

## GUIDELINES ON OBTAINING ENFORCEABLE PATENTS IN SOUTH AFRICA – COST-EFFECTIVELY

Arguably, there have been no newsworthy developments in South African patent law recently, but we have received request for guidelines on how to patent inventions cost-effectively in this jurisdiction that generally favours patentees. In particular, we have been requested to explain our contention that most applicants would benefit from filing Convention patent applications (non-PCT), rather than national phase applications in South Africa.

South African patent applications are not examined substantively, but can be enforced. However, interim interdicts (preliminary injunctions) will not be granted if the patent appears to be clearly invalid (for which the alleged infringer bears the onus). Patentees are obliged to rectify invalidity of which they are aware, in pending applications and in granted patents, and they are required to sign a prescribed declaration (included in Form P3), confirming that they are not aware of reasons for the patent to be invalid. If the application includes invalidity of which the applicant ought to be aware when signing the declaration, it amounts to a misrepresentation that renders the patent incurably invalid. Such invalidity is often easy to prove, especially in PCT-based applications where search reports and opinions are publicly available, so care should be taken when signing the declaration (Form P3).

If a South African patent application is filed when the applicant has no reason to doubt patentability of the invention, e.g. if no adverse search or examination reports have been issued in respect of the invention, then the applicant can sign Form P3 and allow the application to proceed to acceptance and grant. The applicant should still amend the application or patent in due course, if it subsequently becomes aware of invalidity (e.g. if new prior art comes to light during examination of a counterpart application), but Form P3 would not need to be re-signed and would contain no misrepresentation, because the declaration was true at the time when it was signed.

If a South African patent application is filed when the applicant is aware of objections raised against patentability of the invention, e.g. if an adverse Written Opinion was issued in the international application, then the applicant generally has the following options available:

- A. Sign the declaration and accept that the patent may have to stand or fall in its present condition. (This could be appropriate if the applicant is convinced that the objections raised against patentability are wrong.)
- B. Amend application to a form which has not been examined yet and in which the applicant is confident that the objections raised against patentability have been overcome (e.g. by limiting the claims to avoid the objections raised), before signing the declaration. If the amendment amounts to a reasonable, *bona fide* attempt to cure the suspected invalidity, then the declaration would not contain a

2nd Floor, Mariendahl House, Newlands on Main, Main Road, Newlands 7700, Cape Town, South Africa  
PO Box 45060, Claremont 7735, South Africa ■ Docex 7 Newlands  
Tel: +27 21 683 2732 ■ Fax: +27 21 683 9405 ■ Email: [info@brianbacon.com](mailto:info@brianbacon.com)

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Directors: Brian Bacon; Colin Truter; Tim Ball; Vanessa Crease Candidate Attorney: Thapelo Segodi Office Manager: Shireen Gibbons  
Brian Bacon Inc. Reg. No. 2004/001839/21

misrepresentation and the applicant/patentee would be entitled to file future amendments and to enforce the patent.

- C. Delay acceptance of the application and wait for an examined counterpart application to be allowed, before amending the application to accord with the allowed counterpart and then signing the declaration. In such a case, the declaration would almost certainly not contain a misrepresentation and the applicant/patentee would be entitled to file future amendments and to enforce the patent.

If objections have been raised to patentability, before filing the South African patent application, then Option C would in most cases be the most prudent. However, delaying acceptance until a counterpart application has been allowed, can be fairly costly and often frustrates applicants.

So: to take advantage of the simplicity of obtaining enforceable patents in South Africa, applicants should ideally file patent applications at a time when it has no reason to doubt patentability and this would be the case if the outcome of an international application has been entirely favourable. However, the safest, simplest and most cost-effective approach would be to file non-PCT patent applications in South Africa – e.g. to file patent applications claiming Convention priority, before any search report issues that could place the applicant under an obligation to amend the application and in a quandary about what amendments to file.

In an attempt to keep these guidelines brief, they include some generalisations and avoid some specifics which may render them inappropriate for some matters. It is strongly recommended that professional advice be sought in respect of each South African patent application.

Brian Bacon Inc.  
Cape Town, South Africa  
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