

REPUBLIC OF SOUTH AFRICA

INTELLECTUAL PROPERTY LAWS AMENDMENT BILL

(As amended by the Portfolio Committee on Trade and Industry (National Assembly))

(MINISTER OF TRADE AND INDUSTRY)

[B 1B—97]

REPUBLIEK VAN SUID-AFRIKA

WYSIGINGSWETSONTWERP OP INTELLEKTUELE GOEDEREWETTE

(Soos gewysig deur die Portefeuljekomitee oor Handel en Nywerheid (Nasionale Vergadering))

(MINISTER VAN HANDEL EN NYWERHEID)

[W 1B—97]

ISBN 0 621 27195 0

[] Words in bold type in square brackets indicate omissions from existing enactments.

 Words underlined with a solid line indicate insertions in existing enactments.

To amend the Merchandise Marks Act, 1941, so as to substitute, to delete or to amend certain definitions; to define certain expressions; to repeal the provisions relating to the unlawful trading in counterfeit goods in so far as these provisions are to be superseded by other envisaged legislation regarding the counterfeiting of goods; to adjust the powers of inspectors to enter and search premises and attach goods; to substitute or delete certain obsolete provisions and references; to delete a provision imposing a burden of proof on an accused; to provide for a presumption with respect to the offence of offering for sale or hire goods to which any false trade description is applied; and to adjust the provisions regarding penalties for offences; to amend the Performers' Protection Act, 1967, so as to delete or to amend certain definitions; to define certain expressions; to protect performances in countries which are members of the World Trade Organization; to lengthen the term of protection for performances to fifty years; to provide for all broadcasters; to adjust the provisions regarding penalties for offences; and to extend the application of the Act to performances which took place before its commencement to correspond with the Agreement on Trade Related Aspects of Intellectual Property Rights (the TRIPS Agreement); to amend the Patents Act, 1978, so as to define certain expressions; to amend or to substitute certain definitions; to clarify the provisions with respect to the payment of renewal fees, the priority dates of matter as opposed to patent claims, the principle of privilege regarding communications by or to patent agents and the assessment of damages; to bring the Act in line with the Trade Marks Act, 1993, the Designs Act, 1993, and the TRIPS Agreement; to provide for the implementation of the Patent Cooperation Treaty in the event of South Africa's accession thereto; to effect a correction in the Afrikaans text; to repeal or amend certain obsolete provisions and references; and to amend the long title; to amend the Copyright Act, 1978, so as to substitute, to amend or to delete certain definitions; to elaborate the requirement that a work must exist in a material form to qualify for copyright; to adjust the term of copyright in a cinematograph film and to extend the scope of copyright in computer programs in view of the TRIPS Agreement; to provide for all broadcasters; to amend the provisions relating to damages and other compensation for the infringement of copyright in order that it corresponds with the Trade Marks Act, 1993, and the Designs Act, 1993; and to substitute a certain word in the Afrikaans text; to amend the Trade Marks Act, 1993, so as to amend the provisions regarding marks that may not be registered as trade marks and those regarding the protection of well-known trade marks to ensure compliance with the TRIPS Agreement and Article 6ter of the Paris Convention; to effect a correction in the English text; to further regulate the relief for the infringement of registered trade marks; to provide that the registrar must keep a list of emblems of convention countries and international organisations; and to replace an incorrect reference; to amend the Designs Act, 1993, so as to define an expression; to delete a definition; to adjust the

requirements for the registration of a design; to amend the provisions regarding the notification of registration and the certificate of registration; to adjust the provisions regarding compulsory licences in respect of certain registered designs and to further regulate the effect of the registration of a design and the amendment of an application for registration, and of a registration of a design, to ensure compliance with the TRIPS Agreement; and to correct or to clarify certain provisions; and to provide for matters connected therewith.

BE IT ENACTED by the Parliament of the Republic of South Africa, as follows:—

CONTENTS OF ACT

Sections 1—18:	Amendment of Merchandise Marks Act, 1941	
Sections 19—25:	Amendment of Performers' Protection Act, 1967	5
Sections 26—49:	Amendment of Patents Act, 1978	
Sections 50—58:	Amendment of Copyright Act, 1978	
Sections 59—68:	Amendment of Trade Marks Act, 1993	
Sections 69—79:	Amendment of Designs Act, 1993	
Section 80:	Short title and commencement	10

Amendment of section 1 of Act 17 of 1941, as amended by section 1 of Act 39 of 1952, section 1 of Act 47 of 1954 and section 1 of Act 54 of 1987

1. Section 1 of the Merchandise Marks Act, 1941, is hereby amended—
 - (a) by the substitution for the definition of “apply to” for the following definition:

“ ‘apply to’ means emboss, impress, engrave, etch or print upon or weave into or otherwise—

(a) work into or onto;

(b) annex or affix to; or

(c) incorporate in;”;
 - (b) by the deletion of the definition of “bottle”; 20
 - (c) by the insertion after the definition of “covering” of the following definitions:

“ ‘device’ means any visual representation or illustration capable of being reproduced upon a surface, whether by printing or otherwise;

‘document’ means recorded information regardless of form or medium;”;
 - (d) by the substitution for the definition of “false trade description” of the following definition:

“ ‘false trade description’ means any trade description [**whether or not it consists of or includes a trade mark or part of a trade mark**] which is false in a material respect as regards the goods to which it is applied, and includes every alteration of a trade description, whether by way of addition, effacement or otherwise, if that alteration makes the description false in a material respect;”;
 - (e) by the deletion of the definition of “Gazette”; 30
 - (f) by the substitution for the definition of “inspector” of the following definition: 35

“ ‘inspector’ means—

- (a) any member as defined in section 1 of the South African Police Service Act, 1995 (Act No. 68 of 1995), of or above the rank of sergeant;
- (b) the Commissioner for Customs and Excise or any officer as defined in section 1(1) of the Customs and Excise Act, 1964 (Act No. 91 of 1964);
- (c) any officer appointed under section 3;”;
- (g) by the substitution for the definition of “Minister” of the following definition:
 - “ ‘Minister’ means the Minister of **[Economic Affairs and Technology, or any other Minister to whom the State President has assigned the administration of this Act, or any other Minister acting on behalf of any such Minister]** Trade and Industry;”;
- (h) by the deletion of the definition of “police officer”;
- (i) by the insertion before the definition of “sell” of the following definition:
 - “ ‘premises’ includes land, any building or structure, or any vehicle, ship, boat or aircraft or other conveyance;”;
- (j) by the deletion of the definition of “Territory”;
- (k) by the substitution for the definition of “trade mark” of the following definition:
 - “ ‘trade mark’ means a registered trade mark **[registered in the register of trade marks kept under] as defined in section 2(1) of the [Patents, Designs, Trade Marks and Copyright Act, 1916 (Act No. 9 of 1916), or the Patents, Designs, Trade Marks and Copyright Proclamation, 1923 (Proclamation No. 17 of 1923 of the Territory) or an amendment thereof]** Trade Marks Act, 1993 (Act No. 194 of 1993).”; and
- (l) by the deletion of the definition of “Union”.

Substitution of section 2 of Act 17 of 1941

2. The following section is hereby substituted for section 2 of the Merchandise Marks Act, 1941:

“What acts amount to applying trade description

2.(1) A person shall be deemed to apply a **[trade mark or]** trade description to goods who—

- (a) applies it to the goods themselves; or
- (b) applies it to any covering, label or reel in or with which the goods are sold; or
- (c) places, encloses or annexes the goods in, with or to any covering, label, reel or other thing to which that **[trade mark or]** trade description has been applied; or
- (d) uses in connection with the goods a **[trade mark or]** trade description in such manner as to be likely to lead to the belief that the goods are designated or described by that **[mark or]** description.

(2) Goods delivered in pursuance of an offer or request in which reference is made to a trade description contained in any sign, advertisement, invoice, wine list, business letter, business paper or other commercial communication, shall, for the purposes of paragraph (d) of subsection (1), be deemed to be goods in connection with which that trade description is used.

[(3) A person shall be deemed to forge a trade mark who—

- (a) without the assent of the registered proprietor of that trade mark makes that trade mark or a mark so nearly resembling it as to be likely to deceive; or
- (b) alters, adds to or effaces any genuine trade mark.

(4) A person shall be deemed falsely to apply to goods a trade mark

who, without the assent of the registered proprietor of that trade mark, applies to goods that trade mark or a mark so nearly resembling it as to be likely to deceive.]

(5) Any person who sells goods which having been used have been reconditioned, rebuilt or remade, whether in the [Union] Republic or elsewhere, and which bear the trade mark of the original maker or seller of the goods, shall, unless there is applied to them in a conspicuous manner words stating clearly that the goods have been reconditioned, rebuilt or remade, as the case may be, be deemed to [have falsely applied the said trade mark] apply a false trade description to the goods.

(6) Any person who applies to goods any [such] word, name, letter, figure or mark, or arrangement or combination thereof, [whether consisting of or including] other than a trade mark [or part of a trade mark or not], as is likely to lead to the belief that the goods are the manufacture or merchandise of some person other than the person whose manufacture or merchandise they really are, shall be deemed to apply a false description to the goods.”.

Substitution of section 3 of Act 17 of 1941

3. The following section is hereby substituted for section 3 of the Merchandise Marks Act, 1941:

“Appointment of officers

3. Subject to the laws governing the public service, the Minister may appoint such [inspectors] officers as he or she may deem necessary for carrying out the provisions of this Act.”.

Substitution of section 4 of Act 17 of 1941, as amended by section 2 of Act 47 of 1954

4. The following section is hereby substituted for section 4 of the Merchandise Marks Act, 1941:

“Powers of inspectors to enter and search premises and seize certain articles

4. (1) If an inspector suspects that an offence in terms of this Act has been committed, is being or is likely to be committed or that preparations or arrangements for the commission of an offence in terms of this Act are being or are likely to be made on or in any premises (in this section referred to as the “alleged offence”), he or she may, on the authority of a warrant issued under subsection (3)—

- (a) enter the premises and search the premises or the person referred to in the warrant or the owner or person in control of the premises, and there make, subject to subsection (2), the enquiries he or she considers necessary;
- (b) examine any document or thing found on or in the premises, and make copies of or make extracts from that document;
- (c) subject to subsection (2), request the owner or person in control of the premises or any person in whose possession or control that document or thing is, or who may reasonably be expected to have the necessary information, to furnish information regarding that document or thing;
- (d) seize for further examination or safe custody any document or thing on or in the premises which has a bearing on the alleged offence;
- (e) seal or otherwise safeguard any premises on or in which any document or thing which has a bearing on an alleged offence is found;
- (f) take the steps that he or she considers necessary to terminate or prevent the commission of an offence in terms of this Act.

- (2) An inspector requesting information from a person in terms of subsection (1)(a) or (c) or (4)(a) shall, before so requesting information, inform the person in a language that the person understands of—
- (a) the right to remain silent; and
 - (b) the consequences of not remaining silent. 5
- (3) (a) A warrant referred to in subsection (1) shall be issued by a magistrate or a judge of a High Court, if it appears to the magistrate or judge from information on oath or affirmation that there are reasonable grounds for believing that a document or thing that has a bearing on the alleged offence— 10
- (i) is or will be in the possession or under the control of any person or on or in any premises within the area of jurisdiction of that magistrate or judge; and
 - (ii) cannot reasonably be obtained otherwise. 15
- (b) The warrant shall specify which of the acts contemplated in subsection (1)(a) to (f) may be performed thereunder by the inspector to whom it is issued.
- (c) The warrant may be issued on any day and shall be of force until—
- (i) it is executed;
 - (ii) it is cancelled by the person who issued it or, if such person is not available, by any person with similar authority; 20
 - (iii) the expiry of three months from the day of its issue; or
 - (iv) the purpose for which the warrant was issued no longer exists, whichever may occur first.
- (d) An inspector shall, immediately before commencing the execution of the warrant— 25
- (i) identify himself or herself to the person referred to in the warrant or the owner or person in control of the premises, if such person is present;
 - (ii) hand to such person a copy of the warrant or, if the person is not present, affix that copy to a prominent place on the premises; 30
 - (iii) supply such person at his or her request with particulars regarding his or her authority to execute the warrant.
- (4) (a) Subject to paragraph (b) of this subsection and subsections (2) and (5) to (10), any inspector may, without a warrant— 35
- (i) enter any premises, if the person who is competent to do so consents to that entry, and perform such of the acts contemplated in subsection (1)(a) to (f) which the person who is competent to do so consents to; or
 - (ii) enter any premises other than a private dwelling and perform any of the acts contemplated in subsection (1)(a) to (f), except the search of any person, if there are reasonable grounds for believing that— 40
- (aa) a warrant would be issued to the inspector under subsection (3) if the inspector were to apply for that warrant; and
 - (bb) the delay in obtaining that warrant would defeat the purpose of the entry. 45
- (b) An inspector shall, immediately before entering premises in accordance with paragraph (a), identify himself or herself.
- (c) Any acts performed by an inspector by virtue of paragraph (a)(ii) will cease to have any legal effect unless a magistrate or a judge of a High Court having jurisdiction in the area where the acts were performed, confirms those acts on the application of an inspector brought within 10 days of the day on which those acts had been performed. 50
- (5) An entry, search and seizure under this section shall be—
- (a) conducted with strict regard to decency and order, including the protection of a person's right to dignity, to freedom and security and to privacy; and 55
 - (b) executed by day unless the execution thereof by night is justifiable and necessary.

- (6) The seizure of a document or thing under this section shall be effected by removing it from the premises concerned or, if that removal is not reasonably practicable, by sealing or otherwise safeguarding it on or in the premises.
- (7) An inspector who may under this section enter and search any premises—
- (a) shall, immediately before the entry, audibly demand admission to the premises and make known the purpose of the entry and search, unless there are reasonable grounds for believing that a document or thing in respect of which the search occurs, may be destroyed, disposed of or tampered with if that admission is first demanded and that purpose is made known; 5
 - (b) may use the force that is reasonably necessary to overcome resistance to the entry or search or the seizure of a document or thing under this section; 10
 - (c) may utilize or request the assistance of any person to identify any document or thing which has a bearing on the alleged offence or to otherwise conduct the entry or search or the seizure of any document or thing under this section. 15
- (8) A person from whose possession or control a document has been removed under this section may, at his or her own expense and under the supervision of an inspector, make copies thereof or excerpts therefrom. 20
- (9) (a) An inspector who removes a document or thing from any premises under this section shall issue a receipt to the person who is the owner or in possession or in control thereof or, if that person is not present, affix it to a prominent place on the premises. 25
- (b) If an inspector who is not a member of the South African Police Service removes a document or thing under this section, he or she shall forthwith hand it over to any member of that Police Service.
- (10) (a) If, during the conduct of a search under this section, a person claims that a document or thing found on or in the premises contains privileged information and refuses the examination or removal of the document or thing, the inspector conducting the search shall, if he or she is of the opinion that the document or thing contains information which has a bearing on the alleged offence, request the registrar of the High Court which has jurisdiction or his or her delegate, to seize the document or thing for safe custody until a court of law has made a ruling on the question whether the information is privileged or not. 30
- (b) If that information is held not to be privileged, the document or thing concerned shall be available for inspection and testing or analysis under subsection (12). 35
- (11) Subject to subsections (12) to (15), any document or thing seized under this section shall be disposed of in accordance with the applicable provisions of the Criminal Procedure Act, 1977 (Act No. 51 of 1977), as if it has been seized in terms of that Act. 40
- (12) Subject to subsection (10), a document or thing seized under this section shall—
- (a) be open for inspection by any interested person during normal office hours; 45
 - (b) on request of any interested person, be made available for testing or analysis, if the person in whose custody the document or thing is kept or any inspector is satisfied, after taking into account the nature of the document or thing and of the testing or analysis, the purpose of the testing or analysis and the suitability of the person by whom the testing or analysis is to be conducted, that the request is reasonable. 50
- (13) (a) If criminal proceedings are not instituted in connection with a document or thing seized under this section within a reasonable time after the seizure or, if it appears that the document or thing is not required in 55

criminal proceedings for the purposes of evidence or an order of court, it shall—

(i) subject to paragraph (b), be returned to the person from whom it was seized or, if that person may not lawfully possess it, to the person who may lawfully possess it; or

(ii) be released from the safeguarding on or in the relevant premises, as the case may be.

(b) The person in whose custody the document or thing is kept, shall 72 hours before the return notify every complainant (if any) in respect of the alleged offence to which the document or thing relates of the intended return of the document or thing.

(14) In criminal proceedings in connection with a document or thing seized under this section, the court concerned may, without limiting any other powers of the court, order that—

(a) if the document or thing is the subject of an offence in terms of this Act, it be destroyed;

(b) the document or thing be released to a specified person.

(15) When a court holds that imported goods which are destined for exportation and were seized under this section are the subject of an offence in terms of this Act, the court shall not allow the exportation of those goods in an unaltered state, except if it, after due regard to the circumstances regarding the offence, thinks it fit to allow that exportation.”.

Substitution of section 5 of Act 17 of 1941

5. The following section is hereby substituted for section 5 of the Merchandise Marks Act, 1941:

“Obstruction of inspectors

5. Any person who—

(a) hinders or obstructs an inspector in the performance of any of his or her functions in terms of section 4;

(b) refuses or fails without valid reason to—

(i) answer to the best of his or her ability, a question put to him or her by an inspector; or

(ii) furnish information to an inspector, after having been required to do so in terms of section 4; or

(c) wilfully furnishes false or misleading information to an inspector, shall be guilty of an offence.”.

Substitution of section 6 of Act 17 of 1941, as amended by section 1 of Act 26 of 1951

6. The following section is hereby substituted for section 6 of the Merchandise Marks Act, 1941:

“Applying false trade description

6. (1) Any person who applies any false trade description to goods shall be guilty of an offence, if—

(a) at the time of the commission of the alleged offence, the person knew or had reason to suspect that the trade description was not genuine; or

(b) the person did not take all reasonable steps in order to avoid the commission of the alleged offence.

(2) Any person who alters any trade mark, whether by addition of effacement or in any other manner, shall be guilty of an offence, if the person did not take all reasonable steps in order to avoid the commission of the alleged offence.”.

Substitution of section 7 of Act 17 of 1941

7. The following section is hereby substituted for section 7 of the Merchandise Marks Act, 1941:

“Sale and hiring out of goods bearing false trade descriptions

7. Any person who sells or lets or offers for sale or hire any goods to which any false trade description is applied, shall be guilty of an offence, if—

- (a) at the time of the commission of the alleged offence, the person knew or had reason to suspect that the trade description was not genuine; or
- (b) the person did not take all reasonable steps in order to avoid the commission of the alleged offence.”.

Amendment of section 8 of Act 17 of 1941

8. The following heading is hereby substituted for the heading of section 8 of the Merchandise Marks Act, 1941:

“Sale of imported goods bearing name or mark of South African manufacturer or trader, unaccompanied by indication of origin”.

Substitution of section 9 of Act 17 of 1941

9. The following section is hereby substituted for section 9 of the Merchandise Marks Act, 1941:

“Sale of imported goods bearing marks in official language, unaccompanied by indication of origin

9. Any person who sells or, for the purpose of advertising goods, distributes in the [Union] Republic any goods which were not made or produced in the [Union] Republic, and to which there is applied any trade mark, mark or trade description in [the English or Afrikaans] any official language of the Republic, shall be guilty of an offence, unless there is added to that mark or description, in a conspicuous manner, the name of the country in which the goods were made or produced, with a statement that they were made or produced there.”.

Substitution of section 14 of Act 17 of 1941, as substituted by section 2 of Act 54 of 1987

10. The following section is hereby substituted for section 14 of the Merchandise Marks Act, 1941:

“Unauthorized use of certain emblems

14. (1) Any person who uses in connection with his or her trade, business, profession or occupation, or in connection with a trade mark or mark or trade description applied by him or her to goods made, produced or sold by him or her without authority in writing signed by or on behalf of the Minister—

- (a) the coat of arms of the Republic, or of the former Union of South Africa or any former entity before or after Union, the territory of which forms part of the territory of the Republic, or arms so nearly resembling the coat of arms of the Republic as to be likely to deceive;
- (b) the style, title, name, portrait or effigy of the President or Deputy President or a Minister of the Republic;
- (c) the name, portrait or effigy of any former President or other Head of State or representative of such Head of State, Deputy President or Minister, of the Republic or of the former Union of South Africa or any

- former entity before or after Union, the territory of which forms part of the territory of the Republic; or
- (d) a reproduction of any monument, relic or antique as defined in the National Monuments Act, 1969 (Act No. 28 of 1969), or of the Union Building or of any official residence of the President or Deputy President of the Republic, 5
- shall be guilty of an offence: Provided that this subsection shall not apply to a trade mark registered before and in existence on 1 February 1941.
- (2) Any person who uses in connection with his or her trade, business, profession or occupation any device, emblem, title or words in such a manner as to be likely to lead other persons to believe that— 10
- (a) his or her trade, business, profession or occupation is carried on under the patronage of; or
- (b) he or she is employed by or supplies goods to, 15
- the President, any State department or a provincial government, without authority in writing signed by or on behalf of the President, the Minister administering that department or the Premier of the province concerned, as the case may be, shall be guilty of an offence.”.

Amendment of section 15 of Act 17 of 1941

11. Section 15 of the Merchandise Marks Act, 1941, is hereby amended by the substitution for subsection (1) of the following subsection: 20

- “(1) The Minister may, after such investigation as he or she may think fit, by notice in the *Gazette*, prohibit either absolutely or conditionally the use of—
- (a) the National Flag, or any former National Flag, of the Republic; or
- (b) any mark, word, letter or figure or any arrangement or combination thereof, 25
- in connection with any trade, business, profession, [or] occupation or event, or in connection with a trade mark, mark or trade description applied to goods.”.

Substitution of section 16 of Act 17 of 1941

12. The following section is hereby substituted for section 16 of the Merchandise Marks Act, 1941: 30

“Implied warranty on sale of marked goods

16. Every person who sells any goods to which a [trade mark or] trade description has been applied shall be deemed to warrant that [the mark is a genuine trade mark and not forged or falsely applied, or that] the trade description is not a false trade description [as the case may be] unless 35

the contrary is expressed in writing signed by the seller or on his or her behalf and delivered at the time of the sale to and accepted by the purchaser.”.

Substitution of section 17 of Act 17 of 1941, as amended by section 2 of Act 55 of 1967 40

13. The following section is hereby substituted for section 17 of the Merchandise Marks Act, 1941:

“Containers marked with owner’s name not to be sold

- 17.(1) Any person—
- (a) who buys or sells any [bottle] container or [screw stopper] closure 45
- therefor to which have been indelibly applied words in [the English or Afrikaans] any official language of the Republic stating plainly that

- the **[bottle]** container or **[screw stopper]** closure is the property of a named person; or
- (b) who sells any goods contained in any such **[bottle]** container without the consent in writing of the person so named, unless those goods are the property of or have been produced or manufactured by the person so named, 5
- shall be guilty of an offence.
- (2) Subsection (1) shall not apply to any transaction whereby any such **[bottle]** container or **[screw stopper]** closure is sold—
- (a) by the manufacturer thereof to the person named thereon; or 10
- (b) with the whole of the business in connection with which it is used.”.

Amendment of section 18 of Act 17 of 1941, as amended by section 3 of Act 26 of 1951

14. Section 18 of the Merchandise Marks Act, 1941, is hereby amended— 15
- (a) by the deletion of subsection (1); and
- (b) by the addition of the following subsection:
- “(3) If in the prosecution of any person for an offence referred to in section 7 it is proved that—
- (a) the accused conducts business in goods of the same or similar type as the goods to which any false trade description was applied; and 20
- (b) the goods—
- (i) were found in possession of the accused; or
- (ii) the existence of which the accused was aware of or could reasonably be expected to have been aware of, were found on or in premises of which the accused was on the particular day 25
- the owner, occupier, manager or person in charge,
- it shall be presumed, until the contrary is proved, that the accused offered for sale or hire the goods.”.

Repeal of section 19 of Act 17 of 1941

15. Section 19 of the Merchandise Marks Act, 1941, is hereby repealed. 30

Amendment of section 20 of Act 17 of 1941

16. Section 20 of the Merchandise Marks Act, 1941, is hereby amended by the substitution for subsection (1) of the following subsection:
- “(1) (a) Any person convicted of an offence in terms of this Act, except section 5, shall be liable— 35
- (i) in the case of a first conviction, to a fine not exceeding R5 000 for each article to which the offence relates or to imprisonment for a period not exceeding three years or to both such fine and such imprisonment;
- (ii) in any other case, to a fine not exceeding R10 000 for each article to which the offence relates or to imprisonment for a period not exceeding five years or to both such fine and such imprisonment. 40
- (b) Any person convicted of an offence referred to in section 5 shall be liable to a fine or to imprisonment for a period not exceeding six months.”.

Repeal of section 21bis of Act 17 of 1941, as inserted by section 3 of Act 39 of 1952 and substituted by section 3 of Act 55 of 1967 45

17. Section 21bis of the Merchandise Marks Act, 1941, is hereby repealed.

Substitution of certain word in Act 17 of 1941

18. The Merchandise Marks Act, 1941, except section 14, is hereby amended by the substitution for the word “Union”, wherever it occurs, of the word “Republic”.

Amendment of section 1 of Act 11 of 1967

19. Section 1(1) of the Performers' Protection Act, 1967, is hereby amended—
- (a) by the deletion of the definitions of “broadcasting” and “Corporation”;
 - (b) by the insertion before the definition of “literary and artistic works” of the following definitions:
 - “ ‘broadcast’, when used as a noun, means a telecommunication service of transmissions consisting of sounds, images, signs or signals which—
 - (a) takes place by means of electromagnetic waves of frequencies of lower than 3 000 GHz transmitted in space without an artificial conductor; and
 - (b) is intended for reception by the public or sections of the public, and, when used as a verb, shall be construed accordingly;
 ‘broadcaster’ means a person who undertakes a broadcast; ‘fixation’ includes storage of—
 - (a) sounds or images or both sounds and images; or
 - (b) data or signals representing sounds or images or both sounds and images;”;
 - (c) by the substitution for the definition of “rebroadcasting” of the following definition:
 - “ ‘rebroadcasting’ means the simultaneous broadcasting by one **[broad-casting organization]** broadcaster of the broadcast of another **[broad-casting organization]** broadcaster, and ‘rebroadcast’ has a corresponding meaning.”.

Substitution of section 4 of Act 11 of 1967

20. The following section is hereby substituted for section 4 of the Performers' Protection Act, 1967:

“Extension of protection of performers’ rights to performances in certain countries

4. The protection granted to performers by this Act shall **[subject to such limitations as may hereinafter be prescribed]** be extended automatically to performers in respect of their performances—
- (a) taking place;
 - (b) broadcast without a fixation; or
 - (c) first fixed,
- in a country which **[being a party to the International Convention for the Protection of Performers, Producers of Phonograms and Broadcasting Organizations, by law grants in its territory similar rights to performers in respect of their performances in the Republic]** is a member of the World Trade Organization.”.

Substitution of section 7 of Act 11 of 1967

21. The following section is hereby substituted for section 7 of the Performers' Protection Act, 1967:

“Term of protection

7. The prohibition against the use of a performance **[without the consent of the performer]** as provided for in section 5, shall commence upon the day when the performance first took place or, if incorporated in a phonogram, when it was first fixed on such phonogram, and shall continue for a period of **[twenty]** 50 years calculated from the end of the calendar year in which the performance took place or was incorporated in a phonogram, as the case may be.”.

Amendment of section 8 of Act 11 of 1967

22. Section 8 of the Performers' Protection Act, 1967, is hereby amended—

- (a) by the deletion of subsection (1);
- (b) by the substitution for paragraph (a) of subsection (3) of the following paragraph:

“(a) **[The Corporation]** A broadcaster may make by means of **[its]** his or her own facilities a fixation of a performance and reproductions of such fixation without the consent required by section 5, provided that, unless otherwise stipulated—

- (i) the fixation and the reproductions thereof are used solely in the broadcasts made by the **[Corporation]** broadcaster;
- (ii) the fixation and any reproductions thereof, if they are not of an exceptional documentary character, are destroyed before the end of the period of six months commencing on the day on which the fixation was first made; and
- (iii) the **[Corporation]** broadcaster pays to the performer, whose performance is so used, in respect of each use of the fixation or of any reproduction thereof, an equitable remuneration, which, in the absence of agreement, shall be determined in accordance with the provisions of the Arbitration Act, 1965 (Act No. 42 of 1965), or alternatively, at the option of the performer, by the Copyright Tribunal established by the Copyright Act, **[1965 (Act No. 63 of 1965)]** 1978 (Act No. 98 of 1978).”; and

- (c) by the deletion of subsection (4).

Amendment of section 9 of Act 11 of 1967

23. Section 9(1) of the Performers' Protection Act, 1967, is hereby amended by the substitution for paragraphs (i), (ii) and (iii) of the following paragraphs, respectively:

- “(i) in the case of a contravention referred to in paragraph (a), to a fine **[not exceeding fifty rand]** or to imprisonment for a period not exceeding three months, and the court convicting him or her may in addition, on the application of the performer whose rights have been infringed, and without proof of any damages, order him or her to pay to the performer as damages such amount, not exceeding **[one hundred rand]** the amount determined by the Minister from time to time by notice in the *Gazette*, as may in the circumstances of the case appear to it to be reasonable;
- (ii) in the case of a contravention of paragraph (b), to a fine not exceeding **[ten rand]** the amount determined by the Minister, in consultation with the Minister of Justice, from time to time by notice in the *Gazette* in respect of each fixation or reproduction; and
- (iii) in the case of a contravention of paragraph (c), to a fine **[not exceeding one hundred rand]** or to imprisonment for a period not exceeding six months or to both such fine and such imprisonment.”.

Amendment of section 10 of Act 11 of 1967

24. Section 10 of the Performers' Protection Act, 1967, is hereby amended by the substitution for paragraph (a) of the following paragraph:

- “(a) an amount not exceeding **[one hundred rand]** the amount determined by the Minister from time to time by notice in the *Gazette*, and such court may, without proof of any damages and in addition to the costs of the action, award as damages such amount, not exceeding the said amount, as may in the circumstances of the case appear to it to be reasonable; or”.

Amendment of section 14 of Act 11 of 1967

25. Section 14 of the Performers' Protection Act, 1967, is hereby amended by the substitution for subsection (2) of the following subsection:

- “(2) This Act shall **[not]** apply to performances which took place before the commencement of this Act as it applies in relation to performances which take place thereafter.”.

Amendment of section 1 of Act 57 of 1978

26. Section 1 of the Patents Act, 1978, is hereby amended—

- (a) by the deletion of the expression “16”; and
- (b) by the insertion after the words “CHAPTER V Applications for Patents (sections 25 to 43)” of the following words: 5
“CHAPTER VA International Applications under the Patent Cooperation Treaty (sections 43A to 43F).”.

Amendment of section 2 of Act 57 of 1978, as amended by section 1 of Act 76 of 1988

27. Section 2 of the Patents Act, 1978, is hereby amended—

- (a) by the substitution for the definition of “convention country” of the following definition: 10
“ ‘convention country’, in relation to any provision of this Act, means any country, including any group of countries and any territory for whose international relations another country is responsible, which the President has with a view to the fulfilment of any treaty, convention, arrangement or engagement, by proclamation in the *Gazette* declared to be a convention country for the purposes of such provision; and the expressions ‘convention aircraft’, ‘convention land vehicle’ and ‘convention vessel’ have corresponding meanings;”; 15
- (b) by the substitution for the definition of “patent” of the following definition: 20
“ ‘patent’ means [letters] a certificate in the prescribed form to the effect that a patent for an invention has been granted in the Republic;”;
- (c) by the insertion after the definition of “patent” of the following definition: 25
“ ‘Patent Cooperation Treaty’ means the Patent Cooperation Treaty of 19 June 1970 as amended from time to time and as acceded to by the Republic and as in force in the Republic;”; and
- (d) by the deletion of the definition of “priority date”.

Amendment of section 3 of Act 57 of 1978, as amended by section 1 of Act 14 of 1979

28. Section 3(1) of the Patents Act, 1978, is hereby amended by the substitution for paragraph (d) of the following paragraph: 30

- “(d) be subject to the provisions of section 39 of the repealed law, except that the term of any such patent shall not be extended for a period exceeding five years, and provided further that, as from 1 January 1979, no renewal fees shall be payable in respect of such an extended period.”.

Repeal of section 11 of Act 57 of 1978 35

29. Section 11 of the Patents Act, 1978, is hereby repealed.

Amendment of section 24 of Act 57 of 1978

30. Section 24 of the Patents Act, 1978, is hereby amended—

- (a) by the substitution for subsection (7) of the following subsection: 40
“(7) The registrar or the South African Institute of Intellectual Property Law shall have right to apply to the commissioner for an interdict and other appropriate relief against any person contravening any provision of this section.”; and
- (b) by the addition of the following subsection: 45
“(9) Any communication made by or to a patent agent in his or her capacity as such shall be privileged from disclosure in legal proceedings in the same manner as is any communication made by or to an attorney in his or her capacity as such.”.

Amendment of section 25 of Act 57 of 1978

31. Section 25 of the Patents Act, 1978, is hereby amended—

- (a) by the substitution for subsection (5) of the following subsection:
 “(5) An invention shall be deemed to be new if it does not form part of the state of the art immediately before the priority date of **[any claim to]** that invention.”; 5
- (b) by the substitution for subsection (7) of the following subsection:
 “(7) The state of the art shall also comprise matter contained in an application, open to public inspection, for a patent, notwithstanding that that application was lodged at the patent office and became open to public inspection on or after the priority date of **[any claim to that]** the relevant invention, if— 10
 - (a) that matter was contained in that application both as lodged and as open to public inspection; and
 - (b) the priority date of that matter is earlier than that of the **[relevant claim] invention.**”; 15
- (c) by the substitution for subsection (9) of the following subsection:
 “(9) In the case of an invention consisting of a substance or composition for use in a method of treatment of the human or animal body by surgery or therapy or of diagnosis practised on the human or animal body, the fact that the substance or composition forms part of the state of the art immediately before the priority date of **[any claim to]** the invention shall not prevent a patent being granted for the invention if the use of the substance or composition in any such method does not form part of the state of the art at that date.”; and 20 25
- (d) by the substitution for subsection (10) of the following subsection:
 “(10) Subject to the provisions of section 39(6), an invention shall be deemed to involve an inventive step if it is not obvious to a person skilled in the art, having regard to any matter which forms, immediately before the priority date of **[any claim to]** the invention, part of the state of the art by virtue only of subsection (6) (and disregarding subsections (7) and (8)).” 30

Substitution of section 26 of Act 57 of 1978

32. The following section is hereby substituted for section 26 of the Patents Act, 1978:

“Prior knowledge or publication of invention excused in certain circumstances 35

26. A patent shall not be invalid by reason only of the fact that the invention in respect of which the patent was granted or any part thereof was disclosed, used or known prior to the priority date of **[a claim to]** the invention—

- (a) if the patentee or his or her predecessor in title proves that such knowledge was acquired or such disclosure or use was made without his or her knowledge or consent, and that the knowledge acquired or the matter disclosed or used was derived or obtained from him or her, and, if he or she learnt of the disclosure, use or knowledge before the priority date of the **[claim in question] invention**, that he or she applied for and obtained protection for his or her invention with all reasonable diligence after learning of the disclosure, use or knowledge; or 40 45
- (b) as a result of the invention being worked in the Republic by way of

reasonable technical trial or experiment by the applicant or patentee or the predecessor in title of the applicant or patentee.”.

Amendment of section 30 of Act 57 of 1978

33. Section 30(6) of the Patents Act, 1978, is hereby amended by the substitution for paragraph (b) of the following paragraph:

“(b) The provisions of paragraph (a)(iii) and (iv) shall be deemed to have been complied with, in the case of a convention application, by the inclusion in the prescribed form of the number, date and title of **[such] the relevant application in the convention country from which such convention application claims priority and the name of the convention country**, if the specification and drawings, if any, are lodged within 14 days of the date on which the application was lodged.”.

Amendment of section 31 of Act 57 of 1978, as amended by section 2 of Act 14 of 1979, section 1 of Act 67 of 1983 and section 1 of Act 44 of 1986

34. Section 31(1) of the Patents Act, 1978, is hereby amended by the substitution for paragraph (iv) of the following paragraph:

“(iv) the applicant in the application claiming priority is the proprietor of the prior application referred to in paragraph (a) or (b) **[and, where priority is claimed in terms of paragraph (c) the person claiming that priority is also the applicant in the convention country]** or of the application in the convention country referred to in paragraph (c), or the applicant has acquired the right to claim priority in the Republic **[has become vested in him]**.”.

Substitution of section 33 of Act 57 of 1978, as amended by section 2 of Act 67 of 1983

35. The following section is hereby substituted for section 33 of the Patents Act, 1978:

“Priority dates

33.(1) For the purposes of this Act, the priority date of an invention to which an application for a patent relates, and also that of any matter contained in any such application, whether or not such matter is the same as the invention, shall, except as otherwise provided in this Act, be the date of the lodging of the application.

(2) Where priority is claimed in an application in terms of section 31(1) from one or more prior applications, or one or more prior applications in a convention country or countries, or both, and the invention claimed in the application is fairly based on matter disclosed in one or more of the prior applications, the priority date of the invention shall be the date of lodging of the earliest of the prior applications in which that matter was disclosed in so far as it is fairly based on such earliest application.

(3) Any invention claimed in an application may have one or more priority dates.

(4) Until the contrary is proved, the priority date of an invention shall be the earliest priority date claimed in an application.

(5) In determining whether an invention claimed in an application is fairly based on the matter disclosed in a prior application or a prior application in a convention country, regard shall be had to the disclosures contained in all documents lodged at the same time as and in support of that prior application or prior application in a convention country.

(6) The priority date of new matter introduced by way of a supplementary disclosure in terms of section 51(8) shall be the date of lodging of the supplementary disclosure.”.

Amendment of section 37 of Act 57 of 1978

36. Section 37 of the Patents Act, 1978, is hereby amended by the addition of the following subsection, the existing section becoming subsection (1):

“(2) A patent granted on such fresh application shall not be revoked or invalidated on the ground only that the invention claimed in such fresh application is not new having regard to the matter disclosed in the first-mentioned application.”.

Amendment of section 43 of Act 57 of 1978, as amended by section 4 of Act 67 of 1983

37. Section 43 of the Patents Act, 1978, is hereby amended by the addition of the following subsection:

“(4)(a) After the expiry of five years following the date of application for a patent, any person may apply to the registrar for the patentee to supply the applicant with the prescribed particulars of any search report issued in another country in respect of an application for a patent relating to the same subject-matter which has been lodged in that country.

(b) On receipt of the application, the registrar shall forward a copy thereof to the patentee at the patentee’s address for service.

(c) If the patentee fails to comply with the application within three months of receipt of the copy of the application at the patentee’s address for service, the applicant may apply to the commissioner for an order requiring compliance with the application.

(d) Upon an application for compliance, the commissioner may order such compliance and, if the order is not complied with, the commissioner may make the further order that he or she thinks fit.”.

Insertion of Chapter VA in Act 57 of 1978

38. The following Chapter is hereby inserted after Chapter V of the Patents Act, 1978:

“CHAPTER VA INTERNATIONAL APPLICATIONS UNDER THE PATENT COOPERATION TREATY

Interpretation

43A. In this Chapter, unless the context otherwise indicates, any word or expression defined in the Patent Cooperation Treaty shall have the same meaning as in that Treaty.

Effect of international application designating Republic

43B. Subject to this Chapter, an international application designating the Republic shall be deemed to be an application for a patent lodged at the patent office in terms of this Act.

Patent office as receiving, designated and elected Office

43C. The patent office shall be—

- (a) the receiving Office in respect of an international application lodged at it by a person who is a resident or national of the Republic;
- (b) the designated Office in respect of an international application designating the Republic;
- (c) the elected Office, if an applicant in an international application designating the Republic elects the Republic for the purposes of an international preliminary examination under Chapter II of the Patent Cooperation Treaty.

National processing

43D. The patent office as designated Office or elected Office shall not commence processing of an international application designating or electing the Republic before the expiration of the period referred to in section 43E(1) except where the applicant complies with that section and lodges with the patent office a written request for early commencement of such processing. 5

Commencement of national phase

43E.(1) Before the expiration of the applicable period contemplated in Article 22 or 39 of the Patent Cooperation Treaty or of such further period as may be prescribed by regulation under this Act, the applicant in respect of an international application designating or electing the Republic shall— 10

- (a) pay the prescribed national fee to the patent office; and
- (b) if the international application has not been lodged or published in terms of the Patent Cooperation Treaty in English, lodge at the patent office a translation of the international application, containing the prescribed contents, in an official language of the Republic. 15

(2) If the applicant does not comply with subsection (1) within the period referred to in that subsection or the further period that the registrar allows, the international application concerned shall be deemed to have been abandoned for the purposes of this Act. 20

Administration

43F. (1) When processing an international application, the patent office shall, subject to subsections (2) and (3), apply the Patent Cooperation Treaty, the regulations made thereunder and the administrative instructions issued under those regulations, and the other provisions of this Act. 25

(2) When processing an international application, the Patent Cooperation Treaty, the regulations made thereunder and the administrative instructions issued under those regulations shall prevail in the event of any conflict with this Act. 30

(3) When processing an international application designating the Republic—

- (a) (i) section 9(b) shall not apply; and
- (ii) the applicant shall be represented by an agent who shall be appointed within the prescribed time; 35
- (b) section 10 shall apply only if the applicant complies with section 43E(1) and the applicant who so complies shall, for the purposes of section 10, be deemed to be the applicant in respect of the international application;
- (c) section 16(2) shall apply in relation to time limits specified in terms of the Patent Cooperation Treaty, the regulations made thereunder and the administrative instructions issued under those regulations unless otherwise provided therein; 40
- (d) (i) section 30(1), (5), (6) and (7) shall not apply; and
- (ii) the international application shall date from, and the date of application of the international application shall be, the international filing date accorded in terms of the Patent Cooperation Treaty; 45
- (e) (i) the description, claims, drawings (if any) and abstract referred to in Article 3(2) of the Patent Cooperation Treaty shall be deemed to be a complete specification; and 50
- (ii) section 32(5) shall not apply;
- (f) if—
- (i) the international application is a convention application; 55

- (ii) the applicant has complied with Rule 17.1 of the regulations made under the Patent Cooperation Treaty; and
 - (iii) the priority document referred to in the said Rule 17.1 is a prescribed document for the purposes of section 35(2),
the applicant shall be deemed to have furnished a copy of the priority document within the prescribed period referred to in section 35(2); 5
 - (g) section 38 shall not apply;
 - (h) for the purposes of section 40, the period of 18 months from the date of the application shall be a period of 12 months from the date on which the applicant complies with section 43E(1); 10
 - (i) section 43(3) shall not apply but, when the applicant has complied with section 43E(1) and the application has been published in terms of Article 21 of the Patent Cooperation Treaty, the application shall be open to public inspection as provided in section 43(1);
 - (j) section 43(4) shall not apply; 15
 - (k) any correction or rectification of any document made in terms of the regulations made under the Patent Cooperation Treaty shall be deemed to be a correction or amendment made in terms of section 50;
 - (l) (i) if an application for amendment of the international application is made before the acceptance of the international application, the application for amendment shall not be advertised as contemplated in section 51(2); 20
 - (ii) if—
 - (aa) the applicant has not elected the Republic for the purposes of an international preliminary examination under Chapter II of the Patent Cooperation Treaty before the expiration of 19 months from the priority date as defined in Article 2(xi) of that Treaty and the applicant has complied with section 43E(1), any amendment made in terms of Article 19 of that Treaty; and 25
 - (bb) the applicant has elected the Republic for the purposes of an international preliminary examination under Chapter II of that Treaty before the expiration of 19 months from the priority date as defined in Article 2(xi) of the Patent Cooperation Treaty and the applicant has complied with section 43E(1), any amendment annexed to the international preliminary examination report, 30
- shall be deemed to have been made in terms of section 51 but may be set aside in terms of subsection (10) thereof.”. 35

Amendment of section 44 of Act 57 of 1978

40

39. Section 44 of the Patents Act, 1978, is hereby amended by the substitution in the Afrikaans text for subsection (3) of the following subsection:

“(3) Die patent geld vanaf die datum van die publikasie in subartikel [(2)] (1) vermeld.”.

Amendment of section 45 of Act 57 of 1978

45

40. Section 45 of the Patents Act, 1978, is hereby amended by the substitution for subsection (1) of the following subsection:

“(1) The effect of a patent shall be to grant to the patentee in the Republic, subject to the provisions of this Act, for the duration of the patent, the right to exclude other persons from making, using, exercising, **[or]** disposing or offering to dispose of, or importing the invention, so that he or she shall have and enjoy the whole profit and advantage accruing by reason of the invention.”. 50

Amendment of section 46 of Act 57 of 1978, as amended by section 5 of Act 67 of 1983

41. Section 46 of the Patents Act, 1978, is hereby amended by the substitution for subsection (1) of the following subsection:

“(1) The duration of a patent shall, unless otherwise provided in this Act, be 20 years from the date of application therefor, subject to payment of the prescribed renewal fees by the patentee concerned or an agent.”.

Amendment of section 49 of Act 57 of 1978

42. Section 49 of the Patents Act, 1978, is hereby amended by the substitution for subsection (6) of the following subsection:

“(6) Where any dispute arises between joint patentees as to their respective rights in or to a patent, the institution of proceedings relating to the patent or the manner in which they should deal with the patent or the patented invention, any joint patentee may apply to the commissioner to decide the matter in dispute.”.

Amendment of section 51 of Act 57 of 1978, as amended by section 7 of Act 67 of 1983 and section 3 of Act 44 of 1986

43. Section 51 of the Patents Act, 1978, is hereby amended by the substitution for the proviso to subsection (8) of the following proviso:

“Provided that in determining the validity of the patent under this Act, regard shall be had to the priority date of the new matter introduced by way of the supplementary disclosure.”.

Amendment of section 55 of Act 57 of 1978

44. Section 55 of the Patents Act, 1978, is hereby amended by the addition of the following proviso:

“Provided that the commissioner shall not grant such a licence unless—”

- (a) the invention claimed in the dependent patent involves an important technical advance of considerable economic significance in relation to the invention claimed in the prior patent;
- (b) the proprietor of the dependent patent granted the proprietor of the prior patent on reasonable terms a cross-licence to use the invention claimed in the dependent patent; and
- (c) the use authorised in respect of the prior patent is not assignable except with the assignment of the dependent patent.”.

Amendment of section 56 of Act 57 of 1978, as amended by section 2 of Act 76 of 1988

45. Section 56 of the Patents Act, 1978, is hereby amended—

(a) by the substitution for subsection (1) of the following subsection:

“(1) Any interested person who can show that the rights in a patent are being abused may apply to the **[registrar]** commissioner in the prescribed manner for a compulsory licence under the patent.”;

(b) by the deletion of subsection (1A) and paragraph (b) of subsection (2);

(c) by the substitution for paragraph (a) of subsection (4) of the following paragraph:

“(a) The commissioner shall consider the application on its merits and may order the grant to the applicant of a licence on such conditions as he or she may deem fit, including a condition precluding the licensee from importing into the Republic any patented articles.”;

(d) by the addition of the following paragraph to subsection (4):

“(c) A licence granted under this section shall include a provision that, subject to adequate protection of the legitimate interests of the licensee,

the licence shall, on application by the patentee, be terminated if the circumstances which led to its grant cease to exist and, in the opinion of the commissioner, are unlikely to recur.”;

(e) by the substitution for subsection (5) of the following subsection:

“(5) **[If the only abuse found by the commissioner to have been established is that set out in subsection (2)(a), any]** Any licence granted under this section shall be non-exclusive **[but]** and shall not be transferable except to a person to whom the business or part of the business in connection with which the rights under the licence were exercised has been transferred.”;

(f) by the deletion of subsection (6);

(g) by the substitution for subsection (10) of the following subsection:

“(10) Subject **[to the provisions of subsection (11) and]** to the conditions that may be attached to the licence, a licensee under this section shall have the same rights and obligations as any other licensee under a patent.”; and

(h) by the deletion of subsections (11) and (12).

Amendment of section 65 of Act 57 of 1978, as amended by section 3 of Act 76 of 1988

46. Section 65 of the Patents Act, 1978, is hereby amended by the substitution for subsection (6) of the following subsection:

“(6) In lieu of damages the plaintiff may, at his or her option, be awarded an amount calculated on the basis of a reasonable royalty which would have been payable by a licensee or sub-licensee in respect of the patent concerned.”.

Amendment of section 91 of Act 57 of 1978

47. Section 91 of the Patents Act, 1978, is hereby amended by the substitution for the words following paragraph (g) of the following words:

“generally, as to any matter which he or she considers **[it]** necessary or expedient to prescribe in order to carry out, or give effect to, the Patent Cooperation Treaty or that the purposes of this Act may be achieved.”.

Substitution of certain expression in Act 57 of 1978

48. The Patents Act, 1978, is hereby amended by the substitution for the expression “South African Institute of Patent Agents”, wherever it occurs, of the expression “South African Institute of Intellectual Property Law”.

Substitution of long title of Act 57 of 1978

49. The following long title is hereby substituted for the long title of the Patents Act, 1978:

“ACT

To provide for the registration and granting of patents for inventions and for matters connected therewith.”.

Amendment of section 1 of Act 98 of 1978, as amended by section 1 of Act 56 of 1980, section 1 of Act 66 of 1983, section 1 of Act 52 of 1984, section 1 of Act 13 of 1988 and section 1 of Act 125 of 1992

50. Section 1(1) of the Copyright Act, 1978, is hereby amended—

(a) by the substitution for the definition of “broadcast” of the following definition:

“ ‘broadcast’, when used as a noun, means a telecommunication service of transmissions consisting of sounds, images, signs or signals which—

(a) takes place by means of electromagnetic waves of frequencies of lower than 3 000 GHz transmitted in space without an artificial conductor; and

- (b) is intended for reception by the public or sections of the public, and includes the emitting of programme-carrying signals to a satellite, and, when used as a verb, shall be construed accordingly;”
- (b) by the substitution for the definition of “broadcaster” of the following definition: 5
 “ ‘broadcaster’ means a person who undertakes a broadcast;”;
- (c) by the substitution for the definition of “cinematograph film” of the following definition: 10
 “ ‘cinematograph film’ means **[the]** any fixation or storage by any means whatsoever on film or any other material of data, signals or a sequence of images capable, when used in conjunction with any other mechanical, electronic or other device, of being seen as a moving picture and of reproduction, and includes the sounds embodied in a sound-track associated with the film, but shall not include a computer program;”;
- (d) by the deletion of the definition of “Corporation”; 15
- (e) by the substitution for paragraph (g) of the definition of “literary work” of the following paragraph:
 “(g) tables and compilations, including tables and compilations of data stored or embodied in a computer or a medium used in conjunction with a computer;”;
- (f) by the substitution for the definition of “rebroadcasting” of the following definition: 20
 “ ‘rebroadcasting’ means the simultaneous or subsequent broadcasting by one **[broadcasting organization]** broadcaster of the broadcast of another **[broadcasting organization]** broadcaster;”;
- (g) by the substitution for the definition of “record” of the following definition: 25
 “ ‘record’ means any disc, tape, perforated role or other device in or on which sounds, or data or signals representing sounds, are embodied or represented so as to be capable of being automatically reproduced **[therefrom]** or performed therefrom;”;
- (h) by the substitution for the definition of “sound recording” of the following definition: 30
 “ ‘sound recording’ means any fixation or storage of sounds, or data or signals representing sounds, capable of being reproduced, but does not include a sound-track associated with a cinematograph film;”.

Amendment of section 2 of Act 98 of 1978, as amended by section 2 of Act 56 of 1980, section 2 of Act 52 of 1984 and section 2 of Act 125 of 1992

51. Section 2 of the Copyright Act, 1978, is hereby amended by the substitution for subsection (2) of the following subsection:

“(2) A work, except a broadcast or programme-carrying signal, shall not be eligible for copyright unless the work has been written down, recorded, represented in digital data or signals or otherwise reduced to a material form.”. 40

Amendment of section 3 of Act 98 of 1978, as amended by section 3 of Act 52 of 1984 and section 3 of Act 125 of 1992

52. Section 3(2) of the Copyright Act, 1978, is hereby amended by the substitution for paragraph (b) of the following paragraph: 45

“(b) cinematograph films, photographs and computer programs, fifty years from the end of the year in which the work—
 (i) is made available to the public with the consent of the owner of the copyright; or
 (ii) is first published, whichever term is the longer, or failing such an event within fifty years **[from]** of the making of the work, fifty years from the end of the year in which the work is made;”.

Substitution of section 11B of Act 98 of 1978, as inserted by section 10 of Act 125 of 1992

53. The following section is hereby substituted for section 11B of the Copyright Act, 1978:

“Nature of copyright in computer programs

5

11B. Copyright in a computer program vests the exclusive right to do or authorize the doing of any of the following acts in the Republic:

- (a) Reproducing the computer program in any manner or form;
- (b) publishing the computer program if it was hitherto unpublished;
- (c) performing the computer program in public;
- (d) broadcasting the computer program;
- (e) causing the computer program to be transmitted in a diffusion service, unless such service transmits a lawful broadcast, including the computer program, and is operated by the original broadcaster;
- (f) making an adaptation of the computer program;
- (g) doing, in relation to an adaptation of the computer program, any of the acts specified in relation to the computer program in paragraphs (a) to (e) inclusive;
- (h) letting, or offering or exposing for hire by way of trade, directly or indirectly, a copy of the computer program.”.

10

15

20

Amendment of section 12 of Act 98 of 1978, as amended by section 11 of Act 125 of 1992

54. Section 12 of the Copyright Act, 1978, is hereby amended by the substitution for subsection (5) of the following subsection:

“(5)(a) The copyright in a literary or musical work shall not be infringed by the reproduction of such work by **[the Corporation]** a broadcaster by means of its own facilities where such reproduction or any copy thereof is intended exclusively for lawful broadcasts of the **[Corporation]** broadcaster and is destroyed before the expiration of a period of six months immediately following the making of the reproduction, or such longer period as may be agreed to by the owner of the relevant part of the copyright in the work.

25

30

(b) Any reproduction of a work made under paragraph (a) may, if it is of an exceptional documentary nature, be preserved in the archives of the **[Corporation]** broadcaster, but shall, subject to the provisions of this Act, not be used for broadcasting or for any other purpose without the consent of the owner of the relevant part of the copyright in the work.”.

35

Amendment of section 24 of Act 98 of 1978, as amended by section 21 of Act 125 of 1992

55. Section 24 of the Copyright Act, 1978, is hereby amended by the substitution for subsections (1A), (1B) and (1C) of the following subsections, respectively:

40

“(1A) In lieu of damages the plaintiff may, at his or her option, be awarded an amount calculated on the basis of a reasonable royalty which would have been payable by a licensee in respect of the work or type of work concerned.

(1B) For the purposes of determining the amount of damages or a reasonable royalty to be awarded under this section or section 25(2), the court may direct an enquiry to be held and may prescribe such procedures for conducting such enquiry as the court considers necessary.

45

(1C) Before the owner of copyright institutes proceedings under this section, he or she shall give notice in writing to the exclusive licensee or sub-licensee of the copyright concerned of the intention to do so, and the exclusive licensee or sub-licensee may intervene in such proceedings and recover any damages he or she may have suffered as a result of the infringement concerned or a reasonable royalty to which he or she may be entitled.”.

50

Amendment of section 25 of Act 98 of 1978, as amended by section 21 of Act 125 of 1992

56. Section 25 of the Copyright Act, 1978, is hereby amended by the substitution for subsection (2) of the following subsection:

“(2) Before an exclusive licensee or sub-licensee institutes proceedings under subsection (1), he or she shall give notice in writing to the owner of the copyright concerned of the intention to do so, and the owner may intervene in such proceedings and recover any damages he or she may have suffered as a result of the infringement concerned or a reasonable royalty to which he or she may be entitled.”.

Substitution of section 34 of Act 98 of 1978

57. The following section is hereby substituted for section 34 of the Copyright Act, 1978:

“Diffusion service

34. In a dispute concerning the transmission of broadcasts in a diffusion service in the Republic, the tribunal shall disallow any claim under this Act to the extent to which the licences of the broadcaster concerned provide for or include such transmission in a diffusion service.”.

Substitution of certain word in Act 98 of 1978

58. Sections 6(e), 7(d), 8(1)(d) and 10(c) of the Copyright Act, 1978, are hereby amended by the substitution in the Afrikaans text for the word “voortgesit”, wherever it occurs, of the word “bedryf”.

Amendment of section 10 of Act 194 of 1993

59. Section 10 of the Trade Marks Act, 1993, is hereby amended—

(a) by the substitution for paragraph (5) of the following paragraph:

“(5) a mark which consists exclusively of the shape, configuration, [or] colour or pattern of goods where such shape, configuration, [or] colour or pattern is necessary to obtain a specific technical result, or results from the nature of the goods themselves;”;

(b) by the substitution for paragraph (6) of the following paragraph:

“(6) subject to the provisions of section 36(2), a mark which, on the date of application for registration thereof, or, where appropriate, of the priority claimed in respect of the application for registration thereof, constitutes, or the essential part of which constitutes, a reproduction, imitation or translation of a trade mark which is entitled to protection under the Paris Convention as a well-known trade mark within the meaning of section 35(1) of this Act and which is used for goods or services identical or similar to the goods or services in [question] respect of which the trade mark is well-known and where such use is likely to cause deception or confusion;”;

(c) by the substitution for paragraph (8) of the following paragraph:

“(8) (a) a mark which consists of or contains the national flag of the Republic or a convention country, or an imitation from a heraldic point of view, without the authorization of the competent authority of the Republic or convention country, as the case may be, unless it appears to the registrar that use of the flag in the manner proposed is permitted without such authorization;

- (b) a mark which consists of or contains the armorial bearings or any other state emblem of the Republic or a convention country, or an imitation from a heraldic point of view, without the authorization of the competent authority of the Republic or convention country, as the case may be; 5
- (c) a mark which consists of or contains an official sign or hallmark adopted by the Republic or a convention country, or an imitation from a heraldic point of view, and which indicates control and warranty, in relation to goods or services of the same or a similar kind as those in relation to which it indicates control and warranty, without the authorization of the competent authority of the Republic or convention country, as the case may be; 10
- (d) a mark which consists of or contains the flag, the armorial bearings or any other emblem, or an imitation from a heraldic point of view, or the name, or the abbreviation of the name, of any international organization of which one or more convention countries are members, without the authorization of the organization concerned, unless it appears to the registrar that use of the flag, armorial bearings, other emblem or imitation or the name or abbreviation in the manner proposed, is not such as to suggest to the public that a connection exists between the organization and the mark, or is not likely to mislead the public as to the existence of a connection between the organization and the proprietor of the mark: 15
20
25
- Provided that—
- (i) paragraphs (b), (c) and (d) shall apply to a state emblem and an official sign or hallmark of a convention country and an emblem, the name, or the abbreviation of the name, of an international organization only if and to the extent that— 30
- (aa) the convention country or international organization, as the case may be, has notified the Republic in accordance with Article 6ter of the Paris Convention that it desires to protect that emblem, official sign or hallmark, name or abbreviation, as the case may be; 35
- (bb) such notification remains in force; and
- (cc) the Republic has not objected to it in accordance with Article 6ter of the Paris Convention or any such objection has been withdrawn; 40
- (ii) paragraph (b), (c) or (d) shall apply only in relation to applications for registration made more than two months after receipt of the notification referred to in paragraph (i)(aa);
- (iii) paragraph (b) or (c) shall not prevent the registration of a trade mark by a citizen of any country who is authorized to make use of a state emblem or official sign or hallmark of that country, notwithstanding the fact that it is similar to that of another country;” 45
- and
- (d) by the substitution for paragraph (17) of the following paragraph: 50
- “(17) a mark which is identical or similar to a trade mark which is already registered and which is well-known in the Republic, if the use of the mark sought to be registered would be likely to take unfair advantage of, or be detrimental to, the distinctive character or the repute of the registered trade mark, notwithstanding the absence of deception or confusion, unless the proprietor of such trade mark consents to the registration of such mark:” 55

Amendment of section 11 of Act 194 of 1993

60. Section 11 of the Trade Marks Act, 1993, is hereby amended by the substitution for subsection (2) of the following subsection:

“(2) Where a trade mark has, either before or after the commencement of this Act, been registered as contemplated in subsection (1) and, during the subsistence of that registration, the prescribed classification in accordance with which the trade mark was registered as aforesaid is revised or is replaced by a new classification, the proprietor of the trade mark **[shall, when applying for the renewal of the registration thereof in terms of section 37, at the same time]** may, at any time, apply in the prescribed manner for revision, in accordance with the revised or new classification, of the class or classes in which the trade mark is registered.”. 5

Repeal of section 13 of Act 194 of 1993

61. Section 13 of the Trade Marks Act, 1993, is hereby repealed. 10

Amendment of section 27 of Act 194 of 1993

62. Section 27 of the Trade Marks Act, 1993, is hereby amended—

(a) by the substitution in subsection (1) for the words preceding paragraph (a) of the following words:

“Subject to the provisions of **[sections 13 and]** section 70(2), a registered trade mark may, on application to the court, or, at the option of the applicant and subject to the provisions of section 59 and in the prescribed manner, to the registrar by any interested person, be removed from the register in respect of any of the goods or services in respect of which it is registered, on the ground either—”; and 15 20

(b) by the addition of the following subsection:

“(5) Subsection (1)(a) and (b) does not apply to a trade mark in respect of which protection may be claimed under the Paris Convention as a well-known trade mark within the meaning of section 35(1) of this Act.”.

Amendment of section 30 of Act 194 of 1993

25

63. Section 30 of the Trade Marks Act, 1993, is hereby amended by the substitution for subsection (3) of the following subsection:

“(3) Any association of a trade mark with any other trade mark registered in the name of the same proprietor shall be deemed to be an **[associate]** association with all trade marks associated with that other trade mark.”. 30

Amendment of section 34 of Act 194 of 1993

64. Section 34(3) of the Trade Marks Act, 1993, is hereby amended—

(a) by the substitution for the words preceding paragraph (a) of the following words:

“Where a trade mark registered in terms of this Act has been infringed, **[the court]** any High Court having jurisdiction may grant the proprietor the following relief, namely—”; and 35

(b) by the substitution for paragraph (d) of the following paragraph:

“(d) in lieu of damages, at the option of the proprietor, a reasonable royalty which would have been payable by a licensee for the use of the trade mark concerned, including any use which took place after advertisement of the acceptance of an application for registration and which, if taking place after registration, would amount to infringement of the rights acquired by registration.”. 40

Amendment of section 35 of Act 194 of 1993

45

65. Section 35 of the Trade Marks Act, 1993, is hereby amended—

(a) by the insertion after subsection (1) of the following subsection:

“(1A) In determining for the purposes of subsection (1) whether a trade mark is well-known in the Republic, due regard shall be given to the knowledge of the trade mark in the relevant sector of the public, including knowledge which has been obtained as a result of the promotion of the trade mark.”; and

(b) by the addition of the following subsection:

“(4) Where, by virtue of section 10(8), the authorization of the competent authority of a convention country or an international organization is required for the registration of a mark as a trade mark, such authority or organization is entitled to restrain the use in the Republic of such a mark without such authorization.”.

Amendment of section 39 of Act 194 of 1993

66. Section 39 of the Trade Marks Act, 1993, is hereby amended—

(a) by the substitution for subsection (4) of the following subsection:

“(4) **[Notwithstanding anything to the contrary contained in subsections (1), (2) and (3), a registered trade mark is not assignable or transmissible if]** If, as a result of the assignment or transmission of a registered trade mark, **[and]** the use of the trade mark by different persons in the Republic or elsewhere **[circumstances exist or would exist which give rise or]** would give rise to the likelihood of deception or confusion, section 10(13) shall apply.”; and

(b) by the deletion of subsection (6).

Insertion of section 48A in Act 194 of 1993

67. The following section is hereby inserted after section 48 of the Trade Marks Act, 1993:

“List of emblems of convention countries and international organizations

48A. (1) The registrar shall keep a list of—

(a) all state emblems and official signs and hallmarks of convention countries; and

(b) all emblems, names and abbreviations of names of international organizations,

which are protected in terms of the Paris Convention by virtue of notification to the Republic in accordance with Article 6ter of the Convention.

(2) The list referred to in subsection (1) shall be open at all convenient times during office hours to inspection by the public.”.

Substitution of section 51 of Act 194 of 1993

68. The following section is hereby substituted for section 51 of the Trade Marks Act, 1993:

“Registration to be *prima facie* evidence of validity

51. In all legal proceedings relating to a registered trade mark (including applications under section [25] 24) the fact that a person is registered as the proprietor of the trade mark shall be *prima facie* evidence of the validity of the original registration of the trade mark and of all subsequent assignments and transmissions thereof.”.

Amendment of section 1 of Act 195 of 1993

69. Section 1(1) of the Designs Act, 1993, is hereby amended by the deletion of the definition of “personal representative”.

Amendment of section 14 of Act 195 of 1993

70. Section 14 of the Designs Act, 1993, is hereby amended—

- (a) by the substitution for the proviso to subsection (2) of the following proviso: 5
 “Provided that in the case of the release date thereof being the earlier, the design shall not be deemed to be new if an application for the registration of such design has not been lodged—
(a) in the case of an integrated circuit topography, a mask work or a series of mask works, within two years; or
(b) in the case of any other design, within six months, 10
of such release date.”; and
- (b) by the substitution for paragraph (b) of subsection (3) of the following paragraph:
 “(b) all matter contained in an application—
 (i) for the registration of a design in the Republic; or
 (ii) **[of an application]** in a convention country for the registration 15
 of a design which has subsequently been registered in the Republic in accordance with the provisions of section 44,
of which the date of application in the Republic or convention country, as the case may be, is earlier than the date of application or
the release date contemplated in subsection (2).”. 20

Amendment of section 15 of Act 195 of 1993

71. Section 15 of the Designs Act, 1993, is hereby amended by the addition of the following subsection:

- “(5) Where an application for the registration of a design has been made or a design has been registered and a further application is made by the same applicant 25
 to register the design or a part thereof in the same or the other Part of the register and in the same class or in one or more other classes, such further application shall not be invalidated on the ground that the design—
 (a) in the case of—
 (i) an aesthetic design, is not new and original; 30
 (ii) a functional design, is not new and is commonplace in the art in question, by reason only that the design forms the subject of such previous application or registration; or
 (b) was previously made available to the public by reason only that the design has been applied to articles within the class in which such previous application or 35
registration was lodged.”.

Substitution of section 18 of Act 195 of 1993

72. The following section is hereby substituted for section 18 of the Designs Act, 1993:

“Certificate of registration 40

- 18. As soon as practicable after the registration of a design under section 15(1) the registrar shall—**
 (a) issue a notification of registration to the applicant; and
 (b) cause to be published in the journal in the prescribed form a notice of such registration and, upon such publication, issue a certificate of 45
registration to the registered proprietor.”.

Amendment of section 20 of Act 195 of 1993

73. Section 20 of the Designs Act, 1993, is hereby amended by the addition of the following subsection:

“(3) Notwithstanding subsection (1), the rights of the registered proprietor of a registered design in the form of an integrated circuit topography shall not be infringed by a person who—

- (a) makes an article embodying the registered design or a design not substantially different from the registered design, for private purposes or for the sole purpose of evaluation, analysis, research or teaching; 5
- (b) imports or disposes of an integrated circuit embodying the registered design which has been unlawfully produced or an article incorporating such an integrated circuit and proves that at the time of acquiring the integrated circuit or article he or she was not aware and had no reasonable grounds of becoming aware that the integrated circuit or article embodied a registered design which had been unlawfully produced: Provided that when the person receives sufficient notice that the registered design was unlawfully produced, the person may dispose of any stock of such integrated circuits or articles but shall be liable to pay to the registered proprietor a sum calculated on the basis of a reasonable royalty which would have been payable by a licensee or sub-licensee in respect of the registered design concerned.”. 10 15

Amendment of section 21 of Act 195 of 1993

74. Section 21 of the Designs Act, 1993, is hereby amended by the addition of the following subsection: 20

“(14) If the registered design in respect of which an application is made under subsection (1) for the granting of a compulsory licence is an integrated circuit topography, a mask work or a series of mask works—

- (a) subsections (2)(b), (5), (6), (11) and (12) shall not apply; 25
- (b) the court shall consider that application on its merits in deciding whether or not to grant a licence as provided for in subsection (4);
- (c) a licence granted under subsection (4) upon that application shall include a provision that, subject to adequate protection of the legitimate interests of the licensee, the licence shall, on application by the registered proprietor of the registered design, be terminated if the circumstances which led to its grant cease to exist and, in the opinion of the court, are unlikely to recur; and 30
- (d) a licence granted under subsection (4) upon that application shall be non-exclusive and shall not be transferable except to a person to whom the business or part of the business in connection with which the rights under the licence were exercised has been transferred.”. 35

Amendment of section 23 of Act 195 of 1993

75. Section 23 of the Designs Act, 1993, is hereby amended by the substitution for subsection (1) of the following subsection:

“(1) Where, after the commencement of this Act, the registration of a design has lapsed owing to non-payment of any prescribed renewal fee within the prescribed period or the extended period referred to in section 22(2), the registered proprietor may in the prescribed manner and on payment of the prescribed fee, apply to the registrar for the restoration of such registration.”. 40

Amendment of section 26 of Act 195 of 1993

76. Section 26 of the Designs Act, 1993, is hereby amended by the substitution for subsections (4) and (5) of the following subsections, respectively: 45

“(4) If a correction is requested and it appears to the registrar that the correction would materially alter the scope of the document to which the request relates and the document is open for public inspection, the registrar may require notice of the

request to be published in the journal and to be served upon such persons as he or she may deem necessary.

(5) If the registrar has not required such notice **[has not been]** to be so published and served or, if it had been so published and served and there is no opposition to such a correction, the registrar may decide the matter or, in the latter case, refer it to the court, which shall decide it as it may deem fit.” 5

Amendment of section 27 of Act 195 of 1993

77. Section 27 of the Designs Act, 1993, is hereby amended—

(a) by the substitution for paragraph (a) of subsection (3) of the following paragraph: 10

“(a) **[Any]** If the registration of a design to be amended is open for public inspection, any person may oppose the application for amendment of the registration of the design within the prescribed time and in the prescribed manner.”; and

(b) by the substitution for subsection (6) of the following subsection: 15

“(6) No amendment of—

(a) an application for the registration of a design, or a registration of a design, shall be allowed if— 20

(i) the effect of the amendment would be to introduce new matter or matter not in substance disclosed in the application for the registration of a design or the registration of the design before amendment; or

(ii) registration of a design as amended would include any matter not fairly based on matter disclosed in the document before amendment; 25

(b) a registration of a design shall be allowed if—

(i) the effect would be to alter a registration in terms of the repealed Act from a Part A to a Part F registration; or

(ii) the scope of the registration after amendment would be wider than that before amendment.”. 30

Amendment of section 35 of Act 195 of 1993

78. Section 35(3) of the Designs Act, 1993, is hereby amended by the substitution for paragraph (d) of the following paragraph:

“(d) in lieu of damages, at the option of the plaintiff, an amount calculated on the basis of a reasonable royalty which would have been payable by **[the]** a licensee or sub-licensee in respect of the registered design concerned.”. 35

Amendment of section 44 of Act 195 of 1993

79. Section 44(1) of the Designs Act, 1993, is hereby amended by the substitution for the words preceding paragraph (a) of the following words:

“An application for registration of a design **[or similar right]** in respect of which protection has been applied for in a convention country, by way of an application for registration of a design or similar right, may be made in accordance with the provisions of this Act by the person by whom the application for protection in the convention country was made or his or her **[personal representative or]** cessionary: Provided that no application shall be made by virtue of this section after the expiry of six months from the date of the application for protection in a convention country or, where more than one such application for protection has been made, from the date of the first application: Provided further that if after the filing of the first application for protection in a convention country in respect of any design or similar right, a subsequent application is filed in that country in respect of the same design or similar right, such subsequent application shall be regarded as the first application in that country in respect of that design or similar right, if at the time of filing thereof—”. 40 45 50

Short title and commencement

80. (1) This Act shall be called the Intellectual Property Laws Amendment Act, 1997, and shall, subject to subsections (2) and (3), come into operation on the date when this Act is first published in the *Gazette* as a law.

(2) Sections 1 to 18 shall come into operation on a date determined by the President 5
by proclamation in the *Gazette*.

(3) If on the date of the first publication of this Act in the *Gazette*, the Patent Cooperation Treaty of 19 June 1970, as amended from time to time, has not been approved by resolution in both the National Assembly and the National Council of Provinces under section 231(2) of the Constitution of the Republic of South Africa, 1996 10
(Act No. 108 of 1996), sections 26, 27(c), 38 and 47 shall come into operation on the date immediately following the date on which the Treaty is so approved.

MEMORANDUM ON THE OBJECTS OF THE INTELLECTUAL PROPERTY LAWS AMENDMENT BILL, 1997

1. The field of intellectual property law in South Africa is regulated primarily by the Patents Act, 1978 (Act No. 57 of 1978), the Trade Marks Act, 1993 (Act No. 194 of 1993), the Designs Act, 1993 (Act No. 195 of 1993), and the Copyright Act, 1978 (Act No. 98 of 1978). These Acts make provision for, respectively, the registration of patents, trade marks and designs in South Africa by both South African and foreign nationals; in the case of the Copyright Act, 1978, provision is made for copyright to subsist automatically in various types of works, both where those works emanate from South Africa and foreign countries.

2. The Merchandise Marks Act, 1941 (Act No. 17 of 1941), deals with the marking of goods sold in the South African market place, both by means of trade marks and other types of designations and descriptions. It provides a measure of protection against the counterfeiting of goods.

3. The Performer's Protection Act, 1967 (Act No. 11 of 1967), makes provision for protection in the nature of copyright to be conferred upon the performances of actors, singers and other persons who perform various types of work in public or for purposes of recording or broadcasting. Local South African performances as well as performances emanating from some foreign countries are protected in terms of that Act.

4. Amongst the international agreements concluded during the recent Uruguay round of GATT negotiations was the Agreement on Trade Related Aspects of Intellectual Property Rights (the "TRIPS Agreement"). South Africa has acceded to this Agreement. The TRIPS Agreement requires all parties thereto to provide certain minimum standards of protection for intellectual property in their laws dealing with this subject matter and lays down coercive measures which can be taken against those parties which do not meet their treaty obligations. As a party to the TRIPS Agreement, South Africa is obliged to ensure that its intellectual property laws meet the minimum requirements of the Agreement. Compliance with the TRIPS Agreement is already overdue.

5. In the field of patents there is in existence a treaty known as the Patent Cooperation Treaty (the "PCT"), done at Washington on 19 June 1970, to which South Africa has not acceded in the past because of its political isolation. The PCT provides for a simplified form of applying for the registration of international patents which is conducive to foreign inventors registering their patents in countries which are parties thereto and thus facilitating transfer of technology to those countries. South Africa's accession to the PCT is envisaged in order to attract foreign patent applications and thus technology transfer to South Africa. It is necessary to amend the Patents Act, 1978, in order to harmonise it with the provisions of the PCT and to make it possible for patent applications in terms of the PCT to be lodged and processed in South Africa. The commencement of these amendments are made subject to Parliament's approval of accession to the PCT in accordance with section 231(2) of the Constitution of the Republic of South Africa, 1993 (Act No. 200 of 1993—the "Constitution").

6. In order to deal properly with the problem of counterfeiting of goods available on the South African market and to bring about South Africa's compliance with the TRIPS Agreement relating to counterfeit goods, and customs and other measures to counteract such goods, a draft Bill regarding the counterfeiting of goods has been prepared. This draft Bill overlaps with the Merchandise Marks Act, 1941, insofar as it deals with issues relating to the counterfeiting of goods. Accordingly, it is necessary to amend the Merchandise Marks Act, 1941, so as to avoid and eradicate these areas of overlap and to have all measures regarding the counterfeiting of goods dealt with comprehensively in a single law.

7. The TRIPS Agreement also deals with the question of the protection of the performances by performers. Certain amendments to the Performers' Protection Act, 1967, are necessary in order to ensure that the Act is fully in compliance with South Africa's obligations in regard to this subject matter contained in the TRIPS Agreement.

8. All the aforementioned intellectual property laws require some modernisation and updating in order to make them fully effective. This is particularly true of the Merchandise Marks Act, 1941, and the Performers' Protection Act, 1967, which were passed more than 30 years ago and have scarcely been amended since.

9. The main features of the amendments to the various intellectual property laws are as follows:

9.1 The amendments to the Merchandise Marks Act, 1941, seek to delete those provisions in the Act which deal with matters encompassed in the draft Bill regarding the counterfeiting of goods and to amend those provisions of the Act which are outdated and ineffective or require modernisation. These provisions include references to penalties which a court may impose upon a conviction for an offence under that Act. Amendments to provisions which may be in conflict with Chapter 3 of the Constitution are also suggested.

9.2 The proposed amendments to the Performers' Protection Act, 1967, seek to bring the Act into compliance with South Africa's obligations in this area under the TRIPS Agreement. It is proposed to extend the term of protection in terms of that Act from 20 years to 50 years and the protection afforded by the Act to performances emanating from countries which are parties to the TRIPS Agreement. It is also suggested that the Act be made retrospective so as to cover performances made before it came into operation on 30 December 1967. Certain adjustments to that Act are proposed so that it is brought up to date with advances in technology and increased usage of electronic and digital storage of information or signals. Certain amendments also seek to modernise several outdated provisions of the Act, including the penalties which can be imposed for any contravention of its provisions and the recognition of other broadcasters besides the SABC.

9.3 The proposed amendments to the Patents Act, 1978, seek to achieve compliance of the Act with the TRIPS Agreement and to make the Act compatible with the PCT if South Africa accedes to those international agreements. Further proposed amendments to the Patents Act, 1978, seek to remove uncertainties relating to the payment of renewal fees for patents, priority dates of matter as opposed to patent claims, the principle of privilege regarding communications to and by patent agents and the assessment of damages.

9.4 Certain amendments to the Copyright Act, 1978, are suggested in order to achieve South Africa's full compliance with the provisions of the TRIPS Agreements relating to copyright. Certain extensions to the scope of copyright in computer programs and adjustments to the term of copyright in cinematograph films are proposed. The other adjustments to that Act are suggested so that it is kept abreast with advances in technology and the increased usage of electronic and digital storage of information or signals. Proposed amendments to the provisions of that Act relating to damages and other compensation due to a copyright owner pursuant to infringement seek to bring the Act into conformity with corresponding provisions of the Trade Marks Act, 1993, and the Designs Act, 1993. Further amendments are proposed in order to provide for all broadcasters.

9.5 The proposed amendments to the Trade Marks Act, 1993, seek to ensure compliance of the Act with the provisions of the TRIPS Agreement in this regard and to bring South African trade mark law into line with international norms and standards relating to the protection of well-known foreign trade marks. In addition it is proposed to correct or clarify certain other provisions of that Act.

9.6 Amendments to the Designs Act, 1993, are suggested in order to achieve compatibility between the Act and the TRIPS Agreement. Other proposed amendments seek to correct or clarify certain provisions of that Act.

10. The draft Bill has been prepared by the Standing Advisory Committee in regard to copyright, trade marks, patents and designs constituted under section 40 of the Copyright Act, 1978. Being of a technical nature, the contents thereof were discussed with the South African Institute of Intellectual Property Law. In so far as the amendments to the Patents Act, 1978, relate to harmonising the Act with the PCT, close consultation with the World Intellectual Property Organisation ("WIPO") took place. In

several instances recommendations made by the South African Institute of Intellectual Property Law were accepted while representatives of WIPO participated in the drafting of the relevant amendments to the Patents Act, 1978.