

PATENTS ACT 57 OF 1978

[extracts]

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2 Definitions

In this Act, unless the context otherwise indicates —

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'applicant' includes the legal representative of a deceased applicant or of an applicant who is a person under legal disability;

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'application in a convention country' means —

- (a) any application for a patent lodged in a convention country;
- (b) any application for a utility model lodged in a convention country; or
- (c) any application for an inventor's certificate lodged in a convention country in which applicants have the right to apply, at their option, either for a patent or for an inventor's certificate in respect of the invention in question;

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'convention application' means an application for a patent made in the Republic which claims priority from a relevant application in a convention country

'convention country', in relation to any provision of this Act, means any country, including any group of countries and any territory for whose international relations another country is responsible, which the President has with a view to the fulfilment of any treaty, convention, arrangement or engagement, by proclamation in the *Gazette* declared to be a convention country for the purposes of such provision; and the expressions **'convention aircraft'**, **'convention land vehicle'** and **'convention vessel'**, have corresponding meanings;

'court', in relation to any matter, means the division of the High Court of South Africa having jurisdiction in respect of that matter;

'date of application', in relation to an application for a patent, means the date referred to in section 30(5);

'invention' means an invention for which a patent may be granted under section 25;

'journal' means the patent journal to be published in terms of section 14;

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'patent' means a certificate in the prescribed form to the effect that a patent for an invention has been granted in the Republic;

'Patent Cooperation Treaty' means the Patent Cooperation Treaty of 19 June 1970 as amended from time to time and as acceded to by the Republic and as in force in the Republic;

'patented article' means any article in respect of which a patent has been granted and is for the time being in force;

'patentee' means the person whose name is for the time being entered in the register as the name of the grantee or proprietor of a patent;

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'priority date', in relation to any claim of a complete specification accompanying an application for a patent, means the date specified in section 33 as the date from which such claim shall have effect;

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'specification' means a provisional or a complete specification, as the circumstances may require, mentioned in section 32(1);
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3 Application of Act

(1) The provisions of this Act shall apply in respect of all patents, whether granted before or after the date of commencement of this Act: Provided that a patent granted on an application made before such commencement shall —

- (a) not be revoked except upon any ground on which it could have been revoked in terms of the repealed law;
- (b) not be subject to the provisions of section 44(4) of this Act;
- (c) unless it is revoked in terms of paragraph (a), expire on the date on which it would in terms of the repealed law have expired if that law had not been repealed; and
- (d) be subject to the provisions of section 39 of the repealed law, except that the term of any such patent shall not be extended for a period exceeding five years, and provided further that, as from 1 January 1979, no renewal fees shall be payable in respect of such extended period.

(2) All applications and proceedings commenced under the repealed law shall be dealt with in accordance with the provisions of that law.

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CHAPTER V : APPLICATIONS FOR PATENTS

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 or industry or agriculture.

(2) Anything which consists of —

- (a) a discovery;
- (b) a scientific theory;
- (c) a mathematical method;
- (d) a literary, dramatic, musical or artistic work or any other aesthetic creation;
- (e) a scheme, rule or method for performing a mental act, playing a game or doing business;
- (f) a program for a computer; or
- (g) the presentation of information,

shall not be an invention for the purposes of this Act.

(3) The provisions of subsection (2) shall prevent, only to the extent to which a patent or an application for a patent relates to that thing as such, anything from being treated as an invention for the purposes of this Act.

(4) A patent shall not be granted —

- (a) for an invention the publication or exploitation of which would be generally expected to encourage offensive or immoral behaviour; or
- (b) for 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 of such a process.

(5) An invention shall be deemed to be new if it does not form part of the state of the art immediately before the priority date of that invention.

(6) The state of the art shall comprise 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.

(7) The state of the art shall also comprise matter contained in an application, open to public inspection, for a patent, notwithstanding that that application was lodged at the patent office and became open to public inspection on or after the priority date of that invention, if -

- (a) that matter was contained in that application both as lodged and as open to public inspection; and
- (b) the priority date of that matter is earlier than that of the invention.

(8) An invention used secretly and on a commercial scale within the Republic shall also be deemed to form part of the state of the art for the purposes of subsection (5).

(9) In the case of an invention consisting of a substance or composition for use in a method of treatment of the human or animal body by surgery or therapy or of diagnosis practised on the human or animal body, the fact that the substance or composition forms part of the state of the art immediately before the priority date of the invention shall not prevent a patent being granted for the invention if the use of the substance or composition in any such method does not form part of the state of the art at that date.

(10) Subject to the provisions of section 39(6), an invention shall be deemed to involve an inventive step if it is not obvious to a person skilled in the art, having regard to any matter which forms, immediately before the priority date of the invention, part of the state of the art by virtue only of subsection (6) (and disregarding subsections (7) and (8)).

(11) An invention 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 shall be deemed not to be capable of being used or applied in trade or industry or agriculture.

(12) Subsection (11) shall not prevent a product consisting of a substance or composition being deemed to be capable of being used or applied in trade or industry or agriculture merely because it is invented for use in any such method.

26 Prior knowledge or publication of invention excused in certain circumstances

A patent shall not be invalid by reason only of the fact that the invention in respect of which the patent was granted or any part thereof was disclosed, used or known prior to the priority date of the invention —

- (a) if the patentee or his or her predecessor in title proves that such knowledge was acquired or such disclosure or use was made without his or her knowledge or consent, and that the knowledge acquired or the matter disclosed or used was derived or obtained from him or her, and, if he or she learnt of the disclosure, use or knowledge before the priority date of the claim in question, that he or she applied for and obtained protection for his invention with all reasonable diligence after learning of the disclosure, use or knowledge; or
- (b) as a result of the invention being worked in the Republic by way of reasonable technical trial or experiment by the applicant or patentee or the predecessor in title of the applicant or patentee.

27 Who may apply for a patent

(1) An application for a patent in respect of an invention may be made by the inventor or by any other person acquiring from him the right to apply or by both such inventor and such other person.

(2) In the absence of an agreement to the contrary, joint inventors may apply for a patent in equal undivided shares.

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30 Form of application for a patent

(1) An application for a patent shall be made in the prescribed manner and on payment of the prescribed fee and shall be accompanied by a provisional specification or by a complete specification.

(2) Every such application shall contain an address for service in the Republic to which all notices and communications may be sent, and every applicant for a patent shall, before the acceptance of his application, lodge with the registrar a declaration in the prescribed form.

(3) An address for service furnished in terms of section 9(2) of the repealed law, shall be deemed to have been furnished in terms of subsection (2) of this section.

(4) Any person other than the inventor making or joining in an application for a patent shall in the prescribed manner furnish such proof of his title or authority to apply for a patent as may be prescribed.

(5) An application shall, save as is otherwise provided in this Act, date from the day when it is lodged at the patent office.

- (6)(a) An application shall not be denied a lodging date on formal grounds only in that it does not comply with the requirements of subsection (1), provided it is accompanied by —
- (i) the prescribed fee;
 - (ii) the prescribed application form signed either by the applicant or his agent;
 - (iii) one copy of the specification in one of the official languages of the Republic or in an official language of any convention country; and
 - (iv) one copy of the drawings, if any, notwithstanding that they are not in the prescribed form.
- (b) The provisions of paragraph (a)(iii) and (iv) shall be deemed to have been complied with, in the case of a convention application, by the inclusion in the prescribed form of the number, date and title of the relevant application in the convention country from which such convention application claims priority and the name of the convention country, if the specification and drawings, if any, are lodged within 14 days of the date on which the application was lodged.
- (c) Any specification not in an official language of the Republic shall be replaced within three months of the date of lodging by a translation in one of such official languages, certified to the satisfaction of the registrar.

(7) An application may be amended within two months from the date on which it has been lodged, in order to claim priority.

31 Claiming priority

- (1) An application accompanied by a complete specification may claim priority from —
- (a) the date of the lodging of a prior application relating to the same subject-matter, accompanied by a provisional specification;
 - (b) the date of the lodging of a prior application relating to the same subject-matter, accompanied by a complete specification and claiming no priority; or
 - (c) the date of an application in a convention country relating to the same subject-matter,

provided —

- (i) in the case of an application claiming priority in terms of paragraph (a) or (b) the prior application was lodged not earlier than one year before or, on payment of the

prescribed fee, not earlier than 15 months before, the date of the application claiming priority;

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- (iii) in the case of an application claiming priority in terms of paragraph (c) the application in the convention country was lodged not earlier than one year before the convention application and was the first application in any convention country in respect of the relevant invention; and
- (iv) the applicant in the application claiming priority is the proprietor of the prior application referred to in paragraph (a) or (b) or of the application in the convention country referred to in paragraph (c), or the applicant has acquired the right to claim priority in the Republic.

(2) Where, after the lodging of the first application in a convention country in respect of any invention a subsequent application is lodged in that country in respect of the same invention, such subsequent application shall be deemed to be the first application in that country in respect of that invention if, at the time of the lodging thereof —

- (a) the previous application had been withdrawn, abandoned, or refused without having been open to public inspection;
- (b) no priority rights have been claimed on the strength of such previous application; and
- (c) no rights are outstanding in the convention country in question in connection with such previous application.

(3) An application which has been withdrawn, abandoned or refused shall not after the lodging of a subsequent application relating to the same subject-matter, be capable of supporting a claim for priority rights under this section unless any rights are outstanding in the Republic or in any convention country in connection with the first-mentioned application.

(4) Where a person has applied for protection for any invention by an application which —

- (a) in accordance with the terms of a treaty subsisting between any two or more convention countries, is equivalent to an application duly made in any one of those convention countries; or
- (b) in accordance with the law of any convention country is equivalent to an application made in that convention country,

he shall for the purposes of this section be deemed to have applied in a convention country.

(5) If no priority is claimed from an application accompanied by a provisional specification within the period specified in subparagraph (i) of subsection (1), the application shall lapse.

32 Contents of specification

(1) Every specification shall indicate whether it is a provisional or a complete specification, and shall commence with a title sufficiently indicating the subject-matter of the relevant invention.

(2) A provisional specification shall fairly describe the invention.

(3) A complete specification shall —

- (a) have an abstract as prescribed;
- (b) fully describe, ascertain and, where necessary, illustrate or exemplify the invention and the manner in which it is to be performed;
- (c) disclose the best method of performing the invention known to the applicant at the time when the specification is lodged at the patent office; and
- (d) end with a claim or claims defining the invention for which protection is claimed.

(4) The claim or claims of a complete specification shall relate to a single invention, shall be clear, and

shall be fairly based on the matter disclosed in the specification.

(5) Drawings and illustrations, if any, shall be as prescribed.

(6) 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 (date of commencement to be proclaimed).

33 Priority dates

(1) For the purposes of this Act, the priority date of an invention to which an application for a patent relates, and also that of any matter contained in any such application, whether or not such matter is the same as the invention, shall, except as otherwise provided in this Act, be the date of the lodging of the application.

(2) Where priority is claimed in an application in terms of section 31(1) from one or more prior applications, or one or more prior applications in a convention country or countries, or both, and the invention claimed in the application is fairly based on matter disclosed in one or more of the prior applications, the priority date of the invention shall be the date of lodging of the earliest of the prior applications in which that matter was disclosed in so far as it is fairly based on such earliest application.

(3) Any invention claimed in an application may have one or more priority dates.

(4) Until the contrary is proved, the priority date of an invention shall be the earliest priority date claimed in an application.

(5) In determining whether an invention claimed in an application is fairly based on the matter disclosed in a prior application or a prior application in a convention country, regard shall be had to the disclosures contained in all documents lodged at the same time as and in support of that prior application or prior application in a convention country.

(6) The priority date of new matter introduced by way of a supplementary disclosure in terms of section 51(8) shall be the date of lodging of the supplementary disclosure.

34 Examinations of applications and specifications

The registrar shall examine in the prescribed manner every application for a patent and every complete specification accompanying such application or lodged at the patent office in pursuance of such application and if it complies with the requirements of this Act, he shall accept it.

35 Procedure if result of examination of application is adverse to applicant

(1) If the result of an examination in connection with an application for a patent, or in connection with the specification which accompanied that application, is adverse to the applicant, the registrar may refuse to accept the application or require the application or the specification which accompanied it to be amended in such manner as may be necessary.

(2) If in the case of a convention application the prescribed documents do not accompany the application or are not furnished within the prescribed period, the registrar may deal with the application as an ordinary application.

36 Power to refuse applications in particular cases

(1) If in the case of any application it appears to the registrar —

(a) that the application is frivolous on the ground that it claims as an invention anything obviously

contrary to well established natural laws; or
(b) that the use of the invention to which the application relates would be generally expected to encourage offensive or immoral behaviour,
he shall refuse the application.

(2) If it appears to the registrar that any invention in respect of which an application for a patent is made might be used in any manner contrary to law, he may refuse the application unless the specification is amended by the addition of such disclaimer in respect of that invention, or such other reference to the illegality thereof, as the registrar may think fit.

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39 Manner of obtaining and effect of patent of addition

(1) Where a patent for an invention (hereinafter referred to as the main invention) has been applied for or granted, and the applicant or the patentee applies in the prescribed manner for a further patent in respect of any addition to, improvement in or modification of the invention described or claimed in the complete specification of the main invention, he may be granted a patent of addition.

(2) The period for which such patent of addition shall be granted, shall be so much of the period of the patent for the main invention as is unexpired, and no fees shall be payable for the renewal of such patent of addition.

(3) Where an invention consisting of an addition to or improvement in or modification of a main invention is the subject of an independent patent, and the patentee in respect of the independent patent, being also the patentee in respect of the main invention, so requests, the registrar may revoke the independent patent and grant a patent of addition in respect of the addition, improvement or modification, having the same date of application as the independent patent so revoked, and having effect from the date as from which that patent had effect.

(4)(a) Where the patent for the main invention is surrendered, revoked, refused or abandoned, the patent of addition shall, unless the commissioner or the registrar otherwise directs, become an independent patent and the normal term of such independent patent shall not extend beyond the date on which the patent for the main invention would have expired if it had not been surrendered, revoked, refused or abandoned.

(b) The prescribed renewal fees which would have been payable in respect of the patent for the main invention shall, as from the date on which a patent becomes an independent patent in terms of paragraph (a), be payable in respect of the last-mentioned patent.

(5) An application for a patent of addition shall not be accepted before the acceptance of the application for the patent for the main invention: Provided that where no patent is granted for the main invention, the application for a patent of addition may be dealt with as an ordinary application for a patent.

(6) The grant of a patent of addition shall be conclusive evidence that the invention is a proper subject for such a patent, and shall not be refused, nor shall any such patent be liable to be revoked or invalidated, on the ground only that the invention claimed in the complete specification does not involve any inventive step having regard to the main invention.

(7) A patent for a main invention and its patent of addition shall not be capable of assignment apart from one another.

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42 Notice and publication of acceptance of complete specification

(1) When a complete specification has been accepted, the registrar shall give written notice of that fact

to the applicant.

(2) Such notice shall contain —

- (a) the date of acceptance of the specification; and
- (b) a statement that on publication by the applicant in the journal of the acceptance of the specification, the patent concerned shall be deemed to have been sealed and granted as from the date of such publication.

(3) Unless the acceptance is so published in the journal within the prescribed period or within such further period as the registrar may, on application to him and on good cause shown and on payment of the prescribed fee, allow, the application shall lapse.

43 Inspection by public

(1) After the publication contemplated in section 42, or after being open for public inspection in terms of subsection (3) of this section, the patent and the application and all documents lodged in support thereof shall on payment of the prescribed fee be open to public inspection in the patent office.

(2) When an application which claims a priority date in terms of section 31(1) is so open to public inspection, any other application from which it claims a priority date and any documents lodged in support of such an application shall simultaneously be open likewise to public inspection.

(3) If the acceptance of an application which claims priority in terms of section 31(1)(c) is not published in terms of section 42 within 18 months from the earliest priority date claimed from the relevant application in a convention country, it shall be open to public inspection as provided in subsection (1).

- (4)(a) After the expiry of five years following the date of application for a patent, any person may apply to the registrar for the patentee to supply the applicant with the prescribed particulars of any search report issued in another country in respect of an application for a patent relating to the same subject-matter which has been lodged in that country.
- (b) On receipt of the application, the registrar shall forward a copy thereof to the patentee at the patentee's address for service.
- (c) If the patentee fails to comply with the application within three months of receipt of the copy of the application at the patentee's address for service, the applicant may apply to the commissioner for an order requiring compliance with the application.
- (d) Upon an application for compliance, the commissioner may order such compliance and, if the order is not complied with, the commissioner may make the further order that he or she thinks fit.

CHAPTER VA : INTERNATIONAL APPLICATIONS UNDER THE PATENT COOPERATION TREATY

43A Interpretation

In this Chapter, unless the context otherwise indicates, any word or expression defined in the Patent Cooperation Treaty shall have the same meaning as in that Treaty.

43B Effect of international application designating Republic

Subject to this Chapter, an international application designating the Republic shall be deemed to be an application for a patent lodged at the patent office in terms of the Act.

43C Patent office as receiving, designated and elected Office

The patent office shall be —

- (a) the receiving Office in respect of an international application lodged at it by a person who is a resident or national of the Republic;
- (b) the designated Office in respect of an international application designating the Republic;
- (c) the elected Office, if an applicant in an international application designating the Republic elects the Republic for the purposes of an international preliminary examination under Chapter II of the Patent Cooperation Treaty.

43D National processing

The patent office as designated Office or elected Office shall not commence processing of an international application designating or electing the Republic before the expiration of the period referred to in section 43E(1) except where the applicant complies with that section and lodges with the patent office a written request for early commencement of such processing.

43E Commencement of national phase

(1) Before the expiration of the applicable period contemplated in Article 22 or 39 of the Patent Cooperation Treaty or of such further period as may be prescribed by regulation under the Act, the applicant in respect of an international application designating or electing the Republic shall —

- (a) pay the prescribed national fee to the patent office; and
- (b) if the international application has not been lodged or published in terms of the Patent Cooperation Treaty in English, lodge at the patent office a translation of the international application, containing the prescribed contents, in an official language of the Republic.

(2) If the applicant does not comply with subsection (1) within the period referred to in that subsection or the further period that the registrar allows, the international application concerned shall be deemed to have been abandoned for the purposes of this Act.

43F Administration

(1) When processing an international application, the patent office shall, subject to subsection (2) and (3), apply the Patent Cooperation Treaty, the regulations made thereunder and the administrative instructions issued under those regulations, and the other provisions of the Act.

(2) When processing an international application, the Patent Cooperation Treaty, the regulations made thereunder and the administrative instructions issued under those regulations shall prevail in the event of any conflict with the Act.

(3) When processing an international application designating the Republic —

- (a)
 - (i) section 9(b) shall not apply; and
 - (ii) the applicant shall be represented by an agent who shall be appointed within the prescribed time;
- (b) section 10 shall apply only if the applicant complies with section 43E(1) and the applicant who so complies shall, for the purposes of section 10, be deemed to be the applicant in respect of the international application;
- (c) section 16(2) shall apply in relation to time limits specified in terms of the Patent Cooperation Treaty, the regulations made thereunder and the administrative instructions issued under those regulations unless otherwise provided therein;
- (d)
 - (i) section 30(1), (5), (6) and (7) shall not apply; and
 - (ii) the international application shall date from, and the date of application of the international application shall be, the international filing date accorded in terms of the Patent Cooperation Treaty;
- (e)
 - (i) the description, claims, drawings (if any) and abstract referred to in Article 3(2) of the

- Patent Cooperation Treaty shall be deemed to be a complete specification; and
- (f) (ii) section 32(5) shall not apply;
 - if —
 - (i) the international application is a convention application;
 - (ii) the applicant has complied with Rule 17.1 of the regulations made under the Patent Cooperation Treaty; and
 - (iii) the priority document referred to in the said Rule 17.1 is a prescribed document for the purposes of section 35(2),
 the applicant shall be deemed to have furnished a copy of the priority document within the prescribed period referred to in section 35(2);
- (g) section 38 shall not apply;
- (h) for the purposes of section 40, the period of 18 months from the date of the application shall be a period of 12 months from the date on which the applicant complies with section 43E(1);
- (i) section 43(3) shall not apply but, when the applicant has complied with section 43E(1) and the application has been published in terms of Article 21 of the Patent Cooperation Treaty, the application shall be open to public inspection as provided in section 43(1);
- (j) section 43(4) shall not apply;
- (k) any correction or rectification of any document made in terms of the regulations made under the Patent Cooperation Treaty shall be deemed to be a correction or amendment made in terms of section 50;
- (l) (i) if an application for amendment of the international application is made before the acceptance of the international application, the application for amendment shall not be advertised as contemplated in section 51(2);
 - (ii) if —
 - (aa) the applicant has not elected the Republic for the purposes of an international preliminary examination under Chapter II of the Patent Cooperation Treaty before the expiration of 19 months from the priority date as defined in Article 19 of that Treaty; and
 - (bb) the applicant has elected the Republic for the purposes of an international preliminary examination under Chapter II of the Treaty before the expiration of 19 months from the priority date as defined in Article 2(xi) of the Patent Cooperation Treaty and the applicant has complied with section 43E(1), any amendment annexed to the international preliminary examination report, shall be deemed to have been made in terms of section 51 but may be set aside in terms of subsection (10) thereof.

CHAPTER VI : GRANT, DURATION AND EFFECT OF PATENTS

44 Granting and sealing of patent

(1) As soon as practicable after the publication contemplated in section 42, a patent in the form prescribed shall be granted to the applicant, and the registrar shall cause the patent to be sealed with the seal of the patent office, and such sealing shall be deemed to have been effected on the date of that publication.

(2) The date on which that sealing is so deemed to have been effected shall for the purposes of this Act be the date of the sealing of the patent.

(3) The patent shall have effect from the date of the publication mentioned in subsection (1).

(4) No proceedings for the infringement of a patent shall be instituted within a period of nine months from the date of the sealing thereof: Provided that the commissioner may, on good cause shown, grant leave to institute such proceedings at any time after the date of the sealing of the patent.

45 Effect of patent

(1) The effect of a patent shall be to grant to the patentee in the Republic, subject to the provisions of this Act, for the duration of the patent, the right to exclude other persons from making, using, exercising, disposing or offering to dispose of, or importing the invention, so that he or she shall have and enjoy the whole profit and advantage accruing by reason of the invention.

(2) 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.

46 Duration of patent

(1) The duration of a patent shall, unless otherwise provided in this Act, be 20 years from the date of application therefor, subject to the payment of the prescribed renewal fees by the patentee concerned or an agent.

(2) A patent shall lapse at the end of the period prescribed for the payment of any prescribed renewal fee, if it is not paid within that period: Provided that the registrar may upon application and subject to the payment of such additional fee as may be prescribed, extend the period for payment of any such fee for a period not exceeding six months.

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CHAPTER VII : CORRECTIONS AND AMENDMENTS

50 Correction of clerical errors and amendment of documents

(1) The registrar or the commissioner may authorize —

- (a) the correction of any clerical error or error in translation in any patent, application for a patent or document lodged in pursuance of such an application, or in the register;
- (b) the amendment otherwise of any document for the amending of which no express provision is made in this Act.

(2) A correction may be made in pursuance of this section, either upon a request in writing accompanied by the prescribed fee or without such a request.

(3) Where it is proposed to make a correction otherwise than upon such a request, the registrar shall give notice of the proposed correction to the patentee or the applicant for the patent, as the case may be, and to any other person who appears to him to be concerned, and shall give any such person an opportunity of being heard before the correction is made.

(4) Where a request is made for any such correction and it appears to the registrar that the correction would materially alter the scope of the document to which the request relates, the registrar may require notice of the request to be advertised in the journal and to be served upon such persons as he may consider necessary.

(5) If such notice has not been so advertised and served or if it has been so advertised and there is no opposition to such correction, the registrar may decide the matter or refer it to the commissioner, who shall decide it as he may deem fit.

(6) Where such notice has been so advertised and served, any person may oppose the request mentioned in subsection (2) within the prescribed time and in the prescribed manner, and thereupon the matter shall be dealt with by the commissioner as he may deem fit.

51 Amendment of specification

(1) An applicant for a patent or a patentee may at any time apply in the prescribed manner to the registrar for the amendment of either the relevant provisional specification or the relevant complete specification, and shall in making such application, set out the nature of the proposed amendment and furnish his full reasons therefor.

(2) An application for the amendment of a specification that is open to public inspection shall, except in the case of an application so open in terms of section 43(3), be advertised in the prescribed manner.

- (3)(a) Any person may oppose such application for amendment within the prescribed time and in the prescribed manner.
- (b) Such opposition to such application for amendment shall be dealt with by the commissioner in the prescribed manner, and the commissioner shall determine whether and on what conditions, if any, the amendment ought to be allowed.

(4) Where the acceptance of a specification concerned has not been published in terms of section 42 or there is no opposition in terms of subsection (3)(a) of this section, the registrar may determine whether and on which conditions, if any, the amendment ought to be allowed.

(5) An amendment of a provisional specification shall be allowed if it is by way of correction, including correction of an obvious mistake, and no amendment of a provisional specification shall be allowed if it would introduce new matter or matter not in substance disclosed in the specification sought to be amended.

(6) No amendment of a complete specification which becomes open to public inspection after the publication of the acceptance of the specification in terms of section 42, whether before or after it so becomes open to public inspection, shall be allowed if —

- (a) the effect of the amendment would be to introduce new matter or matter not in substance disclosed in the specification before amendment; or
- (b) the specification as amended would include any claim not fairly based on matter disclosed in the specification before amendment.

(7) No amendment of a complete specification which has become open to public inspection after the publication of the acceptance of the specification in terms of section 42 shall be allowed if the specification as amended would include any claim not wholly within the scope of a claim included in the specification before amendment.

(8) Where an amendment may not be allowed by reason of the prohibition imposed by subsection (6)(a), but it describes matter which may fairly be associated with the matter described in the specification as framed and the acceptance of the specification concerned has not been published in terms of section 42, the new matter may be introduced by way of a supplementary disclosure attached to the specification and dated with the date on which the application for amendment is made: Provided that in determining the validity of the patent under this Act, regard shall be had to the priority date of the new matter introduced by way of the supplementary disclosure.

(9) Where any proceedings relating to an application for a patent or a patent are pending in any court, an application for the amendment of the relevant specification shall be made to that court, which may deal with such application for amendment as it thinks fit but subject to the provisions of subsections (5), (6) and (7), or may stay such pending proceedings and remit such application for amendment to the registrar to be dealt with in accordance with subsections (2), (3) and (4).

(10) Any amendment of a specification made in conflict with the provisions of this section, other than an amendment allowed by the commissioner or a court, may be set aside by the commissioner at any time on application made to him.

52 Rectification of register

The registrar may order the register to be rectified by the making, amendment or deletion of any entry therein, and such order may be made either on a request in the prescribed manner or without such request: Provided that where the registrar intends to make an order otherwise than upon a request, he shall give notice of his intention to do so to the patentee or the applicant for the patent, as the case may be, and to any other person who appears to him to be concerned, and shall give such patentee or applicant or other person an opportunity of being heard before making the order.

CHAPTER VIII : LICENCES

53 Licences of right

(1) At any time after the date of the sealing of a patent, the patentee may apply to the registrar for the patent to be endorsed with the words 'licences of right' and where such an application is made the registrar shall, if satisfied that the patentee is not precluded by contract from granting licences under the patent, cause the patent to be endorsed accordingly.

(2) Where a patent has been endorsed under this section —

- (a) any person shall at any time thereafter be entitled as of right to a licence under the patent upon such conditions as may, in default of agreement, be decided by the commissioner on the application of the patentee or the person requiring the licence;
- (b) the commissioner may, on the application of the holder of any licence granted under the patent before the endorsement, order such licence to be replaced by a licence to be granted by virtue of the endorsement on conditions to be decided by the commissioner;
- (c) No interdict shall, in proceedings for infringement of the patent (otherwise than by the importation of goods) be granted against the defendant if he undertakes to take a licence upon conditions to be decided by the commissioner, and the amount, if any, recoverable from the defendant by way of damages shall in such case not exceed double the amount which would have been payable by him as licensee if such a licence had been granted before the earliest infringement;
- (d) the renewal fee payable in respect of the patent after the date of the endorsement shall be one half of the renewal fee which would have been payable if the patent had not been so endorsed.

(3) The licensee under a licence granted by virtue of the endorsement of a patent in terms of this section may (unless in the case of a licence whereof the conditions are decided by agreement, the licence otherwise expressly provides) call upon the patentee to institute proceedings in respect of any infringement of the patent, and if the patentee fails to do so within two months after being so called upon, the licensee may institute proceedings for the infringement in his own name as if he were patentee, joining the patentee as a defendant.

(4) A patentee so joined as a defendant shall not be liable for any costs unless he enters an appearance and takes part in the proceedings.

(5) An application for the endorsement of a patent in terms of this section shall contain a statement, to be verified in such manner as may be prescribed, that the patentee is not precluded by contract from granting licences under the patent, and the registrar may require from the applicant such further evidence as he may think necessary.

(6) An application under this section for the endorsement of a patent of addition shall be dealt with as an application for the endorsement of the patent for the main invention also, and an application made under this section for the endorsement of a patent in respect of which a patent of addition is in force, shall be dealt with as an application for the endorsement of the patent of addition also, and where a patent of addition is granted in respect of a patent already endorsed under this section, the patent of addition shall also be so endorsed.

(7) Every endorsement of a patent in terms of this section shall be recorded in the register and shall be advertised in the journal and in such other manner as the registrar may direct, to bring the endorsement to the notice of interested persons.

...

54 Cancellation of endorsement on patent

(1) At any time after a patent has been endorsed in terms of section 53, the patentee may apply to the registrar for the cancellation of the endorsement.

(2) Where such an application is made and the balance paid of all renewal fees which would have been payable if the patent had not been endorsed, the registrar may, if he is satisfied that there is no existing licence under the patent or that all licensees under the patent consent to the cancellation, cancel the endorsement.

(3) Within the prescribed period after a patent has been endorsed in terms of section 53, any person who claims that the patentee is, and was at the time of the endorsement, precluded by a contract in which the claimant is interested from granting licences under the patent, may apply to the registrar for cancellation of the endorsement.

(4) Where the registrar is satisfied, on an application under subsection (3), that the patentee is and was precluded as aforesaid, he shall cancel the endorsement, and thereupon the patentee shall pay to the registrar, within such period as may be prescribed, a sum equal to the balance of all renewal fees which would have been payable if the patent had not been endorsed and, if that sum is not paid within that period, the patent shall lapse at the expiry of that period.

(5) An application for the cancellation of the endorsement of a patent of addition shall be dealt with as an application for the cancellation of the endorsement of the patent for the main invention also, and an application for the cancellation of the endorsement of a patent in respect of which a patent of addition is in force shall be dealt with as an application for the cancellation of the endorsement of the patent of addition also.

(6) Where the endorsement of a patent is cancelled under this section, the rights and liabilities of the patentee shall thereafter be the same as if the endorsement had not been made.

55 Compulsory licences in respect of dependent patents

Where the working of a patent (hereinafter referred to as a dependent patent) without infringement of a prior patent is dependent upon the obtaining of a licence under that prior patent, the proprietor of the dependent patent may, if agreement cannot be reached as to such licence with the proprietor of the prior patent, apply to the commissioner for a licence under the prior patent, and the commissioner may grant such a licence on such conditions as he may impose, but including a condition that such licence shall be used only for the purpose of permitting the dependent patent to be worked and for no other purpose; Provided that the commissioner shall not grant such a licence unless —

- (a) the invention claimed in the dependent patent involves an important technical advance of considerable economic significance in relation to the invention claimed in the prior patent;
- (b) the proprietor of the dependent patent granted the proprietor of the prior patent on reasonable terms a cross-licence to use the invention claimed in the dependent patent; and
- (c) the use authorized in respect of the prior patent is not assignable except with the assignment of the dependent patent.

56 Compulsory licence in case of abuse of patent rights

(1) Any interested person who can show that the rights in a patent are being abused may apply to the commissioner in the prescribed manner for a compulsory licence under the patent.

- (2) The rights in a patent shall be deemed to be abused if —
- (a) the patented invention is not being worked in the Republic on a commercial scale or to an adequate extent, after the expiry of a period of four years subsequent to the date of the application for the patent or three years subsequent to the date of the application for the patent or three years subsequent to the date on which that patent was sealed, whichever period last expires, and there is in the opinion of the commissioner no satisfactory reason for such non-working;
 - ...
 - (c) the demand for the patented article in the Republic is not being met to an adequate extent and on reasonable terms;
 - (d) by reason of the refusal of the patentee to grant a licence or licences upon reasonable terms, the trade or industry or agriculture of the Republic or the trade of any person or class of persons trading in the Republic, or the establishment of any new trade or industry in the Republic, is being prejudiced, and it is in the public interest that a licence or licences should be granted; or
 - (e) the demand in the Republic for the patented article is being met by importation and the price charged by the patentee, his licensee or agent for the patented article is excessive in relation to the price charged therefor in countries where the patented article is manufactured by or under licence from the patentee or his predecessor or successor in title.
- (3) The patentee or any other person appearing from the register to be interested in the patent may in the prescribed manner oppose the application.
- (4)(a) The commissioner shall consider the application on its merits and may order the grant to the applicant of a licence on such conditions as he or she may deem fit, including a condition precluding the licensee from importing into the Republic any patented articles.
 - (b) If the commissioner is of the opinion that an order directing the grant of a licence is not justified, he may refuse the application.
 - (c) A licence granted under this section shall include a provision that, subject to adequate protection of the legitimate interests of the licensee, the licence shall, on application by the patentee, be terminated if the circumstances which led to its grant cease to exist and, in the opinion of the commissioner, are unlikely to recur.
- (5) Any licence granted under this section shall be non-exclusive and shall not be transferable except to a person to whom the business or the part of the business in connection with which the rights under the licence were exercised has been transferred.
- ...
- (7) In determining the conditions on which any licence is granted the commissioner shall have regard to any relevant facts, including the risks to be undertaken by the licensee, the research and development undertaken by the patentee and the terms and conditions usually stipulated in licence agreements in respect of the subject-matter of the invention, between persons who voluntarily enter into such agreements.
- (7A) The commissioner may order that a licence granted in terms of this section shall be deemed to have been granted on the date on which the application has been received by the registrar.
- (8) Any order of the commissioner under this section shall be made with a view to avoiding the abuse found by the commissioner to have been established.
- (9) The commissioner may amend or revoke any licence granted under this section.
- (10) Subject to the conditions that may be attached to the licence, a licensee under this section shall have the same rights and obligations as any other licensee under a patent.
- ...
- (13)(a) The commissioner may, when ordering the grant of a licence under subsection (4)(a), award

costs against the applicant or patentee concerned or any person opposing the relevant application.

- (b) In so awarding costs, the commissioner shall inter alia have regard to —
- (i) the nature and extent of the abuse found by him to have been established; and
 - (ii) whether the application for a licence under this section might have been avoided by the grant, by the patentee concerned to the applicant, of a voluntary licence on reasonable terms.

(14) For the purposes of this section the expression 'patented article' includes any composition of matter or any product of a patented process or method or any product produced by a patented machine.

57 Termination of contracts relating to licences

(1) Any contract, in so far as it relates to a licence under a patent to make, use, exercise or dispose of a patented invention, shall terminate on the date on which the patent, under which the licence was granted, expires, is revoked or otherwise ceases to protect such invention: Provided that where the contract as relates to any particular licence shall terminate when the patent under which it was granted expires, is revoked or otherwise ceases to protect the invention concerned, and that the contract as a whole shall terminate when all the patents under which all such licences were granted and which were in force at the time when the contract became operative, expire, are revoked or otherwise cease to protect the relevant inventions.

(2) Nothing in this section shall affect any right to terminate a contract or a condition in a contract independently of this section.

58 Effect of licence

In default of an agreement to the contrary —

- (a) a licence to make a patented article shall carry with it the right to use or dispose of the patented article; and
- (b) a licence to use or exercise a patented process shall carry with it the right to make, use or dispose of the product of the process.

CHAPTER IX : ASSIGNMENT, ATTACHMENT AND HYPOTHECATION OF PATENTS AND APPLICATIONS FOR PATENTS

59 Assignment and devolution of patents by operation of law

(1) Subject to the provisions of section 39(7), the rights vested in a patentee or an applicant for a patent shall be capable of assignment and of devolution by operation of law.

(2) Any condition in a contract of employment which —

- (a) requires an employee to assign to his employer an invention made by him otherwise than within the course and scope of his employment; or
- (b) restricts the right of an employee in an invention made by him more than one year after the termination of the contract of employment,

shall be null and void.

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CHAPTER X : REVOCATION OF PATENTS

61 Grounds for application for revocation of patent

(1) Any person may at any time apply in the prescribed manner for the revocation of a patent on any of the following grounds only, namely —

- (a) that the patentee is not a person entitled under section 27 to apply for the patent;
- (b) 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;
- (c) that the invention concerned is not patentable under section 25;
- (d) 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;
- (e) that the complete specification concerned does not —
 - (i) fully describe, ascertain and, where necessary, illustrate or exemplify the invention and the manner in which it is to be performed; or
 - (ii) disclose, in the specification as accepted, 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;
- (f) that the claims of the complete specification concerned are not —
 - (i) clear; or
 - (ii) fairly based on the matter disclosed in the specification;
- (g) that the prescribed declaration lodged in respect of the application for the patent contains a false statement or representation which is material and which the patentee knew to be false at the time when the declaration was made;
- (h) that the application for the patent should have been refused in terms of section 36;
- (i) that the complete specification claims as an invention a microbiological process or a product thereof and that the provisions of section 32(6) have not been complied with.

(2) An application for revocation shall be served on the patentee and lodged with the registrar in the prescribed manner and shall thereafter be dealt with in the manner prescribed.

(3) The commissioner shall decide whether the patent shall be revoked or whether and, if so, subject to what amendments, if any, of the specification or claims thereof, the patent shall be upheld: Provided that the commissioner shall not allow any amendment which is in conflict with the provisions of section 51(6) or (7): Provided further that the commissioner may in the exercise of his discretion as to costs take into consideration the conduct of the patentee in framing his specification and claims and permitting them to remain as so framed.

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CHAPTER XI : INFRINGEMENT

65 Proceedings for infringement

(1) Subject to the provisions of section 53(3), proceedings for infringement of a patent may be instituted by the patentee or an exclusive licensee mentioned in section 56(11).

(2) Proceedings for infringement shall be instituted and prosecuted in the manner prescribed.

(3) A plaintiff in proceedings for infringement shall be entitled to relief by way of —

- (a) an interdict;
- (b) delivery up of any infringing product or any article or product of which the infringing product forms an inseparable part; and
- (c) damages.

(4) In any proceedings for infringement the defendant may counterclaim for the revocation of the patent and, by way of defence, rely upon any ground on which a patent may be revoked.

(5) The plaintiff in any such proceedings shall, before he institutes the proceedings, give notice thereof to every licensee under the patent in question whose name is recorded in the register, and any such licensee shall be entitled to intervene as a co-plaintiff.

(6) In lieu of damages the plaintiff may, at his or her option, be awarded an amount calculated on the basis of a reasonable royalty which would have been payable by a licensee or sub-licensee in respect of the patent concerned.

66 Restriction on recovery of damages for infringement

(1) A patentee shall not be entitled to recover damages in respect of infringement of a patent from a defendant who proves that at the date of the infringement he was not aware, and had no reasonable means of making himself aware, of the existence of the patent, and the marking of an article with the word 'patent' or 'patented' or any word or words expressing or implying that a patent has been obtained for the article, stamped, engraved, impressed on or otherwise applied to the article, shall not be deemed to constitute notice of the existence of the patent unless such word or words are accompanied by the number of the patent: Provided that nothing in this section shall affect any proceedings for an interdict.

(2) Any person who represents that any invention is patented, without such representation disclosing the number of the patent concerned, and from whom the number of such patent has been requested in writing by registered post by any other person unaware of such number, may not recover from such other person damages, or obtain an interdict against him, in respect of any infringement of such patent by such other person, committed during the period commencing with the representation and terminating two months after the date on which such other person was notified in writing by the first-mentioned person of the number of the patent concerned.

(3) Any person who, having made a request referred to in subsection (2), expends during the period referred to in that subsection, any money, time or labour with a view to making, using, exercising or disposing of the invention, may apply in the manner prescribed to the commissioner for compensation in respect of the money, time or labour reasonably so expended, and the commissioner may issue such order as he may deem fit.

(4) If proceedings are instituted in respect of infringement of a patent, committed after the failure to pay any prescribed renewal fee within the prescribed period, and before any extension of the period for such payment, the commissioner may, if he thinks fit, refuse to award any damages in respect of the infringement.

(5) Where an amendment of a specification has been allowed under section 51, the commissioner may in his discretion refuse to award damages in respect of any acts of infringement committed before that amendment was so allowed and, in exercising his discretion, the commissioner may take into consideration the conduct of the patentee in framing the specification and permitting it to remain in its unamended form.

67 Presumptions in relation to new substances

(1) A claim in respect of a patent for a process or an apparatus for producing any product shall be construed as extending to such product when produced by the process or apparatus claimed.

(2) If the invention for which a patent is granted is a process for obtaining a new product, the same product produced by a person other than the proprietor of the patent or a licensee under that patent shall, unless the contrary is proved, be deemed, in any proceedings, to have been obtained by that process.

(3) In considering whether any person has discharged the onus imposed upon him by subsection (2), the commissioner shall not require him to disclose any secret process used by him in producing the product concerned, if it appears to the commissioner that it would be unreasonable to do so.

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69 Declaration as to non-infringement

(1) A declaration that the use by any person of any process, or the making or use or sale by any person of any article, does not or would not constitute an infringement of a patent, may be made by the commissioner in proceedings between that person and the patentee or an exclusive licensee mentioned in section 56(11), notwithstanding that no assertion to the contrary has been made by the patentee or licensee, if it is proved —

- (a) that such person has applied in writing to the patentee or licensee for a written acknowledgement to the effect of the declaration claimed, and has furnished him with full particulars of the process or article in question; and
- (b) that the patentee or licensee has failed to give such an acknowledgement.

(2) The costs of all parties to proceedings for a declaration instituted by virtue of this section shall be awarded in such manner as the commissioner may deem fit.

70 Remedy for groundless threats of infringement proceedings

(1) Where any person, by circular, advertisement or otherwise, threatens any other person with proceedings for infringement of a patent, a person aggrieved thereby may, whether the person making the threats is or is not entitled to or interested in a patent, or an application for a patent, institute proceedings against him and obtain a declaration to the effect that such threats are unjustifiable and an interdict against the continuance of such threats, and may recover such damages, if any, as he has sustained thereby, unless the person making the threats proves that the acts in respect of which the proceedings are threatened, constitute or, if done, would constitute an infringement of a patent in respect of a claim in the specification which is not shown by the plaintiff to be invalid: Provided that a circular, advertisement or communication addressed to any person, which comprises only a notification of the existence of a particular patent upon which the proprietor relies for protecting his interests shall not, by itself, be deemed to be a threat of proceedings for infringement.

(2) The defendant in any such proceedings may apply by way of a counterclaim in the proceedings for any relief to which he would be entitled in separate proceedings in respect of any infringement by the plaintiff of the patent to which the threat relates.

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CHAPTER XVI : MISCELLANEOUS

...

90 Certain conditions excluded from contracts

(1) Any condition in a contract relating to the sale of a patented article or to a licence under a patent of which the effect will be —

- (a) to prohibit or restrict the purchaser or licensee from purchasing or using any article or class of articles, whether patented or not, supplied or owned by any person other than the seller or licensor or his nominee;
- (b) to prohibit or restrict the licensee from using any article or process not protected by the patent;
- (c) to require the purchaser or licensee to acquire from the seller, licensor or his nominee any article or class of articles not protected by the patent;
- (d) to require or induce the purchaser to observe a specified minimum resale price in respect of any article or class of articles protected by the patent; or
- (e) to prohibit or restrict the making, using, exercising or disposing of the invention concerned in any country in which the invention is not patented,

shall be null and void.

(2) Nothing in this section shall —

- (a) affect any condition in a contract whereby a person is prohibited from selling any goods other than those of a particular person; or
- (b) affect any condition in a contract for the lease of or a licence to use a patented article, whereby the lessor or licensor reserves to himself or his nominee the right to supply such new parts of the patented article, other than ordinary articles of commerce, as may be required to put or keep it in repair.

...

96 Short title and commencement

This Act shall be called the Patents Act, 1978, and shall come into operation on 1 January 1979, except section 21, which shall come into operation on promulgation of this Act, and except section 32 (6), which shall come into operation on a date fixed by the State President by proclamation in the Gazette.