



## African Regional Patent Systems and the PCT: Brief Overview of the ARIPO Patent System

### WIPO REGIONAL FORUM ON THE ROLE OF PATENTS AND THE PATENT COOPERATION TREATY (PCT) IN RESEARCH IN DEVELOPING COUNTRIES

NAIROBI, KENYA,

MARCH 30 TO APRIL 1, 2009

By ARIPO Secretariat



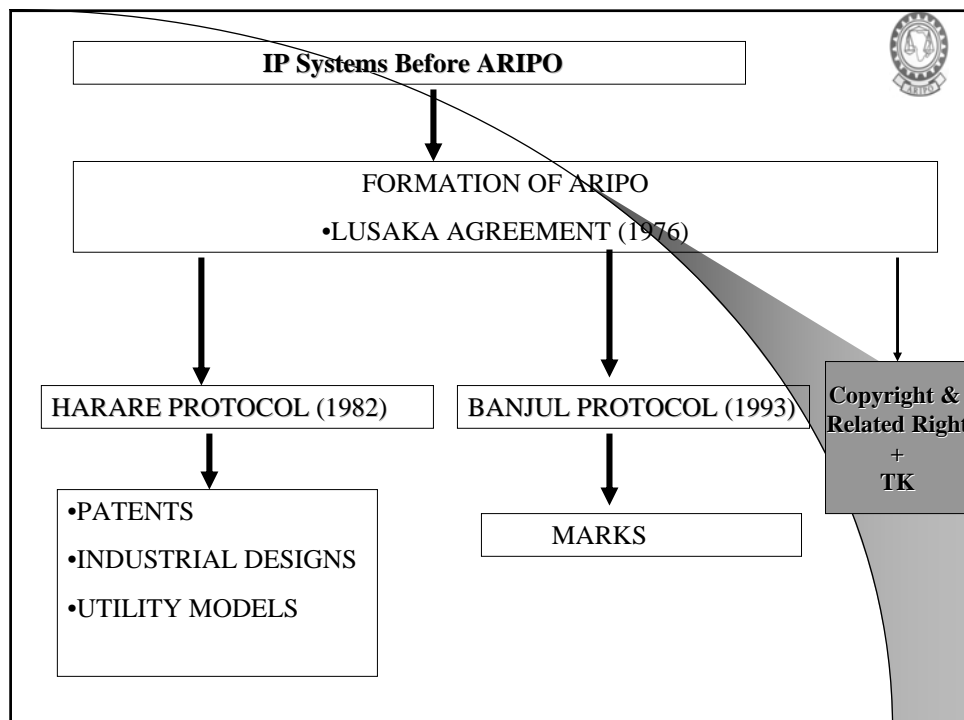
## Presentation overview

- ARIPO Background;
- ARIPO, its Major Activities and Objectives;
- ARIPO and the PCT;
- Functions of ARIPO as a Regional Patent Office;
- Challenges



## Brief History of ARIPO

- Lusaka Agreement was signed on 9 December 1976;
- Lusaka Agreement came into force on February 15, 1978;
- ARIPO Secretariat was established in Nairobi Kenya on June 1, 1981;
- 1982 ARIPO Secretariat moved to Harare, Zimbabwe;
- Harare protocol was signed on 10 December 1982;
- Harare Protocol in force on 25 April 1984;
- Harare Protocol was amended and linked to the PCT on 1 July 1994;
- Banjul Protocol on Marks – 24 November 1993;
- Banjul Protocol came into force on 6 March 1997;
- Harare Protocol was amended to include utility models on 1 January 2001.

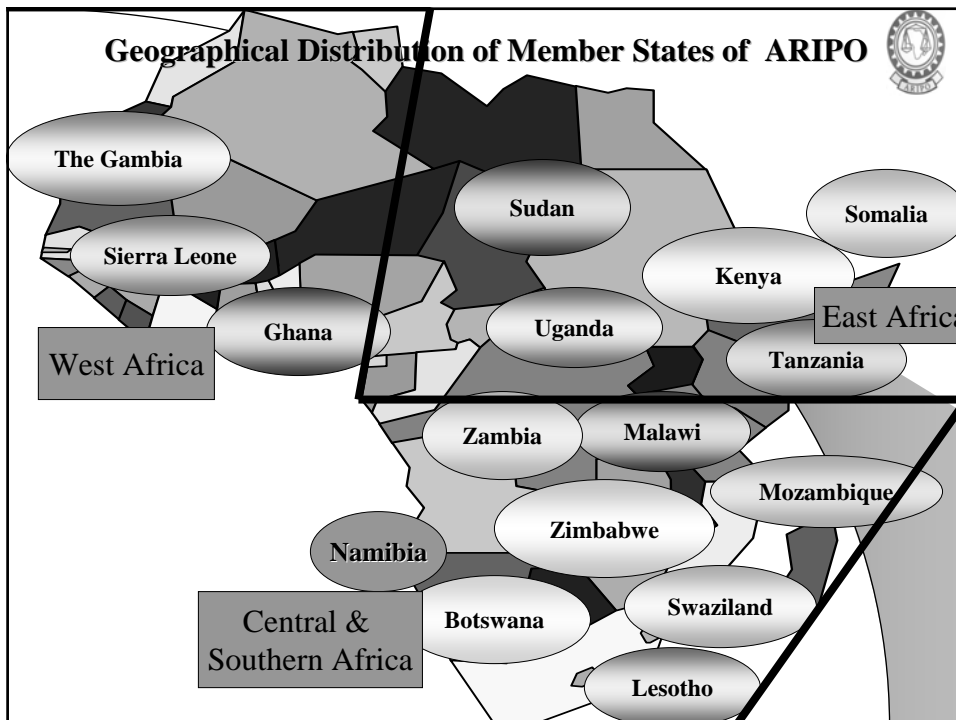


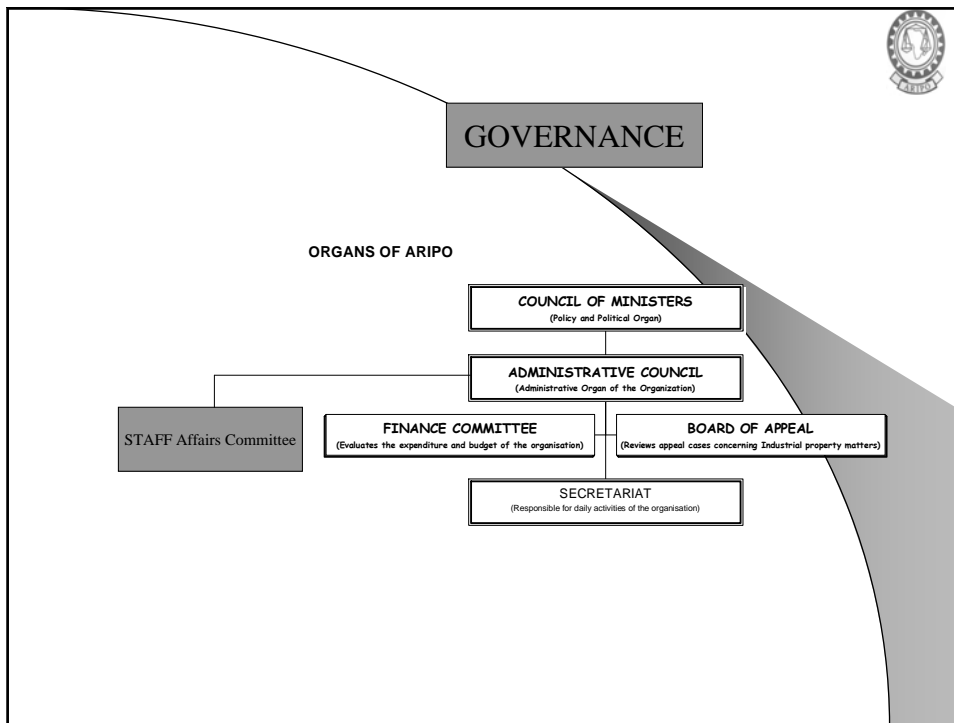


# The ARIPO Office



## Geographical Distribution of Member States of ARIPO





## Financing of ARIPO

- Fees Received from the two Protocols;
- Annual Contributions ( Self sustaining , Since January 1, 2008 );
- Donor Funds (Normally not in cash but in Activities & Equipment).

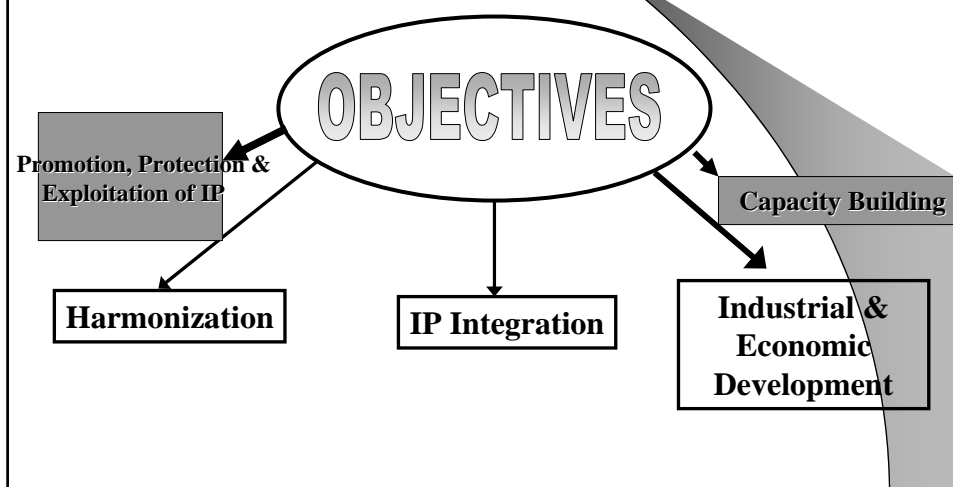


## The Main Objectives of ARIPO

- The main objective among others is to Pool Resources of its Member States together in solving IP related issues by;
  - Harmonizing IP Laws and Coordinating IP Activities among the Member States;
  - Centrally handling most of the matters related to IP including Grant & Registration of IP Rights on behalf of the Member States;
  - Dissemination of Information Relating to IP;
  - Capacity building;
  - Stimulation Business, Human Resources and Institutional Building of IP in the Member States, etc.



## ACHIEVING A REGIONAL APPROACH THROUGH ARIPO





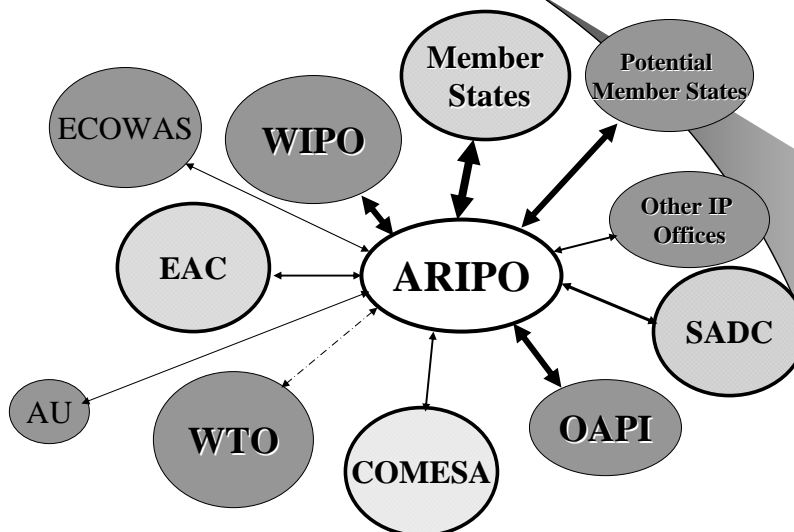
## ACHIEVING A REGIONAL & GLOBAL APPROACH

### Main Areas of Action

- ⇒ Standards, Norms setting and Training
- ⇒ United Industrial, Economic & IP Policy Strategy
- ⇒ United Developmental Strategy
- ⇒ Information & Data Exchange System



### Cooperation with other IP Offices and Organizations





## The Harare Protocol

- Empowers ARIPO to grant Patents and register Utility Models and Industrial Designs on behalf of its Member States.
- All Member States of ARIPO (except Somalia) are party to the Harare Protocol and to the Patent Cooperation Treaty (PCT).



## The Main Objectives of The Harare Protocol

- **Promote, Harmonize & Develop** Industrial Property among the Member States of ARIPO;
- **Facilitates the protection and management of patents, Industrial Designs and Utility Models in the Contracting States;**
- **ARIPO Patents, Industrial Designs & Utility Models are equivalent to a bundle of national registrations and their management is centralized and made easier;**
- **Only one Filing, one Grant, one publication, one agent is needed and**
- **All procedures like: renewals, amendments, representation, etc. are Centralized.**



## **The Harare Protocol and the Patent Cooperation Treaty (PCT)**

The Harare Protocol was effectively linked to the PCT on July 1, 1994 and had the following effects:

- a) Any applicant filing for a PCT application automatically designates ARIPO and its Member States;
- b) The ARIPO Office acts as a Receiving Office under the PCT for such states and
- c) The ARIPO Office may be elected in any PCT application and all contracting states of the Harare Protocol which are also party to the PCT.



## **Traditional Patent System Before The PCT**

- Worldwide filing had to be done within 12 months from priority date (Paris Convention);
- Multiple formality requirements undertaken;
- Multiple searches;
- Multiple publications;
- Multiple examinations & prosecutions of applications;
- Translations & national fees payable within 12 months, etc.

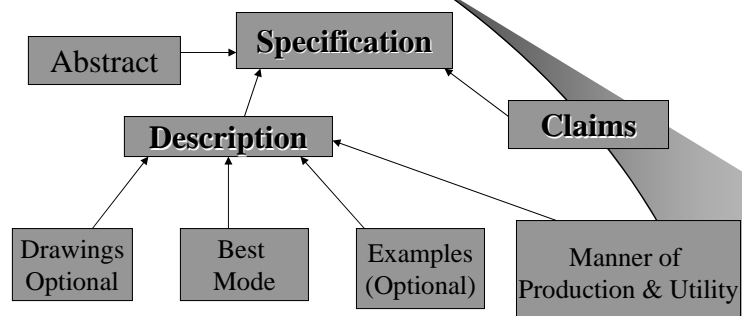




## Member States of ARIPO and the PCT

- Except Somalia, all ARIPO Member States are party to the PCT;
- Somalia is neither party to the PCT nor to the Harare Protocol;
- ARIPO is a Receiving Office for all Member States party to PCT;
- NA, TZ & UG are not Receiving Offices of PCT applications & ARIPO & WIPO are their only Receiving Offices;
- SZ closed her national route with regard to PCT applications & all PCT applications can only lodged through ARIPO;

## Structure of a Patent Specification





## Elements of an International PCT Patent Application

- Request/Application form;
- Description;
- One or more claims
- Abstract (May be filed later without affecting the international; filing date);
- Drawings where applicable;
- Sequence listing where applicable and
- Indications containing references to deposited microorganisms.



## ARIPO as Receiving Office –PCT Initial Formality Examination

- Applicant's residence;
- Request form must be properly completed;
- Applicants & inventors must be identified;
- Specification must have a description & at least 1 claim;
- Three copies should be lodged;
- Fees or undertaking to lodge fees and
- ARIPO Office helps applicants to correct defects.



## **Actions after Initial Formality Examination of PCT applications at ARIPO**

- ❑ **Accord international filing date;**
- ❑ **Assign International application number e.g. PCT/AP/2009/000001;**
- ❑ **Make final formality checks;**
- ❑ **identify record, search and home copies**
- ❑ **undertake correspondence with applicant, IB & ISA and receive fees on their behalf, etc.**



## **What is NOT immediately required for obtaining an International filing date**

- Payment of fees on filing;
- Translation of the international application;
- Applicant's signature;
- Title of the invention and
- Abstract and drawings.



## **Functions of ARIPO as a Receiving Office for PCT applications**

- **Specifies the ISA(s) for PCT applications in the International phase;**
- **Specifies the IEA (s) for PCT applications;**
- **Prescribes the languages in which PCT applications must be lodged at ARIPO;**
- **Fixes the amount of transmittal fee;**
- **Undertakes formality checks & accords filing dates, etc.**



## **PCT Procedures at ARIPO**

- **Checks document list on PCT Request Form;**
- **Further Checks the physical requirements**
- **ARIPO advises applicant of application number, filing dates and defects if any;**
- **Record Copy plus fees is sent to IB;**
- **Search copy plus fees is sent ISA;**
- **Home copy plus receiving office fees kept by ARIPO;**
- **ISA for AP are EP, AT & SE**



## PCT Fees

- ❑ **ARIPO Receiving Office Fees USD 50** (or equivalent in local currency);
- ❑ **Basic fee to IB: 10% of USD1102;**
- ❑ **Search Fee to ISA 25% of the fee charged by EPO, About USD200;**
- ❑ **PCT-Easy reduction by Sfr.200- =USD 190 from Basic fee**



## Main Objectives of the PCT

- **Lodging one application, with one Office & in one language;**
- **Formal examination by a single patent office;**
- **Good International search & examination reports;**
- **Provides more time (31 months at ARIPO) to the applicant;**
- **Strong patents are granted;**
- **Facilitates the provision of patent information, etc.**



## Correction of Defects



- ❑ AP helps applicants to correct defects;
- ❑ Bad defects-Application withdrawn, IB Informed;
- ❑ Fees already received-refunded to applicant



## Refund of Fees by ARIPO as a PCT Receiving Office

- ❑ If no filing date accorded or
- ❑ If application withdrawn  
Before transmittal of Record Copy,  
Before Transmittal of Search Copy to the ISA  
Transmittal Fees refundable if none of the documents has been transmitted.





## **Time limits for ARIPO REGIONAL/NATIONAL phase of PCT Applications**

- **31 months if no demand lodged before 19 months ( Chapter I);**
- **31 months if demand lodged [Chapter II];**
- **Applicant has 60 days to comply with formality requirements;**
- **International filing date is also the filing date accorded by ARIPO;**
- **Priority data remain the same,**



## **Processing of PCT applications in the Regional/national phase**

- **Initial Formality Examination;**
- **Accord Filing Date;**
- **International filing date is also the ARIPO filing date;**
- **Open Technical & Administrative files**
- **Accord AP Application Number e.g. AP/P/1998/0000010**
- **Request for translations if necessary;**
- **Capture bibliographic data in the ARIPO AFPAT database;**



### **Mandatory Requirements for according a filing date and application number for ARIPO Patent Application**

- **Completed ARIPO Request Form 3;**
- **Something like a description;**
- **One or more Claims;**
- **Designation of at least one contracting state and**
- **Fees or undertaking to pay fees in 21 days.**



### **Formality requirements in the Regional Phase**

- Patent agent, if applicant is not resident in any member state;
- completion of the ARIPO Request Form;
- Assignments of invention needed only if applicants are not the same (not needed for PCT in regional phase);
- At least one Member State must be designated;
- Fees or undertaking that fees to be paid in 21 days;
- Physical requirements must be acceptable.





## **Substantive Search & Examination at ARIPO**

- **PCT search & Examination results are consulted & used;**
- **Applications must follow Administrative Instructions of the Harare Protocol;**
- **Patentability Criteria of Designated States are considered;**
- **Amendments are acceptable**

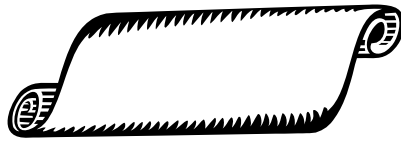


## **Objectives of Search and substantive Examination at ARIPO**

- **Harare Protocol, Administrative Instructions must be adhered to;**
- **Limitations to Patentability in Member States are considered;**
- **Invention must be new, not obvious and industrially applicable;**
- **local databases consulted before grant;**
- **Invention (claims) must be clear & concise;**
- **Infringement & Litigation can be avoided;**
- **Monopoly Rights correctly given;**
- **Strong internationally recognized patents issued by the ARIPO Office.**

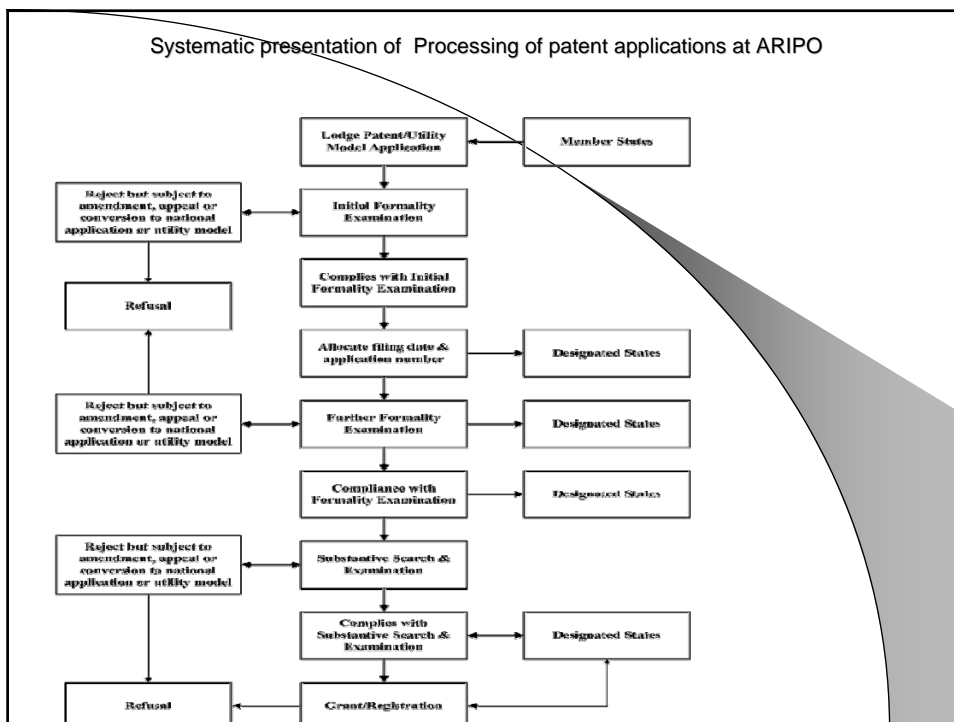


## Grant & Publication of an ARIPO Patent



- Six months after search & examination, if positive;
- Any Designated state can refuse the Grant of a patent;
- Grant & publication fees must have been paid;
- Has effect in all designated states ;
- patent Valid for 20 years in all designated States

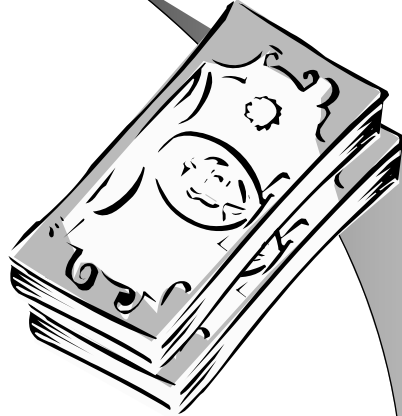
### Systematic presentation of Processing of patent applications at ARIPO





# ARIPO Fees

- **Application fees;**
- **Designation fees;**
- **Annual Maintenance fees;**
- **Grant & Publication fees;**
- **Any other fees as requested.**



## Schedule of Fees PATENTS

Type of fees	Amount (US Dollars,
<b>Application fee</b>	<b>250</b>
<b>Designation fees per Country designated</b>	<b>75</b>
<b>Examination Report fee</b> (if no Examination report)	<b>250</b>
<b>Search Report fee</b> (if no Examination report)	<b>250</b>
<b>Publication fee</b>	<b>300</b>
<b>Surcharge for each additional page after 40 pages</b>	<b>15</b>
<b>Surcharge for each additional claim after 10 claims</b>	<b>40</b>
<b>Grant fee</b>	<b>300</b>
<i>Annual maintenance fees</i> <i>in respect of each designated State increasing by USD 20 per year</i>	
<b>1st anniversary</b>	<b>40</b>
<b>2nd</b> “	<b>60</b>
<b>3rd</b> “	<b>80</b>
<b>4th</b> “	<b>100</b>



## Schedule of Fees Utility Models in USD

- Application fee 100
- Designation fee (per country) 20
- Registration & Publication fee 50
- Maintenance fees (per designated State):
  - First year 20
  - second year 25
  - Third year 30
  - Fourth Year 40
  - Fifth year 50
  - Sixth year 60
  - Seventh year 70



## General Advantages of the PCT system to ARIPO & the Region

- Increase of the number of applications;
- Simpler examination procedures;
- Local applicants have more time before filing world wide;
- PCT offers foreign & local investors with patentable technology;
- Free Technical Information & equipment;
- Training of local staff, etc.



## **Specific Advantages of using the PCT/ ARIPO Route**

- **Simplified procedure;**
- **Single application, protection in many states;**
- **Centralized renewal;**
- **Single representation in all states;**
- **Cheaper if compared to individual filings;**
- **Possibility of conversion to utility model or national patent ;**
- **Uniform duration of rights in all states, etc**



## **Major Challenges to ARIPO & Its Member States**

- **Harmonization of IP laws of the Member States;**
- **Limited Resources to undertake all the Objectives & Projects of the Organization & its member States;**
- **Limited Capacity particularly in the National Offices to undertake & adopt Policies Developed in the Region;**
- **Limited knowledge & Information relating to IP among the citizens of the Member States;**
- **Limited Infrastructure e.g. Communication, in the Region;**
- **High cost of Obtaining, Promoting & Enforcing IP Rights;**
- **Perceptions that IP is too cumbersome and is therefore for the Rich, Developed Countries, etc.**

## **Challenges continued**

- Limited number of Schools with IP in their curricular in the region;
- Lack of National IP Strategies;
- Lack of IP Strategies in most institutions including universities in the region;
- Lack of adequate market & qualified personnel for IP Services;
- Lack of resources for capacity building in IP, etc.

## **African Regional intellectual Property Organization (ARIPO)**



- Physical Address: 11 Natal Rd Belgravia-Harare;
- Tel: +263-4-794065 to 794074;
- Fax: +263-4-794072/3;
- E-mail: [mail@aripo.org](mailto:mail@aripo.org), [aripo@ecoweb.co.zw](mailto:aripo@ecoweb.co.zw)  
Website: [www.aripo.org/](http://www.aripo.org/)

**Thank you**