

---

CHAMBERS GLOBAL PRACTICE GUIDES

---

# Patent Litigation 2026

---

Definitive global law guides offering  
comparative analysis from top-ranked lawyers

## **South Africa**

### **Law & Practice**

At van Rooy, Annelise Engelbreg,  
Tim Laurens and Diseko Boikanyo  
KISCH IP

### **Trends & Developments**

Tim Laurens and Ursula Baravalle  
KISCH IP



# SOUTH AFRICA



## Law and Practice

### Contributed by:

At van Rooy, Annelise Engelbreg, Tim Laurens and Diseko Boikanyo  
**KISCH IP**

## Contents

### 1. Intellectual Property Rights and Granting Procedure p.5

- 1.1 Types of Intellectual Property Rights p.5
- 1.2 Grant Procedure p.5
- 1.3 Timeline for Grant Procedure p.7
- 1.4 Term of Each Intellectual Property Right p.7
- 1.5 Rights and Obligations of Owners of Intellectual Property Rights p.8
- 1.6 Further Protection After Lapse of the Maximum Term p.8
- 1.7 Third-Party Rights to Participate in Grant Proceedings p.8
- 1.8 Remedies Against Refusal to Grant an Intellectual Property Right p.9
- 1.9 Consequences of Failure to Pay Annual Fees p.9
- 1.10 Post-Grant Proceedings Available to Owners of Intellectual Property Rights p.9

### 2. Initiating a Lawsuit p.10

- 2.1 Actions Available Against Infringement p.10
- 2.2 Third-Party Remedies to Remove the Effects of Intellectual Property p.10
- 2.3 Courts With Jurisdiction p.10
- 2.4 Specialised Bodies/Organisations for the Resolution of Disputes p.11
- 2.5 Prerequisites to Filing a Lawsuit p.11
- 2.6 Legal Representation p.11
- 2.7 Interim Injunctions p.11
- 2.8 Protection for Potential Opponents p.12
- 2.9 Special Limitation Provisions p.12
- 2.10 Mechanisms to Obtain Evidence and Information p.12
- 2.11 Initial Pleading Standards p.12
- 2.12 Representative or Collective Action p.13
- 2.13 Restrictions on Assertion of an Intellectual Property Right p.13

### 3. Infringement p.13

- 3.1 Necessary Parties to an Action for Infringement p.13
- 3.2 Direct and Indirect Infringement p.14
- 3.3 Process Patents p.14
- 3.4 Scope of Protection for an Intellectual Property Right p.14
- 3.5 Defences Against Infringement p.14
- 3.6 Role of Experts p.15
- 3.7 Procedure for Construing the Terms of the Patent's Claim p.15
- 3.8 Procedure for Third-Party Opinions p.15

### 4. Revocation/Cancellation p.15

- 4.1 Reasons and Remedies for Revocation/Cancellation p.15
- 4.2 Partial Revocation/Cancellation p.16
- 4.3 Amendments in Revocation/Cancellation Proceedings p.16
- 4.4 Revocation/Cancellation and Infringement p.16

## **5. Trial and Settlement p.17**

- 5.1 Special Procedural Provisions for Intellectual Property Rights p.17
- 5.2 Decision-Makers p.17
- 5.3 Settling the Case p.17
- 5.4 Other Court Proceedings p.17

## **6. Remedies p.17**

- 6.1 Remedies for the Patentee p.17
- 6.2 Rights of Prevailing Defendants p.18
- 6.3 Types of Remedies p.18
- 6.4 Injunctions Pending Appeal p.18

## **7. Appeal p.18**

- 7.1 Special Provisions for Intellectual Property Proceedings p.18
- 7.2 Type of Review p.18

## **8. Costs p.18**

- 8.1 Costs Before Filing a Lawsuit p.18
- 8.2 Calculation of Court Fees p.18
- 8.3 Responsibility for Paying the Costs of Litigation p.18

## **9. Alternative Dispute Resolution p.18**

- 9.1 Type of Actions for Intellectual Property p.18

## **10. Assignment and Licensing p.18**

- 10.1 Requirements or Restrictions for Assignment of Intellectual Property Rights p.18
- 10.2 Procedure for Assigning an Intellectual Property Right p.19
- 10.3 Requirements or Restrictions to License an Intellectual Property Right p.19
- 10.4 Procedure for Licensing an Intellectual Property Right p.19

**KISCH IP** is a multinational group with experts in intellectual property (IP) law, taxation and commercial law services. Clients are assured that their innovations, finances and corporate assets are attended to at the highest professional standards. KISCH IP serves as a

key partner for international and regional entities, and for local companies seeking to enter African markets. The lawyers fulfil their clients' needs while continually growing and protecting clients' personalised IP, commercial and tax portfolios.

## Authors



**At van Rooy** is board chair and a director in KISCH IP's litigation department. At has more than 30 years' experience in specialist intellectual property law litigation and has successfully represented a wide

range of international clients in patent and copyright litigation, up to the Supreme Court of Appeal and the Constitutional Court of South Africa. He has extensive experience in patent, design and copyright litigation, plant breeders' rights and GMO litigation, Anton Piller-type proceedings, pharmaceutical, agrochemical and veterinary product liability litigation and patent filing and prosecution. His technical expertise includes life sciences, pharmaceuticals, veterinary sciences, agrochemicals, medical sciences, chemistry, biotech, plant breeders' rights, product liability, copyright litigation, IP licensing contracts and registered designs.



**Annelise Engelbreg** is head of KISCH IP's patent and design administration and formalities department. Annelise has more than 15 years' experience in IP and, specifically, in patents and registered designs. She specialises in

the filing of patent and registered design applications received from abroad and dealing with all subsequent administration, prosecution and formalities thereof. Annelise is a member of the International Federation of Intellectual Property Attorneys (FICPI) and a fellow of the South African Institute of Intellectual Property Law (SAIIPL).



**Tim Laurens** is a multifaceted patent attorney and attorney of the High Court of South Africa with a strong blend of technical and legal expertise. A senior associate at KISCH IP, he focuses on patent and design

prosecution, drawing on his chemical engineering background to draft patents in chemistry, chemical processes, pharmaceuticals, blockchain and software technologies. He is equally engaged in the commercialisation of intellectual property, particularly patents, and has litigation experience in unlawful competition involving confidential information, trade secrets and restraint-of-trade disputes. Holding an LLM in Medical Law (cum laude), Tim combines technical insight with legal precision and maintains a keen interest in the intersection of IP, technology and commercial law.



**Diseko Boikanyo** is a patent attorney clerk in the patent department of KISCH IP. She holds a BSc (Chemistry and Biology), BSc Hons (Chemistry), MSc (Chemistry) and PhD (Chemistry). Her focus within the

patent department is patent, design, plant breeder's rights and litigation, intellectual property agreements and opinions. Diseko is an experienced researcher in the fields of inorganic chemistry and materials science. Diseko has done extensive research in several thematic areas including electrochemistry, catalysis and functional materials for water treatment technology applications.

## KISCH IP

5 Inanda Greens Business Park  
54 Wierda Road West  
Wierda Valley  
Sandton  
Johannesburg 2146  
South Africa

Tel: +27 113 243 000  
Fax: +27 866 036 118  
Email: [info@kisch-ip.com](mailto:info@kisch-ip.com)  
Web: [www.kisch-ip.com](http://www.kisch-ip.com)



## 1. Intellectual Property Rights and Granting Procedure

### 1.1 Types of Intellectual Property Rights

Patents, registered designs (functional and aesthetic), plant breeders' rights (for plant varieties and GMO plant varieties) and copyright are the different types of intellectual property rights in South Africa, and they are based on statutory law.

### 1.2 Grant Procedure

South Africa's intellectual property framework is expected to undergo significant reform. A new Patents Bill is anticipated to introduce phased substantive search and examination in selected technical fields, publication of applications on filing with scope for third-party observations, a novelty grace period and utility models (with conversion from patent applications). It is also expected to require disclosure of the origin of genetic resources and associated traditional knowledge, provide limited-grounds post-grant opposition and an administrative tribunal for compulsory licences, adjust fees for small and large entities, transfer circuit layout protection to the Patents Act and adopt a hybrid exhaustion regime. A Designs Amendment Bill is expected to remove functional designs, introduce an opposition period, extend disclosure requirements to traditional knowledge and cultural expressions, and prepare for accession to the Hague Agreement and alignment with the Riyadh Design Law Treaty.

However, presently, the grant procedure for each intellectual property right is as follows.

### Patents

South Africa is a member of the Paris Convention and the Patent Cooperation Treaty (PCT), thus providing two main filing routes by which a foreign inventor/applicant may obtain a patent. It is important to note that South Africa is currently a non-examining country with regard to the content of a patent specification. Therefore, as long as the formal requirements are met, the patent will be granted. Only during infringement and/or revocation proceedings will the substance of the specification be examined by the court for novelty, inventiveness and applicability.

In the Republic-based route to grant a patent, the following general procedure occurs:

- priority is established through the filing of a provisional or complete patent application in South Africa, or by the first convention application in a Paris Convention member country;
- for a foreign applicant, a patent can be obtained through the filing of a convention application claiming priority or a PCT national phase application;
- when a complete specification has been lodged at the Patent Office (through the applicant's attorney), the applicant has 18 months (extendable by three months – or more if good cause is shown) in which to bring the application into acceptable order for formal acceptance (ie, the filing of declarations) – if the application is not in acceptable format by the deadline, the application is deemed to have lapsed;
- once the application is accepted, the registrar will provide a notice of acceptance along with the date of acceptance (also recorded in the patent

register), and the applicant must ensure the patent specification is published in the patent journal within three months (extendable by prior request with good cause) – if no publication occurs within this time or a prior accepted extension, the patent application will be deemed to have lapsed; and

- the patent is deemed to be granted on the date of publication, and the term will start from the date of filing the application with the Patent Office – after publication, the registrar will issue a certificate for the letters patent.

There is, however, a nine-month moratorium (except with leave of the commissioner) on instituting infringement proceedings from the date of grant.

For a South African PCT national phase application, the following general procedure applies. Applicants need to file the national phase complete specification within 31 months of the earliest priority date claimed in the PCT application. This is extendable by three months upon request, or by condonation. It is important to note that the national phase application date is deemed to be the PCT application filing date, and thus the term of monopoly begins from this date. Once the national phase application has been accepted by the Patent Office, the procedure going forward is identical to that of complete specification filed under the Republic-based route. If any discrepancies occur between the PCT and local legislation, the PCT, and its regulations and administrative instructions, will prevail.

## Registered Designs

The applicant needs to lodge an application with the Designs Office at the latest within six months of the release date of the design. This release date is applicable to designs made available to the public worldwide. The application date will be the date the application is lodged at the Designs Office, or if applicable, the date it is lodged at an office in a convention country.

It is important to note that some foreign jurisdictions allow a 12-month period from the release date in which to lodge a registered design application. In situations where the applicant has lodged a registered design application in a convention country more than six months after the release date, the subsequent

application in the Republic will not be valid. Upon receipt of an application, the registrar will examine the application for formal compliance and, if found to be acceptable, issue a notice of registration. Note that no substantive examination will occur during this examination. The applicant is then obliged to publish a notice of registration in the patent journal and, after publication, the registrar will issue a certificate of registration.

It is important to note that there is no time limit specified in which the publication must occur, but if it does not occur, the registrar must refuse the application. The design, when registered, will be from the date of application. Registration may be as an aesthetic or functional design, or both – and in multiple classes – and the registrar may assist with the classification if requested.

## Plant Breeders' Rights

The applicant for the registration of a plant breeders' right lodges an application with the registrar of plant breeders' rights at the latest within one year of commercially disposing of plant material in South Africa, or six years for trees and vines and four years for other types if the plant material is commercially disposed of in another member country of the International Union for the Protection of New Plant Varieties (UPOV).

The registration procedure may be conducted physically with the registrar online via UPOV PRISMA. This application typically contains documents encompassing the application form, a technical questionnaire, photographs, the right to apply (ie, assignment) and proof of payment. The application is published by the registrar in the government gazette, and an interested person has six months from the publication date to oppose the application. The Department of Agriculture grows and evaluates the variety to ensure it meets registration standards (ie, distinct, uniform and stable). Depending on the variety type, this could take between three months and several years. As such, the applicant must supply plant material to the Department of Agriculture within an extendable 12-month period.

If the material originates outside of the Republic, a phyto-sanitary certificate and import permit must be

obtained. It is important to note that another country's testing results for the equivalent plant breeders' right are not accepted in the Republic. Provisional protection while the application is pending is possible, provided that the applicant provides a written undertaking not to sell or consent to sell reproductive material of the variety. If the registrar is satisfied that the variety meets the requirements of protection, the right is granted and the term of protection starts on the grant date. The registrar will issue a certificate of registration, enter the details in the register and publish the particulars by way of notice in the government gazette. If the registrar refuses the application, the decision may be appealed to the appeals board.

## Copyright

The vesting of copyright rights is automatic; therefore, no grant procedure is prescribed.

South Africa's intellectual property framework is expected to undergo significant reform. A new Patents Bill is anticipated to introduce phased substantive search and examination in selected technical fields, publication of applications on filing with scope for third-party observations, a novelty grace period and utility models (with conversion from patent applications). It is also expected to require disclosure of the origin of genetic resources and associated traditional knowledge, provide limited-grounds post-grant opposition and an administrative tribunal for compulsory licences, adjust fees for small and large entities, transfer circuit layout protection to the Patents Act and adopt a hybrid exhaustion regime. A Designs Amendment Bill is expected to remove functional designs, introduce an opposition period, extend disclosure requirements to traditional knowledge and cultural expressions, and prepare for accession to the Hague Agreement and alignment with the Riyadh Design Law Treaty.

### 1.3 Timeline for Grant Procedure

A patent can be granted at any time from eight to 18 months from the date of application unless delay of acceptance is requested by the applicant. Such a request is voluntary, in order to delay the acceptance and, hence, the grant of a patent. There is no limit on the number of times an application can be delayed, nor on the length of the delay sought. For registered

designs, enforceable rights can be obtained within six months from application, and the grant process can be completed within 12 months from application. For plant breeders' rights, the grant procedure will depend on the nature of the plant variety for which protection is sought, given that comparative growth trials are conducted during the prosecution process. Typically, the grant procedure takes between one and three years from application. For copyright, there is no grant procedure.

The inventor/applicant has to appoint a local patent attorney to act as the address for service if not resident in South Africa. The average cost to grant varies depending on whether the applicant delays acceptance or has amendments to effect, but is usually in the range of USD3,500–4,000.

### 1.4 Term of Each Intellectual Property Right

The terms of the different intellectual property rights are as follows:

- patents – 20 years from the date of lodging the complete specification at the Patent Office or from the international filing date in the case of a national phase application;
- functional design – ten years from the date on which the application for a design registration was lodged at the Designs Office;
- aesthetic design – 15 years from the date on which the application for a design registration was lodged at the Designs Office; and
- plant breeders' rights – 25 years for vines and trees from the date of issue of certification, and 20 years for all other cases (note: this is based on the 1976 Plant Breeders' Rights Act No 15 of 1976 (the "PBR Act"). The new Plant Breeders' Rights Act No 12 of 2018 is set to come into force soon, and it will alter the term of protection to 20, 25 or 30 years depending on the particular kind of plant).

## Copyright

In general, the term of copyright is 50 years from:

- the end of the year of death of the author;
- the end of the year in which the work is made available or first published; or

- the end of the year in which the work is first published, broadcast or emitted as signals to a satellite.

## 1.5 Rights and Obligations of Owners of Intellectual Property Rights

The rights afforded to the owners of different intellectual property rights are as follows.

- **Patents:** The owner of this right may, during the term of the patent, exclude others from making, using, exercising, disposing or offering to dispose of – or importing – the invention, so that the owner may enjoy the ensuing economic and other advantages. Licensees of the patent may enjoy limited rights in relation to the foregoing. Remedies include Anton Piller-type orders, interim and final interdicts (injunctions), delivery up of the infringing item(s), damages (non-punitive) and reasonable royalties in lieu of damages.
- **Registered designs:** The owner of this right may, during the term of the registered design, exclude others from making, importing, using or disposing of any article (or substantially similar article) included in the class in which the design is registered, so that the owner may enjoy the ensuing economic and other advantages. Licensees of the registered design may enjoy limited rights in relation to the foregoing. Remedies include Anton Piller-type orders, interdicts, delivery up of the infringing item(s), damages (non-punitive) and reasonable royalties in lieu of damages.
- **Plant breeders' rights:** In general, the owner of a plant breeders' right may prevent others, without a licence, from multiplying, conditioning for the purpose of propagation, sale or any other form of marketing, exporting, importing or stocking, for the foregoing purposes, material of the protected variety. Remedies include Anton Piller-type orders, interdicts and damages (non-punitive). Additionally, the court may ensure that any order regarding the custody, surrender or disposal of any material (tangible or otherwise) is connected to the right.
- **Copyright:** In addition to moral rights, copyright exists but depends on the nature of the work enjoying protection. Remedies include Anton Piller-type orders, interdicts, delivery up of the infringing

item(s), damages (non-punitive) and reasonable royalties in lieu of damages.

The obligations afforded to the different intellectual property rights are as follows.

- **Patents:** Yearly renewal fees are required for the patent to remain valid but they may be paid upfront for the full term. The owner is obliged not to abuse the patent (ie, to sufficiently meet demand in the Republic, amongst other acts or omissions). There is also an obligation to disclose the patent number when requested by an interested person to prevent erosion of certain rights afforded to the owner.
- **Registered designs:** Yearly renewal fees are required for the patent to remain valid but they may be paid upfront for the full term. As with patents, the owner is obliged to not abuse the registered design. There is an obligation to disclose the registration number, when requested by an interested person, to prevent a reduction in the potential damages that may be awarded for infringement.
- **Plant breeders' rights:** The owner is obliged to pay yearly renewal fees. The owner may also not unreasonably refuse or impose unreasonable conditions on a licence for the right. Compulsory licences may be granted in such cases.
- **Copyright:** There are no obligations in respect of fees payable or disclosing the copyright symbols or numbers upon works in the Republic.

With regard to public listings of patents related to certain products or processes, these do not currently exist in South Africa. In addition, South Africa does not have a patent/ registration linkage system that connects drug marketing approval with the resolution of patent disputes.

## 1.6 Further Protection After Lapse of the Maximum Term

There is no applicable information in this jurisdiction.

## 1.7 Third-Party Rights to Participate in Grant Proceedings

For patents and registered designs, there is no opportunity for third parties to participate in grant proceedings. The applicable procedure is the filing of an application for the revocation of the patent or reg-

istered design post-grant. Once the Patents Bill and Designs Amendment Bill are in force, it is anticipated that third-party participation will expand through pre-grant observations and post-grant opposition mechanisms administered by the Companies and Intellectual Property Commission (CIPC) and an administrative tribunal.

Concerning plant breeders' rights, both the application and intention to grant a plant breeders' right are published in the plant variety journal, and third parties have the right to object to the grant thereof.

## 1.8 Remedies Against Refusal to Grant an Intellectual Property Right

Remedies against a refusal to grant exist for all applicable intellectual property rights. These include the following:

- patents and registered designs are subjected to formal examination only, and no substantive examination is conducted – any refusal to grant a registered design or patent by the registrar may be challenged by a review application to the commissioner of patents (then further to the court in the case of patents), and to court in the case of registered designs; and
- with respect to plant breeders' rights, any decision by the registrar that adversely affects the rights of the applicant may be appealed to the appeals board. Further appeal to the court is possible.

## 1.9 Consequences of Failure to Pay Annual Fees

The consequences of not paying annual fees for the different intellectual property rights, where applicable, are as follows.

- Patents: Non-payment of renewal fees will lead to a lapse of the patent. Restoration of the patent is possible but, after the restoration of the patent and under specific circumstances, there may be limited rights of enforcement or obligations to pay compensation to third parties who incurred costs to work the invention during the period of lapse and restoration.
- Registered designs: Non-payment of renewal fees will lead to a lapse of the design. Restoration of

the design is possible but, after the restoration of the design and under specific circumstances, there may be limited rights of enforcement or obligations to pay compensation to third parties who incurred costs to work the invention during the period of lapse and restoration.

- Plant breeders' rights: The registrar may terminate a plant breeders' right if renewal fees are not paid.

## 1.10 Post-Grant Proceedings Available to Owners of Intellectual Property Rights

Amendments of the granted rights are possible. The procedures and limitations of these amendments are as follows.

- Patents: Correction of clerical errors is possible on request to the registrar. If the correction materially alters the scope of the document, the registrar may require the publication of a notice to amend the document. If an opposition to the amendment occurs, the commissioner of patents will decide the matter.
- Concerning amendments to the specification of a patent, amendments introducing new subject matter or claims not fairly based on the subject matter are not permissible. Amendments may be applied for at any time, where the applicant will give reasons for the amendment to the registrar in addition to the details of the amendment. Advertisement of the amendment will occur, with specifications open to public inspection. If an opposition to the amendment is lodged, the commissioner will determine the matter; otherwise, if no objection is lodged or if advertisement was not applicable, the registrar may affect the amendment. In *Timrite (Pty) Ltd and Another v Vesper Projects (Pty) Ltd and Another* [2025] ZACCP 2, the Court of the Commissioner of Patents (CCP) emphasised its wide procedural discretion under Section 51 (9) and postponed an opposed amendment to be heard together with a pending non-infringement application where issues of fair basis and continuing invalidity substantially overlapped.
- Registered designs: Amendment through the correction of clerical errors in any document may be authorised by the registrar, with or without a request. If requested, the request must be in writing; if not requested, the registrar shall give notice

to the owner of the registered design. If the registrar is of the opinion that the correction will materially alter the scope of the design, the registrar may require notice of the request to be published in the patent journal. If no opposition to the amendment occurs, or if notice was not published, the registrar may decide the matter. If opposition occurs, the courts may decide the matter.

- With regard to the amendment of the application, design or registration, the owner may at any time apply for the amendment with a prescribed fee. The application for amendment must provide the full reasons therefor, whereupon the application will be advertised in the patent journal. If there is no opposition to the amendment within the prescribed time, the registrar may determine the matter; if there is opposition, the court may determine the matter. No amendment will be accepted if it will introduce new matter or matter not in substance disclosed beforehand. It will also not be accepted if it introduced matter not fairly based on that disclosed beforehand.
- Plant breeders' rights: The amendment of an application for a registered plant variety is possible through an application to the registrar. If it is made before the original application's publication in the government gazette, there are no requirements to meet in order to amend the application. If it occurs after the publication, the registrar shall republish the application in amended form.
- The amendment of clerical errors or corrections to any document post-registration, or to any procedure in any proceedings (if not detrimental to any person), is possible upon written request. The registrar may also make such amendment *mero motu* with notice to the owner.

## 2. Initiating a Lawsuit

### 2.1 Actions Available Against Infringement

Applicable actions available to the holder of an intellectual property right generally include negotiation, mediation, arbitration (such as through the [Intellectual Property Arbitration Centre, South Africa](#)) and approaching the court for relief or Anton Piller-type orders. Certain actions unique to the different intellectual property rights are detailed in the following:

- patents – infringement proceedings in court are always initiated in the CCP, located in Pretoria;
- designs – all other matters dealing with the infringement are initiated in the High Court that has jurisdiction;
- copyright – in addition to infringement and criminal proceedings, the Copyright Tribunal hears licencing and royalty disputes; and
- plant breeders' rights – in addition to infringement proceedings in the High Court, the PBR Act, Section 24A provides for the issuing of a warrant to search, sample and seize material, items and documents believed to be involved in the infringement of a plant breeders' right.

### 2.2 Third-Party Remedies to Remove the Effects of Intellectual Property

With patents and registered designs, any person may apply for the revocation of a patent or registered design at any time. The grounds for such revocation are discussed more fully in the following. Compulsory licences for patents and registered design are possible upon application by an interested person if the patent or design is being abused. Declarations of non-infringement are also possible.

### 2.3 Courts With Jurisdiction

South Africa has a hierarchal court structure generally represented, in order of increasing authority, by the Magistrate's Court, High Court, Supreme Court of Appeal (SCA) and finally the Constitutional Court (CC). Depending on the nature of the relief sought, the High Court may hear the matter in the first instance. In extreme cases, the CC may be approached directly, although this is rare and often refused. Certain courts have jurisdiction in the first instance depending on the type of intellectual property, as discussed in the following.

- Patents: The CCP has jurisdiction in the first instance. A non-specialised judge of the High Court is appointed as the commissioner. Appeals may be heard in the SCA followed by the CC. Criminal proceedings related to patent matters may follow the hierarchal structure referred to in the foregoing.
- Registered designs: The High Court has jurisdiction in the first instance for any matter related to regis-

tered designs, after which the hierarchy described in the foregoing is followed.

- Plant breeders' rights: Matters are heard in the first instance before the registrar, followed by the appeal board. Thereafter, the High Court and subsequent hierarchy are applicable.
- Copyright: The jurisdiction follows the standard hierarchy referred to in the foregoing. Infringement proceedings are often initiated in the High Court with applicable jurisdiction, and the Copyright Tribunal may be approached first to decide licensing disputes.

## 2.4 Specialised Bodies/Organisations for the Resolution of Disputes

There are certain specialised bodies that may resolve different types of intellectual property rights; these include the Intellectual Property Arbitration Centre of South Africa, which may resolve all intellectual property disputes, the Plant Breeders' Rights Board – dedicated to hearing disputes relating to plant breeders' rights – and the Copyright Tribunal, which hears licensing disputes.

## 2.5 Prerequisites to Filing a Lawsuit

There are some prerequisites to filing a lawsuit involving the different intellectual property rights. Concerning patents, there is a nine-month moratorium after the grant of the patent before infringement proceedings may be instituted. Furthermore, when filing, the patent number must be recorded as the case number. Additionally, there are restrictions on the recovery of damages if an infringer has not been made aware of the existence of the patent and its number. The mere statement that an invention is protected by patent is insufficient; the number must be stated. Joint owners of a patent are required to be in agreement before any proceedings may be initiated, and the owner of a patent is required to notify licensees before proceedings are initiated. Finally, a licensee is required to wait for two months after requesting the owner of a patent to initiate proceedings before initiating proceedings in lieu of the owner.

For registered designs, the foregoing details regarding patents equally apply, except that the nine-month moratorium does not exist, and an exclusive licensee

may institute proceedings without delay as if he or she were the owner of the design.

Prerequisites involving plant breeders' rights include:

- providing the registrar with all material information and samples of the variety, and a written undertaking not to dispose or offer to dispose the plant material to the public for enforceable provisional protection; and
- the lack of any possibility of objection to the registration of the right or an appeal to the board.

Since copyright vests automatically without formal registration or grant, the owner must establish the subsistence of copyright and entitlement. In general, with all types of intellectual property, the lack of a letter of demand may influence the quantum of costs awarded to the successful litigant, and an attempt at mediation is required before the filing of court proceedings.

## 2.6 Legal Representation

If the owner is resident in South Africa, they have right of appearance, although in practice (due to the complexity of intellectually property matters) the owner is best represented by a legal practitioner skilled in intellectual property. If the owner is a foreign resident, they will be required to obtain legal representation.

## 2.7 Interim Injunctions

Interim interdicts (injunctions) are available and require the following to be awarded:

- there must be a prima facie right to the intellectual property;
- there must be irreparable damage or a reasonable belief that irreparable damage will occur;
- the balance of convenience must favour the applicant; and
- there must be no alternative remedy.

The balance of convenience requirement is not applicable in case of a final interdict.

Ex parte Anton Piller-type orders are also available, and the following are required for such an order:

- a prima facie right;
- prima facie evidence of infringement of the right;
- evidence that the respondent possesses or controls evidence pertaining to the infringement; and
- a material threat that the evidence might be destroyed or concealed if not seized immediately.

## 2.8 Protection for Potential Opponents

Litigation is costly and, as such, a litigant may demand security for costs. There are several circumstances in which a court will award an order for the security for costs:

- against a plaintiff/applicant that is a peregrinus of the Republic;
- against a plaintiff/applicant where the court is satisfied that the litigation is vexatious or reckless, or amounts to an abuse of the court process; and
- against a close corporation if that corporation is a plaintiff/applicant, or has filed a counterclaim, and there exists a risk that the close corporation may be wound up.

Furthermore, the commissioner in the CCP may order the security of costs against any party to the proceedings, having regard to the prospects of success or the bona fides of the party. Any party includes an incola of the Republic.

## 2.9 Special Limitation Provisions

A nine-month moratorium on the initiation of infringement proceedings exists after the grant of a patent. There is no time limitation to institute proceedings, and a claim for damages will prescribe after three years of becoming aware of the damage. This three-year period will be interrupted by the institution of court proceedings.

## 2.10 Mechanisms to Obtain Evidence and Information

A party to an intellectual property matter may obtain relevant information from the other party through two main routes: Anton Pillar-type orders and the discovery, inspection and production of documents (“discovery”). The procedures for these routes are as follows.

- For Anton Pillar-type orders, an ex parte application is brought to the relevant court in camera, and

the applicant will need to establish the requirements for such an order as detailed in the foregoing. An Anton Pillar order is obtained before a letter of demand or main application or action is instituted.

- Through discovery, a party to proceedings may bring an application to the court compelling any party to the proceedings to discover all documents and tape recordings relating to any matter in question. The timing of discovery is usually after the close of pleadings but before the hearing of the matter. The discovered documents or tape recordings are required to be made available for inspection and may be copied or transcribed. The application for discovery is not made before the initiation of the main matter, as the courts would regard this as premature and an attempt to obtain court assistance to determine a cause of action. Third parties are included if a party to the proceedings has “control” over documents or tape recordings in the possession of a third party.
- Parties may also be subpoenaed to testify.

## 2.11 Initial Pleading Standards

There are two main mechanisms through which a lawsuit is initiated in the courts: action or motion proceedings.

An action proceeding is mainly brought by a combined summons including the particulars of a claim and averments on facts in question (*facta probanda*), which are to be proved during a trial. The defendant files a plea (with or without a counterclaim) in opposition to the summons, which will also contain *facta probanda* and *probandia*. The court will decide the matter based on the hearing of the oral and other evidence.

A motion proceeding is brought by way of application to the court. The notice of motion is combined with a founding affidavit, which sets out all the material facts that are requirements for relief (*facta probanda* and *facta probantia*). The respondent has an opportunity to file an answering affidavit. This is followed by a replying affidavit. As such, the matter is heard on paper only, and no oral testimony or other evidence is given. If material disputes of fact arise, the matter may be referred to oral proceedings.

In both action and motion proceedings, there is an opportunity to introduce new evidence through the filing of further pleas or affidavits (respectfully) before pleadings close. After pleadings have closed, but before judgment, new evidence or arguments may be introduced with leave of the court. This mostly occurs when new evidence has come to light after the pleading is closed and will have a material bearing on the outcome of the matter.

## 2.12 Representative or Collective Action

The South African legal system permits representative or collective actions (such as class actions). The right to bring a class action is derived from Section 38 (c) of the Constitution of South Africa, which allows individuals or groups to approach the courts on behalf of a class when rights are allegedly infringed.

Class actions in intellectual property law typically arise in cases involving the infringement of intellectual property rights that affect a group of people. The plaintiffs must define the group (class) clearly, and the members of the class should have a common legal or factual issue concerning the intellectual property matter. There must be common questions of law or fact that predominate over individual issues, and the proposed class action must be certified by the court before proceeding.

Certification requires:

- demonstrating the existence of a class;
- demonstrating the commonality of legal or factual issues;
- demonstrating that a class action is the most appropriate means to resolve the dispute;
- the representative(s) of the class to adequately and fairly represent the interests of all class members, and to have a direct interest in the matter and sufficient resources to conduct the litigation effectively; and
- the court to be satisfied that instituting a collective action is in the interests of justice.

Factors considered include the significance of the rights involved, the scale of the harm and the practicality of individual litigation. The matter must be within the jurisdiction of the court in which the action

is brought. Procedural rules, including the filing of a class action notice and the provision of sufficient information about the class and the claims, must be followed, and the relief sought must be capable of addressing the harm suffered by the class as a whole (eg, damages, declaratory relief or injunctions).

## 2.13 Restrictions on Assertion of an Intellectual Property Right

There are several restrictions on the assertion of intellectual property rights by the owner. These mainly include exhaustion of rights, Bolar provisions, the nine-month moratorium on instituting patent infringement proceedings and the abuse of the intellectual property rights. Except for copyright, the abuse of intellectual property rights may lead to the granting of a compulsory licence. Typical abuse conditions include, amongst others, the refusal to grant a licence on reasonable terms or, if the invention is not being worked in the Republic, the lack of an adequate supply thereof. There are also restrictions on enforcing design and patent rights if the registered design number or patent number has not been communicated on request.

Furthermore, there is a restriction on copyright and designs for the creation of spare parts that primarily have a utilitarian function. With patents, a further provision is given in the relevant Act preventing certain contractual agreements from occurring, such as – but not limited to – preventing a purchaser or licensee from making or using the invention in a country where the invention is not protected.

A copyright holder may also not enforce the right against fair dealings, which generally constitutes research or private study, criticism or review or the reporting of current events.

## 3. Infringement

### 3.1 Necessary Parties to an Action for Infringement

The registered owner is usually a party to an action for infringement. However, under certain circumstances, the licensee of patents and registered designs will not be a party to the action. This occurs where the owner

has notified the licensee and they chose not to be a party. In the case of patents, the owner will not be a party to the action if the licensee notified them two months beforehand and the owner has elected not to be a party to the action. With registered designs, an exclusive licensee, under compulsory licences, must be a co-party, along with the owner, to the action. In case of plant breeders' rights, the licensee and the owner must be co-joined in actions. In case of copyright, the owner or licensee may be a party to actions. Where the licensee initiates infringement actions, they are obliged to inform the owner, who may decide to join in the action.

### 3.2 Direct and Indirect Infringement

There are differences in direct and indirect infringement among the different intellectual property rights.

Concerning patents, indirect infringement may occur where an individual aids and abets the direct infringement of the right of another person and is actionable. South African courts recognise indirect infringement of patent rights, and interdicts, damages, delivery up and Anton Piller-type orders are available against direct and indirect infringement. As with patents, indirect infringement of registered designs is recognised in South African law.

With copyright, the relevant Act recognises both direct and indirect infringement. Direct infringement occurs when an act is performed that may only be performed by the owner or licensee. Indirect infringement occurs when an unauthorised person deals with or allows the public performance of works constituting direct infringement. Interdicts (injunctions), damages, delivery up and Anton Piller-type orders are available against direct and indirect infringement.

### 3.3 Process Patents

Under South African law, a patented article is any product produced through a patented process, method or machine. There is also a rebuttable presumption that such article is made by a patented process, method or machine. However, the owner of a patent right may not contractually prevent a purchaser of a patented article from using or acquiring any article obtained from a process not protected by the right.

### 3.4 Scope of Protection for an Intellectual Property Right

The scope of protection of an intellectual property right is, by default, determined by the courts. In the case of patents, the principles used to determine whether infringement has occurred are mainly derived from the test created by *Ensign-Bickford (South Africa) (Pty) Ltd and others v AECL Explosives & Chemicals Ltd* 1998 BIP 271 (SCA). As per this case, the test involves determining:

- whether the alleged infringer committed an act that may constitute an infringement;
- whether the act falls within the scope of any of the claims after they have been construed; and
- whether the defendant has a valid defence.

The concept of equivalent infringement only plays a role after construing the claims and determining the essential and non-essential integers. If the essential integers are substituted by an equivalent, no infringement occurs. The prosecution history plays a role in whether a valid defence exists for the alleged infringer – eg, whether assignment has occurred or there has been a lapse.

### 3.5 Defences Against Infringement

Fair, reasonable, and non-discriminatory (FRAND) voluntary licences do not exist in South African patent law. Rather, the use of an invention to determine information for regulatory bodies is considered an act of non-infringement and forms part of bolar provisions. Laches is similarly not a part of South African law.

Concerning patents and designs, defences against infringement include all the grounds for revocation, special pleas of *lis pedens* and *res judicata*, issue estoppel and the exhaustion of rights, leave and licence, election and waiver. Additionally, the alleged infringing act must not constitute making, using, exercising, disposing of, offering to dispose of or importing the invention.

Concerning copyright, the use of any of the exceptions to protect the work may be used as a defence. There is some precedent for the use of the constitutional right to freedom of expression as a defence but this is not well developed. Other defences include

that the work is not original or the claimer is not the owner, the claimant has abandoned the right to claim copyright infringement or a tacit licence exists.

Concerning plant breeders' rights, a defence against infringement will include an application to terminate the right based on any of the grounds for termination.

### 3.6 Role of Experts

The role of expert witnesses is mainly to guide the court in order for it to understand the technology in question, as viewed by a person skilled in the art. These witnesses are mostly appointed by the respective parties and offer evidence in support of their argument. The expert does not determine the meaning of a claim or whether it stands to be revoked. Rather, the experts guide the court on the state of the art while making such determinations. Often, contradictory expert evidence is given, and the court will analyse the logical argument behind the evidence offered by opposing experts. It is therefore the duty of the court to determine the meaning of the specifications and whether infringement, novelty or obviousness is present.

### 3.7 Procedure for Construing the Terms of the Patent's Claim

The procedure for construing the terms of the patent claims originates from case law in South Africa. The authoritative case for construing patent claims is *Gentiruco AG v Firestone SA (Pty) Ltd* 1972 (1) SA 589 (A), as modified by *Monsanto Co v MDB Animal Health (Pty) Ltd (formerly MD Biologics CC)* 2001 (2) SA 887 (SCA). In general, the approach used to construe the claims incorporates purposive interpretation while examining all aspects of the interpretation, from the ordinary meaning of words and those defined in the document to contextual analysis.

### 3.8 Procedure for Third-Party Opinions

In accordance with Section 38 of the Constitution, the court may involve experts to uphold constitutional values. Also, in accordance with Rule 16A of the High Court, the court may decide to involve an amicus curiae under specific circumstances where it is deemed necessary to assist the court in making an informed decision. In this context, when a case involves highly technical, scientific or otherwise specialised knowl-

edge that goes beyond the expertise of the judiciary, the court may invite experts to offer their insights as amicus curiae.

Examples include cases involving intellectual property disputes, environmental issues or intricate financial matters.

## 4. Revocation/Cancellation

### 4.1 Reasons and Remedies for Revocation/Cancellation

Revocation of a patent may occur through the following grounds:

- the patentee is not a person entitled to apply for the patent;
- the grant of the patent is in fraud of the rights of the applicant or of any person under or through whom he or she claims;
- the invention concerned is not patentable (ie, is not new, inventive or applicable in trade or industry, or is on an exclusion list);
- the invention, as illustrated or exemplified in the complete specification concerned, cannot be performed or does not lead to the results and advantages set out in the complete specification;
- the complete specification concerned does not sufficiently describe, ascertain and, where necessary, illustrate or exemplify the invention and the manner in which it is to be performed in order to enable the invention to be carried out by a person skilled in the art of such invention;
- the claims of the complete specification concerned are not (i) clear or (ii) fairly based on the matter disclosed in the specification;
- the prescribed declaration lodged in respect of the application for the patent or the statement lodged concerning traditional use contains a false statement or representation, which is material and which the patentee knew or ought reasonably to have known to be false at the time when the statement or representation was made;
- the application for the patent should have been refused on the basis of being contrary to law or morality, or because the patent is frivolous; or

- the complete specification claims as an invention a microbiological process or a product thereof, where the provisions of such have not been complied with.

In *Regents of the University of California v Eurolab (Pty) Ltd and Others* [2025] ZACCP 1, the CCP revoked a pharmaceutical patent under Section 61 (1)(a), holding that Section 27 requires a non-inventor applicant to have acquired the right to apply from all inventors before filing, and found related threats of infringement unjustifiable.

Revocation of a registered design may occur through the following grounds:

- the application for the registration of the design was not made by a person entitled thereto;
- the registration of the design is in fraud of the rights of the applicant or of any person under or through whom he or she claims;
- the design in question is not registrable;
- the application for the registration of the design contains a false statement or representation, which is material and which the registered proprietor knew was false at the time when the statement or representation was made; or
- the application for the registration of the design should have been refused due to a lack of formal compliance.

The grounds for cancellation of a plant breeders' right are as follows:

- any information submitted to the registrar in the application for such a right, or in connection with such an application, was incorrect, and such a right would not have been granted if the registrar had known that the information was incorrect;
- information has come to light that, if discovered earlier, would have resulted in the plant breeders' right being refused;
- priority should be given to any other convention country application for the grant of a plant breeders' right for the same variety;
- the holder of the plant breeders' right refuses, or has failed or is not in a position to, furnish the

registrar with propagating material of the relevant variety;

- the holder of the plant breeders' right has failed to comply with any request from the registrar concerning the facilities maintaining the variety, or has prevented the registrar from undertaking an inspection;
- the holder of the plant breeders' right refuses, has failed or is not in a position to submit a proposal for an alteration or a supplementation of a denomination after having been requested to do so;
- the annual fee was not paid within the period referred to;
- the plant breeders' right has been granted to a person who is not entitled thereto (an applicable ground unless it is transferred to the person who is entitled thereto); or
- the holder of the plant breeders' right is ordered to terminate the plant breeders' right by an order of court.

Any person may apply for the revocation of a patent or registered design at any time, and an interested party may apply to the registrar to cancel the plant breeders' right.

## 4.2 Partial Revocation/Cancellation

Partial revocation of a patent is possible through the finding that certain claims of the specification are invalid. This finding usually occurs through a determination made by the commissioner of patents after revocation proceedings have been instituted. Invalid claims may be excised through amendment.

## 4.3 Amendments in Revocation/Cancellation Proceedings

Amendment of specifications during revocation proceedings is possible. The usual process for amendment during revocation proceedings is to bring an application therefor through motion proceedings. The commissioner has wide discretion to deal with the application as they see fit.

## 4.4 Revocation/Cancellation and Infringement

Revocation proceedings for patents and registered designs are heard first before infringement findings; these proceedings are usually separated but can be heard sequentially.

## 5. Trial and Settlement

### 5.1 Special Procedural Provisions for Intellectual Property Rights

The procedures of the CCP are under the Patent Act and its regulations – specifically infringement and revocation procedures. If no specific procedures are outlined in the Act or regulations, the procedure is that of the High Court. The timelines for revocation proceedings are extensively prescribed by the regulations as follows:

- a person will lodge and serve an application for revocation, and the patent owner will have two months (extendable by agreement or request to registrar) in which to file a counterstatement (plea);
- if a counterstatement is not lodged within two months, the patent is deemed to be revoked;
- within two months of filing the counterstatement, the applicant must file and serve his or her evidence in the form of an affidavit;
- within two months of the applicant filing the evidence affidavit, the patentee may file and serve an answering evidence affidavit;
- within two months of the patentee filing the answering evidence affidavit, the applicant may file and serve replying evidence, whereupon no further evidence shall be filed except with leave; and
- on completion of filing, the applicant may request a hearing date or, if he or she fails to do so within six weeks, the patentee may request a hearing date.

Similarly, the Designs Act and its regulations prescribe the process and timelines in detail. There is typically a single trial hearing per issue, such as revocation and infringement issues, although these may be heard together. In application proceedings, for example an interim interdict, the experts do not testify in person, their evidence is in the form of an affidavit or sworn statement and the matter is heard on paper. In action proceedings, such as for a final interdict and damages, and also in the case of revocation proceedings (a hybrid between application and action proceedings where the expert testimony is in the form of an affidavit but may refer to oral evidence), the expert witness gives oral evidence and may be cross-examined.

Typically, the determination of damages will be separated out from the main hearing and determined at a later stage after infringement has been established.

### 5.2 Decision-Makers

Cases are determined by legal judges, but in the case of plant breeders' rights, the registrar may appoint a panel containing technical and legal experts.

### 5.3 Settling the Case

The parties can at any stage prior to judgment settle the matter or engage in mediation. The judge may also direct the parties to consider mediation at any stage before judgment.

### 5.4 Other Court Proceedings

In South African law, interlocutory applications have the effect of staying the main matter from being heard. Additionally, with patents and designs, the infringement and revocation proceedings may be heard together, typically with revocation proceedings being determined first.

## 6. Remedies

### 6.1 Remedies for the Patentee

Interim (provisional) damages are focused on personal injury claims and, in general, punitive damages are not recoverable under South African patent law. However, there is (although it is extremely unlikely) the possibility of constitutional damages in general and additional damages in cases of flagrant infringement of copyright, which can be seen as punitive.

Litigation costs may be awarded, in order of increasing value, for a no costs order, on a party-party scale, on an attorney-client scale and as an order of costs *de bonis propriis* (which is a sanction punishing the attorney for “despicable behaviour”). Costs may be taxed at the applicable court rate, and the taxing master may allow special rates for exceptionally complex technical matters. Regardless, the typical recovered costs are around one-third of the actual litigation costs.

If a party disregards an order of court, they will be in contempt of court, which is a crime and enforceable

as such. A party may make an application to the court or an alternative order enforcing the outcome.

## 6.2 Rights of Prevailing Defendants

With patents and registered designs, there is, in addition to costs, a remedy against groundless threats of infringement, which includes a declaratory order, an interdict and the ability to recover damages arising from the baseless threat of infringement.

## 6.3 Types of Remedies

Apart from the remedies mentioned in the foregoing, criminal sanctions are possible with copyright infringement, and the new Plant Breeders' Rights Act introduces criminal sanctions for infringement.

## 6.4 Injunctions Pending Appeal

The usual practice is to apply for an interim interdict by way of motion proceedings, pending an action for final interdict and damages/reasonable royalty. Conventionally, an interim interdict is not appealable as it is not final in effect, but recently it has been found that if an interim interdict has a final effect in practice, an appeal may be allowed. If a final interdict is granted by way of an action, a subsequent appeal will suspend the working of the interdict pending the final outcome of the appeal.

## 7. Appeal

### 7.1 Special Provisions for Intellectual Property Proceedings

In the case of patents and designs, an appeal is possible from the CCP to a full bench of the High Court, or directly to the SCA, and a further appeal to the CC is possible. In the case of plant breeders' rights, a decision of the registrar may be appealed to the appeal board, and then to the High Court followed by a full bench of the High Court, or directly to the SCA. Further appeal to the CC is possible.

### 7.2 Type of Review

An appeal will review the facts of the case as forming part of the record. Usually, no facts outside the record are considered.

## 8. Costs

### 8.1 Costs Before Filing a Lawsuit

The cost before filing a lawsuit typically involves an opinion on the validity and/or infringement, which would be based on a prior art search and interpretation of claims, and an interpretation of the infringing items. Following that, letters of demand are usually sent before the preparation and filing of the lawsuit.

### 8.2 Calculation of Court Fees

There are no court fees as such, and the fees are calculated based on the professional hourly fees of the patent attorney and advocate (ie, solicitors and barristers) and the hourly fee of the expert witnesses.

### 8.3 Responsibility for Paying the Costs of Litigation

There are no court fees as such. The party who is not successful in instituting the defending court proceedings is liable to pay the tax cost dependent on the costs order made by the court, which may include the costs of one or two counsel and expert witness fees.

## 9. Alternative Dispute Resolution

### 9.1 Type of Actions for Intellectual Property

Alternative dispute resolution is not a common way of settling an intellectual property case, although there are sufficient mechanisms available to avail oneself of this procedure. It is typically not in a respondent's or defendant's interest to follow alternative dispute resolution.

## 10. Assignment and Licensing

### 10.1 Requirements or Restrictions for Assignment of Intellectual Property Rights

Assignments must be in writing, but there is no requirement to be registered (but this is then only valid between parties). An application to record an assignment must be made within six months of the date thereof, but it is possible to file a request for a time extension. Approval from the Reserve Bank of South Africa needs to be obtained if assignment occurs from a South African entity to a foreign entity.

## **10.2 Procedure for Assigning an Intellectual Property Right**

An assignment agreement signed by the parties is registered at the Patent Office by filing a P16 form and paying the prescribed official fee. The assignment is recorded in the patent register as evidence of said assignment.

## **10.3 Requirements or Restrictions to License an Intellectual Property Right**

There are certain statutory restrictions to licensing agreements concerning patents. In effect, these restrictions are aimed at preventing unfair and anti-competitive licensing practices.

## **10.4 Procedure for Licensing an Intellectual Property Right**

There are different types of licence agreements, and licences can be recorded at the Patent Office and shown in the patent register by filing the requisite form and paying the prescribed official fee. An application to record a licence must be made within six months of the date thereof, but it is possible to file a request for a time extension.

With plant breeders' rights, a deed of record of the licence must be filed within 30 days, and in case of copyright, exclusive licences must be in writing.

## Trends and Developments

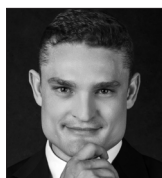
### Contributed by:

Tim Laurens and Ursula Baravalle  
**KISCH IP**

**KISCH IP** is a multinational group with experts in intellectual property (IP) law, taxation and commercial law services. Clients are assured that their innovations, finances and corporate assets are attended to at the highest professional standards. KISCH IP serves as a

key partner for international and regional entities, and for local companies seeking to enter African markets. The lawyers fulfil their clients' needs while continually growing and protecting clients' personalised IP, commercial and tax portfolios.

## Authors



**Tim Laurens** is a multifaceted patent attorney and attorney of the High Court of South Africa with a strong blend of technical and legal expertise. A senior associate at KISCH IP, he focuses on patent and design

prosecution, drawing on his chemical engineering background to draft patents in chemistry, chemical processes, pharmaceuticals, blockchain and software technologies. He is equally engaged in the commercialisation of intellectual property, particularly patents, and has litigation experience in unlawful competition involving confidential information, trade secrets and restraint-of-trade disputes. Holding an LL.M in Medical Law (cum laude), Tim combines technical insight with legal precision and maintains a keen interest in the intersection of IP, technology and commercial law.



**Ursula Baravalle** is head of the patent department of KISCH IP. She has more than 20 years' experience in the drafting and prosecution of local and international patent applications filed in the chemical, petrochemical,

pharmaceutical, microbiological and biochemical fields. She assists a leading petrochemical company with the drafting and prosecution of their local and international Fischer Tropsch patent portfolios and oligomerisation, tetramerisation and trimerisation patent portfolios. Ursula also assists with the drafting of patent validity, infringement and patentability opinions, including on the validity and infringement of design registrations. Her experience encompasses methods for treatment claims, Swiss-type claims and second medical use claims, and the allowability of these claims in South Africa.

---

## KISCH IP

5 Inanda Greens Business Park  
54 Wierda Road West  
Wierda Valley  
Sandton  
Johannesburg 2146  
South Africa

Tel: +27 113 243 000  
Fax: +27 866 036 118  
Email: [info@kisch-ip.com](mailto:info@kisch-ip.com)  
Web: [www.kisch-ip.com](http://www.kisch-ip.com)



## South African Patent And Design Law: Reform, Enforcement And Practical Risk

### *A system on the brink of structural change*

South Africa's patent and design landscape is in the middle of a major reset. The South African legislator has confirmed that a new Patents Bill and a Designs Amendment Bill will be placed before Parliament, with public consultation expected in 2026. [These bills](#) are intended to modernise the system, align it with international standards and make it more accessible to local innovators.

At the same time, recent court decisions have sharpened litigation risk in several areas: entitlement to apply for a patent, the value of registered designs and the limits of using anti-counterfeiting law against parallel imports. New sector-specific regimes, such as the updated plant breeders' rights framework and the World Intellectual Property Organization (WIPO) treaty on genetic resources and traditional knowledge, add further complexity.

For clients doing business in South Africa, this combination of legislative reform and case law means that technical IP rights can no longer be treated as "file and forget" assets. Entitlement, drafting quality, portfolio mix and litigation strategy all need to be revisited.

### *From depository rights to examined assets*

#### *Substantive search and examination*

Historically, South African patents have been granted on a depository basis: that is, if the formalities were correct and the fees paid, a patent was granted without any real check on novelty or inventive step. The forthcoming Patents Bill will change that by introducing substantive [search and examination \(SSE\)](#) in phases.

The proposed system will offer the following:

- a move from automatic grant to quality-focused examination, initially in fields like chemistry, bio-chemistry, ICT, physics and engineering;
- publication of applications and a window for third-party observations before or during examination; and
- a requirement to request examination within set time limits, timed so that applicants can align

South African claims with examined counterparts elsewhere.

For rights holders, this will front-load a portion of the validity debate that, until now, typically played out only in revocation or infringement proceedings. For challengers, it creates earlier and cheaper opportunities to attack weak patents before they ever reach the courtroom.<sup>2</sup>

### *Utility models and a more layered system*

The Patents Bill is expected to introduce [utility models](#) (a "second-tier" right) for incremental inventions that may not meet the full inventive-step threshold but are still new and industrially applicable.

This has several practical implications:

- local innovators, especially SMEs, will have access to simpler, cheaper protection for practical improvements;
- some subject matter that is currently protected as "functional designs" will move into the utility-model space, changing how portfolios are structured; and
- litigation over incremental technologies may increasingly involve utility models and patents side by side, with different validity thresholds and term lengths in play.

Large multinationals will need to decide when to rely on patents, when to add utility models and when to use both. Local businesses may find that utility models offer a more realistic route into litigation-grade protection.

### *Opposition and a new administrative layer*

For the first time, South Africa plans to introduce post-grant opposition procedures as well as a more formal pre-grant opposition framework. The Patents Bill and the Designs Amendment Bill envisage:

- third-party observations after publication and before examination;
- post-grant opposition within a defined period (for example, six or 12 months), on limited grounds; and

Contributed by: Tim Laurens and Ursula Baravalle, KISCH IP

- a new administrative tribunal to deal with compulsory licences and certain oppositions, with recourse to the courts via appeal or review.

The upshot is a more layered dispute resolution system. Some fights that would previously have gone straight to the High Court may now start in a specialist administrative forum, with reduced cost and a more flexible procedure. For businesses, that means watching competitor filings far more closely and deciding strategically whether to oppose, negotiate or wait.

### *Modernising design law*

#### *Functional designs, opposition and international alignment*

Designs are also undergoing a rethink. The Designs Amendment Bill aims to update the 1993 Act so that it works alongside the new Patents Bill and prepares South Africa for accession to the Hague Agreement and possible alignment with the Riyadh Design Law Treaty.

The reforms are expected to:

- remove functional designs from the Designs Act, with those technical features instead protected via patents or utility models;
- introduce an opposition period for design registrations, even though designs will not be substantively examined on their merits; and
- extend disclosure requirements to designs that incorporate indigenous cultural expressions.

From a practical standpoint, clients will have a new tool: early opposition to problem designs, which can be quicker and cheaper than full litigation. At the same time, design owners will need to think carefully about how they describe and represent their designs, given the growing emphasis on cultural and traditional knowledge disclosures.

#### *Balser Jan Nienhuis v Africo Solar: design rights as a commercial weapon*

Recent case law has underlined that registered designs are not a poor cousin to patents. In *Balser Jan Nienhuis v Africo Solar (Pty) Ltd*, the dispute centred on registered designs for brackets used to mount solar panels on different roofs. The respondent

argued that because the brackets could also be used for other purposes, they fell outside the class in which the designs were registered. The [court disagreed](#) and found infringement.

Two practical messages stand out from commentary on this case:

- the court confirmed that class designation is not a loophole for copyists – if a competing product falls within the registered class and closely embodies the design, it can infringe even if it has other uses; and
- the test is not strict identity, but whether the competing article is “not substantially different” to the registered design in the eyes of the notional user.

For businesses in sectors like solar hardware, furniture, packaging, consumer products and automotive parts, this is a clear signal that well-drafted design registrations can be decisive. They are relatively fast and cost-effective to obtain and provide a strong deterrent against look-alike products.

#### *Entitlement and chain-of-title risk: Regents v Eurolab*

The Court of the Commissioner of Patents’ decision in [Regents of the University of California and Others v Eurolab \(Pty\) Ltd and Others](#) [2025] ZACCP 1 is one of the most important entitlement cases in years.

The patent in issue related to a prostate cancer treatment. Eurolab, a local generics company, challenged the patent and sought relief for groundless threats of infringement, arguing that the patentee had never properly acquired the right to apply for the patent from all the inventors. The [Commissioner agreed](#) and held that:

- where the applicant is not the inventor, it must have acquired the right to apply from the inventors before filing the South African application;
- attempts to “fix” the chain of title after filing did not cure the defect in this case; and
- because the patent was invalid for lack of entitlement, the threats of infringement were groundless, and Eurolab was entitled to corresponding relief.

Contributed by: Tim Laurens and Ursula Baravalle, KISCH IP

For patent owners, the litigation lesson is straightforward but far-reaching.

- In collaborative and cross-border projects, entitlement can no longer be treated as a formality. Every link in the chain, from individual inventors to universities, research institutes, funders and licensees, must be documented before filing in South Africa.
- Aggressive enforcement campaigns, especially against generics, carry a real risk that the first response will be an entitlement-based revocation attempt coupled with a groundless threats claim.

Given that the future Patents Bill will also tighten quality standards via examination and oppositions, entitlement and validity will sit side by side as key litigation risk points. Many sophisticated patentees are already auditing entitlement for their highest-value South African patents before asserting them.

### *Infringement and design-around strategies: Timrite v Vesper*

The second 2025 decision of the Commissioner of Patents,

[Timrite \(Pty\) Ltd and Another v Vesper Projects \(Pty\) Ltd and Another](#) [2025] ZACCP 2, dealt with mine support “bags” used in underground operations. The patentee alleged that the Vesper bag infringed its patent; the court disagreed, finding that the Vesper product differed in important technical respects.

Although the details are technical, two general themes emerge from case reports and commentary.

- South African courts remain committed to a claim-based, purposive approach to infringement. Clever engineering differences that genuinely avoid the language and purpose of the claims can succeed.
- Expert evidence is critical: The court leaned heavily on how a skilled person in the field would understand both the claims and the technical differences between the products.

For defendants, *Timrite* illustrates that a well-planned design-around, backed by evidence, can be an effective way to manage patent risk. For patentees,

it emphasises the importance of clear drafting and strategic amendments that do not unduly narrow the scope of protection.

### *Counterfeit goods, parallel imports and the Enrico Coveri ruling*

In a separate development, the Supreme Court of Appeal’s decision in the *Enrico Coveri* trade mark case has reshaped how rights holders think about customs seizures and parallel imports. The court held that authentic designer goods [cannot be treated as “counterfeit”](#) simply because they were imported without the local trade mark owner’s consent.

While the case turned on trade mark and counterfeit-goods legislation, it has knock-on effects for patent and design owners.

- Genuine products sourced overseas are less likely to be stopped at the border as “counterfeit”. Rights owners will need to rely more directly on patent, design and trade mark infringement claims where parallel imports infringe their IP.
- Parallel importers with robust evidence of authenticity now have a stronger position, although they remain exposed if they infringe a South African patent or design.

The practical takeaway is that customs and anti-counterfeit actions should be seen as part of a broader enforcement mix, rather than the primary tool. In design-driven industries, registered designs are increasingly important in structuring that mix.

### *Sector focus: plant breeders’ rights and biodiversity*

#### *New Plant Breeders’ Rights Act*

On 1 June 2025, South Africa’s [Plant Breeders’ Rights Act 12 of 2018](#) finally [came into force](#), replacing the 1976 Act. The new regime is aligned with the International Union for the Protection of New Varieties of Plants (*Union internationale pour la protection des obtentions végétales* UPOV) 1991 Act and significantly upgrades the protection available for new plant varieties.

Among others, important changes include the following:

- protection now extends to all plant genera and species, not only those listed from time to time;
- the term of protection is extended (up to 30 years for some varieties);
- the Act introduces detailed rules on farm-saved seed, including categories of farmers and conditions under which saved seed can be used; and
- infringement can constitute a criminal offence, with potentially severe penalties.

For seed companies, agri-biotech firms and investors, this creates a more powerful set of rights and remedies, often used in tandem with patents that cover traits, enabling technologies or methods. For farmers and co-operatives, it raises the stakes of non-compliance and makes it essential to understand licence terms and statutory exemptions.

### *Genetic resources and traditional knowledge*

South Africa is also preparing to implement the [WIPO Treaty on Intellectual Property, Genetic Resources and Associated Traditional Knowledge](#), adopted in 2024. The treaty is expressly referenced in commentary on the Patents Bill and in practitioner analysis.

Under this framework, patent applicants who use genetic resources or associated traditional knowledge will likely be required to:

- disclose the country of origin of the genetic resources, or the source if the origin is unknown; and
- identify relevant indigenous communities or other holders of traditional knowledge, or the source of that knowledge.

This sits alongside existing biodiversity and bio-prospecting rules under national environmental legislation. In litigation, non-compliance with disclosure and benefit-sharing obligations may become a validity and enforcement issue, particularly for pharmaceuticals, nutraceuticals, cosmetics and agro-biotech products. Businesses in these sectors should already be documenting their sourcing and benefit-sharing arrangements with a view to future court scrutiny.

### *Filing trends: foreign dominance and local innovation headwinds*

Recent filing data show a widening gap between foreign and local patent activity. An [analysis of South African patent filings for 2024](#) indicates that provisional applications, which are typically filed by South African residents and serve as a barometer of local R&D activity, are still around 40% below pre-pandemic levels.

By contrast, complete patent filings (including convention and Patent Cooperation Treaty (PCT) national-phase entries) have grown by roughly a third since 2020, largely driven by non-resident applicants. A significant portion of this growth comes from Chinese, US, UK and Indian patentees.

These trends have several implications:

- South African courts are likely to continue hearing disputes that involve foreign-owned patents enforced against local manufacturers and distributors;
- domestic businesses risk being predominantly on the defensive side of patent litigation unless local innovation activity and filings recover; and
- the introduction of utility models and small-entity fee structures is deliberately aimed at reversing this trend by making protection more accessible for local innovators.

For multinational clients, this means that South Africa remains a meaningful enforcement venue, but one operating in a politically and socially sensitive environment, particularly when patents intersect with public health or essential infrastructure.

### *Practical action points for businesses*

Given these trends and developments, businesses operating in or through South Africa should consider the following practical steps.

- Clean up entitlement and assignment chains:
  - (a) audit key patents and applications to confirm that the applicant had acquired the right to apply from all inventors before filing, particularly in collaborative or cross-border projects; and
  - (b) resolve gaps proactively rather than waiting for a challenge in litigation, and ensure that future

- projects build entitlement checks into their standard R&D and filing workflows.
- Prepare portfolios for SSE and opposition:
  - (a) draft South African applications on the assumption that examiners and third parties will scrutinise novelty and inventive step; and
  - (b) monitor competitor filings and be ready to use pre- and post-grant opposition and third-party observations strategically, especially in concentrated technology areas.
- Use designs as a front-line tool:
  - (a) for products where visual appearance or configuration drives market differentiation, such as solar hardware, furniture, packaging and consumer goods, treat registered designs as core assets, not afterthoughts; and
  - (b) ensure that class selection, representations and specifications are carefully prepared so that enforcement, if needed, is straightforward.
- Align agri-tech strategies with the new plant breeders' regime:
  - (a) breeders should review their licensing, labelling and farm-saved seed policies to align with the new Plant Breeders' Rights Act, noting its extended terms and potential criminal remedies; and
  - (b) producers and downstream players should ensure that their sourcing and multiplication practices comply with the new rules to avoid inadvertent infringement.
- Build biodiversity and traditional knowledge compliance into R&D:
  - (a) map any reliance on genetic resources or associated traditional knowledge, and integrate disclosure and benefit-sharing considerations into early stage project design; and
  - (b) keep a clear documentary record that can be deployed in future oppositions or court proceedings if the validity of patents is challenged on these grounds.
- Recalibrate enforcement and defence strategies:
  - (a) in light of the *Enrico Coveri* decision, recognise that anti-counterfeit measures are not a catch-all solution to parallel import concerns – instead, combine trade marks with patents, designs and contractual controls in a co-ordinated way; and
  - (b) when launching in South Africa, build in freedom-to-operate and design-around analysis to anticipate how courts are likely to apply claim construction and design-infringement tests.
- Factor South Africa into global tech and standard-essential patent (SEP) strategies:
  - (a) SEP holders and implementers should treat South Africa as a [genuine litigation and negotiation venue](#), not just as a peripheral market; and
  - (b) AI-driven businesses should be alive to the potential for class actions in IP-relevant contexts under [Rule 11A](#).

South Africa is moving from a relatively formalistic, low-scrutiny regime towards a more examined, opposable and procedurally sophisticated system. For clients, that creates both new risks and new opportunities. Those who invest early in entitlement hygiene, smart portfolio design and litigation-ready strategies will be best placed to navigate – and capitalise on – this new landscape.

---

## CHAMBERS GLOBAL PRACTICE GUIDES

---

Chambers Global Practice Guides bring you up-to-date, expert legal commentary on the main practice areas from around the globe. Focusing on the practical legal issues affecting businesses, the guides enable readers to compare legislation and procedure and read trend forecasts from legal experts from across key jurisdictions.

To find out more information about how we select contributors, email [Rob.Thomson@chambers.com](mailto:Rob.Thomson@chambers.com)