



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

GUIDELINES FOR INVENTION DISCLOSURE

| Contents | Page |
|-------------------------------------|-------------|
| 1. Introduction | 2 |
| 2. Criteria for Patenting | 2 |
| 3. Non-patentable Inventions | 3 |
| 4. Disclosing an Invention | 3 |
| 5. Responsibilities of the Inventor | 4 |
| 6. Responsibilities of ORID | 4 |

1. Introduction

An invention disclosure serves as an initial official record of an invention. It also affords the basis for establishing patentability and provides the background and technical information needed in drafting a patent application. An inventor is required to disclose an invention created in the course of his/ her employment at the University of Ghana to the Office of Research, Innovation and Development.

2. Conditions for Patenting

An invention must satisfy the following conditions in order to qualify for patenting.

- a) **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.

For the purposes of establishing prior art, a disclosure of the invention to the public shall not be taken into consideration if it occurred within twelve months preceding the filing date¹ or, where applicable, the priority date² 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)]

Please take note that the conditions for establishing prior art differs from one filing jurisdiction to another. For example, if an application is being made at the Africa Regional Intellectual Property Office, then a disclosure will not be taken into consideration if it occurred within six months preceding the filing date. It is highly recommended therefore that inventors desist from making a public disclosure of an invention until the appropriate IP protection has been sought for that invention where applicable.

- b) **Inventive step (non-obvious):** The invention must represent sufficient improvement in relation to existing state of the art. It should not be obvious, (i.e. a person with ordinary skill in the art should not be able to solve the problem at which the invention is targeted by using the same procedure or doing the same thing).
- c) **Useful:** The invention must be capable of being applied or used by industry.
- d) **Patentable:** It must not fall within the category of non-patentable inventions under applicable national law.

¹ The date on which a patent application is first filed at a Patent Office.

² The date used to establish the novelty and/or inventive step of a 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.

3. 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 Patents Act, 2003 (Act 657) are excluded from patent protection even if they satisfy the conditions indicated in 2. above;

- a) Discoveries³, 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 does 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.

4. Disclosing an Invention

- a) An inventor is required to disclose his/her invention by completing the [Invention Disclosure Form](#).
- b) The description of the invention should be accurate, clear and complete such that a person skilled in the art can understand and reproduce the invention given the disclosed information.
- c) The inventor must submit a summary of prior art search conducted together with the Invention Disclosure Form. The search report must capture the reference details of the prior art (*e.g. patent or publication number, name of inventor, title of the invention, etc.*), a cut and pasted abstract, key words used in conducting the search and a brief comment on the relevance of the prior art to one's invention. The inventor must also highlight the way(s) in which the prior art is similar to or different from his/ her invention and how it does not impact on the inventiveness of the invention. Patent documents can be accessed from the under listed or other patent databases.
 - PatentScope: <http://www.wipo.int/patentscope/en/>
 - Google Patent: <http://www.google.com/patents/>
 - Espacenet: <http://worldwide.espacenet.com/>
- d) The Invention Disclosure Form must be signed by the inventor or principal investigator (in the case of multiple inventors).
- e) The Form must be endorsed by the Head of Department, Dean/Director of the School/Institute/Centre and Provost of the College.
- f) The Form and supporting documents must be submitted to the Office of Research, Innovation and Development.
- g) Inventors are required to disclose inventions which do not satisfy condition 2. above, to allow for their protection with other intellectual property tools.

³ 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.

5. Responsibilities of the Inventor

- a) Disclose an invention in detail to ORID.
- b) Avoid a premature disclosure (*release information on the invention through abstracts, publications, poster sessions, oral discussions, etc.*) of the invention in a manner that may compromise its patentability prior to the filing of a patent application.
- c) Where there is the need to disclose research findings in fulfillment of research contracts/ agreements, the researcher may do so under the terms of a Non-Disclosure Agreement or a Confidentiality Agreement. Kindly contact our office for such support.
- d) Maintain accurate and reliable records of all documents necessary for ascertaining the originality or creation of the invention and for the protection of one's intellectual property.
- e) Offer support as may be required, prior to, during and after intellectual property protection and technology transfer process. This support will include but not limited to providing technical input for the drafting of patent application, engaging potential partners and licensees about the invention and signing necessary forms.
- f) Disclose promptly all potential conflicts of interest.

6. Responsibilities of the Office of Research, Innovation and Development

- a) Review the disclosure to verify all the required information and supporting documents have been provided. Following this, the disclosure will be assigned a number.
- b) Meet with the inventor to discuss the invention.
- c) Pre-evaluate the disclosure to determine whether the invention will be accepted for the purposes of protection and/ or commercialisation.
- d) Forward the disclosure to the Intellectual Property Committee (IPC) who will conduct a detailed evaluation of the invention to ascertain novelty, commercial potential and industrial relevance, to inform its recommendation on the invention.
- e) Notify the inventor of the decision made by the Intellectual Property Committee on the invention.
- f) Engage the services of a patent attorney for the drafting and filing of an application, where a decision is made to file for intellectual property protection.
- g) Work with the inventor to provide the necessary support in preparation of documents required to protect the intellectual property.
- h) Develop a plan for the commercialisation of the invention together with the inventor.
- i) Maintain all disclosures confidential.