

PATENT EXAMINATION BOARD

EXAMINATION 2019

**PATENT ATTORNEYS PRACTICE**

Group 2(g)

Examiners: A. Apostolidis

Moderator: V. Williams

Time: 4 hours

Marks: 100

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Instructions:

1. The paper consists of a total of 7 pages (including the cover page).
  2. Answer 4 of the 5 questions.
  3. Cite relevant case law where appropriate.
  4. Each question is worth 25 marks
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## QUESTION 1

You are approached by your client, Super Advertising, asking for advice on the infringement of its patent which was granted two years ago. The claims of the patent read:

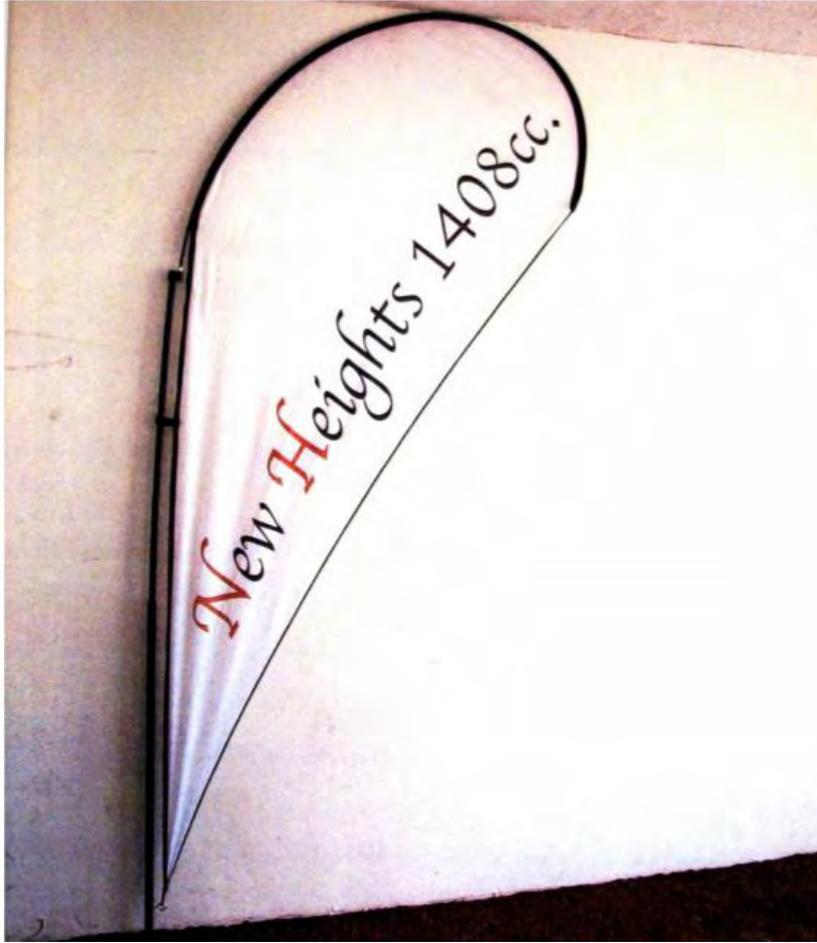
1. A flag construction comprising a pole which includes, at least at the top end thereof, a flexible section which is adapted to be bent into a substantially U-shaped section and being adapted to engage at least a portion of the periphery of a piece of material and to maintain it under tension at least in the area defined by the pole, the U-shaped section and a line between a point towards the tip of the flexible section and a point along the length of the pole.
2. The flag construction according to claim 1 in which the top end of the pole includes a flexible section of fibreglass or the like which tapers to a narrow diameter.
3. A flag construction according to claim 2 in which the tapered section is integral with the pole.
4. The flag construction according to claim 3 in which the material includes a seam or sleeve along one edge, into which the tapered end of the pole is slid (*sic*).
5. A flag construction according to any of the above claims including the combination of an inverted U-shaped section with an inverted teardrop-shaped piece of material.
6. A flag construction according to any of the above claims in which the pole is adapted to rotate about its own axis.
7. A flag construction substantially as described with reference to the accompanying drawing.'

Your client wrote a letter of demand to the alleged infringer to which the alleged infringer included a photo of its product (shown further below) and argued that its advertising banner does not infringe because:

- (a) The top periphery of its product is not "U shaped";
- (b) Its product does not have a pole, but three interlinked pieces of piping; and
- (c) Even if there were a pole, it is not the pole that engages the flag material but rather the flag material that engages the pole since the flag is provided with a sleeve to receive the pole.

This response angered your client further, and he now wishes to write a letter to the South African Rugby Union to cancel the award of a tender, worth R2.5 million, to the infringer to supply it with advertising banners of the type in question.

Advise your client on the prospects of success from an infringement point of view and whether he should contact the South African Rugby Union to warn them of the infringement.



[25]

## QUESTION 2

A potential South African client contacts you to set up a conference call concerning the infringement of its patent in South Africa. The patent relates to a type of container, used for transportation of liquids, known as an intermediate bulk container (IBC).

An IBC consists of an outer protective cage and a removable plastic inner bottle in which the liquid is held (see picture below).

In some IBCs, the bottle can be replaced when it becomes unusable. IBC manufacturers sell replacement bottles, but there is also a market for replacement bottles produced by manufacturers other than the manufacturer of the original IBC.

A South African company called Delta has been identified as reconditioning used IBCs by removing the old bottle, repairing the cage as appropriate, and fitting a new bottle. Delta purchased its replacement bottles from South African Bottle Co and would then sell the reconditioned IBCs in competition with the patentee.



Your client tells you that the inventive concept lies in the cage and that the bottle has a very specific design which will only fit the cage of the patentee and no other IBC. Your client also mentions to you that he noted, while speaking to you, that the 2016 renewal fee for the patent in question was underpaid by R150.00.

Assuming that Delta's product falls within the scope of claim 1 of your client's patent, advise your client on infringement with respect to both Delta and South African Bottle Co and its prospects of success.

**[25]**

### QUESTION 3

You filed a South African national phase application from a PCT international application 3 months ago. In reviewing the claims of the application, prior to grant, you note that there are 3 claims only, which read:

Claim 1: A compound "XYZ" for use in the treatment of diabetes.

Claim 2: A kit comprising Compound "XYZ" and a package insert.

Claim 3: A method of treating diabetes by administering compound "XYZ" to a patient in need thereof.

On considering your file, you also note that the Form P3 has been signed by your client.

#### PART A

Advise your client concerning the validity and enforceability of the application if it were to proceed to grant and advise your client what remedies, if any, you would suggest be undertaken. (15)

#### PART B

On advising your client, you receive a response to proceed according to the remedies suggested in Part A of this question. Client however also mentions that the inventor, whilst working on the invention, incorrectly characterised compound "XYZ" due to a lack of appreciation of certain organic chemistry principles. The correct compound is actually "XZY". Your client asks you to amend the specification to reflect the correct compound and to replace examples 1 to 3 with new examples 1 to 3 that reflect the results using the correct compound.

Advise your client concerning this latest instruction. (10)

**[25]**

#### QUESTION 4

You are contacted by EasyRide (Pty) LTD (EasyRide), a South African company that runs an “uber” type application in South Africa.

You are told that an ex-employee, a Mr De Vos, has obtained a patent in respect of integrating into the EasyRide app, for a cellular phone, the feature of being able to order food through the EasyRide app so that when a customer enters his “ride”, the food will be waiting there for him. The priority date is two years ago.

Mr De Vos, you are told, was the marketing manager for EasyRide, who had left six years back under acrimonious circumstances. Your client believes that the invention should belong to it, especially in terms of its contract of employment with Mr De Vos, the relevant clauses being:

1. Mr De Vos is employed to market the EasyRide application.
2. Any intellectual property that Mr De Vos creates shall belong to EasyRide.
3. “Clause 2” above shall survive termination of the employment of Mr De Vos for a period of 5 years.

Advise your client as to the recourse it would have and what its chances of success are.

**[25]**

## QUESTION 5

A new client, Joints-Are-Us, writes:

'For many years we have produced joints for robots. In the last month we have expanded into the field of artificial hip joints for humans. The artificial hip joints have a rod for attachment to a femur and a head which is received in a hip socket.

We have designed a number of such hip joints with various head shapes and have had machinery made to produce the joints and would like to patent them.

We have performed a patent search and have identified two ZA patents, D1 and D2, owned by HipsAre-Us which are of concern to us.'

The client has provided you with three hip joints, one with a spherical head, one with an elliptical head and one with a cubic head.

Review of patent D1 reveals that all the new hip joints infringe the claims of this patent. The last renewal fee was due on 03 June 2018 and has not been paid. No application for restoration has yet been published.

A review of patent D2 reveals that it is in force. The patent has only one claim; the claim is to a hip joint having a teardrop shaped head. The description states that this is an improvement over joints having spherical heads as tear drop shapes allow for lesser friction and will last longer.

Advise your client concerning the patentability of their hip joints. Also advise your client concerning patent infringement.

**[25]**