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MEMORANDUM ON PATENTS

The patenting of inventions in South Africa is governed by the Patents Act No. 57 of 1978 as amended (the "Act"). In accordance with the Act, two types of patent applications may be filed namely a Provisional and Complete patent application.

The major difference between a provisional and complete patent application is that a provisional patent specification does not include any claims and does not become open to public inspection. Also, a provisional patent application does not afford the Applicant any rights apart from a right to claim priority from the date of filing of the provisional patent application.

The Act states that a patent may be granted for any **new** invention which involves an **inventive step** and which is capable of being **used** or applied in trade or industry or agriculture. However, it should be noted that certain categories of subject matter are not considered inventions and are therefore not patentable.

NOVELTY

An invention is considered to be new if it does not form part of the state of the art immediately before the priority date of the invention. The state of the art 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 manner.

Thus, the requirement of novelty is an absolute requirement and, preferably, there should be no disclosure of the invention before a patent application is filed. Disclosure made on a confidential basis does not destroy the novelty of an invention but one should be careful in making the confidential nature of that disclosure explicitly clear to the disclosee. Non-confidential disclosure of the invention may destroy the novelty of the invention and rule out the possibility of obtaining valid patent protection. The secret use of an invention on a commercial scale in the Republic will also destroy novelty.

Disclosure of an invention as a result of the working of the invention in South Africa by way of reasonable technical trial or experiment does not destroy novelty. Unauthorized disclosure may also be excused, provided that the applicant applies for protection with all reasonable diligence after learning of the disclosure.

INVENTIVENESS

An invention is deemed to involve an inventive step if it is not obvious to a person skilled in the art to which the invention relates, having regard (with certain exceptions) to any matter which forms part of the state of the art immediately before the priority date of the invention. Although it is not possible to provide a definitive test for determining whether an invention is obvious, the requirement of non-obviousness should be borne in mind, particularly where an invention involves a minor departure from that which is already known. In short, the

question of obviousness is one of fact and in most instance will only be determined by expert evidence.

EXCLUDED SUBJECT MATTER

The Patents Act provides that the following do not comprise inventions for the purposes of the Act and hence is not patentable: discovery; a scientific theory; a mathematical method; a literary, dramatic, musical or artistic work or any other aesthetic creation; a scheme, rule or method for performing a mental act, playing a game, or doing business; a program for a computer; or the presentation of information.

The Act excludes inventions only to the extent to which a patent or an application for the patent relates to an excluded category as such. Thus, an invention, which relates only in part to one of the aforementioned items, may be patentable and professional advice should be sought in this regard. Certain other inventions are also excluded. These include: any variety of animal or plant or any essentially biological process for the production of animals or plants, not being a micro- biological process or the product for such a process and a method of treatment of the human or animal body by surgery or therapy or of diagnosis practiced on the human or animal body. However, a substance or a composition for use in such a method of treatment or diagnosis is patentable even if the substance or composition itself is known, provided its use in the method of treatment is new.

PROGRESS

In most instances an Applicant will file a provisional patent application in the first instance. This enables him to make minor modification to his invention and to “test” the market before the complete patent application, claiming priority from the earlier provisional patent application, need to be filed.

A complete patent application must be filed within 12 (TWELVE) months from the provisional patent application from which priority rights are claimed, alternatively a complete patent application may be filed in the first instance. As mentioned earlier, a complete patent application includes a set of claims, which define the scope of the protection. Please note that only a registered patent attorney may file a complete patent application.

South Africa does not have an extensive examination system and consequently an application is only examined to meet certain minimum requirements. Normally the Registrar of Patents will examine such complete patent application a few months after it has been filed and, provided all the formalities prescribed by the Patents Act have been complied with, the application is accepted.

The Registrar does not examine an application on the merits i.e. to determine whether or not the invention is, in fact, patentable. The application is then advertised in the Patents Journal within three months of the acceptance date and is simultaneously granted.

EFFECT OF A PATENT

The effect of a patent shall be to grant to the patentee, within the Republic, for the duration of the patent, the exclusive right to make, use, exercise, dispose of or offer to dispose of, or import the invention. However, the sale of a patented article by or on behalf of a patentee or his licensee shall, subject to other patent rights, give the purchaser the right to use and dispose of that article. This is also known as the doctrine for "Exhaustion of rights".

DURATION AND RENEWAL FEES

The term of a patent is 20 years from its filing date subject to the payment of annual renewal fees commencing 3 years after the filing date. Such renewal

fees are due before or on the anniversary date of the patent. However an extension of up to 6 (SIX) months is available for the payment of prescribed renewal fees.

A patent, which has lapsed due to the non-payment of a renewal fee, may be restored under certain circumstances and on payment of a prescribed fine.

MODIFICATIONS AND DEVELOPMENTS

It often occurs that an invention is materially modified after the filing of a complete application, for example during its development or exploitation. In this event, please consult immediately with us so that we can determine whether the altered invention is adequately covered by the complete specification or whether a further patent application should be filed.

FOREIGN APPLICATIONS

A South African complete specification which contains inventive subject matter and which was not included in an earlier application may offer a basis for obtaining foreign patent rights in respect of the additional matter. Such application should be filed within 12 (TWELVE) months from the earliest priority date. Please consult with us if you would like us to explore this possibility as there are a number of options available, which include the filing of a PCT application.

INFRINGEMENT

(a) Proceedings for the infringement of a patent may only be commenced 9 months after the date of advertisement in the Patent Journal, but damages may be recovered from the date of advertisement. Damages cannot be recovered from an infringer who was not aware of the existence of the patent.

(b) It must be stressed that the grant of a patent does not mean that the invention covered thereby can be put into practice, or exploited, without regard to earlier patents. A patent carries with it the right to prevent others from using the associated invention and clearly if the invention is used by anyone, including the patentee, earlier patents may be infringed.

MARKING

It is advisable to mark the product of the invention, its packaging and literature etc, with the description S.A. PATENT followed by the patent number. Such marking is of importance to the question of damages in an infringement action.

ASSIGNMENT, LICENCE, AND CHANGE OF NAME

Any change in the status of the patentee, or any interest in the patent, should be recorded at the Patent Office to be effective against third parties. However, it will still be affective between the parties thereto.

DISCLAIMER *The information provided in this memorandum is, by its nature, brief and incomplete and is not meant as a substitute for detailed legal advice. Richards Attorneys will not be liable for any loss resulting from the use of any of the information provided herein.*