



Regional Seminar on the Patent Cooperation Treaty (PCT) for Selected African Countries

ARIPO as a Designated/Elected Office Under the PCT

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Gaborone, Botswana
September 10-12, 2019



Fostering Creativity and Innovation for Economic Growth and Development in Africa

PCT Regional Phase in ARIPO

Statutory Basis: The Harare Protocol

- **Adopted in 1982 (entered into force in 1984)**
- **The Harare Protocol empowers ARIPO to grant patents... on behalf of the contracting States**
- **Since July 1, 1994, the Harare Protocol has been linked to the Patent Cooperation Treaty (PCT)**
- **All 18 ARIPO member States party to the Harare Protocol are members of PCT.**



Statutory Basis: The Harare Protocol

- An international application in which a Contracting State which is also bound by the PCT is designated for the purposes of obtaining a patent under the provisions of this Protocol shall be considered to be an application for the grant of a patent under this Protocol... **[Section 3bis(2)]**
- The ARIPO Office act as designated Office under Article 2(xiii) of the Patent Cooperation Treaty in relation to an international application referred to in Sub-section (2) of this section”. **[Section 3bis(4)]**
- The ARIPO Office act as elected Office under Article 2(xiv) of the Patent Cooperation Treaty in relation to an international application referred to in Sub-section (2) where a Contracting State is elected for the purposes of international preliminary examination under Article 31(4) of the Patent Cooperation Treaty. **[Section 3bis(5)]**



Statutory Basis: The Harare Protocol

- **ARIPO patent applications include:**
 - **5% ARIPO first filings, and**
 - **95% PCT applications entering the ARIPO regional phase**

- **Entry into regional phase within 31 months from the priority date**



Content of Application – *Sec. 3(1); R.5*

Patents application shall contains:

- ✓ **a request Form (Form 3)**
- ✓ **a description of the invention**
- ✓ **one or more claim(s)**
- ✓ **drawing(s)/ sequence listing - when necessary**
- ✓ **an abstract**
- ✓ **a designate the contracting State(s)**
- ✓ **be subject to the payment of prescribe feed**



Formality Requirements – *Rule 23(2) HP*

- For an international application, the applicant shall, within the time limit applicable:
 - Pay the following fees, as prescribed in the Schedule of Fees, to the ARIPO Office:
 - ✓ the application and designation fees or an undertaking to pay the fees within 21 days of entry into the regional phase
 - ✓ the annual maintenance fees which is due on the eve of each anniversary of the international filing date



Formality Requirements – *Rule 23(2) HP*

- Furnish an English translation – if the international application was published in a language other than English
 - Power of attorney (Form 4) - if applicant is not resident
 - Deed of assignment of invention - if applicants is not the same as inventor
 - Physical requirements must be acceptable (i.e. discription, claims, drawing)
- If the application meets these requirements – a notification of compliance with formality requirement **(Form 13)** is issued to the Applicant and each designated State.
- If not -Applicant is invited **(Form 14)** to comply within **2 months**



Substantive Examination – *Sec. 3(3); R.18*

- Carried out to determine whether the invention meets patentability requirements
- Substantive examination is not automatic - Carried out upon request - *Form 13A*
- Request should be filed up to 3 years from the date of filing
- In addition to request for examination, possible to request for expedited / accelerated examination



Substantive Examination – (Sec 3(3); R.18)

▪ Rule 23(2)&(4) HP

- For the purpose of Section 3(3) and Rule 18 (2) of the Harare Protocol,
 - an international search report established for an international application for which the ARIPO Office acts as designated Office, and
 - an international preliminary examination report established for an international application for which the ARIPO Office acts as elected Officeshall be taken into consideration.



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



Outcome of Substantive Examination

- If the patentability requirements met, the Office issue a notification of compliance and decision to grant patent – **Form 21**
 - Form 21 is accompanied by examination search and reports
- Notification issued and sent to:
 - the **applicant; and each designated State(s)**
- Applicant invited to pay grant and publication fees within 3 months
- Designated States has **6 months** to respond



Grant and Publication

- **After expiry of the 6 months** and subject to the payment of the grant and publication fees the Office grant and publishes the patent.
- **Certificate of grant and copy of patent issued to Applicant**
- **Reference to grant published in the ARIPO Journal**
- **Patent recorded in the Patents Register**
- **Copy of certificate and granted patent transmitted to each designated State**



Renewal Fees – *Sec.3(11); R.21*

- Annuity fees required to be paid in respect of ARIPO patent application / patent
- Annuities payable to ARIPO
- Fees fall due on the eve of each anniversary of the date of filing and are payable in USD
- Fees may still be validly paid up to 6 months after due date, provided that a surcharge of the belated renewal fee is paid within the same period
- Failure to pay annuities and any additional fee due in time, application deemed to be withdrawn / abandoned; patent deemed to lapse



Re-establishment/Restoration of Rights - *Sec. 5bis; R.24*

- **Loss of rights due to applicant or proprietor of an application / patent being unable to observe a time limit**
- **Rights could be re-established upon written request subject to meeting certain requirements**





African Regional Intellectual Property Organization

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