

# *Study unit 3*

## *How to apply for a patent*

### *Overview*

This study unit deals with the procedure for obtaining a patent. We will distinguish between national applications and international applications. We will determine who may lodge a patent application and how, where, and when it must be lodged.

### *Learning outcomes*

- After completion of this study unit, you should be able to —
- ☐ establish when an employer may apply for a patent for an invention that was made by an employee
  - ☐ describe the patent application procedure
  - ☐ explain what a "priority date" means
  - ☐ explain the significance of application procedures through the PCT the Patent Law Treaty and the Paris Convention
  - ☐ describe the international patent application procedures
  - ☐ distinguish between the national and international phase of an international patent application
  - ☐ explain what an "examining office" is
  - ☐ determine the term of a patent

### *Setting the scene*

Vuzi now wants to lodge a patent application for his cream. He wants to obtain patent protection for the anti-ageing properties of the cream, the diagnostic use of the cream and he also wants to obtain patent protection for the computer program. He now wants you to prepare the patent application for him. He wants to know what information you need. He wants to know where he must lodge his application. He wants to export the cream to the United States and to Europe, and he wants to know whether he must lodge an application in each of those countries. Vuzi wants to know in whose name the patent application must be lodged, as Thandi insists to be named a "part inventor". He also wants to know in which countries he must lodge applications and how he must comply with all the laws of the different countries. He also wants to know from when his patent will enjoy protection and for how long.

The discussion of national applications will focus on the South African Patents Act. In the discussion of international applications, we will focus on the Patent Co-operation Treaty (PCT).

The Paris Convention for the Protection of Industrial Property was concluded in Paris in 1883 and has been revised fairly regularly. South Africa became a party to the convention in 1947; most important countries are members. The member countries of the Paris Convention are obliged to accord the nationals of other member countries the same rights as far as the protection of industrial property is concerned, as their own nationals enjoy in terms of their respective laws (art 2).

Under the traditional Paris Convention route a national application may form the basis for subsequent filings in foreign countries within 12 months of the earlier filing. Generally, with the exception of regional patent systems (the ARIPO Harare Protocol, the Eurasian Patent Convention, the European Patent Convention and the OAPI Agreement), this would mean the preparation of national applications for every single national system under which the applicant seeks protection. The preparation of these multiple applications would also entail expenses for translations, patent attorney fees as well as patent office filing fees.

The Patent Co-operation Treaty (PCT) is a multilateral treaty which simplifies the process of obtaining international patent protection for inventions. It is a special agreement under the Paris Convention. The PCT entered into force in 1978 and it is administered by WIPO.

With the PCT, it has become possible to file a single international application which has the same effect as filing separate applications with the patent office of each country party to the PCT which is designated in the application. It provides for the filing of one patent application ("the international application"), with effect in several States, instead of filing several separate national and/or regional patent

applications. At the present time, an international application may include designations for regional patents via the so-called “ARIPO-PCT route”, the “Eurasian-PCT route”, the “Euro-PCT route”, and the “OAPI-PCT route”.

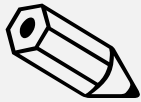
In the case of the European Patent Convention, it is also possible to obtain patents through combined use of that Convention and the PCT in the States to which a European patent may be extended. The Patent Law Treaty (PLT) was adopted on 1 June 2000 by the EPO, the Eurasian Patent Organization and ARIPO. The PTL deals with procedural aspects of PCT applications. This treaty is open for signature by any State that is also a member of the Paris Convention or any of the aforementioned three organizations.

### *The objectives of the PCT*

These new international instruments have created a greater efficiency and have brought an element of competitiveness into the international application system. The patent industry can only benefit from these additional routes that have been created to facilitate obtaining of patent rights in multiple jurisdictions. The PCT is one of the most significant developments in international cooperation in the field of patent law since the adoption of the Paris Convention.

The principle objective of the PCT is to render the obtaining of patent protection in several countries more effective and economical. To achieve this objective the PCT provides for:

- ☐ a single international application in one language
- ☐ formal examination of the international application by a single office
- ☐ subjects each international application to an international search on prior art by the International Searching Authority
- ☐ a centralized international publication of international applications
- ☐ an option of international preliminary examination by the Preliminary Examination Authority
- ☐ technical information related to inventions and assists developing countries to access technology



### *Activity 3.1*

Ascertain to whether your country is —

- ☐ a member of the Paris Convention,
- ☐ a member of the PCT, and
- ☐ a party to any regional patent system.

### *Discussion*

### *National applications*

#### *The applicant*

#### *The inventor*

The identity of the applicant for a patent is closely tied to that of the inventor. Section 27(1) of the Patents Act provides that application for the registration of a patent may be made by the inventor, or by some other person who has acquired the right to apply from the inventor, or by both the inventor and such other person (sect 27(1)). The definition of the term "applicant" includes the legal representative of a deceased applicant or an applicant under legal disability. The person entitled to exercise the rights of a deceased inventor or an inventor under disability will have to be determined in accordance with general principles.

Historically, the term "inventor" included a person who had imported an invention into South Africa (similar to the position in England prior to the 1977 Patent Act). This approach was amended 1896 in *Hay v African Gold Recovery Co* ((1896) III OR 244). The court noted (at 277-278):

“The question now arises, in what sense the words *first and true inventor* must be interpreted....The person who has been the first to introduce an invention into England from abroad, is regarded as an ‘inventor’, and as falling under the statute. ‘Inventor’ is read as including ‘importer’... [and] the words ‘first and true inventor’ are not to be taken in the artificial sense of the English Law, but in their natural sense. They are not limited to persons within the State; nor can ‘inventor’ carry the meaning of ‘importer’. The ‘first and true inventor’ signifies that the

person so described made the discovery himself, and that he did so before anyone else in any part of the world.”

The South African Patent Act also now specifically **excludes** applications made by importers or communicatees of inventions (see "Who may not apply" below).

### *Joint inventors*

Joint inventors may apply for a patent in equal undivided shares, unless they agree to some other disposition of rights. Section 29 provides for the settlement by the commissioner of disputes relating to an application between joint applicants. Upon application made to him, the commissioner also decides disputes between persons about their rights to obtain a patent for an invention, or to make, use, exercise or dispose of an invention, or to the right or title to a patent.

### *Employment situation*

The question now arises what happens if an invention is made within the course and scope of employment? Disputes between employer and employee in respect of an invention made by the employee are common.

The Act does not expressly provide for the allocation of inventions made by employees in the course of their employment. The only statutory provisions specifically relating to the employer-employee relationship are those contained in section 59, more about which below.

According to Burrell (*South African Patent Law and Practice* 320) the correct approach is that an invention made in the course and scope of an employee's employment shall belong to the employer **only if** an agreement exists between the parties to this effect (see, generally, Burrell op cit 319-328).

This approach is in line with that taken in the United States of America (see Burrell op cit 323 and 327-328 on the American position). In England, prior to the Patents Act 1977, the position, in the absence of specific legislative regulation, was as set out by Lord Reid in *Sterling Engineering Co Ltd v Patchett* [1955]

AC 534 at 547 ([1955] 72 RPC 50 at 58):

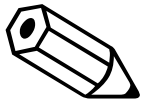
“No doubt the respondent was the inventor and in the ordinary case the benefit of an invention belongs to the inventor. But at the time when he made these inventions he was employed by the appellants as their chief designer and it is, in my judgement, inherent in the legal relationship of master and servant that any product of the work which the servant is paid to do belongs to the master: I can find neither principle or authority for holding that this rule ceases to apply if a product of that work happens to be a patentable invention. Of course, as the relationship of master and servant is constituted by contract the parties can, if they choose, alter or vary the normal incidents of the relationship, but they can only do that by express agreement or by an agreement which can be implied from the facts of the case.”

Presently, the Patents Act 1977 expressly provides that inventions made by employees in certain circumstances shall belong to the employer, while other inventions shall belong to the employees themselves. In the absence of specific provisions in the South African Patents Act, the allocation of an invention made by an employee shall, in the case of a dispute, be made in accordance with general principles (see *Brown NO v Simmonds* 1947 (4) SA 108 (SR)).

It is important to note that, in terms of section 59(2), any condition in a contract of employment which (1) requires an employee to assign to his employer an invention made by him otherwise than within the course and scope of his employment; or (2) restricts the right of an employee in an invention made by him more than one year after the termination of the contract of employment, is null and void.

*Who may not apply?*

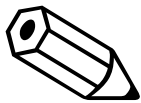
An importer or a communicatee may not apply for a patent. Furthermore, an officer or employee of the Patens Office may also not make an application for a patent as an assignee. In other words, an officer or employee of the Patents Office may only file a patent application if she is the inventor or is she had obtained the rights by bequest or devolution of law.



### *Activity 3.2*

In your patents Act –

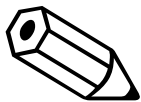
- ☐ explain the meaning of the term “applicant”
- ☐ determine whether an importer or communicatee of an invention may lodge a patent application



### *Activity 3.3*

Vuzi wants to know in whose name the patent application must be lodged, as Thandi insists to be named a “part inventor”.

- ☐ What would the position be if Thandi had written the computer program for the manufacturing process of Vuzi’s cream as an independent contractor?
- ☐ What would the position be if Thandi had written the computer program for the manufacturing process of Vuzi’s cream as an independent contractor?



### *Activity 3.4*

Thandi is an employee of Vuzi, a manufacturer of cosmetic creams. Thandi is a computer programmer. Thandi enters into an employment contract with Vuzi. The agreement contains the following clause:

“The employee hereby assigns all rights and title in **any** invention made by herself to her employer.”

Thandi weaves materials from fibres of different textures as a hobby. One day she accidentally leaves a piece of her weaving on one of Vuzi’s heaters. Hours later she discovers that certain fibre combinations form a very strong, almost unbreakable material when exposed to heat. During the next few days she brings different samples of fibre to work and she experiments using different combinations of the fibre and different periods and settings of heat exposure. As a result of all her experimentation, Thandi discovers that a very strong and

durable type of material may be made by the specific combination of different types of fibre for a period of time on the employer's heater. The material is suitable for windsurfing and she thinks that a considerable commercial market exists for the material.

Vuzi and Thandi approach you for legal advice.

- ☐ Vuzi is of the opinion that the invention belongs to him, the employer, because it was made during her hours of employment with him and his equipment was used.
- ☐ Thandi argues the her invention has nothing to do with her employer.

What is your opinion on the ownership of the invention?

### *Discussion*

### *Application procedure*

Patent applications are made in the form prescribed by section 30 and the regulations under the Act. They must contain an address for service of notices and communications in respect of the application. A declaration setting out the facts relied upon in support of the application must be lodged with the registrar before he will accept the application. The application must be signed by the applicant or his agent, and, where the applicant is a person other than the inventor, or a joint applicant with the inventor, proof of title or authority to apply must be filed.

A patent application must be accompanied by either a provisional or a complete specification; in the former case the application is referred to in patent vocabulary as a provisional application, although the Act itself does not use this term.

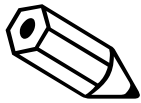
### *Provisional and complete specifications*

All that is required of a provisional specification is that it should fairly describe the invention.

A complete specification, by contrast, is required -



- ☐ to have an abstract
- ☐ fully to describe, ascertain, and where necessary, illustrate or exemplify the invention and the manner it is to be performed
- ☐ to disclose the best method of performing the invention known to the applicant at the time he lodges the specification at the patent office
- ☐ end with a claim or claims defining the invention for which protection is claimed.



### *Activity 3.5*

Describe in your own words the difference between a provisional and a final patent specification.

### *Discussion*

We have now discussed the applicant and application procedure of national applications. We now turn to the procedure for lodging international applications.

### *International applications*

#### *Introduction*

*nine months*

International applications pass through two stages. The first, general stage is called the international phase; it is followed by the national phase.

#### *The international phase*

In the international phase there are four main steps:

- ☐ the filing;
- ☐ the international search;
- ☐ the international publication; and
- ☐ the international preliminary examination.

An international application must be an application for the protection of an invention. The PCT encompasses the filing of applications for patents for inventions, inventors' certificates, utility certificates, utility models, and various kinds of patents and certificates of addition (see Article 2(i)). An international

application thus cannot validly be filed for certain other forms of industrial property rights which fall outside the scope of "inventions," such as, for example, purely ornamental designs.

### *The applicant*

Members of a PCT Contracting State, as well as persons having their place of business or residence in a Contracting State can file a PCT application. Where there are two or more applicants, at least one of them must be a national or a resident of a Contracting State. Where a PCT application is filed at the EPO (the so-called "Euro-PCT" application) there is an additional requirement that the PCT applicant must also be a EPC national, or have his place of business or residency in one of those member states. For example, a US citizen may not file a PCT application at the EPO if he does not live or have a place of business in the EPC member states.

The national law of any designated State may require that, for the purposes of the designation of that State, the applicant must be the inventor. There is presently one such State – the United States of America.

Note, however, that where more than one type of protection is available for a Contracting State, different applicants may not be indicated for different types of protection. A designation of a State by an applicant is unitary. Even if more than one type of protection for an invention is available in a designated State, such types of protection are available only for the same applicant.

### *Residency and nationality requirements*

The question whether an applicant is a resident or national of a Contracting State depends on the national law of that State and is decided by the receiving Office. In any case, however, possession of a real and effective industrial or commercial establishment in a Contracting State is considered residence in that State, and a legal entity constituted according to the national law of a Contracting State is considered a national of that State. Where a question of the applicant's residence or nationality arises in connection with an international application filed with the International Bureau as receiving Office, the

International Bureau will request the national Office of, or acting for, the Contracting State concerned to decide the question and will inform the applicant of such request. The applicant has the opportunity to submit arguments relating to the issue of residence or nationality directly to that national Office, which will decide the question promptly.

### *Joint inventors*

Two or more persons can be joint applicants for an invention and they may designate different Contracting States. However, the PCT rules require a jointly designated common agent to be appointed. Where no common agent has been designated, the first-named applicant will be deemed to be the common representative.

### *Receiving offices*

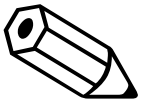
An applicant may file a PCT application with his own national Office as receiving Office, even at the very end of the priority year, and still obtain an immediate automatic filing effect with the regional Office concerned. At such time of filing the PCT application, the applicant pays only one designation fee for each regional patent desired, no matter how many States are designated in respect of each of them. The four regional designations which are presently possible cover more than 50 PCT Contracting States. Similar advantages are offered by use of the ARIPO-PCT, Eurasian-PCT, Euro-PCT and OAPI-PCT routes in the reverse direction. In other words, a national of a State party to one of the regional patent treaties or of one of the States to which a European patent may be extended may, instead of filing separate patent applications with his regional Office and, for instance, the Japanese Patent Office and the United States Patent and Trademark Office, choose to file, on the basis of a national application or as a first application, an international application under the PCT containing a designation for the purposes of obtaining the regional patent concerned and at the same time designating other Contracting States of the PCT, for instance, Japan and the United States of America.

### *The national phase*

On completion of the international phase, further action is required before and in each of the designated Offices. There is a national phase for every one of the offices before which the applicant will have to complete the patenting process, including both national and regional offices.

In particular, the applicant has to pay to those Offices the required regional or national fees, furnish them with any translations that are required and appoint a representative (patent agent) where required. The designated Offices then examine the application and grant or refuse the national (or regional) patent on the basis of their national laws. (In the PCT any reference to “national law” is also a reference to a regional treaty such as the ARIPO Harare Protocol, the Eurasian Patent Convention, the European Patent Convention and the OAPI Agreement) These procedures before the designated Offices constitute what is usually referred to as the "national phase" of the PCT procedure.

For example: in the national phase a European patent can be obtained at present for 19 countries bound by the PCT. In that case, the applicant would go to the European Patent Office and obtain a European patent which would be effective in 19 countries; he would not therefore have to go to each of the 19 countries to complete the patenting process. He would have to meet a number of requirements, such as paying fees to the 19 offices, but the question of grant of a patent would not be reopened at that stage.



#### *Activity 3.6*

Vuzi and Thandi wants to file a Euro-PCT patent application.

- ☐ Will they be allowed to file such an application?
- ☐ What questions would you pose to Thandi and Vuzi?
- ☐ What would the position be if Thandi was the owner of fast-food restaurant in London?

*National and international applications*

In the case of an invention comprising a micro-biological process, section 32(6) of the Patents Act requires the deposit of samples. It states:

“If a complete specification claims as an invention a microbiological process or a product thereof, samples of any micro-organism in question which is not available to the public shall before the acceptance of the application be dealt with in the prescribed manner....”

In 1997, South Africa acceded to the Budapest Treaty on the International Recognition of the Deposit of Micro-organisms for the Purposes of Patent Procedure. As a result, a new regulation 28A, entitled "microbiological processes and products", has been inserted in the patent regulations. This new regulation prescribes the manner in which a micro-organism should be dealt with in the circumstances envisaged by section 32(6).

Briefly, a culture of the micro-organism must be deposited with an international depositary authority recognised in terms of the Treaty, not later than the date of lodging the application in South Africa. Where an international application is filed under the PCT, a microorganism must be deposited on filing or priority date.

The complete specification should state the name (or a recognised abbreviation) of the relevant international depositary authority, and provide certain other information. The information regarding the international depositary authority may be added to the specification by way of amendment at any time before the application becomes open to public inspection ("the publication date"). The communication of the information about the deposit is considered to constitute the unreserved and irrevocable consent of the applicant to make the deposited culture available to the public from the publication date. A sample of the deposited culture must be furnished to any requesting party from the publication date, provided that a valid request for it is made to the relevant international depositary authority.

## *Priority date*

### *National and international applications*

#### *Date of the application*

The date of the application is usually the date of filing the application with the patent office (sect 33(1)).

#### *Priority date*

A priority date refers to the possibility of ante-dating an application to an earlier date (sect 37). A patent claim can, in certain circumstances, be entitled to a date **earlier** than the date on which the patent application was actually filed at the patent office. Such an earlier date is referred to as the priority date. This section should, of course, be read with section 33.

An international application which has been accorded an international filing date is the equivalent of a "regular national filing" within the meaning of the Paris Convention for the Protection of Industrial Property and, consequently, may be invoked as the basis of a priority claim in a national, regional or other international application filed subsequently within the time limit and subject to the conditions provided for in that Convention. Any invention claimed in an application may have one or more priority dates.

There is a rebuttable presumption that the priority date of an invention is the earliest priority date claimed in an application. When one determines whether an invention claimed in an application is fairly based on the matter disclosed in an earlier application or an earlier application in a convention country, one should consider the disclosures contained in all documents lodged at the same time as and in support of such earlier application.

Priority can be claimed in the following instances (see sect 31(1)):

- ☐ An application accompanied by a complete specification

can claim priority from the date of application (this will then be the priority date) of a previous application in respect of the same invention and accompanied by a **provisional** specification, which was filed not more than one year (or at the most 15 months on payment of a prescribed fee) prior to the application claiming priority.

- ☐ An application accompanied by a complete specification can claim priority from the date of filing (again, the priority date) of a previous application in respect of the same invention and accompanied by a **complete** specification but which itself was without a claim to priority, and which was filed not more than one year prior to the application claiming priority.
- ☐ An application accompanied by a complete specification can claim priority from the date (again, the priority date) of an **application in a convention country** in respect of the same invention, which was filed not more than one year prior to the application claiming priority and which was the first application in a convention country. (A "convention application" is an application for a patent made in South Africa, which application claims priority from a relevant application in a convention country.)

A person who has filed a patent application in any member country enjoys a right of priority for a period of 12 months from the date of filing the application in the first member country (referred to as the "convention country"), and is, therefore, entitled to obtain a patent in preference to other applicants in any other member country, provided that a corresponding application is filed in that member country within the twelve-month period specified (art 4). The priority period is calculated from the first application for protection in a convention country. But in certain circumstances a subsequent application will be regarded as the "first" application – where, after filing of a first application in a convention country, a subsequent application is filed in the same country and in respect of the same invention, and

- ☐ the first application has been withdrawn, abandoned or refused without having been open to public inspection;
- ☐ no priority rights have been claimed on the strength of the first application; and
- ☐ no rights are outstanding in the convention country in

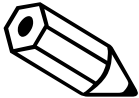
connection with the first application (sect 31(2)).

But it is possible to claim as a priority date a date earlier than the date of application: where priority is claimed from one or more earlier applications, or one or more earlier convention applications, or both, and the invention claimed in the specification is fairly based on matter disclosed in one or more of these earlier applications, the priority date of the invention is the date of lodging the earliest application in which the matter was disclosed in so far as it is fairly based on such earlier application.

The priority date of new matter introduced by way of a supplementary disclosure in terms of section 51(8) is the date of lodging such disclosure (sect 33(6)).

An application accompanied by a provisional specification (the provisional application) lapses unless:

- ☐ a further application with a complete specification (the complete application) is lodged within 1 year, or (if a prescribed fee is paid) within 15 months of the date of the provisional application;
- ☐ priority is claimed in the complete application from the date of the provisional application.



*Activity 3.7*

In your Patents Act, list all the circumstances under which “priority” may be claimed for a patent application.

*Discussion*

*Examination of the application*

*National applications*

*unjustifiable threats*

The registrar examines the complete application only as to form, since the patent office has neither the staff nor the facilities to examine each application for subject-matter and merit. Where the registrar is satisfied that the formal



requirements of the Act have been met, he will accept the application (sect 34).

The application shall be refused where it appears to the registrar that:

- ☐ the application is frivolous on the ground that it claims as an invention that which is obviously contrary to well-established natural laws;
- ☐ use of the invention to which the application relates would be generally expected to encourage offensive or immoral behaviour;
- ☐ use of the invention in respect of which a patent is sought might be used in some manner contrary to law.

The registrar may allow the application to proceed if the applicant adds a disclaimer in respect of such use, or some other reference to the illegality of such use, as the registrar may determine (see sections 25(4)(1) and 36(1)-(2)).

In other cases where the registrar is not satisfied with the application, he may refuse to accept it altogether or may require amendment of the application or specification to comply with the Act (sect 35(1)).

### *International applications*

The international search report is established for each international application, according to high, internationally regulated standards, by one of the Patent Offices that are highly experienced in examining patent applications and that have been specially appointed to carry out international searches.

The international preliminary examination report, a report which is available from equally experienced Offices which have also been appointed to that effect, contains very valuable information on the patentability of the invention.

### *Acceptance, grant, and sealing*

If the registrar finds that the application is in order, he gives the applicant written notice of acceptance of the complete specification. The notice specifies the date of acceptance of the

specification and states that once the applicant publishes the fact of acceptance of the specification in the patent journal, the patent shall be deemed to have been sealed and granted as from the date of publication. Failure to advertise the acceptance of the application timorously, or within an extended period allowed on application to the registrar, will cause the application to lapse (sect 42).

After publication, the registrar grants and seals a patent in respect of the invention with the seal of the patent office. Sealing is deemed to have been effected at the date of publication of the complete specification, and the patent is effective from that date (sect 44).

It should be noted that, subject to certain exceptions, an application will lapse if the registrar has not accepted a complete specification in respect of it within 18 months of the date of application.

### *Opposition and revocation*

Once a patent has been granted, any person may apply in the prescribed manner for the revocation of the patent upon the grounds specified in section 61, and only upon those grounds.

The grounds to which the section refers are:

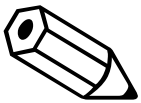
- ☐ that under section 27 the patentee is not entitled to apply for the patent
- ☐ that the grant of the patent is in fraud of the rights of the applicant or of any person under or through whom he claims
- ☐ that the invention is not patentable under section 25 of the Act
- ☐ that the invention as illustrated or exemplified in the complete specification concerned cannot be performed or does not lead to results and advantages set out in the complete specification
- ☐ that the complete specification does not fully describe, ascertain and, where necessary, illustrate or exemplify the invention and the manner in which it is to be performed
- ☐ that the complete specification as accepted does not disclose the best method of performing the invention

- known to the applicant for the patent at the time when the specification was lodged at the patent office
- ☐ that the claims of the complete specification are not clear, or are not fairly based on the matter disclosed in the specification
  - ☐ that the declaration lodged in respect of the application as prescribed contains a false statement or representation which is material and which the patentee knew to be false when the declaration was made (false statements of particular relevance here are ones relating to inventorship, to the right of the applicant to apply, and to convention applications where priority is claimed)
  - ☐ that the application for the patent should have been refused under section 36
  - ☐ that the complete specification claims a microbiological process or product of it as an invention, and the requirements of section 32(6) have not been satisfied

The commissioner has the power either to revoke the patent, or to uphold it subject to suitable amendment.

The invalidity of one claim renders the entire patent susceptible to revocation, unless it is amended to cure the invalidity (see *Wright Boag & Head Wrightson (Pty) Ltd v Buffalo Brake Beam Co* December 1965 Patent Journal 34). Burrell (*South African Patent Law and Practice* 258) points out that the entire patent should not be seen as invalid, since section 68 specifically provides for relief for the infringement of a partly-valid patent.

Revocation of a patent is retrospective to the date of the grant of the patent. Note that a patent which has expired is nevertheless capable of being revoked (see *Wright Boag & Head Wrightson (Pty) Ltd v Buffalo Brake Beam Co (supra)*).



### *Activity 3.8*

In your Patents Act, list the grounds upon which a patent may be revoked.

The TRIPS Agreement provides in article 33 that the term of protection available to a patent holder shall not end before the expiration of a period of twenty years calculated from the filing date. Section 45 of the South African patent Act provides that the term of a patent is 20 years from the date of application. The patent's subsistence is subject to payment of the prescribed renewal fees. A patentee whose patent has lapsed because of a failure to pay the prescribed fees may apply to the registrar for its restoration (sect 47). If the registrar is satisfied that the omission was unintentional and that the application has not been unduly delayed, he must advertise the application. Any person may then give notice of opposition to the restoration of the patent. If the restoration is not opposed, the registrar must issue an order for the restoration of the patent on payment of the prescribed fees; if it is opposed the commissioner decides the matter.

*Amendment of a specification, and  
correction of the register and other documents*

An applicant or patentee may at any time apply for the amendment of his provisional or complete specification. His application must take the prescribed form and must contain full reasons for the requested amendment (sect 51(2)).

Where the specification concerned is open to public inspection, the amendment application must be advertised and is open to opposition. The commissioner deals with such opposition and determines whether and on what conditions, if any, the amendment ought to be allowed (sect 51(2) and (3)).

But where the specification concerned is not open to public inspection, or where no opposition to an application for amendment has been entered, the registrar determines whether an amendment should be allowed, and if so, on what basis (sect 51(4)).

Amendments which introduce new matter into a specification or which introduce matter previously not disclosed in substance in the specification, will not be allowed (sect 51(5) and (6)). With a

complete specification not yet open to public inspection, new matter may be introduced by way of a supplementary disclosure attached to the specification. This supplementary disclosure will then be considered, should the validity of the patent be questioned later. It must describe matter which may fairly be associated with the matter described in the specification as originally framed, and should not be capable of forming the subject of a patent of addition (sect 51(8)). When determining the validity of the patent, regard should be had to the priority date of the new matter introduced by way of the supplementary disclosure.

The amendment of a complete specification which will have the effect that claims will be included which are not fairly based on the specification before amendment, or that claims will be included which are not wholly within the scope of a claim before amendment, will not be allowed (sect 51(6) and (7)).

The amendment of a provisional specification shall be allowed if it is by way of correction, including correction of an obvious mistake. This concerns an amendment by way of correction where the draftsman of the provisional specification has, despite his intention to do so, failed to draft the specification in a way which correctly reflects his intention. No amendment of a provisional specification shall be allowed if it would introduce into the specification new matter or matter not in substance disclosed in the specification sought to be amended before the amendment.

Section 50 provides for the correction of clerical errors or errors in translation in any document which is part of a patent or a patent application, or in the register. Where such a correction is applied for and the registrar is of the opinion that the correction would materially alter the scope of the document, he may require that the correction be published in the patent journal, or be served on such persons as he may consider necessary. Any person can then enter an opposition against such a correction (sect 50).

The registrar may order the register to be rectified by the making, amendment or deletion of any entry therein; such an order may be made either upon the request of an interested party or without such a request (sect 52).

### *Conclusion*

The basic formal requirements for the lodging of a patent application and the important role that the PCT plays in securing international patent protection should now be clear to you.