

AFRICAN REGIONAL INTELLECTUAL PROPERTY ORGANIZATION (ARIPO)

HARARE PROTOCOL

ON PATENTS AND INDUSTRIAL DESIGNS 2018

amended by the Administrative Council of ARIPO

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Section 1 General

(1) The African Regional Intellectual Property Organization (ARIPO) is empowered to grant patents and to register utility models and industrial designs and to administer such patents, utility models and industrial designs on behalf of Contracting States in accordance with the provisions of the Protocol, through its Secretariat (hereinafter referred to as "the Office").

(2) Patents granted or utility models and industrial designs registered by virtue of this Protocol shall respectively be called ARIPO patents, ARIPO utility models and ARIPO industrial designs.

(3) The ARIPO patent or ARIPO utility model or ARIPO industrial design shall in each of the Contracting States for which it is granted or registered, as the case may be, have the effect of, and be subject to the same conditions as, a national patent granted, or utility model and industrial design registered, by that State.

Section 1bis Application to Contain one or More Designations of Contracting States

The grant of an ARIPO patent or the registration of an ARIPO utility model or an ARIPO industrial design may be requested for one or more of the Contracting States.

Section 2 Filing and Transmittal of Applications

(1) Applications for the grant of patents or the registration of utility models and industrial designs by the Office shall be filed by the authorized representative of the applicant or by the applicant with either the Office or, where the law of a Contracting State so permits, the industrial property office of a Contracting State.

(2) An application filed with the industrial property office of a Contracting State under the provisions of paragraph (1) of this Section shall have the same effect as if it had been filed on the same date at the Office.

(3) The provisions of paragraphs (1) and (2) of this Section shall not preclude the application of legislative provisions which, in any Contracting State-

(a) govern inventions which, owing to the nature of their subject-matter, may not be communicated abroad without the prior authorization of the competent authority of that State, or

(b) prescribe that each application is to be filed initially with the industrial property office of the Contracting State or make direct filing with another authority subject to prior authorization.

(4) An applicant may be represented by an attorney, agent or legal practitioner who has the right to represent applicants before the industrial property office of any Contracting State. Where-

(a) an application is filed directly with the Office but the applicant's ordinary residence or principal place of business is not situated in the host country of the Office; or

(b) an application is filed with the industrial property office of a Contracting State by an applicant whose ordinary residence or principal place of business is not situated in a Contracting State, the applicant shall be represented.

(5) Where the application is filed with the industrial property office of a Contracting State, such office shall within one month of receiving the application, transmit that application to the Office.

(6) Applications for an ARIPO patent, or for registration of an ARIPO utility model or an ARIPO industrial design, may be lodged in any language which must be translated into English within 2 months from the date of filing in accordance with Rule 5(2).

(7) Any person, or his successor in title, who has duly applied-

(a) to any state party to the Paris Convention for the Protection of Industrial Property, or

(b) to any member of the World Trade Organization,

for a patent, or for registration of a utility model or of an industrial design, shall enjoy for the purposes of filing for an ARIPO patent, or for registration of a utility model or of an industrial design, in respect of the same invention or design a right of priority during a period of 12 months (patents and utility models) and 6 months (industrial designs), from the date of filing the first application.

(8) Right of priority:

(a) Every filing that is equivalent to a regular national filing under the national law of the State where it was due, under bilateral or multilateral agreement including this Protocol, shall be recognized as giving rise to a right of priority.

(b) An applicant desiring to take advantage of the priority of the previous application shall file a declaration of priority and any other document required in accordance with the Implementing Regulations.

(c) Multiple priorities may be claimed in respect of an ARIPO patent application or an ARIPO utility model application or an ARIPO industrial design application, notwithstanding that they originated in different countries. Where appropriate, multiple priorities may be claimed for one claim. Where multiple priorities are claimed, time

limits which run from the date of priority shall run from the earliest date of priority.

Section 2bis ARIPO Patent Applications

(1) An ARIPO patent application:

(a) Shall relate to one invention only or to a group of inventions so linked that they form a single general inventive concept.

(b) Shall disclose the invention in a manner sufficiently clear and complete for it to be carried out by a person skilled in the art.

(2) The claims shall define the matter for which protection is sought. They shall be clear and concise and shall be supported by the description.

(3) The abstract shall merely serve for use as a source of technical information; in particular not for the purposes of interpreting the scope of the protection sought.

Section 3 Patents

(1) (a) An ARIPO patent application shall-

(i) identify the applicant;

(ii) contain, as prescribed, a description of the invention, a claim or claims, a drawing or drawings (where necessary), sequence listing (where necessary) and an abstract;

(iii) designate the Contracting States for which a patent is requested to be granted;

(iv) be subject to the payment of the prescribed fees.

(b) Where the patent application describes or claims as an invention that relates to biological material and requires for the performance of the invention, the use of a biological material which is not available to the public on the filing date of the application and which cannot be made or obtained on the basis of the description in the application, the biological material shall before the acceptance of the application be dealt with in the manner prescribed in the Regulations.

(2) (a) The Office shall examine whether the formal and physical requirements for applications as laid down in the Implementing Regulations and the Administrative Instructions have been complied with and, if so, shall accord the appropriate filing date to the application.

(b) If the Office finds that the application does not comply with the formal and/or physical requirements, it shall notify the applicant accordingly, inviting him to comply with the requirements within the

prescribed period. If the applicant does not comply with the requirements within the said period, the Office shall refuse the application.

(c) The Office shall notify the applicant and each designated State of the fact that a patent application has been filed which complies with the prescribed formal requirements.

(3) The Office shall, on request, undertake, or arrange for, the substantive examination of the patent application. If it finds that the invention claimed in the application does not comply with the requirements of patentability referred to in Sub-section (10), it shall refuse the application.

(4) Where under-

(a) sub-section (2)(b) or (3) of this Section, the Office refuses any application, the applicant may, within the prescribed period, request the Office to reconsider the matter.

(5) If after the Office has reconsidered the application, the Office is still of the view that the application should be refused, the applicant may lodge an appeal against the decision of the Office to the Board of Appeal established in terms of Section 4*bis* of the Protocol.

(6) (a) Before expiration of 6 months from the date of the notification referred to in Sub-section (7), a designated State may make a written communication to the Office that, if a patent is granted by the Office, that patent shall have no effect in its territory for the reason-

(i) that the invention is not patentable in accordance with the provisions of this Protocol, or

(ii) that, because of the nature of the invention, a patent cannot be registered or granted or has no effect under the national law of that State.

(b) If the Office decides to grant a patent, it shall notify the applicant and each designated State. A copy of the search and examination report shall be attached to the said notification. The designated State shall have 6 months within which to respond to the notification.

(7) After expiration of the said 6 months, the Office shall grant the patent, which shall have effect in those designated States which have not made the communication referred to in Sub-section (6). The Office shall publish the patent granted.

(8) If the Office refuses the application notwithstanding a request for reconsideration under Subsection (4), the applicant may, within 3 months from being notified of such refusal, request that his

application be treated, in any designated State, as an application according to the national law of that State.

(9) At any time before the grant or refusal of a patent, an applicant for a patent may, upon payment of the prescribed fees, convert the application into an application for a utility model, which shall be accorded the filing date of the initial application. An application may not be converted under this Sub-section more than once.

(10) (a) Patents shall be granted for any inventions, in all fields of technology, provided that they are new, involve an inventive step and are susceptible of industrial application.

(b) An invention shall be considered to be new if it is not anticipated by the prior art.

(c) Everything made available to the public anywhere in the world by means of a written disclosure (including drawings and other illustrations), an oral disclosure or by use or an exhibition, shall be considered prior art, provided that such publication occurred before the date of filing of the application or, if priority is claimed, before the priority date claimed in respect thereof and further provided that a disclosure of the invention at an official or officially recognized exhibition shall not be taken into consideration if it occurred not more than 6 months before the date of filing of the application or, if priority is claimed, before the priority date claimed in respect thereof.

(d) An official or officially recognized exhibition is an exhibition recognized by a State or falling within the terms of the Convention on international exhibitions.

(e) An invention shall be considered as involving an inventive step if, having regard to the prior art, it is not obvious to a person skilled in the art.

(f) An invention shall be considered as susceptible of industrial applicability if it can be made or utilized in any kind of industry including agriculture.

(g) An applicant for an ARIPO patent application shall be allowed at least one opportunity of amending the description, claims and drawings of his own volition. An ARIPO patent application or ARIPO patent may not be amended in such a way that it contains subject-matter which extends beyond the content of the initial application as filed.

(h) The following in particular shall not be regarded as inventions within the meaning of paragraph 10(a):

- (i) discoveries, scientific theories and mathematical methods;
- (ii) aesthetic creations;

(iii) schemes, rules and methods for performing mental acts, playing games or doing business, and programs for computers;

(iv) presentation of information.

(i) Paragraph (h) above shall exclude the patentability of the subject-matter or activities referred to therein only to the extent to which a patent application relates to such subject-matter or activities as such.

(j) Patents shall not be granted in respect of:

(i) inventions the commercial exploitation of which would be contrary to "ordre public" or morality; such exploitation shall not be deemed to be so contrary merely because it is prohibited by law or regulation in some or all of the Contracting States;

(ii) plant or animal varieties or essentially biological processes for the production of plants or animals; this provision shall not apply to microbiological processes or the products thereof;

(iii) methods for treatment of the human or animal body by surgery or therapy and diagnostic methods practised on the human or animal body; this provision shall not apply to products, in particular substances or compositions, for use in any of these methods.

(11) On each anniversary of the filing of the application, the ARIPO Office shall collect the prescribed annual maintenance fees, part of which shall be distributed among the designated States concerned as provided for in the regulations. The amount of the fees shall depend on the number of States in respect of which the application or patent is maintained. Provided it is maintained, a patent granted by the Office shall in each designated State have the same effect as a patent registered, granted or otherwise having effect under the applicable national law. The duration of the patent shall be 20 years from the filing date.

(12) A patent granted by the Office shall in each designated State be subject to provisions of the applicable national law on compulsory licences, forfeiture or the use of patented inventions in the public interest.

(13) An assignment of an ARIPO patent application shall be made in writing and shall require the signature of the parties to the agreement.

(14) (a) If two or more persons have made the same invention independent of each other, the right to an ARIPO patent therefor shall belong to a person whose patent application has the earliest date of filing, provided that the first application has been published.

(b) An ARIPO patent shall confer on its proprietor from the date on which the mention of its grant is published in the ARIPO Journal, in

each Contracting State in respect of which it is granted, the same rights as would be conferred by a national patent granted in that State.

(c) An ARIPO patent application shall on the date of its publication provisionally confer upon the applicant the protection provided for in Section 3(14)(b) in the contracting states designated in the application. Any contracting state may prescribe that an ARIPO patent shall not confer such protection as specified in Section 3(14)(b).

(d) An infringement of any ARIPO patent shall be dealt with by the national law of the Contracting State.

(15)(a) An ARIPO divisional application shall be filed directly with the ARIPO Office in accordance with Rule 18bis. It may be filed only in respect of a subject matter which does not extend beyond the scope of an earlier application as filed. In so far as this requirement is complied with, the divisional application shall be deemed to have been filed on the date of filing of the earlier application and shall enjoy the same right of priority.

(b) All Contracting States designated in the earlier application at the time of filing of an ARIPO divisional application shall be deemed to be designated in the divisional application.

(16) The extent of the protection conferred by an ARIPO patent or an ARIPO patent application shall be determined by the terms of the claims. Nevertheless, the description and drawings shall be used to interpret the claims.

(17) The Administrative Instructions shall specify the following:

(i) the time limits which are to be observed in proceedings before the ARIPO Office but which are not fixed by this Protocol;

(ii) the manner of computation of time limits and the conditions under which time limits may be extended;

(iii) the minima and maxima for the time limits to be determined by the ARIPO Office.

Section 3bis International Applications under the Patent Cooperation Treaty (PCT)

(1) In this Section-

"elected office" means an industrial property office of a Contracting State, or any other office or organization including the ARIPO Office acting for that industrial property office, which is elected by an applicant under Chapter II of the Patent Cooperation Treaty;

"international preliminary examination" shall be understood in the meaning evolved under the Patent Cooperation Treaty.

(2) An international application in which a Contracting State which is also bound by the Patent Cooperation Treaty 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. The provisions of the Patent Cooperation Treaty shall apply to such international application in addition to the provisions of this Protocol and the Regulations under this Protocol; in case of conflict, the provisions of the Patent Cooperation Treaty shall apply.

(3) The ARIPO Office may act as receiving Office under Article 2(xv) of the Patent Cooperation Treaty in relation to an international application filed by an applicant who is a resident or national of a Contracting State which is also bound by the Patent Cooperation Treaty.

(4) The ARIPO Office shall 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.

(5) The ARIPO Office shall 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.

(6) In relation to an international application referred to in Sub-section (2), without limiting the generality of that sub-section-

(i) Sections 2 and 3(2) shall not apply;

(ii) any annual maintenance fee which falls due under Section 3(11) need not be paid until the expiration of the applicable time limit under Article 22 or 39(1) (a) of the Patent Cooperation Treaty.

Section 3ter Utility Models

(1) In this Section, "utility model" means any form, configuration or disposition of elements of some appliance, working tools and implements as articles of everyday use, electrical and electronic circuitry, instrument, handicraft, mechanism or other object or any part thereof in so far as they are capable of contributing some benefit or new effect or saving in time, energy and labour or allowing a better or different functioning, use, processing or manufacture of the subject matter or that gives utility advantages, environmental benefit, and includes micro-organism or other self-replicable material, products of genetic resources, herbal as well as nutritional formulations which give new effects.

(2) A utility model shall be protected under the Protocol if it is new and industrially applicable.

(3) An application for registration of a utility model shall-

(i) identify the applicant;

(ii) contain, as prescribed, a description of the utility model, a claim or claims, a drawing or drawings or a model, and an abstract;

(iii) designate the Contracting States for which the utility model is requested to be registered;

(iv) be subject to payment of the prescribed fees.

(4) (a) The Office shall examine whether the formal requirements for applications have been complied with and shall, if so, accord the appropriate filing date to the application.

(b) If the Office finds that the application does not comply with the formal requirements, it shall notify the applicant accordingly, inviting him to comply with the requirements within the prescribed period. If the applicant does not comply with the requirements within the said period, the Office shall refuse the application.

(c) The Office shall notify each Designated State of the fact that an application for the registration of a utility model has been filed which complies with the prescribed formal requirements.

(5) The Office shall undertake, or arrange for, the substantive examination of the application for the utility model. If it finds that the application does not comply with the requirements for registration of a utility model referred to in Sub-section (2), it shall refuse the application.

(6) Where under-

(a) Sub-section 4(b) or (5) of this section,

(b) any other protocol within the framework of ARIPO, the Office refuses any application, the applicant may, within the prescribed period, request the Office to reconsider the matter.

(7) If after the Office has reconsidered the application, the Office is still of the view that the application should be refused, the applicant may lodge an appeal against the decision of the Office to the Board of Appeal.

(8) Before expiration of 6 months from the date of the notification referred to in Sub-section 4(c), a designated State may make a written communication to the Office that, if a utility model is registered by the Office, that registration shall have no effect in its territory for the reason-

(i) that the utility model is not registrable under the provisions of the Protocol, or

(ii) that, because of the nature of the utility model, such utility model cannot be registered or has no effect under the national law of that State.

(9) If the Office refuses the application notwithstanding a request for reconsideration under Subsection (7), the applicant may, within 3 months from being notified of such refusal, request that his application be treated, in any designated State, as an application according to the national law of that State.

(10) On each anniversary of the filing of the application, the Office shall collect the prescribed annual maintenance fees, part of which shall be distributed among designated States concerned as provided for in the regulations. The amount of fees shall depend on the number of States in respect of which the application or registration is maintained. Provided it is maintained, a utility model registered by the Office shall in each designated State have the same effect as a utility model registered or otherwise having effect under the applicable national law. The duration of the utility model shall be 10 years from the filing date.

(11) At any time before the refusal of an application for, or the registration of, a utility model, an applicant for registration of a utility model may, upon payment of the prescribed fees, convert his application into a patent application, which shall be accorded the filing date of the initial application.

(12) A registration of a utility model registered by the Office shall in each designated State be subject to provisions of the applicable national law on compulsory licences, forfeiture or the use in the public interest of registered utility models.

Section 4 Industrial Designs

(1) An application for the registration of an industrial design filed shall-

- (i) identify the applicant;
- (ii) contain a reproduction of the industrial design;
- (iii) designate the Contracting States for which the registration is requested to have effect;
- (iv) be subject to the payment of the prescribed fees.

(2) (a) The Office shall examine whether the formal requirements for applications have been complied with and, if so, shall accord the appropriate filing date to the application.

(b) If the Office finds that the application does not comply with the formal requirements, it shall notify the applicant accordingly,

inviting him to comply with the requirements within the prescribed period. If the applicant does not comply with the requirements within the said period, the Office shall refuse the application.

(c) The Office shall notify each designated State of the fact that an application for the registration of an industrial design has been filed which complies with the prescribed formal requirements.

(3) Before expiration of 6 months from the date of the notification referred to in Sub-section (2)(c), each designated State may make a written communication to the Office that, if the industrial design is registered by the Office, that registration shall have no effect in its territory for the reason-

(i) that the industrial design is not new,

(ii) that, because of the nature of the industrial design, it cannot be registered or a registration has no effect under the national law of that State, or

(iii) that, in the case of a textile design, it is the subject of a special register.

(4) After the expiration of the said 6 months, the Office shall effect the registration of the industrial design, which shall have effect in those designated States which have not made the communication referred to in Sub-section (3). The Office shall publish the registration.

(5) If the Office refuses the application, the applicant may, within 3 months from being notified of such refusal, request that his application be treated, in any designated State, as an application according to the national law of that State.

(6) On the anniversary of the filing of the application, the ARIPO Office shall collect the prescribed annual maintenance fees, part of which shall be distributed among the designated States concerned as provided for in the regulations. The amount of the fees shall depend on the number of States in respect of which the application or registration is maintained. Provided that it is maintained, the registration of an industrial design effected by the Office shall in each designated State have the same effect as a registration effected or otherwise in force under the applicable national law. The duration of such a registration shall be 10 years from the filing date.

(7) An industrial design registered by the Office shall in each designated State be subject to the provisions of the applicable national law on compulsory licences or the use in the public interest of registered industrial designs.

Section 4bis The Board of Appeal

- (1) There is hereby established a Board to be known as the Board of Appeal (hereinafter referred to as "the Board").
- (2) The Board shall consist of 5 members who are experienced in intellectual property matters 2 of whom shall be patent examiners.
- (3) At all sittings of the Board, at least one patent examiner shall be present.
- (4) The members of the Board shall be appointed by the Administrative Council of the Organization-
 - (a) for a period of 2 years renewable once for another term of 2 years;
 - (b) from the Member States of the Organization; and
 - (c) on such other terms and conditions as the Council may determine.
- (5) The functions of the Board are-
 - (a) to consider and decide on any appeal lodged by the applicant in terms of Section 3(5) of this Protocol;
 - (b) to review any final administrative decision of the Office in relation to the implementation of the provisions of this Protocol;
 - (c) to decide on any other matter related to or incidental to the exercise of the Board's powers.
- (6) Three members of the Board shall form a quorum.
- (7) Decisions of the Board shall be final.
- (8) The Board shall have power to make and adopt its own rules of procedure.

Section 5 Regulations

- (1) The Administrative Council of ARIPO shall make Regulations for the implementation of this Protocol and may amend them, where necessary.
- (2) The Regulations shall in particular relate to-
 - (i) any administrative requirements, matters of procedure, or any details necessary for the implementation of the provisions of this Protocol and any relevant international treaties;
 - (ii) the fees to be charged by the Office and the details of the distribution of part of those fees among the Contracting States.

Section 5bis Re-establishment of Rights

- (1) An applicant for or proprietor of an ARIPO patent, utility model or industrial design who, in spite of all due care required by the circumstances having been taken, was unable to observe a time limit, shall have his rights re-established upon request if the non-observance of this time limit has the direct consequence of causing the refusal of the ARIPO application or of a request, or the deeming

of the application to have been withdrawn, or the loss of any other right or means of redress.

(2) The ARIPO shall grant the request, provided that the conditions of paragraph 1 and any other requirements laid down in the Implementing Regulations are met. Otherwise, it shall reject the request.

(3) If the request is granted, the legal consequences of the failure to observe the time limit shall be deemed not to have ensued.

(4) No right shall be deemed re-established until such a time that the request has been granted. The Implementing Regulations may rule out re-establishment of other time limits.

(5) Any person who, in a designated Contracting State, has in good faith used or made effective and serious preparations for using an invention or design which is the subject of a published ARIPO patent, utility model or industrial design application or an ARIPO patent, utility model or industrial design in the period between the loss of rights referred to in paragraph 1 and publication in the ARIPO Journal of the mention of re-establishment of those rights, may without payment continue such use in the course of his business or for the needs thereof.

(6) Nothing in this Section shall limit the right of a Contracting State to grant re-establishment of rights in respect of time limits provided for in this Protocol and to be observed vis-à-vis the authorities of such State.

Section 5ter Request for limitation (Post grant amendment)

(1) At the request of the proprietor, the ARIPO patent or utility model may be limited by an amendment. The request shall be filed with the ARIPO Office in accordance with the Implementing Regulations. It shall not be deemed to have been filed until the limitation fee has been paid.

(2) Any amendment to the claims must fall wholly within the scope of the claims before the amendment.

Section 6 Entry into Force and Final Provisions

(1) (a) Any State which is a member of the Organization or any State to which membership of the Organization is open in accordance with Article IV(1) of the Agreement on the Creation of the African Regional Intellectual Property Organization may become party to this Protocol by-

(i) signature followed by the deposit of an instrument of ratification, or

(ii) deposit of an instrument of accession.

(b) Instruments of ratification or accession under this Protocol shall be deposited with the Government of the Republic of Zimbabwe.

(c) This Protocol shall enter into force 3 months after 3 States have deposited their instruments of ratification or accession.

(d) Any State which is not party to this Protocol upon its entry into force under Sub-section (1) (c) of this section shall become bound by this Protocol 3 months after the date on which such State deposits its instrument of ratification or accession.

(2) (a) Ratification of, or accession to, this Protocol shall entail acceptance of the Agreement on the Creation of an African Regional Intellectual Property Organization.

(b) The deposit of an instrument of ratification of, or accession to, this Protocol by a State which is not a party to the Agreement referred to in paragraph (a) of this sub-section shall have the effect that the said State shall become party to the said Agreement on the date on which it deposits its instrument of ratification of, or accession to, this Protocol.

(3) (a) Any Contracting State may denounce this Protocol by notification addressed to the Government of the Republic of Zimbabwe.

(b) Denunciation shall take effect 6 months after receipt of the said notification by the Government of the Republic of Zimbabwe. It shall not affect any patent application or application for the registration of an industrial design or of a utility model filed with the Office prior to the expiration of the said six-month period or any patent granted or registration of an industrial design or utility model effected upon such application.

(4) (a) This Protocol shall be signed in a single copy and shall be deposited with the Government of the Republic of Zimbabwe.

(b) The Government of the Republic of Zimbabwe shall transmit certified copies of this Protocol to the Contracting States, other States members of the African Regional Intellectual Property Organization and the States to which membership of the Organization is open in accordance with Article IV(1) of the Agreement on the Creation of the African Regional Intellectual Property Organization, the World Intellectual Property Organization and the United Nations Economic Commission for Africa.

(c) This Protocol may be amended at the instance of any Contracting State or by the Director General during the sessions of the Administrative Council of ARIPO.

(d) Adoption of amendments of any provision of this Protocol shall

require two-thirds of the votes of all Contracting States.