

SOUTH AFRICAN PATENT SYSTEM

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The following information is supplied for the convenience of our clients and is to be considered as a brief and simplified outline only.

What is a patent?

A patent is a document granting an inventor sole rights to an invention and includes a number of official forms as well as a patent specification consisting of a concise yet all encompassing description of the invention and, in some cases, patent claims defining the scope of protection afforded by the patent when it is granted.

As it is a document, its value lies in how the patent specification is written and later interpreted as well as in whether all legal formalities are complied with. Thus, particular care must be taken in preparing the application forms and drafting the patent specification. It is thus advisable to use a well qualified and skilled draftsmen in order to obtain the best possible protection from any eventual patent.

Lodging of a Patent Application in South Africa.

In South Africa, it is possible to file a provisional patent application, a complete patent application, or a Patent Co-operation Treaty (PCT) so called International Patent Application which also designates South Africa.

If the idea has not been finalised in detail yet then a provisional patent application is usually the first step in obtaining patent protection while having 12 months during which to conduct further experiments and make further improvements. The provisional patent application is an important document, which will later form the basis for a complete patent application and should be drawn up professionally and with great care and should contain as much detail as possible. A poorly drawn provisional patent application may be completely worthless from the legal point of view.

In order to obtain a patent, a provisional patent application must be followed by a fresh patent application with a complete specification within twelve months from the date of filing the provisional specification (an extension of three months can be obtained on payment of a fee) or else all rights will lapse irrevocably.

In a case where the full practical details of your invention have already been developed, a complete patent application or even a PCT patent application may be lodged in the first instance without the cost of a provisional patent application being incurred.

However, if for the time being, you only require temporary protection for the purpose of testing the commercial possibilities of an invention, you may prefer to lodge a provisional patent application initially even if the information available might be adequate for a complete patent application.

If, after a provisional specification has been filed you make further important discoveries or improvements in connection with the invention before the period for lodging the complete patent application has expired then it is advisable to file additional provisional patent applications to cover the improvements or to immediately file a complete patent application even before the 12 month period has passed since the provisional application was filed.

The owner of a granted patent can protect subsequent improvements or modifications to the invention covered by the patent by the filing of an application for a patent of addition. Whether or not a patent of addition is called for rather than an independent patent, has to be determined carefully in each specific case.

Validity requirements in South Africa

The South African Patent Office does not investigate the validity of patent claims. However, the validity of a patent can be attacked at any time by others. The following are some of the most common grounds of attack, which should, if possible, be borne in mind even at the time of filing a patent application:

- (a) that the invention was obvious to a person skilled in the art in the light of the state of the art which comprises all matter (whether a product, a process, information about either, or anything else) which has been made available to the public (whether in the Republic or elsewhere) by written or oral description, by use or in any other way, immediately prior to the priority date of the invention;

- (b) that the invention was not new in that, immediately prior to the priority date of the invention,
- i) it formed part of the state of the art as described in (a) above, or
 - ii) the invention was described in an application for a patent of earlier priority date which subsequently became open to public inspection, or
 - iii) was used secretly and on a commercial scale in the Republic of South Africa.

In connection with (a) and (b), we have to rely very largely on your information. However, with regard to item (b)(ii), and quite generally the establishment of the existence of earlier patent specifications and other aspects should be investigated at the Patent Office either by the applicant or by a patent attorney. Although a good search may sometimes be expensive, it may prevent you from wasting money eventually.

Safeguards against infringement of patents held by others

The grant of a South African patent gives a patentee the right to prevent in South Africa, other persons from making, using, exercising, disposing of, offering to dispose of, or importing the patentee's invention. Infringement includes all forms of using the patented invention. It even includes private use as well as manufacturing, selling, offering for sale or importing articles covered by the patent. The term of a South African patent is 20 years, subject to annual renewal after the third year.

The grant of a patent does not authorise the patentee to commercialise his or her invention if some aspects of the invention are covered by patents held by somebody else. A patentee who wishes to commercialise an invention should make sure that he or she is not infringing somebody else's patent. For this purpose we strongly recommend a search at the Patent Office.

Protection in foreign countries

Foreign patent applications must be filed within 12 months (not extendible) of the filing date of the first patent application for the invention if the original filing date (called the priority date) is to be retained internationally.

The popular term "world patent" is based on a fallacy. "World patents" do not exist. Instead separate protection must be applied for in each country individually, except for the following:

a) **The PCT Route :**

The PCT (viz Patent Co-operation Treaty), also called an International Patent Application, is a route to obtaining the grant of separate (national) patents in 123 countries (as of January 2004), including South Africa. A single PCT application is filed. A key advantage of this route is that costs are contained at this stage. By requesting an international examination, an examination report is obtained. Before expiry of a 30 month period from the priority date, separate national or regional patent application(s) must be filed at the usual fee levels. As a private individual who is a resident and/or national of South Africa a substantial discount is obtained on the PCT route International Phase (75% of most of the official fees).

The PCT route includes, at no extra charge, an international search and patentability opinion prepared by an International Searching Authority, such as the European Patent Office. This will give a good indication of the patentability of the invention before patenting is proceeded with in the individual PCT contracting states.

b) **The European patent**

This patent covers any of the European countries which are members of the European Patent Convention (not all countries in Europe).

c) **The OAPI Patent**

This patent covers all of the following African countries:

Mauritania, Senegal, Ivory Coast, Burkina-Faso, Benin, Niger, Chad, Cameroon, Togo, Central African Republic, Gabon, Congo, Mali, Guinea and Equatorial Guinea.

d) **The ARIPO Patent**

This patent covers any of the following African countries designated by the patentee:

Zimbabwe, Zambia, Botswana, Swaziland, Gambia, Ghana, Lesotho, Kenya, Malawi, Mocambique, Namibia, Uganda, Tanzania and Sudan.

South Africa is not a member of either ARIPO or OAPI but is a member of the International Patent Convention (also referred to as the Paris Convention) and is a contracting state of the PCT.