

# Frequent Procedural Mistakes in the Prosecution of Patents and Industrial Designs

Regional Workshop on Human Resources  
Development of patent/Trademark Agents in ARIPO  
Member States and Observer States

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# Outline

- Frequent Procedural Mistakes From Filing up to Grant or registration;
- Actions to be undertaken to Avoid such mistakes;
- The need to create an on-line forum to discuss issues with all stake holders including patent offices, agents and the public at large
- Feed back from Agents on
  - Shortcomings of ARIPO Services and
  - How to improve the ARIPO Services to make the attractive to Users and member States;



# Mistakes when Completing Application Form 3

- Inaccuracy of Bibliographic data can lead to unnecessary Amendments & Corrections which is time consuming & expensive;
  - Forms must have correct bibliographic data;
- All applicants and inventors must be correctly indicated
  - , the Deed of assignment from all inventors to the applicant.
- It is not be possible to remove an inventor without his/her consent!
- The Paragraph VII of Form3 relating to exhibitions is normally not indicated even if the inventor had exhibited his/her invention;
- The Priority Data must be accurate as this can lead to the rejection of priority;
- The number of pages indicated most times are not correct;



## Mistakes when Completing Application Form 3

- Agents should advise small inventors first to undertake **a novelty Search** before applying for Patents;
- Encourage local inventors to initially lodge utility models which can be converted into patent applications if necessary;
- Few Patent applications from small inventor normally meet the patentability criteria!



# Possible Mistakes when Lodging a patent Application

- An Application for a Patent Shall Contain the following (Rule 5(1):
  - A Request;
  - Description;
  - One or More Claims;
  - One or More drawings (Where Applicable);
  - An Abstract and
  - A designation of a country
- To get a filing date only the first three are needed (Rule 14) -Form 12
- The rest of the documents including fees can be lodged in 8 week (Extendable)



# Power of Attorney

- To complete Formality requirements, all applicants (if more than one) must sign the appointment of the agent;
- To solicit business, some applications receive more than one power of attorney!
- Some Applicants prefer to provide one general power of attorney to all their applications;
- Some Attorneys try to lodge renewal fees for applications which are not theirs and this sometimes causes problems in the accounts department;
- Agents should lodge Renewal Fees only after confirmation from Applicant;
- Some Agents try to take over cases which are not theirs!



# Formal Requirements

- After all Formal Requirements have been met, Form 13 is issued;
- Applicants or Agents must always provide the ARIPO reference number which is normally the application number-
  - Record keeping by agents is essential;
  - Applicants sometimes forget to request for extensions of time limits-
  - This is be costly in terms of time & surcharges;
  - After ICT upgrade, applications will automatically lapse;
  - Agents are urged to monitor their applications;
- After Form 13, The application is queued for substantive Search and Examination;



# Substantive Examination Procedures

- To avoid delays and extra costs, Agents should lodge corresponding Search and Examination reports of applications;
  - Before the office requests for them;
  - A Fee of USD500 is charged for applications without corresponding report;
  - On request, small local applicants can be excused;
  - This will quicken the examination process
- Prosecution of an application from application to grant takes 2 to 3 years;
- We are trying to reduce this to 1.5 to 2 years;
- Reminders for the Office to Examine are always welcome;
- On request accelerated examination can be undertaken.





# Refusal of an application after Examination

- Refusal is issued on Form 18;
- Initial refusal does not mean complete refusal;
- Applicant/Agent must study the cited documents and make a formal reply;
- If the application was granted by some other Office e.g. USPTO, it does not mean that ARIPO will automatically also grant the patent;
- Time limits in response to Form 18 are often ignored and can lead to extension of time costs!
- The Application can be converted into either a utility model or a bundle of national patent applications



# Decision to Grant

- Decision to Grant is on Form 21;
- This is transmitted to the Agent who is expected to figure out what the comments by the examiner could mean to the Patent Granted;
- Please remember that member states can still refuse the application;
- The fees for grant & publication must be paid within 3 months and not six months from the date of Examination;
- For Publication purposes, Physical requirements must be met-clean copies are most times needed.



# Surcharges on Renewal Fees

- Application maturing through the PCT don't have to lodge late payment surcharges if lodged in time
  - 90% of all applications come through the PCT;
- Late lodging of Renewal fees leads to payment of surcharges;
  - Agents must monitor the progress of their applications to avoid missing time limits



# Industrial Designs

- Design Application must contain a reproduction of the design;
- The ARIPO Office Examines Industrial Designs only to Formality Requirements;
- Member States are responsible for the Examination of Designs as to Substance;
- If Designated states remain silent, the Office prepares the Registration of the Design.



# Board of Appeal

- Applicants can lodge an appeal against any decision of the ARIPO Office with the Board of Appeal;
- The Decision of the Board is normally final;
- Most times Agents ignore this facility!



# Comments on operations of the ARIPO System

- In order to Improve our services the Office invites comments and Recommendations from users;
- These recommendations are later discussed by working groups on the amendment of the two protocols;
- Agents are our customers and communication should be increased;
- The Automation Project will be initiated in February next year and it envisaged that most communication will be undertaken on line;
- Even the Journal will be available online free of charge;
- Agents will be able to monitor their respective applications online;
- Agents will be able to lodge applications and pay fees online;
- All agents are invited to participate in the AC which will be held in Victoria falls from November 17 to 21, 2014 as observers.



# Discussion & Feed back from users

- To Improve the processing of ARIPO Applications, Please indicate the most frustrating Actions by the Office;
- And make possible recommendations;
- This can be a continuous process;
- All recommendations must be address to the Director General





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