused, without being open to public inspection and without leaving any rights outstanding, and had not served as a basis for claiming priority. The examiner will not normally consider this question unless there is clear evidence of the existence of an earlier application as, for example, in the case of a United States continuation application. Where it is clear that an earlier application for the same subject matter exists, and where the priority right is important because of intervening prior art (see paragraph 6.06), the applicant should be invited to satisfy the examiner that there were no rights outstanding in the earlier application in respect of the subject matter of the application being examined.

6.05 An application may claim rights of priority based on more than one earlier application (“multiple priorities”), even if they originate in different countries. This is based on Article 4F of the Paris Convention, which states:

F. No country of the Union may refuse a priority or a patent application on the ground that the applicant claims multiple priorities, even if they originate in different countries, or on the ground that an application claiming one or more priorities contains one or more elements that were not included in the application or applications whose priority is claimed, provided that, in both cases, there is unity of invention within the meaning of the law of the country. With respect to the elements not included in the application or applications whose priority is claimed, the filing of the subsequent application shall give rise to a right of priority tinder ordinary conditions.

The earliest application must have been filed not more than 12 months before the date of filing of the PCT international application, or filing of a national patent application in Egypt. An element of an application will be accorded the priority date of the earliest priority application which discloses it.

Example: The application describes and claims two embodiments (A and B) of an invention, A being disclosed in a French application and B in a German application, both filed within the last 12 months, the priority dates of both the French and German applications may be claimed for the appropriate parts of the application. Embodiment A will have the French priority date and embodiment B the German priority date.

It is not permitted for applicants to combine the disclosures of several priority documents to provide the basis for a single invention. An exception to this might arise where one priority document contains a reference to the other and explicitly states that features from the two documents may be combined in a particular manner.

Example: If an application is based on one earlier application disclosing a feature C and a second earlier application disclosing a feature D, neither disclosing the combination of C and D, a claim to that combination will be entitled only to the date of filing of the application itself.

DETERMINING PRIORITY DATES

6.06 As a general rule, the examiner should not make any investigation as to the validity of a right to priority. However, the priority right assumes importance if subject matter (prior art) relevant with regard to the determination of novelty or inventive step (non-obviousness) of the claimed invention:

(i) has been published on or after the priority date claimed and before the effective filing date in Egypt (for example, the filing date of a PCT application designating Egypt);

(ii) forms part of the content of a non-written disclosure, which occurred before the effective filing date in Egypt but after the priority date (but see exceptions in Law Article 3); or

(iii) forms part of the content of an application or patent, that is, an application or patent which was published on or after that date but was filed earlier than the international filing date or claimed the priority of an earlier application which was filed prior to the international filing date (see Law Article 3(i)).

In such cases (that is, cases where the art in question would be relevant if of earlier date), the examiner must satisfy himself/herself that the priority date(s) claimed may be accorded to the appropriate parts of the application he is examining and, where appropriate, will also

consider the validity of any priority date claimed for the application or patent disclosing the relevant subject matter.

6.07 When the examiner needs to consider the question of priority date, s/he should bear in mind all the matters which are mentioned in paragraphs 6.03 to 6.05. S/He should also remember that, to establish a priority date, it is not necessary that all of the elements of the invention for which priority is claimed should be found among the claims in the previous (priority) application. It is sufficient that the documents of the previous application taken as a whole specifically disclose such elements. The description and any claims or drawings of the previous application should, therefore, be considered as a whole in deciding this question, except that account should not be taken of subject matter found solely in that part of the description referring to prior art, or in an explicit disclaimer.

6.08 The requirement that the disclosure must be specific means that it is not sufficient if the elements in question are merely implied or referred to in broad and general terms. A claim to a detailed embodiment of a certain feature would not be entitled to priority on the basis of a mere general reference to that feature in a priority document. The exact terminology need not be used in the priority document and the claims. It is enough that, on a reasonable assessment, there is in substance a disclosure of the combination of all the important elements of the claim.

6.09 The basic test to determine whether a claim is entitled to the date of a priority document is that the subject matter of the claim must be explicitly or inherently disclosed in the priority document, including any implicit features (that is, expected to be known or understood) by a person skilled in the art).

Example: As an example of an implicit disclosure, a claim to apparatus including "releasable fastening means" would be entitled to the priority date of a disclosure of that apparatus in which the relevant fastening element was, say, a nut and bolt, or a spring catch or a toggle-operated latch, provided the general concept of "releasable fastening" is implicit in the disclosure of such element.

6.10 If the tests set out in paragraphs 6.07 to 6.09 are not satisfied in relation to a particular earlier application where priority is claimed, then the relevant date of the claim will either be the priority date of the earliest application (if any) which satisfies the tests and does provide the required disclosure or, in the absence of such, will be the effective filing date of the application itself, either in Egypt or of an PCT international application designating Egypt.

CLAIMING PRIORITY

6.11 An applicant who wishes to claim priority must give the particulars of the previous filing, as specified.

6.12 If a PCT international application is filed designating Egypt wherein a priority claim is made, the Patent Office shall rely in this claim during the national phase.

6.13 The prescribed form of a request for priority includes the giving of the following indications:

(i) the date on which the earlier application was filed, being a date falling within the period of 12 months preceding the international filing date;

(ii) the number of the earlier application;

(iii) where the earlier application is a national application, the country party to the Paris Convention for the Protection of Industrial Property or the Member of the World Trade Organization that is not party to that Convention in which it was filed;

(iv) where the earlier application is a regional application, the authority entrusted with the granting of regional patents under the applicable regional patent treaty;

(v) where the earlier application is an international application, the receiving Office with which it was filed.

6.14 Where the earlier application is a regional application or an international application, the applicant may also indicate in the priority claim one or more countries party to the Paris Convention for the Protection of Industrial Property for which that earlier application was filed.

6.15 Where the earlier application is a regional application and at least one of the countries party to the regional patent treaty is neither party to the Paris Convention for the Protection of Industrial Property nor a Member of the World Trade Organization, the priority claim must indicate at least one country party to that Convention or one Member of that Organization for which that earlier application was filed.

6.16 Reserved

6.17 If the examiner needs a copy of the priority document (see paragraph 6.06), the copy is supplied on request from the applicant or, in the case of a PCT application entering the national phase in Egypt, from the International Bureau, unless the International Bureau has not yet received the priority document, in which event the examiner may invite the applicant himself to furnish such a copy. If the priority document is not in the Arabic language, the examiner may invite the applicant to furnish a translation of the priority document within two months of the invitation according to PCT rule (44 bis 3.d), but only if is necessary for examination (see paragraph 6.06). No examiner may disregard the priority claim before giving the applicant an opportunity to furnish the priority document within a two month time limit, nor may the examiner disregard the priority claim if the priority document is available to it from a digital library in accordance with the PCT Administrative Instructions.

CHAPTER 7
CLASSIFICATION OF APPLICATIONS

DEFINITION

7.01 Classification involves the assigning of one or more classification symbols to a particular application, whereby the technical subject of the invention of that application is identified. Every application must be classified according to the International Patent Classification system (IPC), and this chapter deals only with such classification.

DEFINITIVE CLASSIFICATION OF THE APPLICATION

7.02 The classification of the application is determined by the technical examiner. Classification symbols are applied to each application according to the current rules of the IPC. The IPC Guide can be accessed through the World Intellectual Property Organization web site at www.wipo.int.

MULTIPLE CLASSIFICATIONS

7.03 If the application requires more than one classification symbol, then all such classifications are assigned in accordance with the IPC Guide.

CLASSIFICATION OF DISCLOSURE AS FILED

7.04 The classification is determined without taking into consideration the probable content of the application after any amendment, since this classification should relate to the disclosure in the published application, that is, the application as filed. If, however, the examiner's understanding of the invention, or of the content of the application as filed, alters significantly as a result of the search (for example, as a result of prior art found, or because of the clarification of apparent obscurities), the classification should be amended accordingly.

7.05 Reserved

CLASSIFICATION WHEN SCOPE IS OBSCURE

7.06 When the scope of the invention is not clear, the classification has to be based on what appears to be the invention insofar as this can be understood. It may be necessary to amend the classification, at a later stage, if obscurities are removed by the search, as discussed in paragraph 7.04.

LACK OF UNITY OF INVENTION

7.07 All claimed inventions must be fully classified, whether or not there is lack of unity of invention, since all are disclosed in the published application. Each invention claimed is classified as set out in paragraphs 7.02 to 7.06.

7.08 Reserved.

CHAPTER 8
QUALITY FRAMEWORK

INTRODUCTION

8.01 It is crucial to the unqualified acceptance of the work of the Egyptian Patent Office that there are quality standards for the Office. This helps to ensure that the work of the Office is of consistent high quality and meets the expectations both of the local users and the international patent community.

8.02 This chapter sets out the main features of a quality framework for the work of the Patent Office. There is a detailed plan implementing this framework at the Patent Office. This detailed plan is reviewed and updated on a regular basis to ensure that it is consistent with the needs of the Patent Office to maintain a high level of quality.

QUALITY MANAGEMENT SYSTEM

8.03 The Patent Office maintains a quality management system (QMS) which sets out the basic requirements with regard to resources, administrative procedures, feedback, and communication channels required to underpin the search and examination process. The QMS established by the Patent Office also incorporates a quality assurance scheme for monitoring compliance with the procedures of the Examination Procedures Manual.

8.04 The QMS should help build confidence in the work of the Office by ensuring that the measures they have taken to meet the requirements of the QMS are effective and appropriate.

RESOURCES

8.05 The Patent Office is able to accommodate changes in workload and has an appropriate infrastructure to support the search and examination process and comply with the QMS requirements and the Examination Procedures Manual. The following are the resources and infrastructure the Patent Office has established:

(a) A sufficient number of staff to deal with the inflow of work and which maintains the technical qualifications to search and examine in the required technical fields and has the language facilities to understand at least those languages in which the minimum documentation referred to in PCT Rule 34 is written or the languages into which it has been translated;

(b) Appropriately trained/skilled administrative staff and resources at a level to support the technically qualified staff and facilitate the search and examination process;

(c) Appropriate equipment and facilities, such as IT hardware and software, to support the search and examination process;

(d) Access to, at least the minimum documentation referred to in PCT Rule 34, properly arranged for search and examination purposes;

(e) Comprehensive and up-to-date work manuals to help staff understand and adhere to the quality criteria and standards and follow work procedures accurately and consistently;

(f) An effective training and development program for all staff involved in the search and examination process to ensure they acquire and maintain the necessary experience

and skills and are fully aware of the importance of complying with the quality criteria and standards; and

(g) A system for continuously monitoring and identifying the resources required to deal with demand and comply with the quality standards for search and examination.

ADMINISTRATION

8.06 The Patent Office has in place the following practices and procedures for handling search and examination requests and performing related functions such as data-entry and classification:

(a) Effective control mechanisms regarding timely issuance of search and examination results at a quality standard consistent with this Procedures Manual;

(b) Appropriate control mechanisms regarding fluctuations in demand and backlog management; and

(c) An appropriate system for handling complaints and taking corrective and preventative action where appropriate, and the application of monitoring procedures for measuring user satisfaction and perception, and for ensuring their needs and legitimate expectations are met.

QUALITY ASSURANCE

8.07 The Patent Office has procedures regarding timely issuance of search and examination reports at a quality standard in accordance with this Procedures Manual. Such procedures include:

(a) An effective internal quality assurance system for self assessment, involving verification and validation and monitoring of search and examination work for compliance with this Procedures Manual and channeling feedback to staff;

(b) A system for measuring, recording, monitoring and analyzing the performance of the quality management system to allow assessment of conformity with the requirements;

(c) A system for verifying the effectiveness of actions taken to address deficiencies and to prevent issues from recurring; and

(d) An effective system for ensuring the continuous improvement of the established processes.

FEEDBACK ARRANGEMENTS

8.08 To help improve performance and foster continual improvement, the Patent Office communicates the results of their internal quality assurance process to their staff to ensure that any necessary corrective action is taken and for the dissemination and adoption of best practice.

COMMUNICATION AND GUIDANCE TO USERS

8.09 The Patent Office has in place the following arrangements for ensuring effective communication with users:

(a) Effective communication channels so that enquiries are dealt with promptly and that appropriate two-way communication is possible between applicants and examiners; and

(b) Clear, concise and comprehensive guidance and information to users (particularly applicants not represented by agents) on the search and examination process which is included on the Patent Offices' web site as well as in guidance literature.

INTERNAL REVIEW

8.10 In addition to establishing a quality assurance system for checking and ensuring compliance with the requirements set out in its QMS, the Patent Office has established its own internal review arrangements to determine the extent to which it has established a QMS based on the above model and the extent to which it is complying with the QMS requirements and this Procedures Manual. The review is objective and transparent so as to demonstrate whether or not those requirements and procedures are being applied consistently and effectively and is undertaken at least once a year.

8.11 The following are the basic components of the Patent Office's internal review mechanism and reporting system.

MONITORING AND MEASURING

8.12 The input to each review includes information on:

(a) Conformity with the QMS requirements and this Procedures Manual;

(b) Any corrective and preventative action taken to eliminate the cause of non-compliance;

(c) Any follow-up action from previous reviews;

(d) The effectiveness of the QMS itself and its processes;

(e) Feedback from customers, including agents and applicants; and

(f) Recommendations for improvement.

8.13 Arrangements are in place for monitoring, recording and measuring compliance with the QMS requirements and this Procedures Manual. Arrangements are also made to measure customer satisfaction, which should include the views applicants and their representatives.

ANALYSIS

8.14 The collected data is used to determine to what extent the QMS requirements and this Procedures Manual are being met. The results of the internal review are presented to senior management so that they can gain an objective appreciation of performance against the QMS requirements and this Procedures Manual and to identify opportunities for improvement and whether changes are needed.

IMPROVEMENT

8.15 The Patent Office:

(a) Has an established system to continually improve its performance against the QMS requirements and to review the effectiveness of its QMS; and

(b) Identifies and promptly takes corrective action to eliminate the cause of any failure to comply with the QMS requirements and this Procedures Manual.

CHAPTER 9
EXCLUSIONS FROM, AND LIMITATION OF, SEARCH AND EXAMINATION

INTRODUCTION

9.01 Article 16 provides for examination of each patent application to determine whether it meets requirements set forth elsewhere in the Law. To be patentable under Article 16 of the Law, the subject matter of the claim must be an invention as mentioned in Article 1, must meet the three standards of novelty, inventive step, and industrial applicability set forth in Article 1, as well as all other requirements for patentability, and it must not be subject matter excluded under Article 2 of the Law.

The Law does not define the term "invention," which should be understood in its usual sense as referring to a product of the imagination that can be put into practice. It is therefore distinct from a mere idea for accomplishing something where that idea is not accompanied by an understanding of the means of putting it into practice. Contrast, for example, the idea of paint to add color to an item, with the invention of paint in which the inventor has a completed concept of the ingredients and process needed to make and apply paint to add color to an item.

An invention is made when the inventive idea, with all its essential attributes present, is so clearly defined in the mind of the inventor that it is capable of being converted into reality and put into practice by the inventor or by one who has ordinary skill in the relevant area of technology. The method by which the inventor arrives at this completed concept is not important, that is, it may be as the result of painstaking research or as a sudden flash of inspiration.

9.02 In addition to the foregoing requirements for patentability, a patent application must describe patentable subject matter. Article 2 of the Law lists five categories of subject matter that are not patentable in Egypt.

Subparagraph (2) of Article 2 excludes patents for subject matter that are ordinarily not considered inventions, i.e., discoveries, scientific theories, mathematical methods, programs, and drawings.

The other four subparagraphs of Article 2 list several categories of products and processes that are inventions but are excluded from patentable subject matter under Egyptian Law. These categories are:

> Subparagraph 1 Inventions -- inventions the exploitation of which could affect national security, contradict with public morals and public order, or cause severe damage to the environment or harm the life or health of humans, animals or plants;
>
> Subparagraph 3 Inventions -- diagnostic, therapeutic, and surgical methods for treatment of humans and animals;
>
> Subparagraph 4 Inventions -- plants and animals however rare or unique including biological processes for the production of animals and plants, with the exception of micro-organisms, non-biological processes and micro-biological processes; and
>
> Subparagraph 5 Inventions – Organs, tissues, live cells, natural biological substances, nuclear acid and genome -- but see TRIPS Article 27 (3)

As a legal principle, exceptions are to be interpreted narrowly. Therefore, the examiner should exercise care not to interpret these provisions in a way that extends the exclusions beyond the precise meaning set forth in Article 2 of the law. Therefore, an application that

consists solely of the excluded subject matter would be rejected, but an application that includes, uses, or relates to the excluded subject matter may be patentable subject matter.

9.03 Article 27 of the Agreement on the Trade-Related Aspects of Intellectual Property Rights (TRIPS Agreement) limits the extent to which Egypt may exclude inventions from patentable subject matter. Therefore, the scope of each of these five categories should be interpreted in a manner that is consistent with the limitations in the TRIPS Agreement. TRIPS Article 27 (3) reads as follows:

> Members may also exclude from patentability:
>
> (a) diagnostic, therapeutic and surgical methods for the treatment of humans or animals;
>
> (b) plants and animals other than micro-organisms, and essentially biological processes for the production of plants or animals other than non-biological and microbiological processes. However, Members shall provide for the protection of plant varieties either by patents or by an effective *sui generis* system or by any combination thereof. The provisions of this subparagraph shall be reviewed four years after the date of entry into force of the WTO Agreement.

9.04 If the examiner determines that the subject matter of the claim is not an invention under subparagraph 2 of Article 2, or that it is an invention but falls within the categories defined in subparagraphs 1, 3, 4, and 5, the examiner must reject the claim for lack of compliance with Article 2 of the Law. The scope of each of these categories is discussed below.

LAW ARTICLE 2, SUBPARAGRAPH 2 – SUBJECT MATTER WHICH IS NOT AN INVENTION

9.05 As mentioned, claims drawn to discoveries, scientific theories, mathematical methods, programs and drawings per se are not inventions and must be rejected under the second subparagraph of Article 2 of the Law. In general, the basis for these exclusions is that they do not constitute a patentable invention, as described above. That is, a scientific theory, mathematical method, program, or scheme may be a creation of the mind, but by itself, and without any means of producing some effect, it would not be an invention. Such creative works would also not be of such a nature as to be put into practice and therefore would lack the industrial applicability necessary for patentability. In addition, a discovery of something that already exists, perhaps in nature, would not be a patentable invention because it would always lack novelty.

The term “discovery” is susceptible of more than one meaning. The act of invention is sometimes referred to as a discovery, particularly when the inventor’s appreciation of the invention occurs suddenly, as a flash of genius. This is not the sense in which the term “discovery” is used in subparagraph (2), and the exclusion should not be applied to this usage of the term. For purposes of subparagraph (2), “discovery” should be understood in its other sense, as finding something that already exists. The examiner should take care not to extend the meaning of the term discovery beyond this sense of the word.

The fact that a claim may incorporate a discovery, scientific theory, or mathematical method does not automatically mean that the subject matter of the claim is not an invention, however. If the claim, viewed as a whole, describes discoveries, theories, or methods that are applied or implemented to produce a practical application or to have a technical character, the subject matter of the claims is an invention that is patentable subject matter and not barred under Article 2. For example, if the claim only recites the physical theory of semi-conductivity, the claim would be drawn to a scientific theory, not an invention. Whereas, new semiconductor devices and processes for manufacturing that implement the scientific theory are inventions that are included in patentable subject

matter. Mathematical methods are a particular example of the principle that purely abstract or intellectual methods are excluded. For example, a shortcut method of division would be not be an invention but a calculating machine designed to operate accordingly would be an invention included in patentable subject matter.

9.06 A computer program by itself is not considered to be an invention. A mere program listing that describes an executable code that is not tangibly embodied as a record on a computer-readable carrier would not be an invention, and therefore would not be patentable subject matter, and should be rejected under subparagraph 2 of Article 2 of the Law. Even though this is not excludable subject matter, any claims drawn to these inventions should not include the computer program in the body of the claims. The computer program should be fully disclosed in the specification to allow those skilled in the art to be able to make and/or use the invention.

Similarly, a claim drawn to an executable program producing only an expression of an idea (such as a mathematical theory) even if tangibly embodied, would not be an invention and should be rejected.

However, like discoveries, theories, *etc.*, the fact that a claim may describe or incorporate a computer program does not automatically mean that it is not an invention. A program containing executable code tangibly embodied on a computer-readable carrier, which when executed has a practical application, would be an invention and patentable subject matter.

In addition, a data-processing operation can be implemented either by means of a computer program or by means of special circuits, and the choice may have nothing to do with the inventive concept but be determined purely by factors of economy or practicality. This means, for example, that program-controlled machines and program-controlled manufacturing and control processes should normally be regarded as inventions and are patentable subject matter and not barred under Article 2 of the Law.

It follows also that where the claimed subject matter is concerned only with the program-controlled internal working of a known computer, the subject matter would be an invention if it provides a practical application. For, example transformation of data, representing discrete dollar amounts, by a computer through a series of mathematical calculations into a final share price, constitutes a practical application of a mathematical algorithm, formula, or calculation, because it produces 'a useful, concrete and tangible result' -- a final share price momentarily fixed for recording and reporting purposes and even accepted and relied upon by regulatory authorities and in subsequent share trades. It therefore would be an invention, and patentable subject matter. However, the computer program itself cannot be part of the claim but can be part of the description and referred to in either the independent or dependent claims.

The subject matter of a claim should be examined as a whole, and a claim that includes reference to a computer program may or may not be drawn to the computer program. For example, if the claim is drawn to a device or process in which a computer program is one element of the device, or one step of the claim. Even if the only novel point of the claim is that a computer program is used to control a portion of a process or regulate the working of a device, the claim is drawn to a process or product and is patentable subject matter. However, if the only novel feature of the claim is the substitution of one computer program for another, then the claim is essentially drawn to the computer program, despite the addition of other, non-novel elements or steps. In evaluating the claims, the comparison should be made not between the two programs but between the two inventions taken as a whole.

9.07 Claims including only drawings or including the presentation of information characterized solely by the content of the information, are not considered to be an invention and should

be rejected under subparagraph 2 of Article 2 of the Law. Thus, a claim directed (1) to the presentation of the information (i.e., by acoustical signals, spoken words, visual displays), (2) to information recorded on a carrier (i,e., books characterized by their subject, gramophone records characterized by the musical piece recorded, traffic signs characterized by the warning thereon, magnetic computer tapes characterized by the data or program recorded), or (3) to processes and apparatus for presenting information (i.e., indicators or recorders characterized solely by the information indicated or recorded) is not an invention under subparagraph 2.

If, however, the claim is directed to the presentation of encoded information that has a technical character, or if it has both a structural and functional relationship to the information carrier, process or apparatus, then the claim is directed to an invention as the subject matter relates to the information carrier or to the process or apparatus for presenting the information. Examples of inventions include a measuring device with volumetric markings having both a structural and functional relationship with a measuring receptacle providing for re-calibration of the device depending on the quantities desired (*e.g.*, a measuring cup with English and metric markers side-by-side); a gramophone record characterized by a particular groove form to allow stereo recordings; or a diapositive with a sound track arranged at the side of it (*e.g.,* movie film constructed in a way to permit sound and pictures to be recorded simultaneously).

LAW ARTICLE 2, SUBPARAGRAPH 1 CATEGORY OF EXCLUDED INVENTIONS – GENERAL EXCLUSIONS

9.08 Subparagraph 1 of Article 2 of the law excludes from patentable subject matter "inventions the exploitation of which could affect national security, contradict with public morals and public order, or cause severe damage to the environment or harm the life or health of humans, animals or plants." The reference to national security creates the possibility of implementing TRIPS Article 73, which permits WTO Members to take actions necessary to protect their "essential security interests," and should be interpreted consistent with TRIPS Article 73. The remainder of this exclusion is similar but not identical to the exclusion in TRIPS Article 27.2 that permits Egypt to exclude patents for certain inventions only if preventing commercialization of those inventions is necessary to protect public order or morality, but not merely because exploitation is prohibited by law.

The term "public order" (o*rdre public)* is a French legal concept that refers to compelling issues of public policy necessary for a well-ordered society. The concept is not limited to particular subjects but should be understood as referring to principles of such importance that the government cannot depart from them. TRIPS specifically recognizes that this provision encompasses measures that are necessary to protect human, animal or plant life or health or to avoid serious prejudice to the environment. Since this provision was adopted to implement TRIPS Article 27, the scope of this category of exclusions should be interpreted consistently with the provisions of TRIPS Article 27.2.

9.09 Thus, subparagraph 1 requires examiners to reject claims drawn to inventions that are not permitted to be commercialized in Egypt because their effects on public order, life or health, or the environment are too dangerous to justify any benefits from their use. For example, examiners should reject claims to a highly toxic explosive if its commercialization threatens Egypt's essential security interests or public order and Egyptian law prohibits the marketing and use of that explosive

However, an examiner cannot reject a claim merely because the invention cannot be marketed in Egypt. For example, suppose the law only permits the sale of educational videos in one format to ensure that schools only need to acquire a single type of video viewer. Examiners should not reject inventions related to devices for viewing other

formats, even those they may not be presently sold in Egypt, because these inventions do not represent a danger to public morality, the environment, or life or health.

It should also be noted that examiners are not permitted, to reject claims drawn to inventions that some believe may be used in ways that are contrary to public order, life, health, and the environment, if those inventions can legally be marketed. For example, some believe that use of non-organic fertilizers harms the environment or health. An examiner cannot rely on this provision to reject claims drawn to non-organic fertilizers if they may be legally marketed and used in Egypt.

Decisions as to whether the subject matter should be excluded from search or examination are not made by Patent Office staff, but are made by the relevant ministry after the conclusion of the examination as set forth in Law Article 17. That is, within 10 days from the end of the examination those applications found to be otherwise acceptable but where there is a question as to whether the subject matter should be excluded under Law Article 2, will be sent to the relevant ministry along with all the relevant information as required by Law Article 17. If the ministry concludes that the subject matter is excluded from patenting in Egypt, the Patent Office will communicate this to the applicant.

LAW ARTICLE 2, SUBPARAGRAPH 3 CATEGORY OF EXCLUDED INVENTIONS – TREATMENTS

9.10 Subparagraph 3 of Article 2 of the law excludes “diagnostic, therapeutic, and surgical methods for treatment of humans and animals” from patentable subject matter. As a result, examiner should reject claims drawn to methods for removing cataracts surgically as well as methods to determine if a patient suffers from tuberculosis.

It should be noted this provision only requires examiners to reject claims drawn to methods. This exclusion does not permit examiners to reject claims drawn to products such as vaccines used to treat humans or animals, to machines such as those to control the intravenous introduction of medicines, or surgical equipment such as a scalpel or hemostat.

For example, an item that is used in a diagnostic, therapeutic, or surgical method may be a patentable invention, provided it meets other requirements of the law, even though the diagnostic, therapeutic, or surgical method in which the item is used would be excluded from patentability. If an application includes claims to a device for use in diagnosis, therapy, or treatment, as well as claims to the diagnosis, therapy, or treatment itself, the examiner should require the applicant to limit the claims so that they apply to the device but not to the method. However, it is not appropriate to require the applicant to remove discussion of the use of the device from the specification since a description of use in the specification is usually necessary to meet the requirement of enabling disclosure and sometimes also industrial applicability.

A reference to the use of a device may also appear in the introduction (also known as the preamble) to a claim, for example, “I claim a device for use in surgery, comprising:…”. Generally, words in the introduction have no effect on the interpretation of a claim. In those cases, an applicant should be permitted, but should not be required, to delete the reference to the use of a device from the introduction. In some cases, however, the introduction is necessary to give meaning to the claim. In that situation, the examiner should evaluate whether removing the words that give meaning to the claim would broaden the invention, possibly beyond what was conceived by the invention, in which case there should be no requirement to remove the words, or whether, upon taking those words into account in evaluating the claim, the claim itself should still be rejected in accordance with Law Article 2(3).

9.11 Also, it should be noted that this provision only requires an examiner to reject claims drawn to treatments to relieve a medical condition. An examiner is not permitted to reject claims drawn to methods of treatment for other purposes. For example, an examiner may not reject under Law Article 2 (3) a claim drawn to the treatment of a sheep to promote growth, to improve the quality of mutton or to increase the yield of wool. An examiner may not rely on subparagraph 3 to reject other methods of measuring or recording characteristics of the human or animal body. For example, examiners may not reject a method of measuring the head of person to determine the hat size of a person under this subparagraph. An examiner should not reject a claim drawn to a method of applying decoration to a human skin (tattoo), but should reject a claim drawn to a method of surgically enhancing appearance. An application containing claims directed to the cosmetic treatment of a human by administration of a chemical product should be searched and examined. A search or examination of a cosmetic treatment involving surgery need not, however, be carried out (see the second sentence of the second paragraph in section 9.10).

9.12 A treatment or diagnostic method, to be excluded, must actually be limited to being carried out on the living human or animal body. A treatment of or diagnostic method practiced on a dead body would therefore not be excluded from search and examination. Treatment of body tissues or fluids after they have been removed from the human or animal body, or diagnostic methods applied thereon would not be excluded from the search or examination insofar as those tissues or fluids are not returned to the same body. Thus, the treatment of blood for storage in a blood bank or diagnostic testing of blood samples is not excluded, whereas a treatment of blood by dialysis with the blood being returned to the same body could be excluded.

Diagnostic methods comprise the carrying out of an investigation for medical purposes into the state of a human or animal body, so that a method of measuring the blood pressure of a body or a method of obtaining information regarding the internal state of a body by passing X-rays through the body could be excluded from search or examination. A treatment by therapy implies the curing of a disease or malfunction of the body; prophylactic methods, for example, immunization, are considered to be therapeutic treatments and thus may be excluded. Surgery is not limited to healing treatments, being more indicative of the nature of the treatment; methods of cosmetic surgery may thus be excluded from search and examination.

LAW ARTICLE 2, SUBPARAGRAPH 4 CATEGORY OF EXCLUDED INVENTIONS – BIOLOGICAL MATERIALS

9.13 While plant and animal varieties may be excluded from search, transgenic plants and genetically modified animals, as well as methods of making these types of inventions would be searched and examined. The question whether a process is “essentially biological” is one of degree, depending on the extent to which there is technical intervention by humans in the process; if such intervention plays a significant part in determining or controlling the result it is desired to achieve, the process would not be excluded. For example, a method of selectively breeding horses involving merely selecting for breeding and bringing together those animals having certain characteristics would be essentially biological. However, a method of treating a plant characterized by the application of a growth-stimulating substance or radiation would not be essentially biological since, although a biological process is involved, the essence of the claimed invention is technical.

Similarly, methods of genetically manipulating animals are not essentially biological processes and would be searched and examined. The treatment of soil by technical means to suppress or promote the growth of plants is also not excluded. Likewise, the fact that an application may include claims that involve the use of a plant or animal in a product or process does not require rejection under subparagraph 4. The term

"microbiological process" is to be interpreted as covering not only industrial processes using microorganisms but also processes for producing microorganisms, for example, by genetic engineering. The product of a microbiological process may also be subject to search and examination. . Propagation of the product of a microbiological process itself is to be construed as a microbiological process; consequently, the product can be protected per se as it is a product obtained by a microbiological process. The term "product of a microbiological process" covers plasmids and viruses also.

9.14 Reserved

EXCLUSIONS FROM REQUIREMENTS TO SEARCH FOR PRIOR ART AND TO EXAMINE CLAIMS

INTRODUCTION

9.15 As a general rule, examiners are required to search for the evidence of the prior art which is most closely related to the subject matter in each claim of a patent application and to examine each claim for compliance with the requirements set forth in Chapter 1 of Book 1 of the Intellectual Property Law and Section 1 of Chapter 1 of the Executive Regulations that implement that Law. There are rare exceptions to this general rule, however, when an examiner cannot or should not search for evidence of the prior art related to the subject matter of a claimed invention. If it is not possible or appropriate to search for this evidence of the prior art, it is not possible or appropriate to examine that claim for compliance with the requirements of novelty and inventive step as set forth in Article 1 of the Law.

9.16 Reserved.

SEARCH NOT REQUIRED

9.17 First, an examiner should not search for evidence of the prior art if the claimed invention is not disclosed with sufficient clarity for the examiner to conduct a "meaningful search". A "meaningful search" is a search that is reasonably expected to provide sufficient evidence of the prior art for the examiner to make an informed decision as to whether a claimed invention is new and involves an invention step. For example, an examiner should not search for prior art when the claimed invention is described as a substance that acts as a catalyst but the chemical structure of substance is not disclosed.

9.18 Second, an examiner should not search for evidence of the prior art if the claimed invention is clearly directed to subject matter excluded from patentability by Article 2 of the Law. See section 9.02 for a discussion of which inventions are not patentable subject matter. For example, examiners should not search for prior art when the claimed invention is a horse or any other non-microbiological animal. There is no possibility that the claimed invention will be found to be patentable subject matter. Therefore, a search is not an effective use of the time of the examiner.

9.19 Third, an examiner should not search for evidence of the prior art if the claimed invention is clearly without an industrial application as required by Article 1 of the Law. For example, examiners should not search for prior art when the claimed invention is a perpetual motion machine, or any other device that does not work, as there is no possibility that the claimed invention will be found to have industrial application. Therefore, a search is not an effective use of the time of the examiner.

REQUIREMENT TO NOTIFY APPLICANT

9.20 If an examiner determines that a search related to a particular claim in an application is not possible or appropriate on the grounds listed above, the examiner must notify the applicant, in compliance with Article 19 of the Executive Regulations, that the examiner did not search for evidence of the prior art with respect to that claim or examine that claim for compliance with the requirements of novelty and inventive step. In situations where there is a lack of clarity of the description and/or the claims (see paragraphs 5.31 +), the applicant is given an opportunity to clarify the description and/or claims. Only after the clarification is made which is acceptable to the examiner, a search and examination will take place..

EXAMPLES OF CLAIMS FOR WHICH NO MEANINGFUL SEARCH IS POSSIBLE[1]

9.21 **Example 1**

Claim: "My invention is worth a million dollars."

Claim 1 is the only claim in the application. The description does not provide sufficient information about the invention to determine the subject matter to which the claim might reasonably be expected to be directed after it had been amended.

Given that there is no description of how to make and use the invention and the invention is not clearly defined in the Claim, the examiner should reject the Claim for failure to comply with paragraphs 1 and 2 of Article 13 of the Law. The examiner cannot conduct a meaningful search, however, as the applicant did not provide any details of the invention. The examiner should request the applicant to clarify the claimed invention. The notification required by Article 19 of the Regulations should indicate that the examiner did not conduct a search with regard to the Claim and did not examine the claim for novelty and inventive step.

9.22 **Example 2**

Claim 1: "A composition of matter comprising kryptonite."

The description recites the term "kryptonite." However, the description fails to define the purported material in terms of any of the elements of the periodic table. The description also fails to set forth any of the physical properties of the purported material such as density, melting point, etc.

Given that there is no known element called "kryptonite," and the applicant has not supplied information that would otherwise clearly identify the material to which the applicant refers, the invention is not fully disclosed and clearly claimed. Thus, after giving the applicant the opportunity to clarify this and the applicant fails to do so, the examiner should reject the Claim for failure to comply paragraphs 1 and 2 of Article 13 of the Law. The examiner cannot conduct a meaningful search, as the element does not exist and the applicant did not provide any details of the invention. The notification required by Article 19 of the Regulations should indicate that the examiner did not conduct a search with regard to the Claim and did not examine the claim for novelty and inventive step.

[1] These examples are drawn directly from *PCT International Search and Preliminary Examination Guidelines* (PCT/GL/ISPE/1), paras. 9.28 and 9.29, *et seq.*)

SEARCH MAY BE APPROPRIATE

9.23 The examiner may search for evidence of the prior art if it is possible to conduct a meaningful search, even if the disclosure of the claimed invention does not meet the requirements of Article 13, (i.e., requirements to disclose the invention in paragraph 1, and requirement to claim the invention clearly in paragraph 2).

9.24 First, a search for evidence of the prior art may enable an examiner to avoid improperly rejecting a claimed invention for failure to disclose the invention as required by Article 13 of the law. From the application alone, it may appear to the examiner that claimed invention is not disclosed in accordance that Article. The examiner may discover evidence of the prior art in the search that, considered with the description submitted by the applicant, may indicate that the claimed invention was fully disclosed. For example, an applicant failed to describe how to use an element of a claimed invention. Upon review of the application, the examiner may conclude initially that this failure was inconsistent with the requirement in Article 13 of the Law to disclose the invention fully. During the search, however, the examiner could discover from patent documents and technical journals that the element and its uses were well known by those of ordinary skill in the art. Thus, the claimed invention would be disclosed in the application in accordance with Article 13 of the Law. The examiner may not have understood that the claim complied with the requirements in Article 13 without the search.

9.25 It is the policy of the Patent Office to resolve issues of clarity before carrying out the substantive examination. For example, suppose that an applicant failed to describe how to use an element of a claimed invention, the examiner should request clarification because the claimed invention was not disclosed in the manner required by Article 13 of the Law, but does not search for evidence of the prior art or examine the claim for novelty or inventive step. Upon receipt of the examiner's request for clarification, however, suppose that the applicant provides the examiner with evidence from patent documents and technical journals that the person of ordinary skill in the art knew how to make and use the element in question. The examiner would now be required to search for evidence of the prior art and examine the claim for novelty and inventive step as required by Article 1 of the Law.

9.26 For similar reasons, the examiner should search for evidence of the prior art only after the applicant has satisfied the requirement by the examiner to show that the invention is industrially applicable, in those case where there is doubt as to the industrial applicability of the invention as required by Law Article 1.

9.27 Reserved

EXAMPLES OF CLAIMS FOR WHICH A MEANINGFUL SEARCH IS POSSIBLE AFTER CLARIFICATION BY APPLICANT[2]

9.28 **Example 1**

Claim that fails to meet the disclosure requirements of the first and second paragraphs of Article 13 of the Law and Article 3, paragraph 1 of the Regulations.

[2] Most of these examples were drawn directly from *PCT International Search and Preliminary Examination Guidelines* (PCT/GL/ISPE/1), para. 9.20, *et seq.*

Claim 1. "Distillate fuel oil boiling in the range 120°C to 500°C which has a wax content of at least 0.3 percent weight at a temperature of 10°C below the Wax Appearance Temperature, the wax crystals at that temperature having an average particle size less than 4000 nanometers."

The description does not disclose any other method of obtaining the desired crystal size than the addition of certain additives to the fuel oil, and there is no common general knowledge of making fuel oils of this kind available to the person skilled in the art.

Given the lack of a description of a method of obtaining the crystal size, the examiner must give the applicant an opportunity to clarify the Claim because it is not supported by a "detailed description of the invention including a full statement of the subject matter and the preferred method that enables the skilled in the art to execute it with respect to each product and process that is the subject matter of the application" as required by the first paragraph of Article 13(2) of the Law.

9.29 **Example 2:**

Claim that fails to meet the clarity requirements of the second paragraph of Article 13 of the Law.

Claim 1: "A process of reacting starting materials in such a way that a sustained release tablet with improved properties is obtained."

The description discloses an example of reacting particular materials in a particular manner to obtain a sustained release tablet having a particular release rate of a particular bio-active material.

Given the lack of details about the process in the Claim, the examiner should request clarification to define the invention clearly as required by paragraph 2 of Article 13 of the Law because (1) the claim fails to recite any steps of a process such that the scope of the invention is identified, (2) the phrase "improved properties" is a relative term and not clear, and (3) the claim attempts to define the invention solely by the result to be achieved

9.30 **Example 3:**

Claim characterized solely by unusual parameters that do not meet the requirement for industrial application.

Claim 1: "A fat having a nausea index of less than or about 1.0."

The description discloses a number of fats that purportedly have a nausea index of less than 1.0 and a number of fats which have a nausea index greater than 1.0. Examples of fats having a nausea index of less than 1.0 include different mixtures of saturated and unsaturated fats. Examples of fats having a nausea index greater than 1.0 also include different mixtures of saturated and unsaturated fats. No other properties, for example, melting point, of these mixtures of fats are disclosed. The description discloses determining the nausea index by whipping the fat at a particular speed and temperature and measuring the viscosity of the whipped mixture at room temperature.

Given that the neither the Claim nor the description mention a use for the claimed fat, the examiner request clarification as to how the claimed meets the requirement for industrial applicability as required by Article 1 of the Law.

9.31 **Example 4:**

Chemical Markush-type claim encompassing many embodiments that do not meet the disclosure requirements.

> *In this example, the claims encompass a very large number of possible embodiments while the description discloses, and provides support for, only a relatively small proportion of those embodiments (see paragraph 5.48).*

Given the lack of a description for many of the possible embodiments, the examiner should request clarification as to how the description meets the requirements of the first paragraph of Article 13 of the Law.

9.32 **Example 5:**

Chemical Markush-type claim with many options, variables, etc. that does not meet the disclosure and clarity requirements.

> *In this example, the claim contains so many options, variables, possible permutations and/or provisos, that the claim is rendered unclear and/or inconcise to the extent that it is not in compliance with Egyptian Law (see paragraph 5.42).*

Given the lack of disclosure of some of the claimed inventions and the lack of clarity in definition of the invention, the examiner should ask applicant to clarify how the claims meet the requirements of in paragraphs 1 and 2 of Article 13 of the Law.

9.33 **Example 6:**

Claim that may be drawn to excluded subject matter

> *Claim: A process for curing rubber comprising several steps that include constantly taking measurements such as temperature and pressure of the rubber and calculating the remaining time to cure the rubber.*

The description includes details about the steps taken and the complex algorithms used by a computer to calculate the remaining cure time.

The examiner might conclude that the subject matter of the Claim was a computer program and request applicant to clarify the matter or amend the claims so they are clearly drawn non-excludable subject matter. If the applicant does so, a search and examination can then take place.

CHAPTER 10
UNITY OF INVENTION

DETERMINATION OF UNITY OF INVENTION

10.01 An application should relate to only one invention or, if there is more than one invention, the inclusion of those inventions in one application is only permitted if all inventions are so linked as to form a single general inventive concept (Law Article 12). With respect to a group of inventions claimed in an application, unity of invention exists only when there is a technical relationship among the claimed inventions involving one or more of the same or corresponding special technical features. The expression "special technical features" is defined as meaning those technical features that define a contribution which each of the inventions, considered as a whole, makes over the prior art. The determination is made on the contents of the claims as interpreted in light of the description and drawings (if any).

10.02 Whether or not any particular technical feature makes a "contribution" over the prior art, and therefore constitutes a "special technical feature," is considered with respect to novelty and inventive step. For example, a document discovered in the search shows that there is a presumption of lack of novelty or inventive step in a main claim, leaving two or more dependent claims without a single general inventive concept and thereby there would be no unity of invention between these two dependent claims.

10.03 Lack of unity of invention may be directly evident, before considering the claims in relation to any prior art, or may only become apparent, after taking the prior art into consideration. For example, independent claims to A + X, A + Y, X + Y can be said to lack unity as there is no subject matter common to all claims. In the case of independent claims to A + X and A + Y, unity of invention is present as A is common to both claims. However, if it can be established that A is known, there is lack of unity, since A (be it a single feature or a group of features) is not a technical feature that defines a contribution over the prior art.

10.04 There should be a broad, practical consideration of the degree of interdependence of the alternatives presented in the claims, in relation to the state of the art as revealed by the search or, by any additional document considered to be relevant. If the common matter of the independent claims is well known and the remaining subject matter of each claim differs from that of the others without there being any unifying novel inventive concept common to all, then clearly there is lack of unity of invention. If, on the other hand, there is a single general inventive concept that appears novel and involves inventive step, then objection of lack of unity does not arise. For determining the action to be taken by the examiner between these two extremes, rigid rules cannot be given and each case is considered on its merits, the benefit of any doubt being given to the applicant.

10.05 From the preceding paragraphs it is clear that the decision with respect to unity of invention rests with the examiner. However, the examiner should not raise objection of lack of unity of invention merely because the inventions claimed are classified in separate classification groups or merely for the purpose of restricting the search to certain classification groups.

10.06 Unity of invention has to be considered in the first place only in relation to the independent claims in an application and not the dependent claims. The examiner should bear in mind that a claim may also contain a reference to another claim even if it is not a dependent claim. One example of this is a claim referring to a claim of a different category (for example, "Apparatus for carrying out the process of Claim 1 ...," or "Process for the manufacture of the product of Claim 1 ..."). Similarly, in a situation like the plug and socket

example in paragraph 5.19, a claim to the one part referring to the other cooperating part, for example, “plug for cooperation with the socket of Claim 1 ...”) is not a dependent claim.

10.07 If the independent claims are patentable over the prior art and satisfy the requirement of unity of invention, no problem of lack of unity arises in respect of any claims that depend on the independent claims. In particular, it does not matter if a dependent claim itself contains a further invention. For example, suppose claim 1 claims a turbine rotor blade shaped in a specified manner, while claim 2 is for a “turbine rotor blade as claimed in claim 1” and produced from alloy Z. Then no objection arises either because alloy Z was new and its composition was not obvious and thus the alloy itself already contains the essential features of an independent possibly later patentable invention, or because, although alloy Z was not new, its application in respect of turbine rotor blades was not obvious, and thus represents an independent invention in conjunction with turbine rotor blades. As another example, suppose that the main claim defines a process for the preparation of a product A starting from a product B and the second claim reads: “Process according to claim 1 characterized by producing B by a reaction using the product C.” In this case, too, no objection arises, whether or not the process for preparation of B from C is novel and inventive, since claim 2 contains all the features of claim 1. The subject matter of claim 2 therefore falls within claim 1. Equally, no problem arises in the case of a genus/ species situation where the genus claim avoids the prior art and satisfies the requirement of unity of invention. Moreover, no problem arises in the case of a combination/ sub-combination situation where the sub-combination claim avoids the prior art and satisfies the requirement of unity of invention and the combination claim includes all the features of the sub-combination.

10.08 If an independent claim is not patentable over the prior art, then the question whether there is still an inventive link between all the claims dependent on that claim needs to be carefully considered. If there is no link remaining, an objection of lack of unity may be raised. Similar considerations apply in the case of a genus/species or combination/sub-combination situation. This method for determining whether unity of invention exists is intended to be applied even before the commencement of the search. Where a search of the prior art is made, an initial determination of unity of invention, based on the assumption that the claims avoid the prior art, may be reconsidered on the basis of the results of the search of the prior art.

10.09 Alternative forms of an invention may be claimed either in a plurality of independent claims, or in a single claim. In the latter case, the presence of the independent alternatives may not be immediately apparent. In either case, however, the same criteria are applied in deciding whether or not there is unity of invention, and lack of unity of invention may then also exist within a single claim. Where the claim contains distinct embodiments that are not linked by a single general inventive concept, the examiner should object to the claims as lacking unity of invention.

10.10 Objection as to lack of unity of invention does not normally arise if the combination of a number of individual elements is claimed in a single claim (as opposed to distinct embodiments as discussed in the paragraph immediately above), even if these elements seem unrelated when considered individually (see paragraph 15.27).

ILLUSTRATIONS OF PARTICULAR SITUATIONS

10.11 There are three particular situations for which the method for determining unity of invention is explained in greater detail:

(i) combinations of different categories of claims (see paragraphs 10.12 to 10.16);

(ii) so-called “Markush practice (see paragraph 10.17);” and

(iii) intermediate and final products (see paragraphs 10.18 and 10.19).

Principles for the interpretation of the method, in the context of each of those situations are set out below. Examples to assist in understanding the interpretation on the three areas of special concern referred to in the preceding paragraph are set out below.

COMBINATIONS OF DIFFERENT CATEGORIES OF CLAIMS

10.12 The method for determining unity of invention is construed as permitting, in particular, the inclusion of any one of the following combinations of claims of different categories in the same application:

(i) in addition to an independent claim for a given product and an independent claim for a process specially adapted for the manufacture of the said product, or

(ii) in addition to an independent claim for a given process, an independent claim for an apparatus or means specifically designed for carrying out the said process, or

(iii) in addition to an independent claim for a given product, an independent claim for a process specially adapted for the manufacture of the said product and an independent claim for an apparatus or means specifically designed for carrying out the said process.

10.13 Thus, a process is considered to be specially adapted for the manufacture of a product if the claimed process results in the claimed product with the technical relationship being present between the claimed product and claimed process. The words “specially adapted” are not intended to imply that the product could not also be manufactured by a different process.

10.14 Also an apparatus is considered specifically designed for carrying out a claimed process if the contribution over the prior art of the apparatus corresponds to the contribution the process makes over the prior art. Consequently, it would not be sufficient that the apparatus or means is merely capable of being used in carrying out the claimed process. However, the expression “specifically designed” does not imply that the apparatus or means could not be used for carrying out another process, nor that the process could not be carried out using an alternative apparatus or means.

10.15 Reserved.

10.16 A single general inventive concept must link the claims in the various categories and in this connection the wording of paragraph 10.12 should be carefully noted. The link between product and process in subparagraph (i) is that the latter must be “specially adapted for the manufacture of” the former. Similarly, in paragraph 10.12, subparagraph (ii), the apparatus or means claimed must be “specifically designed for” carrying out the process. Likewise, in subparagraph (iii), the process must be “specially adapted for the manufacture of)” the product and the apparatus must be “specifically designed for” carrying out the process. In combinations (i) and (iii), the emphasis is on, and the essence of the invention should primarily reside in, the product, whereas in combination (ii) the emphasis is on, and the invention should primarily reside in, the process. (See Examples below.)

“MARKUSH PRACTICE”

10.17 In the situation involving a single claim that defines alternatives (chemical or non-chemical), the so-called “Markush practice,” the requirement of a technical

interrelationship and the same or corresponding special technical features, is considered met when the alternatives are of a similar nature.

(a) When the Markush grouping is for alternatives of chemical compounds, they are regarded as being of a similar nature where the following criteria are fulfilled:

(A) all alternatives have a common property or activity, and

(B)(1) a common structure is present, that is, a significant structural element is shared by all of the alternatives, or

(B)(2) in cases where a common (significant) structure is not present all alternatives must belong to a recognized class of chemical compounds in the art to which the invention pertains.

(b) In paragraph (a)(B)(1), above, the words "significant structural element is shared by all of the alternatives" refer to cases where the compounds share a common chemical structure which occupies a large portion of their structures. In the case when the compounds have in common only a small portion of their structures, the commonly shared structure must constitute a structurally distinctive portion in view of existing prior art, and the common structure is essential to the common property or activity. The structural element may be a single component or a combination of individual components linked together.

(c) In paragraph (a)(B)(2), above, the words "recognized class of chemical compounds" mean that there is an expectation from the knowledge in the art that members of the class will behave in the same way in the context of the claimed invention. In other words, each member could be substituted one for the other, with the expectation that the same intended result would be achieved.

(d) The fact that the alternatives of a Markush grouping can be differently classified (that is, classified in different IPC classifications) is not, taken alone, considered to be justification for a finding of a lack of unity of invention.

(e) When dealing with alternatives, if it can be shown that at least one Markush alternative is not novel over the prior art, the question of unity of invention should be reconsidered by the examiner. Reconsideration does not necessarily imply that an objection of lack of unity will be raised.

(See Examples below.)

INTERMEDIATE AND FINAL PRODUCTS

10.18 (a) The term "intermediate" is intended to mean intermediate or starting products. Such products have the ability to be used to produce final products through a physical or chemical change in which the intermediate loses its identity.

(b) Unity of invention is considered to be present in the context of intermediate and final products where the following two conditions are fulfilled:

(A) the intermediate and final products have the same essential structural element, in that:

(1) the basic chemical structures of the intermediate and the final products are the same, or

(2) the chemical structures of the two products are technically closely interrelated, the intermediate incorporating an essential structural element into the final product, and

(B) the intermediate and final products are technically interrelated, this meaning that the final product is manufactured directly from the intermediate or is separated from it by a small number of intermediates all containing the same essential structural element.

(c) Unity of invention may also be considered to be present between intermediate and final products for which the structures are not known, for example, as between an intermediate product having a known structure and a final product the structure of which is not known, or as between an intermediate product of unknown structure and a final product of unknown structure. In order to satisfy unity in such cases, there must be sufficient evidence to lead one to conclude that the intermediate and final products are technically closely interrelated as, for example, when the intermediate product contains the same essential element as the final product or incorporates an essential element into the final product.

(d) It is possible in a single application to accept different intermediate products used in different processes for the preparation of the final product, provided that they have the same essential structural element.

(e) If during the process leading from an intermediate (starting) product to a final product, there is another product which is not new, then there is lack of unity of invention..

(f) If the same application claims different intermediates for different structural parts of the final product, unity is not regarded as being present between the intermediates.

(g) If the intermediate and final products are families of compounds, each intermediate compound must correspond to a compound claimed in the family of the final products. However, some of the final products may have no corresponding compound in the family of the intermediate products so that the two families need not be absolutely congruent.

10.19 As long as unity of invention can be recognized after applying the above interpretations, the fact that, besides the ability to be used to produce final products, the intermediates also exhibit other possible effects or activities should not affect the decision on unity of invention.

EXAMPLES CONCERNING UNITY OF INVENTION

10.20 The application of the principles of unity of invention is illustrated by the following examples for guidance in particular cases.

CLAIMS IN DIFFERENT CATEGORIES

10.21 **Example 1**

Claim 1: A method of manufacturing chemical substance X.

Claim 2: Substance X.

Unity exists between claims 1 and 2. The special technical feature common to all the claims is substance X. However, if substance X is known in the art, unity would be lacking because there would not be a special technical feature common to all the claims.

10.22 **Example 2**

Claim 1: A process of manufacture comprising steps A and B.

Claim 2: Apparatus specifically designed for carrying out step A.

Claim 3: Apparatus specifically designed for carrying out step B.

Unity exists between claims 1 and 2 or between claims 1 and 3. There is no unity between claims 2 and 3 since there exists no common special technical feature between the two claims.

10.23 **Example 3**

Claim 1: A process for painting an article in which the paint contains a new rust inhibiting substance X including the steps of atomizing the paint using compressed air, electrostatically charging the atomized paint using a novel electrode arrangement A and directing the paint to the article.

Claim 2: A paint containing substance X.

Claim 3: An apparatus including electrode arrangement A.

Unity exists between claims 1 and 2 where the common special technical feature is the paint containing substance X or between claims 1 and 3 where the common special technical feature is the electrode arrangement A. However, unity is lacking between claims 2 and 3 since there exists no common special technical feature between them.

10.24 **Example 4**

Claim 1: A group of compounds X used as insecticides.

Claim 2: Compound X1 belonging to group X.

Provided X1 has the same activity and has the same special technical feature as in claim 1, unity is present.

10.25 **Example 5**

Claim 1: A process for treating textiles comprising spraying the material with a particular coating composition under special conditions (for example, as to temperature, irradiation).

Claim 2: A textile material coated according to the process of claim 1.

Claim 3: A new nozzle arrangement usable with a spraying machine to provide better distribution of the composition being sprayed.

The process according to claim 1 imparts unexpected properties to the product of claim 2. The special technical feature in claim 1 is the use of special process conditions corresponding to what is made necessary by the choice of the particular coating. Unity exists between claims 1 and 2. The nozel in claim 3 does not correspond to the above identified special technical feature. Unity does not exist between claim 3 and claims 1 and 2.

10.26 **Example 6**

Claim 1: A fuel burner with tangential fuel inlets into a mixing chamber.

Claim 2: A process for making a fuel burner including the step of forming tangential fuel inlets into a mixing chamber.

Claim 3: A process for making a fuel burner including casting step A.

Claim 4: An apparatus for carrying out a process for making a fuel burner including feature X resulting in the formation of tangential fuel inlets.

Claim 5: An apparatus for carrying out a process for making a fuel burner including a protective housing B.

Claim 6: A process of manufacturing carbon black including the step of tangentially introducing fuel into a mixing chamber of a fuel burner.

Unity exists between claims 1, 2, 4, and 6. The special technical feature common to all the claims is the tangential fuel inlets. Claims 3 and 5 lack unity with claims 1, 2, 4, and 6 since claims 3 and 5 do not include the same or corresponding special technical feature as set forth in claims 1, 2, 4, and 6. Claims 3 and 5 would also lack unity with one another.

10.27 **Example 7**

Claim 1: A high corrosion resistant and high strength ferritic stainless steel strip consisting essentially of, in percent by weight: Ni=2.0-5.0; Cr=15-19; Mo=1-2; and the balance Fe, having a thickness of between 0.5 and 2.0 mm and a 0.2% yield strength in excess of 50 kg/mm squared.

Claim 2: A method of producing a high corrosion resistant and high strength ferritic stainless steel strip consisting essentially of, in percent by weight: Ni=2.0-5.0; Cr=15-19; Mo=1-2; and the balance Fe, comprising the steps of:

(a) hot rolling to a thickness between 2.0 and 5.0 mm;

(b) annealing the hot rolled strip at 800-1000°C under substantially no oxidizing conditions;

(c) cold rolling the strip to a thickness of between 0.5 and 2.0 mm; and

(d) final annealing the cold rolled strip at between 1120 and 1200°C for a period of 2-5 minutes.

Unity exists between product claim 1 and process claim 2. The special technical feature in the product claim is the 0.2% yield strength in excess of 50 kg/mm squared. The process steps in claim 2 inherently produce a ferritic stainless steel strip with a 0.2% yield strength in excess of 50 kg/mm squared. Even if this feature is not apparent from the wording of claim 2, it is clearly disclosed in the description. Therefore said process steps are the special technical feature which correspond to the limitation in the product claim directed to the same ferritic stainless steel with the claimed strength characteristics.

CLAIMS IN THE SAME CATEGORY

10.28 **Example 8**

Claim 1: Plug characterized by feature A.

Claim 2: Socket characterized by corresponding feature A.

Feature A is a special technical feature that is included in both claims 1 and 2 and therefore unity is present.

10.29 **Example 9**

Claim 1: Transmitter provided with time axis expander for video signals.

Claim 2: Receiver provided with time axis compressor for video signals received.

Claim 3: Transmission equipment for video signals comprising a transmitter provided with time axis expander for video signals and a receiver provided with time axis compressor for video signals received.

The special technical features are, in claim 1 the time axis expander, and in claim 2 the time axis compressor, which are corresponding technical features. Unity exists between claims 1 and 2. Claim 3 includes both special technical features and has unity with claims 1 and 2. The requirement for unity would still be met in the absence of the combination claim (claim 3).

10.30 **Example 10**

Claim 1: Conveyor belt with feature A.

Claim 2: Conveyor belt with feature B.

Claim 3: Conveyor belt with features A + B.

Feature A is a special technical feature and feature B is another unrelated special technical feature.

Unity exists between claims 1 and 3 or between claims 2 and 3, but not between claims 1 and 2.

10.31 **Example 11**

Claim 1: Control circuit A for a d.c. motor.

Claim 2: Control circuit B for a d.c. motor.

Claim 3: An apparatus including a d.c. motor with control circuit A.

Claim 4: An apparatus including a d.c. motor with control circuit B.

Control circuit A is a special technical feature and control circuit B is another unrelated special technical feature.

Unity exists between claims 1 and 3 or between claims 2 and 4, but not between claims 1 and 2 or 3 and 4.

10.32 **Example 12**

Claim 1: A display with features A + B.

Claim 2: A display according to claim 1 with additional feature C.

Claim 3: A display with features A + B with additional feature D.

Unity exists between claims 1, 2, and 3. The special technical feature common to all the claims is features A + B.

10.33 **Example 13**

Claim 1: Filament A for a lamp.

Claim 2: Lamp B having filament A.

Claim 3: Searchlight provided with lamp B having filament A and a swivel arrangement C.

Unity exists between claims 1, 2, and 3. The special technical feature common to all the claims is the filament A.

10.34 **Example 14**

Claim 1: A marking device for marking animals, comprising a disc-shaped element with a stem extending normally therefrom, the tip of which is designed to be driven through the skin of the animal to be marked, and a securing disk element to be fastened to the protruding tip of the stem on the other side of skin.

Claim 2: An apparatus for applying the marking device of claim 1, constructed as a pneumatically actuated gun for driving the stem of the disc-shaped element through the skin, and provided with a supporting surface adapted for taking up a securing disc element, to be placed at the other side of the body portion in question of the animal to be marked.

The special technical feature in claim 1 is the marking device having a disc-shaped element with a stem and a securing disc element to be fastened to the tip of the stem. The corresponding special technical feature in claim 2 is the pneumatically actuated gun for driving the marking device and having a supporting surface for the securing disc element. Unity exists between claims 1 and 2.

10.35 **Example 15**

Claim 1: Compound A.

Claim 2: An insecticide composition comprising compound A and a carrier.

Unity exists between claims 1 and 2. The special technical feature common to all the claims is compound A.

10.36 **Example 16**

Claim 1: An insecticide composition comprising compound A (consisting of a1, a2...) and a carrier.

Claim 2: Compound a1.

All compounds A are not claimed in the product claim 2 for reasons of lack of novelty of some of them for instance.

There is nevertheless still unity between the subject matter of claims 1 and 2 provided a_1 has the insecticidal activity that is also the special technical feature for compound A in claim 1.

10.37 **Example 17**

Claim 1: A chair with a lifting mechanism.

Claim 2: A chair with a mechanical screw lifting mechanism.

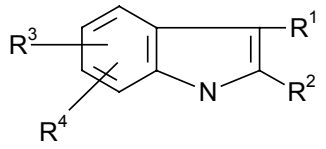
Claim 3: A chair with a hydraulic lifting mechanism.

Unity exists between claims 1-3. The special technical feature common to all the claims is the lifting mechanism. However, if any lifting mechanism is known in the art, unity would be lacking because there would not be a special technical feature common to all the claims.

MARKUSH PRACTICE

10.38 **Example 18: Common Structure (Pharmaceutical)**

Claim 1: A compound of the formula:

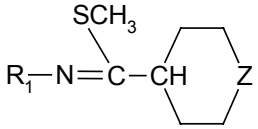


wherein R^1 is selected from the group consisting of phenyl, pyridyl, thiazolyl, triazinyl, alkylthio, alkoxy, and methyl; R^2-R^4 are methyl, benzyl, or phenyl. The compounds are useful as pharmaceuticals for the purpose of enhancing the capacity of the blood to absorb oxygen.

In this case the indolyl moiety is the significant structural element that is shared by all of the alternatives. Since all the claimed compounds are alleged to possess the same utility, unity is present.

10.39 **Example 19: common structure: (Pharmaceutical)**

Claim 1: A compound of the formula:



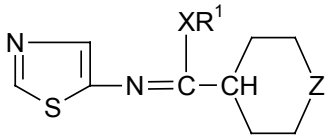
wherein R1 is selected from the group consisting of phenyl, pyridyl, thiazolyl, triazinyl, alkylthio, alkoxy, and methyl; Z is selected from the group consisting of oxygen (O), sulfur (S), imino (NH), and methylene (-CH2-).

The compounds are alleged to be useful as pharmaceuticals for relieving lower back pain.

In this particular case the iminothioether group -N=C-SCH3 linked to a six atom ring is the significant structural element which is shared by all the alternatives. Thus, since all the claimed compounds are alleged to possess the same use, unity would be present.

10.40 **Example 20: Common Structure (Pharmaceutical)**

Claim 1: A compound of the formula:

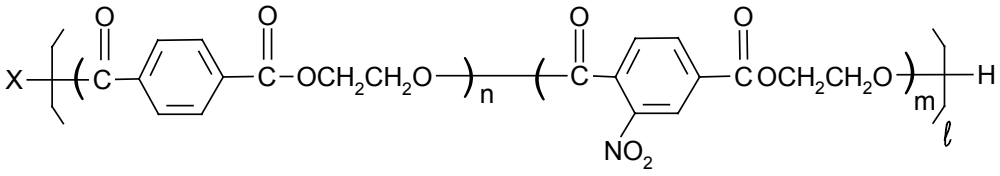


wherein R^1 is methyl or phenyl, X and Z are selected from oxygen (O) and sulfur (S).

The compounds are useful as pharmaceuticals and contain the 1,3-thiazolyl substituent which provides greater penetrability of mammalian tissue which makes the compounds useful as relievers for headaches and as topical anti-inflammatory agents.

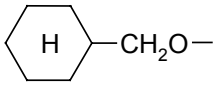
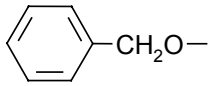
All compounds share a common chemical structure, the thiazole ring and the six atom heterocyclic compound bound to an imino group, which occupy a large portion of their structure. Thus, since all the claimed compounds are alleged to possess the same use, unity would be present.

10.41 **Example 21: Common Structure**



$1 \leq \ell \leq 10$

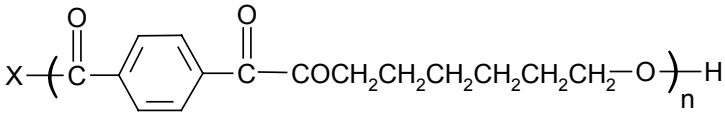
$200 \geq n + m \geq 100$

X:  *or* 

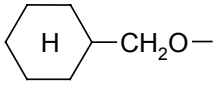
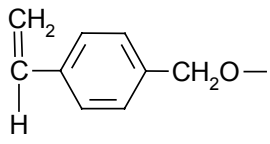
All of the above copolymers have in common a thermal degradation resistance property, due to the reduced number of free COOH radicals by esterification with X of the end COOH radicals which cause thermal degradation.

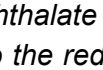
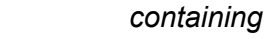
The chemical structures of the alternatives are considered to be technically closely interrelated to one another. A grouping in one claim is therefore allowed.

10.42 **Example 22: Common Structure:**



$100 \geq n \geq 50$

X:  *or* 

The compound obtained by esterifying the end COOH radical of known polyhexamethyleneterephthalate with  *has a thermal degradation resistant property, due to the reduced number of free COOH radicals which cause thermal degradation. In contrast, the compound obtained by esterifying the end COOH radical of known polyhexamethyleneterephthalate with a vinyl compound containing a*  *moiety serves as a raw material for a setting resin when mixed with unsaturated monomer and cured (addition reaction).*

All esters covered by the claim do not have a property or activity in common. For example, the product obtained through esterification with the "CH_2 = CH" vinyl compound does not have a thermal degradation resistant property. The grouping in a single application is not allowed.

10.43 **Example 23: No Common Structure**

Claim 1: A herbicidal composition consisting essentially of an effective amount of the mixture of A 2,4-D(2,4-dichloro-phenoxy acetic acid) and B a second herbicide selected from the group consisting of copper sulfate, sodium chlorate, ammonium sulfamate, sodium trichloroacetate, dichloropropionic acid, 3-amino-2,5-dichlorobenzoic acid, diphenamid (an amide), ioxynil (nitrile), dinoseb (phenol), trifluralin (dinitroaniline), EPTC (thiocarbamate), and simazine (triazine) along with an inert carrier or diluent.

The different components under B must be members of a recognized class of compounds. Consequently in the present case a unity objection would be raised because the members of B are not recognized as a class of compounds, but, in fact, represent a plurality of classes which may be identified as follows:

(a) inorganic salts:
- copper sulfate
- sodium chlorate
- ammonium sulfamate

(b) organic salts and carboxylic acids:
- sodium trichloroacetate
- dichloropropionic acid
- 3-amino-2,5-dichlorobenzoic acid

(c) amides:
- diphenamid

(d) nitriles:
- ioxynil

(e) phenols:
- dinoseb

(f) amines:
- trifluralin

(g) heterocyclic:
- Simazine

10.44 **Example 24 (Pharmaceutical)**

Claim 1: A pharmaceutical compound of the formula:

A – B – C – D – E

wherein:

A is selected from C_1-C_{10} alkyl or alkenyl or cycloalkyl, substituted or unsubstituted aryl or C_5-C_7 heterocycle having 1-3 heteroatoms selected from O and N;

B is selected from C_1-C_6 alkyl or alkenyl or alkynyl, amino, sulfoxy, C_3-C_8 ether or thioether;

C is selected from C_5-C_8 saturated or unsaturated heterocycle having 1-4 heteroatoms selected from O, S or N or is a substituted or unsubstituted phenyl;

D is selected from B or a C_4-C_8 carboxylic acid ester or amide; and

E is selected from substituted or unsubstituted phenyl, naphthyl, indolyl, pyridyl, or oxazolyl.

From the above formula no significant structural element can be readily ascertained and thus no special technical feature can be determined. Lack of unity exists between all of the various combinations. The first claimed invention would be considered to encompass the first mentioned structure for each variable, that is, A is C_1 alkyl, B is C_1 alkyl, C is a C_5 saturated heterocycle having one O heteroatom, D is C_1 alkyl, and E is a substituted phenyl.

10.45 **Example 25**

Claim 1: *Catalyst for vapor phase oxidation of hydrocarbons, which consists of (X) or (X+a).*

In this example (X) oxidizes RCH3 into RCH2OH and (X+a) oxidizes RCH3 further into RCOOH.

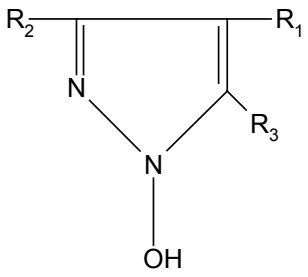
Both catalysts share a common component and a common activity as oxidation catalyst for RCH3. With (X+a) the oxidation is more complete and goes until the carboxylic acid is formed but the activity still remains the same.

A Markush grouping is acceptable in this case.

INTERMEDIATE/FINAL PRODUCT

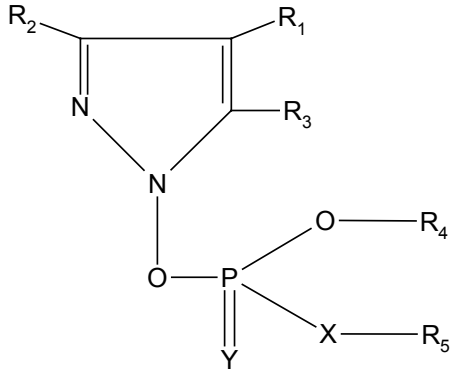
10.46 **Example 26**

Claim 1:



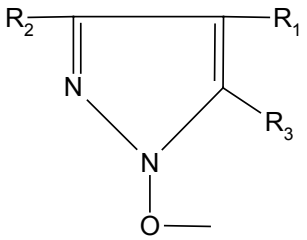
(intermediate)

Claim 2:



(final product)

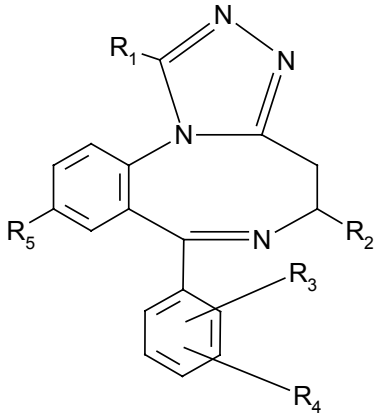
The chemical structures of the intermediate and final product are technically closely interrelated. The essential structural element incorporated into the final product is:



Therefore, unity exists between claims 1 and 2.

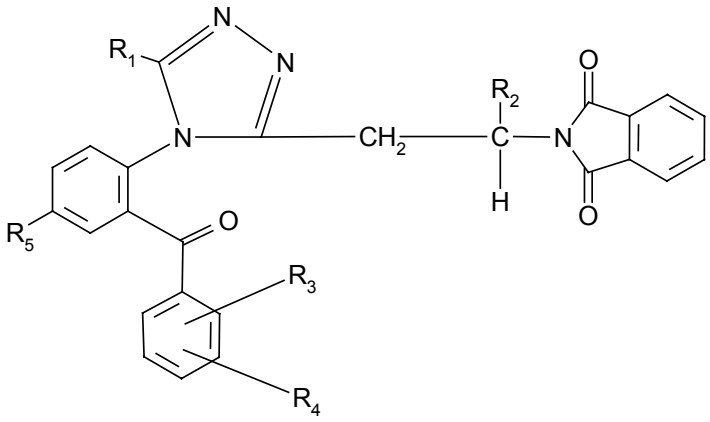
10.47 **Example 27**

Claim 1:



(I)

Claim 2:



(II)

(II) is described as an intermediate to make (I). The closure mechanism is one well known in the art. Though the basic structures of compound (I) (final product) and compound (II) (intermediate) differ considerably, compound (II) is an open ring precursor to compound (I). Both compounds share a common essential structural element that is the linkage comprising the two phenyl rings and the triazole ring. The chemical structures of the two compounds are therefore considered to be technically closely interrelated.

The example therefore satisfies the requirement for unity of invention.

10.48 **Example 28**

Claim 1: Amorphous polymer A (intermediate).

Claim 2: Crystalline polymer A (final product).

In this example a film of the amorphous polymer A is stretched to make it crystalline.

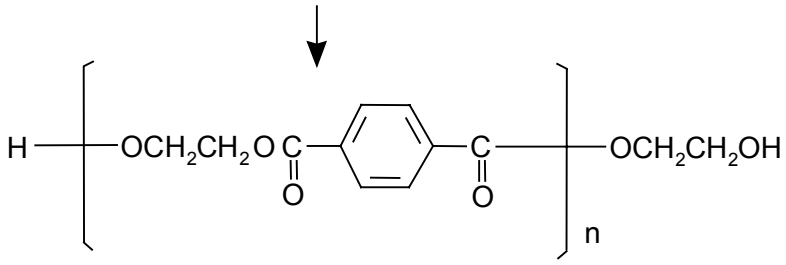
Here unity exists because there is an intermediate final product relation in that amorphous polymer A is used as a starting product to prepare crystalline polymer A.

For purposes of further illustration, assume that the polymer A in this example is polyisoprene. Here the intermediate, amorphous polyisoprene, and the final product, crystalline polyisoprene, have the same chemical structure.

10.49 **Example 29**

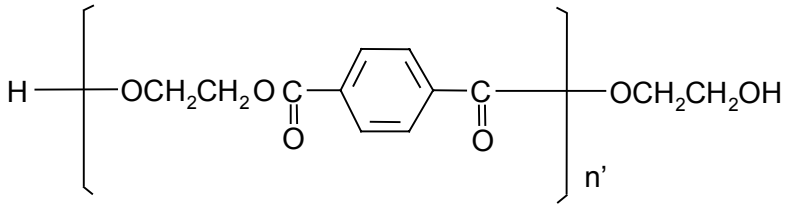
Claim 1: Polymeric compound useful as fiber material identified by the following general formula:

[repeating unit (X)]



Claim 2: Compound identified by the following general formula:

(useful as intermediate for polymeric compound I)



(primary condensation product)

The two inventions are in an intermediate and final product relationship.

Substance (II) is a raw material for substance (I).

Meanwhile, both compounds share an essential structural element (repeating unit (X)) and are technically closely interrelated. The intermediate and final products therefore satisfy the requirements for unity.

10.50 **Example 30**

Claim 1: Novel compound having structure A (Intermediate).

Claim 2: Product prepared by reacting A with a substance X (Final Product).

(see below for further details)

10.51 **Example 31**

Claim 1: Reaction product of A and B (Intermediate).

Claim 2: Product prepared by reacting the reaction product of A and B with substances X and Y (Final Product).

In examples 30 and 31 the chemical structure(s) of the intermediate and/or the final product is not known. In (30) the structure of the product of claim 2 (the final product) is not known. In (31) the structures of the products of claim 1 (the intermediate) and claim 2 (the final product) are unknown.

Unity exists if there is evidence that would lead one to conclude that the characteristic of the final product which is the inventive feature in the case is due to the intermediate. For example, the purpose for using the intermediates in Examples 30 or 31 is to modify certain properties of the final product. The evidence may be in the form of test data in the specification showing the effect of the intermediate on the final product. If no such evidence exists then there is no unity on the basis of an intermediate-final product relationship.

"NON-MARKUSH" PHARMACEUTICAL INVENTION

10.52 **Example 32: Method of Screening and Compounds Identified by the Method**

Claim 1: A method to identify compounds that are antagonists of receptor R comprising the steps of contacting cells expressing on their outer membrane receptor R with its natural ligand; observing the binding of the ligand; contacting said cells bound to said ligand with a candidate compound selected from a library of compounds; and observing any change in the binding of the ligand.

Claim 2: Compound X, having formula 1.

Claim 3: Compound Y, having formula 2.

Claim 4: Compound Z, having formula 3.

Receptor R and its natural ligand are proposed as a drug target. Compounds that antagonize receptor R are proposed to have physiological effects that may be useful in therapeutic treatment. The aim is to identify lead compounds as a basis for further screening and testing of combinatorial libraries. A library is described as providing many possible structurally different compounds. Examples show that the method of claim 1 can be used to identify compounds affecting the physiological effect of binding of the natural ligand to the receptor. Only compounds X, Y and Z were shown to have such effects, but they do not appear to share a significant structural element. The description is silent with regard to both the relationship between the structure and activity of the claimed compounds and the relationship between the structure of receptor R and the structure of the compounds.

Receptor R, its biological function, and its natural ligand are known in the prior art. No compounds that function as antagonists of receptor R are known.

The technical feature of method claim 1 resides in the step of observing the effect of the candidate compounds on ligand binding in a screening assay. Neither the same nor a corresponding special technical feature is present in any of compounds X, Y, or Z. No manufacturing relationship exists between the screening method and the claimed compounds. Further, the screening method is not a method of using claimed compounds X, Y, and Z. In the absence of any teaching as to the structure required for a compound to act as a receptor R antagonist, there is no single general concept that links the method to the claimed compounds. Thus, unity of invention is lacking.

Compounds X, Y, and Z would be regarded as having the same or corresponding technical feature if they had a common property or activity, and shared a significant structural element that is essential to the common property or activity. While compounds X, Y, and Z do share the common property of antagonizing receptor R, there is no teaching as to a shared significant structural element, and hence, there is no disclosure of the same or corresponding technical feature.

One possible grouping would be:

Invention 1: Method to identify compounds... (claim 1)

Invention 2: Compound X (claim 2)

Invention 3: Compound Y (claim 3)

Invention 4: Compound Z (claim 4)

If prior art existed teaching either protein X or the DNA encoding protein X, the examiner may find that the same or corresponding technical feature did not make a contribution over the prior art, that is, was not a special technical feature, and therefore unity was lacking.

CHAPTER 11
PRIOR ART

PRIOR ART GENERALLY

11.01 The prior art is defined in Article 3 of Law 82/2002 for the purposes of assessing the novelty (see chapter 12) and inventive step (whether or not the invention is obvious; see chapter 13) of an invention as set forth in 82/2002 Article 1 of that Law.

Law 82/2002 Articles 1 and 3 provide as follows:

Law Article 1

A patent shall be granted, in accordance with the provisions of this Law, to any

Industrially applicable invention, which is new, involves an inventive step, whether connected with new industrial products, new industrial processes, or a new application of known industrial processes.

The patent is also granted, independently, for any modification, improvement or addition to a previously patented invention, which meets the criteria of being new, inventive and industrially applicable, as stated in the preceding paragraph; in which case the patent shall be granted, under the provisions of this Law, to the owner of the modification, improvement or addition.

Law Article 3

An invention shall not be considered wholly or partly new:

(i) if, before the filing date of the patent application, a patent application has been filed for the same invention or a patent was already issued in or outside Egypt for the invention or part thereof;

(ii) if, before the filing date of the patent application, the invention was used publicly in; or outside Egypt, or the description of which was disclosed in a manner *so as* a person having expertise in the art is able to exploit it.

According to the provisions of the preceding Article, disclosure shall not include displaying the invention in national or international exhibitions within the six months before the date on which the application was filed.

The Regulations shall specify the conditions and the procedures for the disclosure of a patent.

11.02 Law Article 3 defines the prior art as anything “before the filing date of the patent application” which shows “the invention was used publicly in or outside Egypt or the description of which was disclosed in a manner so as a person having expertise in the art is able to exploit it.” However, this “shall not include displaying the invention in national or international exhibitions within the six months before the date on which the application was filed.”

11.03 There are no restrictions whatsoever as to the geographical location where, or the language or manner (including written disclosure posted on the Internet or an on-line database) in which, the relevant information contained in the written disclosure was made available to the public. There are no restrictions as to the age of the prior art document (whether it is 100 years old or was published one day prior to the effective filing date) so

long as the document was made available to the public before the effective filing date. If the applicant describes certain subject matter as prior art, that subject matter (for example, a figure in an application labeled as "prior art") may be presumed by the examiner to constitute prior art. The presumption that this subject matter constitutes prior art may be rebutted by the applicant.

DATE OF DISCLOSURE

11.04 Reserved

11.05 Reserved

11.06 For the purposes of the examiner search of the prior art, the "effective filing date" of the application being examined is:

(i) the filing date of the Egyptian national application; or

(ii) the international filing date of the PCT international application; or

(iii) where the Egyptian national application and/or international application validly claims the priority of an earlier application, the filing date of such earlier application.

11.07 Clearly, when a potentially relevant document has been published between a claimed priority date of the application and its filing date in Egypt either as an international filing date or a Paris Convention filing date, the examiner is required to consider whether the claimed priority date is valid for the purposes of determining the effective filing date of the claims in the application.

DOCUMENTS CASTING DOUBT ON PRIORITY CLAIM MADE IN THE APPLICATION

11.08 Documents showing that a priority claim in the application might not be justified should be mentioned in the letter to applicant. (For example, an earlier application by the same applicant, or a patent resulting from that earlier application, indicating that the application from which priority is claimed may not be the first application for the invention concerned, would be ground for requesting clarification from the applicant.) No special action is normally made by the examiner to determine whether the priority claim made in the application is justified, except when there is a special reason to do so. This could be the situation when priority is claimed of a US application, since the US has a continuation-in-part practice. A continuation-in-part application is a second filed application which has substantially the same subject matter as the earlier application but adds some new subject matter not disclosed in the earlier application. Another example might be, when the country of residence of the applicant is different from the country of the priority application, it may be an indication of possible lack of first filing.

OTHER RELEVANT DOCUMENTS

11.09 Furthermore, the examiner should cite published patent applications or patents whose publication date is the same as, or later than, but whose filing date, or, where applicable, claimed priority date, is earlier than the filing date of the application searched, and which would constitute relevant prior art for the purposes of Law Article 3 (1). This would be the case when the pending application being examined in the Patent Office claims the same invention as the published application or patent.

11.10 Reserved

11.11 Reserved

COPENDING APPLICATIONS FROM THE SAME APPLICANT

11.12 Two patents shall not be granted to the same applicant for one invention. It is however, permissible to allow an applicant to proceed with two applications having the same description where the claims are quite distinct in scope and directed to different subject matter. However, in the rare case in which there are two or more applications from the same applicant and the claims of those applications have the same priority date and relate to the same invention (even though they may not necessarily claim that invention in identical terms), the second filed application should be rejected by the first filed application. For determining the order of filing, the examiner should look at the date, time, and serial number of the two applications.

DOCUMENTS RELEVANT TO UNDERSTANDING THE INVENTION

11.13 Certain other situations may occur in which a document published on or after the effective filing date is relevant;

Examples:

A later document containing the principle or theory underlying the invention, which may be useful for a better understanding of the invention, or

A later document showing that the reasoning or the facts underlying the invention are incorrect.

The search is not extended for this purpose, but documents of this nature known to the examiner may be selected for citation. Such documents are cited and their relevance explained.

FORM OF DISCLOSURE

AVAILABILITY OF WRITTEN DISCLOSURES TO THE PUBLIC

11.14 A written disclosure, that is, a document, is regarded as made available to the public if, at the effective filing date (see paragraphs 11.04 to 11.07), it was possible for members of the public to gain access to the content of the document and to acquire possession of the content of the document, and there was no bar of confidentiality restricting the use or dissemination of knowledge gained thereby. Whether the absence of an index or a catalogue of the document constitutes inaccessibility of the content of the document to the public is determined in accordance with the above principle. Where the document only provides the month or the year, but not the specific date, on which the document was made

available to the public, the content of the document is presumed to have been made available to the public on the last day of that month or that year, respectively, unless evidence is provided to prove otherwise.

DISCLOSURE ON THE INTERNET

11.15 Prior art disclosure on the Internet or on an on-line database is considered in the same manner as other forms of written disclosure. Information disclosed on the Internet or in an on-line database are considered to be publicly available as of the date the disclosure was publicly posted. When citing an Internet disclosure (a web page), problems may arise in establishing the date of publication and whether or not the disclosure has been modified over time. When establishing the publication date of a web page, it is important to distinguish between two types of Internet disclosure, that is,: those made on the web sites of trusted publishers and those made on web sites of unknown reliability.

DISCLOSURE MADE ON THE WEB SITES OF TRUSTED PUBLISHERS

11.16 Examples of these are on-line scientific journals (which make available the contents of a paper journal on-line, or may be uniquely on-line publications). The web sites of newspapers, periodicals, television and radio stations will usually fall into this category as well. This type of Internet disclosure gives the publication date of the disclosure which, in the absence of evidence to the contrary, should be taken at face value. The examiner should cite the Internet disclosure and use it in determining patentability. The onus is on the applicant to prove otherwise.

11.17 It may happen that the publication date is not sufficiently identified to know if it is published in time to be considered to be state of the art (that is, it is not clear if the disclosure occurred before or after the valid priority date). This may happen, for example, where only the month or year of publication is given and this is the same as the month or year of the valid priority date of the application. In these cases, the examiner may need to make enquiries with the owner of the web site in order to establish the publication date to a sufficient degree of accuracy to know if it is relevant state of the art in the same way as it would act in order to establish a more accurate publication date for a paper published document. This type of enquiry should not be made without the advance approval of the President of the Patent Office.

DISCLOSURES MADE ON WEB SITES OF UNKNOWN RELIABILITY

11.18 Examples of such web sites include those belonging to private individuals, private organizations (for example, clubs), commercial web sites (for example, advertising) etc. Where such an Internet disclosure is retrieved during the search and it does not give any explicit indication of the publication date in the text of the disclosure, the examiner may consider using those technical means available to it to attempt to reveal the publication date.

11.19 Such technical means include:

(a) Information relating to the publication date embedded in the Internet disclosure itself.. Date information is sometimes hidden in the programming used to create the web site, but is not visible in the web page as it appears in the browser,

(b) Indexing dates given to the web page by search engines. These are usually later than the actual publication date of the disclosure since the search engines usually take some time to index a new web site); and

(c) Information available relating to the web site on commercial Internet archiving databases for example, the “Internet Archive Wayback Machine”.

11.20 Where the examiner obtains an electronic document which establishes the publication date for the Internet disclosure, he should make a print-out of this document, which must mention both the URL of the relevant Internet disclosure and the date of publication of that relevant Internet disclosure. The examiner must then cite this print-out as a relevant Internet disclosure according to the relevance of its content and according to the date as established. Where the examiner is unable to establish the publication date of the relevant Internet disclosure and it is relevant to the inventive step and/or novelty of the claimed invention, he should cite it for those claims which it would have affected if it were published in time and giving it the date it was printed out as the publication date.

11.21 Where this type of Internet disclosure does explicitly mention a publication date and this publication date:

(i) Is not contradicted by the information sources mentioned above

(In this regard it should be noted that the indexing date given by a search engine is usually later than the actual publication date and so where the examiner uncovers an indexing date for an Internet disclosure which is later than the publication date given in the Internet disclosure itself; this does not necessarily mean that the Internet disclosure was made available later than it claimed. It simply means that it was indexed by that search engine after it was made available); and

(ii) Is accurate enough to establish if the document was published early enough to be considered relevant,

then the examiner should trust the date given and give this as the publication date and use this publication for determining patentability. The responsibility is on the applicant to prove otherwise.

11.22 In the absence of evidence to the contrary, the examiner should assume that the content of the Internet disclosure has not changed over time.

11.23 Reserved.

DOCUMENTS REPRODUCING AN EARLIER ORAL DESCRIPTION

11.24 Where an oral description (for example, public lecture) or a prior use or sale (for example, display at a public exhibition) was publicly available before effective filing date of the application but a document, which reproduces the oral description or gives an account of the prior use or sale, was published on or after the effective filing date of the application, that document may be cited by the examiner. An exhibition is not treated as part of the prior art for purposes of determining novelty and inventive step unless such activity took place more than 6 months before the filing date (Law Article 3). Applicant must provide a certificate as set forth in Regulation Article 3(8). Also see Regulation Articles 49 to 51 for the requirements for obtaining the certificate.

DIFFICULTY IN ESTABLISHING DATE OF A DOCUMENT

11.25 The search may uncover a document where there is difficulty in establishing whether the date of publication or public availability of the document is or is not the same as, or later than, the filing date of the application. The examiner should try to remove any doubt that may exist. Additional documents providing evidence in the case of doubt may be cited. Any indication in a document of the date of its publication should be accepted as correct by the examiner unless proof to the contrary has been offered, showing earlier publication, or by the applicant, showing later publication. If the applicant presents sound reasons for doubting that the document forms part of the prior art in relation to his application and any further investigation does not produce evidence sufficient to remove that doubt, the examiner should not pursue the matter further.

EFFECTIVE FILING DATE IN RELATION TO INDIVIDUAL CLAIMS OR PARTS OF CLAIMS

11.26 It should be noted that the “effective filing date,” for the purpose of considering prior art, is defined in paragraph 11.04. It should be remembered also that different claims, or different alternatives claimed in one claim, may have different effective filing dates.

11.27 Of course, if all the matter in the prior art was made available to the public before the date of the earliest priority document, the examiner need not (and should not) concern himself with the allocation of priority dates.

11.28 The validity of priority dates for a claim or a part of a claim is considered in detail in Chapter 6.

CHAPTER 12
NOVELTY

MEANING OF NOVELTY

12.01 For the purposes of the examination, the invention, as defined by a claim, lacks novelty (Law Art.3) if every element or step is explicitly or inherently disclosed within the prior art (see paragraphs 11.01 and 11.04), including any features that are implied, or would be considered to be inherent, by a person skilled in the art (see paragraph 13.11 for a definition of the "person skilled in the art"). Inherency requires that the extrinsic evidence relied on by the examiner must make clear that the missing descriptive matter is necessarily present in the reference, and that it would be so recognized by persons skilled in the art. Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient. Well-known equivalents not disclosed within a prior art document are not considered when assessing novelty; this is a matter of obviousness (see chapter 13 - Inventive Step). Naturally the same considerations apply selecting documents for inclusion in the search report (except that in the case where the relevant date may be different, see paragraphs 11.02 to 11.05).

12.02 The prior art disclosure must enable a person skilled in the art to carry out the claimed invention. Ordinarily, enablement may be inferred by the examiner when considering patent documents (published applications and issued patents) within the prior art. When considering non-patent literature that on its face raises a question as to enablement, the examiner should determine that the prior art would have enabled a person skilled in the art to carry out the claimed invention. When determining whether a particular document is enabling and therefore defeats novelty, knowledge from outside the prior art document may be considered where appropriate, if that knowledge was known on the effective date of the particular document. A chemical compound, the name or formula of which was mentioned in a document, is not considered as known unless the information in the document, together, where appropriate, with other knowledge generally available to a person skilled in the art, enable it to be prepared and separated or, for instance in the case of a product of nature, only to be separated. A prior art document that does not defeat novelty because it is not enabling for the claimed invention may nonetheless be relied upon in determining whether the claimed invention lacks inventive step. See chapter 13.

CONSIDERATIONS IN DETERMINING NOVELTY

METHODOLOGY

12.03 For the assessment of novelty, the examiner should apply the following steps:

(i) evaluate the elements of the claimed invention;

(ii) determine if a document under consideration forms part of the "prior art" (see paragraphs 11.01 to 11.07);

(iii) assess whether each and every element or step of the claimed invention was explicitly or inherently disclosed in combination by the document, to a person skilled in the art, on the date of publication of the document.

INHERENT OR IMPLICIT DISCLOSURE

12.04 Lack of novelty may be apparent from what is explicitly stated in a published document, or it may be apparent from an inherent or implicit teaching of the document. For example, where the elastic properties of rubber are relied upon in a document that does not explicitly state

that rubber is an “elastic material,” a claim to an “elastic material” is anticipated because the rubber taught in the prior art inherently is an “elastic material”. Alternatively, lack of novelty may be implicit in the sense that, in carrying out the teaching of the prior document, the skilled person would inevitably arrive at a result falling within the terms of the claim. Lack of novelty of this kind should be raised by the examiner only where there can be no reasonable doubt as to the practical effect of the prior teaching. Otherwise it should be considered in respect of inventive step (see chapter 13).

INTERPRETATION OF CLAIMS

12.05 In interpreting claims for the consideration of novelty, the examiner should have regard to the guidance given in paragraphs 5.20 to 5.41. In particular, the examiner should remember that statements in the claim reciting the purpose or intended use must be evaluated to determine whether the recited purpose or intended use results in a structural difference (or in the case of process claims, a difference in the process steps) between the claimed invention and the prior art. Non-distinctive characteristics of a particular intended use should be disregarded (see paragraphs 5.21 to 5.23). For example, a claim to a substance X for use as a catalyst would not be considered to be novel over the same substance known as a dye, unless the use referred to implies a particular form of the substance (for example, the presence of certain additives) which distinguishes it from the known form of the substance. That is to say, characteristics not explicitly stated but implied by the particular use should be taken into account. For example, if a claim refers to a “mould for molten steel”, this implies certain limitations for the mould. Therefore a plastic ice cube tray with a melting point much lower than that of steel would not come within the scope of the claim which would thereby be considered as being novel.

COMBINING DOCUMENTS

12.06 It should be noted that in considering novelty (as distinct from inventive step), it is not permissible to combine separate items of prior art together (see paragraph 13.12). However, if a document (the “primary” document) refers explicitly to a second document (for example, as providing more detailed information on certain features), the teachings of the second document may be regarded as incorporated into the primary document to the extent indicated in the primary document. Equally, it is permissible to use a dictionary or similar document of reference in order to interpret how a special term used in the primary document would have been understood on the date of publication. It is also permissible to rely on additional documents as evidence to show that the disclosure of the primary document was sufficient (for example, for a chemical compound to be prepared and separated or, in the case of a product of nature, to be separated). See paragraph 12.02. It is also permissible to rely on additional documents as evidence to show that a characteristic not disclosed in the primary document was inherent in the primary document on the date of publication of the primary document (for example, documents that teach rubber to be an “elastic material” for the example set forth in paragraph 12.04).

ALTERNATIVES

12.07 Where a claim contains alternatives, for example Markush claims (P1, P2, P3 ... Pn), if any of the alternatives are disclosed in the prior art, the claim will not be considered to be novel. See Section 10.17 for an explanation of Markush practice.

GENERIC VS. SPECIFIC DISCLOSURES

12.08 Where a claim recites an invention in generic terms, for the determination of novelty, the disclosure of a specific example falling within the parameters of the generic claim anticipates the generic claim. For example, a disclosure of copper in a prior art document defeats the novelty of metal as a generic concept, but not the novelty of any metal other than copper, and a disclosure of rivets defeats the novelty of fastening means as a generic concept, but not the novelty of any specific fastening means other than rivets.

12.09 An item of prior art that discloses a genus does not always anticipate a claim to a species falling within the genus. In other words, if a claim under examination recites a specific example, and that specific example is not explicitly named but falls within a generic disclosure found in an item of prior art, the claim is not anticipated unless the specific example is identified with sufficient specificity in the item of prior art. If the item of prior art identifies the claimed example with sufficient specificity, that example lacks novelty no matter how many other species are additionally described in the item of prior art.

RANGES

12.10 A specific example in the item of prior art which is within a claimed range anticipates the range claimed. Therefore, where, as by a recitation of ranges or otherwise, a claim covers several compositions, the claim is anticipated if one of them is described in the item of prior art. For example, a claim to titanium (Ti) alloy with 0.6 to 0.7% nickel (Ni) and 0.2 to 0.4% Molybdenum (Mo) would be anticipated by an item of prior art that describes a Ti alloy containing 0.65% Ni and 0.3% Mo. Where an item of prior art discloses a range which touches, overlaps or is within the claimed range, but does not disclose a specific example falling within the claimed range, a case by case determination must be made as to the novelty of the claim. In order to anticipate the claim, the claimed subject matter should be disclosed with sufficient specificity in the item of prior art. If the claim is directed to a narrow range, the item of prior art discloses a broad range, and the claimed narrow range is not merely one way of carrying out the teaching of the item of prior art (for example, there is evidence that the effect of the selection (for example, unexpected results) occurred in all probability only within the claimed narrow range), depending on the other facts of the case, it may be reasonable to conclude that the narrow range is not disclosed with sufficient specificity in the prior art in order to anticipate the claims (a selection invention). The unexpected results may also render the claims unobvious. See chapter 13 - Inventive Step.

CHAPTER 13
INVENTIVE STEP

MEANING OF INVENTIVE STEP

13.01 A claimed invention is considered to involve an inventive step if, having regard to the prior art (see paragraph 11.01), it is not, at the relevant date (see paragraphs 11.02 to 11.05) obvious to a person skilled in the art. Novelty and inventive step are different criteria. A claim lacks novelty if every element or step is explicitly or inherently disclosed within the prior art (see paragraph 12.01). The condition of inventive step/non-obviousness is fulfilled if the invention as a whole, compared to the prior art as a whole, would not have been obvious to a person skilled in the art. Multiple items of prior art may be combined in the determination of whether the requirement of inventive step/non-obviousness is met. Therefore, the examiner should take into consideration the claim's relation not only to individual documents or parts thereof taken separately but also to combinations of such documents or parts of documents, where such combinations are obvious to a person skilled in the art.

13.02 The "prior art" for the purposes of considering both novelty and inventive step is as defined in Law Art 3 (see chapter 11);

Law Article 3

An invention shall not be considered wholly or partly new:

(i) if, before the filing date of the patent application, a patent application has been filed for the same invention or a patent was already issued in or outside Egypt for the invention or part thereof;

(ii) if, before the filing date of the patent application, the invention was used publicly in; or outside Egypt, or the description of which was disclosed in a manner so as a person having expertise in the art is able to exploit it.

According to the provisions of the preceding Article, disclosure shall not include displaying the invention in national or international exhibitions within the six months before the date on which the application was filed.

The Regulations shall specify the conditions and the procedures for the disclosure of a patent.

Prior art does not include later published applications or patents although, in the circumstances mentioned in paragraph 11.07, a later published application or patent may be cited.

CONSIDERATIONS IN DETERMINING INVENTIVE STEP

WHAT IS "OBVIOUS"?

13.03 The question to consider, in relation to any claim defining matter for which protection is sought, is whether, at the relevant date of that claim, it would have been obvious to a person skilled in the art to arrive at something falling within the terms of the claim, having regard to the art known at that time. If so, the claim is considered to lack inventive step. The term "obvious" means that which does not go beyond the normal progress of technology but merely follows plainly or logically from the prior art, that is, something which does not involve the exercise of any skill or ability beyond that to be expected of the person skilled in the art.

The following are the basic considerations that apply in determining inventive step/non-obviousness:

(i) The claimed invention must be considered as a whole;

(ii) The references must be considered as a whole and the skilled person must be motivated or prompted into combining the teaching of the documents so as to arrive at the subject matter as claimed, including consideration of a reasonable expectation or likelihood of success; and

(iii) The references must be viewed without the benefit of impermissible hindsight vision afforded by the claimed invention.

LIGHT OF LATER KNOWLEDGE

13.04 In considering inventive step, as distinct from novelty (see paragraph 12.02), it is fair to construe any published document in the light of subsequent knowledge and to have regard to all the knowledge generally available to the person skilled in the art at the relevant date of the claim but see paragraph 13.15.

INVENTION AS A WHOLE; COMBINATION OF KNOWN OR OBVIOUS ELEMENTS

13.05 In determining inventive step (non-obviousness), the invention claimed must normally be considered as a whole. In determining the differences between the prior art and the claims, the question is not whether the differences themselves would have been obvious but whether the claimed invention as a whole would have been obvious. Thus, it is not correct as a general rule, in the case of a combination claim, to argue that the separate features of the combination, taken by themselves, are known or obvious and that "therefore" the whole subject matter claimed is obvious. The only exception to this rule is where there is no functional relationship between the features of the combination. (see the example under paragraph 13.14(c)).

13.06 While the claim should, in each case, be directed to technical features (and not, for example, merely to an idea) in order to assess whether an inventive step is present, it is important for the examiner to bear in mind that there are various ways in which a person skilled in the art may arrive at an invention.

13.07 In identifying the contribution any particular invention makes to the art in order to determine whether there is an inventive step, account should be taken first of what the applicant himself acknowledges in his description and claims to be known. Any such acknowledgment of known art should be regarded by the examiner as being correct unless the applicant states he has made a mistake. However, the further prior art contained in the search report or any additional document considered to be relevant may put the claimed invention in an entirely different perspective from that apparent from the disclosure by itself and, indeed, this cited prior art may cause the applicant voluntarily to amend his claims to redefine his invention. The general knowledge of the person skilled in the art should also be taken into account for the determination of inventive step. Also, the prior art must be enabling for what is taught therein, even if it is not the entirety of the claimed invention. Therefore, whatever combination of items of prior art and admission or general knowledge is used, this combination must provide enablement with respect to the claimed invention.

ASSESSING THE CONTRIBUTION AGAINST THE PRIOR ART

13.08 The following considerations should be applied in the assessment of inventive step/non-obviousness:

(i) Determination of the scope of the claimed invention;

(ii) Determination of the scope of the relevant item(s) of prior art;

(iii) Determination of a person skilled in the art in the relevant case;

(iv) Identification of the differences and similarities between the relevant item(s) of prior art and the claimed invention;

(v) Assessment of whether the claimed invention as a whole would have been obvious to a person skilled in the art having regard to the relevant item(s) of prior art and the general knowledge of a person skilled in the art.

13.09 The invention as a whole is obvious if any item(s) of prior art or general knowledge of the person of skill in the art would have motivated or prompted the person of skill in the art on the relevant date (see paragraphs 11.02 to 11.05) to reach the claimed invention by substituting, combining or modifying one or more of those items of prior art with a reasonable likelihood of success. One particular way to determine inventive step is to apply the problem-solution approach, described in the appendix to this chapter.

13.10 In order to reach a final conclusion as to whether any claim includes an inventive step, it is necessary to determine the difference between the subject matter of that claim as a whole and the whole of the known art. (SSo far as dependent claims are concerned, see also paragraph 13.19.

In considering this matter, the examiner should identify the closest prior art as the basis for the assessment of inventive step. This is considered to be that combination of features derivable from one single reference that provides the best basis for considering the question of obviousness.

In determining the scope of the disclosure of the items of prior art, in addition to the explicit disclosure, an implicit disclosure, that is, a teaching which a person skilled in the art could reasonably draw from the explicit disclosure, should also be taken into account. The critical time for the determination of such disclosure is the claim date of the application concerned. The general knowledge of the person skilled in the art on the relevant date of the claim should also be taken into account.

THE "PERSON SKILLED IN THE ART"

13.11 The person skilled in the art should be presumed to be a hypothetical person having ordinary skill in the art and being aware of what was common general knowledge in the art at the relevant date. The person of skill in the art should also be presumed to have had access to everything in the "prior art," in particular, the documents cited in the search report, and to have had at his disposal the normal means and capacity for routine experimentation. If the problem on which the invention is based and which arises from the closest prior art prompts the person skilled in the art to seek its solution in another technical field, the person skilled in the art in that field is the person qualified to solve the problem. The assessment of whether the solution involves an inventive step must therefore be based on that specialist's knowledge and ability.

There may be instances where it is more appropriate to think in terms of a group of persons, for example, a research or production team, than a single person. This may apply, for example, in certain advanced technologies such as computers or telephone systems and in highly specialized processes such as the commercial production of integrated circuits or of complex chemical substances.

COMBINING TEACHINGS

13.12 In considering whether there is inventive step as distinct from novelty (see chapter 12), it is permissible to combine the teachings of two or more prior art references, for example, different published patents, or several teachings contained in the same prior art reference, such as one particular book, but only where such combination would be obvious to the person skilled in the art. In determining whether it would be obvious to combine the teachings of two or more distinct documents, the examiner should have regard to the following:

(i) whether the nature and content of the documents are such as to make it likely or unlikely that the person skilled in the art would combine them;

(ii) whether the documents come from similar or neighboring technical fields and if not, whether the documents are reasonably pertinent to the particular problem with which the invention was concerned.

13.13 The combination, substitution or modification of the teachings of one or more items of prior art may only lead to a lack of inventive step/obviousness where a person skilled in the art would have been motivated by the prior art or his general knowledge, with a reasonable likelihood, to combine, substitute or modify one or more items of prior art. Conversely, where such combination could not have been expected from a person skilled in the art, the requirement of inventive step (non-obviousness) would be met, even if each single item would have been obvious if taken individually.

The combining of two or more parts of the same document would be obvious if there is a reasonable basis for the person skilled in the art to associate these parts with one another. It would normally be obvious to combine with other prior art documents a well-known text book or standard dictionary; this is only a special case of the general proposition that it is obvious to combine the teaching of one or more documents with the common general knowledge in the art. It would, generally speaking, also be obvious to combine the teachings of two documents, one of which contains a clear and unmistakable reference to the other.

It should be noted that the motivation to modify the prior art teachings need not be the same as the applicant's. It is not necessary that the prior art suggest the combination to achieve the same advantage or result discovered by the applicant. The prior art may suggest the claimed invention, but for a different purpose or to solve a different problem. In some instances the content of a single item of prior art may lead to a finding of lack of inventive step. The following are examples of situations in which this may occur:

(i) Where a technical feature known in a technical field is applied from its original field to another field and its application therein would have been obvious to a person skilled in the art;

(ii) Where a difference between the document's content and the claimed matter is so well known that documentary evidence is unnecessary;

(iii) Where the claimed subject matter relates to the use of a known product, and the use would have been obvious from the known properties of the product;

(iv) where the claimed invention differs from the known art merely in the use of equivalents that are so well known that the citation of documentary evidence is unnecessary

EXAMPLES

13.14 The following examples provide guidance, as to circumstances where a claimed invention should be regarded as obvious or where it involves a positive determination of an inventive step (non-obviousness). It is to be stressed that these examples are only guides for the examiners and that the applicable principle in each case is:, "Was it obvious to a person skilled in the art?" Examiners should avoid attempts to fit a particular case into one of these examples where the example is not clearly applicable. Also, note that this list is not exhaustive.

(a) Claimed inventions involving the application of known measures in an obvious way and in respect of which an inventive step is therefore lacking:

(iii) The teaching of a prior document is incomplete as to the entire claimed invention and at least one of the possible ways of supplying the missing claim feature(s) would naturally or readily occur to the person skilled in the art thereby resulting in the claimed invention.

Example 1*:* The claimed invention relates to a building structure made from aluminum. A prior document discloses the same structure and says that it is of lightweight material but fails to mention the use of aluminum. Aluminum is a light-weight material that is well known in the art to be useful as a building material.

(iv) The claimed invention differs from the prior art merely in the use of well-known equivalents (mechanical, electrical or chemical) possessing the same purpose, wherein the equivalency is recognized in the prior art. Note that the applicant's recognition within the application that an element is equivalent to another, which had previously been used for a different purpose, does not mean that the use of this element instead of the other is obvious.

Example 2*:* The claimed invention relates to a pump-motor combination which differs from a known pump-motor combination solely in that the motor is hydraulic instead of an electric motor.

(v) The claimed invention consists merely in a new use of a well-known material employing the known properties of that material.

Example 3*:* A washing composition containing as a detergent a known compound having the known *property* of lowering the surface tension of water, this property being known to be an essential one for detergents.

(vi) The claimed invention consists in the substitution in a known device of a recently developed material whose properties make it plainly suitable for that use (analogous substitution).

Example 4*:* An electric cable comprises a polyethylene sheath bonded to a metallic shield *by* an adhesive. The claimed invention lies in the use of a particularly newly developed adhesive known to be suitable for polymer-metal bonding.

(vii) The claimed invention consists merely in the use of a known technique in a closely analogous situation (analogous use).

***Example 5**:* The claimed invention resides in the application of a pulse control technique to the *electric* motor driving the auxiliary mechanisms of an industrial truck, such as a fork-lift truck, the use of this technique to control the electric propulsion motor of the truck being already known.

(b) Claimed inventions involving the application of known measures in a non-obvious way and in respect of which an inventive step is therefore present:

(i) A known working method or means when used for a different purpose involves a new, surprising effect.

***Example 6**:* It is known that high-frequency power can be used in inductive butt welding. It should therefore be obvious that high-frequency power could also be used in conductive butt welding with similar effect. An inventive step would exist in this case, however, if high-frequency power were used for the continuous conductive butt welding of a coiled strip but without removing scale (such scale removal being ordinarily necessary in order to avoid arcing between the welding contact and the strip). The unexpected result is that scale removal is found to be unnecessary because at high frequency the current is supplied in a predominantly capacitive manner via the scale which forms a dielectric.

(ii) A new use of a known device or material involves overcoming technical difficulties not resolvable by routine techniques providing that the means for overcoming the technical difficulties are defined in the claim.

***Example 7**:* The claimed invention relates to a device for supporting and controlling the rise and fall of gas holders, enabling the previously employed external guiding framework to be dispensed with. A similar device was known for supporting floating docks or pontoons but practical difficulties not encountered in the known applications needed to be overcome in applying the device to a gas holder.

(c) Obvious combination of features not involving an inventive step:

The claimed invention consists merely in the juxtaposition or association of known devices or processes functioning in their normal way and not producing any non-obvious working interrelationship.

***Example 8**:* Machine for producing sausages consists of a known mincing machine and a known filling machine disposed end to end.

(d) Not obvious and consequently a combination of features involving an inventive step:

The combined features mutually support each other in their effects to such an extent that a new technical result is achieved. It is irrelevant whether each individual feature is fully or partly known by itself.

***Example 9**:* A mixture of medicines consists of a painkiller (analgesic) and a tranquilizer (sedative). It was *found* that through the addition of the tranquilizer, which intrinsically appeared to have no pain-killing effect, the analgesic effect of the pain-killer was intensified in a way which could not have been predicted from the known properties of the active substances.

(e) Obvious selection or choice among a number of known possibilities not involving an inventive step:

(i) The claimed invention consists merely in choosing from a number of equally likely alternatives.

***Example 10**:* The claimed invention relates to a known chemical process in which it is known to supply heat electrically to the reaction mixture. There are a number of well-known alternative ways of so supplying the heat; the claimed invention resides merely in the choice of one alternative way of supplying the desired heat.

(ii) The claimed invention resides in the choice of particular dimensions, concentrations, temperature ranges or other parameters from a limited range of possibilities, and it is clear that these parameters or workable ranges were encompassed by the prior art and could be arrived at by routine trial and error or by the application of normal design procedures. Where the general conditions of a claim are disclosed in the prior art, it is not inventive to discover the optimum or workable ranges by routine experimentation.

***Example 11**:* The claimed invention relates to a process for carrying out a known reaction and is characterized by a specified rate of flow of an inert gas. The prescribed rates are merely those which would necessarily be arrived at by a person skilled in the art.

(iii) The claimed invention can be arrived at merely by a simple extrapolation in a straightforward way from the known art.

***Example 12**:* The claimed invention is characterized by the use of a specified minimum content of a substance X in a preparation Y in order to improve its thermal stability, and this characterizing feature can be derived merely by extrapolation on a straight-line graph, obtainable from the known art, relating thermal stability to the content of substance X.

(iv) The claimed invention consists merely in selecting a small number of chemical compounds (that is, a subgenus or species) from a broad field of chemical compounds (genus).

***Example 13**:* The prior art discloses a chemical compound characterized by a generic formula including a substituent group designated “R.” This substituent “R” is defined so as to embrace entire ranges of broadly defined radical groups such as all alkyl or aryl groups either unsubstituted or substituted by halogen and/or hydroxy. Only a very small number of examples of specific embodiments within the broadly defined radical groups are disclosed in the prior art. The claimed invention consists in the selection of a particular radical or small group of radicals from among those well known to be contained within the broadly defined radical groups disclosed in the prior art as the substituent “R”. The prior art provides motivation to select any well known member of the broadly defined radical groups and, thus, provides motivation to one skilled in the art to make the modifications needed to arrive at the claimed compound(s). Moreover, the resulting compounds:

– are not described as having, nor shown to possess, any advantageous properties not possessed by the prior art examples; or

– are described as possessing advantageous properties, compared with the compounds specifically referred to in the prior art but these properties are ones which the

person skilled in the art would expect such compounds to possess so that he is likely to be led to make this selection.

(f) Non-obvious selection or choice and consequently inventive step among a number of known possibilities:

(i) The claimed invention involves the special selection within a process, of particular operating conditions (for example, temperature and pressure) within a known range, such selection producing unexpected effects in the operation of the process or the properties of the resulting product.

***Example 14**:* In a process where substance A and substance B are transformed at high temperature into substance C, it was known in the prior art that there is in general a constantly increased yield of substance C as the temperature increases in the range between 50 and 130°C. It is now found that in the temperature range from 63 to 65°C, which previously had not been explored, the yield of substance C was considerably higher than expected.

(ii) The claimed invention consists in selecting particular chemical compounds (subgenus or species) from a broad field of compounds (genus), wherein the specific compounds selected have unexpected advantages.

***Example 15**:* In the example of a substituted chemical compound given at (iv) under (13.4(e)), above, the claimed invention again resides in the selection of the substituent radical "R" from the total field of possibilities defined in the prior art. In this case, however, not only does the invention embrace the selection of specific compounds from the possible generic field of compounds and result in compounds that are described and shown to possess advantageous properties, but there are no indications which would lead the person skilled in the art to this particular selection rather than any other in order to achieve the described advantageous properties.

(g) Overcoming a technical prejudice:

As a general rule, there is an inventive step if the prior art leads the person skilled in the art away from the procedure proposed by the claimed invention. This applies in particular when the person skilled in the art would not even consider carrying out experiments to determine whether these were alternatives to the known way of overcoming a real or imagined technical obstacle.

***Example 16**:* Drinks containing carbon dioxide are, after being sterilized, bottled while hot in sterilized bottles. The general opinion is that immediately after withdrawal of the bottle from the filling device, the bottled drink must be automatically shielded from the outside air so as to prevent the bottled drink from spurting out. A process involving the same steps but in which no precautions are taken to shield the drink from the outside air (because none is in fact necessary) could therefore involve an inventive step.

OTHER CONSIDERATIONS

EX POST FACTO ANALYSIS

13.15 It should be remembered that a claimed invention which at first sight appears obvious might in fact involve an inventive step. Once a new idea has been formulated, it can often be shown theoretically how it might be arrived at, starting from something known, by a series of

apparently easy steps. The examiner should be wary of such "after the fact" analysis of this kind. The teaching or suggestion to make the claimed invention must be found in the prior art and/or the general knowledge of the person skilled in the art and not based on the applicant's disclosure. A factor to be considered in determining the motivation or prompting for combining the prior art teachings is whether there would have been a reasonable expectation or likelihood of success in combining the collective suggestions in the prior art. In all cases, the examiner should seek to make a practical "real-life" assessment. The examiner should take into account all that is known concerning the background of the claimed invention and give fair weight to relevant arguments or evidence submitted by the applicant.

TECHNICAL VALUE, LONG-FELT NEEDS

13.16 In order to establish the positive assertion that the claimed invention involves an inventive step (non-obviousness), the following factors should also be taken into account as secondary considerations:

(i) Whether the claimed invention fulfills a long-felt need;

(ii) Whether the claimed invention overcomes a scientific prejudice;

(iii) Whether others have previously attempted, but failed to achieve what the claimed invention achieves;

(iv) Whether the claimed invention involves an unexpected result; and

(v) Whether the claimed invention has a particular commercial success.

13.17 If, for example, a claimed invention is shown to be of considerable technical value and, particularly, if it provides a technical advantage which is new and surprising and this can be convincingly related to one or more of the features included in the claim defining the invention, the examiner should be hesitant in raising a negative determination that such a claim lacks inventive step. The same applies where the claimed invention solves a technical problem which workers in the art have been attempting to solve for a long time, or otherwise fulfills a long-felt need, or overcomes a scientific prejudice.

COMMERCIAL SUCCESS

13.18 Commercial success alone is not to be regarded as indicative of inventive step, but evidence of immediate commercial success when coupled with evidence of a long-felt want is of relevance provided the examiner is satisfied that the success derives from the technical features of the claimed invention and not from other influences (for example, selling techniques or advertising) and is commensurate in scope with the claimed invention.

DEPENDENT CLAIMS

13.19 The examiner should bear in mind that, when considering whether the claimed invention appears to be novel, to involve an inventive step (to be non-obvious), and to be industrially applicable, a dependent claim is regarded as limited by all the features of the claim on which it depends. Therefore, if the statement concerning novelty of the independent claim is positive, it should normally be positive for the dependent claims. This principle applies to inventive step and industrial applicability as well.

APPENDIX TO CHAPTER 13

PROBLEM-SOLUTION APPROACH

A13.08.1 One specific method of assessing inventive step might be to apply the so called “problem-solution approach”. The approach consists of the following stages:

1. Determining the closest prior art (see also paragraph 13.08);
2. Establishing the objective technical problem to be solved; and
3. Considering whether or not the claimed invention, starting from the closest prior art and the objective technical problem would have been obvious to the skilled person.

Step 1

A13.08.2 The closest prior art is that combination of features derivable from one single reference that provides the best basis for considering the question of obviousness. The closest prior art may be, for example:

(i) A known combination in the technical field concerned that discloses technical effects, purpose or intended use, most similar to the claimed invention; or

(ii) That combination which has the greatest number of technical features in common with the invention and is capable of performing the function of the invention.

Step 2

A13.08.3 In the second stage one establishes in an objective way the technical problem to be solved. To do this, one studies the claimed invention, the closest prior art, and the difference in terms of features (structural and functional) between the claimed invention and the closest prior art, and then formulates the technical problem.

A13.08.4 In this context the technical problem means the aim and task of modifying or adapting the closest prior art to provide the technical effects that the claimed invention provides over the closest prior art.

A13.08.5 The technical problem derived in this way may not be what the application presents as “the problem,” since the objective technical problem is based on objectively established facts, in particular appearing in the prior art revealed in the course of the proceedings, which may be different from the prior art of which the applicant was actually aware at the time the application was filed.

A13.08.6 The expression technical problem should be interpreted broadly; it does not necessarily imply that the solution is a technical improvement over the prior art. Thus the problem could be simply to seek an alternative to a known device or process providing the same or similar effects or which is more cost-effective.

A13.08.7 Sometimes the features of a claim provide more than one technical effect, so one can speak of the technical problem as having more than one part or aspect, each corresponding to one of the technical effects. In such cases, each part or aspect generally has to be considered in turn.

Step 3

A13.08.8 In the third stage the question to be answered is whether there is any teaching in the prior art as a whole that would (not simply could, but would) prompt the skilled person, faced with the technical problem, to modify or adapt the closest prior art while taking account of that teaching, thus arriving at something falling within the terms of the claims, and thus achieving what the invention achieves."

A13.08.9 Note that the requirement of technical progress is not a requirement for the problem-solution approach. Nevertheless, according to the problem-solution approach an objective problem can always be formulated ("finding an alternative", "making it easier to manufacture", "cheaper to manufacture") even in the case where there is no technical progress.

CHAPTER 14
INDUSTRIAL APPLICABILITY

MEANING OF INDUSTRIAL APPLICABILITY

14.01 A claimed invention is considered industrially applicable within the meaning of Law Article 1 if, according to its nature, it can be made or used (in the technological sense) in any kind of industry. The term "industrially applicable" may be deemed to be synonymous with the term "utility". Failure to clearly show industrial applicability will result in the examiner needing to request the applicant to clarify this issue and if applicant is unable to clarify this to the satisfaction of the examiner, the application will be rejected for failure to meet the requirements of Law Article 1.

14.02 "Industry" is understood in its broadest sense, as in the Paris Convention for the Protection of Industrial Property. Industry therefore includes any physical activity of a technical character, that is, an activity which belongs to the useful or practical arts as distinct from the aesthetic arts; it does not necessarily imply only the use of a machine or the manufacture of an article and could cover a process for dispersing fog, or a process for converting energy from one form to another.

14.03 Focusing on the general common characteristics of the industrial applicability and utility requirements, an invention that is inoperative, for example, an invention which is clearly non-operable in view of well-established laws of nature, does not comply with either the industrial applicability requirement or the utility requirement. This type of invention is considered either as having no application in industry or as not being useful for any purpose, because it doesn't work.

METHODOLOGY

14.04 For the assessment of industrial applicability, the following steps are applied:

(i) Determine what the applicant has claimed; and

(ii) Determine whether a person skilled in the art would recognize the claimed invention to have industrial applicability.

14.05 In most cases, industrial applicability will be self-evident and no more explicit description on this point will be required. The examiner might find it useful to conduct a search of the prior art to help determine if the disclosed invention is industrially applicable, particularly if the invention relates to newer technology.

14.06 If any product or process is alleged to operate in a manner clearly contrary to well-established physical laws and thus the invention cannot be carried out by a person skilled in the art, the claim does not have industrial applicability and the applicant should be so notified.

14.07 A claimed invention is considered industrially applicable if it has a utility that is: (a) specific, (b) substantial, and (c) credible.

SPECIFIC, OR PARTICULAR, UTILITY

(a) It is necessary to distinguish between situations where an applicant has disclosed a specific use or application of the invention, and situations where the applicant merely indicates that the invention may prove useful without identifying with specificity why it is considered useful. For example, indicating that a

compound may be useful in treating unspecified plant diseases, or that the compound has "useful biological" properties, would not be sufficient to define a specific utility for the compound. A general statement that a compound could be used to diagnose a plant disease would ordinarily be insufficient absent a disclosure of what condition can be diagnosed. Contrast the situation where an applicant discloses a specific biological activity of a compound and reasonably correlates that activity to a plant disease condition. This should be sufficient to identify a specific utility for the invention

SUBSTANTIAL, OR PRACTICAL "REAL WORLD" UTILITY

(b) Utilities that require or constitute carrying out further research to identify or reasonably confirm a "real world" context of use are not substantial utilities. For example, both a compound for treating a known or newly discovered plant disease and an assay method for identifying compounds that themselves have a "substantial utility" define a "real world" context of use. An assay that measures the presence of a material which has a stated correlation to a predisposition to the onset of a particular plant disease condition would also define a "real world" context of use in identifying potential candidates for preventive measures or further monitoring. It is necessary to distinguish between inventions that have a specifically identified substantial utility and inventions whose asserted utility requires further research to identify or reasonably confirm. Labels such as "research tool," "intermediate" or "for research purposes" are not helpful in determining whether an applicant has identified a specific and substantial utility for the invention.

The following are examples of situations that require or constitute carrying out further research to identify or reasonably confirm a "real world" context of use and, therefore, do not define "substantial utilities:"

(i) Basic research such as studying the properties of the claimed product itself or the mechanisms in which the material is involved;

(ii) A method of assaying for or identifying a material that itself has no specific and/or substantial utility;

(iii) A method of making a material that itself has no specific, substantial, and credible utility; and

(iv) A claim to an intermediate product for use in making a final product that has no specific, substantial and credible utility.

CREDIBLE UTILITY

(c) An assertion is credible unless (i) the logic underlying the assertion is seriously flawed, or (ii) the facts upon which the assertion is based are inconsistent with the logic underlying the assertion. Credibility, as used in this context, refers to the reliability of the statement based on the logic and facts that are offered by the applicant to support the assertion of utility. One situation where an assertion of utility would not be considered credible is where a person skilled in the art would consider the assertion to be "incredible (i.e. not believable) in view of contemporary (current) knowledge" and where nothing offered by the applicant would counter what contemporary knowledge might otherwise suggest. Claims directed to a compound for curing a plant disease or preventing a disease in plants for which there have been no previously successful cures or means for prevention, warrant careful review for compliance with the industrial applicability

requirement. The credibility of an asserted utility of a compound for treating crops may be more difficult to establish where current scientific understanding suggests that such a task would be impossible. Such a determination has always required a good understanding of the state of the art as of the time that the invention was made. The fact that there is no known cure for a disease, however, cannot serve as the basis for a conclusion that such an invention lacks industrial applicability. Rather, it is necessary to determine whether the asserted utility for the invention is credible, based on the information disclosed in the application.

CHAPTER 15
SEARCH OF THE PRIOR ART

OBJECTIVE OF THE SEARCH OF THE PRIOR ART

15.01 The objective of the search is to discover relevant prior art, which is defined in section 11.01 and which is capable of being of assistance in determining if the claimed invention is or is not new (see chapter 12) and if it does or does not involve an inventive step (that is, that it is or is not obvious; see chapter 13). See Section 11.01 for the definition of prior art. The examiner endeavors to discover as much of the relevant prior art as possible, taking into accounts the limitations set by the Patent Office..

15.02 In order to establish a complete search, the examiner is also encouraged to cite prior art documents which might be of assistance in determining whether other requirements such as sufficiency of the disclosure, support for the claims, and industrial applicability are fulfilled.

15.03 When performing the search, examiners should be mindful to pick out and select for citation, prior art which may be relevant. However, the examiner need not expand the search beyond the standard search parameters to discover such art.

15.04 A further objective of the search is to be as complete as possible to thereby avoid, or at least minimize, additional searching at a later stage.

NON-WRITTEN DISCLOSURES

15.05 A non-written disclosure such as an oral disclosure, use, exhibition (but see the exception in Law Article 3 and Regulations Article 39 and 49 to 51) or other means of disclosure is relevant prior art for the purposes of the search whether or not, it is substantiated by a written disclosure made available to the public prior to the filing date.

GEOGRAPHICAL LOCATION, LANGUAGE, AGE AND MANNER OF DISCLOSURE

15.06 It is to be noted that there is no restriction whatever with respect to the geographical place where, or the language or manner in which, the relevant information was made available to the public; also no age limit is stipulated with respect to documents containing this information.

15.07 Documents issued electronically are considered published provided they are retrievable (see paragraphs 11.12 to 11.20).

THE EXAMINER

15.08 The search itself is normally performed by one examiner but is not limited to one. In appropriate cases, where the invention is of a nature requiring searching in widely dispersed specialized fields, the work of two or more examiners may be necessary.

15.09 Reserved.

BASIS OF THE SEARCH

15.10 The application may be amended (Law Article 14, Regulation Article 21) prior to when the search has been established, consequently the search must be carried out on the basis of the application as amended.

15.11 Reserved.

15.12 Reserved

15.13 Reserved

SCOPE OF THE SEARCH

15.14 The search is essentially a thorough, high quality, search of the most relevant resources. and serves to provide information on the relevant prior art to the applicant.

15.15 The PCT International Report on Patentability, if any, should be consulted to help determine the scope of the search.

15.16 Completeness should be the ultimate goal of the search, and therefore, the examiner considers the most relevant search resources for the technology, including databases listed in the Search Guidance Intellectual Property Digital Library (available through the WIPO web site at www.wipo.int), and organizes the search effort and utilizes the search time in such a manner as to reduce to a minimum the possibility of failing to discover existing highly relevant prior art.

ORIENTATION AND SUBJECT OF THE SEARCH

ANALYSIS OF THE CLAIMS

15.17 When taking up an application to be searched, the examiner first considers the application in order to determine the subject of the claimed invention, taking account of the guidance given below and in chapter 5. For this purpose, the examiner makes a critical analysis of the claims in the light of the description and drawings.

15.18 The search is directed to the invention defined by the claims, as interpreted with due regard to the description and drawings (if any) and with particular emphasis on the inventive concept towards which the claims are directed. See chapter 5 for the relationship between the disclosure and the claims.

15.19 Reserved.

15.20 Reserved.

FULL COVERAGE

15.21 In principle, and insofar as possible and reasonable, the search should cover the entire subject matter to which the claims are directed or to which they might reasonably be expected to be directed after they have been amended. For example, where an application relating to an electric circuit contains one or more claims only directed to the function and manner of operation, and the description and drawings include an example with a detailed non-trivial transistor circuit, the search must necessarily include this circuit. Nevertheless, reasons of economy (that is, to allow for efficient use of examiner time) may make certain restrictions on the completeness of the search necessary, for example, when there is a broad claim and many examples and it is not possible to foresee which will be the subject of amended claims.

SPECULATIVE CLAIMS

15.22 No special search effort need be made for searching unduly wide or speculative claims, beyond the extent to which they are supported by the description. For example, if in an application relating to and describing in detail an automatic telephone exchange, the claims are directed to an automatic communication switching center, the search should not be extended to automatic telegraph exchanges, data switching centers, etc., merely because of the broad wording of the claim, except if it is probable that such an extended search could produce a document on the basis of which a reasonable objection as regards lack of novelty or inventive step could be established. Likewise, if a claim is directed to a process for manufacturing an "impedance element" but the description and drawings, relate only to the manufacture of a resistor element, and give no indication as to how other types of impedance elements could be manufactured by the process of the claimed invention, extension of the search to embrace, say, manufacture of capacitors, would not normally be justified. However, if a meaningful search based on a claim that is not supported by the description can be carried out without much increase in effort, the search should be extended to cover the claimed subject matter that is not supported by the description if the scope of the claim is not unduly wide.

DEPENDENT CLAIMS

15.23 The search carried out for the independent claim(s) must also take into consideration the subject matter of all dependent claims. Dependent claims are interpreted as being restricted by all features of the claim(s) upon which they depend. Therefore, where the subject matter of the independent claim is novel, that of the dependent claims is also considered novel. When the novelty and inventive step of the independent claim are apparent as a result of the search, there is no need to make a further search in respect of the subject matter of the dependent claims as such.

15.24 However, where the novelty or inventive step of the main claim is questioned, it may be necessary for assessing inventive step of a dependent claim to establish whether the features of the dependent claim as such are novel by expanding the field of search. No special search should be made for features that are so well known that documentary evidence seems to be unnecessary; however, if a handbook or other document showing that a feature is generally known can be found rapidly, it should be cited. When the dependent claim adds a further feature (rather than providing more detail of an element figuring already in the main claim), the dependent claim in effect constitutes a combination claim and should be dealt with accordingly (see paragraph 15.27).

SEARCH OF PARTICULAR CLAIM TYPES AND FEATURES

15.25 The words of a claim must be read as they would be understood by a person skilled in the art in accordance with the meaning and scope which they normally have in the relevant art. See paragraphs 5.20 through 5.28 for guidelines regarding interpretation of particular claim types and features.

15.26 In two-part claims (known as "Jepson claims"), the claimed invention includes the limitations of the an introductory portion (preamble) in combination with the limitations in the "characterizing" portion of the claim. In these cases, the claim introductory portion is regarded as a limitation on the scope of the claim (see paragraph 5.22). In certain circumstances, it may be desirable to extend the subject matter of the search to include the "technological background" of the claimed invention. This would include:

(i) the introductory portion of the claim, that is, the part preceding the expression "characterized by" or "the improvement comprising";

(ii) the state of the prior art as explained in the introduction of the description of the application but not identified by specific citations; and

(iii) the general technological background of the invention (often called "general state of the art").

COMBINATION CLAIMS

15.27 For claims characterized by a combination of elements (for example, A, B and C), the search should be directed towards the combination A search in additional classification units either for sub-combinations (for example, AB, AC, BC) or for individual elements of the combination (for example, A, B and C separately) should only be performed if this is still necessary for establishing the novelty of the element in order to assess the inventive step of the combination.

DIFFERENT CATEGORIES OF CLAIM

15.28 When the application contains claims of different categories that comply with the unity requirement (see chapter 10), all these must be included in the search. When the application contains only claims of one category, it may be desirable to include other categories in the search. A reference describing a process of making a product but only claiming the product itself might only be classified in a subclass directed to the product and not be cross-referenced in a subclass directed to the process. Accordingly, when searching for a particular process of making a product it may be necessary to search for the product in order to discover the best prior art disclosing the process of making the product. As such, for example, except when the application contains indications to the contrary, one may generally assume that in a claim directed to a chemical process, the starting products form part of the state of the art and need not be searched; the intermediate products will only be searched when they form the subject of one or more claims; but it is highly recommended that the final products always be searched, except when they are evidently known, since the most relevant prior art may only be classified in terms of the final products. See also paragraph 10.18.

CASES WHERE NO MEANINGFUL SEARCH IS POSSIBLE

15.29 The examiner, in general, excludes from the search subject matter for which no searches are to be carried out (see law Article 2), or for which no meaningful search can be made; this may result, for example, from the fact that certain subject matter may be excluded from the search, or from exceptional situations where no search at all is possible for a particular claim(s). The examiner indicates the reasons for why there has no search or examination in respect of the relevant claims. See Chapters 5 and 9.

15.30 Reserved.

15.31 Reserved.

15.32 Reserved

SEARCH STRATEGY

15.33 Documents cited in the application should be examined if they are cited as the starting point of the invention, or as showing the state of the art, or as alternative solutions to the problem concerned, or when they are necessary for a correct understanding of the application; however, when such citations clearly relate only to details not directly relevant to the claimed

invention, they may be disregarded. If the application cites a document that is not published or otherwise not accessible to the examiner and the document appears essential to a correct understanding of the invention to the extent that a meaningful search would not be possible without knowledge of the content of that document, the examiner, may postpone the search and request the applicant to provide a copy of the document. If no copy of the document is received, the examiner should first attempt to carry out the search and then, if necessary, indicate that no meaningful search could be carried out in total or that the search needed to be restricted. In the same sense, if there is an earlier application, whether it is a PCT or a priority application, and there are prior art citations made by an examiner in another patent office, or international searching and examining authority, these should be reviewed by the examiner.

15.34 Reserved .

15.35 Reserved

15.36 Reserved.

15.37 Having determined the subject of the invention, as outlined in paragraphs 15.17 and 15.18, it may be desirable for the examiner to prepare first a written search statement, defining the subject of his search as precisely as possible. In many instances, one or more of the claims may themselves serve this purpose, but they may have to be generalized in order to cover all aspects and embodiments of the invention. At this time, the considerations relating to the exclusion from search (see chapter 9) and to lack of unity of invention (see chapter 10) should be borne in mind. The examiner may also have to restrict the search in exceptional situations because no search at all is possible; but the examiner should not do this if it can be avoided.

15.38 The claims should be construed and searched having particular regard to the various types and forms of claims used, such as two-part claims and product-by-process claims (see paragraphs 15.27-15.29).

FIELD OF SEARCH

15.39 The examiner carrying out the search endeavors to discover as much of the relevant prior art as its facilities permit, and considers the Local Egyptian Patent Database, other relevant databases, and other search resources such as those listed in the Search Guidance Intellectual Property Digital Library (IPDL), which appears on the World Intellectual Property Organization web site (www.wipo.int).

15.40 Thus, the examiner in searching an application, in principle, consults all documents within the field of search that exists in the search files or databases, irrespective of their language or age, or of the type of document. Nevertheless, the examiner should, for reasons of economy (that is, to allow for efficient use of examiner time), exercise appropriate judgment, based on his knowledge of the technology in question and of the documentation involved, to omit segments of the search file or databases in which the likelihood of finding any relevant documents is very small, for example, documents falling within a period preceding the time when the area of technology in question began to develop. Similarly the examiner need only consult one member of a patent family unless there is good reason to suppose that, in a particular case, there are relevant substantial differences in the content of different members of the same family or because only another member of a patent family was published before the effective filing date and must therefore be cited in the first place.

15.41 The search is carried out on the basis of the search files or the Local Egyptian Patent Database which may contain material pertinent to the claimed invention. It covers all directly relevant technical fields. The search may then have to be extended to include other listed

resources or databases, such as those listed in the Search Guidance IPDL, or to analogous fields, but the need for this must be judged by the examiner in each individual case, taking into account the outcome of the search in the initial fields. See paragraph 15.57.

15.42 The question of which of the listed relevant search resources, including the databases listed in the Search Guidance IPDL, are to be consulted in a given area of technology must be judged by the examiner in each individual case. Classification places to be included in the search should be selected in all directly relevant fields and, if necessary, in analogous fields. The examiner should consider all relevant search resources for the technology field and determine those most appropriate for the application. Search resources listed in the Search Guidance IPDL relevant to the technical areas may provide a useful guide for relevance to the application at hand. This includes, for example, specialized search systems, abstracting journals, and on-line databases. Where searches are made by using the IPC, the selection of classification places in analogous fields should be limited to:

(i) higher subdivisions allowing searching by abstraction (generalization) inasmuch as this is justified from a technical viewpoint, and

(ii) parallel subdivisions, bearing in mind the fact that the fields in question will become increasingly unrelated.

15.43 Often various search strategies are possible that are relevant to the subject matter of the application. The examiner should exercise judgment based on experience and knowledge of the search resources, to select the search strategies most appropriate to the case in hand, and establish the order in which various strategies (that is, classification places, databases, and other resources) are to be consulted accordingly. This process should give precedence to the main technical field of the application, and to the search resources and strategies in which the probability of finding relevant documents is highest.

ANALOGOUS FIELDS

15.44 The field of search should, where appropriate, include analogous fields to the extent they are consistent with the description and drawings.

15.45 The question of which arts are, in any given case, to be regarded as analogous is considered in the light of what appears to be the necessary function or use of the claimed invention and not only the specific functions expressly indicated in the application.

15.46 In determining analogous fields into which the search should be extended, it is useful to give consideration to:

(i) fields in which the same or similar structure would be expected by a person skilled in the art to be employed in different work or use;

(ii) fields to which a generic concept of claimed features pertains;

(iii) art within the field of the inventor's endeavor and reasonably pertinent to the particular problem with which the inventor was involved;

(iv) fields relevant to the function or utility inherent in the subject matter covered by the claims, that is, the field to which the application is most likely to be applied would be searched in addition to the general field of the subject matter.

15.47 The decision to extend the search to fields not mentioned in the application must be left to the judgment of the examiner, who should not try to imagine all the kinds of applications of the claimed invention that might have been envisioned by the inventor. The overriding principle in determining the extension of the search in analogous fields should be whether it

is possible that a reasonable objection that there is a lack of inventive step could be established on the basis of what is likely to be found by the search in these fields.

CONDUCTING THE SEARCH

15.48 The examiner carries out the search, directing attention to any prior art likely to have bearing on novelty or inventive step. In addition, the examiner is encouraged to cite any prior art likely to be of assistance in determining sufficiency of description through the whole of the field claimed, per paragraphs 5.52 and 5.53 and the requirement that the claimed invention be fully supported by the description, per paragraphs 5.54 to 5.58. The examiner should also note any documents that may be of importance for other reasons, such as documents putting doubt upon the validity of any priority claimed, contributing to a better or more correct understanding of the claimed invention, or illustrating the technological background, but the examiner should not spend time in searching for these documents, nor in the consideration of such matters unless there is a special reason for doing so in a particular case. Documents which do not qualify as prior art because they post-date the claimed invention may nevertheless be cited to show a universal fact, such as characteristics or properties of a material, or a specific scientific fact, or to show the level of ordinary skill in the art.

15.49 The examiner should concentrate the search efforts on the search resources and strategies in which the probability of finding highly relevant documents is greatest. Where the examiner intends to cite any prior art likely to be of assistance in determining sufficiency of description, then while conducting a search in a relevant area, the examiner should identify all documents, regardless of publication dates, which are highly relevant to the determination of novelty, inventive step, adequacy of support, and industrial applicability of the claimed invention. The examiner should always take account of the search results already obtained (for example, in the PCT International Search Report part of the International Preliminary Report on Patentability) in considering whether to extend the search (that is, consult additional databases, broaden a search query, or include additional classification places).

15.50 The examiner typically conducts a search of the patent literature first. In certain art areas, such as those identified in the Search Guidance IPDL (see paragraph 15.39), a search of the non-patent literature may be necessary. However, regardless of the art being searched, if little or no relevant patent prior art is located, the examiner should consider broadening the resources searched to include databases containing non-patent literature.

15.51 Note that no special search should be made for features that are instantly and unquestionably demonstratable as being well known such that documentary evidence seems unnecessary. Preferably, however, a handbook or other document showing that a feature is generally known should be cited if practicable.

SECURITY OF SEARCHING USING THE INTERNET

15.52 When conducting a search on an international application, it may be necessary to make use of the Internet as a search tool. There exists the danger that search terms used in the search on non-secure Internet search engines or in databases available on the Internet may be observed by third parties. This may reveal details of the application before its acceptance is published, which is clearly undesirable. It should be stressed that it is common practice for Internet sites to keep records of queries, which result in their retrieval. This is particularly dangerous to the applicant, where the web site retrieved belongs to a competitor.

15.53 Reserved.

15.54 Since all web sites must be treated as non-secure, extreme caution must be exercised when using the Internet as a search tool. Where a relevant database is accessible via the Internet, but an alternative secure connection to the same database is accessible by the examiner, the secure connection must be used.

15.55 Where no secure connection to a database on the Internet is available to the examiner, the search may be conducted on the Internet using generalized search terms representing combinations of features that relate to the claimed invention, which have already been shown to exist in the state of the art.

NO DOCUMENTS FOUND

15.56 If no documents of a more relevant nature for assessing novelty and inventive step are available, the examiner should consider citing the documents most relevant to the "technological background" of the invention which have been noted during the search. Generally speaking, no special search effort should be undertaken for this purpose. However, the examiner may exercise discretion here in special cases. In exceptional cases, a search may be completed without any relevant document having been found.

STOPPING SEARCH

15.57 Reasons of economy (that is, efficient use of examiner time) dictate that the examiner use appropriate judgment to end the search when the probability of discovering further relevant prior art becomes very low in relation to the effort needed. The search may also be stopped when one or more documents have been found clearly demonstrating lack of novelty in the entire subject matter to which the claims are directed or to which they might reasonably be expected to be directed, apart from features the application of which would not involve an inventive step and which are instantly and unquestionably demonstrable as being well known in the field under consideration such that documentary evidence seems to be unnecessary. Accordingly, the examiner should not stop the search if lack of novelty is demonstrated for only a limited number of claimed embodiments. The examiner may continue searching if there are any outstanding issues regarding the requirement for a clear and complete description of the claimed invention so as to enable a person skilled in the art to make and use the invention, Other types of issues that could be clarified by searching and reviewing additional prior art include the requirement that the claimed invention be fully supported by the description, and the requirement of industrial applicability. See paragraph 15.48. Where the document is an Internet disclosure and doubts exist with regard to its publication date (such that it is not clear if it was published before the relevant date), the examiner should continue the search as though that Internet disclosure had not been retrieved.

RECORDING THE SEARCH

15.58 In recording the search history, the examiner lists the classification identification of the fields searched. This includes recording the details of any patent and non-patent literature searches as well as searches conducted on the Internet, including the key words and query operators, expressed as complete search queries to the extent practical, logic employed as the basis of a text search which resulted in the discovery of prior art, or the amino acid or nucleic acid sequence employed as the basis of a sequence search and the sequence alignment corresponding to prior art that was obtained from the sequence search, or the chemical structure employed as the basis of a chemical structure search or details of other non-classification or non-text searches performed. The recorded search history should also include any query used in any of the foregoing searches. Provision of the actual search query from these search histories is generally easily accomplished by direct printing of the

search query from the automated system used to construct and perform the search query from a given electronic search resource. Where an electronic database is used, the name of the database should be provided; the actual search queries used may also be useful information. Examiners are also encouraged to record the search history to include the details of searches used to determine compliance with the requirements of novelty, inventive step, industrial applicability, support, sufficiency, or other appropriate requirements.

EVALUATING THE PRIOR ART

15.59 The examiner makes a determination of whether the claimed invention meets the standards for novelty and inventive step as set out in chapters 12 and 13.

15.60 Reserved.

15.61 Reserved.

15.62 Reserved.

SELECTION OF CITATIONS AND IDENTIFYING MOST RELEVANT PORTIONS

15.63 After completion of the search, the examiner should select, from the documents retrieved, the most relevant documents. Less relevant documents should only be cited when they concern aspects or details of the claimed invention not found in the documents already selected for citation. In cases of doubt or borderline cases in relation to novelty or inventive step, the examiner should readily make citations in order to give the applicant, the opportunity to consider the matter more fully.

15.64 To avoid increasing costs unnecessarily, the examiner should not cite more documents than is necessary, and therefore when there are several documents of equal relevance, the examiner should not normally cite more than one of them. When more than one member of the same patent family is present in a search file, the examiner, in selecting from these documents for citation, should pay regard to language convenience. Also, due regard should be paid to the possible need of the applicant to translate cited documents. Therefore, the examiner should, whenever possible, identify precisely the part or passage of a cited document which is relevant by, for example, indicating also the page and paragraph or lines where the relevant passage appears.

15.65 As a general rule, the examiner will select for citation only documents which are present in the search files of the examiner or to which access is readily available in some other manner; in that way no doubt will exist about the contents of the documents cited, since the examiner will generally have consulted each document cited.

15.66 However, under certain circumstances a document whose contents have not been verified may be cited, provided there is justification for the assumption that there is identity of contents with another document which the examiner has inspected and cited. Both documents should then be mentioned. For example, instead of the document published before the filing date in an inconvenient language and selected for citation, the examiner may have inspected a corresponding document (for example, another member of the same patent family, or a translation of an article) in a more convenient language and possibly published after the filing date. Also the examiner may assume that, in the absence of explicit indications to the contrary, the contents of an abstract of a document are contained in that original document. Also the examiner should assume that the contents of a report of an oral disclosure are in agreement with that disclosure.

15.67 Before citing documents in a language with which the examiner is not familiar, the examiner should be satisfied that the document is relevant (for example, through translation by a

colleague, through a corresponding document or abstract in a familiar language, through a drawing, or chemical formula in the document).

15.68 Reserved.

15.69 Reserved.

15.70 Reserved.

CHAPTER 16
REFUSALS AND OBJECTIONS NOT BASED ON PRIOR ART

16.01 In the event that fundamental objections arise, including ones which have been introduced by amendment, it may be more appropriate to deal with this objection before making a detailed technical examination.

16.02 All of the refusals or objections to the claims or the description should be clear and complete. A statement of the grounds for the objection or refusal should always be set forth before the explanations. That is, **the Law 82 /2002 Article or the Regulation Article which forms the basis for the refusals or objection should be set forth in the letter followed by the examiners explanation as to the reasoning used for this refusal or objection.** The following form paragraphs are used to guide the examiner in writing the refusals and objections.

EXCLUSIONS FROM PATENTABILITY

16.03 As set forth in detail in Chapter 9, there are situations in which the subject matter claimed is excluded from patenting in Egypt. If this is the case, the examiner should use the following in the letter to the applicant:

Law 82 of 2002 Article 2

Patents shall not be granted for:

(1) Inventions whose exploitation is likely to be contrary to public order or morality, or prejudicial to the environment, human, animal or plant life and health.

(2) Discoveries, scientific theories, mathematical methods, programs and schemes.

(3) Diagnostic, therapeutic and surgical methods for humans and animals.

(4) Plants and animals, regardless of their rarity or peculiarity, and essentially biological processes for the production of plants or animals, other than microorganisms, non-biological and microbiological processes for the production of plants or animals.

(5) Organs, tissues, live cells, natural biological substances, nuclear acid and genome.

Claim(s) _____ is (are) refused under Law 82 of 2002 Article 2 as being directed to subject matter excluded from patenting. [1]

In [1] the examiner should include a description of the portion of Law 82 of 2002 Article 2 which excludes the subject matter from patenting e.g. a claim drawn to only a scientific theory.

LACK OF FULL AND COMPLETE WRITTEN DISCLOSURE

16.04 In the situation when it is the examiner's position is that nothing within the scope of the claims is enabled (i.e. includes a full and complete written disclosure which would allow one of expertise to execute the invention), the examiner should provide a reasoned explanation as to why this is the case. The format should be as follows:

Law 82 of 2002 Article 13 (paragragh 1)

The patent application shall be accompanied by a detailed description of the invention, including a full statement of the subject matter and of the best way to enable an person of expertise to execute it, and of each product or method for which protection is sought.

The subject matter of claim(s) _____ is (are) not based on a disclosure which is a full and complete description of the invention which would allow one of expertise to execute the invention as required by Law 82 of 2002, Article 13, paragraph 1. [1]. Applicant is required to clarify this by amendment (Law Article 14), without affecting the substance of the invention (Law Article 15).

In [1] the examiner should insert the reasoning for this e.g. the disclosure fails to recite any catalyst which allows the reaction to take place.)

16.05 In the situation where there is an enabling disclosure but the scope of the claims is not commensurate with the scope of the enabling disclosure, the following should be used:

Article 13 (paragraph 1)

The patent application shall be accompanied by a detailed description of the invention, including a full statement of the subject matter and of the best way to enable an person of expertise to execute it, and of each product or method for which protection is sought.

Though the disclosure of the application is enabling for [1]as set forth in claim(s) ____, it is not enabling for [2] as set forth in claim(s) ____. The disclosure does not enable one of expertise to make and use the invention as required by Law 82 of 2002, Article 13, paragraph 1. [3] Applicant is required to clarify this by amendment (Law Article 14), without affecting the substance of the invention (Law Article 15).

In [1] above the examiner should insert the subject matter which is properly enabled and in [2] above include the subject matter which is not properly enabled by the disclosure.

In [3] the examiner should include the reasons for the lack of enablement. See the example used with the form paragraph in section 16.04.

16.06 If the invention as disclosed fails to disclose the "best way (mode)" of making and using the invention then the examiner should be used in a letter to the applicant:

Article 13 (paragraph 1)

The patent application shall be accompanied by a detailed description of the invention, including a full statement of the subject matter and of the best way to enable an person of expertise to execute it, and of each product or method for which protection is sought.

"Applicant is required to clarify the disclosure, since the the disclosure does not set forth the best way (mode) for a person of expertise to execute the invention set forth in claim(s) ____ is (are) as required by Law 82 of 2002 Article 13, first paragraph. [1] Applicant is required to clarify this by amendment (Law Article 14), without affecting the substance of the invention (Law Article 15)."

In [1] the examiner should include an explanation e.g. the disclosed invention sets forth the very broad ranges of calcium which can be used to make the mixture without disclosing a specific percentage (or a narrower range) where the mixture would react the best in the disclosed environment. Another example could be when the disclosure is so poor that the examiner cannot determine the best mode.

CLARITY OF CLAIMS

16.07 The claims should be clear to allow the public to understand the invention covered by the patent. In Law 82 of 2002 Article 13, the term "new elements" is construed to relate to the claimed subject matter. Below are formats to be used for the most common types of requests for clarifications:

Law 82 of 2002 Article 13 (paragraph 2)

The description shall also include in a clear manner the new elements for which the applicant seeks protection accompanied, where necessary, by an illustrative drawing of the invention.

Claims(s) ___ need to be clarified so as to conform to the requirement of Law 82 of 2002 Article 13, paragraph 2, that the claims should be written in a clear manner. (**This paragraph must then be followed by one or more of the following.)**

1) If the claims include terminology inconsistent with accepted meaning, use:

"In claim ___ applicant uses the term [1], in a way which is contrary to the normal meaning of the word. Where applicant uses terms in the claims which are contrary to their normal usage, then applicant must amend the written description to clearly redefine this term so that one of expertise in the art can understand the redefined term".

In [1] indicate the term, which is being used contrary to its normal meaning.

2) IIf claim includes a relative term (e.g. thin) and that term is not clearly defined in the disclosure, use:

> "The term "[1]" used in claim ____ is a relative term which renders the claim indefinite. This term is not defined in the disclosure and therefore one of expertise in the art would not be able to ascertain the scope of the invention."
>
> In [1] indicate the term (e.g. "thin") which is the relative term

3) If there are both a broad range (or limitation) and a narrower range (or limitation) in the same claim, then use:

> "In claim _____ the broad range (or limitation) [1] and the narrower range (or limitation) [2] are both recited. A broad range (or limitation) in the same claim with a narrower range (or limitation) renders the claim indefinite by raising the question as to whether the feature introduced by such language is just an example used in the claim or whether it is required feature of the claim."
>
> In [1] indicate the broad range (or limitation) e.g. "1 to 40% by weight".
>
> In [2] indicate the narrower range (or limitation) e.g. "7 to 9% by weight".

4) If there is a lack of proper basis in the claims for certain limitations set forth in the claims, then use:

> "Claim ____ recites the limitation [1] but there is no basis for this found in this claim or in any claim from which this claim is dependent.
>
> In [1] indicate the term for which there is no basis e.g. dependent claim 5 sets forth the limitation of "the range set forth in claim1", but in claim 1, no such range is found.

5) If the claims appear to be a literal translation into Arabic, then the following should be used:

> "The claims are generally narrative and indefinite, failing to conform to Egyptian practice. They appear to be a literal translation into the Arabic language from a foreign document and are full of grammatical and idiomatic errors."

6) If the phrase "for example" is used in the claims, then the following should be used:

> "Regarding claim _____, the phrase "for example" renders the claim indefinite since it is not clear as to whether the limitation following this phrase is to be considered as part of the claimed invention"

7) If the phrase “or the like” is used in the claim, the following should be used:

> “Regarding claim ____, the phrase “or the like” renders the claim indefinite because this phrase implies that the claim includes limitations not actually set forth in the claim and therefore makes determining the scope of the claims unascertainable.”

8) If the claim includes the phrase “such as”, use the following:

> “Regarding claim ____, the phrase “such as” renders the claim indefinite since it is unclear whether the limitation following this phrase is part of the claimed invention.”

9) If the claim includes a “means” without a function, then use:

> “Regarding claim ____, the word “means” is preceded by the word(s) “[1]” in an attempt to use a “means” clause to recite a claim element as a means for performing a specific function. However, since no function is specified by the word(s) preceding “means,” it is impossible to determine the equivalents of the claimed element.”
>
> Examiner Note: It is necessary for the words which precede “means” to convey a function to be preformed. For example, the phrase “latch means” is definite because the word “latch” conveys the “latching” function. In general, “means” phrases can also be stated (as in this example) as “means for latching” and will still make sense and be definite. However, if “conduit means” is restated as “means for conduiting”, this phrase makes no sense and therefore would not be definite.

10) If an essential or critical step or element is omitted from a claim, the examiner should use:

> “Claims ____ are incomplete for omitting essential steps (or elements). The omitted steps (or elements) are [1]. [2]”
>
> In [1] indicate the step(s) or element(s) which are essential to the invention but are not included in the claims.
>
> In [2] give the reasons why the step(s) or element(s) that are omitted are essential to the invention.

11) If there is an essential relationship between some elements is not included in the claims, the following should be used:

> “Claims _____ are incomplete for omitting essential cooperative relationships of certain elements. As set forth in the disclosure, these omitted structural relationships are [1]. “
>
> In [1] indicate the necessary structural cooperative relationships of elements described in the disclosure as necessary to practice the invention.

12) At times, the claims are so unclear that it is difficult to point out all of the problems to the applicant. Many times this is the case when the person drafting the patent application is inexperienced in patent application drafting. For these situations, use:

> "The claims are narrative in form and full of indefinite and functional or operational language. The structure (or steps) must be organized and correlated in such a manner to present a complete operative device (or process). For examples of proper claim drafting, see the Egyptian Patent Office website at www.egypo.gov.eg"

13) If the claims only refer to the disclosure without any specific structure or steps (e.g. a claim stating only "A device substantially shown and described"). The following should be used:

> "The claims only recite the invention in a general sense, without any structure (or process steps) and therefore are not clear as to what is the claimed invention."

14) If a trademark or trade name is used in the claims, the following should be used:

.

> "Claim ____ uses the trademark (or trade name) [1]. When a trademark or trade name is used, this does not comply with the requirement for clarity since the scope of the claims are uncertain since the trademark or trade name cannot be used properly to identify any particular material or product. A trademark or trade name describes the source of the goods and not the goods themselves and since the goods can change from time to time, it cannot be used to define a claim limitation.
>
> In [1] indicate the trademark or trade name used in the claims

15) The following form paragraph should be used when applicant has stated somewhere, other than in the application as filed, that the invention is something different than as set forth in the claims.

> "Evidence that the claims fail to correspond in scope with that which applicant regards as the invention is found in [1]. In this document, applicant states "[2]" and this statement indicates that the scope of the invention is different than that claimed because [3]."
>
> In [1] indicate where the statement is found (e.g. in the remarks accompanying an amendment to the application) which is relied upon by the examiner to show that the claimed invention is not what applicant regards as the invention.
> In [2] indicate the exact statement made by applicant that led the examiner to determine that applicant's invention is different than that claimed.
> In [3] explain how the statement referred in [2] indicates that the invention is other than what is claimed.

RECOMMENDING AMENDMENTS

16.08 The examiner should not suggest amendments merely because he thinks they will improve the wording of the description or claims. What is important is that the meaning of the description and the claims should be clear. Although not obliged to do so, the examiner should try to indicate to the applicant those amendments which would clarify the inconsistencies or lack of clarity. It must be emphasized that it is not part of the duty of the examiner to invite the applicant to amend the application in a particular way to meet an objection, since the drafting of the application is the applicant's responsibility and the applicant should be free to amend in any way he chooses provided that the amendment removes the deficiency and otherwise satisfies the requirements of Egyptian Law 82 of 2002. However, it may sometimes be useful if the examiner suggests an acceptable form of amendment; but if he does so, he should make it clear that the suggestion is merely for the assistance of the applicant and that other forms of amendments will be considered.

CONSIDERATION OF RESPONSES BY APPLICANT

16.09 If, in the opinion of the examiner, issues such as: (1) the clarity of the claims, the description, and the drawings; (2) the question as to whether the claims are fully supported by the description; and/or (3) defects existing in the form or contents of the application, have not been suitably resolved by the applicant in the prescribed time limit the applicant must appeal the examiners decision or the application will be considered abandoned.

CHAPTER 17
TECHNICAL SEARCH AND EXAMINATION REPORT

GENERAL

17.01 Providing clear, complete and accurate information to applicants regarding the patentability of their inventions is the most important function of the Patent Office. Decisions made by Technical Examiners are to be set forth in the search and examination report in such a clear and complete fashion as to enable applicants to fully understand the examiner's position as to the patentability of every claim. Without a clear and complete report the applicant will not be able to make the decisions as to whether to amend the application or take other action e.g. appeal the examiners decision.

17.02 The report provided to the applicant includes two parts. The first part gives the results of the search carried out by the examiner. The second part gives a detailed analysis of the claims and issues related to patentability.

17.03 Certain issues not related to the prior art should be handled prior to the substantive search and the examination of the claims as to novelty and inventive step. These are set forth in Chapter 16.

17.04 If minor issues not related to the determinations of novelty and inventive step are found only at the time of the substantive examination as to novelty and inventive step, they may be handled at that time using the form and formats set out in Chapter 16.

COMPLETING THE SEARCH REPORT

RESTRICTION OF THE SUBJECT OF THE SEARCH

17.05 The report indicates whether the search was restricted or not for any of the reasons indicated below. If any such restrictions are applied, the claims in respect of which a search has not been carried out are identified and the reasons for this are indicated. The four categories where such restrictions may arise are:

(i) claims drawn to subject matter not required to be searched (see chapter 9);
(ii) claims in respect of which a meaningful search cannot be carried out (see chapter 9);
(iii) improper multiple dependent claims (see paragraph 5.16);
(iv) lack of unity of invention (see chapter 10).

17.06 Where claims are not searched for any of the reasons (i) to (iii), the technical examiner should explain the reasons, e.g. claims 1-3 are excluded subject matter and claims 5-10 are not supported by a detailed description of the subject matter.

CLASSIFICATION OF SUBJECT MATTER

17.07 The Patent Office assigns International Patent Classification (IPC) symbols in accordance with the rules as set forth in the Guide to the IPC and in the IPC itself (using the edition of the

IPC in force at the time) and records this information in the search report. Non-obligatory IPC symbols, as defined in the Guide (such as the optional IPC indexing codes), do not need to be applied. The IPC Guide can be accessed via the WIPO web site at: www.wipo.int. See chapter 7.

FIELDS SEARCHED

17.08 The search report lists the classification identification of the fields.

17.09 Where documentation other than patent documentation is searched, the other documentation searched is identified in the search report. .

ELECTRONIC DATABASE CONSULTED

17.10 Where an electronic database is used in carrying out the search, the name of the database may be included in the search report. In addition, technical examiners may find it useful to indicate the exact search queries used to search the database in the report. If it is impractical to record the exact query or queries, then a summary of the query or queries should be included.

17.11 Where keywords (search terms) are used, it may be useful to include the keywords on the search report. If the number of keywords used is large, then a representative sample of the keywords could be used (for example, "Keywords: A, B, C, and similar terms).

17.12 Structure searches (e.g. benzene rings) are not conveniently indicated on the search report. If a structure search was carried out, this can be indicated by a statement such as "structure search carried out based on the quinoline nucleus in formula (I)".

17.13 Sequence searches should be dealt with in the same way as structure searches ("search of SEQ ID 1-5").

Examples:

DWPI & keywords: A, B, C, and similar terms (Note; DWPI includes WPAT, WPI, WPIL)

JAPIO & keywords: A, B, C, and similar terms

MEDLINE & keywords: A, B, C, and similar terms

DWPI IPC A01B 1/- & keywords: A, B, C

CA & WPIDS: IPC C07D 409/- & keywords: A, B, C

CA: Structure searched based on Formula (I)

ESP@CE keywords: A, B, C.

Genbank: Sequence search on sequence SEQ ID NO: 1.

Notes:

(a) Merely putting “keywords searched” without specifying the actual keywords used is not acceptable.

(b) There is no need to indicate the way the database was accessed. For example, there is no need to specify that ESP@CE was accessed via the Internet, or MEDLINE via STN.

(c) Where the search is conducted using a particularly relevant portion of a longer referenced amino acid sequence, rather than the full length sequence referenced as filed for a particular SEQ ID NO of the sequence listing, the examiner should indicate the region or regions of the full length reference sequence which encompassed the sequence searched.

DOCUMENTS CONSIDERED TO BE RELEVANT

17.14 The search report has three components. These are: the citation category; the citation of the document together with identification of relevant passages where appropriate; and the identification of relevant claim numbers. See below.

17.15 Some general points to note are:

(a) Documents selected for citation should be the prior art that is closest to the applicant’s invention. The duplication of teachings by way of citation of multiple documents showing the same inventive elements should be kept to a minimum (see paragraphs 15.63 and 15.64).

(b) When citing a document, the examiner should clearly indicate which portions and specific pages of the document are most relevant (see paragraph 15.64).

CITATION CATEGORY

17.16 Documents which are cited are given a category indicated by way of an alphabetic character, details of which are given below. The categories for citations are also explained under the “Documents considered to be relevant” section of the report. A category should always be indicated for each document cited. Where needed, combinations of different categories are possible.

PARTICULARLY RELEVANT DOCUMENTS

17.17 Where a document cited in the search report is particularly relevant, it is indicated by the letters “X” or “Y”.

17.18 Category “X” is applicable where a document is such that when taken alone, a claimed invention cannot be considered novel or where a document is such that when considered in light of common general knowledge, a claimed invention cannot be considered to involve an inventive step.

17.19 Category “Y” is applicable where a document is such that a claimed invention cannot be considered to involve an inventive step when the document is combined with one or more

other documents of the same category (Y), such combination being obvious to a person skilled in the art.

DOCUMENTS DEFINING THE STATE OF THE ART NOT PREJUDICING NOVELTY OR INVENTIVE STEP

17.20 Where a document cited in the search report represents state of the art and do not indicate a lack novelty or inventive step of the claimed invention, it is indicated by the letter “A”.

DOCUMENTS WHICH REFER TO A NON-WRITTEN DISCLOSURE

17.21 Where a document cited in the search report refers to a non-written disclosure, the letter “O” is entered. Examples of such disclosures include conference proceedings. The document category “O” is always accompanied by a symbol indicating the relevance of the document according to paragraphs 17.18 to 17.20, for example O,X; O,Y; or O,A.

INTERMEDIATE DOCUMENTS

17.22 Documents published on dates falling between the date of filing of the application being examined and the date of priority claimed, or the earliest priority if there is more than one, are denoted by the letter “P”. The letter “P” is also given to a document published on the same day as the earliest date of priority of the patent application under consideration. The document category “P” is always accompanied by a symbol indicating the relevance of the document, for example P,X; P,Y; or P,A.

DOCUMENTS RELATING TO THE THEORY OR PRINCIPLE UNDERLYING THE INVENTION

17.23 Where any document cited in the search report is a document which may be useful for a better understanding of the principle or theory underlying the invention, or is cited to show that the reasoning or the facts underlying the invention are incorrect, it is indicated by the letter “T”.

POTENTIALLY CONFLICTING PATENT DOCUMENTS

17.24 Any patent document that is filed (or has a priority date) before the filing date of the application being searched but is published later than the filing date of the application searched, and where the content of the patent document would constitute prior art relevant to novelty, is indicated by the letter “E. Where the patent document and the application searched have the same date, the patent document is also identified by the letter “E”.

DOCUMENTS CITED IN THE APPLICATION

17.25 When the search report cites documents already mentioned in the description of the patent application for which the search is carried out, such documents may be identified on the search report by the wording “cited in the application”.

DOCUMENTS CITED FOR OTHER REASONS

17.26 Where any document is cited in the search report for reasons other than those referred to in the foregoing paragraphs (in particular as evidence), for example:

(a) a document which may throw doubt on a priority claim (Article 4(C)(4) of the Paris Convention), or

(b) a document cited to establish the publication date of another citation,

the document is indicated by the letter "L". Brief reasons for citing the document should be given. Documents of this type need not be indicated as relevant to any particular claims. However, where the evidence which they provide relates only to certain claims (for example the "L" document cited in the search report may invalidate the priority in respect of certain claims and not others), then the citation of the document should refer to those claims.

RELATIONSHIP BETWEEN DOCUMENTS AND CLAIMS

17.27 Each citation should include a reference to the claims to which it relates. If necessary, various relevant parts of the document cited should each be related to the claims in like manner (with the exception of "L" documents, see paragraph 17.26 and "A" documents, see paragraph 17.29). It is also possible for the same document to represent a different category with respect to different claims. For example:

Category	Citation	Claims
X	WO9001867 A (WIDEGREN LARS (SE))	1
	8 March 1990 (1990-03-08)	
Y	* figure 1 *	2-5
A	* figure 2 *	6-10

The above example means that Figures 1 and 2 of the cited document disclose subject matter which indicates the lack of novelty or inventive step of claim 1, the lack of inventive step of claims 2-5 when combined with another document cited in the search report, and which represents the state of the art for the subject matter of claims 6-10.

CITATION OF THE DOCUMENTS

17.28 Identification of any document should be made according to WIPO Standard ST.14 ("Inclusion of References Cited in Patent Documents").

17.29 For "A" citations it is not necessary to indicate the relevant claims unless there is good reason to do so; for example when the claims meet the criteria of novelty, inventive step, and industrial applicability and the "A" category citations represent the most relevant prior art.

COPIES OF REFERENCES CITED IN THE SEARCH REPORT

17.30 Copies of most references cited in the Search Report can be found on the Internet.

CONTENT OF THE EXAMINATION REPORT

INTRODUCTION

17.31 This section of the chapter covers the content of the examination portion of the search and examination report.

17.32 The purpose of the examination report is to identify whether or not the claimed invention appears to be novel, involve an inventive step (non-obvious) and be industrially applicable. It can also include objections on certain other substantive defects. See paragraph 17.04.

BASIS OF THE REPORT

17.33 Since there may be amendments in the application filed either at the time of filing of the application or at a later time, the Report should indicate which claims are being examined and whatever other amendments are being relied upon for the basis of the report. It is important that the Examiner take into consideration all amendments which have been properly filed and to notify applicant if any amendments are not being taken into consideration for establishing the report. The reasons for non-consideration of any amendments (e.g. an amendment that adds subject matter not included in the application as filed) by the Examiner must be communicated to the applicant. For PCT applications entering the national phase in Egypt, particular care must be taken to ensure that all the amendments are being properly taken into consideration since applicants have several opportunities to amend the application during the international phase.

PRIORITY

17.34 This part of the report is not relevant if the application does not claim priority. Furthermore, where priority is claimed, but the citations in the search report were all published before the earliest priority date, it is not necessary to consider whether the priority claim is valid (see chapter 6).

17.35 Where one or more citations of the search report were published after the earliest priority date, the validity of that earliest priority date requires checking (see Chapter 6).

17.36 The data pertinent to the priority application(s) (serial number, country and filing date) should be included.

17.37 Where the right to priority is invalid, the examiner should indicate the reason (e.g. the application in Egypt was filed more than 12 months after the filing date of the priority application).

CERTAIN DEFECTS IN THE APPLICATION

17.38 If defects exist in the form or contents of the application, and these were not found earlier the examiner should return the application to the Legal Examiner for correction.

REASONED STATEMENTS WITH REGARD TO NOVELTY, INVENTIVE STEP OR INDUSTRIAL APPLICABILITY AND CITATIONS SUPPORTING SUCH STATEMENT

17.39 A statement should be made as to whether the claims appear to satisfy the criteria of novelty, inventive step (non-obviousness) and industrial applicability. If a negative statement is made regarding industrial applicability, statements should still be made regarding novelty and inventive step if at all possible. The examiner should always cite documents believed to support any negative statement with respect to any of the claimed subject matter in the Search portion of the Search and Examination Report.

17.40 Explanations should clearly indicate, with reference to the cited documents, the reasons supporting the conclusions that any of the said criteria is or is not satisfied. If only certain passages of the cited documents are relevant or particularly relevant, the examiner should identify these, for example, by indicating the page, column or the lines where such passages appear.

17.41 Further guidance on the novelty considerations, inventive step consideration and industrial applicability considerations are provided in Chapters 12, 13 and 14, respectively.

Form Paragraphs for Objections and Refusals

17.42 The format for objections and refusals should be as follows:

Form paragraphs for objections and refusals based on lack of novelty

When there is a single piece of prior art which completely and clearly discloses the invention as claimed, the Examiner should use the following:

Law Article 1
A patent shall be granted, in accordance with the provisions of this Law, to any industrially applicable invention, which is new, involves an inventive step, whether connected with new industrial products, new industrial processes, or a new application of known industrial processes.

The patent is also granted, independently, for any modification, improvement or addition to a previously patented invention, which meets the criteria of being new, inventive and industrially applicable, as stated in the preceding paragraph; in which case the patent shall be granted, under the provisions of this Law, to the owner of the modification, improvement or addition.

Claim(s) _____ is(are) [1] under Article 1 of Law No. 82 of 2002 first paragraph as lacking novelty in view of [2]. All of the limitations of these claims are clearly set forth in this prior art reference. (If the prior art reference includes several embodiments or is very long, it would be useful for the examiner to point out which part of the prior art reference is being relied on to reject the claims.)

In [1] use the phrase “are objected to” for the first letter to applicant and use the word “refused” for final refusals of claims.

In [2] indicate the prior art being relied.

Example A: Claim 1 is refused under Article 1 of Law No. 82 of 2002 as lacking novelty in view of Egyptian Patent Number 12345.

Example B: Claims 1 and 5 to 10 are refused under Article 1 of Law No.82 of 2002 as lacking novelty in view of Egyptian Patent No. 11223. See embodiment 2 and Figure 4 of this patent.

When there is single piece of prior art which completely discloses the invention as claimed, but some explanation is needed by the examiner, then the following should be used:

Law Article 1
A patent shall be granted, in accordance with the provisions of this Law, to any industrially applicable invention, which is new, involves an inventive step, whether connected with new industrial products, new industrial processes, or a new application of known industrial processes.

The patent is also granted, independently, for any modification, improvement or addition to a previously patented invention, which meets the criteria of being new, inventive and industrially applicable, as stated in the preceding paragraph; in which case the patent shall be granted, under the provisions of this Law, to the owner of the modification, improvement or addition.

Claim(s) _____ is(are) [1] under Article 1 of Law No. 82 of 2002 first paragraph as lacking novelty in view of [2]. All of the limitations of these claims are set forth in this prior art reference. [3]

In [1] use the phrase “are objected to” for the first letter to applicant and use the word “refused” for final refusals of claims.

In [2] indicate the prior art being relied on for the basis for the refusal of the claims.

In [3] the examiner should include any explanations of what is not clearly found in the prior art.

Example C: Claims 1 to 4 and 11 are refused under Article 1 of Law No. 82 of 2002 first paragraph as lacking novelty in view of US Patent 123456. All of the limitations of these claims are set forth in this prior art reference. The “rod” as set forth in column 3, line 21 of this patent is read as being the same as the “bar” in applicant’s claim 1.

Form paragraphs related to lack of inventive step

When the claimed invention lacks inventive step in view of only one prior art reference, the examiner should use the following format:

Law Article 1
A patent shall be granted, in accordance with the provisions of this Law, to any industrially applicable invention, which is new, involves an inventive step, whether connected with new industrial products, new industrial processes, or a new application of known industrial processes.

The patent is also granted, independently, for any modification, improvement or addition to a previously patented invention, which meets the criteria of being new, inventive and industrially applicable, as stated in the preceding paragraph; in which case the patent shall be granted, under the provisions of this Law, to the owner of the modification, improvement or addition.

Claim(s) _____ is(are) [1] under Article 1 of Law No. 82 of 2002 first paragraph as lacking inventive step in view of [2]. [3]

In [1] use the phrase “are objected to” for the first letter to applicant and use the word “refused” for final refusals of claims.

In [2] the examiner should identify the prior art used in the refusal.

In [3] the examiner should include any explanation as to how the single piece of prior art can be obviously modified to meet all of the claimed limitations. See Manual Section 13.

Example D: Claims 4 and 11 to 15 are refused under Article 1 of Law No. 82 of 2002 first paragraph as lacking inventive step in view of Egyptian Patent 22113. The Patent sets forth all of the claimed limitations except for the limitation that the bread cutting machine has four blades. The Patent only discloses three blades but it is well known to those skilled in the bread-cutting art that four blades can be used in this type of cutting machine. Therefore, it would be obvious to modify the patent to include four blades and therefore, these claims lack inventive step.

When the claimed invention lacks inventive step in view of two or more prior art references, the examiner should use the following format

Claim(s) _____ is(are) [1] under Article 1 of Law No. 82 of 2002 first paragraph as lacking inventive step in view of _____ further taken in view of _____. (The examiner should include in the report any explanation as to how the two or more prior art citations can be obviously combined to meet all of the claimed limitations) See Manual Section 13)

In [1] use the phrase “are objected to” for the first letter to applicant and use the word “refused” for final refusals of claims.

Example E: Claims 4 to 15 and 21 to 30 are refused under Article 1 of Law No. 82 of 2002 first paragraph as lacking inventive step in view of Egyptian Patent No. 3322 further taken in view of JP Patent 442233. The Egyptian Patent sets forth all of the claimed limitations except for the limitation in claims 4 and 15 that the weld used to close the side seam of the vessel is a TIG weld. The Japanese patent discloses the same type of fluid-containing vessel as the Egyptian Patent and discloses that the side seam can be closed by TIG welding. One of ordinary skill in the art would recognize that different types of welds could be used to close the side seam of fluid-containing vessels and therefore would find it obvious to close the side seam of the vessel of the Egyptian Patent using a TIG weld as set forth in the Japanese Patent and therefore these claims lack inventive step.

Example F: Claims 1 to 15 are refused under Article 1 of Law No. 82 of 2002 first paragraph as lacking inventive step in view of the “Science” journal article by Smith and further in view of Egyptian Patent No. 4555 and further in view of the Australian Patent 122345. The “Science” journal article sets forth all of the claimed limitations except for the percentage of Carbon in the steel and the elasticity of the steel. The Egyptian patent shows that is well known in the art to use 3% carbon in structural steel. The steel beams set forth in both the “Science” article and in the Egyptian patent are both intended to be used in bridge construction. Therefore it would be obvious to one of ordinary skill in the art to make the structural steel beam of the “Science” article with steel to have 3% carbon. Additionally, The Australian patent discloses that the modulus of elasticity of steel used in structural beams can be in a range of 2 to 6, which includes the limitation in the claims that the elasticity be approximately 5. Therefore, it would be obvious to further modify the structural beam as disclosed in the “Science” article by making the modulus of elasticity of the beam approximately 5 as set forth in the Australian patent. Therefore, these claims lack inventive step.

Form paragraphs related to lack of industrial applicability

If the claims are directed to subject matter that lacks industrial applicability, the examiner should use the following:

Law Article 1
A patent shall be granted, in accordance with the provisions of this Law, to any industrially applicable invention, which is new, involves an inventive step, whether connected with new industrial products, new industrial processes, or a new application of known industrial processes.

The patent is also granted, independently, for any modification, improvement or addition to a previously patented invention, which meets the criteria of being new, inventive and industrially applicable, as stated in the preceding paragraph; in which case the patent shall be granted, under the provisions of this Law, to the owner of the modification, improvement or addition.

Claim(s) _____ is(are) [1] under Article 1 of Law No. 82 of 2002 first paragraph as lacking industrial applicability. [2]

In [1] use the phrase “are objected to” for the first letter to applicant and use the word “refused” for final refusals of claims.

In [2] explain why industrial applicability is lacking.

Example G: Claims 1- 10 are refused under Article 1 of Law No. 82 of 2002 first paragraph as lacking industrial applicability since the claimed invention is drawn to a chemical formulation which has no known use.

Example H: Claims 1- 20 are refused under Article 1 of Law No. 82 of 2002 first paragraph as lacking industrial applicability since the claimed invention is drawn to a perpetual motion machine and this is inconsistent with known scientific principles

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CHAPTER 18
HANDLING RESPONSES FROM APPLICANTS AND INTERVIEW PRACTICE

INTRODUCTION

18.01 The examination of a patent application includes a dialogue between examiners and the applicant. The applicant submits an application which is examined to determine whether it meets the requirements for patentability with the Office furnishing the applicant with a clear statement of any grounds for objection to the application. The applicant has an opportunity to respond, and the examiner considers the applicant's response. This dialogue strengthens the examination process and enhances the quality of patents that are issued by the Patent Office.

18.02 To provide a complete application file history and to enhance the clarity of the prosecution history record, the Legal and Technical Examiners must provide clear explanations of all actions taken during prosecution of an application. This includes answering all issues raised by applicants, whether in a written response or in an interview. When an applicant argues against any objection, or any other requirement made by the Patent Office, the examiner may agree or disagree with the applicant's arguments. In either event, whether the examiner decides to adopt the applicant's position, or to modify his or her initial position to agree with the applicant in part, or to maintain the same position, the examiner should take note of and answer the substance of applicant's arguments.

RESPONSES TO THE TECHNICAL EXAMINATION REPORT

APPLICANT'S ARGUMENTS FOUND TO BE PERSUASIVE – APPLICATION ACCEPTABLE

18.03 If applicant's arguments are persuasive, and upon reconsideration of the objection, the Examiner determines that the previous objection should be withdrawn, the Examiner must provide, in the next Office communication, the reasons why the previous objection is withdrawn by referring specifically to the page(s) and line(s) of applicant's remarks which form the basis for withdrawing the objection. It is not acceptable for the Examiner to merely indicate that all of applicant's remarks form the basis for withdrawing the previous objection. If the withdrawal of the previous objection results in the acceptance of the claims, the reasons, which form the basis for the withdrawal of the previous objection, may be included by giving the reasons for acceptance of the application.

18.03.00 Arguments are found to be Persuasive resulting in the withdrawal of Previous Objection – Application ready for Acceptance

Applicant's arguments, see [**1**], filed [**2**], with respect to [**3**] have been fully considered and are persuasive. The objection has been withdrawn.

Examiner Note

1. In bracket **[1]**, identify the page(s) and line number(s) from applicant's remarks which form the basis for the examiner's decision to withdraw the previous objection.

2. In bracket **[2]**, indicate date or dates of applicant's amendment or arguments.

3. In bracket **[3]**, insert claim number, figure number, the portion of the description, the abstract, etc. which was objected to by the examiner.

APPLICANT'S ARGUMENTS FOUND TO BE PERSUASIVE – NEW GROUND OF OBJECTION

18.04 If applicant's arguments are persuasive and the examiner determines that the previous objection should be withdrawn but that, upon further consideration, a new ground of objection should be made, form paragraph 18.04.00 may be used.

18.04.00 Arguments Persuasive - New Ground of Objection

Applicant's arguments, see [**1**], filed [**2**], with respect to the objection of claim(s) [**3**] under [**4**] have been fully considered and are persuasive. Therefore, the objection has been withdrawn. However, upon further consideration, a new ground of objection is made in view of [**5**].

Examiner Note

1. In bracket **[1]**, identify the page(s) and line number(s) from applicant's remarks which form the basis for withdrawing the previous objection

2. In bracket **[2]**, indicate date or dates of applicant's amendment or arguments.

3. In bracket **[3]**, insert the claim number(s).

4. In bracket **[4]**, insert the statutory basis for the previous objection.

5. In bracket **[5]**, insert the new ground(s) of objection, (e.g., different interpretation of the previously applied reference, newly found prior art reference(s), or some part(s) of the description found not to be complete), and provide an explanation the objection. The form paragraphs in Chapter 17 may be used in this situation where appropriate.

APPLICANT'S ARGUMENTS NOT FOUND TO BE PERSUASIVE

18.05 After receiving the Patent Office's Technical Search and Examination Report, the reply by applicant (in addition to making amendments, etc.) may frequently include arguments and supporting evidence (e.g., laboratory test results) to the effect that the prior art cited by the technical examiner should not be used to refuse the claims. If it is the technical examiner's considered opinion that the objection should be maintained, then the following paragraphs

may be used for addressing applicant's arguments. Providing a clear explanation of the basis for refusal will allow the applicant to understand the examiner's position and, if appeal is taken, the Appeals Committee will also better understand the examiner's position.

18.05.00 Use the following when applicants response does not persuade the examiner

Applicant's arguments filed **[1]** have been fully considered but they are not persuasive. **[2]**

Examiner Note

1. The examiner must address all arguments which were made by the applicant and have not already been responded to in the statements of refusal.(See chapter 17)

2. In bracket **[1]** provide the date or dates that applicants response(s) was/were received at the Patent Office

3. In bracket **[2]**, provide explanation as to why the examiner is not persuaded by the applicant by inserting one or more of the following paragraphs as appropriate.

4. At times none of the following paragraphs will be appropriate for addressing applicant's issues. The examiner must, however, address any arguments presented by the applicant which are still relevant.

18.05.01 Applicant Argues Against the Age of the References

In response to applicant's argument based upon the old age of the references, merely stating that the references are old is not persuasive absent a showing that others skilled in the art of the claimed invention, and having knowledge of the references, tried and failed to solve the same problem solved by applicant's invention.

18.05.02 Applicant Argues Against Individual References

In response to applicant's arguments against the references, inventive step cannot be shown by attacking references individually where the refusals are based on combinations of references

18.05.03 Applicant Argues that the Examiner Used Applicant's Reasoning

In response to applicant's argument that the technical examiner relied only on applicant's reasoning as his own reasoning for objecting to the claims, applicant should note that the technical examiner took into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gained only from the applicant's disclosure.

18.05.04 Applicant Argues that there is No Reason to Combine the References

In response to applicant's argument that there is no suggestion to combine the references to show lack of inventive step of the claimed invention, the technical examiner recognizes that lack of inventive step can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so. This suggestion must be found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. In this case, [1].

Examiner Note

In bracket [1], explain where the motivation for the refusal is found, either in the references, or in the knowledge generally available to one of ordinary skill in the art.

18.05.05 Applicant Argues that Non- Analogous Prior Art was Used

In response to applicant's argument that [1] cited by the examiner in the examination report is non-analogous art, applicant should note that for a prior art reference to be analogous, it must either be in the field of the inventor’s invention or, if not, then be reasonably pertinent to the particular problem with which the applicant was concerned, in order to be relied upon as a basis for refusal of the claimed invention. In this case, [2].

Examiner Note

1. In bracket **[1]**, enter the name of the reference which applicant alleges is non-analogous.

2. In bracket **[2]**, explain why the reference is analogous art.

18.05.06 Applicant Argues that too Many Prior Art References were Used

In response to applicant's argument that the technical examiner has combined an excessive number of references in refusing the claim, applicant should note that the reliance on a large number of references in a refusal does not, without other reasons, overcome the position that the claimed invention lacks inventive step.

18.05.07 Applicant Argues that Invention Obtains Results Not Contemplated by Prior Art

In response to applicant's argument that [1], the fact that applicant’s claimed invention merely recognizes another advantage which would flow naturally from following the suggestion of the prior art cannot be the basis for patentability when the differences would otherwise lack inventive step.

Examiner Note

In bracket **[1]**, briefly restate applicant's arguments with respect to the issue of results not contemplated by the prior art.

18.05.08 Applicant Argues about Limitations Which Are Not Claimed

In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., [1]) are not recited in the refused claim(s). Although the claims are interpreted in light of the description, limitations from the description are not considered unless they are specifically included in the claims.

Examiner Note

In bracket **[1]**, recite the features upon which applicant relies, but which are not recited in the claim(s).

18.05.09 Applicant Argues about the Intended Use of the Invention

In response to applicant's argument that [1], note that for a claimed intended use of the invention to show patentability over the prior art, this claimed intended use must result in a structural difference between the claimed invention and the prior art. It is only necessary that the structure of the prior art is capable of performing the same intended use as set forth in the claims

Examiner Note

In bracket **[1]**, briefly restate applicant's arguments with respect to the issue of intended use.

Example: If the introduction to a claim states that the claimed invention is drawn to a bread cutting machine, and the prior art used by the examiner is drawn to a meat cutting machine which is capable of cutting bread, then the claimed bread cutting machine would not patently define the claim over the prior art.

18.05.10 Applicant Argues that the Limitation(s) in Claim Introduction (Preamble) should be Limiting

Applicant argues, that the recitation [1] in the introduction to the claim has not been given patentable significance However, a claim introduction is generally not accorded any patentable significance where it merely recites the purpose of a process or the intended use of a structure, and where the body of the claim does not depend on the introduction for completeness. Applicant should note that even if the limitations related to the introduction are inserted into the non-introductory portions of the claim, it does mean that the claim is patentable just because the insertion is made. It only means that the limitation will be considered by the examiner when assessing patentability of the claim.

Examiner Note

In bracket **[1]**, briefly restate the recitation in the introduction about which applicant is arguing.

This form paragraph both informs the applicant that the examiner did not consider the the introductory portion of the claim and that even if the applicant does add limitations of the process or structure to the claim that this, by itself, may not result in the claim being patentable.

Example: If the introduction to a claim states that claim is drawn to a cutting machine, but the claim only includes structure of a motor with no relationship of this motor to the cutting machine, then this introductory phrase should not be given significance when determining patentability of the claim over the prior art.

18.05.11 Applicant Argues only Generally about Patentability

Applicant's arguments are not persuasive because they amount to a general allegation that the claims define a patentable invention without specifically pointing out how the language of the claims patentably distinguishes them from the references.

RESPONSES TO MATTERS

18.06 If there are any other matters that have been raised by the Patent Office in the Technical Examiners Report and if the response to these matters by the applicant fails to satisfy the requirements of the Patent Office, then these should be addressed by the examiner in the next report

Interview Practice

SCHEDULING THE INTERVIEW

18.07 When applicant requests an interview, an "Applicant Interview Request" form (EGPO Form 94) must be submitted to the Patent Office prior to the interview in order to permit the examiner to prepare in advance for the interview and to focus on the issues to be discussed. This form should identify the participants of the interview, the proposed date of the interview, whether the interview will be personal or by telephone, and should include a brief description of the issues to be discussed. Applicants are encouraged to use form EGPO Form 94, but, the fact that applicant does not submit this form is not, by itself, grounds for the examiner to deny a request for an interview. This form may also accompany an applicant's response to the technical examination report or other communication from the Patent Office.

18.08 Once an appointment for interview is arranged, the appointment should be kept. Many applicants and agents plan trips to Cairo for the purpose of holding an interview with the examiner. After an appointment has been made, if circumstances compel the absence of the examiner whose presence is necessary for the interview to be effective, the other party should be notified immediately so that alternative arrangements may be made, and to minimize the inconvenience to applicant or the applicant's representative.

18.09 When a telephone call is made to an examiner and it becomes evident that the discussion will be lengthy or that the examiner needs time to restudy the situation, the call should be ended with an agreement that the examiner or applicant will call back at a specified time. Any such telephone calls originated by the examiner should be made from the Patent Office.

18.10 An interview should be conducted only when the nature of the case is such that the interview could serve to develop and clarify specific issues and lead to a mutual understanding between the examiner and the applicant, and thereby advance the prosecution of the application. Thus, when presenting himself or herself for an interview, the agent should be fully prepared to discuss the issues raised in the official letter from the Office. When it is obvious that the agent is not so prepared, an interview should not be permitted. It is desirable that the agent or applicant indicate in advance what issues he or she desires to discuss at the interview. This would permit the examiner to prepare in advance for the interview and to focus on the matters set forth in the proposed amendment.

18.11 An interview should normally be denied if an attorney or applicant unexpectedly appears and requests an interview without any previous notice to the examiner, unless there are exceptional circumstances. However, it is appropriate in this situation to offer the attorney or applicant an appointment for an interview at a time that will permit the examiner to prepare for the interview.

APPROVAL OF INTERVIEW

18.12 Any interview with staff of the Patent Office must be approved in advance by the President of the Patent Office, or in the absence of the President, by his or her designee. Requests for approval must include a copy of the "Applicant Interview Request" along with the examiner's recommendation as to whether an interview will be productive, if requested by the President

of the Patent Office. Normally, the examiner should recommend that an interview be approved unless there is some indication that the interview will not be productive (e.g., where there have already been prior interviews with the applicant in the same application with no productive result). The Technical Examiner may also request an interview with the applicant and these requests must also be approved by the President of the Patent Office.

PREPARING FOR THE INTERVIEW

18.13 The examiner should familiarize himself or herself with the status of the application and existing issues before an interview. For the interview to be most productive, both the examiner and the applicant should be fully aware of all of the issues in the application.

CONDUCTING THE INTERVIEW

18.14 The interview should be conducted in a business-like manner, with due respect accorded to both parties.

18.15 The examiner should not hesitate to state, if such be the case, that claims or other issues presented for consideration at the interview require further search and study. The examiner should not hesitate to end an interview when it appears that no common ground can be reached, or when it becomes apparent that the application requires further amendment or an additional action by the examiner. However, the examiner should attempt to identify issues and resolve differences during the interview as much as possible.

18.16 It is the responsibility of both parties to the interview to expedite the interview process so that the interview is concluded in a reasonable time, usually no longer than 30 minutes. Clearly, there are situations where a longer interview can be productive, and therefore an interview should not be terminated merely because it has extended beyond 30 minutes. It is the duty of the examiner to see that an interview is not extended beyond a reasonable period, i.e., the period needed to address the issues that are the subject of the interview.

18.17 During an interview with an applicant who is prosecuting his or her own case and is not familiar with Office procedure, the examiner may make suggestions that will advance the prosecution of this case. However, whether the applicant is represented or not, the examiner should not assume the responsibility of the applicant (or agent) for determining how to prepare the application or what to claim. In addition, the examiner should not devote too much time to such interviews. That is, the examiner should not devote so much time to an interview, even with unrepresented applicants, that time spent in the interview unduly delays or interferes with the examiner's other duties. Both the time devoted to interviews and the degree to which the examiner makes suggestions to advance the prosecution of the case lie wholly within the examiner's discretion

18.18 Where agreement is reached as a result of an interview, applicants should be advised that an amendment pursuant to the agreement should be promptly submitted.

18.19 The substance of any interview, including any agreements made, must be made of record in the application.

CHAPTER 19
OPPOSITIONS

INTRODUCTION

19.01 The purpose of this chapter is to explain the procedures for opposition to the grant of a patent by the Patent Office.

19.02 Briefly, if an interested party has reasons to oppose the grant of a patent due to the existence of evidence that a patent should not be granted, this party may bring this evidence to the attention of the Patent Office, and by doing so it will initiate a process to decide whether the patent should be granted in view of the evidence provided by the opposing party. Oppositions may be based on multiple different grounds, and oppositions may be filed by multiple interested parties

LEGAL BASIS

19.03 The basis for oppositions is set forth in Article 16 of Law 82/2002 and Article 17 of Law 82/2002 sets forth that certain Ministries can oppose the grant of a patent under certain conditions.

Law Article 16

The Patent Office shall examine the patent application and its annexes in order to ascertain that the invention is new, involves an inventive step and is industrially applicable, in conformity with the provisions of Articles 1, 2 and 3 of this Law.

Where the invention satisfies the aforementioned conditions, and where the conditions provided for in Articles 12 and 13 are fulfilled in the patent application, the Patent Office shall publish the application acceptance, in the Patent Gazette, in the manner prescribed in the Regulations.

Any concerned party may submit to the Patent Office, within 60 days from the publication of the application acceptance in the Patent Gazette, and according to the procedure prescribed by the Regulations, a written notice to oppose the granting the patent, stating the reasons therefor.

Such an opposition shall be subject to the payment of a fee, to be fixed by the Regulations, of not less than 100 pounds and not more than 1,000 pounds, which

will be reimbursed in case the opposition is accepted.

Oppositions shall be examined by the Committee established under Article 36, in accordance with the conditions and procedures stipulated in the Regulations.

Law Article 17

The Patent Office shall send to the Ministry of Defense, the Ministry of Military Production, the Ministry of Interior or the Ministry of Health, as required, copies of patent applications, with their annexes, that relate to defense, military production, security matters or that have a military, security or health significance, within 10 days from the examination of the application, notifying the applicant thereof within 7 days. The Minister of Defense, the Minister of Military Production, the Minister of Interior or the Minister of Health, as might be the case, may, within 90 days from the date of notification, oppose the publication of the application acceptance.

Where the acceptance of the application is made public, the competent Minister may oppose the procedure to grant a patent within 90 days from the date of the publication, in the Patent Gazette, of the decision to accept the patent application, if it appears that the application relates to defense, military production, security or is of military, security or health significance.

Opposition in the aforementioned cases shall stop the procedure of granting the patent.

19.04 Further details on oppositions are set forth in Regulation Articles 23 to 30, and 59 which are referred in the appropriate sections below.

REGULATIONS - ARTICLE 23.
Opposition to the grant of a patent shall be made, within sixty days from the date of publication of the acceptance of the application in the Gazette, by a notification addressed to the Office in two copies, using the form established to that effect. An opposition shall be acceptable only upon payment of the fee fixed in the schedule attached to these Regulations. If the opposition is accepted, such fee shall be reimbursed.

REGULATIONS - ARTICLE 24.
The Office shall communicate, by registered mail with acknowledgement of receipt, within seven days from the date of opposition, a copy of the opposition to the applicant.

The applicant may respond to the opposition within fifteen days from the date of communication. The response shall be submitted to the Office, in two copies, using the form established to that effect.

The Office shall send to the opposing party, by registered mail with acknowledgement of receipt, a copy of the response, within seven days from the date of receipt by the Office of the response.

REGULATIONS - ARTICLE 25.
A hearing shall be fixed by the chairman of the committee provided for by Article 36 of the Law, for that committee to consider the opposition. The applicant and the opposing party shall be informed, by registered mail with acknowledgement of receipt, of the date of such hearing at least ten days before such date.

REGULATIONS - ARTICLE 26.
Where the committee decides to designate an expert, such decision shall contain:

(1) Precise statement of the mandate of the expert.

(2) Deadline for the submission of the expert report.

(3) Date of the hearing during which the report will be discussed.

REGULATIONS -ARTICLE 27.
If the expert is a government officer or employee of a governmental authority, the committee shall inform such expert of the designation decision through the authority with which the expert is attached. If the expert is not such an officer or employee, that expert shall be informed by registered mail with acknowledgement of receipt.

REGULATIONS -ARTICLE 28.
If the opposing and responding parties agree on the designation of an expert, the committee shall approve such designation.

REGULATIONS -ARTICLE 29.
The Office shall notify the opposing and responding parties, by registered mail with acknowledgement of receipt, of the decision rendered regarding the opposition and reasons therefore, within ten days from the date at which such decision is rendered.

REGULATIONS -ARTICLE 30.
If no opposition is made against the grant of a patent or an opposition was made and a decision refusing the opposition is rendered, the Office shall proceed with the grant of the patent.

REGULATIONS -ARTICLE 59.
The appeal shall be brought before the Committee referred to under Article 58 of these Regulations, on the form established to that effect, against payment of the fee fixed in the schedule attached to these Regulations.

FORMATION OF THE APPEALS COMMITTEE TO REVIEW OPPOSITIONS

19.05 The Committee to examine oppositions as established in the last paragraph of Law Article 16 is defined by Law Article 36

LAW ARTICLE 36

A committee shall be established by decision of the competent minister and shall be empowered to examine appeals against decisions made by the Patent Office in application of the provisions of this Law. The committee shall be composed of a

chairman who shall be a consultant at the appeal courts or of a corresponding rank from the judiciary, an assistant consultant of the State Council and three experts as members.

Fees of not more than 500 pounds shall be fixed by the Regulations for appeals brought before the committee.

The committee shall decide on an appeal within 60 days from the date of its filing. The decisions of the committee shall be final.

Apart from revocation requests combined with an order to waive execution, no complaints against decisions of the Patent Office may be brought to court before a decision was taken on the appeal, or within 60 days from filing the appeal if not decided.

The Regulations shall fix the rules of procedure of this Committee.

Regulations Articles 58 and 60 set forth the formation and the procedures of the Appeals Committee

REGULATION ARTICLE 58.

The competent Minister for scientific Research Affairs, on a proposal by the President of the Academy of Scientific Research and Technology and in conformity with the legal provisions prescribed with respect to the two members of the Judiciary, issue a decision forming the Appeals Committee provided for by Article 36 of the Law.

Appointment of the chairman and members shall be for a renewable period of one year. The decision shall include the financial treatment fixed for the chairman and members of the Committee and the constitution of a technical secretariat which shall be responsible for the processing of appeal files brought before it, including annexed submissions and documentation, and the minutes of the hearings of the Committee, and the execution of the decisions rendered by it.

REGULATION ARTICLE 60.

The chairman of the Committee shall fix the hearing during which the appeal is to be considered. The number of hearings held by the Committee shall be, at least two per month. A hearing may be held in the absence of an expert member of the Committee. The notification of the person making the appeal of the fixed hearing shall be addressed to that person or the agent or by registered mail with acknowledgement of receipt, at the address indicated in the appeal or, if no such address is indicated in the appeal, the address indicated in the file.

If the person making the appeal fails to attend two consecutive hearings, despite a legally made notification, the Committee shall deem the appeal as non-existent; in which case, that person shall not be entitled to file a new appeal.

The Committee may invite any person having expertise in the art to express an opinion regarding appeals brought before it, without the right to vote in the deliberations.

The Committee shall render its decisions upon hearing the person making the appeal and the representative of the Office, by absolute majority; In case of equal votes, the vote of the chairman shall prevail.

INITIATING AN OPPOSITION

19.06 The time limit for the filing of an opposition, as set forth in Law Article 16 and Regulation Article 23, is set at 60 days from the publication of the acceptance of the application in the Gazette.

19.07 The fee for filing an opposition is set forth in the fee table attached to the current version of the Regulations. If the opposition is accepted (i.e. considered to contain evidence which convinces the Appeals Committee that the patent application in the form accepted by the Patent Office should not be granted as a patent) by the decision of the Appeals Committee, then the fee for filing of the opposition shall be reimbursed to the opposing party as set forth in Regulation Article 23.

19.08 Notifications of the opposition to the grant of a patent shall be addressed to and delivered in person to the Patent Office.

FORMAT AND CONTENT OF THE OPPOSITION

19.09 The party filing the notice of opposition with the Patent Office must furnish a complete explanation of the grounds on which opposition to the grant of the patent is based. Since most patent applications have multiple claims, the claims for which there is opposition should be set forth. There may also be oppositions based on grounds that do not relate to any claims in particular, e.g., if the grounds for opposition are that the Patent application would not be granted to the true inventor or his successor.

19.10 In the situations where the opposition is based on the allegation of lack of novelty or inventive step, the opposing party must clearly and completely explain how the prior art should be used to refuse the claims. A mere furnishing of prior art references without explanation will normally result in the Appeals Committee upholding the acceptance of the application by the Patent Office.

19.11 The notification of opposition must be accompanied by documentary evidence supporting the grounds for opposition. The evidence can include such things as prior art references, rejections or refusals of other patent offices, evidence of prior use or publication of the invention prior to the effective filing date, and proof that the inventor is not as set forth in the application. These are only examples of grounds for opposing the grant of a patent in Egypt.

19.12 If a person is being relied for evidence to support the opposition, then the evidence this person provides must be presented in the form of a notarized, sworn statement. An allegation without any evidentiary support will normally be not be considered by the Appeals Committee.

PROCEDURES AFTER FILING OF THE OPPOSITION

19.13 When an opposition is filed at the Patent Office, a Legal Examiner will check the documents and fee to ensure that everything is proper in accordance with the requirements of the regulations.

19.14 Regulation Article 24 requires that the Patent Office notify the applicant of the filing of an opposition and provide the applicant a copy of the opposition within 7 days of the filing.

19.15 After being informed of the opposition, the applicant has 15 days to file any response to the opposition as set forth in Regulation Article 24. The response must be in duplicate and in the format required by the Patent Office. The response must include copies of any exhibits the applicant expects to introduce in an oral statement to the Committee.

19.16 The response by the applicant should address all of the issues raised by the opposing party. It should be specific as to why the opposition is incorrect. A mere allegation that the opposition is not appropriate without any reasoning will make it difficult for the Appeals Committee to take into account the applicant's position when it considers the opposition.

19.17 Any response from the applicant received by the Patent Office is sent to the opposing party within 7 days from the date of receipt of the response, as required by Regulation Article 24.

19.18 In exceptional cases, either party may, within 7 days of receipt the comment of the other party, request the opportunity to submit a rebuttal to new information raised by the other party in the interest of fairness and to avoid surprise to the Committee or the other party.

19.19 If the applicant or opposer expects to introduce any exhibits in the oral statement to the Appeals Committee, a copy of such exhibits must be submitted to the Appeals Committee at a date to be set by the Committee.

19.20 After this opportunity for the applicant to comment on the issue of the opposition, no further communications related to the substance of the opposition will be permitted since it is necessary for the Patent Office to evaluate the opposition prior to the hearing of the committee.

19.21 After the periods for the applicant and opposing party to submit documents have ended, the entire file of the application will be given to a Technical Examiner for evaluation and recommendation. The Technical Examiner should prepare a report that explains the recommendation. The report should be specifically directed to each and every point made by the opposition party, taking into consideration the response by applicant. A copy of the recommendation and report of the Technical Examiner should be mailed to the applicant and the opposing party at least 10 days prior to the meeting of the Appeals Committee.

19.22 The Appeals Secretariat will prepare the documents related to the request to be viewed by the Appeals Committee. One copy should be prepared for each member of the Committee. The documents should be delivered to each of the Appeals Committee members in advance of the scheduled hearing date of the Committee.

19.23 The documents that should be provided to the Committee member include:

- A copy of the application, including any amendments
- A copy of the opposition
- A copy on any response by the applicant
- A copy of the recommendation of the Technical Examiner

- Copies of any prior art references, if the opposition is directed towards issues related to the prior art

19.24 The Appeals Committee may designate an expert as allowed in Regulation Articles 26 to 28,. The functions of the expert should include a review of the record of the application, the opposition, and any response by the applicant and should be limited to only the issues raised in the opposition. The report of the Expert should be provided to the Appeals Committee by the date fixed by that Committee.

PROCEDURES OF THE APPEALS COMMITTEE FOR DECIDING OPPOSITIONS

19.25 Regulation Article 25 requires the Chairman of the Appeals Committee to fix a date of the hearing for considering the opposition. Law Article 36, establishes the Appeals Committee, with jurisdiction for hearing both appeals and oppositions (see Regulation Article 25). An opposition should be considered as an appeal of a decision of the Patent Office.

19.26 If there is a single party opposing the grant of the patent, then that party or a representative may attend the hearing. Any representative must be registered to practice before the Patent Office.

19.27 If there are multiple parties opposing the grant of the patent, then each may be represented as set forth in the previous paragraph. The Appeals Committee will decide on a case-by-case basis whether multiple opposing parties will appear at the same hearing or whether there will be separate hearings for each opposition.

19.28 The decision of the Appeals Committee will be based solely on the written record of the as compiled by the Patent Office. No new grounds of refusal or evidence will be permitted at the time of the Hearing.

19.29 The applicant and the opposing party will each be given the opportunity to summarize their positions in an oral statement at the Hearing of the Appeals Committee. The statements may not bring up new issues or new evidence, i.e., issues or evidence that was not included in the written documents already submitted. If the statements include any additional issue or evidence, it will be disregarded by the Appeals Committee.

19.30 If the applicant or opposing party intends to make a statement to the Appeals Committee, then the Committee and the Patent Office should be notified.

POST-OPPOSITION PROCEDURES

19.31 Once the Appeals Committee has reached a decision on an opposition, it should prepare a report detailing its decision and the reasons for the decision. The decision with the reasons is communicated to the Patent Office. The Patent Office will communicate the decision with the reasons to the opposing party and the applicant within 10 days of the decision of the Appeals Committee as required in Regulation Article 29.

19.32 Even if the decision of the Appeals Committee upholds the opposition, it may be possible for the applicant to amend the application to place the application again in condition for acceptance by the Patent Office. An example is in the situation where the opposition accepted by the Appeals Committee affects some, but not all, of the claims of the application. In this case, the applicant may be able to amend the claims to place the application in form for acceptance. Or, the applicant may be able to amend claims to avoid the ground for opposition by, for example, introducing limitations that would distinguish the application from the subject matter that is the basis for the opposition. In any event, no new matter can be introduced by the applicant, and at this stage of the proceedings, any amendments must be limited to reasons that are the subject of the opposition. At the time the decision of the Appeals Committee is communicated to the applicant, the applicant should be given a time limit for making any amendments.

19.33 If any such amendments are made to the application and these amendments again place the application in condition for allowance, then the acceptance should again be published in the Gazette.

19.34 If the decision of the Appeals Committee is to reject the opposition, then the Patent Office will proceed with the grant of the patent as required by Regulation Article 30.

APPEAL TO THE ADMINISTRATIVE TRIBUNAL FROM DECISION BY THE APPEALS COMMITTEE

19.35 After the decision by the Appeals Committee, any interested party may appeal the decision to the Administrative Tribunal. Any such Appeal must be made within 60 days of the notification of the Appeals Committee decision as set forth in Law Article 37.

19.36 The procedures of the Administrative Tribunal govern the appeal process before that Tribunal.

CHAPTER 20
APPEALS PROCEDURES

INTRODUCTION

20.01 An applicant who is dissatisfied with a decision of the Patent Office may file an appeal within the Patent Office in accordance with the procedures set forth in the Law, Regulations, and the Procedures. If the applicant is dissatisfied with the decision of the Appeals Committee, the applicant is entitled to file another appeal to the Administrative Tribunal. This Chapter sets forth the procedures for handling appeals to the Appeals Committee.

LEGAL AUTHORITY FOR APPEALS

20.02 The legal authority for appeals is found in Law 82/2002 and the implementing regulations, which provide as follows:

LAW ARTICLE 14

The Patent Office may, as stipulated in the Regulations, require the applicant to make any amendments or complements which it shall deem necessary to comply with the provisions of Article 13. If the applicant fails to comply within three months of notification, he shall be considered as having withdrawn his application.

The applicant may, within 30 days and in accordance with the conditions stipulated in the Regulations, appeal such request by the Patent Office before the Committee provided for in Article 36.

LAW ARTICLE 36

A committee shall be established by decision of the competent minister and shall be empowered to examine appeals against decisions by the Patent Office in application of the provisions of this Law. The committee shall be composed of a chairman who shall be a consultant at the appeal courts or of a corresponding rank from the judiciary, an assistant consultant of the State Council and three experts as members.

Fees of not more than 500 pounds shall be fixed by the Regulations for appeals brought before the committee.

The committee shall decide on an appeal within 60 days from the date of its filing. The decisions of the-committee shall be final.

Apart from revocation requests combined with an order to waive execution, no complaints against decisions of the Patent Office may be brought to court before a decision was taken on the appeal or within 60 days from filing the appeal if not decided.

The Regulations shall fix the rules of procedure of this Committee.

REGULATION ARTICLE 20

The applicant may appeal against the decision of the Office before the committee provided for by Article 36 of the Law, within thirty days from the date of notification of the decision, against payment of the fee fixed in the schedule attached to these Regulations. The appeal shall be made, in two copies, using the form established to that effect.

The Office shall notify, by registered mail with acknowledgement of receipt, the person making the appeal, of the date at which the committee will be convened to consider the appeal, and summon that person to attend the hearing of the committee. Such notification must be received, at least seven days, before the date of the hearing.

A representative of the Office may attend the hearing convened for the consideration of the appeal, and shall be entitled to respond to the objections made by the person making the appeal.

The person making the appeal shall be notified, by registered mail with acknowledgement of receipt, of the decision made by the committee with the reasons therefore.

REGULATION ARTICLE 26

Where the committee decides to designate an expert, such decision shall contain:

(1) Precise statement of the mandate of the expert.

(2) Deadline for the submission of the expert report.

(3) Date of the hearing during which the report will be discussed.

REGULATION ARTICLE 27

If the expert is a government officer or employee of a governmental authority, the committee shall inform such expert of the designation decision through the authority with which the expert is attached. If the expert is not such an officer or employee, that expert shall be informed by registered mail with acknowledgement of receipt.

REGULATION ARTICLE 58

The competent Minister for Scientific Research Affairs, on a proposal by the President of the Academy of Scientific Research and Technology and in conformity with the legal provisions prescribed with respect to the two members of the Judiciary, issue a decision forming the appeal committee provided for by Article 36 of the Law.

Appointment of the chairman and members shall be for a renewable period of one year. The decision shall include the financial treatment fixed for the chairman and members of the Committee and the constitution of a technical secretariat which shall be responsible for the processing of appeal files brought before it, including annexed

submissions and documentation, and the minutes of the hearings of the Committee, and the execution of the decisions rendered by it.

REGULATION ARTICLE 59

The appeal shall be brought before the Committee referred to under Article 58 of these Regulations, on the form established to that effect, against payment of the fee fixed in the schedule attached to these Regulations

REGULATION ARTICLE 60

The chairman of the Committee shall fix the hearing during which the appeal is to be considered. The number of hearings held by the Committee shall be, at least two per month. A hearing may be held in the absence of an expert member of the Committee. The notification of the person making the appeal of the fixed hearing shall be addressed to that person or the agent or by registered mail with acknowledgement of receipt, at the address indicated in the appeal or, if no such address is indicated in the appeal, the address indicated in the file.

If the person making the appeal fails to attend two consecutive hearings, despite a legally made notification, the Committee shall deem the appeal as non-existent; in which case, that person shall not be entitled to file a new appeal.

The Committee may invite any person having expertise in the art to express an opinion regarding appeals brought before it, without the right to vote in the deliberations.

The Committee shall render its decisions upon hearing the person making the appeal and the representative of the Office, by absolute majority; In case of equal votes, the vote of the chairman shall prevail.

PROCEDURES FOR APPEALS WITHIN THE PATENT OFFICE

HOW INITIATED, TIME LIMITS FOR FILING AN APPEAL, NOTICE OF APPEAL, AND NOTIFICATIONS

20.03 An appeal is initiated when an applicant files a Notice of Appeal, appealing from a decision of the Patent Office, within 30 days or 60 days, as the case may be, of the decision from which applicant desires to appeal as set forth in Regulation Article 20. The two copies of the Notice of Appeal as required in Regulation Article 20 should state the decision of the Office from which the applicant appeals. The Notice of Appeal should be addressed to and delivered to the Patent Office.

20.04 The fee for the Appeal is as set forth in the schedule of fees established by the Patent Office.

20.05 For the appeal to be complete, the applicant must provide a written brief explaining the applicant's position. The brief should either be submitted with the Notice of Appeal, or during the examination of the appeal before the Committee.

2.05.1 The brief should be submitted in the format shown below. The Committee will consider an appeal that is stated in another format, provided the necessary information is provided in a succinct and legible manner.

20.06 The Head of the Appeals Committee will set a date for the hearing where the applicant must be represented as required by Regulation Article 20. If applicant fails to attend two hearings scheduled for the review of the appeal, the appeal will be considered to be deemed as non-existent.

20.07 If applicant desires to make an oral presentation to the Appeals Committee hearing, this may be permissible provided that the applicant states the issues brought up before the Committee in a memorandum signed by him/her and including the issues mentioned orally during the hearing.

APPEALS COMMITTEE

20.08 An Appeals Committee should be appointed in accordance with Article 58 of the Regulations.

FORMAT OF APPEALS BRIEFS

20.09 The following format should be used when preparing an appeal brief in an appeal before the Appeals Committee. The purpose of this format is to promote uniformity in the manner in which appeal briefs are presented and to suggest content guidelines.

20.10 Applicant's Appeal Brief shall contain the following items under appropriate headings and in the order indicated below, unless the brief is filed by an applicant who is not represented by a registered patent agent:

(1) *Status of claims*. A statement identifying the claims appealed, if any.

(2) *Status of amendments*. A statement of the status of any amendment filed prior to filing of the appeal.

(3) *Summary of invention.* A concise explanation of the invention defined in the claims involved in the appeal.

(4) *Issues.* A concise statement of the issues presented for review.

(5) *Argument.* The contentions of appellant with respect to each of the issues presented for review, and the basis therefor, with citations of the authorities, statutes, and parts of the record relied on. Each issue should be treated under a separate heading. For each objection or refusal, the arguments should specify why the applicant believes the Patent Office's decision is in error. Applicant's arguments should be detailed and specifically address the ground for rejection or requirements that are the subject of the appeal. It is not sufficient that the applicant simply make a broad statement that applicant disagrees with the Patent Office's decision. Arguments should be specific..

20.11 If a brief is filed which does not comply with all the above requirements, the Appeals Committee is under no obligation to consider the Appeal in relation to any of the omitted requirements. The Appeals Committee may notify the applicant that there are missing items and may give the applicant additional time for completing the requirements necessary for the Committee's consideration, in which case the applicant will be notified of the reasons for non-compliance, and it's up to the Committee to decide this..

ACTIONS BY THE PATENT OFFICE AFTER FILING OF THE APPEAL

20.12 When a Notice of Appeal is received by the Office, it should be docketed and the application is prepared to be viewed by the Committee.

20.13 When an appeal is filed at the Patent Office, a Legal Examiner will check the documents and fee to ensure that everything is proper in accordance with the requirements of the regulations.

20.14 In case of appealing against a decision on technical refusal, the entire file of the application will be given to a technical examiner for evaluation and recommendation. The Technical Examiner should prepare a report that explains the recommendation. The report should be specifically directed to each and every point made in the Appeal. The technical examiner will prepare a Reply Brief, which is the Patent Office's reply to Applicant's Appeal Brief. The Reply Brief should be in substantially the same format as applicant's Appeal Brief. The appeal examination date should be mailed to the appellant at least 10 days prior to the meeting of the Appeals Committee. Either party may request the opportunity to submit a rebuttal to respond to new issues raised by the other party.

If, at the time an application file is sent to the technical examiner for preparation of the evaluation and recommendation, the technical examiner determines that jurisdiction should be restored to him or her for further examination (e.g., to make a new refusal or objection, or to accept the application), the technical examiner should request that the application be returned to the jurisdiction of the technical examiner. Such a request must be approved by the President of the Patent Office. If the examiner's request is granted, the Appeals Committee will stay (suspend) further proceedings in connection with the appeal. If the request is denied, the technical examiner should proceed with preparation of the evaluation and recommendations.

If an expert is designated by the Appeals Committee as allowed in Regulation Articles 26 and 27, then such a designation should be made sufficiently in advance of the hearing date to allow the expert to carry out the required functions. These functions should include a review of the record of the application. The report of the Expert should be provided to the Patent Office such that it can be included in the documents provided to the Appeals Committee and applicant.

20.15 The Secretariat of the Committee will be assigned for the preparation of the documents for the Appeals Committee. One copy should be prepared for each member of the Committee. The documents should be delivered to each of the Appeals Committee members at least 7 days prior to the scheduled hearing date of the Committee.

20.16 The Appeals Secretariat shall notify, by registered mail with acknowledgement of receipt, the person making the appeal, of the date at which the committee will be convened to consider the appeal, and summon that person to attend the hearing of the committee. Such notification must be received, at least seven days, before the date of the hearing.

20.17 The documents that should be provided to each Appeals Committee member include:

- A copy of the application, including any amendments
- A copy of applicant's Appeal Brief and any rebuttal
- A copy of the recommendation of the Technical Examiner, the examiner's Reply Brief, and any rebuttal
- The report of the expert, if an expert is designated
- Copies of any prior art references cited in the application which form the basis of any claims on Appeal.

DELIBERATIONS OF THE APPEALS COMMITTEE

20.18 The Appeals Committee should consider the issues raised for appeal in accordance with the law, regulations, international conventions to which Egypt is a party, and the procedures manual. Only the issues identified in the Notice of Appeal and included in Applicant's Appeal Brief should be considered by the Committee.

20.19 The Appeals Committee may summarily dismiss an appeal in the following circumstances:

1) If the Appeals Committee finds that the appeal involves an identical question of patentability, i.e., involving the same claim elements and issues, that has already been decided in a previous appeal in the same application, or in a parent of the application, or

2) If the Appeals Committee finds that the appeal is based on a frivolous ground, that is, a ground that is without any basis in fact or law.

If the appeal is summarily dismissed, the Appeals Committee need not grant a full consideration of all issues raised by the appellant or address those issues in its written opinion other than by noting the ground and the Committee's reasoning for summary dismissal.

20.20 Ordinarily, an appeal should not be brought until all issues in a case have been decided and the only remaining issue is whether to refuse or accept the application. In certain cases, an examiner may make a requirement that will make a significant change the rights to be obtained by patent. In these cases, the applicant may appeal from that requirement. In this case, the decision of the Committee will be to affirm or reject the examiner's requirement and in either event, the case will be returned to the examiner for further action consistent with the holding of the Appeals Committee.

20.21 In the course of its deliberations, the Appeals Committee may take note of one or more additional issues that affect the patentability of the invention but have not been addressed by the examiner. In this case, the application should be returned to the examiner with instructions to address this issue.

20.22 The Decision of the Appeals Committee should be in writing, with a brief explanation of the reasons supporting its decision. The reasons should address each point raised in the brief of the applicant and in the technical examiner's recommendation. The Appeals Committee should ordinarily issue its Decision (with reasons). Copies of the Appeals Committee Decision, including the reasons, should be provided to the applicant, and a copy should be placed in the application file.

PROCEDURES AFTER DECISION OF THE APPEAL COMMITTEE

20.23 If the Committee decides not to affirm the refusal, and the application is otherwise in condition for publication of the acceptance, the necessary procedures should be initiated by the Patent Office.

20.24 If the application can be amended, e.g. by the cancellation of refused claims, and be put into condition for acceptance, then applicant should be given a grace period.

APPEAL TO THE ADMINISTRATIVE TRIBUNAL FROM DECISION BY THE APPEALS COMMITTEE

20.25 After the decision by the Appeals Committee, any interested party may appeal the decision to the Administrative Tribunal. Any such Appeal must be made within 60 days of the notification date of the Office or the aprties interested as set forth in Law Article 37.