

SOUTH AFRICAN PATENT LAW AND PRACTICE (Group 1b)

EXAMINATION PAPER – JUNE 2016

(PAPER SET UNDER THE AUSPICES OF
THE SOUTH AFRICAN INSTITUTE OF INTELLECTUAL PROPERTY LAW (SAIIPL)
AND
THE PATENT EXAMINATION BOARD (PEB))

EXAMINER:

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MODERATOR:

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NOTES TO CANDIDATES:

1. There is no choice of questions to be answered. All questions should be answered.
2. The paper consists of a total of 10 pages and a total of 16 questions.
3. Duration: 4 hours.
4. Total marks: 200 marks
5. All references to the Act are references to the South African Patents Act, No 57 of 1978, and all references to sections are references to sections in the Act.
6. Wherever possible, your answers should refer to the relevant sections of the Act, the content of the section should be set out and only then should a conclusion be reached.
7. Write neatly and legibly.
8. All questions must be answered in the answer book provided.

QUESTION 1 [20 MARKS] - MULTIPLE CHOICE QUESTIONS (ONLY ONE CORRECT ANSWER IN EACH CASE)

1.1 According to section 90 of the Act, certain conditions relating to the sale of a patented article or to a licence under a patent, are excluded from contracts, these are: [2]

- a) to prohibit or restrict the purchaser or licensee from purchasing or using any article or class of articles, whether patented or not, supplied or owned by any person other than the seller or licensor or his nominee.
- b) to prohibit or restrict the licensee from using any article or process not protected by the patent.
- c) to require the purchaser or licensee to acquire from the seller, licensor or his nominee any article or class of articles not protected by the patent.
- d) to require or induce the purchaser to observe a specified minimum resale price in respect of any article or class of articles protected by the patent.
- e) to prohibit or restrict the making, using, exercising or disposing of the invention concerned in any country in which the invention is patented.
- f) all of the above
- g) a, b, c and e
- h) a, b, c and d

1.2 To comply with the Act's requirements for a complete specification filed at the South African Patent Office, the specification must: [2]

- a) Sufficiently describe, ascertain and, where necessary illustrate or exemplify the invention and the manner in which it is to be performed by a person skilled in the art of such invention.
- b) Disclose the best method of performing the invention known to the applicant at the time when the specification is lodged at the Patent Office.
- c) include claim(s) defining the invention for which protection is claimed.
- d) have an abstract generally limited to a single paragraph of not more than 150 words.
- e) All of the above
- f) a, c and d

1.3 In terms of the Act, which action may the Registrar of Patents not do: [2]

- a) receive evidence and determine whether and to what extent it shall be given by affidavit or viva voce upon oath.
- b) hear and decide any proceedings relating to any matter under the Act.
- c) award costs against any party in any proceedings before him.
- d) both b and c.

1.4 Your client has an existing patent application, which has not yet been granted. Claims 1-7 claims a device and claims 8-21 claims a specific component of the device. You advise your client that a patent may only be granted for a single invention and you believe that his specification includes two separate inventions. With the information given, which option is best suited to your client's needs: [2]

- a) file a supplementary disclosure.
- b) file a divisional application.
- c) abandon the current patent application and file a new application.
- d) file a patent of addition.

1.5 Your client has invented a new composition and use of the composition in stabilising and preserving blood and/or blood products. Of the following claims included in the specification filed at the Patent Office, which are not acceptable in terms of the Act: [2]

- a) A method of stabilising and preserving blood and/or blood products in a subject.
- b) Use of the composition in the manufacture of a medicament for stabilising and preserving blood and/or blood products
- c) A composition comprising 20-30 % active component; 5-10 % preservative; and 40 - 85 % water.
- d) A composition for use in the stabilising and preserving of blood and/or blood products.

1.6 Your client files a South African provisional application on 11 March 2012. When it comes to completing the application, he post-dates it with the maximum allowable time, he then files a PCT application on the last day possible, and then only files his South African complete application after all possible extensions (i.e. on the very last day possible). Assuming all renewal fees are paid, when would the patent finally expire? [2]

- a) 11 March 2031
- b) 11 December 2032
- c) 11 September 2033
- d) 11 March 2033

1.7 Which forms must be signed by the patentee and cannot be signed by his agent? [2]

- a) Form P1
- b) Form P3
- c) Form P25
- d) Form P26
- e) Forms P1 and P3
- f) Forms P3 and P26
- g) Forms P1 and P25

1.8 In what language may the patent specification be filed at the Patent Office initially? [2]

- a) English
- b) Any one of the official languages of South Africa
- c) Any language of a convention country

d) All of the above

1.9 Compound X is well known for treating headaches. Your client has now discovered that compound X works extremely well for curing bee stings, when reduced to a powdered form and applied to the sting site. Your client wants to file a patent application having the claims below. Which are not acceptable: [2]

- a) A method of treating bee stings by applying a powder form of compound X to the sting site.
- b) Use of compound X in the manufacture of a medicament for treating a bee sting.
- c) Compound X for use in the treatment of bee stings.
- d) both a and b
- e) both a and c
- f) both b and c
- g) all of the above

1.10 In accordance with section 10 of the Act, a patent register is kept at the Patent Office containing all relevant details of the patent. Which of the following information is entered in the register? [2]

- a) name and address of applicant
- b) names of inventors
- c) renewal fees paid
- d) classification of invention
- e) Address for service
- f) Length of specification and number of claims filed
- g) All of the above
- h) a-e above

QUESTION 2 [40 marks]:

2.1 Fill in the missing words and phrases.

Section 25. Patentable inventions

(1) A patent may, subject to the provisions of this section, be granted for any (a) _____ which involves (b) _____ and which is (c) _____.

[6 x 1/2]

(2) Anything which consists of -

(a) (d) _____;

[1/2]

(b) (e) _____;

[1/2]

(c) (f) _____;

[1/2]

- (d) (g) _____; [5 x ½]
 (e) (h) _____; [6 x ½]
 (f) (i) _____; or [½]
 (g) (j) _____, [½]

shall not be an invention for the purposes of this Act.

- (3) The provisions of subsection (2) shall prevent, (k) _____, anything from being treated as an invention for the purposes of this Act. [3 x ½]

- (4) A patent shall not be granted -

- (a) for an invention (l) _____; or [4 x ½]
 (b) for any (m) _____, not being a micro-biological process or the product of such a process. [6 x ½]

....

- (10) Subject to the provisions of section 39(6), an invention shall be deemed to involve an inventive step if (n) _____. [5 x ½]

- (11) An invention of a method of (o) _____. [7 x ½]

- (12) Subsection (11) shall not prevent a (p) _____. [5 x ½]
 [Subtotal = 26]

2.2 When is an invention deemed to be new? [2]

2.3 Discuss the state of the art with reference to section 25 of the Act. [12]

QUESTION 3 [10 MARKS]

3.1 You receive the below email from a colleague:

Our client has been selling a product for almost 10 years in multiple countries. The method used to make the product has never been disclosed, and has been modified periodically over this time. The method is not discernible from the product, i.e. the method itself is not able to be reverse engineered from

the product. Our client is now interested in filing a patent application covering this method.

Please let us know whether a valid patent application claiming our client's method can be filed in South Africa (assuming that the claims are novel and inventive over prior art other than our client's own prior secret use).

Please advise with reference to the Act. As your colleague did not mention whether 'multiple countries' include South Africa, make sure your advice makes provision for either situation. [5]

- 3.2 Referring to section 36, the registrar has powers to refuse a patent application on certain grounds, amongst others where the invention relates to the production or use of nuclear energy or to the production, processing or use of nuclear material or restricted matter as defined in section 1 of the Nuclear Energy Act, 1999. What are the other grounds set out in section 36? [5]

QUESTION 4 [14 MARKS]

Vusi has invented a face cream to reverse the aging process and to diagnose skin cancer and is considering filing a patent application therefor.

- 4.1 Can Vusi include the following claims in his patent application? (state yes or no and give a reason with reference to the Act)

- a) Use of a compound x in the manufacture of a skin cream for reversing the aging process and to diagnose skin cancer. [2]
- b) A method of reversing the aging process and diagnosing skin cancer by applying a face cream to skin of a person. [2]
- c) A skin cream for use in reversing the aging process and diagnosing skin cancer. [2]

4.2 Vusi's sister Nola is a famous international model and has been using the face cream for the past three months in order to test its anti aging properties. Nola is photographed and interviewed by a magazine and during the interview she reveals her beauty secret. She tells the reporter how the cream works and even gives details about how her sister manufactures it and the compositions used therein. Her interview together with all the details of the cream is published in the magazine before Vusi has had a chance to file a patent application and now fears that he may not be able to obtain a valid patent for the cream.

- 4.2.1 Has the novelty of Vusi's invention been destroyed? [1]

- 4.2.2 By referring to the Act and giving reasons, can he still obtain a patent for it? [5]

- 4.2.3 If he can, what should he do? [2]

QUESTION 5 [6 MARKS]

Sam is an employee of Vusi, a manufacturer of cosmetic creams. Sam is a computer programmer and enters into an employment contract with Vusi. The agreement contains the following clause:

“The employee hereby assigns all rights and title in any invention made by herself to her employer”

In her spare time Sam weaves materials using different types of fibres. One day she accidentally leaves a piece of her weaving on one of Vusi’s heaters. Hours later she discovers that, as a result of the heat, certain fibre combinations form a very strong, almost unbreakable material. During the next few days she brings different samples of fibres to her place of work and she experiments using different combinations of the fibre and different periods and settings of heat exposure. As a result of all her experimentation, Sam discovers that a very strong and durable type of material may be made by a specific combination of different types of fibre placed, for a certain period of time, on a heater (which happens to be owned by her employer). The material is suitable for windsurfing and she thinks that there may be a commercial market for the material.

Vusi and Sam approach you for legal advice.

Vusi is of the opinion that the invention belongs to him as the employer, as it was made during Sam’s hours of employment with him and his equipment was used. Sam argues that the invention has nothing to do with Vusi.

Please advise referring to the Act.

QUESTION 6 [14 MARKS]

2.2 Who may apply for a patent? [3]

A patent is in the name of joint patentees:

2.3 According to section 27, in the absence of an agreement to the contrary, joint inventors may apply for a patent in _____ shares. [1]

2.4 Referring to section 29 of the Act, describe the rights and restrictions placed on co-applicants of patents. Also describe the remedies in the event of any dispute. [10]

QUESTION 7 [10 MARKS]

When drafting the body of a patent specification (as opposed to the claims) what requirements relating to the complete specification must be met to ensure that the resultant patent is not liable to be revoked? [6]

Assuming that the patentability requirements of section 25 are met, what other requirements should the patent claims meet to ensure that they are not subject to revocation? [4]

QUESTION 8 [14 MARKS]

8.1 Your client's patent application is to be granted soon. There may be a need to amend the claims of the patent application. In terms of section 51, advise your client on whether to amend the patent application prior or after grant. [12]

8.2 What is the term for filing an opposition to amend an application:
8.2.1 pre-grant; and
8.2.2 post-grant. [2]

QUESTION 9 [12 MARKS]

Your client has made some changes to his invention after an application for a patent accompanied by a complete patent specification has already been filed. Explain 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.

QUESTION 10 [22 MARKS]

10.1 Tim has invented a novel blanket, the material of which retains heat much better than existing blankets. Tim has filed and obtained a patent for his blanket and the method of manufacturing the blanket. Assuming that all patentability requirements are met and Tim has a valid patent, consider the following situations separately:

10.1.1 Leanie is advertising Tim's blanket.

10.1.2 Tanya is the owner of a factory where Tim's blanket is being produced.

10.1.3 Sune is using Tim's method to make to make a blanket for a science project.

10.1.4 Bill has bought a blanket from Tim and now sells it to Peter.

10.1.5 Sonja is importing a better blanket manufactured by ABC (Pty) Ltd from the USA

10.1.6 Herman is manufacturing Tim's blanket and donating it to needy individuals.

By referring to the Act, advise Tim on whether any of the above actions falls within his monopoly, and why/why not the actions are considered an infringement (or not) of his exclusive rights. [2 marks each = 12]

10.2 Tim's complete patent application was filed on 1 December 2014 and granted on 6 March 2016. Tim wants to know from which date he will enjoy protection and when his patent will expire (should all his renewal fees be paid). Advise. [2]

10.3 Referring to 10.2 above, when can Tim institute proceedings for infringement? [2]

10.4 Should Tim eventually decide to proceed with infringement proceedings in any of the above situations, what kind of relief would he be entitled to? [6]

QUESTION 11 [4 MARKS]

Your renewal department sends a renewal reminder to one of your clients XYZ CC, who subsequently replies that the patent should not be renewed and can proceed to lapse. Two years later an employee of XYZ enquires as to the status of the patent in question. The employee is shocked to learn of the lapse of the patent and enquires what can be done to restore the patent.

In the circumstances above, can XYZ apply for the restoration of the patent? Please advise fully by referring to the Act and setting out the requirements that must be met before an application for restoration can be successful.

QUESTION 12 [6 MARKS]

South African patent application no. 2012/01234 (ZA 2012/1234) was filed on 13 February 2012, accepted on 8 January 2013 and proceeded to grant on 26 March 2013. The patent claims priority from South African provisional patent application 2011/01544 (ZA 2011/01544) filed on 5 March 2011.

South African patent application no. 2011/07765 (ZA 2011/07765) was filed as a national phase application on 17 July 2011. ZA 2011/07765 was based on a PCT patent application with a filing date of 18 February 2010. The PCT patent application claimed priority from US provisional patent application no. 60/073,255 which was filed on 22 February 2009. ZA 2011/07765 was accepted on 24 April 2012 and proceeded to grant on 26 June 2012.

In respect of (1) ZA 2012/01234 and (2) ZA 2011/07765

12.1 When is/was the first renewal fee due? [2]

12.2 Are extensions available in terms of the renewal fees, and if so, how long? [1]

12.3(a) What was the final deadline for filing a complete patent application from ZA 2011/01544? [1]

12.3(b) Would your answer have differed if the priority application was filed in another convention country? [1]

12.4 What was the deadline, including any extensions, for filing the national phase patent application based on the PCT patent application? [1]

QUESTION 13 [6 MARKS]

Your client has applied for a patent, the working of which would result in the infringement of a prior patent. Your client is intending to obtain a compulsory licence. In terms of section 55, what should your client prove?

QUESTION 14 [7 MARKS]

Your client expresses an interest in filing a PCT application. Advise your client on the advantages and disadvantages of doing so. [1 mark for each point]

QUESTION 15 [10 MARKS]

Your client is the holder of a patent and discussed with you the option of sending letters to all his competitors to make them aware of his patent. Other patents of your client have in the past been infringed by some of these competitors, and for this reason your client is adamant that strongly worded letters should be sent to all his competitors. In terms of section 70 of the Act, advise your client.

QUESTION 16 [5 MARKS]

What do you understand by the term post-dating and what pitfall(s) should you be aware of when adopting this procedure?