EXAMINATION

PATENT EXAMINATION BOARD

PATENT ATTORNEY'S PRACTICE - GROUP 2G

2021

ONE FOUR HOUR PAPER (240 MINUTES)

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Instructions:

Where necessary, please cite relevant sections of the Patents Act. However, please do not re-write the sections in your answer.

Please cite relevant case law where you deem it to be appropriate.

Answer all the questions.

Mark Allocations:

Questions 1 to 4 – 25 marks in total
Question 5, 6 and 7 – 25 marks per question
Total: 100 marks

PLEASE WRITE LEGIBLY

Question 1

Your client approaches you with a copy of a patent license agreement in terms of which client is licensed to manufacture and sell a patented printer. The license however is subject to the proviso that all consumables, which are not subject of the patent, be bought from the Patentee, even though consumables of the same quality are readily available from other sources.

Advise your client as to the lawfulness of the proviso.

Question 2

Your client instructs you to sue for patent infringement one month after the patent is granted. The alleged infringer is a well-established manufacturer of motor vehicles.

Advise your client as to what relief you would have requested over and above an interdict and damages/royalties and what problems may be encountered in succeeding in that relief.

Question 3

A client wishes to enforce a patent and asks you to review the claims of the patent. The following are relevant facts:

In the body of the specification of the patent to be enforced, there is a statement that "compound "Y" of the invention has heretofore been used to treat anxiety". It also states the combination of compound "Y" with diluent "X", in separate vials, results in a more stable mixture. You may assume the latter to be novel and inventive.

Claim 1 of the patent reads:

A kit comprising compound "Y", in a first vial, and a diluent comprising "X" in a second vial.

Claim 10 of the patent reads:

Use of compound Y in the manufacture of a medicament for the treatment of a disease.

Claim 12 of the patent reads:

Compound "Y" for use in treating obesity.

Claim 13 of the patent reads:

Use of compound "Y" for treating obesity.

(a) Advise client on any issues that may arise concerning the validity of the claims. Also advise client of whether the validity can be cured and how you would do so. Assume there is fair basis for any of your proposals and there are no new matter issues.

(b) Assume that while considering the validity of the patent, you receive, as the address for service, an application for revocation. Assuming that your advice is to amend the patent, advise your client

briefly of the process to be followed to amend the patent having regard to the revocation application as well and what the effect of the amendment process will be on the patent.

Question 4

You are approached by a local pharmaceutical company that wants to produce a Covid-19 vaccine in South Africa. You are told that there is a patent on the composition and manufacture of the vaccine. Before advising your client, you do some background research and discover that your client has a very small manufacturing plant that is geared to make simple solid form medicines and that its output capacity is 250 000 tablets a month.

What would you advise client having regard to the existing patent on the vaccine and its manufacture?

[Questions 1 to 4: 25 marks in total]

Question 5

You filed a complete patent application for your client, the application proceeding to grant. Your client contacts you to say that new pieces of prior art have been found in relation to the invention (i.e. your client did not know of the prior art at the time that the complete was granted). The invention comprises a screening panel for screening material that is washed over it. The first claim reads:

A screening panel, comprising:

a. A flexible frame;

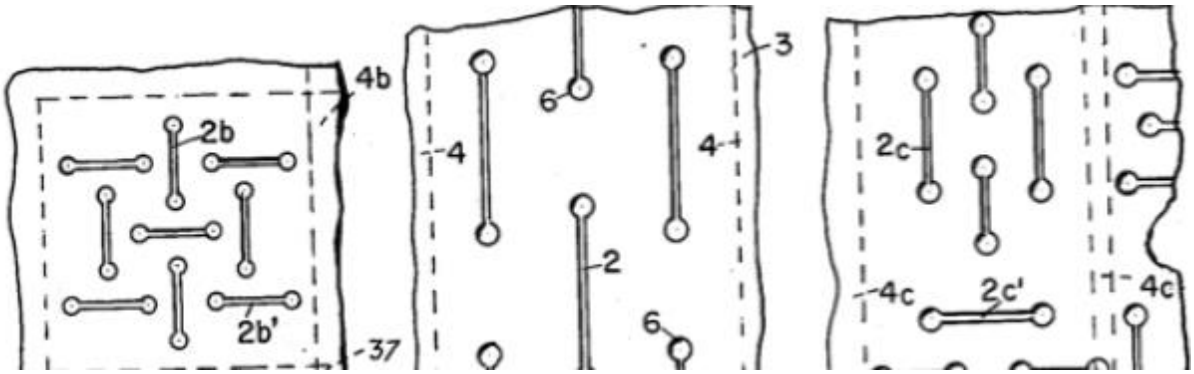
b. A plurality of cross-flow slots and in-flow slots forming a regular pattern

c. Either of the in-flow slots or cross-flow slots being arranged in a staggered pattern.

You notice the following in the body of the specification:

"Each compound slot is a combination of longitudinal (in-flow) slots and transverse (cross) flow slots."

Prior Art Patent 1 – figure (you may assume that a flexible screening panel is disclosed)



Prior Art Patent 2 – the figures below show different types of slot that could be used on a flexible screening panel.

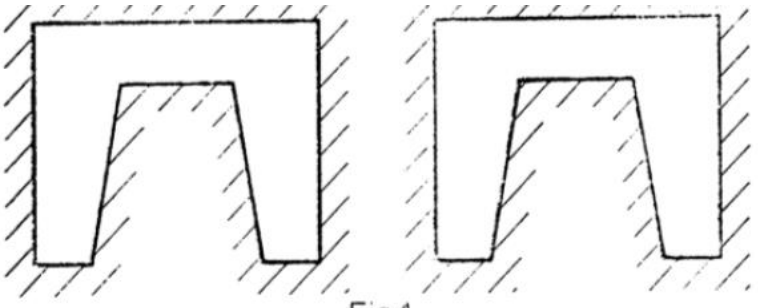


Fig.1

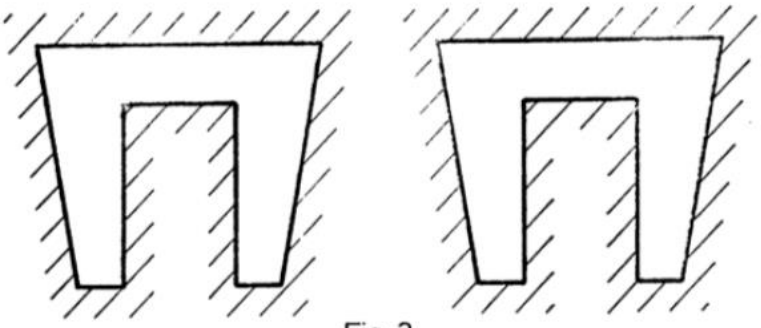
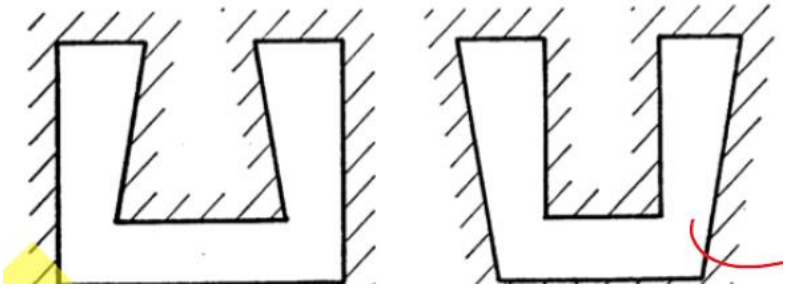


Fig. 2



Advise your client of the impact of the prior art and/or whether any amendments need to be made to save the invention as claimed. If there are potential amendments, please re-draft claim 1 to include your amendments, additions being underlined and deletions being struck through.

[25 marks]

Question 6

During a consultation, your client tells you that he has a brilliant new invention. The invention concerns a radar system used to monitor slope stability in open cast mines, wherein the radar is mounted to a motorized automobile vehicle.

The radar system is known in that it was previously mounted on a trailer and hitched to a motor vehicle. Client also tells you that it was known since the year 2000 to monitor and detect precursor movements to predict if a slope wall will collapse or not. You are further told that different types of radar systems to the one in the invention have been used in military applications. In respect of the invention, your client tells you that its radar is stabilized vis-à-vis the automobile.

Finally, client's mechanical engineer is happy to state to a court that he thinks the invention is inventive.

Advise your client concerning novelty, inventiveness and the role of the expert, citing case law.

[25 marks]

Question 7

Your client wishes to enforce its patent on an urgent basis. The first claim reads:

> *"The use of the compound [Rivaroxaban] for the manufacture of a medicament in an oral dosage form for the treatment of thromboembolic disorder for administration no more than once daily for at least five consecutive days, wherein said compound has a plasma concentration half-life of ten hours or less when orally administered to a human patient, wherein the thromboembolic disorder is pulmonary embolisms, deep vein thrombosis or stroke, and wherein the oral dosage form is a rapid release tablet."*

The terms used in claim 1 are defined in the specification. Two of the definitions which your client draws your attention to are:

(a) *"Half life"* is defined to be *"the time it takes for the plasma concentration or the amount of drug in the body to be reduced by 50%"*; and

(b) *"Rapid-release tablets"* are defined as *"those which, according to the USP release method (using apparatus 2 paddle), have a Q Value (30 minutes) of 75%"*.

Your client tells you that the alleged infringer's product is a generic equivalent to its patented product except that the package insert of the generic says that for the elderly the half life is 11 to 13 hours and sometimes raises to 13 to 15 hours, while for younger and healthier individuals the half life can be 7 to 9 hours but may be raised to 9 to 11 hours for people with renal impairment.

You spot the following in the specification:

"This goal [a once-daily oral dosis] is sometimes difficult to achieve depending on the specific behaviour and properties of the drug substance, especially its plasma concentration half-life".

"Surprisingly, it has now been found in patients at frequent medication that once daily oral administration of a direct factor Xa inhibitor with a plasma concentration half-life time of 10 hours or less demonstrated efficacy when compared to standard therapy …".

Advise your client if you can establish infringement on the facts given and what your argument would be having regard to the development of the law concerning the way claims are to be construed and the question of mechanical/chemical equivalence.

[25 marks]