

PATENT EXAMINATION BOARD

PATENT ATTORNEYS' PRACTICE – GROUP 2(g)

June 2023

Examiner: R. van Niekerk

Moderator: V. Williams

Time: 4 hours

Total marks: 100

This paper consists of 6 pages (including this cover page)

Instructions:

- Answer all questions.
- Write legibly and succinctly.
- Marks are awarded for correctly identifying and explaining the relevant legal principles and applying them to the facts. Cite relevant case law where appropriate.

Question 1 (20 marks)

- a) What are the requirements for obtaining an interim interdict? (4)
- b) What is the difference between an exclusive licence and a sole licence? (2)
- c) Can a licensee intervene as co-plaintiff in an action for infringement of a patent? (2)
- d) What remedies can you claim in an action for infringement of a patent? (4)
- e) Is an expert witness permitted to express an opinion on the meaning of a patent claim? (2)
- f) Is the grant and/or refusal to grant an interim interdict appealable? (2)
- g) Can proceedings for infringement be instituted upon grant of the patent? If not, when can they be instituted? (2)
- h) What is the Gillette defence? (2)

Question 2 (5 marks)

Your client is a South African tech start-up that is in the process of expanding internationally. They are the patentee of a granted patent in South Africa, the US and Australia. As part of their expansion, they would like their US and Australian patents to be owned by a new IP holding company based in the Netherlands. Advise the client as to any special South African requirements that apply when assigning the patents to the new IP holding company.

Question 3 (10 marks)

The Council for Scientific and Industrial Research (CSIR) contacts you to enquire about protecting an anti-obesity and appetite suppressant medication. The CSIR explains to you that, for thousands of years, the San people in the Kalahari region of South Africa have used the bitter flesh of the indigenous plant *hoodia gordonii* to suppress their appetite and give them energy for long trips over inhospitable land. After conducting its research, the CSIR recognised that a specific molecule of the plant (named "P57") could be extracted and commercialised as an anti-obesity and appetite suppressant medication.

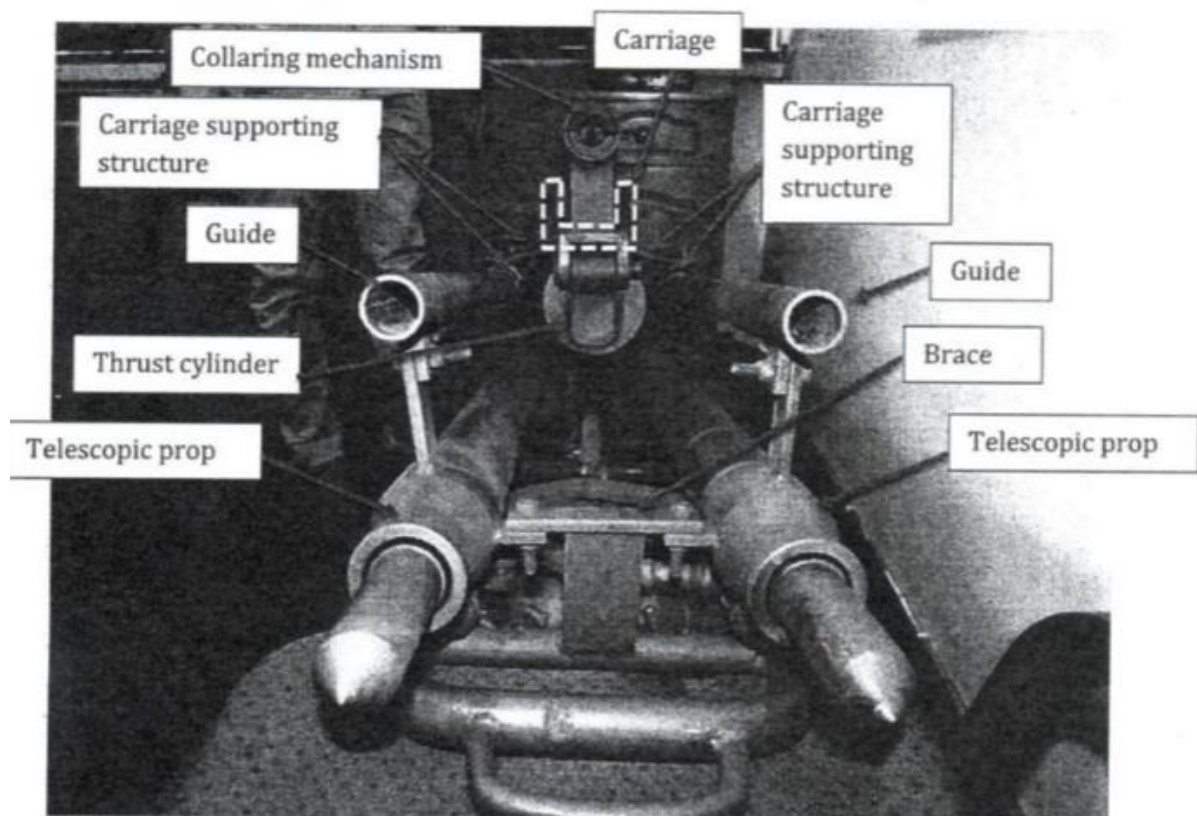
Comment on the patentability of the following proposed claims:

- a) *Hoodia gordonii* for use in a method of suppressing appetite, the method comprising ingesting an effective amount of *hoodia gordonii*. (2)
- b) A pharmaceutical formulation comprising P57. (3)

- c) A method of suppressing appetite comprising ingesting a pharmaceutically effective amount of P57. (2)
- d) The use of *hoodia gordonii* in the manufacture of a medicament for the treatment of obesity. (3)

Question 4 (15 marks)

Your client makes and sells a self-supporting drill rig, shown below, that is used in underground mines to drill holes in the hanging roof (or wall) of a mine for the purposes of placing roof-bolts or other securing attachments to the wall. The drill rig includes two extendable telescopic props onto which are mounted a drill carriage. The props support the surface of the hanging wall during drilling, thus reducing the risk of the hanging wall collapsing onto the user of the drill rig.



Your client brings to your attention that a third party has a South African patent for a drill rig. Claim 1 of the patent reads:

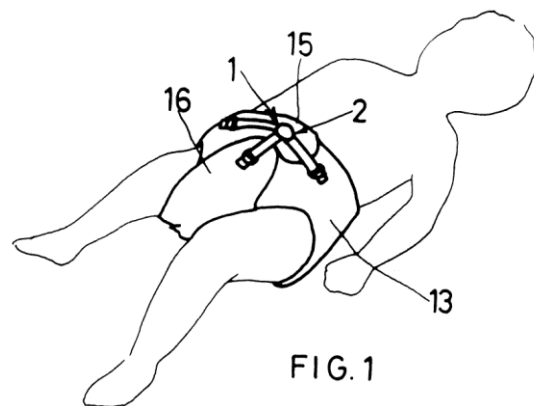
1. A portable self-supporting drill rig comprising a pair of spaced apart telescopic props with a carriage between them, the carriage movable along an axis substantially parallel to those of the props and supporting a drill mounted on the carriage.

Your client points out that their carriage is not located between the spaced apart telescopic props but, as is clear from the picture above, their carriage is offset from the linear space between the telescopic props.

Explain what you need to consider in determining whether there is patent infringement or not and advise your client accordingly.

Question 5 (15 marks)

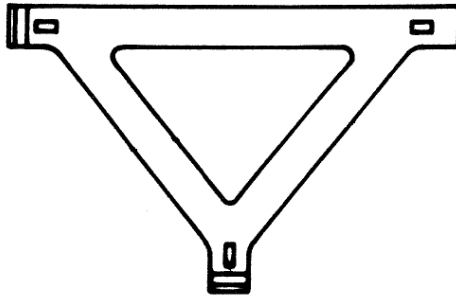
Your client has invented a nappy fastener to be used with cloth nappies (diapers). The fastener has a T-shaped elastic portion having three arms and with hooks at the free ends of each arm. The hooks are sufficiently shallow so as not to injure the infant but still grip the cloth of the nappy. A picture of the diaper fastener and its use is shown below:



You filed a South African complete patent application in the first instance for the invention. Claim 1 reads:

“A diaper fastener comprising three elastically extensible arms radiating from a central area, the arms having hooks close to their ends for engaging the fabric of a diaper to hold the diaper in its functional position”.

After filing the application, your client tells you that another embodiment that will also work is for the elastic member to be in the shape of a triangle, not a T, as shown below:



Assume you can write a valid claim that covers both embodiments. What would you advise your client to do if:

- a) 8 months have passed since the filing of the patent application. (3)
- b) 14 months have passed since the filing of the patent application. (2)
- c) 16 months have passed since the filing date of the patent application, and the application has not yet been accepted. (5)
- d) 16 months have passed since the filing of the patent application and a patent has been granted. (5)

Question 6 (15 marks)

Samsung Co. Ltd., the well-known Korean technology company, sells its plasma screen TVs throughout the world. It has come to their attention that a third party has been purchasing Samsung plasma screen TVs from Samsung's licensee in India, shipping them to South Africa and selling them here. Samsung Co. Ltd. is the patentee of a South African patent covering their plasma screen TVs.

Advise Samsung as to whether it has any remedy under South African patent law against the third party. Also advise Samsung on how it could structure its licence agreement(s) and/or patent ownership to strengthen its position.

Question 7 (5 marks)

Jamba Drinks ("Jamba") has a popular energy drink, the formulation of which they have patented in South Africa. They wish to licence the energy drink formulation to other companies and have put together the following proposed terms for you to prepare a licence agreement:

- a) Jamba grants the licensee a non-exclusive licence to make and sell energy drinks in South Africa, Botswana and Namibia that use the Patented Formulation.
- b) The licensee shall purchase its energy drink bottles from Jamba only.
- c) The licensee shall not be permitted to use the “Jamba” trade mark in respect of its energy drink but shall use its own trade mark(s).
- d) The licence shall remain in place for a period of 10 (ten) years, after which it may be renewed by Jamba at its sole discretion for further periods of 5 (five) years indefinitely.

Explain to your client whether any of these proposed licence terms are problematic, and if so, why.

Question 8 (15 marks)

Your client has a patent for a work area monitor (WAM) that is used to measure slope stability in mines and provide an early warning of possible slope failure. The WAM utilises a special radar system, called an interferometric radar, which is mounted on an automobile vehicle (i.e., a bakkie). Your client tells you that before the priority date of the patent, the same interferometric radar system was mounted on a trailer, but the trailer-mounted system was not as manoeuvrable as the WAM. Your client also informs you that since World War II, other types of radar systems (i.e., not interferometric radar used in mining applications) were known to be mounted on vehicles.

Your client wishes to institute an action for patent infringement against its competitor. Advise your client as to what ground(s) the competitor may have for alleging that the patent is invalid, and the approach that the courts take in determining that ground.