

DEPARTMENT OF TRADE AND INDUSTRY PATENT EXAMINATION BOARD

EXAMINATION 2018

Group 1 Subject (a)

Legal Framework for the Protection of Intellectual Property in South Africa

Examiners: A. van der Merwe, D. Cochrane, D. Biagio

Moderator: L. van der Walt

Time: 4 hours

Marks: 100

Instructions:

1. Answer all four questions.
2. Please note that the four questions carry equal mark values; accordingly, equal time should be devoted to the questions.
3. The term "TRIPS Agreement" or "TRIPS" refers to the Agreement on Trade-Related Aspects of Intellectual Property Rights of the World Trade Organization (WTO).

QUESTION 1: TRADE MARKS ACT, NO. 194 OF 1993 (the “Act”)

- 1.1 What, in terms of the Act, is the definition of:
a) a “device”; and
b) a “trade mark”. (5)
- 1.2 What is the fundamental requirement in terms of the Act for a trade mark to be registrable? Does the Act provide any qualifications to this requirement? If so, indicate briefly what these may be. (3)
- 1.3 Is it necessary, in terms of the Act, to register a trade mark in respect of specified goods or services falling within a certain class? If so, give two brief reasons why this is important. (4)
- 1.4 List the requirements to be proved, in terms of the Act, in an infringement situation where the respective goods/services are identical. (5)
- 1.5 List any three defences to infringement provided in the Act. (3)
- 1.6 (a) Your client, company A, consults with you and informs you that it has recently come to their attention that their product X which they are selling under the trade mark ABC is the same product that their competitor, company B, is selling and that company B has recently registered the identical trade mark ABC. Advise A briefly what their position is, in terms of the Act (-on these facts alone).
- (b) Now assume that A had been using the trade mark ABC for about 10 years and that there had been no confusion or deception in the marketplace between the respective products of A and B? Advise A briefly what they could do in terms of the Act. (5)

Marks [25]

QUESTION 2: COPYRIGHT ACT, NO. 98 OF 1978 (as amended) (the “Act”)

- 2.1 Does copyright protect ideas? If not, what, in essence, does copyright protect? (2)
- 2.2 Name 5 (five) categories of creations that are eligible for copyright protection, in terms of the Act. (5)
- 2.3 Authorship plays an important role in copyright law. Who or what is a “qualified person” in respect of authorship, in terms of the Act? (3)
- 2.4 In terms of the definitions of the Act, who is the author of the following works: (2)
- (a) a drawing of a technical nature such as an engineering drawing?
 - (b) a computer program?
- 2.5 Can the state or an international organization own copyright, in terms of the Act? (3)
- 2.6 In the case of a work made in the course of the author’s employment by another person under a contract of service, who is generally the owner of copyright in that work? (2)
- 2.7 The Act grants exclusive rights to do certain acts in the Republic in respect of *inter alia* musical works. Name 4 (four) of these acts. (4)
- 2.8 What relief can be obtained by a copyright owner in respect of infringement? (4)

[TOTAL 25]

QUESTION 3: PLANT BREEDERS' RIGHTS ACT, NO. 15 OF 1976 (the "Act")

1. One of the basic requirements for obtaining a Plant Breeders' right for a variety of plant in South Africa is that the variety is "new". Discuss the provisions of Section 2 of the South African Plant Breeders' Rights Act in respect of "new".

(4)

2. The three other basic requirements for obtaining a Plant Breeders' right for a variety are that the variety is Distinct, Uniform and Stable. Provide a short explanation for each of these requirements.

(6)

3. From an infringement point of view, name three of the effects of a Plant Breeders' Right in terms of Section 23 of the Plant Breeders' Rights Act.

(3)

4. Mr Smith is a farmer who owns a 1 hectare smallholding in the Free State on which he grows corn. Company A has a valid South African Plant Breeders' Right for a variety of corn called Classic Gold. Mr Smith bought Classic Gold seeds in a legitimate manner from Company A and grew and harvested corn on his smallholding. He consumes some of the corn that he harvests and sells some of it at a local market. He also saves some of the harvested corn and replants it on the same smallholding the next year. With reference to the particular Section of the South African Plant Breeders' Right Act, explain whether Mr Smith's act of saving and replanting seed infringes the Plant Breeder's Right covering the Classic Gold corn variety.

(5)

5. Would your answer be different if Mr Smith was a large scale commercial farmer?

(1)

6. If Mr Smith gives some of the harvested seed to his neighbour, Mrs Khumalo, and Mrs Khumalo plants the seeds and grows the corn on her smallholding, will Mrs Khumalo infringe the Plant Breeder's Right covering the Classic Gold corn variety?

(1)

7. What is the duration of a Plant Breeder's Right in terms of Section 21 of the Plant Breeders' Rights Act?

(3)

8. What is the time-limit for a third party to oppose a Plant Breeders' Right application?

(2)

Marks [25]

QUESTION 4: INTERNATIONAL AGREEMENTS, CONVENTIONS AND TREATIES

4.1(a) Explain how the public's general perception of intellectual property has changed over the past 50 years.

(1)

4.1(b) Why would a group of companies establish a separate IP holding company to own the group's intellectual property? Give two reasons and briefly explain each.

(2)

4.2(a) Indicate (yes/no) if South Africa has acceded to the following conventions/treaties:

- a) Rome Convention for the Protection of Performers and Producers of Phonograms and Broadcasting Organisations
- b) International Convention for the Protection of Industrial Property
- c) International Convention for the Protection of Literary and Artistic Works
- d) Treaty on the International Recognition of the Deposit of Micro-organisms for the Purpose of Patent Procedure
- e) WIPO Copyright Treaty
- f) WIPO Performances and Phonograms Treaty

(3)

4.2(b) Name three international treaties/conventions pertaining to intellectual property, to which **South Africa has not yet acceded but has implemented.**

(3)

4.3 Indicate True/False to the following statements:

- a) The General Agreement on Tariffs and Trade (GATT) was the pre-cursor to TRIPS and was replaced by TRIPS.
- b) TRIPS member states may require use for registration of a trade mark but use must not be a precondition for filing a trade mark application.
- c) TRIPS requires that designs must be new and original to qualify for design protection.
- d) TRIPS provides that undisclosed data for pharmaceutical or agricultural products must be protected against further disclosure and unfair commercial use. Our legislation ensures that we are in compliance with this provision.
- e) TRIPS requires member countries to comply with the moral rights provisions of the Berne Convention.

(5)

- 4.4 Provide 3 main objectives of the TRIPS Agreement (3)
- 4.5 How did the Doha Declaration come about? (1)
- 4.6 In some countries, methods of treatment of humans and animals are excluded from patentable subject matter and in other countries they are not. What is the position of TRIPS on this point? (1)
- 4.7 Article 30 of TRIPS provides that members may provide limited exceptions to the exclusive rights conferred by a patent, provided that such exceptions do not unreasonably conflict with a normal exploitation of the patent and do not unreasonably prejudice the legitimate interests of the patent owner, taking account of the legitimate interests of third parties.
- Explain how the so-called Bolar provision in our Patents Act (s69(A)) restricts the rights of a patentee in this way. (2)
- 4.8 How does the TRIPS provision on the protection of well known marks go beyond the provisions of the Paris Convention? (2)
- 4.9 Article 19 of TRIPS provides that if use is required to maintain a trade mark registration, the registration may be cancelled only after an uninterrupted period of at least three years of non-use, unless valid reasons based on the existence of obstacles to such use are shown by the trade mark owner.
- Does our legislation comply with this provision? Does our legislation go above and beyond this provision? Explain your answer. (2)

Marks [25]