



ARIPO

*African Regional Intellectual
Property Organization*

Overview of the ARIPO Patent System and Procedures



Fostering Creativity and Innovation for Economic Growth and Development in Africa

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- Filing
- Formality Examination
- Substantive Examination
- Grant and Registration



An Introduction to ARIPO



Fostering Creativity and Innovation for Economic Growth and Development in Africa



HISTORICAL BACKGROUND

- Established under the Lusaka Agreement that was adopted by Diplomatic Conference held in Lusaka, Zambia on Dec. 9, 1976.
- Upon creation, the organization was known as the Industrial Property Organization for English–Speaking Africa (ESARIPO)



HISTORICAL BACKGROUND

- Upon creation of the Organization, the WIPO and the UNECA played the role in establishing an Interim Secretariat for the Organization.
- Then Interim Secretariat was replaced by a permanent Secretariat which was established in Sheria House, in Nairobi, Kenya
- In 1982, the organization relocated from Nairobi, Kenya to Harare, Zimbabwe



HISTORICAL BACKGROUND

- In December, 1985, the membership was opened up to all African countries that are members to the UNECA or OAU
- The name change from ESARIPO to ARIPO
- Acquisition of the mandate on Copyright and Related Rights in 2002
- The name change again from ARIPO to ARIPO



WHY ARIPO WAS ESTABLISHED

- To promote the harmonization and development of the IP laws;
- To establish common services and organs may be necessary for coordination, development and harmonization of IP;
- To develop of IP systems for the economic benefit of its member states;
- To establish IP training schemes; organizing conferences, seminars and meetings on IP;
- To promote exchange of ideas and research on IP;
- Etc..



MEMBER STATES

- Botswana
- Gambia
- Ghana
- Kenya
- Liberia
- Lesotho
- Malawi
- Mozambique
- Namibia
- Rwanda
- Sao Tome & Principe
- Sierra Leone
- Somalia
- Sudan
- Swaziland
- Tanzania
- Uganda
- Zambia
- Zimbabwe

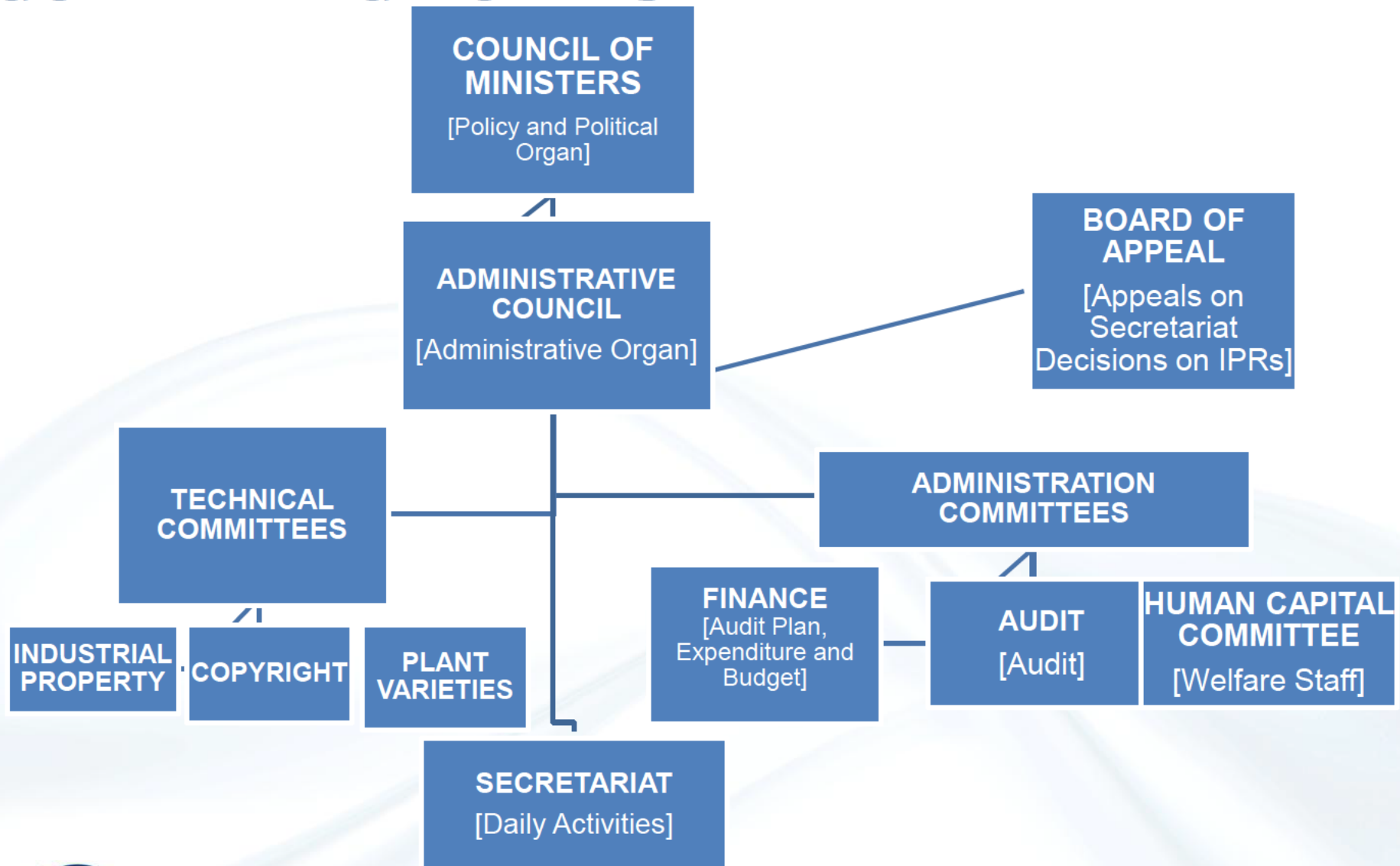


□ The current ARIPO has 19 Member States

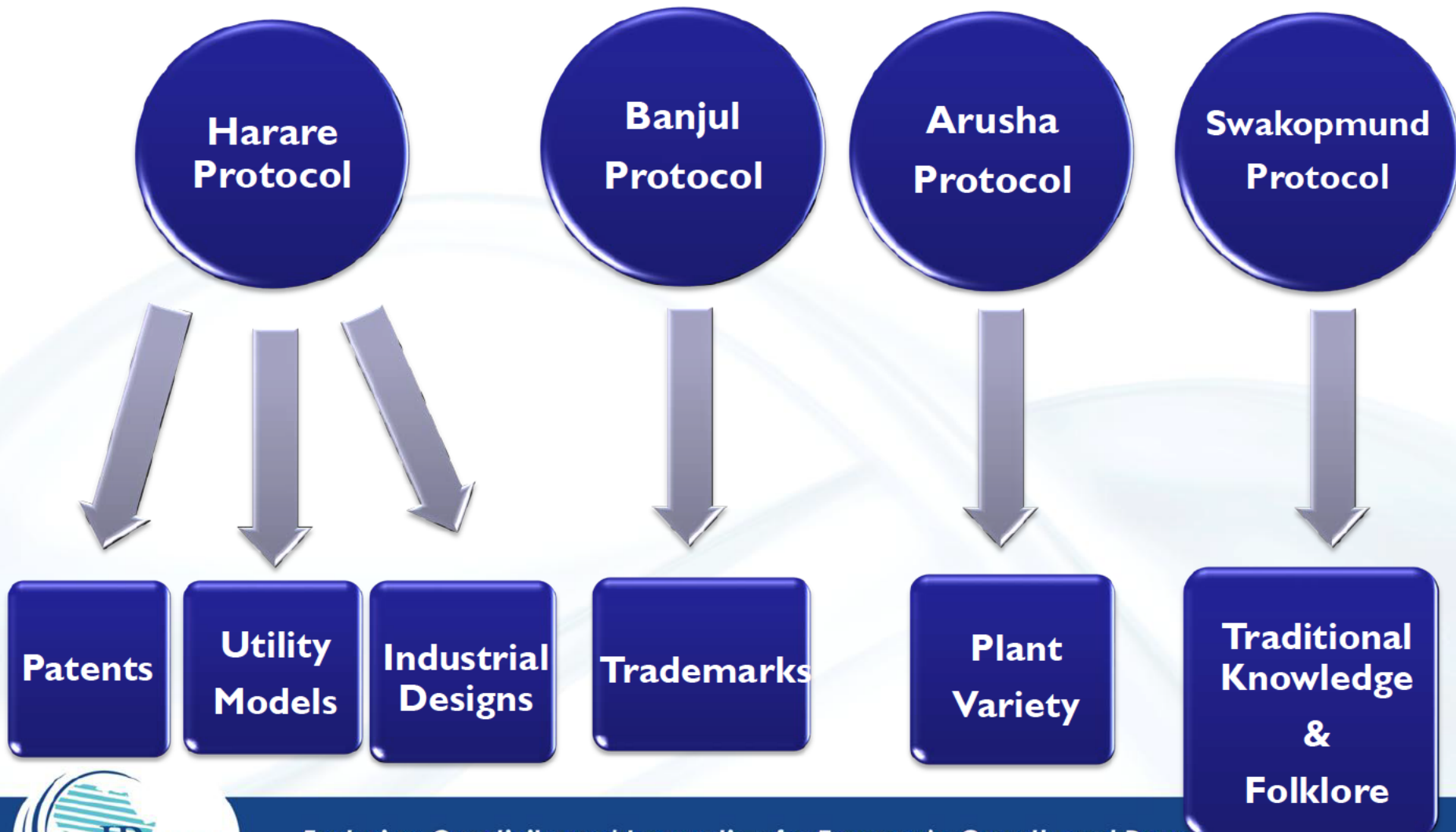


Fostering Creativity and Innovation for Economic Growth and Development in Africa

GOVERNING BODIES



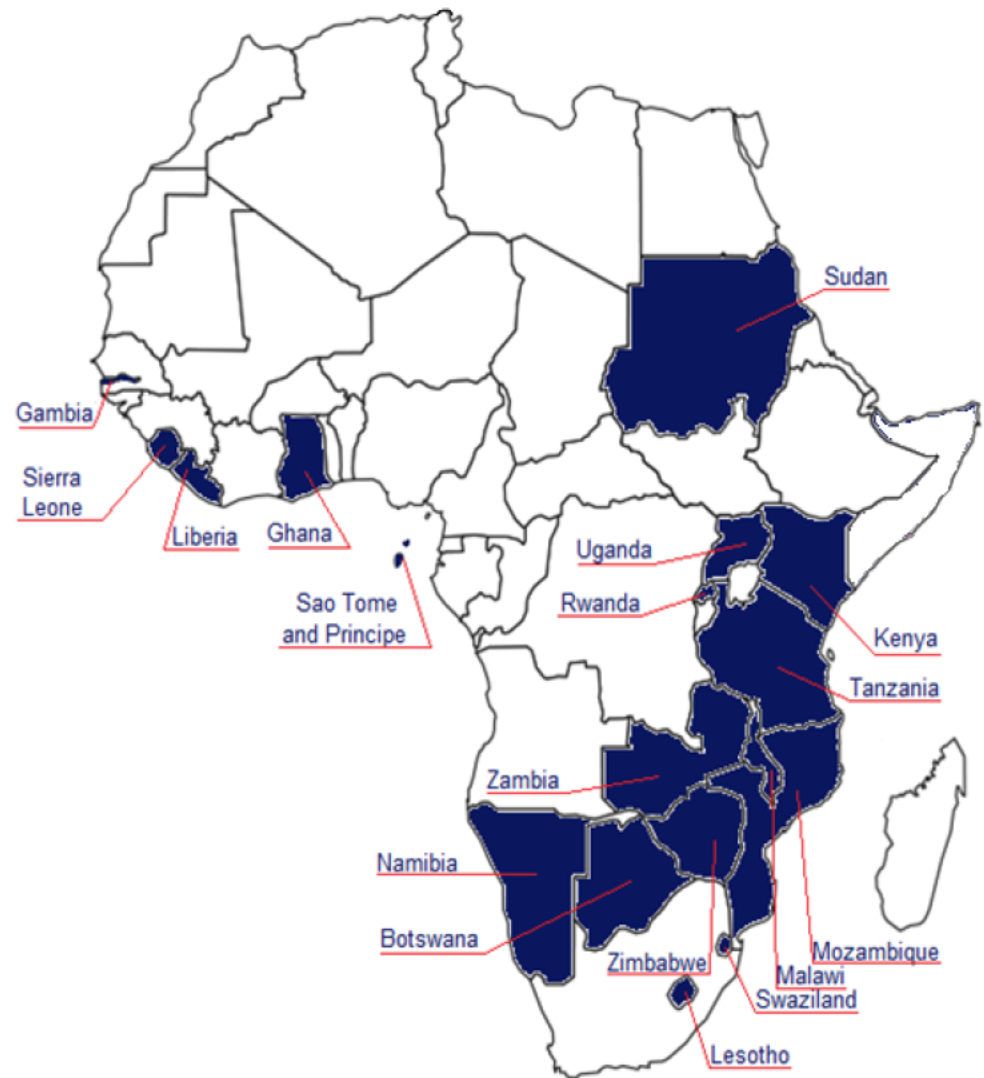
ARIPO PROTOCOLS



ARIPO's Protocols

The Harare Protocol:

- Empowers ARIPO to grant patent and register utility Model and industrial design and on behalf of the contracting states
- Adopted in 1982 in Harare, Zimbabwe.
- Entered into force in 1984.
- 18 States party to the Protocol
- Duration of rights:
 - *Patents - 20 years*
 - *Industrial Designs – 10 years*
 - *Utility Models – 10 years*



The Harare Protocol (HP)

◆ *Sec. 1(1)*

The Harare Protocol **empowered ARIPO** to grant patents and to register utility models and industrial designs and to administer such patents, utility models and industrial designs **on behalf of Contracting States** in accordance with the **provisions of the Harare Protocol**.

◆ *Sec. 2(3)*

The ARIPO patents or utility models or industrial designs **shall in each of the Contracting State** for which it is granted or register, **have the effect of, and subjected to the same condition as a National** patent granted or utility models or industrial designs **registered by that State**.



The Harare Protocol

- Duration of rights:
 - *Patents - 20 years*
 - *Industrial Designs – 10 years*
 - *Utility Models – 10 years*
- Membership: All member states of ARIPO (except Somalia) are party to the Harare Protocol (*BW, GM, GH, KE, LS, LR, MW, MZ, NA, RW, ST, SL, SD, SZ, UG, TZ, ZM and ZW*)



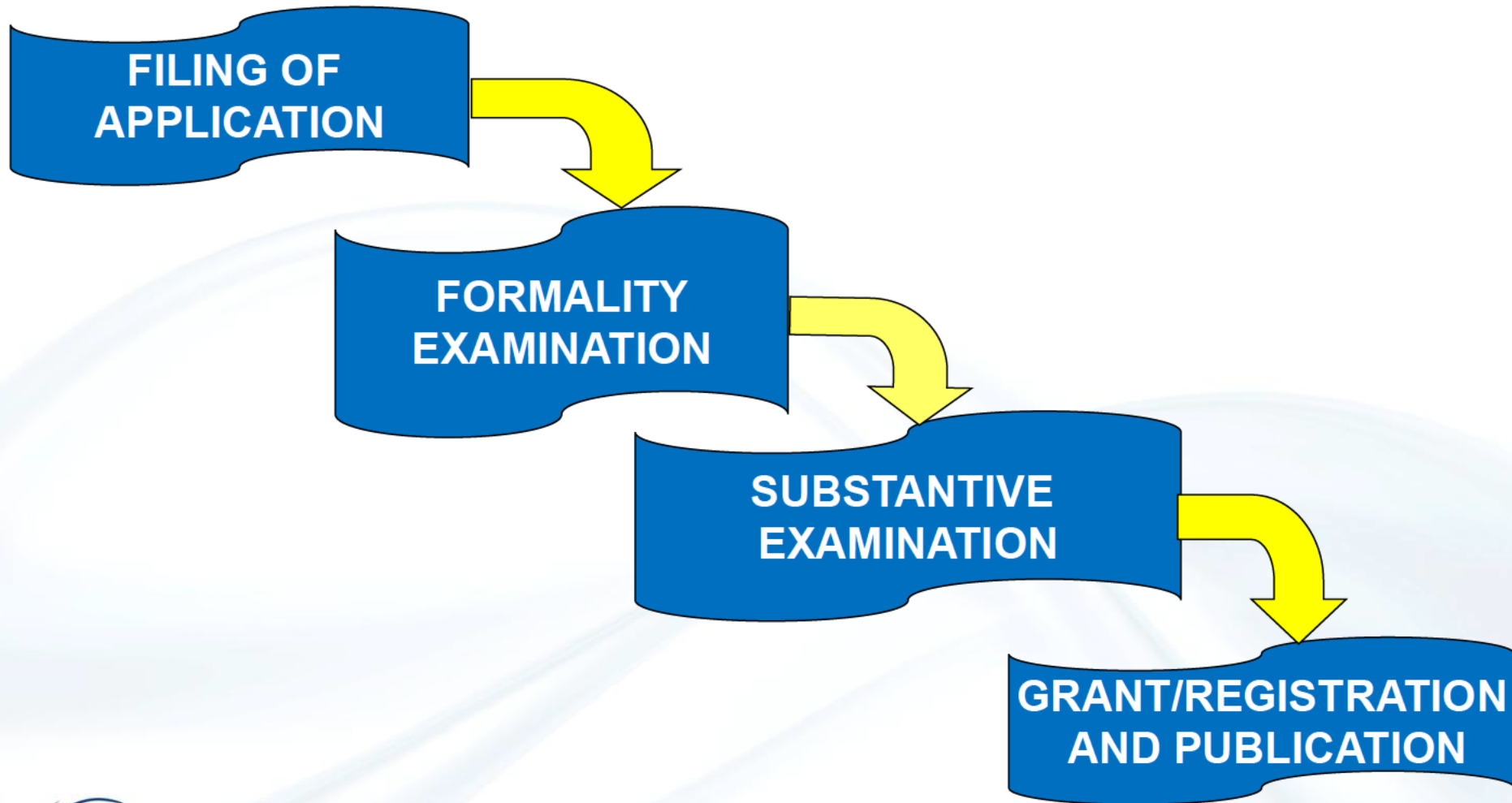
Processing of Patent Application

➤ Main parties involved:

1. Applicant/Representative;
2. The ARIPO Secretariat; and
3. The National IP Office (Filing or Designation)



Processing of Patent Application under the Harare Protocol



Filing Application *(Sec. 2(1))*

Who can Apply:

➤ Applicant

- Individuals from Contracting States
- Private or Public Entities

➤ Authorized Representative

Where to File:

- National IP Office (Receiving offices)
- Direct to ARIPO

Mode of Filing:

- Post, e-mail, fax, courier, depositing at ARIPO,
online filing



Content of Application - *Patents and Utility Model* *Sec. 3(1); 3ter(3)*

Patents and Utility Model application shall:

- ✓ **Request** identify the applicant (Form 3+)
- ✓ **Disclosure** contain:
 - a description of the invention
 - Claim(s)
 - Drawing(s)/ sequence listing - when necessary
 - an abstract
- ✓ designate the contracting State (s)
- ✓ be subject to the payment of prescribe feed



Minimum Requirements for Filing Date Allocation

Patents/Utility Models (*Rule 14/Rule 9*)

- 1) a request Form (Form 3)
- 2) a description
- 3) one or more claims

Industrial Designs (*Rule 14 & Rule 10*)

- 1) a request Form (Form 28)
 - 2) a reproduction of the industrial designs
 - 3) a designation of at least one state
- If the application meets these requirements – a notification of filing date (**Form 12 or 33**) issued to the Applicant and each designated state
 - If not -Applicant is invited (**Form 11 or 32**) to comply within 2 months



Formality Examination - *S.3(2)(a); S.3ter(4)(a); S.4(2)(a);Rule 15)*

Formality Requirements - *(S.3(1); S. 3ter(3); S. 4(1); R.5-8, R.10, R11)*

- ✓ a request Form (Form 3)
- ✓ a description
- ✓ one or more claims
- ✓ one or more drawing or sequence listing - *when necessary*
- ✓ Abstract
- ✓ a designation of at least one state
- ✓ English translation (if application was filled in language other than English)
- ✓ payment of application and designation fees or an undertaking to pay the fees within 21 days
- ✓ Physical requirements must be acceptable



Formality Examination - (S.3(2)(a);

S.3ter(4)(a); S.4(2)(a);Rule 15)

Formality Requirements *cont...*

(S.3(1); S.3ter(3); S.4(1);R.5-8, R.10, R11)

- ✓ Priority document (if priority claimed)
 - ✓ Power of attorney (Form 4) - if applicant is not resident
 - ✓ Deed of assignment of invention- a document assigning invention to applicant (only if applicants is not the same as inventor - *not needed for PCT in regional phase*)
- If the application meets these requirements – a notification of filing date (**Form 13 or 34**) issued to the Applicant and each designated state
- If not -Applicant is invited (**Form 14 or 35**) to comply within **2 months**



Substantive Examination

- Substantive examination undertaken after application has met formality requirements
- Patent, utility model(UM) and industrial design (ID) have different patentability/registration requirements
- For the application filed from 1 January 2017, the applicant is required to **request for substantive examination** for patent application by submitting **Form 13A**.



Substantive Examination – *Patent & Utility Model*

➤ **Sec.3(3) - Patent/S.3ter(5)-Utility Model**

- Provided that the Office shall, **on request**, undertake, or arrange for, the substantive examination of the patent application

➤ **R.18(2)-Patent/R.18ter-Utility Model**

- Provides that a search and examination report shall be established and shall contain the conclusions of the examination



Substantive Examination – *Patent & Utility Model*

Matters to be considered - *Patent*

- **Non patentable subject matters (Sec.3(10)h-j)**
 - e.g. discoveries, scientific theories mathematic methods, method of treatment, plant or animal variety etc.
- **Clear and Complete Disclosure (Sec. 2bis(1)(b))**
 - An ARIPO patent application shall disclose the invention in a manner sufficiently clear and complete for it to be carried out by person skilled in the art
- **Clarity and Full Support (Sec. 2bis(2))**
 - The claims shall define the matter for which the protection is sought. They shall be clear and concise and shall be supported by the description.



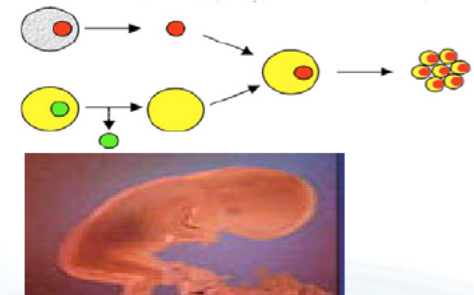
Substantive Examination – *Patent & Utility Model*

Not Patentable Subject Matters - *Patent*

- Inventions whose commercial exploitation would be contrary to ordre public or morality.

e.g.

- Cloning of human beings
- Manipulation of germline
- Use of embryos



- Plant or animal varieties or essential biological process for the production of plant or animals.
- Surgical or therapeutic treatment of or diagnostic methods practised on humans or animals

Substantive Examination – *Patent & Utility Model*

Unity of invention – *Patent* - (Sec. 2bis(1)(a))

- An ARIPO patent application shall relate to **one invention only or to a group of invention** so link that they form a single general inventive concept
- With respect to a **group of inventions** claimed in an ARIPO application, unity of invention exists only when there is a technical relationship among the claimed inventions involving one or more of the same or corresponding **special technical features**.
- The expression "**special technical features**" shall mean those technical features which **makes a contribution over the prior art and is present in each claimed invention**.



Substantive Examination

Patentability Criteria (Sec. 3(10))

Inventions for which patents are granted by Office shall be:-

- ✓ **New** (Novel) - Does not form part of prior art
- ✓ **Involve an inventive step**: Having regard to the prior art, it is not obvious to a person of ordinary skill in the art
 - Problem Solution Approach
 - Obviousness
- ✓ **Industrially applicable**: Can be industrial produced



Substantive Examination – Patent & Utility Model

□ Patentability Criteria-Patent - S.3(10)

- Inventions for which patents are granted by Office shall be:-
 - ✓ **New** (Novel) - Does not form part of prior art
 - ✓ **Involve an inventive step**: Having regard to the prior art, it is not obvious to a person of ordinary skill in the art
 - ✓ **Industrially applicable**: Can be industrial produced

□ Criteria for Registration-Utility Model - S.3ter(2)

- **Utility Model shall be protect if it is:-**
 - ✓ **New** (Novel) - Does not form part of prior art within the jurisdiction of contracting States
 - ✓ **Industrially applicable**: Can be industrial produced



Novelty

➤ The invention, as defined by a claim, lacks novelty if **every feature or step** in the claim is

- *explicitly, or*
- *implicitly*

disclosed within the **relevant prior art**, including any features inherent to a *person skilled in the art*.

➤ A single prior art defeats novelty if it contains all limitations of claimed invention.

Inventive Step - *Patent*

- Assessing Inventive Step follows on after novelty
- The claims which are deemed to be novel are assessed for inventive step
- Objection for lack of Inventive Step occurs where the feature(s) of claim(s) are novel but would naturally suggested themselves (obvious) to person skilled in the art (PSA), in light of common general knowledge.
- Inventive Step objection can be based on
 - A single source of information, or
 - Combination of two (or more) documents (mosaic)

Substantive Examination

Results of Substantive Examination – *Patent & Utility Model*

- Form 18 (notification of non-compliance with substantive requirements and invitation to submit observations and or amended application) issued and sent to the **applicant**
- Form 21 (notification of decision to grant patent/register utility model) issued and sent to the **applicant and** each **designated State(s)**
- Form 18 & Form 21 are both accompanied by search and substantive examination reports



Grant/Registration and Publication

➤ Patent/Utility Model

- Form 21 (notification of decision to grant patent/register utility model) issued and sent to the applicant and each designated State(s)
- After expiry of the **six (6) months** and subject to the payment of the grant/registration and publication fees the Office grant the patent/register utility model and publishes patent or utility model
- Form 25 issued



New Provisions- Harare Protocol

Sec.5bis - Re-establishment of right

- An applicant of an ARIPO patent who, in spite of all due care, was unable to observe a time limit, shall have his rights re-established upon request.
- The request must be filed within 1 year from the date of expiration of time limit.
- The request shall not be deemed to have been filed until the limitation fee has been paid.

Sec. 5ter - Post grant amendment

- The request must be filed with the ARIPO Office in writing.
- The request shall not be deemed to have been filed until the limitation fee has been paid.
- Any amendment to the claims must fall within the scope of the claims before the amendment.





African Regional Intellectual Property Organization

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