



PATENTS

South Africa

Adams & Adams

Patents : an asset worth protecting Patents Act no. 57 of 1978

Intellectual Property

Intellectual property, although intangible, is a valuable asset on the balance sheet of any business - in many cases exceeding in actual marketable value the fixed property of the business.

'Intellectual property' is a generic term used to refer collectively to intangible products such as patents, industrial designs, trade marks and brand names, copyright, trade secrets and know-how, etc., all of which are products created through the innovative or creative efforts of people. It is important for people in business to be informed of the different kinds of intellectual property, to recognise when intellectual property has been created within the ambit of their business activities, and to see to it that the necessary steps are taken timeously to ensure that this property is protected. Legal protection is necessary to prevent others from making unauthorised use of the intellectual property to the detriment of the true owner, and to ensure that the true owner will enjoy the full commercial benefit of his/her creative efforts.

What is a patentable invention

A patent may be granted for any new invention which involves an inventive step and which can be used or applied in trade or industry or agriculture.

Generally, inventions have a technical content and could be in the form of new articles or devices, apparatus or equipment, processes for producing or manufacturing a product, chemical substances and formulations, etc.

Excluded inventions

Certain inventions are excluded from patentability: a 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, is not regarded as an invention for the purposes of the Patents Act. An invention incorporating one or more of these items as mere features of the invention, may still be patentable.

A patent will not be granted for an invention, the publication or exploitation of which can generally be expected to encourage offensive or immoral behaviour; or which may be used in a manner contrary to law; nor for anything contrary to well established natural laws (eg. perpetual motion devices).

A patent will also not be granted for any variety of animal or plant or any essentially biological process for the production of animals or plants, not being a microbiological process or the product of such a process. It is, however, possible to obtain protection for plant varieties by the grant of plant breeders' rights in terms of the Plant Breeders' Rights Act no. 15 of 1976.

An invention consisting of a method of treatment of the human or animal body by surgery or therapy or of diagnosis practised on the human or animal body, is not patentable. However, a substance or 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'.

Requirement of novelty

The most important prerequisite for the patentability of an invention, is that it must be 'new' as defined in the Act. An invention is deemed 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 way. The state of the art for purposes of determining novelty also comprises matter contained in a pending patent application in South Africa where such matter has an earlier priority date. An invention used secretly but on a commercial scale within the

Republic will also form part of the state of the art for the purposes of determining novelty.

Maintain secrecy before filing

The inventor and/or applicant should ensure that the invention is kept secret until such time as a patent application for the invention has been filed. If, before a patent application is filed, it is necessary to disclose details of the invention to other persons, eg. for the purpose of preparing drawings or to obtain technical assistance, or to commercial interests in order to obtain financial assistance, such disclosure should be made under a pledge of secrecy which should preferably be in writing. A non-confidential disclosure of the invention before the patent application is filed may destroy the novelty of the invention and can rule out any hope of obtaining valid patent protection for the invention.

Certain prior disclosures excused

Unauthorised disclosure of an invention by another before the filing of a patent application can be excused provided the applicant files the application with all reasonable diligence after having learned of the disclosure. Disclosure of the invention prior to filing as a result of the invention being worked in the RSA by way of reasonable technical trial or experiment by the applicant or a predecessor in title, can also be excused.

Requirement of inventiveness

Another important prerequisite for patentability is that the invention must involve an 'inventive step' and thus merit patent protection. This involves an enquiry into whether or not the invention is obvious.

An invention is deemed to involve an inventive step if it is not obvious to a person skilled in the art, having regard to matter which, immediately before the priority date of the invention, forms part of the state of the art. The relevant state of the art for assessing inventiveness is somewhat narrower in scope: the subject matter of an earlier pending patent application and prior secret use of an invention do not form part of the state of the art when obviousness is assessed.

Who may apply for a patent

An application for a patent may be made by the inventor or by any other person acquiring from the inventor the right to apply (ie. an assignee), or by both such inventor and such other person. Thus a patent application may be filed in the name of an assignee (eg. a natural person or a company), who has obtained a written assignment of the invention from the inventor.

In the absence of an agreement to the contrary, joint inventors or joint applicants may apply for a patent in equal undivided shares. Where joint applicants apply for a patent it is advisable for them to enter into a written agreement defining their rights and obligations.

Identify the actual inventors

It is essential to name the actual inventor(s) because a wrong statement of inventorship may invalidate a patent. The actual inventor is the (natural) person or persons who invented the entire invention. Thus, it cannot be a company or a person who acquired the invention from someone else, either locally or abroad. Furthermore, a draftsman or model builder who merely carries out the instructions of the inventor, cannot be regarded as an inventor.

Application for a patent

There are two ways in which a first application for a patent may be filed by a local applicant, namely either -

- as a provisional patent application, accompanied by a provisional specification fairly describing the invention. A complete patent application has to be filed within 12 months from the provisional application (ie. the provisional application must be 'completed' within 12 months), or within 15 months on payment of an extension fee; or
- as a complete patent application in the first instance, accompanied by a complete specification fully describing the invention and the manner in which it is to be performed together with illustrative drawings (where applicable) and claims defining the subject matter for which protection is claimed.

Provisional patent application

The filing of a provisional patent application first has substantial advantages over filing a complete patent application in the first instance, namely:

- A provisional patent application can usually be filed with the minimum of delay, inter alia because claims are not required in a provisional specification.
- The filing of a provisional patent application secures a priority date, both nationally and internationally, in terms of the Paris Convention.
- A provisional application affords an opportunity for the novelty, technical merit, and commercial prospects of the invention to be investigated before further patenting costs are incurred.
- Developments and improvements which occur after filing of the provisional patent application can be covered in a later application, eg in the complete patent application.

If a provisional application is not followed by the filing of a complete application within 12 months, it lapses. An extension of 3 months may be obtained for filing the complete application.

Complete patent application in the first instance

The filing of a complete patent application in the first instance, instead of a provisional patent application, is only advisable if the applicant is completely satisfied that the invention has been perfected and that further improvements or modifications thereof are unlikely. In a complete specification, the invention and the manner in which it is to be put into practice must be fully described, and the best method known to the inventor of exercising the invention should be disclosed.

A complete application in the first instance is filed without a claim to priority, and its effective date is the date of lodging the application.

Complete application based on a prior application

A complete application may be based on a prior application, which may be a South African provisional application, or a prior South African complete application which itself does not claim priority, or a first application filed in another convention country. A complete application filed pursuant to a prior South African application may claim the priority date of the prior application, provided such earlier application was filed no more than 12 months before (or 15 months upon payment of an extension fee). A complete application based on an application in another country and filed as a so-called convention application, may claim the priority date of the prior application filed in a convention country not more than 12 months before, in terms of the Paris Convention (see below).

A complete application is examined by the Patent Office for formal correctness only. Examination is **not** for novelty of subject matter or for obviousness.

It is the duty of the applicant to investigate the novelty of the invention, to satisfy himself regarding the validity of the patent, and to determine the position in regard to infringement.

The grant of a patent is no guarantee that the invention is new. Nor is it a guarantee that the patent is valid, nor that the patent cannot be revoked, nor that the exploitation of the invention will not infringe on existing patents.

Effect of filing a patent application

Having filed a provisional patent application for the invention, the applicant may exploit the invention and may disclose it to others without such disclosure in itself affecting the validity of any patent which may be obtained on the patent application. The applicant should, however -

- keep important developments and improvements secret or cover them by new applications;
- exercise caution in exploiting, disclosing or otherwise dealing with the invention, after the patent application has been filed,

if testing and developing the invention can take more than 12 months, thus delaying the filing of a complete application.

The filing of a patent application does not entitle the applicant to restrain others from making, using or disposing of a similar invention. This right to exclude others only arises after the grant of a patent. Furthermore, an applicant's right to exploit the invention is subject to such exploitation not infringing the rights of others.

The filing of a provisional patent application affords the applicant a right in the nature of an option:

- a preferent right over later applicants to obtain a patent for the invention in South Africa, provided a complete application is filed within 12 months;
- a preferent right applicable also to all other convention countries, provided that appropriate steps are taken within 12 months of the filing date of the provisional application.

Searches

It is advisable, though not essential, for the applicant to have searches conducted. An infringement search is to ascertain whether or not exploitation of the invention would infringe a prior patent in South Africa in the name of some other person. An infringement search is advisable before heavy capital costs are incurred in commencing exploitation of an invention. A novelty search is to ascertain the extent to which the invention is novel, and therefore patentable. Such searches should be done before filing patent applications abroad on an extensive scale.

Commercialisation of an invention

The patentability of an invention is not necessarily a measure of its commercial value. Thus an invention may have adequate subject matter to be patentable; yet it may have little commercial value.

Articles in accordance with the invention, and any packaging or advertising therefore, should be marked with the patent application number eg. 'RSA Pat Appln No. 99/1234'.

If the inventor or applicant enters into arrangements for the sale or licensing of the invention, a proper written agreement should be concluded so as to avoid misunderstandings and litigation.

Effect of a granted patent

A patent, when granted, confers upon the patentee in South Africa, for the duration of the patent (as long as it is maintained in force by the payment of the renewal fees), the right to exclude other persons from-

- making,
- using,
- exercising,
- disposing or offering to dispose of, or
- importing

the invention, so that he shall have and enjoy the whole profit and advantage accruing by reason of the invention.

The sale in South Africa 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.

The fact that a patent has been granted, does not mean that it cannot be revoked. At any time after the grant of a patent, any person has the right to apply for the revocation of the patent on any of the grounds prescribed by the Act. The grant of a patent also does not entitle a patentee to exploit the invention; it merely entitles him to exclude others from competing with him. The right to exploit depends upon whether or not prior rights are held by other parties.

Term and maintenance of a patent

The term of a patent is 20 years dating from the date of filing the complete application subject to the patent being maintained in force by the payment of the prescribed renewal fees. In order to maintain the patent in force, it is necessary for annual renewal fees to be paid, commencing at the end of the third year after the filing of the complete application. Failure to pay the renewal fees timeously results in the lapsing of the patent.

Patent protection in countries other than South Africa

A patent granted in this country affords rights in South Africa only, and not in any neighbouring country such as Namibia, Botswana, Lesotho or Swaziland, nor any other country in the world.

If patent protection for the invention is required in any country outside the RSA, separate patent protection must be obtained in each country. This is normally achieved by a separate patent application in each country or by a regional application or via a PCT (Patent Cooperation Treaty) patent application. The priority benefits of the Paris Convention can be claimed in appropriate cases.

Paris Convention benefits

South Africa is a signatory of the Paris Convention for the Protection of Industrial Property, as are most of the important countries of the world.

In terms of the Paris Convention, if an applicant for a South African patent files a corresponding application in another convention country within a year of the date of filing of the first RSA application, the priority of that first South African filing date can be claimed in respect of the application in the convention country. The effective date at which the novelty requirements of that country need to be satisfied will then be the date of filing of the RSA application. The practical effect is that, having filed the RSA application, the applicant may then disclose the invention without prejudicing the validity of any subsequent applications in convention countries, as long as these subsequent applications are filed within a year of the first filed RSA application and priority is claimed.

PCT applications

The Patent Cooperation Treaty is an international agreement, to which South Africa has acceded with effect from 16 March 1999. In terms of PCT, a national or resident of any member country can initially file a single PCT application designating any number of other member countries as designated countries in which patent protection is to be obtained. Priority can be claimed from a basic

application in a member country. The PCT application must be followed by a national patent application in those countries where patent rights are desired.

This procedure entails a number of advantages (including cost advantages) where a national or resident of a PCT member country wishes to file multiple corresponding patent applications in other PCT member countries.

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