

SOUTH AFRICAN PATENT LAW AND PRACTICE

EXAMINATION PAPER - JULY 2015

(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 8 pages and a total of 13 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.

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

1.1 To comply with the Act's requirements for a complete specification filed at the South African Patent Office, the specification must include all of the following, except: [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) claim(s) defining the invention for which protection is claimed.
- d) have a abstract generally limited to a single paragraph of not more than 150 words.

1.2 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.

1.3 Your client has an existing patent, but has now made some changes to his patented invention, which he believes is new but perhaps not inventive, and which he also wants to protect. His existing patent has been granted for some time. 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) file a new patent application.
- d) file a patent of addition.

1.4 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.

1.5 Your client files a South African provisional application on 15 February 2011. When it comes to completing the application, he post-dates it with the maximum allowable time, 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) 15 February 2031
- b) 15 November 2032
- c) 15 August 2031
- d) 15 February 2033

1.6 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

1.7 When can proceedings for patent infringement be instituted: [2]

- a) As soon as the complete patent application has been filed
- b) Upon grant of the patent
- c) 6 months after grant of the patent
- d) 9 months after grant of the patent

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 not entered in the register? [2]

- a) name and address of applicant
- b) names of inventors
- c) renewal fees paid
- d) classification of invention
- e) length of specification and number of claims filed
- f) Address for service

QUESTION 2 [40 marks]:

2.1 What are the extrinsic characteristics for an invention to be patentable in terms of the Act? [3]

2.2 You are provided with various patent specifications, including inter alia, the following claims. Assuming that the extrinsic characteristics are met, are the claims valid in their present form? Briefly explain, giving reasons and relevant section numbers.

2.2.1 A program for a computer which enables the integration of various different components in a security system so that the different components can be controlled from a single control unit. [2]

2.2.2 An apparatus for playing a game simulating the Olympic games, the apparatus including a board having a plurality of demarcated zones indicating different types of Olympic sports, a plurality of tokens adapted to move on the board and a set of rules. [2]

2.2.3 An advertising board which displays information and which is adapted to be mounted over a highway, comprising a lightweight frame and snap-fit connection means to enable the board to be so mounted. [2]

2.2.4 A machine including various gears cooperating so that the machine perpetually runs in order to generate power. [2]

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

2.4 When is an invention deemed to involve an inventive step? [3]

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

2.6.1 A client comes to you with a new invention comprising a new type of improved mop that cleans floors without streaks and which dry faster and easier than with

existing mops on the market. He advises that he has been using it for his own personal use, secretly for about 2 years and has now decided to file a patent application for his new mop. Advise whether it will be possible to file a valid patent application, in South Africa. [2]

2.6.2 It later comes to light that he has in fact been using the mop secretly and commercially in Namibia and not merely using it secretly for his own personal use locally. Would your advice in 2.6.1 differ? [2]

2.6.3 What if the client has been selling it commercially in South Africa? [2]

2.6.4 The client then advises that he really hasn't sold that many mops, only one or two in South Africa to test the market. He enquires whether there is any possible way to file a patent application in South Africa for his new mop, as he really needs protection before marketing it. Please advise your client. [4]

2.7 Is the state bound by a patent? [1]

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

QUESTION 3 [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?

QUESTION 4 [40 MARKS]

You have a client in the pharmaceutical industry who specifically produces generic medicines and wants to start manufacturing and testing a new drug. You advise that patent searches should first be conducted in order to establish whether or not there may be an existing patent which may be infringed by the exploitation of their new drug.

4.1 Your client instructs you to continue with South African patent searches in order to reveal any patents which may be infringed by the exploitation of his new medicine. You reveal a relevant patent that you believe would be infringed by your client.

What is the effect of this patent? [8]

4.2 You warn your client that the patentee could institute proceedings for infringement. What relief would the patentee be able to claim? [6]

4.3 Your client is adamant that he wants to proceed with launching his new generic medicine, even although it is basically a copy of the patented medicament, as he is convinced that the patentee is abusing his patent rights. In this regard, advise your client on the requirements in order to obtain a compulsory licence? [13]

4.4 After advising your client about the possibility of obtaining a compulsory licence and the success rate of such type of applications, your client decides against this route. However, he wants to know whether or not he can start developing his new drug even though the patent is still in force. Advise [13]

QUESTION 5 [20 MARKS]

List 10 differences between a provisional patent application and a complete patent application.

QUESTION 6 [4 MARKS]

Your patent renewal department sends a renewal reminder to one of your clients to renew their patent. Your client advises that he sold the patent to a company about 8 months ago. Advise your client what needs to be done in this regard in order to complete the 'transaction'.

QUESTION 7 [5 MARKS]

There is unusual relief available in the case where a patent is revoked on the ground of fraud. What is it?

QUESTION 8 [12 MARKS]

What are the advantages and disadvantages of a patent of addition?

QUESTION 9 [21 MARKS]

9.1 Section 50 of the Act makes provision for the making of certain corrections and amendments. Which corrections are allowed in terms of this section and who may authorise the making of these corrections? [4]

9.2 Section 51 makes provision for amending, on application, a provisional specification or a complete specification. Who may make application for an amendment, when may such an application be made and to whom shall the application be made? [3]

- 9.3 Discuss amendments that may be made to a provisional specification and particularly limitations with regard to such amendments. [5]
- 9.4 The Act prohibits certain amendments to complete specifications. Which amendments are prohibited? [7]
- 9.5 What is the term for filing an opposition to amend an application:
 9.5.1 pre-grant; and
 9.5.2 post-grant. [2]

QUESTION 10 [13 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

- 10.1 When is/was the first renewal fee due? [2]
- 10.2 Are extensions available in terms of the renewal fees, and if so, how long? [1]
- 10.3 If all the renewal fees are paid, when will the terms of the patents expire? [2]
- 10.4(a) What was the final deadline for filing a complete patent application from ZA 2011/01544? [1]
- 10.4(b) Would your answer have differed if the priority application was filed in another convention country? [1]
- 10.5 What was the deadline, including any extensions, for filing the national phase patent application based on the PCT patent application? [1]
- 10.6 The inventions disclosed in ZA 2012/01234 and ZA 2011/07765 relate to exactly the same invention. Which patent would be valid against the other in terms of novelty requirements? First set out the relevant section in the Act and then provide your answer. [4]
- 10.7 If ZA 2012/01234 has not yet been granted, when would the first renewal fee be due? [1]

QUESTION 11 [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 12 [2 MARKS]

In deciding to restore a patent, the registrar has to be satisfied that certain requirements have been met. What are these requirements.

QUESTION 13 [8 MARKS]

Your client files a patent application for a new microorganism, with reference to section 32(6) explain what needs to happen, and what are the consequences should this not happen?