

PATENT

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Legislation

Ghana

Ghana has had protection for patents since 1934, prior to independence from the United Kingdom. The Patents Act, 2003 (Act 657) (Patents Act) was adopted on December 31, 2003 and replaces the Patent Law (1992 (P.N.D.C.L. 305A) (Patent Law). The Patents Act redefined the scope of protection and what is considered patentable subject matter and was intended to bring Ghana into compliance with the Trade Related Aspects of Intellectual Property (TRIPS). Applicants should be aware that the regulations implementing the Patents Act have only recently been drafted and as of April 2011 had not yet been submitted to Parliament. Until the new regulations are passed by Parliament, the regulations implementing the former Patent Law are still in use, which often results in a disconnect. Applicants are advised to inquire of legal counsel as to the current status of the regulations.

Ghanaian patent law offers protection in two forms: patents and utility model certificates. A patent has a term of 20 years from the date of filing of the application and a utility model certificate has a term of seven (7) years from the date of filing of the application. Protection for both a patent and a utility model certificate may be curtailed for failure to pay annual administrative fees or renouncement.

Violations under the Patents Act are punishable by a fine not exceeding 2000 penalty units (currently, a penalty unit is equal to GHC 12.00; the maximum fine is GHC 24,000.00) or to up to two years imprisonment or to both.

International

Ghana is a member of or has ratified the following international agreements regarding patents:

- [The Convention Establishing the World Intellectual Property Organization \(WIPO\);](#)
- [The Paris Convention for the Protection of Industrial Property \(Paris Convention\);](#)
- [The World Trade Organization \(WTO\) Agreement on Trade-Related Aspects of Intellectual Property rights \(TRIPS\);](#)

- [The Patent Co-operation Treaty, 1970;](#)
- [The African Regional Intellectual Property Organization \(ARIPO\);](#) and
- [The Protocol on Patents and Industrial Designs adopted in 1982 in Harare, Zimbabwe \(Harare Protocol\).](#)

An international or regional application may be filed for a patent or utility model certificate designating Ghana. The Ghana Patent Office (Patent Office) of the Registrar-General's Department (RGD) acts as the receiving office for any international applications.

Coverage – What Does Patent Law Protect?

What Can Be Patented?

Ghanaian law grants patent to inventions, which Ghanaian law defines as an idea of an inventor which permits in practice the solution to a specific problem in the field of technology. The invention may be, or may relate to, a product or process.

An invention is patentable if it is new, involves an inventive step and is industrially applicable. In Ghana, absolute novelty is required. An invention is not considered new if it is anticipated by a prior art, that is, everything disclosed to the public, anywhere in the world, by publication in any form, by use or any other way prior to filing. An exception exists, however, for the disclosure to the public if a that occurred within twelve months preceding the filing date or where applicable the priority date of such application, provided that the disclosure was a consequence of acts committed by the applicant or his predecessor in title or an abuse committed by a third party with regard to the application. An invention involves an inventive step if, having regard to the prior art relevant to the application claiming the invention, it would not have been obvious to a person having ordinary skill in the art. An invention is regarded as industrially applicable if it can be made or used in any kind of industry.

What Is Excluded from Patent Protection?

The following are excluded from patent protection under Ghanaian law:

- Discoveries, scientific theories and mathematical methods;
- Schemes, rules or methods for doing business, performing purely mental acts or playing games;
- Methods or treatment of the human or animal body by surgery or therapy, as well as diagnostic methods practiced on the human or animal body (this does not apply to products used in such methods);
- Inventions, the prevention within the country of the commercial exploitation of which is necessary to protect public order or morality, which includes,
 - The protection of human, animal or plant life or health; or

- The avoidance of serious prejudice to the environment, if the exclusion is not made because the exploitation is prohibited.
- Plants and animals other than micro-organisms;
- Biological processes for the protection of plants and animals other than non-biological and micro-biological processes; and
- Plant varieties.

Rights Conferred by Patent

For patents granted in respect to products, Ghana's law confers the rights of "exploitation" of the patented invention. "Exploitation" means any of the following acts:

- making, importing, offering for sale, selling and using the product; or
- stocking the product for the purposes of offering for sale, selling or using.

For patents granted in respect to a process, Ghana's law confers the rights of:

- using the process;
- making, importing, offering for sale, selling and using the product in respect of a product obtained directly by means of the protected process; or
- stocking the product obtained directly by means of the protected process for the purposes of offering for sale, selling or using the product.

The rights under Ghana's patent law do not extend to:

- acts done in respect of articles which have been put on the market in any country by the owner of the patent or with the patent-owner's consent;
- the use of articles on aircraft, vehicles or vessels of other countries temporarily within Ghana;
- acts done for experimental purposes; or
- prior use or acts performed in good faith by someone other than the applicant who was using the invention or making effective and serious preparations for its use before the filing date of the patent application.

Registration

Ghana currently is experiencing a significant backlog in patent applications due to the lack of trained staff to examine patent applications beyond whether or not the minimum requirements under the law (*i.e.*, is the format correct) have been met. At this time, there are no attorneys/examiners employed by the RGD who have the necessary scientific or technical background to conduct a substantive review. Certain patent applications, filed in

Ghana for Ghana (National Applications) upon being deemed complete by the Patent Office, are sent to WIPO under the WIPO Patent Information Services for Developing Countries – ICSEI Program (International Cooperation for Search and Examination Program), for processing and a determination as to whether or not the subject of the application should be granted a patent. Applications are sent under this program if the applicants who are local inventors are not able to afford the search and substantive examination fee at an external search and examination authority. Other National Applications, however, are sent to ARIPO for processing.

Applicants should be aware that unlike trademarks, which benefit from the presumption of ownership after an application has been filed, a rights-holder may not file a claim for infringement until the patent certificate has been granted. The patent registry is open to the public and anyone may obtain an extract from the register. To date, Ghana has not issued a single patent, including a number of patents approved by both WIPO and ARIPO under international agreements. Nevertheless, rights-holders who enter the Ghanaian market are encouraged to make an application.

Outlined below are the general steps in applying for patent protection in Ghana. Utility model certificate applications follow much the same form, with certain exceptions. Prior to either a grant or denial of a patent or a utility model certificate, a rights-holder/applicant may convert a patent application into an application for a utility model certificate, or application for a utility model certificate into a patent application. Such conversion may only be done once. The steps set out below should be confirmed with the Patent Office upon application. Applicants should be aware that the regulations implementing the Patents Act have only recently been drafted and as of March 2011 had not yet been submitted to Parliament. Until the new regulations are passed by Parliament, the regulations implementing the former Patent Law are still in use, which often results in a disconnect. Applicants may wish to inquire of legal counsel as to the status of the regulations. We recommend that you check the RGD website regularly for updates and current information. <http://rgd.gov.gh/>

Step One: Obtain Qualified Counsel

Where an applicant's ordinary residence or principal place of business is outside of Ghana, the applicant must be represented by local resident practitioners. Moreover, patent law is complicated. As referenced above, an international patent application under the Patent Cooperation Treaty, (a "PCT Application") may be filed by any PCT member states (which include the United States) with Ghana as a designated country. Filing a PCT Application can significantly reduce the complexity of multinational filings and help reduce the risk of loss of novelty and thus patentability as a disclosure in one country may make an invention non-patentable in others. An applicant may also file a regional application with ARIPO, with Ghana as a designated country (Regional Application). National Applications may also be filed, but given the advantages of both the PCT and Regional Applications, National Applications are used much less frequently. Applicants are encouraged to seek firms that have an attorney on staff who has a scientific or technical background in addition to experience with Ghanaian IP law.

Step Two: Prepare and Submit the Application

Patent applications are complicated and will require substantial documentation. Applications are filed with the Patent Office of the RGD and must include:

- A request containing a petition to the effect that a patent be granted, the name of and other prescribed data concerning the applicant, the inventor and the agent, if any, and the title of the invention. Where the applicant is not the inventor, the request must include a statement justifying the applicant's right to the patent.
- A description disclosing the invention in a manner sufficiently clear and complete for the invention to be carried out by a person having an ordinary skill in the art, and shall, in particular, indicate, at least, one mode known to the applicant for carrying out the invention;
- A claim or claims, defining the matter for which protection is sought;
- Any drawings necessary for the understanding of the invention; and
- An abstract for technical information; however, it will not be taken into account for the purpose of interpreting the scope of protection.

The application shall also include the payment of the current application fee. Applications are deemed filed upon receipt of a complete application.

Step Three: Establishing a Priority Claim

An applicant who has filed an application for an invention or utility model in any country that is a member of the Paris Convention or who is a member of the WTO may, within one year of that filing, file subsequent patent applications in other countries claiming the filing date of the first application. Ghana is a first to file regime, not a first to invent, so filing is of paramount importance in protecting patent rights. Where an applicant claims priority from an earlier filing application, the RGD may require a certified copy of the earlier application. The RGD may also request other information such as dates and numbers of foreign applications, communications with foreign patent offices, copies of results of searches or any final decisions on the foreign applications.

Step Four: Preliminary Examination

Upon filing, the RGD determines whether or not the basic requirements of an application have been met. If any information is lacking, the RGD may invite the applicant to file a correction, and accord, as of the filing date, the date of receipt of any correction. If the corrections are not made, the application is treated as if it had never been filed. In the event of missing drawings, however, if the applicant declines to produce any, the RGD accords the filing date as receipt of the application and deletes any reference to the missing

drawings. Once the application is regarded as complete, a filing date is accorded to the application, the application is sent to either WIPO or ARIPO as appropriate and examination of the patent application begins.

Step Five: Examination

In determining eligibility for a patent, the RGD takes into account any international search reports, reports with respect to corresponding foreign applications any final decisions as to non-patentability in other countries. Whenever possible, the RGD should give a final decision on an application not later than two years after commencement of the examination. Due to the lack of qualified patent attorneys in Ghana and in compliance with international agreements, patent applications, upon being deemed complete by the Patent Office, are sent to WIPO or ARIPO, as appropriate, for search and substantive examination.

Step Six: Granting of Patent

When the RGD grants a patent, reference to the grant of the patent will be published and the applicant will be issued a certificate of the grant of patent and a copy of the patent. The patent will be recorded with the RGD and copies of the patent are available to the public upon payment of a prescribed fee. If the RGD denies the patent, an applicant may appeal to the High Court of Ghana.

Enforcement Approaches

Criminal Enforcement

The Commercial Crime Unit (CCU) of the Criminal Investigation Department (CID) of the Ghana Police Service

For infringing goods that are suspected of having been produced in Ghana or have been imported into Ghana, rights-holders may approach the Commercial Crime Unit (CCU) of the Criminal Investigation Department (CID) of the Ghana Police Service.

The majority of the CCU's investigations into IP violations originate from tips from either rights-holders or from informants. Under Ghanaian law, there is a reward for information that leads to the discovery of infringing goods and conviction of the infringer; certain enterprising individuals make their living as professional informants. Upon receiving a tip about infringing goods, the CCU will investigate and upon confirmation that the goods are infringing, is empowered to seize the infringing goods and to arrest any persons in possession of infringing goods. The CCU may allow rights-holders to participate in raids.

The Preventive Unit of CID has a rapid response unit (RRU) that has the capacity to prevent the often quick dissemination of pirated goods. The RRU is used when it is known to a high degree of certainty the location and means by which a shipment of pirated or otherwise

illicit products are entering the country. A court order is usually required before the RRU will investigate possible IPR violations.

Criminal Prosecution

The Criminal Code 1960 (Code) defines a list of types of fraud, including intellectual property fraud. While most often IP fraud is prosecuted under the relevant IP law, upon occasion a charge may be brought under the Code for fraud or fraudulent representation, if the authorities deem it more relevant. If charges are brought under the Code rather than under IPR laws, a rights-holder may elect to pursue damages under the Unfair Competition Act. Anyone found guilty of infringement under the Patent Act may be sentenced to a maximum of two years imprisonment.

Criminal prosecution can better deter violators from repeating their crimes. Many individuals may commit intellectual property crimes not only because they can be relatively easy to commit, but also because the perpetrators believe that they will not be prosecuted. Criminal prosecution plays an important role in establishing public expectations of right and wrong, and in educating the public about intellectual property rights. If you believe that you are a victim of intellectual property theft, we recommend that you document all investigative steps, preserve evidence and contact the relevant authorities right away. Intellectual property crimes may be reported to the relevant offices (*e.g.*, the RGD) and to either Customs, Chief Collector, Preventative OPS – Headquarters (for import and export of counterfeits) at +233 (0)302 686106/684363 or +233 (0)244 364 642 or via email at pr@ghanacustoms.gov.gh or the CCU at +233 (0)302 76 17 34.

You may also submit a tip through the Ghana Police Service website at <http://www.ghanapolice.info/>

Administrative Enforcement

The Customs Division of the Ghana Revenue Authority

Another agency that rights-holders may approach for assistance in combating patent infringement is the Customs Division of the Ghana Revenue Authority (formerly known as the Customs, Excise and Preventive Service (CEPS)) (Customs).

Businesses exporting patent-reliant products that carry a high risk of being counterfeited are encouraged to work directly with Customs. The Preventive Department within Customs is chiefly responsible for blocking infringing goods and otherwise illicit material from entering the country. Businesses that export high risk products should supply the Preventive Department with a detailed description and sample of their product.

Infringing goods are known to enter Ghana from its ports and multiple borders. Customs recommends that if a rights-holder believes that counterfeits of its products are entering the country from multiple entry points that the rights-holder hold an informational workshop. Customs officers from around the country attend workshops in which producers and rights-holders describe and supply prototype authentic and counterfeit goods. The more detailed

the information and training provided by the rights-holder, the more likely Customs officers are to stop infringing goods at the ports and borders.

If a Customs agent believes that a shipment of products contains infringing goods, the agent can stop the shipment at the border. When infringing goods have entered the country and are being warehoused, distributed or retailed, Customs officers are authorized to enter a warehouse, factory or store and take an account of the excisable goods in the custody or possession of the seller. Customs officers are further authorized to take samples of goods suspected of being infringing, to the extent that the usual price of goods is paid. When the Commissioner of the Customs Division of the Ghana Revenue Authority (Commissioner) is satisfied by information and samples that there is reasonable cause to suspect that infringing goods are harbored, kept, or concealed in any premises, the Commissioner may issue a written order authorizing an officer to enter and search the premises, and to seize and take away any of the infringing goods. In addition to seizure of any infringing goods, Customs officers may also arrest any person in whose possession and under whose control the infringing goods are found.

The law provides for a reward for any person whose "tip-off" leads to the confiscation of counterfeit goods and the arrest of anyone dealing in counterfeits. Customs regularly benefits from tip-offs, from private citizens in addition to receiving information from rights-holders and discovery of infringing goods by members of the Customs units itself.

Rights-holders with the requisite level of evidence may submit a written request of detention to Customs independent of any Customs investigation or action. The request must provide evidence that demonstrates a high likelihood that infringement is occurring and that injunctive action is necessary to avoid further damage; such request may or may not require a court order.

In discussions, Customs indicated that a bond is normally only required in situations where the goods themselves are "gray market", that is, authentic, but sold outside an authorized sales territory or by an unauthorized dealer in an authorized sales territory. Under these circumstances, the goods are impounded and a bond paid until the parties have reached an agreement on the goods or a court has determined the outcome of the dispute.

Upon occasion, Customs will allow rights-holders more direct participation beyond informing the Preventive Department that infringement is occurring. In order for a rights-holder to participate more directly in Customs anti-counterfeiting investigations and procedures, Customs requires the producer to demonstrate in writing reasonable grounds for suspecting that counterfeits of its products are entering or being sold within the country.

It is recommended that rights-holders pay a courtesy call to Customs officials upon entering the Ghanaian market, provide Customs with copies of originals and hints on how to spot pirated goods and to establish a relationship with Customs on an ongoing basis, providing information, intelligence and training and support. Face-to-face interaction with enforcement officials may be a more effective means of communication than phone or email.

The Ghana Standards Board (GSB)

The Ghana Standards Board (GSB) is operated under the Standards Authority Act, 1973 and the subsequent Labeling Rules Amendment of 1992 within the Ministry of Trade and Industry. The GSB develops and promulgates the standards by which all manufactured and imported products must comply. The GSB is further charged with ensuring that all products that enter the country comply with its standards. The GSB Destination Inspection Department (DID) and the GSB's Market Surveillance Group monitor and enforce the Board's mandate of protection of the Ghanaian population. The GSB actively collaborates with Customs, the Food and Drug Board and other regulatory bodies in its inspection, testing and monitoring activities.

All shipments of goods arriving at Ghana entry points are checked by the DID and contracted inspection companies. The DID randomly samples shipments for quality testing; upon passing these initial tests products are forwarded to Customs for further inspection and clearance. Certain products that are classified as high risk goods (HRGs) must be duly registered with the GSB prior to importing into Ghana. For a list of HRGs, go to <http://www.gsb.gov.gh/site/home>. Additionally, the GSB regularly deploys the GSB Market Surveillance Group to inspect products being sold to the public and ensure that they are in compliance with the requisite standards. The GSB will inspect and sample non-health related goods at the entry points, and if those goods are found to be counterfeit at the inspection and sampling stage, the GSB has authorization to seize them. The GSB Market Surveillance Group, however, typically reserves investigation and seizure actions for goods that are health-related. For non-health related goods such as layout-design protected goods, Customs may offer more effective market protection.

The GSB encourages rights-holder participation in investigative actions. Prior to taking part in an investigation, rights-holders must first demonstrate that they are legally vested in a right that is being infringed, which may or may not require a court order. Rights-holders must demonstrate that they are legally vested in the trademark appearing on the allegedly passed off or infringing goods and that it is reasonably likely the product will be held in violation of the applicable IP law.

If a rights-holder has specific knowledge of a shipment of counterfeits and their targeted entry point the stakeholder should contact both the DID and Customs. The GSB does not have a rapid response unit, but DID agents cover every legal entry point. They have the power to seize and detain any individuals involved until the police service is able to respond. By contacting both the GSB and Customs, stakeholders are able to use either office as a check on the other and ensure a wider range of coverage.

The GSB may prohibit the sale and distribution of goods that have not been certified by the GSB as well as those products that do not meet the standards set by the GSB. The GSB is obligated to cooperate with any international or domestic organization that is acting in furtherance of the functions of the GSB so long as those organizations are seeking the GSB's cooperation.

Under the Ghana Standards Board General Labeling Rules 1992 Amendment to the 1973 Standards Authority Act, the GSB, in consultation with the Minister of Trade and Industry, has appointed inspectors to participate in the activities of the GSB Market Surveillance Group. Inspectors' enforcement and investigative actions must be authorized by the Executive Director of the GSB. Upon authorization, an inspector may at all reasonable times enter any premises or place where the inspector has cause to believe that counterfeits are being offered for sale, distributed, or disposed of. The inspector may examine the products to ascertain whether they conform to the provisions of the 1992 Amendment's rules and regulations. Inspectors may seize any products which are determined to be counterfeit or products that have been labeled in such a way as to be deceptive, misleading, or false. In practice, the GSB Surveillance Group relies on stakeholders to alert them to infringement, the first step in initiating an investigation.

Civil Enforcement

Invalidation

Under the Patents Act, an interested person may apply with the High Court of Ghana for invalidation of a patent. The High Court shall invalidate the patent if the person requesting invalidation proves that the patent holder has not complied with any of the provisions of the Patents act with respect to applications, that the subject matter of the patent is not patentable or if the owner of the patent is not the inventor or the inventor's successor in title.

If cancellation is only applicable to a portion of a patent, only the corresponding part of the registration is cancelled. Invalidated patents are null and void from the date of the grant of the patent. Cancellations are published by the RGD, after notification from the High Court.

Civil Litigation

At the request of the rights-holder or its licensee (under certain conditions), the High Court may grant an injunction to prevent infringement or imminent infringement, award damages and grant any other relief provided for in the general law. There are three types of High courts in Ghana: the standard High Courts, the "fast track" High Courts and the commercial High Courts. While each offers its own advantages, judges on the commercial courts tend to be more IP-savvy, many having completed IP training. Under the rules of civil procedure, the High Court may grant an award of damages to a rights-holder if it is determined that infringement has occurred. Burden of proof for an award of damages is on the rights-holder, and the amount of damages is determined by the High Court.

Legal proceedings may only be initiated after an application for registration of the patent has been filed with the RGD. For the purpose of proceedings in respect of the rights of the patent owner, if the subject matter of a patent is a process for obtaining a product, the High Court may order the defendant to prove that the process used to obtain an identical product is different from the patented process. Any identical product when produced without the consent of a patent owner is assumed to have been obtained by the patented process absent any proof to the contrary. The chief advantage of pursuing IPR claims in civil

litigation is that unlike administrative or criminal proceedings, they may be initiated directly by the rights-holder. Rights-holders are advised to engage local counsel experienced in IPR issues in the event of any litigation.

Other Measures

NGOs and Professional Organizations

Several non-governmental organizations in Ghana play important roles in helping enforce IPR, including participating in public information campaigns, reporting suspected infringements and training government personnel. Rights-holders are encouraged to seek out such NGOs for information and support. These organizations include:

- Business Coalition Against Counterfeiting and Illicit Trade (CACIT)
<http://bcacit.com/home/index.php>
- Ghana Employers' Association (GEA)
<http://www.ghanaemployers.com/>
- Institute of Packaging Ghana
<http://www.iopg.org.gh/>
- The Association of Ghanaian Industries
<http://www.agighana.org/>
- The Consumers' Association of Ghana
Tel: +233 (0) 302 784461; +233 (0)302 238042

Rights-holders may find it useful to work with one or more of these organizations in protecting their IPR.

Public Information Campaigns

In general, public awareness in Ghana is the cornerstone of a successful IPR protection plan. Upon detection of counterfeits entering the Ghanaian market, rights-holders have informed the public of the illegal nature of counterfeits and the shortcomings associated with them with varying degrees of success. In the past, public relations campaigns have resulted in the return of a portion of the counterfeits that have infiltrated legitimate retail businesses. Rights-holders may also contact relevant agencies and offer training in differentiating authentic versus infringing products to those individuals charged with search and seizure.

FAQ

1. What types of patents are available under Ghanaian law?

There are two types of protection under Ghanaian law: (1) a patent for an invention with duration of 20 years; and (2) a utility model certificate, which has a duration of 7 years.

2. Is it possible to apply for a patent and a utility model certificate for the same subject at the same time?

No. Prior to either a grant or denial of a patent or a utility model certificate, a rights-holder/applicant may convert a patent application into an application for a utility model certificate, or application for a utility model certificate into a patent application. Such conversion may only be done once.

3. If I want to register a patent in Ghana, where do I go?

Registration is made with the Patent Office of the Registrar-General's Department (RGD). You may contact them outside of Ghana at +233 (0)302 664-691-93 or visit their website at <http://rgd.gov.gh/>.

4. How long will it take for a rights-holder to be granted a patent in Ghana?

The Patents Act requires that "where possible" the time from application to grant should be no more than two years from commencement of the substantive examination. Due to the lack of staff at the RGD with a scientific or technical background, substantive examination takes place outside of Ghana, which lengthens the process considerably. To date, Ghana has not issued a single patent, including a number of patents approved by both WIPO and ARIPO under international agreements.

5. Who can request the invalidation of a Ghanaian patent?

Any interested person may request invalidation on the grounds that the current patent holder has not complied with the terms of the patent law or that the current patent holder is not the actual inventor or the inventor's successor in title.

6. What are the penalties for patent infringement in Ghana?

Violations under the Patents Act are punishable by a fine not exceeding 2000 penalty units (currently, a penalty unit is equal to GHC 12.00; the maximum fine is GHC 24,000.00) or to up to two years imprisonment or to both.

We strongly emphasize that the information provided in this Toolkit does not constitute legal advice and should not be a substitute for advice of legal counsel. Its intended purpose is to provide an overview of Ghana's IPR environment, available enforcement mechanisms and Ghanaian government offices sharing jurisdiction over IPR protection and enforcement. We recommend that U.S. companies seeking to do business in Ghana or facing IPR infringement issues in Ghana seek qualified U.S. and/or Ghanaian legal counsel in pursuing their rights through Ghana's IPR enforcement regime. The U.S. Government, the U.S. Department of State, the U.S. Department of Commerce, their employees and contractors assume no legal liability for the accuracy or completeness or usefulness of any information, resource or process contained disclosed herein.

