

PATENT ATTORNEY'S PRACTICE GROUP 2G

WRITTEN EXAM

ANSWER ALL QUESTIONS

NO MARKS WILL BE AWARDED FOR EXTRANEIOUS MATTER

Question 1

Advise whether you believe the below mentioned claims to be valid and motivate your answer:

“A method of diagnosing Covid-19 in a patient wherein the temperature of the patient is measured using a device that analyses the infrared radiation emitted by the skin of the patient.”

“A non-therapeutic cosmetic method of whitening teeth by using a toothpaste composition comprising a whitener and anti-gingivitis bacterial composition”.

“A method of determining Parkinson’s Disease in a patient, the method comprising the steps of:

- i. Withdrawing a blood sample from a patient;
- ii. Culturing the blood sample in vitro;
- iii. Determining the level of beta cells in the blood sample.”

(10 marks)

Question 2

You file a South African national phase application for GlobalComs Limited. The national phase application proceeds to acceptance and grant. After grant, you are contacted by the patentee asking you to make certain corrections and additions to the granted patent. In particular the patentee points out the following:

- i. The unit of measurement following the number 1500 is “ μm ”. Instead, due to different font’s used by the patentee and those used for the international application, the unit of measurement reads “ $\square\text{m}$ ”.
- ii. The patentee used the incorrect formula in claim 1 of the patent although the body of the specification has the correct formula. The formula used was $\Delta D = x^2 + \cos\phi/(a-b)^3$. The correct formula is $\Delta D = (x-r)^2 \times \cos\phi/(a-b)^3 + \psi a^2$.
- iii. The inventor PAUL, Thomas, who worked for GlobalComs Limited needs to be replaced with HESTON, Charles, who was a scientist working at the University of Cardiff.
- iv. An additional claim is to be added to the existing claims that relates to a modification of the original invention. The corresponding paragraph to the new claim is given to you to

insert in the body of the specification. This new feature was broadly mentioned in the specification as it stands.

Advise the patentee.

(20 marks)

Question 3

Your agent in the UK is looking for advice regarding the following questions according to local law in South Africa:

- (i) What happens if an inventor is added after filing (e.g. before or after grant), but during litigation or other proceedings, the other inventors are contacted and disagree that additional inventor contributed to the invention? Are there any potential risks or consequences?
- (ii) What could happen if an employee believes that they should have been named as an inventor, but they were not– can an alleged infringer use that to their advantage? Are there any potential risks or consequences for the proprietor?
- (iii) If there are different inventors named in different countries for the same invention (e.g. the claims of the patents or patent application are identical or very similar in different countries, but in one country inventors A and B are named, but in another country, inventors A, B and C are named) – does this have any potential consequences for the proprietor if they were to try and enforce the patent against third parties in your South Africa?

Advise your client on the above in the situation in which the inventors (and potential inventors) worked for the proprietor with (i) a contract of employment assigning rights to inventions to the proprietors and (ii) where there was no contract of employment.

(20 marks)

Question 4

Discuss the development of the law concerning interpretation of claims with reference to anticipation and also with reference to infringement and cite the relevant cases in this respect.

(25 marks)

Question 5

Advise your client on any issues that may arise in the following scenarios:

- (a) Your client has instituted infringement proceedings with regard to its South African granted patent. The other side raises a counterclaim of invalidity based on a poster that was hung at the back of a lecture room at a conference. Only specific named individuals could attend the conference.
- (b) A client contacts you and says he wants to sue an infringer of his granted patent in South Africa. The client attaches a clear and detailed photo of its product and similarly a clear detailed photo of the infringing product from which it can be seen that the infringing product is exactly the same as the product in the photo belonging to your client.
- (c) You have successfully restored a patent which lapsed in June 2018. The restoration application was published in May 2022 and has now been granted without opposition. The patentee wants you to sue Cylinder Trading (PTY) LTD (CT) for patent infringement of its process and the resultant product. The patentee tells you that CT started its process and selling its products in March 2019.
- (d) Your client, the patentee, receives a letter demanding a license under the patent and proposes terms that are unacceptable to your client. What next ?
- (e) Your client is a South African national employed by a foreign company. Your client is the sole inventor of an invention and in terms of a valid contract of employment assigned all his rights to the foreign company. Are there any approvals needed concerning the assignment ?

(15 marks)

Question 6

What is the test that the court must use to determine whether an invention is obvious once the prior art has been identified and the invention and the step forward. Refer to the case of PHARMA DYNAMICS (PTY) LTD V BAYER PHARMA AG (468/13) [2014] [ZASCA 123](#).

(10 marks)
