

Towards the introduction of a Substantive Search & Examination System for Patents in South Africa

South Africa currently follows a depository system for patent registration. The formal patent examination procedure has availed a weaker patent granting system. The lack of substantive examination has thus impacted on the quality and integrity of patents granted by the office.

Section 25 of the Patent Act, 57 of 1978, sets out the requirements and the criteria for patentability: namely Novelty, Inventive Step, Industrial Applicability and what the state of the art shall include for the purposes of establishing novelty and inventive step. An invention should be new as of the date of filing, and not publicly known anywhere in the world through written or oral disclosure or through use.

Furthermore, Section 34 stipulates that the Registrar shall examine the applications in a prescribed manner and if there is compliance with the requirements of the Patent Act, the Registrar shall accept it for registration. However, the prescribed manner for examination (regulation 40 and 41) provide only for formal examination, the Registrar is thus not in a position to ensure compliance with the Act.

The lack of substantive patent examination by the IP office, leads to granting of patents invalid from the outset, e.g. Software patents”, patents for methods for treatment of humans and animals, patents with marginal inventive step that allows the blocking of the relevant market sectors by powerful companies to the disadvantage of the small and medium enterprises.

The protection of intellectual property rights should contribute to the promotion of technological innovation and to the transfer and dissemination of technology. However, patents granted to an undeserving invention, weakens the innovation system. It is therefore important that the exclusivity in patents, be granted to only inventions that meet the patentability criteria laid down in the Patent Act. Hence the need to introduce the substantive examination procedure to act as the primary gate keeper to the granting of valid, high quality patents with greater legal certainty.

In preparation for the introduction of SSE, 2012-2014, the CIPC and the dti, organised 2 stakeholder round-table discussion sessions to identify the most efficient and effective model to be implemented in South Africa for substantive search and examination of patents. In addition, CIPC embarked on a benchmarking exercise, where countries like Singapore, Brazil etc. were visited to gain a better understanding of their patent granting system, prior art searches and prioritisation of work (local filings vs. foreign filings).

The CIPC has in addition, recruited the first 20 examiners (11 male and 9 female) with different technical backgrounds (Biotechnology/Molecular Biology, Biochemistry, Chemistry, Engineering, Mining, Physics; Information Technology etc.). Out of the 20, 11 have PhD degrees, 6 have Masters and 2 have Bachelor of Honour degrees. The Patent examiners are currently undergoing a two years extensive training programme before they can start with on the job work on priority art searches and substantive examination of patents.

Several international IP offices including the World Intellectual Property Organisation (WIPO) have offered to assist in the training of the examiners on the various aspects of patent search and substantive examination.