Lexology Getting The Deal Through is delighted to publish the seventeenth edition of Patents, which is available in print and online at www.lexology.com/gtdt.

Lexology Getting The Deal Through provides international expert analysis in key areas of law, practice and regulation for corporate counsel, cross-border legal practitioners, and company directors and officers.

Throughout this edition, and following the unique Lexology Getting The Deal Through format, the same key questions are answered by leading practitioners in each of the jurisdictions featured. Our coverage this year includes new chapters on Eurasia, Honduras, Kazakhstan, Ukraine, United States and Uzbekistan.

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Every effort has been made to cover all matters of concern to readers. However, specific legal advice should always be sought from experienced local advisers.

Lexology Getting The Deal Through gratefully acknowledges the efforts of all the contributors to this volume, who were chosen for their recognised expertise. We also extend special thanks to the contributing editor, Louis E Fogel of Jenner & Block, for his continued assistance with this volume.
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South Africa

Marco Vatta and Herman van Schalkwyk
Spoor & Fisher

PATENT ENFORCEMENT PROCEEDINGS

Lawsuits and courts

1 | What legal or administrative proceedings are available for enforcing patent rights against an infringer? Are there specialised courts in which a patent infringement lawsuit can or must be brought?

South African patent law is governed by the Patents Act 57 of 1978 (the Patents Act). The Patents Act makes provision for infringement proceedings, which are held before the Court of the Commissioner of Patents, a specialist court of the Gauteng Division of the High Court of South Africa, Pretoria. No provision is made for any other form of legal or administrative proceedings for enforcing patent rights, and only the Court of the Commissioner of Patents has jurisdiction as court of first instance to hear patent enforcement matters.

Trial format and timing

2 | What is the format of a patent infringement trial?

Patent enforcement proceedings may be brought in two ways, by motion proceedings and action proceedings. In motion proceedings, the evidence is contained in affidavits and, in the ordinary course of proceedings, no oral evidence is heard. The matter may, however, be referred to oral evidence where there is a dispute of fact.

The common approach for patent enforcement is by way of action proceedings, owing to the high likelihood of a dispute of fact. Evidence is given by expert and factual witnesses, in the form of oral evidence, and further evidence may also be by way of affidavit. Witnesses are examined, cross-examined and re-examined. The length of a trial depends on the complexity of the matter and may range from one or two days to five or six days, or even longer.

Judgment in both motion and action proceedings is made by the Commissioner of Patents (a High Court judge appointed to the Court of the Commissioner of Patents).

Proof requirements

3 | What are the burdens of proof for establishing infringement, invalidity and unenforceability of a patent?

The patentee bears the onus of proving infringement on a balance of probabilities. Any person who challenges the validity of the patent bears the onus of proving invalidity on a balance of probabilities.

Standing to sue

4 | Who may sue for patent infringement? Under what conditions can an accused infringer bring a lawsuit to obtain a judicial ruling or declaration on the accusation?

Only a patentee may sue for patent infringement. However, a licensee under a licence of right may also institute infringement proceedings, subject to certain conditions. A patentee must give notice to every licensee under the patent before instituting infringement proceedings, and any licensee is entitled to intervene as co-plaintiff.

In the event of joint ownership of a patent, then any joint patentee may institute proceedings for infringement and shall give notice thereof to every other joint patentee, and any such other patentee may intervene as co-plaintiff.

The accused infringer can file a claim in reconvention for revocation of the patent. This claim is heard at the same time as the claim of infringement.

Inducement, and contributory and multiple party infringement

5 | To what extent can someone be liable for inducing or contributing to patent infringement? Can multiple parties be jointly liable for infringement if each practises only some of the elements of a patent claim, but together they practise all the elements?

Contributory infringement is recognised in South African common law as a delict, and more specifically as unlawful competition. Therefore, anyone who procures, induces, aids or abets another to infringe a patent will be liable under delict for unlawful competition. For contributory infringement to be established, there must be an actual act of infringement. The courts have not decided the issue of joint liability of multiple parties who each practise some of the elements or steps of a claim, and together practise all of the elements or steps of the claim. However, where the multiple parties have a common design to infringe the patent, they should be held to be liable under delict for unlawful competition.

Joinder of multiple defendants

6 | Can multiple parties be joined as defendants in the same lawsuit? If so, what are the requirements? Must all of the defendants be accused of infringing all of the same patents?

Multiple parties may be joined as defendants in infringement proceedings in respect of the patent or patents in question, provided substantially the same question of law or fact will arise.
Infringement by foreign activities
7 To what extent can activities that take place outside the jurisdiction support a charge of patent infringement?

The Patents Act provides that a patent claim for a process or an apparatus for producing any product shall be construed as extending to such product when produced by the process or the apparatus claimed. Thus, if the product is sold in South Africa it will infringe the patent even though the product was produced outside South Africa, provided the process or the apparatus infringe the patent.

Infringement by equivalents
8 To what extent can ‘equivalents’ of the claimed subject matter be shown to infringe?

The doctrine of equivalents is not part of South African law. A purposive construction of claims is applied in order to determine what are, and what are not, the essential integers of the claim. When interpreting the scope of the claim, the court will consider which of the integers are essential to the invention and which are inessential, and will then disregard the inessential integers in determining whether or not there is infringement.

Discovery of evidence
9 What mechanisms are available for obtaining evidence from an opponent, from third parties or from outside the country for proving infringement, damages or invalidity?

Discovery may be requested under the Uniform Rules of Court of all relevant documents in respect of the matter in dispute. Confidential documents must be discovered but privileged documents need not be. If a party fails to make discovery, it may be compelled by the court after a successful application to the court by another party to do so.

In addition, inspection of a product may be called for to determine, for example, if it infringes a patent. The person who inspects the product is required to compile a report on the inspection. It is also possible to subpoena persons to give evidence and to bring relevant documents with them to court.

Litigation timetable
10 What is the typical timetable for a patent infringement lawsuit in the trial and appellate courts?

An infringement action is commenced by issuing a combined summons. Within 10 court days of the date of service of the combined summons on the defendant, the defendant must give notice of intention to defend the matter to the plaintiff. Within 20 court days of the delivery of the defendant’s notice of intention to defend, the defendant must deliver a plea setting out the defences and any counterclaim. Within 15 court days of the delivery of the defendant’s plea and counterclaim, the plaintiff must deliver a replication to that plea and a plea to the counterclaim. Within 10 court days of the delivery of the plea to the counterclaim, the defendant must file a replication in reconvention, if necessary. After the close of pleadings, a trial date can be applied for and preparation for trial is commenced, including the discovery of relevant documents. The period from issuing the combined summons to the hearing of the trial is typically between one and two years.

Appeal proceedings may take another one to one and a half years.

Litigation costs
11 What is the typical range of costs of a patent infringement lawsuit before trial, during trial and for an appeal? Are contingency fees permitted?

The costs of any proceedings will be dependent upon such factors as the volume of evidence, the complexity of the matter and the length of the hearing before the Commissioner of Patents. Further, the seniority of counsel employed affects the quantum of costs, and this may play a part in the decision as to whether both senior and junior counsel are engaged.

The cost of a trial can be between US$200,000 and US$500,000. An appeal can cost between US$100,000 and US$200,000. The losing party is generally ordered to pay the taxed costs, which can be between one-third and one-half of the costs actually incurred by the winning party.

Contingency fees are permitted in South Africa but are not commonly used in patent litigation.

Court appeals
12 What avenues of appeal are available following an adverse decision in a patent infringement lawsuit? Is new evidence allowed at the appellate stage?

The Patents Act makes provision for appeal against any order or decision of the Commissioner of Patents. An application for leave to appeal must be made, as there are no appeals as of right. If granted, the matter is usually heard before the Supreme Court of Appeal. However, leave to appeal to the full bench of the High Court may also be granted. It is also possible to subsequently appeal to the Constitutional Court.

New evidence is very rarely allowed in an appeal.

Competition considerations
13 To what extent can enforcement of a patent expose the patent owner to liability for a competition violation, unfair competition, or a business-related tort?

Enforcement of a valid patent does not expose a patent owner to liability for a competition violation, unfair competition or a business-related tort.

Alternative dispute resolution
14 To what extent are alternative dispute resolution techniques available to resolve patent disputes?

It is possible for parties to make use of alternative dispute resolution in patent disputes. In such cases, an arbitration agreement, for example, will need to include clauses that allow the parties to give effect to an arbitrator’s findings. For example, the arbitration agreement could include clauses to the effect that, if the arbitrator finds that the patent is invalid and there is no appeal, or if the patent is found to be invalid on appeal, then the patentee is required to surrender the patent.

SCOPE AND OWNERSHIP OF PATENTS

Types of protectable inventions
15 Can a patent be obtained to cover any type of invention, including software, business methods and medical procedures?

A patent may be granted for any new invention that involves an inventive step and is capable of being used or applied in trade, industry or agriculture. However, certain subject matter is explicitly excluded from being considered being inventions. These are:

- discoveries;
- scientific theories;
mathematical methods;
• literary, dramatic, musical or artistic works, or any other aesthetic creation;
• schemes, rules or methods for performing a mental act, playing a game or doing business;
• computer programs; and
• the presentation of information.

However, these exclusions apply only to the extent to which the invention relates to the subject matter as such. At present, there is no case law in South Africa interpreting the meaning of these sections. For computer software and business methods, there is a general view that South African courts may follow a European-type approach requiring a ‘technical effect’, as laid down by the Boards of Appeal of the European Patent Office.

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, is deemed not to be capable of being used or applied in trade, industry or agriculture, and therefore not patentable. Second medical uses of known substances are, however, patentable if claimed by way of Swiss-type claims. The law also provides that, in the case of an invention consisting of a substance or composition for use in such methods of treatment, the fact that the substance or composition is not new shall not prevent a patent being granted for the invention, if the use of the substance or composition in any such method is new.

A patent shall also not be granted for any variety of animal or plant or any essentially biological process for the production of animals or plants, but a microbiological process or the product of such a process is patentable.

Finally, a patent shall also not be granted for subject matter that is obviously contrary to natural laws, or subject matter that encourages offensive or immoral behaviour.

Patent ownership

16 Who owns the patent on an invention made by a company employee, an independent contractor, multiple inventors or a joint venture? How is patent ownership officially recorded and transferred?

An application for a patent in respect of an invention may be made by the inventor or by any other person acquiring from the inventor the right to apply, or by both the inventor and such other person. If the applicant for a patent is not the inventor, then the applicant is required to prove its entitlement to apply for or be granted a patent. Proof of transfer may be in the form of a deed of assignment, an employment contract, a contract to do something or by operation of law.

An invention made by an employee that falls within the course and scope of the employee’s employment with an employer is owned by the employer. The Patents Act provides that any condition in an employee’s contract of employment that requires the assignment of an invention made by the employee outside of the employee’s course and scope of employment, or that restricts the employee’s right in an invention made more than one year after the termination of such a contract, will be null and void and is therefore not enforceable.

An invention made by an independent contractor requires an explicit written assignment of right to the party instructing the contractor in order for any right to the invention to be transferred. Without a written assignment, the invention made by the independent contractor is owned by the contractor.

In the absence of an agreement to the contrary, joint inventors may jointly apply for a patent, and will have equal undivided shares in the application. The rights in the application will be encumbered in that the individual co-applicants will not be allowed, without the consent of the other joint applicant or applicants, to deal in any way with the application except where proceedings are required to keep the application from being abandoned.

An assignment of a patent or patent application must be in writing, but no other formalities are prescribed or required. An assignment of rights can be recorded in the patent register, but there is no requirement for the assignment to be recorded in order to have effect between the parties. However, where such an assignment is not recorded, the assignment will only be valid between the parties thereto. An application to record an assignment must be lodged with the South African Patent Office within six months of the event entitling the recordal.

DEFENCES

Patent invalidity

17 How and on what grounds can the validity of a patent be challenged? Is there a special court or administrative tribunal in which to do this?

The Patents Act provides that any person may at any time apply for the revocation of a patent on a closed list of grounds. The most prominent of these grounds are that the invention is not new or that it is obvious. Other grounds include that the person who applied for the patent was not entitled to do so, that the invention cannot be performed or does not lead to the results and advantages as set out in the specification, that the disclosure in the patent is insufficient to enable the invention to be carried out by a person skilled in the field of the invention, or that the claims of the specification are not clear or are not fairly based on the disclosure in the specification. Invalidity may also be raised as a defence in infringement proceedings and a challenge on the validity of a patent is therefore not limited to revocation proceedings.

Revocation proceedings are heard before the Court of the Commissioner of Patents.

Absolute novelty requirement

18 Is there an ‘absolute novelty’ requirement for patentability, and if so, are there any exceptions?

In terms of South African patent law, there is an absolute novelty requirement for patentability. The Patents Act provides for two circumstances under which prior knowledge or publication of an invention may be excused.

The first of these exceptions is where a disclosure of an invention was made without the knowledge or consent of a patentee, subject to the conditions that the knowledge acquired or matter disclosed was obtained from the patentee, and upon learning of the disclosure the patentee applied for and obtained protection for the invention with all reasonable diligence.

The second exception is where an invention was disclosed to the public as a result of the invention being worked in South Africa by way of reasonable technical trial or experiment by the patentee.

Obviousness or inventiveness test

19 What is the legal standard for determining whether a patent is ‘obvious’ or ‘inventive’ in view of the prior art?

The Patents Act defines an inventive step to be one that is not obvious to a person skilled in the art, having regard to any prior art. The courts have interpreted this provision in a number of cases, and it has been held that the standard for obviousness is that it must be more than just obvious to try, but that it must be obvious to try with an expectation of success. The test involves comparing what is said to be the inventive step in the invention with the prior art to determine in what respect the step goes
Monetary remedies for infringement

22 What monetary remedies are available against a patent infringer? When do damages start to accrue? Do damage awards tend to be nominal, provide fair compensation or be punitive in nature? How are royalties calculated?

Damages awards are compensatory in nature, and punitive damages are not part of South African law. Damages are calculated by determining the extent of infringement, what proportion of the infringing products the patentee could have sold but for the infringement and what profit the patentee could have made on selling that proportion.

An award of an amount calculated on the basis of a reasonable royalty that would have been paid by a licensee or sub-licensee in respect of the patent is available to the patentee, at his or her option, instead of damages.

Damages are calculated from the date on which the infringer was aware or had reasonable means of making him or herself aware of the existence of the patent. However, damages may not be claimed for any act of infringement performed more than three years prior to instituting legal proceedings.

Injunctions against infringement

23 To what extent is it possible to obtain a temporary injunction or a final injunction against future infringement? Is an injunction effective against the infringer’s suppliers or customers?

Temporary injunctions are usually granted pending the outcome of a final infringement action. To obtain a temporary injunction, there must be prima facie evidence that the patent is valid and is infringed, the balance of convenience is in favour of the injunction being granted, there is a well-grounded apprehension of irreparable harm and there is an absence of any other satisfactory remedy. Further, a degree of urgency must usually be shown in order to obtain a temporary injunction. If an act of infringement has not yet been committed but there is a well-grounded apprehension of future infringement, it is possible to obtain a temporary injunction.

Final injunctions are usually granted at the end of a successful infringement action. A clear right has to be established, and the patentee must prove a continuing act of infringement and the absence of any other satisfactory remedy. If there is a reasonable apprehension of future infringement, it is also possible to obtain a final interdict.

An injunction is effective only against the party against whom it is ordered.

Banning importation of infringing products

24 To what extent is it possible to block the importation of infringing products into the country? Is there a specific tribunal or proceeding available to accomplish this?

There is no specific tribunal or proceedings available to block the importation of infringing products into South Africa in terms of patent law. The only method available in patent law to do so would be to obtain an injunction against the importation in ordinary infringement proceedings before the Court of the Commissioner of Patents.

Attorneys’ fees

25 Under what conditions can a successful litigant recover costs and attorneys’ fees?

Generally, the successful party is awarded costs. Costs are normally awarded on a party-and-party costs basis. Attorney-own-client costs or costs de bonis propriis may be awarded if the court is dissatisfied with the conduct of the relevant party or its attorney. Costs may be recovered only where an order as to costs is given by the court, and are subject to taxation.

Wilful infringement

26 Are additional remedies available against a deliberate or wilful infringer? If so, what is the test or standard to determine whether the infringement is deliberate? Are opinions of counsel used as a defence to a charge of wilful infringement?

There are no additional remedies available against a deliberate or wilful infringer in patent law.

Time limits for lawsuits

27 What is the time limit for seeking a remedy for patent infringement?

There is no specific time limit for seeking a remedy for patent infringement. Damages may not be claimed for any act of infringement performed more than three years before the instituting of infringement proceedings. A temporary injunction does, however, have to be sought as a matter of urgency.
Patent marking

28 | Must a patent holder mark its patented products? If so, how must the marking be made? What are the consequences of failure to mark? What are the consequences of false patent marking?

A patent holder is under no obligation to mark its patented products. However, it is advisable to mark a patented article with the word 'patent' or 'patented' along with the number of the patent, as this may be relied on to prove that an infringer was aware of the existence of a patent, which is a requirement for a claim for damages. Failure to mark the patented product in the appropriate manner has the consequence that the marking is deemed not to constitute notice of the existence of the patent for the purpose of a claim for damages.

Any person who falsely represents that any article is a patented article is guilty of an offence and is liable to a fine not exceeding 1,000 rand or to imprisonment for a period not exceeding 12 months.

LICENSING

Voluntary licensing

29 | Are there any restrictions on the contractual terms by which a patent owner may license a patent?

Section 90 of the Patents Act prevents a patentee from securing certain contractual rights that fall outside of the scope of the rights afforded by a patent. By virtue of this section, the patentee cannot, as a condition to the contractual rights that fall outside of the scope of the rights afforded by a patent, oblige the licensee to agree to provisions in favour of the licensor that extend beyond the rights afforded by the patent.

As it applies to licensing, section 90 provides as follows:

- A licensor may not prohibit or restrict a licensee from purchasing or using any article supplied or owned by a third party. A licensor is, however, entitled to prohibit a licensee from selling goods other than those of a particular person.
- A licensor may not prohibit or restrict a licensee from using any article or process not protected by the patent. In other words, a licensee cannot be contractually restrained from using an article or method that could be a substitute for the patented article or method.
- A licensor may not require a licensee to acquire from the licensor any article other than that which forms the subject of a patent owned or licensed by the licensor. A licensor is, however, entitled to reserve for him or herself, or his or her nominee, the right to supply new parts of a patented article (parts other than 'ordinary articles of commerce') as may be required to put or keep the patented article in repair.
- A licensor may not require or induce a licensee to apply a specified minimum resale price in respect of any patented article.
- A licensor may not prohibit or restrict the making, using, exercising or disposing of the invention in any country in which the invention is not patented. So, for example, a contractual restraint on a licensee that prohibits the licensee from dealing in the patented invention in territories in which the licensor has not secured patent rights will be null and void.

Compulsory licences

30 | Are any mechanisms available to obtain a compulsory licence to a patent? How are the terms of such a licence determined?

Sections 55 and 56 of the Patents Act, as well as Regulation 96, govern the grant of rights to an entity without the authorisation of the patentee.

In particular:

- section 55 deals with the grant of a compulsory licence to an applicant, where the working of a patent without infringing a prior patent is dependent upon the obtaining of a licence under that prior patent (a dependent patent situation);
- section 56 deals with the grant of a compulsory licence in the case of abuse of patent rights by the patentee; and
- Regulation 96 sets out the procedure for an application for a compulsory licence, namely that such an application will be made by way of notice of motion and shall be served on the patentee and any other person who appears from the patent register to have an interest in the patent.

In the case of dependent patents, the commissioner may grant a compulsory licence if the working of a patent (the dependent patent) without infringing a prior patent is dependent on obtaining a licence under that prior patent. There is presently no substantive examination of patent applications in South Africa. An applicant applying for a compulsory licence under this section should therefore supply evidence to show that the invention of the dependent patent is new and inventive, ie, that it is in fact a valid dependent patent (Atomic Energy Corporation of South Africa Limited v The Du Pont Merck Pharmaceutical Company 1997 BIP 90 (CP)). Furthermore, section 55 directs that the Commissioner shall not grant a licence unless 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.

In the case of abuse of patent rights, section 56(2) sets out a number of grounds upon which the patentee’s rights will be deemed to be abused. Section 56(2)(a) provides that a patent shall be deemed to be abused if the patented invention is not being worked in South Africa on a commercial scale or to an adequate extent, after the expiry of a certain period and without any satisfactory reason for such non-working.

Section 56(2)(b) provides that a patent shall be deemed to be abused if the demand for the patented article in South Africa is not being met to an adequate extent and on reasonable terms.

Section 56(2)(c) provides that a patent shall be deemed to be abused if the trade, industry or agriculture of the country or any person in the country is being prejudiced, or the establishment of a new trade or industry in the country is being prejudiced by reason of the refusal of the patentee to grant a licence or licences upon reasonable terms; and it is in the public interest that a licence should be granted.

In Sanachem (Pty) Limited v British Technology Group PLC 1992 BP 276 (CP), the court indicated that three requirements had to be established by the applicant, namely that:

- the respondent had refused to grant the applicant a licence on reasonable terms;
- the trade, industry or agriculture of the country, as well as the applicant, were being prejudiced by the refusal; and
- it was in the public interest to grant such a licence.

On the question of prejudice, it was held that the meaning of ‘public interest’ is to be construed in its widest meaning, namely, the interests of the community including every class that goes to constitute that body, the purchasing public, traders and manufacturers, the patentee and his or her licensees, and inventors generally.

Section 56(2)(d) provides that a patent shall be deemed to be abused if the demand for the patented article in the country is being met by importation and the price charged by the patentee (or his or her authorised agent) in South Africa 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 or her predecessor or successor in title).

The determination of reasonable licence terms is determined on the individual merits of the case. The Commissioner has wide powers to determine the conditions upon which a licence may be granted, except that where a compulsory licence is granted under section 56 of the Patents Act.
• it shall include a provision that the licence shall, on application by the patentee, be terminated if the circumstances that led to its grant cease to exist and, in the opinion of the Commissioner, are unlikely to recur; and
• it shall be non-exclusive and non-transferable (except to a person to whom the business or part thereof has been transferred).

It may also be possible to obtain a compulsory licence under competition law, especially if the patentee is dominant in the market in question and the patent is considered to be an ‘essential facility’ (defined in section 1 of the Competition Act 89 of 1998 as an infrastructure or resource that cannot be reasonably duplicated and without access to which competitors cannot reasonably provide goods or services to their customers).

## Patent Office Proceedings

### Patenting timetable and costs

31 | How long does it typically take, and how much does it typically cost, to obtain a patent?

A South African complete patent application and a convention patent application typically proceeds to grant between 12 and 15 months from the date of filing the application. A national phase patent application typically proceeds to grant between 15 and 20 months from the date of filing the national phase application in South Africa. It is possible to delay and extend the acceptance of an application at the request of the applicant. This is usually done where the applicant is awaiting the outcome of examination of a corresponding application in an examining jurisdiction.

The cost of filing a convention patent application and a national phase patent application generally amounts to between US$1,000 to US$2,000. Renewals are payable annually from the third year after the South African filing date for a convention application or the international filing date for a national phase application.

### Expedited patent prosecution

32 | Are there any procedures to expedite patent prosecution?

South Africa is not part of the Patent Prosecution Highway, but a patent application generally proceeds to grant relatively quickly due to the lack of substantive examination. It is also possible to apply to the Registrar of Patents to expedite the grant of a pending patent application. In such a case, provided the application meets all of the required formalities, the application will usually proceed to grant between two and four months from making an application.

### Patent application contents

33 | What must be disclosed or described about the invention in a patent application? Are there any particular guidelines that should be followed or pitfalls to avoid in deciding what to include in the application?

The specification of a provisional patent application is required to fairly describe the invention. The specification of a complete patent application, such as a convention patent application and a national phase application, is required sufficiently to describe, ascertain and, where necessary, illustrate or exemplify the invention and the manner in which the invention is to be performed in order to enable the invention to be performed by someone skilled in the art. Such a specification is also required to end with a claim or claims defining the invention for which protection is claimed. The claims are required to be clear, to relate to a single invention and to be fairly based on the matter disclosed in the specification. South Africa is party to the Budapest Treaty, and where an invention relates to a micro-biological process or product derived therefrom, the deposit system in accordance with this treaty applies. No claim or page limits are applicable and multiple dependencies are allowable.

It is a ground of revocation of a South African patent if ‘the declaration in the Form P3 contains a false statement which is material and which the patentee knew or ought reasonably to have known to be false at the time that the declaration was made’. In this regard, the Form P3 states ‘to the best of my/our knowledge and belief, if a patent is granted on the application, there will be no lawful ground for the revocation of the patent’. It is thus imperative that if the applicant is aware of any invalidities in the specification or claims that these invalidities should be cured by way of amendment before grant. This is particularly relevant to the right of applying and being granted a patent for an invention and any adverse patentability opinions received in examining jurisdictions.

### Prior art disclosure obligations

34 | Must an inventor disclose prior art to the patent office examiner?

An inventor does not have to disclose prior art to the South African Patent Office. However, in view of the duty on the applicant to ensure that the patent is maintained in an allowable form, and considering the declaration made on the Form P3, it is imperative that any invalidity that the applicant is aware of be cured by way of amendment.

### Pursuit of additional claims

35 | May a patent applicant file one or more later applications to pursue additional claims to an invention disclosed in its earlier filed application? If so, what are the applicable requirements or limitations?

It is possible to file one or more divisional patent applications stemming from a parent patent application prior to the acceptance of the parent application. A divisional patent application is made in respect of part of the matter disclosed in the parent application and is therefore limited to the subject matter disclosed in the parent application.

It is also possible to file a patent of addition for any addition to, improvement in or modification of the invention of a granted patent. A patent of addition must be novel but may not be invalidated on the grounds that it does not contain an inventive step over the main invention. Unlike a divisional patent application, which is recognised as a fresh patent application that is independent of the parent patent application, a patent of addition is not severable from the patent of the main invention.

### Patent office appeals

36 | Is it possible to appeal an adverse decision by the patent office in a court of law?

The South African Patent Office does not conduct substantive examination and a patent will accordingly be granted provided all of the formal requirements are met. A decision made by the registrar may be appealed or reviewed, but such action is limited to decisions relating to procedural or formal issues.

### Oppositions or protests to patents

37 | Does the patent office provide any mechanism for opposing the grant of a patent?

No mechanisms for opposing the grant of a patent in South Africa exist. However, any person may apply for the revocation of a patent any time after the patent has proceeded to grant.
Priority of invention
Does the patent office provide any mechanism for resolving priority disputes between different applicants for the same invention? What factors determine who has priority?

South Africa follows the first-to-file principle, and the first applicant to have filed a patent application directed to an invention will therefore have the right to priority, irrespective of who was first to invent the invention. The South African Patent Office does not provide any mechanism for resolving priority disputes but does provide for mechanisms for resolving disputes that may arise between persons and their rights to apply for and be granted a patent.

Modification and re-examination of patents
Does the patent office provide procedures for modifying, re-examining or revoking a patent? May a court amend the patent claims during a lawsuit?

As there is no examination of the merits of a patent application in South Africa, a patent application will proceed to grant if no voluntary amendments are filed. However, there are provisions for the voluntary amendment of the patent application before or after granting the application.

Prior to the application being granted, any voluntary amendment may be made, provided:

- no new matter, or matter not in substance disclosed in the specification before amendment, is added; and
- any amended claim is fairly based on the matter disclosed in the specification before the amendment.

The same limitations apply to post-grant amendments. However, there is an additional limitation in that a post-grant amendment cannot result in a claim that does not fall within the scope of a claim prior to amendment. The scope of the broadest claim may accordingly not be broadened during a post-grant amendment.

South African law also provides for the amendment of a patent in the course of legal proceedings. Where legal proceedings are pending in a court in relation to a patent application or patent, then an application for the amendment of such patent application or patent must be made to that court. All the requirements for a normal post-grant amendment will apply.

The law provides a number of exhaustive grounds on which a patent may be revoked. A patent may be revoked on any one or a combination of these grounds.

Patent duration
How is the duration of patent protection determined?

The duration of a patent is 20 years calculated from the date on which a complete patent application or a convention patent application is filed in South Africa, or 20 years calculated from the filing date of an international application (Patent Cooperation Treaty patent application) which has entered South Africa in the national phase.

UPDATE AND TRENDS

Key developments of the past year
What are the most significant developing or emerging trends in the country’s patent law?

The South African Cabinet approved the South African IP Policy on 30 May 2018. The IP Policy recommends key reforms. The major reforms being the introduction of substantive search and examination for patents and the implementation of the ‘utility model’ to support the registration of patents by resident small, medium and micro-enterprises, historically disadvantaged individuals, and companies who are operating in the informal sector. A draft bill is expected later in the year.