Inputs from Member States and Regional Patent Offices to the Thirty-Eighth Session of the Standing Committee on the Law of Patents

Respondent Information

First Name:

[redacted]

Last Name:

[redacted]

Country:

South Africa

IP Office

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Job title

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Disclaimer:

The information provided in response to this questionnaire is understood to be submitted on behalf of the Member State or regional organization concerned, through its competent authority and in accordance with its applicable official internal procedures.
It is assumed that the person completing and submitting the questionnaire is duly authorized to do so and that the information reflects the official position or practice of the Member State or organization, to the extent possible.

I confirm that I have read and understood the statement above and that I agree with its contents.

A. Prior Art

1. How is prior art defined under the applicable national or regional law?

Patents Act No. 57 of 1978 Sections 25 (6) - 25(8) define the state of the art.
Everything made accessible to the public by a written or oral description, use or in any other way before the filing date (priority date).
Contents of South African and international PCT patent applications with an earlier filing date (priority date) which are or become open to public inspection.
Inventions used secretly on a commercial scale in South Africa before the filing date (priority date).

2. Against which date is prior art assessed under the applicable law?

The earliest priority date or the effective filing date, whichever is earliest, of the application in question.

3. Which types of information may constitute prior art under the applicable law, and how is it determined whether such information is considered to form part of the prior art?

Written publications, patent documents, oral disclosures, public use, sales, digital or online disclosures, or other publicly accessible information is treated equally in view of absolute novelty. Disclosures due to clinical trails or experimentation or disclosures made without knowledge or consent of the applicant do not form part of the prior art.

4. Does the applicable law provide for any category of prior art that is taken into account for patentability purposes notwithstanding that it was not publicly available before the relevant filing or priority date (sometimes referred to as "secret prior art")?

Yes

If yes, please indicate, where applicable, the types of information or documents concerned (for example, earlier-filed patent applications), the relevant date(s) for determining such prior art, as well as any limitations, exclusions, or special rules applicable to such prior art. : Contents of South African and international PCT patent applications with an earlier filing date (priority date) which are or become open to public inspection. Such prior art are not considered for inventive step.

5. Please provide any additional information that may be relevant to the understanding or application of prior art under the applicable law, including where applicable, any guidance (for example, patent office manuals or guidelines) or key judicial decisions in your jurisdiction with general relevance to applicants or interested parties, captured by patent office practice.

Gentiruco AG v Firestone South Africa (Pty) Ltd 1972 (1) SA 589 (A)

Merck Sharpe Dohme Group v Cipla Agrimed (Pty) Ltd (2016 (3) SA 22 (SCA))

Please upload any document that may be relevant to the understanding or application of prior art under the applicable law.

Merck_Sharpe_Dohme_Group_v_Cipla_Agrimed_(Pty)_Ltd_(2016_(3)_SA_22_(SCA)).pdf

6. Please indicate whether any legal provisions, including those applicable to utility models or any other similar system (where different from those applicable to patents of invention), are relevant to the subject matter of this section and, if so, kindly provide the relevant information and references.

Disclosures made by the applicant pertaining to functional designs may be subject to a 6 months grace period from the release date made before the application date. Designs relating to integrated topography and series of mask work and are granted a grace period of 2 years between disclosure and publication.

B. Novelty

1. How is the requirement of novelty defined under the applicable national or regional law?

Section 25(5) of the Patents Act No. 57 of 1978 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.

2. For the purposes of assessing novelty under the applicable law, are there any novelty-specific considerations regarding the relevant date or the scope of information taken into account, beyond those addressed in the Prior Art section of this survey?

No.

3. Does the applicable law apply an absolute novelty requirement, or does it provide for any limitations or qualifications to novelty (for example, relative novelty or other restricted approaches), apart from any grace period mechanisms addressed separately in this survey?

The office considers absolute novelty.

4. Apart from the approach described in question 3, are there any specific rules or contextual factors that affect what is taken into account as prior art for the purposes of assessing novelty under the applicable law?

No.

5. Please provide any additional information relevant to the requirement of novelty under the applicable law, to the extent not already addressed in questions 1 to 4, including, where applicable, any guidance (for example, patent office manuals or guidelines) or key judicial decisions in your jurisdiction with general relevance to applicants or other interested parties, captured by patent office practice.

No additional information

6. Please indicate whether any legal provisions, including those applicable to utility models or any other similar system (where different from those applicable to patents of invention), are relevant to the subject matter of this section and, if so, kindly provide the relevant information and references.

None

C. Inventive Step

1. How is the criterion of inventive step or non-obviousness defined under the applicable national or regional law?

Patents Act 57 of 1978 Section 25(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)).

2. For the purposes of assessing inventive step or non-obviousness under the applicable law, what is the relevant date and what prior art or information is taken into account?

The relevant date is the priority date of the invention. The prior art taken into account is all prior art published immediately before the priority date of the invention.

3. What is the standard applied under the applicable law to determine whether an invention involves an inventive step or is non-obvious, in particular as reflected in the concept of the "person skilled in the art", focusing on how the standard is understood or applied, rather than its formal legal definition?

The current test applied is the 4 step approach as per caselaw Roman Roller CC and Another v Speedmark Holdings (Pty) Ltd. (502/93) [1995] ZASCA 78; 1996 (1) SA 405 (SCA); (22 August 1995) and Ensign Bickford (South Africa) (Pty) Ltd. and Others v AECI Explosives and Chemicals Ltd. (4/95) [1998] ZASCA 73; 1999 (1) SA 70 (SCA); [1998] 4 All SA 453 (A); 1998 BIP 271 (SCA) (21 September 1998).

[The Roman-Roller three-step approach was adopted regarding the assessment of inventiveness of the present invention

i) what the art is to which the invention relates,
ii) what was the state of this art at the relevant time; and
iii) who is to be regarded as a 'person skilled in the art'

OR

The Ensign-Bickford four-step approach

1) What is the inventive step said to be involved in the patent in suit?
2) What was, at the priority date, the state of the art (as statutorily defined) relevant to that step?
3) In what respect does the step go beyond, or differ from, that state of the art?
4) Having regard to such development or difference, would the taking of the step be obvious to the skilled man?.

4. Are there any specific rules, limitations, or contextual factors that apply to the assessment of inventive step or non-obviousness under the applicable law?

No

Please indicate, where relevant, whether such rules or factors include geographic or territorial considerations affecting the relevance of prior art (for example, distinctions between domestic and foreign disclosures, uses, or publications, or territorial conditions applicable to particular categories of prior art) or any other particular considerations relevant to the assessment.

***Responses should be limited to such contextual factors asthey relate to the assessment of inventive step or non-obviousness, without restating general rules on what constitutes prior art.*:** N/A

5. Please provide any additional information relevant to the requirement of inventive step or non-obviousness under the applicable law, to the extent not already addressed in questions 1 to 4, including, where applicable, any guidance (for example, patent office manuals or guidelines) or key judicial decisions in your jurisdiction with general relevance to applicants or interested parties, captured by patent office practice.

Covered above (3)

Please upload any document relevant to the requirement of inventive step or non-obviousness under the applicable law.

6. Please indicate whether any legal provisions, including those applicable to utility models or any other similar system (where different from those applicable to patents of invention), are relevant to the subject matter of this section and, if so, kindly provide the relevant information and references.

Functional designs need to be new and not common place whereas patents need to be new and inventive. Designs Act No.195 of 1993 Section 14(1)(b)

D. Grace Period Mechanisms and Pre-Filing Disclosures

1. Does the applicable law provide for any mechanism under which certain disclosures made before the filing or priority date do not prejudice the patentability of an invention, in particular with respect to novelty and/or the legal effect on prior art?

Yes

If yes, please identify the relevant legal provisions (in primary and/or secondary legislation) and describe their operation.: Patents Act No. 57 of 1978 Section 26

2. What is the duration of the mechanism referred to in question 1, during which the covered disclosures do not prejudice the patentability of the invention?

No duration

3. Where such a mechanism exists, which categories of disclosures are covered by it?

Patents Act No. 57 of 1978 Section 26
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 invention, that he or she applied for and obtained protection for his or her 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.

4. Are there any formalities or procedural requirements that must be fulfilled in order to rely on the mechanism identified in question 1?

No

Please describe any such requirements, where applicable, including, for example, the need to file statements, declarations or notices, to submit certificates or other supporting evidence, or to comply with any timing or notification requirements or any information relating to the burden of proof. **:**

5. Does the applicable law provide for prior user rights or other protections for third parties who may be affected by an invention that has benefited from a graced pre-filing disclosure?

No

If yes, identify the relevant legal provisions (including any provisions in primary and/or secondary legislation), and describe the conditions under which such rights or protections arise (for example, good-faith use of the invention prior to the filing or priority date), as well as how such rights or protections operate. **:**

6. Please provide any additional information that may be relevant, including, where applicable, any guidance (e.g. patent office manual/guidelines) or key judicial decisions in your jurisdiction with general relevance to applicants or interested parties, captured by patent office practice.

None

Please upload any document that may be relevant to grace period mechanisms and/or pre-filing disclosures.

7. Please indicate whether any legal provisions, including those applicable to utility models or any other similar system (where different from those applicable to patents of invention), are relevant to the subject matter of this section and, if so, kindly provide the relevant information and references.

Functional designs need to be new and not common place whereas patents need to be new and inventive. Designs Act No.195 of 1993 Section 14(1)(b)

Submission of information concerning other aspects of national/regional patent law

E. Sufficiency of Disclosure

Sufficiency.pdf

F. Exclusions from Patentable Subject Matter

Exclusions.pdf

G. Exceptions and Limitations to Patent rights

Exceptions.pdf

Final review before submission

Confirmation of submission

I am aware that by clicking "Submit" below, my responses will be sent to the SCP Secretariat.