

LAWS OF MALAWI

**PATENTS
CHAPTER 49:02**

<u>PAGE</u>	CURRENT PAGES	<u>L.R.O.</u>
1 – 4		1/1986
5 – 10		1/1968
11 – 12		1/1986
13 – 64		1/1968
65 – 68		1/1970
69 - 86		1/1968
87 – 88		1/1970
89 – 90		1/1993
91 – 108		1/1968
109 – 112		1/1993
112a		1/1993
113 – 114		1/1968
115 – 150		1993
151 – 152		1/1968

**CHAPTER 49:02
PATENTS
ARRANGEMENT OF SECTIONS**

PRELIMINARY

SECTION

1. Short title
2. Interpretation

**PART I
ADMINISTRATION**

3. Establishment of Patent Office
4. Appointment of officers
5. Seal
6. Register of Patents

**PART II
INTERNATIONAL PROVISIONS**

7. Convention arrangements
8. Convention applications
9. Special provisions as to vessels, aircraft and land vehicles
10. Protection of inventions communicated under international agreements
- 10a Patents granted under the Protocol

**PART III
APPLICATIONS GENERALLY**

11. Persons entitled to make application
12. Form of application
13. Complete and provisional specifications
14. Contents of specification
15. Effective date of claims of complete specification
16. Examination of applications and specifications
17. Ante-dating and post-dating of applications
18. Refusal of application in certain cases
19. Powers of Registrar if specification or application defective
20. Lapsing of applications
21. Acceptance and publication of complete specification
22. Opposition to grant of patent
23. Substitution of applicants
24. Provisions for secrecy of certain inventions

**CHAPTER 49:02
PATENTS
ARRANGEMENT OF SECTIONS**

PRELIMINARY

SECTION

**PART IV
GRANT, EFFECT AND TERM OF PATENT**

25. Grant and sealing of patent
26. Amendment of patent granted to deceased applicant
27. Date of patent
28. Extent, effect and form of patent
29. Term of patent
30. Extension of patent
31. Patents of addition
32. Renewal of patents
33. Restoration of lapsed patents
34. Protective provisions to be inserted in order for restoration of patent
35. Endorsement of patent "licences of right"
36. Cancellation of endorsement made under section 35
37. Compulsory licence in case of abuse of insufficient use of patent right
38. Inventions relating to food or certain other commodities
39. Supplementary provisions as to licences
40. Use of patented inventions for services of the Government
41. Special provisions as to Government use during emergency
42. Reference of disputes as to Government use.

**PART V
SPECIAL PROVISIONS RELATING TO SPECIFICATIONS, ANTICIPATION AND RIGHTS
IN INVENTIONS**

43. Amendment of specification by Registrar
44. Amendment of specification with leave of Court or Patents Tribunal
45. Restrictions on recovery of damages in certain cases
46. Savings for anticipation
47. Co-ownership of patents
48. Disputes as to inventions made by employees
49. Avoidance of certain restrictive conditions in contracts
50. Revocation of patents
51. Consequences of revocation on grounds of fraud
52. Surrender of patents

**CHAPTER 49:02
PATENTS
ARRANGEMENT OF SECTIONS**

PRELIMINARY

SECTION

**PART VI
INFRINGEMENT**

- 53. Procedure and conditions in action for infringement
- 54. Relief for infringement of partially valid specification
- 55. Restrictions on recovery of damages for infringement
- 56. Remedy for groundless threats of infringement proceedings
- 57. Power of Court to make declaration as to non-infringement

**PART VII
ASSIGNMENTS AND CORRECTIONS**

- 58. Provisions as to assignments
- 59. Power of Registrar to authorize corrections
- 60. Rectification of register

**PART VIII
FUNCTIONS OF REGISTRAR IN RELATION TO CERTAIN EVIDENCE, DOCUMENTS
AND POWERS**

- 61. Evidence of certain entries and documents
- 62. Requests for information as to patent or patent application
- 63. Loss or destruction of patent
- 64. Exercise of discretionary powers of Registrar
- 65. Proceedings before Registrar
- 66. Advertisements to be approved by Registrar

**PART IX
PATENT AGENTS**

- 67. Patent agents and their functions
- 68. Qualification and registration of patent agents
- 69. Removal of names from register of patent agents
- 70. Privileges of legal practitioners
- 71. Entitlement to practise as patent agent
- 72. Prohibition of certain acts by patent agents

**CHAPTER 49:02
PATENTS
ARRANGEMENT OF SECTIONS**

PRELIMINARY

SECTION

**PART X
PATENTS TRIBUNAL AND APPEALS**

- 73. Appeals from Registrar
- 74. Patents Tribunal
- 75. General powers of Patents Tribunal
- 76. Right of audience
- 77. Costs and security for costs
- 78. Appeals to High Court
- 79. Assessors
- 80. Time for appeals
- 81. Rules
- 82. References to Patents Tribunal by Registrar

**PART XI
OFFENCES AND PENALTIES**

- 83. Falsification of certain documents
- 84. Deceiving or influencing the Registrar or an officer
- 85. Witness giving false evidence
- 86. Prohibition on trafficking in patents by officers in Patent Office
- 87. Unauthorized claim of patent right
- 88. Unauthorized use of certain words
- 89. Penalties

**PART XII
MISCELLANEOUS**

- 90. Lodging and authentication of documents
- 91. Oaths and affirmations
- 92. Expenses of administration
- 93. Provisions as to fees
- 94. Saving for certain forfeitures
- 95. Patent Journal
- 96. Power to make regulations

**PART XIII
APPLICATIONS**

- 97. Application of Act

LAWS OF MALAWI

Patents

Cap. 49:02

13 of 1957 (F)
12 of 1959 (F)
36 of 1960 (F)
1 of 1962 (F)
58 of 1965 (F)
9 of 1985 (F)
G.N.
5/1964/(M)
166/1967

An Act to make provision relating to Patents for Inventions and for other purposes incidental thereto

1ST APRIL 1958

1. This Act may be cited as the Patents Act.
2. (2) In this Act, unless inconsistent with the context –

Short title

Interpretation

“**applicant**” includes a person in whose favour a direction has been given under section 23, or his legal representative;

“**article**” includes any substance or material, and any equipment, machinery or apparatus, whether affixed to land or not;

“**assignee**” means-;

- (a) the person who has derived his title to the invention for Malawi directly or indirectly from the inventor thereof or from the latter’s assignee; or
- (b) the legal representative of such person;

“**Convention**” means the Union Convention of Paris, dated the 20th March, 1883, for the Protection of Industrial Property, revised at Brussels on the 14th December 1900, at Washington on the end June 1911, at The Hague on the 6th November 1925, and at London on the 2nd June 1934, and any revision thereof to which Malawi may accede in terms of section 7;

“**convention application**” means an application made by a person referred to in section 11(c).;

“**convention country**”, in relation to any provision of this Act, means a country (including any colony, protectorate or territory subject to the authority or under the suzerainty of that country, or any territory over which a mandate or trusteeship is exercised) which the Minister has, with a view to the fulfillment of the provisions of the Convention, by notice published in the Gazette declared to be a convention country;

“**Court**” means the High Court;

“**date of lodging**”, in relation to any document lodged under this Act, means the date on which the document is lodged or, where it is deemed by virtue of any provision of this Act to have been lodged on any different date, the date on which it is deemed to have been lodged;

“**effective date**” means, in relation to:-

- (a) an application which has been ante-dated or post-dated under this Act, the date to which that application has been so ante-dated or post-dated;
- (b) an application in a convention country, the date on which the application in respect of the relevant invention was made in the convention country in question or is in terms of the laws of that country deemed to have been so made;
- (c) any other application, the date on which that application was lodged at the Patent Office;

“**examiner**” means, an examiner appointed under section 4;

“**exclusive licence**” means, a licence from a patentee which confers on the licensee, or on the licensee and persons authorized by him, to the exclusion of all other persons (including the patentee), any right in respect of the patented invention, and “exclusive licensee” shall be construed accordingly;

“**former patents legislation**” means this Act as in force from time to time prior to the 1st January 1964;

“**Government department**” means a department of the Government;

“**invention**” means any new useful art (whether producing a physical effect or not), process, machine, manufacture or composition of matter which is not obvious, or any new and useful improvement thereof which is not obvious, capable of being used or applied in trade or industry and includes an alleged invention;

“**inventor**” means the person who actually devised the invention and includes the legal representative of an inventor, but does not include a person to whom an invention has been communicated either from within or outside Malawi;

“**legal representative**” means:-

- (a) the liquidator or receiver of a company;
- (b) the representative recognized by law of any person who has died, become insolvent or bankrupt, assigned his estate, is an infant or a minor, or of unsound mind, or is otherwise under a disability;

“**new**”, in relation to an invention, means, subject to section 8, 10 and 46, that, on or before the effective date of application for a patent in respect thereof, the invention was not:-

- (a) known or used anywhere in Malawi by anyone other than the applicant or his agent, or the person or persons from or through whom such applicant has derived his right or title (secret knowledge or secret user otherwise than on a commercial scale being excluded);
- (b) worked anywhere in Malawi otherwise than by way of reasonable technical trial or experiment by the applicant or any person or persons from or through whom such applicant has derived his right or title.
- (c) Described in a patent specification available to public inspection and bearing a date less than fifty years prior to such effective date;
- (d) Described in writing in any publication of which there was a copy anywhere in Malawi at the effective date of the application, or in a publication printed and published outside Malawi less than fifty years prior to such date;
- (e) Claimed in any complete specification for a patent which, through not available to public inspection at the effective date of the application, was deposited pursuant to an application for a patent which is, or will be, of prior date to the date of any patent which may be granted in respect of the said invention;

“**patent**” means letters patent for an invention granted for Malawi under section 25;

“**patentee**” means the person who is registered as such in terms of section 68(1).

“**patent of addition**” means a patent granted under section 31;

“**Patent Office**” means the Patent Office established under section 3;

“**patented article**” means any article in respect of which a patent has been granted and is for the time being in force;

“**Patents Tribunal**” means the Patents Tribunal established under section 74;

“**published**” means made available to the public and, without prejudice to the generality of the foregoing provision, a document shall be deemed, for the purposes of this Act, to be published if it can be inspected as of right by members of the public, whether upon payment of a fee or otherwise;

“**register**” means the register of patents kept at the Patent Office under section 6;

“**register of patent agents**” means the register of patent agents kept under section 68(1);

“**Registrar**” means the Registrar of Patents appointed under section 4;

LAWS OF MALAWI

“**specification**” means a provisional or a complete specification, as the circumstances may require, referred to in section 14;

2. A reference in this Act to the date of a patent shall be construed as a reference to the appropriate date specified in section 27(1).

**PART I
ADMINISTRATION**

3. There shall be established under the direction of the Minister an office to be called the Patent Office.

**Establishment of
Patent Office.**

4. The Minister shall appoint:-

**Appointment of
officers**

- (a) A Registrar of Patents who shall exercise the powers and perform the duties assigned to the Registrar by this Act and shall be responsible for its administration;
- (b) One or more Deputy Registrars of Patents who shall, subject to the control of the Registrar, have all the powers conferred by this Act upon the Registrar;
- (c) Such examiners and other officers as he may consider necessary for carrying out the Act.

5. There shall be a seal of the Patent Office, and impressions thereof shall be judicially noticed.

Seal

6. (1) There shall be kept at the Patent Office a register of patents, in which shall be entered:

Register of patents

- (a) particulars of patents in force, of assignments and transmissions of patents and of licences under patents; and
 - (b) notice of all matters which are required by or under this Act to be entered in the register and of such other matters affecting the validity or proprietorship of patents as the Registrar thinks fit.
- (2) All registers of patents established and kept under the former patents legislation in respect of patents originating in Malawi shall, under arrangements made by the Registrar and with the approval of the Minister, be incorporated with and form part of the register established under subsection (1), so, however, that such arrangements shall in no way be deemed to extend the term and effect of any patent registered un such registers beyond the term and effect provided in respect of such patent by the said legislation.

- (3) Subject to this Act, the register of patents shall, at all convenient times, be open to inspection by the public, and certified copies, sealed with the seal of the Patent Office, of any entry in the register shall be given to any person requiring them on payment of the prescribed fee.
- (4) The register of patents shall be *prima facie* evidence of any matters required or authorized by or under this Act to be entered therein.
- (5) No notice of any trust, whether expressed, implied or constructive, shall be entered in the register, and the Registrar shall not be affected by any such notice.

**PART II
INTERNATIONAL PROVISIONS**

7. If Malawi accedes to the Convention and any revision thereof as a country of the Union for the Protection of Industrial Property constituted thereunder, the Minister shall, by notice in the *Gazette*, declare that Malawi has become such a country with effect from the date stated in such notice.

Convention
arrangements

8. (1) Subject to section 11, any person who qualifies under Article 2 or 3 of the Convention and who has applied for protection for an invention in a convention country or his legal representative or assignee (if such assignee is also so qualified) shall be entitled to a patent for his invention under this Act in priority to other applicants if application therefore is made in terms of Act within twelve months after the effective date of the first application for protection in the first convention country in which he made such application or, where more than one such application for protection has been made, from the effective date of the first such application, and the patent shall have the same date as the effective date of the application in such convention country but the term of the patent shall run from the date on which the complete specification is lodged at the Patent Office:

Convention
applications

Provided that:

- (a) nothing in this subsection shall entitle the patentee to recover damages for infringements occurring prior to the date on which his complete specification is advertised as having been accepted in Malawi;
 - (b) no patent granted on a convention application lodged within twelve months after the date stated in terms of section 7 shall bear a date or be effected from a date prior to the date so stated.
- (2) Where, after the lodging of the first application in the first convention country in respect of any invention a subsequent application is lodged in that country in respect of the same invention such subsequent shall be regarded as the first application in that country in respect of that

invention, if at the time of the lodging thereof:

LAWS OF MALAWI

Patents

Cap. 49:02

- (a) The previous application has been withdrawn, abandoned or refused without having been open to public inspection; and
 - (b) No priority rights have been claimed by virtue of such previous application; and
 - (c) No rights are outstanding in that convention country in connection with such previous application.
- (3) An application which has been withdrawn, abandoned or refused shall not after the lodging of the subsequent application be capable of supporting a claim for priority rights under this section.
- (4) Where all the rights of each of two or more applicants referred to in subsection (1) who have made application for protection of inventions in any one or more convention countries have become vested in the same person, those applications shall for the purposes of section 13(4) be deemed to have been made by the same applicant.
- (5) Where an applicant referred to in subsection (1) has applied for protection for any invention by an application which, in accordance with the law of any convention country, is equivalent to an application duly made in that convention country, he shall be deemed for the purposes of this section to have applied in that convention country.
- (6) In determining for the purposes of this Act whether an invention described or claimed in a specification lodged in the Patent Office is the same as that for which protection has been applied for in a convention country, regard shall be had to the disclosure contained in the whole of the documents put forward at the same time as and in support of the application in the convention country, being documents of which copies have been lodged at the Patent Office within such time and in such manner as may be prescribed.
- (7) A patent granted in Malawi for an invention upon an application made in terms of this section shall not be invalidated by reason only of:
- (a) The invention having been known or used or published in Malawi or elsewhere on or after the effective date of the application in the convention country in which application was first made; or
 - (b) The granting in Malawi after the effective date of the application in the convention country of a patent of another person for the same invention.

Provided that:

- (i) The effective date of the patent of such other person shall not be prior to the effective date in Malawi of the convention application; and

LAWS OF MALAWI

Patents

Cap. 49:02

- (ii) The convention patentee shall be entitled to have the patent of such other person revoked upon due application under and compliance with section 50.
- (8) An application for a patent under this section shall be made in the same manner as for an application in terms of section 12, save that the application shall be accompanied by a complete specification.
- (9) For the purpose of this Act, matter shall be deemed to have been disclosed in an application for protection in a convention country if it was claimed or disclosed (otherwise than by way of disclaimer or acknowledgement of prior art) in that application or in documents submitted by the applicant for protection in support of and at the same time as that application, but no account shall be taken of any disclosure by any such document unless a copy of the document is lodged at the Patent Office with the convention application or within such period as may be prescribed after the lodging of that application
- 9.** (1) Where a vessel or aircraft registered in a convention country or a land vehicle owned by a person ordinarily resident in such a country comes into Malawi temporarily or accidentally only, the rights conferred by a patent for an invention shall not be deemed to be infringed by the use of the invention.
- (a) In the body of the vessel or in the machinery, tackle, apparatus or other accessories thereof, so far as the invention is used on board the vessel and for its actual needs only; or
- (b) In the construction or working of the aircraft or land vehicle or of the accessories thereof,
- As the case may be.
- (2) This section shall not affect any Act which exempts any or any class of aircraft from seizure on patent claims.
- 10.** (1) Subject to this section, the Minister may make regulations for securing that, where an invention has been communicated in accordance with any agreement or arrangement made by or on behalf of the Government with the government of any country for the supply or mutual exchange of information or articles:
- (a) an application for a patent for an invention so communicated made by a person, his legal representative or assignee, entitled under section 11 to make such application, shall not be prejudiced, and a patent granted on such an application shall not be invalidated by reason only that the invention has been communicated as aforesaid or that in consequence thereof:

Special provisions as to vessels, aircraft and land vehicles.

Protection of inventions communicated under international agreements

LAWS OF MALAWI

Patents

Cap. 49:02

- (i) the invention has been published, made, used, exercised or vended; or
 - (ii) an application for a patent has been made by any other person, or a patent has been granted on such an application;
 - (b) any application for a patent made in consequence of such a communication as aforesaid by a person who is not entitled so to do under section 11 may be refused and any patent granted on such an application may be revoked.
 - (2) Regulations made under subsection (1) may provide that the publication, making use, exercise or vending of an invention or the making of any application for a patent in respect thereof shall, in such circumstances and subject to such conditions or exceptions as may be prescribed by the regulations, be presumed to have been in consequence of such a communication as is mentioned in that subsection.
 - (3) The powers of the Minister under this section, so far as they are exercisable for the benefit of persons from whom inventions have been communicated to the Government by the government of any country, shall only be exercised in so far as to the extent that the Minister is satisfied that substantially equivalent provision has been or will be made under the law of that country for the benefit of persons whose inventions have been communicated by the Government to the government of that country.
 - (4) Reference in subsection (3) to the communication of an invention to or by the Government or the government of any country shall be construed as including references to the communication of the invention by or to any person authorized in that behalf by the government in question.
- 10a** (1) A patent grantee under the Protocol shall, subject to the provisions of the Protocol, have effect in Malawi as if it were a patent granted under this Act.
- (2) In this section, "Protocol" means the Protocol on Patents and Designs within the Framework of the Industrial Property Organisation for English-speaking Africa adopted on 10th December 1982, at Harare in the Republic of Zimbabwe to which Malawi acceded on 3rd January 1984, and any revision thereof to which Malawi has acceded.

Patents granted under the Protocol 9 of 1985.

PART III APPLICATIONS GENERALLY

- 11.** Application for a patent for an invention may be made by any of the following

Persons entitled to make application.

persons, that is to say:

LAWS OF MALAWI

Patents

Cap. 49:02

- (a) A person claiming to be the inventor of the invention who owns the invention in respect of Malawi;
- (b) An assignee;
- (c) A person entitled under section 8(1)
- (d) The legal representative of any person who immediately before his death or disability was entitled to make such application,

And may be made by any above-mentioned person either alone or jointly with any other person.

Form of
application

- 12.** (1) Every application for a patent shall -
- (a) be made in the prescribed form, which must be signed by the applicant or by a person authorized to sign on his behalf;
 - (b) be lodged at the Patent Office in the prescribed manner;
 - (c) state an address for service in Malawi to which all notices and communications may be sent; and
 - (d) in so far as they are not already stated for the purposes of paragraph (c) state the full postal, residential and business addresses of the applicant.
- (2) An assignee or legal representative making or joining in an application shall furnish such proof of title or authority as the Registrar may require or as may be prescribed.
- (3) Every application form shall -
- (a) State that the applicant owns the invention in respect of Malawi;
 - (b) Give the full name of the inventor; and
 - (c) Where the inventor is not the applicant or one of the applicants, contain a declaration that the applicant believes him to be the inventor.
- (4) Every convention application, in addition to the requirements set out in subsection (3), shall state -
- (a) The convention country in which such application for protection was made;

LAWS OF MALAWI

Patents

Cap. 49:02

- (b) Its number;
- (c) The effective date of such application; and
- (d) The respect in which the applicant in the convention country and in Malawi qualifies under Article 2 or 3 of the Convention.

- 13.** (1) Every application for a patent, other than a convention application, shall be accompanied by either a complete specification or a provisional specification and every convention application shall be accompanied by a complete specification.
- (2) If a complete specification does not accompany an application, it shall be lodged within twelve months after the date of lodging of the application or within such further period, not exceeding three months, as the Registrar may in writing allow upon payment of the prescribed fee and if this subsection is not complied with the application shall elapse.
- (3) Where two or more applications accompanied by provisional specifications have been lodged in respect of inventions which are cognate or of which one is a modification of another, a single complete specification may, subject to this section and section 14, be lodged in pursuance of those applications, or, if more than one complete specification has been lodged, may with the leave of the Registrar be proceeded with in respect of those applications.
- (4) Where applications for protection have been made in one or more convention countries in respect of two or more inventions which are cognate or of which one is a modification of another, a single convention application may, subject to sections 11 and 14, be made in respect of those inventions at any time within twelve months from the effective date of the earliest of the said applications for protection.
- (5) In considering the validity of applications made in terms of subsection (3) or (4) and in determining other relevant matters under this Act the Registrar shall have regard to the effective dates of the applications or the convention applications concerned relating to the several matters claims in the specification, and the requirements of section 12(4) shall, in the case of any such application, apply separately to the applications for protection in respect of each of the said inventions.
- (6) Where an application for a patent, not being a convention application, is accompanied by a specification purporting to be a complete specification, the Registrar may, if the applicant so requests at any time before the acceptance of the specification, direct that it shall be treated for the purposes of this Act as a provisional specification and

Complete and provisional specifications.

proceed with the application accordingly.

LAWS OF MALAWI

Patents

Cap. 49:02

- (7) Where a complete specification has been lodged in pursuance of an application for a patent accompanied by a provisional specification or by a specification treated by virtue of a direction under subsection (6) as a provisional specification, the Registrar may, if the applicant so requests at any time before the acceptance of the complete specification, cancel the provisional specification and post-date the application to the date of lodging of the complete specification.

- 14.** (1) Every specification shall indicate whether it is a provisional or a complete specification and shall commence with a title sufficiently indicating the subject to which the relevant invention relates.
- (2) A provisional specification shall fairly describe the invention.
- (3) A complete specification shall –
- (a) Fully describe the invention and the manner in which it is to be performed;
 - (b) Disclose the best method of performing the invention known to the applicant at the time when the specification is lodged at the Patent Office; and
 - (c) End with a claim or claims defining the subject matter for which protection is claimed.
- (4) The claim or claims of a complete specification must relate to a single invention, must be clear and succinct, and must be fairly based on the matter disclosed in the specification.
- (5) Every specification shall be accompanied by drawings if required by the Registrar, and such drawings shall be deemed to be part of the specification, but if drawings which accompanied a provisional specification are sufficient for the purpose of a complete specification, it shall suffice if that complete specification refers to such drawings.
- (6) Subject to the foregoing provisions of this section, a complete specification lodged at the Patent Office after a provisional specification, or with a convention application, may include claims in respect of developments of or additions to the invention which was described in the provisional specification or, as the case may be, in respect of which application for protection was made in a convention country, being developments of or additions in respect of which the applicant would be entitled to make a separate:

Contents of
specification.

Provided that in application shall, in so far as the complete specification contains claims in respect of any such developments or additions, be deemed to have been made on the date on which the complete specification was lodged at

- (7) Where a complete specification claims a new substance, the claim shall be construed as not extending to that substance when found in nature.

- 15.** (1) Every claim of a complete specification shall have effect from the date prescribed by this section in relation to that claim and a patent shall not be invalidated by reason only of the publication or use of the invention, so far as claimed in any claim of the complete specification, on or after the effective date of that claim, or by the grant of another patent upon a specification claiming the same invention in a claim of the same or later effective date.

Effective date of claims of complete specification

- (2) Where the complete specification is lodged in pursuance of a single application preceded by a provisional specification or by a specification which is treated by virtue of a direction under section 13(6) as a provisional specification, and the claim is fairly based on the matter disclosed in that specification, the effective date of that claim shall be the effective date of the application.

- (3) Where the complete specification is lodged or proceeded with in pursuance of two or more applications accompanied by such specifications as are mentioned in subsection (2), and the claim is fairly based on the matter disclosed in one of those specifications, the effective date of the application accompanied by that specification.

- (4) Where the complete specification is lodged in pursuance of a convention application and the claim is fairly based on the matter disclosed in the application for protection in a convention country or, where the convention application is founded upon more than one such application for protection, in one of those applications, the effective date of that claim shall be the effective date of the relevant application for protection.

- (5) Where, under the foregoing provisions of this section, any claim of a complete specification would, but for this provision, have two or more effective dates, the effective date of that claim shall be the earlier or earliest of those dates.

- (6) In any case to which subsection (2), (3), (4) or (5) does not apply, the effective date of a claim shall be the date of lodging of the complete specification in Malawi.

- 16.** (1) The Registrar shall examine every application for a patent and every specification accompanying such application or lodged at the Patent Office in pursuance of such application, in order to ascertain -

Examination of applications and specifications

- (a) whether such application or specification complies with the requirements of this Act;

LAWS OF MALAWI

- (b) in the case of a complete specification lodged after a provisional specification, or of a convention application, whether the invention claimed is substantially the same as that disclosed in the provisional specification or in the application lodged in the convention country, as the case may be.
- (2) Any examination or investigation required in terms of subsection (1) may, on the direction of the Registrar, be undertaken by an examiner who shall report his findings on any such examination or investigation to the Registrar.
- (3) An examination or investigation required by this Act shall not be deemed to warrant the validity of any patent, and no liability shall be incurred by the Government, the Minister, the Registrar or any officer of the Patent Office by reason of or in connection with any such examination or investigation or report or other proceeding consequent thereon.
- 17.** (1) At any time after an application has been lodged under this Act and before acceptance of the complete specification, the Registrar may, at the request of the applicant and upon payment of the prescribed fee, direct that the application shall be post-dated to such date as may be specified in the request:
- Provided that-
- (a) no application shall be posted under this subsection to a date later than six months from the date on which it was actually lodged or would, but for this subsection, be deemed to have been so lodged; and
- (b) a convention application shall not be postdated under this subsection to a date later than the last date on which, under this Act, the application could have been made.
- (2) Where an application or specification lodged under this Act is amended before acceptance of the complete specification, the Registrar may direct that the application or specification shall be postdated to the date on which it is amended or, if it has been returned to the applicant, to the date on which it is again lodged under this Act.
- (3) Where, at any time after an application or specification has been lodged at the Patent Office and before acceptance of the complete specification, a fresh application or specification is lodged in respect of any part of the subject matter of the first mentioned application or specification, the Registrar may direct that the fresh application or specification shall be antedated to a date not earlier than the date of lodging of the first mentioned application or specification.

Antedating and
post-dating of
applications.

LAWS OF MALAWI

Patents

Cap. 49:02

- (4) An appeal shall lie from any decision of the Registrar under subsection (2) or (3).

18. (1) If it appears to the Registrar in the case of any application for a patent:-

- (a) that it is frivolous on the ground that it claims as an invention anything obviously contrary to well established natural laws; or
- (b) that the use of the invention in respect of which the application is made would be contrary to law or morality; or
- (c) that it claims as an invention a substance capable of being used as food or medicine which is a mixture of known ingredients possessing only the aggregate of the known properties of the ingredients, or that it claims as an invention a process producing such a substance by mere admixture, he may refuse the application.

- (2) If it appears to the Registrar that any invention in respect of which an application for a patent is made might be used in any manner contrary to law, he may refuse the application unless he specification is amended by the insertion of such disclaimer in respect of that use of the invention, or such other reference to the illegality thereof, as the Registrar thinks fit.

- (3) An appeal shall lie from any decision of the Registrar under this section.

19. (1) If, in the case of a complete specification lodged in pursuance of an application for a patent, which application was accompanied by a provisional specification, the result of any examination or investigation made in terms of section 16 is adverse to the applicant in regard to any matter referred to in that section, or it is found that the invention described in the complete specification is not substantially the same as that described in the provisional specification or that the complete specification includes an invention not included in the provisional specification, the Registrar may, subject to section 14(6):-

- (a) refuse to accept the complete specification until it has been amended to his satisfaction;
- (b) with the consent of the applicant, cancel the provisional specification and direct that the application be postdated to the date upon which the complete specification was lodged at the Patent Office; or

**Refusal
application
certain cases.** of
in

**Powers
Registrar
specification
application
defective.** of
if
or

LAWS OF MALAWI

Patents

Cap. 49:02

- (c) where the complete specification includes an invention not included in the provisional specification, allow the application to be proceeded with in so far as the invention included both in the provisional and in the complete specification is concerned and allow an application for the additional invention included in the complete specification to be made and authorize the application for such additional invention, if lodged at the Patent Office within such period as he may determine, to be dated with the date on which the complete specification was lodged at the Patent Office.
- (2) If in the case of a convention application it is found that the invention claimed is not substantially the same as that claimed in the application made in the convention country in question, the Registrar may, subject to section 14(5):-
 - (a) Refuse to accept the application until it has been amended to his satisfaction; or
 - (b) With the consent of the applicant, treat the application as an application in terms of section 12.
- (3) If in the case of a convention application it is found that the specification lodged in Malawi includes an invention not included in the specification lodged in the convention country, the Registrar may allow the application to be proceeded with in so far as the invention included in both the convention and the Malawi specification is concerned, and allow an application for the additional invention to be made and authorize such application, if lodged at the Patent Office within the period he may determine, to be dated with the date on which the Malawi specification was lodged at the Patent Office.
- (4) An appeal shall lie from any decision of the Registrar under this section.

- 20.** (1) If a complete specification is not accepted within eighteen months from the date of lodging of an application, the application shall lapse unless:-
- (a) refuse to accept the complete specification until it has been amended to his satisfaction;
 - (b) the time within which such appeal may be lodged has not expired; or
 - (c) the delay in accepting the specification was not due to any neglect or default on the part of the applicant.

Provided that where an application is made for an extension of time for the acceptance of a complete specification, the Registrar shall, on payment of the prescribed fee, grant an extension of time to the extent

Lapsing of applications

applied for, but not exceeding three months.

LAWS OF MALAWI

Patents

Cap. 49:02

(2.) If, at the expiration of the period allowed under subsection (1), an appeal to the Patents Tribunal is pending under any of the provisions of this Act in respect of the application (on, in the case of an application for a patent of addition, either in respect of the application or in respect of the application for the patent for the main invention) or the time within which such an appeal could be brought in accordance with Part X, apart from any future extension of time thereunder, has expired, then:-

(a) Where such an appeal is pending, or is brought within the time aforesaid or before the expiration of any extension of that time granted in the case of the first extension, on an application made within that time or, in the case of a subsequent extension on an application made before the expiration of the last previous extension, the said period shall be extended until such date as the Patents Tribunal may determine.

(b) Where no such appeal is pending or is so brought, the said period shall continue until the end of the time aforesaid, or, if any extension of that time is granted as aforesaid, until the expiration of the extension or the last extension so granted.

21. (1) Subject to section 20, the complete specification may be accepted by the Registrar at any time after the applicant has complied with the requirements imposed upon him by this Act:-

**Acceptance and
publication of
complete
specification.**

(a) refuse to accept the complete specification until it has been amended to his satisfaction;

Provided that the applicant may give notice to the Registrar requesting him to postpone acceptance until such date, not being later than eighteen months from the date of lodging of the application, as may be specified in the notice and the Registrar may postpone acceptance accordingly.

(2) On the acceptance of a complete specification the Registrar shall give notice to the applicant who shall, within the prescribed period or within such further period as the Registrar may allow, advertise in the prescribed manner the fact that the specification has been accepted and, unless the acceptance of the specification is so advertised, the application shall lapse.

(3) Upon advertisement under subsection (2) the application form, the specification and other documents essential to obtain acceptance lodged in pursuance thereof shall be open to public inspection.

LAWS OF MALAWI

Patents

Cap. 49:02

- (4) After the date of the publication as prescribed in subsection (2) of notice of acceptance of a complete specification and until the sealing of a patent in respect thereof, the applicant shall have the like privileges and rights as if a patent for the invention had been sealed on the publication of such notice.

22. (1) Any interest, including the Government, may within three months from the date of the advertisement of the acceptance of a complete specification or within such further period as the Registrar, on application made to him within the said period of three months, may allow, or with the consent of the applicant, at any time before the sealing of the patent, oppose the grant of a patent in accordance with this section by giving written notice to the Registrar of opposition to such grant on any of the following grounds and no others, namely:-

Opposition to grant of patent.

- (a) that the applicant is not a person entitled under section 11 to make the application;
- (b) that the application is in fraud of the rights of the person giving such notice or of any persons under or through whom he claims;
- (c) that the invention does not relate to an art (whether producing a physical effect or not), process, machine, manufacture or composition of matter, which is capable of being applied in trade or industry;
- (d) subject to section 31, that the invention is obvious in that it involves no inventive step having regard to what was common knowledge in the art at the effective date of the application;
- (e) that the invention is not useful;
- (f) that the complete specification does not fully describe and ascertain the invention and the manner in which it is to be performed;
- (g) that the claims of the complete specification do not sufficiently and clearly define the subject matter for which protection is claimed;
- (h) that the complete specification does not disclose the best method of performing the invention known to the applicant at the time when the specification was lodged at the Patent Office;
- (i) that the application contains a material misrepresentation;

- (j) that the invention described or claimed in the complete specification is not the same as that described in the provisional specification, and:-
 - (i) in so far as it is not described in the provisional specification, was not new at the date when the complete specification was lodged at the Patent Office, or
 - (ii) forms the subject of a pending application made in Malawi for a Patent the effective date of which is prior to the date on which the complete specification was lodged at the Patent Office;
 - (k) in the case of a convention application, that the specification describes or claims an invention other than that for which protection has been applied for in the convention country and that such other invention either:-
 - (i) forms the subject of an application for a Patent in Malawi, which, if granted, would bear a date in the interval between the lodging of the application in the convention country and the effective date of the application in Malawi; or
 - (ii) is not an invention as defined in this Act.
 - (l) That the invention was not new at the effective date of the application;
 - (m) That the specification includes claims which, in terms of section 18(1), should have been refused.
- (2) A copy of any notice given under subsection (1), and of any statement which in terms of subsection (3) accompanies such notice, shall be served by the objector on the applicant for the patent.
 - (3) Any notice of opposition given under subsection (1) shall state the grounds on which the objector intends to oppose the grant of the patent, and shall be accompanied by a statement setting out particulars of the facts alleged in support of the said grounds, and proof of service on the applicant concerned of a copy of such notice and of such statement shall be furnished to the Registrar.
 - (4) If the applicant wishes to contest the opposition, he shall within such time as is prescribed, or such further time as the Registrar may allow, lodge at the Patent Office a counter statement setting out particulars of the grounds upon which the opposition is to be contested.

LAWS OF MALAWI

- (5) A copy of any such counter statement lodged at the Patent Office shall be served by the applicant on the objector concerned.
- (6) Particulars delivered may from time to time be amended by leave of the Registrar.
- (7) No evidence shall be admitted in proof of any ground on which particulars have not been delivered as aforesaid, except by leave of the Patents Tribunal.
- (8) When, in relation to any opposition, the foregoing provisions of this section have been complied with to the extent therein required, the Registrar shall hand all relevant papers to the Registrar of the Patents Tribunal who shall arrange for the matter to be heard by that Tribunal in the manner prescribed and the Patents Tribunal may make such order therein as it deems just.
- (9) Upon being notified of the order of the Patents Tribunal by the Registrar thereof, the Registrar shall take such further action therein as may be necessary.

23.

- (1) If the Registrar is satisfied, on a claim made in the prescribed manner at any time before a patent has been granted, that by virtue of any assignment or agreement made by the applicant or one of the applicants for a patent, or by operation of law, the claimant would, if the patent, were then granted, be entitled thereto or to the interest of an applicant therein, or to an undivided share of the patent or of that interest, the Registrar may, subject to this section, direct that the application shall proceed in the name of the claimant or in the names of the claimant and the applicant or the other joint applicant or applicants, as the case may require.
- (2) No such direction as aforesaid shall be given by virtue of any assignment or agreement made by one of two or more joint applicants for a patent except with the consent of the other joint applicant or applicants.
- (3) No such direction as aforesaid shall be given by virtue of any assignment or agreement for the assignment of the right to an invention unless:-
 - (a) The invention is identified therein by reference to the number of the application for the patent;
 - (b) There is produced to the Registrar an acknowledgement by the person by whom the assignment or agreement was made that the assignment or agreement relates to the invention in respect of which that application is made; or

Substitution of applicants

(c) The rights of the claimant in respect of the invention have been finally established by a decision of the Patents Tribunal or any court to which an appeal against such a decision has been brought.

(4) Where one of two or more joint applicants for a patent has died at any time before the patent has been granted, the Registrar, if satisfied of such decease, may alter the application by substituting the legal representative of such deceased applicant and shall thereafter seal the application in the names of the surviving applicants and of such legal representative unless, upon a request in that behalf made by the survivor or survivors, and with the consent of such legal representative, the Registrar directs that the application shall proceed and be sealed in the name of the survivor or survivors alone.

(5) If any dispute arises between joint applicants for a patent whether or in what manner the application should be proceeded with, the Registrar may, upon application made to him in the prescribed manner by any of the parties, and after giving to all parties concerned an opportunity to be heard, give such directions as he thinks fit for enabling the application to proceed in the name of one or more of the parties alone or for regulating the manner in which it shall be proceeded with, or for both those purposes, as the case may require.

(6) An appeal shall lie from any decision of the Registrar under this section.

24. (1) In this section the expression “**competent authority**” means the Minister.

(2) Where, before or after the date of commencement of this Act, an application for a patent has been made in respect of an invention, and it appears to the Registrar that the invention is one of a class notified to him by a competent authority as relevant for defence purposes, he may give directions for prohibiting or restricting the publication of information with respect to the invention, or the communication of such information to any person or class of persons specified in the directions, and while such directions are in force the application may, subject to the directions, proceed up to the acceptance of the complete specification, but the acceptance shall not be advertised nor the specification published, and no patent shall be granted in pursuance of the application.

(3) Where the Registrar gives any such directions as aforesaid, he shall give notice of the application and of the directions to the competent authority, and thereupon the following provisions shall have effect, that is to say:-

**Provisions for
secrecy of certain
inventions.**

- (a) The competent authority shall, upon receipt of such notice, consider whether the publication of the invention would be prejudicial to the defence of Malawi and unless a notice under paragraph (c) of this subsection has previously been given by that authority to the Registrar, shall consider that question before the expiration of nine months from the date of lodging of the application for the patent and at least once in every subsequent year.
 - (b) For the purpose aforesaid, the competent authority may, at any time after the complete specification has been accepted or, with the consent of the applicant, at any time before the complete specification has been accepted, inspect the application and any documents furnished to the Registrar in connection therewith.
 - (c) If upon consideration of the invention at any time it appears to the competent authority that the publication of the invention would not, or would no longer, be prejudicial to the defence of Malawi, that authority shall give notice to the Registrar to that effect;
 - (d) On the receipt of any such notice the Registrar shall revoke the directions and may, subject to such conditions, if any, as he thinks fit, extend the time for doing anything required or authorized to be done by or under this Act in connection with the application, whether or not that time has previously expired.
- (4) When directions have been given under this section, if any use of the invention is made during the continuance in force of such directions by or on behalf of or to the order of a Government department, section 40 shall apply in relation to that use as if a patent had been granted for the invention.
 - (5) If an applicant for a patent has suffered loss of damage by reason of his invention having been kept secret in pursuance of a direction under subsection (2), the Minister, with the consent of the Minister of Finance, shall pay to him such reasonable compensation as is agreed upon, or, in default of agreement, as may be determined by the Patents Tribunal on a reference under section 42)1).
 - (6) Where a patent is granted in pursuance of an application in respect of which directions have been given under this section, no renewal fees shall be payable in respect of any period during which those directions were in force.
 - (7) If any person fails to comply with any direction given under this section he shall be guilty of an offence.

**PART IV
GRANT, EFFECT AND TERM OF PATENT**

**Grant and sealing
of patent.**

- 25.** (1) If the conditions precedent to the grant of a patent, as prescribed in this Act have been complied with and there is no opposition to such grant or, in the event of such opposition, the final determination is in favour of the grant of a patent, a patent shall be granted to the applicant, or, in the case of an application by two or more persons jointly, to the applicants jointly, and the Registrar shall cause the patent to be sealed with the seal of the Patent Office:-

Provided that:-

- (a) where an applicant under a joint application has died, the patent may, with the consent of his heir or legal representative, be granted to the survivors of the joint applicants;
 - (b) where an applicant has agreed in writing to assign the invention or a share in the invention or, in the case of an application by two or more persons jointly, his interest in the invention, to another person, the patent may upon proof of the agreement to the satisfaction of the Registrar be granted to and in the name of the assignee either solely or jointly with the applicant or, in the case of an application by two or more persons jointly, to and in the name of the assignee jointly with the other applicants or their assignees.
- (2) A patent shall be sealed as soon as may be, but not later than twenty-two months after the date of lodging of the application therefore:-

Provided that:-

- (a) Where the Registrar or the Patents Tribunal has allowed an extension of the time within which a competent specification may be lodged or accepted, a corresponding extension of the time for the sealing of the relevant patent shall be allowed;
- (b) Where the sealing is delayed by an appeal or by opposition to the grant of the patent, the patent may be sealed at such time as the Registrar may determine;
- (c) Where the patent is to be granted to the heir or legal representative of an applicant who has died before the expiration of the time which would otherwise be allowed for sealing the patent, the patent may be sealed at such later time as the Registrar may decide;
- (d) The Registrar may, on payment of the prescribed fee, extend the period of twenty-two months for such further time as

- (e) Where it is proved to the satisfaction of the Registrar that hardship would arise in connection with the prosecution of the corresponding application for a patent in any other country unless the period for the sealing of such patent is extended, that period may be extended from time to time by the Registrar to such periods as appear to him to be necessary in order to prevent the hardship arising, if an application in that behalf is made to him and the prescribed fee is paid within the first mentioned period, or in the case of a subsequent application under this paragraph, within the period to which such first mentioned period was extended on the last preceding application;
- (f) In respect of applications lodged during the years 1964 and 1965 the period of twenty-two months shall be deemed to have been extended to forty-six months.
- 26.** Where, at any time after a patent has been sealed in pursuance of an application under this Act, the Registrar is satisfied that the person to whom the patent was granted had died, or, in the case of a body corporate, had ceased to exist, before the patent was sealed, he may amend the patent by substituting for the name of that person the name of the person entitled thereto according to law, and the patent shall have effect, and shall be deemed always to have had effect, accordingly.
- 27.** (1) Subject to this Act, the date of a patent shall be the effective date of the application therefore.
- (2) The date of a patent shall be entered in the register and shall be inserted in the patent.
- 28.** (1) Subject to this Act, a patent shall have the same effect against the Government as it has against a subject.
- (2) A patent shall be in such form as may be prescribed.
- (3) A patent shall be granted for one invention only, but it shall not be competent for any person in an action or other proceeding to take any objection to a patent on the ground that it has been granted for more than one invention.
- (4) The effect of a patent shall be to grant to the patentee, subject to this Act and the conditions of the patent, full power, sole privilege and authority by himself, his agents and licensees during the term of the patent to make, use, exercise and vend the invention within Malawi in such a manner as to him seems meet, so that he shall have and enjoy the whole profit and advantage accruing by reason of the invention during the terms of the patent.

Amendment of patent granted to deceased applicant.

Date of patent.

Extent, effect and form of patent.

LAWS OF MALAWI

Patents

Cap. 49:02

- 29.** The term of every patent shall, subject to this Act, be sixteen years from the date of lodging the complete specification in the Patent Office.
- 30.** (1) A patentee or an exclusive licensee may, after advertising in the prescribed manner, apply to the Patents Tribunal for an extension of the term of the relevant patent on any one or more of the following grounds, namely:-
- (a) that he has not derived adequate remuneration from that patent;
 - (b) that by reason of hostilities between Malawi and any foreign state, he has suffered loss or damage including:-
 - (i) loss of damage arising out of action taken in pursuance of an official request to keep secret the specification of the invention to which the patent relates; and
 - (ii) loss of opportunity for dealing in or developing the invention on account of:-
 - a. the fact that he or his employees were engaged in work of national importance; or
 - b. lack of supplies or loss of markets as a result of such hostilities, wherever such lack or loss occurs.
- (2) Any such application may be made:-
- (a) In the case of an application under subsection (1)(a), not more than twelve and not less than six months before the date of expiration of the term of the patent in question or at such later time, being not later than the date of expiration of the patent, as the Patents Tribunal may allow; and
 - (b) In the case of an application under subsection (1)(b) at any time before the date of expiration of the patent or within two years after the date on which hostilities ceased, whichever is the later date.
- (3) Any person may within the prescribed time give written notice to the Registrar and the applicant of objection to any such extension, and the registrar of the Patents Tribunal shall fix a date for the hearing of the application by that Tribunal and shall advise the applicant and any objector of the date so fixed.

Term of patent.

Extension of patent.

- (4) The Patents Tribunal may, after hearing the applicant and any person who may have objected to the extension, refuse the application or order the extension of the term of the patent in question for such period and subject to such conditions as it may deem fit or, if the patent has already lapsed, order the issue of a new patent for such a period and subject to such conditions:

Provided that no such extension shall be granted:-

- (a) On the grounds mentioned in subsection (1)(a) for a term exceeding five years or, in what the Patents Tribunal may deem to be exceptional circumstances, ten years; or
- (b) On the grounds mentioned in subsection (1)(b), for a term exceeding the period of hostilities.
- (5) Section 34 shall *mutatis mutandis* apply in respect of any extension of the term of a patent granted as a result of an application under subsection (1)(b):

Provided that in the application of those provisions are reference in that section to a period of three months from the date on which any renewal fee referred to therein was due shall be construed as a reference to the date on which any patent whereof the term is extended under this section lapsed by effluxion of time.

- (6) An extension of the term of a patent under this section shall be endorsed on the relevant patent by the Registrar and recorded in the register.
- (7) Except where the Patents Tribunal otherwise decides, an application based on the grounds specified in subsection (1)(b), shall not be considered if the patentee or exclusive licensee is a subject of such foreign state as is referred to in that paragraph or is a company the business whereof is managed or controlled by such subjects or is carried on wholly or mainly for the benefit or on behalf of such subjects, notwithstanding that the company may be registered in accordance with any law relating to companies.

Patents of addition.

- 31.** (1) Subject to this section, where an application for a patent is pending or has been granted thereon for an invention (hereinafter referred to as the main invention) and the applicant or patentee applies for a further patent in respect of any improvement in or modification of the main invention, the Registrar may, if the applicant so requests, grant a patent for the improvement or modification as a patent of addition.

- (2) Subject to this section, where an invention, being an improvement in or modification of another invention, is the subject of an independent patent and the patentee in respect of that patent is also the patentee in respect of the patent for the main invention, the Registrar may, if the patentee so requests, by order revoke the patent for the improvement or modification and grant to the patentee a patent of addition in respect thereof, bearing the same date as the date of the patent so revoke.
- (3) A patent shall not be granted as a patent of addition unless the date of lodging of the complete specification was the same as or later than the date of lodging of the complete specification in respect of the main invention.
- (4) A patent of addition shall not be sealed before the sealing of the patent for the main invention, and if the period within which, but for this provision, the sealing of a patent of addition could be made under section 25 expires before the period within which the sealing of the patent for the main invention may be so made, the sealing of the patent of addition may be made at any time within the last mentioned period.
- (5) A patent of addition shall remain in force as long as the patent for the main invention shall remain in force, including any extension of the term thereof but no longer, and no fees shall be payable for renewal of a patent of addition:

Provided that, where the patent for the main invention is revoked, the Registrar or the Patents Tribunal, as the case may be, may order that the patent of addition shall become an independent patent, and the fees payable in respect of such independent patent and the times for the payment thereof shall be determined according to the date of the former patent of addition, but the normal term of the independent patent shall not extend beyond the date on which the patent for the main invention would have expired if it had not been revoked.

- (6) The grant of a patent of addition shall be conclusive evidence that the invention is a proper subject for such a patent, and shall not be refused, nor shall any such patent be liable to be revoked or invalidated, on the ground only that the invention claimed in the complete specification does not involve any inventive step having regard to the main invention, so, however, that this subsection shall not apply to an independent patent referred to in the proviso to subsection (5).
- (7) A patent for a main invention and its patent of addition shall not be capable of assignment apart from one another.
- (8) An appeal shall lie from any decision of the Registrar under this

section.

LAWS OF MALAWI

Patents

Cap. 49:02

- 32.** (1) Subject to this section, every patent shall lapse if the fees prescribed for its renewal are not paid within the prescribed times. **Renewal of patents.**
- (2) The Registrar may, upon application of the patentee and subject to the payment of such additional fees as may be prescribed, extend the time for payment of a fee referred to in subsection (1) for a period not exceeding six months.
- (3) No fee referred to in subsection (1) shall be payable for the renewal of a patent granted or registered under any enactment repealed by the former patents legislation in respect of the period of its term which had elapsed before the 1st January 1964.
- 33.** (1) Where a patent has lapsed owing to the failure of the patentee to pay any prescribed fee within the prescribed time, the patentee may in the prescribed manner apply to the Registrar for the restoration of the patent. **Restoration of lapsed patents.**
- (2) If the Registrar is satisfied that such failure was unintentional, and that no undue delay has occurred in making the application, he shall direct the patentee to advertise the application in the prescribed manner, and thereupon any person may within such time as may be prescribed give notice in the prescribed manner of opposition to the restoration of the patent.
- (3) If there is no opposition to such restoration the Registrar shall, on payment of the unpaid renewal fees, make an order restoring the patent.
- (4) Where notice of opposition is given, the Registrar shall notify the applicant thereof and shall, after the expiration of the prescribed period and after hearing the applicant and the objector, decide the matter and make an order either restoring the patent, subject to section 34, or dismissing the application.
- (5) An appeal shall lie from any decision of the Registrar under this section.
- 34.** In every order restoring a lapsed patent made under section 33, there shall be inserted for the protection of persons who may have availed themselves of the subject matter of the patent after a lapse of a period of three months from the date on which the renewal fees was due, the following provisions, namely, that the patentee shall not commence or prosecute any action or other proceedings or recover damages: **Protective provisions to be inserted in order for restoration of patent.**
- (a) In respect of any infringement of the patent which has taken place after the lapse of the said period and before the date of the order;

- (b) In respect of any use of the subject matter of the patent at any time after the date of the order by the employment of any means or composition of matter actually made within or imported into Malawi in infringement of the patent after the lapse of the said period and before the date of the order, or in respect of the sale, purchase or use of any article which is the product of the use of the said means, composition of matter, or process:

Provided that the employment of the said means, composition of matter or process shall be limited to the person by or for whom the said means, composition of matter, or process was so made, imported or put into operation, his legal representative, his successors or assigns, or his vendees, as the case may be;

- (c) In respect of the employment at any time after the date of the order of any further means, composition of matter, or process, being a reproduction or improvement of the means, composition of matter, or process referred to in paragraph (b) or in respect of the sale, purchase or use of any article which is the product of the said further means, composition of matter, or process;

Provided that the employment of the said further means, composition of matter, or process shall be limited to a person entitled to use as aforesaid the means, composition of matter, or process specified in that paragraph.

- 35. (1) At any time after the sealing of a patent the patentee may apply to the Registrar for the patent to be endorsed with the words “licences of right” and where such an application is made, the Registrar shall notify the application to any person entered on the register as entitled to an interest in the patent and if satisfied, after giving any such person an opportunity to be heard, that the patentee is not precluded by contract from granting licences under the patent, cause the patent to be endorsed accordingly, so, however, that no such endorsement shall be made in respect of an exclusive licence.

Endorsement of patent “licences of right”.

- (2) Where a patent is endorsed under this section:
 - (a) Any person shall, at any time thereafter, be entitled as of right to a licence under the patent upon such terms as may, in default of agreement and subject to subsection (3), be settled by the Registrar on the application of the patentee or the person requiring the licence;
 - (b) The Registrar may, on the application of the holder of any licence granted under the patent before the endorsement, order the licence to be exchanged for a licence to be granted by virtue of the endorsement upon terms to be settled as

aforesaid;

LAWS OF MALAWI

- (c) If in proceedings for infringement of the patent, otherwise than by the importation of goods, the defendant undertakes to take a licence upon terms to be settled by the Registrar as aforesaid, no injunction shall be granted against him, and the amount, if any, recoverable against him by way of damages shall not exceed double the amount which would have been payable by him as licensee if such a licence had been granted before the earliest infringement;
 - (d) The renewal fees payable in respect of the patent after the date of the endorsement shall be one half of the renewal fees which would be payable if the patent were not so endorsed.
- (3) In settling the terms of the licence for the purposes of subsection (2)(a) or (b), the Registrar shall:-
- (a) Take cognizance of section 38 with respect to a patent falling under that section; and
 - (b) Provide, *inter alia*, for the following matters:-
 - (i) The period of the licence;
 - (ii) The terms of renewal, if any;
 - (iii) The amount of and method for payment of royalties;
 - (iv) Arrangements for cancellation of the licence upon application made to him by the patentee after failure by the licensee to pay royalties or to observe any other conditions included in the licence by the Registrar, who is hereby authorized to include such conditions, so, however, that no such licence may be cancelled unless the licensee, after reasonable notice given to him by the patentee, has failed to observe such conditions.
- (4) The licensee under any licence granted by virtue of the endorsement of a patent under this section shall, unless in the case of a licence the terms of which are settled by agreement the licence otherwise expressly provides, be entitled to call upon the patentee to take proceedings to prevent any infringement of the patent, and if the patentee refuses or neglects to do so within two months after being so called upon, the licensee may institute proceedings for the infringement in his own name as if he were patentee, making the patentee a defendant:

Provided that a patentee so added as defendant shall not be liable for any costs unless he enters an appearance and takes part in the proceedings.

- (5) An application for the endorsement of a patent under this section shall contain a statement, to be verified in such manner as may be prescribed, that the patentee is not precluded by contract from granting licences under the patent, and the Registrar may require from the applicant such further evidence as he may think necessary.
- (6) An application made under this section for the endorsement of a patent of addition shall be treated as an application for the endorsement of the patent for the main invention also, and an application made under this section for the endorsement of a patent in respect of which a patent of addition is in force shall be treated as an application for the endorsement of the patent of addition also, and where a patent of addition is granted in respect of a patent already endorsed under this section, the patent of addition shall also be so endorsed:

Provided that no royalty shall be paid by a licensee in respect of such endorsement.

- (7) All endorsements of patents under this section shall be entered in the register and shall be published in the prescribed manner.
- (8) An appeal shall lie from any decision of the Registrar under this section.

- 36.**
- (1) Within such time as may be prescribed after a patent has been endorsed under section 35, the patentee may apply to the Registrar for cancellation of the endorsement and where such an application is made and the balance paid of all renewal fees which would have been payable if the patent had not been endorsed, the Registrar may, if satisfied that there is no existing licence under the patent or that all licensees under the patent consent to the application, cancel the endorsement accordingly.
 - (2) Within the prescribed period after a patent has been endorsed as aforesaid, any person who claims that the patentee is, and was at the time of the endorsement, precluded by a contract in which the claimant is interested from granting licences under the patent may apply to the Registrar for cancellation of the endorsement.
 - (3) Where the Registrar is satisfied, on application made under subsection (2), that the patentee is and was precluded as aforesaid, he shall cancel the endorsement, and thereupon the patentee shall be liable to pay, within such period as may be prescribed, a sum equal to the balance of all renewal fees which would have been payable if the patent had not been endorsed, and if that sum is not paid within that period the patent shall cease to have effect at the expiration of that period.
 - (4) Where the endorsement of a patent is cancelled under this section, the rights and liabilities of the patentee with respect to it shall thereafter

Cancellation of endorsement made under section 35.

be the same as if the endorsement had not been made.

LAWS OF MALAWI

Patents

Cap. 49:02

- (5) An applicant shall advertise in the prescribed manner any application made by him under this section and within the prescribed period after such advertisement:-
- (a) In the case of an application under subsection (1), any person interested; and
 - (b) In the case of an application under subsection (2), the patentee and either additionally or alternatively any person interested;

may give notice to the Registrar of opposition to the cancellation.

- (6) Where any such notice of opposition is given, the Registrar shall fix a date for the hearing of the application and shall advise in writing the parties of the date so fixed, and shall, after giving the applicant and the opponent an opportunity to be heard, give such decision on the application as he may consider just.

- (7) An application made under this section for the cancellation of the endorsement of a patent of addition shall be treated as an application for the cancellation of the endorsement of the patent for the main invention also, and an application made under this section for the cancellation of the endorsement of a patent in respect of which a patent of addition is in force shall be treated as an application for the cancellation of the endorsement of the patent of addition also.

- (8) An appeal shall lie for any decision of the Registrar under this section.

- 37.** (1) Subject to subsection (14), any person interested who can show that he has been unable to obtain a licence under a patent on reasonable terms may, after the expiration of a period of three years subsequent to the date of which that patent was sealed, or four years subsequent to the date on which the application in respect thereof was lodged whichever manner for a compulsory licence on the ground that the reasonable requirements of the public with respect to the invention in question have not been or will not be satisfied.

**Compulsory
licence in case of
abuse or
insufficient use of
patent rights.**

(2) Every application under this section shall set out fully the nature of the applicant's interest, the facts on which he bases his case and the relief he seeks, and shall be accompanied by an affidavit verifying the facts set out in such application.

(3) If, after consideration of any such application, the Registrar is satisfied that the applicant has *bona fide* interest, and that a *prima facie* case for relief has been made out, he shall direct the applicant to serve copies of the application and of the relevant affidavit upon the patentee and upon any other person appearing from the register to be interested in the patent, and to advertise the application in the prescribed manner.

(4) If the patentee or any other person wishes to oppose the grant of a licence under this section, he may within the prescribed period, or within such further period as the Registrar may on application allow, deliver to the Registrar a counter statement, verified by affidavit, setting out fully the grounds on which the application is opposed, and shall at the same time serve upon the applicant copies of the counter statement and of such affidavit.

(5) When, in relation to an application or an opposition thereto, the foregoing provisions of this section have been complied with to the extent therein required, the Registrar shall hand all relevant papers to the registrar of the Patents Tribunal, who shall arrange for the matter to be heard by that Tribunal in the manner prescribed and, subject to this section, the Patents Tribunal may make such order therein as it deems just.

(6) The reasonable requirements of the public referred to in subsection (1) shall be deemed not to have been satisfied in any of the following circumstances, namely:-

- (a) If the patented invention, being an invention capable of being worked in Malawi, is not being worked therein on a commercial scale and there is no satisfactory reason for such non-working;

Provided that, if an application for a compulsory licence is made on this ground and the Patents Tribunal is of the opinion that the time which has elapsed since the sealing of the patent has by reason of the nature of the invention or for any other reason been insufficient to enable the invention to be worked within Malawi on a commercial scale, the Patents Tribunal may make an order adjourning the hearing of the application for such period as will in its opinion be sufficient for that purpose;

- (b) If the working of the invention within Malawi on a commercial scale is being prevented or hindered by the importation of the patented article by the patentee or persons claiming under him, or by reasons directly or indirectly purchasing from him or by persons against whom the patentee is not taking or has not taken proceedings for infringement;
- (c) If the demand for the patented article in Malawi is not being met to an adequate extent and on reasonable terms;
- (d) If by reason of the refusal of the patentee to grant a licence or licences upon reasonable terms, the trade or industry of Malawi or the trade of any person or class of persons trading in Malawi, or the establishment of any new trade or industry in Malawi, is being prejudiced, and it is in the public interest that a licence or licences should be granted.

- (e) If any trade or industry in Malawi, or any person or class of persons engaged therein, is being prejudiced by unfair conditions attached by the patentee, whether before or after the date of commencement of this Act, to the purchase, hire, licence or use of the patented article, or to the using or working of the patented process;
- (f) If an condition which under section 49 is null and void as being in restraint of trade and contrary to public policy, has been inserted in any contract made in relation to the sale or lease of or any licence to use or work any article or process protected by the patent:

Provided that, for the purpose of determining whether there has been any abuse of the monopoly rights under a patent, due regard shall be had to the fact that patents are granted not only to encourage invention but also to secure that inventions shall so far as possible be worked on a commercial scale in Malawi without undue delay.

(7) The Patents Tribunal may order the grant to the applicant of a licence on such terms as it may think expedient, including a term precluding the licensee from importing into Malawi any goods whereof the importation by persons other than the patentee or persons claiming under him, would be an infringement of the patent.

(8) If in respect of an application under this section the Patents Tribunal is satisfied that the invention which is the subject of the application is not being worked on a commercial scale within Malawi, and is such that it cannot be so worked without the expenditure of capital for the raising of which it will be necessary to rely on the patent monopoly, it may, unless the patentee or those claiming under him will undertake to find such capital, order the grant to the applicant or any other person, or to the applicant jointly with one or more other persons, if able and willing to provide such capital, of an exclusive licence on such terms as the Patens Tribunal may think just, but subject as hereinafter provided.

(9) The terms of any exclusive licence ordered to be granted under subsection (8) shall, with due regard to the risks to be undertaken by the licensee in providing the capital and working the invention, be so framed as:-

- (a) To secure to the patentee the maximum royalty compatible with the successful working of the invention within Malawi on a commercial scale and at a reasonable profit;
- (b) To guarantee to the patentee a minimum yearly sum by way of royalty, if and so far as it is reasonable to do so;

LAWS OF MALAWI

Patents

Cap. 49:02

- (i) Work the invention within the time specified in the order;
- (ii) Expend the amount specified in the licence as being the amount which he is able and willing to provide for the purpose of working the invention on a commercial scale within Malawi; or
- (iii) Pay to the patentee the royalties payable in terms of the licence.

(10) In deciding to whom an exclusive licence is to be granted, the Patents Tribunal shall, unless good reason is shown to the contrary, prefer an existing licensee to a person who, according to the register, has no interest in the patent.

(11) The order directing the grant of an exclusive licence under this section shall operate to divest the patentee of any right which he may have as patentee to work or use the invention, and to revoke all existing licences, unless otherwise provided in the order, and may, if considered fair and equitable by the Patents Tribunal, be made subject to the condition that the licensee shall give proper compensation to be fixed by the Patents Tribunal for any money or labour expended by the patentee or any existing licensee in developing or working the invention.

(12) A licensee under this section shall be entitled to call upon the patentee concerned to institute any proceedings which may be necessary to prevent infringement of the patent in question and shall in all other respects have the same rights as any other licensee, and if the patentee fails within two months after being called upon by the licensee, or within such further period as the Patents Tribunal may allow, to institute any such proceedings, the licensee may himself institute such proceedings as if he were the patentee, making the patentee a defendant, but the patentee shall not be liable for any costs in connection with such proceedings unless he enters an appearance and takes part in those proceedings.

(13) The existence of a compulsory licence solely on the ground that an invention is not being worked in Malawi on a commercial scale shall not preclude the grant of further licences (including compulsory licences) in respect of that invention, but the holder of any compulsory licence shall not be entitled to transfer that licence or grant a sub licence thereunder except to a person to whom the business or the part of the business in connection with which the rights under the licence were exercised, has been transferred.

(14) Except in the case of a licence to be granted under subsection (8), no licence shall be granted in terms of this section or of section 38 while the relevant patent remains endorsed "licences of right" under section 35.

LAWS OF MALAWI

Patents

Cap. 49:02

(15) For the purposes of this section, the expression “**patented article**” includes any article made by a patented process.

Inventions relating to food or certain other commodities.

38. (1) Subject to section 37(14) and without prejudice to the other foregoing provisions of this Act, where a patent is in force in respect of:-

- (c) a substance capable of being used as food or medicine, or in the production of food or medicine;
- (d) a process for producing such a substance as aforesaid; or
- (e) any invention capable of being used as or as part of a surgical or curative device,

the Patents Tribunal shall, on application made to it by any person interested, order the grant to the applicant of a licence under the patent on such terms as it thinks fit unless it appears to SUCH Tribunal that there are good reasons for refusing the application.

(2) In settling the terms of licences under this section the Patents Tribunal shall endeavor to secure that food, medicines, and surgical and curative devices shall be available to the public at the lowest prices consistent with the patentees deriving a reasonable advantage from their patent rights.

(3) A licence granted under this section shall entitle the licensee to make, use, exercise and vend the invention as a food or medicine, or for the purposes of the production of food or medicine or as part of a surgical or curative device, but for no other purposes.

Supplementary provisions as to licences.

39. (1) Any order under this Act for the grant of a licence shall, without prejudice to any other method of enforcement, have effect as if it were an agreement executed by the patentee and all other necessary parties granting a licence in accordance with the order.

(2) No order shall be made in pursuance of any application under section 37 which would be at variance with the Convention.

40. (1) Notwithstanding anything in this Act, any Government department or any person authorized in writing by the Minister may make, use or exercise any invention disclosed in any specification lodged at the Patent Office for the service of the Government in accordance with this section.

Use of patented inventions for services of the Government.

(2) If and so far as the invention has, before the effective date of the relevant claim of the complete specification, been duly recorded by or tried by or on behalf of a Government department or a person authorized in terms of subsection (1) otherwise than in consequence of the communication thereof directly or indirectly by the patentee or any person from whom he derives title, any use of the invention by

virtue of this section may be made by such Government department or person free of any royalty or other payment to the patentee.

LAWS OF MALAWI

Patents

Cap. 49:02

- (3) If and so far as the invention has not been so recorded or tried as aforesaid, any use of the invention made by virtue of this section at any time after the acceptance of the complete specification in respect of the patent, or in consequence of any such communication as aforesaid, shall be made upon such terms as may be agreed upon, either before or after the use, between the Minister and the patentee with the approval of the Minister of Finance, or as may in default of agreement be determined by the Patents Tribunal on a reference under section 42(1).
- (4) The authority of the Minister in respect of an invention may be given under this section either before or after the patent is granted and either before or after the acts in respect of which the authority is given are done, and may be given to any person, whether or not he is authorized directly or indirectly by the patentee to make, use, exercise or vend the invention.
- (5) Where any use of an invention is made by or with the authority of the Minister under this section, then, unless it appears to him that it would be contrary to the public interest so to do, the Minister shall notify the patentee as soon as practicable after the use is begun, and furnish him with such information as to the extent of the use as he may from time to time require.
- (6) For the purposes of this section, section 41 and section 42, any use of an invention for the supply to the government of any other country, in pursuance of any agreement or arrangement between the Government of Malawi and the government of that country, of articles required for the defence of that country shall be deemed to be a use of the invention for the services of the Government, and the power of a Government department or a person authorized by the Minister under this section to make, use and exercise an invention shall include power:-
 - (a) To sell such articles to the government of any country in pursuance of any such agreement or arrangement as aforesaid: and
 - (b) To sell to any person any articles made in the exercise of the powers conferred by this section which are no longer required for the purpose for which they were made.
- (7) The purchaser of any articles sold in the exercise of powers conferred by this section, and any person claiming through him, shall have power to deal with them in the same manner as if the patent were held on behalf of the Government.
- (8) The Minister may make regulations governing the rights of third parties in relation to any use of a patented invention, or an invention in respect of which an application for a patent is pending, made for

the services of the Government in terms of this section or section 41.

LAWS OF MALAWI

Patents

Cap. 49:02

Special provisions
as to Government
use during
emergency.

- 41.** (1) For the purposes of this section, the expression “period of emergency” means any period beginning on such date as may be declared by the Minister by notice published in the *Gazette* to be the commencement, and ending on such date as may be so declared to be the termination, of a period of emergency.
- (2) During any period of emergency the powers exercisable in relation to an invention by a Government department, or a person authorized by the Minister under section 40, shall include power to make, use, exercise and vend the invention for any purpose which appears to the Minister to expedient:-
- (a) For the efficient prosecution of any war in which Malawi may be engaged;
 - (b) For the maintenance of supplies and services essential to the life of the community;
 - (c) For securing a sufficiency of supplies and services essential to the well being of the community;
 - (d) For promoting the productivity of industry, commerce and agriculture;
 - (e) For fostering and directing exports and reducing imports or imports of any classes, from all or any countries and for redressing the balance of trade;
 - (f) Generally for ensuring that the whole resources of the community are available for use, and are used, in a manner best calculated to serve the interests of the community; or
 - (g) For assisting the relief of suffering and the restoration and distribution of essential supplies and services in any part of Malawi or an other countries that are in grave distress as the result of war;

and any reference in that section or in section 42 to the services of the Government shall be construed as including a reference to the purposes aforesaid.

Reference of
disputes as to
Government use.

- 42.** (1) Any dispute as to:-
- (a) the exercise by a Government department or a person authorized by the Minister of the powers conferred by section 40;

- (b) the terms for the use of an invention for the services of the Government thereunder;

LAWS OF MALAWI

Patents

Cap. 49:02

- (c) the compensation payable upon a reference to the Patents Tribunal under section 24(5); or
- (d) the right of any person to receive any part of a payment determined in terms of paragraph (b) or (c);

may be referred to the Patents Tribunal by any party to the dispute in such manner as may be prescribed.

- (2) In any proceedings under this section to which a Government department is a party, the Minister may:-

- (a) If the patentee is a party to the proceedings, apply for revocation of the patent upon any ground upon which a patent may be revoked under section 50;

- (b) In any case, put in issue the validity of the patent without applying for its revocation.

- (3) If in such proceedings as aforesaid any question arises whether an invention has been recorded or tried as mentioned in section 40, or has been used by or on behalf of or to the order of a Government department under section 24(4), and the disclosure of any document recording the invention, or of any evidence of the trial or use thereof, would, in the opinion of the Minister, be prejudicial to the public interest, the disclosure may be made confidentially to counsel appearing for the other party or to an independent expert agreed upon by the parties.

- (4) In determining under this section any dispute between a Government department and any person as to terms for the use of an invention for the services of the Government, the Patents Tribunal shall have regard to any benefit or compensation which that person or any person from whom he derives title may have received, or may be entitled to receive, directly or indirectly from any Government department in respect of the invention in question.

**PART V
SPECIAL PROVISIONS RELATING TO SPECIFICATIONS, ANTICIPATION
AND RIGHTS IN INVENTIONS**

Amendment of
specification by
Registrar

- 43.** (1) An applicant for a patent or a patentee may at any time by request in writing lodged at the Patent Office seek leave to amend either his provisional or his complete specification, including drawings forming part thereof, and shall in making any such request state the nature of the proposed amendment and the reasons therefore.

LAWS OF MALAWI

Patents

Cap. 49:02

- (2) Where there are joint applications or patentees, the request shall be made by them jointly or by one or more of them with the written consent of the other or others, and in the case of disagreement between them the Registrar may, if satisfied that one or more of them should be allowed to proceed alone and subject to such conditions as he may impose, permit the request to be made without the consent of the others:-

Provided that all parties interested shall be notified by the applicant of the request and be entitled to be heard before any decision is given thereon.

- (3) An amendment of an accepted complete specification shall be allowed only if it is by way of disclaimer, correction or explanation, and no amendment of any specification, except by way of correcting an obvious mistake, shall be allowed if the result would be that the specification as amended would claim or describe matter not in substance disclosed in the specification before amendment, or would include any claim wholly within the scope of a claim included in the specification before amendment.
- (4) The request for an amendment of an accepted complete specification and its nature shall be advertised by the applicant in the prescribed manner, and at any time within three months of the advertisement, or such further time as the Registrar, subject to such conditions as he may impose, may allow, any person may give notice at the Patent Office of opposition to the amendment.
- (5) Notice of opposition shall be given in the prescribed manner to the Registrar and to the person making the request, and the Registrar shall hear the person making the request and the person who has given notice of opposition and determine whether and subject to what conditions, if any, the amendment ought to be allowed.
- (6) Where a complete specification has not been accepted or, if it has been accepted, no notice of opposition has been given or any such notice has been withdrawn, the Registrar shall determine whether and subject to what conditions, if any the amendment out to be allowed.
- (7) No request for amendment under this section shall be allowed if and so long as any proceedings are pending for infringement or revocation of the patent in question.
- (8) An appeal shall lie from any decision of the Registrar made under this section.

LAWS OF MALAWI

Patents

Cap. 49:02

44. In any action for infringement of a patent or any proceedings before the Patents Tribunal for the revocation of a patent, the Court or the Patents Tribunal, as the case may be, may, subject to section 43(3), allow the patentee to amend his complete specification in such manner and subject to such terms as to costs, advertisement or otherwise as the Court or the Patents Tribunal may think fit, and, if in any such proceedings for revocation the Patents Tribunal decides that the patent is invalid, it may allow the specification to be amended under this section instead of revoking the patent.

Amendment of specification with leave of Court or Patents Tribunal.

45. Where an amendment of a specification by way of disclaimer, correction or explanation has been allowed under this Act after the publication of the specification, no damages shall be awarded in any proceedings in respect of the use of the invention before the date of the decision allowing the amendment, unless the Court or the Patents Tribunal is satisfied that the specification as originally published was framed in good faith and with reasonable skill and knowledge.

Restrictions on recovery of damages in certain cases.

46. (1) A patent shall not be refused or held to be invalid by reason only of the fact that the invention in respect of which the patent is applied for or was granted or any part thereof was published, used or known prior to the effective date of the application, if the applicant or the patentee, as the case may be, proves that the knowledge was acquired or the publication or use was made without his knowledge or consent, and that the knowledge or the matter published or used was derived or obtained from him, and, if he learnt of the disclosure, use or knowledge before the effective date of his application for the patent, that he applied for and obtained protection for his invention with all reasonable diligence after learning of the disclosure.

Savings for anticipation.

Provided that the protection afforded by this section shall not extend to a patentee or an applicant for a patent who has or whose predecessors in title have prior to the effective date of the application worked the invention in Malawi commercially, otherwise than for the purpose of reasonable technical trial thereof.

(2) An invention claimed in a complete specification shall not be deemed to have been anticipated by reason only of the communication of the invention to a Government department or to any person authorized by the Minister to investigate the invention or its merits, or of anything done by any person whomsoever in consequence of such a communication, for the purpose of the investigation.

Co-ownership of patents.

47. (1) Where a patent is granted to two or more persons, each of those persons shall, unless an agreement to the contrary is in force, be entitled to an equal undivided share in the patent.

(2) Subject to this section where two or more persons are registered as patentees, then, an agreement to the contrary is in force, each of those persons shall be entitled by himself for his agents, to make, use,

exercise and vend the patented invention for his own benefit without accounting to the other or others.

LAWS OF MALAWI

Patents

Cap. 49:02

- (3) Subject to subsections (6), (7) and (8) and to any agreement for the time being in force, a licence under a patent shall not be granted and a share in a patent shall not be assigned, except with the consent of all persons, other than the licensor or assignor, who are registered as patentees.
- (4) Where a patented article is sold by one of two or more persons registered as patentees the purchaser and any person claiming through him shall in respect of such article be entitled to deal with it in the same manner as if it has been sold by a sole patentee.
- (5) Subject to this section, the rules of law applicable to the ownership and devolution of movable or personal property generally shall apply in relation to patents as they apply in relation to other incorporeal rights or choses in action.
- (6) Where two or more persons are registered as patentees, the Registrar may, upon application made to him in the prescribed manner by any of those persons, give such directions in accordance with the application as to the sale or lease of the patent or any interest therein, the grant of licences under the patent or the exercise of any right under subsections (1) to (5) inclusive in relation thereto, as he thinks fit.
- (7) If any person registered as patentee fails to execute any instrument or to do any other thing required for the carrying out of any direction given under this section within fourteen days after being requested in writing so to do by any of the other persons so registered, the Registrar may, upon application made to him in the prescribed manner by any such other person, give directions empowering any person to execute that instrument or to do that thing in the name and on behalf of the person in default.
- (8) Before giving directions in pursuance of an application under subsection (6) or (7), the Registrar shall give an opportunity to be heard:-
 - (a) In the case of an application under subsection (6), to the other person or persons registered as patentees;
 - (b) In the case of an application under subsection (7), to the person in default.
- (9) An appeal shall lie from any decision of the Registrar under this section.
- (10) No directions shall be given under this section so as to affect the mutual rights or obligations of trustees or of the legal representatives

of a deceased person, or their rights or obligations as such.

LAWS OF MALAWI

Patents

Cap. 49:02

Disputes as to inventions made by employees.

- 48.** (1) Where a dispute arises between an employer and a person who is or was at the material time his employee as to the rights of the parties in respect of an invention made by the employee either alone or jointly with other employees or in respect of any patent granted or to be granted in respect thereof, the Registrar may, upon application made to him in the prescribed manner by either or the parties, and after giving to each of them an opportunity to be heard, determine the matter in dispute, and may make such orders for giving effect to his decision as he considers expedient.
- (2) In proceedings before the Patents Tribunal between an employer and a person who is or was at the material time his employee, or upon an application made to the Registrar under subsection (1), the Patents Tribunal or Registrar, as the case may be, may unless satisfied that one or other of the parties is entitled, to the exclusion of the other, to the benefit of an invention made by the employee, by order provide for the apportionment between them of the benefit of the invention, and of any patent granted or to be granted in respect thereof, in such manner as the Patents Tribunal or Registrar considers just.
- (3) A decision of the Registrar under this section shall have the same effect as between the parties and persons claiming under them as a decision of the Patents Tribunal.
- (4) An appeal shall lie from any decision of the Registrar under this section.
- 49.** (1) It shall not be lawful in any contract made after the date of commencement of this Act in relation to the sale or lease of or a licence to use or work any article or process protected by a patent to insert a condition the effect of which will be:-
- (a) to prohibit or restrict the purchaser, lessee or licensee from using any article or class of articles, whether patented or not, or any patented process, supplied or owned by any person other than the seller, lessor or licensor or his nominee; or
- (b) to require the purchaser, lessee or licensee to acquire from the seller, lessor or licensor or his nominee any article or class of articles not protected by the patent;

Avoidance of certain restrictive conditions in contracts.

and any such condition shall be null and void, as being in restraint of trade and contrary to public policy:

Provided that this subsection shall not apply if:

- (i) the seller, lessor or licensor proves that at the time the contract was entered into the purchaser, lessee or licensee had the option of purchasing the article

or obtaining a lease or licence on reasonable terms without such conditions as aforesaid; and
LAWS OF MALAWI

Patents

Cap. 49:02

- (ii) the contract entitle the purchaser, lessee or licensee to relieve himself of his liability to observe any such condition on giving the other party three months' notice in writing and on payment, if the Registrar so directs, or compensation for such relief, in the case of a purchase of such sum, or in case of a lease or licence of such rent or royalty for the residue of the term of the contract, as may be fixed by the Registrar.

An appeal shall lie from any decision of the Registrar under proviso (ii).

- (2) Any contract relating to the lease of or licence to use or work any patented article or patented process may, at any time after the patent or all the patents by which the article or process was protected in Malawi at the time of the making of the contract has to have ceased to be in force, and notwithstanding anything to the contrary in the same or in any other contract, be determined by either party on giving three months' notice in writing to the other party.
- (3) Nothing in this section shall:-
 - (a) Affect any condition in a contract whereby any person is prohibited from selling any goods other than those of a particular person;
 - (b) Be construed as validating any contract which would, apart from this section, be invalid;
 - (c) Affect any right of determining a contract or condition in a contract exercisable independently of this section;
 - (d) Affecting any condition in a contract for the lease of or a licence to use a patented article, whereby the lessor or licensor reserves to himself or his nominee the right to supply such new parts of the patented article as may be required to put or keep it in repair.

Revocation of patents.

50. (1) Application for revocation of a patent may be made to the Patents Tribunal by any person interested, including the Government, upon any one or more of the grounds on which the grant of a patent might have been opposed, but, subject to subsection (2), proviso (ii) to section 8 (7)(b), and section 10(1)(b), on no other grounds.

(2) Where an order for the granting of a licence under the patent has been made in pursuance of an application under section 37 any person interested may, at any time after the expiration of two years from the date of that order, apply to the Patents Tribunal for the revocation of the patent upon any of the grounds specified I subsection (6) of the said section 37; and if upon such application

the Patents Tribunal is satisfied:-

LAWS OF MALAWI

- (a) That any of the said grounds are established; and
- (b) That the purpose for which an order may be made in pursuance of an application under the said section 37 could not be achieved by the making of any further order under that section.

It may order the patent to be revoked

- (2) Any such application shall state the grounds on which the applicant relies, and shall be accompanied by a statement setting out particulars of the facts alleged in support of the said grounds, and a copy of the application and of the statement shall be served by the applicant on the patentee and proof of such service shall be furnished to the Registrar.
- (3) If the patentee wishes to contest the application made in terms of subsection (1) or subsection (2), he shall within such time as may be prescribed, or such further time as the Patents Tribunal may allow, lodge at the Patent Office a counterstatement setting out particulars of the grounds upon which the application is contested and deliver to the applicant a copy of that statement.
- (4) Except by leave of the Patents Tribunal, no evidence shall be admitted in proof of any ground, particulars of which are not delivered as aforesaid.
- (5) Particulars delivered may from time to time be amended by leave of the Patents Tribunal.
- (6) The Patents Tribunal shall appoint a time for the hearing of any such application, and shall thereafter decide whether the patent shall be revoked or whether and, if so, subject to what amendments, if any, of the specification or claims thereof, the patent shall be upheld:-

Provided that the Patents Tribunal:-

- (a) Shall not allow any amendment of the specification or claims as aforesaid if it is established to its satisfaction that the original complete specification and claims were not framed in good faith and with reasonable skill and knowledge; and
- (b) May, in the exercise of its discretion as to costs, take into consideration the conduct of the patentee in framing his original specification and claims and permitting them to remain as so framed.

LAWS OF MALAWI

Patents

Cap. 49:02

- 51.** (1) Where a patent is revoked on the ground of fraud, or a patent fraudulently obtained has been surrendered and revoked, or the grant of a patent has been refused under section 22(1)(b), the patents Tribunal may, on the application of the person entitled to the invention for Malawi or his legal representative, made in accordance with this Act, direct the grant to him of a patent for the whole or any part of the invention, bearing the same date as the patent so revoked or as would have been borne by the patent which has been refused, if the grant thereof had not been refused.
- (2) Where in proceedings before the Patents Tribunal in connection with opposition to the grant of a patent, the Patents Tribunal has found that an invention was in part obtained from the objector and has required that the specification be amended by the exclusion of that part of the invention, the Patents Tribunal may direct that, on the application of the inventor or any person claiming through or under him made in accordance with this Act within three months after the date of the direction or within such further period as the Patents Tribunal may allow, a patent for that excluded part of the invention bearing the date of an having the same effective date as the opposed application be granted to the applicant concerned.
- (3) No action shall be brought for any infringement of a patent committed:-
- (a) In the case of a patent granted under subsection (1), before the date of sealing thereof; or
- (b) In the case of a patent granted under subsection (2), before the date of advertisement of acceptance of the complete specification lodged in pursuance of the application for such patent.
- 52.** (1) A patentee may at any time by notice given to the Registrar offer to surrender his patent.
- (2) Where such an offer is made the patentee shall advertise the offer in the prescribed manner, and within the prescribed period after such advertisement any person interested may give notice to the Registrar of opposition to the surrender.
- (3) Where any such notice of opposition is duly given the Registrar shall notify the patentee.
- (4) If the Registrar is satisfied, after hearing the patentee and any opponent, if desirous of being heard, that the patent may properly be surrendered he may accept the offer and by order revoke the patent.
- (5) An appeal shall lie from any decision of the Registrar under this

Consequences of revocation on grounds of fraud.

Surrender of patents.

section.

LAWS OF MALAWI

Patents

Cap. 49:02

**PART VI
INFRINGEMENTS**

53. (1) An action for infringement of a patent may only be instituted by the patentee or the exclusive licensee. Such action shall be heard and determined by the High Court and, subject to any rules made under section 81, the following provisions shall apply in connection therewith, namely:-

Procedure and conditions in action for infringement.

- (a) any ground upon which a patent may be revoked under this Act may be relied upon by way of defence;
- (b) the defendant may, by way of counter-claim in the action, apply for the revocation of the patent;
- (c) the plaintiff shall, with his statement of claim or declaration or on the order of the Court at any subsequent time, deliver full particulars of the infringement complained of;
- (d) the defendant shall, with his statement of defence or plea or on the order of the Court at any subsequent time, deliver particulars of any objections on which he relies in support thereof;
- (e) at the hearing no evidence shall, except by leave of the Court, be admitted of any infringement or on any objections of which particulars have not been so delivered.
- (f) The Court may allow the patentee to amend his specification, subject to such terms as to costs, advertisement or otherwise as it may impose and to section 43(3)

(2) In any action under this section where an exclusive licensee is the plaintiff, the patentee shall, unless he is joined as plaintiff in such action, be added as defendant:

Provided that a patentee so added as defendant shall not be liable for any costs unless he enters an appearance and takes part in the proceedings.

(3) If the patentee is the plaintiff in any such action, he shall give notice thereof to the exclusive licensee under the patent in question and any such licensee shall be entitled to intervene as a co-plaintiff and to recover any damages he may have suffered as a result of the infringement.

(4) No action under this section shall lie in respect of an infringement which took place before the publication referred to in section 21(2).

LAWS OF MALAWI

Patents

Cap. 49:02

- (5) In an action for infringement of a patent the plaintiff shall be entitled to relief by way of injunction and damages and the Court may, on application, make such order for an injunction, damages, inspection or account and impose such terms and give such directions as it may deem fit.
- (6) In an action for infringement of a patent in respect of an invention which relates to the protection of a new substance, any substance of the same chemical composition and constitution shall in the absence of proof to the contrary be deemed to have been produced by the patented process.

54. (1) Where, in any action for the infringement of a patent, the Court finds that any claim in the specification in respect of which the infringement is alleged is valid, but that any other claim thereunder is invalid, then, notwithstanding section 53, the following provisions shall apply, namely:-

**Relief for
infringement of
partially valid
specification.**

- (a) unless the Court is satisfied that the invalid claim was not framed in good faith and with reasonable skill and knowledge, the Court shall, subject to its discretion as to costs and as to the date from which damages should be reckoned, and to such terms as to amendment of the specification as it may deem desirable, grant relief in respect of any valid claim which is or has been infringed, without regard to the invalidity of any other claim in the specification, and in exercising such discretion the Court may take into consideration the conduct of the patentee in inserting the invalid claim in the specification or permitting that claim to remain there;
- (b) if the Court is so satisfied, it shall not grant any relief by way of damages or costs, but may grant such other relief in respect of any valid claim which is or has been infringed as to it seems just and may impose such terms as to amendment of the specification as a condition of granting any such relief as it may deem desirable.
- (c) If a counterclaim for revocation of the patent has been made in the action on the ground of invalidity of any claim in the specification, the Court may postpone the operation of any order made thereon for such time as may be requisite to enable the patentee to effect any amendment of the specification pursuant to terms imposed by the Court and may attach such other conditions to any order to be made on the counterclaim as the Court may deem desirable.

LAWS OF MALAWI

Patents

Cap. 49:02

- 55.** (1) In proceedings for the infringement of a patent, damages shall not be awarded against a defendant who proves that, at the date of the infringement, he was not aware, and had no reasonable grounds for supposing and had no reasonable means of making himself aware, that the patent existed, and the application to an article of the word “patent”, “patented”, or any word or words expressing or implying that a patent has been obtained for the article, shall not constitute such grounds or means unless the number and year of the patent accompanied the word or words in question.
- (2) If proceedings are taken in respect of infringement of a patent committed after the failure to pay any fee within the prescribed time and before any extension of time for such payment, the Court may, if it thinks fit, refuse to award any damages in respect of such infringement.
- (3) Nothing in this section shall affect the power of the Court to grant an injunction in any proceedings for the infringement of a patent.
- 56.** (1) Where any person (whether entitled to or interested in a patent or an application for a patent or not) by circulars, advertisements or otherwise threatens any other person with proceedings for infringement of a patent, any person aggrieved thereby may in the prescribed manner bring an action against him in the High Court for any such relief as is mentioned in subsection (2).
- (2) Unless in any action brought by virtue of this section the defendant proves that the acts in respect of which proceedings were threatened constitute or, if done, would constitute, an infringement of a patent or of rights arising from the publication of a complete specification in respect of a claim of the specification not shown by the plaintiff to be invalid, the plaintiff shall be entitled to the following relief, that is to say:-
- (a) A declaration to the effect that the threats are unjustifiable;
- (b) An injunction against the continuance of the threats; and
- (c) Such damages, if any, as he has sustained thereby.
- (3) For the avoidance of doubts, it is hereby declared that a mere notification of the existence of a patent does not constitute a threat of proceedings within the meaning of this section.
- (4) The defendant in any such action as aforesaid may apply, by way of counterclaim in the action, for any relief to which he would be entitled in a separate action in respect of any infringement by the plaintiff of the patent to which the threats relate.
- 57.** (1) A declaration that the use by any person of any process, or the making or use or sale by any person of any article, does not or would not constitute an infringement of a claim of a patent may be made by the High Court in proceedings between that person and the patentee or the holder of an exclusive licence under the patent, notwithstanding that no assertion to the contrary has
- Restrictions of recovery of damages for infringement.**
- Remedy for groundless threat of infringement proceedings.**
- Power of Court to make declaration as to non-infringement.**

been made by the patentee or licensee, if it is shown:-

LAWS OF MALAWI

Patents

Cap. 49:02

- (a) that the plaintiff has applied in writing to the patentee or licensee for a written acknowledgement to the effect of the declaration claimed, and has furnished him with full particulars in writing of the process or article in question; and
 - (b) that the patentee or licensee has refused or neglected to give such an acknowledgement.
- (2) The costs of all parties in proceedings for a declaration brought by virtue of this section shall be ordered as the Court may deem fit:

Provided that a patentee or holder of an exclusive licence under the patent shall not be liable for any costs unless he enters an appearance and takes part in the proceedings.

- (3) The validity of a claim of the specification of a patent shall not be called in question in proceedings for a declaration brought by virtue of this section, and accordingly the making or refusal of such a declaration in the case of a patent shall not be deemed to imply that the patent is valid.
- (4) Proceedings for a declaration may be brought by virtue of this section at any time after the date of the notice of the acceptance of the complete specification in pursuance of an application for a patent, and references in this section to the patentee shall be construed accordingly.

**PART VII
ASSIGNMENT AND CORRECTIONS**

- 58.** (1) A Subject to section 31(7), the rights granted to a patentee by a patent shall be capable of assignment and of devolution by operation of law and of being mortgaged and pledged.
- (2) Where any person becomes entitled by assignment, transmission or operation of law to a patent or to a share in a patent, or becomes entitled as mortgagee, licensee or otherwise to any other interest in a patent, he may apply to the Registrar in the prescribed manner for the registration of his title as proprietor or co-proprietor, or as the case may be, of notice of his interest, in the register, and the Registrar shall, upon proof of such entitlement to his satisfaction, register such title or notice against the patent accordingly.
 - (3) Except for the purposes of an application to rectify the register under this Act, a document in respect of which no entry has been made in the register under subsection (2) shall not be admitted in any proceedings as evidence of the title of any person to a patent, or a share of or interest in a patent, unless the Patents Tribunal or Court concerned otherwise directs.

**Provisions as to
assignments**

LAWS OF MALAWI

Patents

Cap. 49:02

- 59.** (1) The Registrar may authorize:
- (a) the correction of any clerical error or omission, or error in translation in any patent, application for a patent or document lodged in pursuance of such an application, or in the register;
 - (b) the amendment otherwise of any documents for the amending of which no express provision is made in this Act;
 - (c) the condonation or correction of any irregularity in procedure in any proceedings before him, if such condonation or correction is not detrimental to the interests of any person.
- (2) A correction may be made in pursuance of this section, either upon a request in writing accompanied by the prescribed fee or without such a request.
- (3) Where it is proposed to make a correction otherwise than upon such a request, the Registrar shall give notice of the proposal to the patentee or the applicant for the patent, as the case may be, and to any other person who appears to him to be concerned, and shall give any such person an opportunity of being heard before the correction is made.
- (4) Where a request is made for the correction of any such clerical error or omission and it appears to the Registrar that the correction would materially alter the scope of the document to which the request relates, the Registrar may require notice of the request to be advertised in the prescribed manner and to be served upon such persons as he considers necessary.
- (5) Any opposition to the request for such correction may be lodged and shall be dealt with by the Registrar in the manner prescribed.
- (6) An appeal shall lie from any decision of the Registrar under this section.
- 60.** (1) The Patents Tribunal may, on the application of any person aggrieved, order the register to be rectified by the making of any entry therein or the variation or deletion of any entry therein.
- (2) The Patents Tribunal may determine any question which it may be necessary or expedient to decide in connection with the rectification of the register.
- (3) Notice of any application to the Patents Tribunal under this section shall be given in the prescribed manner to the Registrar and all interested parties, and the Registrar and all such parties shall be entitled to appear and be heard on the application.

Power of Registrar to authorize corrections.

Rectification of register.

**PART VIII
FUNCTIONS OF REGISTRAR IN RELATION TO CERTAIN EVIDENCE,
DOCUMENTS AND POWERS**

- 61.** (1) A certificate purporting to be signed by the Registrar and certifying that any entry which he is authorized by or under this Act to make has or has not been made, or that any other thing which he is so authorized to do has not been done, shall *prima facie* evidence of the matters so certified. **Evidence of certain entries and documents.**
- (2) A copy of any entry in any register or of any document kept in the Patent Office or of any patent, or an extract from any such register or document, certified by the Registrar and sealed with the seal of the Patent Office, shall be admitted in evidence without further proof and without production of the original.
- 62.** The Registrar shall, on the request of any person and on payment of the prescribed fee, furnish copies of any documents which are open to public inspection and which are lodged at the Patent Office or particulars from the register, or furnish a certificate in respect thereof. **Request for information as to patent or patent application.**
- 63.** Where the Registrar is satisfied that a patent has been lost or destroyed or cannot be produced, he may at any time cause a duplicate thereof to be sealed on payment of such fees as may be prescribed. **Loss or destruction of patent.**
- 64.** (1) Without prejudice to any provisions of this Act requiring the Registrar to hear any party to proceedings thereunder, or give to any such party an opportunity to be heard, the Registrar shall give to any applicant for a patent, or for amendment of a specification, an opportunity to be heard before exercising adversely to the applicant any discretion vested in the Registrar by or under this Act. **Exercise of discretionary powers of Registrar.**
- (2) Subject to section 80(2), where by this Act any time is specified within which any act or thing is to be done, the Registrar may, save where it is expressly otherwise provided, extend the time, either before or after its expiration, if he is satisfied that the failure to comply with the provisions relating to such time has not been or will be due to any neglect or default on the part of the person concerned.
- 65.** (1) Evidence in any proceedings before the Registrar under this Act shall be given by affidavit, so, however, that the Registrar may, if he thinks fit in any particular case, take oral evidence on oath in lieu of or in addition to such evidence as aforesaid, and may allow any witness to be cross examined on his affidavit or oral evidence. **Proceedings before Registrar.**
- (2) The powers, rights and privileges of the Registrar in proceedings before him under this Act shall be the same as those conferred upon commissioners by the Commissions of Inquiry Act and sections 9, 10 and 12 of that Act shall, *mutatis mutandis*, apply in relation to the hearing and determination of any matter before the Registrar under this Act and to any person summoned to give evidence or giving **Cap. 18:01**

evidence before him.

LAWS OF MALAWI

Patents

Cap. 49:02

- 66.** No advertisement or notice, other than a notice issued under the authority of the Minister, shall be published by any person under this Act unless it is in the prescribed form and the Registrar has approved the contents of such advertisement or notice, and no advertisement or notice which has not been so approved shall have any force or effect for the purposes of this Act.

Advertisements to be approved by Registrar.

**PART IX
PATENT AGENTS**

- 67.** (1) Subject to this Act, a patent agent may act as agent on behalf of any person in connection with any matter or proceeding before the Registrar under this Act and may draw and sign all documents and make all communications between an applicant and the Patent Office and may represent an applicant at all attendances before the Registrar.

Patent agents and their functions.

- (2.) A patent agent shall not be guilty of an offence under any law prohibiting the preparation for reward of certain documents by persons not legally qualified, by reason only of the preparation by him of any document relating to patents for use in the Patent Office or required in any proceedings under this Act before the Registrar or the Patents Tribunal.

- 68.** (1) The Registrar shall keep a register of patent agents in which the name of every person, immediately upon his being accepted for registration, shall be registered, showing against his name such particulars as the Registrar shall from time to time deem necessary and the Registrar shall enter in such register of patent agents all changes relating to registrations.

Qualification and registration of patent agents.

- (2.) Any person who:-
- (a) Has passed the prescribed examinations;
 - (b) Produces proof that he is a Fellow in good standing of the Chartered Institute of Patent Agents of the United Kingdom, incorporated by Royal Charter on the 11th August 1891;
 - (c) Produces proof that he is a British Oversea member in good standing of such Institute;
 - (d) Produces proof that he holds any qualification recognized by the Minister as being equivalent to the qualifications required for the purposes of paragraph (a), (b) or (c); or
 - (e) Is a legal practitioner and satisfies the Registrar that prior to the date* of commencement of the Patents (Amendment) Act, he has, within Malawi, performed the functions of a Patent Agent as set out in section 67 and has publicly described himself as a Patent Agent in Malawi,

58 of 1965

May make application to the Minister in the prescribed manner to be registered as a Patent Agent, and the Minister shall arrange such registration by the Registrar if he is satisfied that there is no good reason why it should not be arranged and that the applicant is not a person whose name could be removed from the register of Patent Agents under section 69(1), (b) (c) or (f):

Provided that:-

- (i) The Minister may refuse to arrange such registration without assigning any reason therefore;
- (ii) A public officer who has been employed in the patent office shall not be registered as a Patent Agent or be permitted to practice as such until at least twelve months have expired since he ceased to be so employed.

(3.) No appeal shall lie from any decision of the Minister made under subsection (2).

69. (1) Registrar may remove from the register of patent agents the name of any agent upon proof to his satisfaction that such patent agent:-

- (a) has died;
- (b) has become of unsound mind;
- (c) has been adjudged or otherwise declared bankrupt or insolvent under any law or has made an assignment to or composition with his creditors;
- (d) has ceased to maintain a place of business in Malawi
- (e) has applied for his name to be so removed;
- (f) has at any time been convicted (whether in Malawi or elsewhere) of theft, any offence involving an element of fraud, forgery, uttering a forged document, perjury or any similar offence, by whatever name called, and has been sentenced therefore to serve a term of imprisonment without the option of a fine, whether such sentence is suspended or not, and has not received a free pardon;
- (g) having been entitled to practise as a legal practitioner, or to be registered as a patent agent, has ceased to be so entitled; or
- (h) having been entitled to practise as a legal practitioner or a patent agent, has ceased to practise as such

Removal of names from register of patent agents.

An appeal shall lie from any decision of the Registrar made under this subsection.

- (2.) Subject to this section and such procedure as may be prescribed, the Patents Tribunal may order the Registrar to remove the name of any patent agent from the register of patent agents or may suspend any patent agent from practicing as such for such time as it thinks fit if it is satisfied, after due inquiry, that such person has been guilty of conduct discreditable to a patent agent or has been guilty of a breach of any regulations prescribed for the conduct of patent agents.
- (3.) No order shall be made by the Patents Tribunal in terms of subsection (2) unless the patent agent concerned has been given notice of any allegations made against him and has had an opportunity to adduce evidence and to be heard.
- (4.) Any institute or other organization recognized by the Minister as being representative of the patent agents in Malawi shall be entitled to be represented, to adduce evidence and to be heard by the Patents Tribunal before it makes any order in terms of subsection (2).
- (5.) Where the name of any patent agent has been removed from the register of patent agents under subsection (1) or (2), his name shall not be restored to that register except by direction of the Patent Tribunal, which may further direct that such restoration shall be made either without fee or on payment of such fee, not exceeding the registration fee, as it may fix, and the Registrar shall restore the name accordingly.

70. Every person entitled to practise as a legal practitioner may practise as a patent agent and perform the functions set out in section 67 without being registered as a patent agent, but no such person shall be entitled to be so registered except under section 68.

Privileges of legal practitioners.

71. (1) No person shall practise as a patent agent unless he is registered as such or is, by virtue of section 70, entitled so to practise.

Entitlement to practise as patent agent.

- (2.) A person shall be deemed to practise as a patent agent if he performs any of the functions of a patent agent set out in section 67 or if he carries on within Malawi the business of applying for or obtaining for other patents in Malawi or elsewhere.
- (3.) No person who is not a legal practitioner or registered as a patent agent shall describe himself as, or hold himself out to be, a patent agent or any term implying such a meaning, such as “**patent attorney**” or “**attorney for patents**”, nor shall he permit himself to be so described or held out.
- (4.) Any person who contravenes this section shall be guilty of an offence.

LAWS OF MALAWI

Patents

Cap. 49:02

- 72.** (1) No patent agent shall have an interest either as a partner or manager or otherwise in more than one firm of patent agents in Malawi.
- (2.) No patent agent shall practise under a name or title which includes the name of any person who is not or was not:-
- (a) In his lifetime ordinarily resident in Malawi; or
 - (b) Registered as a patent agent under this Act.
- (3.) No person shall practise as a patent agent if he is a party to:-
- (a) A contract of partnership; or
 - (b) An arrangement providing for the sharing or paying over of any professional fees;
- Relating to the business of a patent agent with any person who is prohibited from practicing as a patent agent.
- (4.) Any person who contravenes this section shall be guilty of an offence.

Prohibition of certain acts by patent agents.

**PART X
PATENTS TRIBUNAL AND APPEALS**

- 73.** Where this Act provides for appeals from decisions of the Registrar, all such appeals shall be made to the Patents Tribunal in accordance with this Part.
- 74.** (1) For the purposes of hearing and determining appeals in accordance with section 73 and of exercising the other powers conferred upon it by this Act, there is hereby established a Patents Tribunal, which shall consist of a Chairman appointed by the Minister.
- (2.) The Chairman shall be a person who:-
- (a) Has been a judge of a court having unlimited jurisdiction in civil and criminal matters in some part of the Commonwealth; or
 - (b) Is and has for not less than ten years been qualified and entitled to practise as an advocate or barrister in any court or courts having such jurisdiction.
- (3.) The Patents Tribunal shall sit at such times and places as it may appoint.
- (4.) There shall be paid to the Chairman such remuneration and allowances as the Minister may determine with the approval of the Minister of Finance.
- (5.) The Minister shall appoint a registrar of the Patents Tribunal and such other officers thereof as he may deem necessary.

Appeals from Registrar

Patents Tribunal.

LAWS OF MALAWI

Patents

Cap. 49:02

- 75.** (1) The Patents Tribunal shall, in connection with any proceedings before it under this Act, have all the powers of the High Court, and without prejudice to the foregoing and to the other powers conferred upon it by this Act, the Patents Tribunal shall have power to make any order for the purpose of securing the attendance of any person, the discovery or production of any document, or the investigation or punishment of any contempt of court, which the High Court has power to make.
- (2.) The procedure and practice of the Patents Tribunal shall, save as otherwise provided for by rules made under his part, be those prevailing in such High Court, in so far as the same are applicable, and if any matter should arise which is not contemplated by either such procedure, practice or rules, the Patents Tribunal may give instructions regarding the course to be pursued, which instructions shall be binding on all parties.
- (3.) Upon any appeal to the Patents Tribunal under this Part, such Tribunal may:-
- (a) Confirm, set aside or vary the order or decision in question;
 - (b) Exercise any of the powers which could have been exercised by the Registrar in the proceedings in connection with which the appeal is brought.
 - (c) Make such order as to costs as it may think fit.
- (4.) In any proceedings before it, the Patents Tribunal may, subject to section 91, accept evidence by affidavit or take oral evidence on oath and allow any witness to be cross-examined on his affidavit or oral evidence.
- 76.** In any proceedings before the Patents Tribunal under this Act the parties to such proceedings may appear in person or be represented and appear by a legal practitioner and, in any case where the Patents Tribunal deems fit, it may grant leave to the Registrar to intervene and he may thereafter appear or be so represented.
- 77.** (1) If any party to any proceedings before the Patents Tribunal is resident outside Malawi, the Patents Tribunal may, on the application of any other party to the proceedings, order that security to its satisfaction be lodged or given by the first mentioned party in respect of any costs which may be awarded against him in those proceedings and may refuse to permit such proceedings to be continued until such security has been lodged or given.
- (2.) Unless otherwise agreed between the parties, any costs awarded in terms of section 75(3) shall be taxed by the registrar of the Patents Tribunal in accordance with rules made under this Part, which taxation shall be subject to appeal to the Patents Tribunal, and any such costs may be recovered by action in a court of competent jurisdiction.

General powers of Patents Tribunal.

Right of audience.

Costs and security for costs.

LAWS OF MALAWI

Patents

Cap. 49:02

- 78.** (1) Any party to proceedings before the Patents Tribunal may appeal in accordance with rules made under this Part from any order or decision of such Tribunal to the High Court. **Appeals to High Court**
- (2.) Upon the hearing of an appeal under this section, the High Court may, without prejudice to its other powers:-
- (a) Confirm, set aside or vary the order or decision in question;
 - (b) Remit the proceedings to the Patents Tribunal with such instructions for further consideration, report, proceedings or evidence as the High Court may think fit to give;
 - (c) Exercise any of the powers which could have been exercised by the Patents Tribunal in the proceedings in connection with which the appeal is brought.
 - (d) Make such order it may think just as to the costs of the appeal or of earlier proceedings in the matter before the Patents Tribunal.
- 79.** The Patents Tribunal may appoint any person with special expert knowledge to act as an assessor in an advisory capacity in any case where it appears to such Tribunal that such knowledge is required for the proper determination of the case. **Assessors.**
- 80.** (1) Appeals under this Part, whether from decisions of the Registrar or orders or decisions of the Patents Tribunal, shall be brought within three months after the date of the decision or order in question, or within such further time as the Patents Tribunal or High Court to which the appeal is brought may allow upon application by the appellant concerned. **Time for appeals**
- (2.) The powers of the Registrar as to extensions of time under section 64(2) shall not apply in relation to times for bringing appeals under this Part.
- 81.** The Minister may make rules for regulating generally the practice and procedure of the Patents Tribunal and with respect to appeals or references to such Tribunal as to the time within which any requirement of the rules is to be complied with, as to the costs and expenses of and incidental to any proceedings in such Tribunal, as to the fees to be charged in respect of proceedings therein, as to the fees to be paid to assessors, and in particular may make rules providing for the summary determination of any appeal which appears to the Patents Tribunal to be frivolous or vexatious or to be brought for the purpose of delay. **Rules.**

- 82.** (1) When any matter to be decided by the Registrar under this Act appears to him to involve point of law or to be of unusual importance or complexity, he may, after giving notice to the parties, refer such matter to the Patents Tribunal for a decision and shall, thereafter, in relation to such matter, act in accordance with the decision of that Tribunal or any decision substituted therefore on appeal to the High Court.
- (2.) Where any matter has been referred to the Patents Tribunal in terms of subsection (1), the Registrar and the parties shall be entitled to be heard by the Patents Tribunal before any decision is made in such matter and may appear or be represented in accordance with section 76.

References to Patents Tribunal by Registrar.

**PART XI
OFFENCES AND PENALTIES**

- 83.** If any person makes or causes to be made a false entry in any register kept under this Act, or a writing falsely purporting to be a copy of an entry in any such register, or produces or tenders or causes to be produced or tendered in evidence any such writing, knowing the entry or writing to be false, he shall be guilty of an offence.
- 84.** (1) Any person who:-
- (a) for the purpose of deceiving the Registrar or any other officer of the Patent Office in the execution of this Act; or
 - (b) for the purpose of procuring or influencing the doing or omission of anything in relation to this Act or any matter thereunder,
- makes or submits a false statement or representation, whether orally or in writing, knowing the same to be false, shall be guilty of an offence.
- (2.) Any person who, having innocently made a false statement or representation, whether orally or in writing, for the purpose of procuring or influencing the doing or omission of anything in relation to this Act, or any matter thereunder and who on becoming aware that such statement or representation was false fails to advise the Registrar forthwith of such falsity, shall be guilty of an offence.

Falsification of certain documents.

Deceiving or influencing the Registrar or an officer.

- 85.** Any person who, after having been sworn, or having in lieu thereof made an affirmation or declaration, willfully gives false evidence before the Registrar or the Patents Tribunal concerning the subject matter or the Patents Tribunal concerning the subject matter of the proceeding in question, knowing such evidence to be false or not knowing or believing, it to be true, shall be guilty of an offence.

Witness giving false evidence.

LAWS OF MALAWI

Patents

Cap. 49:02

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| <p>86. (1) Any officer of the Patent Office who buys, sells, acquire, or traffics in any invention or patent or any right under a patent shall be guilty of an offence.</p> <p>(2.) Every purchase, sale or acquisition, and every assignment of any invention or patent, by or to any such officer shall be null and void.</p> <p>(3.) Nothing in this section contained shall apply to the inventor or to any acquisition by bequest or devolution in law.</p> | <p>Prohibition on trafficking in patents by officers in Patent office.</p> |
| <p>87. If any person falsely represents that any article sold by him is a patented article, he shall be guilty of an offence, and for the purposes of this provision a person who sells an article having stamped engraved or embossed thereon or otherwise applied thereto the word “patent” or “patented” or any other word expressing or implying that the article is a patented article.</p> | <p>Unauthorised claim for patented right.</p> |
| <p>88. If any person other than a person appointed in terms of section 4 uses on his place of business, or on any document issued by him, or otherwise, the words “Patent Office” or any other words suggesting that his place of business is, or is officially connected with, the Patent Office, he shall be guilty of an offence.</p> | <p>Unauthorised use of certain words.</p> |
| <p>89. Any person who is guilty of an offence under this Act shall be liable to a fine of £500 and to imprisonment for three years.</p> | <p>Penalties.</p> |

**PART XII
MISCELLANEOUS**

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| <p>90. (1) Any application, notice or document authorized or required under this Act to be lodged, made or given at the Patent Office, or to the Registrar or any other person, may be delivered by hand or sent by registered post.</p> <p>(2.) No authentication shall be required in respect of any document lodged in the Patent Office under the provisions of this Act and used in proceedings before the Registrar or the Patents Tribunal.</p> | <p>Lodging and authentication of documents.</p> |
| <p>91. Any person who is required under this Act to take any oath or swear to the truth of any affidavit may, in lieu thereof, make an affirmation or declaration in accordance with the law relating to affirmations or declarations.</p> | <p>Oaths and affirmations.</p> |
| <p>92. All moneys necessary for the purpose of this Act shall be paid out of moneys provided by Parliament.</p> | <p>Expenses of administration.</p> |
| <p>93. (1) Where under this Act:-</p> <p style="padding-left: 40px;">(a) a fee is payable in respect of the performance of any act by the Registrar, the Registrar shall not perform that act until the fee has been paid;</p> | <p>Provisions as to fees.</p> |

LAWS OF MALAWI

- (b) a fee is payable in respect of the doing of any act by any person other than the Registrar, the act shall be deemed not to have been done until the fee has been paid; or
 - (c) a fee is payable in respect of the lodging of a document, the document shall be deemed not to have been lodged until the fee has been paid.
 - (2.) All fees shall be paid at the Patent Office in such manner as the Registrar, with the approval of the Minister, may accept.
- 94.** Nothing in this Act shall affect the right of the Government or of any person deriving title directly or indirectly from the Government to sell or use articles forfeited to the Government under any enactment in force in Malawi. **Saving for certain forfeitures.**
- 95.** (1) The Minister may, when he deems fit, direct the publication by the Registrar of a journal, to be referred to as the Patent Journal, containing particulars of applications for patents and other proceedings or matters arising under this Act, together with such reports of cases and other relevant matters as the Minister may deem fit. **Patent Journal.**
 - (2.) The Registrar shall make provision for selling copies of the Patent Journal at such price and in such manner as the Minister may direct.
- 96.** (1) The Minister may make regulations prescribing anything which under this Act is to be prescribed and generally for the better carrying out of the objects and purposes of this Act or to give force or effect to its provisions or for its better administration. **Power to make regulations.**
 - (2.) Without derogation from the generality of subsection (1), regulations made by the Minister may provide for:-
 - (a) The form of applications for patents and of any specifications, drawings or other documents which may be lodged at the Patent Office, and the furnishing of copies of any such documents;
 - (b) The procedure to be followed in connection with any application or request to the Registrar, or any proceeding before him, and the authorizing of the rectification of irregularities of procedure;
 - (c) The service of notices and other documents required to be served in connection with proceedings under this Act;
 - (d) Examinations for the qualification of patent agents in terms of this Act, the recognition for such purpose of qualifications obtained either in or outside Malawi, and the fees to be paid in connection with the registration of patent agents;

- (e) The conduct of the business of the Patent Office;
- (f) Other fees payable under this Act, and fees which may be charged in relation to the conduct of patent business by patent agents and legal practitioners performing the functions of patent agents;
- (g) Authorizing the publication and the sale of copies of specifications, drawings and other documents in the Patent Office, and of indexes to and abridgements of such documents;
- (h) The professional conduct of patent agents

**PART III
APPLICATION**

97. Any patent which immediately before the 1st January 1964, was registered in Malawi under any encashment relating to patent and was protected under the former patents legislation and any patent which immediately before the commencement of the said legislation was registered in the United Kingdom under any agreement relating to patents and was protected in Malawi under the Registration of Patents Ordinance (now repealed) shall be deemed to be registered under this Act and shall be protected under this Act while it would have been protected in the Federation of Rhodesia and Nyasaland or in the United Kingdom as the case may be:

Application of Act.

Provided that:-

- (a) A patent referred to in this section shall not be liable to revocation except upon some ground upon which it would have been liable to revocation in terms of the said legislation;
- (b) An application in respect of a patent referred to in this section which was pending in the Federation of Rhodesia and Nyasaland immediately prior to the 1st day of January 1964, may be refused by the Registrar only in accordance with the provisions of this Act;
- (c) Fee in respect of an application referred to in paragraph (b) shall continue to be payable at appropriate rates provided under the said legislation except that they shall be paid in terms of section 93 and shall thereafter be paid into the Consolidated Fund.
