



**H A H N · H A H N I N C**  
INTELLECTUAL PROPERTY PRACTITIONERS

Postal Address  
**P O Box 13575 Hatfield 0028**  
**Republic of South Africa**  
**Docex 219 Pretoria**

**Physical Address**  
Hahn Forum 222 Richard Street  
Hatfield Pretoria 0083  
Republic of South Africa

**Email:** hahn@hahn.co.za  
http://www.hahn.co.za

**Tel:** (27) (12) 342 1774  
**Fax:** (27) (12) 342 3027

© April 2012

**MEMORANDUM ON PROSECUTING A PCT NATIONAL PHASE  
APPLICATION IN SOUTH AFRICA**  
*(REVISED April 2012 – Ruling by Court in U P case on extensions of time)*

**IMPORTANT NOTICE ON PRESCRIBED DUE DATES**

In a recent Judgment of the Commissioner of Patents in the case of University of Pretoria v The Registrar of Patents and others, the Court ruled that the granting of extensions of time could in most cases only be considered valid where the extension of time is applied for prior to reaching the deadline which is to be extended and then only if a formal application is made and the reasons for requiring the extension are presented, and these reasons must be true and good reasons. As obtaining extensions incurs costs and, in most cases we would require the full true reasons for the need for the extension, please ensure we are provided with all documents well ahead of the due dates or provide us with instructions to apply for an extension beforehand.

***Failure to adhere to the above can result to the irrevocable lapsing of a patent application.***

**Documentary Requirements**

1. In terms of Section 43E of the South African Patents Act, commencement of the PCT National Phase must take place before the expiration of 31 months from the priority date regardless whether a Chapter II demand was filed as long as South Africa is elected. The applicant in respect of an international application designating or electing the Republic shall-
  - (a) pay the prescribed national fee to the patent office; and
  - (b) if the international application has not been lodged or published in terms of the Patent Cooperation Treaty in English, lodge at the patent office within the prescribed period (viz. **31 months from the priority date**) a **translation** of the international application, containing the prescribed contents, in an **official language** of the Republic. (English is an official language)

A **maximum three month extension** is possible for the lodging of the translation and if the applicant does not provide the **verified translation of the application within 3 months** of entering the national phase the international application concerned shall be **deemed to have been abandoned**.

**PLEASE NOTE:** In accordance with the latest Judgment of the Court of the Commissioner of Patents, failure to comply with this deadline will lead to lapsing of the Patent Application. Please ensure we are in receipt of the translation well in advance of the deadline.

2. The Registrar also requires satisfactory evidence that the applicant is entitled to apply for the South African patent, and to this end the standard **Assignment** is acceptable, although other means of satisfying the Registrar, such as excerpts from employment contracts and Affidavits by employers are also acceptable. This document may be filed **within 6 months** of the filing date.
3. A Power of Attorney, on South African Patents Form P3 (the standard Declaration and Power of Attorney), is also required to be lodged within **6 months** of the filing date although extensions of this period are available.
4. A Statement on the Use of Indigenous Biological Resource, Genetic Resource, Traditional Knowledge or Use on South African Patents Form P26 is also required to be lodged within **6 months** of the filing date although extensions of this period are available. We believe this to be limited to South African resources, knowledge or use.
5. Where the Form P26 contains a statement that the invention for which protection is claimed is based on or derived from an indigenous biological resource, a genetic resource, or traditional knowledge or use, the applicant shall, before acceptance of the application furnish the registrar with proof of his or her title or authority to make use of the indigenous biological resource, the genetic resource, or the traditional knowledge or use, by lodging with the registrar one or more of the following:
  - (a) a copy of the permit issued in terms of Chapter 7 of the National Environmental Management: Biodiversity Act, 2004;
  - (b) if applicable, proof that prior consent had been obtained as contemplated in section 82(2)(a) or 82(3)(a) of the National Environmental Management: Biodiversity Act, 2004;
  - (c) if applicable, proof of a material transfer agreement as contemplated in section 82(2)(b)(i) of the National Environmental Management: Biodiversity Act, 2004;
  - (d) if applicable, proof of a benefit-sharing agreement as contemplated in section 82(2)(b) of the National Environmental Management: Biodiversity Act, 2004;
  - (e) if applicable, proof of co-ownership of the invention for which protection is claimed;

- (f) any other proof to the satisfaction of the registrar.

**Notes on 2 to 5 above:**

**ASSIGNMENTS**

Please do not alter any assignment forms which we have provided for signature or use your own forms without first confirming with us that your forms would be suitable for filing in South Africa.

Please ensure that the effective date of the Assignment of Invention is prior to the date of signature of the patent forms P3 (Power of Attorney and Declaration) and P26 (Declaration as to Indigenous Knowledge or Resources).

In the event that the priority application was filed in the name of an applicant other than the applicant appearing on the WO publication, please let us know as an Assignment of Priority will be required.

Where there are two co-applicants and the employees of each co-applicant have contributed parts of the invention as claimed, a cross assignment by all of the inventors to both co-applicants is required. It is not sufficient that the employees of a co-applicant only assign their invention to that co-applicant because under South African law each co-applicant owns an **undivided share** in the invention.

**FORM P26**

Please be advised that the Form P26 is required for **all** the inventions filed in South Africa regardless of technical area to which an invention belongs.

In the event that the invention is NOT based on or derived from a **South African** indigenous biological resource or genetic resource, please cross out 3(a), 4(a) and 5(a).

In the event that the invention IS based on or derived from a **South African** indigenous biological resource or genetic resource, please cross out 3(b), 4(b) and 5(b).

The meaning of “the invention for which protection is claimed is based on or derived from traditional knowledge or use” is that such traditional knowledge or use is claimed as an essential element of the invention.

**Specification Requirements**

6. The South African Patent Office will obtain a copy of the International Application, with Article 19 and Article 34 amendments directly from WIPO and copies of the specification, claims, drawings, and abstract are not receivable from the applicant.

7. Where either or both Article 19 and Article 34 amendments have been made during the International Phase, then such **amendments will automatically form part of the South African application**, however where said **amendments were not made in English** then a **verified translation** thereof into English must be provided within **3 months**.

<p><b>PLEASE NOTE:</b> Our cautious view is that in accordance with the latest Judgment of the Court of the Commissioner of Patents, failure to comply with this deadline will lead to lapsing of the Patent Application. Please ensure we are in receipt of the translation well in advance of the deadline.</p>
---

8. South Africa is a non-examining country and thus the only examination is to form and not as to substance. It is the duty of the applicant to ensure that the application is valid as to novelty and inventive step.
  - 8.1 South Africa's novelty requirements are very similar to those of most of the developed world including Europe, Australia, USA and Japan, and thus any amendments made to overcome novelty objections before these examining offices should be incorporated into the South African application, preferably prior to grant of the patent.
  - 8.2 South Africa's inventive step requirements differ from some of the above jurisdictions and thus a South African application should be scrutinised in the light of the International Search Report and/or the International Preliminary Examination Report to decide to what extent the PCT International Specification as filed and/or as published should be amended when filing a South African application to reduce the risk of invalidity on the grounds of lack of inventive step of any South African patent which may be granted on the application.
  - 8.3 We usually recommend that amendments made before examining offices solely to overcome inventive step objections are considered carefully before being incorporated in the South African application. This course of action prevents the unnecessary limitation of the scope of the claims of the South African patent. Only a court can decide on the question of inventive step.
  - 8.4 It may thus in some instances be preferable not to be limited by the amendments annexed to the International Preliminary Examination Report but rather to selectively amend the South African patent application prior to acceptance of the patent. This can be undertaken at the same time as the omnibus claims are added (see 9. below) by amending the application to reverse the amendments made during the International Phase, where possible.
  - 8.5 In terms of South African patent practice, omnibus claims are usually included in a South African application prior to grant of the patent. These omnibus claims must be introduced by way of amendment as set out in 9. below.

9. **Amendments**
  - 9.1 Omnibus claims, claims not allowable in South Africa, such as method of treatment claims, and any other claims usually added according to South African practice, and which are not annexed to the International Application, must be added, deleted, or corrected after filing but prior to grant of the patent application (**about 8 months**);
  - 9.2 Unless we **hear from you to the contrary within 2 months** from the date of entry into the National Phase in South Africa, we will formally apply for amendment of the application to bring it into conformance with South African patent practice and legal requirements, as set out in 8.1 above. At the same time we can also attend to any other amendments and corrections, for example, in the light of prior art which has become known to the applicant as explained in 8. above.
10. **Priority Document.**
  - a. If the applicant complies with rule 17.1 of the PCT then neither the priority document nor a translation thereof need be lodged.
  - b. If the applicant does not comply with rule 17.1 of the PCT then a priority document, together with a verified translation thereof, must be lodged with the Patent Office within 6 months of entering the South African National phase. This time limit may be extended at the discretion of the Registrar on application for extension being made.
11. **Renewal fees** are payable **from 36 months after the International Filing date**, but may be paid **within 6 months of the grant** of a patent if a patent is granted more than 33 months after the International Filing date.