

What is a patent?

Stripped of legal speak, a patent is a 20 year monopoly granted to an inventor by the State.

What is patentable?

You must have originated something that is:

- New;
- Inventive; and
- Useful

If your invention meets these three requirements, generally it will be considered patentable, subject to certain exceptions discussed below.

How do I know if my invention is “new”?

An indication of the novelty of your invention may be obtained by conducting patent and literature searches. This will show whether anyone has brought an invention identical to yours into the public domain. South Africa has a so-called absolute novelty requirement – this means that even the inventor may unwittingly have destroyed the novelty of his/her own invention by disclosing it prior to obtaining patent protection. However, reasonable technical trials may sometimes be excused.

What is considered “inventive”?

Even if your invention is new (i.e. there is nothing identical to it in the public domain), then there may still be other products that are similar to your invention (also known as the “prior art”). To determine whether your invention may be considered inventive, one has to ask whether someone skilled in the field of the invention would have considered your invention to have been obvious. This is usually a very subjective assessment and the decision to patent is sometimes dictated more by business strategy than by obviousness considerations.

Utility – must my invention have a use?

Yes - this is generally the easiest patenting hurdle to overcome, as a use can be found in trade, industry or agriculture for most inventions that are considered new and inventive.

I have created something new, inventive and useful – what next?

Speak to us about preparing and filing a patent application for your invention. However, you must keep your invention secret until you have filed a patent application to avoid destroying the novelty thereof. Remember that the patentability of your invention is no guarantee of commercial success.

What is NOT patentable?

Traditionally, software and business methods have not been considered to be patentable under South African law. However, due to increasing numbers of patents being granted for software and business method inventions in the USA and Europe, we trust that South African courts will soon rule favourably on this matter. In addition, games, mathematical methods, discoveries, artistic, musical or dramatic works, methods of performing mental acts and the presentation of information are not considered patentable under SA law. Similarly, inventions that will encourage offensive or immoral behaviour are also excluded from patentability, together with frivolous inventions like perpetual motion machines. In the medical and biological sciences, methods of treatment, therapy or diagnosis performed on humans or animals are not considered patentable, nor are products of biological processes which are not essentially microbiological in nature. For further information in this regard, please refer to our Life Sciences brochure.

Can I obtain patent protection for something I saw at a show or in a foreign country?

No. Except for the fact that you cannot claim someone else's invention as your own, the invention will no longer be considered "new" under SA law. Only the actual inventor and/or any person to whom he/she has assigned the patent may apply for patent protection. It may, however, still be possible for you to exploit the invention in SA, provided it has not been patented in this country. Speak to your patent attorney regarding the conducting of infringement and state of the art searches. Alternatively, may apply to the patentee for a license to exploit the invention in protected areas.

How do I obtain a patent?

Patenting is essentially a two step process, with the two steps being spaced 12 months apart. The first step is to file a provisional patent application for your invention. This is done so that you may have the earliest possible date from which to claim rights to your intellectual creation – similar to an option to protect your invention. The second step is to file a complete patent application within 12 months of filing the provisional application. This application will claim a first (or "priority") date from your provisional application. In other words, the rights you are protecting date back to the filing date of your provisional application – you do not lose any rights in the interim 12 month period.

Why this two step approach?

Complete applications are more expensive to file than provisional applications and it is not possible to add additional matter to a complete application once it has been filed. The reason for this two-step approach is therefore to give you time to (cost-effectively) see whether there is a market for your invention without losing any rights, as well as to give you time to hone your invention into its "perfected" form. Thus, the filing of a provisional patent application is a sensible, cost-effective way of testing the waters. Furthermore, it must be borne in mind that any modifications that you

make to the invention as contained in the provisional specification must be kept secret until such modifications have been captured in a second provisional patent application or are included in the eventual complete patent application. As you develop your invention, your patent portfolio must keep abreast as well.

Must I file a complete patent application?

It is important to note that a provisional patent application does not provide you with an enforceable right - it is merely a device which allows you to test the market without destroying the novelty of your invention. You only have an enforceable right once you have filed a complete patent application for the final form of your invention and it has been granted by the Patent Office. However, should your competitors start copying your invention while your application is still pending, it is possible to expedite the granting of your patent at the Patent Office. Annual maintenance fees must then be paid to keep the patent in force, failing which the patent lapses and you lose your rights to the invention.

What does "Patent Pending" on articles refer to?

This refers to a patent application that has not yet proceeded to grant. However, once application has been made for patent protection, all such articles made must reflect the patent application and the eventual granted patent number(s) thereupon.

Can I file my own provisional patent application?

This is not advisable - a patent specification should preferably be drawn up by a qualified patent attorney. The drafting of a patent specification is a skill and must be done in such a way that competitors cannot merely substitute a trifling part of your invention and circumvent your patent protection. While it should provide you with patent protection which is as broad as possible, it should not be composed in such a way as to read on to prior inventions in the field of your invention. As such, it is a delicate balancing act that is best left to patent attorneys who have received training in the drafting of patent specifications. Furthermore, by drafting your patent specification yourself you run the risk of not fully describing your invention, an often fatal omission. In addition, under South African patent law, only registered patent attorneys are allowed to file complete patent applications.

What does provisional patent protection cost?

For inventions of low to medium technical complexity, typical costs for filing a provisional patent application will be in the range of R8000 to R12000, depending on the complexity of the invention. The more complex the invention (such as biotechnological and software/IT inventions), the more it costs to protect. However, after consulting with you, we will provide you with a cost estimate for compiling and filing the patent specification. We will only proceed once we have received your express instructions to do so and will take no further actions in this regard should you not wish to proceed. South African complete patent applications are slightly more expensive than provisional patent applications, but by then you have a much clearer idea of whether there is a market for your invention and whether you wish to file a complete patent application.

Where do I go for international patent protection?

It is important to note that patents are territorial rights – one cannot enforce a granted South African patent in countries other than South Africa. There is no such thing as a worldwide patent, which means that you must file patent applications in each country in which you wish to exploit your invention. Through our network of foreign patent agents, we can provide you with a one-stop foreign patent portfolio that covers your countries of interest. Please consult our brochure on international patent protection for more information. As Taiwan and a few other countries are not members of certain international treaties, we would ask you please to let us know at the time of filing your South African PROVISIONAL application whether you intend exploiting your invention in these countries. A list of such countries is available on request.

I've heard that patents are time-critical – what does this mean?

You only have 12 months time available in which to file a complete patent application based on your provisional application. However, it is important that you contact us within 9 months or so of filing your provisional application in order to give us sufficient time to draft and prepare a complete patent application for your invention, should you wish to proceed. Failure to file applications within the specified times may result in your patent rights being forfeited.

Can any of the deadlines be extended?

A three month extension period beyond the 12 month deadline is available in South Africa only for filing a complete application. This is not available in other countries. One may claim priority for a foreign application from a South African provisional application, but one is only allowed 12 months to do so from the date of filing the provisional application. Why should I file a patent at all? Someone else independently may come up with your idea and capture your intended market. However, if you have filed an earlier patent application which proceeds to grant, you may prohibit your competitors from doing so. Even if a competitor starts manufacturing an invention similar to yours between the dates of filing the provisional and complete application, you will still be able to stop them. You do not lose any rights in the 12 month period, provided you claim priority from your earlier (provisional) application when filing a complete application. In addition, patents serve as strategic business tools and may be sold or licensed for a royalty income.

What do I need to give my patent attorney?

A full, detailed description of the invention. If you have a model or drawings of your invention, this would also suffice, together with a description of the functions it performs and the advantages of your invention. It is of critical importance that we include as much detail in the application as possible, to ensure that all embodiments and features of the invention are protected. As you are the expert when it comes to your invention, we will draft the patent specification, forward it to you for approval and comment, and only file it once we have received such approval.

Will my invention be safe?

As with other attorneys, patent attorneys are bound by attorney-client privilege and are not allowed to disclose or exploit your invention. However, when discussing your invention with any person other than a patent attorney, always insist on having such other person sign a non-disclosure agreement. We can provide you with such an agreement

should this be required. In addition, following submission of your patent application at the South African Patent Office (SAPO), it is kept secret at the SAPO, which ensures that third parties will not have insight into your invention until it has become open to public inspection upon grant. Even if you decide not to proceed with your patent application, your invention will remain secret and will not become open to public inspection.

Whom may I contact regarding patent protection?

We have experience in filing patent applications relating to most fields of technology. Please feel free to contact us to discuss the protection of your inventions - our contact details are reflected at the end of this brochure. Please note that this brochure is of an explanatory nature only and does not constitute legal advice. Always consult a registered patent attorney if you have any queries relating to your specific invention, or are about to take any action that may impact your patent rights.

Contact

Please do not hesitate to contact any member of the Smit & Van Wyk team – we pride ourselves on being available to clients whenever and wherever we are needed.

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Impressum

Smit & Van Wyk Patent, Trademark & Copyright Attorneys

Legal Information

Smit & Van Wyk, Inc. are registered attorneys of the High Court of South Africa in terms of the Attorneys Act No. 53 of 1979, registered patent attorneys in terms of Section 20 of the Patents Act 57 of 1978, and trademark attorneys.

They are members of the South African Institute of Intellectual Property Law and subject to the relevant professional codes of the Law Society of the Northern Provinces (available at www.northernlaw.co.za) and the Code of Ethics of the Council of the Institute under Article 32 of the Constitution of the South African Institute of Intellectual Property Law (available at www.saiipl.org.za).

The company is incorporated in terms of Section 64 of the Companies Act of 1973.

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