

PATENT EXAMINATION BOARD

SOUTH AFRICAN PATENT LAW AND PRACTICE – GROUP 1(b)

25 June 2024

Examiner: M Vatta

Moderator: T Mashabela

Time: 09:00 to 13:00

Total marks: 200

This examination consists of 8 pages (including this cover page).

Instructions and notes:

1. Answer all questions (14 in total).
2. Write neatly and legibly.
3. All references to the Act are references to the South African Patents Act, No. 57 of 1978, as amended.
4. All references to the Regulations are references to the South African Patent Regulations, 1978, as amended.
5. Wherever possible, your answers should refer to the relevant case law, sections of the Act and/or Regulations, the content of the section and/or regulation should be set out and only then should you make a conclusion.

QUESTION 1

Discuss the key principles of the Paris Convention and the advantages of filing an international patent application via the Patent Cooperation Treaty (PCT). (10 marks)

QUESTION 2

Discuss the extrinsic criteria for patentability under South African Patent Law, highlighting the key requirements. In your answer, provide the statutory provisions. (10 marks)

QUESTION 3

3.1 You receive the following e-mail from a foreign associate:

Dear Colleagues

One of our clients, a large US-based pharmaceutical manufacturer, wishes to enter the national phase of an international PCT patent application in South Africa. Our client wishes to know whether the following claim is permissible in terms of South African law:

“1. A method of treating a subject suffering from a urinary disorder selected from the group consisting of urinary incontinence, urge incontinence, urinary frequency noturia and enuresis, comprising administering to the subject a therapeutically effective amount of the compound of Formula X”.

Please provide to us your comments.

Write a response to your client, setting out the relevant provision(s) of our Act.

(10 marks)

3.2 You receive a follow-up query from the foreign associate:

Dear Colleagues

Thank you for your helpful advice and prompt assistance.

Our client now wishes to know the South African position on the patentability of the use of the same compound of Formula X for the treatment of diabetes mellitus.

We look forward to receiving your advice.

Referring to the relevant provision(s) of our Act, and case law, write a response to your client's query. (10 marks)

QUESTION 4

4.1 Explain the exceptions to novelty, referring to the relevant sections of the Act, where undisclosed inventions are considered prior art. (8 marks)

4.2 In terms of Section 26 of the Act, there are instances where the public disclosure of an invention will not invalidate a patent. Discuss these exceptions. (6 marks)

QUESTION 5

Discuss, with reference to the questionable provisions of the Act and Regulations, the ruling of the Court of the Commissioner of Patents in the case of *University of Pretoria v Registrar of Patents and Others* and how the judgement in the case of *Mu Mecanicos Unidos S.A.S. v The Registrar of Patents* differs from the University of Pretoria case. (10 marks)

QUESTION 6

6.1 Your clients, James Bond and Jason Bourne, for whom you are prosecuting a South African patent application accompanied by a complete specification, approach you for advice. Since the filing of their patent application, they have made a new improvement

to the invention that they now seek to protect. Advise your clients on the option(s) available to them and advise them of the provisions relating to their option(s).

(13 marks)

6.2 The business relationship between James Bond and Jason Bourne has soured because Jason Bourne believes that James Bond is conducting business with their competitor and is of the view that James Bond did not really contribute to the invention. Jason Bourne believes that he should be the sole patentee as he made the discovery that led to the inventive concept.

6.2.1 Advise your clients on who is entitled to apply for a patent application. (2 marks)

6.2.2 What restrictions are placed on joint patentees? (3 marks)

6.2.3 In terms of Section 49, advise your clients regarding the remedy to resolve their dispute as to the ownership of the patent. (4 marks)

6.2.4 Jason Bourne concedes that James Bond is an inventor and is indeed entitled to his share of the patent, but to part ways amicably, James Bond agrees that Jason Bourne may have his share of the right, title, and interest in and to the patent. What formal requirements must be complied with to ensure that Jason Bourne is the sole patentee, that it is effective against third parties, and ideally by when? (3 marks)

6.2.5 James Bond and Jason Bourne reconcile their relationship, but Jason Bourne believes that because he contributed to 75% of the development of the invention, he should be entitled to 75% of any profit accruing to him from the sales of the patented invention. What would you advise Jason? (3 marks)

QUESTION 7

You receive the following e-mail from your client, the applicant for South African Patent Application No. 2023/01234:

After conducting an inventor analysis of the invention disclosed in the subject application, we realised that Austin Powers, should have been named as an inventor. Please proceed to add Austin Powers as an inventor.

- 7.1 What provision(s) of the Act would you rely on to add Austin Powers as an inventor to the application? (2 marks)
- 7.2 What are some of the formal requirements that you believe need to be complied with when requesting to the registrar that Austin Powers be added as an inventor? (4 marks)

QUESTION 8

Your foreign instructing attorney contacts you on behalf of their client, whom you represent in South Africa. The client's patent has recently proceeded to grant, despite counterpart applications across multiple jurisdictions still undergoing substantive search and examination. The instructing attorney advises that the client now wishes to amend the South African patent specification to distinguish the invention more fully over prior art now cited in other jurisdictions.

- 8.1 Advise the instructing attorney, who is unfamiliar with South African patent law, on the requirements for such an amendment, as well as the formal and procedural requirements. (6 marks)
- 8.2 What requirements must the claims of a patent specification meet? (2 marks)

QUESTION 9

- 9.1 During proceedings for infringement, the commissioner of patents finds that one claim of the patent is valid but that the remainder of the claims are invalid. Referring to the section of the Act, what relief does the patentee have? (4 marks)
- 9.2 Once relief is sought, what powers does the commissioner of patents have? (2 marks)

9.3 What relief may a plaintiff seek in proceedings for infringement? (5 marks)

9.4 Referring to case law, set out the test for the determination of infringement. (4 marks)

QUESTION 10

Your client advised you at the time of filing their patent application that you are not responsible for the payment of renewal fees and that the responsibility for the payment of the renewal fees will be handled by a global renewal agency. However, your client contacts you in a state of panic five years later, after the application proceeded to grant, and informs you that South African Patent No. 2012/01598 had lapsed. The patent is extremely valuable to your client who still wishes to make use of their monopoly over the invention.

10.1 Advise your client on what can be done, how you would do this, what requirements must be satisfied, the procedural steps that follow once application is made and the possible outcomes. Please refer to specific timelines. (13 marks)

10.2 The rights of a patentee of a restored patent are limited in terms of section 48(1) of the Act. Please discuss these limitations. (10 marks)

QUESTION 11

It was confirmed in the case of *Buzzbee (Pty) Ltd v Registrar of Patents 2010 BIP 42 (CP)* that the grounds of revocation are exhaustive. List these grounds of revocation. (14 marks)

QUESTION 12

Any interested party may seek to obtain a compulsory licence to an invention subject of a patent where there is an abuse of rights. Referring to the Act, when is a patent deemed to be abused? (10 marks)

QUESTION 13

When does the official file, in respect of an application for a patent, accompanied by a complete specification, first become open to public inspection where:

- 11.1 It claims priority from a convention application? (2 marks)
- 11.2 It claims priority from a South African provisional patent application? (2 marks)
- 11.3 It does not have any claim to priority? (2 marks)
- 11.4 It claims priority from a South African complete application filed in the first instance in respect of the invention? (2 marks)
- 11.5 It is a national phase patent application filed via the PCT, and claims priority from an application filed in a foreign country? (2 marks)

QUESTION 14

South African Patent No. 2005/09876 (ZA 2005/09876) was filed on 17 October 2005, accepted on 12 December 2006, and proceeded to grant on 28 February 2007. The patent claims priority from South African Provisional Patent Application No. 2004/06123 (ZA 2004/06123) filed on 11 August 2004.

South African Patent No. 2020/01439 (ZA 2020/01439) was filed as a national phase patent application on 6 March 2020 from a PCT patent application with a filing date of 10 August 2018. The PCT patent application, and consequently the national phase patent application, claims priority from Chinese Provisional Patent Application No. 201710985755.5, which was filed on 20 October 2017. ZA 2020/01439 was accepted on 20 July 2020 and proceeded to grant on 26 August 2020.

Answer the questions that follow by providing the dates in full, where relevant.

In respect of (1) ZA 2005/09876 and (2) ZA 2020/01439:

- 14.1 When was the first renewal fee due on each patent? (4 marks)
- 14.2 When were/are the third renewal fees due on each patent? (4 marks)
- 14.3 Are extensions of time available for paying renewal fees? If so, mention the extension period available? (2 marks)
- 14.4 If all renewal fees are paid, when will the patents expire? (4 marks)
- 14.5 What was the final deadline, including possible extensions of time, for filing a complete patent application from ZA 2004/06123? (2 marks)
- 14.6 Would your answer have differed if the priority application was filed in Australia? If so, provide the final deadline? (2 marks)
- 14.7 What was the deadline for filing the national phase patent application of the PCT application? Provide the deadline with and without extensions of time. (4 marks)