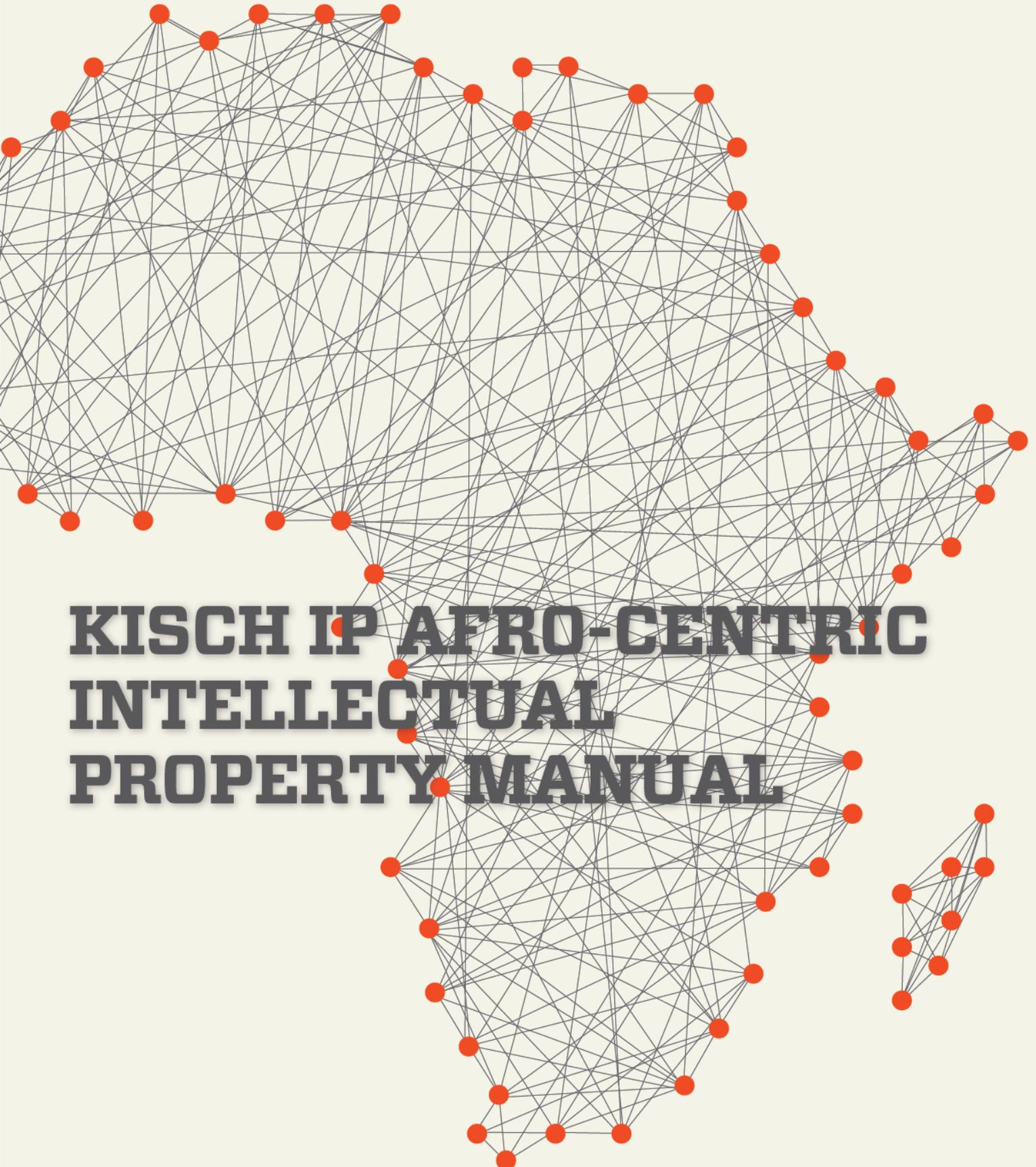


KISCH IP

Patent. Trade Mark. Copyright Attorneys.



**KISCH IP AFRO-CENTRIC
INTELLECTUAL
PROPERTY MANUAL**

EXECUTIVE SUMMARY

African IP specialists, KISCH IP, presents this Afro-Centric Intellectual Property Manual as a comprehensive guide to assist our clients in navigating the intricacies of IP protection and enforcement in the rising continent of Africa. The manual further provides a practical IP manual to entrepreneurs and global corporations alike, providing holistic and detailed information serving as a platform for specialist and focused solution driven advice.

TABLE OF CONTENTS:

1.	INTRODUCTION.....	9
1.1.	PURPOSE OF MANUAL	9
1.2.	WHY PROTECT AND MANAGE INTELLECTUAL PROPERTY?.....	9
1.2.1.	<i>Corporate perspective</i>	9
1.2.1.1.	Commercial incentive	9
1.2.1.2.	Sustainable intellectual property cycle	12
1.2.2.	<i>Individual perspective</i>	12
2.	INTELLECTUAL PROPERTY	13
2.1.	TYPES OF INTELLECTUAL PROPERTY	13
2.1.1.	<i>What is intellectual property?</i>	13
2.1.2.	<i>Patents</i>	13
2.1.2.1.	What is a patent?	13
2.1.2.2.	What is a patentable invention?	14
2.1.2.3.	What is not patentable?.....	16
2.1.2.4.	Special patentability provisions	17
2.1.2.5.	Foreign patent applications	18
2.1.2.6.	Who can apply for a patent?	19
2.1.2.7.	What are the rights afforded by a patent?	19
2.1.2.8.	How long does a patent last?	20
2.1.2.9.	What territory does a South African patent cover?	20
2.1.2.10.	Patent searches	20
2.1.2.11.	Types of patent applications.....	20
2.1.2.12.	Filing of a complete patent application	21
2.1.2.13.	What protection does a provisional patent application provide?.....	21
2.1.2.14.	Does a pending patent application provide any protection against infringers?	21
2.1.2.15.	Does a patent provide any protection against infringement of the patent rights of other persons?	21
2.1.2.16.	Is patent protection worth the cost involved?	22
2.1.2.17.	On what grounds can a patent be revoked?.....	22
2.1.2.18.	Patent licences.....	23
2.1.2.19.	Patent valuations.....	27
2.1.2.20.	Legal insurance.....	27
2.1.3.	<i>Plant breeders' rights</i>	27
2.1.3.1.	What are plant breeders' rights (PBR)?.....	27
2.1.3.2.	What is UPOV?	28
2.1.3.3.	When does a variety qualify for PBR protection?	28
2.1.3.4.	What is the term of a PBR registration?	29
2.1.3.5.	Who can apply for a PBR?	29
2.1.3.6.	What are the rights of the PBR holder?	29
2.1.3.7.	When does one infringe a PBR?	30
2.1.3.8.	Can an applicant enjoy protection whilst his application is pending?	31
2.1.3.9.	What is the effect of provisional protection?	31
2.1.3.10.	Are renewal fees payable?	31
2.1.3.11.	Does the applicant have to submit plant material?	31
2.1.3.12.	Are there any quarantine provisions?.....	32
2.1.4.	<i>Registered designs</i>	32
2.1.4.1.	What is a registered design?.....	32
2.1.4.2.	What rights does the proprietor of a registered design have?	32
2.1.4.3.	What is the difference between aesthetic designs and functional designs?	33
2.1.4.4.	How long does a design registration last?.....	33
2.1.4.5.	Can one file both a patent application and a registered design application?	33
2.1.4.6.	Is design protection worth the cost involved?.....	33
2.1.4.7.	What are the requirements for registrability?.....	34
2.1.4.8.	Which designs cannot be protected?	34
2.1.4.9.	Who may apply for design registration?	35
2.1.4.10.	On what grounds can a design registration be revoked?	35
2.1.5.	<i>Trade marks</i>	36
2.1.5.1.	What is a trade mark?	36
2.1.5.2.	Where is the application for registration filed?.....	36
2.1.5.3.	What is the procedure for applying for the registration of a trade mark?	36
2.1.5.4.	Why is a trade mark application advertised?.....	37
2.1.5.5.	On what grounds can a trade mark application be opposed?	37

2.1.5.6.	What is the procedure for opposing a trade mark Application?	38
2.1.5.7.	Who hears the case?	38
2.1.5.8.	Is there an appeal procedure against the judgment?	38
2.1.5.9.	What rights are acquired on registration of a mark?	39
2.1.5.10.	Are well-known marks protected in South Africa?	39
2.1.5.11.	Can a trade mark be licensed, and what are the different forms of licensing?	39
2.1.5.12.	Should licences be in writing and recorded?	40
2.1.5.13.	Is it possible to buy or sell a trade mark?	40
2.1.5.14.	For how long is a trade mark valid?	41
2.1.5.15.	Does a trade mark registration provide a company or close corporation name protection?	41
2.1.5.16.	How do trade marks relate to domain names?	42
2.1.5.17.	What can I do if an unrelated domain name uses my registered trade mark?	42
2.1.5.18.	When can one use ® and ™?	42
2.1.5.19.	What about protection outside South Africa?	43
2.1.6.	<i>Foreign trade marks</i>	43
2.1.6.1.	International trade mark protection	43
2.1.6.2.	Trade mark protection in Africa	43
2.1.6.3.	Trade mark protection beyond the shores of Africa	48
2.1.7.	<i>Copyright</i>	50
2.1.7.1.	What is copyright?	50
2.1.7.2.	Which works are eligible for copyright protection?	50
2.1.7.3.	When does copyright subsist in a work?	52
2.1.7.4.	What conditions must be met for copyright to subsist in a work?	52
2.1.7.5.	What does it mean if a work is original?	53
2.1.7.6.	Who is a qualified person?	53
2.1.7.7.	Who is the owner of the copyright in a work?	53
2.1.7.8.	Who is the author of a work?	55
2.1.7.9.	Is joint authorship possible?	55
2.1.7.10.	Is joint ownership possible?	56
2.1.7.11.	What are the moral rights of the author?	56
2.1.7.12.	What is the duration of copyright protection?	56
2.1.7.13.	What is copyright infringement?	57
2.1.7.14.	Who can take legal steps in the event of copyright infringement?	58
2.1.7.15.	What remedies are available in the case of copyright infringement?	58
2.1.7.16.	What are the exceptions to copyright infringement?	59
2.1.7.17.	Do only South African works enjoy copyright protection in South Africa?	60
2.1.7.18.	Can copyright be licensed or assigned?	60
2.1.7.19.	Are any formalities required for assignments or licenses?	60
2.1.7.20.	Can copyright in respect of a future work be assignment or licensed?	61
2.1.7.21.	What is a copyright notice and is it necessary?	61
2.1.8.	<i>Trade secrets</i>	61
2.1.9.	<i>Patents v. trade secrets</i>	63
2.1.10.	<i>Domain names</i>	65
2.1.10.1.	What is a domain name?	65
2.1.10.2.	Why should I register a domain name?	65
2.1.10.3.	What is the difference between a domain name and a trade mark?	66
2.1.10.4.	What do gTLD and ccTLD mean?	66
2.1.10.5.	In which TLD should I register my domain name?	67
2.1.10.6.	Who controls registration of domain names?	67
2.1.10.7.	Reservation of domain names	68
2.1.10.8.	Cyber-squatting	68
2.1.10.9.	If I register a domain name, will I then own the name?	68
2.1.11.	<i>Anti-counterfeiting</i>	68
2.1.11.1.	How can I protect my products against counterfeiting in South Africa?	68
2.1.11.2.	Which intellectual property rights are protected under this Act?	69
2.1.11.3.	What is the procedure for laying a complaint against counterfeiters?	69
2.1.11.4.	Which Acts are prohibited in terms of the Counterfeit Goods Act?	6970
2.1.11.5.	What action can be taken once the warrant has been obtained?	70
2.1.11.6.	Preventing seized goods from re-entering the market	71
2.1.11.7.	Can I stop counterfeit goods from being imported into South Africa?	71
2.1.11.8.	Once the goods have been seized is there a possibility that the goods may be returned to the suspect?	72
2.2.	PATENTABILITY OF BIOTECHNOLOGICAL INVENTIONS	72
2.2.1.	<i>Claiming biotechnological inventions</i>	72
2.2.2.	<i>Proposed test of patentability of life sciences inventions in South Africa</i>	74
2.2.3.	<i>Further guidance from Trilateral Project B3B</i>	75
2.2.4.	<i>Method of treatment claims</i>	76

2.2.5.	<i>Second medical use claims</i>	77
2.2.6.	<i>Swiss-type claims</i>	77
2.3.	TYPES OF COSTS ASSOCIATED WITH INTELLECTUAL PROPERTY	78
2.3.1.	<i>Preparation and filing fees</i>	78
2.3.2.	<i>Prosecution costs</i>	78
2.3.3.	<i>Grant/publication/validation fees</i>	78
2.3.4.	<i>Maintenance fees</i>	78
2.3.5.	<i>Enforcement</i>	79
2.4.	INTERNATIONAL IP LAW ASPECTS	79
2.4.1.	<i>Treaties/Conventions</i>	79
2.4.1.1.	Paris Convention	79
2.4.1.2.	Patent Cooperation Treaty (PCT).....	79
2.4.1.3.	Budapest Treaty.....	80
2.4.1.4.	UPOV Convention.....	80
2.4.1.5.	Berne Convention	80
2.4.1.6.	Madrid Protocol	81
2.4.1.7.	TRIPS.....	84
2.4.2.	<i>IP law of selected foreign jurisdictions</i>	85
2.4.2.1.	United States of America (US)	85
2.4.2.2.	Australia (AU).....	87
2.4.2.3.	Japan (JP).....	90
2.4.2.4.	Europe.....	91
2.4.2.5.	GCT.....	95
2.4.3.	<i>IP law of Africa</i>	96
2.4.3.1.	African Regional Intellectual Property Organisation (ARIPO).....	96
2.4.3.2.	Algeria	101
2.4.3.3.	Angola	103
2.4.3.4.	Benin	105
2.4.3.5.	Botswana	105
2.4.3.6.	Burkina Faso	107
2.4.3.7.	Burundi.....	107
2.4.3.8.	Cameroon	109
2.4.3.9.	Cape Verde	109
2.4.3.10.	Central African Republic.....	111
2.4.3.11.	Chad.....	111
2.4.3.12.	Comoros.....	111
2.4.3.13.	Congo, Republic of the.....	112
2.4.3.14.	Congo, Democratic Republic of the (DRC).....	112
2.4.3.15.	Djibouti	114
2.4.3.16.	Egypt.....	115
2.4.3.17.	Equatorial Guinea	118
2.4.3.18.	Eritrea.....	118
2.4.3.19.	Ethiopia	118
2.4.3.20.	Gabon	121
2.4.3.21.	Gambia, The	121
2.4.3.22.	Ghana	123
2.4.3.23.	Guinea.....	125
2.4.3.24.	Guinea-Bissau.....	126
2.4.3.25.	Ivory Coast (Côte d'Ivoire).....	126
2.4.3.26.	Kenya	126
2.4.3.27.	Lesotho	129
2.4.3.28.	Liberia	131
2.4.3.29.	Libya.....	133
2.4.3.30.	Madagascar	134
2.4.3.31.	Malawi	136
2.4.3.32.	Mali	138
2.4.3.33.	Mauritania	138
2.4.3.34.	Mauritius.....	138
2.4.3.35.	Morocco	139
2.4.3.36.	Mozambique.....	142
2.4.3.37.	Namibia	144
2.4.3.38.	Niger.....	145
2.4.3.39.	Nigeria.....	146
2.4.3.40.	Organisation Africaine de la Propriété Intellectuelle (OAPI)	147
2.4.3.41.	Rwanda	150
2.4.3.42.	São Tomé and Príncipe (St Thomas and Prince's Islands)	152
2.4.3.43.	Senegal.....	154

2.4.3.44.	Seychelles.....	154
2.4.3.45.	Somalia	156
2.4.3.46.	Sierra Leone.....	156
2.4.3.47.	St Helena	158
2.4.3.48.	Sudan.....	159
2.4.3.49.	South Sudan	160
2.4.3.50.	Swaziland.....	161
2.4.3.51.	Tanzania	162
2.4.3.52.	Togo	164
2.4.3.53.	Tunisia.....	164
2.4.3.54.	Uganda.....	166
2.4.3.55.	Western Sahara	168
2.4.3.56.	Zambia	169
2.4.3.57.	Zanzibar.....	171
2.4.3.58.	Zimbabwe.....	171
3.	IP SEARCHING	174
3.1.	INTRODUCTION.....	174
3.2.	PATENTS AS AN INFORMATION SOURCE	174
3.2.1.	<i>Why conduct a patent search?</i>	174
3.3.	TYPES OF PATENT SEARCHES	175
3.3.1.	<i>Subject matter search</i>	175
3.3.1.1.	Patentability search.....	175
3.3.1.2.	Validity search.....	176
3.3.1.3.	State of the art search	176
3.3.1.4.	Infringement search	177
3.3.2.	<i>Bibliographic search</i>	177
3.3.2.1.	Name search.....	178
3.3.2.2.	South African equivalent search.....	178
3.3.2.3.	International family search	178
3.3.2.4.	Class search	178
3.4.	PERFORMING SEARCHES	178
3.4.1.	<i>Electronic vs. manual databases</i>	178
3.4.2.	<i>Country coverage</i>	179
3.4.3.	<i>Reliability of information</i>	179
3.4.4.	<i>Limitations</i>	179
3.4.5.	<i>Databases used</i>	180
3.4.5.1.	Derwent.....	181
3.4.5.2.	Inpadoc	181
3.4.5.3.	USPTO.....	181
3.4.5.4.	EPO.....	181
3.5.	PERFORMING A BASIC PRIOR ART SEARCH.....	182
3.5.1.	<i>Accessing a publicly available patent database</i>	182
3.5.2.	<i>Performing a keyword-based search</i>	182
3.5.3.	<i>Cursory evaluation of patent revealed in keyword search</i>	182
3.5.4.	<i>Perusal of patents in detail</i>	183
3.6.	PLANT BREEDERS' RIGHTS SEARCHES.....	183
3.7.	DESIGN SEARCHES	183
3.7.1.	<i>Design novelty search</i>	184
3.7.2.	<i>Design infringement search</i>	184
3.8.	TRADE MARK SEARCHES	184
4.	IP INTERPRETATION	185
4.1.	INTERPRETING A PATENT SPECIFICATION	185
4.1.1.	<i>Requirements for patent specifications</i>	185
4.1.2.	<i>Anatomy of a patent specification</i>	186
4.1.3.	<i>Determining the scope of protection and ascertaining the content of the disclosure</i>	186
4.2.	INTERPRETING PLANT BREEDERS' RIGHTS.....	187
4.3.	INTERPRETING REGISTERED DESIGNS	188
4.4.	INTERPRETING TRADE MARKS	189
4.4.1.	<i>Requirements for trade mark applications</i>	189
4.4.2.	<i>Anatomy of a trade mark application</i>	189
4.4.3.	<i>Determining the scope of protection</i>	190
4.4.3.1.	The Intellectual Property Laws Amendment Act No 28 of 2013	190
5.	CONSIDERATION OF THIRD PARTY IP	191
5.1.	IP MAPPING	191

5.2.	ASCERTAINING THE STATE OF THE ART	193
5.3.	FREEDOM TO OPERATE	193
6.	R&D MANAGEMENT	194
6.1.	OWNERSHIP OF INVENTIONS	194
6.1.1.	<i>Rights of ownership</i>	194
6.1.2.	<i>Employee contracts</i>	194
6.1.3.	<i>Assignments</i>	195
6.2.	IP CAPTURING AND REPORTING PRACTICES	196
6.2.1.	<i>Capturing of IP</i>	196
6.2.2.	<i>Reporting of IP</i>	196
7.	DECISION TO PROTECT	197
7.1.	IS IT WORTH PROTECTING?	197
7.2.	IS IT PROTECTABLE?	198
7.3.	WHICH FORM OF IP TO USE?	198
7.4.	DECISION TO PATENT	198
7.4.1.	<i>Prospects of obtaining a valid patent</i>	198
7.4.2.	<i>Scope of protection obtained</i>	198
7.4.3.	<i>Circumvention of patent</i>	199
7.4.4.	<i>Competitor analysis</i>	199
7.4.5.	<i>Relationship of the patent with other IP</i>	199
7.4.6.	<i>Assessment of commercial potential</i>	200
7.4.7.	<i>Timing of filing patent application</i>	200
7.4.8.	<i>The Golden Year</i>	201
8.	COMMERCIAL EXPLOITATION	202
8.1.	INTELLECTUAL PROPERTY AS AN ASSET	202
8.2.	VALUATION OF INTELLECTUAL PROPERTY	202
8.2.1.	<i>Impact of IP value on transfer pricing</i>	202
8.3.	COMMERCIALISATION MODELS	203
8.3.1.	<i>Exploitation</i>	203
8.3.2.	<i>Assign/Sell IP</i>	203
8.3.3.	<i>Licensing</i>	204
8.3.4.	<i>Joint venture</i>	204
8.4.	LICENSING	204
8.4.1.	<i>Introduction</i>	204
8.4.2.	<i>Types of licences</i>	205
8.4.3.	<i>Reasons for licensing</i>	205
8.4.4.	<i>Risks and reward from the licensor's perspective</i>	205
8.4.5.	<i>Finding the right licensee</i>	205
8.4.6.	<i>Negotiations and payment</i>	206
8.4.7.	<i>The licence agreement</i>	206
8.5.	DUE DILIGENCE	206
8.5.1.	<i>Patents</i>	207
8.5.2.	<i>Copyrights</i>	208
8.5.3.	<i>Trade marks</i>	208
8.5.4.	<i>General IP due diligence issues</i>	208
8.6.	ENFORCING INTELLECTUAL PROPERTY RIGHTS.....	210
8.6.1.	<i>Introduction</i>	210
8.6.2.	<i>The reality of defending IP</i>	210
8.7.	GENERAL CONTRACTUAL PRINCIPLES	210
8.7.1.	<i>Agreements encountered</i>	210
8.7.1.1.	<i>Licensing agreements</i>	210
8.7.1.2.	<i>Joint venture agreements</i>	211
8.7.1.3.	<i>Research and development agreements</i>	211
8.7.1.4.	<i>Assignment / Sale agreements</i>	212
8.7.1.5.	<i>Non-Disclosure / Confidentiality agreements</i>	212
8.7.2.	<i>Legal framework to take cognisance of</i>	212
9.	CONTRACT MANAGEMENT	213
9.1.	INTRODUCTION.....	213
9.2.	CONTRACT MANAGEMENT POLICY	213
9.2.1.	<i>The approval process</i>	213
9.2.2.	<i>Control of documentation</i>	214
9.2.3.	<i>Management of standard documentation / agreements</i>	214
9.2.3.1.	<i>Protecting contracts</i>	214
9.2.3.2.	<i>Amendments</i>	214
9.2.3.3.	<i>Version control</i>	215

9.2.3.4.	Agreement policy manual.....	215
9.2.4.	<i>Management of agreements / documentation provided to third parties.....</i>	215
9.2.5.	<i>Management of completed agreements.....</i>	216
9.3.	IMPLEMENTING A CONTRACT MANAGEMENT POLICY.....	216
9.4.	RESEARCH MANAGEMENT / AGREEMENTS.....	217
9.4.1.	<i>Legally binding agreements.....</i>	217
9.4.1.1.	Trade marks.....	217
9.4.1.2.	Copyright.....	217
9.4.1.3.	Patents.....	217
9.4.1.4.	Designs.....	218
9.4.2.	<i>Care when entering into agreement with an individual such as an Inventor.....</i>	218
9.4.3.	<i>Need for caution when signing any agreement.....</i>	218
9.4.4.	<i>Entering into other agreements concerning IP.....</i>	218
10.	DISCLAIMER.....	218

1. INTRODUCTION

1.1. PURPOSE OF MANUAL

This manual is designed to provide a practical introduction to the nature, identification, protection and management of intellectual property rights with a particular focus on AFRICA and extensively on SOUTH AFRICA. It is intended to contribute material for use in training courses, to assist in raising awareness of some of the complex issues that surround the protection and management of intellectual property and to assist in the development of practical skills.

The manual does not seek to provide legal, managerial or technical advice on intellectual property law. It should in no way be considered a substitute for expert legal, technical and managerial advice. A user of this manual is advised to seek qualified professional advice on any aspect of intellectual property law and management, and should not rely solely on this manual.

The manual is divided into nine main chapters, which outline aspects of the IP management process from conception of an idea through to its protection and subsequent successful commercialisation.

1.2. WHY PROTECT AND MANAGE INTELLECTUAL PROPERTY?

1.2.1. Corporate perspective

Awareness concerning intellectual property rights is an increasingly important issue for researches and business entities. All businesses possess intellectual property (IP), regardless of their size or sector. This could be in the form of the name of one's business, copyright, designs, patents and trade marks. The value of IP is contingent upon the mode and efficacy of its utilization/commercialisation. Adopting a systematic approach to the effective use and commercialisation of IP will ensure good returns on the investment in the IP assets.

1.2.1.1. Commercial incentive

Intellectual property is a valuable asset and thus securing and protecting it is essential to the business' future success. Accordingly, it is vital that one understands one's rights and how the law can help the IP owner.

IP can, *inter alia*:

- set one's business apart from competitors;
- be sold or licensed, forming an important revenue stream;
- offer customers something new and different; and
- form an essential part of your marketing or branding.

To exploit IP to its full potential, it makes strong business sense to do all one can to secure it, following which one can then, *inter alia*:

- protect it against infringement by others and ultimately defend in the courts one's sole right to make, use, sell or import it;
- stop others making, using, selling or importing it without permission;
- earn royalties by licensing it;
- exploit it through strategic alliances; and
- generating income by selling it.

This manual also explains the importance of conducting an audit of a business' IP. It sets out the different kinds of legal protection available for IP and explains the options available in order to ensure the protection and management of IP rights.

It is essential that public and private sector researchers and technology managers have access to capabilities for managing IP and negotiating commercial arrangements. A long-held concern has been that South Africa has not derived adequate benefit from commercialisation of its research in the past and that South African IP has been, too frequently, sold or licensed for commercialisation overseas, sometimes unnecessarily. Further, in cases where overseas commercialisation is appropriate, it has been claimed that South Africa has not always obtained the maximum possible benefit.

Consequently, the answer to the question "Why protect and manage intellectual property?" is self-evident. Intellectual property protection provides an incentive for innovation, and without it industry would be unwilling to invest time and money in research and development (R&D). There is also a strong argument that, the exclusivity associated with IP protection, provides a commercial incentive to invest in research and development resulting in benefits to the wider community through the products developed as a result of that incentive; benefits which may not be so forthcoming without the underlying profit motivation afforded by IP protection.

To obtain commercial returns from IP, certain conditions must exist. These include:

- The existence of a customer or the ability to create customers; and
- An entity controlling the manufacture and sale of the resulting products.

Usually, commercialization will begin on a local scale, assuming that there is a local market for the IP. Having assessed the market, a reasonable assessment of possible strategies for entering the market needs to be made. Part of this assessment involves consideration of the levels of investment that will be required, and over what time period, for successful commercialization of the IP. At this point, an entity can form a tentative view of whether it may be feasible to commercialize the IP itself, or whether possible licensees or potential purchasers of the IP should be identified and approached.

Factors that should assist in focusing an entity on commercializing their IP/innovations include:

- A technological development should always be assessed in terms of the market or its commercial merit;
- It should be ensured that there is a person within the entity who manages the IP portfolio and its commercialization and that person is the right person to do so: they are trained to assess target markets, competition within those markets etc.;
- Concentration on IP creation and protection should be balanced by a similar concentration on commercialization of the IP; and
- Innovation and technological R&D should not be undertaken in isolation from the commercial market realities. Therefore, market considerations should be introduced very early in the IP commercialization strategy.

The IP of an entity, whether it be patents, designs, trade marks or other forms of IP, typically represents a large investment from which the entity and its stakeholders expect a return. Consequently, a crucial stage in the innovation process can be seen as the transforming of an invention into a marketable product so that it begins to generate revenue and, eventually, profits.

The revenue generated can then be applied for further R&D or to fuel a sustainable R&D cycle as is shown in paragraph 1.2.1.2.

1.2.1.2. Sustainable intellectual property cycle

Benefit

Funds to reinvest into R&D.
Benefit sharing with inventors



Invent

Create services, ideas, technology, know-how and expertise



Sustainable R&D Cycle



Application

Commercialize
Licence / sell
Generate income



Protection

Protect IP rights
Manage and protect trade secrets
Enforce IP

1.2.2. Individual perspective

Benefits that are derived from IP are however not limited to the economic sphere. Often the greatest reward for inventors and/or researchers is the academic acknowledgement that they obtain through publication and other forms of recognition. It is of utmost important to understand that IP and recognition are not mutually exclusive – in fact, publication in the form of citation as an inventor in a patent application is nowadays a very important publication vehicle. Also, recognition as an IP generator and/or innovator can be used as a very efficient benchmark of the professional performance of an individual, and can therefore also form a key part of incentivised R&D.

2. INTELLECTUAL PROPERTY

2.1. TYPES OF INTELLECTUAL PROPERTY

2.1.1. What is intellectual property?

Intellectual property, very broadly, means the legal rights that result from intellectual activity in the industrial, scientific, literary and artistic fields. Countries have laws to protect intellectual property for two main reasons. One is to give statutory expression to the moral and economic rights of creators in their creations and the rights of the public in access to those creations. The second is to promote, as a deliberate act of Government policy, creativity and the dissemination and application of its results and to encourage fair-trading that would contribute to economic and social development.

IP is the tangible representation of intellect and creativity and is represented in the form of patents, trade marks, registered designs, copyright, circuit layouts, geographical indications, plant breeder's rights and trade secrets.

Generally speaking, intellectual property law aims at safeguarding creators and other producers of intellectual goods and services by granting them certain time-limited rights to control the use made of the productions of those goods and services. These rights do not apply to the physical object in which the creation may be embodied but instead to the intellectual creation as such.

The rights embodied within these representations provide the creator with the ability to prevent others from infringing or using or developing the IP of the creator.

2.1.2. Patents

2.1.2.1. What is a patent?

A patent is an exclusive right or monopoly granted by the state, to a person, persons or legal entity, for the right to exclude third parties from exploiting a patented invention for a limited period in a specific territory.

Patents are territorial and have to be applied for in every country where patent protection is required.

A patent application does not, however, have to be filed immediately in each country where an inventor or applicant requires patent protection. There are

international conventions and treaties that allow applicants for patents to file one patent application in one country only and after a certain time, to file corresponding applications in other convention countries. Various patent procedures are explained further below.

2.1.2.2. What is a patentable invention?

An invention, (which may include an article, an apparatus, a product, a device, a process, or a method) is patentable, if it is new, inventive and useful. These three requirements are dealt with in more detail below.

2.1.2.2.1. *Novelty*

An invention is new if it does not form part of the “state of the art”. The “state of the art” comprises all matter (the “prior art”), which has been made available to the public anywhere in the world, in any way, before the date of filing a patent application for the invention. In other words, an invention, which is known to the public anywhere in the world, is not patentable, as the invention is not regarded as new. Inventors should, for this reason, keep their inventions secret until they file patent applications for such inventions.

As stated above, the prior art or state of the art comprises “all matter which has been made available to the public”. This means that any publication, including marketing material or use or any other disclosure of an invention falls within this provision.

In South Africa, as in most other countries, the state of the art also consists of prior patent applications (“pending patents”), filed in South Africa, despite the fact that such prior applications were not open to public inspection and not known to the public at the time of filing a first patent application for an invention. Also included as part of the state of the art, are later patent applications claiming an earlier priority date from an application for a patent filed in a convention country. The priority date of a patent or patent application is the date on which a first patent application for an invention is filed. It is thus important to file a patent application for an invention as soon as possible after the invention is made as a prior patent application or a patent application claiming an earlier priority date forms part of the state of the art in accordance with the South African Patents Act No. 57 of 1978 (“the Act”).

Searches can be conducted to establish whether an invention is new. However, the cost of a search may not always be justified, and, in some cases, a patent application is filed subject to the risk of the invention to which it relates not being new. Searches and patent applications are dealt with in further detail below.

An invention used secretly and on a commercial scale, in the Republic of South Africa, also forms part of the state of the art. An example of such an invention is where an inventor commercially, but secretly, uses new or special tools in an industry. The tools themselves would not be patentable once they are used on a commercial scale even if they are not disclosed to third parties. Third parties can also not obtain a valid patent for the tools after such secret commercial use, as the tools form part of the state of the art.

2.1.2.2.2. *Inventiveness (“non-obviousness”)*

An invention involves an inventive step if it is not obvious to a person skilled in the art, having regard to any matter which was available to the public, anywhere in the world, immediately before the date of filing (priority date) of a patent application for the invention.

The Act does not require a quantitative test for inventiveness but rather a qualitative test. The only thing required is that the invention must not be obvious to an ordinary person skilled in the art having regard to all matter, available to the public, immediately before the date on which a first patent application for the invention was filed. The “quantity” of inventiveness is not in issue. Also, the skilled person is a person with ordinary skill in the art and not a specialist or highly qualified person in the art. Specialist doctors would be “ordinary people skilled in their art.” However, some specialist doctors may have additional qualifications such that they will not be regarded “ordinary people skilled in the art”.

2.1.2.2.3. *Usefulness*

The Act states that a patentable invention must be capable of being used or applied in trade or industry or agriculture. The Act also states that a patent may be revoked where the invention, as illustrated or exemplified in the patent specification (patent specifications are dealt with below) cannot be performed or does not lead to the results and advantages set out in the patent specification.

A patentable invention must thus be “useful”. To be useful, the invention must be workable in trade, industry or agriculture. The invention must also lead to the results and advantages set out in the patent specification.

The invention does not have to be a commercial success. The commercial success of the invention may, however, indicate that an invention is in fact useful.

2.1.2.3. What is not patentable?

The Act states that anything which consists of:

- a discovery;
- a scientific theory;
- a mathematical method;
- a literary, dramatic, musical or artistic work or any other aesthetic creation;
- a scheme, rule or method for performing a mental act, playing a game or doing business;
- a program for a computer; or
- the presentation of information;

shall not be an invention for the purposes of the Act.

It is important to remember that only the above items as such are not patentable. For example, the presentation of information is not patentable, but a method of presenting information or an article that presents information may be patentable if such a method or article is new, inventive and useful.

A computer program itself is also not patentable, but a method or system that utilizes a computer program to provide a certain result may be patentable. A computer with a particular program in its memory may also be patentable.

Internationally there have been some changes in the approach towards the patentability of business methods and computer programs. In some countries, methods of doing business and computer programs may be patentable. We suggest that you seek our advice should you have any questions in this regard.

A patent will also not be granted for an invention, the publication or exploitation of which would be generally expected to encourage offensive or immoral behaviour.

2.1.2.4. Special patentability provisions

2.1.2.4.1. *Animals, plants and biological processes*

A patent cannot be obtained for any variety of animal or plant or any essentially biological process for the production of animals or plants, not being a microbiological process or the product of such a process.

The product of a microbiological process as well as the process itself may be patentable. Such processes and products are found, for example, in the manufacture of antibiotic medicines. Again, the process and/or product must be new, inventive and useful to be patentable.

2.1.2.4.2. *Treatment of the human or animal body*

A method of treatment of the human or animal body by surgery or therapy or by diagnosis practiced on the human or animal body is not patentable. There is some uncertainty as to whether preventative treatment of the human or animal body is patentable or not. In most cases it would depend on the specific invention.

Treatment of the human or animal body for example, to promote growth, could be patentable if such treatment is not done by surgery, therapy or diagnosis.

The treatment of body tissues or bodily fluids separate from the human or animal body could also be patentable.

A product consisting of a substance or composition for use in a method of treatment of the human or animal body is patentable provided the substance or composition is new, inventive and useful.

2.1.2.4.3. *New medical use of a known substance or composition*

In the case of an invention consisting of a substance or composition for use in a method of treatment of the human or animal body by surgery or therapy or by diagnosis practiced on the human or animal body, the fact that the substance or composition forms part of the state of the art, does not prevent a patent being granted for the invention, if the use of the substance or composition in any such method does not form part of the state of the art at that date.

In other words, a new medical use of an old substance or composition is patentable. Such “medical use” must be new, inventive and useful.

2.1.2.5. Foreign patent applications

A South African provisional patent application or complete patent application in the first instance provides the applicant with an option to apply for patents in most other countries of the world under the provisions of an international convention. This option must, however, be exercised within 12 months of the filing date of the provisional patent application in South Africa. This 12 month period cannot be extended.

The option does not, however, extend to all countries in the world. For example Taiwan and Namibia are not included.

There are various ways of obtaining foreign patent protection. For example, regional patent applications can be filed in Europe, Africa and certain eastern countries. A regional patent application is examined by the relevant regional authorities. Patents are generally not granted on regional applications. Regional applications provide additional time before applications (national applications) have to be filed in the chosen countries of a region where patent protection is sought. Regional applications are examined by the relevant regional authorities and these examinations provide some indication of the patentability of the invention and the prospects of obtaining patents in the countries of a region. Examination reports issued during the term of a regional application can reduce prosecution costs in the countries of that region.

Another type of “regional” application is a Patent Co-operation Treaty (PCT) patent application. At present there are just over a hundred PCT member states throughout the world. A PCT patent application can be filed in the first instance or within 12 months from filing a first patent application for an invention. Again, patents are not granted by the PCT. National patent applications based on a PCT application have to be filed in all PCT member countries or regions where patent protection is required. An advantage of a PCT patent application is that national applications can be filed up to 30 months from filing a first patent application for an invention. This postpones the filing costs of national applications in all countries where patent protection is required. Other advantages are that searches are conducted and opinions are provided on the patentability of the invention in light of the prior art located during the searches.

It can be a complex and costly exercise to obtain patents in foreign countries. We accordingly recommend that clients discuss these matters with us should they be interested in obtaining patent protection in foreign countries.

2.1.2.6. Who can apply for a patent?

It is only the inventor himself who can apply for a patent or any other person or entity who has acquired the right to apply from the inventor. A patent may be applied for jointly by the inventor and/or such other person/s.

A patent application may thus be filed in the name of a legal entity such as a company that has acquired the right to apply for a patent from the inventor. A patent application can also be filed in the name of two or more persons and/or entities as co-applicants.

2.1.2.7. What are the rights afforded by a patent?

The effect of a patent is to grant to the patentee in the Republic for the duration of the patent, the right to exclude other persons from:

- (a) making;
- (b) using;
- (c) exercising;
- (d) disposing or offering to dispose of; or
- (e) importing the invention, so that he or she will have and enjoy the whole profit and advantage acquired by reason of the invention.

Once the application has been filed, a filing or effective date (priority date) is established. Novelty is only considered up to this date. The invention may then be disclosed to others without fear of destroying the novelty of the invention.

The filing of a patent application does not give the patentee the right to manufacture or apply the invention. Remember that there may be earlier patent rights covering the invention. This can only be determined by conducting a patent search.

The grant of a patent does not allow the patentee immediately to stop an infringer by way of court proceedings. Such proceedings may only be instituted after nine months from the date of grant (or sealing) of the patent. However, if a good cause exists to start proceedings earlier, the Commissioner of Patents may be approached for leave to do so.

2.1.2.8. How long does a patent last?

A patent lasts for a maximum period of 20 years from the date of filing of the complete application (or from the international filing date in the case of South African national phase patent application emanating from a PCT application), provided it is kept in force by payment of the necessary renewal fees. The 20-year term cannot be extended.

2.1.2.9. What territory does a South African patent cover?

A South African patent covers only the territory of the Republic of South Africa. Separate patent applications must be filed in every other country in which patent protection is required.

2.1.2.10. Patent searches

Many inventors or applicants file patent applications without conducting searches. Such applications are thus filed subject to the risk of an invention not being patentable.

If it later turns out that the invention is in fact not patentable, the patent specification may be amended so that it will claim a patentable invention or a patentable feature of the invention. If it is not possible to amend the specification in this way, the application would have to be abandoned.

Although they are not conclusive, patentability searches may provide a good idea of the patentability or otherwise of an invention.

Infringement searches may also be required prior to entering the market with a product or process to ensure that one cannot be interdicted from infringing the patent rights of a third party.

2.1.2.11. Types of patent applications

An application for a patent is made by filing a provisional patent application or a complete patent application. Patent applications are filed with patent specifications. It is generally recommended that a provisional patent application be filed first. Once a provisional patent application has been filed, the inventor or applicant can commence with the exploitation of the invention. If the invention appears to be commercially viable, a complete patent application should then be filed in order to obtain a patent. Patents are not granted on provisional patent

applications. A complete patent application in the first instance can be filed where it is a certainty that the invention is in its final form. This is, however, rarely the case and it may be a disadvantage to file a complete patent application in the first instance.

2.1.2.12. Filing of a complete patent application

A complete patent application must be filed within 12 months of the filing date of a provisional patent application. The provisional application will lapse if a complete application is not filed within the 12 month period. However, where patent protection is sought in South Africa only, a complete patent application can be filed up to 15 months from the date of filing a South African provisional application.

2.1.2.13. What protection does a provisional patent application provide?

The filing of a first patent application for an invention in the form of a provisional patent application or a complete application in the first instance establishes a priority date for the application and subsequent patents granted on such application. A disclosure of the invention to the public before the priority date by the inventor or by any other person from any source will invalidate the application. The novelty and inventiveness of an invention claimed in a patent is tested against prior art available immediately before its priority date.

An applicant may disclose the invention freely to other persons once the first application has been filed. This is, however, not always recommended and may depend on the planned commercialisation of the invention. The filing of a provisional patent application gives the applicant the opportunity of finalizing the technical details of the invention and testing its commercial prospects before a decision is made on the filing of a complete application.

2.1.2.14. Does a pending patent application provide any protection against infringers?

The filing of a provisional or complete application does not give the applicant any enforceable rights against infringers. Enforceable rights against infringers are only obtained upon grant of a patent.

2.1.2.15. Does a patent provide any protection against infringement of the patent rights of other persons?

It is important to note that filing a provisional or complete application does not protect the application against the consequences of infringement of any existing patent rights of other persons. Similarly, the grant of a patent does not protect the patentee against the consequences of infringement of any patent rights of other persons. It is the exploitation of a product that may give rise to infringement of the patents of others. The fact that a patent has been granted or that patent applications for the invention or product have been filed is irrelevant.

We recommend that before the exploitation of an invention commences, an infringement search be conducted to ascertain whether exploitation of the invention might infringe existing patent rights of other persons. This is especially important where large amounts will be expended on the exploitation of a product that might already be patented by others.

2.1.2.16. Is patent protection worth the cost involved?

This will depend on the commercial value of the invention and it should accordingly be considered whether the expected commercial profit and advantage that can be derived from the invention will justify the cost of applying for patent protection.

Obviously, there is little point in incurring the cost of applying for a patent if exploitation of the invention is unlikely to yield a reasonable profit. If, on the other hand, an invention has the potential for commercial success a patent application should be filed timeously to protect the invention.

Where a substantial research and development program is involved, the cost of applying for patent protection may be compared with the cost of the program to assist in deciding whether or not a patent application should be filed.

2.1.2.17. On what grounds can a patent be revoked?

It is not within the scope of this manual to deal with revocation in detail, but it must be mentioned that a patent can be revoked on the grounds, amongst others, that the invention was not new at the priority date of the patent for the invention and/or the invention does not involve an inventive step and/or the invention cannot be applied in trade or industry or agriculture.

The novelty of an invention can be destroyed by the actions of the applicant, patentee or inventor by having made the invention available to the public before

the priority date of the patent. Novelty can also be destroyed by a disclosure of the invention to the public by an independent third party anywhere in the world before the priority date of the patent.

A patent can also be revoked on certain formal grounds relating to the manner in which the complete specification and claims are prepared and to the information disclosed in the specification. The preparation of a patent specification is a skilled task and it is essential that there is close co-operation between the inventor and his patent attorney and that the inventor provides the patent attorney with full and clear information on all aspects of the invention.

2.1.2.18. Patent licences

When a licence is granted over a patent, the effect is to give the licensee a right to do what he/she would otherwise be prohibited from doing, i.e. a licence makes lawful what otherwise would be unlawful.

A licence may be exclusive, sole or non-exclusive.

An exclusive licence permits only the licensee and persons authorised by the licensee to exploit the invention and therefore exclude all other persons from doing so, including the patentee.

A sole licence permits the patentee to work the patent but prevents the grant of additional licences as opposed to an exclusive licence that excludes the patentee from exploiting the patented invention.

A non-exclusive licence allows the patentee to retain the right to exploit the licensed property as well as the right to grant additional licences to third parties.

2.1.2.18.1. *Compulsory licenses*

A first patent, which may be referred to as the main patent, may cover claims for an invention, which allow for further inventive developments to take place. Such an inventive development may be covered by way of a subsequent dependent patent of which the patentee is different to the patentee of the main patent.

The situation therefore arises that the dependent patentee cannot apply his invention for which he has validly obtained patent rights, because infringement of the main patent would then take place. On the other hand the patentee of the main

patent cannot apply the invention as covered by the dependent patent because there with an infringement of the dependent patent would arise.

This is a stalemate situation, which often leads to negotiations between the parties and results in the grant of cross-licences.

However, if an agreement cannot be reached, Section 55 of the Patents Act provides relief. Section 55 provides that the dependent patentee can apply to the commissioner for a licence under the main patent. The commissioner then may grant the licence on such terms and conditions as he may impose but including a condition that the licence shall be used only for the purpose of permitting the dependent patent to be worked and for no other purpose.

This means that the dependent patentee, when obtaining such a licence, cannot under that licence apply the invention as covered by the main patent as such. In all cases the invention of the dependent patent would have to be applied.

The commissioner also would not grant such a licence unless:

- (1) The invention as claimed in the dependent patent involves an important technical advance of considerable economic significance in relation to the invention as claimed in the main patent. This means that an unimportant or simple variation as covered by the dependent patent would not necessarily facilitate the grant of such a licence.
- (2) The patentee of the dependent patent must also grant to the proprietor of the main patent under reasonable terms a cross-licence to allow the patentee of the main patent to use the invention claimed in the dependent patent.
- (3) The use authorised in respect of the main patent cannot be assigned except with the assignment of the dependent patent. In other words, the licence is linked to the dependent patent.

In addition to the grant of a compulsory licence in the case of a dependent patent, the Patents Act provides for the grant of a compulsory licence under certain circumstances where the rights in a patent are being abused. In such cases a compulsory licence is provided for on application to the Commissioner of Patents.

The Act defines four situations when compulsory licences may be granted. These are the following:

- (1) **Non-working:** If the patented invention is not being worked in the Republic on a commercial scale or to an adequate extent after the expiry of a period of four years subsequent to the filing of the application of the patent or three years subsequent to the date on which that patent was sealed, whichever period expires last. In the opinion of the Commissioner there must be no satisfactory reason for such non-working;
- (2) **Demand not met:** If the demand for the patented article in the Republic is not being met to an adequate extent and on reasonable terms;
- (3) **Public interest:** If, by reason of the refusal of the patentee to grant a licence or licences on reasonable terms the trade or industry or agriculture of the Republic or the trade of any person or class of persons trading in the Republic or the establishment of a new trade or industry in the Republic is being prejudiced. It must be in the public interest that a licence or licences should be granted; and
- (4) **Demand met by importation:** If the demand in the Republic for the patented article is being met by importation and the price charged by the patentee, his licensee or agent for the patented article is excessive in relation to the price charged therefore in countries where the patented article is manufactured by or under licence from the patentee or his predecessor or successor in title.

The first situation (non-working) has an object to force the patentee of a patent to work his invention in South Africa within a period of three or four years as defined. The intention of the patentee could have been not to obtain a patent so as to apply the invention but merely to prevent other parties from applying the invention in question.

The second situation (demand not met) arises when there is a demand in South Africa for the patented article and yet this demand is not being met to an adequate extent and on reasonable terms. Such a situation would apply in particular in the case of pharmaceuticals where there is a critical demand for the particular pharmaceutical and yet unsatisfactory quantities are being supplied to South Africa and unreasonable prices are being charged.

The third reason (public interest) is to protect the trade or industry or agriculture in South Africa or the establishment of any new trade or industry in South Africa. In other words, if the patentee by way of his particular patent rights, prevents the invention in question from being applied in South Africa and thereby resulting in a

disadvantage to the trade or industry or agriculture or any trade of any person or class of persons in South Africa.

Finally, the fourth situation (demand met by importation) relates to the situation where a particular article is manufactured in a low cost country, such as India or China, and yet the article is then exported to South Africa and sold for a price which is based on cost calculations for producing such an article in high cost countries, such as European countries or the USA.

In any such application to the Commissioner of Patents, the patentee or any other person appearing from the register to be interested in the patent may oppose the application.

Aspects that the Commissioner has to bear in mind when considering such an application for the grant of a compulsory licence are the following:

- The Commissioner must consider the application on its merits;
- He may order the grant to the applicant of a licence on such terms and conditions as he may deem fit including a condition precluding the licensee from importing any patented article into the Republic;
- If the Commissioner is not satisfied that the grant of a licence is justified he may refuse the application;
- A licence granted by the Commissioner must include a provision that, subject to the adequate protection of the legitimate interests of the licensee, the licence, on application by the patentee, may be terminated if the circumstances, which led to the grant of the licence, cease to exist and if in the Commissioner's opinion they are unlikely to recur;
- The licence shall be non-exclusive;
- The licence is not transferable except to a person to whom the business or part of the business in connection with which the rights under licence was exercised, has been transferred.

2.1.2.18.2. *Cross-licences*

A cross-licence is an agreement according to which two parties grant a licence to each other for the exploitation of the subject matter claimed in patents. Thus, cross-licensing is the mutual sharing of patents between companies without an

exchange of a licence fee if both patent portfolios are of equal value. Large corporations like Microsoft use this method to accumulate licences for technology developed by other companies. For example, if Sony owns a patent of interest to IBM, and IBM owns a patent of interest to Sony, Sony may grant a licence to IBM for the Sony patent while at the same time IBM grants a licence to Sony for the IBM patent. Then Sony and IBM will have concluded a cross-licensing agreement, in this hypothetical example. This means each company can make, use, and sell products claimed in each other's licensed patents and that will not constitute infringement.

If a third party, let's call it InfringerCorp, infringes the Sony patent, Sony can sue InfringerCorp for infringement. In accordance with our patent law, IBM can become a party to the court proceedings and also claim damages from InfringerCorp.

2.1.2.19. Patent valuations

Patents are assets to which a monetary value can be attached. Clients should seek our advice where intellectual property and patent valuations are required. The valuation of intellectual property is a specialized task and may be a valuable exercise when investments are required or a company or a business is valued for the sale thereof.

2.1.2.20. Legal insurance

Intellectual property legal insurance can be obtained for patents, registered or unregistered designs and trade marks. Patent legal insurance companies provide insurance for both the defence and pursuit of an infringement matter.

2.1.3. Plant breeders' rights

2.1.3.1. What are plant breeders' rights (PBR)?

New plant varieties are protected in South Africa in terms of the Plant Breeders' Rights (PBR) Act No 15 of 1976. South Africa does not have, as opposed to the USA, a "plant patent" system, as the Patents Act 57 of 1978 states that a patent shall not be granted for any variety of plant. New plant varieties are therefore protected exclusively in terms of the PBR Act. However, genetically modified plants could be subject matter under the Patents Act, as they are not strictly "new varieties" of plants.

2.1.3.2. What is UPOV?

The International Union for the Protection of New Varieties of Plants (UPOV) is an intergovernmental organization based in Geneva, Switzerland. UPOV was established by the International Convention for the Protection of New Varieties of Plants, which was adopted in Paris in 1961 and later revised in 1978 and 1991. The objective of the Convention is to provide and promote an effective system of plant variety protection, with the aim of encouraging the development of new varieties of plants, for the benefit of society. For more information about UPOV and its member, please visit: www.upov.org.

South Africa is a signatory of the 1978 Act of the UPOV Convention and the PBR Act was promulgated as a result of the implementation of UPOV. In terms of the UPOV convention, member countries grant the same rights to persons of foreign member countries as they grant to their own. UPOV also regulates the right to claim priority from an application filed in another member country. This simply means that a PBR application in a UPOV member country could form the basis for a PBR application in another UPOV member country, for the same variety, filed within 1 year.

2.1.3.3. When does a variety qualify for PBR protection?

In order to qualify for PBR protection, a variety has to be new, distinct, uniform and stable. A variety is considered to be:

New if propagating material or harvested material thereof has not been sold or otherwise disposed of by, or with the consent of, the breeder for purposes of exploitation of the variety within certain time limits. If the variety has been disposed of in this fashion in South Africa, more than a year before the date of the filing of the application, it is no longer new. In the case of applicants from other UPOV countries, applications for the registration of vines and trees, have to be made within six years, or, in the case of other varieties, within four years from the date of first sale or other disposal in such UPOV country for the variety to be new. The definition of “sell” in the Act includes - agree to sell, or to offer, advertise, keep, expose, transmit, send, convey or deliver for sale, or to exchange or to dispose of to any person in any manner for a consideration; and “sold” and “sale” have a corresponding meaning. Thus, a mere agreement to sell propagating material or harvested material, as opposed to the actual sale thereof can destroy the novelty

of a variety, as an “agreement to sell” is also included in the definition and deemed to be the same as “sell”.

Distinct if, at the date of filing of the application for a PBR in South Africa, it is clearly distinguishable from any other variety of the same kind of plant of which the existence on that date is a matter of common knowledge;

Uniform if, subject to the variation that may be expected from the particular features of the propagation thereof, it is sufficiently uniform with regard to the characteristics of the variety in question; and

Stable if the characteristics thereof remain unchanged after repeated propagation or, in the case of a particular cycle of propagation, at the end of each such cycle.

2.1.3.4. What is the term of a PBR registration?

A PBR is granted for a period of 25 years, in the case of vines and trees; and 20 years, in all other cases, calculated from the date on which the certificate of registration is issued.

2.1.3.5. Who can apply for a PBR?

An application for the grant of a PBR can be made by the breeder thereof. A “breeder” is defined as the person who bred, or discovered and developed the variety. If a variety was bred in the course and scope of the breeder’s employment the employer is regarded as being the breeder.

An application for a PBR can only be made by a person who is a citizen of, or is domiciled in, South Africa or a UPOV country. In the case of a juristic person, it must have a registered office in South Africa or in a UPOV country.

2.1.3.6. What are the rights of the PBR holder?

In the absence of licence agreements, the PBR holder has the exclusive right to undertake the:

- (a) production or reproduction (multiplication);
- (b) conditioning for the purpose of propagation;
- (c) sale or any other form of marketing;
- (d) exporting;

- (e) importing; or
- (f) stocking for any of these purposes, of propagating material of the relevant variety; or harvested material, including plants, which was obtained through the unauthorised use of propagating material of the relevant variety.

However, a person who procures any propagating material of a variety in a legitimate manner will not infringe the PBR in respect of the variety if he resells that propagating material, or sells any plant, reproductive material or product derived from that propagating material for purposes other than the further propagation or multiplication thereof. The same applies to use or multiplication of that propagating material in the development of a different variety use for purposes of *bona fide* research and use of that propagating material for private or non-commercial purposes. The Act also allows a farmer, who procured propagating material legitimately, to retain and replant seed on the same land, but only for one season and the right is limited to the particular farmer.

2.1.3.7. When does one infringe a PBR?

A PBR is infringed by any person who, not being the holder of the PBR, performs, or causes to be performed without a licence the following acts:

- (a) production or reproduction (multiplication);
- (b) conditioning for the purpose of propagation;
- (c) sale or any other form of marketing;
- (d) exporting;
- (e) importing;
- (f) stocking for any of the purposes referred to in paragraphs (a) to (e),
of-

- (i) propagating material of the relevant variety; or
- (ii) harvested material, including plants, which was obtained through the unauthorised use of propagating material of the relevant variety.

A licensee that fails to comply with any term or condition of a licence also infringes the PBR. It is also an infringement to use the approved denomination of a protected variety in relation to plants or propagating material of any other variety for any purpose whatsoever or to sell plants or propagating material of a protected

variety under any other denomination than the approved denomination of that variety.

2.1.3.8. Can an applicant enjoy protection whilst his application is pending?

Whilst an application is pending the registrar can issue a protective direction to the applicant. Such protective direction will only be issued if:

- (a) the registrar is satisfied that the information, facilities and material he requires to enable him to consider the application for the grant of a PBR, have been furnished to him; and
- (b) the applicant has given a written undertaking to the registrar that he will not, while the protective direction is in force, sell or consent to sell any reproductive material of the variety in question in South Africa. However, the holder of a protective direction is, notwithstanding an undertaking, entitled to sell or offer for sale reproductive material of the variety in question for the purposes of multiplication or testing, as well as harvested material not being reproductive material. All the reproductive material produced, directly or indirectly, during such multiplication or testing, as well as any unused reproductive material, will remain the property of the holder of the protective direction.

2.1.3.9. What is the effect of provisional protection?

While a protective direction is in force, the variety in respect of which it was issued will be protected as if a PBR had been granted in respect thereof, and anything that would constitute an infringement of a PBR or would be actionable in proceedings by the holder of such right, will, if it is done with reference to a variety so protected, be actionable.

2.1.3.10. Are renewal fees payable?

Renewal fees are payable annually, with the first such fee being payable on or before 1 January of the year following the date on which a PBR is granted, and any subsequent annual fee shall be paid before 1 January of each year. An extension of time of 6 months for the late filing of the renewal fees is available on application and on paying an additional fee.

2.1.3.11. Does the applicant have to submit plant material?

Plant material of the varieties in issue has to be accessible to officers of the Department of Agriculture for evaluation within 1 year of the filing of the application. However, an extension of time is available on request.

2.1.3.12. Are there any quarantine provisions?

When importing plant material into South Africa, strict compliance with quarantine provisions is required. The period of quarantine depends on the time of year and season when the plant material is received and whether or not a phytosanitary certificate accompanies the plant material. Should the plant material be imported during, say July of one year, together with a phytosanitary certificate, it could be released after one season during March the following year, for example. However, if no phytosanitary certificate accompanies the plant material, it would have to be cultivated through two seasons.

2.1.4. Registered designs

2.1.4.1. What is a registered design?

In terms of the Designs Act No. 195 of 1993, a registered design entitles the proprietor of the registered design to a monopoly in South Africa in that design for a limited period of time. The protection is aimed at the appearance of a product embodying the design, and is therefore not aimed at protecting an underlying concept.

2.1.4.2. What rights does the proprietor of a registered design have?

A registered design entitles the proprietor to exclude others from:

- (a) making;
- (b) importing;
- (c) using; or
- (d) disposing

of any article included in the class in which the design is registered, and embodying the registered design or a design not substantially different from the registered design in South Africa.

The proprietor is thus granted a monopoly in the design enabling him to have and enjoy the whole profit and advantage accruing by reason of the registration of the design.

A design registration is an asset that can be bought or sold, or in respect of which licences may be granted.

The proprietor of a design registration is entitled to institute legal proceedings against an infringer for an interdict to prevent further infringement of the registration, surrender of any infringing product and for damages suffered by the proprietor as a result of infringement.

2.1.4.3. What is the difference between aesthetic designs and functional designs?

An aesthetic design involves the pattern, shape, configuration or ornamentation applied to an article, having features that appeal to, and are judged, solely by the eye. A design does not have to be subjectively appealing to qualify for protection as an aesthetic design.

A functional design, on the other hand, involves the pattern, shape or configuration of an article, having features that are necessitated by the function the article is to perform. A functional design includes an integrated circuit topography, a mask work and a series of mask works.

2.1.4.4. How long does a design registration last?

An aesthetic design registration endures for 15 years, and a functional design for 10 years. The time period is calculated from the date of application or from the release date (see 2.1.4.7 below), whichever date is earlier. This duration is subject to the payment of annual renewal fees.

2.1.4.5. Can one file both a patent application and a registered design application?

The scope of protection provided by a patent and registered design is somewhat different, although many articles may qualify for both forms of protection. Where an article qualifies for design protection, the design is registrable, irrespective of whether or not the article is the subject of a patent application.

2.1.4.6. Is design protection worth the cost involved?

Design protection relates specifically to the pattern, shape, configuration, or ornamentation of an article. In short, the protection relates specifically to how the article looks. For some articles, this kind of protection is extremely valuable, but in other cases, the design of an article can easily be changed, resulting in the circumvention of design protection.

The cost of filing a registered design application is lower than a patent application and the procedure is somewhat simpler, resulting in further cost savings when compared to a patent application.

Also, upon registration, a design is deemed to have been registered as from the date of the application, in contrast to a patent application, which is typically only granted several months or even years from the date of application.

2.1.4.7. What are the requirements for registrability?

In general, an aesthetic design is registrable if it is new and original, and a functional design is registrable if it is new and not commonplace in the art in question.

A design is new if it is different from the state of the art immediately before the date of the application or the release date, whichever is earlier. The release date is the date on which the design is first made available to the public.

Most design applications are filed before the release date, but if a design has been made available to the public, the application must be filed within 6 months of the release date. An exception to this rule is the case of integrated circuit typographies and mask works, for which the application must be filed within 2 years of the release date.

The state of the art includes all matter made available to the public, anywhere in the world, by written description, use or in any other way, as well as matter contained in prior design applications.

As to the requirements that an aesthetic design be original and a functional design be not commonplace in the art in question, the essence of these requirements is that the design be distinctive in some way when viewed against the state of the art.

2.1.4.8. Which designs cannot be protected?

The following are specifically excluded from protection in terms of the Designs Act:

- Designs of articles which are not intended to be multiplied by an industrial process;
- Aesthetic design protection cannot be obtained in respect of any feature of an article insofar as it is necessitated solely by the function which the article is intended to perform, or for a method or principle of construction; and
- Functional design protection cannot be obtained for an article, which is in the nature of a spare part of a machine, vehicle or equipment.

2.1.4.9. Who may apply for design registration?

The Designs Act states that the proprietor of a design may apply for the registration of such design. Although the term “proprietor” is defined in the Act, the definition is somewhat unclear. Be that as it may, broadly speaking the following categories of persons would be the proprietor of a design:

- the author of the design;
- where the design is executed for another person, that other person; or
- a person acquiring rights in the design from a previous proprietor of that design.

In light of the lack of certainty arising from the definition of “proprietor” in the Act, it is always advisable to address the ownership of designs in agreements relating to the procurement of design services, and particularly in contracts of employment.

2.1.4.10. On what grounds can a design registration be revoked?

Design registrations may be revoked by a court on application by any person on various grounds set out in the Designs Act. It is not within the scope of this discussion to deal with revocation in detail, but broadly speaking, the grounds can be categorised as substantive grounds and formal grounds.

Formal grounds relate to procedural flaws in the application for registration while substantive grounds relate to the registrability of the subject matter of the design registration.

In order to reduce any risk of revocation of a design registration, it is essential that an applicant for a design registration correctly and fully discloses to his patent

attorney all information relating to the design, and particularly the basis on which the applicant claims his rights in the design.

2.1.5. Trade marks

2.1.5.1. What is a trade mark?

A trade mark, in terms of the Trade Marks Act No. 194 of 1993 (“the Trade Marks Act”), is a mark used to distinguish the goods or services in relation to which the mark is used, or proposed to be used, of one person from the same kind of goods or services connected in the course of trade from that of another.

Although a mark may consist of a number of signs, including a logo, name, signature, word, letter, numeral, shape, configuration, pattern, ornamentation, colour or container for goods or the foregoing in combination, it is essential that such a mark must be capable of being represented graphically. This means that such a mark must be capable of a visual representation by means of writing, drawing, photographing, etc.

Trade marks are a company’s most valuable asset. As time passes, a trade mark can appreciate in value and as a company’s reputation grows, so too does its trade mark value.

2.1.5.2. Where is the application for registration filed?

The Registrar of Trade Marks (“the Registrar”), whose office is situated in Pretoria is responsible for the maintenance of a register (“the Register”) of all trade mark applications filed (“applications”) and trade mark registrations (“registrations”) in South Africa.

2.1.5.3. What is the procedure for applying for the registration of a trade mark?

Before adopting a trade mark and/or filing an application for registration of a trade mark, it is advisable that we conduct a search of the Register, with a view to determining if the proposed trade mark is in conflict with any existing applications and /or registrations. Not only will such a search reveal entries on the Register that may serve as a bar to the use and registration of a proposed trade mark, it will also allow a trade mark practitioner the opportunity to express an opinion on the inherent registrability of a trade mark and if the proposed trade mark complies with the requirements laid down by the Trade Marks Act.

Whether to conduct a search is a question of management of risk – if one has used the mark for some time and is sure that there are no third parties using an identical or similar mark, an availability search may not be necessary in the circumstances.

The application must include a description of the goods or services involved as the Register is divided into 45 different classes, indicating in a general manner the fields to which the goods and services in principle belong, as well as a more detailed description thereof. It is therefore necessary to first determine the exact nature of the goods and services for which protection is sought, whereafter the application(s) must be filed accordingly in the relevant class or classes

On filing the application, the Registrar will allocate an application number and a filing date, which date is of great importance, as the rights obtained on registration will be effective from that date.

The application is, in due course, examined by the Registrar to ensure that the application complies with the requirements of the Trade Marks Act, and is not in conflict with existing applications or registrations filed prior to the application being filed. The Registrar may, in the process, impose requirements, which must be complied with before the Registrar will accept the application.

Once the Registrar has accepted the application, it must be advertised in the Patent and Trade Mark Journal, which appears monthly, for opposition purposes. The importance of the pre-filing search will be seen at this stage, as it will indicate whether there is a likelihood of opposition being encountered by third parties.

2.1.5.4. Why is a trade mark application advertised?

The purpose of advertising an application is to allow third parties the opportunity to familiarize themselves with the rights to be granted by the imminent registration, and to oppose the application in the event of the application being in conflict with the prior rights of a third party.

2.1.5.5. On what grounds can a trade mark application be opposed?

There are various grounds upon which an application can be opposed. The most common grounds include that the application is in conflict with a registered trade mark (i.e. statutory rights), alternatively an application filed prior to the application

being opposed or is in conflict with a third party's rights resulting from use of a trade mark (i.e. common law rights).

2.1.5.6. What is the procedure for opposing a trade mark Application?

An interested party may oppose any application once the application has been advertised, provided that such opposition is filed within 3 months of the date of advertisement of the application in the Patent and Trade Mark Journal. A first request of the extension of the opposition term is granted by the Registrar in terms of the Regulations.

Thereafter, it is possible to request the trade mark applicant to grant further extension(s) of the opposition period. It is common practice, to grant at least one 3 month extension which enables the parties to explore the possibility of settling the potential conflict amicably.

The opposition is initiated by the party opposing the application ("the opponent"), usually by addressing a letter to the applicant of the application, or its legal representative, providing details of the opponent's rights and calling for the application to be withdrawn. Should the applicant refuse to comply with these demands, the opponent may formally oppose the application through filing a Notice of Opposition at the Registrar's office, which Notice is accompanied by a supporting affidavit(s), setting out the grounds on which the application is being opposed.

The applicant may, once the above Notice has been filed, submit evidence in answer, again in affidavit form, where after the opponent is allowed the opportunity to file replying evidence, without submitting new evidence.

2.1.5.7. Who hears the case?

The case is heard by the Registrar who has the same authority and jurisdiction in trade mark proceedings as a single Judge of a Local Division of the High Court.

The Registrar or the parties may by agreement transfer the matter to the High Court, for reasons such as expediency, consolidation, etc.

2.1.5.8. Is there an appeal procedure against the judgment?

There is an automatic right of appeal to the North Gauteng Division of the High Court from any decision of the Registrar.

However, any appeal from the North Gauteng Division of the High Court, to the full bench of the same division or to the Supreme Court of Appeal, requires the consent of the Court from which the appeal is lodged.

2.1.5.9. What rights are acquired on registration of a mark?

The proprietor of a registered trade mark has the right to use the trade mark to the exclusion of all others, in relation to the goods or services for which it is registered.

Furthermore, the proprietor has the right to object to the unauthorized use of the trade mark, or any similar trade mark, not only in relation to goods or services for which it is registered, but also in relation to goods or services similar to those goods and services for which the trade mark is registered, and which is likely to lead to deception or confusion.

2.1.5.10. Are well-known marks protected in South Africa?

South Africa is a signatory to the Paris Convention that grants protection to well-known trade marks. This protection is extended to South Africa by virtue of the Trade Marks Act, which contains several sections which give recognition and protection to the owners of well-known trade marks, which do not necessarily require a well-known trade mark to be registered in South Africa.

Sections 10 (6) and (17) of the Trade Marks Act enable the proprietor of a well-known trade mark, in certain circumstances, to object to attempts to register a well-known trade mark in South Africa, whereas sections 34 (1) (c) and 35 enable the proprietor of a well-known trade mark to object to the unauthorised use of the well-known trade mark in South Africa.

2.1.5.11. Can a trade mark be licensed, and what are the different forms of licensing?

A trade mark, whether registered or in commercial use only (“common law trade mark”), may be licensed to third parties. Such a licence may be granted:

- tacitly or expressly; or
- orally or in writing; or
- on an exclusive or nonexclusive basis; or
- as a sole licence.

An exclusive licence grants the rights to use a trade mark, to the exclusion of all others, even the trade mark proprietor, whereas a non-exclusive licence grants a licensee a right to use the trade mark, but not necessarily to the exclusion of other third parties. A sole licence, on the other hand, grants the licensee a right to use the trade mark to the exclusion of all third parties, although the proprietor is also entitled to use the trade mark.

2.1.5.12. Should licences be in writing and recorded?

A written licence agreement creates certainty, and is therefore advisable, and extends to both registered and common law trade marks.

Once a trade mark has been registered, it is possible to record a trade mark licence against the registration at the Registrar's office. Such a licence agreement is commonly referred to as a "registered user agreement".

Although the recordal of a trade mark licence against a registration is not mandatory, such recordal has the advantage that any use, which the licensee (registered user) makes of the trade mark in terms of the licence, is clearly for the benefit of the registered proprietor. Such a licensee (registered user) may also call upon the registered proprietor to institute infringement proceedings against third parties, and failure to do so entitles the licensee, under the Trade Marks Act, to institute proceedings against the infringer as if he was the proprietor of the registration.

Where a registered user is recorded against a registration, the proprietor of such mark is required to give the licensee notice of his intention to institute proceedings so that the licensee may join in the legal proceedings.

2.1.5.13. Is it possible to buy or sell a trade mark?

Registered and common law trade marks are both important assets in a business and are often bought and sold as part of bigger transactions.

Changing ownership of registrations and applications is done by way of recording the assignment agreement, entered into between the purchaser ("the assignee") and the trade mark owner ("the assignor"), at the Registrar's office.

The assignment agreement should include the effective date of the assignment, whether or not the assignment is with or without the goodwill of the trade mark, as well as full details of the registration and/or application being assigned. Goodwill is usually only transferred when the sale is part of an acquisition of the entire business to which the trade mark attaches, as opposed to the trade mark on its own.

2.1.5.14. For how long is a trade mark valid?

A registration remains in force for ten years, effective from the date of application for registration, and may be renewed in 10 yearly intervals, in perpetuity.

Notwithstanding the above, it is important to note that the rights granted under a registration are subject to the proviso that the trade mark must be used in the course of trade, by the proprietor thereof. The reason for this is that it is contrary to commercial principles to grant an exclusive monopoly in circumstances where a trade mark is not being used and where third parties, who may have an interest in using the trade mark, are thereby prohibited from doing so.

As a result of the above, there are grounds upon which one may challenge a registration's validity. One such ground is that, if a trade mark is not used for a continuous period of 5 years or longer after the trade mark has been registered, the registration may be removed from the Register on the basis of non-use. However, if use of the trade mark has re-commenced before proceedings are instituted, it is no longer possible to attack the registration's validity based on non-use of the trade mark.

2.1.5.15. Does a trade mark registration provide a company or close corporation name protection?

The Trade Marks Office and the Companies Office operate independently of one another and do not consult each other in the process of searching or registration. The rights flowing from registration in these offices are accordingly diverse and do not automatically extend to the other. In this regard, it is necessary to note that the registration of a company or close corporation provides a party with very limited rights, whereas registration of a trade mark leads to far greater rights and protection.

In order to prevent the use of your trade mark as a company or close corporation name, it is advisable to file an application for the registration of your trade mark as a defensive company name.

2.1.5.16. How do trade marks relate to domain names?

A domain name is a right independent of a trade mark right, and is essentially an Internet address to a website. However, domain names often, unlawfully, incorporate trade marks, the use of which may infringe the rights of a trade mark proprietor.

2.1.5.17. What can I do if an unrelated domain name uses my registered trade mark?

The Electronic Communications and Transactions (ECT) Act 25 of 2002 makes provision for the creation of a dispute resolution policy and also addresses the issues of domain name and trade mark infringement on the Internet in South Africa. There is a dispute resolution and procedure in place, in the regulations to deal with domain disputes in South Africa, including those disputes that extend to the country code, co.za (and net.za, web.za and org.za).

If a domain name unlawfully incorporates another's name or trade mark and the owner thereof is not prepared to cease using the domain name, it is possible to lodge a domain name dispute with the South African Institute of Intellectual Property Law (SAIIPL). If the dispute is not decided by an adjudicator for any reason, the matter may be referred to the High Court. In this process, an applicant will have to base its action on trade mark infringement and rely on the protection afforded by the Trade Marks Act, alternatively common law remedies such as passing-off or unlawful competition.

Should a third party unlawfully use a trade mark as part of a domain name ending in .com, it is possible to object to such use by lodging the necessary objection with the international dispute resolution body, ICANN.

2.1.5.18. When can one use ® and ™?

The ® symbol may only be used once a trade mark has been registered. A trade mark is only registered once the certificate of registration has been issued and use of the symbol ® in other circumstances is a criminal offence. Where a trade mark has not (yet) been registered, the symbol ™ may be used to denote ownership of the trade mark/trade mark pending.

2.1.5.19. What about protection outside South Africa?

Trade marks rights are territorial rights, and as such, separate protection must be obtained in each country in question. The requirements and costs vary from country to country, and depend to a great extent on the exchange rate of the moment. It is therefore advisable to seek qualified assistance before deciding to expand trade mark rights to other jurisdictions.

2.1.6. Foreign trade marks

2.1.6.1. International trade mark protection

Trade marks are legally protectable and may be registered as such in most countries of the world.

In general, a separate application for the registration of a trade mark is required in each country of interest. In other words, if trade mark protection is sought in Swaziland, Canada and China, separate trade mark applications must be filed in Swaziland, Canada and China respectively.

The European Union, as an example, is an exception. A single trade mark application (Community Trade Mark application) will cover all member states of the European Union, although national trade mark registrations in the member states are possible.

Likewise, a Benelux trade mark registration covers Belgium, The Netherlands and Luxembourg (also members of the European Union). However, unlike other member states of the European Union, national trade mark registrations in the individual Benelux states are not possible.

In Africa, an organisation known as OAPI (Organisation Africaine de la Propriété Intellectuelle) provides another exception. Here, a single trade mark application covers seventeen Western African French speaking countries.

Also in Africa, an organisation known as ARIPO (African Regional Industrial Property Organisation) provides an alternative to national trade mark protection in its member states.

2.1.6.2. Trade mark protection in Africa

2.1.6.2.1. Introduction

Africa is one of the fastest growing economic regions in the world with countries with natural resources such as mining, oil and gas, and agriculture, benefitting from increased commodity prices. Even countries without an abundance of natural resources have experienced economic growth in wholesale, retail, transportation, telecommunications, manufacturing, construction and finance. Contributing factors to this growth include good governance on macroeconomic policies, improved transport and logistics infrastructure, as well as less restrictive trade barriers.

The importance of securing enforceable trade mark rights in Africa grows with economic growth. More and more of Africa's population now live in cities with access to the internet, satellite television and social media which means brand exposure as never before.

There are 54 countries on the African continent with over 1500 different languages and dialects spoken, and trade mark rights and their enforcement often differ from country to country. It soon becomes clear too, that trade mark protection strategies will also differ from country to country, but are nonetheless very important before entering a market, particularly if products or services are to be offered through local agents or distributors.

Most African countries recognise common law rights acquired through continuous *bona fide* use of a trade mark, where the holder of a registered trade mark cannot prevent use of a mark by another party, provided such use by the other party commenced prior to the date of use and/or registration of the trade mark

There are, however, some countries in Africa where common law rights are not recognised in their laws, or where laws do not make express provision for the recognition of common law rights. In these countries, owners would be wise not to delay in seeking trade mark protection. The danger here is that you may have been selling a particular product in a country for some time, but if the trade mark was never registered and a third party subsequently registers it, that third party may be able to prevent you from continuing to sell that branded product in that country, unless you are in a position (usually at prohibitive cost and delay) to prove bad faith or that that your brand is well-known in that country prior to the other parties' application to register it.

There are a number of other important considerations when it comes to trade marks in Africa. Examples of such important considerations include the following:

- trade marks in Malawi and Zambia, cannot be registered in relation to services.
- A trade mark application in Tanzania does not automatically cover Zanzibar despite both territories falling under the United Republic of Tanzania.
- Certain goods are prohibited in some countries, for example, listing alcoholic beverages under classes 32 and 33 in certain countries would be against the law.
- There can also be local regulatory requirements. An example of this is The National Agency for Food and Drug Administration and Control (NAFDAC), responsible in Nigeria for regulating amongst other things, the importing, advertising, sale and distribution of foodstuffs (including wine and beverages), pharmaceuticals, cosmetic products, medical devices and chemicals. In this regard it is important to note that proof of a Nigerian Trade Mark is a requirement for obtaining a NAFDAC registration.
- Registration of trade marks is not possible in Somalia or Eritrea where no trade mark laws apply. In these territories trade mark owners can elect to publish so-called Cautionary Notices in local newspapers as a means of announcing and making their proprietary rights known to the public in that region. This practice has recently been reintroduced in Somalia after years of suspension. The publication of Cautionary Notices remains suspended in Eritrea at this time. Trade mark applications in South Sudan have also been suspended until such time as new laws are enacted in this country.

Brand integrity is incredibly important in the context of trade marks in Africa. One must tread carefully in considering local meanings and connotations of a proposed trade mark which may have no specific meaning in one country, but which may have an offensive meaning or negative connotation in another language.

Another risk to brand integrity includes the common practice in certain African countries for infringers to copy a product label (particularly design and colours) instead of the particular product name. This may be due to low levels of literacy in some regions and/or diversity in languages. However, it seems that association with many brands in

some regions is primarily through images and colours (get-up) and not always the brand name itself.

Brand owners are advised to seek protection for colour label marks and/or entire product get-up (i.e. the overall look and feel of the product) in addition to the product name.

2.1.6.2.2. *Regional Trade Mark Registration Systems*

Trade marks can be registered in Africa either nationally under the Organisation Africaine de la Propriété Intellectuelle (OAPI), under the African Regional Intellectual Property Office (ARIPO), or designated under an International Registration under the Madrid System. Each system should be properly assessed as to suitability in the particular circumstances.

OAPI

If trade mark protection is desired in any one or more of the OAPI member countries, an Applicant has no choice but to apply for an OAPI trade mark application, which automatically covers all 17 member states, namely:

- Benin
- Burkina Faso
- Cameroon
- Central African Republic
- Chad
- Comoro Islands
- Congo
- Equatorial Guinea
- Gabon
- Guinea
- Guinea Bissau
- Ivory Coast
- Mali
- Mauritania
- Niger
- Senegal
- Togo

In other words, OAPI offers Applicants a means of securing protection across all member countries, via a single OAPI registration, and it is not possible to designate specific countries.

It is important to note that while OAPI facilitates and maintains these registrations, enforcement on infringement must be dealt with within the member country/countries concerned.

ARIPO

At this time there are 19 Member States of ARIPO. Somalia is currently inactive. Of the 18 active Member States, only 10 are signatory to the Banjul Protocol relating to trade marks, and may be designated under an ARIPO trade mark application. They are:

- Botswana
- Lesotho
- Liberia
- Malawi
- Namibia
- Swaziland
- São Tomé and Príncipe
- Tanzania (“Tanzania mainland” or “Tanganyika”, not Zanzibar)
- Uganda
- Zimbabwe

Of these signatories of the Banjul Protocol, not all have incorporated the provisions of the Protocol into their national laws. Therefore, there is doubt as regards the validity of trade marks registered under the ARIPO system in these countries.

The application for a mark must be filed either directly at the ARIPO Office in Harare, Zimbabwe or via the Industrial Property Office of a contracting state referred to as the Receiving Office.

Madrid in Africa

Twenty African countries and one regional system, OAPI, have joined the Madrid system. The current African Madrid member states Algeria, Botswana, Egypt, Gambia, Ghana, Kenya, Lesotho, Liberia, Morocco, Mozambique, Namibia, Rwanda, Sierra Leone, Sudan, Swaziland, Tunisia, Zambia, Zimbabwe,

Madagascar and Sao Tome & Principe. Of these countries, though, very few have amended their national laws to recognise rights in International Trade Mark Registrations (IRs). In certain countries where national laws have not yet been amended, it appears that enforceability is taking place on a practical level, at the discretion of the respective trade marks office.

2.1.6.3. Trade mark protection beyond the shores of Africa

In this brief introduction to our Foreign Trade Mark Department, we have not gone into great detail about trade mark registrations in each and every country of the world. The options are plentiful and would require more than a brief introduction to be afforded adequate discussion. We are however available upon request to discuss any aspect of international trade mark protection and we do encourage any queries to be addressed to us.

Having said this, we have chosen to focus attention on three jurisdictions of international trade mark protection, namely, the European Union, the United States of America, and the Madrid System:

2.1.6.3.1. *European Union*

Although it is of course possible to obtain trade mark protection in each member country of the European Union individually (and very often this may be the desirable route depending on the circumstances), it is also possible to obtain registration of a trade mark which covers all member states of the European Union by filing a single application for a European Trade Mark (EUTM) via the European Intellectual Property Office (EUIPO).

An EUTM is valid for 10 years and is renewable for additional 10-year periods. Use of the trade mark must have commenced in at least one member state within 3 years of registration to avoid the trade mark being vulnerable to cancellation on the basis of non-use.

2.1.6.3.2. *United States of America*

A trade mark application in the United States of America (USA) can be based on:

- a trade mark's actual use in the USA;
- a genuine intention to use the trade mark in the USA in the foreseeable future; or

- a prior home (e.g. South African) trade mark registration.

Where a trade mark application is filed on the basis of an intention to use the trade mark in the USA, it is important to note that registration of the trade mark will not be allowed until use of the trade mark has in fact been proved. In this regard the required statement of use and accompanying evidence must be filed within six months of the date on which the notice of allowance is issued, although a limited number of extensions of this deadline may be applied for.

Upon registration of a trade mark in the USA, the trade mark remains valid for 10 years from the date of filing and is renewable for a further period of 10 years provided use of the trade mark is proved between the 7th and 8th anniversary of its registration.

2.1.6.3.3. *Madrid System*

South African companies or individuals who have real and effective business establishments or who are domiciled in, or nationals of, foreign countries which are members of the Madrid Union are in a position to avail themselves of a highly cost-effective way of securing trade mark protection in multiple countries.

The Madrid System for International Registration of Marks allows a trade mark owner to file a single, central application through the World Intellectual Property Office (WIPO) and designate any or all of the Madrid member countries in which registration is sought. An application for international registration must be based on an existing application or registration (base application / registration) in a Madrid member state (base country) and must be filed through the registry of the base country.

Another advantage of an international registration is that it is renewed centrally and all administrative matters, such as amendments and assignments are filed and processed centrally through WIPO.

Although South Africa is not a signatory to either the Madrid Agreement or Madrid Protocol at this stage, the topic of International Registrations is certainly worth discussion, provided that the proposed applicant has the necessary entitlement to file, as described above.

A further discussion of the Madrid System is contained in the chapter below dealing with International IP Law Aspects, and our Foreign Trade Mark

Department will gladly discuss the Madrid System in more detail upon request and in consultation with our clients.

2.1.7. Copyright

2.1.7.1. What is copyright?

The owner of copyright in a work is by statute given the exclusive right to perform certain specified acts in respect of his work or to authorise others to do so and hence to prevent unauthorised persons from performing those acts. Only certain specified categories of works defined in the Copyright Act 98 of 1978 as amended, are eligible for copyright protection.

2.1.7.2. Which works are eligible for copyright protection?

Only works which fall within the following categories are eligible for copyright protection:

- Literary works, irrespective of their literary quality.

“Literary” works include:

- *novels, stories and poetical works;*
- *dramatic works, stage directions, cinematograph film scenarios and broadcasting scripts;*
- *textbooks, treatise, histories, biographies, essays and articles;*
- *encyclopaedias and dictionaries;*
- *letters, reports and memoranda;*
- *lectures, speeches and sermons; and*
- *tables and compilations, including tables and compilations of data stored or embodied in a computer or a medium used in conjunction with a computer.*

- Artistic works irrespective of their artistic quality.

“Artistic works” include:

- *paintings, sculptures, drawings, engravings and photographs;*
- *works of architecture, being either buildings or models of buildings; and*

- works of craftsmanship.

“Drawing” includes any drawing of a technical nature or any diagram, map, chart or plan.

- Computer programs;
A “computer program” is a set of instructions which, when used on a computer, direct its operation to bring about a result.
- Musical works;
“Musical works” consist of music, without any words or actions which are intended to be sung, spoken or performed with the music.
- Cinematograph films;
“Cinematographic films” include data, signals or sequences of images stored on film or other material and capable of being seen as a moving picture.

It includes the sound embodied in a sound-track associated with the film, but does not include a computer program.
- Sound recordings;
 - *“Sound recordings” do not include a sound-track associated with a cinematograph film.*
- Broadcasts;
A “broadcast” is a telecommunication service of transmissions consisting of sounds, images, signs or signals which-
 - (a) *takes place by means of electromagnetic waves of frequencies of lower than 3000 GHz transmitted in space without an artificial conductor; and*
 - (b) *is intended for reception by the public, and includes the emitting of programme-carrying signals to a satellite.*
- Programme-carrying signals;
“Programme-carrying signals” are signals embodying a program which are emitted and pass through a satellite.
- Published editions, being the first print of a literary or musical work.

2.1.7.3. When does copyright subsist in a work?

Copyright automatically subsists in a work that is eligible for copyright protection, provided all the conditions for the subsistence of copyright have been met. The conditions are set out in question 2.1.7.4 hereafter.

Copyright, unlike patent, design and registered trade mark rights, is not dependent upon registration at a central registry. In other words, copyright comes about automatically and no formalities are prescribed for the acquisition of copyright in works.

With the exception of cinematograph films, no registration of copyright is possible in South Africa. Although registration is not required for copyright to subsist in a cinematograph film, registration serves to alleviate the burden of proof and to facilitate enforcement. There is registration of copyright in certain other territories (e.g. US and China) but this also is mainly for enforcement purposes.

2.1.7.4. What conditions must be met for copyright to subsist in a work?

Copyright will immediately and automatically subsist in a work if:

- the work falls within the scope of one of the categories of works that are eligible for copyright protection (refer to paragraph 2.1.7.2 above);
- the work is original in the sense that it is the result of the author's own, independent, labour, skill and effort;
- the work, except in the case of a broadcast or programme-carrying signal, is reduced to material form, e.g. an engineering drawing put on paper, or a musical work written down in music notation, or recorded on tape, record or compact disc. In the case of a broadcast the work must have been broadcast and in the case of a programme-carrying signal the work must have been transmitted by a satellite; and
- the author of the work is a qualified person. Alternatively, except in the case of broadcasts and programme-carrying signals, the work has first been published in South Africa or a country to which the operation of the Copyright Act has been extended. In the case of a broadcast the

requirement is that the broadcast was made in South Africa. In the case of a programme-carrying signal the requirement is that the signal was emitted to a satellite from a place in South Africa.

As will be explained in more detail below, copyright protection has been extended to the Berne Convention countries, which include most of the industrialised countries of the world (an updated list can be retrieved [here](#)).

2.1.7.5. What does it mean if a work is original?

'Originality' has no statutory definition and it is ultimately up to our Courts to determine whether a work is 'original'.

A work may be deemed to be original where it can be shown that sufficient labour, skill and effort has been expended by the author in creating the work and that the work is not a slavish copy of an already existing work.

A work can still be original if it is based on a previous work.

2.1.7.6. Who is a qualified person?

A qualified person is defined as:

- **In the case of a natural person**
a person who is resident in, or domiciled in, or who is a citizen of South Africa or any of the countries to which the operation of the Act has been extended;
- **In the case of a juristic person**
a body incorporated under the laws of South Africa or a country to which the operation of the Act has been extended.

2.1.7.7. Who is the owner of the copyright in a work?

The general rule is that the author of a work is the first owner of the copyright in the work.

However, there are important exceptions to this general rule, namely:

Where a literary or artistic work

- is made by an author in the course of his employment by the proprietor of a newspaper, magazine or similar periodical under a contract of service or apprenticeship; and
- is made for the purpose of publication in a newspaper, magazine, or similar periodical;

the proprietor of the newspaper, magazine or periodical is the owner of the copyright in the work insofar as the copyright relates to publication of the work in any newspaper, magazine or similar periodical or to reproduction of the work for the purpose of it being so published.

In terms of the aforementioned general rule, the author is still the owner of the balance of the copyright.

Where a person commissions:

- the taking of a photograph;
- the painting or drawing of a portrait;
- the making of a gravure;
- the making of a cinematograph film; or
- the making of a sound recording;

and pays or agrees to pay for it in money or money's worth, the person commissioning the work is the owner of the copyright in the work.

It is to be noted that this exception relates only to the commissioned works, and would not apply, for example, to engineering drawings, advertising material, graphic designs or computer programs.

Course and scope of employment:

In the event where the creation of a work does not fall within the aforementioned paragraphs, and an employee under a contract of service or apprenticeship makes

the work in the course of the employee's employment, the employer is the owner of any copyright subsisting in the work.

The operation of the previously mentioned exceptions may be excluded by an agreement between the parties. Such an agreement must be in writing.

2.1.7.8. Who is the author of a work?

The Act defines the meaning of the term "author" in relation to the different categories of works, as follows:

- **a literary, musical or artistic work** – the person who first makes or creates the work;
- **a photograph** – the person who is responsible for the composition of the photograph;
- **a sound recording and cinematograph film** – the person by whom the arrangements for the making of the relevant work were made;
- **programme-carrying signal** – the first person emitting the signal to a satellite;
- **a broadcast** – the first broadcaster;
- **a computer program** – the person who exercised control over its making;
- **a literary, dramatic, musical or artistic work or computer program generated by a computer** – the person by whom the arrangements necessary for the creation of the work were undertaken;
- **published edition** – the publisher of the edition.

2.1.7.9. Is joint authorship possible?

Where a work is created by more than one person, such persons are joint authors and may be co-owners of the copyright in the work.

2.1.7.10. Is joint ownership possible?

As stated above, joint authors may be joint owners of copyright. Furthermore, an owner of copyright in a work may also assign part of the copyright to another party, which will result in such a party, together with the original owner, becoming joint owners of the copyright in the work.

2.1.7.11. What are the moral rights of the author?

Notwithstanding the transfer of copyright in a literary, musical or artistic work, in a cinematograph film, or in a computer program, the author thereof still has the right to claim authorship of the work and to object to any distortion, mutilation, or the modification of the work, where such action is or would be prejudicial to the honour or reputation of the author.

It is, however, important to note that the moral rights of an author are subject to the provision that an author who authorises the use of his work in a cinematograph film or a television broadcast, or an author of a computer program of a work associated with a computer program may not prevent or object to modifications that are absolutely necessary on technical grounds, or for the purpose of commercial exploitation of the work.

2.1.7.12. What is the duration of copyright protection?

The respective terms of copyright protection for the different categories of works are as follows:

- **literary works, artistic works (other than photographs) and musical works** – for the life of the author and 50 years from the end of the year in which he dies;
- **computer programs, photographs and cinematograph films** – 50 years from the end of the year in which the work is lawfully made available to the public or is first published, whichever term is the longer. If neither of this happens within 50 years from the making of the work, 50 years from the end of the year in which the work is made;
- **sound recordings** – 50 years from the end of the year in which the broadcast first takes place;

- **broadcasts** – 50 years from the end of the year in which the broadcast first takes place;
- **programme-carrying signals** – 50 years from the end of the year in which the signals are emitted to a satellite; and
- **published editions** – 50 years from the end of the year in which the edition is first published.

2.1.7.13. What is copyright infringement?

A distinction is drawn between direct and indirect infringement of copyright.

- **Direct copyright infringement** occurs when a person, without the consent of the copyright owner, does one of the acts specifically reserved for the copyright owner or causes any other person to do so. The acts specifically reserved for exploitation by the copyright owner differ in relation to each of the different categories of works, but generally these acts include the reproduction or copying of the work, making an adaptation of the work, the first publication of the work and in certain categories, the performing, broadcasting or televising of the work. Computer programs, sound recordings and cinematograph films are subject to an additional exclusive right in terms of which the letting, offering or exposing for hire of copies of these works are reserved for the copyright owner. Accordingly, the letting or hiring of copies of these works, without the specific licence of the copyright owner constitutes an infringement.

In the case of a reproduction or copy of a work, infringement of copyright can occur only if the work, or a substantial part thereof, is copied. Thus, the independent creation of a second work substantially similar to an original work does not *per se* constitute copyright infringement.

In fact, if the creation of the subsequent, independently created work, complies with all the conditions for the subsistence of copyright, as set out in the answer to question 4 above, the second work will automatically enjoy its own, independent copyright.

In the case of direct copyright infringement, it is not necessary for the infringer to have known that the work was the subject of copyright protection.

- **Indirect copyright infringement** involves the doing, without a licence from the copyright owner, of certain acts in respect of infringing copies of a work. Infringing copies are works that are made by directly infringing the copyright in a work. Acts of indirect infringement include importing into South Africa, selling, letting, offering or exposing for sale or hire, and distributing in South Africa articles that are infringing copies of a work.

In the case of indirect copyright infringement, guilty knowledge on the part of the infringer is required, i.e. knowledge that an infringing article was involved.

Furthermore, the copyright in a literary or musical work shall be infringed by any person who permits a place of public entertainment to be used for a performance, in public, of the work, where the performance constitutes an infringement of the copyright in the work: provided that this provision shall not apply in a case where the person permitting the place of public entertainment to be so used was not aware and had no reasonable grounds for suspecting that the performance would be an infringement of the copyright.

Whereas knowledge of the copyright is not necessary to establish direct infringement of copyright, indirect copyright infringement cannot be established without proving that the alleged infringer knew that the copies concerned were infringing copies or that the performance was an infringement of copyright.

2.1.7.14. Who can take legal steps in the event of copyright infringement?

The owner of copyright in a work can institute proceedings for copyright infringement. An exclusive licensee or exclusive sub-licensee may intervene in such proceedings.

2.1.7.15. What remedies are available in the case of copyright infringement?

Remedies include damages, an interdict and delivering up of infringing copies or plates used or intended to be used for making infringing copies. Damages may, at the option of the plaintiff, be calculated on the basis of a reasonable royalty which would have been payable in the circumstances by a licensee. Additional or so-

called special damages may also be available, if justified by the flagrancy of the infringement, and benefits accrued to the infringer.

The Act also provides for criminal sanctions in certain cases where guilty knowledge can be ascertained.

2.1.7.16. What are the exceptions to copyright infringement?

The Copyright Act provides for certain exceptions to acts of copyright infringement and these exceptions may serve as a defence to an allegation of copyright infringement. The exceptions specifically relating to those acts reserved for exploitation by the copyright owner differ in relation to each of the different categories of works, but generally these exceptions include:

- Fair dealing with a specified work when it is for the purposes of research or private study, criticism or review, or reporting current events;
- Using a specified work for judicial proceedings or for reporting judicial proceedings;
- Quoting a specified work where the quotation is compatible with fair practice and the source and name of the author is mentioned;
- Illustrating a specified work for the purposes of teaching;
- Reproducing or broadcasting a specified work for information purposes or where it relates to any current economic, political or religious topic, official texts of a legislative, administrative or legal nature or speeches of a political nature;
- Reproduction or including a specified work in a cinematograph film or a television broadcast or transmission in a diffusion service, if such work is permanently situated in a street, square or a similar public place or if its inclusion is merely incidental or by way of background;
- Making copies of a computer program for back-up purposes intended for personal or private purposes; or
- Making a three-dimensional reproduction or adaptation of an artist's work where the three-dimensional reproduction of that artistic work

has already been made available to the public with the consent of the copyright owner and where the reproductions or adaptations primarily have a utilitarian purpose and are made by an industrial process.

The above merely highlights a handful of the exceptions to copyright infringement.

2.1.7.17. Do only South African works enjoy copyright protection in South Africa?

As stated above, the South African Copyright Act does not apply to South African works only. The operation of the Act has been extended to works emanating from certain other countries as well. These other countries to which the operation of the Act has been extended are listed in a Schedule published with a Notice under the Act.

South Africa is a member of the Berne Convention. The Berne Convention is aimed at obliging member countries to provide for certain minimum standards of copyright protection. South Africa also adheres to the World Trade Organization (WTO) Agreement and the Agreement on Trade Related aspects of Intellectual Property Rights (TRIPS). In terms of its obligations under the latter Agreement, South Africa must afford to works emanating from other member countries, the same protection as it affords to South African works. Not all Berne Convention and WTO member countries are yet included in the aforementioned Schedule, but most industrialised countries of the world are. Works emanating from countries not scheduled, do not enjoy copyright protection in South Africa.

2.1.7.18. Can copyright be licensed or assigned?

The ownership of the copyright in a work may be transferred by assignment, testamentary disposition or operation of law. Licences may also be granted in respect of the copyright in a work. An assignment or licence relating to copyright may be limited so as:

- to apply to only some of the acts which the owner of the copyright has the exclusive right to control, or;
- to the term of the copyright, or;
- to a specified country or other geographical area.

2.1.7.19. Are any formalities required for assignments or licenses?

The only formality that is required is that an assignment of copyright and an exclusive licence under copyright must be in writing and duly executed by the assignor or licensor, in order to have effect. Other licences may be based on oral agreements or even inferred from the conduct of the parties.

2.1.7.20. Can copyright in respect of a future work be assignment or licensed?

An assignment, licence or testamentary disposition may be made or granted in respect of the copyright in a future work. Future copyright in a work is similarly transmissible.

2.1.7.21. What is a copyright notice and is it necessary?

A copyright notice is a statement declaring to the world that the work to which the notice is applied is the subject of copyright protection. In its simplest form, the notice consists of the letter '©' (or the word COPYRIGHT, or both) together with the name of the copyright owner and the year in which the work was completed. Such notices are usually used where space is at a premium. Fuller notices detailing the copyright are preferable where space permits, for example, on literary works or in computer programs.

The presence or absence of a copyright notice on works subject to copyright can play a significant role in determining whether or not a copyright owner is entitled to recover damages from an infringer. If a defendant in a copyright action is able to show that he was not aware, (or had no reasonable grounds for suspecting) that copyright subsisted in a work to which the action relates, the plaintiff will not be able to recover damages.

A copyright notice thus serves to ensure that it is not open to an infringer to raise the defence of lack of knowledge of the subsistence of copyright.

Furthermore, information or claims in a copyright notice on works embodying cinematograph films or sound recordings introduce certain presumptions in law, which may alleviate a plaintiff's onus of proof in litigation.

2.1.8. Trade secrets

A trade secret is a formula, practice, process, design, instrument, pattern or compilation of information which is known only by a particular business and is used

by that business to obtain an advantage over competitors within the same industry or profession.

A company can protect its trade secrets through non-disclosure contracts with its employees and third parties to whom such trade secrets are disclosed. The law of protection of confidential information effectively allows a perpetual monopoly in trade secrets - it does not expire as would a patent. The lack of formal protection, however, means that a third party is not prevented from independently duplicating and using the trade secret once it is discovered.

The sanctioned protection of such type of information from public disclosure is viewed as an important legal aspect by which a society protects its overall economic vitality. A company typically invests time and energy into generating information regarding refinements of process and operation. If competitors had access to the same knowledge, the first company's ability to survive or maintain its market dominance would be impaired. Where trade secrets are recognised, the creator of property regarded as a "trade secret", is *entitled* to regard such "special knowledge", as intellectual property.

A trade secret is defined as information that:

- is not generally known to the relevant portion of the public;
- confers some sort of economic benefit on its holder;
- is the subject of reasonable efforts to maintain its secrecy.

Trade secrets are not protected by law in the same manner as trade marks or patents.

Trade secrets are by definition *not* disclosed to the world at large. Instead, owners of trade secrets seek to keep their special knowledge out of the hands of competitors through a variety of civil and commercial means, not the least of which is the employment of non-disclosure agreements (NDA's). In exchange for the opportunity to be employed by the holder of secrets, a worker will sign an agreement not to reveal his prospective employer's proprietary information. Often, he will also sign over rights to the ownership of his own intellectual production during the course (or as a condition) of his employment. Violation of the agreement generally carries stiff financial penalties, agreed to in writing by the worker and designed to operate as a disincentive to going back on his word. Similar agreements are often signed by representatives of other companies with whom the trade secret holder is engaged, e.g. in licensing talks or other business negotiations.

Trade secret protection *can*, in principle, extend indefinitely and in this respect offers an advantage over patent protection (which lasts only for a specifically delimited period, for example twenty years in South Africa). (One company that has no patent for its formula and has been very effective in protecting it for many more years than a patent would have is Coca Cola.)

Companies often try to discover one another's trade secrets through lawful methods of reverse engineering on one hand, and less lawful methods of industrial espionage, on the other. Acts of industrial espionage are generally illegal in their own right under the relevant governing laws. The importance of that illegality to trade secret law is as follows: if a trade secret is acquired by improper means, (a somewhat wider concept than "illegal means", but inclusive of such means), the secret is generally deemed to have been *misappropriated*. Thus, if a trade secret has been acquired via industrial espionage, its acquirer will probably be subject to legal liability for acquiring it improperly. (The holder of the trade secret is nevertheless obliged to protect against such espionage to some degree in order to safeguard the secret. As noted above, under most trade secret regimes, a trade secret is not deemed to exist unless its purported holder takes reasonable steps to maintain its secrecy.)

2.1.9. Patents v. trade secrets

Tension frequently exists between the options of keeping an invention a trade secret or filing a patent application that discloses the invention. Using a trade secret may eliminate any possibility of ever being able to patent an invention. On the other hand, the publication of a patent destroys any trade secrets that it discloses. Sometimes, the choice to patent or to maintain a trade secret is clear. Usually, however, the decision requires balancing various commercial, business and legal factors.

A patent is a legally recognised monopoly that is granted in exchange for disclosure of how to make and use an invention. A trade secret is something that confers a business advantage, is not generally known, and that the owner of the trade secret, takes steps to maintain as a secret. Because of the disclosure requirements of patents and the secrecy requirements of trade secrets, these two forms of intellectual property usually cannot be maintained for any one particular technology. A choice either to patent or to maintain as a trade secret must be made.

The decision whether to patent or keep a trade secret must be based on the particular facts and circumstances regarding a technology and the circumstances of the business enterprise.

There are situations wherein patents exist as the clear choice over trade secrets. A trade secret is of no use to protect a product that can be reverse engineered. In this situation, a patent is the only viable option. Patents have a firm duration, and will remain in force until twenty years from the filing date of the application. In contrast, the duration of a trade secret is uncertain, as trade secret protection can be lost overnight if the secret is publicly disclosed, even if the disclosure was not intentional. Furthermore, once a patent application is filed, the information that is in the application can be freely disclosed without loss of proprietary rights. However, trade secrets cannot be freely disclosed, and still maintained as a secret. Accordingly, if there is a need to publicly disclose information, patents would provide the better option.

With respect to technology that is to be licensed out, a licensee may be more willing to pay for technology that is patented. Licensees may worry that their rights are less clearly defined for trade secrets and that the value of a trade secret may be abruptly lost if the licensor fails to maintain the secret.

There are a number of instances where the decision clearly favours trade secrets. Trade secrets are the only option when the secret covers something that is not patentable. This occurs when the trade secret concerns subject matter in the form of business methods.

A further situation in favour of trade secrets is when the advantage due to the ownership of the technology is of very short duration. If the major competitive advantage is by being “first-to-market”, or if the technology will be obsolete in less time than it would take for a patent to issue, then a patent is of little or no use.

Trade secrets also have an advantage over patents because they can potentially last indefinitely. A classic example is the formula for Coca-Cola, which cannot be reverse engineered. If the formula had been patented when it was first used in 1886, the formula would have been in the public domain a long time ago and would now be free to be copied by anyone. However, by maintaining the formula as a trade secret for over one hundred years, Coca-Cola has continued to dominate the worldwide soft drink industry. In this way, trade secrets may be preferred over patents for technologies that preserve their competitive advantage for longer than the term of a patent.

An often frustrating and costly part of maintaining a trade secret involves the employees of a company. Generally, when employees leave a company, they have a right to take with them the skill, experience, and ideas they acquired during the

period of employment. Many companies require their employees to sign non-disclosure and non-competition agreements, however these agreements are subject to limitations in their scope and are often difficult to enforce.

In light of the aforesaid, the decision whether to seek patent protection or to maintain an invention as a trade secret is a decision that must be considered on an individual case basis by examining the specific facts related to the case. Sometimes, the decision is evident. If an invention can be reversed engineered, or if there is a need to disseminate information about the invention, or further where the invention concerns technology for which a licensee will only pay if it is patented, then the choice is clearly in favour of patents. On the other hand, if the invention is not patentable, if it provides an advantage which is of a shorter duration than the time that it would take to obtain a patent, or if the invention will be valuable for a very long time, and it can be maintained as a trade secret during that time, then the choice is clearly in favour of trade secrets. Most times, however, the choice is not so clear and various business, commercial and legal considerations must be balanced in order to arrive at a decision.

2.1.10. Domain names

2.1.10.1. What is a domain name?

A domain name is the address of a web site e.g. <http://www.kisch-ip.com>.

A web address, in its technical form, is a series of random numbers (196.22.160.5) known as an Internet Protocol (or “IP”) address that directs an Internet user to a specific website. This technical address system is confusing, difficult to remember and discourages Internet use. To avoid this technical impediment and to facilitate easy use, domain names were developed as an alternative to the use of such IP addresses.

2.1.10.2. Why should I register a domain name?

Domain names are registered on a “first come, first-served” basis in most cases, without requiring proof from the registrant of its rights to a particular domain name. A domain name registration ensures web-brand protection and web-trade mark protection. It prevents cyber-squatting and establishes a brand and trade mark identity on the Internet. A domain name which is identical to your business name or trade mark allows clients to locate your website, services or goods, with sufficient ease, in the mass of information that forms the Internet.

2.1.10.3. What is the difference between a domain name and a trade mark?

Domain names are registered on a “first come, first-served” basis, without requiring proof from the registrant of its legitimate rights to use and/or register the domain name. Domain names are registered virtually instantaneously, online.

Domain names are not classified into specific classes and once registered preclude third parties from registering the identical domain name in that specific Top Level Domain (TLD). However, registration of kisch-ip.com does not debar other parties from registering kisch-ip.com and various other misspellings of the name.

Domains are usually renewable annually or bi-annually.

Trade Marks - there may be a multitude of identical trade marks registered in the name of different proprietors in relation to different goods or services and/or registered in different territories without infringing on other parties' rights.

Registration of a trade mark in a particular class prevents another party from registering an identical or confusingly similar trade mark in relation to the same or similar goods or services.

The registration process is lengthy. South African trade marks are renewable every 10 years.

2.1.10.4. What do gTLD and ccTLD mean?

Domain name extensions, such as .com and .net are referred to as Top Level Domains or TLDs. There are two basic types of TLDs: generic (gTLDs) and country code (ccTLDs).

The most popular gTLDs, such as .com, .net and .org and the relatively new .biz, .info and .name are unrestricted and may be registered by Internet users worldwide and are not specific to a geographical territory.

A country code Top Level Domain Name (ccTLD) is a two-letter code for a specific geographic territory such as .za for South Africa and .uk for the United Kingdom. Every country is allocated a ccTLD.

A ccTLD is further divided into second level domains such as .co (commercial) and .org (organization). The complete ccTLD is then represented as .co.za and .org.za. Numerous second level domains may exist within each ccTLD.

ccTLD domain name registrations may be restricted in certain countries in that registration is reserved for applicants who satisfy certain criteria.

2.1.10.5. In which TLD should I register my domain name?

It is advisable to simultaneously register a gTLD and ccTLD in order to secure and reserve web-brand identity and trade mark protection on-line, in your country's namespace, as well as in the international namespace.

2.1.10.6. Who controls registration of domain names?

No organisation regulates or controls the Internet. ICANN (the Internet Corporation of Assigned Names and Numbers), the organisation that administers the generic TLDs, has introduced a Uniform Dispute Resolution Policy (the "UDRP"), which provides for an arbitration procedure under which a domain name may be cancelled or transferred to the trade mark owner. The UDRP allows a party whose rights have been infringed by a third party's gTLD registration, to approach the WIPO (World Intellectual Property Organization) Arbitration and Mediation Centre for relief. The complaint is lodged with the Centre and heard before a panel, whose decision is binding on the parties, notwithstanding an appeal to a court with jurisdiction to hear the matter.

ccTLD's are typically administered according to the laws of the country having jurisdiction over the particular ccTLD. In South Africa, the South African Institute of Intellectual Property Law (SAIIPL) is accredited as a dispute resolution provider in terms of the .za Alternative Dispute Resolution Regulations. Such Regulations were published on 22 November 2006 and are substantively similar to those offered by ICANN for gTLD's. Previously, domain name disputes would be referred to the High Court of South Africa and would form part of trade mark infringement and/or passing off proceedings. However, the new dispute procedure under the Regulations was instituted after accreditation of adjudicators during the course of 2007.

The dispute procedure entitles any party having the relevant rights to lodge a complaint against a co.za ; net.za ; web.za; and org.za domain, where the disputed domain name is an abusive or offensive registration. Complaints can be filed against domain names which incorporate prior registered or unregistered trade marks. Complaints can also be filed against domain names which amount to hate speech or racism or any other such names which are contrary to public policy. This procedure provides a cost efficient and expeditious resolution of domain

name disputes. Disputes filed with SAIPL are normally concluded within two to three months using on-line procedures, whereas court litigation would take significantly longer. Legal fees incurred by the parties are significantly lower than High Court litigation.

2.1.10.7. Reservation of domain names

A defensive domain name registration or domain parking is recommended to guard against cyber-squatting and secures a trade mark proprietor's rights to a gTLD or ccTLD.

It is advisable to commence use of your domain name as soon as possible, so as to avoid another party claiming proprietary rights to the domain name.

2.1.10.8. Cyber-squatting

Cyber-squatting refers to the practice of buying domain names that reflect the names of existing businesses or trade marks, with the intention of selling the names back to the relevant businesses or trade mark proprietors for a substantially inflated price.

2.1.10.9. If I register a domain name, will I then own the name?

No, you only own the right to use the name for a defined period, which is usually two years in the first instance. Should you wish to maintain the domain name, you will be required to pay a renewal fee before the expiry of the initial registration period, or risk losing control of the domain name.

A domain name registration does not guarantee the right to keep the name indefinitely, although in practice as long as the domain name registration does not infringe another party's rights and the registration is continually renewed, the domain name will essentially be yours to control and use.

2.1.11. Anti-counterfeiting

2.1.11.1. How can I protect my products against counterfeiting in South Africa?

The Counterfeit Goods Act No. 37 of 1997, was proclaimed to enforce and protect intellectual property right holders against counterfeiting. The Counterfeit Goods Act enables the owner of certain intellectual property rights or any other person with

an interest in the protected goods, including the licensee, importer, exporter, distributor and/or a duly authorised attorney or agent, to act speedily and efficiently against persons involved in counterfeiting on either a criminal or civil level.

2.1.11.2. Which intellectual property rights are protected under this Act?

In order to rely on the provisions of the Act, the counterfeit goods must feature either a trade mark that is registered in South Africa, or constitute a trade mark which is well known in South Africa (whether registered or not), or a copyrighted work and/or the goods must contain a prohibited mark, which is protected under the provisions of the Merchandise Marks Act.

The ambit of the Act does not cover the infringement of registered designs or patents and in such cases, you would have to rely on the provisions of the Patents and Designs Act to prevent the unlawful copying of the protected features of your products.

In order to ensure that you can effectively combat counterfeiting in South Africa, it is necessary to ensure that your intellectual property rights are properly protected in South Africa.

2.1.11.3. What is the procedure for laying a complaint against counterfeiters?

Any person with an interest in the protected goods, who reasonably suspects that a counterfeiting offence is being or has been committed, may lay a complaint with an Inspector, who may be an official appointed by the Minister of Trade and Industry (DTI), a Police official with the rank of Sergeant or higher, or the Commissioner of Customs and Excise.

On laying a complaint, the complainant must furnish the Inspector with sufficient information confirming that an act, prohibited in terms of the Counterfeit Goods Act, is being performed, or is likely to be performed. Once the inspector is satisfied that the complainant is entitled to lodge the complaint, that an intellectual property right subsists in the protected goods, and that the suspicion on which the complaint is founded is reasonable, the Inspector may obtain a warrant for the seizure and removal of all counterfeit goods and evidence that serves to confirm that an act of counterfeiting has been or is being committed.

2.1.11.4. Which Acts are prohibited in terms of the Counterfeit Goods Act?

Any act, which amounts to dealing in counterfeit goods, is prohibited in terms of the Act. These include:

- Possession or control of such goods in the course of business;
- The manufacture or production of such goods for use, other than private or domestic use;
- Selling, hiring out or exchanging of such goods or offering or exposing them for sale;
- Exhibiting such goods for the purposes of trade or any other purpose with the result that the holder of the intellectual property rights suffers prejudice;
- Be imported into or through, or exported from or through the Republic of South Africa, except if such import or export is for the private and domestic use of the importer or exporter; and
- Depositing of such goods in any other manner in the course of trade.

2.1.11.5. What action can be taken once the warrant has been obtained?

The warrant entitles the Inspector and complainant to enter any place, premises or vehicle and to seize, detain or remove any counterfeit goods, collect evidence relating to the counterfeit activities, conduct any searches reasonably necessary, seal off any place, premises or vehicle where counterfeiting activities have been taken place or are taking place, seize or detain and/or remove any tools involved in the counterfeiting activities and procure any relevant documents, books and materials, including supplier and customer details.

Once the suspected counterfeit goods and any evidence relating to the counterfeit activities have been seized and properly recorded in an inventory, the seized goods are then removed and stored in declared counterfeit goods depots, where they will be held pending the finalization of the criminal or civil proceedings against the suspect.

2.1.11.6. Preventing seized goods from re-entering the market

The complainant must elect whether to proceed civilly or criminally against the suspect. Failure to do so within the prescribed time periods will result in the goods being returned to the suspect.

Whether one proceeds civilly or criminally, will normally depend on the circumstances of each case, taking into account the quantity and value of goods seized, whether the offender has previous convictions or whether he is a first time offender and the likelihood of reclaiming costs and damages from the offender.

In cases where large consignments of goods have been seized and the suspect can be easily identified and is in a financial position to comply with a damage and cost order, it is advisable to proceed with civil action against the suspect.

The advantage of proceeding with civil action is that the complainant can claim damages that he has suffered as a result of the act of counterfeiting. The court may also order the seized goods to be delivered up to the intellectual property rights owner, or to the complainant, for destruction and that the identity be disclosed of any person involved in the manufacture, importation and distribution of the counterfeit goods.

In criminal proceedings and upon conviction of an offence in terms of the Act, the person convicted may be fined to an amount not exceeding R5 000 per article, or to imprisonment for a period not exceeding three years, or both such fine and imprisonment. On subsequent convictions, the fine increases to R10 000 per article and the maximum period of imprisonment is 5 years.

Although criminal proceedings are less costly than civil proceedings, there is a substantial delay in obtaining a criminal conviction. This is a factor that must be taken into account by the complainant, as the complainant is liable for the storage costs until the matter is finalized.

2.1.11.7. Can I stop counterfeit goods from being imported into South Africa?

The owner of an intellectual property right protected under the Act may apply to the Commissioner for Customs and Excise to seize and detain all counterfeit goods that fall under Customs control, including goods which are exported from or goods imported into or entering South Africa, thereby providing an effective means of preventing any counterfeit goods from entering the local market. In such cases, the Commissioner requires the complainant to lodge a formal application, setting out the intellectual property rights, to indemnify the customs authorities and cover the expenses associated with the detention, seizure and storage of the counterfeit

goods. Our Anti-Counterfeiting department will be able to assist in the preparation and filing of the application.

- 2.1.11.8. Once the goods have been seized is there a possibility that the goods may be returned to the suspect?

Proceedings in terms of the Act are subject to strict technical requirements and deadlines. If these time limits and procedures are not complied with, the counterfeit goods must be returned to the suspect who may then claim any damages that he may have suffered as a result of the wrongful seizure of the suspected counterfeit goods.

2.2. PATENTABILITY OF BIOTECHNOLOGICAL INVENTIONS

2.2.1. Claiming biotechnological inventions

In terms of section 25(4) of the South African Patents Act no 57 of 1978, a patent shall not be granted for:

- an invention, the publication or exploitation of which, would be generally expected to encourage offensive or immoral behaviour. (A fictional example of such an invention would be a patent for an apple tree containing a gene which expresses a protein in apples which acts as an aphrodisiac in humans); or
- any variety of animal or plant, or any essentially biological process for the production of animals or plants, not being a microbiological process, or the product of such a process.

For an understanding of what an “*essentially biological process*” for the production of animal or plants and “*microbiological process*” or the products of such processes means in the absence of the South African court cases dealing with these definitions, guidance is to be obtained from the European Directive for the Legal Protection of Biotechnological Inventions (Directive 98/44/EC). This Directive entered into force on 30 July 1998 and the EU member states implemented the Directive into their national laws by 30 July 2000.

In terms of this Directive:

“*Biotechnological inventions*” are defined as inventions that concern a product consisting of, or containing, biological material or a process by means of which biological matter is produced, processed or used.

“Biological material” means any material containing genetic information and capable of reproducing itself or being reproduced in a biological system.

A process for the production of plants or animals is *“essentially biological”* if it consists entirely of natural phenomena such as crossing or selection.

“Microbiological process” is defined as any process involving or performed upon or resulting in microbiological material.

“Plant variety” means any plant grouping within a single botanical taxon of the lowest known rank, which grouping, irrespective of whether the conditions for the grant of a plant variety are fully met, can be:

- Defined by the expression of the characteristics that result from a given genotype or combination of genotypes;
- Distinguished from any other plant grouping by the expression of at least one of the said characteristics; and
- Considered as a unit with regard to its suitability for being propagated unchanged.

Biotechnological inventions shall also be patentable if they concern:

- Biological material which is isolated from its natural environment or produced by means of a technical process even if it previously occurred in nature;
- Plants or animals if the technical feasibility of the invention is not confined to a particular plant or animal variety; and
- A microbiological or other technical process or a product obtained by means of such a process other than a plant or animal variety.

Patents shall not be granted in respect of biotechnological inventions which, in particular, concern the following:

- Process for cloning human beings;
- Processes for modifying the germ line genetic identity of humans;

- Uses of human embryos for industrial or commercial purposes; and
- Processes for modifying the genetic identity of animals, that are likely to cause them suffering without any substantial medical benefit to man or animal, and also animals resulting from such processes.

The human body, at the various stages of its formation and development, and the simple discovery of one of its elements, including the sequence or partial sequence of a gene, cannot constitute patentable inventions. However, an element isolated from the human body or otherwise produced by means of a technical process, including the sequence or partial sequence of a gene, may constitute a patentable invention, even if the structure of that element is identical to that of a natural element.

2.2.2. Proposed test of patentability of life sciences inventions in South Africa

When considering the patenting of a life sciences invention in South Africa, it is proposed that the following questions are applied:

1. Is the invention novel?
If YES – see next question
If NO - end of enquiry.
2. Is the invention inventive?
If YES – see next question
If NO - end of enquiry.
3. Is the invention useful? i.e. Is the invention capable of being used or applied in trade/industry/agriculture?
If YES – see next question
If NO - end of enquiry.
4. Is the invention excluded by section 25(2) as being patentable?
If YES – end of enquiry
If NO – see next question.
5. Would the publication or exploitation of the invention encourage offensive or immoral behaviour?
If YES – end of enquiry
If NO – see next question.

6. Does the invention pertain to a variety of animal/plant or an essentially biological process for the production of animals/plants not being a microbiological process/product of such a process?

If YES – end of enquiry

If NO – see next question.

7. Does the invention pertain to the cloning of a human being?

If YES – end of enquiry

If NO – see next question

8. Does the invention pertain to the modification of human germ line genetic ID?

If YES – end of enquiry

If NO – see next question.

9. Does the invention pertain to the use of human embryos for industrial/commercial purposes?

If YES – end of enquiry

If NO – see next question.

10. Does the invention relate to the modification of the genetic identity of animals causing “unjustifiable” suffering?

If YES – end of enquiry

If NO – see next question.

11. Does the invention pertain to the human body at the various stages of its formation and development and not to the simple discovery of one of its elements including the sequence or partial sequence of a gene?

If YES – end of enquiry

IF NO – THEN IT IS PATENTABLE.

2.2.3. Further guidance from Trilateral Project B3B

Further guidance can be obtained from the trilateral project B3B setting out guidelines for the USPTO, EPO and JPO in considering the patentability of DNA fragments:

- A mere DNA fragment without indication of a function or specific asserted utility is not a patentable invention.

- A DNA fragment, of which specific utility, e.g. use as a probe to diagnose a specific disease, is disclosed, is a patentable invention as long as there are no other reasons for rejection.
- A DNA fragment showing no unexpected effect, obtained by conventional method, which is assumed to be part of a certain structural gene based on its high homology with known DNA encoding protein with a known function, is not a patentable invention in Europe and Japan and it would not be patentable in the USA if the specification fails to indicate an asserted utility.
- The mere fact that DNA fragments are derived from the same source is not sufficient to meet the requirement for unity of invention.

2.2.4. Method of treatment claims

Section 25(11) of the South African Patents Act no 57 of 1978 states that an invention of a method of treatment of the human or animal body by surgery or therapy or of diagnosis practiced on the human or animal body shall not be patentable.

However, this shall not prevent a product consisting of a substance or composition being patentable merely because it is invented for use in any such method. Such a product is therefore patentable provided all the other criteria for patentability are met.

In terms of the Concise Oxford English dictionary, “*surgery*” is defined as the treatment of bodily injuries or disorders by incision or manipulation, especially with instruments. “*Therapy*” is defined as treatment intended to relieve or heal a disorder or the treatment of mental or psychological disorders by psychological means. “*Diagnosis*” is defined as the identification of the nature of an illness or other problem by examination of the symptoms. It is generally accepted that the term “*therapy*” should be construed in its wider sense as meaning the medical treatment of disease, including preventative treatment, as well as a curative treatment. It is to be noted that the treatment referred to herein as being unpatentable has to be practiced on the human body (*in vivo*) and that diagnosis practiced *in vitro* would be patentable.

Method of treatment claims – for example, “a method of treating [condition Y] comprising administering [compound X]” are not allowable in South Africa.

2.2.5. Second medical use claims

Section 25(9) of the Patents Act states that in the case of an invention consisting of a substance or composition for use in a method of treatment of the human or animal body by surgery or therapy, or of diagnoses practiced on the human or animal body, the fact that the substance or composition forms part of the state of the art immediately before the priority date of the invention, shall not prevent a patent being granted for the invention if the use of the substance or composition in any such method does not form part of the state of the art at that date. Thus, the novel and inventive use of a known substance is patentable.

In Europe, under the European Patent Convention (EPC) 2000 claim form, second medical uses for example “[Compound X]* for use in the treatment of [condition Y] (*where compound X is a known compound)” – are allowable.

Strictly speaking, South Africa does not permit patents covering new uses of known pharmaceutical compounds (i.e., second medical use claims). Following the European provision, the Patents Act provides that a known substance can be claimed for use in a method of medical treatment only the first time that it is disclosed as being useful in a medical treatment. The South African courts have confirmed this.

Once the use of the compound in a method of medical treatment has formed part of the state of the art, it cannot then be claimed a second time in respect of a new medical use.

In order to overcome this prohibition, South Africa has adopted Swiss-type claims to provide protection in instances where a second medical use is sought to be protected. This serves as a mechanism by which second medical uses are protectable in South Africa, albeit through the Swiss form and not via direct protection of the second medical use.

2.2.6. Swiss-type claims

Swiss-type claims take the form of “Use of [compound X] in the manufacture of a medicament for the treatment of [condition Y]”.

Swiss-type claims focus on the method of manufacture. Once disclosed, the method forms part of the prior art and thus any subsequent Swiss-type claims that vary the dosage regimes may not be patentable.

The position of different claim formulations in South Africa may be summarised as follows:

- Method of treatment claims are not patentable in South Africa;
- Second medical use claims are not patentable in South Africa; and
- Swiss-type claims are patentable in South Africa.

2.3. TYPES OF COSTS ASSOCIATED WITH INTELLECTUAL PROPERTY

Many different kinds of costs will be encountered during the lifespan of most forms of IP. Generally speaking, the types of costs involved with the application for and enforcement of IP are summarised below:

2.3.1. Preparation and filing fees

Cost associated with original preparation and filing of applications to obtain statutory protected IP. These costs include both professional time of IP practitioners, and costs incurred at the IP registration offices.

2.3.2. Prosecution costs

Once filed, the applications for most types of IP are examined at the relevant IP filing offices, usually resulting in oppositions, amendments, reasoned arguments and other substantive communication between the IP practitioner and an examiner. These costs again include professional time of IP practitioners as well as costs incurred at the IP registration offices.

2.3.3. Grant/publication/validation fees

Once the examination or prosecution of the IP application has been successfully completed, grant, publication, printing and translation fees are often payable. This predominantly comprises IP registration office fees.

2.3.4. Maintenance fees

Renewal and/or maintenance fees are payable in order to keep registered IP in force. The frequency of payment differs substantially between the different types of IP, as well as between different jurisdictions.

2.3.5. Enforcement

Once granted, the proprietor of the registered IP has the right to enforce the IP against third parties that may be infringing the same. However, the cost of enforcement is often very high, and only part of the legal costs may be recoverable from a third party is successful.

2.4. INTERNATIONAL IP LAW ASPECTS

2.4.1. Treaties/Conventions

With the exception of the Madrid Protocol, South Africa is a signatory of each of the Treaties and Conventions mentioned in this section.

2.4.1.1. Paris Convention

This Convention was established with the purpose of protecting industrial property, including patents, utility models, industrial designs, trade marks, service marks, trade names, indications of source or appellations of origin, and the repression of unfair competition. The mandate of the Convention is the administration of intellectual property and harmonisation of intellectual property laws amongst the member states, and it is administered by the World Intellectual Property Organisation (WIPO). Perhaps the most important principle contained in the Convention is the undertaking amongst each member states to grant to all subjects of other member states the same protection and advantages that it grants to its own nationals: a principle known as "reciprocity of national treatment".

2.4.1.2. Patent Cooperation Treaty (PCT)

The PCT provides a unified procedure for filing patent applications to protect inventions internationally simultaneously in each of a large number of countries. A single filing results in an international search and a written opinion, and optionally a preliminary examination. Importantly, the filing of a PCT application does not lead to the grant of an "international patent": such a patent does not exist, and applicants will ultimately need to prosecute patent applications through the national patent office of each country in which patent protection is sought. A PCT application may be filed by anyone who is a national or resident of a contracting state to the Treaty. While it is not compulsory to file a PCT application if one intends obtaining foreign patent protection, it does provide many advantages e.g. The time period in which to decide how to proceed and in which to pay prosecution fees is extended by up to 18 months; and since each application is published

together with a search report, applicants are in a better position to formulate a well-founded opinion about the patentability of the claimed invention, before deciding on whether to continue patent prosecution in individual states.

2.4.1.3. Budapest Treaty

The Budapest Treaty on the International Recognition of the Deposit of Microorganisms for the Purposes of Patent Procedure, to give its full title, is also administered by WIPO. The central feature of this Treaty is the requirement that all contracting states that allow or require the deposit of microorganisms for the purposes of patent procedure must recognise, for such purposes, the deposit of a microorganism with any international depositary authority. The Treaty makes the patent system of the contracting states more attractive and is primarily advantageous to the depositor: the deposit of a microorganism under the procedures provided are cost advantageous because, instead of depositing the microorganism in every contracting State in which an applicant files a patent application referring to that microorganism, he will have to deposit it only once, with one depositary authority. In addition, the Treaty increases the security of the depositor because it establishes a uniform system of deposit, recognition and furnishing of samples of microorganisms.

2.4.1.4. UPOV Convention

The International Union for the Protection of New Varieties of Plants (UPOV) is an intergovernmental organisation, which has as its objective the protection of new varieties of plants by way of intellectual property rights. The Convention provides a unique form of intellectual property protection, adapted specifically for the process of plant breeding and that has been developed with the aim of encouraging breeders to develop new varieties of plants. Just as in the case of the Paris Convention, the principle of reciprocity of national treatment is also a fundamental feature of the UPOV Convention.

2.4.1.5. Berne Convention

The Berne Convention for the Protection of Literary and Artistic Works, usually known as the Berne Convention, is an international agreement concerned with copyright. The Berne Convention requires its member states to protect the copyright of works of authors from other member states in the same way it protects the copyright of its own nationals. Significantly, though, under this Convention, an author is not entitled to longer protection abroad than at home, even if the laws

abroad give longer protection. The Berne Convention also serves the interests of publishing industries and authors by requiring member states to provide strong minimum standards for copyright law.

2.4.1.6. Madrid System for International Registration of Marks

Whilst the name of this system refers to “international registration”, it must be understood that although the system provides an efficient and cost effective method of obtaining registration of a trade mark covering multiple countries, as will become apparent from the discussion below, it is not possible to simply file a single application that will automatically cover the entire world.

The system of international registration of marks is governed by two treaties:

- The Madrid Agreement, concluded in 1891 and revised at Brussels (1900), Washington (1911), The Hague (1925), London (1934), Nice (1957), and Stockholm (1967), and amended in 1979; and
- The Protocol relating to that Agreement, which was concluded in 1989, with the aim of rendering the Madrid system more flexible and more compatible with the domestic legislation of certain countries which had not been able to accede to the Agreement.

The Madrid Agreement and Protocol are open to any State that is party to the Paris Convention for the Protection of Industrial Property. The two treaties are parallel and independent and States may adhere to either of them or to both. In addition, an intergovernmental organization that maintains its own Office for the registration of marks may become party to the Protocol. Instruments of ratification or accession must be deposited with the Director General of WIPO. States and organizations that are party to the Madrid system are collectively referred to as Contracting Parties.

The system makes it possible to protect a mark in a large number of countries by obtaining an international registration that is effective in each of the Contracting Parties that has been designated.

2.4.1.6.1. *Who may use the system?*

An application for international registration may be filed only by a natural person, or legal entity, having a connection, through establishment, domicile or nationality, with a Contracting Party to the Agreement or the Protocol. As mentioned above in

the chapter dealing with foreign trade marks, this means that the natural person must be domiciled in, a national of, or have a real and effective industrial or commercial establishment in a Madrid member country.

A mark may be the subject of an international application only if it has already been registered with the Trade Mark Office (referred to as the Office of origin) of the Contracting Party with which the applicant has the necessary connections. However, where all the designations are effected under the Protocol (see below), the international application may be based on a mere application for registration filed with the Office of origin. An international application must be presented to the International Bureau of WIPO through the intermediary of the Office of origin.

2.4.1.6.2. *The international application*

An application for international registration must designate one or more Contracting Parties where protection is sought. Further designations can be effected subsequently, by way of a subsequent designation. A Contracting Party may be designated only if it is party to the same treaty as the Contracting Party whose Office is the Office of origin. The latter cannot itself be designated in the international application.

The designation of a given Contracting Party is made either under the Agreement or under the Protocol, depending on which treaty is common to the Contracting Parties concerned. If both Contracting Parties are party to both the Agreement and the Protocol, the designation will be governed by the Agreement, in accordance with the so-called “safeguard clause”.

Where all the designations are effected under the Agreement, the international application and any other subsequent communication must be in French. Where at least one designation is effected under the Protocol, the applicant has the option of English or French, unless the Office of origin restricts this choice to one of these.

2.4.1.6.3. *International registration*

Once the International Bureau receives the application for international registration, it carries out an examination for compliance with the requirements of the Agreement, the Protocol, and the Common Regulations. This examination is restricted to formalities, including the classification and comprehensibility of the list of goods and/or services; any matter of substance, such as whether the mark qualifies for protection or whether it is in conflict with an earlier mark, is left to each

designated Contracting Party to determine. If there are no irregularities, the International Bureau records the mark in the International Register, publishes the international registration in the WIPO Gazette of International Marks, and notifies it to each designated Contracting Party.

2.4.1.6.4. *Refusal of protection*

The designated Contracting Parties may examine the international registration for compliance with their domestic legislation and, if some substantive provisions are not complied with, they have the right to refuse protection in their territory. Any such refusal, including the indication of the grounds on which it is based, must be communicated to the International Bureau, normally within 12 months from the date of the notification. However, a Contracting Party to the Protocol may declare that, when it is designated under the Protocol, this time limit is extended to 18 months. Such a Contracting Party may also declare that a refusal based on an opposition may be communicated to the International Bureau even after this time limit of 18 months.

The refusal is communicated to the holder, recorded in the International Register and published in the Gazette. The procedure subsequent to a refusal (such as an appeal or a review) is carried out directly between the administration or court of the Contracting Party concerned and the holder, without any involvement of the International Bureau. The final decision concerning the refusal must, however, be communicated to the International Bureau, which records and publishes it.

It must be noted that if the office of the designated Contracting Party does not undertake examination of an application for international registration within the applicable 12 or 18-month period after the date of designation, or notify the International Bureau that this time period will not be complied with, the mark will be deemed to be registered in that country after expiry of the relevant 12 or 18-month period.

2.4.1.6.5. *Effects of an international registration*

The effects of an international registration in each designated Contracting Party are, as from the date of the international registration, the same as if the mark had been deposited directly with the Office of that Contracting Party. If no refusal is issued within the applicable time limit, or if a refusal originally notified by a Contracting Party is subsequently withdrawn, the protection of the mark in

question is, from the date of the international registration, the same as if it had been registered by the Office of that Contracting Party.

Protection may be limited with regard to some or all of the goods or services or may be renounced with regard to only some of the designated Contracting Parties. An international registration may be transferred in relation to all or some of the designated Contracting Parties and all or some goods or services.

2.4.1.6.6. *Advantages of the Madrid System*

The system of international registration of marks has several advantages for trade mark owners. Instead of filing many national applications in all countries of interest, in several different languages, in accordance with different national procedural rules and regulations and paying several different (and often higher) fees, an international registration may be obtained by simply filing one application with the International Bureau (through the Office of the home country), in one language (either English or French) and paying only one set of fees.

Similar advantages exist when the registration has to be renewed; this involves the simple payment of the necessary fees, every 10 years, to the International Bureau. Likewise, if the international registration is assigned to a third party or any other change, such as a change in name and/or address, has occurred, this may be recorded with effect for all the designated Contracting Parties by means of a single procedural step.

2.4.1.7. TRIPS

The Agreements on Trade-Related Aspects of Intellectual Property Rights (TRIPS) binds all member states of the World Trade Organisation (WTO), with the purpose of ensuring adequate standards of protection in all member states. Unlike the Paris Convention, however, TRIPS provides for minimum standards that each government must implement, and means for enforcing associated rights. The TRIPS Agreement extends to the following types on intellectual property: copyright, trade marks and service marks, geographic indications, industrial designs, integrated circuit topographies, and trade secrets. The TRIPS Agreement also adopts the principles of reciprocity of national treatment and of “favoured nation” status being applied reciprocally amongst member states. In addition, the TRIPS Agreement provides for dispute settlement procedures between member states.

2.4.2. IP law of selected foreign jurisdictions

2.4.2.1. United States of America (US)

The US is a member state of the Paris Convention, the Patent Cooperation Treaty (PCT) and the International Convention for the Protection of New Plant Varieties (UPOV).

The US has various types of protection for intellectual property. These include utility patents, design patents, plant patents, plant variety protection certificates, and statutory invention registrations.

2.4.2.1.1. *Utility patent*

A US utility patent is equivalent to a South African patent. The requirements for a utility patent are that the invention must be a new, useful, and non-obvious process, machine, manufacture, or composition of matter.

The novelty requirements of the US are more complicated than any other country. Of note is the novelty grace period of 12 months from the time of disclosure, within which an application should be filed.

A utility patent is valid for 20 years from date of filing a PCT application or, if the application is a convention application, from the date of filing the convention application.

Patentable subject matter includes: computer program related inventions; business methods; novel compositions of matter; micro-organisms; non-naturally occurring live organisms; asexually produced plants; new uses of known inventions; and processes consisting only in the use of a mechanism.

Unpatentable inventions include scientific principles; laws of nature; natural phenomena; abstract ideas; mathematical models; mere ideas; suggestions; semiconductor chips; printed matter; nuclear or atomic inventions; and computer programs.

Patent applications undergo substantive examination before they are granted.

2.4.2.1.2. *Design patents*

A design patent may be obtained for any new, non-obvious, original and ornamental design for an article. A design patent protects only the appearance of the article and not structural or utilitarian features.

The proceedings relating to granting of design patents are the same as those relating to utility patents.

US design patents are valid for 14 years from the date of grant.

2.4.2.1.3. *Plant patents and Plant Variety Protection certificates*

US Plant patents may be granted for varieties of plants that are asexually reproduced.

The requirements for a plant patent are that the variety must be a new and distinct variety of plant. This includes cultivated sports, mutants, hybrids, and newly found seedlings. A plant patent will not be granted for tuber-propagated plant or a plant found in an uncultivated state. Algae and macro fungi are regarded as plants, but bacteria are not.

The term of a plant patent is 20 years from the date on which the application for the patent was filed in the United States or, if the application contains a specific reference to an earlier filed application from the date of the earliest such application was filed.

A separate system provides for the protection of sexually reproduced varieties in the form of a plant variety protection certificate. Asexually propagated plants are those that are reproduced by means other than from seeds, such as by the rooting of cuttings, by layering, budding, grafting, inarching, etc. The requirements for protection are that the variety be uniform, stable, and distinct from all other varieties.

A Certificate of Protection remains in effect for 18 years from the date of issuance.

2.4.2.1.4. *Statutory invention registrations*

A statutory invention registration is not a patent. It has the defensive attributes of a patent, but does not have the enforceable attributes of a patent.

An applicant for a US patent may request, during the pendency of applicant's complete application, that the application be published as a statutory invention registration. The applicant, therefore, waives his right to receive a patent. The application is published and once published, cannot be claimed by another person. This is done to prevent others from obtaining a patent for the same subject matter.

2.4.2.1.5. *Trade marks*

See "Foreign trade marks" above.

2.4.2.2. *Australia (AU)*

Australia is a member state of the Paris Convention, the PCT and UPOV. There are four kinds of protection available, namely standard patents, innovation patents, registered designs and plant breeders' rights.

2.4.2.2.1. *Standard patent*

To be patentable, an invention, which is a manner of manufacture, must be novel, useful and involve an inventive step.

An invention must not have been disclosed anywhere in the world for an invention to be novel. A novelty grace period of 12 months is available if the applicant has disclosed the invention. In certain circumstances, however, a shorter novelty grace period of six months is applicable.

A standard patent is valid for 20 years from date of filing a PCT application or, if the application is a convention application, from the date of filing the convention application.

Patentable subject matter includes computer programmes, foodstuffs, method of treatments, business claims, animal varieties, plant varieties, microbiological processes, products of these processes and microbes.

Unpatentable subject matter includes human beings, biological processes in the production of human beings, inventions the use of which are contrary to law, substances that are mere mixtures of known ingredients or processes for producing these mixtures, semi-conductive chips.

All applications for standard patents undergo substantive examination. Australia uses a deferred system of examination, which means that once an application has been filed, a request for examination must be lodged within five years from the filing date. If such a request is not filed, the application lapses.

2.4.2.2.2. *Innovation patent*

An Australian innovation patent can be applied for if an invention does not meet the higher inventive threshold required for standard patents. The innovation patent requires an *innovative step* rather than an *inventive step*.

An innovation patent will not be granted for plants, animals, and biological processes for their generation, or humans.

The innovation patent provides protection for 8 years.

An innovation patent is granted within one month, without examination, whereas a standard patent may take up to four years. An innovation patent is, however, unenforceable unless it has been examined. An applicant must therefore request examination after grant if the applicant wishes to enforce the patent.

2.4.2.2.3. *Registered designs*

In Australia, a design, in relation to a product, means the overall appearance of the product resulting from one or more visual features of the product.

To be registrable, a design must be new and distinctive. 'New' means that an identical design has not been publicly used in Australia nor published in a document within or outside Australia. A design is distinctive unless it is substantially similar in overall impression to a design that has been publicly used in Australia or to a design published in a document within or outside Australia. A novelty grace period of six months is available in limited circumstances.

The design registration lasts for a period of 10 years from the date of the application.

Design applications only undergo formal examination before being registered. There is a post-registration substantive examination which will only be undertaken if requested. An Australian design will only be enforceable if it has undergone substantive examination.

2.4.2.2.4. *Plant Breeder's Rights*

In Australia plant varieties may be protected by way of a standard patent, provided the variety complies with the requirements, or a plant breeder's right. It is possible to obtain both forms of protection at the same time.

A plant breeder's right may be obtained for new or recently exploited varieties which are distinct, uniform and stable.

A new variety is one that has not been sold with the breeder's consent. A recently exploited variety is one which has been sold with the breeder's consent within 12 months in Australia and within for four years for overseas varieties. A six-year overseas prior sale limit is permitted for trees and vines.

Plant breeders' rights endure for 25 years from the date of granting in the case of tree and vine varieties. For all other varieties, the plant breeder's right continues for 20 years from the date of granting. Transgenic plants, algae and fungi can be protected by way of plant breeders' rights.

2.4.2.2.5. *Trade marks*

Australia is a member of the Madrid System for International Registration of Marks as well as the Paris Convention for Protection of Industrial Property. It is possible to claim priority under the Paris Convention in Australia.

The types of trade marks that may be registered in Australia include words, phrases, letters, numbers, slogans, logos, packaging, pictures or any combination of these. It is also possible to register certification marks and collective marks, as well as sound and smell marks. Australia also provides for the registration of series marks.

Australia follows a multi-class classification system in terms of the Nice classification of goods and services.

Common law trade marks and well-known trade marks in terms of the Paris Convention are recognised and enforceable in Australia.

Trade mark registrations are valid for 10 years from the date of filing and may be renewed for any number of subsequent 10-year periods.

A registered trade mark may be cancelled on action by an interested party if it has not been used for a continuous period of 3 years after the date of registration.

2.4.2.3. Japan (JP)

Japan is a member state of the Paris Convention, the PCT and UPOV. There are three kinds of protection available, namely patents of invention, utility models, and plant breeders' rights.

2.4.2.3.1. *Patent*

The invention should be novel, involve inventive merit and be capable of being used in industry to be patentable.

An invention must not have been disclosed anywhere in the world for the invention to be novel in Japan. A novelty grace period of six months is available, but in limited circumstances.

The duration of a standard patent is twenty years from the date of filing.

Patentable subject matter includes computer programme related inventions, foodstuffs, beverages, refreshments and methods to prepare, substances manufactured through nuclear transformation, animals and plants, as long as the requirements for patentability are met, microbiological processes, products of these processes, and microbes.

Japan also makes use of a deferred system of examination, which means that substantive examination must be requested within three years from the date of filing. If this is not done the application will lapse.

2.4.2.3.2. *Utility model*

Any novel device relating to shape, construction, or assemblage of an article may be the subject of a utility model application.

The novelty requirements are the same as for a patent application.

Methods, computer software, chemical compositions and plant and animal varieties may not be registered.

The duration of a utility model is 10 years from the date of application.

A utility model application does not undergo substantive examination before registration and is enforceable without examination.

2.4.2.3.3. *Plant breeders' rights*

Plant variety protection may be obtained for varieties that are novel, distinct, uniform and stable. It is possible to obtain patent protection for plant varieties provided they meet the requirements for a patent.

A variety will not be novel if the seeds and seedlings or harvested material of the variety have been transferred in the course of business, in Japan earlier than one year before the date of application for variety registration, or in a foreign country earlier than four years before the date of such an application for variety registration.

The Duration of a breeders' right is twenty-five years (thirty years in the case of perennial plants) from the date of variety registration.

2.4.2.3.4. *Trade marks*

Japan is a member of the Madrid System for International Registration of Marks as well as the Paris Convention for Protection of Industrial Property. It is possible to claim priority under the Paris Convention in Japan.

The types of trade marks that may be registered in Japan include words, phrases, letters, numbers, slogans, logos, packaging, pictures or any combination of these. It is also possible to register hologram marks and sound marks in Japan.

Japan follows a multi-class classification system in terms of the Nice classification of goods and services.

Well-known trade marks are recognised and enforceable in Japan.

Trade mark registrations are valid for 10 years from the date of filing and may be renewed for any number of subsequent 10-year periods.

A registered trade mark may be cancelled on action by an interested party if it has not been used for a continuous period of 3 years after the date of registration.

2.4.2.4. Europe

In Europe it is possible to obtain protection for patents of invention, community designs and community plant variety rights. Each form of protection is administered by a separate body and is therefore applicable to different countries.

2.4.2.4.1. *Patents*

The European Patent Convention (EPC) established the European patent office. The European patent system is a regional system and the effect of a European patent application is that the application is deemed to be made in every country that is designated.

The member states are: Austria; Belgium; Bulgaria; Croatia; Cyprus; Czech Republic; Denmark; Estonia; Finland; France; Greece; Germany; Hungary; Iceland; Ireland; Italy; Latvia; Liechtenstein; Lithuania; Luxembourg; Malta; Monaco; Netherlands; Norway; Poland; Portugal; Romania; Slovenia; Slovakia; Spain; Sweden; Switzerland; Turkey and the United Kingdom.

States which recognise European patents and where protection is also possible through bilateral treaties include: Albania; Bosnia; Herzegovina; the former Yugoslav Republic of Macedonia; and Serbia.

Once a European patent is granted, a further step of validating in all countries where protection is sought must be taken. If the patent is not validated in a designated member country, no national patent will result in that country. A granted European patent does not confer any rights on an applicant unless it is validated in a member country.

A patent applicant has a choice to file directly in a particular country or to file one European patent application and to validate in selected countries. Usually the cost of the application decides which route to take. One European patent application will result in a bundle of national patents once the application has been validated in the member countries.

A European patent may be granted for an invention that is new, involves an inventive step and is susceptible to industrial application.

The invention must not have been disclosed anywhere in the world as absolute worldwide novelty is required, but a novelty grace period of six months is granted in limited circumstances.

The following subject matter is not patentable: discoveries; scientific theories and mathematical models.

Patentable subject matter includes a computer programme related invention, a method of treatment of the human or animal body. Animal varieties or essentially biological processes for the production of animals are not patentable. Patent protection is available for plants.

Biotechnological inventions may be patented provided they are novel, inventive and capable of industrial application.

Patent applications undergo rigorous substantive examination before grant.

2.4.2.4.2. *Community designs*

The European Union (EU) provides for a system for the protection of designs. The system is administered by the European Union Intellectual Property Office.

There are two types of design rights that exist. The first is an unregistered Community design right which is similar to copyright, whereas the second is a registered Community design right.

A design is defined as the appearance of the whole or part of a product resulting from the features of, in particular, the lines, contours, colours, shape, texture, and/or materials of the product itself and/or its ornamentation.

To be registerable, designs must be new and have an individual character. A design will be new if no identical design has been made available to the public before the date of application or priority date. A novelty grace period of 12 months is available in certain circumstances.

A registered Community design is valid for up to 25 years, subject to payment of renewal fees in block of five years. On the other hand, an unregistered Community design is afforded protection of a period of three years only from the date on which the design was first made available to the public with the territory of the EU.

Protection for registered Community designs may be obtained through a single application to the European Union Intellectual Property Office. A granted application is effective in all member states of the EU.

The member states of the EU include Austria, Belgium, Bulgaria, Croatia, Cyprus, Czech Republic, Denmark, Estonia, Finland, France, Germany, Greece, Hungary, Ireland, Italy, Latvia, Lithuania, Luxembourg, Malta, the Netherlands, Poland, Portugal, Romania, Slovakia, Slovenia, Spain, Sweden, and the United Kingdom.

Candidate member countries include Albania, Montenegro, Serbia, Former Yugoslav Republic of Macedonia and Turkey.

2.4.2.4.3. *Community plant variety right*

Protection for plant varieties in the EU may be obtained through a single application to the Community Plant variety office. A granted application is effective in most of the member states of the EU.

Protection is granted for plant varieties which are new, distinct, uniform and stable.

A granted Community plant variety right is valid for a period of 25 years, or 30 years for trees, vines and potatoes.

A variety shall be deemed to be new if, at the date of application, constituents or harvested material of the variety have not been disposed of to others, by or with the consent of the breeder, for purposes of exploitation of the variety: earlier than one year before the abovementioned date, within the territory of the Community; or earlier than four years or, in the case of trees or of vines, earlier than six years before the said date, outside the territory of the Community.

A variety which is the subject matter of a Community plant variety right may not be the subject of a national plant variety right or any patent for that variety within any of the member states. Any national rights which co-exist with a Community plant variety right, for the same variety are unenforceable.

2.4.2.4.4. *European Trade Mark (EUTM)*

The European Intellectual Property Office (EUIPO) is a member of the Madrid System for International Registration of Marks as well as the Paris Convention for Protection of Industrial Property. It is possible to claim priority under the Paris Convention when filing an EUTM.

The types of trade marks that may be registered in as EUTM's include words, phrases, letters, numbers, slogans, logos, packaging, pictures or any combination of these. It is also possible to register certification marks and collective marks, as well as sound and smell marks.

The EUIPO follows a multi-class classification system in terms of the Nice classification of goods and services.

Common law trade marks and well-known trade marks in terms of the Paris Convention are recognised and enforceable in the EU.

Trade mark registrations are valid for 10 years from the date of filing and may be renewed for any number of subsequent 10-year periods.

A registered trade mark may be cancelled on action by an interested party if it has not been used for a continuous period of 3 years after the date of registration in at least one EU member state.

2.4.2.5. GCT

The Gulf Cooperation Council created a common patent system similar to that of the Eurasian Patent Convention.

Its member countries are Bahrain, Kuwait, Oman, Qatar, Saudi Arabia and the United Arab Emirates.

It is possible to obtain protection for patents and designs.

2.4.2.5.1. *Patents*

Under the GCC patent system, a patent may be obtained which extends to all its member states at once.

To be patentable an invention must be new, involve an inventive step and must be applicable in industry.

The novelty of an invention shall not be destroyed by disclosure of the invention within one year before the filing date or priority date as a result of an abuse made by a third party against the applicant or his predecessor in title; or by a display

within six months preceding the filing or priority date at an officially recognised international exhibition by the applicant or his predecessor in title.

A patent has a duration of 20 years from the date of filing an application, subject to the payment of annual fees.

2.4.2.5.2. *Designs*

There is at present no unified design registration or protection system within the GCC.

In Bahrain, Kuwait and the United Arab Emirates applications for the registration of a design may be filed.

In Oman, a design law has been adopted but is at present not yet operative.

In Qatar and Saudi Arabia there is at present no design law.

2.4.3. IP law of Africa

2.4.3.1. African Regional Intellectual Property Organisation (ARIPO)

ARIPO was established in 1976 as the Industrial Property Organization for Africa by the Lusaka Agreement. Originally, membership was open only to the English speaking African countries, but has since been amended and is open to all members of the UN Economic Commission for Africa of the African Union. The administrative headquarters are situated in Harare, Zimbabwe.

ARIPO is a member of the Paris Convention and it is possible to file independent applications claiming Convention priority. ARIPO is also a member of the PCT and may be designated in a PCT application.

There are currently eighteen states that are party to the Lusaka Agreement and therefore members of ARIPO. These are: Botswana, Gambia, Ghana, Kenya, Lesotho, Liberia, Malawi, Mozambique, Namibia, Rwanda, Sao Tome e Principe, Sierra Leone, Somalia, Sudan, Swaziland, Tanzania, Uganda, Zambia and Zimbabwe.

ARIPO has adopted the Harare Protocol on Patents and Industrial Designs and the Banjul Protocol on Marks. Through these protocols, it is possible to obtain

protection for patents, industrial designs, utility models and trade marks in all of the member countries through a single application. This has the effect of a national application and means that the applicant must still validate the patent, design, model or trade mark application in each designated country. A member state is not obliged by the protocol to grant the patent, design, model or trade mark as the member countries maintain their own national laws and it is accordingly also possible to file directly in any member country.

All ARIPO states are also members of the PCT and may thus be designated when entering the regional phase of the PCT application.

As stated above, an ARIPO application designated to a member state will be examined for compliance with that state's own national legislation and this may require amendments of the designated application. ARIPO therefore does not replace the various national legislations, as is the case with OAPI, but it does require all member states to provide an equal duration of protection of the various forms of intellectual property as provided by the ARIPO Protocols.

2.4.3.1.1. *Patents*

Applications for the registration of a patent can be lodged at the Industrial Property Office of any contracting state, or directly with the ARIPO Office.

Applications for the grant of patents should designate the member state(s) where protection for the inventions is required, although enforceable protection will depend on the national laws of each state. Applications must be lodged in English or be accompanied by a verified translation.

A patent will be granted if the invention is found to be novel, inventive and industrially applicable. Absolute novelty is a requirement however, a six-month novelty grace period is applicable if the inventor or his successor discloses the invention by exhibiting it at an officially recognised international exhibition.

As member states retain their national laws on IP, patentability criteria differ from one country to another country. Amendments may be necessary depending on the member state the patent is to be validated in.

Examination of patents are substantive and based on search and examination reports. A patent has a duration of 20 years from the filing date, subject to renewal fees being paid. Where a renewal annuity is missed and not paid within six months of the date of the renewal, the patent will lapse. Restoration of the patent is at the discretion of the Director-General of ARIPO and may be requested.

Since 1 January 2017, substantive examination has to be requested at the ARIPO Office. Thus, if an application has an international filing date of 1 January 2017 or later, examination will have to be requested within three years of the filing date. Applications with an international filing date of 1 January 2017 or earlier, will still be examined automatically and no extension is required.

2.4.3.1.2. *Industrial designs*

Applications for the registration of industrial designs can be lodged at the industrial property office of any member state, or directly with the ARIPO Office.

A registered design is a monopoly right for the appearance of the whole or a part of a product resulting from the features of, in particular, the lines, contours, colours, shape of the product or its ornamentation. Textile designs are not registrable under the Harare Protocol. Ghana does provide for the registration of textile designs, but an applicant will not be able to register the design via ARIPO and will have to file a national application at the industrial property office of Ghana.

To qualify for registration, a design must be new and have individual character.

New, meaning that it must not be the same as any design which has already been made available to the public. Individual character refers to the overall impression the design produces on an informed user which must differ from the overall impression produced on such a user by any design which has already been made available to the public. In assessing individual character, account is taken as to the degree of freedom of the designer in creating the design. Different member states have different laws relating to designs, thus some states only recognise aesthetic designs and others recognise both aesthetic and functional designs.

Examination as to form will be carried out to determine whether the mandatory application requirements have been met. Substantive examination is not carried out by the ARIPO Office, but upon approval of the formal examination, the ARIPO Office will forward the design application to the designated state(s), which carry out the substantive examination. The designated state(s) has six months from receiving the application to examine and inform the ARIPO Office that the design will have no effect in its jurisdiction. If the six-month period lapses without the ARIPO Office having received a notification of rejection, the design will be registered in that state(s).

An industrial design has a duration of 10 years from the filing date, subject to renewal annuities being paid.

2.4.3.1.3. *Utility models*

It is possible to protect a utility model if it is new and applicable in industry. The Harare Protocol places no burden of inventiveness on utility models, although this requirement is still applicable in some of the member states.

Utility model means any form, configuration or disposition of elements of some appliance, working tools and implements and articles of everyday use, electrical and electronic circuitry of another object or part thereof, in so far as they are capable of contributing some benefit or new effect of saving in time, energy, or labour or improving the hygienic or socio-physiological working conditions by means of new configuration, arrangement or device or a combination thereof, and are industrially applicable.

Some member states do not recognise utility models, which means the applicant will need to file his/her invention as a patent or a design. It is therefore important to understand that even if an ARIPO utility model is granted it will be limited to those states that recognise this form of intellectual property.

Patents can be converted into utility models or vice versa and utility models and patents may be converted into national applications on request.

Applications for registration of utility models are filed directly with the ARIPO Office or the industrial property office of any member state.

Examination must be requested for applications with an international filing date of 1 January 2017 or later. Applications filed before 1 January 2017 will be examined automatically. The ARIPO Office will conduct the substantive examination and upon approval, the application is forwarded to the designated state(s). Each state then has six months from the date of the notification to object to the grant of the utility model in their jurisdiction. If the ARIPO Office does not receive a notification of objection, it will grant the utility model in respect of all states designated.

A utility model has a duration of 10 years from the date of filing.

2.4.3.1.4. *Trade marks*

A trade mark constitutes any sign that individualises the goods of a given enterprise and is capable of distinguishing such goods from the goods of competitors.

The application for a mark must be filed either directly at the ARIPO Office in Harare, Zimbabwe or via the Industrial Property Office of any member state referred to as the Receiving Office.

The Office shall examine the application for compliance with formal requirements, and accord the appropriate filing date to the application.

The duration of the protection is 10 years and is indefinitely renewable for periods of 10 years each.

2.4.3.1.5. *Copyright*

The Lusaka Agreement and the Harare Protocol only address industrial property rights and accordingly contains no provision for dealing with copyright.

The national laws of the ARIPO member states will determine the position regarding copyright protection.

2.4.3.1.6. *Plant breeders' rights*

Plant breeders' rights are protected under the Arusha Protocol, which currently has four member states, including The Gambia, Ghana, Mozambique and São Tomé & Príncipe.

To be granted a plant breeders' right the variety must be new, distinct, uniform and stable. An application must be brought to the ARIPO Office.

Once granted, the term of protection is 25 years for vines and trees and 20 years in respect of all other plants.

The regulations to the Protocol have not been implemented yet, and thus it is not practically possible to file an application for a plant breeders' right through the ARIPO Office.

2.4.3.2. Algeria

2.4.3.2.1. *Patents*

Algeria is a member of the Paris Convention and the PCT. Patent protection is thus obtainable by either a national application or by way of an international application under the PCT. In a national application priority may be claimed from another convention country.

Patentable subject matter must be novel, inventive and capable of being used and applied in industry. Subject matter that is unpatentable in Algeria is substantially similar to unpatentable subject matter according to South African patent laws. Absolute novelty is required and the invention may not have been disclosed to the public in any way prior to the filing date thereof. A novelty grace period of twelve months is applicable in cases where any manufacturing or preparatory work has been carried out on the invention by the inventor or his predecessor in title, where a third party perpetuated an abuse of rights or if the invention is disclosed at an internationally recognised exhibition.

Only formal examination is conducted, but if a patent is filed via the PCT system, it would have undergone substantive examination. A patent has a duration of 20 years from the date of filing. Patents must be worked within four years of filing or three years from grant, otherwise the government has the power to extend compulsory licenses to other parties.

2.4.3.2.2. *Designs*

Design protection may be obtained by way of a national filing. Applications may also claim convention priority from other countries since Algeria is a member of the Paris Convention.

A registered design may be obtained for the appearance of the whole or a part of a product resulting from the features of, in particular, the lines, contours, colours, shape, texture materials of the product or its ornamentation and layout designs (topography) for the elements and connections of integrated circuits.

Priority may be claimed from another convention application as is provided for in the Paris Convention, provided that the application is filed within six months of the priority date.

The duration of a design is 10 years from the date of filing.

2.4.3.2.3. *Trade marks*

Algeria is a party to the Madrid System for International Registration of trade marks and the Paris Convention for Protection of Industrial Property. It is possible to claim priority under the Paris Convention.

Algeria follows a multi-class filing system and recognises both goods and services classes in terms of the Nice Classification.

Trade mark applications are examined for compliance with formal and substantive requirements and are published in the official gazette after acceptance. There is no provision for opposition proceedings.

Algeria is a first to file jurisdiction and there is no statutory provision for the protection of common law trade mark rights. Well-known trade marks in terms of the Paris Convention are, however, recognised and enforceable in Algeria.

Trade mark registrations are valid for 10 years from the date of filing and may be renewed indefinitely for 10-year periods thereafter.

A registered trade mark may be cancelled on action by an interested party if it has not been used for a continuous period of 3 years after the date of registration.

2.4.3.2.4. *Copyright*

All original works as mentioned in section 2.1.7.2, enjoy protection in Algeria.

The duration of copyright protection generally endures for the lifetime of the author plus 50 years.

2.4.3.2.5. *Plant breeders' rights*

These rights are governed by Algerian national legislation relating to seeds, plantations and the protection of plants. This law must be consulted in conjunction with the legislation on patents. No further details regarding the application for plant breeders' rights were available at the time of publication of this document.

2.4.3.3. Angola

2.4.3.3.1. *Patents*

Angola is a member of the PCT and the Paris Convention. Applications claiming Convention priority must be filed within 12 months of the priority date.

A patent may be obtained for any invention which makes it possible to solve a particular technological problem by a product or a process. It must be new, involve an inventive step and be capable of being applied in industry.

Only formal examination is conducted and if the application complies with the requirements, it will be accepted and published. The patent will be published in the Official Bulletin and third parties will have six months from the publication thereof to oppose the application. If no opposition is filed, the patent will proceed to grant.

A patent endures for 15 years from the date of filing.

2.4.3.3.2. *Designs*

The protection for a design may be obtained via the Industrial Property Act. Angola is a member of the Paris Convention and priority may be claimed upon national filing.

A design is claimed for any shape or form that may be associated with lines or colours and is used in the manufacture of an industrial or handcrafted article.

Only formal examination is conducted. Upon compliance with the formal requirements it will be published in the Angola Official Bulletin of Industrial Property. Once all issuance fees have been paid, the Certificate of Registration will be issued.

The duration of the registration is 5 years from the filing date, which may be renewed for two 5-year periods, for a total duration of 15 years.

2.4.3.3.3. *Utility Models*

A utility model relates to any new shape or arrangement introduced into an object, mainly tools, which improves the usefulness of that object.

Only formal examination is conducted. Upon compliance with the formal requirements it will be published in the Angola Official Bulletin of Industrial Property. Once all issuance fees have been paid, the utility model will be granted.

The utility model endures for five years from the filing date, which may be renewed for two five-year periods, for a total duration of 15 years.

2.4.3.3.4. *Trade marks*

Angola is a party to the Paris Convention for Protection of Industrial Property. It is possible to claim priority under the Paris Convention.

A mark may be composed of any visual, nominative, figurate or emblematic sign that distinguishes the products or services to which it relates from another enterprise.

Angola follows a single class filing system and recognises both goods and services classes in terms of the Nice Classification.

Trade mark applications are examined for compliance with formal requirements only and are published in the official bulletin after registration. Trade marks may be opposed within 60 days of the date of publication in the bulletin.

Angola is a first to file jurisdiction and there is no statutory provision for the protection of common law trade mark rights. Well-known trade marks in terms of the Paris Convention are not recognised.

Trade mark registrations are valid for 10 years from the date of filing and may be renewed indefinitely for 10-year periods thereafter.

A registered trade mark may be cancelled on action by an interested party if it has not been used for a continuous period of 2 years after the date of registration.

2.4.3.3.5. *Copyright*

Angola has national legislation controlling copyright related aspects, but is not a member of the Berne Convention.

Works eligible for copyright are the same as discussed in section 2.1.7.2 in this manual.

Copyright in a work endures for the lifetime of the author plus 50 years after his/her death. This additional period is shortened to 25 years in respect of photographic works or works of applied art.

2.4.3.4. Benin

Benin has no separate industrial property laws or systems and industrial property protection in this jurisdiction is conferred by the Bangui Agreement and is administered by the OAPI Office.

2.4.3.5. Botswana

2.4.3.5.1. *Patents*

Botswana is a member of the Paris Convention and the PCT and may be designated from either system. It is furthermore also a member of the Harare Protocol and may be designated in an ARIPO patent application.

An invention is patentable if it is new, involves an inventive step and is industrially applicable.

Formal and substantive examination is possible for patent applications, however substantive examination does not always occur and patents may go to grant without being examined.

A patent in Botswana has a duration of 20 years from the date of filing.

2.4.3.5.2. *Designs*

Any composition of lines or colours or three-dimensional form which gives a special appearance to a product of industry or handicraft is registerable. Functional designs are not recognised by the national legislation.

Only formal examination is conducted and if the design complies with all the requirements, it will be registered.

The duration of a design is 5 years, which is extendable for another two 5-years periods, for a total duration of 15 years.

2.4.3.5.3. *Utility models*

An invention must be new and industrially applicable and is only examined for formal compliance.

According to the national legislation, a utility model has a duration of 7 years from the filing date.

2.4.3.5.4. *Trade marks*

Any visible sign capable of distinguishing the goods or services of an enterprise will be deemed registerable.

Apart from being a member of ARIPO, Botswana is a party to the Madrid System for international registration of trade marks and the Paris Convention for Protection of Industrial Property. It is possible to claim priority under the Paris Convention.

Botswana follows a multi-class filing system and recognises both goods and services classes in terms of the 10th edition of the Nice Classification.

Trade mark applications are examined for compliance with formal and substantive requirements and are published in the official gazette after acceptance. Trade marks may be opposed within 3 months from the date of publication.

Well-known trade marks in terms of the Paris Convention and common law trade mark rights are recognised in Botswana in relation to trade names.

Trade mark registrations are valid for 10 years from the date of filing and may be renewed indefinitely for 10-year periods thereafter.

A registered trade mark may be cancelled on action by an interested party if it has not been used for a continuous period of 3 years after the date of registration.

2.4.3.5.5. *Copyright*

Botswana is member to a number of Conventions and Treaties, which includes the Berne Convention, the WIPO Copyright Treaty and the WIPO Performances and Phonograms Treaty as well as being member to the WTO/TRIPS.

Copyright extends to all works as discussed in section 2.1.7.2.

The duration of copyright is for the life of the author plus 50 years. In the case of works of applied art, this period is only 25 years from the date of the creation of the work.

2.4.3.6. Burkina Faso

Burkina Faso is a member of OAPI and intellectual property protection can only be obtained in terms of the Bangui Agreement. The Agreement requires a uniform adoption of its legislation, thereby doing away with the existing national legislation.

2.4.3.7. Burundi

2.4.3.7.1. *Patents*

A patent may be obtained for any invention that is new, inventive and capable of industrial application. As Burundi is not a member of any convention or treaty, intellectual property rights need to be filed at the same time as in other jurisdictions. Although specific exclusions to patentability include chemical compositions and second medical use inventions, software is patentable.

An application is filed at the national industrial property office and is formally examined. Substantive examination is carried out with regard to novelty only.

The duration of a patent is 20 years from the date of filing. However, if the patent is granted more than 4 years after the filing date, the duration of the patent will be extended by that period.

2.4.3.7.2. *Designs*

A design registration may be obtained for any design or model which gives an article a novel aspect or original shape.

The application is filed at the national industrial property office and will undergo both formal and substantive examination.

Once the application is found to comply with all the requirements, it will be registered and is effective for 5 years from the filing date, which is renewable for 2 further terms of 5 years each, for a maximum duration of 15 years.

2.4.3.7.3. *Utility model*

A utility model may be obtained for any model consisting of a sufficient technical creation, introduced into an object, which increases the functionality or use of the object.

The application is filed at the national industrial property office and is examined for formal and substantive requirements.

A granted utility model has a duration of 10 years from the filing date.

2.4.3.7.4. *Trade marks*

Any distinctive sign, which can be graphically represented and capable of distinguishing the goods and services from another company, may be registered as a trade mark.

Burundi is a party to the Paris Convention for Protection of Industrial Property. It is possible to claim priority under the Paris Convention.

Burundi follows a multi-class filing system and recognises both goods and services classes in terms of the Nice Classification.

Trade mark applications are examined for compliance with formal requirements only and are published in the official gazette after acceptance. It is possible to oppose a trade mark within 30 days of the date of publication.

Burundi is a first to file jurisdiction and there is no statutory provision for the protection of common law trade mark rights. Well-known trade marks in terms of the Paris Convention are, however, recognised and enforceable in Burundi.

Trade mark registrations are valid for 10 years from the date of filing and may be renewed indefinitely for 10-year periods thereafter.

A registered trade mark may be cancelled on action by an interested party if it has not been used for a continuous period of 3 years after the date of registration

2.4.3.7.5. *Copyright*

In Burundi, copyright is an automatic right and needs not be registered. All the normal works as per section 2.1.7.2 are recognised in Burundi.

Copyright will exist for the lifetime of the author plus 50 years. Works of applied art are protected for 25 years from the date of creation.

2.4.3.8. *Cameroon*

Cameroon is a member of OAPI and intellectual property protection can only be obtained in terms of the Bangui Agreement. The Agreement requires a uniform adoption of its legislation, thereby doing away with the existing national legislation.

2.4.3.9. *Cape Verde*

2.4.3.9.1. *Patents*

New inventions, involving an inventive step and capable of being applied in industry, may be patented. All the usual exclusions apply, except that software is patentable.

An application is filed at the national industrial property office. As Cape Verde is not a member of any regional system, convention or treaty, the filing must be done simultaneously with filings in other jurisdictions, or the applicant risks destroying the novelty of the invention.

Formal and substantive examination is conducted and if the application is found to comply with the requirements, it will proceed to grant.

The duration of a patent is 20 years from the date of filing.

2.4.3.9.2. *Designs*

A design may be obtained for the whole or partial appearance of any product consisting of lines, colours, shape, texture or material of the product itself and of its decoration.

The application is filed at the industrial property office and undergoes formal and substantive examination.

Once all the requirements under examination have been met, the design is registered.

The duration of a design is 25 years from the filing date.

2.4.3.9.3. *Utility model*

A utility model is any new invention which involves an inventive step and is capable of industrial application. The requirements are the same as for a patent, except that utility models apply to inventions which are simpler in nature, although an applicant may file both a patent and utility model for his/her invention.

A grace period exists for inventions disclosed at an internationally recognised exhibition, as long as the application is made within 6 months of the disclosure.

The application is made at the industrial property office and will undergo formal examination only. Substantive examination must be requested. The utility model is provisionally granted if no substantive examination is conducted, but must be requested for a final grant.

The duration of a utility model is 6 years from the filing date, which may be renewed for 2 periods of 2 years, for a total duration of 10 years.

2.4.3.9.4. *Trade marks*

A trade mark may consist of any sign which is capable of being represented graphically and can distinguish the goods and services from another enterprise.

Cape Verde is not a party to the Paris Convention for Protection of Industrial Property, however, it is possible to claim priority under the Paris Convention.

Cape Verde follows a multi-class filing system and recognises both goods and services classes in terms of the Nice Classification.

The total time from filing to registration is approximately 24 months. Trade mark applications are examined for compliance with formal and substantive requirements and are published in the official gazette after acceptance. It is possible to oppose a trade mark within 2 months of the date of publication.

Cape Verde is a first to file jurisdiction and there is no statutory provision for the protection of common law trade mark rights. Well-known trade marks in terms of the Paris Convention are, however, recognised and enforceable in Cape Verde.

Trade mark registrations are valid for 10 years from the date of filing and may be renewed indefinitely for 10-year periods thereafter.

A registered trade mark may be cancelled on action by an interested party if it has not been used for a continuous period of 5 years after the date of registration.

2.4.3.9.5. *Copyright*

Cape Verde is a member to both the Rome and Berne Conventions as well as the WTO/TRIPS.

Copyright normally exists in the works as discussed in section 2.1.7.2.

Copyright is a non-registrable right and endures for the lifetime of the author plus 50 years. The duration of copyright in respect of photographic works is 25 years from the date of creation and 50 years for computer programs.

2.4.3.10. Central African Republic

The Central African Republic is a member of OAPI and intellectual property protection can only be obtained in terms of the Bangui Agreement. The Agreement requires a uniform adoption of its legislation, thereby doing away with the existing national legislation.

2.4.3.11. Chad

Chad is a member of OAPI and intellectual property protection can only be obtained in terms of the Bangui Agreement. The Agreement requires a uniform adoption of its legislation, thereby doing away with the existing national legislation.

2.4.3.12. Comoros

Comoros is a member of OAPI and intellectual property protection can only be obtained in terms of the Bangui Agreement. The Agreement requires a uniform adoption of its legislation, thereby doing away with the existing national legislation.

2.4.3.13. Congo, Republic of the

The Republic of Congo is a member of OAPI and intellectual property protection can only be obtained in terms of the Bangui Agreement. The Agreement requires a uniform adoption of its legislation, thereby doing away with the existing national legislation.

2.4.3.14. Congo, Democratic Republic of the (DRC)

2.4.3.14.1. *Patents*

A patent may be granted for any invention which is new, inventive and capable of being applied in industry. The normal exclusions apply, but the DRC allows a patent of importation. This means an article that is patented under the jurisdiction of another country, may be extended to the DRC.

The application is filed directly with the industrial property office of the DRC. Since the DRC is party to the Paris Convention, priority may be claimed from a previous filing, as long as it is filed within 12 months of the priority date thereof.

Examination is only conducted in respect of formal requirements, thus if the application complies, the patent will be granted.

The patent will endure for 20 years from the filing date. Patents concerning medicines endure for a period of 15 years. A patent of importation will be granted the unexpired term of the foreign patent on which it is based, but may not exceed 20 years from the date of filing.

2.4.3.14.2. *Designs*

Two- and three-dimensional designs may be filed, provided that these are new, original and capable of commercial exploitation.

The application is filed at the industrial property office of the DRC. Convention priority may be claimed from a previous application if the application is filed within 6 months of the priority date.

The duration of a design is 5 years from the filing date, which may be renewed for another period of 5 years, for a maximum duration of 10 years.

2.4.3.14.3. *Trade marks*

Any distinctive sign, which is capable of distinguishing the services or goods to which it relates from the goods or services of another company, may be registered.

DRC is a party to the Paris Convention for Protection of Industrial Property and it is possible to claim priority under the Paris Convention.

DRC follows a multi-class filing system and recognises both goods and services classes in terms of the Nice Classification.

Trade mark applications are examined for compliance with formal and substantive requirements and are published in the official gazette after acceptance. There is no provision for opposition proceedings, however an interested party, including the Public Minister, may invoke the nullity (in other words, apply for cancellation) of a mark on the ground that it should not have been registered in the first place.

DRC is a first to file jurisdiction and common law trade mark rights are not recognised, except in limited and exceptional cases. Well-known trade marks are also not specifically recognised in the DRC.

Trade mark registrations are valid for 10 years from the date of filing and may be renewed indefinitely for 10-year periods thereafter.

A registered trade mark may be cancelled on action by an interested party if it has not been used for a continuous period of 3 years after the date of registration.

2.4.3.14.4. *Copyright*

The DRC is a member to the Berne Convention and the Phonograms Convention, as well as the WTO/TRIPS.

Copyright subsists in the works as discussed in section 2.1.7.2.

It is a non-registrable right and exists for the lifetime of the author plus 50 years. Copyright in photographs endure for 25 years from the date of creation.

2.4.3.15. Djibouti

2.4.3.15.1. *Patents*

A patent may be granted for any invention that is new, inventive and capable of being applied in industry.

The application is filed at the industrial property office and priority may be claimed from international and convention applications.

In practice, only formal examination is conducted, although the national law provides for substantive examination. If the application complies with the formal requirements, it will proceed to grant.

The patent has a duration of 20 years from the filing date.

2.4.3.15.2. *Designs*

Any new and original arrangement of lines or colours or three-dimensional shapes applied to an industrial article or serving as a pattern, may be registered as a design.

The application is filed at the industrial property office and convention priority may be claimed.

Only formal examination is conducted and once the application complies, it will be registered.

The design has a duration of 15 years, subject to renewals being paid on the 5th and 10th annuity.

2.4.3.15.3. *Trade marks*

Any mark which is capable of being represented graphically and distinguishes the goods or services from the goods or services of other companies, may be registered as a trade mark.

Djibouti is a party to the Paris Convention for Protection of Industrial Property, however, the law contains no provision for claiming priority under the Paris

Convention. It is therefore uncertain whether priority can be claimed, but in practice the Registrar does take priority claims into account.

Djibouti follows a multi-class filing system and recognises both goods and services classes in terms of the Nice Classification.

Trade mark applications are examined for compliance with formal requirements only and are published in the official gazette after registration. There is no provision for opposition proceedings.

Djibouti is a first to file jurisdiction and common law trade mark rights are not recognised. Well-known trade marks in terms of the Paris Convention are recognised.

Trade mark registrations are valid for 10 years from the date of filing and may be renewed indefinitely for 10-year periods thereafter.

A registered trade mark may be cancelled on action by an interested party if it has not been used for a continuous period of 5 years after the date of registration.

2.4.3.15.4. *Copyright*

Djibouti is member to the Berne Convention and the WTO/TRIPS and, as such, the normal copyright works are protected.

This right is non-registrable and endures for the lifetime of the author plus 50 years. The duration for films is 50 years from the date of publication and 25 years in respect of photographs.

2.4.3.16. *Egypt*

2.4.3.16.1. *Patents*

A patent may be granted for any invention that is new, involves an inventive step and is capable of industrial application.

The application is filed at the patent office and both Paris Convention and PCT priorities apply.

Formal examination is conducted automatically, whilst substantive examination should be requested within 6 months of the filing date.

Once a patent is granted, it will remain in force for 20 years from its filing date.

2.4.3.16.2. *Designs*

A design may be registered for any arrangement of lines or three-dimensional form which possesses a new shape and is industrially applicable.

The application is filed at the Trade mark Office. Each application is examined for novelty and industrial applicability. The examiner may require from the applicant to make certain adjustments and should the applicant fail to comply, the design application will be cancelled.

A design is registered for an initial period of 10 years from the filing date, which may be extended once for a period of 5 years for a maximum duration of 15 years.

2.4.3.16.3. *Utility models*

Utility models may be granted for any new, useful and technical addition to the structure or composition of devices, tools, equipment or their components, products, processes or means of manufacturing.

The application for a utility model is done at the Patent Office. The models are examined for both form and novelty.

A utility model is granted for a period of 7 years from the filing date.

2.4.3.16.4. *Trade marks*

A trade mark should be capable of distinguishing the goods or services from the goods or services of another party. It may be in any form, words, letters, figures, symbols or colours or any combination thereof.

Egypt is a party to the Madrid System for International Registration of Marks and the Paris Convention for Protection of Industrial Property and it is possible to claim priority under the Paris Convention.

Egypt follows a multi-class filing system and recognises both goods and services classes in terms of the Nice Classification.

Trade mark applications are examined for compliance with formal and substantive requirements and are published in the official gazette after registration. Trade marks may be opposed within 60 days of the date of publication

Well-known trade marks in terms of the Paris Convention and common law trade mark rights are recognised in Egypt.

Trade mark registrations are valid for 10 years from the date of filing and may be renewed indefinitely for 10-year periods thereafter.

A registered trade mark may be cancelled on action by an interested party if it has not been used for a continuous period of 5 years after the date of registration.

2.4.3.16.5. *Copyright*

Egypt is a member of the Berne and Phonograms Convention, as well as the WTO/TRIPS.

Copyright protection is recognised in all the works as discussed in section 2.1.7.2.

The duration of copyright is for the lifetime of the author plus 50 years. Works of applied art may be protected for 25 years from the date it was first published, recordings for 50 years from the date on which a recording was made and broadcasts for 20 years from the date the broadcast is made.

2.4.3.16.6. *Plant variety protection*

Variety protection for a new plant may be obtained if the plant is distinct, uniform and stable (DUS).

The application for the protection of a plant variety may be filed at the Plant Varieties Protection Office and will undergo DUS testing for two years. Should the same variety have been examined in another jurisdiction, the applicant can supply the DUS results of that jurisdiction to reduce this period of examination to one year.

The term of protection is 25 years from the date of grant in respect of trees and vines and 20 years for all other plant species.

2.4.3.17. Equatorial Guinea

Equatorial Guinea is a member of OAPI and intellectual property protection can only be obtained in terms of the Bangui Agreement. The Agreement requires a uniform adoption of its legislation, thereby doing away with the existing national legislation.

2.4.3.18. Eritrea

Eritrea was formerly an Italian colony and British protectorate. It became federated with Ethiopia in 1952 as one of Ethiopia's provinces. In May 1993, Eritrea became an independent country and as such it is no longer possible to protect intellectual property in Eritrea. The country does have a commercial code which recognises various intellectual property elements however, no patent, trade mark, industrial design, utility model or protection of plant varieties law has been enacted.

2.4.3.19. Ethiopia

2.4.3.19.1. *Patents*

A patent may be granted for any invention that is new, involves an inventive step and is capable of industrial application. Ethiopia is party to the Paris Convention and priority may be claimed therethrough. Ethiopia furthermore provides for a patent of introduction, which is granted when the invention has already been validly granted in another foreign jurisdiction.

The application is filed at the Ethiopian Intellectual Property Office. Formal examination is conducted automatically and once the formal requirements are met, the application is sent to the ARIPO Office for substantive examination based on an agreement between the offices.

Once a patent is granted, it will remain in force for 15 years from the filing date, which may be extended for an additional 5 years if the invention is being worked. Patents of introduction are in force for 10 years from the filing date.

2.4.3.19.2. *Designs*

A design may be registered for any arrangement of lines or three-dimensional form which possess a new shape and is industrially applicable.

The application is filed with the Ethiopian Intellectual Property Office. Each application is examined for novelty and industrial applicability. The examiner may require from the applicant to make certain adjustments and should the applicant fail to comply, the design application will be cancelled.

This jurisdiction provides a 1-year grace period where a right to priority is claimed.

A design is registered for an initial period of 5 years from the filing date, which may be extended for another two 5-year periods for a maximum duration of 15 years.

2.4.3.19.3. *Utility models*

Utility models may be granted for minor inventions which are new to Ethiopia and industrially applicable. A minor invention does not need to involve an inventive step and is considered new if it has not been made available to the public of Ethiopia before the application date.

The application for a utility model is done at the Ethiopian Intellectual Property Office. The application is examined for formality only, although substantive examination will be conducted if a third party opposes the grant of the utility model. A 6-month grace period applies where priority rights can be claimed.

A utility model is granted for a period of 5 years from the filing date and may be extended for another two 5-years periods, for a maximum duration of 15 years.

2.4.3.19.4. *Trade marks*

A trade mark should be capable of distinguishing the goods or services of one party from the goods or services of another party. It may be in any form, words, letters, figures, symbols or colours or any combination thereof.

Ethiopia is not a member of or signatory to any regional or international trade mark systems, agreements or treaties.

Ethiopia follows a multi-class filing system and recognises both goods and services classes in terms of the Nice Classification.

Trade mark applications are examined for compliance with formal and substantive requirements and are published in the official gazette after registration. Trade marks may be opposed within 60 days of the date of publication

Ethiopia is a first to file jurisdiction. Common law trade mark rights are recognised although not specifically dealt with in terms of existing legislation. Well-known trade marks are also not specifically recognised in Ethiopia.

Trade mark registrations are valid for 7 years from the date of filing and may be renewed indefinitely for 7-year periods thereafter.

A registered trade mark may be cancelled on action by an interested party if it has not been used for a continuous period of 3 years after the date of registration.

2.4.3.19.5. *Copyright*

Copyright is applicable to all works as discussed in section 2.1.7.2.

The duration of protection of literary, artistic and musical works is the lifetime of the author plus 50 years. For sound recordings and computer programs the duration of protection is 50 years from the date of publication and 20 years in respect of broadcasting rights.

2.4.3.19.6. *Plant breeders' rights*

A plant breeders' right may be obtained for any new plant which is distinct, uniform and stable (DUS).

The application for a plant breeders' right may be filed with the Ministry of Agriculture and Rural Development and will undergo DUS testing. The application will enjoy provisional protection during the period of testing.

The term of protection is 25 years from the date of grant in respect of trees and vines and 20 years for all other plant species.

2.4.3.20. Gabon

Gabon is a member of OAPI and intellectual property protection can only be obtained in terms of the Bangui Agreement. The Agreement requires a uniform adoption of its legislation, thereby doing away with the existing national legislation.

2.4.3.21. Gambia, The

The Gambia is member to the ARIPO system (Harare Protocol), Paris Convention, The PCT and WTO/TRIPS.

2.4.3.21.1. *Patents*

A patent may be granted for any invention that is new, involves an inventive step and is capable of being applied in trade and industry.

The Gambia is a member of the PCT and the Paris Convention. Therefore, The Gambia may be designated during national phase filings and priority rights may be claimed from convention applications. The national laws have, however, not been amended to provide for PCT filings. Filings via the ARIPO system is thus preferred until the national laws have been amended.

A national phase patent application will be subject to both formal and substantive examination. If granted in terms of national legislation, the patent will last for 15 years from the filing date, which is extendable for another 5-year period if the invention is being worked.

2.4.3.21.2. *Designs*

A design may be registered for any composition of lines of forms, which give a new shape to an article and may also extend to a pattern of a product.

A national application may claim priority for a period of six months from a preceding filing date. Both formal and substantive examination will be conducted by the Gambian Intellectual Property Office.

An application which complies with the requirements for registrability, is registered for an initial period of 5 years from the filing date, which may be extended for another two 5-year periods, for a maximum duration of 15 years.

2.4.3.21.3. *Utility models*

The Gambia requires only that utility models be novel and applicable in industry and is available for the protection of inventions which does not comply with requirements of a patent.

National applications for utility models may claim priority for 6 months from a preceding filing.

The application for a utility model is done at the Industrial Property Office. The application is examined for formal requirements only and, once it complies, will be afforded a filing date.

A utility model is granted for a period of 7 years from the filing date.

2.4.3.21.4. *Trade marks*

A trade mark should be capable of distinguishing the goods or services of one party from the goods or services of another party. It may be in any form, words, letters, figures, symbols or colours or any combination thereof.

Gambia is a party to the Madrid System for international registration of trade marks and the Paris Convention for Protection of Industrial Property. It is possible to claim priority under the Paris Convention. Gambia is a member of the African Regional Intellectual Property Organisation (ARIPO) but it is not a signatory to the Banjul Protocol and it is therefore not possible to register trade marks in Gambia via the ARIPO system.

Gambia follows a multi-class filing system and recognises both goods and services classes in terms of the Nice Classification.

Trade mark applications are examined for compliance with formal and substantive requirements and are published in the official gazette after registration. Trade marks may be opposed within 3 months of the date of publication

Well-known trade marks in terms of the Paris Convention are recognised in Gambia.

Trade mark registrations are valid for 10 years from the date of filing and may be renewed indefinitely for 10-year periods thereafter.

A registered trade mark may be cancelled on action by an interested party if it has not been used for a continuous period of 5 years after the date of registration.

2.4.3.21.5. *Copyright*

The Gambia is a member of the Berne Convention and the WTO/TRIPS.

It is a non-registrable right and all the works of section 2.1.7.2 are recognised for copyright protection.

The duration of copyright in literary, musical and artistic works endures for the lifetime of the author plus 50 years. Photographs are protected for 50 years from the date of publication.

2.4.3.22. Ghana

Ghana is member to the ARIPO system and it is possible to obtain protection via the system. Ghana is also a member of the Paris Convention, the PCT and WTO/TRIPS. The paragraphs following hereunder only discuss the provisions according to national legislation.

2.4.3.22.1. *Patents*

A patent may be granted for any invention that is new, involves an inventive step and is capable of being applied in trade and industry.

Ghana is a member of the PCT and may be designated during national phase filings. It is also a member of the Paris Convention and therefore priority rights may be claimed.

The application is filed at the Ministry of Justice in Accra.

A national phase patent will be subject to both formal and substantive examination. If granted in terms of national legislation, the patent will last for 20 years from the filing date.

2.4.3.22.2. *Designs*

A design registration may be obtained for any composition of lines or colours or any three-dimensional form that gives a special appearance to an object.

A national application may claim priority for a period of 12 months from a preceding filing date. Only formal examination is conducted and when the application is found to comply with all formalities, it will be registered.

The duration of the design is 5 years from the filing date, which may be renewed twice for 5-year periods each, for a total duration of 15 years.

At present, it is impossible to file a design registration since the regulations to the enabling legislation have not been implemented.

2.4.3.22.3. *Utility models*

A utility model may be obtained for any new invention which improves or increases the usefulness or performance of a product or process and does not meet the requirements for a patent.

National applications for utility models may claim priority for 12 months from a preceding filing.

The application for a utility model is filed at the Ministry of Justice. The application is examined for formality only, and once it complies will be afforded a filing date.

A utility model is granted for a period of 7 years from the filing date.

2.4.3.22.4. *Trade marks*

A trade mark should be capable of distinguishing the goods or services of one party from the goods or services of another party. It may be in any form, words, letters, figures, symbols or colours or any combination thereof.

Ghana is a party to the Madrid System for international registration of trade marks and the Paris Convention for Protection of Industrial Property. It is possible to claim priority under the Paris Convention. Ghana is a member of the African Regional Intellectual Property Organisation (ARIPO) but it is not a signatory to the Banjul

Protocol and it is therefore not possible to register trade marks in Ghana via the ARIPO system.

Ghana follows a single class filing system and recognises both goods and services classes in terms of the Nice Classification.

Trade mark applications are examined for compliance with formal and substantive requirements and are published in the official gazette after registration. Trade marks may be opposed within 3 months of the date of publication

Well-known trade marks in terms of the Paris Convention are recognised in Ghana.

Trade mark registrations are valid for 10 years from the date of filing and may be renewed indefinitely for 10-year periods thereafter.

A registered trade mark may be cancelled on action by an interested party if it has not been used for a continuous period of 5 years after the date of registration.

2.4.3.22.5. *Copyright*

Ghana is a member of the Berne Convention and the WIPO Copyright Treaty, as well as WTO/TRIPS.

Works eligible for copyright are the same as discussed in section 2.1.7.2.

Copyright endures for the lifetime of the author plus 70 years. Audio-visual works and sound recordings enjoy copyright protection for 70 years from the date of publication.

2.4.3.23. Guinea

Guinea is a member of OAPI and intellectual property protection can only be obtained in terms of the Bangui Agreement. The Agreement requires a uniform adoption of its legislation, thereby doing away with the existing national legislation.

2.4.3.24. Guinea-Bissau

Guinea-Bissau is a member of OAPI and intellectual property protection can only be obtained in terms of the Bangui Agreement. The Agreement requires a uniform adoption of its legislation, thereby doing away with the existing national legislation.

2.4.3.25. Ivory Coast (Côte d'Ivoire)

Ivory Coast is a member of OAPI and intellectual property protection can only be obtained in terms of the Bangui Agreement. The Agreement requires a uniform adoption of its legislation, thereby doing away with the existing national legislation.

2.4.3.26. Kenya

Kenya is member to the ARIPO system and protection of intellectual property may be obtained via the system. Kenya is also a member of the PCT, Paris Convention and WTO/TRIPS. The paragraphs following hereunder discusses the provisions of the national legislation.

2.4.3.26.1. *Patents*

A patent may be granted for any invention that is new, involves an inventive step and is capable of being applied in trade and industry.

Kenya is a member of the PCT and may be designated during national phase filings. As it is also a member of the Paris Convention, priority rights may be claimed.

An application is filed at the Industrial Property Office. The patent application is only examined for formal requirements; however, the Office may decide to conduct substantive examination of any invention if deemed necessary.

If granted in terms of national legislation, the patent will last for 20 years from the filing date.

2.4.3.26.2. *Designs*

A design registration may be obtained for any composition of lines or colours or any three-dimensional form that gives a special appearance to an object.

A national application may claim priority for a period of 12 months from a preceding filing date. Only formal examination is conducted and when the application is found to comply with all formalities, it will be registered.

The duration of the design is 5 years from the filing date, which may be renewed twice for 5-year periods each, for a total duration of 15 years.

2.4.3.26.3. *Utility models*

A utility model may be obtained for any new invention which improves or increases the usefulness or performance of a product or process and does not meet the requirements for a patent.

National applications for utility models may claim priority for 12-months from a preceding filing.

The application for a utility model is done at the Industrial Property Office. The application is examined for formality only and once it complies, will be afforded a filing date.

A utility model is granted for a period of 10 years from the filing date.

2.4.3.26.4. *Trade marks*

A trade mark should be capable of distinguishing the goods or services from the goods or services of another party. It may be in any form, words, letters, figures, symbols or colours or any combination thereof.

Kenya is a party to the Madrid System for international registration of trade marks and the Paris Convention for Protection of Industrial Property. It is possible to claim priority under the Paris Convention. Kenya is a member of the African Regional Intellectual Property Organisation (ARIPO) but it is not a signatory to the Banjul Protocol and it is therefore not possible to register trade marks in Kenya via the ARIPO system.

Kenya follows a multi-class filing system and recognises both goods and services classes in terms of the Nice Classification.

Trade mark applications are examined for compliance with formal and substantive requirements and are published in the official gazette after acceptance. Trade marks may be opposed within 60 days from the date of publication.

Well-known trade marks in terms of the Paris Convention are recognised in Kenya and although no specific provision is made for the protection of common law trade mark rights in the country's local legislation, such rights are recognised in Kenya.

Trade mark registrations are valid for 10 years from the date of filing and may be renewed indefinitely for 10-year periods thereafter.

A registered trade mark may be cancelled on action by an interested party if it has not been used for a continuous period of 5 years after the date of registration.

2.4.3.26.5. *Copyright*

Kenya is a member to the Berne Convention, the Brussels Convention, the Phonograms Convention and the WTO/TRIPS. As a result, all of the works as discussed in section 2.1.7.2. are recognised.

The period for which copyright endures is the lifetime of the author plus 50 years in respect of literary, musical and artistic works. Photographs and everything else are protected for 50 years from the date of publication.

2.4.3.26.6. *Plant breeders' rights*

Kenya is a member of the UPOV Convention and thus priority may be claimed from an earlier application in a UPOV member country.

A plant breeders' right may be obtained for any new plant which is distinct, uniform and stable (DUS).

The application for a plant breeders' right may be filed with the Kenya Plant Health Inspectorate Service and will undergo DUS testing. Should the applicant have the DUS results from another jurisdiction, this may be substituted for a formal DUS test. The application will enjoy provisional protection during the period of testing.

The term of protection is 25 years from the date of grant in respect of trees and vines and 20 years for all other plant species.

2.4.3.27. Lesotho

Lesotho is a member of ARIPO and protection of intellectual property may be obtained via the system. Following hereunder is a discussion of the national provisions.

2.4.3.27.1. *Patents*

A patent may be granted for any invention that is new, involves an inventive step and is capable of being applied in trade and industry.

Lesotho is a member of the PCT and may be designated during national phase filings. As it is also a member of the Paris Convention, priority rights may be claimed.

The application is filed at the Registrar General's Office. A national phase patent application is examined both for adherence to formal and substantive requirements. Lesotho is an exception to the norm in that software may be patented.

If a patent is granted in terms of national legislation, the patent will last for 15 years from the filing date, which is extendable for another 5-years where working of the patent can be proved.

2.4.3.27.2. *Designs*

A design registration may be obtained for any composition of lines or colours or any three-dimensional form that gives a special appearance to an object.

A national application may claim priority for a period of 6 months from a preceding filing date. The application is filed at the Registrar General's Office.

Only formal examination is conducted and when the application is found to comply with all formalities, it will be registered.

The duration of the design is 5 years from the filing date, which may be renewed twice for 5-year periods each, for a total duration of 15 years.

2.4.3.27.3. *Utility models*

A utility model may be obtained for any new invention which improves or increases the usefulness or performance of a product or process and does not meet the requirements for a patent.

National applications for utility models may claim priority of 6-months from a preceding filing.

The application for a utility model is done at the Registrar General's Office. The application is examined formally only, and once it complies will be afforded a filing date.

A utility model is granted for a period of 7 years from the filing date.

2.4.3.27.4. *Trade marks*

A trade mark should be capable of distinguishing the goods or services of one party from the goods or services of another party. It may be in any form, words, letters, figures, symbols or colours or any combination thereof.

Apart from being a member of ARIPO, Lesotho is a party to the Madrid System for international registration of trade marks and the Paris Convention for Protection of Industrial Property. It is possible to claim priority under the Paris Convention.

Lesotho follows a multi-class filing system and recognises both goods and services classes in terms of the Nice Classification.

Trade mark applications are examined for compliance with formal and substantive requirements and are published in the official gazette after acceptance. Trade marks may be opposed within 3 months from the date of publication.

Well-known trade marks in terms of the Paris Convention are recognised in Lesotho.

Trade mark registrations are valid for 10 years from the date of filing and may be renewed indefinitely for 10-year periods thereafter.

A registered trade mark may be cancelled on action by an interested party if it has not been used for a continuous period of 3 years after the date of registration.

2.4.3.27.5. *Copyright*

Lesotho is a member to both the Berne and Rome Conventions, as well as the WTO/TRIPS. All works as discussed in section 2.1.7.2 are copyright protected.

The duration of copyright is the lifetime of the author plus 50 years. Cinematographic and audiovisual works are protected for 50 years and photographs for 25 years from the making of the work.

2.4.3.28. Liberia

Liberia is member to the ARIPO system and protection of intellectual property may be obtained via the system. The discussion hereunder covers the provisions according to the national laws.

2.4.3.28.1. *Patents*

A patent may be granted for any invention that is new, involves an inventive step and is capable of being applied in trade and industry.

Liberia is a member of the PCT and may be designated during national phase filings. As it is also a member of the Paris Convention, priority rights may be claimed.

A national phase patent application is filed at the Industrial Property Office and examined only for adherence to form.

A patent granted in terms of the national legislation will endure for 20 years from the date of filing.

2.4.3.28.2. *Designs*

A design registration may be obtained for any composition of lines or colours or any three-dimensional form that gives a special appearance to an object.

A national application may claim priority for a period of 12 months from a preceding filing date. After filing the application at the Industrial Property Office, only formal examination is conducted and when the application is found to comply with all formalities, it will be registered.

The duration of the design is 5 years from the filing date, which may be renewed twice for 5-year periods each, for a total duration of 15 years.

2.4.3.28.3. *Trade marks*

A trade mark should be capable of distinguishing the goods or services of one party from the goods or services of another party. It may be in any form, words, letters, figures, symbols or colours or any combination thereof.

Apart from being a member of ARIPO, Liberia is a party to the Madrid System for international registration of trade marks and the Paris Convention for Protection of Industrial Property. It is possible to claim priority under the Paris Convention.

Liberia follows a multi-class filing system and recognises both goods and services classes in terms of the Nice Classification.

Trade mark applications are examined for compliance with formal requirements only and are published in the official gazette after acceptance. Trade marks may be opposed within 2 months from the date of publication.

Well-known trade marks in terms of the Paris Convention are recognised in Liberia.

Trade mark registrations are valid for 15 years from the date of filing and may be renewed indefinitely for 15-year periods thereafter.

A registered trade mark may be cancelled on action by an interested party if it has not been used for a continuous period of 3 years after the date of registration.

2.4.3.28.4. *Copyright*

Liberia is a member to the Berne, Rome, Phonograms and Universal Copyright Conventions and the WTO/TRIPS. The works as discussed in section 2.1.7.2 are subject to copyright protection.

The duration of copyright is the lifetime of the author plus 50 years. Cinematographic and audiovisual works are protected for 50 years and photographs for 25 years from the publication of the work.

2.4.3.29. Libya

2.4.3.29.1. *Patents*

A patent may be granted for any invention that is new, involves an inventive step and is capable of being applied in trade and industry.

Libya is a member of the PCT, but since national laws have not been amended to recognise PCT, it is uncertain whether protection obtained via PCT is enforceable. It is a member of the Paris Convention and therefore priority rights may be claimed.

A national phase patent application is filed at the Industrial Property Office and is examined only for adherence to formal requirements.

Granted patents subsist for a period of 15 years from the filing date. Patents in respect of chemical processes relating to foodstuffs, medicines or pharmaceutical compositions are protected for 10 years from the filing date.

2.4.3.29.2. *Designs*

A design registration may be obtained for any composition of lines or colours or any three-dimensional form that gives a special appearance to an object.

A design application is made at the Industrial Property Office and is examined for both form and registrability.

Once registered, a design is protected for a duration of 5 years from the filing date, which may be renewed twice for 5-year periods each, for a total duration of 15 years.

2.4.3.29.3. *Trade marks*

A trade mark should be capable of distinguishing the goods or services of one party from the goods or services of another party. It may be in any form, words, letters, figures, symbols or colours or any combination thereof. Libyan law specifically excludes protection of marks in respect of pork, alcoholic and Christmas-related products.

Libya is a party to the Paris Convention for Protection of Industrial Property. It is possible to claim priority under the Paris Convention.

Libya follows a single class filing system and recognises both goods and services classes in terms of the Nice Classification.

Trade mark applications are examined for compliance with formal and substantive requirements and are published in the official gazette after acceptance. Trade marks may be opposed within 3 months from the date of publication.

Well-known trade marks in terms of the Paris Convention are recognised in Libya.

Trade mark registrations are valid for 10 years from the date of filing and may be renewed indefinitely for 10-year periods thereafter.

A registered trade mark may be cancelled on action by an interested party if it has not been used for a continuous period of 5 years after the date of registration.

2.4.3.29.4. *Copyright*

Libya is a member of the Berne Convention.

It is necessary to apply for the registration of copyright as this right is not automatically conferred. Copyright only subsists in Libyan citizens or for works first published in Libya and works which are protected under the Berne Convention.

The duration of copyright is the lifetime of the author plus 25 years, but the total duration of protection shall not be less than 50 years. Photographs and cinematographic works are protected for 5 years from the date of publication.

2.4.3.30. Madagascar

2.4.3.30.1. *Patents*

A patent may be granted for any invention that is new, involves an inventive step and is capable of being applied in trade and industry. A notable exception of patentable material includes pharmaceuticals and cosmetics.

Madagascar is a member of the PCT and may be designated during national phase filings. As it is also a member of the Paris Convention, priority rights may be claimed.

A national phase patent application is filed at the Industrial Property Office and examined only for adherence to formal requirements.

If a patent is granted in terms of national legislation, the patent will last for 15 years from the filing date, which is extendable for another 5-years, for a total duration of 20 years.

2.4.3.30.2. *Designs*

A design registration may be obtained for any composition of lines or colours or any three-dimensional form that gives a special appearance to an object.

A national application may claim priority for a period of 6 months from a preceding filing date. The application is filed at the Industrial Property Office and only formal examination is conducted. If the application is found to comply with all formalities, it will be registered.

The duration of the design is 5 years from the filing date, which may be renewed twice for 5-year periods each, for a total duration of 15 years.

2.4.3.30.3. *Trade marks*

A trade mark should be capable of distinguishing the goods or services of one party from the goods or services of another party. It may be in any form, words, letters, figures, symbols or colours or any combination thereof.

Madagascar is a party to the Madrid System for international registration of trade marks and the Paris Convention for Protection of Industrial Property. It is possible to claim priority under the Paris Convention.

Madagascar follows a multi-class filing system and recognises both goods and services classes in terms of the Nice Classification.

Trade mark applications are examined for compliance with formal and substantive requirements. There is no provision for opposition proceedings.

Well-known trade marks in terms of the Paris Convention are not recognised in Madagascar.

Trade mark registrations are valid for 10 years from the date of filing and may be renewed indefinitely for 10-year periods thereafter.

A registered trade mark may be cancelled on action by an interested party if it has not been used for a continuous period of 5 years after the date of registration.

2.4.3.30.4. *Copyright*

Madagascar is a member to both the Berne Convention and the WTO/TRIPS. Copyright subsists in all the works as discussed in section 2.1.7.2.

The duration of copyright is the lifetime of the author plus 70 years. Copyright in computer programs lasts for 20 years.

2.4.3.31. Malawi

Malawi is a member of ARIPO and protection of intellectual property may be obtained via the system. Following hereunder is a discussion of the national provisions.

2.4.3.31.1. *Patents*

A patent may be granted for any invention that is new, involves an inventive step and is capable of being applied in trade and industry.

Malawi is a member of the PCT and may be designated during national phase filings. As it is also a member of the Paris Convention, priority rights may be claimed.

A national phase patent application is filed at the Ministry of Justice and is examined only for adherence to formal requirements.

If a patent is granted in terms of national legislation, the patent will last for 15 years from the filing date, which is extendable for another 5-years where working of the patent can be proved.

2.4.3.31.2. *Designs*

A design registration may be obtained for any composition of lines or colours or any three-dimensional form that gives a special appearance to an object.

The application for a design is filed at the Ministry of Justice. Only formal examination is conducted for a national phase application and when the application is found to comply with all formalities, it will be registered.

The duration of the design is 5 years from the filing date, which may be renewed twice for 5-year periods each, for a total duration of 15 years.

2.4.3.31.3. *Trade marks*

A trade mark should be capable of distinguishing the goods or services of one party from the goods or services of another party. It may be in any form, words, letters, figures, symbols or colours or any combination thereof.

Apart from being a member of ARIPO, Malawi is a party to the Paris Convention for Protection of Industrial Property. It is possible to claim priority under the Paris Convention.

Malawi follows a multi-class filing system in terms of the Nice Classification but does not recognise service classes.

Trade mark applications are examined for compliance with formal and substantive requirements and are published in the official gazette after acceptance. Trade marks may be opposed within 2 months from the date of publication.

Well-known trade marks in terms of the Paris Convention are recognised in Malawi.

Trade mark registrations are valid for 7 years from the date of filing and may be renewed indefinitely for 7-year periods thereafter.

A registered trade mark may be cancelled on action by an interested party if it has not been used for a continuous period of 3 years after the date of registration.

2.4.3.31.4. *Copyright*

Malawi is a member of the Berne Convention and copyright subsists in the works as discussed in section 2.1.7.2.

The duration of copyright is the lifetime of the author plus 50 years in the case of literary, musical and artistic works. All other works enjoy protection for a period of

50 years from the date of publication. Photographs are protected for 25 years and computer programs for 10 years from the publication of the work.

2.4.3.32. Mali

Mali is a member of OAPI and intellectual property protection can only be obtained in terms of the Bangui Agreement. The Agreement requires a uniform adoption of its legislation, thereby doing away with the existing national legislation.

2.4.3.33. Mauritania

Mauritania is a member of OAPI and intellectual property protection can only be obtained in terms of the Bangui Agreement. The Agreement requires a uniform adoption of its legislation, thereby doing away with the existing national legislation.

2.4.3.34. Mauritius

2.4.3.34.1. *Patents*

A patent may be granted for any invention that is new, involves an inventive step and is capable of being applied in trade and industry.

Mauritius is a member of the Paris Convention and priority rights may be claimed.

A patent application is filed at the Industrial Property Office, where it is examined both for adherence to formal and substantive requirements.

The duration of a granted patent is 20 years from the filing date.

2.4.3.34.2. *Designs*

A design registration may be obtained for any composition of lines or colours or any three-dimensional form that gives a special appearance to an object.

A national application may claim priority for a period of 12 months from a preceding filing date and is filed at the Industrial Property Office. Only formal examination is conducted and when the application is found to comply with all formalities, it will be registered.

The duration of the design is 5 years from the filing date, which may be renewed twice for 5-year periods each, for a total duration of 15 years.

2.4.3.34.3. *Trade marks*

A trade mark should be capable of distinguishing the goods or services of one party from the goods or services of another party. It may be in any form, words, letters, figures, symbols or colours or any combination thereof.

Mauritius is a party to the Paris Convention for Protection of Industrial Property. It is possible to claim priority under the Paris Convention.

Mauritius follows a multi-class filing system in terms of the Nice Classification.

Trade mark applications are examined for compliance with formal and substantive requirements and are published in the official gazette after acceptance. Trade marks may be opposed within 2 months from the date of publication.

Well-known trade marks in terms of the Paris Convention are recognised in Mauritius.

Trade mark registrations are valid for 10 years from the date of filing and may be renewed indefinitely for 10-year periods thereafter.

A registered trade mark may be cancelled on action by an interested party if it has not been used for a continuous period of 3 years after the date of registration.

2.4.3.34.4. *Copyright*

Mauritius is a member of both the Berne and Universal Copyright Conventions, as well as the WTO/TRIPS. Copyright subsists in all the works as discussed in section 2.1.7.2.

The duration of copyright is the lifetime of the author plus 50 years. Audiovisual works are protected for 50 years and photographs for 25 years from the publication of the work.

2.4.3.35. *Morocco*

2.4.3.35.1. *Patents*

A patent may be granted for any invention that is new, involves an inventive step and is capable of being applied in trade and industry.

Morocco is a member of the PCT and may be designated during national phase filings. As it is also a member of the Paris Convention, priority rights may be claimed. Additionally, European patents may be validated for Morocco. Any patent validated from a European patent will have a duration of 20 years from the filing date of the European application.

A national phase patent application is filed at the Industrial Property Office and examined both for adherence to form and substance.

If a patent is granted in terms of national legislation, the patent will last for 20 years from the date of filing.

2.4.3.35.2. *Designs*

A design registration may be obtained for any composition of lines or colours or any three-dimensional form that gives a special appearance to an object.

Only formal examination is conducted and when the application is found to comply with all formalities, it will be registered.

The duration of the design is 5 years from the filing date, which may be renewed four times for 5-year periods each, for a total duration of 25 years.

2.4.3.35.3. *Trade marks*

A trade mark should be capable of distinguishing the goods or services of one party from the goods or services of another party. It may be in any form, words, letters, figures, symbols or colours or any combination thereof.

Morocco is a party to the Madrid System for international registration of trade marks and the Paris Convention for Protection of Industrial Property. It is possible to claim priority under the Paris Convention.

Morocco follows a multi-class filing system in terms of the Nice Classification.

Trade mark applications are examined for compliance with formal requirements only and are published in the official gazette after acceptance. Trade marks may be opposed within 60 days from the date of publication.

Well-known trade marks in terms of the Paris Convention are recognised in Morocco.

Trade mark registrations are valid for 10 years from the date of filing and may be renewed indefinitely for 10-year periods thereafter.

A registered trade mark may be cancelled on action by an interested party if it has not been used for a continuous period of 5 years after the date of registration.

2.4.3.35.4. Copyright

Morocco is a member to the Berne Convention, the WIPO Copyright Treaty, the WIPO Performances and Phonograms Treaty, as well as the WTO/TRIPS. Copyright subsists in all the works as discussed in section 2.1.7.2.

The duration of copyright is the lifetime of the author plus 70 years. Audiovisual works are protected for 70 years from the date of publication. Applied art, phonograms, performances and broadcasts are protected for 70 years from the year of production or creation.

2.4.3.35.5. Plant breeders' rights

Morocco is a member of the UPOV Convention and thus priority may be claimed from an earlier application in a UPOV member country.

A plant breeders' right may be obtained for any new plant which is distinct, uniform and stable (DUS).

The application for a plant breeders' right may be filed with the Ministry of Agriculture and will undergo DUS testing. Should the applicant have the DUS result from another jurisdiction, this may be substituted for a formal DUS test. The application will enjoy provisional protection during the period of testing.

The term of protection is 25 years from the date of grant in respect of trees and vines and 20 years for all other plant species.

2.4.3.36. Mozambique

Mozambique is a member of the Paris Convention, the PCT, WTO/TRIPS and the ARIPO system and protection of intellectual property may be obtained via the system. The following paragraphs discuss the national provisions.

2.4.3.36.1. *Patents*

A patent may be granted for any invention that is new, involves an inventive step and is capable of being applied in trade and industry.

Mozambique is a member of the PCT and may be designated during national phase filings. As it is also a member of the Paris Convention, priority rights may be claimed.

A national phase patent application is filed at the Industrial Property Office where it is examined for adherence to both formal and substantive requirements.

A patent granted in terms of the national legislation will endure for 20 years from the date of filing.

2.4.3.36.2. *Designs*

A design registration may be obtained for any composition of lines or colours or any three-dimensional form that gives a special appearance to an object.

Only formal examination is conducted and when the application is found to comply with all formalities, it will be registered.

The duration of the design is 5 years from the filing date, which may be renewed four times for 5-year periods each, for a total duration of 25 years.

2.4.3.36.3. *Utility models*

A utility model may be obtained for any new invention which improves or increases the usefulness or performance of a product or process and does not meet the requirements for a patent.

The application for a utility model is done at the Industrial Property Office. The application is only examined for formal requirements, but substantive examination

will be conducted where an opposition is raised against the grant of a model or the Office finds it necessary.

A utility model is granted for a period of 15 years from the filing date.

2.4.3.36.4. *Trade marks*

A trade mark should be capable of distinguishing the goods or services of one party from the goods or services of another party. It may be in any form, words, letters, figures, symbols or colours or any combination thereof.

Mozambique is a party to the Madrid System for international registration of trade marks and the Paris Convention for Protection of Industrial Property. It is possible to claim priority under the Paris Convention. Mozambique is a member of the African Regional Intellectual Property Organisation (ARIPO) but it is not a signatory to the Banjul Protocol and it is therefore not possible to register trade marks in Mozambique via the ARIPO system.

Mozambique follows a single class filing system in terms of the Nice Classification.

Trade mark applications are examined for compliance with formal and substantive requirements and are published in the official gazette after acceptance. Trade marks may be opposed within 30 days from the date of publication.

Well-known trade marks in terms of the Paris Convention are recognised in Mozambique.

Trade mark registrations are valid for 10 years from the date of filing and may be renewed indefinitely for 10-year periods thereafter. Aside from renewal, it is necessary to file a declaration of use every 5 years.

A registered trade mark may be cancelled on action by an interested party if it has not been used for a continuous period of 5 years after the date of registration.

2.4.3.36.5. *Copyright*

Mozambique is a member of the WTO/TRIPS and copyright vests in the works as discussed in section 2.1.7.2 of this manual.

The duration of copyright is the lifetime of the author plus 70 years. Works of applied art and audiovisual works are protected for 70 years from the date of completion or publication respectively.

2.4.3.37. Namibia

Namibia is a member of the PCT, Paris Convention, WTO/TRIPS and the ARIPO system.

2.4.3.37.1. *Patents*

A patent may be granted for any invention that is new, involves an inventive step and is capable of being applied in trade and industry.

Namibia is a member of the PCT, but the national laws have not been amended to recognise PCT. As such it is uncertain whether national applications that are filed and granted are guaranteed of enforceable rights. Namibia is also a member of the Paris Convention and ARIPO, through which national phase filings may also be filed.

A national phase patent application is filed at the Industrial Property Office and examined only for adherence to formal requirements.

A patent granted in terms of the national legislation will endure for 14 years from the date of filing, which may be extendable for 7 or 14 years.

2.4.3.37.2. *Designs*

A design registration may be obtained for any composition of lines or colours or any three-dimensional form that gives a special appearance to an object.

Only formal examination is conducted and when the application is found to comply with all formalities, it will be registered.

The duration of the design is 5 years from the filing date, which may be renewed four times for 5-year periods each, for a total duration of 25 years.

2.4.3.37.3. *Trade marks*

A trade mark should be capable of distinguishing the goods or services of one party from the goods or services of another party. It may be in any form, words, letters, figures, symbols or colours or any combination thereof.

Apart from being a member of ARIPO, Namibia is a party to the Madrid System for international registration of trade marks and the Paris Convention for Protection of Industrial Property. It is possible to claim priority under the Paris Convention.

Namibia follows a multi-class filing system in terms of the Nice Classification.

Trade mark applications are examined for compliance with formal requirements only and are published in the official gazette after acceptance. Trade marks may be opposed within 2 months from the date of publication.

Well-known trade marks in terms of the Paris Convention and common law trade marks are recognised in Namibia.

Trade mark registrations are valid for 10 years from the date of filing and may be renewed indefinitely for 10-year periods thereafter.

A registered trade mark may be cancelled on action by an interested party if it has not been used for a continuous period of 5 years after the date of registration.

2.4.3.37.4. *Copyright*

Namibia is a member of the Berne Convention and WTO/TRIPS. All the works as discussed in section 2.1.7.2 enjoy copyright protection in Namibia.

The duration of copyright in literary, artistic and musical works is for the lifetime of the author plus 50 years. Photographs and all other works enjoy copyright protection for 50 years from the date of publication.

2.4.3.38. *Niger*

Niger is a member of OAPI and intellectual property protection can only be obtained in terms of the Bangui Agreement. The Agreement requires a uniform adoption of its legislation, thereby doing away with the existing national legislation.

2.4.3.39. Nigeria

2.4.3.39.1. *Patents*

A patent may be granted for any invention that is new, involves an inventive step and is capable of being applied in trade and industry.

Nigeria is a member of the PCT and may be designated during national phase filings. As it is also a member of the Paris Convention, priority rights may be claimed.

A national phase patent application is filed at the Registry of Patents and Designs and is examined only for conforming to formal requirements.

A patent granted in terms of the national legislation will endure for 20 years from the date of filing.

2.4.3.39.2. *Designs*

A design registration may be obtained for any composition of lines or colours or any three-dimensional form that gives a special appearance to an object.

Only formal examination is conducted and when the application is found to comply with all formalities, it will be registered.

The duration of the design is 5 years from the filing date, which may be renewed four times for 5-year periods each, for a total duration of 25 years.

2.4.3.39.3. *Trade marks*

A trade mark should be capable of distinguishing the goods or services of one party from the goods or services of another party. It may be in any form, words, letters, figures, symbols or colours or any combination thereof.

Nigeria is a party to the Paris Convention for Protection of Industrial Property, however, it is not possible to claim priority as Nigeria's national trade mark legislation has not been amended to give effect to the Paris Convention.

Nigeria follows a single class filing system in terms of the Nice Classification.

Trade mark applications are examined for compliance with formal requirements only and are published in the official gazette after acceptance. Trade marks may be opposed within 2 months from the date of publication.

Well-known trade marks in terms of the Paris Convention are not recognised in Nigeria.

Trade mark registrations are valid for 7 years from the date of filing and may be renewed indefinitely for 7-year periods thereafter.

A registered trade mark may be cancelled on action by an interested party if it has not been used for a continuous period of 5 years after the date of registration.

2.4.3.39.4. *Copyright*

Nigeria is a member of the Berne and Rome Conventions, as well as the WTO/TRIPS. All works as discussed in section 2.1.7.2. are protected under copyright.

The duration of copyright in literary, musical and artistic works is the lifetime of the author plus 70 years. Photographs, sound recordings and broadcasts and cinematographic films are protected for 50 years from the date of publication.

2.4.3.40. Organisation Africaine de la Propriété Intellectuelle (OAPI)

OAPI is the African Intellectual Property Organisation for French-speaking Africa.

The member countries are Benin, Burkina-Faso, Cameroon, Central African Republic, Chad, Comoro Islands, Congo (Republic of), Equatorial Guinea, Gabon, Guinea, Guinea-Bissau, Ivory Coast, Mali, Mauritania, Niger, Senegal and Togo. It must be noted that it is not possible to obtain protection in any of these countries other than by way of an OAPI application.

OAPI is also a member of the PCT. The deadline for PCT Regional Phase Entry is 30 months from the priority date.

An OAPI application automatically designates and extends to all member states and therefore no designation is necessary.

It is possible to obtain protection for patents, utility models, industrial designs and trade marks.

2.4.3.40.1. *Patents*

For a patent to be granted, the invention must be new, involve an inventive step and must be applicable in industry. Novelty shall not be denied if, during the twelve months preceding the filing of the application, the invention has been displayed at an internationally recognised exhibition.

The law of all OAPI member states provides for examination as to form, unity of invention and patentability *per se*.

The duration of a patent is 20 years from the date of filing.

2.4.3.40.2. *Utility models*

Utility models are defined as tools or objects to be used or parts of such tools or objects, insofar as they are of use for the work or employment for which they are destined, due to a new outline, new arrangement or new device, and insofar as they are applicable in industry.

This model need only be novel in that the invention claimed therein has not been described in printed publications and not publicly used in any member state of OAPI prior to the filing or priority date.

Novelty is not destroyed by a disclosure during the 12 months preceding the filing or priority date as a consequence of an evident abuse in relation to the applicant or his predecessor in title; or by a display during the 12 months preceding the filing or priority date at an officially recognised international exhibition by the applicant or his predecessor in title.

Protection is granted for an initial period of 5 years from the date of application, which may be extended once by a period of 3 years. All member states are automatically covered in an OAPI application and it is not possible to select only some member states.

2.4.3.40.3. *Industrial designs*

Industrial designs are defined as any new design, three-dimensional form, or industrial object which differs from similar objects either by a distinct and recognisable form giving it an aspect of novelty, or by one or more external effect which gives a new and distinct appearance.

The design must not have been made available to the public anywhere in the world by publication in tangible form, by use or by any other means before the filing or priority date.

Novelty is not destroyed by the same elements as for utility models noted in paragraph 2.4.3.40.2 above.

Protection is granted for an initial period of 5 years from the application date, which may be renewed twice by a period of 5 years, for a total duration of 15 years.

2.4.3.40.4. *Trade marks*

A trade mark constitutes any sign that individualises the goods of a given enterprise and is capable of distinguishing such goods from the goods of competitors.

OAPI is a party to the Madrid System for International Registration of trade marks and the Paris Convention for Protection of Industrial Property and it is possible to claim priority under the Paris Convention.

OAPI follows a multi- class filing system in terms of the Nice Classification, but separate applications must be filed for goods and services.

Trade mark applications are examined for compliance with formal requirements only and are published in the official gazette after acceptance. There is no procedure for opposition of trade mark applications in OAPI.

Well-known trade marks in terms of the Paris Convention are recognised in OAPI.

Trade mark registrations are valid for 10 years from the date of filing and may be renewed indefinitely for 10-year periods thereafter.

A registered trade mark may be cancelled on action by an interested party if it has not been used for a continuous period of 5 years after the date of registration.

2.4.3.40.5. *Copyright*

All OAPI member countries are also members to the Berne Convention, the Rome Convention, the WIPO Copyright Treaty, the WIPO Performances and Phonograms Treaty and WTO/TRIPS.

Copyright is afforded under the Bangui Agreement, thus protection may be enjoyed in all 19 member countries.

All normal subject matter as provided in section 2.1.7.2. enjoys copyright and it need not be registered.

The duration of copyright is for the lifetime of the author plus 70 years. Works of applied art enjoy a protected status for 25 years after the making of the work.

2.4.3.40.6. *Plant breeders' rights*

Plant breeders' rights are protected under the Bangui Agreement and protection under the Agreement automatically extends to all the member states.

To be granted a plant breeders' right the variety must be new, distinct, uniform and stable. An application is filed at the OAPI Office. Examination is conducted to both form and substance and a technical examination is also undertaken to determine that the variety is distinct, uniform and stable.

Once granted, the term of protection is 25 years.

2.4.3.41. Rwanda

Rwanda is a member of Paris Convention, the PCT, WTO/TRIPS, the ARIPO system and protection of intellectual property may be obtained via the system. National applications may also be filed and will be processed according to national laws, as discussed below.

2.4.3.41.1. *Patents*

A patent may be granted for any invention that is new, involves an inventive step and is capable of being applied in trade and industry.

Rwanda is a member of the PCT and may be designated during national phase filings, although the national legislation has not been amended to include the provisions of the PCT. As it is also a member of the Paris Convention, priority rights may be claimed.

A national phase patent application is filed at the Office of the Registrar General and is examined for formal adherence only, although substantive examination is conducted at the discretion of the Registrar.

A patent granted in terms of the national legislation will endure for 20 years from the date of filing.

2.4.3.41.2. *Designs*

A design registration may be obtained for any composition of lines or colours or any three-dimensional form that gives a special appearance to an object.

Only formal examination is conducted, but the Registrar may decide to conduct substantive examination at his/her discretion. When the application complies with all standards, it will be registered.

The duration of the design is 15 years from the filing date.

2.4.3.41.3. *Utility models*

Any new innovation that does not meet the criteria for patentability, may qualify for a utility model.

Only formal examination is conducted, but the Registrar may decide to conduct substantive examination subject to his/her discretion. When the application complies with all standards, it will be granted.

A utility model is granted for a period of 10 years from the filing date.

2.4.3.41.4. *Trade marks*

A trade mark should be capable of distinguishing the goods or services of one party from the goods or services of another party. It may be in any form, words, letters, figures, symbols or colours or any combination thereof.

Rwanda is a party to the Madrid System for international registration of trade marks and the Paris Convention for Protection of Industrial Property. It is possible to claim priority under the Paris Convention. Rwanda is a member of the African Regional Intellectual Property Organisation (ARIPO) but it is not a signatory to the Banjul Protocol and it is therefore not possible to register trade marks in Rwanda via the ARIPO system.

Rwanda follows a multi-class filing system in terms of the Nice Classification.

Trade mark applications are examined for compliance with formal and substantive requirements and are published in the official gazette after acceptance. Trade marks may be opposed within 30 days from the date of publication, although there is some uncertainty around the length of the opposition period.

Well-known trade marks in terms of the Paris Convention are recognised in Rwanda.

Trade mark registrations are valid for 10 years from the date of filing and may be renewed indefinitely for 10-year periods thereafter.

A registered trade mark may be cancelled on action by an interested party if it has not been used for a continuous period of 5 years after the date of registration.

2.4.3.41.5. *Copyright*

Rwanda is a member of the Berne, Rome and Universal Copyrights Conventions, and the WTO/TRIPS. The works as discussed in section 2.1.7.2 of this manual is subject to copyright protection in Rwanda.

The duration of copyright is the lifetime of the author plus 50 years. Works of applied art are protected for 50 years.

2.4.3.42. São Tomé and Príncipe (St Thomas and Prince's Islands)

São Tomé and Príncipe is a member of ARIPO and protection of intellectual property may be obtained via the system. National applications may also be filed and will be processed according to national laws.

2.4.3.42.1. *Patents*

A patent may be granted for any invention that is new, involves an inventive step and is capable of being applied in trade and industry.

São Tomé and Príncipe is a member of the PCT and may be designated during national phase filings. As it is also a member of the Paris Convention, priority rights may be claimed.

A national phase patent application is filed at the Industrial Property National Service and examined for both formal and substantive requirements.

A patent granted in terms of the national legislation will endure for 20 years from the date of filing.

2.4.3.42.2. *Designs*

A design registration may be obtained for any composition of lines or colours or any three-dimensional form that gives a special appearance to an object.

The application is filed at the Industrial Property National Service. Both formal and substantive examination are conducted for design applications.

The duration of the design is 5 years from the filing date, which is renewable for two 5-years periods for a total duration of 15 years.

2.4.3.42.3. *Trade marks*

A trade mark should be capable of distinguishing the goods or services of one party from the goods or services of another party. It may be in any form, words, letters, figures, symbols or colours or any combination thereof.

Apart from being a member of ARIPO, São Tomé is a party to the Madrid System for international registration of trade marks and the Paris Convention for Protection of Industrial Property. It is possible to claim priority under the Paris Convention.

São Tomé follows a multi-class filing system in terms of the Nice Classification.

Trade mark applications are examined for compliance with formal and substantive requirements and are published in the official gazette after acceptance. Trade marks may be opposed within 90 days from the date of publication.

Well-known trade marks in terms of the Paris Convention are recognised in São Tomé.

Trade mark registrations are valid for 10 years from the date of filing and may be renewed indefinitely for 10-year periods thereafter.

A registered trade mark may be cancelled on action by an interested party if it has not been used for a continuous period of 5 years after the date of registration.

2.4.3.42.4. *Copyright*

Copyright is recognised in São Tomé and Príncipe, although an English version of the provisions of the law could not be obtained and therefore it is not possible to elaborate on the provisions. São Tomé and Príncipe is a member of the Berne Convention and the Geneva Convention.

2.4.3.43. Senegal

Senegal is a member of OAPI and intellectual property protection can only be obtained in terms of the Bangui Agreement. The Agreement requires a uniform adoption of its legislation, thereby doing away with the existing national legislation.

2.4.3.44. Seychelles

2.4.3.44.1. *Patents*

A patent may be granted for any invention that is new, involves an inventive step and is capable of being applied in trade and industry.

Seychelles is a member of the PCT and may be designated during national phase applications. As it is also a member of the Paris Convention, priority rights may be claimed.

A national phase patent application is filed at the Patent Office and examined only for formal adherence and given a filing date when all the formal requirements have been met.

A patent granted in terms of the national legislation will endure for 20 years from the date of filing.

2.4.3.44.2. *Designs*

A design registration may be obtained for any composition of lines or colours or any three-dimensional form that gives a special appearance to an object.

The application is filed at the Patent Office. Only formal examination is conducted and the application is accorded a filing date upon meeting formal requirements.

The duration of the design is 5 years from the filing date, which is extendable for two 5-year periods for a maximum duration of 15 years.

2.4.3.44.3. *Utility models*

Utility models are defined as tools or objects to be used or parts of such tools or objects, insofar as they are of use for the work or employment for which they are destined, due to a new outline, new arrangement or new device, and insofar as they are applicable in industry.

Once the application is filed at the Patent Office, only formal examination is conducted and the application is accorded a filing date upon meeting formal requirements.

A utility model is granted for a period of 10 years from the filing date.

2.4.3.44.4. *Trade marks*

A trade mark should be capable of distinguishing the goods or services of one party from the goods or services of another party. It may be in any form, words, letters, figures, symbols or colours or any combination thereof.

Seychelles is a party to the Paris Convention for Protection of Industrial Property. It is possible to claim priority under the Paris Convention.

Seychelles follows a single class filing system and follows its own system of classification, which closely follows the Nice Classification.

Trade mark applications are examined for compliance with formal and substantive requirements and are published in the official gazette after acceptance. Trade marks may be opposed within 2 months from the date of publication.

Well-known trade marks in terms of the Paris Convention are recognised in Seychelles.

Trade mark registrations are valid for 10 years from the date of filing and may be renewed indefinitely for 7-year periods thereafter.

A registered trade mark may be cancelled on action by an interested party if it has not been used for a continuous period of 3 years after the date of registration.

2.4.3.44.5. *Copyright*

Copyright protection vests in all the works as discussed in section 2.1.7.2.

The duration of copyright for literary, musical and artistic works is the lifetime of the author plus 25 years. Photographs and all other works are protected for 25 years from the date of publication.

2.4.3.45. Somalia

Somalia is a member of ARIPO, although a designation from an ARIPO filing will have no effect, since Somalia is, at present, a non-functioning country. The 1991 coup of the government has led to a total collapse of all functions, including jurisprudential ones. As such, no statutes on industrial or intellectual property exists.

2.4.3.46. Sierra Leone

Sierra Leone is a member of ARIPO and protection may be obtained via the system. The provisions of the national legislation are discussed below.

2.4.3.46.1. *Patents*

A patent may be granted for any invention that is new, involves an inventive step and is capable of being applied in trade and industry.

Sierra Leone is a member of the PCT and may be designated during national phase applications, although filings through PCT are presently not recognised in the national legislation. As it is also a member of the Paris Convention, priority rights may be claimed.

A national phase patent application is filed at the Industrial Property Office and examined only for formal adherence. It is accorded a filing date when all requirements have been met.

A patent granted in terms of the national legislation will endure for 20 years from the date of filing.

2.4.3.46.2. Designs

A design registration may be obtained for any composition of lines or colours or any three-dimensional form that gives a special appearance to an object.

The application is filed at the Industrial Property Office where only formal examination is conducted. The application is accorded a filing date upon meeting formal requirements.

The duration of the design is 5 years from the filing date, which is extendable for two 5-year periods for a maximum duration of 15 years.

2.4.3.46.3. Utility models

Utility models are defined as tools or objects to be used or parts of such tools or objects, insofar as they are of use for the work or employment for which they are destined, due to a new outline, new arrangement or new device, and insofar as they are applicable in industry.

The application is filed at the Industrial Property Office. Only formal examination is conducted and the application is accorded a filing date upon meeting formal requirements.

A utility model is granted for a period of 7 years from the filing date.

2.4.3.46.4. Trade marks

A trade mark should be capable of distinguishing the goods or services of one party from the goods or services of another party. It may be in any form, words, letters, figures, symbols or colours or any combination thereof.

Sierra Leone is a party to the Madrid System for International Registration of trade marks and the Paris Convention for Protection of Industrial Property. It is possible to claim priority under the Paris Convention.

Sierra Leone follows a single class filing system in terms of the old British 50 class classification. Registration of service is currently not possible.

Sierra Leone has passed legislation adopting the Nice Classification and providing for the registration of service marks but the legislation is not yet in effect.

Trade mark applications are examined for compliance with formal requirements only and are published in the official gazette after acceptance. Trade marks may be opposed within 3 months from the date of publication.

Well-known trade marks in terms of the Paris Convention are not recognised in Sierra Leone.

Trade mark registrations are valid for 14 years from the date of filing and may be renewed indefinitely for 14-year periods thereafter.

A registered trade mark may be cancelled on action by an interested party if it has not been used for a continuous period of 5 years after the date of registration.

2.4.3.47. St Helena

St Helena does not have its own authority on industrial and intellectual property and, as such, only patents, designs and trade marks as granted or registered in the United Kingdom can be designated to St Helena.

Copyright is also recognised in terms of the United Kingdom national provisions.

2.4.3.48. Sudan

Sudan is a member of ARIPO and protection may be obtained via the system. The provisions of the national legislation are discussed below.

2.4.3.48.1. *Patents*

A patent may be granted for any invention that is new, involves an inventive step and is capable of being applied in trade and industry.

Sudan is a member of the PCT and may be designated during national phase filings. As it is also a member of the Paris Convention, priority rights may be claimed.

A national phase patent application is filed at the Patent Office and examined only for adherence with formal requirements.

A patent granted in terms of the national legislation will endure for 20 years from the date of filing.

2.4.3.48.2. *Designs*

A design registration may be obtained for any composition of lines or colours or any three-dimensional form that gives a special appearance to an object.

The application is filed with the Registrar General for Intellectual Property. Only formal examination is conducted and when the application complies with all standards, it will be registered.

The duration of the design is 5 years from the filing date, which is extendable for two 5-year periods for a maximum duration of 15 years.

2.4.3.48.3. *Trade marks*

A trade mark should be capable of distinguishing the goods or services of one party from the goods or services of another party. It may be in any form, words, letters, figures, symbols or colours or any combination thereof.

Sudan is a party to the Madrid System for international registration of trade marks and the Paris Convention for Protection of Industrial Property. It is possible to claim

priority under the Paris Convention. Sudan is a member of the African Regional Intellectual Property Organisation (ARIPO) but it is not a signatory to the Banjul Protocol and it is therefore not possible to register trade marks in Sudan via the ARIPO system.

Sudan follows a single class filing system and recognises both goods and service classes in terms of the Nice Classification.

The total time from filing to registration is approximately 24 months. Trade mark applications are examined for compliance with formal and substantive requirements and are published in the official gazette after acceptance. Trade marks may be opposed within 8 months from the date of publication.

Well-known trade marks in terms of the Paris Convention are recognised in Sudan.

Trade mark registrations are valid for 10 years from the date of filing and may be renewed indefinitely for 10-year periods thereafter.

A registered trade mark may be cancelled on action by an interested party if it has not been used for a continuous period of 5 years after the date of registration.

2.4.3.48.4. *Copyright*

Sudan is a member of the Berne Convention. Copyright subsists in all of the works as discussed in section 2.1.7.2.

The duration of copyright is the lifetime of the author plus 50 years. Photographs, cinematographic films and audiovisual works are protected for 25 years for the date of publication. Works that are published for the first time after an author's death or published under a pseudonym or anonymously endures for 25 years from the date of publication.

2.4.3.49. South Sudan

South Sudan gained independence from Sudan in July 2011. At present, there is no legislative framework for the protection of intellectual property.

2.4.3.50. Swaziland

Swaziland is a member of ARIPO and applications for protection of intellectual property may be designated to Swaziland.

2.4.3.50.1. *Patents*

Swaziland is a member of the PCT and may be designated during national phase filings. As it is also a member of the Paris Convention, priority rights may be claimed.

The national legislation of Swaziland has not been amended to recognise ARIPO or PCT. Application via these routes are accepted, but there is no guarantee of the applicant gaining enforceable rights in this jurisdiction.

South African and United Kingdom patents and designs are both recognised in Swaziland and the duration of such a patent or design is normally the remainder of the South African or United Kingdom term.

Only formal examination is conducted and the application is accorded a filing date when meeting the requirements.

2.4.3.50.2. *Trade marks*

A trade mark should be capable of distinguishing the goods or services of one party from the goods or services of another party. It may be in any form, words, letters, figures, symbols or colours or any combination thereof.

Apart from being a member of ARIPO, Swaziland is a party to the Madrid System for international registration of trade marks and the Paris Convention for Protection of Industrial Property. It is possible to claim priority under the Paris Convention.

Swaziland follows a multi-class filing system and recognises both goods and services classes in terms of the Nice Classification.

Trade mark applications are examined for compliance with formal and substantive requirements and are published in the official gazette after acceptance. Trade marks may be opposed within 3 months from the date of publication.

Well-known trade marks in terms of the Paris Convention are recognised in Swaziland.

Trade mark registrations are valid for 10 years from the date of filing and may be renewed indefinitely for 10-year periods thereafter.

A registered trade mark may be cancelled on action by an interested party if it has not been used for a continuous period of 3 years after the date of registration.

2.4.3.50.3. *Copyright*

Swaziland is a member of the Berne Convention and copyright subsist in all works as discussed in section 2.1.7.2.

The duration of copyright is the lifetime of the author plus 50 years.

2.4.3.51. Tanzania

Tanzania is a member of ARIPO and intellectual property may be designated to it through the system.

2.4.3.51.1. *Patents*

A patent may be granted for any invention that is new, involves an inventive step and is capable of being applied in trade and industry.

Tanzania is a member of the PCT and may be designated during national phase filings. As it is also a member of the Paris Convention, priority rights may be claimed.

A national phase patent application is filed at the Patent Office and examined for both formal and substantive requirements.

A patent granted in terms of the national legislation will endure for 20 years from the date of filing.

2.4.3.51.2. *Designs*

Only ARIPO designs may be registered in Tanzania.

The duration of the design is 10 years from the filing date of the ARIPO application, but it is possible to extend the design for up to 25 years in Tanzania.

2.4.3.51.3. *Utility models*

Utility models are defined as tools or objects to be used or parts of such tools or objects, insofar as they are of use for the work or employment for which they are destined, due to a new outline, new arrangement or new device, and insofar as they are applicable in industry.

Both formal and substantive examination are conducted at the Patent Office.

A utility model is granted for a period of 7 years from the filing date.

2.4.3.51.4. *Trade marks*

The United Republic of Tanzania comprises of Tanganyika, on the African mainland, and the island of Zanzibar (including Pemba). Although Tanzania is a United Republic, uniting Tanganyika and Zanzibar, Zanzibar retained its independence (in some areas), resulting in two separate legal systems. Therefore, intellectual property laws are handled separately in each of these territories.

A trade mark should be capable of distinguishing the goods or services of one party from the goods or services of another party. It may be in any form, words, letters, figures, symbols or colours or any combination thereof.

Apart from being a member of ARIPO, Tanzania is a party to the Paris Convention for Protection of Industrial Property. It is possible to claim priority under the Paris Convention.

Tanzania follows a single class filing system and recognises both goods and services classes in terms of the Nice Classification.

Trade mark applications are examined for compliance with formal and substantive requirements and are published in the official gazette after acceptance. Trade marks may be opposed within 60 days from the date of publication.

Well-known trade marks in terms of the Paris Convention are recognised in Tanzania.

Trade mark registrations are valid for 7 years from the date of filing and may be renewed indefinitely for 10-year periods thereafter.

A registered trade mark may be cancelled on action by an interested party if it has not been used for a continuous period of 3 years after the date of registration.

2.4.3.51.5. *Copyright*

Tanzania is a member of the Berne Convention and the WTO/TRIPS. The works as discussed in section 2.1.7.2. will be protected by copyright in Tanzania.

The duration of copyright in literary, musical and artistic works is the lifetime of the author plus 50 years. Audiovisual works are protected for 50 years and works of applied art are protected for 25 years from the date of publication.

2.4.3.51.6. *Plant breeders' rights*

A plant breeders' right may be obtained for any new plant which is distinct, uniform and stable (DUS).

The application will undergo DUS testing. Should the applicant have the DUS result from another jurisdiction, this may be substituted for a formal DUS test. The application will enjoy provisional protection during the period of testing.

The term of protection is 25 years from the date of grant in respect of trees and vines and 20 years for all other plant species.

2.4.3.52. Togo

Togo is a member of OAPI and intellectual property protection can only be obtained in terms of the Bangui Agreement. The Agreement requires a uniform adoption of its legislation, thereby doing away with the existing national legislation.

2.4.3.53. Tunisia

2.4.3.53.1. *Patents*

A patent may be granted for any invention that is new, involves an inventive step and is capable of being applied in trade and industry.

Tunisia is a member of the PCT and may be designated during national phase filings. As it is also a member of the Paris Convention, priority rights may be claimed.

A national phase patent application is filed at the National Institute for Standardization and Industrial Property, where it is examined for both formal and substantive requirements.

A patent granted in terms of the national legislation will endure for 20 years from the date of filing.

2.4.3.53.2. *Designs*

A design registration may be obtained for any composition of lines or colours or any three-dimensional form that gives a special appearance to an object.

The design application is also filed at the Institute and are only examined for adherence to form and will be accorded a registration date when the application complies.

The duration of the design is 5, 10 or 15 years at the applicant's choice, although if the applicant selects the 5- or 10-year periods, he/she will be allowed to renew the design for a maximum duration of 15 years.

2.4.3.53.3. *Trade marks*

A trade mark should be capable of distinguishing the goods or services of one party from the goods or services of another party. It may be in any form, words, letters, figures, symbols or colours or any combination thereof.

Tunisia is a party to the Madrid System for International Registration of trade marks and the Paris Convention for Protection of Industrial Property. It is possible to claim priority under the Paris Convention.

Tunisia follows a multi-class filing system and recognises both goods and services classes in terms of the Nice Classification.

Trade mark applications are examined for compliance with formal and substantive requirements and are published in the official gazette after acceptance. Trade marks may be opposed within 2 months from the date of publication.

Well-known trade marks in terms of the Paris Convention are recognised in Tunisia.

Trade mark registrations are valid for 10 years from the date of filing and may be renewed indefinitely for 10-year periods thereafter.

A registered trade mark may be cancelled on action by an interested party if it has not been used for a continuous period of 5 years after the date of registration.

2.4.3.53.4. *Copyright*

Tunisia is a member of the Berne Convention and the WTO/TRIPS. The works as discussed in section 2.1.7.2. enjoy copyright protection in Tunisia.

The duration of all works is the lifetime of the author plus 50 years, except for photographs which is 25 years from the date of creation.

2.4.3.53.5. *Plant breeders' rights*

Tunisia is a member of the UPOV Convention and an application from a member country may be designated to Tunisia.

A plant breeders' right may be obtained for any new plant which is distinct, uniform and stable (DUS).

The application will undergo DUS testing under the supervision of the Ministry of Agriculture. Should the applicant have the DUS result from another jurisdiction, this may be substituted for a formal DUS test. The application will enjoy provisional protection during the period of testing.

The term of protection is 15 – 30 years from the date of filing and depend on the variety.

2.4.3.54. *Uganda*

Uganda is a member of ARIPO and intellectual property may be designated to it through the system.

2.4.3.54.1. *Patents*

A patent may be granted for any invention that is new, involves an inventive step and is capable of being applied in trade and industry.

Uganda is a member of the PCT and may be designated during national phase filings. As it is also a member of the Paris Convention, priority rights may be claimed.

A national phase patent application is filed at the Registrar General's Office and is examined for both formal and substantive requirements.

A patent granted in terms of the national legislation will endure for 20 years from the date of filing.

2.4.3.54.2. *Designs*

Only United Kingdom registered designs may be extended to Uganda. There are no other provisions under which a design can be registered.

The duration of the design is 5 years from the filing date of the United Kingdom application, but it is possible to renew the design every 5 years for a maximum duration of 25 years.

2.4.3.54.3. *Utility models*

Utility models are defined as tools or objects to be used or parts of such tools or objects, insofar as they are of use for the work or employment for which they are destined, due to a new outline, new arrangement or new device, and insofar as they are applicable in industry.

The application is filed at the Registrar General's Office. Only formal examination is conducted and utility models will be granted if it is new and industrially applicable.

A utility model is granted for a period of 7 years from the filing date.

2.4.3.54.4. *Trade marks*

A trade mark should be capable of distinguishing the goods or services of one party from the goods or services of another party. It may be in any form, words, letters, figures, symbols or colours or any combination thereof.

Apart from being a member of ARIPO, Uganda is a party to the Paris Convention for Protection of Industrial Property. It is possible to claim priority under the Paris Convention.

Uganda follows a single class filing system and recognises both goods and services classes in terms of the Nice Classification.

Trade mark applications are examined for compliance with formal and substantive requirements and are published in the official gazette after acceptance. Trade marks may be opposed within 60 days from the date of publication.

Well-known trade marks in terms of the Paris Convention are recognised in Uganda.

Trade mark registrations are valid for 7 years from the date of filing and may be renewed indefinitely for 10-year periods thereafter.

A registered trade mark may be cancelled on action by an interested party if it has not been used for a continuous period of 3 years after the date of registration.

2.4.3.54.5. *Copyright*

All the works as discussed in section 2.1.7.2. enjoy copyright protection in Uganda.

The duration of copyright in literary, musical and artistic works is the lifetime of the author plus 50 years, except for photographs. All other works are protected for 50 years from the date of publication.

2.4.3.55. *Western Sahara*

Western Sahara is a disputed territory with no legislation of its own, however, it is effectively controlled by Morocco, thus intellectual property may be obtained via the provisions of Moroccan legislation.

2.4.3.56. Zambia

Zambia is a member of ARIPO and intellectual property designated to it through the system, is recognised.

2.4.3.56.1. *Patents*

A patent may be granted for any invention that is new, involves an inventive step and is capable of being applied in trade and industry.

Although Zambia is a member of the PCT and may be designated during national phase filings, specific provisions for the implementation of the PCT have not been introduced yet. As it is also a member of the Paris Convention, priority rights may be claimed.

A national phase patent application is filed at the Patents and Companies Registration Agency and examined only for formal adherence and when the application complies, the patent will be granted.

A patent granted in terms of the national legislation will endure for 16 years from the date of filing.

2.4.3.56.2. *Designs*

A design registration may be obtained for any composition of lines or colours or any three-dimensional form that gives a special appearance to an object.

An industrial design application is filed with the Agency. Registration is obtained after formal examination.

The duration of the design is 5 years from the filing date of the application, but is extendable for two 5-year periods for a total of 15 years.

2.4.3.56.3. *Trade marks*

A trade mark should be capable of distinguishing the goods or services of one party from the goods or services of another party. It may be in any form, words, letters, figures, symbols or colours or any combination thereof.

Zambia is a member of the African Regional Intellectual Property Organisation (ARIPO) but it is not a signatory to the Banjul Protocol and it is therefore not possible to register trade marks in Zambia via the ARIPO system. Zambia is a member of the Paris Convention for Protection of Industrial Property. It is possible to claim priority under the Paris Convention.

Zambia follows a single class filing system in terms of the international classification but does not recognise service classes.

Trade mark applications are examined for compliance with formal and substantive requirements and are published in the official gazette after acceptance. Trade marks may be opposed within 3 months from the date of publication.

Well-known trade marks in terms of the Paris Convention are recognised in Zambia.

Trade mark registrations are valid for 7 years from the date of filing and may be renewed indefinitely for 14-year periods thereafter.

A registered trade mark may be cancelled on action by an interested party if it has not been used for a continuous period of 5 years after the date of registration.

2.4.3.56.4. Copyright

Zambia is a member of the Berne Convention and the WTO/TRIPS. Copyright subsists in those works as discussed in section 2.1.7.2.

The duration of copyright in literary, musical and artistic works is the lifetime of the author plus 50 years. All other works are protected for 50 years from the date of publication.

2.4.3.56.5. Plant breeders' rights

A plant breeders' right may be obtained for any new plant which is distinct, uniform and stable (DUS).

The application will undergo DUS testing. Should the applicant have the DUS result from another jurisdiction, this may be substituted for a formal DUS test. The application will enjoy provisional protection during the period of testing.

The term of protection is 25 years in the case of perennials and trees and 20 years in the case of annual crop.

2.4.3.57. Zanzibar

As a partner state of Tanzania, Zanzibar is a member of the Paris Convention, the PCT, WTO/TRIPS and ARIPO.

2.4.3.57.1. *Patents*

Zanzibar has not yet recognised the Harare Protocol and there are no provisions regulating the patent and design filings in ARIPO yet. Patent protection is thus available in Zanzibar via a national filing or an ARIPO application designating Tanzania.

2.4.3.57.2. *Trade marks*

Zanzibar is a party to the Paris Convention for Protection of Industrial Property. It is possible to claim priority under the Paris Convention.

Zanzibar follows a single class filing system and recognises both goods and services classes in terms of the Nice Classification.

Trade mark applications are examined for compliance with formal and substantive requirements and are published in the official gazette after acceptance. Trade marks may be opposed within 60 days from the date of publication.

Well-known trade marks in terms of the Paris Convention are recognised in Zanzibar.

Trade mark registrations are valid for 7 years from the date of filing and may be renewed indefinitely for 10-year periods thereafter.

A registered trade mark may be cancelled on action by an interested party if it has not been used for a continuous period of 3 years after the date of registration.

2.4.3.58. Zimbabwe

Zimbabwe is a member of ARIPO and the ARIPO Head office is located in the capital city, Harare. Patents may be designated to Zimbabwe through the ARIPO system.

2.4.3.58.1. *Patents*

A patent may be granted for any invention that is new, involves an inventive step and is capable of being applied in trade and industry.

Zimbabwe is a member of the PCT and may be designated during national phase filings. As it is also a member of the Paris Convention, priority rights may be claimed.

A national phase patent application is filed at the Intellectual Property Office and only examined for formal requirements.

A patent granted in terms of the national legislation will endure for 20 years from the date of filing.

2.4.3.58.2. *Designs*

A design registration may be obtained for any composition of lines or colours or any three-dimensional form that gives a special appearance to an object.

Applications are filed at the Intellectual Property Office and examined for adherence to formal and substantive requirements.

The duration of the design is 5 years from the filing date of the application, but is extendable for two 5-year periods for a total of 15 years.

2.4.3.58.3. *Trade marks*

A trade mark should be capable of distinguishing goods or services from the goods or services of another party. It may be in any form, words, letters, figures, symbols or colours or any combination thereof.

Apart from being a member of ARIPO, Zimbabwe is a party to the Madrid System for International Registration of trade marks and the Paris Convention for

Protection of Industrial Property. It is possible to claim priority under the Paris Convention.

Zimbabwe follows a single class filing system and recognises both goods and services classes in terms of the 8th edition of the Nice Classification.

Trade mark applications are examined for compliance with formal and substantive requirements and are published in the official gazette after acceptance. Trade marks may be opposed within 3 months from the date of publication.

Well-known trade marks in terms of the Paris Convention and common law trade marks are recognised in Zimbabwe.

Trade mark registrations are valid for 10 years from the date of filing and may be renewed indefinitely for 10-year periods thereafter.

A registered trade mark may be cancelled on action by an interested party if it has not been used for a continuous period of 5 years after the date of registration.

2.4.3.58.4. Copyright

Zimbabwe is a member of the Berne Convention and the WTO/TRIPS. The works as discussed in section 2.1.7.2. enjoy copyright protection in Zimbabwe.

The duration of copyright of literary, musical and artistic works is the lifetime of the author plus 50 years. Photographs and all other works enjoy copyright protection for 50 years from the publication date.

2.4.3.58.5. Plant breeders' rights

A plant breeders' right may be obtained for any new plant which is distinct, uniform and stable (DUS).

The application will undergo DUS testing. Should the applicant have the DUS result from another jurisdiction, this may be substituted for a formal DUS test. The application will enjoy provisional protection during the period of testing.

The term of protection is 20 years from the date of the grant, which may be extended for 5 years in exceptional circumstances.

3. IP SEARCHING

3.1. INTRODUCTION

A patent search involves searching different databases to ascertain whether an invention or idea has already been patented, in order to establish whether the invention or idea is novel. [Recall that, if (an aspect of) an invention is not novel, then (that aspect) is not patentable) → Manual § 2.1.2.2.]

In order to extract meaningful information from a patent search, it is important that the search should be conducted in a thorough and precise manner. Whilst it should be borne in mind that no patent database or searching method exists which can be entirely conclusive, it is important to strive to minimise the chances of overlooking relevant documents by adopting an efficient search strategy tailored to the particular aspects of the invention that is the subject of the search.

In practice, it is generally recommended that, prior to the filing of a patent application, a patent search be conducted in an effort to determine the probable patentability of a particular invention. Although patent searches are never exhaustive, they provide a good source of background information to assist in recognising and defining the true invention. A patentability search will range in cost depending upon such factors as:

- how thorough and exhaustive the search is required to be;
- the quantity of results requiring consideration; and
- the complexity of the proposed invention.

3.2. PATENTS AS AN INFORMATION SOURCE

Patents provide a valuable source of information. For instance, patents are often reviewed in a particular research area in order to point out new directions in research and to ascertain new uses for existing technologies.

3.2.1. Why conduct a patent search?

Patent searches are conducted for many purposes, *inter alia*, to:

- determine whether a particular invention is novel, and find published patent specifications that are directed towards a particular invention;
- assess the state of the art in a particular field of technology;

- study the rate of innovation in a particular field of technology;
- obtain the most active fields of technology in a particular jurisdiction;
- determine the patent portfolio of a specific company or a person;
- determine if an invention infringes upon the intellectual property rights of others;
- identify other possible uses for a new product;
- identify independent inventors or companies currently or historically obtaining patents in a particular area;
- search for potential solutions to design or safety problems;
- identify potential licensees; and
- identify additional reference materials (journal articles, books, product literature) of use to those working in this area, since patents often list printed reference materials.

3.3. TYPES OF PATENT SEARCHES

3.3.1. Subject matter search

3.3.1.1. Patentability search

A patentability search seeks, as its name suggests, to determine whether or not an invention is patentable. In order for an invention to be patentable, the invention must satisfy the requirements of novelty, inventiveness and must be applicable in trade, industry or agriculture. [→ See Manual § 2.1.2.2.]

Of these requirements, novelty is perhaps the most commonly assessed requirement when conducting such searches. An invention will satisfy the novelty requirement if it is not anticipated by the prior art. Prior art is any body of knowledge that relates to the invention under investigation and that has been made available to the public. Prior art can exist in fixed tangible form such as previous patents, trade journal articles, publications (including data books and

catalogues), and photographs. Prior art may further exist in unfixed forms, such as oral presentations, public discussions and demonstrations, trade shows, and public use or sales anywhere in the world.

By performing a patentability search prior to the filing of a patent application, an applicant is afforded the opportunity to make an early and informed decision on the likely success of a future patent application.

In addition, the information gained in early patentability searches can help steer research projects around problematic prior art.

While a patentability search is optional, conducting such a search is highly recommended prior to the filing of a provisional patent specification.

3.3.1.2. Validity search

A validity search is designed to locate specifications of prior art patents and published patent applications which predate the priority date of a granted patent being investigated. A validity search is usually more comprehensive than a patentability search. For instance, an investigation may be conducted to locate witnesses who are willing to attest to oral disclosure of the invention under investigation before its filing date. Accordingly, a validity search can be used to establish whether a competitor's invention is, in fact, patentable.

A validity search can also serve as a basis for a legal opinion regarding infringement, and may also form part of a due diligence investigation to be conducted prior to selling or licensing of a patent. [→ See Manual § 8.5.]

3.3.1.3. State of the art search

A state of the art search is directed to locating patents and the specifications of published patent applications, that represent the general state of art relevant to a particular invention, and is thus aimed at obtaining a broad overview of a particular technological field.

A state of the art patent search is the broadest and most general of all the patent searches. To a person who is contemplating entry into a particular field, state of the art search results can often provide an indication of the merits or advisability of the decision to enter the market. Seen from another perspective, that of a person who is currently active in a particular field, state of the art search results can lay out the path that ought to be followed to design around the current art, in

order to avoid infringement of other parties' rights. In this way, by investigating what work has been done previously, what problems have been solved, who is active in the field of art, and the chronological development of their work, inventors can prevent repeating redundant investigations and incurring unnecessary expenditure.

The scope of a state of the art search is not always easy to define. On the one hand, the searcher must search a broad array of sources, including published patent specifications, technical publications and even transcripts of important scientific meetings where technical papers may be presented before publication. Accordingly, the scope of the state of the art search should be broad in terms of the array of sources of information it uses while its field should be limited in order to give relevant and meaningful results.

3.3.1.4. Infringement search

A distinction needs to be drawn between the concepts of novelty and infringement: it is important to understand that, even if one's own invention is novel over the prior art, exercise of that invention could still infringe an earlier patent belonging to somebody else if the invention falls within the scope of the claims of that earlier patent. An infringement search, also known as a "product clearance" or "freedom to operate" search, is targeted at locating patents having claims that describe the proposed new invention.

An infringement search involves the careful review of unexpired patents relating to the proposed invention in a particular jurisdiction in order to ascertain whether the invention falls within the scope of any of the claims.

An infringement search of South African patents is a manual search carried out by considering the official records of the South African Patent Office. [→ See Manual § 3.4.1 – 3.4.4.]

3.3.2. Bibliographic search

Unlike subject matter searches, which are technical in nature, and are directed towards specific aspects of particular inventions, the purpose of bibliographic searches is simply to assess whether a patent (or patent application) has been filed in a particular name, or adheres to other bibliographic information. Examples of bibliographic searches are the following:

3.3.2.1. Name search

Name searches are intended to produce a list of all patents and patent applications that have been filed in the name of a particular proprietor (or applicant) and/or citing a particular inventor, during a particular time period.

3.3.2.2. South African equivalent search

As has been explained above (See Manual §2.1.2.9), patents are territorial in nature. Accordingly, if one is aware of a foreign patent that is filed in the name of a particular entity or person, it is possible to assess whether a corresponding South African patent (or patent application) exists. An equivalent search may, in appropriate circumstances, provide a neater alternative, or a confirmatory search, to conducting a name search.

3.3.2.3. International family search

International family searches can be seen as being extensions of South African equivalent searches. More specifically, if one is aware of the number of a patent (or a patent application) that was filed in a particular patent office, it is possible to search and compile a list of all other jurisdictions in which an equivalent patent (or patent application) had been filed.

3.3.2.4. Class search

Patents are categorised according to their field of technology into particular classes, which classes have been established under the International Patent Classification (IPC) System. The IPC System operates very much like the Dewey numbering system that is found in libraries. This makes it possible to search for patents that are classified into particular fields of technology.

3.4. PERFORMING SEARCHES

3.4.1. Electronic vs. manual databases

Regrettably, most records of the South African Patent Office are not yet available electronically, which means that most searches through these records need to be conducted manually. A manual search, understandably, is a time-consuming process, relative to an electronic search that is conducted using key word searches. If one

wishes to conduct an infringement assessment in South Africa, it will be necessary to conduct such a manual search, purely because no reliable alternative is available.

Fortunately, since novelty searches are most often conducted through the (electronic) records of patent offices other than the South African Patent Office, novelty searches need not be conducted manually. (Compare novelty searches to infringement searches → See Manual §3.3.1)

3.4.2. Country coverage

Each type of patent search is conducted through the records of particular patent offices only. It is neither feasible, cost effective, nor practical, to search through the records of every patent office on the planet. While choice of particular patent offices to search is often obvious in the case of bibliographic searches, it is very important to consider the choice of which patent offices' records to search when one conducts substantive patent searches. Typically, the “big four” patent offices that are searched through are those of the USA, Europe, Japan and WIPO.

3.4.3. Reliability of information

The reliability of the results returned in any type of patent search will always be dependent on the accuracy of the records that are maintained at the relevant patent offices.

3.4.4. Limitations

No novelty search can ever be truly exhaustive or conclusive. There are many reasons for this, including the following:

- the results obtained are subject to the accuracy and completeness of the records of the databases searched;
- searches are limited inherently by the search terms used and/or classes searched. Determining the choice of search terms and/or classes to be used is often a difficult assessment to make, and should not be taken lightly;
- the searches generally do not extend to non-patent literature which could reveal the existence of a prior disclosure of a particular

invention;

- in many countries, patent specifications generally fall open to public inspection 18 months from the earliest priority date. However, notwithstanding the fact that these are “hidden” from public view in that 18-month period, in South Africa, the contents of certain patent applications filed in other countries will form part of the pool of prior art against which the novelty of subsequent SA patent applications is judged, even though one could not have known of the existence of such prior art at the time of filing the later applications; and
- similarly, inventions used secretly and on a commercial scale within South Africa are also deemed to form part of the state of the art for the purpose of assessing novelty.

Despite these limitations, it is not true to suggest that conducting a novelty search is not a useful exercise: there is much value to be found in the wealth of relevant prior art that is inevitably revealed in the process.

3.4.5. Databases used

When it comes to assessing the pool of prior art, a number of sources are available. The databases of certain patent offices, such as the United States Patent Office, are available electronically, and are free-to-use over the Internet. This is an extremely valuable resource to patent attorneys and the general public alike. Unfortunately, though, not every patent office has an electronic database of its records, which might be searched by members of the public. The records of such patent office, including the South African Patent Office, can be searched manually only.

There are other subscription-based databases available commercially that are used by patent attorneys to conduct searches. These are extremely powerful, and the information contained and presented in these databases is often more extensive and more reliable than other free-to-use options.

Another excellent source of prior art that is available to the public-at-large, and that is not stored exclusively in databases is, popular literature: periodicals such as “Popular Mechanics” and “Chemical and Engineering News” are good examples of these, and the contents of such literature will certainly count amongst the pool of prior art. If you are aware of any relevant articles from these periodicals, it is advisable to bring these to the attention of your patent attorney, so that you may be advised fully.

A number of the most frequently used databases are briefly described below:

3.4.5.1. Derwent

The Derwent World Patents Index (DWPI™) features about 1.5 million patent documents which have been added to the database each year by more than 50 patent-issuing authorities. Derwent has a team of specialist editors that assess, classify and index these documents to provide concise English language abstracts which are readily searched and easily understood. As of February 2016, the database contains 30.4 million patent records.

3.4.5.2. Inpadoc

The INPADOC Database is produced by the European Patent Office (EPO) and is hosted on many databases including Thomson Innovation, Questel-Orbit, Dialog and STN Networks. Included are PFS (Patent Families) and PRS (Legal Status Information), produced by the EPO, the largest patent databases in the world in terms of both the countries and time-span covered. The former, namely Patent Families, deal with all patent documents applied in 65 patent offices worldwide, whilst the latter, namely Legal Status Information, deals with the legal status of patents (are they in force or not) in 22 patent offices. Simultaneous family/legal status searching is possible.

3.4.5.3. USPTO

US Patent & Trademark Office at <http://www.uspto.gov>

This database provides patent searches on patents issued by the USPTO since 1976. This site provides facilities to conduct key word searches on abstracts and full texts. Searches based on specified fields are also possible. Furthermore, the site provides a wide range of information on the activities at USPTO.

3.4.5.4. EPO

European Patent Office: Europe's network of patent databases at <http://ep.espacenet.com>.

This site is hosted by the European Patent Office, which provides the free access to all European patent applications filed and granted by EPO. The site also provides access to EPO's collection of patent databases named Globepat of about 60 countries, more than 30 million patents and also to Japanese abstracts.

Abstracts and claims of patents are also available on the site free of cost; all European patents; full text documents along with images (150 million pages) are also available on the site for free access. During 2012, the EPO launched a free patent translation service whereby patent documents could be translated into a number of different languages.

3.5. PERFORMING A BASIC PRIOR ART SEARCH

An inventor can perform a basic prior art search to see what knowledge (in the form of patents) already exists in the invention's scientific area. A basic patent search involves the following steps:

3.5.1. Accessing a publicly available patent database

The USPTO and Espacenet databases, *supra*, as well as the Google Patents database are of particular relevance here.

3.5.2. Performing a keyword-based search

Insert your first keyword or combination of keywords in the search interface provided. Repeat this step for various combinations of keywords until you think you've found the relevant existing patents. The keywords used in a novelty search are very important and have a direct bearing on the number of records returned by the enquiry. The use of more keywords in combination will result in fewer returns, as the field of the enquiry will be limited. However, there is an increased risk of not revealing relevant prior art. Conversely, the use of fewer keywords will result in a large volume of prior art being returned. Studying a large volume of prior art will provide a better indication of patented technology, but will involve longer hours spent perusing the search results.

3.5.3. cursory evaluation of patent revealed in keyword search

The search results initially reveal only patent numbers and corresponding titles. One would have to study the search results and obtain patent abstracts of those patents that appear to be relevant judging by titles only. The abstracts should then be ranked according to their relevance and complete patent specifications should be downloaded in respect of those patents that appear to be the most relevant in light of the patent abstracts. By skimming the first pages of each patent you can eliminate the majority of the records from your search.

3.5.4. Perusal of patents in detail

Once you have eliminated the non-relevant patents, the relevant patents will have to be considered in detail in order to determine whether a patent revealed by the search anticipates your invention.

It is important to bear in mind that a search of this nature can never be conclusive, although it provides a good indication of patented technology and thus the patentability (novelty and inventiveness of one's invention). The accuracy of the search results will depend on the accuracy of the records and databases searched. Moreover, these databases contain only published patent specifications and published patent applications – it does not include records of pending patent applications that are not yet open to public inspection. Furthermore, it does not reveal non-patented, but possibly known technology that would also form part of the state of the art, such as prior commercial use or other non-patent publications.

3.6. PLANT BREEDERS' RIGHTS SEARCHES

Each year a plant variety journal is published wherein the registered plant breeders' rights and the varieties on the national variety list are recorded. This journal is available online at: <http://www.nda.agric.za>. In this plant variety journal, particulars such as the holder of the right, the registration number and the term of the registration could be obtained in respect of the plant breeders' rights registered for each type of plant. Even more information on each registration could be obtained from the plant breeders' rights register and the application file.

Similar plant variety journals are published by other member countries of the International Union for the protection of New Varieties of Plants (UPOV). These variety journals are available from the respective plant protection offices, the particulars of which are available online at: <http://www.upov.org>.

3.7. DESIGN SEARCHES

In South Africa, the designs register is split into two sections. Firstly, an aesthetic design protects the appearance of an article, irrespective of the aesthetic value thereof (such as cell phone covers or automobile designs). The duration of an aesthetic design is 15 years. Secondly, a functional design protects the appearance of an article in as far as its appearance is necessitated by the function that the article is to perform (such as a paving stone or aluminium profiling). The duration of a functional design is 10 years.

In addition, designs are grouped into different classes of technology and a design application may be filed in one or more classes, to provide protection against infringing products falling in the same class. It is important to note that the protection is limited to articles falling in the same class for which the design has been registered.

3.7.1. Design novelty search

A design novelty search is conducted in order to identify whether the design for which registration is sought has been anticipated by any prior art, in the form of one or more similar registered design(s). Design novelty searches are conducted on KISCH IP's in-house design database. The results obtained from the search are then confirmed by the official records of the South African Designs Office in Pretoria.

3.7.2. Design infringement search

In order to decide whether or not infringement of a design registration has taken place, one must construe the representations and definitive statement filed in support of the application for registration to determine whether or not the alleged infringement falls within the scope of the registration. Furthermore, according to our courts, the state of the art at the time when the design was registered and the degree of novelty (and originality) achieved by the registered design is also an important factor. According to *Homecraft Steel Industries (Pty) Ltd v SM Hare & Son (Pty) Ltd and Another 1984 (3) SA 678 (A)* "if only small differences separate the registered design from what has gone before, then equally small differences between the alleged infringement and the registered design will be held to be sufficient to avoid infringement".

Central to the inquiry is to conduct a limited prior art search in order to ascertain the scope of protection afforded by the design registration. Accordingly, the registered design is compared to the prior art revealed by the search. Thus, if the step taken between the client's product and the registered design is greater than the step taken between the registered design and the prior art, the scope of protection of the registered design will be limited and the client's product will not fall within the ambit of the scope of protection afforded by the registered design.

3.8. TRADE MARK SEARCHES

Whilst not compulsory, it is advisable to conduct an infringement and registrability trade mark search prior to commencing use of a proposed trade mark and/or prior to filing an application to register the trade mark. Searches are carried out using the records maintained by the Trade Marks Office. Searches are relied upon in order to determine whether:

- a proposed trade mark will infringe an existing right of a proprietor with a prior registration or pending mark; and
- the proposed trade mark may be registered in exclusivity (this depends on the inherent nature and distinctiveness of the trade mark).

Ideally, the search results ought to be interpreted by a Trade Mark attorney, who will provide an opinion based on those results.

4. IP INTERPRETATION

4.1. INTERPRETING A PATENT SPECIFICATION

4.1.1. Requirements for patent specifications

Not just any document can be submitted to the Patent Office, and be described as a patent specification. There are a number of formal and substantive requirements directed towards specifications. As far as the formal requirements are concerned, there are multiple regulations that prescribe, for example, required line spacing, conventions regarding scientific measurements, and formalities for accompanying figures. It is advisable to leave it to your patent attorney to attend to these formal aspects. As far as the content of a provisional patent specification is concerned, it is required that the specification must *fairly describe* the invention.

The corresponding requirements for complete patent specifications are more onerous: these specifications must *sufficiently describe* the invention (i.e. not only *fairly describe* the invention). It is also required that examples be provided of the invention, as well as the manner in which it is to be performed. When assessing whether the content of the specification is sufficient, the test to be applied is whether the examples are sufficient “to enable the invention to be performed by a person skilled in the art.”

In cases where an invention can be performed in a number of ways, it is advisable to describe in the specification the best method of performing the invention. While this is not a prescribed requirement under South African law, it is often advisable, generally, to do so. Moreover, when one is considering applying for patent protection in foreign countries, it is important to note that it is a specific requirement in certain jurisdictions, such as the USA, that the best method must be disclosed.

4.1.2. Anatomy of a patent specification

It is a specific requirement that a complete patent specification includes each of the following:

- a title, that is short, specific, and not descriptive of the invention;
- a description and, where appropriate, illustrations and examples to enable the invention to be performed by a person skilled in the art;
- a set of claims defining the invention. Generally speaking, the claims may be regarded as being the heart of the patent application invention, as it is in the claims that the scope of protection is set out; and
- an abstract, that is narrative in nature, and generally limited to a paragraph not exceeding 150 words in length. An abstract may be regarded as being a “technical snapshot” of the invention.

Strictly speaking, these requirements do not apply to a provisional patent specification. However, it is often good practise amongst patent attorneys, wherever possible, to include a title, description & examples in a provisional specification. These specifications will also include what are described as “consistory clauses”, which help to define the invention, and which will form the basis for formulating the claims of what will become a complete patent specification. This is done to ensure that priority can be claimed from the provisional application when complete and/or foreign applications are filed.

Finally, while it is not compulsory, provisional and/or complete patent specifications may also include a background section, which describes the current art and prior art, and the problems with these. This often assists in laying a platform for describing the benefits derived from the application of the invention. Again, it is important to note that in certain jurisdictions, a background section discussing all relevant prior art is required.

4.1.3. Determining the scope of protection and ascertaining the content of the disclosure

While the heading to this section might appear to relate to a single concept, it relates, in fact, to two different topics. The difference between the two, although sometimes subtle, is crucial.

First, it is important to bear in mind that the boundaries of protection afforded by a patent are defined in the claims of a patent. Thus, for example, when assessing whether a particular article infringes a patent, one will need to compare the *claims* of the patent (and not, for example, the contents of the abstract of the patent) against the allegedly infringing article. Generally speaking, the claims stand on their own. However, it is sometimes permissible to have reference to the body of the specification (that includes the description and examples of the invention); this happens, most frequently, when definitions are inserted into the body of the specification.

It is a different question, entirely, to ask what content is disclosed by a particular patent. This question is relevant, for example, when conducting a novelty search, where it is necessary to determine if the contents of a particular patent specification anticipate the novelty of a current invention. (→ See Manual § 3.3) Under South African law, the “whole contents” approach is adopted and, as the name implies, all matter contained in a prior art patent specification, and not only the claims, may be considered.

4.2. INTERPRETING PLANT BREEDERS' RIGHTS

One of the criteria for obtaining a valid plant breeders' right registration is that the variety must be distinctive. To be distinct the variety must be clearly distinguishable from any other variety of the same kind of plant. Unlike patents where a range of different embodiments of an invention could infringe a single claim having a relatively broad scope, in the case of plant breeders' rights the registration is infringed only by the unauthorized actions contemplated in section 23(1) practised in respect of the protected variety. In other words, infringement takes place only if these reserved actions are applied in respect of a variety, which is not clearly distinguishable from the protected variety.

This is, however, subject to the fact that the protection is applied also to varieties:

- which are essentially derived from the protected variety, where the protected variety is not itself an essentially derived variety;
- which are not distinguishable from the protected variety; or
- the production of which requires the repeated use of the protected variety.

A variety shall be deemed to be essentially derived from another variety if:

- it is predominately derived from that other variety, or from a variety that is itself predominately derived from that other variety, while retaining the essential characteristics of that other variety; and
- it is clearly distinguishable from that other variety; and
- except for the differences which result from the process of derivation, it conforms to that other variety in respect of the essential characteristics.

To determine whether or not a particular variety infringes a protected variety, several techniques could be applied.

Firstly, a copy of the application filed in support of the registration could be obtained and the characteristics of the protected variety, as set out in the technical questionnaire and other documentation filed in support of the application, compared with the alleged infringing variety.

In addition, seed of the protected variety could be obtained and comparative growth trials conducted under controlled conditions, to compare the actual plants of the protected variety with actual plants of the alleged infringing variety. This could, however, be time consuming and may not be suitable in the case of trees and vines.

Another method of determining infringement is to prepare unique DNA fingerprints of the protected variety and to obtain plant material of the alleged infringing variety. Comparative DNA fingerprinting tests could then be conducted to determine objectively whether or not the alleged infringing variety is the same as the protective variety.

This will provide an answer as to whether or not the alleged infringing variety is clearly distinguishable from the protected variety. The question of whether or not the alleged infringing variety is an essentially derived variety is a question of fact and if the essentially derived variety is clearly distinguishable from the protected variety, comparative growth trials would not provide an answer in this regard, but DNA fingerprinting tests might.

4.3. INTERPRETING REGISTERED DESIGNS

The most important aspect in interpreting the scope of protection afforded by a design registration is the principle that designs are directed to specific features of articles, where:

- in the case of aesthetic designs, these features are judged solely by the eye (such as a jewellery box, or a design to be applied to a floor tile); and

- in the case of functional designs, where the form of these features is necessitated by their function (such as a fan-belt in a motor car).

Refer to the following sections elsewhere in the Manual:

- (i) § 2.1.4.3 - The difference between aesthetic designs and functional designs; and
- (ii) § 2.1.4.7 - The requirements for registrability of a design.

This is very different to patents, which are directed to an inventive concept in general, and which are not limited, to specific physical shapes.

The effect of having a registered design is that the registered proprietor may “exclude other persons from the making, importing, using or disposing of any article included in the class in which the design is registered and embodying the registered design or a design not substantially different from the registered design”. (→ See Manual § 3.7. regarding classification of designs).

Accordingly, the test to be applied in determining whether a registered design has been infringed, is an assessment of whether the allegedly infringing article is *substantially different* from the registered design. It will also be apparent that the tests for patent infringement and trade mark infringement are assessed differently to that for design infringement.

4.4. INTERPRETING TRADE MARKS

4.4.1. Requirements for trade mark applications

There is an obvious need to ensure that the trade mark specification correctly describes the nature of the goods or services for which registration is sought. A specification which includes goods/services not falling in a class for which a trade mark has been registered is subject to attack by third parties. A trade mark may be vulnerable for expungement (removal) from the Register, on the basis of non-use, if the Registrar is satisfied that:

- a) the goods/services reflected in the specification for goods/services which a trade mark is registered do not in fact cover the goods or services in respect of which the proprietor uses the trade mark;
- b) the proprietor had no intention to use the trade mark; and / or
- c) the proprietor has not used the registered trade mark for a continuous period at least 5 years.

4.4.2. Anatomy of a trade mark application

The Registrar of Trade Marks requires the following information when filing a trade mark application:

- a) the full name, legal status and physical address of the Applicant/Proprietor;
- b) a graphical indication of the trade mark (if it is a device mark clear prints of the device must be provided);
- c) specification of the class and goods/services to be covered;
- d) an original, signed Power of Attorney; and
- e) a certified copy of the priority documents, translated into English, if necessary, to be filed within 3 months of the date of application (and must be based on an earlier identical application filed in another Convention country at least six months prior to filing in South Africa).

4.4.3. Determining the scope of protection

Trade mark rights are registered in connection with specific goods and services and the scope of rights generally extends only to the countries in which the trade mark is registered and used.

In this regard, trade mark law protects an owner's right to use marks that distinguish its goods or services from others, and to prevent other persons from using marks that are likely to cause confusion in trade. Trade marks particularly symbolise the goodwill associated with particular products and the businesses for which the marks are used. Trade mark law protects this goodwill and consumers' ability to accurately ascertain the source of goods and services. Users of distinctive marks generally have superior rights to any later users. Should a mark contain a descriptive element, the Registrar will require, as a condition for registration, that the descriptive element be disclaimed (for example: in an application HAPPY CLOTHES in class 25 – which is the trade mark clothing class – the Registrar of Trade Marks will require that the word “CLOTHES” be disclaimed. This would mean that the user would have rights in HAPPY and be able to prevent someone else from using the element HAPPY on clothing, but will be restricted from claiming rights in the word CLOTHES as it is a descriptive element in the clothing class). However, the applicant will still have rights in the combination of the words.

4.4.3.1. The Intellectual Property Laws Amendment Act No 28 of 2013

The IPLA Act expressly provide for protection for Geographical Indicators (GIs), e.g. Rooibos, Karoo Lamb, etc, and for traditional or indigenous cultural expressions.

The IPLA Act was created to provide for the recognition and protection of certain manifestations of traditional/indigenous terms or expression, i.e. traditional/indigenous cultural expressions (and derivative cultural terms or expressions) that have a traditional or indigenous origin.

A geographical indication means an indication which identifies goods or services as originating in the territory of the Republic or in a region or locality in that territory, and where a particular quality, reputation, or other characteristic of the goods or services is attributable to the geographical origin of the goods or services, including natural and human factors.

5. CONSIDERATION OF THIRD PARTY IP

5.1. IP MAPPING

Knowledge of current and potential competitors is an important marketing and management tool for any business, in order to aid in the assessment of their strengths and weaknesses. It must first be decided what the industry in question is, who the competitors are, and more specifically in which field of technology such competitors operate. It may sound surprising that patent searches could be used as a useful analysis tool in regard.

Patent searches are conducted for various different reasons, for example, novelty searches to obtain an indication of the novelty of an invention, infringement searches to determine whether or not the exploitation of an invention would infringe a patent in a specific country, and patent name searches to determine if a party, usually a competitor, has any patents registered in its name.

A further reason, and an often neglected one, for conducting patent searches is to gain statistical data and information regarding patents. This information could be used to position oneself in the market relative to one's competitors, and to gain knowledge about trends in patent filings in specific technology fields. The results of these types of patent searches are referred to as patent maps. Patent maps are different graphs, such as bar graphs, line graphs, pie charts, and any other types of graphs, which depict patent information. The patent map is a visual representation of patent information of related fields, related industries or related inventors. The map is produced by gathering related patent information for certain technology fields, which is analysed and graphically represented in the form of a graph. These graphs show trends in patent filing and reveal, *inter alia*, the number of patents filed in a specific field over a period and by whom such patents are being filed.

Patent maps serve to depict patent information, which is publicly available, in a useful and efficient manner. One should therefore strive to gather and understand patent information to aid in understanding market development and technology growth. The type of patent map created depends on the information required. The map could be stand-alone for one entity or patent class or it could show the interaction of related companies and patents classified in different classes.

Patent maps provide valuable information which could be used for the following purposes:

1. To show technology trends: patents are classified in patent classes according to the technology to which a patent relates. Patent searches are conducted for patents in specific classes, to show trends and development in those fields. The number of patents filed can usually be linked to industry trends and development.
2. To understand the state of a technology: this information is especially useful for an entity that is starting out and that is in a research phase. Such an entity could focus on specific fields of technology, and may need to gather information about competitors in a similar market. This information is also important for the licensing of technology or when one is interested in obtaining a licence. These graphs provide background information pertaining to the field of technology, which could be used as background in developing new technology. These graphs also track technology and development by competitors to determine in which fields they are focusing.
3. To track technology changes: the number of patents filed per year in a specific class can be indicative of changes in a field of technology. One can therefore predict when demand for inventions in a specific field will increase or decrease. This type of information gives one an advantage over one's competitors.
4. To determine business opportunities: to determine market needs in specific technological fields. An entity could focus on areas in which patents have not been filed, and where a gap in the market may thus exist. This would help decide on a direction of product development and to spot potential gaps in the marketplace.
5. To obtain patent details: information such as ownership, inventors, filing date, nationality of inventors could be obtained. One could therefore obtain an overall view of companies active in specific fields. It is important to know the industry in which one is active, and to predict development and direction of technology and areas in which the competition is focusing. This information could be used to gain information about other companies to analyse their intellectual property and their innovation culture. This information is especially important when going into a

business venture with a company, since patents are assets. The value of its patents could then be measured against similar patents of other related companies. This information could also be used when an entity wants to partner with a company and share technology. Information about inventors could also be used by human resource management, to determine who the top inventors are in competing companies.

6. To determine a current field of technology and to view development of international businesses: this is especially important in 21st century companies, since one cannot merely take the domestic market into account. Patent maps could show patent filing trends in USA and Europe and not merely SA.
7. To obtain infringement checks: to position one's own patents relevant to other patents being filed. Patents being filed are therefore continuously being verified and status reports conducted.

Patent mapping is therefore a tool for creative thinking, allowing researchers to find solutions to problems using state of the art technology disclosed in patent specification. This information allows researchers to make improvements to existing inventions, and to file patents for their improvements to such inventions, without wasting unnecessary resources and money.

5.2. ASCERTAINING THE STATE OF THE ART

Before the decision is taken to file a provisional patent application in respect of a particular invention, it may be desirable first to assess what technology has been disclosed publicly already. The rationale for conducting such searches is that, if the invention has, or aspects of it have, already been disclosed publicly, then (those aspects of) the invention will not be novel, and hence not patentable. The results of such searches may often be disappointing: in a worst-case scenario, every aspect of the invention may be anticipated by prior art documents. However, even such a drastic disappointment has the benefit of the knowledge that you would not be pursuing patent protection in respect of an invention that was not patentable. Ultimately, this would save much time and effort. There is no obligation on a would-be patentee to conduct a state of the art search, but the service is certainly available to those who would like to use it.

These searches are conducted in similar fashion to novelty searches → See Manual § 3.3.

5.3. FREEDOM TO OPERATE

It sometimes happens that a manufacturer wishes to put a new product on the market, or produce a product using a new method (whether or not that product or method is patented is

irrelevant for purposes of this discussion). In order to assess whether offering the product for sale or using the new method will infringe another person's patent, it is possible to assess whether any patents exist, which would be infringed by these acts. Such searches are referred to as "product clearance", "freedom to operate" or "infringement" searches, and are discussed in detail in Chapter 5.

6. R&D MANAGEMENT

6.1. OWNERSHIP OF INVENTIONS

6.1.1. Rights of ownership

It is all too often assumed that, merely because an employee is employed by a company, or merely because an external consultant has been engaged and remunerated to perform certain work, that any invention which is conceived by the employee / consultant automatically belongs to the employer / instructing party (as the case may be). Unfortunately, this is not always the case, and certain formalities may need to be complied with in order to ensure that the desired results follow.

An example of a potential consequence of not complying with these formalities is that an invention may belong to an employee, who ultimately leaves his company's employ to set up a business in competition with the ex-employer. If that ex-employee is the owner of the invention in question, he may well be able to restrain the ex-employer from using that invention. Similarly, an external contractor, if he is the owner of the invention, may be entitled to licence or sell the invention to third parties, including competitors of the instructing party. The extent of such consequences cannot be understated, and it is extremely important that the process be regulated properly right from the start.

6.1.2. Employee contracts

It is possible to place provisions in an employee's contract to compel him to assign an invention to his employer. However, the Patents Act places limitations on the scope and extent of such provisions. Specifically, any provision requiring an employee to assign an invention:

- other than one that was conceived within the course and scope of his employment; and/or
- that was made more than one year after the termination of his employment;

shall be null and void.

In a related matter, patents and inventions should not be considered in isolation: a holistic approach to the protection and management of IP ought to be adopted, as works of copyright and confidential information may well also be developed during the process of development of an invention. These aspects may be inextricably intertwined and, for this reason, it is prudent to ensure that all forms of IP are assigned properly and fully to the employer / instructing contractor (again, as the case may be). It should also be appreciated that the provisions in the Patents Act extend only to patents and patent applications, and that there is other legislation having further requirements that regulate the assignment of other forms of intellectual property to employers and instructing parties. Because of these multiple formalities, it is always best to consult your IP practitioner for advice before embarking on a project in which IP is expected to be generated.

6.1.3. Assignments

The act of transferring intellectual property from one person to another is known as an “assignment”. It is not only patents, trade marks and designs that are capable of being assigned, but also applications for each of these, as well as rights to inventions and works of copyright.

The Patents, Designs, Trade Marks and Copyright Acts all contain somewhat different provisions and formalities relating to assignments. Generally speaking, the most conservative and cautious approach in such matters would be to ensure that all assignments are executed:

- in writing; and
- on or before the effective date of assignment (rather than after).

When your company (Company “A”) enters into an agreement with a third party company (Company “B”), in terms of which company B is to produce intellectual property for you, formalities will be important on two levels:

- first, as one would expect, an assignment from Company B to Company A will be necessary; and

- an assignment from Company B's employee(s) to company B will also be necessary.

If either of these types of assignment is missing, it is possible that Company A may not be the owner of the IP in question, even if this was the intention.

Finally, when assignment is made of any registerable form of IP (patents, designs, trade marks) it is important to have the relevant register sheet endorsed to reflect the assignment, as this is necessary in order to inform the public-at-large of the change in ownership of the IP. A failure to do so may have drastic consequences when determining who may sue or be sued in subsequent court proceedings. Always remember to have your patent attorney or trade mark attorney attend to the endorsement of the register following any assignment.

6.2. IP CAPTURING AND REPORTING PRACTICES

One of the most important aspects of efficient IP management, and thus of fuelling a sustainable IP cycle, is the proper capturing and reporting of IP. In too many cases valuable IP is lost, or at least diluted, due to a lack of, or improper application of, IP capturing and reporting principles and practices.

6.2.1. Capturing of IP

The first step of protecting IP is to ensure that it is timeously and thoroughly captured in a useable format. IP often remains trapped in the minds of inventors, and it is therefore imperative that all IP, or potential IP, be reduced to material form as soon as it is generated. This may for instance be in the form of detailed lab notebooks, experimental reports and status reports. A very important principle in this regard is that the captured information should not be limited to end results only, but should include processes followed (mental or physical), assumptions, know-how applied and relevant background IP considered and applied.

6.2.2. Reporting of IP

All new IP, whether protectable by statute or not, should at all times be treated as confidential information, and should not be disclosed to any third party without prior approval from the relevant authorities.

Any inventor must therefore, as soon as reasonably possible, disclose any invention, new plant variety or any form of IP that may fall within the scope of the inventor's

employ to his or her relevant IP manager by way of an IP Declaration, without any filtering. An IP Declaration should include at least the following information:

- a) inventor(s) details;
- b) technical details of what was invented;
- c) circumstances leading to the invention;
- d) information on any agreements entered into to facilitate the development of the invention;
- e) facts concerning subsequent activities, undertaken and planned;
- f) information regarding any resources, understood to include information, that contributed to the invention;
- g) information the inventor(s) may have relating to other activities relating to the invention; and,
- h) any other information that may prove useful in making a determination as to intellectual property protection.

7. DECISION TO PROTECT

The decision whether, and if so how, to protect IP is not always as simple as may be initially assumed. Many factors play a role in determining the value and viability of protecting new IP, such as, for example the value of the IP to a proprietor, the inherent protectability, and the form that protection can and should take. These aspects should all be considered holistically so as to ensure that a prudent and commercially sound approach is followed.

In practice, the following issues can, inter alia, be isolated:

7.1. IS IT WORTH PROTECTING?

Often an invention is a true novel and inventive concept in the theoretical sense, but the commercial viability of the exploited invention may be lacking due to many different reasons. Conversely, an invention may be marginally inventive, but the commercial environment may be such that a potentially 'weak' patent or protected right may in the end be of immense commercial value. The theoretical and legalistic protectability of an invention or of new IP should therefore never be considered in isolation when determining whether IP is worth protecting – the IP should be seen against the commercial backdrop in which the proprietor of the IP is operating, taking cognisance of market demand, timing and potential commercial benefit. However, it is always prudent to err on the side of caution when deciding whether IP is worth protecting, because a decision not to protect is usually not one that can be reversed at a later stage.

7.2. IS IT PROTECTABLE?

Whether IP is protectable is a factual question in which the subject matter for which protection is sought is compared to the different forms of registrable and unregistrable IP. It is important to remember that even IP that is not necessarily protectable by statute may still be protectable - for instance in the case of trade secrets and confidential information.

7.3. WHICH FORM OF IP TO USE?

The next logical step would be to decide which form of IP would be most suitable given the particular set of facts surrounding the development and envisaged use of the IP. In many cases more than one form of protection (e.g. Patent, Design and Copyright) may be available, but in other cases different types of IP may be mutually exclusive (e.g. Patent and Trade Secret). The selection of the most suitable type of IP, if options are indeed available, should again be dictated by the bigger commercial environment and business orientation.

7.4. DECISION TO PATENT

A decision whether a patent application should be filed in order to seek protection for a particular invention is often a particularly difficult one, and some factors that may assist in reaching the correct conclusion are discussed below:

7.4.1. Prospects of obtaining a valid patent

In cases, for example, where there is much prior art, or where there is doubt regarding the patentable merit of the invention, the prospects of obtaining a valid patent may appear to be low. In such cases, one ought to expect a lengthy and expensive prosecution process in examining states. Also bear in mind the risk that the mere filing of a patent application in an examining state is no guarantee that the patent will be granted ultimately.

7.4.2. Scope of protection obtained

If the invention is directed to a particularly narrow aspect, the question must be asked whether the monopoly that would be afforded by a patent will be worth the cost involved in obtaining it. Again, one must also bear in mind the risk that the patent application might ultimately be unsuccessful. At the opposite end of the spectrum is the concern that, if the claims of a patent are framed too broadly, this may place the

patent in a position where it stands to be revoked, on the basis that the invention is, in fact, not patentable. It is extremely important that a proper balance is struck when assessing the boundaries of the scope of protection.

7.4.3. Circumvention of patent

Part of the art of drafting a patent specification is to make it as difficult as possible for other parties to circumvent the patent. For this reason, it is extremely important to consider all possible ways in which the advantage of an invention can be achieved. So, for example, if the same advantage can be achieved in any number of ways, this might be an indication that the invention would be too easily circumventable to merit pursuing patent protection. After all, if one cannot effect a patent against potential infringers, it must be asked whether the patent is of any real value to the patent-holder.

7.4.4. Competitor analysis

Inventions and business plans alike do not exist in isolation. Pursuing patent protection in respect of an innovation is a practical stratagem to obtaining a monopoly on at least some part of the market. The advantage of having a patent can therefore be seen to be twofold: first, it places a monopoly in the hands of the patent-holder, and simultaneously places an obstacle in the path of the patent-holders' competitors. This is particularly true in non-examining states like South Africa, where it is relatively easy to obtain a patent in respect of an invention. The law in such states tends to be biased in favour of a patentee, and this can be an opportunity to be exploited.

7.4.5. Relationship of the patent with other IP

The point has already been made that a holistic approach to the protection and management of IP ought to be adopted. A corollary of this is that it will need to be assessed whether an invention will be protected sufficiently by other forms of IP alone, or whether patent protection ought to be pursued to compliment or consolidate protection for the invention.

Also bear in mind that, if a patent is to be obtained, the patent specification, which includes detailed and often confidential information, will become a public document, and hence open to inspection by the public-at-large, including your competitors. This may be a disincentive against pursuing patent protection in certain circumstances. (→ Manual § 2.1.9. above)

7.4.6. Assessment of commercial potential

Obtaining a patent is one thing; commercialising it effectively to generate commercial returns is another matter entirely. As with all other forms of investment, the costs and risks associated with filing patent applications will need to be weighed-up against potential commercial returns that are expected to be generated.

Relevant questions to be asked here include the following:

- is the proposed patent likely to generate revenue for the patent-holder?
- is the proposed patent likely to present at least some obstacle to the position of competitors in the market place?
- even if a patent is obtained ultimately, will you be prepared to spend more money, if need be, on the enforcement of the patent?
- what if the patent application in a particular country is refused ultimately – can the cost be absorbed / justified?
- given that it may take years to obtain a patent in certain foreign jurisdictions, will the technology still be worth protecting then, or is it likely to be redundant?
- what do the above factors, when taken as a whole, indicate would be the most prudent approach to follow?

A final thought: when considering the factors described above, even if the factors in favour of pursuing patent protection appear to be outweighed by the factors mitigating against it, don't despair: remember that IP consists of a basket of tools, of which patents are merely one. It is always important to assess how your particular IP budget should be optimised to suit your risk-return profile, and pursuing patent protection is not always the best option in every circumstance.

7.4.7. Timing of filing patent application

After considering the factors described above, and once the decision has been taken to file a provisional patent application, the next question is when this ought to be done. Given that the novelty requirement (→ See Manual § 2.1.2.2) is an absolute requirement, it is imperative that a provisional patent application should be filed before

any public disclosure of the invention is made. Doing this in the reverse order will be fatal to the patentability of the invention.

As a general rule, a patent application ought to be filed sooner, rather than later, as an earlier priority date will mean less prior art that might be cited against your invention. Even if it should happen, as it often does, that the desired research and experimentation into the invention is not yet complete, it may still be possible and preferable that a provisional patent application be filed now, and the remaining research and experimentation be conducted over the course of the next 12 months. (→ Manual § 2.1.2.11 above)

On the topic of timing, the filing of a provisional patent application is merely the first step in pursuing patent protection around the world, and it should also be remembered that there are further deadlines that will apply to filing national phase applications and performing other related acts. Many of these deadlines are not extendable, and missing certain of these deadlines may result in the patentee losing a number of rights and advantages, including the right to file patent applications in certain countries. (→ Manual §§ 2.1.2.5 and 2.4)

7.4.8. The Golden Year

It is imperative to make the most of the first year of 'provisional' protection provided by a provisional patent application. There is no obligation on any person who files a provisional patent application to file a complete patent application, but essentially the law provides a twelve-month period in which to make the decision whether to proceed. Ideally, that twelve-month period ought to be used to do the following (not all will be relevant to every invention):

- locating potential licensees and other commercial partners such as manufacturing and distribution agents;
- conducting further research and development; and
- investigating which markets – local and international - are worth pursuing.

On the basis of what is revealed in these investigations, a decision can then be taken on how best to proceed at the twelve-month mark.

8. COMMERCIAL EXPLOITATION

8.1. INTELLECTUAL PROPERTY AS AN ASSET

Intellectual Property is often not regarded as a 'true asset' due to the intangible nature thereof. However, in the modern knowledge economy IP is just that – an asset. An asset that can be sold, bought, licensed, securitized, serve as collateral – in other words very much a tradable commercial tool and commodity. Most statutes also recognise IP as an asset in all senses of the word, and there is no reason for a prudent business not to follow suit. It is therefore of utmost importance that IP should be regarded for what it really is in a commercial environment – assets that a business entity can effectively use to further its own interests.

8.2. VALUATION OF INTELLECTUAL PROPERTY

Pursuant to the above, it follows that IP will also have inherent financial value.

As a general rule IP value is gauged from the extent to which the IP has been (or can reliably be expected to be) utilized and contributes to the generation of revenues at demonstrable levels of operating profitability, and from correspondingly motivated forecasts of anticipated revenue generation at demonstrable levels of operating profitability.

As a further general rule, the valuation exercise invariably requires an investigation of the nature and extent to which the IP is embedded, or will be embedded, in functioning operating systems within the relevant business i.e. an investigation of the technology/brand support intangibles that have been customised to enable the IP commercially to be exploited.

The process of ascertaining such value is however not a simple exercise, and should best be left in the hands of skilled IP valuation experts. Various models are nowadays used to value IP, with the most popular and generally accepted method being the Royalty Savings method. It is however not within the scope of this manual to deal with valuation principles and methodologies at length, and it is recommended that any valuations enquiries should thus be directed to relevant IP practitioners.

8.2.1. Impact of IP value on transfer pricing

The value and role of IP and the technology/ brand support intangibles customised to exploit it, is an increasingly important issue in Transfer Pricing adjustments, companies operating across borders are required to make. Changing user responsibilities and the risks assumed by the different cross-border entities of a given business in the course of the exploitation life-cycle of

the IP, need to be monitored and accounted for, as these changes attract transfer pricing adjustment obligations.

8.3. COMMERCIALISATION MODELS

IP can be commercialised in many different ways. A suitable commercialisation should in each case be selected based on the particular facts of the matter. A few potential commercialisation models are described below.

8.3.1. Exploitation

It is possible for a business to exploit its own Intellectual Property as the proprietor of the Intellectual Property. This can be a complicated process and can place huge strains on the financial and management resources of a business. It is of critical importance that direct exploitation of IP is done professionally and according to sound business principles. This would require:

- the creation of a sound and realistic business plan;
- the acquisition of the necessary infrastructure, which will be required for the exploitation of the intellectual property;
- the obtaining of the necessary financing for the exploitation; and
- the determination and assessment of the physical operational work which will be involved and the management planning which would be required.

8.3.2. Assign/Sell IP

Once a business has developed IP it would be possible for the business to enter into an outright sale agreement with interested parties who have the necessary means and resources with which to exploit such IP. In an outright sale the determination of the price or the value of the IP being sold is of critical performance. It is extremely difficult to assess the value of premature ideas and to attach a commercial value thereto. Even though an idea or IP may in theory be extremely promising, there may be certain obstacles in the successful commercialisation thereof, for example difficulties in establishing a distribution channel or in marketing an unknown or uncertified technology, which obstacles need to be considered in determining a price for such IP.

8.3.3. Licensing

It is further possible for a business to licence its IP to third parties who have the necessary means with which to commercialise or exploit the IP. When entering into a Licensing Agreement there are two general methods of being remunerated for the granting of a licence. The first is via the receipt of a once off licence payment and the second is via the receipt of periodic royalties. A combination of the two may of course also be applied. The second method is generally more common than the first, however the appropriate method to apply depends on the nature of the IP being licensed. Of key importance would be to ensure that the business negotiates a royalty for the licensing of the IP that is based on turnover and is not based on profits. It is possible for third parties to manipulate their profits, thereby causing a lesser royalty to be paid to the business. During negotiation pertaining to licensing, it is recommended that the appropriate legal advice is sought and that ownership of the IP be retained and that necessary clauses pertaining to limitation of liability and to royalties be inserted. It is also suggested that the Licence Agreement be drafted in such a way that it can be terminated should the third party not exploit the IP to the business's satisfaction. The benchmarks and criteria for exploitation should be clearly set out within the Licence Agreement.

8.3.4. Joint venture

It is further possible for the business to enter into a Joint Venture with third parties for the commercial exploitation of IP. These joint ventures can take the form of a basic partnership or could be in the form of a company that would act as the Joint Venture vehicle. Typically in a Joint Venture, the business would own a certain share percentage in the Joint Venture company subject to the transfer of the IP either by way of assignment / outright sale or by way of licence from the business to the Joint Venture company. The other shareholders to the Joint Venture company would be such third parties that have the necessary financial and operational means with which to exploit the IP.

8.4. LICENSING

8.4.1. Introduction

Before entering into a Licence Agreement careful attention needs to be given to the nature of the IP which is to be licensed. Some forms of IP by their very nature are easier to licence where certain other forms of IP lend themselves more to a sale.

8.4.2. Types of licences

The following characteristics define some of the most pertinent aspects of licence agreements:

- Exclusive / Sole / Non-exclusive;
- Sub-licensing provisions;
- Running royalty / upfront payment / combination;
- Ownership of developments;
- Territory;
- Licensed object.

8.4.3. Reasons for licensing

The main reasons for licensing IP is because it is a form of commercial exploitation of the IP in terms of which the business will retain title or ownership of the IP whilst enjoying the receipt of licence fees or royalties in terms of the Licence Agreement.

8.4.4. Risks and reward from the licensor's perspective

The reward, which a Licensor could obtain by licensing its rights to intellectual property, pertain to the securing of a revenue stream, in the form of licence fees and royalties. A further benefit from licensing is that the Licensor can procure a revenue without having to incur the expenses and/or risk associated with actual employment / utilisation of the intellectual property concerned.

The risks pertaining to the licensing are several and include, but are not limited to, non-payment of the licence fees, third party infringement, contractual liability, and damage / destruction of the intellectual property concerned.

8.4.5. Finding the right licensee

When selecting a Licensor, we suggest that the following factors be considered:

- the nature of the Intellectual Property being licensed;
- the market where the Intellectual Property will be used; and
- the experience, resources, strategic operation plans of prospective Licensees.

8.4.6. Negotiations and payment

As licensing negotiations are extremely complex, these should only be undertaken by persons who have the relevant and necessary training and experience. The structuring of licence payments is extremely crucial and great care must be taken in this regard.

8.4.7. The licence agreement

Licence Agreements should be drafted by attorneys with consultation with the relevant key persons at the business, in order to ensure that the agreement clearly and accurately, represents the intention of the business.

8.5. DUE DILIGENCE

Due diligence is a process via which a buyer (or potential licensee or assignee) seeks to identify and gather information relating to the business and assets of a seller (or potential licensor or assignor) in order to allow a reasonable estimate of the viability, the risk and the future profitability of the transaction in question.

Such an exercise aims to enhance understanding of what exactly is being acquired and to enable the parties to place a meaningful value on the assets to be transferred with the benefit of legal opinion. The due diligence effort should, therefore, be conducted at an early stage since its conclusions will, undoubtedly, have a significant impact on negotiations leading to the structure and completion of the transaction.

Due diligence should start by identifying all rights involved in a transaction. For example, these may include a mixture of registered or registrable rights such as pending or granted patents and trade marks existing in numerous territories and unregistered rights such as copyright, know-how and trade secrets. Once registered rights such as patents have been identified and their current status and expiry dates checked, it should be verified that all due fees have been paid. Official records should reveal the history of a patent in terms of any changes in ownership or granting of licences. Rights are often pledged as security and it is, therefore, also important to extend the search to security interests.

It is not enough, however, merely to consider the rights in isolation. In order to make informed decisions, it is also necessary to consider how the rights relate to the main products and services of the seller. There is little point in acquiring a “peripheral” right that does not properly protect the products and services that the purchaser of the rights hopes to sell upon completion

of the licence agreement of sale. Thus it should be verified that the rights to be acquired correlate with the main products and services of the seller.

The buyer of the IP assets must satisfy himself/herself that the seller has the legal right to transfer the property in question, for example, as owner of sub-licensing rights. It follows that the downstream consequences of wrongly assuming that a seller has a legal right to transfer the property are potentially disastrous.

One high-profile example came in mid-1998 when Volkswagen was negotiating to acquire the automotive operations of Rolls Royce. VW paid £479 million for these operations, only to find that it had acquired no rights in the valuable Rolls Royce trade mark. The mark went to BMW, which had separately negotiated to acquire the trade mark rights. In the context of this highly publicized transaction, VW's response options were constrained: It had to get value for its purchase money, yet it did not want to appear to shareholders, the business press and to the public that it had carelessly failed to nail down a key deal term.

The following preliminary issues should be reviewed by both buyer and seller well before closing:

8.5.1. Patents

- Review all granted, pending and abandoned patent applications and patents. Include all applications and patents filed by the seller, currently or formerly owned by the seller, or licensed to the seller.
- Review all patent searches conducted by or on behalf of seller related to inventions or designs.
- Confirm payment of maintenance fees for all patent applications and issued patents.
- Review all cooperative research agreements, license agreements and merchandising agreements, regardless of whether seller was the licensee or licensor.
- Review all threatened or pending interferences involving seller's patent applications or patents.
- Review all invention disclosures related to the business assets being transferred that are either awaiting disposition or are to be the basis of a patent application.

- Review all technologies that are material to the business assets being transferred, together with a description of how each such technology was developed or acquired and copies of all documents evidencing any such acquisition.

8.5.2. Copyrights

- Review all copyrightable works that seller has created, commissioned or acquired rights to that are used with the business assets being transferred. If seller does not own a copyright in such works, review who owns the copyright and the nature of seller's right to use the works.
- Review all documents concerning all copyright registrations, including applications, correspondence, transfers and security interests.
- Review all licences, regardless of whether seller is the licensee or licensor, related to any copyrightable works used by seller.

8.5.3. Trade marks

- Review all trade marks and service marks registered or used by the seller anywhere in the world, whether as owner or as licensee. Review both the geographic area of use and the date of first use of each such mark in each region.
- Review the prosecution files for any registrations or pending applications.
- Review all trade mark searches performed or obtained in connection with such marks.
- Review all licences related to such marks, regardless of whether seller is the licensee or licensor.
- Review all quality control manuals, files or guidelines relating to goods or services sold under the marks.
- Review specimens of each use of such mark for each jurisdiction in which the mark has been used or registered.

8.5.4. General IP due diligence issues

- Review copies of all letters of demand sent out or received by the seller concerning IP.
- Review all threatened or pending litigation concerning IP.
- Review all settlement agreements concerning IP.
- Review all domain names in the name of or controlled by seller that incorporate any trade mark or service mark of seller or are used in connection with any of the business assets being transferred.
- Review all trade secrets concerning the business assets being transferred and the means by which their secrecy is maintained.
- Review any proprietary information owned by seller and not protected by copyright, trade mark or patent, including trade secrets, know-how and confidential information.
- Review all agreements pursuant to which seller's goods or services are distributed or marketed to third parties.
- Review seller's standard agreements with employees, directors, temporary employees and independent contractors regarding employment, confidentiality, non-disclosure, assignment of inventions and copyright.
- Review all non-standard agreements between seller and its employees, directors, temporary employees and independent contractors regarding employment, confidentiality, non-disclosure, assignment of inventions and copyright.
- Review all policies and guidelines of the seller relating to the protection or use of proprietary information protected by copyright, trade mark, patent and trade secret.
- Review all documents and filings affecting title to IP (security interests, releases of security interests, assignments, changes of name) to confirm a complete chain of title.

- Review all security interests, security agreements and releases of them, whether or not recorded, relating to any of the IP assets scheduled to be transferred.

8.6. ENFORCING INTELLECTUAL PROPERTY RIGHTS

8.6.1. Introduction

The effect of a patent is to grant to the patentee, in the Republic of South Africa, the right to have the whole profit and advantage accruing by reason of the invention. Likewise, the proprietor of a registered design, trade mark and copyright has the exclusive right to exploit such design, trade mark or copyright.

8.6.2. The reality of defending IP

The enforcement of IP rights involves the IP owner's action of calling on a court's assistance to exercise the negative rights flowing from IP rights by intervening with the actual or threatening infringement acts of an infringer. The reality of defending one's IP is however that it will most likely result in lengthy and costly litigation. It is therefore imperative for a prudent IP owner to ensure that sufficient funds are allocated for the protection of IP, as the IP is only as valuable as the IP owner's capacity and willingness to enforce the same.

IP litigation is a complex and highly specialised area of the law and any potential litigant is advised to procure the services of a skilled IP practitioner as soon as any threatening litigious matter arises.

8.7. GENERAL CONTRACTUAL PRINCIPLES

8.7.1. Agreements encountered

What follows is a cursory discussion of agreements that are commonly encountered in the realm of the commercial exploitation of IP.

8.7.1.1. Licensing agreements

Licensing Agreements pertain to the licensing of Intellectual Property rights by the business as Licensor to third parties who will be the Licensee. Such agreement typically deals with the nature of the licence, payment received in lieu of the licence being granted, confidentiality and various aspects pertaining to Intellectual

Property rights, limitation of liability and warranties, user parameters and termination.

8.7.1.2. Joint venture agreements

A Joint Venture Agreement contains provisions which regulate the co-operation between two or more contracting parties in which they jointly co-operate with each other towards the achievement of a common goal. The agreement is concluded to the benefit of all parties to the Joint Venture.

Typically a Joint Venture Agreement deals with the formation of a Joint Venture company or another form of business or structure in terms of which the Joint Venture will be housed, the funding requirements for the Joint Venture, various suspensive conditions which would be conditional to the formation of a Joint Venture, the ownership of the Joint Venture and the appointment of directors for a Joint Venture company or the creation of a management structure for the Joint Venture, meetings between the parties to the Joint Venture, provisions setting out the responsibilities of the various parties to the Joint Venture and the levels of authority for any management committee for the Joint Venture, provisions pertaining to the day to day running and operation and management of the Joint Venture, the provisions dealing with the duties and obligations of the parties to the Joint Venture, provisions dealing with the distribution of the proceeds and the profits achieved by the Joint Venture, guarantees and indemnities, the manner in which the financial accounting of the Joint Venture will be handled, the duration of the Joint Venture, provisions pertaining to pre-emptive rights pertaining to the sale of an interest in the Joint Venture, dispute resolution and termination, provisions dealing with contribution of assets to the Joint Venture and disposal of assets belonging to the Joint Venture and provisions pertaining to the intellectual property held by the Joint Venture.

8.7.1.3. Research and development agreements

Research and Development Agreements generally deal with provisions in terms of which the parties to the agreement have agreed upon the funding of research and development for a specific project or purpose. This type of agreement will normally contain provisions pertaining to certain conditions precedent to the research and development, the nature of the research and development to be done, the scope thereof, the duration of the agreement, the funding obligations of the parties, the various duties and obligations of the parties to the agreement, the ownership of the Intellectual Property rights developed from the research and

development, the possible exploitation of the proceeds or product of the research and development, confidentiality undertakings, dispute resolution and termination.

8.7.1.4. Assignment / Sale agreements

Sale of Intellectual Property Agreement deals with the sale of the ownership in the Intellectual Property from the seller to the buyer. The assignment of the Intellectual Property is a process by which the Intellectual Property is transferred from the seller into the name of the purchaser. In terms of the sale of Intellectual Property, this agreement will deal with aspects as to the nature of the Intellectual Property sold, the price, the date on which ownership will transfer, when payment will take place, the date on when risk will transfer, deals with aspects as to whether the Intellectual Property includes goodwill and in the case where the Intellectual Property is sold to a foreign entity, will deal with the requirement of obtaining the South African Reserve Bank's prior approval to the sale being concluded.

8.7.1.5. Non-Disclosure / Confidentiality agreements

A non-disclosure or confidentiality agreement is a very important arrow in the IP quiver. A non-disclosure agreement is predominantly used to protect the confidentiality of IP by preventing unauthorised disclosure thereof, but often also fulfils an important non-circumvention purpose in that circumvention of the disclosed IP, as well as general unauthorised use thereof, can also be regulated.

8.7.2. Legal framework to take cognisance of

IP Commercialisation should never be seen in isolation. One must be aware of many different statutes that will certainly have an impact on the commercialisation of IP, including:

- Patents Act no. 57 of 1978
- Plant Breeders' Rights Act no. 15 of 1976
- National Environmental Management: Biodiversity Act no. 10 of 2004
- Designs Act no. 195 of 1993
- Trade Marks Act no. 194 of 1993
- Copyright Act no. 98 of 1978
- Counterfeit Goods Act no. 37 of 1997
- Merchandise Marks Act no. 17 of 1941
- Common Law
- Exchange control statutes and regulations

- Occupational Health and Safety Act no. 85 of 1993 (OHSA)
- Labour Law
 - *Employment Equity Act no. 55 of 1998 (EEA)*
 - *Labour Relations Act no. 66 of 1995 (LRA)*
 - *Integration of Labour Laws Act no. 49 of 1994*
 - *Skills Development Act no. 97 of 1998*
- Black Economic Empowerment (BEE)
 - *Broad-Based Black Economic Empowerment Act no. 53 of 2003*

9. CONTRACT MANAGEMENT

9.1. INTRODUCTION

In order to ensure a consistent approach to contracting and the manner in which business risk is addressed and in particular the manner in which Intellectual Property rights are addressed, a business should continuously be reviewing the agreements pertaining to its Intellectual Property rights.

In conjunction with the review of agreements pertaining to a business's intellectual property rights, and in order to manage its legal and business risks, a Contract Management / Governance Policy should be adhered to. This will ensure that there is a consistent approach to the conclusion of the agreements and that legal input is provided at critical junctures during the creation, management and exploitation of a business's Intellectual Property.

9.2. CONTRACT MANAGEMENT POLICY

A Contract Management Policy will have a number of aspects to it. These will range from dealing with specific agreements to business issues such as the delegation of authority and approval.

9.2.1. The approval process

Most organisations have specific processes and procedures which need to be followed in order for approval to be given for the embarking on particular projects or a course of action. Levels of authority within a business organisation structure need to be established for this purpose.

Unfortunately, in many organisations during the approval process, the legal function is not involved until just before contract signature. This can result in delays in the contract signature and loss of an advantage in contract negotiations.

Authorisation and structure approval processes of a business should be examined and critical junctures should be identified at which legal input is to be given. Ideally, legal input should be provided as early as possible in the process and the potential risks which may arise in the transaction and risk litigation measures from a legal perspective should be identified as early as possible as this assists in the business process.

9.2.2. Control of documentation

The control of standard documentation and the retention of signed legal documents are of critical importance and a procedure for this should be implemented within the greater organisational structure of the business. These aspects are discussed in more detail below.

9.2.3. Management of standard documentation / agreements

Standard IP Agreements should be strictly controlled, preferably by an IP Legal / Commercial Manager. No opportunity should be given to any other person within a business organisation to amend or modify any standard agreements or documents without the express authorisation of the IP Manager or other department e.g. the legal department. Elements of this include:

9.2.3.1. Protecting contracts

The locking of all standard agreements, either to the level at which comments can be inserted, alternatively to the level at which documents can only be read or printed. If this system is implemented, it may be necessary to have a standard protocol with regard to passwords for the agreements or documents. The difficulty with this is that passwords may be compromised. An alternative approach is to convert documents into Adobe PDF files, which renders largely incapable of amendment and removes the issue of passwords.

9.2.3.2. Amendments

Amendments must be recorded in a schedule - in order to assist a business in the management of its Standard IP Agreements, a system should be implemented

whereby all amendments negotiated with a third party will be placed in a separate schedule and signed off with the agreement. The advantage of this approach is that one does not have to read every agreement to determine the changes that have been made, rather the reviewer of the agreement can accept that the standard agreement / document has been used with all amendments reflected in one schedule. This approach has been adopted by many of the major corporations both locally and internationally.

9.2.3.3. Version control

Version Control is not only unavoidable, but it is indeed desirable that a business Standard Agreements change and evolve to reflect the operational and organisation changes within a business structure. In respect of updating standard agreements, the following procedure is recommended:

- There should be a standard agreement policy manual containing the latest version / release of each Standard IP Agreement; and
- When changes are made to a Standard Agreement that are of a general nature, the agreement will be updated and a new release issued. With each new release detailed guidelines will be issued describing the nature of the change and the reason therefore. Changes may be made to documents where clients consistently query a particular provision and a management decision to be taken to remove it from the Standard Agreement or where additional areas of risk are identified and a recommendation is made to cater for such risk in the Standard IP Agreement.

9.2.3.4. Agreement policy manual

It is recommended that a Comprehensive Agreement Policy Manual be maintained in order to ensure a consistent approach to contracting. In addition to facilitating the version and release control outlined above, the Agreement Policy should also provide some basic and detailed instruction regarding to risk aspects addressed in specific agreements. The standard approach to issues such as Intellectual Property, limitation of liability and the like will have to be developed and implemented, but it may also be desirable that the Agreement Policy Manual contains guidelines in respect to alternative clauses which may be requested by third parties (which are not contained in the Standard Agreement) and which are acceptable in principle to a business.

9.2.4. Management of agreements / documentation provided to third parties

The process of Standard Agreements and documentation which is released to third parties should be carefully monitored, particularly in order to ensure that management and legal input is obtained at the appropriate junctures. It is particularly important that documentation pertaining to new inventions or which embody Intellectual Property rights be carefully vetted by a business's IP Manager prior to such documents being released to any third party.

9.2.5. Management of completed agreements

All signed agreements should be held at a central repository and a copy of the signed agreements should be stored at a secure off-site location. If possible, a business should hold duplicate originals of all signed agreements. Each agreement (or possibly set of agreements for a project or customer) should be assigned a unique contract / agreement number in order to facilitate indexing and cross-referencing. A contract management tool may prove extremely useful as it provides the accessibility, archiving and retrieval of agreements.

Part of the function of a central point / repository should be to diarise and monitor key contractual milestones and dates. For example, termination clauses often require written notice of a certain number of months prior to the end of a contract term. This would be of particular importance during or pertaining to contracts that deal with the licensing of Intellectual Property. Where contracts provide for an option to be exercised or notice to be given, it is essential that these dates be monitored and adhered to. The renewal of trade marks and patents can also be accommodated in a contract management tool.

9.3. IMPLEMENTING A CONTRACT MANAGEMENT POLICY

A contract management policy requires rigorous attention to detail, a dedication to the implementation and enforcement of the required process and the ongoing recordal and capturing of organisational experience and knowledge in documentary form.

In order to implement such policy, a business needs to ensure that the following steps are taken:

- Determine the nature of the agreement which is to be entered into;

- Determine the current transaction authorisation process and determine key areas where legal input is justified and necessary;
- Implement an agreement indexing system; and
- Compile and implement an agreement policy manual.

9.4. RESEARCH MANAGEMENT / AGREEMENTS

9.4.1. Legally binding agreements

In principle, an agreement must be legal to constitute a contract. Generally, therefore, an illegal agreement will not create obligations. In order to ensure that agreements are legally binding and enforceable, it is important for a business to have regard of the following:

9.4.1.1. Trade marks

For an assignment of a trade mark to be valid, such assignment has to be in writing and assigned by both parties, state whether the assignment is with or without goodwill and even though the agreement becomes legally binding between the parties to the assignment, such assignment will only be binding on third parties once the assignment has been registered with the Registrar of Trade Marks.

9.4.1.2. Copyright

For an assignment of a copyright to be valid, such assignment has to be in writing and assigned by both parties, state whether the assignment is with or without goodwill and even though the agreement becomes legally binding between the parties to the assignment, such assignment will only be binding on third parties once the assignment has been registered with the Registrar of Copyrights.

9.4.1.3. Patents

For an assignment of a patent to be valid, such assignment has to be in writing and assigned by both parties, state whether the assignment is with or without goodwill and even though the agreement becomes legally binding between the parties to the assignment, such assignment will only be binding on third parties once the assignment has been registered with the Registrar of Patents.

9.4.1.4. Designs

For an assignment of a design to be valid, such assignment has to be in writing and assigned by both parties, state whether the assignment is with or without goodwill and even though the agreement becomes legally binding between the parties to the assignment, such assignment will only be binding on third parties once the assignment has been registered with the Registrar of Designs.

9.4.2. Care when entering into agreement with an individual such as an Inventor

In terms of the Patents Act, tests should be taken when entering into Licence Agreements with inventors as the Act contains various default provisions pertaining to the licensing of Patents. (Sections 57 and 58)

9.4.3. Need for caution when signing any agreement

When signing agreements there are two primary principles which should be considered. Firstly, the person signing the agreement must ensure that he/she clearly understands the Agreement and that the Agreement accurately reflects the intention of the parties, and secondly, that the person signing the agreement has the necessary authority to do so.

9.4.4. Entering into other agreements concerning IP

The business should take particular caution when employing individuals who will during the course and scope of their employment create Intellectual Property. The conditions of employment pertaining to such individuals should be carefully vetted to ensure that all Intellectual Property created within the course and scope with such individual's employment be transferred to the business and that all Intellectual Property created by the individual even after the employment relationship has been terminated, but which emanates from the scope of the individual's employment with the business, also be transferred to the business. (Section 59 of Patents Act).

10. DISCLAIMER

This IP manual strives to provide a cursory overview of some of the most important IP issues that one can expect to encounter in the course of the business of a business. However, it should be reiterated that the information contained herein should not be seen as legal advice, and that this manual should thus never be used in the alternative to procuring professional legal advice. A business is therefore encouraged to contact the authors of this manual, DM KISCH INC, should any of the issues touched on in this manual arise in practice.

