

## A) PATENTS

### 1. CONVENTION PATENT APPLICATIONS

1.1 The deadline for filing a convention patent application in South Africa is 12 months from the earliest priority date. This period is extendable by an additional 3 months (i.e. up to 15 months from the priority date) upon application to the Registrar of Patents and upon payment of an additional fee.

1.2 The following minimum requirements must be met to secure a valid filing date in respect of a convention patent application:

- Full name(s) and registered address(es) of each applicant
- Full name(s) and residential address(es) of each inventor
- Title of the invention
- Priority application number(s), country and date(s)

1.3 The following additional documents are required to complete the filing requirements of a convention patent application:

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| <u>Within 14 days</u> of the national filing date  | (i) Complete patent specification, claims and drawings.   |
| <u>Within 3 months</u> of the national filing date   | (ii) English translation of the complete patent specification, claims and drawings, if the application was not filed in English.  |
| <u>Within 6 months</u> of the national filing date ( <i>this period is extendable upon application to the Registrar</i> )  | (iii) Form P3*, Declaration and Power of Attorney – signed by the applicant.<br>(iv) Form P26*, Statement on the use of indigenous biological resource, genetic resource, traditional knowledge or use – signed by the applicant.<br>(v) A certified copy of each priority document. If the priority document is not in English, a certified English translation is required. |
| <u>Before acceptance</u> ( <i>these documents must be filed in time for acceptance within 18 months, or on application to the Registrar, 21 months from the national filing date</i> ) | (vi) Assignment of Invention* – signed by each inventor who is not an applicant.<br>(vii) Abstract of the invention.<br>(viii) Assignment of Priority Rights*, if the applicant is not the applicant in respect of the  |

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|  | priority application |
| <i>* No legalization of formal documents is required</i> |                      |

- 1.4 South Africa has a so-called “deposit system” for patents – i.e. patent applications do not undergo formal examination for the substantive patentability requirements of inventions.
- 1.5 There is no provision for opposition to the registration of a patent application.
- 1.6 No excess claim fees, page fees or grant fees are payable in South Africa.
- 1.7 Patents in South Africa have a maximum duration of 20 years from the national filing date, subject to the payment of annual renewal fees from the third year after the national filing date.
- 1.8 South Africa is a member of the Paris Convention and of the PCT.

## 2. PCT NATIONAL PHASE PATENT APPLICATIONS

- 2.1 The deadline for filing a PCT national phase patent application in South Africa is 31 months from the earliest priority date. This period is extendable by an additional 3 months (i.e. up to 34 months) upon application to the Registrar of Patents and upon payment of an additional fee.
- 2.2 The minimum requirement for a South African national phase patent application is the WIPO publication sheet, or the WO publication number, or the PCT international application number.
- 2.3 The following additional documents are required to complete the filing requirements of a PCT national phase patent application:

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| <u>Within 3 months</u> of the national phase filing date  | (i) English translation of the PCT specification, claims and drawings, if the application was not filed in English.*   |
| <u>Within 6 months</u> of the national phase filing date ( <i>this period is extendable upon application to the Registrar</i> ) | (ii) Form P3**, Declaration and Power of Attorney – signed by the applicant.<br>(iii) Form P26**, Statement on the use of indigenous biological resource, genetic resource, traditional knowledge or use – signed by the applicant.<br>(iv) A certified copy of each priority document. The priority document does not need to be translated into English. |
| <u>Before acceptance</u> ( <i>these documents must be filed in time for acceptance within 18 months, or on application to</i>   | (v) Assignment of Invention** – signed by each inventor who is not an applicant.   |

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| <i>the Registrar, 21 months from the national phase filing date)</i>  | (vi) Abstract of the invention.<br>(vii) Assignment of Priority Rights**, if the applicant is not the applicant in respect of the priority application |
| * <i>The translation does not need to be certified</i><br>** <i>No legalization of formal documents is required</i> |  |

2.4 South Africa has a so-called “deposit system” for patents – i.e. patent applications do not undergo formal examination for the substantive patentability requirements of inventions.

2.5 There is no provision for opposition to the registration of a patent application.

2.6 No excess claim fees, page fees or grant fees are payable in South Africa.

2.7 Patents have a maximum duration of 20 years in South Africa from the PCT filing date, subject to the payment of annual renewal fees from the third year after the PCT filing date.

2.8 South Africa is a member of the Paris Convention and of the PCT.

### 3. PATENTABILITY REQUIREMENTS

For an invention to be patentable in South Africa, the invention must be –

3.1 ABSOLUTELY NOVEL – i.e. the invention must not have been made available to the public, anywhere in the world, in any manner (whether through written or oral description, through use, or in any other way) before the first patent application in respect of the invention is filed.

3.2 INVENTIVE – i.e. the invention must not be obvious to a person who is skilled in the particular technology to which the invention relates, if such a skilled person had the benefit of all prior art relating to the invention.

3.3 USEFUL – i.e. the invention must be capable of being used or applied in trade, industry or agriculture.

#### Technology Searches

It is not always easy to know for certain if an invention satisfies the novelty and inventiveness requirements for patentability. However, we can conduct international technology searches for all prior technologies and disclosures relating to any invention. Please contact us for a detailed quotation.

### 4. NON-PATENTABLE INVENTIONS

- 4.1 The following are not patentable subject matter in South Africa:
- Discoveries
  - Scientific theories
  - Mathematical methods
  - Aesthetic creations (e.g. literary, dramatic, musical or artistic works)
  - Methods of conducting business, playing games or performing mental acts
  - Computer programs
  - The presentation of information
  - Methods of treatment of the human or animal body through surgery, therapy or diagnosis practiced on the human or animal body
- 4.2 In the case of business methods and computer programs, the restriction only applies to inventions which relate to pure business methods and/or computer programs per se, not to inventions which merely make use of or incorporate business methods or computer programs.
- 4.3 In the case of methods of treatment of the human or animal body, the restriction typically only applies to in vivo treatment of the human or animal body, but does not exclude in vitro treatment, or a substance for use in a method of treatment.
- 4.4 First medical claims are allowed in South Africa – i.e. inventions relating to a known substance for use in a new method of treatment, provided the substance has not been used in any such method. It is not yet clear whether second medical claims or Swiss-type claims will be enforceable in South Africa.
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## **5. PATENT PROCEDURE**

- 5.1 Obtaining a patent, whether in South Africa only or also in other countries, is generally a two-fold process, which commences with filing a provisional patent application, including a specification, drawings and set of formal documents, at the South African Patent Office in Pretoria. The provisional patent application has a maximum duration of 12 months, which is referred to as the “priority period”.
- 5.2 During the 12 month priority period, an applicant may freely disclose the invention, internationally, including licensing, assigning or otherwise trading with the provisional patent application.
- 5.3 At or before expiry of the 12 month priority period, the provisional patent application must be completed, either (i) in South Africa only (thus limiting the patentee’s monopoly rights to South Africa), or (ii) as one or more convention patent applications in foreign countries, or (iii) as a PCT application. A patentee’s rights are ultimately limited to the specific countries and/or regions in which patent protection is procured.
- 5.4 South Africa has a so-called “deposit system” for patents – i.e. patent applications do not undergo formal examination for the substantive patentability requirements of inventions.

- 5.5 There is no provision for opposition to the registration of a patent application.
- 5.6 After a complete South African application has been filed and once all formal requirements have been met, the application is accepted by the Registrar of Patents, who then issues a Notice of Acceptance.
- 5.7 The accepted patent application is subsequently published in the South African Patent Journal within a period not exceeding three months from the acceptance date. From the publication date the patent is granted in South Africa.
- 5.8 Patents have a maximum duration of 20 years in South Africa from the filing date of the complete patent application, subject to payment of annual renewal fees from the third year after the complete application filing date.
- 5.9 Please contact us for advice on how to obtain patent protection in other countries and jurisdictions.
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