



**OFFICE OF RESEARCH, INNOVATION AND DEVELOPMENT (ORID)
TECHNOLOGY TRANSFER AND INTELLECTUAL PROPERTY SERVICES (TTIPS)**

**GUIDELINES FOR EVALUATION OF
INVENTION DISCLOSURES**

Content	Page
1.0 Introduction	2
2.1 Patentable Inventions	2
2.2 Non –patentable Inventions	2
3.0 Evaluation of Invention Disclosures	2
4.0 Recommendation on Invention Disclosure	3
5.0 Communicating Outcomes of Evaluations	3
6.0 Filing for Patent Protection	3

1.0 Introduction

This document serves as a guide to the Intellectual Property Committee (IPC) in evaluating invention disclosures. It provides a basis for determining whether innovative research findings should be protected as an intellectual property asset for the University of Ghana, based on the commercial potential, competing technologies, (potential) market demand, etc.

2.1 Patentable Inventions

An invention is patentable if it is new, involves an inventive step and is industrially applicable.

2.2 Non-patentable Inventions

Discoveries of materials already existing in nature, laws of nature, scientific theories or mathematical methods cannot be patented.

The under listed inventions as indicated in Section 2 of Ghana's Patent Act, 2003 (Act 657) are excluded from patent protection even if they satisfy the conditions indicated in **2.1** above.

- a) Discoveries¹, scientific theories and mathematical methods;
- b) Schemes, rules or methods for doing business, performing purely mental acts or playing games;
- c) Methods for treatment of the human or animal body by surgery or therapy, as well as diagnostic methods practiced on the human or animal body; this provision will not apply to products for use in any of those methods;
- d) Inventions, the prevention within the country of the commercial exploitation of which is necessary to protect public order or morality, which includes:
 - i) The protection of human, animal or plant life or health; or
 - ii) The avoidance of serious prejudice to the environment; if the exclusion is not made because the exploitation is prohibited.
- e) Plants and animals other than micro-organisms;
- f) Biological processes for the protection of plants or animals other than non-biological and micro-biological processes; and
- g) Plant varieties.

The subject matter of what is patentable and what is excluded from patentability depends on national legislation or international treaty. Generally, the above-named inventions cannot be patented at the national, regional or international levels.

3.0 Evaluating Invention Disclosures

Following the receipt of an Invention Disclosure Form and/or report of a preliminary patent search the IPC would conduct a detailed evaluation of the invention. This is to determine whether the invention will be accepted for the purposes of protection and/ or commercialisation.

In doing this, the following would be considered;

- i. **Novelty:** The invention must depict some element of novelty and must not be anticipated by prior art.

Prior art consists of any information disclosed to the public, anywhere in the world, by publication in tangible form or oral disclosure, by use or in any other way, prior to the filing or, where appropriate, the priority date, of the application claiming the invention.

Prior art supports an inventor's claim that the invention is novel, inventive and useful. It also serves as a means of verifying whether an invention infringes on an existing patent.

¹ Discoveries refer to the act of finding something that is already in existence. However, the process of discovery could be protected if it satisfies certain criteria such as involving an inventive step.

For the purposes of establishing prior art, a disclosure of the invention to the public will not be taken into consideration if it occurred within twelve months preceding the filing date² or, where applicable, the priority date³ of the application, and if it was by reason or in consequence of acts committed by the applicant or the applicant's predecessor in title or of an abuse committed by a third party with regard to the applicant or the applicant's predecessor in title. [Culled from Section 3(4) of the Patent Act 2003 (Act 657)].

- ii. **Usefulness:** The invention must serve a specific purpose or should be capable of being applied by industry.
- iii. **Commercial potential:** This will be assessed to determine whether the invention has the potential to do well when introduced onto the market.
- iv. **Patentable:** The invention must not fall within the category of non-patentable inventions under applicable national law.

4.0 Recommendations on Invention Disclosures

Following an evaluation of an invention, the IPC would recommend any of the following;

- a) Request the inventor to provide additional information or undertake further work on the invention to support the case for protection and/or commercialisation;
- b) Delay publication of the research until the intellectual property is protected;
- c) Recommended for protection through a patent or other appropriate mechanism⁴;
- d) File for protection and assign some or all the rights to the invention.
- e) Proceed with commercialisation or begin the process of commercialising the intellectual property.

Where a decision is made to file for patent protection, ORID would engage the services of a patent attorney in the drafting and filing of the patent application.

Where the University of Ghana has no immediate commercial interest in the invention, it may

- i. Assign ownership of the invention to the inventor(s).
In this case, the IPC in its recommendation will take into consideration, the inventor's expertise, resources, business networks, etc. in making this decision. Under this circumstance, the University will agree on the mode for the sharing of royalties from the commercialisation of the invention to compensate it for the use of its resources in the development of the invention;
- ii. Where the inventor is not interested in the commercial development of the invention, the University will retain ownership of the invention, or assign to third parties.

5.0 Communicating Outcomes of Evaluations

- a. The Committee will prepare a report to the Pro-Vice Chancellor (RID) of its recommendation with respect to an intellectual property. In all cases, the IPC will provide details of the basis for its recommendation.
- b. The Secretary to the Committee will notify the inventor of the Committee's decision on the invention.

6.0 Filing of Patent Protection

Where an invention is recommended for protection, the Office of Research, Innovation and Development will file for patent protection at the national, regional or international level on behalf of the University of Ghana.

² The date on which a patent application is first filed at a Patent Office.

³ The date used to establish the novelty and/or inventive step of an invention relative to prior art. The priority date could be earlier than the actual filing date of an application. If an application claims priority to an earlier parent application, then its priority date may be the same as the parent.

⁴ It is worth noting that not all inventions developed at the University can be patented. Nonetheless, they can be protected with other intellectual property tools such as trade secrets and utility models. An invention qualifies for application of the grant of a utility model certificate if it is new and can be applied by industry. Existing inventions which have been slightly improved, modified or enhanced may be recommended for protection with a utility model.