

PATENT EXAMINATIONS BOARD
PATENT ATTORNEY'S PRACTICE – GROUP 2G

Note to Students : The exam paper comprises two sections, section A and Section B. Answer each section in a separate answer book and mark the cover of the answer book clearly “Section A” and “Section B” respectively.

SECTION A

Question 1

You filed a complete patent application for your client on 10 January 2008. Your client approaches you in February 2010 and asks for the Letters Patent for his patent. You discover from your file that you never received a notice from the registrar of patents to the effect that the application has been accepted.

What is the effect of the above on the status of the patent application and what steps could be taken to remedy the situation ?

(5 marks)

Question 2

Your client approaches you and instructs you to amend his granted patent to include a second independent claim to a new and inventive cricket ball. The first independent claim relates to a new and inventive cricket bat.

Advise your client as to whether the fact that the patent would comprise two independent claims to two different inventions would jeopardize it in any way. Cite relevant case law.

(5 marks)

Question 3

You client approaches you with the following facts:

- i. He developed an invention relating to a stope support and filed a patent application therefor on 12 June 1998.
- ii. The patent was accepted in December 1998 and ultimately granted to your client, Mr X. He is recorded as the sole inventor.
- iii. Your client's employer, ABC (Pty) Limited, claims that its two employees invented the invention in the course and scope of employment and that your client, Mr X, had nothing to do with the invention. It therefore claims that the invention belongs to it. It also claims that the invention is not patentable in any event for lack of inventiveness.
- iv. The employment contract of the two employees has a clause that relates to intellectual property which reads as follows:

“All inventions made in the course of employment, and for a period of 5 years after termination of employment shall belong to ABC (Pty) Ltd”.

- v. All negotiations have failed and the parties do not intend to negotiate further.

Advise your client as to the manner in which the issues may be resolved, the task of the court in considering such an issue, the onus of proof and prospects of success. (Cite relevant case law).

(10 marks)

Question 4

On 01 August 2008 you receive instructions from a correspondent in the USA to file a South African patent application claiming convention priority from US application Serial No. 08/454 398 filed 03 November 2007. During preparation of the application, you note that the US Specification commences with the following statement:

“This is a continuation in part of US Application Serial No. 07/327 899 filed October 2006”

Explain how you will handle your correspondent’s instructions.

(10 marks)

Question 5

Your client approaches you with details of South African patent no. 2003/4598 and a register sheet which shows that the patent has been hypothecated and is about to lapse, the end of the 6 month extension period within which renewal fees may be paid has almost expired. You are also not the address for service. He tells you that the patent was hypothecated in his favour and it is vital that the patent not be allowed to lapse. He instructs you to renew the patent.

What would your advice be citing relevant case law.

(10 marks)

Question 6

Your client approaches you with clear proof of the infringement of South African Patent no. 2002/3493 (the Patent) and would like to take immediate action against the infringer. The Patent contains only contains two claim which reads as follows:

“1. A pharmaceutical composition comprising R-amlodipine besylate.”

“2. Use of amlodipine besylate in the manufacture of a medicament for treating heart disorders”.

On investigation of the Patent you discover that the applicant, your client, has a corresponding US Patent claim 1 of which was corrected in 2000 to:

“A pharmaceutical composition comprising S-amlodipine besylate”

Your client informs you that there was an error in the nomenclature of the composition claimed in the SA patent and what should have been an “S” was an “R”. He believes the error was a result of the patent attorney not appreciating that the designations “S” and “R” relate to different isomers i.e. compounds which have the same molecular formula but different structures such that they are essentially different compounds. The patent attorney that drafted the patent has retired and can no longer be found and the in house counsel that worked with the patent attorney has left the firm under bad circumstances and cannot be used.

Part A

Advise your client whether to proceed by way of correction or by way of an application for amendment and outline the difficulties associated with both having regard to the facts and what would eventually have to be deposed to by way of affidavit. (Cite relevant case law)

(10 marks)

Part B

Despite your advice, your client would like to proceed by way of amendment and would like to sue for patent infringement immediately.

Explain to your client the manner in which you would proceed and the associated advantages and disadvantages. (Cite relevant case law)

(10 marks)

Total for Question 6 : 20 marks

TOTAL FOR SECTION A : 60 MARKS

SECTION B

Question 7

A very distressed client tells you that he has for the past 5 years been making a GIZMO which he had seen on a trip to USA and he has now been told by an American company that it has a South African patent for it. Give complete advice to this client of all the options available to him, firstly: -

7.1. if no patent is found to exist or one is found but your opinion is that it is not infringed.

(6 marks)

7.2. a patent is found and your opinion is that it is infringed.

(15 marks)

Total for Question 7 : 21 marks

Question 8

You receive instructions from a foreign company to apply for SA patent rights based on an original US patent application and a continuation-in-part patent application that followed it, it is still within 12 months of the original US patent application. After you file in SA but before grant he gives you details of a development of the invention that he wants protected as well. Afterwards but still before grant he tells you that he would like to have an aspect described in the specification separately protected. A still further development of the invention is made after grant of the SA patent. Advise client of the procedures that are available to provide for these circumstances.

(11 marks)

Question 9

Your company receives the following letter from an irate client:-

“31ST May 2010

Dear Sir,

RE: PROVISIONAL PATENT

It is with great regret and deep concern that we write this letter to you as we are shocked and horrified that after spending a vast sum on a provisional patent in South Africa with Patent, Design & Trademark Attorneys such as yourselves that our patent holds no ground. That we are now told that even though a product exactly the same has now hit South African Soil, sold by a South African company now this month in South Africa -that there is nothing legally we can do even though we hold the provisional patent. I was also informed today that should the product be anywhere else in the world before our filing date that our patent is worth nothing anyway?

Our question to you is – how can you as a company charge business’s for your time when the provisional patent is not worth the paper it is written on? Should this have been explained to us we would not have gone the provisional patent route as how are we to know what is in the market outside of South Africa – hence the reason why we provisionally patented in South Africa. The meaning of patent means as stated in the dictionary:-

pat·ent (p t nt)

n.

1.

- a. A grant made by a government that confers upon the creator of an invention the sole right to make, use, and sell that invention for a set period of time.*
- b. Letters patent.*
- c. An invention protected by such a grant.*

The only definition for provisional patent as far as I can research is as follows:-

The keyword in provisional patent application is "provisional". A provisional patent application only gives one year of protection. After that you must file for a non-provisional patent or abandon your patent.

We were told that our patent would protect our rights in South Africa for this product that we would have 12 months which we could extend by 3 months to lodge the final patent concept and design. From my conversation with a member of your staff today this is suddenly not the case. There is NO protection and NO legal standing therefore the services we requested from you is not worth the paper your patent application is written on as it is not a patent. We paid money to you based on being protected by the provisional patent.

I suggest you as a company actually divulge all necessary facts to all potential patentees as personally we feel robbed, cheated and done in - very expensive purchase for scrap paper. We would be very interested to have some form of feedback in this regard; we need to know what the legal document that we possess is? If it is worth nothing as we were told today we demand a refund. We will be looking into our legal grounds in this matter should we not receive a refund and respectfully request all dealings hence forth are done by e-mail."

In order to avoid such misunderstandings in the future, your firm decides to prepare a general information pamphlet which can be handed or sent to client after a consultation. The memorandum should include details of the requirements

for filing a patent application in South Africa (do not list prohibitions) as well as the steps and procedure to be followed from the filing of a provisional application all the way through to the grant of national phase patents in Europe and the USA. You can assume that the PCT route is followed.

(28 marks)

TOTAL MARKS FOR SECTION B : 60 MARKS

TOTAL MARKS FOR PAPER : 120 MARKS
