

Patent Procedure

Patents

A patent is an exclusive right granted for an invention, which is a product or a process that provides a new way of doing something, or offers a new technical solution to a problem. The patent provides protection for the owner, which gives him/her the right to exclude others from making, using, exercising, disposing of the invention, offering to dispose, or importing the invention. The protection is granted for a limited period, generally 20 years.

Services of Patents Experts

In terms of the [South African Patents Act](#), individuals may file their own provisional patent applications. It is however, advisable for applicants to seek the assistance of the Patent Attorneys.

If a provisional patent is filed and the invention is then made public, the strength and breadth and scope of protection ultimately obtained will depend on the wording and content of the specification, the broad definitions and detailed description of the invention. The Patent Office takes precautions to maintain confidentiality but cannot be held responsible for what occurs outside the office.

Patent Attorneys and Agents are familiar with international requirements and are thus in a position to draft provisional specifications in an internationally acceptable fashion, thus promoting protection both in South Africa and abroad.

South Africa is one of 124 countries that accepts the Patent Co-operation Treaty (PCT). This Treaty allows an individual to file an international application as well as a national application. The international application will designate countries in which the applicant seeks protection. Extra fees are payable for this type of registration.

The Patent Office cannot accept any responsibility for the loss of rights arising if the invention becomes public and is copied and the provisional specifications have not been properly drafted.

What is the Lifespan of a Patent?

A patent can last up to 20 years, provided that it is renewed annually before the expiration of the third year. It is important to pay an annual renewal fee to keep it in force. The patent expires after 20 years from the date of application.

What can be patented?

Section 25 of the Patent Act, Act 57 of 1978 deals with this question and is as follows:

25. Patentable inventions

(1) A patent may, subject to the provisions of this section, be granted for any new invention which involves an inventive step and which is capable of being used or applied in trade and industry or agriculture.

(2) Anything which consists of:

- (a) a discovery;
- (b) a scientific theory;
- (c) a mathematical method;
- (d) a scheme, rule or method for performing a mental act, playing a game or doing business;
- (f) a program for a computer; or

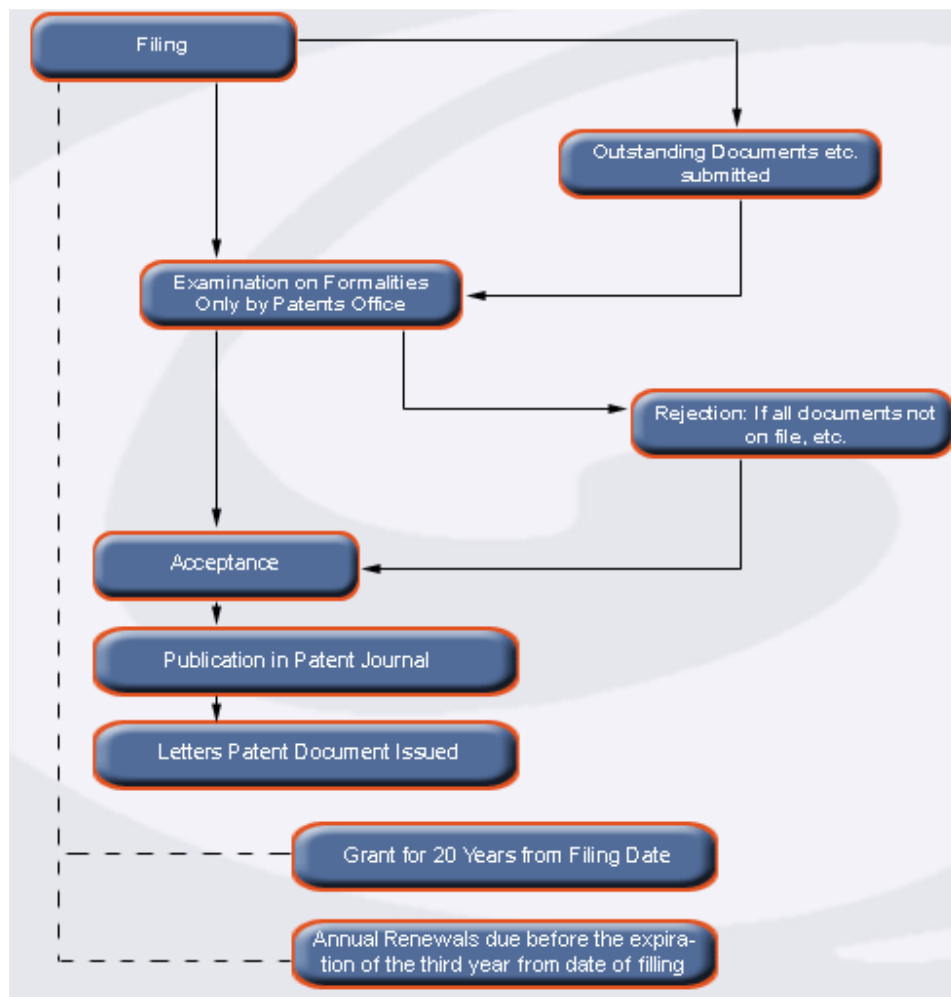
The presentation of information, shall not be an invention for the purposes of this Act.

The Patent Journal

This is a journal published by the Government Printers on a monthly basis, and it contains information on patents, trade marks, designs and copyright on cinematographic films that exist in South Africa. This Patent Journal is obtainable from Government Printers in Pretoria.

Registration Procedure
Patent Cooperation Treaty

Registration Procedure



Regardless of whether the registration process will be via the services of a Patent Attorney or Agent, or whether it will be initiated by the applicant, the following stages **must** be followed:

Step 1: Conduct a Search on Existing Patents

- This search can be undertaken by the applicant / inventor or by the patent attorney / agent
 - This is to ensure that no existing patents are being infringed and that the invention is new/novel (S25 of Patent Act)
 - Although this initial search is not essential it is advisable.
 - The search is conducted in the Pretoria office of the Patents Registrar.

Step 2: Application to Register

- The application for a patent can be in one of three ways:
 - File a provisional application - This may be undertaken by the applicant with or without the assistance of an attorney.
 - File a complete application - This must be via a patent attorney.
 - File a PCT (Patent Co-operation Treaty) application (if applicable)
- The following forms can be obtained free of charge from CIPRO. They must be completed (in black ink or typewritten) and submitted to CIPRO:
 - P1: "Application for a Patent and Acknowledgement of Receipt" and submitted in duplicate
 - P2: "Register of Patents", submitted in duplicate
 - P3: "Declaration of Power of Attorney", 1 only submitted
 - P6: "Provisional Specification", 1 only submitted
 - All documents should preferably be type-printed
- If a **Provisional Patent Application** is submitted, the assistance of a patent attorney is not essential. It is important that the description of the specification is comprehensive and clear, and where applicable, drawings must be attached, on A4 pages.
 - Forms P1, P2, P6 will be completed and P3 if there is a Power of Attorney involved.
 - The fee of for a provisional application is R60.
- In the case of a **Provisional Patent Application**, the office of the Patent Registrar will open a file and provide a provisional patent application number for the purpose of enquiries. The applicant is notified by the return of one of the copies of the P1 that was submitted.
 - Thereafter, a Complete Patent Application must be submitted within 12 months of the date of filing the Provisional Patent Application (via a Patent Attorney or Patent Agent).
 - During this time (i.e. the 12 month period) the inventor is able to work on his invention.
 - During this period the inventor / manufacturer can also "test-the-market" to assess the viability of the invention before incurring the costs involved in a Complete Patent Application.
- If a **Complete Patent Application** is being submitted, the assistance of a Patent Attorney is essential.
 - Forms P1, P2, P3 (Power of Attorney) must be completed.
 - The fee for a complete application is R266-00.
 - Full detailed descriptions and specifications, drawings on a A4 pages etc should be included.
 - Consideration may also be given to applying for patent rights / protection in other countries.
 - PCT applications are regarded as complete applications.

Step 3: Registration of a Patent

Once a Complete Patent Application has been lodged, formal examination commences. This process usually takes about 6 months.

- If all the formalities have been complied with, the application is accepted. The applicant is then required to publish his / her patent in the Patents Journal, published monthly by the government printers.
 - This allows members of the public the opportunity to lodge objections.
 - If after 3 months, there are no objections, the Patents Registrar will issue a Patent Certificate.

Patent Cooperation Treaty

Introduction

With the traditional patent system, if patent protection is sought in other countries, individual patent applications need to be made for each respective country. This involves the preparation and filing of several patent applications, translation costs, the services of patent attorneys in these countries, and fees to the various patent offices – all resulting in considerable costs.

Under the traditional system, the patent office in each country (where protection is sought) must carry out formal examination of the application and search procedures i.e. duplication of effort.

In order to overcome some of these problems the Patent Co-operation Treaty (PCT) came into effect in 1978. This treaty came into effect in South Africa in March 1999. There are at present 124 countries (including South Africa) that are part of this international treaty.

What is the PCT?

As the name (Patent Co-operation Treaty) suggests, the PCT is an agreement for international co-operation in the field of patents. More specifically, it is a treaty that provides for rationalisation and co-operation with regard to the filing, searching and examination of patent applications.

The PCT does not provide for the granting of "international patents".

- The task and responsibility for the actual granting of patents remains in the hands of the Patent Offices in the designated countries where protection is being sought.
- The PCT streamlines the international search and examination process and this results in cost cutting.
- The PCT provides for the formal examination of the international application by way of a single patent office – the Receiving Office.
- Each international application is subjected to an international search and the searching authority provides a report on whether any similar inventions have been lodged. This enables the applicant to decide whether or not the invention is patentable.
- The PCT provides a centralised international publication of international applications together with related international search reports. It provides the option of an international preliminary examination and provides reports that assist the Patent Offices in the various signatory countries, with an opinion as to whether the claimed invention meets certain international criteria for patentability.
- These services obviously streamline the traditional procedures for patent application to foreign countries, and result in considerable reduction in time and costs.
 - Under the "traditional" system, the applicant for a patent registration:
 - a. Files for a Provisional patent application, and then
 - b. Within 12 months applies for a "Complete patent application" and
 - c. At this point the applicant would file patent applications abroad to designated countries (as required), under the Paris Convention.
 - d. These international patent applications result in
 - multiple formality requirements
 - multiple searches
 - multiple examinations and procedural formalities
 - translations and national fees, all payable after the patent is lodged in each country.
 - With regard to the PCT system, when an international application is made, a further 8 to 18 months is added for the international search and international publication i.e. up to 21 months or even 31 months before the applicant has to finally decide whether or not to proceed with the actual patent applications in other designated countries.
 - Thus the applicant, under the PCT system "buys time" before committing to a decision whether or not to apply for patents in other countries and incurring the considerable costs involved in this process.

The PCT System Procedures

- If an applicant has come up with an invention that he or she wishes to patent in a number of countries, the applicant is advised to utilise the Patent Cooperation Treaty (PCT) prior to actually lodging patent applications in these countries – the benefits of the PCT system have been outlined above. However certain "benefits" or "discounts" can apply – and CIPRO is able to provide advice and guidance in respect of how to qualify for these.
- The Applicant or Patent Attorney will complete a "Patent Cooperation Treaty Request Form" (in triplicate), together with the respective specifications, drawings etc.
- The PCT office at CIPRO processes this application and calculates the costs involved.

NOTE:

- Any national or resident of a PCT contracting state (e.g. a South African national or resident) can file an international application at the Receiving Office in South Africa.
- The PCT system is a patent "filing" system, and is not a patent "granting" system. There is no "PCT patent".
- 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 decision on granting patents is taken exclusively by national or regional offices in the national phase.
- Only inventions may be protected via the PCT by applying for patents, utility models and similar titles.
- Design and trade mark protection cannot be obtained via the PCT. There are separate international conventions dealing with these types of industrial property protection (The Hague Agreement and the Madrid Agreement, respectively). SA is not yet a member of these agreements.

