

## **PATENT ATTORNEY'S PRACTICE – 2015**

Tuesday, 30 June 2015; 9am to 1pm

**EXAMINER: DR. MM KLEYN**

**MODERATOR: MR. VICTOR WILLIAMS**

### **GROUP 2(g) – Examination paper**

**ANSWER ALL QUESTIONS. THE MARKS ALLOCATED TO A QUESTION ARE GIVEN IN BRACKETS AFTER IT. THE TOTAL NUMBER OF MARKS FOR THE PAPER IS 100. WHEN GIVING ADVICE, YOUR REPLY SHOULD BE THAT OF A PATENT ATTORNEY ADVISING his CLIENT IN FULL**

#### **Question 1 (10 marks)**

Your client has recently acquired a portfolio of South African patents and applications from a third party. Your client advises that he wishes to expand the coverage to other countries and wants to ensure that the current portfolio is maintained. Having regard to the facts below, advise your client on the possibility to file further applications based on the portfolio acquired and the maintenance of the matters.

- Patent D1 was filed on 31 January 2011 and granted on 30 September 2014. Inspection of the register shows that no renewal fees have been paid.
- Patent D2 is a provisional application filed on 31 August 2014
- Patent D3 was filed on 10 November 2010 and granted on 31 January 2012. Inspection of the register shows that no renewal fees have been paid.
- Patent D4 was filed as complete in the first instance without priority claim on 1 July 2014 and delay of acceptance has been requested.
- Patent D5 was filed on 2 February 2012 and was granted on 12 December 2013. No renewal fees have been paid.

#### **Question 2 (7 marks)**

Your client writes "We have been selling our patented product for many years. The patent expiry date is 15 December 2020. All products have been marked "Patent Pending". One of our distributors have advised us that Company A, a competitor, has approached the distributor offering products for sale that, from the price list and product label appear to be the same as the patented product we supply. The

pricing of the products offered for sale by Company A are substantially lower than ours which will affect our business significantly.

On closer investigation it appeared that Company A is blatantly unaware of the patent rights. Our distributor further gave us notice of termination of the supply and distribution contract and indicated that it is more economical for them to acquire the products from Company A. We are not sure whether our distributor is actually buying from Company A already. What should we do?"

Advise your client.

### **Question 3 (8 marks)**

- a) Your client has invented a method of immunisation (i.e. one which prevents rather than cures a disease). Is the method excluded from patentability? Substantiate your answer.
- b) Your client has invented a method of diagnoses of a human disease in which a patient's blood is tested in a test tube. Is the method excluded from patentability?
- c) Your client claims to have invented a perpetual motion machine. List two grounds on which this is likely not to pass the test as an invention for the purpose of patentability.

### **Question 4 (15 marks)**

Your client has developed a cordless beer cooler and a solar-powered charging station for the beer cooler. A PCT application was filed on 4 January 2014, without a priority claim. The PCT application fully describes both the beer cooler and the charging station. The PCT application contains claims to the beer cooler but not the charging station.

The PCT application was published on 10 July 2014, with the International Search Report. The Written Opinion accompanying the International Search Report indicated that the claims to the beer cooler were novel but not inventive.

Your client has become aware of a third party who has started selling an identical beer cooler and charging station in Germany, France, Netherlands and South Africa. Your client wishes to take action against the third party as soon as possible with respect to infringement of both the cooler and the charging station.

The PCT claims contain an omnibus form claim that reads "a beer cooler substantially as herein described".

EPO, USA and South African national phase applications have been filed based on the PCT application. Client is not sure what the status of the South African case is, but advises you that the USA case has just been granted.

Advise your client on any steps that should be taken to enforce his rights.

### Question 5 (25 marks)

Your client has developed a pharmaceutical product and he shows you the developed packaging. He advises you that this is a product not previously available on the market as it contains an ingredient that has been found to be effective for treating headaches. The specific ingredient is a herb that the indigenous folk of Thamboland have been using for treatment of muscle pain for years.

The developed packaging looks as follows:



- Advise your client on the potential forms of intellectual property protection available for protection of the product and packaging
- Advise specifically on the patentability of the formulation and use of the pharmaceutical product
- Will the fact that this is a new use for a known indigenous substance effect the validity of a patent application for the product?

### **QUESTION 6 (10 marks)**

Your client has a patent to an invention that includes form A and form B which are mutually distinct forms of the same invention. The complete specification describes both form A and form B, but the claims are limited to form A only. The patent, as for all granted patents, has come open to public inspection after the publication of the acceptance of the specification in terms of Section 42 of Act 57 of 1978. Your client advises you that a competitor is selling his invention in South Africa, but in form B only. Advise your client on his prospects of succeeding in an infringement action against the competitor. If your client's prospects of succeeding in the infringement action are not good, can your client amend the claims of the patent to improve his position?

### **QUESTION 7 (10 marks)**

7.1 What is a "grant back" clause in terms of technology licensing?

7.2 Are there any advantages or disadvantages in including such a clause in a license agreement?

### **QUESTION 8 (5 marks)**

Your client, a private corporation, outsourced certain research to the University of Stellenbosch. The service agreement was signed with the catalyst research centre and included provisions that all intellectual property created as a consequence of the research is assigned to your client. The University technology transfer office was unaware of the agreement being signed and subsequently approached your client and argued that the agreement is null and void, or alternatively that the university owns the IP.

Advise your client, with reference to the appropriate legislation, what the client's corporation's rights are.

### **QUESTION 9 (10 marks)**

(a) What do you understand under contributory infringement and is it a part of South African law? Substantiate your answer with reference to the relevant legislation and case law.

(b) What is parallel importation and is it a part of South African law? Substantiate your answer with reference to the relevant legislation and case law.