

SOUTH AFRICAN PATENT LAW AND PRACTICE

EXAMINATION PAPER - JULY 2018

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

EXAMINER:

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MODERATOR:

James Davies

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 6 pages and a total of 10 questions.
3. The duration of the exam is 4 hours.
4. Total marks of the exam is 170 marks
5. All references to the Act are references to the South African Patents Act, No 57 of 1978.
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.

QUESTION 1 [30 MARKS]

- 1.1 The Act provides for certain intrinsic characteristics of patentable inventions. What are these characteristics? (5 marks)
- 1.2 One of the extrinsic characteristics of an invention is that it must be new in that it shall not form part of the state of the art immediately before the priority date of that invention. What comprises the state of the art? (7 marks)
- 1.3 Is an invention of a method of treatment of the human or animal body by surgery, therapy or of diagnosis practiced in the human or animal body patentable? Justify your answer by referring to the Act. (3 marks)
- 1.4 You consult with a new client. The client's invention has apparently been 'stolen' by somebody in America. The client explains that he has conceived the idea and then used Word to write down the details of his invention. He saved the document on his laptop. This all happened several months ago. A week before the consultation, the client read an article on gizmodo.com which describes an invention of a certain Mr Joe American, which invention is very similar to his invention. He is now convinced that Mr American has hacked his computer and stolen his idea. Referring to Section 26(a) only, advise your client whether or not he has any remedy in terms of obtaining protection for his invention. (7 marks)
- 1.5 Referring to the Act (Section 29), describe the rights and restrictions placed on co-applicants of patents. Also describe the remedies in the event of any dispute. (8 marks)

QUESTION 2 [15 MARKS]

- 2.1 The correction of which errors may the registrar or the commissioner of patents authorise in terms of Section 50 of the Act? (3 marks)
- 2.2 When may a patent application or a patent be amended on application to the registrar and who may make such an application? (2 marks)
- 2.3 What are the requirements when applying to amend a complete patent application that is open to public inspection? (5 marks)
- 2.4 When is an applicant for amendment of a patent obliged to apply to court for the amendment and what may the court do on receipt of an application of an application for amendment? (4 marks)

- 2.5 When may the commissioner of patents not set aside an amendment made in conflict with the provisions of Section 51 of the Act? (1 mark)

QUESTION 3 [15 MARKS]

- 3.1 Section 55 of the Act makes provision for compulsory licenses in respect of dependant patents.
- a) what is a dependant patent; and (2 marks)
- b) what conditions must be satisfied before the commissioner of patents will grant a compulsory licence? (5 marks)
- 3.2 Section 50 of the Act makes provision for compulsory licences in cases where the rights in a patent are being abused. What conditions are deemed to indicate an abuse of the rights in a patent? (8 marks)

QUESTION 4 [23 MARKS]

- 4.1 Who may apply for a patent? (3 marks)
- 4.2 What do you understand by the term post-dating, and of what pitfall(s) should you be aware when adopting this procedure? (4 marks)
- 4.3 At what stage does a patent application accompanied by a complete specification first come open to public inspection where:
- a) it claims priority from a convention application? (2 marks)
- b) it claims priority from a South African provisional patent application? (2 marks)
- 4.4 What is the effect of a patent, and how does the sale of a patented article alter this effect? (4 marks)
- 4.5 You filed a provisional patent application for a client six months ago. Your client now wants to file a provisional patent application which will include the subject matter of the first filed provisional patent application and some additional subject matter. The client tells you that he will file local and foreign patent applications and that he will ultimately not want to claim priority from the first filed provisional patent application, but from the provisional patent application which will be filed in the next couple of days. Referring to the Act (Section 31), if priority is to be claimed from the provisional application that will be filed in the next couple of days, what is essential for you to do to properly claim priority and why? (8 marks)

QUESTION 5 [21 MARKS]

- 5.1 Under what circumstances would you advise your client to surrender its patent? (3 marks)
- 5.2 To what relief is a plaintiff in infringement proceedings entitled? (4 marks)
- 5.3 What do you understand by the term ‘Gillette Defence’? (3 marks)
- 5.4 What form of letter would you send to a third party if you were not quite sure if the third party was in fact infringing your client’s patent? What do you need to guard against? (3 marks)
- 5.5 In terms of section 33, what is the function of the claims, and what requirements should the claims of a complete specification meet? (4 marks)
- 5.6 In deciding to restore a patent, the registrar has to be satisfied that certain requirements have been met. List the requirements. (4 marks)

QUESTION 6 [5 MARKS]

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 marks)

QUESTION 7 [16 MARKS]

You are a candidate attorney at an IP law firm in South Africa. Your boss, a difficult partner, is out of town. A client phones and advises that he has made some changes to an invention. Your boss has already filed a complete patent application covering the original invention, which application is to proceed to grant *tomorrow*. You have no way of contacting the partner. From the information available, it seems as if the changes are modifications to certain key components of the invention. Assume that the changes constitute new matter, even though the impact on the functionality of the invention is limited.

You are pressed for time and have to analyse the relevant sections of the Act in detail to determine what your best options would be to obtain protection for the new matter. In analysing the problem, you are not to consider the filing of a new provisional patent application. Set out the relevant sections of the Act, and then

explain your options in addressing the issue today, or waiting until your boss comes back tomorrow. Also explain by referring to the Act what the approach would be with your options.

(16 marks)

QUESTION 8 [10 MARKS]

Your client has a patent. Although you advised the client that it would be prudent to conduct a subject matter/freedom to operate type of search through the records of the South African Patent Office before launching the patented product, the client launched the product without such investigation. Your client has now received a letter of demand and phones you confused as he was under the impression that his patent gives him the right to sell his product in South Africa. Referring to section 45(1), explain the type of right obtained under a patent and the effect of a patent.

(10 marks)

QUESTION 9 [22 MARKS]

List the grounds of revocation. Give a very brief explanation where a ground refers to another section. The other sections need not be discussed at length, only give a very short overview of what the other section relates to.

(22 marks)

QUESTION 10 [13 MARKS]

South African provisional patent application no. 2010/06789 (ZA 2010/06789) was filed on 8 March 2010.

A PCT application claiming priority from ZA 2010/06789 was filed on 3 March 2011.

Subsequently a national phase patent application was filed in South Africa, which was accepted and proceeded to grant on 28 August 2014.

- 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 When was the first renewal fee due with an extension? (2 marks)
- 10.6 If all the renewal fees are paid, when will the patent expire? (2 marks)
- 10.7 If your client decided not to file the abovementioned PCT application, and to only continue with a South African complete application claiming priority from ZA 2010/06789, what would have been the last day for filing such a complete patent application with the maximum extension possible? (1 mark)