ANNEX I

Amendments to the Harare Protocol on Patents and Industrial Designs

Proposal to Amend the Preamble as shown below in red and italics:

Intellectual Property Organization (ARIPO) then known as the Industrial Property Organization for English-Speaking Africa, concluded in Lusaka (Zambia) on December 9, 1976, and in particular to its Article III (c), in accordance with which the objectives of the Organization include the establishment of such common services or organs as may be necessary or desirable for the co-ordination, harmonization and development of the intellectual property activities affecting its members, Having regard to Article 19 of the Paris Convention for the Protection of Industrial Property signed in Paris on March 18, 1883 and revised on July 14, 1967 and a Regional Treaty within the meaning of Article 45, Paragraph 1 of the Patent Cooperation Treaty of June, 1970",

Desiring to strengthen co-operation between the States in respect of protection of patents, utility models and industrial designs,

Desiring that such protection may be obtained in those States by a single procedure for the grant of patents, registration of utility models and industrial designs and by the establishment of certain standard rules governing patents so granted and utility models and industrial designs so registered,

Explanatory Notes to the Amendment of the Preamble

It is proposed that the preamble of the Harare Protocol be amended to include the Paris Convention and Patent Cooperation Treaty Articles as indicated in red above.

2. PROPOSAL TO INCLUDE NEW SECTIONS 1(2) AND 1(3)

Amendment: Section 1 was amended to include paragraphs (2) and (3):

- (2) Patents granted or utility models and industrial designs registered by virtue of this Protocol shall respectively be called ARIPO patents, ARIPO utility models and ARIPO industrial designs.
- (3) The ARIPO patent, utility model or industrial design shall in each of the contracting states for which it is granted or registered, have the effect of, and be the subject to the same conditions as a national patent granted, utility model and industrial design registered by that state.

Explanatory Notes to the Amendment of Section 1

New paragraphs 2 and 3 clearly defines the ARIPO patents, industrial designs and utility models and their effect in relation to the Member States.

3. New Section 1bis Territorial Effect

It is proposed to amend Section 1 and introduce a new Section *1bis* with the subtitle Territorial Effect as follows:

Amendment: The grant of an ARIPO patent or the registration of an ARIPO utility model or industrial design maybe requested for one or more of the contracting states.

Explanatory Notes to New Section 1bis

Section 1*bis* clearly indicates that an ARIPO patent, industrial design or utility model can have effect in any or all of the contracting states.

4. New Section 2(3): Joint applicants designating Different Countries

New Section 2(3): An ARIPO patent, utility model or industrial design Application may also be filed either by joint applicants or by two or more applicants designating different contracting states.

Explanatory Notes to New Section 2(3)

New Section 2(3) clearly facilitates applications by joint applicants designating different contracting states.

5. New Section 2(7): Language of Applications

New Section 2(7): Applications for an ARIPO patent, utility model or industrial design can be lodged in any language which must be translated into English within **two (2) months** from the date of filing in accordance with Rule 5(2).

Explanatory Notes to New Section 2(7)

New Section 2(7) clearly supports Rule 5(2) in confirming the fact that application can be lodged in any language but must be translated to English within 2 months.

6. New Section 2(8): Right of Priority

New Section 2(8(i)): Any person who has duly filed, in or for:

- (a) Any state party, to the Paris Convention for the protection of industrial property or be
- (b) Any member of World Trade Organization,

an application for a patent, utility model or industrial design or his successor in title shall enjoy for the purposes of filing for an ARIPO patent, utility model or industrial design application, in respect of the same invention a right of priority during a period of 12 months (patents and utility model) and 6 months (industrial designs), from the date of filing of the first application.

7. New Section 2(8(ii)): Right of Priority

- (a)Every filing that is equivalent to a regular national filing under the national law of the state where it was due, under bilateral or multilateral agreement including this Protocol shall be recognized as giving rise to a right of priority.
- (b) An applicant desiring to take advantage of the priority of the previous application shall file declaration or priority and any other document required in accordance with the implementing regulations.
- (c) Multiple priorities may be claimed in respect of an ARIPO patent, utility model or industrial design, notwithstanding that they originated in different countries. Where appropriate multiple priories maybe claimed for one claim. Where multiple priorities are claimed, time limits which run from the date of priority shall run from the earliest date of priority.

Explanatory Notes to New Section 2(8)

New Section 2(8) clearly defines the right of priority of each patent, industrial design or utility model.

8. New Section 3(1A to 1D)

New Section 3(1A to 1 D): Invention Disclosure

An *ARIPO* patent application shall relate to one invention only or to a group of inventions so linked so as form a single general inventive concept.

- (1B) An ARIPO patent application must disclose the invention in a manner sufficiently clear and complete for it to be carried out by a person skilled in the art.
- (1C) The claims shall define the matter for which protection is sought. They shall be clear and concise and be supported by the description.
- (1D) The abstract shall merely serve for use as technical information; in particular not for the purpose of interpreting the scope of the protection sought.

Explanatory Notes to New Section 3(1A to 1D)

New Section 3(1A to 1D) will clearly define that any ARIPO patent application will relate to one invention which will be clearly disclosed such that any person skilled in the art could reproduce the invention.

9. Proposal to Amend Section 3(2A)

Amendment: Section 3(2A): Physical Requirements

The Office shall examine whether the formal and physical requirements for the applications as laid down in the Regulations and Administrative Instructions have been complied with and shall accord the appropriate filing date to the application.

Explanatory Notes to Section 3(2A)

There is need to link the physical requirements as defined in the Administrative Instructions as indicated in the new re-drafted Section 3, 2(A).

10. New Section 3(6A)

New Section 3(6A): Member States Right to Accept or refuse the application

If the office decides to grant the patent, it shall notify the applicant and each designated State. Where the examination was based on a search report or examination report, a copy of the same shall be attached to the said notification. The designated State shall have six (6) month within which to respond to the notification.

Explanatory Notes to New Section 3(6A)

New Section 3(6A) clearly provides Member States the opportunity to either accept or refuse a patent granted or due for grant by the ARIPO Office. The old Section 3(6) will be re-numbered to 3(6B).

11. Amendment to Amend Section 3(7)

Amendment: **Section 3(7):** Novelty of Inventions

Re-numbered Section 3(7) should be amended to refer to sub-section 3(6) and not 3(5).

12. New Section **3(11A)**

New Section 3(11A):

An invention shall be considered to be new if it is not anticipated by the prior art.

Explanatory Notes to New Section 3(11A)

New Section 3(11A) clearly defines the novelty of an invention and the old Section 3(11) will be re-numbered Section 3(11G).

13. New Section **3**(**11B**)

New Section 3(11B): Defines Prior Art Documents

Everything made available to the public anywhere in the world by means of written disclosure (including drawings and other illustrations), oral disclosure or by use or exhibition, shall be considered prior art provided that such making available occurred before the date of filing of the application or, if priority is claimed, before the priority date validly claimed in respect thereof and further provided that a disclosure of the invention at an official or officially recognized exhibition shall not be taken into consideration if it occurred not more than six (6) months before the date of filing of the application or, if priority is claimed, before the priority date validly claimed in respect thereof".

Explanatory Notes to New Section 3(11B)

Section 3(11B) clearly defines prior art documents.

14. New Section **3**(11C)

New Section 3(11C): International Exhibitions

An official or officially recognized exhibition is an exhibition recognized by a State or falling within the terms of the Convention on international exhibitions signed at Paris on 22 November 1928 and last revised on 30 November 1972.

Explanatory Notes to New Section 3(11C)

Section 3(11C) clearly define exhibition in relation to the Convention on International Exhibitions.

15. New Section **3(11D)**

New Section 3(11D):Inventive Step

An invention shall be considered as involving an inventive step if, having regard to the prior art, it is not obvious to a person skilled in the art.

Explanatory Notes to New Section 3(11D)

New Section 3(11D) defines inventive concept of an invention.

16. New Section **3(11E)**

New Section 3(11E): Industrial Applicability

An invention shall be considered as susceptible of industrial applicability, if it can be made or utilized in any kind of industry including agriculture.

Explanatory Notes to New Section 3(11E)

New Section 3(11E) clearly defines industrial applicability of an invention lodged at ARIPO.

17. New Section 3(11F): Amendments

New Section 3(11F): An applicant for an ARIPO patent application Shall be allowed at least one opportunity of amending the description, claims and drawings of his own volition. An ARIPO patent application or ARIPO patent may not be amended in such a way that it contains subject-matter which extends beyond the content of application as filed

Explanatory Notes to New Section 3(11F)

New Section 3(11F) clearly defines the possibilities for the amendment of an application.

18. New Section 3(13A): Licensing of IP Rights in respect on designates states

New Section 3(13A): An ARIPO patent application may be licensed in whole or in part for the whole or part of the territories of the designated Contracting States.

Explanatory Notes to New Section 3(13A)

Section 3(13A) provides for part or whole licensing in respect of the designated states.

19. New Section 3(13B): Assignments

New Section 3(13B): An assignment of an ARIPO patent application shall be made in writing and shall require the signature of the parties to the contract.

Explanatory Notes to New Section 3(13B)

New Section 3(13B) defines the assignment of an ARIPO patent.

20. New Section 3(14A): Ownership

New Section 3(14A): Right to an ARIPO patent shall belong to the inventor or his successor in title if the inventor is an employee, the right to any ARIPO patent shall be determined in accordance with the law of the state in which the employee is mainly employed; if the state in which the employee is mainly employed cannot be determined, the law to be applied shall be that of the state in which the employer has a place of business to which the employee is attached.

21. New Section 3(14B): Ownership

New Section 3(14B): If two or more persons have made the same invention independent of each other, the right to an ARIPO patent therefore shall belong to a person whose patent application has earliest date of filing, provided that this first application has been published.

22. New Section 3(14C): Ownership

New Section 3(14C): An ARIPO patent shall confer on its proprietor from the date on which the mention of its grant is published in the ARIPO Journal, in each contracting state in respect of which it is granted, the same rights as would be conferred by a national patent granted in that state".

23. New Section 3(14D): Terms of protection

New Section 3(14D): An ARIPO patent application shall on the date of its publication provisionally confer upon the applicant the protection provided for in **Section 3(14C)** in the contracting states designated in the application.

24. New Section 3(14E): Infringement

New Section 3(14E): Any infringement of any ARIPO patent shall be dealt with by the national law.

Explanatory Notes to New Section 3(14A to E)

New Sections 14A to 14E clearly define the ownership of the patent rights of an ARIPO patent and clearly indicates that in case of infringement, the national law takes precedence.

25. New Section 3(15A): Divisional Applications

New Section 3(15A): An ARIPO divisional application shall be filed Directly with the ARIPO Office in accordance with the implementing regulations 28 (1). It may be filed only in respect of a subject matter which does not extend beyond the scope of an earlier application as filed; In so far as this requirement is complied with, the divisional application shall be filed on the date of filing of the earlier application and shall enjoy the same right of priority.

26. New Section **3(15B)**

New Section 3(15B): All contracting states designating the earlier application at the time of filing of an ARIPO divisional application shall be deemed to be designated in the divisional application.

Explanatory Notes to New Section 3(15A to 15B)

New Sections 3(15A to 15B) clearly defines the procedures for filing divisional applications with the Office.

27. New Section 3(16): Meaning of Claims

New Section 3(16): The extent of the protection conferred by an ARIPO patent or ARIPO application shall be determined by the terms of the claims. Nevertheless, the description and drawings shall be used to interpret the claims.

Explanatory Notes to New Section 3(16)

New Section 3(16) clearly defines the terms and interpretation of the claims, description and drawings in an ARIPO application.

28. New Section 3(17): Time Limits

- New Section 3(17): The Administrative Instructions under the Regulations for Implementing the Protocol on patents, utility models and industrial designs within the framework of the African Regional Intellectual Property Organization (ARIPO) shall specify the following:
 - (i) The time limits which are to be observed in proceedings before the ARIPO Office and are not fixed by this Protocol;
 - (ii) The manner of computation of time limits and the conditions under which time limits may be extended;
 - (iii) The minima and maxima for the time limits to be determined by the ARIPO Office.

Explanatory Notes to New Section 3(17) to 3(17)(iii))

New Section 3(17) to 3(17)(iii)) clearly specifies the time limits laid down under the Administrative Instructions and Regulations for implementing the Harare Protocol.

29. New Section 3(18): Revocation or Invalidation

New Section 3(18): An ARIPO patent application and the resulting patent shall be deemed not to have had, as from the outset, the effects specified in (14B) and (14C) to the extent that the patent has been revoked in opposition proceedings:

Explanatory Notes to New Section 3(18)

New Section 3(18) clearly defines procedures for revocation or invalidation of an ARIPO patent.

30. New Section 5bis

New Section 4bis: It is proposed that new Section 4bis be introduced in order to link the Harare Protocol to The Hague Agreement to facilitate the filing of international industrial designs.

New Section 5bis

Section 5bis

International Industrial Design Applications under The Hague Agreement
(1) In this Section:

- "The Hague Agreement" is constituted by 3 international Treaties namely:
- The agreement done at The London Act of June 2, 1934,
- The Hague Agreement on November 28, 1960 and
- The Geneva Act of July 2, 1999.

"International application" means an industrial design under The Hague Agreement.

- (2) An international application in which a Contracting State which is also bound by The Hague Agreement is designated for the purposes of obtaining an industrial design under the provisions of this Protocol shall be considered to be an application for the registration of an industrial design under this Protocol. The provisions of The Hague shall apply to such international application in addition to the provisions of this Protocol and the Regulations under this Protocol; in case of conflict, the provisions of The Hague Agreement shall apply.
- (3) The ARIPO Office may act as receiving Office under The Hague Agreement in relation to an international application filed by an applicant who is a resident or national of a Contracting State which is also bound by The Hague Agreement.
- (4) The ARIPO Office shall act as designated Office under The Hague Agreement in relation to an international application referred to in subsection (2).

Explanatory Notes to New Rule 5bis

In order to make the Harare Protocol more attractive to users it is proposed that the Protocol is linked to the Hague System for the international registration of industrial designs administered by the World Intellectual Property Organization. Therefore, it is proposed that ARIPO joins and ratifies the Hague System for the international registration of industrial designs as soon as possible.

31. Proposed New Section 5(2(iii))

Section 5(2(iii))

Proposal: New Section 5(2(iii)): The Rules relating to Fees shall determine in particular the amount of the fees and the ways in which they are to be paid.

Explanatory Notes to New Section 5(2(iii))

Rule 5(2(iii)) clearly defines the amount of fees and ways of payment as specified under the Regulations.

32. Amendment to Rule 5(3): Electronic Filing

Amendment to Rule 5(3): The request shall be made on a printed form copies of which shall be obtainable from the ARIPO Office, *ARIPO website or from any other electronic media* and from the industrial property offices of Contracting States.

33. New Rule 5bis Electronic Filing of Patents, Industrial Designs and Utility Model Applications

- 1. "Patents industrial designs utility model applications may be filed and processed in electronic form or by electronic means in accordance with the Administrative Instructions provided that the ARIPO Office or any Member States' office shall permit the filing of applications on paper.
- 2. These regulations shall apply mutatis mutandis to all applications filed in electronic form or by electronic means subject to any special provisions of the Administrative Instructions.

- 3. The Administrative Instructions shall set out the provisions and requirements in the filing and processing of applications filed, in whole or in part in electronic form or by electronic means including but not limited to, provisions and requirements in relation to acknowledgement of receipt, procedures relating to the according of a filing date, physical requirements and the consequences of non-compliance with those requirements, signature of documents, means of authentication of documents and of the identity of parties communicating with offices and applicants.
- 4. No Member State shall be obliged to receive or process ARIPO patent applications filed in electronic form or by electronic means unless if the member state has notified the ARIPO Office that it is prepared to do so in compliance with the applicable provisions of the Administrative Instructions.
- 5. No Member State which has given the ARIPO Office a notification under paragraph (d) may refuse the process in an application filed in electronic form or by electronic means which complies with the applicable requirements under the Administrative Instructions.
- 6. Rule 5bis shall apply mutatis mutandis to other correspondence documents relating to all ARIPO applications.

34. Amendment of Rule 18bis (2): Examination of Utility Models

Old Rule 18bis (2) states that: Novelty and inventive step within the Contracting States of the Protocol shall be applied with respect to utility models.

Amendment: It is proposed that the wording 'inventive step' in Rule 18 *bis* (2) be replaced by industrial applicability to be in conformity with Section 3ter (2).

Proposed Amended Rule 18*bis* (2): Novelty and industrial applicability within the Contracting States of the Protocol shall be applied with respect to utility models.

Explanatory Notes to Amendment of Rule 18*bis*(2)

For utility models inventive step is not taken into consideration and only novelty with reference to local documentation is taken into consideration.

35.

Deletion of Rule 21(3)

Proposal to Delete Rule 21(3): The ARIPO Office shall, at least one month prior to the date on which an annual maintenance fee shall fall due, issue a reminder to the applicant or the owner of the patent.

Deletion of Rule 21 (3) is intended to remove the obligation of the Office to remind applicant or the owner of the patent to renew the patent or patent application at least one month prior to the date in which an annual maintenance fee shall fall due. This is to follow suit with other similar offices where applicants have to monitor the renewal dates of their respective patents or patent applications.

36. Amendment of Rule 22(1)

Amendment Rule 22(1): Communications between the ARIPO Office and the industrial property offices of contracting states on matters relating to the Protocol and regulations shall be effected direct by registered mail *or any other safe electronic means of communication*.

Explanatory Notes to Amendment of Rule 22(1)

There is need to include electronic communication between the Office and designated states.

[End of Annex I]

ANNEX II

Amendments to the Banjul Protocol

1. Section 1

General

1:1 The African Regional Intellectual Property Organization (ARIPO) is hereby entrusted with the registration of marks and the administration (*proposal to replace the wording 'administration' with 'management'*) of such registered marks on behalf of the Contracting States in accordance with the provisions of this Protocol.

Explanatory Notes to the Amendment of Section 1:1

Users feel that ARIPO does "management" rather than "administration" of rights. The word "management" should be used.

2. <u>Section 2:4</u>

FILING OF APPLICATIONS

2:4 Where an application is filed with the Industrial Property Office of a Contracting State, such office shall, within one month of receiving the application, transmit the application to the Office.

Amendment: Where an application is filed with the Industrial Property Office of a Contracting State, such office shall, within one month of receiving the application, transmit the application to the Office. Failure to do so, the application shall be accorded the date it is received at the ARIPO Office as the filing date.

Explanatory Notes to the Amendment of Section 2:4

This is aimed at solving the issue of allocation of a filing date where application is transmitted after one month from the date of receiving it.

3. **SECTION 3:2**

3:2 the application shall indicate the goods and/or services in respect of which protection of a mark is claimed, including the corresponding class or classes provided for under the Nice Agreement Concerning the International Classification of Goods and Services for the Purposes of the Registration of Marks of June 15, 1957 as revised. For this purpose the ARIPO Office will check that the applicant has made such indication of class or classes and that indication is correct and where the applicant does not give such indication or the indication is not correct, the ARIPO Office shall classify the goods or services under the appropriate class or classes of the *latest edition* of the Nice Classification on payment of a classification fee.

Explanatory Notes to the Amendment of Section 3:2

After noting that states recognise different editions of the Nice Classification, it was proposed that it be clearly stated that all ARIPO mark applications recognise the *latest edition of the Nice Classification* and that states be encouraged to recognise such.

Secondly it is proposed that the *fees schedule* include a fee for such classification by ARIPO.

3:3 Where colour, smell or sound is claimed to be a distinctive feature of the mark, the applicant shall make a statement to that effect as well as the name or names of the colour or colours claimed and an indication, in respect of each colour, of the principal parts of the mark which are in that colour.

Amendment: It is proposed that this should be extended to include smell And sound marks.

Explanatory Notes to the Amendment of Section 3:2

There is need to adhere to international standards and extend the distinctive features of a mark to include smell and sound.

4. SECTION 3bis

FILING DATE

The Office shall accord as the filing date of an application the date on which the following indications or elements were received by the Contracting State in which the application was filed or received by the Office:

- (i) an express or implied indication that registration of a mark is sought;
- (ii) an indication allowing the identity of the applicant to be established;
- (iii) indications sufficient to contact the applicant or his representative, if any, by mail;
- (iv) a clear reproduction of the mark;
- (v) a list of goods and/or services for which the registration is sought;

provided that the Office may accord as the filing date of the application the date on which it received only <u>some</u> of the indications or elements referred to.

<u>Amendment</u>: to remove the word **some** and clearly specify the minimum elements needed to accord a filing date as elements indicated in (i) and (ii).

Explanatory Notes to the Amendment of Section 3bis

The change will clearly specify the minimum elements needed to accord a filing date.

5. <u>SECTION 6:2</u>

SUBSTANTIVE EXAMINATION BY A DESIGNATED STATE

6:2 Before the expiration of twelve nine months-from the date of the Notification referred to in Section 5:3, each designated state may make a written communication to the Office that, if a mark is

registered by the Office, that registration shall have no effect on its territory on the basis of any grounds, both absolute and relative, including the existence of third party rights.

Amendment: to reduce the substantive examination period from 12 Months to 9 months.

Explanatory Notes to the Amendment of Section 6:2

It is proposed that the time limit of 12 months be reduced to 9 months due to the fact that users are complaining because of the delay in response to the Member States. This period will be further reduced to 6 months after the digitization of data in the Member States.

6. <u>SECTION 7</u>

DURATION AND RENEWAL OF REGISTRATION

7:1 The registration of a mark shall be for a period of 10 years from The *filing date*. *Priority date*.

Amendment: The date be changed from filing date to 'Priority date'.

Explanatory Notes to the Amendment of Section 7:1

In most jurisdictions and international standards, the registration period for a mark is from the priority date and not the filing date. Therefore, there is need to change Section 7:1 to reflect the correct date as the date where 10 years is calculated from.

7. Rule 10: Fees Including Individual fees

Fees

Rule 10.2: Rule 10.2 was changed to include regional fees and the concept of 'individual fees' for each designated state be introduced in line with the Madrid System.

New Rule 10.3: "Any Contracting State may declare that, in connection with each application filed under the Banjul Protocol, and in connection with the renewal of any such registration, it wants to receive, instead of a share in the fee charged by the ARIPO Office, a fee (hereinafter referred to as "the individual fee") whose amount shall be indicated in a declaration, and can be changed in further declarations".

New Rule 10.3.1: "A Contracting State that makes or has made a declaration under Rule 10.3 of the Protocol shall notify the Director General of the individual fee to be charged".

New Rule 10.3.2:" The individual fee received by the Contracting State may not be higher than the equivalent of the amount which the said Contracting State's Office would be entitled to in a national application".

- 1. In May 2014, the ARIPO Office wrote a letter to all Member States party to the Banjul Protocol requesting them to advise the ARIPO Office by completing a Declaration Form in accordance with New Rule 10.3 of the Banjul Protocol indicating the fee structure suitable to their respective offices and provide their current fee structures.
- 2. In July 2014, the ARIPO Secretariat wrote a letter to all Member States of ARIPO who are not party to the Banjul Protocol advising them of the amendments to the Protocol whereby the individual fee structures of their respective national offices will be the fees to be charged if they accede to the Protocol, making the Banjul Protocol financially more attractive. It is envisaged that all Member States of ARIPO will accede the Banjul Protocol in the near future.

Explanatory Notes to the Amendment of Section 10:2

Only 9 out of 18 Member States of ARIPO are party to the Banjul Protocol due to the fact that Member States depend on the revenue generated from trademarks. Therefore, in order to make the Banjul Protocol more attractive to Member States, it is advisable to adopt the above-mentioned proposal.

[End of Annex II]

ANNEX III



AFRICAN REGIONAL INTELLECTUAL PROPERTY ORGANIZATION (ARIPO)

Banjul Protocol Declaration of Individual Fee Structure by Contracting States Individual Fee under Rule 10.3: The Republic/Kingdom of 1. The Government of the Republic/Kingdom of has made the declaration referred to in new Rule 10.3 of the Banjul Protocol whereby it wants to receive an individual fee when the Republic/Kingdom of is designated in a regional application or in respect of the renewal of a regional registration designating the Republic/Kingdom of (Instead of the 50% share of fees between the ARIPO Office and the designated states as per Rule 10.2). In accordance with Rule 10.3(1) of the Regulations for implementing the 2. Banjul Protocol, the Director General of the African Regional Intellectual Property Organization (ARIPO) has, after consultation with the Office of the Republic/Kingdom of established the following amounts in United States dollars of the said individual fee: **ITEMS** Amount (in US\$) Application or for one class of goods or services Subsequent Designation for each additional class

3.	The declaration concerning the individual fee made by the
	Republic/Kingdom ofwill enter into force on:

for each additional class

for one class of goods or services

Official Stamp and Date

Renewal