

# **SOUTH AFRICAN PATENT LAW AND PRACTICE**

EXAMINATION PAPER

8 SEPTEMBER 2020

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 (excl. this cover sheet), 1 annexure and a total of 10 questions.
3. The duration of the exam is 4 hours.
4. There is a total 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 the basic theory of the patent system and its purpose. (5 marks)
- 1.2 You e-mail a grant report to your client, wherein you inform your client that the acceptance of the application has been published in the Patent Journal of 26 February 2020. Your client, with a limited understanding of patent law, asks you what is the effect of the patent proceeding to grant. Referring to the Act, explain to your client the type of right granted by a patent and advise your client on the effect thereof. (9 marks)
- 1.3 After providing your client with the advice relating to the above in 1.2, your client informs you on 17 July 2020 that there is a possible infringement of the granted patent and that they immediately wish to proceed with infringement proceedings. Advise your client with reference to Section 44 (4) of the Act. (4 marks)
- 1.4 In order to provide your client with an infringement opinion, you are required to make a determination of infringement. Referring to case law, advise your client on the steps taken in ascertaining whether or not there has been an infringement of your client's patent. (4 marks)
- 1.5 To what relief is your client, as the plaintiff in proceedings for infringement, entitled? (5 marks)

## QUESTION 2

*The following synopsis relates to questions 2, 3 and 4:*

You consult with your clients, a software engineer (Mr Robot) and a medical doctor (Dr Jekyll), who have collaborated on the development of an invention that they now wish to protect. Their invention is for a mobile application that is able to integrate with the databases of doctors and dentists in order for a patient to complete a new patient questionnaire and to facilitate the booking of an appointment.

- 2.1 Given that this is the first dealing your clients have had in seeking patent protection for an invention, advise your clients, with reference to the Act, on the extrinsic requirements (the legal standards) that an invention must meet in order to be patentable. (5 marks)
- 2.2 Furthermore, advise your clients on the exclusions from patentability in terms of section 25(2). (8 marks)
- 2.3 You, as an expert in intellectual property law, advise your client that copyright protection automatically comes into existence when the screen layout and computer code of the mobile application is reduced to a material form, provided that it is original. However, copyright protection only extends to the unauthorised copying of the screen layout and source code without affording any protection for the reproduction of the functionality of the mobile application. Advise your client, with reference to the Act, on the patentability of their mobile application. (4 marks)
- 2.4 It transpires during your consultation that Dr Jekyll briefly discussed the idea of their invention with a colleague whilst attending a seminar in Switzerland. Advise your clients, in detail, with reference to sections 25(5) and 25(6) of the Act, as well as case law, whether or not the patent may still be patentable in South Africa. (8 marks)
- 2.5 Dr Jekyll, during your consultation, also informs you that he has developed a refined method of surgically removing a patient's appendix. Dr Jekyll asks if he may obtain a patent for the method he has developed. Referring to the Act, advise Dr Jekyll on the patentability of his method. (6 marks)
- 2.6 Referring to case law, advise your clients how the Court of the Commissioner of Patents assesses the novelty and inventiveness of an invention? State whether or not it is possible to mosaic prior art documents in each assessment. (10 marks)
- 2.7 It comes to light, after conducting a patentability search, that there has indeed been prior disclosure of your clients' invention. Briefly explain to your clients the provisions of the Act dealing with the exceptions regarding novelty where there has been a disclosure of the invention but the novelty thereof is not destroyed. (9 marks)

### QUESTION 3

3.1 You proceeded to file a provisional patent application for Mr Robot and Dr Jekyll five months ago for their invention. However, they have since made an improvement to the invention and now wish to file a provisional patent application that will include the subject matter of the first filed provisional patent application, as well as the improved subject matter. Your clients inform you that they do not intend on claiming priority from the first filed provisional patent application when they file local and foreign patent applications. They will instead only claim priority from the second filed provisional patent application.

In your own words, discuss with reference to section 31 of the Act, what is essential for you to do in order to properly claim priority from the provisional patent application that you will file during the course of the upcoming week and why. (8 marks)

3.2 Your clients have proceeded to file a complete patent application, claiming priority from the newly filed provisional patent application. Again, a few months down the line, your clients contact you to inform you that they have made an improvement in the invention described in their complete patent specification.

In terms of the provisions of section 39 of the Act, advise your clients fully on what option exists to them to protect their improvement to the invention already disclosed. Give your clients a concise summary of the contents of section 39. (10 marks)

### QUESTION 4

Your clients provide you with an instruction to file a complete patent application for their invention in South Africa in the names of both Mr Robot and Dr Jekyll. Referring to section 29 of the Act, describe the rights and restrictions placed on co-applicants of patent applications and the remedies in the event of any dispute between Mr Robot and Dr Jekyll.

(8 marks)

## QUESTION 5

5.1 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 EP 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)

5.2 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)

5.3 What additional step needs to be taken in terms of an amendment made after the publication of acceptance in the Patent Journal?

(2 marks)

5.4 Your client also informs you that they have received a unity of invention objection in the European examination report and asks for your advice. Draft a response to your client setting out what the Act states in terms of section 62 regarding a patent comprising more than one invention.

Also advise your client on what action may be taken, irrespective of the provision of section 62. Discuss the provisions of the Act and refer to relevant case law. (8 marks)

## QUESTION 6

6.1 South Africa, as is the rest of the world, is faced with a crisis in the wake of the COVID-19 pandemic. The world's hope in combating SARS-CoV-2 is in the successful development of a vaccine. Fast-forwarding to the future, a successful vaccine has been developed, trialled, patented and placed on the market. As we know, in terms of

section 4 of the Act, the State is bound by a patent. In terms of section 4 and section 78, what remedies does the State have in order to gain access to the vaccine for the people of South Africa, when may the State do so and what requirement(s) must be met? (6 marks)

6.2 Apart from the State, any interested party may also seek to obtain a compulsory licence to the invention subject of the patent when there is an abuse of rights. Referring to the Act, what conditions are deemed to indicate an abuse of the rights in a patent? (10 marks)

### **QUESTION 7**

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.

7.1 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)

7.2 Is there an opposition period to oppose such an application? If so, what is the opposition period? (2 marks)

7.3 Referencing the Act, advise your client on his limited rights should he be successful in his application. (10 marks)

### **QUESTION 8**

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 9

- 9.1 Your client contacts you and informs you that he has verbally assigned his valuable patent to a reliable friend of his. Advise your client whether there has been a valid assignment of his patent and what step should be taken for the assignment to be effective against third parties. Also, by when should this step be taken? (4 marks)
- 9.2 What conditions in a contract of employment shall be deemed null and void? (4 marks)

## QUESTION 10

With the aid of “Annexure 1” (a copy of the patent register of South African Patent No. 2019/01039) answer the questions that follow by providing the dates in full, where relevant.

- 10.1 What was the last day for filing a PCT patent application? (2 marks)
- 10.2 What was the last day for filing a national phase patent application in South Africa without an extension? (2 marks)
- 10.3 What was the last day for filing a national phase patent application in South Africa with an extension? (2 marks)
- 10.4 When was the first renewal fee due without an extension? (2 marks)
- 10.5 What is the last day on which the first renewal fee may be paid, with an extension? (2 marks)
- 10.6 If all the renewal fees are paid, when will the patent expire? (2 marks)
- 10.7 If the priority claimed was from a South African provisional patent application (with the same filing date as the EP 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 last day for filing such a complete patent application? (2 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 <b>2019/01039</b>	22		47	2020/02/27
International classification		Lodging date: Complete		Granted date	
51	C11D	23	2017/09/06		2020/05/27
International Application No.		International filing Date		Priority Date	
PCT/EP2017/072330		2017/09/06		2016/09/29	
71	Full name(s) of applicant(s)/Patentee(s): UNILEVER PLC Unilever House, 100 Victoria Embankment, London, Greater London, EC4Y 0DY, United Kingdom				
71	Applicant substituted:			Date registered	
71	Assignee(s):			Date registered	
72	Full name(s) of inventor(s): MARTIN CHARLES CROSSMAN BELINDA FAY DAWSON CHRISTOPHER CLARKSON JONES NICKI ELIZABETH MILLIGAN				
Priority claimed:		Country	Number	Date	
		33 EP	31 16191806.9	32	2016/09/29
54	Title of invention <b>LAUNDRY COMPOSITION</b>				
Address of applicant(s)/patentee(s): Unilever House, 100 Victoria Embankment, London, Greater London, EC4Y 0DY UNITED KINGDOM					
74	Address for service				
81	Patent of addition No.		Date of any change		
Fresh application based on.		Date of any change			