



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

## Topic 6: The Harare Protocol on Patent and Designs: Processing Patent Applications Under the Harare Protocol

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*Fostering Creativity and Innovation for Economic Growth and Development in Africa*

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# Legal Framework

- **Harare Protocol (HP)**
- **Regulations under the HP**
  - **Administrative Instructions under the HP**
  - **Guidelines for Examination at ARIPO (published 2018)**



# The Harare Protocol

- **Adopted in 1982; entered into force in 1984**
- **Empowers ARIPO (AP) to grant patents and to register utility models and industrial designs; and to administer the same on behalf of Contracting States**
- **Contracting States: All member States of ARIPO (except Somalia) are party to the HP**
- **Duration – 20 year from filling date**



# HP Contracting States

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

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## The Link Between HP and PCT - *Sec. 3bis*

- The Harare Protocol has been linked to the PCT in 1994
- All 18 contracting States party to the Harare Protocol are PCT contracting States
- Any applicant filing a PCT application automatically designate all 18 Harare Protocol contracting States
- However, upon entry into the national phase, Applicant decides which the Harare Protocol Contracting States to designate
- ARIPO Office acts as a receiving office under the PCT



# The HP and Budapest Treaty - *Sec. 3(1)*

- A deposit of **biological material** must be made in a recognized institution in the case of inventions involving micro-organisms
- Applications should contain name of Institution, date when the **biological material** was deposited and reference number
- **Biological material** shall be available to third parties from the date of publication of the ARIPO application
- ARIPO publishes the list of depository institutions;

# Processing of Patent Application

## ➤ Main Stakeholder are:

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





# Processing of Patent Application

- **Section 2(3) of the Harare Protocol**

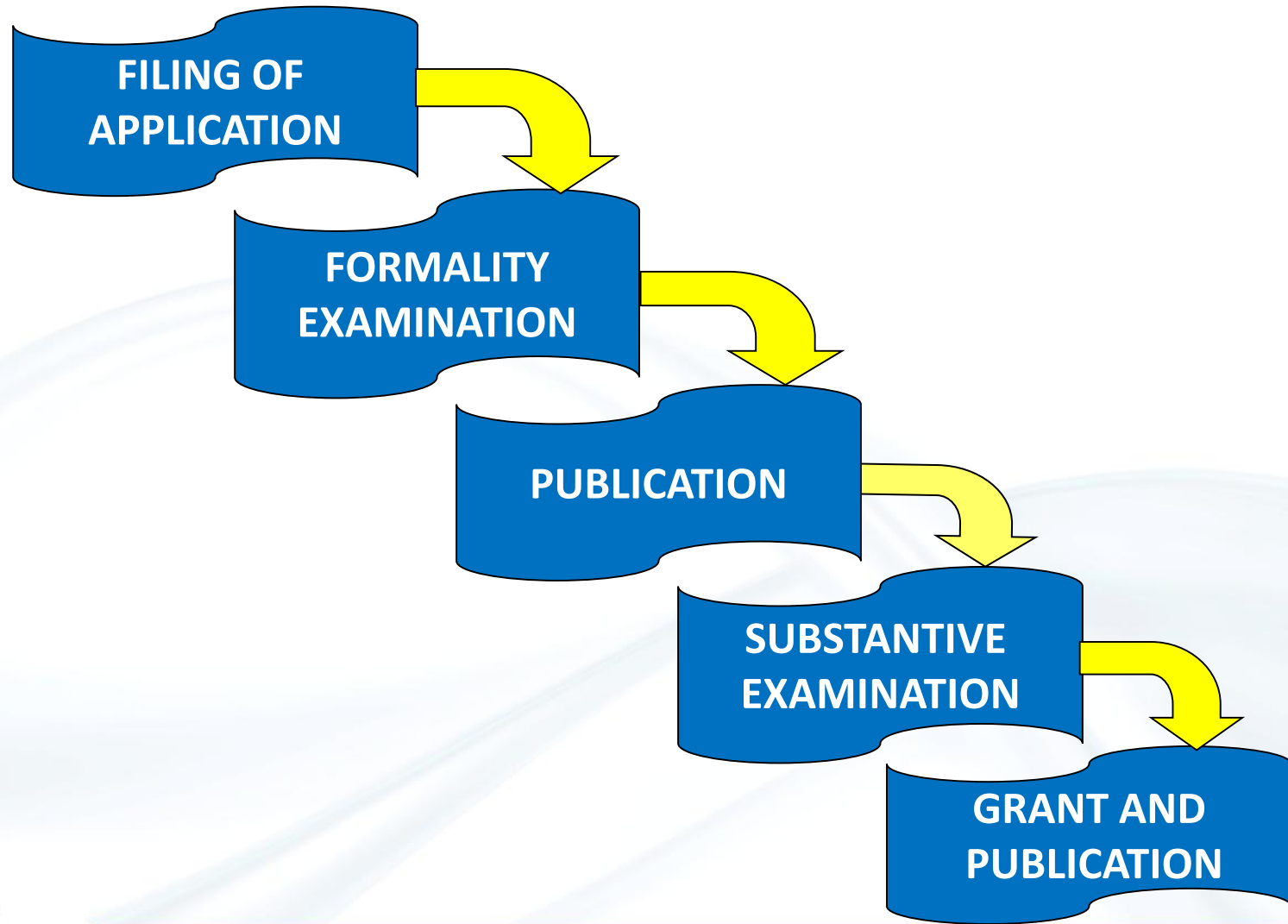
“The ARIPO patents... **shall in each of the Contracting State** for which it is granted..., **have the effect of, and subjected to the same condition as a National patent granted... by that State”** .

- **Botswana Industrial Property Act, 2010 – Sec. 29**

“A patent in respect of which Botswana is a designated State, granted by the ARIPO by virtue of the Harare Protocol, shall have the same effect and enjoy the same protection in Botswana as a patent granted under this act unless the Registrar communicate to ARIPO, in respect of the application therefor, a decision, in accordance with the provision of the Protocol, that if a patent is granted by ARIPO, that the patent shall have no effect in Botswana ”



# Processing of Patent Application under HP



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

- **Who can Apply:**
  - Applicant
  - Authorized Representative
  
- **Where to File:**
  - Direct to ARIPO
  - National IP Office (Receiving offices)
  
- **Mode of Filing:**
  - Post, e-mail, fax, courier, at ARIPO, **online filing**



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

## Patents application shall:

- ✓ 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



## Filing Date Allocation – *Sec.3(2); R.14*

- Upon receipt of application, the Office examines whether application can be accorded filing date
- Minimum Requirements for allocation of filing date are:
  - 1) a request (Form 3),
  - 2) a description, and
  - 3) one or more claims
- If the application meets these requirements – a notification of filing date issued to the Applicant and each designated state - **(Form 12)**
- If not - Applicant is invited to comply within 2 months - **(Form 11)**



## Formality Examination - *(Sec.3(1); Rule 5)*

- If filing date has been accorded, the Office checks following:
  - ✓ 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



# Formality Examination - *Sec.3(1); Rule 5*

- ✓ Physical requirements must be acceptable
  - ✓ Priority document (if priority claimed)
  - ✓ Power of attorney (Form 4) - *if applicant is not resident*
  - ✓ Deed of assignment of invention - *if applicants is not the same as inventor*
- 
- If the application meets these requirements – a notification of compliance with formality is issued to the Applicant and each designated State - **(Form 13)**
  - If not -Applicant is invited to comply within **2 months - (Form 14)**



## Publication of ARPO Application - *Rule 19bis*

- Application published promptly after expiry of 18 months from filing date or if priority is claimed, from the priority date
- Application withdrawn or abandoned before expiry of 18 months from filing date not published

### Note:

- No re-publication of PCT applications entering national phase.
- Publication would have been done by the International Bureau of WIPO (IB) during the international phase





# 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 - *Matters considered*

- **Unity of invention (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
  
- **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.



# Search and Search Report – *Sec. 3(10)(c); R.18*

- Search performed to establish relevant prior art
- Search conducted on the basis of the claims, with due regard to the description and drawings if any
- Search report drawn upon conclusion of the search
- Search report indicates prior art documents considered necessary for evaluation of novelty and inventive step



# Example of a Search Report

C. DOCUMENTS CONSIDERED TO BE RELEVANT		
Category*	Citation of document, with indication, where appropriate, of the relevant passages	Relevant to claim No.
X	JP 50-14535 B (NCR CORPORATION) 28 May 1975 (28.05.75), column 4, lines 3 to 27	7-9, 11
X	GB 392415 A (JONES) 18 May 1933 (18.05.33) Fig. 1	1-3
Y	page 3, lines 5-7	4, 10
A	Fig. 5, support 36	11-12
X	GB 2174500 A (STC) 5 November 1986 (05.11.86) page 1, lines 5-15, 22-34, 46-80; Fig. 1	1-3
Y		4
A	US 4322752 A (BIXTY) 30 March 1982 (30.03.82) claim 1	1
A	GREEN, J.P. Integrated Circuit and Electronic Compass, IBM Technical Disclosure Bulletin, October 1975, Vol. 17, No. 6, pages 1344 and 1345	1-5

**Symbols indicating which aspect of relevance patentability the document cited is relevant to**

**Documents relevant to whether or not your invention may be patentable**

**The claim numbers in your application to which the document is relevant**

# Patentability Criteria - *Sec. 3(10); R.18*

Inventions for which patents are granted 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 – *Sec. 3(3); R.18*

- If the patentability requirement not met, the Office issue a notification of non-compliance with substantive requirements and invite the applicant to submit observations and/or amended application – **Form 18**
  - Form 18 accompanied by search and substantive examination reports
- The applicant has to respond within **6 months** from the date of notification.



# 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**





# Appeals - *Sections 3(5), 4bis*

- Appeals may be filed before the ARIPO Board of Appeal
- The Board:
  - Considers and decides on any appeal lodged by the applicant;
  - Reviews any final administrative decision of the Office in relation to the implementation of the HP
- The Board's decision is final



## Effect of an ARIPO Patent – *Sec.1(3), 3(11), 3(12)*

- Provided it is maintained, patent granted by ARIPO have the same effect as patent registered or granted or otherwise having effect under the applicable national law
- Patent is subject to applicable national law of each designated state
- Duration of ARIPO patent - 20 years from filing date



## 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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