WORKSHOP ON THE PROMOTION OF ARIPO PROTOCOLS

Processing of Applications under the Harare Protocol

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Port Louis, Mauritius, 31 May – 2 June, 2023

Fostering Creativity and Innovation for Economic Growth and Development in Africa
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- Processing of Patent & Utility Model Application under the Harare Protocol
- Processing of Industrial Design Application under the Harare Protocol

Focus: Filling Application; Formality Examination; Substantive Examination; Grant/Registration
The Harare Protocol

- EmpowersARIPO to grant patent and register utility Model and industrial design and on behalf of the contracting states.
- Entered into force in 1984.
- Duration of rights:
  - Patents - 20 years
  - Industrial Designs – 10 years
  - Utility Models – 10 years
Processing of Application

- **Main Stakeholder are:**
  1. Applicant/Representative;
  2. The ARIPO Secretariat; and
  3. The National IP Office (Filling or Designation)

- **Section 1(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”. 
Processing of Patent and Utility Model Application

- Filing of Application
- Formal Examination
- Publication Application
- Prior Art Search
- Substantive Examination
- Intension to Grant
- Refusal
- Appeal
- Grant and Publication

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Filing Application - *Sec. 2*

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 Filling:

- Post, e-mail, fax, courier, depositing at ARIPO, online filing
Content of Application - Sec. 3(1)

Patents application contains:

✓ a request Form – ARIPO Form 3
✓ 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 fees
Filing Date Allocation – Rule 14

- Minimum Requirements for allocation of filing dates are:
  1. a request (Form 3)
  2. a description
  3. one or more claims

- If the application meets these requirements – a notification of filing date (Form 12) issued to the Applicant and each designated state

- If not - Applicant is invited (Form 11) to comply within 2 months
Formality Requirements - **Sec.3(1); Rule 5**

- 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
- Priority document (if priority claimed)
Formality Examination

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

- Power of attorney (Form 4) - *if applicant is not resident*
- Deed of assignment – *if the applicant is not the inventor*

- If the application meets these requirements – a notification of filing date *(Form 13)* 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*

**Sec.3(3) HP:**
- Provided that the Office shall, on request, undertake, or arrange for, the substantive examination of the patent application

**Substantive examination undertaken when:**
- Patent application has met formality requirements;
- Request for examination has been made (*Form 13A*);
- Search and examination fee has been paid
Outcome of Substantive Examination

➢ 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.
  ▪ the option of converting his application into a national patent application or into an ARIPO utility model application
Outcome of Substantive Examination

- Notification of compliance and decision to grant patent
  - Form 21

- Notification issued and sent to:
  - the applicant; and
  - each designated State(s)

- Form 21 is accompanied by search and examination reports

- 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.

➢ Form 25 issued – ARIPO Patent
Conversion of the patent application

- Patent application can be converted to Utility Model
  - At any time before the grant or refusal of a patent, an applicant for a patent,
  - upon payment of the fee,
  - shall be accorded the filing date of the initial application.
Maintenance/Renewal Requirement

- On each anniversary of the filing of the application, the applicant is required to pay the annual **maintenance fees**.

- If an annual maintenance fee is not paid in, the application shall be deemed to have been **withdrawn** or the patent shall **lapse**.

- The lapsed patent or withdrawal of application will be published in the ARIPO Journal.
Content of Application - *Sec. 4(1), R.9*

- Industrial Designs application shall contain:
  - ✓ contain a request for registration *(Form 28)*;
  - ✓ Contain a reproduction of the design;
  - ✓ designate the contracting State(s)
  - ✓ payment of the prescribed fees
Minimum Requirements for Allocation of Filing Date

*(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 33)* issued to the Applicant and each designated state

➢ If not - Applicant is invited *(Form 32)* to comply within 2 months
Formality Examination

✓ a request Form (Form 28)
✓ a reproduction of the industrial designs
✓ a designation of at least one state
✓ payment of the application and designation fees
✓ English translation (if application was filled in language other than English)
✓ Priority document (if priority claimed)
✓ Power of attorney (Form 4) - if applicant is not resident

➢ If the application meets these requirements – a notification of complies with formal requirements (Form 34) issued to the Applicant and each designated state
➢ If not - Applicant is invited (Form 35) to comply within 2 months
The substantive examination for industrial design is undertaken by each designated state.

After the application meets formal requirement, ARIPO notify each designated State.

Each designated State has 6 months to undertake substantive examination and notifies ARIPO, whether the design meets or does not meet the requirements for registration.

If application does not comply with National Law - Applicant can appeals within national Office.
Substantive Examination - S.4; R.18quater

- If designated State communicates that an industrial design shall have no effect in its territory, the applicant may respond, within 3 months, by providing amendments and/or arguments in relation to the communication.

- Where an applicant submits amendments and/or arguments, the designated State shall respond within 3 months.

- If the designated State refuses the application notwithstanding the applicant’s amendments and/or arguments, the applicant may, within 3 months, request that the application be treated, as application according to the national law of that State.
✓ After the expiry of the six (6) months, ARIPO registers and publishes the design

✓ Form 39 - certificate of registration of industrial design, issued
Some Benefit of the Harare Protocol

- Simple, cost effective and user friendly.
- Centralized processing, grant and renewal
- More efficient and streamlined procedures
- ARIPO Conducts Substantive Examination and grant stronger patents
- Effective and appropriate tool for increasing foreign direct investment
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