IN THE BOARD OF APPEAL OF THE AFRICAN REGIONAL INTELLECTUAL PROPERTY ORGANIZATION

IN THE MATTER OF APPEAL AGAINST THE DECISION OF THE OFFICE IN REFUSING THE REQUEST FOR RESTORATION OF PATENT APPLICATION NUMBER AP/P/2018/011005

BETWEEN

ARI KAHN, THE APPELLANT

VERSUS

THE AFRICAN REGIONAL INTELLECTUAL PROPERTY ORGANIZATION (ARIPO), THE RESPONDENT

Counsel for the Appellant: Sophia Smallbones, Ramon Pereira, Amalia Vilanculos, Nicky Garnett, and Ntabi Phaswana

Representing the Respondent: Director, Intellectual Property

RULING
Dated: 15 May 2025

FACTUAL BACKGROUND

1. The Board of Appeal received two applications from the appellants as follows:

i. Notice of appeal to the Board of Appeal against a decision of the ARIPO Office; and
ii. Application for an extension of time to file an appeal. The application for extension of time to appeal was filed out of an abundance of caution, where the Board decides that the Notice of Appeal was filed out of time.

2. The background facts on the circumstances leading to this appeal are largely common cause and are not contested. In their letter dated 18 March 2021, the Appellant notified the Respondent of their appeal against the refusal to extend the time to apply for restoration, dated 21 December 2020. Thereafter, on 20 April 2023, the Respondent was officially served with an appeal filed by Adams & Adams in respect of Patent application number AP/P/2018/011005.

3. The Appellant filed the ARIPO Patent Application No. AP/P/2018/011005 on 17 September 2018, claiming priority on PCT international application no. PCT/IB2017/000277, which was filed on **15 February 2017**. The Appellant engaged the services of Helios IP, which in turn instructed RWS, which subsequently instructed Spoor and Fisher Jersey. Fisher, Cormack, and Botha, an associate firm of Spoor and Fisher Jersey, eventually filed the said application.

4. On the same day (i.e. 17 September 2018), as per page 2 of Exhibit C, RWS reported to Helios IP that the application had been filed and requested Helios IP to "direct future correspondence to the agent (Spoor and Fisher Jersey) for all post-filing matters."

5. However, according to page 2 of Exhibit C, on the same day, **17 September 2018**, Spoor and Fisher Jersey emailed Helios IP advising that "*we do have a conflict in this matter, and we will be unable to assist you with the further prosecution of the application. We request that you now entrust this matter to another agent operating in the ARIPO region, and we will be happy to provide a potential recommendation if required*."

6. On **26 November 2018**, Spoor and Fisher Jersey followed up with an email sharing the official filing receipt and advising Helios IP that the 'file is now closed.'

7. The first annuity fee due on 15 February 2018 was paid timely on filing the ARIPO patent application. However, the next annuity fee, which fell due for payment on **15**

February 2019, was neither paid by the due date nor within the six-month grace period allowed for late payment of annuity fees, which ended on **15 August 2019**.

8. On February 4, 2020, the Respondent served notice to the record agent, Fisher, Cormack and Botha, regarding the lapsed application due to non-payment of the annuity (Exhibit D). However, the Appellant claims this was never brought to their attention.

9. Under Rule 24 of the Regulations for implementing the Harare Protocol on Patents and Industrial Designs, the Applicant had one year, until 15 August 2020, to request the re-establishment of rights for maintaining the application.

10. The Appellant alleges that on **11th August 2020**, Helios IP contacted Adams & Adams to take up the case. Adams & Adams confirmed on 13 August 2020 that they would be able to represent the Appellant. Subsequently, on 19 August 2020, Helios IP provided Adams & Adams with the Power of Attorney.

11. The Appellant submitted that on **2 September 2020**, Adams and Adams filed a request at ARIPO to be recorded as agents on record, and on **16 November 2020**, the Respondent issued the letter that they had sent to Fisher, Cormack and Botha on the lapsed application to Adams & Adams.

12. **On 8 December 2020**, the Appellant filed a request for an ***extension of time within which to apply for restoration of the patent application***. The Respondent refused this request in a letter dated ***21 December 2020*** (Exhibit B); the Appellant subsequently notified the Respondent on ***18 March 2021*** of its appeal against the refusal.

13. On February 12, 2021, the Appellant submitted a letter to the Respondent requesting a stay of the request for examination pending the determination of the appeal against the refusal of an extension of time within which to apply for the restoration of the patent application. (Exhibit F and an Affidavit deposed to by Ralph G. Schroeder, an Attorney at Helios IP).

14. On April 20, 2023, the Appellant filed an application for a delay extension to appeal, arguing they were unaware of the rules of procedure of the ARIPO Board of Appeal.

15. Another important issue is the Appellant's failure to request a substantive examination of the patent application. The Harare Protocol allows an applicant to request examination of the patent application within 3 years from the filing date, which is February 15, 2017, making the deadline February 15, 2020. Under the provisions for delayed examination, an additional period of up to 1 year is allowed, extending the deadline to February 15, 2021.

16. The Appellant argued that the deadline of 15 February 2021 may have likely passed by the time the appeal against the refusal to extend the period to request restoration was heard by the Board of Appeal.

THE APPELLANT'S CASE

17. Before the Board of Appeal on October 9, 2024, the Appellant, represented by Adams & Adams, earnestly urged the Board to show leniency and allow the appeal based on: (1) lack of awareness of the applicable obligations to pay annuities and meet deadlines as outlined under the Harare Protocol; (2) absence of records or information regarding communications from ARIPO that were sent to the designated agent; and (3) the difficulties caused by the global business disruption due to COVID-19 from late 2020 through 2022, which, in their view, hindered the Appellant's ability to timely take necessary steps to maintain the application at ARIPO as required by the Harare Protocol. To support their case, the Appellant aimed to highlight the chronological events leading to this appeal, as summarized above.

18. In brief, the Appellant initially engaged the services of Helios IP. Helios IP instructed RWS, which in turn instructed Spoor and Fisher Jersey. Fisher, Cormack, and Botha, an associate firm of Spoor and Fisher Jersey, filed the ARIPO application. On the day the ARIPO regional application was filed, RWS reported to Helios IP that the application had been filed and that any further correspondence concerning the prosecution of the ARIPO application would be reported directly to them by Spoor and Fisher Jersey. Later that day, Spoor and Fisher Jersey reported to Helios IP that they had a conflict of interest in prosecuting the patent application and would not be able to assist the applicant further. A couple of weeks later, they furnished Helios IP with a copy of the filing receipt.

19. Advancing further his argument, the Appellant, without citing any supporting authority imposing obligation to ARIPO to advise agents, argued before the Board of Appeal that Helios IP was not informed that an ARIPO application required renewals (annuities) to be paid during its pendency, the expected due dates, a request for examination, and the due date thereof. Helios IP, therefore, understood that the application was in good standing.

20. Furthermore, in what appears to be an attempt to distance himself from the actions of his representative/agent, Counsel for the Appellant earnestly argued that the Appellant, Mr. Ari Kahn, is not an IP specialist in any regard. He entirely relied on his IP agents to advise him of all requirements and deadlines concerning his IP applications. The final date on which the renewal fee was due was 15 August 2019; however, Rule 24 of the Harare Protocol allowed the applicant until 15 August 2020 to apply for reinstatement of the patent application. The Appellant argued that this period was shortly before the eruption of the COVID-19 pandemic, which caused significant business disruptions globally.

21. The Appellant further contended that Helios IP conducted a portfolio review and approached Adams & Adams to become agents on record for this application. After obtaining the requisite signed power of attorney, on 2 September 2020, Adams and Adams requested that it be recorded as the agent of the applicant.

<u>THE RESPONDENT'S SUBMISSION</u>

22. The Respondent submitted that the refusal to grant the extension of time to apply for restoration of the application is due to the Appellant's non-compliance with Section 5bis (4) of the Harare Protocol. The Respondent argued that the appeal against the refusal of an extension of time to apply for restoration should be dismissed. The Respondent contended that the Appellant was advised by the filing agent on 17 September 2018, the same day of filing, that they could no longer represent them. Still, they chose to appoint a new agent 24 months later, on 2 September 2020. Additionally, the Respondent argued that the Appellant failed to request a substantive examination in its letter of 8 December 2020.

23. The Respondent submitted that Rule 15*ter* cited by the Appellant does not apply under Section 5bis (4). The Respondent further argued that the Appellant's cause of action is

against the patent agent (Spoor and Fisher Jersey), who had the duty to advise on deadlines. The Respondent submitted that the appeal be dismissed and that its decision, refusing an extension of time to apply for restoration of the patent application, be upheld by the Board of Appeal.

ISSUES FOR DETERMINATION BY THE BOARD

24. Based on the notice of appeal, the Respondent's reply, and the oral submission of the parties, the Board is of the view that to properly determine the appeal, the pertinent issues for consideration are:

    (1) What is the law regarding the extension of time for the restoration of the application under the Harare Protocol?
    (2) Whether there are justifying circumstances for the extension of time in the present case?
    (3) Collateral to the argument by the Appellant regarding his agents, what are the roles of representatives or agents in intellectual property filings at ARIPO?

25. As a preliminary note, the Board would like to highlight three guiding benchmarks: (1) the prescribed rules under various legal instruments of ARIPO must be earnestly followed to ensure institutional credibility, consistency, and predictability; (2) when applying these rules, appropriate consideration should be given to ARIPO's overall objectives of promoting creativity and innovation, so that the interpretation and application of rules support, rather than hinder, the establishment's goals; and (3) it is the responsibility of the applicants, appellants, or their agents to process their applications diligently and, in cases like the present, to convincingly demonstrate to the Board the existence of extenuating circumstances justifying a time extension.

26. Having set the guiding benchmarks, we now embark on addressing the issue: What is the law regarding the extension of time for the restoration of the application under the Harare Protocol? A highlight of few applicable provisions of the Harare Protocol is pertinent in this regard:

    (a) The mandate of the African Regional Intellectual Property Organization (ARIPO) to grant and administer patents on behalf of Contracting States is derived from Section 1 of the Harare Protocol.

(b) According to Section 2 (1), applications for the grant of patents or the registration of utility models and industrial designs by the Office can be filed by the applicant or his/her authorized representative/agents. In the case of the latter, a duly filled and signed Power of Attorney in the prescribed form, along with payment of fees, must be submitted to ARIPO.

(c) According to Rule 18 of the Regulations for Implementing the Harare Protocol, once the application meets the formal requirements, the applicant may request a substantive examination of the patent application within three years from the filing date, provided the application has not lapsed due to non-payment of annual maintenance fees and the required fees are fully paid. If no request is made within the specified period, the application will be considered lapsed.

(d) Rule 21 provides that annual maintenance fees become due on the anniversary of the date of filing the application and must be paid in advance to the Office. There is a grace period of 6 months for payment of annuities, failure of which the application will be deemed as withdrawn or the policy will be considered as lapsed.

(e) The request for the extension of time to apply for restoration of the application submitted by the Appellant to the Respondent is provided under Section 15ter (1) of the Harare Protocol on Patents and Industrial Designs (2023 Edition) as follows:

> *The Director General may extend a time limit if:-*
> *(i) the applicant or the proprietor of the patent requests him to do so; and*
> *(ii) the request complies with the relevant requirements of rules.*

27. This means that an applicant may request the Director General to extend a time limit, provided that such a request complies with the relevant rule.

28. The Respondent's refusal is stated under Section 5*bis*(4) of the Harare Protocol (2023 Edition), which states that *"re-establishment of rights shall be ruled out in respect of the time limit for requesting re-establishment of rights"*.

29. The Harare Protocol has, therefore, expressly ruled out extending the time limit for requesting the re-establishment of rights.

30. It is provided in Rule 18(1) (a) that "*For the purposes of the request under Section 3(3) of the Protocol, the applicant may request examination of the patent application up to 3 years from the date of filing*."

    (c) The request shall be deemed to have been filed when the request for the examination fee has been lodged. Where no request is made, within the prescribed period, the application shall lapse.

31. Rule 24 on request for re-establishment of rights provides as follows:

(1) Any request for re-establishment of rights under Section 5bis, paragraph 1, shall be filed in writing within 2 months of the removal of the cause of non-compliance with the period, but at the latest within one year of the expiry of the unobserved time limit. However, a request for re-establishment of rights in respect of any of the periods specified in Section 2(8) shall be filed within 2 months of the expiry of that period. The request for re-establishment of rights shall not be deemed to have been filed until the prescribed fee has been paid.

(2) The request shall state the grounds on which it is based and shall set out the facts on which it relies. The omitted act shall be completed within the relevant period for filing the request according to paragraph 1.

(3) The request shall only be deemed filed upon payment of the restoration fee.

32. Further, rule 18(7)(b) on delayed commencement of substantive examination provides for up to 1 year beyond the stipulations of Rule 18(1)(a), provided:

    (i) a request for substantive examination has been lodged by the stipulated time in Rule 18(1)(a);
    (ii) a written explanation satisfactory to the Director General has been submitted with the request;
    (iii) the application does not lapse due to non-payment of annuities.

APPLICATION OF THE LAW TO THE FACTS

33. The timelines appear to be undisputed, based on the file and documents on record, as well as the arguments presented by counsel for both parties.

34. The Appellant admits that his ARIPO Patent Application No. AP/P/2018/011005 was filed on September 17, 2018, claiming priority from PCT international application no. PCT/IB2017/000277, which was filed on February 15, 2017.

35. Under the Harare Protocol, an applicant is required to pay annual maintenance fees on each anniversary of the application's filing, failing which the application shall be deemed withdrawn**.**

36. The 1st anniversary fee, which was due for payment on 15 February 2018, was paid timeously on filing the ARIPO patent application. However, the 2nd Anniversary fees, which fell due on 15 February 2019, were not paid by the due date nor within the six-month grace period allowed for late payment of renewal fees, which ended on 15 August 2020. This resulted in the application lapsing on **15 August 2019.**

37. The Appellant thereafter had one year to request the re-establishment of rights, which ended on **17 August 2020**.

38. The Board of Appeal, after reviewing the record of appeal and hearing the parties' arguments, finds that the Appellant was properly represented by capable agents who are likely knowledgeable about the rules under the Harare Protocol on Patents and Industrial Designs.

39. The Board of Appeal agrees that the Appellant is not an IP specialist, which is why he relied entirely on his IP agents to advise him on the requirements and deadlines for the application.

40. The Board of Appeal noted that on 17 September 2018, soon after the filing, the filing agent notified Helios IP that it could no longer represent the Appellant. However, Helios IP chose to appoint a new agent 24 months later, on 2 September 2020. Had the appellant been vigilant in following up on the application with Helios IP, the agent he contracted, this long period of inaction might have been avoided.

41. The Board believes that the Respondent's denial of the extension request for re-establishing rights was within the scope of the Harare Protocol, which authorizes the Office to grant patents. The Board emphasizes the Respondent's legal responsibilities to follow the established deadlines. This is crucial for ensuring that users of the

Respondent’s system comply with the rules under the Harare Protocol to enhance the efficiency of the ARIPO system.

42. During the hearing, counsel for the Appellant admitted that when they filed to be recorded as agents for the Appellant, the deadlines set by the Harare Protocol had already passed, and the application had expired. However, the Board noted the Appellant's persistence in pursuing this matter since March 2021 and the fact that the Respondent only responded to the Notice of Appeal in 2023.

43. Regarding the issue of whether there are justifying circumstances for the extension of time in this case, although Section 5bis(4) of the Harare Protocol (2023 Edition) explicitly and clearly prohibits extending the time limit for requesting re-establishment of rights, the Board refers to its second guiding benchmarks; that is, in applying the prescribed rules, whenever appropriate, regard must be given to the overall ultimate objectives of ARIPO in promoting creativity and innovation. Thus, the interpretation and application of rules should facilitate rather than hinder the set objective for establishing ARIPO.

44. In this regard, the Board refers to Rule 15ter on Extension of Time Limits, which provides as follows:

(1) The Director General may extend a time limit if:-

(a) the applicant or the proprietor of the patent requests him to do so;

(b) the request complies with the relevant requirements of rules; or

(c) 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.

(2) Where more than one request of extension of time limit is or are requested in one request, each request shall be subject to the payment of the prescribed fee.

(3) An extension of time limit shall not exceed 3 months.

45. The Board finds Rule 15ter very instructive in this case, as it clarifies the circumstances that generally justify the extension of time. One of the grounds for an extension is “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.

46. The Board takes judicial notice of the impact of the COVID-19 pandemic, which disrupted economies and businesses worldwide. The Appellant, in his submissions and

arguments, referred to COVID-19 disruptions affecting businesses, which contributed to the Appellant's inability to pursue the patent application. After considering the submissions of both the Appellant and the Respondent, and having taken judicial notice of the extraordinary challenges posed by the COVID-19 pandemic, the Board finds merit in the argument that the disruptions caused by this global crisis constitute exceptional circumstances under Rule 15ter. The Appellant's inability to pursue the patent application within the prescribed time limit results from circumstances beyond their reasonable control.

47. The Board notes that Rule 15ter provides clear justification for time extensions during exceptional events, and the COVID-19 pandemic clearly qualifies. The Appellant has adequately shown the pandemic's negative effect on their ability to meet procedural requirements, thus qualifying for the requested relief.

48. On the issue of the roles of representatives or agents in intellectual property filings at ARIPO, the Board makes reference to Section 2(4) of the Harare Protocol (2023 Edition), which states as follows:

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.

49. This means that applicants who do not have their usual residence or main place of business in a Contracting State must be represented by an agent, who can be an attorney or legal practitioner authorized to represent applicants before the industrial property office of a Contracting State. Having an agent who can act on behalf of the applicant before the industrial property office is essential to ensure that applicants can defend their IP rights before the national IP office or a court with proper jurisdiction. Agents provide law-related services aimed at securing patent protection for applicants,

making the relationship between agents and applicants similar to that of a lawyer and client.

50. The lawyer-client relationship is one of the most essential aspects of legal practice across all legal systems, whether they are common law or civil law jurisdictions. A key principle of this relationship is that lawyers must always act in their clients' best interests as part of their fiduciary duty. This includes the duty of utmost care and the duty of disclosure.

51. In this case, on 17 September 2018, the ARIPO regional application was filed by Fisher, Cormack, and Botha, an associate firm of Spoor and Fisher Jersey, having been instructed to act by RWS, who was also instructed by Helios IP. Later that day, Spoor and Fisher Jersey reported to Helios IP that they had a conflict of interest in prosecuting the patent application and would not be able to further assist the applicant. On **26 November 2018,** Spoor and Fisher furnished Helios IP with a copy of the filing receipt, advising Helios IP that the 'file is now closed.' The first annuity fee, due on 15 February 2018**,** was paid upon filing the ARIPO patent application. However, the next annuity fee was not paid by the due date, nor within the six-month grace period allowed for late payment of annuity fees. On 4 February 2020, the Respondent served notice on the agent on record, Fisher, Cormack, and Botha, regarding the lapsed application due to non-payment of the annuity. The Appellant claims that this notice was never brought to his attention.

52. The Board finds as a fact that the agent, Spoor and Fisher, when he advised Helios IP that the "file is now closed," means that he had handed over the file to Helios IP. Ralph G Schroeder, an attorney at Helios IP, deposed in the Affidavit in support of the Notice Appeal that Helios IP relies on its county agents to provide information on due dates. It was also strongly argued by Counsel for the Appellant that because Helios IP was not informed by Spoor and Fisher of any due date or future filings, they failed to notify the Appellant of the need to seek new representation before the lapse of the application. In August 2020, the Client advised Helios IP to hire an agent to resume prosecution of the ARIPO application.

53. An agent has the duty of utmost care to disclose all matters to properly advise the client on the status of an application, especially regarding due dates. This aligns with the intent of Section 2(4) of the Harare Protocol (2023 Edition), which explicitly states that applicants who do not have their ordinary residence or principal place of business in a

Contracting State must be represented by an agent. This agent may be an attorney or legal practitioner authorized to represent applicants before the industrial property office of a Contracting State. The purpose is clearly to ensure that foreign applicants receive proper legal advice to increase the chances of their applications being successful.

54. The Board of Appeal believes this case should be an exception to the rule that principals are liable for their agents' shortcomings, to ensure fairness for principals and clients. Agents need to be held responsible for their professional duties; if not, principals or clients should not be liable for those failures.

DISPOSITION

55. The Board is mindful of and recognizes the Respondent's objective under the Harare Protocol, which is to promote and encourage applications for and grants of patents, and registration of utility models and industrial designs using the ARIPO system. The Board of Appeal is therefore of the considered view that the Appellant be given another opportunity for re-establishment of the lapsed application. The peculiar circumstances in which the Appellant found himself are rather unfortunate. The key legal issue is the extent to which the lapses of IP agents should be impugned against patent applicants, such as in this case. Overall, the justice of this case, as well as the need to promote IP, demands that the Appellant be given another opportunity to prosecute the patent application.

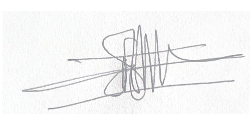
56. The Appellant's appeal hereby succeeds. The Board of Appeal grants the request for the extension of the time for re-establishment of the rights of the Appellant. The Appellant is given three (3) months from the release of this judgment within which to submit the request for an extension of the time limit to apply for the re-establishment of the lapsed rights.

Chairperson, Board of Appeal
(Dr. Gift Manyatera)

Member, Board of Appeal
(Ms. Jamus Bannah)

Member, Board of Appeal
(Prof. Saudin J. Mwakaje)

Member, Board of Appeal
(Ms. Purnima Maudhoo)



Member, Board of Appeal
(Mr. Ibrahim Sam Johnson)

Adams & Adams, Appellant's Legal Practitioners