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MEMORANDUM ON FOREIGN PATENTS

I want to register a worldwide patent - how do I proceed?

At present, there is no single worldwide patent as patents are generally territorially limited. In general, separate protection must be applied for in each country individually. A patent granted in South Africa by the South African Patent Office cannot be enforced in any country other than South Africa, unless you have filed patent applications in each country in which you wish to obtain patent protection. Regional patent organizations do exist. Such organizations cover patent prosecution in more than one country, for example, ARIPO, OAPI, the European Patent Office, the Eurasian Patent Office and the Gulf Co-operation Countries.

One must proceed to prosecute each patent application to grant in each country where enforceable patent rights are sought. As with South African patents, no enforceable patent rights exist until such time as the patent has been granted by the Patent Office in the country of interest.

Would a South African provisional patent application benefit me?

South Africa is a member to the Paris Convention (which regulates international patent rights), thus, you are extended the same patent rights in each member country as you would have in your own country. Within 12 months of the filing of a South African provisional patent application, separate patent applications must be filed the countries in which protection is required (including South Africa) so as to claim the date of filing of your South African provisional patent application as a "priority" patent date

This is an advantage as a Applicant may file a South African provisional patent application, market the product / invention in the countries of interest and gauge the response thereto, if the response is favorable, the Applicant may then elect to proceed to file patent applications at the Patent Offices of such country within 12 months of filing their South African provisional patent application.

It is important to note that in order to claim enforceable patent rights in foreign countries, each foreign patent application must be prosecuted to granted patent status and thereafter be maintained and kept in force.

Which Countries are members of the Paris Convention?

Most countries (including South Africa) are members of the Paris Convention. Notable exceptions include India and Taiwan. For non-member countries, Non-Convention patent applications must be filed at the same time as filing your South African provisional patent application and before your invention is disclosed to the public. Applicants cannot rely on the 12 month patent grace period when filing at the Patent Office of these countries. As the list of member countries is extended periodically, please contact us when required so that we may forward to you a copy of such Paris Convention member countries.

Are the patent deadlines for filing at foreign Patent Offices extendable?

None of the patent deadlines can be extended for foreign patents. An Applicant forfeits their patent rights if they miss any of the patent deadlines. Foreign Patent Offices each have their own internal patent deadlines, and you will be guided by your patent attorney in this regard.

What is the Patent Co-Operation Treaty?

The Patent Cooperation Treaty (PCT) is a treaty that provides co-operation with regard to the filing, searching and examination of patent application and is administered by the World Intellectual Property Organization (WIPO) in Geneva.

A single PCT application is filed and allows an Applicant who is a national or resident of a member state to file a single PCT patent application, within the convention period of one year. The applicant may designate up to some 77 designations which cover over 144 countries as countries envisaged for protection. The PCT streamlines the international search and examination process and thus results in a reduction of the considerable costs involved in this process

Please note that a PCT patent application does not lead to the grant of a "PCT Patent" or an "International Patent". A PCT patent application is merely a means for facilitating the filing of patent applications. It is necessary for the Applicant to file national applications flowing from the PCT patent application in those countries in which patent protection is desired.

Do I still need to pay a patent filing fee to file patent applications at the Patent Offices of each country after having filed a PCT patent application?

Yes – however, this cost is deferred by up to 18 months, allowing you to carefully identify target markets and to acquire funding for the rest of the patenting process. Advantageously, Applicants are also issued with a patent examination report detailing the patentability of their invention, which will allow them to make an informed decision as to whether or not you wish to proceed with obtaining patent protection.

The PCT System Procedure:

If an Applicant has an invention that he or she wishes to patent in a number of countries, the Applicant is advised to utilize the Patent Cooperation Treaty (PCT) prior to lodging patent applications in these countries

A "Patent Cooperation Treaty Request Form" together with the respective specifications, drawings will be submitted to any suitable receiving office (in South Africa – CIPC). The Request will be processed by CIPC.

The PCT system provides for:

An international phase comprising:

- Filing of the international application
- International search
- International publication and
- International preliminary examination
- A national/regional phase before designated Offices and/or Elected offices. The PCT system includes an international search by an International Searching Authority at no additional charge. The results of the international search will provide the Applicant with a good indication of the patentability of the invention prior to proceeding with the patenting process in the individual PCT contracting states.

By requesting international examination, the Applicant will be afforded the opportunity to argue and/or amend the application in light of the Examiner's objections with a view to obtaining a clear preliminary examination report.

Please contact us should you require a schedule of costs of requesting such international examination and for arguing and/or amending the application.

What are the benefits to filing a PCT patent application?

PCT patent applications are examined at the World Intellectual Property Organization in order to determine whether your invention is in fact useful, new and inventive – and therefore worthy of a patent. The patent examiners conduct extensive patent novelty searches following which they will issue you with a

patent search report. The patent examiners are skilled in the field of each invention, usually having advanced degrees in the field of each patent technology. From the results obtained from such patent search reports you may be able to get an indication of whether your invention is considered patentable, prior to incurring the expense of filing various patent applications at the Patent Offices of each foreign country you wish to extend your patent rights to.

What is the situation when I do not wish to continue with the patent?

Should you not wish to proceed with the process of obtaining patent protection for your invention, please advise us immediately. Unnecessary patent expenses may be avoided by withdrawing your patent application should you decide with final effect not to proceed with the patent process. Please note that all patent rights to your invention will be irrevocably lost should you elect to withdraw your patent application after it has been made public by yourself or after publication by WIPO.

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