

# **SOUTH AFRICAN PATENT LAW AND PRACTICE**

EXAMINATION PAPER

22 JUNE 2021

EXAMINATION SET UNDER THE AUSPICES OF THE PATENT EXAMINATION BOARD AND  
THE SOUTH AFRICAN INSTITUTE OF INTELLECTUAL PROPERTY LAW

## **EXAMINER**

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## **MODERATOR**

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## **NOTES TO CANDIDATES**

1. All questions should be answered.
2. The paper consists of a total of 7 pages, 1 annexure and 10 questions.
3. The duration of the exam is 4 hours.
4. There is a total mark allocation of 200 marks.
5. All references to the Act are references to the South African Patents Act, No 57 of 1978.
6. All references to the Regulations are references to the South African Patent Regulations, 1978.
7. Wherever possible, your answers should refer to the relevant case law, sections of the Act and/or Regulations, the content of the section and/or regulation should be set out and only then should a conclusion be reached.
8. Write neatly and legibly.

## QUESTION 1

You are a highly regarded South African patent attorney, with a keen interest in educating small business owners on protecting their intellectual property, particularly inventions that they create or develop.

You are invited, as a guest speaker, to a small business enterprise indaba to present an introductory lecture on patents. The organiser of the indaba has given you a blank canvass but does require that you provide them with your notes before the lecture for their approval.

Please prepare your notes for the introductory lecture, with specific inclusion of what a patent is, what the benefits of a patent are, what the legal requirements for an invention are to be deemed patentable and what the effect of a patent is. (20 marks)

## QUESTION 2

At the same indaba mentioned above, you allow for brief *pro bono* consultations for a select number of attendees. One of the attendees, Mr Zupta, informs you that he has developed a new type of squeegee that is more effective than conventional squeegees as it does not leave streaks on windows due to its unique curved end portions. He has secretly been using the squeegee to clean his neighbours' cars for a fee in his backyard in his homeland, Namibia.

- 2.1 Advise, with reference to the Act, whether it will be possible to file a patent application for the squeegee in South Africa. (4 marks)
- 2.2 Mr Zupta advises that he has been using the squeegee to clean the windows of his home in Pretoria in order to further develop the prototype. Would your advice above differ? Substantiate with reference to the Act. (4 marks)
- 2.3 You are told that three squeegees have been given to the local fuel station in Pretoria to trial the squeegee on their customers' vehicles while they fill their cars with fuel. Mr Zupta enquires whether there is any possible way to file a patent application in South Africa for his squeegee as he believes that it will be profitable to enter the market with

his product after receiving promising feedback from the local fuel station. Advise your client. (3 marks)

- 2.4 Mr Zupta provides you with an instruction to file a complete patent application for the squeegee in South Africa in the names of Mr Zupta and business partner Ms Ndabeni, to whom he has assigned a share of his invention. Referring to section 29 of the Act, describe the rights and restrictions placed on co-applicants of patent applications and the remedies in the event of any dispute between Mr Zupta and Ms Ndabeni. (8 marks)
- 2.5 During a consultation with another attendee of the indaba, Ms Zara, you are informed that an invention she has developed may have been disclosed to a competitor by a disgruntled ex-employee of hers. Referring to the Act, advise Ms Zara on the provisions of the Act regarding this scenario and what steps should be taken to ensure that there is no loss of rights. (5 marks)

### QUESTION 3

Throughout your career, you have consulted with inventors who sought to protect their concepts by way of patents. Below are some recent examples of these concepts. Having assumed that the concepts described below were novel and inventive, what would your advice on the patentability of the concepts have been with reference to section 25(2) and/or section 25(3) of the Act?

- 3.1 Your client has the idea of entering into a novel business venture with farmers who have vacant land alongside the N3 highway. The idea is to use a small portion of their land to stack refurbished shipping containers so that the outer sections of the containers may be used as advertising space that is easily visible to passing motorists. In return for the use of the land, the farmer is able to use the shipping containers to grow vegetables given that the containers have been customised with the inclusion of hydroponic plant growing units. Your client provides you with further details of the engaging mechanism he has designed to allow for the shipping containers to be securely fit together. (6 marks)

- 3.2 Your client, a medical aid service provider, has developed a new method implemented by a software mobile application that is able to integrate with the databases of government and pharmacies. This will allow its members to make appointments for receiving the SARS-CoV-2 vaccine. (4 marks)
- 3.3 Your client has created a new board game that requires the players in the game to roll dice and move newly designed tokens on the board to different sections. The rules of the game provide that the players, in teams, are able to move forward on the board if they correctly identify the opposing team's interpretation of a selected phrase by silently acting out that phrase. The game board provides for a number of unique and precise folds that enables the board to be folded to a compact size for easy storage and transportation when traveling. (6 marks)
- 3.4 Your client has developed a machine that he believes will solve the world's energy crisis. Your client's machine includes multiple gears that cooperate with each other, and without an external energy source, is able to do work indefinitely and generate power into perpetuity. Advise in terms of s36 of the Act. (2 marks)

#### **QUESTION 4**

Mr Bugman, a chemist, who is an avid nature lover, regularly visits nature reserves across South Africa. On a recent trip he stayed in a hut overlooking a watering hole, and although a beautiful setting, was a known breeding ground for mosquitoes. However, Mr Bugman noticed that there were no mosquitoes around his hut. He was curious to know the reason for this and asked the caretaker if there was an explanation. The caretaker advised that members from the local community planted a certain indigenous shrub around the hut, which acts as a repellent for mosquitoes.

Mr Bugman invents a mosquito repelling body lotion using an extract from the indigenous shrub he was introduced to whilst on his recent trip.

- 4.1 Mr Bugman instructs you to file a complete patent application for a patent in the name of his company, Buzz Off Ltd, and which validly claims priority from his earlier filed

- South African provisional patent application. What documents must be submitted in order to complete the formality requirements for this application? (14 marks)
- 4.2 To what extent is the Registrar of Patents required to examine the above patent application? (1 mark)
- 4.3 Mr Bugman, informs you that he has made an improvement to his invention that is not disclosed in the granted patent. The improvement is the inclusion of a preservative in the formulation of the lotion to extend its shelf-life. However, there is no mention of this preservative in the patent specification. What is the best option that is available to your client for the protection of this improvement? Referring to the Act, advise Mr Bugman fully. (10 marks)
- 4.4 If the preservative mentioned in question 4.3 was disclosed in the description of the specification at the time of filing the patent application, would it be possible to file an application for the amendment of the claims to include the preservative as an integer of the claims i) before the application proceeded to grant; and ii) after the application proceeded to grant? In your answer, include the requirements for both pre- and post-grant amendments, with reference to the relevant sections of the Act and Regulations. (10 marks)
- 4.5 Mr Bugman is the patentee of another patent, for which you are not recorded as the address for service. However, he wishes to consolidate his patent portfolio with you but before doing so, requests that you provide him with a status report of his patent. You noticed from the patent register that the patent application was accepted on 14 January 2021 and that the acceptance was published on 28 April 2021. Referring to the Act, Regulations and relevant case law, please write a letter to your client advising him of the status of his patent. (10 marks)

## **QUESTION 5**

- 5.1 Mr Bugman contacts you in distress when he learns that his patent is being infringed and instructs you to institute infringement proceedings. Mr Bugman's principal and only place of business is in Johannesburg. The party whom your client wishes to sue

for patent infringement has its principal place of business in Durban but the infringement is taking place in Durban. What would be the appropriate court(s) in which proceedings should be instituted? Substantiate your answer. (3 marks)

5.2 In order to provide your client with an infringement opinion, you are required to make a determination of infringement. Referring to case law, advise your client on the steps taken in ascertaining whether or not there has been an infringement of your client's patent. (4 marks)

5.3 Prior to instituting proceedings for infringement, Mr Bugman, unbeknownst to you and the registrar, informs you that he recently entered into a licence agreement with another party who is competing directly with the alleged infringer and is therefore also suffering damages as a result of the infringement. Advise your client on the steps to be taken to ensure that the licensee is able to recover damages? (4 marks)

5.4 To what relief is your client, as the plaintiff in proceedings for infringement, entitled? (5 marks)

## QUESTION 6

6.1 South Africa, as is the rest of the world, is eagerly awaiting the vaccination of the global population against SARS-CoV-2. Successful vaccines have been developed, trialled, patented and placed on the market by various pharmaceutical companies. As we know, in terms of section 4 of the Act, the State is bound by a patent. In terms of section 4 and section 78, what remedies does the State have in order to gain access to the vaccine for the people of South Africa, when may the State do so and what requirement(s) must be met? (6 marks)

6.2 Apart from the State, any interested party, may also seek to obtain a compulsory licence to the invention subject of the patent when there is an abuse of rights. Referring to the Act, what conditions are deemed to indicate an abuse of the rights in a patent? (10 marks)

## QUESTION 7

- 7.1 In deciding to restore a patent, the registrar has to be satisfied that certain requirements have been met. List the requirements, the procedural steps that follow once application is made and the possible outcomes. (11 marks)
- 7.2 The rights of a patentee of a restored patent are limited in terms of section 48(1) of the Act. Please discuss these limitations. (10 marks)

## QUESTION 8

It was confirmed in the case of *Buzzbee (Pty) Ltd v Registrar of Patents 2010 BIP 42 (CP)* that the grounds of revocation are exhaustive. List these grounds of revocation. (14 marks)

## QUESTION 9

Your client, the licensee, instructs you to review a draft licence agreement and to advise on the suitability of the undertakings and warranties. Advise your client on each of the following clauses, with reference to the Act:

- 9.1 The licensee shall not manufacture, package, market, distribute, sell or export any of the products subject to the patent in or to any country or territory outside of South Africa without the written consent of the licensor. (3 marks)
- 9.2 The licensee shall not cause any other party to engage, directly or indirectly, in South Africa, in the manufacture, sale, distribution, import or export of products competitive with or similar to the products subject to the patent. (3 marks)
- 9.3 The licensee shall not purchase or import into South Africa any products competitive with or similar to any of the products subject to the patent. (3 marks)
- 9.4 The licensee shall sell the products subject to the patent at the retail price and shall not provide any discounts on the sale of any of the products in excess of a maximum discount as advised by the licensor. (3 marks)

## QUESTION 10

With the aid of “Annexure 1” (a copy of the patent register page for South African Patent No. 2020/01439) answer the questions that follow by providing the dates in full, where relevant.

- 10.1 What was the last day for filing a PCT patent application? (2 marks)
- 10.2 What was the last day for filing a national phase patent application in South Africa without an extension? (2 marks)
- 10.3 What was the last day for filing a national phase patent application in South Africa with an extension? (2 marks)
- 10.4 When is the first renewal fee due without an extension? (2 marks)
- 10.5 What is the last day on which the first renewal fee may be paid, with an extension? (2 marks)
- 10.6 If all the renewal fees are paid, when will the patent expire? (2 marks)
- 10.7 If the priority claimed was from a South African provisional patent application (with the same filing date as the CN priority application) and your client decided not to file a PCT application, but to only continue with a South African complete application claiming priority from the South African provisional patent application, what would have been the last day for filing such a complete patent application? (2 marks)



# ANNEXURE 1

## PATENT REGISTER SHEET

REPUBLIC OF SOUTH AFRICA		REGISTER OF PATENTS		PATENTS ACT, 1978	
Official application No.		Lodging date: Provisional		Acceptance date	
21	01 <b>2020/01439</b>	22		47	2020/07/20
International classification		Lodging date: Complete		Granted date	
51	G06K	23	2020/03/06		2020/08/26
International Application No.		International filling Date		Priority Date	
PCT/CN2018/099915		2018/08/10		2017/10/20	
71	Full name(s) of applicant(s)/Patentee(s):				
ADVANCED NEW TECHNOLOGIES CO., LTD Cayman Corporate Centre ~27 Hospital Road~George Town ~Grand Cayman~KY1-9008, Cayman Islands					
71	Applicant substituted:				Date registered
71	Assignee(s):				Date registered
72	Full name(s) of inventor(s):				
DANDAN ZHENG WEI XU LIANG LI					
Priority claimed:		Country	Number		Date
		33   CN	31   201710985755.5		32   2017/10/20
54	Title of invention				
<b>DOCUMENT VERIFICATION AND IDENTITY VERIFICATION METHOD AND DEVICE</b>					
Address of applicant(s)/patentee(s):					
Cayman Corporate Centre ~27 Hospital Road~George Town ~Grand Cayman~KY1-9008 CAYMAN ISLANDS					
74	Address for service				
SOUTH AFRICA Reference No.					
61	Patent of addition No.			Date of any change	
Fresh application based on.					
			Date of any change		