



The African Regional Intellectual Property Office (“ARIPO”), in Harare, Zimbabwe has tabled various important changes on Trademarks, Patents & Industrial Designs in terms of procedure/process and substance. Whilst we await finalisation it is important for stakeholders to acquaint themselves with these updates as they may have financial and documentary implications. We have briefly captured some of the developments as follows:

## 1. PATENTS (the Harare Protocol)

### *Patent applications*

Third party observations- The proposal, contained in Section 2, is to allow for third party observations to ARIPO patent and Utility Model applications. The observer will not become a party to the proceedings.

### *Request for grant*

Section 3 (1) is to be amended by specifically requiring the application to contain ‘a request for the grant of an ARIPO patent’ rather than simply ‘identify the patent’

### *Converting to a national*

A Section 3(6)(b) is to be added. This will state that ‘if the designated State refuses the application, the application may, within three months from being notified of such refusal, request that his application be treated, in the designated State, as an application according to the national law of that State.’

## 2. UTILITY MODELS

### *Novelty and industrial applicability*

Section 3, which provides that a utility



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model must be new and industrially applicable, is to be amended by providing that ‘a utility model shall be considered to be new if it is not anticipated by the prior art within the jurisdiction of the Contracting States of the Protocol.’ As for industrial applicability, this will be present ‘if it can be made or utilized in any kind of industry including agriculture.’

## 3. INDUSTRIAL DESIGNS

### **Duration**

Section 6 is to be amended to provide that the duration shall be 15 years (previously 10) from the filing date, ‘except for designated States with a shorter term of protection’, where the term ‘will expire at end of term of protection provided for under their respective national design laws.’

## Regulations under the Harare Protocol (patents)

### *Additional Fees*

Rule 11 bis is to be amended by making it clear that the additional fee payable for an ARIPO patent application will be '*calculated on the basis of the pages of the description, claims, any drawings and abstract.*' It further says that '*if an amendment filed after payment of additional fees introduces more claims and pages than those paid for, fees shall be payable on/for the extra claims and pages.*'

### *Time Limits*

Rule 15(bis), which sets out the time limit for the applicant to request the Office to reconsider a matter, shall be '*not less than two months and not more than six months*' after the date of notification of the decision of the Office that the application has been refused.

### *Extensions*

Perhaps due to the Covid-19 pandemic, Rule 15 - which deals with extensions of time limits- is to be amended to make provision for extensions due to '*an exceptional occurrence such as a pandemic, a natural disaster, war, civil disorder or a general breakdown in any means of electronic communication.*'

### *Examination as to substance*

Rule 18 will be amended to regulate, inter alia: how an applicant can respond to examination through comments, corrections or amendments etc; how an applicant must identify amendments and indicate the basis for them.

### *Observations*

A Rule 19 will be introduced. This will provide that, following publication of an ARIPO patent application, any person will be entitled to present observations concerning the patentability of the invention. Further points include:

- The observations can be considered if they relate to novelty, inventive step, claims clarity, sufficiency of disclosure, patentability of subject matter and allowable amendments.
- The observations must be in English, although supporting evidence may be in another language.
- The person filing the observations does not become a party to the proceedings.
- The observations should preferably be electronic.
- If the observations relate to patentability of the invention the Office must consider them in any proceedings that are pending before the Office.
- Where observations are filed during the international phase, ARIPO as the designated Office will consider them upon entry into the Regional phase.

### *International applications*

Rule 23 will be amended to provide that where a Contracting State which is bound by the PCT is designated the applicant has a period of 31 months from the filing date of the application or priority date to do various things, such as furnish an English translation of the international application and pay the fees.

## 4. TRADEMARKS (the Banjul Protocol)

### *Publication of refusals*

Section 6 bis will be amended to include a 6bis.1(B) reading: *An application for registration of mark which has been refused by the office... or by a designated state...shall be published in the Marks Journal as having been refused.*

### *Restoration*

Section 7 currently allows for the restoration of a trademark registration that had been removed due to non-payment of renewal fees. The proposed amendment was to remove this wording from Section 7, and introduce Section 7bis to amplify on the restoration provisions and also allow for the restoration of any lapsed applications due to failure on the applicant's part to comply with any formalities. Comments on the proposed amendments have been provided, and these are now under review.

### *Classification*

Rule 3 will provide that the surcharge for all words over 50 in a specification must be paid at the time of filing. The amendment simply provides clarity on the timing of the payment.

### *Cancellation of designated states*

Rule 13 will provide that an applicant will be entitled to cancel the number of designated states at any time, subject to the payment of a fee. The proposed changes relate only to the fee and prescribed forms.

## New Banjul Protocol Membership: Mozambique



Mozambique deposited its Instrument of Accession to the Banjul Protocol on **15 May 2020**, and the provisions of the Banjul Protocol will enter into force in Mozambique on **15 August 2020**.

This means that applicants will be able to designate Mozambique under ARIPO for trademark filings. This brings the total of countries under Banjul to eleven (11): **Botswana, Malawi, Tanzania, Lesotho, Namibia, Uganda, Liberia, Swaziland, Zimbabwe, Sao Tome & Principe and Mozambique.**



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