

# **PATENT EXAMINATION BOARD**

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

**24 June 2025**

Examiner: M Vatta

Moderator: T Mashabela

Time: 09:00 to 13:00

Total marks: 190

This examination consists of 9 pages (including this cover page).

### Instructions and notes:

1. Answer all questions (16 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**

In terms of section 25(2) the Act, what shall not be an invention for the purposes of the Act?  
(7 marks)

### **QUESTION 2**

When may the Registrar refuse to accept an application for a patent?  
(4 marks)

### **QUESTION 3**

Explain what is meant by “the state of the art” in terms of section 25 of the Act. (12 marks)

### **QUESTION 4**

Explain any four conditions in a licensing agreement that are deemed null and void under the Act.  
(8 marks)

### **QUESTION 5**

Your client, a company called BioGlow (Pty) Ltd, has filed a South African patent application for a luminescent gel used in emergency signage. Seven months later, the company developed an improved formulation with longer glow time.

- 5.1 Advise your client on their options of how to protect the improved formulation, assuming the original application was filed with a complete specification and is still pending. (10 marks)
- 5.2 BioGlow (Pty) Ltd informs you that two months prior to filing a South African patent application for its luminescent gel formulation, the invention was disclosed to a potential distributor during a meeting that was intended to be confidential. However, the distributor subsequently disclosed the formulation to a third party without authorisation.

Advise your client, with reference to South African patent law, on whether this unauthorised disclosure may affect the validity of the patent. (5 marks)

- 5.3 Some months after the patent was granted, the client has received notice from a competitor alleging that the claimed invention lacks inventive step based on a prior art reference. Explain the test for inventive step. (5 marks)

## QUESTION 6

You are approached by two inventors who have jointly developed a novel drone navigation system. One inventor wants to exclude the other from commercialising the system.

- 6.1 Who is entitled to apply for a patent? (2 marks)
- 6.2 What are the rights and restrictions of joint patentees? (4 marks)
- 6.3 What remedies are available in the event of a dispute between co-owners? (4 marks)
- 6.4 If one patentee assigns their share of the patent to the other, what formalities must be followed to perfect the assignment against third parties? (3 marks)

## QUESTION 7

The acceptance of your client's patent application (ZA 2023/01234) was published on 29 March 2023. In May 2025, they wish to amend the claims due to prior art discovered in a Japanese counterpart patent application by adding an integer disclosed in the description of the specification into claim 1.

Advise your client on the requirements and process for the amendment of ZA 2023/01234, and address whether the amendment would be allowed. Also provide details of section 51(3). (10 marks)

## QUESTION 8

The Commissioner received a compulsory licence application alleging that your client is abusing their patent rights. Discuss:

8.1 Grounds for granting the compulsory licence under the Act. (12 marks)

8.2 Restrictions and conditions on such a licence. (6 marks)

## QUESTION 9

You receive an e-mail from a foreign associate:

“Our client, a Canadian biotech company, seeks to file a patent application in South Africa for a method of treating an autoimmune disease using a new monoclonal antibody. Please advise on the acceptability of the following claims in South Africa:

- (1) A method of treating lupus by administering X antibody.
- (2) Use of X antibody for the manufacture of a medicament for treating lupus”.

Write a response explaining the acceptability of each claim in South African law, citing statutory and case law authority. (12 marks)

## QUESTION 10

You act for a client who is the patentee of South African Patent No. 2020/04567. The client informs you that they are seeking to encourage greater uptake of the patented technology through licensing. After conducting your due diligence, you determine that the client may benefit from a licence of right endorsement under section 53 of the Act.

Answer the following:

10.1 Explain what a licence of right is under South African patent law. (2 marks)

- 10.2 Set out the requirements for obtaining a licence of right endorsement on the register. (2 marks)
- 10.3 Once a patent is endorsed with a licence of right, what effect does this have on the renewal fees? (2 marks)
- 10.4 What recourse does a patentee have if they wish to cancel a licence of right endorsement? Explain the conditions. (2 marks)
- 10.5 Briefly discuss one strategic advantage and one potential risk to the patentee of such an endorsement. (2 marks)

## QUESTION 11

You act on behalf of TechNova (Pty) Ltd, a local start-up developing solar charging technology. They are being threatened with infringement proceedings by SolBright Energy Inc., the patentee of South African Patent No. 2019/07891. After reviewing the patent, your client believes it is invalid and instructs you to take steps to have it revoked.

Answer the following, with reference to the Act:

- 11.1 Outline who is entitled to bring an application for revocation of a patent and in what forum such an application must be brought. (3 marks)
- 11.2 List and explain five grounds upon which a South African patent may be revoked under section 61. (10 marks)
- 11.3 Your client believes that the claimed invention is obvious in view of two prior patents. Can these documents be combined for purposes of revocation? Support your answer with legal reasoning. (3 marks)
- 11.4 If the court finds that some claims are valid and others are invalid, what remedial options are available to the patentee? (2 marks)

- 11.5 Discuss whether a third party who was unaware of the revocation proceedings but had been commercially exploiting the patented invention before revocation, would acquire any rights after the patent is revoked. (2 marks)

## QUESTION 12

Your client, GreenWare Innovations, has received a strongly worded letter from EcoTech Solutions (Pty) Ltd, the patentee of South African Patent No. 2018/09234. The letter demands that GreenWare immediately cease the manufacture and sale of one of its eco-friendly valve products, failing which EcoTech will “institute immediate legal proceedings for patent infringement”. The letter was also copied to one of GreenWare’s major customers, resulting in the customer cancelling a supply contract.

GreenWare insists that their product does not infringe the patent and wishes to know whether it can take legal action against EcoTech for the threat.

Answer the following:

- 12.1 What relief is available to a person who receives an unjustified threat under the Act? (3 marks)
- 12.2 Discuss what burden of proof rests on the person making the threat in proceedings under section 70. (3 marks)
- 12.3 Would it make a difference if the patent had already lapsed for non-payment of renewal fees at the time the letter was sent? Substantiate your answer. (2 marks)

## QUESTION 13

Your client, MedPharm SA, is the patentee of South African Patent No. 2021/10456, which claims a process for synthesising a new compound, Compound X, and includes product claims to Compound X per se. Compound X is used in the treatment of chronic inflammation and is not found in nature.

MedPharm has discovered that PharmaLite (Pty) Ltd is selling tablets that contain Compound X. MedPharm suspects that PharmaLite is making Compound X using the patented process but cannot obtain any direct evidence of the process used. MedPharm wishes to sue for infringement of both the process and product claims.

Answer the following:

- 13.1 Explain the legal presumption created by section 67 of the Act. (3 marks)
- 13.2 What must the patentee show to invoke the presumption under section 67? (2 marks)
- 13.3 Once the presumption is established, what burden shifts to the alleged infringer, and how can they rebut it? (2 marks)
- 13.4 Would the presumption apply if Compound X was known in nature prior to the patent application? Motivate your answer. (3 marks)

#### QUESTION 14

South African Patent No. 2010/05555 (ZA 2010/05555) was filed on 1 June 2010, accepted on 15 November 2011, and proceeded to grant on 20 January 2012. The patent claims priority from South African Provisional Patent Application No. 2009/04444 (ZA 2009/04444) filed on 10 December 2009.

South African Patent No. 2021/02222 (ZA 2021/02222) was filed as a national phase patent application on 5 May 2021 from a PCT patent application with a filing date of 1 September 2019. The PCT patent application claims priority from United States Provisional Patent Application No. 62/784,321 filed on 15 September 2018. ZA 2021/02222 was accepted on 10 September 2021 and proceeded to grant on 5 November 2021.

Answer the following questions by providing the dates in full where relevant:

- 14.1 When was the first renewal fee due on each patent? (2 marks)

- 14.2 When were/are the third renewal fees due on each patent? (2 marks)
- 14.3 Are extensions of time available for paying renewal fees? If so, state the period of extension available. (2 marks)
- 14.4 If all renewal fees are paid on time, when will each patent expire? (2 marks)
- 14.5 What was the final deadline, including possible extensions of time, for filing a complete patent application from the provisional patent application ZA 2009/04444? (2 marks)
- 14.6 Would your answer differ if the priority application of ZA 2010/05555 was filed in the United States instead of South Africa? If so, provide the final deadline. (4 marks)
- 14.7 What was the deadline for filing the national phase patent application for the PCT application? Provide the deadline both with and without any extensions of time. (4 marks)

### QUESTION 15

Discuss, compare and contrast the findings of the following two cases and the Commissioner's decision:

- *University of Pretoria v Registrar of Patents and Others*
- *Mu Mecanicos Unidon S.A.S. v The Registrar of Patents* (10 marks)

### QUESTION 16

Artificial Intelligence (AI) and its role in innovation has recently been a hot topic. South African Patent No. 2021/03242, granted to Stephen L. Thaler for a "food container and devices and methods for attracting enhanced attention", identifies an AI system named "DABUS" as the inventor. This marked the first time a patent has been granted anywhere in the world where an AI, rather than a natural person, is listed as the inventor. The inventor is described in the register as: "DABUS, the invention was autonomously generated by an artificial intelligence."



Critically discuss whether the South African Patent Office was correct in granting a patent in which an AI is listed as the inventor. In your answer, consider the relevant provisions of the South African Patents Act and provide reasoned argument in support of your conclusion.

Note: marks will be awarded for critical reasoning, reference to statutory provisions, and thoughtful engagement with the policy implications of AI inventorship. (10 marks)

Moderated