



REPUBLIC OF SOUTH AFRICA



Regional Seminar for Certain African Countries on the Implementation and Use of Several Patent-Related Flexibilities

***Topic 13: The Effective Administrative Process for the Grant
of Compulsory Licenses***

**Durban, South Africa
January 29 to 31, 2013**



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THE REPUBLIC OF UGANDA

THE EFFECTIVE ADMINISTRATIVE PROCESS FOR THE GRANT OF A COMPULSORY LICENSE:

**A paper presented at the Regional Seminar for Certain African Countries on
the Implementation and Use of Several Patent-Related Flexibilities**

Durban, South Africa, January 29 to 31, 2013

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Legal frame work

- About Uganda -General status of IP laws
- Patent Act Cap 217 -1993
- The Patent Regulations, SI 216-1
The Act provides for:
 - i. Exploitation by the Government or persons authorised by the Government (Section 29).
 - ii. Compulsory licenses (Section 30) The

NOTE: *Industrial Property Bill, 2009 will soon replace the current Patent act and has comprehensive provisions relating to compulsory licenses*



Exploitation by the Government or persons authorised by the Government-

- Directive by the Minister in consultation with the registrar
- Reason :Vital public interest (matters of paramount importance pertaining to national security, public health, public order and morality and the national economy)
- The patented invention may be exploited by a Government agent or other person designated by the Minister,
- The owner of the patent and any licensee must be given an opportunity to be heard before the decision is made.
- Government has to provide for the payment of adequate remuneration as fixed by the registrar.



How an application for a compulsory license is processed

- The parties in the grant of compulsory license include the Patentee, the state and the applicant.
- The Patent Act permits court to grant a compulsory license
- The grounds are listed in the Act.
- The Act provides that any person may request court. This includes a private company or government agency.
- The applicant must state the grounds or reasons for the grant of a CL.
- CL is subject to payment of remuneration of the licensee or the patent owner



Exploitation by the Government Or Persons Authorised- Uganda

- The Minister consults the Registrar
- The owner of patent is given at least 1 days notice in writing of the date on which the matter will be heard,
- The owner of the patent gives written notice of the hearing to all licensees
- Minister makes direction and states for the direction and shall state the terms of exploitation and transmit decision to the registrar.
- The registrar then records the direction of the minister and publishes it in the Gazette.
- The registrar shall in writing notify
- the owner of the patent



ARTICLE 31 TRIPS

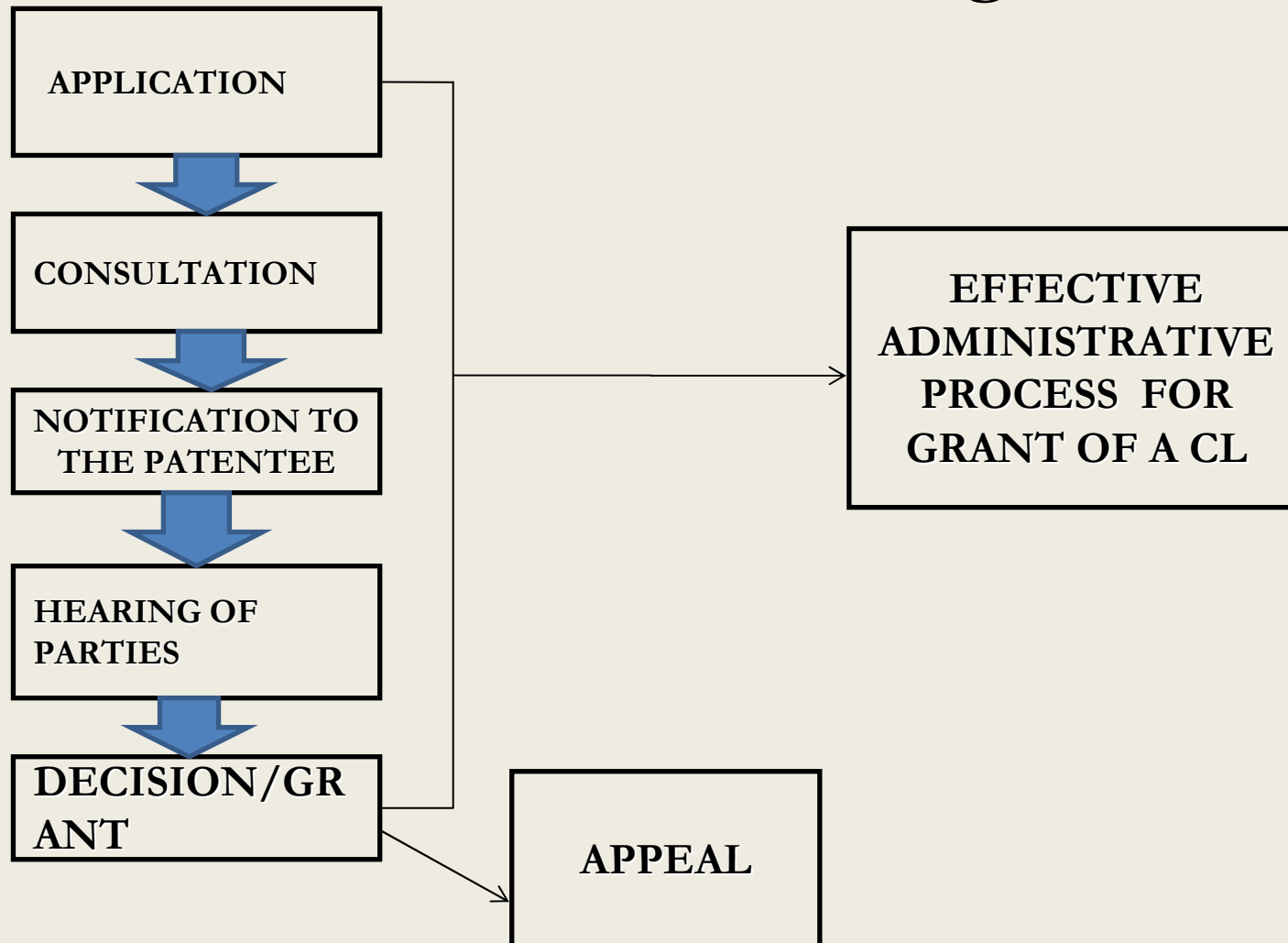
- Permits the use of administrative practices in all Article 31 decisions
- The process should be fair, transparent and accountable relying on records and decisions
- The parties should be given an opportunity to be heard



- There should be an appeals process by an independent body
- Requires that the administrative process provides for an independent review by a distinct higher authority eg a minister of health could appoint an officer to make decisions



Effective administrative process for the grant of a CL





Effective administrative process for the grant of a CL

- **APPLICATION:** Application/petition is initiated by the applicant to the Patent office. The application should be accompanied with grounds and other supporting documents.
-Payment of fees for application(if the applicant is a government agency/ department, the official fee should be waived)-
- **CONSULTATION:** the Patent office should consult with experts in the area and the authorities.
- **NOTIFICATION:** The Patent Office will then send a copy of the application to the patentee who must state his/her opinion within a specified period.
- **HEARING:** Both parties(applicant and patentee) have to be heard.(Hearing)

- **DECISION/GRANT:** The patent office may grant a CL after giving notice to the patentee of the reasons for the grant. The Patent office will then make a decision. The Grant decision can be appealed against.
- The licensees of a CL is required to pay reasonable compensation.
- Note: *terms for the grant of a CL. If the application is rejected, the Patent Office should state reasons for rejection*

- The applicant should always try to acquire a voluntary licence
- There should also be an appeals process independent body
- The process must not be overly legalistic and expensive to administer
- The system for compensation should be relatively predictable and easy to administer

Conclusion

Therefore for an effective administration process of grant of a compulsory license for a patent, the interested parties have to be involved in the process, given an opportunity to be heard and remunerated accordingly. The process should also make provision for appeals.



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THANK YOU