

PATENT ATTORNEY'S PRACTICE

EXAMINATION

SEPTEMBER 2020

INSTRUCTIONS TO CANDIDATES:

- (a) Answer any 4 out of 5 questions. Please indicate the questions answered on the front cover of your examination script.
 - (b) The paper is out of 100. Each question is worth 25 marks.
 - (c) Marks are awarded for the correct application of the law, coherency of argument, conciseness, reference to appropriate case law and overall impression concerning the depth and breadth of a student's knowledge.
 - (d) Please write neatly.
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Question 1

You are approached by the patentee of an important pharmaceutical product having an active ingredient called Zylophage.

Client tells you that she has heard rumours, through her sales staff, who will not attest to an affidavit, of the launch of a generic version of the patented product even though the patent has some 5 years still to run.

She would like to institute proceedings for infringement immediately.

In considering the matter you review the claims of the patent which read as follows:

1. A pharmaceutical composition comprising Zylophage.
2. Use of Zylophage for use in treating diabetes.
3. Zylophage for use in the treatment of diabetes.
4. Use of Zylophage in the manufacture of a medicament for use in medicine.

The body of the specification only exemplifies and mentions the treatment of diabetes. Furthermore, you note from the prosecution of the corresponding European application that a pharmaceutical composition comprising Zylophage is not novel.

Please advise on whether infringement proceedings can be instituted immediately and if any amendments are required and when, if at all, it would be opportune to make the amendments. Please also indicate the manner in which you would amend the claims if you believe they need amending.

Question 2

Distinguish between the following two scenarios concerning the legal effect, under patent law, on the Registrar and/or the Patentee and/or the application, as the case may be, and what consequences and/or remedies, if any, exist:

Scenario 1 : Your client has instructed you to file a patent of addition. Before you are able to file the patent of addition, the Registrar accepts the parent application which then proceeds to grant.

Scenario 2: You are waiting for client to provide you with a signed Form P3 and P26. The six month time period within which to file the Form P3 and P26 has not expired yet but to be safe you file an extension of time for one year. Inadvertently, your extension of time request refers to the wrong year, i.e. instead of requesting 15 September 2021 you request 15 September 2020. The latter request for delay was allowed by the Registrar but no acceptance has taken place.

Question 3

You are approached by a manufacturer and supplier of technology designed to aid vendors to set up efficient payment systems.

Client's latest creation is a point of sale device at a till which allows a customer to input and process payment without the teller handling the device or the credit card of the customer.

Client's creation, for which it has a granted patent, comprises the reconfiguration of the Apple iOS software on an apple phone so as to only provide an interface for payment by the customer and includes a housing for the apple phone.

Additionally, your client has patented, in the same patent, the addition of a "chip" reader and a magnetic reader to the apple phone for a customer to swipe his or her credit card or to insert it into the housing where the "chip" reader will read the "chip" on the card.

To add the above functionality, your client has to modify the apple phone in order to integrate the magnetic and "chip" readers which includes replacing the majority of the circuit boards in the phone.

You conduct a freedom to operate search and find a patent by Apple covering its phone and components and its iOS.

It is very likely that the new and inventive point of sale device will infringe at least one claim in the patent for the phone.

Your client cannot understand what the issue is since Apple and its patent does not relate to point of sale devices and is different because of the readers integrated into it.

Advise your client concerning your client's confusion and advise as to what he might do to avoid infringement.

Question 4

Advice is sought from you by your client with regard to a third party's headphone set that is similar to the one your client patented.

Claim 1 of your client's granted patent reads:

"A set of headphones including two over ear muffs, a headband and connectivity means for wirelessly connecting to a phone or music device, wherein the connectivity means comprises Wi-Fi 5.0 or below and BlueTooth".

The third party's headset also has the capability of wireless connectivity but does so using Near Field Communication (NFC). Otherwise it is the same as your client's product.

Reading the body of the specification of your client's patent, you note that an example therein mentions NFC.

Your client therefore instructs you to add NFC to claim 1.

Advise your client whether this is permissible and if not, why not.

Question 5

A client of yours is a manufacturer and seller of medical devices. His best-selling product is a smartwatch with the requisite sensors to not only read a user's heart beat and to provide an ECG, but also to provide a blood pressure reading. Your client tells you that he has regulatory approval in South Africa, Europe and America and that his smartwatch has been patented since 2016.

Your client tells you that he has been made aware of a competitor in South Africa that is trialing a smartwatch that also measures heart beat and blood pressure (and reportedly provides an ECG). This competitor is working with the South African Bureau of Standards as well as the regulatory authority responsible for approval of medical devices in South Africa.

Your client wants to sue immediately before the competitor gets into the market, and on an urgent basis.

In considering the merits of the matter, you note that there is an omnibus claim to a smartwatch as herein described and exemplified with reference to the figures. Figure 2, that shows how the microchips for each function of the smartwatch are layered, is missing and is also not in the patent office file, nor was it included in the corresponding international application.

Finally, when you check the register sheet for the patent, you note that the renewals are fully paid up but that there is a caveat on the register sheet to inform Mr X of any changes affecting the patent. Your client tells you that Mr X was a former employee of his company and was cited as an inventor but in your client's opinion Mr X should be deleted as inventor in that he was involved in designing the strap for the smartwatch and was only peripherally involved with the electronics of the smartwatch, your client believing that Mr X's contribution was insignificant in his mind.

Advise your client concerning the enforcement of his patent.