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Obtaining Cost-effective, Enforceable Patents in South Africa

Most applicants would benefit from filing non-PCT based patent applications, 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 in pending applications and granted patents, and to sign a declaration (in Form P3), confirming that they are not aware of any invalidity. 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.

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 patent ability 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 patent ability are wrong.)

B Amend application to a form which has not been examined yet and in which the applicant is justifiably 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 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 contain no misrepresentation and the applicant/patentee would be entitled to file future amendments and to enforce the patent.

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 before any search report issues that could obligate the applicant to amend the application and cause 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.

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