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Patents, Utility Models and Registered Designs

Protection in Countries other than The Republic of South Africa

Protection for new technology can be obtained in other countries by means of a patent, utility model and/or a registered design. A patent provides protection for an invention, a registered design provides protection for the appearance of an article, and a utility model provides protection that is somewhere between that of a patent and a registered design. This pamphlet deals primarily with patents; however, sections 2 and 3 deal briefly with utility models and designs respectively.

1. Patents

1.1 Patent protection is obtained in most countries by the filing of a patent application accompanied by a complete specification. In some countries it is possible first to file a provisional specification and in other countries it is possible to extend a patent granted in another country to that country.

1.2 As with South Africa, all other countries require that an invention must be "new" and "inventive" in order to be patentable. Each country has its own definitions and standards in regard to these requirements, some more strict and others less so than South Africa. The requirement of novelty is of prime importance as one's own actions in disclosing and/or using the invention could have the result that a valid patent application can no longer be filed in a particular country.

1.3 Paris Convention

1.3.1 In order to assist inventors, a number of countries, including South Africa, have entered into an agreement, the Paris Convention for the Protection of Industrial Property, whereby nationals of such countries can obtain the benefits of a so-called Convention priority right. In terms of the Convention, nationals of member countries may file a first patent application in any one country and are then entitled to file further patent applications in the other countries, even if the invention has been disclosed and/or used after the filing of the first patent application, if the invention has been adequately described in the first application and if corresponding foreign applications are filed **within a year** of the first filed application. These patent applications are referred to as "Convention patent applications" and the countries, known as the "Convention" countries, are marked in the list at the end of the pamphlet in the column under the heading "Paris".

An applicant is entitled to the benefit provided by the Convention if a first filed or basic patent application in South Africa was accompanied by a provisional specification or a complete specification in the first instance.

1.3.2 The benefit provided by the Convention is termed a “priority right”. Thus, if further corresponding foreign applications are filed within a year of the basic application one can "claim priority". Any such application will have, as its effective date, the date of filing of the basic patent application and not, as would normally be the case, the actual date of filing of the foreign application. The date of filing of the basic application is termed the "priority date". Accordingly, the novelty requirements of the country in question would only need to be satisfied as at the priority date and not as at the date on which the foreign application is actually filed, thereby excusing any disclosure and/or use of the invention by the applicant or anybody else subsequent to the priority date. Further, if someone else files a competing patent application for the same invention, the person having the earlier priority date will normally be granted the patent (presuming a patent is granted).

1.3.3 A Convention patent application must be accompanied by a complete specification.

1.3.4 As will be noted from the list of countries at the end of the pamphlet, not all countries are members of the Convention. A notable exception isTaiwan. Thus, in general, if valid patent protection is desired in non-convention countries, the novelty requirements of the country in question must be satisfied as at the date of filing of the patent application in that country. However, the TRIPS agreement, which is binding on member countries of the World Trade Organization (WTO), obliges member countries of WTO, such as Taiwan, to extend existing privileges given to any other WTO country, such as the right to claim priority, to applicants from other WTO countries.

This effectively allows a South African applicant to treat these countries as Paris Convention countries under circumstances where the WTO country of interest provides the right to claim priority to any other WTO country. There are however grace periods, in some cases extending up to 2016, which are applicable before the obligations under the TRIPS agreement have to be implemented. Before attempting to file a "Convention application" on the strength of WTO membership only, it would be advisable to ascertain if such an application can validly be filed. The WTO member countries are indicated in the list at the end of the pamphlet.

1.3.5 Although it is preferable to file corresponding patent applications in the Convention countries within a year of the basic patent application (in order to obtain the priority right) patent applications may be filed in these countries after expiry of the convention year, if the novelty requirements of the country in question are still satisfied as at the actual date of filing in the country in question. Patent applications in countries that are not members of the Convention, and patent applications that are filed more than a year after the basic application in a country that is a member of the Convention, are termed "non-Convention" patent applications.

1.3.6 As the novelty requirements vary from country to country, it is not possible to list them all in this pamphlet. The novelty requirements of any country of interest will be supplied on request. However, it should be noted that in most countries it is not possible to obtain valid patent protection after the Convention year has expired, if the invention has been made known, if it has been described in a printed publication or if a patent has been granted anywhere. Thus, once a basic complete specification has been filed in South Africa, or elsewhere, if other patent applications are contemplated, but it is not possible to file such applications as Convention applications, then we should be instructed to delay acceptance of the basic complete specification thereby to delay grant. If this is not done, then the basic complete specification may be accepted some months after it has been filed, the acceptance published in the Patent Journal and a patent granted. After publication or grant it will not be possible to file any valid corresponding patent applications in most of the important overseas countries. It must also be noted that in many countries a complete specification is laid open to public inspection 18 months after the **priority date**, i.e. typically after about 6 months after the complete specification is filed. This laying open also can prevent the subsequent filing of non-convention applications.

1.4 Examination and prosecution

1.4.1 In South Africa the patent office considers patent applications that have been filed only to ascertain if the required formalities are satisfied. This is also the case in some other countries such as Zimbabwe, Malawi, Namibia and the other surrounding states. However, in most of the important overseas countries, patent applications are examined on the merits, and patent office examiners conduct a search to ascertain what relevant prior art there is and they then compare the claims of the application (in which the scope of protection that one desires is defined) with the prior art. If the particular examiner is of the opinion that any claim is too broad in the light of the prior art he rejects that claim. In some countries examiners may only reject a claim because the invention defined therein is not new, and in other countries (such as the USA, Australia, China, most European countries, Japan and Taiwan) examiners may also reject a claim because the invention described therein is obvious in the light of prior art that the examiner has cited against the application.

1.4.2 Prior art cited against an application in one country is usually also relevant in all the other countries in which corresponding patent applications have been filed. If a patent application is filed in the USA there is a continuing obligation on the applicant to advise the US patent office of all relevant prior art of which the applicant is aware. The same, or a similar, obligation also applies in certain other countries, such as Israel. Thus, if an extremely relevant item of prior art (such as a prior patent) is found in any other country, which totally invalidates the application in that country, one must advise the US patent office. If this particular item of prior art (or some equally damaging prior art) is not found by the examiner in any other country in which patent applications have been filed, patents may be granted in such other countries. However these patents will most probably be invalid and they could subsequently be attacked by anybody. Such an attacker could conduct searches to investigate any further relevant prior art other than that cited against the patent in issue, and if the party attacking the patent finds the extremely relevant item of prior art referred to above, it would be used to attack the patent.

1.4.3 If, after examining the application, the examiner rejects any of the claims, the applicant must amend or delete those claims that have been rejected and/or he must submit arguments to the examiner in an attempt to persuade the examiner that his objections are unfounded. If and when an applicant is able to satisfy the examiner that all the claims are acceptable and all the examiner's objections have been responded to, then the application will be allowed.

1.4.4 In some countries, such as Germany, once the application has been allowed, a notice is published in a patent journal or gazette to advise the public thereof and the application then enters an opposition stage in which any interested party may oppose the application. If nobody opposes the application, or if any opposition is successfully defended, then the patent is granted. If an application is opposed it may take several years before the matter is decided.

1.4.5 In other countries, once an application has been allowed, the patent is granted without any opposition stage. However, in some of these countries, such as the USA, it is necessary to pay an official sealing fee to obtain grant of the patent.

1.4.6 In some countries, such as the USA, examination occurs automatically six months to two years after the application has been filed. In other countries, it is necessary to request examination with the payment of an official fee which can be substantial (in the order of R5000 to R10000). In those countries where examination must be requested, it is sometimes possible to defer examination for several years. For example, in Germany it is possible to defer examination for up

to seven years, in Canada for up to five years, and in Japan for up to three years.

1.5 Regional patent applications

1.5.1 Normally, if patent protection is required in a particular country, a patent application must be filed in that country and prosecuted in that country. In order to assist inventors a number of countries have come to regional arrangements and have established regional patent offices where a single application may be filed designating a number of countries. There are five such regional arrangements that should be noted:

- The European Patent Convention
- The Eurasian Patent Convention
- The African Regional Industrial Property Organisation (ARIPO)
- The African Organisation for Intellectual Property (OAPI)
- The Cooperation Council of the Gulf Arab States (GCC).

1.5.2 European Patent Convention

The European Patent Office (EPO) has a main office in Munich, with sub-offices in various contracting states. The official languages of the EPO are English, French and German. A European patent confers on its proprietor, in each contracting state for which it is granted, the same rights as would be conferred by a national patent granted in that country. The enforcement of a European patent must, however, take place in the country concerned according to the national law of that country.

1.5.2.1 European patent countries

At present, Albania, Austria, Belgium, Bulgaria, Croatia, Cyprus, Czech Republic, Denmark, Estonia, Finland, France, Germany, Greece (Hellenic Republic), Hungary, Iceland, Ireland, Italy, Latvia, Liechtenstein, Lithuania, Luxembourg, Former Yugoslav Republic of Macedonia, Malta, Monaco, Netherlands, Norway, Poland, Portugal, Romania, San Marino, Serbia, Spain, Sweden, Slovenia, Slovakia, Switzerland, Turkey and the United Kingdom are contracting countries. It is possible that other countries will also become contracting countries in the future. So-called extension agreements have also been established between the European Community and certain countries, whereby these countries can also be designated in an EPO application. At present extension agreements exist with the following countries: Montenegro and Bosnia and Herzegovina.

1.5.2.2 General procedure

A European (EPO) patent application, like a national patent application, can be filed as a "convention" application as discussed in paragraph 1.3 above. A European patent application follows the general procedure of filing, examining for form, examining for substance, official action, amendment, allowance, advertisement and grant. However, instead of this procedure taking place individually and separately in each of the contracting countries, with translations at various stages, this procedure now takes place once only (normally for us in South Africa in English).

1.5.2.3 European patent application

At the time of filing of a European application, the applicant must designate those contracting states in which he ultimately requires patent protection (at least one country must be designated). Further designations may be added within a limited time period, with the payment of additional fees. If however designation fees for seven countries have been paid, all contracting countries are designated. Countries which have been designated may be withdrawn. Once the prosecution of the application has been completed, national patents are granted by or on behalf of each of the contracting countries which were designated.

1.5.2.4 Initial processing

All European applications are forwarded to an appropriate search division, where a search is made for relevant prior art. When the search is completed, a search report is issued in which prior art that has been found is listed. At this time, an applicant may file an amendment if required. Thereafter no voluntary amendment is permitted. Eighteen months from the filing date or from the earliest priority date, the application as originally filed is published, together with the search report and any amendments which may have been made.

1.5.2.5 Substantive processing

The applicant must request substantive examination within six months of publication of the search report. If substantive examination is requested the application is subjected to a technical, substantive examination by an official Examiner. The Examiner then issues a report listing any objections which he may have. If there are any objections a response must be filed within a period of 4 months in reply to the Examiner's objections, if the applicant wishes to proceed with the application. At this stage, amendments can also be made to the specification and claims. If the Examiner's objections can be overcome then the application is allowed on payment of a grant and publication fee and lodgement of French and German translations of the claims within a set deadline. The specification and claims must then be translated into the national languages of those designated countries in which the applicant still wishes to obtain patent protection, and individual agents appointed for the conversion of the EPO application into national patents in those designated states. Once the EPO application has been allowed there is a nine month period in which the matter can be opposed by any interested party.

1.5.2.6 Advantages and disadvantages of a European patent application

(a) A disadvantage of lodging a European patent application is that if the application is rejected by the EPO then the applicant does not obtain a patent in any one of the

designated countries. Thus, by following the EPO route an applicant may lose all right to a patent whereas, if individual patent applications are filed in the various European countries, i.e. via the national route, patents may possibly be obtained in at least some of the countries, such as the Netherlands and Italy which usually do not examine for novelty and inventiveness.

(b) If a European patent application is opposed there could be significant delay in obtaining patents in the designated countries. However, as several of the contracting counties do not provide for opposition procedure, if the national route is followed and the Examiners in the countries concerned allow the application in those countries, then patents will be granted there.

(c) The EPO route has the advantage that translation charges, where necessary, are deferred until prosecution has been completed. If prosecution is successful, patents will, however, still be granted individually for the various designated countries and will have to be maintained separately by the payment of annual renewal fees. Translation costs, where required, may be high, being in the region of R12000 to R18000 (or more) per country for a specification of normal length. In some countries, it is however necessary to translate the claims only, which reduces validation costs in such countries. The costs of requesting examination are also high, i.e. about R20000.

(d) A European patent application requires only one prosecution procedure and amendment. This can all be done in English. Translations are done after prosecution has been completed. There can therefore be a considerable saving in filing and post-filing prosecution charges when the EPO route is followed instead of the national route. Where a national route is followed, all amendments have to be made in the language of the country. Such amendments and arguments in support will have to be translated into the language in question. Such multiple prosecutions in foreign languages will be more costly than a single prosecution in English.

1.5.3 ARIPO (African Regional Industrial Property Organisation)

ARIPO like the EPO, is a regional patent application prosecution organisation. ARIPO provides the opportunity to obtain protection by means of a single filing of a patent or industrial design application, in some or all of the English-speaking African countries which are party to ARIPO. An ARIPO application can be filed as a "Convention" application. ARIPO is empowered to grant patents and to register industrial designs. After grant, the contracting states have six months within which to inform ARIPO that a patent in a particular country will not be granted. Currently there are eighteen contracting States which are party to the ARIPO Protocol:

Botswana	Rwanda
Gambia	Sierra Leone
Ghana	Somalia*
Kenya	Sudan
Lesotho	Swaziland
Liberia	Tanzania
Malawi	Uganda
Mozambique	Zambia
Namibia	Zimbabwe

* Somalia has acceded to the Lusaka Agreement establishing ARIPO, but has not yet ratified the Harare Protocol on Patents and Industrial Designs.

ARIPO has its headquarters in Harare, Zimbabwe. Further information will be given on request.

1.5.4 OAPI (Organisation Africaine de la Propriété Intellectuelle)

The OAPI office is at Yaounde. A single registration at OAPI protects the invention in all member states:

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

An OAPI application can be filed as a "Convention" application. Patents are granted for a term of twenty years. Further information will be given on request.

1.5.5 Eurasian Patent Convention

The Eurasian Patent Convention was established in 1994 between the following countries of the former Soviet Union: Russia, Armenia, Azerbaijan, Belarus, Kazakhstan, Kyrgyzstan, Moldova, Tadjikistan and Turkmenistan. Moldova is no longer a party to the Convention as of 26 April 2012. A Eurasian patent application can be filed at the Eurasian Patent Office in Moscow as a "convention" application (as set out in paragraph 1.3 above) and the specification must be in the Russian language. A Eurasian patent, which automatically applies in all member countries, remains in force for 20 years, subject to the payment of annual renewal fees.

1.5.6 GCC (Cooperation Council of the Gulf Arab States)

The Cooperation Council of the Gulf Arab States approved the GCC Patent Law in 1992 and the implementing regulations were published some time later. The following countries are members of the GCC: Bahrain, Kuwait, Oman, Qatar, Saudi Arabia and United Arab Emirates.

A GCC application can be filed as a "Convention" application. However, a GCC application, claiming convention priority in terms of the Paris Convention, is mutually exclusive with a corresponding domestic application in any GCC member country. The specification and claims must be in English and Arabic. The patent term is 15 years from the date of grant.

1.5.7 PCT (Patent Cooperation Treaty)

The Patent Cooperation Treaty is an international agreement, administered by the World Intellectual Property Organisation (WIPO). In terms of PCT, a national of any member country can file a single PCT application designating all member countries as designated countries in which patent protection is to be obtained. A PCT application can be filed as a "Convention" application. This procedure entails a number of advantages (including cost advantages) where a national of a PCT member country wishes to file multiple corresponding patent applications in other PCT member countries.

There are already more than 140 PCT member countries; these countries are indicated in the list at the end of the pamphlet.

South Africa's accession to the Patent Cooperation Treaty (PCT) became effective on 16 March 1999, when South Africa became the 100th member of the PCT. As from 16 March 1999, South African nationals or residents are able to use the PCT filing procedure in international applications (which may be filed in South Africa or e.g. at the International Bureau in Switzerland). From the same date, nationals or residents of other PCT member countries are able to designate or elect South Africa in PCT international applications filed in other member countries. Further information will be given on request.

1.6 Cost of filing and prosecuting foreign patent applications

Charges in other countries and exchange rates are continually changing and the following estimates are given as a rough guide only, as a basis for budgeting. These charges are irrecoverable if a patent application is abandoned at any stage after filing.

1.6.1 Initial filing charges

The filing of a patent application in Namibia costs about R9000 to R11000. If applications are filed in Zimbabwe, Zambia or Malawi, the cost is about R22000 to R28000 each.
In overseas countries, the filing costs are substantially more, in particular in those countries where the specification must be in a language other than English, and translation is necessary. For an invention of average complexity, patent applications in English-speaking countries cost about R15000 to R35000 and in non-English-speaking countries R30000 to R45000. Where specifications are long or complex and if there are a large number of claims, there could be substantial additional charges. If a list of specific countries is furnished, a more accurate estimate of charges can be given.

The cost of an application at the EPO designating all countries can be about R70000 to R85000 (or more). Thus, an applicant will save initially by filing an EPO application, if patent protection is required in three or more countries. Similar costs can be expected for an OAPI application, with an ARIPO application being slightly less.

The above costs do not include the cost of preparing a basic complete specification which is normally included in the cost of preparing and filing of the complete specification in South Africa.

1.6.2 Additional prosecution charges

In addition to the initial filing charges, further charges will become payable in most overseas countries. Thus, in those countries where a search and/or examination must be requested, there will be a charge therefor. For example the cost of requesting examination at the EPO is presently in the region of R20000. Once an application is examined and an official letter is issued by the patent office in question, costs are incurred in considering it, obtaining copies of cited prior art and reporting. In most cases that are proceeded with, it is necessary to amend the specification and claims and/or prepare and submit arguments to overcome objections raised by the examiner. The cost of preparing such amendment and arguments will depend on the nature of the examiner's objections. Further, once the application is allowed, a sealing fee is payable in many countries. Some countries also require maintenance fees to be paid. We cannot give an accurate indication of the prosecution charges that will arise in any particular country. However, experience has indicated that the average prosecution charges per country are at least R10000-R15000 and often substantially more. One must bear in mind that it can take several years before a patent is granted and accordingly the prosecution charges referred to above are spread over a number of years.

1.6.3 Maintenance fees

As discussed earlier, in some countries maintenance fees must be paid, usually annually, and these may be substantial.

1.7 Microbiological processes or products

The respective patents laws of, inter alia, the EPO, USA, Japan and Australia include special provision in respect of applications which claim as an invention a microbiological process or a product thereof. A common provision requires that, if no samples of the micro-organism in question are available to the public, a culture of the micro-organism must be deposited at a recognised culture collection, and the name of the culture collection, the date of deposit, and the official deposit number must appear in the complete specification. Certain countries may require that the deposit of the culture be made prior to the filing dates of the respective patent applications in those countries. Most of the important countries are signatories to the Budapest treaty, and accordingly recognise the culture collections listed therein. The fee levied by the institutions responsible for the culture collections vary, but generally are in the region of R500-R1000 (or even more) per deposit.

1.8 Confirmation and revalidation patents

In some countries, notably in South America, it is possible to obtain a confirmation patent after a patent for the invention has been granted in some other country, even though the invention has been patented and (in certain cases) used elsewhere than in the country in which the confirmation patent is desired. Similarly in some of the dependencies, or erstwhile dependencies, of Britain, such as Swaziland and Hong Kong, a British patent automatically extends to the territory or may be extended there by registration. A South African patent may also be registered in Swaziland.

1.9 Important points to bear in mind

Prior to embarking upon a foreign patenting programme attention should be given to at least the points dealt with in the following paragraphs.

1.9.1 Agreement with inventor - assignee applicant

Before foreign patent applications are filed, it is imperative to have an agreement between all the parties concerned (i.e. the inventor, the South African applicant, and the foreign applicant) clearly defining their rights in and to the invention, both for the Republic of South Africa and for foreign countries. The agreement should define their reciprocal rights and obligations as to maintenance, prosecution, etc., of the applications. Additionally, foreign Patent Offices frequently require proof of the existence of such an agreement in order to establish the foreign applicant's rights to file foreign patent applications. This is of particular importance in case the inventor is not available or is unwilling to sign the necessary documents. If required we can assist in preparing such an agreement.

1.9.2 Novelty searches

1.9.2.1 Bearing in mind the heavy costs of filing patent applications in other countries (see paragraph 1.6) it is advisable, if not essential, to have novelty searches conducted. They may be conducted locally and/or abroad to test the degree of novelty of the invention. The prospects of obtaining a valid Patent for the invention in other countries can be assessed from such searches. The searches should preferably be done before the basic (South African) complete specification is prepared and before foreign applications are filed. If a PCT application is filed, consideration can be given to dispensing with a novelty search since an International Search is conducted as part of the PCT prosecution.

1.9.2.2 Novelty searches also have the advantage that they can give an indication of the strength of the patent which may be granted on the South African patent application. They will also enable the draftsman of the complete patent specification to know, in the light of prior patents revealed by the searches, how widely claims may be framed for the invention.

1.9.2.3 It is difficult to provide an accurate estimate of the costs associated with novelty searches, considering that these costs are greatly affected by the nature and complexity of the invention, the number of subject matter classes in which the invention can be classified (if class-based searching is to be conducted), as well as the size of these subject matter classes.

1.9.2.4 A cursory and fairly adequate novelty search for an invention of average complexity can be conducted in-house through an online database including records of the US and European patent offices, as well as through the records of the World Intellectual Property Organisation (WIPO) for between about ZAR 5000 and about ZAR15000.

1.9.2.5 More detailed classification-based searches can be conducted

- in South Africa, at the South African Patent Office, through available South African patent specifications, for about R5000 to about R30000 (or more, depending on the complexity of the invention and the size(s) of the subject matter class(es) in which the search(es) is (are) to be conducted),
- severally through patent specifications available in online databases in a number of foreign jurisdictions including Europe (including the European Patent Office, the UK Patent Office and the patent offices of a number of continental countries), the US, and Asia (including China, Japan, South Korea and a number of others), for about R8500 to about R12000 per jurisdiction (outsourced),
- in two of the abovementioned jurisdictions (excluding South Africa), for about R12000 to about R15000 (outsourced),
- in all of the abovementioned jurisdictions (including South Africa and also including Australia, Canada, New Zealand, Russia), for about R15000 to about R20000 (outsourced).

Please note that the abovementioned estimates are provided only as a rough guide. As has been mentioned, the actual costs of searches can vary widely, depending upon the subject matter, the extent and complexity of the field in which the invention falls, and in which countries the searches are to be made. Please also take note that significantly higher costs may be involved if detailed novelty opinions are required on the basis of the results of a novelty search.

1.9.2.6 A favourable search result cannot be regarded as a conclusive indication of the novelty of an invention because no guarantee can be given that in a search all relevant disclosures have been located. If a search is to be made then we must be instructed well before the due date for filing applications because the searches can be completed only in about four to eight weeks.

1.9.3 Patentability and commercial value of an invention

An invention may be patentable but may have only little commercial value, or it may have substantial commercial value but may be of doubtful patentability. Again the commercial value of an invention may be substantial in one country and less in another, depending upon the facilities available to the patentee for exploiting it in that country. Bearing in mind that a patent is a monopoly right and has value only when it is desired to prevent competition in the country concerned, there is no

advantage in filing applications for patents in countries where the monopoly right is not really required. There can be limited merit in having a large number of patents in foreign countries if the invention is not going to be exploited.

1.9.4 Subject matter and patentability in different countries

Some inventions may be accepted by examiners of some Patent Offices as having sufficient subject matter to be patentable but not by those of other Patent Offices, because patent laws and their interpretation differ from country to country.

1.9.5 Renewal fees

In arriving at a decision on a patenting programme it must be borne in mind that, with the exception of a few countries, annual renewal fees are payable in order to maintain the Patent in force when granted. In some countries the annual fees are relatively small (about R700) but in other countries renewal fees increase annually to a very substantial figure. For example the cost of maintaining a patent in force in Germany or the UK throughout the term of the patent can exceed R160000 and R85000 respectively. In Sweden and in Brazil, the total renewal fees per patent are in the region of R20000 and R15000 respectively. The total renewal fees to keep patents in the ARIPO countries in force for their full term exceed R40000. More detailed information in this regard is available on request.

1.9.6 Working of inventions

In some countries inventions have to be "worked" if claims for compulsory licences are not to be risked or if the existence of the patents themselves is not to be endangered. Different countries have different requirements. Generally "working" requirements are met if inventions are being actively exploited by manufacture in the country concerned. This usually requires the grant of licences.

1.9.7 Instructions to be given timeously

1.9.7.1 Patenting programme

Much work is involved in the preparation of documents for filing foreign patent applications. For instance, the application in some countries requires a lengthy legalisation procedure. Accordingly, we must be advised of the extent of the patenting programme as soon as possible.

1.9.7.2 Technical information

Depending on the complexity of the invention we must receive full details of the invention about three months before the due date, to ensure the timeous despatch of the documents, and their translation where necessary.

1.9.7.3 Time Limits

If instructions for filing applications abroad have been left too late, then it may be possible in certain circumstances to obtain extra time by post-dating the basic application in South Africa. Owing to circumstances beyond our control, e.g. postal delays and strikes, we can never guarantee that foreign applications will be filed under the Convention. Such post-dating involves a risk that the post-dated application may not be recognised by some countries for Convention priority purposes. It is a procedure which should not be resorted to except under exceptional circumstances. Further information will be given on request.

1.9.8 When charges are payable

The filing of patent applications abroad requires heavy disbursements by us, and we must be placed in funds before we despatch the application documents for filing abroad, i.e. at least six weeks before the due date, because once we have instructed our correspondents, we have to pay their charges. During prosecution of the application, further heavy disbursements can be made and we require that funds be made available to us from time to time.

1.9.9 Amendment of South African patent application

If as a result of an examination, it is necessary to amend the claims of corresponding applications, it may be advisable, and in some circumstances even imperative, to amend the South African case correspondingly. If the claims are too wide in scope, then the patent is invalid. No steps should therefore be taken to enforce the RSA patent before the claims (and specification, if necessary) have been amended. Depending upon circumstances, we recommend that such amendment of the RSA case be carried out as soon possible after prior art, necessitating amendment, comes to the attention of the South African applicant or patentee.

2. Utility models

2.1 In some countries, notably in Australia, Brazil, Germany, Italy and Japan, it is possible to obtain protection by way of a utility model (also known as a petty patent) for an article which does not have sufficient technical merit to support a patent. Such an article may have a particular shape for functional purposes. Processes cannot be protected by utility models. A utility model may be obtained by way of a Convention application based upon a basic application in a Convention country, as for any patent application, or can be obtained upon a non-convention application.

2.2 If an application for a full patent is rejected, then it may, in some countries such as Argentina, France, Germany, Japan, Spain and Taiwan, be converted into an application for a utility model. A utility model application is not subjected to as rigorous an examination into novelty as an application for a patent, but in most countries, the term of a utility model is less than that of a full patent.

3. Designs

3.1 As indicated earlier, a registered design protects aesthetic features of shape and appearance of an article and, in most countries, a registered design does not provide protection for functional features (South Africa being one exception).

3.2 Further, as with patents, the protection afforded by a registered design is territorially limited, i.e. if protection is required in any particular country, then an application must be filed in that country. There are only a few regional arrangements for registered designs, i.e. ARIPO, Benelux and the Registered Community Design.

3.3 The Paris Convention is also applicable to designs, but contains specific provisions for designs. Corresponding foreign design applications have to be filed within **six months** of the first-filed design application to be able to claim convention priority.

3.4 In most of the important countries, design applications are also examined and our comments earlier in this regard with respect to patents are applicable. In some countries there are also maintenance fees.

4. General

If difficulties are experienced in any country in exploiting an invention, our expertise and facilities may be of assistance. Further information and assistance will be provided on request.

States Party to the PCT and the Paris Convention and Members of the World Trade Organization[1]

(status on 27 February 2017)

State/Member	PCT (151)	Paris (177)	WTO[2] (164)	State/Member	PCT	Paris	WTO
Afghanistan (AF)	-	X[3]	X	Ghana (GH) **(AP)**	X	X	X
Albania (AL) **(EP)**	X	X	X	Greece (GR) **(EP)**	X	X	X
Algeria (DZ)	X	X	-	Grenada (GD)	X	X	X
Andorra (AD)	-	X	-	Guatemala (GT)	X	X	X
Angola (AO)	X	X	X	Guinea (GN) **(OA)**	X	X	X
Antigua and Barbuda (AG)	X	X	X	Guinea-Bissau (GW) **(OA)**	X	X	X
Argentina (AR)	-	X	X	Guyana (GY)	-	X	X
Armenia (AM) **(EA)**	X	X	X	Haiti (HT)	-	X	X
Australia (AU)	X	X	X	Holy See (VA)	-	X	-
Austria (AT) **(EP)**	X	X	X	Honduras (HN)	X	X	X
Azerbaijan (AZ) **(EA)**	X	X	-	Hong Kong (HK)	-[4]	-[4]	X
Bahamas (BS)	-	X	-	Hungary (HU) **(EP)**	X	X	X
Bahrain (BH)	X	X	X	Iceland (IS) **(EP)**	X	X	X
Bangladesh (BD)	-	X	X	India (IN)	X	X	X
Barbados (BB)	X	X	X	Indonesia (ID)	X	X	X
Belarus (BY) **(EA)**	X	X	-	Iran (Islamic Republic of) (IR)	X	X	-
Belgium (BE) **(EP)**	X	X	X	Iraq (IQ)	-	X	-
Belize (BZ)	X	X	X	Ireland (IE) **(EP)**	X	X	X
Benin (BJ) **(OA)**	X	X	X	Israel (IL)	X	X	X
Bhutan (BT)	-	X	-	Italy (IT) **(EP)**	X	X	X
Bolivia (Plurinational State of) (BO)	-	X	X	Jamaica (JM)	-	X	X
Bosnia and Herzegovina (BA)	X	X	-	Japan (JP)	X	X	X
Botswana (BW) (**AP)**	X	X	X	Jordan (JO)	-	X	X
Brazil (BR)	X	X	X	Kazakhstan (KZ) **(EA)**	X	X	X
Brunei Darussalam (BN)	X	X	X	Kenya (KE) **(AP)**	X	X	X
Bulgaria (BG) **(EP)**	X	X	X	Kuwait (KW)	X	X	X
Burkina Faso (BF) **(OA)**	X	X	X	Kyrgyzstan (KG) **(EA)**	X	X	X
Burundi (BI)	-	X	X	Lao People's Democratic Republic (LA)	X	X	X
Cabo Verde (CV)	-	-	X	Latvia (LV) **(EP)**	X	X	X
Cambodia (KH)	X	X	X	Lebanon (LB)	-	X	-
Cameroon (CM) **(OA)**	X	X	X	Lesotho (LS) **(AP)**	X	X	X
Canada (CA)	X	X	X	Liberia (LR) **(AP)**	X	X	X
Central African Republic (CF) **(OA)**	X	X	X	Libya (LY)	X	X	-
Chad (TD) **(OA)**	X	X	X	Liechtenstein (LI) **(EP)**	X	X	X
Chile (CL)	X	X	X	Lithuania (LT) **(EP)**	X	X	X
China (CN)	X[4]	X[4,5]	X	Luxembourg (LU) **(EP)**	X	X	X
Colombia (CO)	X	X	X	Macao, China (MO)	-	-[5]	X
Comoros (KM)	X	X	-	Madagascar (MG)	X	X	X
Congo (CG) **(OA)**	X	X	X	Malawi (MW) **(AP)**	X	X	X
Costa Rica (CR)	X	X	X	Malaysia (MY)	X	X	X
Côte d'Ivoire (CI) **(OA)**	X	X	X	Maldives (MV)	-	-	X
Croatia (HR) **(EP)**	X	X	X	Mali (ML) **(OA)**	X	X	X
Cuba (CU)	X	X	X	Malta (MT) **(EP)**	X	X	X
Cyprus (CY) **(EP)**	X	X	X	Mauritania (MR) **(OA)**	X	X	X
Czech Republic (CZ) **(EP)**	X	X	X	Mauritius (MU)	-	X	X
Democratic People's Republic of Korea (KP)	X	X	-	Mexico (MX)	X	X	X
Democratic Republic of the Congo (CD)	-	X	X	Monaco (MC) **(EP)**	X	X	-
Denmark (DK) **(EP)**	X	X	X	Mongolia (MN)	X	X	X
Djibouti (DJ)	X	X	X	Montenegro (ME)	X	X	X
Dominica (DM)	X	X	X	Morocco (MA)	X	X	X
Dominican Republic (DO)	X	X	X	Mozambique (MZ) **(AP)**	X	X	X
Ecuador (EC)	X	X	X	Myanmar (MM)	-	-	X
Egypt (EG)	X	X	X	Namibia (NA) **(AP)**	X	X	X
El Salvador (SV)	X	X	X	Nepal (NP)	-	X	X
Equatorial Guinea (GQ) **(OA)**	X	X	-	Netherlands (NL) **(EP)**	X	X	X
Estonia (EE) **(EP)**	X	X	X	New Zealand (NZ)	X	X	X
European Union (EU)	-	-	X	Nicaragua (NI)	X	X	X
Fiji (FJ)	-	-	X	Niger (NE) **(OA)**	X	X	X
Finland (FI) **(EP)**	X	X	X	Nigeria (NG)	X	X	X
France (FR) **(EP)**	X	X	X	Norway (NO) **(EP)**	X	X	X
Gabon (GA) **(OA)**	X	X	X	Oman (OM)	X	X	X
Gambia (GM) **(AP)**	X	X	X	Pakistan (PK)	-	X	X
Georgia (GE)	X	X	X	Panama (PA)	X	X	X
Germany (DE) **(EP)**	X	X	X	Papua New Guinea (PG)	X	X	X

States Party to the PCT and the Paris Convention and Members of the World Trade Organization[1]

(status on 27 February 2017)

State/Member	PCT (151)	Paris (177)	WTO[2] (164)	State/Member	PCT	Paris	WTO
Paraguay (PY)	-	X	X	Suriname (SR)	-	X	X
Peru (PE)	X	X	X	Swaziland (SZ) **(AP)**	X	X	X
Philippines (PH)	X	X	X	Sweden (SE) **(EP)**	X	X	X
Poland (PL) **(EP)**	X	X	X	Switzerland (CH) **(EP)**	X	X	X
Portugal (PT) **(EP)**	X	X	X	Syrian Arab Republic (SY)	X	X	-
Qatar (QA)	X	X	X	Taiwan, Province of China (TW)[6]	-	-	X
Republic of Korea (KR)	X	X	X	Tajikistan (TJ) **(EA)**	X	X	X
Republic of Moldova (MD)	X	X	X	Thailand (TH)	X	X	X
Romania (RO) **(EP)**	X	X	X	The former Yugoslav Republic of Macedonia (MK) **(EP)**	X	X	X
Russian Federation (RU) **(EA)**	X	X	X	Togo (TG) **(OA)**	X	X	X
Rwanda (RW) **(AP)**	X	X	X	Tonga (TO)	-	X	X
Saint Kitts and Nevis (KN)	X	X	X	Trinidad and Tobago (TT)	X	X	X
Saint Lucia (LC)	X	X	X	Tunisia (TN)	X	X	X
Saint Vincent and the Grenadines (VC)	X	X	X	Turkey (TR) **(EP)**	X	X	X
Samoa (WS)	-	X	X	Turkmenistan (TM) **(EA)**	X	X	-
San Marino (SM) **(EP)**	X	X	-	Uganda (UG) **(AP)**	X	X	X
Sao Tome and Principe (ST)	X	X	-	Ukraine (UA)	X	X	X
Saudi Arabia (SA)	X	X	X	United Arab Emirates (AE)	X	X	X
Senegal (SN) **(OA)**	X	X	X	United Kingdom (GB) **(EP)**	X	X	X
Serbia (RS) **(EP)**	X	X	-	United Republic of Tanzania (TZ) **(AP)**	X	X	X
Seychelles (SC)	X	X	X	United States of America (US)	X	X	X
Sierra Leone (SL) **(AP)**	X	X	X	Uruguay (UY)	-	X	X
Singapore (SG)	X	X	X	Uzbekistan (UZ)	X	X	-
Slovakia (SK) **(EP)**	X	X	X	Vanuatu	-	-	X
Slovenia (SI) **(EP)**	X	X	X	Venezuela (Bolivarian Republic of) (VE)	-	X	X
Solomon Islands (SB)	-	-	X	Viet Nam (VN)	X	X	X
South Africa (ZA)	X	X	X	Yemen (YE)	-	X	X
Spain (ES) **(EP)**	X	X	X	Zambia (ZM) **(AP)**	X	X	X
Sri Lanka (LK)	X	X	X	Zimbabwe (ZW) **(AP)**	X	X	X
Sudan (SD) **(AP)**	X	X	-				

1. Under PCT Rule 4.10(a), it is possible to claim in an international application the priority of one or more earlier applications filed in or for any country party to the Paris Convention for the Protection of Industrial Property, or in or for any Member of the World Trade Organization (WTO) that is not party to that Convention.
2. WTO Members cannot necessarily become party to the Paris Convention or the PCT.
3. Will become party to the Paris Convention on 14 May 2017.
4. China has notified the Director General of WIPO that the Paris Convention and the PCT apply also to Hong Kong, China.
5. China has notified the Director General of WIPO that the Paris Convention applies also to Macau, China.
6. Also referred to by the WTO as "Chinese Taipei" or "Separate Customs Territory of Taiwan, Penghu, Kinmen and Matsu".

Where a state can be designated in a PCT application for a regional patent, the two-letter code for the regional patent concerned is indicated in bold in parentheses (**AP** = ARIPO patent, **EA** = Eurasian patent, **EP** = European patent, **OA** = OAPI patent).