

## PATENT ATTORNEYS PRACTICE 2018 WRITTEN EXAM

ANSWER ANY FOUR QUESTIONS.

EACH QUESTION HAS A 25 MARK ALLOCATION ATTRIBUTED TO IT.

TIME: 4 HOURS

### Question 1

You are approached by a new client on 01 June 2018. He indicates to you that he self-filed a provisional patent application on 15 April 2017 for a new stope support for use in a mine. He would like you to file a complete patent application as soon as possible in South Africa and internationally as he is aware of the fact that a competitor has started making the same product a month ago and is approaching the mines. The competitor operates on the internet only and seems that it wants to sell as many stope supports as possible in a short period of time.

He also tells you that before filing the provisional, he tested his stope support in three mines in South Africa and supplied over 500 stope supports between the three mines at a low price. He has also sold 10 000 units after the filing of the provisional and has advertised them in the magazine Mining Weekly.

Advise your client concerning the viability of filing a complete patent in South Africa and internationally, infringement and any validity risks his patent may face.

### Question 2

Your client e-mails you concerning the fact that it is the patentee of a patent (patent A) which relates to a pharmaceutical composition. Patent A has a priority date of 15 May 2012 and all renewal fees have been paid.

The e-mail further states that your client has received a letter demanding the abandonment of Patent A based on the fact that Patent A is not novel and inventive as a result of a US Patent (patent B) that was published and open to the public in 2008.

The claims of Patent A read:

Claim 1 - A pharmaceutical composition comprising

- i. Herceptin
- ii. Castor oil
- iii. A hydrophobic carrier selected from the group consisting of triacetin, benzyl benzoate or ethyl oleate or a combination thereof; and

acylated monoglycerides, propyl dicaprylates/dicaprates, caprylic/capric acids; triglycerides, or a combination thereof

Claim 2 – The use of the pharmaceutical composition of claim 1 for use in the treatment of Parkinson’s Disease.

Patent B (the prior art patent) contains a disclosure of a pharmaceutical composition comprising Herceptin, castor oil and a hydrophobic carrier.

Finally, client tells you that it was completely unexpected that the hydrophobic carriers claimed in Patent A worked together with Herceptin in that their research with the same carriers and a molecule similar to Herceptin was a complete failure.

Advise your client on the validity of Patent A.

### Question 3

Legal in house counsel for O-Flix contacts you and tells you that it has received a letter of demand from an individual, Mr V, saying that real time streaming on demand was his idea and that he has a patent on it and is claiming a royalty in lieu of damages which amount to R250 million. Your client is surprised because it is the only service provider in the world that provides this service and it took a great deal of research to be able to service millions of subscribers at a time who may be watching the same program at the same time, including having to deal with the issue of real time buffering.

You obtain a copy of the patent and the file contents from CIPC. You immediately note that the filing fee for the complete patent application was short paid by R50. Your client, O-Flix, wants to pursue the fact that the Registrar granted the patent to Mr V when the incorrect filing fee was paid.

Discuss the merits or lack thereof.

When you study Mr V’s patent you are amazed to discover that it constitutes two pages, the first page being a description of the invention. The relevant portion of the description reads:

*“A user, using a remote control, is able to navigate the servers of a service provider and choose a program or film that the user wishes to watch, which program or film is played in real time and on demand”.*

The drawing underneath is simply of a user, with a remote control, pointing at a TV which has a line drawn between it and a server.

Claim 1 of the Mr V's patent is:

A system for providing a real time on demand television and film service, wherein a user uses a remote control to navigate a server including a database in order to initiate play back of a film or program, wherein the server is located in a housing complex and is restricted to 10 users at a time.

Advise your client what grounds of revocation you would raise to attack the validity of Mr V's patent. You may assume there is no other relevant information in the patent specification other than what has been said above.

#### **Question 4**

A new client is introduced to you and on setting up a meeting with him the client tells you that he has a new application for a smart phone, the application being able to use the smart phone's GPS and location information to find the closest available patent attorney to the user, the application accessing a database of participating patent attorneys. The client intends that a user would then be able to book a patent attorney and meet with the patent attorney at a specific time provided by the selected patent attorney at the location nearest to the patent attorney. The application would be linked to the user's credit card which would be used to process payment of an agreed rate with the patent attorney.

Advise your client concerning the patentability of such an invention and how the claims would have to be drafted. In providing this advice, also advise as to the novelty and inventiveness of the invention having regard to your common general knowledge of smart phone applications currently available.

#### **Question 5**

Your client instructs you to send a letter of demand to CopyCo Pty LTD that they are to immediately desist from infringing your client's patent, which is in force with all renewal fees paid up. Your client tells you that CopyCo's product is not exactly the same as that which is claimed in the patent but client wants to send it to CopyCo to scare them off.

**Advise your client concerning whether it is a good idea to send the letter of demand.**

You are about to send the letter of demand to CopyCo at the instance of your client, when your client tells you that CopyCo has expended at least R3 million to set up its factory and has employed 250 staff members and furthermore your client wants to send a copy of the letter of demand to the relevant government department that has initiated a tender process worth R25 million so as to put CopyCo out of the running for the tender in respect of which your client is also participating. Client also wants to send a copy of the letter to all the customers of CopyCo.

**Advise your client further given the additional set of facts.**