



# AFRICA IP FORUM 2013

Intellectual Property and Economic Growth and  
Development in Africa

Track 1:

*Benefits of Substantive Examination of Patents  
versus the Depository System*

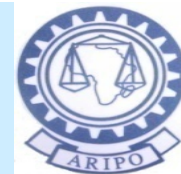
*Johannesburg, South Africa,  
February 26-28, 2013*

*C.J.Kiige, Director Industrial Property*



# Presentation overview

- ARIPO Background;
- Execution of Patent applications at ARIPO;
- Comparison Substantive Examination of Patents versus the depository system;
- Discussions & Conclusion



# Member States of ARIPO

**The Gambia (LDC)**

**Sierra Leone (LDC)**

**Liberia (LDC)**

West Africa

**Ghana (D)**

Central &  
Southern Africa

**Sudan (LDC)**

**Somalia (LDC)**

**Kenya (D)**

East Africa

**Uganda (LDC)**

**Tanzania (LDC)**

**Rwanda (LDC)**

**Zambia (LDC/D) !**

**Malawi (LDC)**

**Namibia (D)**

**Zimbabwe (D)**

**Mozambique (LDC)**

**Botswana (D)**

**Swaziland (LDC)**

**Lesotho (LDC)**



**Pre-ARIPO, IP Systems in Member States**

**FORMATION OF ARIPO**

**•LUSAKA AGREEMENT (1976)**

**HARARE PROTOCOL (1982)**

**BANJUL PROTOCOL (1993)**

**Copyright & Related Right**

- PATENTS
- INDUSTRIAL DESIGNS
- UTILITY MODELS

**MARKS**

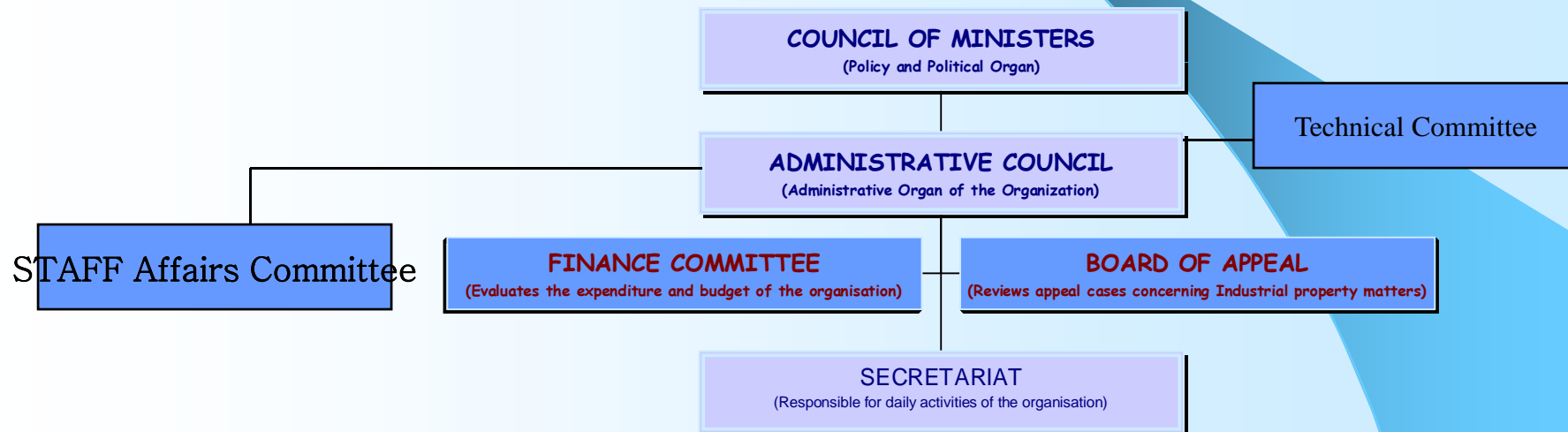
**Swakopmund Protocol (2010)**

**Traditional Knowledge & Expressions of Folklore**



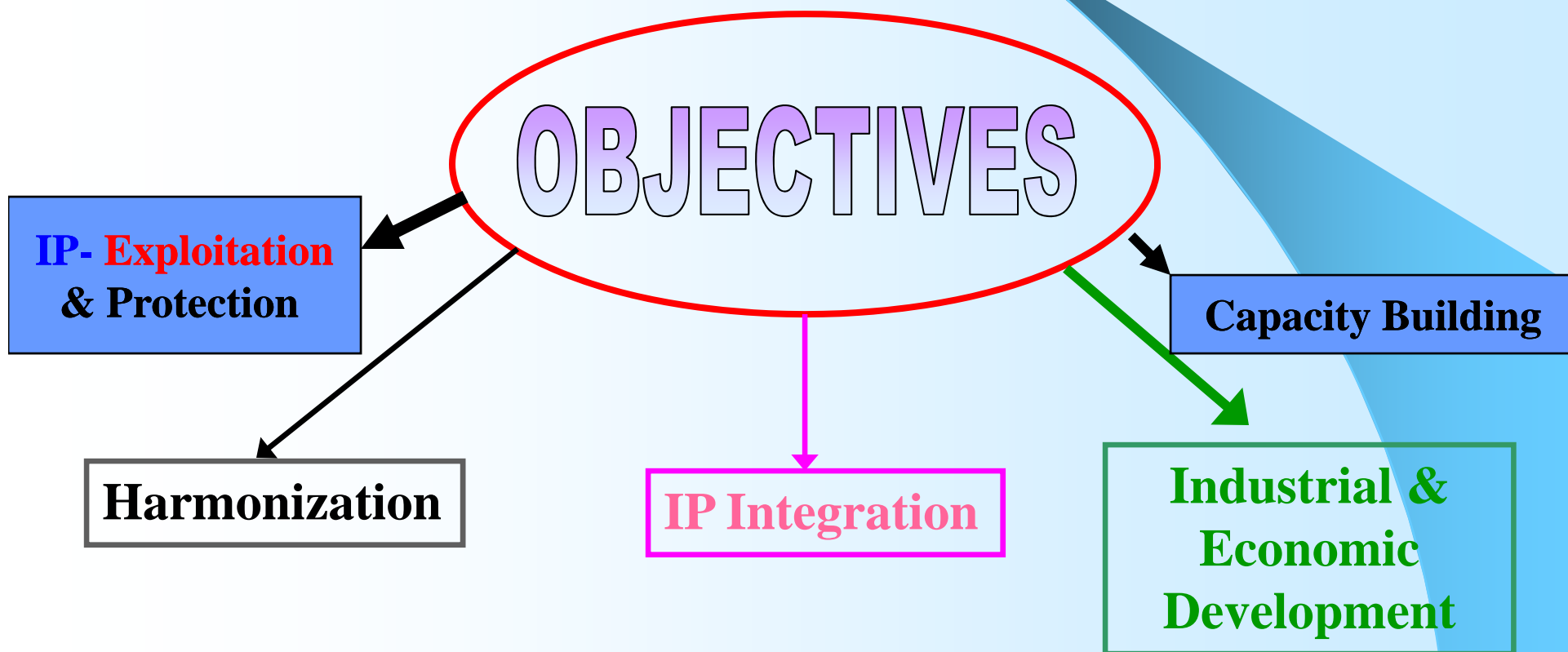
# GOVERNANCE OF ARIPO

## ORGANS OF ARIPO





# ARIPO Regional Strategy & Policy





# The Harare Protocol

- Empowers ARIPO to grant Patents & Register Utility Models and Industrial Designs on behalf of member states.
- All member states of ARIPO (except Somalia) are party to the Harare Protocol and to the Patent Cooperation Treaty (PCT).

# Patentability Requirements at ARIPO



- Novelty;
- Inventivity;
- Industrial applicability;
- Full disclosure;
- Unity of Invention;
- **Morality?**
- **Technical features?**



# Execution of Patent Applications at ARIPO



- Examination as to form;
  - *Member States have access to the status of applications at all times*
- Substantive Search & Examination;
  - **Member States are advised on intention to Grant;**
  - **Member States/public must oppose grant within 6 months;**
  - **Member States have final responsibility for granting and ARIPO is responsible for the quality of the patents;**
  - **If no Opposition from public or member state, application is granted;**
- A granted Patent becomes a bundle of national patents;
  - **Centrally managed/ renewed at ARIPO;**
  - **Opposition could be filed at national Office or at ARIPO:**



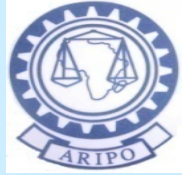
## Patent prosecution – different options:

- Depository System;
- **Full substantive examination;** (Procedures for ARIPO);
- Rely on results of other IPOs (for PCT, other priorities):  
requires identical claims ), Sometimes used at  
ARIPO
- **Outsourcing full patent Substantive Examination  
prosecution** Some member States use this option  
(e.g. Botswana, Lesotho, etc.) .



# Execution of National Patent Applications by some Member States

- ARIPO Member States Which undertake Substantive Examination include:
  - Botswana-Examination undertaken by ARIPO;
  - Ghana-Examination undertaken by ARIPO;
  - Gambia- Examination undertaken by ARIPO;
  - Kenya- Examination undertaken by KIPI;
  - Lesotho-Examination undertaken by ARIPO;
  - Uganda- Examination undertaken by ARIPO;



# Execution of National Patent Applications by Member States

- ARIPO Member States Which use the **Depository System** of national applications include:
  - Liberia
  - Malawi,
  - Mozambique
  - Namibia;
  - Rwanda;
  - Sierra Leone;
  - Sudan;
  - Swaziland;
  - Tanzania;
  - Zambia and Zimbabwe;



## Ideas/options for beginning Substantive Examination Procedures

- Cooperation with other Organizations/ Patent offices;
- Sharing search tools, Procedures/databases developed by other offices;
- Including local databases & Traditional Knowledge as search tools;
- Establishing a platform for exchange of best practices;
- Setting pre and pro grant opposition procedures;
- Local & Foreign training in patent application processing & substantive Examination;



## Advantages of Substantive Examination of Patent Applications

- Very Strong valid Inventions;
- Valid IP rights are licensed;
- Avoid expensive future litigations;
- Prior art in search reports can be used for reverse Engineering, Patent Information & IP Exploitation;
- Well established & expensive IP Litigations can be avoided;
- Governments & Industry can avoid paying Royalties for invalid patents;
- Protection of the Public & local Industry, etc.



## Disadvantages of Patent Depository System

- Novelty & inventive step not considered until Litigation;
- Small inventors can easily be suppressed by big inventors/ applicants;
- The Country must have IP Tribunals/Courts with very experienced IP Judges;
- Patent agents examine on behalf of the state and control what is patentable in the country;
- Counterfeits are could be encouraged;
- Royalties are paid for non existent inventions,
- Local Industry & public exposed to IP Abuse, etc.



## Challenges in African Countries

- Lack of Political will and Public Awareness;
- Outdated National IP laws in some states;
- Lack of Relevant National IP Strategies/Policies;
- Lack of Relevant Institutional IP Strategies/policies in most institutions including universities in the region;
- Limited number of Schools with IP in their curricular, in the region;
- Lack of adequate market & qualified personnel for IP Services;
- Limited resources for capacity building in IP, etc.





# How to contact ARIPO

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**THANK YOU**