

PATENTS ACT OF 1971

(Law No 58 of 1971)

THE PATENTS ACT 1971
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(The purpose of this Act is to encourage inventiveness through adequate protection of inventions and technical know-how)

Be It Hereby Enacted by the Council of Ministers in Accordance with the Presidential Decree No. I as Follows:

PART I

PRELIMINARY PROVISIONS

CHAPTER I

- Title 1. This Act may be cited as "The Patents Act, 1971."
- Definitions 2. In this Act, unless the context otherwise requires:
- (a) "The Court" means the High Court;
 - (b) "Minister" means the Attorney General;
 - (c) "Patent Office" means the Office that the Minister shall establish to perform the functions assigned to it under this Act.

CHAPTER II

TERMS OF PATENTABILITY

- Patentable Inventions 3. (1) Any invention which is new, involves an inventive step and is capable of industrial application shall be patentable.
- (2) Any invention constituting an improvement upon a patented invention shall be patentable if it is new, involves an inventive step and is capable of industrial application.
- (3) Principles and discoveries of a scientific nature shall not be considered to be inventions.
- Novelty 4. (1) An invention is new if it is not anticipated by prior art, prior art being constituted by everything disclosed to the public, anywhere and at any time whatsoever, by means of a written or oral disclosure, by use, or in any other way, before the date of the filing of the patent application or the priority date validly claimed in respect thereof.
- (2) An invention shall not be deemed to have been made available to the public solely by reason of the fact that, within the period of six months preceding the filing of the application for a patent, the inventor or his successor in title has exhibited it in an official or officially recognized international exhibition.
- Inventive Step 5. An invention shall be considered as involving an inventive step if it does not obviously follow from the state of the art, either as to the method, the application, the combination of methods, or the products which it concerns, or as to the industrial results it produces.
- Industrial Application 6. An invention shall be considered as capable of industrial application if it can be manufactured or used in any kind of industry, including agriculture.

Exceptions to Patentability 7. Patents may not be validly obtained in respect of inventions the publication or working of which would be contrary to public order or morality, provided that the working of an invention shall not be considered as contrary to public order or morality merely because such working is prohibited by law or regulation

CHAPTER III

RIGHT TO THE GRANT OF A PATENT

The Right to a Patent 8. (1) Subject to Section 10, the right to a patent shall belong to the inventor or his successor in title.
(2) If two or more persons have jointly made an invention, the right to a patent shall belong to them or their successors in title jointly and equally; a person who has merely assisted in the execution of an invention without having contributed any inventive activity shall not, however, be deemed to be an inventor or co-inventor.
(3) The person who is the first to file an application for a patent, or is the first validly to claim the earliest priority for an application for the same invention, shall, subject to the provisions of Sections 9 and 10, be deemed to be the inventor or successor in title of the inventor.

Usurpation 9. Where the applicant has obtained the essential elements of an invention which is the subject of his application from the invention of another person, without the latter having consented to the applicant's doing so and to his filing an application for a patent, the person whose invention has been unlawfully usurped may demand that the application, or the patent granted in respect of the application, be transferred to him.

Inventions Made Pursuant to Commission or by an Employee 10. (1) Subject to the legal provisions governing commission and employment contracts, and in the absence of contractual provisions to the contrary, the right to a patent for an invention made in execution of such a contract shall belong to the person having commissioned the work or to the employer.
(2) The preceding subsection shall apply when an employment contract does not require the employee to exercise any inventive activity, but when the employee has made the invention using data or means made available to him through his employment.
(3) In the circumstances provided for in subsection (2), the employee-inventor shall have a right to remuneration taking into account his salary and the importance of the patented invention, which remuneration shall, in the absence of agreement between the parties, be fixed by the Court. In the circumstances provided for in subsection (1), the employee-inventor shall have a similar right if the invention is of very exceptional importance and the employment contract requires the exercise of inventive activity.
(4) The advantages conferred on the employee-inventor by the provisions of the preceding subsection shall not be reduced by contract.

Right of the True Inventor to be Named as Such 11. (1) The true inventor shall be entitled to be named as such in the patent.
(2) The preceding subsection may not be contravened by contract.

CHAPTER IV

GRANT OF PATENT

Terms of Application

12. (1) An application for a patent shall be made to the Patent Office and shall contain:

(a) the complete name and address of the applicant and, if the applicant's address is outside the Democratic Republic of the Sudan, the indication of an address for service within the Democratic Republic of the Sudan;

(b) a description of the invention with the drawings, if any, referred to therein;

(c) one or more claims.

(2) Where appropriate, the application for the patent shall be accompanied by a declaration, signed by the true inventor, requesting that he be mentioned as such in the patent and giving his name and address.

(3) Where the application is made by an agent, it shall be accompanied by a signed power of attorney; authentication or certification of the signature shall not be necessary.

(4) The details of the formal requirements with which an application for a patent must comply shall be prescribed in the Regulations.

Contents of the Description and Claims

13. (1) The description shall disclose the invention in a manner sufficiently clear and complete for it to be carried out by a person skilled in the art.

(2) The claim or claims shall define the matter for which protection is sought.

(3) The claims shall not exceed the contents of the description.

Unity of the Invention

14. (1) An application for a patent shall relate to one invention only.

(2) Subject to the preceding subsection, an application for a patent may include, in particular:

(a) apart from claims for one or more products, claims for one or more manufacturing processes for the product or products, and claims for one or more applications of the product or products;

(b) apart from claims for one or more manufacturing processes, claims for means of working the process or processes, claims for the product or products which result from that working, and claims for the application of such products.

Right of Priority

15. The applicant for a patent who wishes to avail himself of the priority of an earlier application made in another country shall be required to append to his application a written declaration indicating the date and number of the earlier application, the country in which he or his predecessor in title made such application and the name of the applicant, and shall, within a period of three months from the date of the later application, furnish a copy of the earlier application, certified as correct by the Patent Office of the country where it was made.

Payment of Fees

16. An application for a patent shall not be accepted unless the fee prescribed for this effect has been paid.

description

Examination
of
Application
as to Form

17. (1) The Patent Office shall examine the application as to its conformity with Sections 12, 14, 15 and 16.
- (2) Where the provisions of Sections 12 or 16 have not been complied with, a patent shall not be granted; where the provisions of Section 15 have not been complied with, the Patent Office shall not mention in the patent the priority claimed.
- (3) Where the application does not fulfill the requirements of Section 14, the applicant shall be invited by the Patent Office to restrict the application so that it relates to only one invention. At the same time, the Patent Office shall notify the applicant that, within a period of three months, he may file, for the rest of the application, one or more divisional applications, which shall benefit from the date of the filing of the original application, and, if relevant, from the priority date claimed under Section 15. Where the applicant does not comply with this invitation to restrict the original application to one invention, no patent shall be granted.

Grant of
Patent
without
Examination
as to the
Substance
of the
Application

18. (1) Where the examination referred to in Section 17 shows that the application satisfies the requirements of Sections 12, 14, and 16, the patent, as applied for, shall be granted without further examination, particularly without examination of the question whether the subject of the application is patentable within the terms of Sections 3 to 7, and whether, for the same invention, an application benefiting from an earlier priority has been made in the Democratic Republic of the Sudan or whether a patent has been granted as a result of such application.
- (2) Where the examination referred to in Section 17 shows that the provisions of Section 15 have been complied with, the Patent Office shall mention in the patent the priority claimed.
- (3) Patents are granted at the risk of the patentee and without guarantee as to their validity.

Issuance
and
Registration
of Patents

19. (1) A patent shall be granted by the issuance of letters patent to the patentee. The patent must contain the number thereof in order of grant; the name and address of the patentee and, if his address is outside the Democratic Republic of the Sudan, an address for service in the Democratic Republic of the Sudan; the dates of the application and grant; indication, if priority is claimed, of this fact, and the number, date and country of the application, basis of the priority claimed; the description of the invention, the claims and the drawings, if any, relating to the description; and, finally, the name and address of the true inventor if he has requested to be mentioned in the patent.
- (2) The Patent Office shall maintain a Register in which shall be recorded patents granted, numbered in their order of grant, and, in regard to each patent, where appropriate, its lapse for non-payment of annual fees, and all transactions to be recorded by virtue of the present Act.
- (3) The Patent Office shall record the changes of address or of address for service which shall be notified to it by the registered owner of the patent.
- (4) Communications to be made to the registered owner of the patent by virtue of the present Act shall be sent to him at his most recently recorded address and at the same time to his most recently recorded address for service.

- Publication of Patents
20. (1) The Patent Office shall publish in the Gazette as soon as possible all patents granted in the order of their grant, mentioning the contents of the patent in accordance with Section 19(1), with the exception of the description and the drawings. The publication of the claims of the patent may, to the extent permitted and in the manner prescribed in the Regulations, be replaced by a summary of the claims, without prejudice to the scope of the patent and its validity.
- (2) Patents registered at the Patent Office may be consulted free of charge at that Office, and any person may obtain copies thereof at his own expense. This provision shall also be applicable to transactions recorded in regard to any patent.

CHAPTER V

RIGHTS CONFERRED BY THE PATENT

- Nature of Rights Conferred
21. The patent shall confer upon its registered owner the right to preclude third parties from the following acts:
- (a) when the patent has been granted in respect of a product:
- (i) making importing, offering for sale, selling, and using the product,
- (ii) stocking such product for the purposes of offering for sale, selling, or using;
- (b) when the patent has been granted in respect of a process:
- (i) applying the process,
- (ii) doing any of the acts referred to in (a) above in respect to a product obtained directly by means of the process.
- Scope of Protection
22. (1) The scope of the protection conferred by the patent shall be determined by the terms of the claims.
- (2) The description and the drawings included in the patent shall be used to interpret the claims.
- Limitation of Rights Under the Patent
23. (1) The rights under a patent shall only extend to acts done for industrial or commercial purposes.
- (2) The rights under a patent shall not extend to acts in respect of the product covered by the patent after the product has been lawfully sold in the Democratic Republic of the Sudan; nevertheless, insofar as the patent also concerns a special application of the product, this application shall continue to be reserved to the registered owner of the patent.
- Rights Derived from Prior Manufacture Use
24. Any person who, at the date of the filing of the patent application by another person, or at the date of priority claimed in respect of such validly application, was, in good faith, manufacturing the product or applying the process, which is the subject of the invention, or had made serious preparations with a view to such manufacture or use, shall, despite the patent, have the right to continue such acts and, with respect to products obtained thereby, to perform the other acts referred to in Section 21. This right is only transferable with the undertaking which is the beneficiary of the right.

CHAPTER VI

DURATION OF PATENT AND FEES

- Duration of Patent and Fees
25. (1) A patent shall expire at the end of the twentieth year from the date of the filing of the application, subject to the payment of the annual fees as prescribed in the Regulations.
- (2) A period of grace of six months shall be granted for the payment of the annual fees upon payment of a surcharge as prescribed in the Regulations.
- (3) The lapse of a patent for non-payment of fees shall be published in the Gazette by the Patent Office as soon as possible.

CHAPTER VII

TRANSFER OF PATENT APPLICATIONS AND PATENTS;
JOINT OWNERSHIP OF PATENTS

- Assignment and Transfer of Patent Applications and Patents
26. (1) Patent applications and patents may be assigned or transferred by succession.
- (2) The assignment of patent applications and patents shall be made in writing and shall require the signatures of the contracting parties.
- (3) Assignments, or transfers by succession, of patent applications and patents shall be registered in the Patent Office on payment of a fee as prescribed in the Regulations; assignments shall have no effect against third parties until such registration.
- Joint Ownership of Patents
27. In the absence of any provision to the contrary between the parties, joint owners of a patent may, separately, transfer their parts, exploit the patented invention, and exercise the rights granted under Section 21, but may only jointly grant a license to a third party to exploit the patent.

CHAPTER VIII

CONTRACTUAL LICENSES

- License Contracts
28. (1) The applicant for or owner of a patent may, by contract, grant to some other person or undertaking a license to exploit his invention.
- (2) A license contract must be in writing and shall require the signatures of the contracting parties.
- (3) Every license contract must be registered in the Patent Office, on payment of a fee as prescribed in the Regulations; the license shall have no effect against third parties until such registration.
- Right of Licensor to Grant Further Licenses
29. (1) In the absence of any provision to the contrary in the license contract, the grant of a license shall not prevent the licensor from granting further licenses to third persons, or from exploiting the invention himself.
- (2) The grant of an exclusive license shall prevent the licensor from granting licenses to third persons and, in the absence of any provision to the contrary in the license contract, from exploiting the invention himself.

Rights of Licensee

30. In the absence of any provision to the contrary in the license contract, the licensee shall be entitled to exploit the invention during the whole duration of the patent, in the entire territory of the Democratic Republic of the Sudan, through any application of the invention, and in respect to all the acts referred to in Section 21.

Non-Assignability of Licenses

31. In the absence of any provision to the contrary in the license contract, a license contract shall not be assignable to third parties and the licensee shall not be entitled to grant sublicenses.

License Contracts Involving Payments Abroad

32. In view of the country's needs and its economic development, the Minister may, by order, provide that on pain of invalidity, license contracts or certain categories of them, and amendments or renewals of such contracts, which involve the payment of royalties abroad, shall require his previous approval.

Invalid Clauses in License Contracts

33. (1) Clauses in license contracts or relating to such contracts shall be null and void insofar as they impose upon the licensee, in the industrial or commercial field, restrictions not deriving from the rights conferred by the patent.

(2) The following in particular shall be deemed not to constitute such restrictions:

(a) limitations concerning the degree, extent, quantity, territory or duration of exploitation of the subject of the patent;

(b) limitations justified by the interest of the licensor in the technically flawless exploitation of the subject of the patent;

(c) the obligation imposed upon the licensee to abstain from all acts capable of impeding or preventing the grant of the patent or prejudicing its validity.

CHAPTER IX

COMPULSORY LICENSES

Section 44
Follow

Compulsory License for Non-Working and Similar Reasons

34. (1) At any time after the expiration of a period of four years from the date of the filing of an application for a patent, or three years from the date of the grant of a patent, whichever period expires last, any person interested may, in accordance with the conditions specified in Section 44, apply for the grant of a compulsory license upon one or more of the following grounds:

(a) that the patented invention, capable of being worked within the Democratic Republic of the Sudan, has not been so worked within the terms of subsection (3);

(b) that the working of the patented invention within the Democratic Republic of the Sudan does not meet on reasonable terms the demand for the product;

(c) that the working of the patented invention within the Democratic Republic of the Sudan is being prevented or hindered by the importation of the patented article;

(d) that, by reason of the refusal of the registered owner of the patent to grant licenses on reasonable terms, the establishment or development of industrial or commercial activities in the Democratic Republic of the Sudan is unfairly and substantially prejudiced.

(2) In all the above cases, a compulsory license shall not be granted if the owner of the patent proves that his actions in respect of the patented invention are legitimately justifiable in the circumstances. Importation shall not constitute a legitimate reason.

(3) The working of a patented invention under this Section means the manufacture of a patented article, the application of a patented process, or the use in manufacture of a patented machine, by an effective and serious establishment existing within the Democratic Republic of the Sudan, and on a scale which is adequate and reasonable in the circumstances.

(4) A compulsory license shall permit the licensee to perform some or all the acts referred to in Section 21 with the exception of importation.

- Compulsory License for Products and Processes Declared to be of Vital Importance for the Defense or Economy of the Country or for Public Health
35. The Minister may, by order, provide that, for certain patented products or processes, or for certain categories of such products and processes, which are declared by that order of vital importance for the defense or the economy of the Democratic Republic of the Sudan or for public health, compulsory licenses may be granted, in the conditions provided for in Section 34, even before the expiration of the period mentioned in subsection (1) of that Section and even for importation into the Democratic Republic of the Sudan.
- Compulsory Licenses Based Upon Inter-dependence of Patents
36. (1) If an invention protected by a patent within the Democratic Republic of the Sudan cannot be worked without infringing rights deriving from a patent granted on a prior application or benefiting from an earlier priority, a compulsory license may, upon application, be granted under the conditions specified in Section 44 to the registered owner of the later patent, to the extent necessary for the working of his invention, insofar as such invention serves industrial purposes different from those of the invention forming the subject of the earlier patent, or constitutes noteworthy technical progress in relation to it.
- (2) If the two inventions serve the same industrial purpose, a compulsory license shall be granted only if a license is granted in respect of the later patent to the registered owner of the earlier patent, if he so requests.
- Refusal of Contractual License
37. Any person who applies for a compulsory license under Sections 34, 35 or 36 must furnish proof showing that he has previously approached the registered owner of the patent, by registered letter, requesting a contractual license, but has been unable to obtain such a license from him on reasonable terms and within a reasonable time.
- Guarantee Required from Applicant for a Compulsory License
38. In the cases provided for in Sections 34 and 35, a compulsory license shall be granted only to an applicant offering the necessary guarantees to work the invention sufficiently to remedy the deficiencies or to satisfy the requirements which gave rise to the application for the compulsory license.
- Scope of Compulsory Licenses
39. (1) Compulsory licenses shall be non-exclusive.
- (2) The terms of a compulsory license, fixed in accordance with Section 44, may contain obligations and restrictions both for the licensee and for the registered owner of the patent.
- Compensation
40. A compulsory license shall only be granted subject to the payment of adequate royalties commensurate with the extent to which the invention is worked.

Compulsory
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Guarantees

Transfer of Compulsory License

41. (1) A compulsory license may only be transferred with the undertaking of the licensee or with that portion of his undertaking which uses the patented invention. Any such transfer shall, on pain of invalidity, require the authorization of the authority which granted the compulsory license.

(2) Sections 42 and 44 shall be applicable to the transfer of a compulsory license.

(3) The grantee of a compulsory license shall not be entitled to grant sublicenses.

Registration of Compulsory License

42. Every compulsory license shall, either at the request of the interested party or following notification to the Patent Office provided for in subsection 44(4), be registered at the Patent Office without fee. The license shall have no effect as against third parties until such registration.

Amendment and Cancellation of Compulsory License

43. (1) Upon the request of the registered owner of the patent or of the licensee of the compulsory license, the terms of the license may be amended by the authority which granted it when new facts so justify, in particular when the registered owner of the patent grants contractual licenses on terms more favorable to the contractual licensees.

(2) At the request of the registered owner of the patent, the compulsory license may be cancelled if the licensee does not comply with the prescribed terms of the license or if the conditions which justified the grant of the compulsory license have ceased to exist; in the latter case, a reasonable time shall be given to the licensee to cease working the invention if an immediate stoppage would cause serious damage to him.

(3) Sections 42 and 44 shall be applicable to the amendment and cancellation of compulsory licenses.

Procedure

44. (1) Any application for a compulsory license shall be made to the Court.

(2) The Registrar of the Court shall invite, by registered letter, the applicant for the compulsory license and the registered owner of the patent to appear or to be represented before the Court within a reasonable time; the Court shall hear the party or parties or their representatives who have appeared. Before granting a compulsory license, the Court shall seek the advice of the Minister, who may delegate a representative to intervene at the hearing and to make any pertinent observations.

(3) The Court shall first decide whether a compulsory license may be granted. If it finds that it may be granted, it will give the parties reasonable time to agree on the terms. If there is no agreement between the parties when the time limit expires, the Court shall fix the terms, including the amount of royalties referred to in Section 40. The terms of a compulsory license, including those relating to royalties, shall be considered to constitute a valid contract between the parties.

(4) The decision of the Court granting a compulsory license shall be notified by the Registrar of the Court to each of the parties involved and to the Patent Office.

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CHAPTER X

LICENSES OF RIGHT

Licenses of Right

- 45. (1) Any registered owner of a patent not precluded by the terms of any previously registered license from granting further licenses may apply to the Patent Office to have, in respect of his patent, the mention "licenses of right" entered in the Register. The mention shall be entered in the Register, and this fact shall be published by the Patent Office as soon as possible.
- (2) The entry of this mention in the Register shall entitle any person to obtain a license to exploit the said patent upon such terms as shall, in the absence of agreement, be fixed by the Court.
- (3) The amount of the annual fees payable in respect of any patent after the date on which the mention "licenses of right" has been entered in the Register shall be reduced by one half.
- (4) The registered owner of the patent may, at any time, apply to the Patent Office to cancel the entry "licenses of rights." If no license is in force, or if all licensees agree thereto, the Patent Office shall cancel the entry, after payment of all fees and annual fees which would have been payable if the entry had not been made in the Register.
- (5) The provisions of Sections 28(3), 30, 32 and 33, shall be applicable equally to licenses or right.
- (6) The grantee of a license of right may neither assign it nor grant sublicenses under it.

CHAPTER XI

SURRENDER AND NULLITY

Surrender of Patent

- 46. (1) A patent may be surrendered by its registered owner by written declaration addressed to the Patent Office.
- (2) The surrender may be limited to one or more claims of the patent.
- (3) The surrender shall be immediately registered and published by the Patent Office. Surrender shall be effective only after it has been registered.
- (4) If a contractual license or a license of right is registered at the Patent Office, surrender of the patent shall only be registered upon the submission of a declaration by which the registered licensee consents to the surrender.

Nullity of Patent

- 47. (1) On the request of any person including any competent authority, the Court shall declare a patent null and void in the following circumstances:
 - (a) Where the subject of the patent is not patentable within the terms of Sections 3 to 7;
 - (b) Where the description of the invention or the claim or claims in the patent do not satisfy the requirements of Section 13;
 - (c) Where, for the same invention, a patent has been granted in the Democratic Republic of the Sudan as the result of a prior application or of an application benefiting from an earlier priority.

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PART II

TECHNICAL KNOW-HOW

- Conditions of Protection of Technical Know-How
53. (1) Subject to any right conferred by patents in force and the provisions of subsection (2) of the present Section, any person may freely use manufacturing processes or knowledge concerning the use and application of industrial techniques.
- (2) Nevertheless, provided that these processes and knowledge have not been published or made available to the public, they shall be protected against unlawful use, disclosure or communication by third parties, on condition that the person who has developed them has taken the necessary steps to preserve their secret character.
- Unlawful Acts
54. Any use, disclosure or communication, without the consent of the owner, of the processes and knowledge referred to in Section 53(2) by any person who is aware of their secret character, or who could not fail to be aware of such character, shall be deemed to be unlawful, and Sections 49 and 50 shall be applicable in respect of those unlawful acts.
- Independent Acquisition
55. Any person who has developed, by his own means, manufacturing processes or knowledge concerning the use and application of industrial techniques and any person who has legally acquired those processes and that knowledge from the former shall, even if another person has kept secret the same processes and knowledge, be entitled to use, disclose or communicate them to third parties.
- Transfers and Licenses
56. (1) The processes and knowledge referred to in subsections (1) and (2) of Section 53 may be transferred and may form the subject of a license contract.
- (2) Sections 26(2), 28(2), 29, 30, 31 and 32 shall be applicable by analogy.

PART III

GENERAL PROVISIONS

57. If an enterprise commits an infringement under this Act, any person acting as a member of the Administration Board, as Director General or Secretary, or any person having a similar activity or who appears to be the executor of such task in that enterprise on the date of the infringement, shall be considered to be an infringer unless he provides proof that the relevant infringement had not been committed with his consent or was not due to his negligence and that he had used his best efforts to avoid the infringement within the limits of his competence under the given circumstances in effect.
- Power of Minister to Promulgate Regulations
58. The Minister may prescribe Regulations in order to perform the purposes of this Act, once the Minister of the Treasury and the Minister of Economy, Commerce and Supply have approved the prescribed fees.