

SOUTH AFRICAN PATENT LAW AND PRACTICE

EXAMINATION PAPER

4 JULY 2019

**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 6 pages, 1 annexure and a total of 13 questions.
3. The duration of the exam is 4 hours.
4. There is a 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 Patent Regulations, 1978.
7. Wherever possible, your answers should refer to the relevant 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

- 1.1 Provide a brief summary of your understanding of a patent, the nature of a patent right and the purpose of a patent. (6 marks)
- 1.2 Referring to the Act, what is the effect of a patent and how does the sale of a patented article alter this effect? (9 marks)

QUESTION 2

- 2.1 Does the Act provide a definition of an invention? (1 mark)
- 2.2 Provide the exclusions from patentability in terms of section 25(2) of the Act and give a brief reason for each of the exclusions. (11 marks)
- 2.3 How are these exclusions qualified by section 25(3) of the Act? (2 marks)
- 2.4 In addition to section 25(2) of the Act, further exclusions are provided in sections 25(4) and 25(11). What do these sections say? (7 marks)
- 2.5 The registrar of patents is provided with statutory authority to refuse certain inventions. State the section of the Act and the inventions that the registrar may refuse. Give an example of each and advise conditions under which some of these inventions will be accepted. Do not concern yourself with the provisions of nuclear-related technologies. (5 marks)

QUESTION 3

Your studious client, Dr Knowitall, meets with you to discuss his invention. He informs you that his invention is for a new use of a known pharmaceutical compound. The independent claim for a patent of the already known pharmaceutical compound is:

(S)-N-((R)-2-(2,5-difluorophenyl)-pyrrolidin-1-yl)-pyrazolo[1,5-a]pyrimidin-3-yl) for use in a method of treating a cancer in a patient in need thereof.

Advise Dr Knowitall on the patentability of his invention for the treatment of arthritis, referring to the Act and relevant case law. Also provide him with a patentable claim for his review.

(8 marks)

QUESTION 4

- 4.1 In light of section 25(1) of the Act, provide the extrinsic requirements (the legal standards) that an invention must meet in order to be patentable. (4 marks)
- 4.2 With reference to sections 25(5) and 25(6) of the Act, when is an invention deemed to be new? Fully discuss and refer to case law. (8 marks)
- 4.3 In preparation for filing a patent application for your client's invention in South Africa, it transpires during consultation with your client that there has been prior use of the invention. Briefly advise your client on the provisions in the Act dealing with the exceptions regarding novelty, where:
 - 4.3.1 even though there has been no prior disclosure of the invention, the novelty thereof is destroyed; and
 - 4.3.2 there has been disclosure of the invention but the novelty thereof is not destroyed.(10 marks)
- 4.4 Referring to case law, how would the Court of the Commissioner of Patents assess the novelty and inventiveness of an invention? State whether or not it is possible to mosaic prior art documents in each assessment. (10 marks)

QUESTION 5

Referring to section 29 of the Act, describe the rights and restrictions placed on co-applicants of patent applications. Describe the remedies in the event of any dispute. (8 marks)

QUESTION 6

- 6.1 The registrar of patents is authorised to allow certain corrections in terms of section 50 of the Act, one of which is the correction of a clerical error. Referring to case law, what is a clerical error? (6 marks)
- 6.2 What other type of correction may be allowed by the registrar in terms of section 50 of the Act? (2 marks)

QUESTION 7

- 7.1 Your foreign instructing attorney contacts you on behalf of their client, whom you represent in South Africa. The client has patent applications across multiple jurisdictions for the same invention. The instructing attorney advises that the client wishes to amend the South African patent specification so as to limit the scope of the claims to distinguish the invention more fully over prior art. The prior art was cited during examination in Europe for a corresponding EU application. The South African application is still pending and is due to be accepted shortly. Advise the instructing attorney, who is unfamiliar with South African patent law, on the requirements for such an amendment by referring to the relevant section of the Act and Regulations. (6 marks)
- 7.2 Would the requirements be any different if the acceptance of the application has already been published in the Patent Journal? If so, what is the difference in requirements? (2 marks)

QUESTION 8

Your client advised you at the time of filing their patent application that you are not responsible for the payment of renewal fees and that the responsibility for the payment of the renewal fees will be handled by a global renewal agency. However, your client contacts you in a state of panic five years later, after the application proceeded to grant, and informs you that South African Patent No. 2012/01598 has lapsed due to the non-payment of renewal fees. The patent is extremely valuable to your client who still wishes to make use of their monopoly over the invention.

- 8.1 Referring to the Act and Regulations, advise your client on what can be done, what requirements must be satisfied and what procedure must be followed. (7 marks)
- 8.2 Is there an opposition period to oppose such an application? If so, what is the opposition period? (2 marks)
- 8.3 Referencing the Act, advise your client on his limited rights should he be successful in his application. (10 marks)

QUESTION 9

The Act provides for an exhaustive list of grounds on which a patent may be revoked. List these grounds and where the ground refers to another section of the Act, give a brief overview of what the referenced section relates to. (22 marks)

QUESTION 10

- 10.1 In terms of section 32 of the Act, what is the function of the claims, and what requirements should the claims of a complete specification meet? (4 marks)

- 10.2 To what relief is a plaintiff in proceedings for infringement entitled? (5 marks)
- 10.3 Certain acts that would otherwise be considered an infringement of a patent are excused in terms of the Act. Refer to the section of the Act and explain to what extent these acts will not be deemed to be an infringement. (5 marks)
- 10.4 Your client, the patentee of South African Patent No. 2015/09845, has fierce competition in the marketplace. He wishes to send letters to his competitors who have previously been found to infringe some of his other patents. Your client is adamant that the letters should be strongly worded, if not threatening, in order to scare off any potential infringement of South African Patent No. 2015/09845 by his competitors. With reference to the Act advise your client. (6 marks)

QUESTION 11

Section 90 of the Act prohibits a patentee from attempting to secure rights contractually which fall outside the rights granted by a patent. Elaborate on the conditions which shall be null and void in terms of the Act. (5 marks)

QUESTION 12

With the aid of “Annexure 1” (a copy of the patent register of South African Patent No. 2017/02130) answer the questions that follow by providing the dates in full, where relevant.

- 12.1 What was the last day for filing a PCT patent application? (2 marks)
- 12.2 What was the last day for filing a national phase patent application in South Africa without an extension? (2 marks)
- 12.3 What was the last day for filing a national phase patent application in South Africa with an extension? (2 marks)

- 12.4 Within how many months' time from the date of acceptance must the acceptance be published in the Patent Journal? Only state the number of months. (1 mark)
- 12.5 What is the consequence of not advertising the acceptance of the application in the Patent Journal within the prescribed period? Refer to supporting case law. (2 marks)
- 12.6 When was the first renewal fee due without an extension? (2 marks)
- 12.7 What is the last day on which the first renewal fee may be paid, with an extension? (2 marks)
- 12.8 If all the renewal fees are paid, when will the patent expire? (2 marks)
- 12.9 If the earliest priority claimed was from a South African provisional patent application (having the same filing date as the US 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 absolute last day for filing such a complete patent application? (2 marks)

QUESTION 13

Your client has made modifications to her invention after an application for a patent accompanied by a complete patent specification has already been filed. Explain fully the options available to your client under sections 39 and 51(8), respectively, for the case (i) where the application is still pending and (ii) has already proceeded to grant. Comment on any exceptions in so far as rights or obligations are concerned. (12 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	2017/02130	22		47 2018/04/09
International classification		Lodging date: Complete		Granted date	
51 A61K;A61M		23	2017/03/27	2018/06/27	
International Application No.		International filing Date		Priority Date	
PCT/EP2015/072736		2015/10/01		2014/10/03	
71 Full name(s) of applicant(s)/Patentee(s): PHARMACEUTICALS APS Dalslandsgate 11, 2300, København S, Denmark					
71 Applicant substituted:				Date registered	
71 Assignee(s):				Date registered	
72 Full name(s) of inventor(s): NENAD BENCIC					
Priority claimed:		Country	Number	Date	
		33 US	31 62/059,748	32 2014/10/03	
54 Title of invention INHALATION DEVICE					
Address of applicant(s)/patentee(s): Dalslandsgate 11, 2300, København S DENMARK					
74 Address for service					
61 Patent of addition No.		Date of any change			
Fresh application based on.		Date of any change			