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The logo for SAIPL, featuring the letters 'SAIPL' in a bold, sans-serif font. The letter 'I' is stylized with a red dot above it, resembling a speech mark or a drop.

FROM THE EDITOR

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The friendly welcoming kosmos flowers announced the seasonal change into Spring. In the world of IP we have seen some interesting changes too.

The landmark judgment of the Constitutional Court has confirmed an order by the High Court that the Copyright Act, in particular sections 6 and 7, read with section 23 of the Copyright Act 98 of 1978, is invalid as it limits the access to books in comprehensible formats, meaning braille, for blind people.

Since the WTO waiver announcement in June 2022 the WHO mRNA Technology Transfer Hub, which is headquartered in South Africa, was established as a response to global inequities in Covid-19 vaccines access. The hub may face some intellectual property challenges in the face of granted patents on mRNA technology. The introduction of substantive examination would be critical in rejecting broad patents which could create barriers to introducing the vaccine to people in the South African market.

As reported earlier the European Unified Patent Court (UPC) is likely to open its doors in 2023. Apart from decisions patentee's will have to make, i.e., whether to turn a patent granted by the EPO into a patent with unitary effect; or if chosen not to register with unitary effect, whether to 'opt-out' the conventional EP from the exclusive jurisdiction of the UPC, and, if so, whether and when to subsequently withdraw the 'opt-out; a proper review of patent license agreements would be necessary. Should a licensee who has been responsible for prosecution of an application have the power to choose between a unitary and conventional European patent, and whether or not to opt-out, or withdraw an opt-out? How does a licensor balance the interests of one licensee whose preference may be to use a reputable national court to bring an action for infringement, against the interests of all other licensees who may prefer to select the UPC over smaller national courts where such licensees happen to operate? The suitability of patent licenses is something to consider by all licensors and licensees of European patents.

"The world as we have created it is a process of our thinking. It cannot be changed without changing our thinking." – Albert Einstein



Primary Trade Mark Infringement - Will the Time Come When We Have to Laugh It Off?

By Owen Salmon

Source: in.pinterest.com

Primary infringement is the expression used, loosely, to refer to the infringement of a registered trade mark in terms of section 34(1)(a) of the Trade Marks Act 1993. This addresses unauthorised use of a trade mark which is confusingly similar to a registered trade mark, if the use is in relation to goods or services covered by the specification of the registration.

The Act also provides protection to the registered proprietor against the unauthorised use of a similar mark in relation to goods or services similar to those specified in the registration - this is section 34(1)(b). And, in terms of section 34(1)(c) of the Act, there is also protection against the dilution of rights in a registered trade mark, which is well-known, whether by blurring or by tarnishment.

The case of Laugh It Off Promotions CC v SAB International (Finance) BV
2006 1 SA 144 (CC)

concerned the dilution provisions. More particularly, the decision concerned the interface of the Constitutionally entrenched right to the

by the SCA to be - tarnishing use of a parody on SAB's well-known Black Label logo.

In short, the Constitutional Court recorded that the starting point must be the right entrenched by section 16 of the Constitution, which states:

(1) Everyone has the right to freedom of expression, which includes-

- (a) freedom of the press and other media;*
- (b) freedom to receive or impart information or ideas;*
- (c) freedom of artistic creativity; and*
- (d) academic freedom and freedom of scientific research.*

(2) The right in subsection (1) does not extend to-

- (a) propaganda for war;*
- (b) incitement of imminent violence; or*
- (c) advocacy of hatred that is based on race, ethnicity, gender, or religion, and that constitutes incitement to cause harm.*

The rights can be limited, according to section 36 of the Constitution, but only by law of general application - and then, to the extent that

the limitation is reasonable and justifiable in an open and democratic society based on human dignity, equality, and freedom, considering all relevant factors. These include:

- (a) the nature of the right;
- (b) the importance of the purpose of the limitation;
- (c) the nature and extent of the limitation;
- (d) the relation between the limitation and its purpose; and
- (e) less restrictive means to achieve the purpose.

In order to assess whether it is thus to be limited, a balancing exercise therefore must take place - a proportionality reckoning, in other words. As Justice Moseneke stated in Laugh It Off:¹

A Court will have to carefully weigh the competing interests of the owner of the mark against the claim of free expression of a user without permission.

In the weighing up process, the injunction to construe statutes consistent with the Constitution means that, where reasonably possible, the Court is obliged to promote the rights entrenched by the Constitution. Put differently, the bounds of the Constitutional guarantee of free expression generously impel a construction of the section most compatible with the right to free expression. The infringement provision must bear a meaning which is the least

destructive of the free expression right. The reach of the statutory prohibition (that is, here, section 34(1)(a)) must be curtailed to the least intrusive means necessary to achieve its purpose. The exercise calls for an evaluation of the importance of the purpose, nature, extent, and impact of the limitation of free expression, and this in turn postulates an understanding of the internal requirements of the section through the lens of the Constitution.

The facts in Laugh It Off should be well known, as will be the outcome. In its judgment, the Constitutional Court held that, in the absence of evidence establishing that SAB had suffered damage to its business in beer as a result of what was (non-competing) use of the “Black Labour - White Guilt” logo on T-shirts, there was no justified limitation (imposed by section 34(1)(c), in other words) on the entrenched right, which therefore survived.

One takeaway point from the Laugh It Off decision is the recordal that if expression is not excluded (in terms of section 16(2) of the Constitution) then it is Constitutionally protected expression. So, *all* expression, if not thus excluded, falls for protection under the entrenched right - and this includes commercial expression. SAB did not contend that the parody was not commercial expression, and as the parody had to be a “mark” for SAB competently to invoke the provisions of section

¹ Paragraph 40

34(1)(c) of the Act, it seems that a trade mark must have been accepted as being commercial expression. As Justice Moseneke stated:²

s 34(1)(c) seeks, in effect, to oust certain expressive conduct in relation to registered marks with repute. It thus limits the right to free expression embodied in at least s 16(1)(a) to (c) of the Constitution.

Given that the entrenched rights must be interpreted liberally, the chances of a trade mark in use being held *not* to be commercial expression are, I would think, remote indeed.

That being so, does this have a bearing on primary infringement? It is tempting to dismiss the notion outright as being somewhat avant garde; but so, what if it is novel? Justice Moseneke opened his judgment in Laugh It Off with the comment that the issue was 'novel'. Fact remains trade marks constitute commercial expression and, until Laugh It Off is overruled (or Parliament legislates), commercial expression is constitutionally protected. It - the use - can only be stopped if the proportionality reckoning shows the interdict more justified than the entrenched right. On the facts of Laugh It Off, this is quite some ask, but it would seem to be postulated of an applicant for interdict relief.

Here's how - and why - the balancing exercise would work in primary infringement.

Imagine the following scenario. Joe Bloggs owns a successful second hand motor vehicle dealership in Roodepoort, Gauteng. He is a former Provincial wrestler and rugby player. His business is called Big JB's, after his nickname in the neighbourhood. He runs a website, does some local advertising, and the main slogan he punts is "Bigger Wheels Deals at Big JB's". He is also registered as a micro-lender. He does not have a business, or reputation to speak of outside of Roodepoort, but he has registered the phrase "Bigger Wheels Deals" as a trade mark in the classes covering general retail, business, and financial services.

The semiconductor chip scarcity a thing of the past, new vehicles become readily and widely available and prices start to fall (just go with me on this, the example is fictional...). One of the big banks, XYZ, commences a nationwide campaign in which it promotes its credit facility offerings with, amongst others, the slogan "Look No Further than XYZ for Bigger Wheels Deals." Our Roodepoort wrestler is annoyed and, not one to stand back from a barney, Joe Bloggs launches proceedings. Of course, an interdict is a fairly harsh measure, giving rise to a remedy in royalties as well.

Leaving aside considerations of registrability and *bona fide* use defences - at least, for the moment - we have the following position concerning infringement. Initially, let's recap on section 34(1)(a): the registration of a trade

² Paragraph 48

mark is infringed by the unauthorised use, in the course of trade in relation to services for which the trade mark is registered, of a mark so nearly resembling the registered trade mark as to be likely to deceive or cause confusion.

- First, the slogan “Look No Further than XYZ for Bigger Wheels Deals” is not authorised by Joe Bloggs;
- Its use by XYZ is in the course of trade in relation to services covered by the registration; and
- In that the XYZ slogan incorporates the whole of the registered mark, “Bigger Wheels Deals”, arguably, it so nearly resembles the registered mark as to be likely to deceive or cause confusion.

Prima facie, there is a reasonable case on infringement for XYZ to answer.

But does Laugh It Off not say that the point of departure is XYZ’s entrenched constitutional right to the freedom of commercial expression? This has not been determined in any primary infringement case of which I am aware, but should it not be?

How else does one read the dictate of Laugh It Off?

Indeed, does the Court not have an obligation to interpret legislation in a manner that

promotes the spirit, purport, and objects of the entrenched rights? It does, according to section 39(2) of the Constitution.

Put differently, perhaps, is the onus properly on a Respondent to raise this Constitutional point if that is, anyway, the Court’s point of departure - as mandated by the Constitutional Court? And, moreover, does the evidentiary burden not swing on to an *applicant* to demonstrate why its registered trade mark right trumps the Constitutionally entrenched right to freedom of expression?

Interesting questions, indeed.

Back to Joe Bloggs. The XYZ slogan is undoubtedly commercial expression. Here are some factors, in my view, why the registered trade mark rights would not prevail.

First, and foremost, just as Justice Moseneke noted that the purpose of section 34(1)(c) was to protect the advertising value or selling power of the well-known trade mark (the ‘commercial magnetism’) we must be clear about the underlying rationale of section 34(1)(a) of the Act. Surely it protects the proprietor’s trade in the goods or services for which the mark is registered? If not, what business does the section have, being concerned about marks likely to deceive, or cause confusion?

That quality is only relevant because, being extant, it will likely lead to a diverted purchase – a sale lost to the proprietor.

It is understandable that infringement can occur in circumstances where the registered proprietor has never used its mark, but here we are talking about the underlying rationale of the protection.

Indeed, for that matter, let's consider the proprietor's non-use. A trade mark is a *mark* to be used in *trade*, after all. If a registered right – a privilege granted by Parliament – has not been exercised, is it justified? The use-it or lose-it provisions say not – but, more pertinently, what about the postulated proportionality? Should the rights in a registered mark be enforced, when it is not being used – rather, does the naked registered right outweigh the constitutionally entrenched right? Why? The fact of registration does not bestow on the mark some mystical or sacred magnificence. In my view, if there is to be this proportionality reckoning, the proprietor's non-use gets it off to a bad start.

What about our man of the moment? His registered right protects the trade brought about by his 'Bigger Wheels Deals' badge of origin, but Joe Bloggs only uses his slogan in Roodepoort. What is the rationale for the registered right to be enforceable in Cape Town, or Durban? The interdict sought will impact XYZ nationwide, but Joe Bloggs cannot show any business interest outside of Roodepoort.

Does such geographically-restricted real interest stack up to trounce the Constitutionally-granted freedom for XZY to use "Look No Further than XYZ for Bigger Wheels Deals" in its nationwide ad campaign?

And then, Joe Bloggs does not really have any business operation in the sphere in which XYZ uses its slogan; he sells vehicles, it sells credit facilities. So, his interdict application is not designed to protect his mark as a badge of origin – remembering the purpose of section 34(1)(a). He does not make use of the registered trade mark other than in relation to his trade in motor vehicles, and perhaps micro-lending services. The specification of his registered trade mark includes (generically) "financial affairs" – which is for what XYZ uses its slogan, but such a broad specification is not really warranted for a trade in micro-lending. Moreover, Joe Bloggs could not show any loss of business, or any other harm for that matter – actual or likely – as a result of XYZ's marketing pitch. In addition, XYZ does not use the slogan "Look No Further than XYZ for Bigger Wheels Deals" in a trade mark sense – it is not a badge of origin, it's just marketing jive. Lastly, the term "Bigger Wheels Deals" is arguably non-distinctive in relation to financial services, so raising questions about registrability in terms of the Trade Marks Act – a weak mark, in other words. Concomitantly, XYZ's use arguably constitutes the *bona fide* use which the statutory defence of section 34(2)(b) shelters.

When once these factors are all put together, it is not a stretch to conclude that there is not much of a basis to outweigh the Constitutionally entrenched right. Result? No infringement.

Ed Sheeran complained a few months ago in the context of an alleged copyright infringement case in which he was involved:

There's only so many notes and very few chords used in pop music. Coincidence is bound to happen if 60,000 songs are being released every day on Spotify. That's 22 million songs a year and there's only 12 notes that are available.

I wrote fairly recently³ in a similar context concerning trade marks:

The problem is that there are only 26 letters in the alphabet of the languages we use in South Africa.... The permutations of 26 letters into intelligible word forms are manifold, no doubt, but they are also significantly limited. Just consider that a word trade mark should, ideally, be capable of audial reproduction and immediately the scope shrinks dramatically.

These problems of the crowded spaces could well be addressed by the Constitutional imperative addressed in this article. The Joe Bloggs example might not match the classic primary infringement situation and,

obviously, each dispute has its own facts wherein the balancing will encompass myriad issues, varying from case to case.

In straightforward counterfeit situations, for example, the balancing would likely be a no-brainer. However, as the facts incrementally portray less competitive roles, 'weaker' trade marks, the absence of any prospect of business damage, and so on, the balancing postulated by the impact of the entrenched right can only serve to produce an authentic result - fair, reasonable, and justifiable.



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³ "Statutory Trade Mark Infringement and Questions About Confusion" - (2019) IPLJ 163 at 173

Can AI invent? Courts around the world weigh in.

By Dr Joanne van Harmelen

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The question of whether artificial intelligence ("AI") can be listed as an inventor on a patent application is a highly topical issue, given the exponential use of AI in a myriad of different technologies.

A seminal player in this landscape is Dr Stephen Thaler, the CEO, and president of Imagination Engines. Dr Thaler is the applicant in a number of patent applications where the inventor of the patent was listed as DABUS (a device for the autonomous bootstrapping of unified sentience), a type of AI system.

USA and Europe

Patent Offices in the USA and Europe have already rejected patent applications filed by Dr Thaler where DABUS was listed as the inventor, confirming that the patent laws in these territories do not recognise AI systems as inventors.

In the USA, the Virginia Eastern District Court affirmed the USPTO's refusal of Dr Thaler's applications, based on the plain statutory language of the U.S. Patent Act and Federal Circuit authority that an AI machine cannot be an inventor because an inventor must be an "individual," i.e., a natural person. On appeal to the Federal Circuit, the court agreed, holding that "[T]here is no ambiguity: the Patent Act requires that inventors must be natural persons; that is, human beings... Congress has determined that only a natural person can be an inventor, so AI cannot be." Dr Thaler's legal representatives plan to appeal this decision, indicating that they are of the view that "The court adopted a narrow and textualist approach to resolving the key issues in this case that ignored the purpose of the Patent Act and the outcome that AI-generated inventions are now unpatentable in the United States. That is an outcome with real negative social consequences. We do plan to appeal."

The European Patent Office Board of Appeal after an oral hearing on 21 December 2021 confirmed the preliminary view of the Board rejecting Dr Thaler's patent applications, finding that "under the European Patent Convention (EPC) the inventor designated for the purpose of a patent application must be a person having legal capacity."

South Africa

Last year, the South African Patent Office made headlines around the world by issuing a patent filed by Dr Thaler where the AI system, DABUS, was listed as the inventor.

However, it certainly seems that the South African Patent Office's approach will be an exception to the rule, and given that there is no substantive examination of patent applications in South Africa, it is fair to assume that the granting of this patent was of fairly limited significance.

Australia

More recently, the Australian courts have considered the same question with regard to Dr Thaler's corresponding Australian patent application. The Australian Deputy Commissioner of Patents had originally rejected the application since no human inventor was named.

However, when this decision was taken into review, a judge of the Federal Court of Australia found that although ownership of a patent is limited to the inventor or the person who derives title from the inventor, the term "inventor" is not defined in Australian legislation. According to the court, there is nothing in the legislation that excludes an inventor from being a non-human AI device or system.

The position in Australia has been brought in line with the majority of Patent Office decisions now though, as when the decision of the judge was taken on appeal, the Full Court of the Federal Court of Australia reversed the decision of the lower court. The Full Court said that "the origin of entitlement to the grant of a patent lies in human endeavour." In other words, an inventor must be human.

UK

Similarly in 2021, with regard to Dr Thaler's corresponding UK patent applications, the UK Court of Appeal ruled against Dr Thaler, who had argued that DABUS should be recognised as the inventor. In this case, the judge, said, "Only a person can have rights – a machine cannot...a patent is a statutory right and it can only be granted to a person."

According to a recent UK IP Office ("UKIPO") announcement, it is unlikely that things will change anytime soon. The UKIPO recently announced that it is of the view that, as things stand, an AI system cannot be the inventor for the purposes of patent law. This announcement followed a UKIPO investigation which established that there is much doubt among experts as to whether AI can invent without human assistance.

The UKIPO acknowledged that it will have to keep its eye on the ball – it said that it will need to "understand how our IP system should protect AI-devised inventions in the future." It further undertook to be involved in international discussions on the issue in order to ensure that the UK remains competitive.

Further findings

The UKIPO made some further findings relating to AI developed inventions:

- No changes to patent law are envisaged.
- No changes are required regarding copyright protection for computer-generated works, in other words, works that are made without a human author. These works are protected under the UK legislation, the Copyright, Designs and Patents Act 1988. Section 9(3) defines the "author" of such a work as "the person by whom the arrangements necessary for the creation of the work are undertaken."
- UKIPO will, in due course, grant a new copyright and database right exception to allow for text and data mining (TDM) – an activity that is often beyond the scope of humans – for any purpose, not simply non-commercial purposes.



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Copyright, a right to copy, right?

Copyright is an assignable right, or is it?

Copyright is an intellectual property right that vests automatically. The question arises, whether the right has international enforcement due to the nature of the right.

Copyright subsists the moment it meets the two basic criteria that qualifies the work to be protected by copyright, i.e. originality and reduction to material form. This begs the question, is it then an international right?

The mere creation vests an international right despite per-country-national legislation. Or does it not? International instruments such as TRIPS and the Paris Convention addresses the authorship and enforcement of copyright by its members.

In terms of the Trade Related Aspects of Intellectual Property (TRIPS) Agreement under the General Agreement on Tariffs and Trade (GATT). Signatories to the GATT are required to implement national laws of a basic international standard and establish procedures for the effective enforcement of the copyright of national and foreign rightsholders.

The Berne Convention deals with the protection of copyright works and the rights of their authors and sets the minimum standards of protection that its members should grant copyright creators. Three basic principles are defined , i.e.

1. Works of an author which is a national of a contracting member state must be given the same protection in each of the other contracting member state as the latter grants to the works of its own;
2. Protection must not be conditional upon compliance with any formality - it must thus be automatic; and
3. Protection is independent of the existence of protection in the country of origin of the work.

The Berne Convention sets the minimum duration that copyright will apply in various types of work and defines, for the duration of copyright, the exclusive rights which requires the permission of the copyright owner. These are:

- The right to authorise translations of the work.
- The exclusive right to reproduce the work, though some provisions are made under national laws which typically allow limited private and educational use without infringement.
- The right to authorise public performance or broadcast, and the communication of broadcasts and public performances.
- The right to authorise arrangements or other types of adaptation to the work.
- Recitation of the work, (or of a translation of the work).
- The exclusive right to adapt or alter the work.

The Berne Convention also provides for the protection of an author moral rights, i.e.

- the right to claim authorship
- the right to object to any treatment of the work which would be 'prejudicial to his honour or reputation.

Each member country may permit certain uses of works in its legislation, such as a statutory licence for reproduction and communication of works by educational institutions. The Berne Convention limits the impact of such exceptions to the copyright owner's exclusive rights by providing that the normal exploitation of the work and legitimate interests of the author must not be affected.

In addition to the Berne convention, but less significant (Since almost all countries are either members or aspiring members of the World Trade Organization (WTO), and thus comply with the Agreement on Trade-Related Aspects of Intellectual Property Rights Agreement (TRIPS), the UCC has lost significance.), is the Universal Copyright Convention (UCC). The UCC is an international instrument that was drawn up in 1952 under the auspices of UNESCO. The UCC was concluded in an attempt to incorporate a greater number of countries into the international copyright community.

The UCC contains the following generally recognized principles of international protection of copyright:

- (a) requirement for the adequate and effective protection of copyright at the national level;
- (b) the national treatment of foreign authors;
- (c) replacement of the obligatory formalities as a condition of copyright by the copyright notice;
- (d) the minimum terms of protection;
- (e) the exclusive right of translation ;
- (f) the notion of publication of a work;
- (g) non-retroactivity;
- (h) the system of compulsory licences in favour of developing countries.

Not all rights are equal

Although copyright protection, in the majority of countries, is obtained automatically without the need for registration or other formalities, most countries nonetheless have a system in place to allow for the voluntary registration of works.

Despite the international conventions, there is no “international copyright” that will automatically protect a work throughout the world. Protection against unauthorized use in a particular country depends on the national laws of that country.

The vesting of the right, in the opinion of the author, is an international right, by the true nature of the right, the enforcement thereof, I however a jurisdictional matter, which tips the scale to the unbalanced side.

If a right vests automatically when the work is created, the default position in terms of copyright law is that the creator owns the work created – the author-owner concept.

An author-owner is free to assign copyright to anyone. Outsourcing work to freelance consultants such as software development, website development, creation of logo’s, designs and drawings, are thus owned by the person which authored them. A written contract can change this basic rule. As an example, many publishers require assignment of copyright as a condition of publication.

In some jurisdictions legislation prescribe certain categories for commissioning of a work (work-for-hire) , where such commissioning of the work is in writing and signed by the creator or creators before the work begins.

In an employment relationship the creator-owner rule generally does not apply. Work created by an employee in the course and scope of the employees’ employment, belongs to the employer.

Works for hire, on the other hand, requires a contractual arrangement between the creator and hirer to transfer copyright ownership.

There are two ways by which a copyright owner can transfer some, or all, rights to copyright, i.e. either through a license or by assignment.

A copyright assignment is when the copyright holder transfers **ownership** of the copyright to another person or organisation. A license is a limited assignment and the copyright owner still retains certain rights to the work. A license is often preferred over an assignment when the copyright holder wishes to maintain and exercise some ownership control over the rights and how the licensee uses the copyright holder's rights

A valid assignment of copyright must be in writing and signed by, or on behalf of, the copyright owner/assignor. The subject of the assignment must be clear as to what copyright is being assigned in which work(s).

A copyright license, i.e. the permission to use a copyright work, does not have to be in writing, unless it is an exclusive license. A license can be oral or arise by implication when considering all of the facts and circumstances surrounding the transaction between the copyright owner and the purported licensee. For example, when a website is made available on the world wide web, an implied licence is granted to internet users to copy that website for the purpose of viewing it on a web browser. However, the exact scope of implied and unwritten licences may be unclear.

The territoriality conundrum

The vesting of copyright may be international, but copyright protection, however, remains territorial in nature. A work will only enjoy copyright protection if it meets the legal requirements of the copyright law of the country where protection is sought.

The scope of the right and the assignability thereof is also a matter of territorial nature.

Of specific importance is the creation of a work by more than one author from more than one employer, where the authors, and the employers, are of different nationality and based in different countries and the work is commissioned on the understanding that the product qualifies as a work-for-hire.

Under the work-for-hire doctrine, the employer or the company that has commissioned the work is considered the author and automatic copyright owner of the work.

Not all jurisdictions acknowledge the assignability of copyright works. In a scenario where a copyright work is completed as a “work for hire”, the jurisdiction of the creator of the work becomes relevant.

For example, German copyright law does not recognise the ‘work made for hire’ doctrine. Even when an employee creates a work in the course of employment, the employer will not become the owner of the copyright; and an independent contractor will remain the owner of the copyright work created. An author/creator can however grant licences to other persons authorising the use of the copyright work.

The right of a licensee is more restrictive than an owner right. Where the subject of the copyright work is a design for a product or equipment that is needed by the commissioner of the work for commercial exploitation or use, the impossibility of ownership could have severe economic impact. It is thus important to verify on works-for-hire whether ownership in the work is transferable, or whether the only possible right may be a license, thus depriving the “contractual” owner of copyright enforcement.

A comparative analysis of some countries assignment possibilities and requirement for assignment recordal in official registries are tabled below.

Jurisdiction	Formalities for assignment of copyright	Registration requirements	Form of Assignment of copyright required to be effective against a third party
Brazil	Assignment must be in written form and signed by both the assignor and the assignee.	Copyright can be registered, although it is not mandatory. Registration can serve as rebuttable evidence of creation and ownership.	Copyright law 92610/98 no longer requires the recordation of the assignment of an existing registration for it to be enforceable against third parties.
Canada	To be valid, the assignment must be made in writing and signed by both the assignor and the assignee	The assignment does not have to be registered or recorded but can be registered.	Written assignment signed by both assignor and assignee.
Chile	Works of authorship can be registered in Chile before the Department of Intellectual Rights (DDI).	In order to be valid, assignments of copyrights should be registered with this same institution within a 60 day term following execution of the assignment document.	Formalities of assignment require the signature of the assignment document in the presence of a notary public and if executed outside of Chile, the assignment must be apostilled.
China	Owner may assign ownership provided it is in writing and signed by both assignor and assignee. Personal rights can only belong to the author because they cannot be assigned or inherited	Not compulsory. The Copyright Protection Centre of China provide such services. The applicant must complete an online application form and submit the materials requested for recording to the Centre. Materials include the application form, the transfer contract, the identification certificate of the applicant, the registration certificate of the rights and the search results for the registration of the rights, if available.	Written assignment signed by both assignor and assignee.
France	Only performance, publishing and audio-visual production agreements, and free performance authorisations must be in writing (<i>Article L. 131-2, IPC</i>). Considering the importance of mandatory clauses in copyright assignment under Article L. 131-3 of the IPC, it is recommended that a written agreement be entered into.	Copyright arises automatically from the mere act of creation, that is, no registration is required. It is however recommended to proceed with some sort of filing (for example, via an <i>enveloppe Soleau</i> or with a bailiff) so as to evidence the date of creation of the work.	Written assignment signed by both assignor and assignee.

Germany	Copyright cannot be assigned, only licensed. There are generally no formal requirements for copyright licences. Licences covering future works that are not specified, or are only referred to by type, must be in writing.	Copyright cannot be registered.	Not applicable
Gibraltar	In writing and signed by the assignor.	Copyright cannot be registered.	If assigned as a deed, it must be clear that the document is a deed. Executed and delivered as a deed.
Hong Kong	An assignment of copyright must be in writing and signed by the assignor, or in the case of a body corporate, signed or under the seal of the corporate body.	Copyright cannot be registered in Hong Kong.	Written assignment signed by both assignor and assignee.
India	Assignable in writing, or by inheritance. An assignment may be general, i.e., without limitation or an assignment may be subject to limitations. It may be for the whole term of copyright or any part thereof. An assignment transfers an interest in and deals with copyright itself as provided under section 14 of the Act.	Can be registered. If the copyright in a work has been registered with the Copyright Office and its particulars have been recorded in the Register of Copyrights, then transfer of ownership may be recorded in the Register pursuant to an application to the Registrar of Copyrights in a prescribed form, along with a prescribed fee.	Written assignment signed by both assignor and assignee.
Indonesia	A copyright assignment must be executed in writing by the assignor and assignee.	To ensure optimum protection, copyright can be recorded with the Directorate General of Intellectual Property (DGIP).	An assignment of copyright must be recorded with the DGIP.
Ireland	An assignment of the copyright in a work, whether in whole or in part, is not effective unless it is in writing and signed by or on behalf of the assignor.	No, copyright cannot be registered.	Written assignment signed by both assignor and assignee.
Italy	A written assignment is preferable, signed by both parties and including specific provisions on the rights of the seller (if purchased, from whom and which rights) and a clear indication of what kind of rights are assigned.	Copyright can be registered at the Italian Society for Authors and Producers. It is not mandatory.	Copyright is protected and effective against third parties even without registration. Written assignment signed by both assignor and assignee.
Japan	Copyright cannot be assigned in Japan.	Copyright can be registered.	Copyright must be registered to be effective against a third party.
Malaysia	Copyright can be assigned like a personal property, all or part of it. Assignment must be in writing. No formal requirements. Future copyright can be assigned that is copyright that will exist once the work is made in order for the copyright to be transferred automatically by law as soon as the work comes into existence.	Copyright (amendment) Act 2012, an easy access was made for the copyright owners to notify the IPCM of any copyright, through the Voluntary Notification System. This is done willingly and does not hinder the necessities of non-formality under the Berne convention, to enjoy and practice copyright protection.	Copyright must be registered to be effective against a third party.
Malta	A copyright assignment must be in writing and signed by or on behalf of the assignor.	Copyright is granted automatically by application of the law. There is no copyright registration under Maltese law.	An agreement in writing is sufficient for enforcement against third parties in the Maltese courts, or to be effective with regards to third parties.

Mexico	Acts, agreements and contracts by which the owner of the economic rights is assigned must be in writing, signed by the assignor and assignee, temporary and for consideration.	Yes, copyright can be registered.	Any assignment by which economic rights are transferred must be recorded with the Mexican Copy Office to be effective against third parties.
Paraguay	A document of assignment is required, executed by the assignor and assignee, in Spanish or translated by a Sworn translator. Legalisation is required. A power or attorney document (legalised) granted by the assignee	Copyright need not be registered but an assignment of copyright must be recorded as a deed.	The assignment must be recorded to be effective against a third party.
Romania	Although no formalities are required for validity of the assignment, proof of its existence and the terms of the agreement can only be made in writing, signed by the parties.	Copyrighted works can be optionally registered with the Copyright Office, but this is not a condition for protection. Assignment of copyright (in registered or non-registered works) can but need not be registered.	Written assignment signed by both assignor and assignee.
Russia	Written form and signed by both assignor and assignee	Some forms of registration are possible, e.g. software and databases can be optionally registered with Rospatent.	For enforcement against third parties, the assignment of copyright vested in the registered software or database must be registered.
South Africa	A valid assignment of copyright must be in writing and signed by or on behalf of the assignor.	In general, copyright cannot be registered and the recordal of an assignment of copyright on a register is therefore not possible. Cinematographic films can be registered.	In practice, copyright assignment agreements are entered into between the parties for clarity or to enable a party to bring infringement proceedings.
Spain	An assignment must be in writing and must specify the rights assigned and the duration of the assignment. If not specified, the duration will be five years by default.	Registration is not mandatory to validate the assignment.	Parties can register the assignment in the General Registry of Intellectual Property. Registration ensures effectiveness of the assignment against a third party.
Switzerland	Copyright is transferable by assignment or by inheritance. Moral rights (e. g. the right of recognition of authorship and the right of integrity of work) are not assignable.	No.	Written assignment signed by both assignor and assignee.
UK (England and Wales)	An assignment of copyright must be in writing and signed by the assignor. Must be executed and delivered as a deed.	There is no copyright registration system in the UK.	Written assignment signed by both assignor and assignee.
United Arab Emirates	In writing, signed by both parties, as consideration is a requirement.	Copyright can be registered. The assignment needs to be notarised and legalised for it to be recorded.	The copyrights and the assignment must be recorded for the assignment to take effect against third parties.
United States of America	Copyright is transferable by assignment, license, mortgage or security. It can also be transferred by inheritance or by involuntary transfer, for example, bankruptcy, mortgage foreclosure, or divorce by court order.	In general, registration is voluntary. Copyright exists from the moment the work is created. You will have to register, however, if you wish to bring a lawsuit for infringement of a U.S. work (https://www.copyright.gov/registration/)	Written assignment signed by both assignor and assignee.



Andre van der Merwe

Andre is a former director of Kisch IP and is now a retired patent and IP attorney



UNCERTAIN TIMES FOR SOUTH AFRICA AND ITS IP LAW?

and equitable access to such vaccines (and related medication).

These vaccines, as with most new pharmaceuticals, are invariably subject to patent protection, and the issue of so-called “patent waiver” had reared its head in recent times, and South Africa’s president, Mr. Cyril Ramaphosa, had mentioned this issue in some of his speeches dealing with the Covid-19 pandemic and the availability of vaccines.

Africa, in particular sub-Saharan Africa, had lagged behind the world in vaccination against the Covid-19 virus and its variants. Although the low rate of vaccination had a number of causes or reasons that have been identified by various authors, the main reason had generally been the shortage of vaccines and hence the lack of access to sufficient vaccines – also referred to generally as “vaccine inequity.” Another reason advanced is that of insufficient know-how transfer more particularly by the leading vaccine-producing companies.

This “vaccine inequity” had been blamed (-wrongly, it is submitted) on the patent system that serves to protect these vaccines, and that allegedly prevents developing countries from importing larger supplies of vaccines (or of course potentially manufacturing their own supplies of vaccines). This is unfortunately a facile and totally uninformed view and is quite baseless.

INTRODUCTION

South Africa, together with the rest of the world, had experienced considerable uncertainty since 2020 with the Covid-19 pandemic, its impact, and its associated lockdowns.

The Covid-19 pandemic has certainly affected various aspects of our lives and *inter alia* had spilled over into South Africa’s intellectual property (“IP”) legal regime. Other (unrelated to Covid) developments and matters affecting our IP law have also contributed to the overall uncertainty that South Africa’s IP law is experiencing at present.

PATENT LAW ISSUES

Patent Waiver and South Africa’s Application to the WTO

Developing countries had generally not been able to acquire sufficient supplies of Covid vaccines, and this had raised the question of world-wide fair

However, the patent system had been seized upon as the convenient “whipping- boy”, and certain parties had realized that the means for overcoming the perceived “blocking” of access to vaccines by patents was by way of patent waiver.

Those familiar with patent waiver are aware that it can be granted in principle by the World Trade Organization (“the WTO”) in terms of the WTO’s Trade-Related Aspects of Intellectual Property Rights Agreement (-abbreviated to the “TRIPS” Agreement) which provides for patent (infringement) waiver to be granted to a member country of the WTO in certain circumstances such as a national emergency or other circumstances of extreme urgency - which would include a situation such as the Covid-19 pandemic. Patent waiver allows an applicant country to freely manufacture and use (and/or or import and use, and even export) one or more vaccines without infringing the relevant patent(s) in the applicant country. Such a grant would invariably have a limited purpose and period.

In March 2020 the World Health Organization (the “WHO” - an agency of the United Nations) had declared the Covid-19 outbreak to be a pandemic. Subsequently in October 2020 South Africa, which is a signatory to the TRIPS Agreement, and hence is able to apply to the WTO for patent waiver, had submitted such an application for patent waiver in respect of patents protecting Covid-19 vaccine(s). Incidentally and interestingly, at that time India (which has an extensive pharmaceutical industry) had also submitted an application to the WTO for patent waiver in respect of Covid-19 vaccines.

To the knowledge of the author hereof, the WTO had not granted, nor even received, a patent waiver application under this provision of its TRIPS Agreement prior to the abovementioned South African application (and that of India), and hence this was an unknown path for the WTO and South Africa/India. It is clear that granting by the WTO of patent waiver is a serious matter that would not be easily or lightly granted. The patent “home” country of a Covid-19 vaccine patent (and probably other major pharma-based countries)

would understandably be inclined to oppose such a patent waiver application because its grant would generally be financially prejudicial not only to a Covid-vaccine patentee but also to its home country, at least for a period.

Accordingly, the WTO would have been required to conduct a critical due diligence examination of all relevant factors such as availability and affordability of vaccines in the applicant country, efforts made to obtain a voluntary licence (and of course patents/patent applications in the applicant country?) before deciding such a patent waiver application on its merits.

It appears from a recent article entitled “Patents cannot be blamed for inequitable access to Covid-19 vaccines” by *inter alia* Dr Ulrich Storz, published in the Institute’s IP BRIEFS Newsletter of March 2022 (Volume 1, Issue 9), bearing in mind the very recent development of these vaccines, that the authors of that article had identified 3 international patent applications filed under the Patent Co-operation Treaty (“PCT”) system (or so-called international patent “families”) relating to Covid-19 mRNA vaccines *per se*. These patent applications had been filed respectively by (and in the names of) Moderna, CureVac and BioNTech. Those authors have also reported that no corresponding national applications had yet been filed in the countries of interest to the patent applicants (-and none in South Africa). This being the case and bearing in mind that such national applications will still have to be examined and granted, could take a few years to be finalized. Accordingly, these patent applicants do not as yet have any granted patents or patent infringement rights that they could enforce in South Africa. Factually, therefore, at least at the time of writing that article, it appears that there was no South African granted patent (or patents) in respect of which the WTO can grant a patent waiver - unless such patent waiver was to be granted subject to a patent (or patents) being granted in South Africa at some future time.

Interestingly, it appears from the above-cited article that these three patent families overlap to a certain extent in their technology coverage, and hence it is possible that legal disputes may arise

between these parties and/or involving a third party (such as the National Institute of Health (“NIH”) of the USA, which claims to have certain (relevant) rights as against Moderna and its PCT patent application).

A further factor is that consensus by the WTO’s 194 member countries is required, and apparently certain European countries such as Germany had opposed the application - while the USA had indicated its conditional support. With the Covid-19 pandemic having subsided world-wide, and also in South Africa, this would appear to be a major factor in determining whether the WTO should grant any patent waiver. Whatever the considerations, until fairly recently, the uncertainty of the grant of patent waiver was palpable in the IP legal field in South Africa.

Regardless of the above, and as recently as 17 June 2022, the outcome of the patent waiver application for South Africa (and India) became clear when the WTO decided to grant (partial) patent waiver in respect of Covid-19 vaccines. This approval is somewhat unexpected and will likely not have the beneficial impact originally intended essentially because the world-wide demand for these vaccines has reduced dramatically from 2020 when these patent waiver applications were submitted to the WTO. In addition, and a critically important practical consideration namely manufacturing these vaccines from “scratch” (for example based on the contents of any relevant patent specification) requires highly complex nano-technologies, know-how and massive capital investments. All of these resources are not readily (and certainly not presently) available in most developing countries, including South Africa), and would take considerable time to acquire.

Factors such as mentioned above have unfortunately contributed to the grant of this patent waiver being largely academic for South Africa (-but not necessarily for India with its extensive and well-developed pharma industry). For further comment on the South African situation, reference is made to the article entitled “The TRIPS Covid-19 waiver: Too little? Too late?” by Dr Joanne van Harmelen in the Institute’s IP

BRIEFS Newsletter of June 2022 (Volume 2 Issue 9).

Additional/Commercial efforts to obtain Vaccine supplies

While South Africa was awaiting the outcome of its above application for patent waiver from the WTO, certain entities in South Africa were busy looking at other potential, and commercial, arrangements i.e., licensing agreements with major vaccine-producing companies.

The earliest effort reported by the media had been that Aspen Pharmacare had entered into an agreement with Johnson & Johnson for a “fill and finish” production arrangement for its single-dose Covid-19 vaccine at Aspen’s manufacturing plant in Port Elizabeth. Unfortunately, it appears that this effort has not been successful because it has been reported more recently that because of a lack of orders for the vaccine product, this production arrangement may unfortunately be closed down.

Of apparently greater potential and importance, from media reports in July 2021, Pfizer, and the Biovac Institute (which is a partly SA state-owned entity) based in Cape Town had signed a letter of intent preparatory to reaching a “fill and finish” agreement for the Biovac Institute to provide the Pfizer/BionTech (BNT162b2) vaccine locally. This agreement will have its limitations, but it will allow the local entity to import the active and other ingredients from Europe and vial-fill these before packaging and distribution from its high-tech Cape Town facility. This agreement will aim at producing the vaccine in large quantities, starting production in 2022, and increasing to over 100 million doses per year - for exclusive distribution in South Africa and African countries.

The above arrangements - somewhat in conflict with the patent waiver application at that time and raising uncertainty - should also be seen against the general background of efforts by other vaccine-producing companies including the above-mentioned two companies, and Moderna to provide vaccines to developing/poorer countries worldwide. Moderna, for example, in 2021 had delivered more than 200 million doses to low or

middle-income countries and had indicated that this could have been higher but for factors such as lack of refrigeration facilities, transportation problems, limited numbers of health workers to administer the vaccine, and vaccine hesitancy.

However, because of the fairly rapid overall local and world-wide reduction in infections of Covid-19 and its variants, the drop in need and demand for vaccines has made the above commercial efforts - and the grant of patent waiver to South Africa - unneeded, unnecessary and without practical application.

Patent Law and Artificial Intelligence Systems as inventors?

Another aspect of patent law that has raised uncertainty in recent times is the matter of patents when inventions including artificial intelligence ("AI") are patented and when a computer or computer system is cited as the (or an) inventor (-correctly or incorrectly based on the merits of each case).

As is raised in the article "Can AI invent" in this issue of the IP Briefs® this question has arisen in a number of jurisdictions - for example in Australia where a Court has upheld the validity of a patent granted with a computer system as the inventor, in South Africa a patent has recently been granted citing a computer system as the inventor although no substantive examination of the patent application had taken place. However, a formalities examination, including as to the names of the patent applicant and inventor(s), would have taken place.

This has happened while the legal position in South Africa, and generally world-wide, is that an inventor must be a natural person failing which such a patent will be invalid and liable to be revoked by the relevant Court on application by a third party.

The patent applications corresponding to the above-mentioned patents have been refused by the USA Patent & Trade Marks Office and by the European Patent Office, and these patent applications are presently subject to appeal procedures.

The inconsistent situation outlined above has led to a level of uncertainty and concern about the recognition of a computer system as an inventor in AI-based patent applications. The fundamental question is of course whether a computer (or computer system) is capable of totally independent and original thought and creation. Some will argue that human intervention of some kind will always be required with a computer to get it configured to deal with and solve a particular problem - and hence that a human will be the inventor (or at the very least a co-inventor). Others will argue that a computer may in future, if not at present, be able to select a problem of its own choosing, for example finding a cure for a specific medical problem, configure itself for this task with the necessary algorithm(s) and data, and search for one or more possible solution(s) to that problem.

Unless, for example in an appeal procedure in the above US and/or EPO cases, computer experts can bring substantive evidence to show that modern computer systems have the abovementioned capabilities, the respective patent offices, and other patent offices around the world (and also the relevant courts) will continue to demand the "human inventor" criterion.

Although certain countries may wish to proceed on the basis as followed in Australia (and South Africa), this will lead to a lack of international harmony - and hence an undesirable situation in international patent law and practice. The international legal community is generally conservative and would overwhelmingly tend to retain the present human-based approach. However, if the major world approach in future was to accept computer systems as inventors, this should ideally be achieved by an amendment to the Paris Convention through the World Intellectual Property Organization ("WIPO" - an agency of the United Nations).

The "computer inventor" criterion will therefore probably remain an open question, and hence an uncertainty, for some considerable time - until and unless a bold new step may possibly be taken in a different direction in future.

COPYRIGHT LAW ISSUES

Amendments proposed by the Dept of Trade, Industry and Competition (“the Department”) to the Copyright Act have brought considerable uncertainty to our copyright law. Historically, South Africa’s Copyright Act, No. 98 of 1978 (“the Act”) had been drafted closely along the lines of the (earlier) 1956 British Copyright Act and had undergone various amendments in the following years. Following on the report of the Copyright Review Commission in 2011, the Department had drafted the 2017 Copyright Amendment Bill (“the Bill”) containing a raft of proposed amendments to the Copyright Act (and also the Performers’ Protection Bill which will not be discussed herein).

The proposed amendments to the (Copyright) Bill had been strenuously criticized and objected to in 2017 *inter alia* by the Institute and by IP and copyright law experts. In spite of these formal objections, the Bill had been approved by the relevant Portfolio Committee and passed by the National Assembly in 2018. However, the State President had refused to sign the Bill into law and had sent it back to that body (and the Portfolio Committee), in his and his legal advisors’ wisdom, for further revision because of the nature and seriousness of the earlier objections. Thereafter a committee of experts had been appointed to advise the Portfolio Committee of proposed changes, which provided a substantial revision and amendment of the Bill, but the result has unfortunately still not resolved all the earlier criticisms.

The Institute had made written and oral formal submissions in respect of various aspects of the Bill in respect of both versions of the Bill. These submissions included the proposed addition of exceptions for the benefit of blind persons and those with visual and print disabilities (hereinafter “the braille exceptions”) - to avoid copyright infringement; plus, the introduction of a so-called “fair use” basis in the Act; and the unconstitutionality and non-compliance with various international treaties - of a number of specific provisions in the Bill. The Institute had also submitted that a socio-economic impact assessment was required in respect of the

proposed copyright exceptions. Last but not least, the Institute had proposed that the services of an independent Senior Counsel experienced in constitutional law should be engaged to assess and advise on the constitutionality of the Act and the treaty compliance of various provisions of the Bill.

As criticized by the authors Mr. Andre Myburgh and Mr. Stephen Hollis in their article entitled “Controversial Legislation Derailed - South Africa’s Copyright Reform” published in the Institute’s IP BRIEFS of August 2020 (Volume 2 Issue 7), these authors had indicated that, for reasons that remain unclear, the Department (and Government) appear to be wedded to the Bill as the instrument for reform despite its defects having been laid bare by the legal fraternity, by other experts and by industry stakeholders, for all to see.

Regarding the “braille exceptions”, there is no principial or substantive objection to adding these exceptions to the existing exceptions already in the Act. The criticism is merely procedural in that it is not necessary to amend the Act itself because the Act clearly provides in section 13 thereof that any additional exception(s) may quite simply be made by the Minister by regulation published in the Government Gazette. This avoids the unnecessary formality of legislative amendment before Parliament, and the accompanying delay and waste of time especially if and when objections to aspects of a Bill arise - which has been the case here. The Minister may therefore at any time merely promulgate such (additional) braille exceptions by publication of the prescribed notice in the Government Gazette - which could have been done quite simply several years ago by the Minister. This step should be taken as soon as reasonably possible to assist blind and visually impaired persons in South Africa (and foreign countries).

Regarding the proposed introduction of the “fair use” basis or concept in avoiding copyright infringement, this is a concept that is part of, and has developed in, the copyright law of the United States of America. Hence it is foreign to (and different from) South African copyright law which has adopted and developed the “fair dealing”

concept from British law, and which South Africa has followed for many decades. In cases where “fair use” is raised in the US courts as a defence to infringement, this allows the courts to make a very wide enquiry into the particular business of an alleged infringer to determine if its use is consistent with “fair use” or otherwise. Such introduction into our Copyright Act would substantially change the scope, impact, and direction of this aspect of our copyright law - away from that of South Africa and United Kingdom copyright law, in future - and that is unnecessary and hence undesirable in both principle and practice.

Accordingly, the introduction of the “fair use” concept and basis into our Copyright Act is strongly opposed on the merits - but the outcome of this objection is uncertain, and the attitude of the amendment drafters appears to be strongly set in favour of the “fair use” basis. The Bill had therefore become stalled for the above and other reasons in uncertain territory.

While the Bill was “paralyzed” in the above quandary before the National Assembly, Blind SA, an organization representing blind and visually-impaired persons in South Africa, frustrated by the inordinate delay in the progress of the Bill, had brought a formal application to the Pretoria High Court in September 2021 to expedite the amendment of the Act in respect of the “braille exceptions.” The formal application sought relief for the applicant’s members by requesting the High Court to find the Copyright Act unconstitutional in that it unnecessarily and unreasonably limits and/or prevents persons with visual and print disabilities from accessing copyright works - and that it does not include the necessary provisions of the Marrakesh Treaty (to which South Africa has not yet acceded and which aims to facilitate such access for persons who are blind, visually impaired, or otherwise print disabled). The formal application also sought an order *inter alia* to suspend the declaration of unconstitutionality for 12 months to afford Parliament an opportunity to remedy the above defect and to approve the Marrakesh Treaty; and deeming the Act to read as though it contained the

proposed new section 19D contemplated by clause 20 of the Bill. Interestingly, 3 *amici curiae* had been admitted and joined in these proceedings, including the International Community of Jurists.

On 7 December 2021, the Pretoria High Court, had found and declared [pending and subject to confirmation proceedings by the Constitutional Court (hereinafter “the ConCourt”)], the Copyright Act to be unconstitutional and invalid in respect of the above braille exceptions, and suspended the declaration of invalidity on the grounds of unconstitutionality for a period of 24 months to afford Parliament an opportunity to remedy the defect and cure the invalidity in the Act.

Before the ConCourt could hear the confirmation proceedings, Dr Owen Dean, retired IP attorney and copyright law specialist, had applied in his own name to be admitted as an *amicus curiae* of the ConCourt, *inter alia* to comment on the Act, and to provide expert evidence on the Bill, its constitutionality, its treaty non-compliance, and the shortcomings of various of its provisions.

The ConCourt duly heard the above confirmation proceedings of the Pretoria High Court decision on 12 May 2022 and the judgment of the ConCourt is presently awaited - at the date of writing this article (mid-August 2022). Hence until that time the uncertainty of these copyright law issues will remain. Whether or not there will be clarity and certainty regarding the constitutionality of the Act and regarding the braille exceptions, we shall have to await the judgement of the ConCourt on these two particular issues. And what of the other contentious issues in the Bill and its procedural shortcomings?

However, it is clear and important that the National Assembly should await the ConCourt judgment before the National Assembly proceeds with the adoption of the amended Bill because such ConCourt judgment may no doubt affect some, if not all, the contested issues in this matter *inter alia* including the requirement to conduct a socio-economic impact assessment and non-compliance with international treaties, which remain unresolved.

What South Africa sorely needs at present in respect of this Bill is a proper resolution of the other contested issues of the Bill and of course the braille exceptions to aid the needs of the blind, visually-impaired and print-disabled communities. If this could be achieved by the ConCourt coming to suitable findings in the above matter presently before it, that would certainly be greatly welcomed.

On a purely subjective basis by the author hereof, assuming that the ConCourt admits Dr Dean as an *amicus curiae* and accepts his expert views and proposals (in preference to the views of the three *amici curiae* before the Court a quo), a progressive but just, reasonable, fair and welcome finding by the ConCourt, in the difficult and wider circumstances of the Copyright Amendment Bill, that will fully recognize and provide for the needs of the blind, visually-impaired and print-disabled communities, would be well received. Such finding(s) and judgment would, in the respectful opinion of the author hereof, be a judgment in or along the following or similar terms:

-Setting aside the entire order of the Court a quo i.e., paragraphs 1 to 6 of the order of the Pretoria High Court, and substituting it with the following -

- [In principle] finding and declaring that the 1978 Copyright Act (as amended) is valid and constitutional in terms of the Constitution in that it makes clear and express provision for exceptions to be made in terms of section 13 of the Copyright Act that empowers the First Respondent (i.e. the Minister of Trade, Industry and Competition) to make the necessary regulations, as prescribed, for such exceptions - and as required for example for the braille exceptions - with the regulations to be published in the National Government Gazette;

- Ordering the First Respondent without delay to prepare the prescribed notice for the necessary regulations in respect of the abovementioned braille exceptions [-for assistance the full wording thereof is provided in Annexure OHD1 to the affidavit of the *amicus curiae* before this Court], and to publish the prescribed notice/regulations in the National Government Gazette within 1 (one)

month from the date of this judgment, with a copy of such published regulations to be formally served on all parties herein and to be formally lodged with this Court;

- Ordering the Second Respondent (i.e., the Minister of International Relations and Cooperation) without delay to take all steps necessary for South Africa, with Parliament following the necessary procedure, to accede formally to the Marrakesh Treaty, including lodging the necessary formal instrument of accession with the World Intellectual Property Organization [“WIPO”] of the United Nations.

- [Optionally because the ConCourt may decide to deal with the braille exceptions only - and because this term could otherwise be over-reaching-] While respecting the doctrine of separation of powers and the legal rule *iudicis ius dicere non facere*, this Court respectfully refers the balance of the contested issues of the amended Copyright Amendment Bill, as raised and submitted by the *amicus curiae* before this Court, back to the First Respondent and Third Respondent (i.e. the Speaker of the National Assembly) to resolve. Further having found that the legal submissions made by the *amicus curiae* before this Court are both legislatively and judicially sound and hence acceptable, this Court respectfully requests the National Assembly/Parliament to consider accepting the aforementioned submissions, and to pass the thus corrected amended Bill, substituting it for the earlier version of the Copyright Amendment Bill passed in 2018 by the National Assembly but not signed into law by the State President;

- In respect of costs, ordering the First Respondent to pay the costs of the application before the Court a quo and the costs of the confirmation proceedings before this Court, with such costs to include the costs consequent upon the employment of two Counsel, where applicable.

Although the above is speculative (and personal), and whatever the findings and judgment of the ConCourt, until it hands down its findings and judgment, this unknown situation will unfortunately allow the present uncertainties in

respect of South Africa's copyright law to continue.

SOUTH AFRICA AND ITS IP LAW AND AMENDMENTS THEREOF - LOOKING/GOING FORWARD IN GENERAL

A question raised by the author, partly arising from some of the aforementioned matters, is with respect whether (excepting purely technical/mechanistic IP law amendments) a state department with its "top-down" approach is the proper *fons et origo* for new IP law, alternatively for amendments thereof, or whether an "outside" objective body would not provide a broader and better conceptual and objective approach for this purpose. This issue has caused concern and uncertainty among IP practitioners and academics, and hence is raised for consideration and discussion - to explore the way forward and hopefully to ensure a better regime for IP law and hence IP protection in South Africa.

Section 40 of the Copyright Act makes provision for the Minister to appoint a standing IP Advisory Committee having IP expert members, and a High Court judge or a senior counsel as chairperson (and with the Registrar of Patents, Trade Marks, Designs and Copyright as Secretary of the Committee). This Committee had operated for a number of decades, advising the Minister as to new IP laws and amendments to existing IP laws, and would draft such legislation for the Minister's approval and submission to the National Assembly. This Committee had functioned very well over an extended period, under the able chairmanship of former High Court judges Mr. Justice Plewman, thereafter Mr. Justice Louis Harms (highly respected as a High Court judge and later the Deputy Chief Justice of the Supreme Court of Appeal, who had handed down a number of leading appeal court IP decisions and who was widely considered as the leading South African IP jurist at that time), and last but not least Mr. Justice Ian Farlam.

However, this Committee, unfortunately and for reasons unknown, had become moribund about 20 years ago, and the activity of this Committee had simply come to a quiet and inauspicious end. During its active years, and with its expert and balanced membership with some of its members being academics and others having specialized IP law qualifications plus extensive IP law practice and experience, it was viewed as a centre of excellence of IP law in South Africa. As such, it had provided wise and much-needed leadership in the field of IP law and had contributed significantly to making South Africa proud of its world-class IP laws and hence its overall IP legal system.

The author hereof respectfully proposes that this Advisory Committee with its expert committees is revived - in order to provide an invaluable service to our IP legal system and the business/industrial community. Without such excellent services and their delivery, South Africa will in future, no doubt, continue to experience a level of uncertainty in respect of its IP laws.

APPRECIATION NOTE FROM THE INVENTOR ASSISTANCE PROGRAM TEAM

The Companies and Intellectual Property Commission (CIPC) in collaboration with its partner agencies, including the Small Enterprise Development Agency (SEDA), the Technology Innovation Agency (TIA) and the National Intellectual Property Management Office (NIPMO), has been implementing the Inventor Assistance Program (IAP) under the auspices of the World Intellectual Property Organization (WIPO).

The Inventor Assistance Program matches developing country inventors and small businesses with limited financial means with patent attorneys, who provide pro bono legal assistance to secure patent protection (free legal advice on how to file a patent to protect their inventions).

One of the main role-players in the IAP are Patent Attorneys, who provide *pro bono* legal services to assist individual inventors and small businesses secure patent protection. The Patent Attorneys are, therefore, the catalyst in the implementation of the IAP. The provision of *pro bono* legal services has helped to improve access to the patent system for inventors and small businesses with limited financial resources.

South Africa is now approaching 5 years as a participating country in the IAP. This journey would not have been possible without the Patent Attorneys. The IAP team, CIPC and WIPO would like to thank and acknowledge the following legal practitioners for excellent legal services they continue to provide under the IAP:

- James Davies; Colin Mackenzie; Wynand Fourie; and Philip Pla (*Adams & Adams*).
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- Trod Lehong (*Afriqinnov8*).
- Tumelo Mashabela (*Tshaya Mashabela Attorneys*).
- Erik van der Vyver (*Von Seidels Intellectual Property Attorneys*).

We greatly appreciate your services and loyalty over the past few years. We are looking forward to working together in growing the IAP and expanding access to the patent system.

Un grand merci à tous

Ready to support South African innovators transform their ideas into assets? Volunteer to provide your services to the Inventor Assistance Program at <http://iap.wipo.int/>



From the Juta Law Reports

The following judgments were reported June to September 2022

Copyright – Copyright Act 98 of 1978 – Constitutionality of provisions that had effect of limiting or preventing persons with visual or print disabilities from accessing copyrighted works (ss 9(3), 10, 16(1)(b), 29(1) and 30) – Effect of impugned provisions being that copyright owners need to give permission for production of accessible-format copies of their works – Applicant (Blind SA) pointing out that legislative framework required to permit production of accessible format copies – Proposed amendment to Act to rectify this by insertion of s 19D stalled in Parliament – Aggrieved by legislative delay, Blind SA obtaining High Court order declaring offending provisions unconstitutional pending confirmation by Constitutional Court – Constitutional Court pointing out urgent need to align Act with Marrakesh ‘Access’ Treaty of 2013 – Blind SA’s suggestion that s 19D be read into Act with immediate effect not best solution for various reasons, including its perceived limitations – Constitutional Court instead declaring impugned provisions invalid and suspending declaration of invalidity for 24 months to give Parliament time to cure Act’s defects. *Blind SA v Minister of Trade, Industry and Competition and Others*, Constitutional Court case No CCT 320/21, Juta 2022 JDR 2649 (CC) (Unterhalter J (unanimous)), 21 September 2022, 30 pages.

Procedure – Proof of copyright infringement – Application for striking-out of foreign affidavits intended to prove infringement – Respondent (Lewis) seeking to interdict applicant (Homechoice) from cloning its core business – To prove its copyright by assignment, Lewis intending to introduce affidavits by international designers – Homechoice invoking rule 30 (irregular proceedings) to have affidavits struck out on ground that not properly authenticated – Lewis, while conceding that striking out would be fatal to its case, arguing that Homechoice’s rule 30 application was mere delaying tactic – Court however agreeing with Homechoice that authentication of several affidavits as well as copyright agreement deficient in various ways – Court granting application to strike out but giving Lewis opportunity to rectify matters by delivering properly authenticated affidavits and agreements. *Homechoice v Lewis Stores (Pty) Ltd*, Western Cape High Court case No 17166/2018, Juta 2022 JDR 1626 (WCC) (Baartman J), 10 pages.



Trademark – Infringement – Disclaimer – Cochrane Steel’s application for order interdicting Jumalu Fencing from infringing its CLEAR VU trademark for fencing by using term ‘clear view’ in its advertising dismissed by High Court – In appeal by Cochrane Steel, Supreme Court of Appeal discussing effect of disclaimer to effect that registrant of mark would not debar others from bona fide descriptive use of words ‘clear view’ – SCA pointing out that Jumalu’s dominant mark was CLAMBERPRUFE and that words ‘clear view’ were used in a descriptive sense only and was not mala fide – Jumalu's use of 'clear view' to describe the kind of its security steel fencing and its characteristic of having a clear view aesthetic did not infringe Cochrane Steels’s mark – Nor did Jumalo’s conduct amount to passing-off. *Cochrane Steel Products (Pty) Ltd v Jumalu Fencing (Pty) Ltd*, Supreme Court of Appeal case No 166/21, Juta 2022 JDR 1746 (SCA) (Meyer AJA (unanimous)), 22 June 2022, 10 pages.

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