

PATENTS EXAMINATION BOARD

PRACTICAL LEGAL PROBLEMS

EXAMINATION: JUNE/JULY 2024

PAPER 2

EXAMINERS: J WHITTAKER
D DOHMEN

MODERATOR: R. BAGNALL

DURATION: READING TIME – 30 MINUTES
EXAMINATION TIME – 3 HRS
TOTAL: 3 HOURS 30 MINUTES

NOTES TO CANDIDATES:

1. Attached to the paper are copies of the following documents:
 - (i) A copy of the Patents Act No. 57 of 1978;
 - (ii) A copy of the Patent Regulations 1978; and
 - (iii) A copy of the Uniform Rules of the High Court under the Superior Courts Act 10 of 2013 (Rules 6, 14, 17, 18, 19, 21, 22, 23, 24, 25, 30, 35, 36, 37 and 63).
2. Each candidate is also allowed access to (1) one dictionary during the exam.
3. This paper comprises 11 pages in total, made up of Questions 1 to 4 (100 marks and 9 pages) as well as attached Annexure Q.1.A (1 page) and Annexure Q.1.B (2 pages).
4. Where appropriate, reference should be made to case law.

QUESTION 1:

(30 marks)

You receive the below correspondence from your client.

“Dear Patent Attorney

I am the CEO of Global Cement Inc. which is the patentee of South African patent no. 2015/01234. You are our South African patent attorneys of record for the patent.

ZA2015/01234 forms part of one of our important patent families and the claims of the South African patent are identical to those of the corresponding US and EPO patents which were examined and granted.

As you know our patent has three sets of claims. Claims 1 to 10 relate to a cement product, claims 11 to 15 to a method of producing a cement product, and claims 16 to 20 relate to a lightweight cementitious filler material which comprises a combination of a cement product (the same as the one claimed in claim 1) and loose (as opposed to agglomerated) expanded polystyrene granules.

For a number of years one of our biggest competitors has been a company called CopyChem. In about April 2024 CopyChem started marketing and selling a cement product which it calls Fastbrick in competition to our Rockard cement product. A description of the Fastbrick product can be found on their website at www.copychem.co.za/products/fastbrick. There is also a description of the method which they use to produce Fastbrick at www.copychem.co.za/products/fastbrick/manufacturingprocess.

We bought a few bags of Fastbrick (see a copy of the invoice which is attached hereto marked Annexure Q.1.A) and have tested the Fastbrick cement product.

Our tests of the Fastbrick cement product show that the Fastbrick product is exactly the same as the cement product claimed in claims 1, 2 and 6 of our patent. From CopyChem’s website it is also clear that the process which they use to produce the Fastbrick product is the same as the method claimed in claims 11 and 14 of our patent.

We also have evidence that CopyChem is supplying Fastbrick and separate bags of expanded polystyrene granules to some of its clients. The clients can then mix the Fastbrick cement and the polystyrene in a range of ratios as explained in a brochure which CopyChem provides with the bags of polystyrene and depending on the intended application of the filler mixture. The filler mixtures are used in the same way as our lightweight cement filler and are the same as the combination product of claim 16 of the patent.

Fastbrick is having a noticeable impact on the sales of our Rockard and lightweight cement filler products and we have decided to immediately launch court proceedings based on the patent against CopyChem. Our aim is to get them to withdraw Fastbrick from the market and to pay us compensation for our lost sales.”

You obtain a copy of the Form P2 extract of ZA2015/01234 from the Patent Register. The form P2 copy is attached hereto marked Annexure Q.1.B.

Please draft the particulars of claim to accompany a summons instituting a patent infringement action based on ZA2015/01234 in terms of your client's instructions.

QUESTION 2:**(30 marks)**

You receive the below correspondence from your client.

“Dear Patent Attorney

I refer to my pending South African complete patent application no ZA2022/5678 entitled “Compound and Composition for the Treatment of Skin Diseases” which was filed on 11 November 2022.

As you know the complete patent application claims priority from South African provisional patent application no. ZA2021/6123 dated 14 November 2021. As per your previous advice all formalities for the complete patent application have correctly been complied with and the complete patent application has not yet been accepted by the Registrar of Patents.

The specification of the complete patent application describes each of the compounds X, Y and Z alone and in combination. Examples are also given of pharmaceutical compositions made from each of compounds X, Y and Z as well as their combinations for use in medicines for the treatment of a range of skin diseases and conditions. The pharmaceutical compositions are applied topically to the affected skin.

The current claims of the complete patent application are as follows:

- 1. The compound X.*
- 2. The compound Y.*
- 3. The compound Z.*
- 4. A pharmaceutical composition comprising the compound of claim 1, and any one or both of the compounds of claim 2 and of claim 3.*
- 5. A pharmaceutical composition comprising the compound of claim 2 and the compound of claim 3.*
- 6. A pharmaceutical composition according to claim 4 or 5 and a pharmaceutically acceptable carrier, adjuvant, or vehicle.*
- 7. A method of treatment of a skin disease in a patient comprising administration to the patient of a pharmaceutical composition according to claim 6.*

8. *A method of treatment according to claim 7 wherein the pharmaceutical composition is administered topically to the patient.*

During online patent searches I recently came across the following two patent applications:

- a. *PCT/US2017/03859 entitled "Advances in Skin Care" which has an international filing date of 12 December 2017, claims priority from US60/721,213 of 14 December 2016 and which was published on 24 June 2018; and*
- b. *PCT/EP2021/03859 entitled "New Compounds of Interest" which has an international filing date of 5 July 2021, claims priority from JP202020-0500015 of 8 July 2020 and which was published on 22 January 2022.*

PCT/US2017/03859 discloses the use of compound X in medicines for the treatment of eczema and PCT/EP2021/03859 discloses a combination of compounds X and Y as part of various combinations of compounds which may be of interest for further research and possible application in medicines. No mention is made of possible combinations of compounds X and Z or of X, Y and Z.

I am concerned about the validity of the current claims of the complete application in light of the above two PCT publications.

Please let me know (i) what the impact of these publications are on the validity of the current claims of the complete patent application, (ii) what, if anything, should be done to improve the validity of the claims of the complete patent application, and (iii) when and how such actions should be taken."

You can assume that all claims to priority of the current claims are valid and that the current claims are fairly based on the disclosures in the complete patent specification.

Advise your client accordingly and fully.

QUESTION 3:

(10 marks)

After you had advised your client concerning the enquiry in Question 2 above, you receive the below correspondence from your client.

“Dear Patent Attorney

We have today received preliminary data on our research on the compounds and combinations thereof described in our pending South African complete patent application no ZA2022/5678 [which is also the subject of the above Question 2].

The data shows excellent results for compound Z on its own as well as unexpected synergistic effects for the combinations of compound Z with compounds X and Y.

We are now actively seeking funding for the separate pharmaceutical development of compound Z as well as the combination of compounds Z, X and Y.

Is there any way in which we can improve our patent protection for these separate developments?”

Advise your client accordingly and fully.

QUESTION 4:

(Total 30 marks)

Please answer each of the below separate questions and/or advise your client as requested.

4.1 SA Metals is the patentee of South African complete patent no. 2015/4921. ZA2015/4921 was filed on 1 July 2015 and claims priority from a South African provisional patent application dated 1 July 2014. The patent was granted on 25 April 2016 and all renewal fees are paid up to date. The patent includes two claims:

1. A metal alloy comprising a metallic composite A in a solid matrix which includes between 1% and 5% carbon by weight of the matrix.
2. A metal alloy as claimed in claim 1 which includes between 3% and 4% carbon by weight of the matrix.

Your client, who is a competitor of SA Metals wants to import and sell its own metal alloy. However, the imported metal alloy would infringe claim 1 of ZA2015/4921 and your client is concerned about any claims of patent infringement which may be made against it.

Your client draws to your attention to the existence of South African patent no. ZA2012/0001 which was published on 25 April 2013. The disclosure in the specification most likely impacts the validity of claim 1 of ZA2015/4921.

Given the circumstances, advise your client on possible courses of action for it to follow; the procedures, timelines and risks involved with the different courses of action as well as the best course of action to follow.

(10 marks)

4.2 What must an applicant establish in an application for urgent interim relief and how should the Court exercise its general discretion in an application for an urgent interim interdict in a patent infringement matter?

(5 marks)

4.3 How should public interest be dealt with as part of the enquiry in the above question 4.2?

(5 marks)

4.4 You received the below email from your client.

“We have developed a new and innovative tamper proof security bag to seal courier packages. The drawings of the bag, assembly procedure, materials of the various parts of the bag, the folding and attachment techniques to integrate the various separate parts of the bag and the suppliers of the different parts of the bag are critical and valuable information which took significant time, effort and resources on our part to put together.

We have identified SA Plastics as a potential manufacturer of the bag and we intend to send drawings as well as manufacturing and bag information and specifications to them in order for them to manufacture a batch of test bags.

We want to ensure that our rights are protected, and that SA Plastics does not disclose any of our proprietary information in respect of the bag or use such information in any of their other products or for any of their other projects or clients.

Please provide us with an appropriate confidentiality clause whereunder we can safely disclose our documents and information to SA Plastics.”

(10 marks)

TOTAL: 100 marks

“Annexure Q.1.A”

Sales Invoice

CopyChem (Pty) Ltd

registration no. 2011/012345/07

Head office and Factory

Address:

Plot 567

No 321 Main Reef Road

Langlaagte, Johannesburg

Gauteng, 2197

Tel: 011 654 3210

sales@copychem.co.za

Invoice no. 9876/2024

Date: 24 April 2024

Purchaser: Mr SJ Portland

Delivery Address: Factory depo collection

Sales Items

5 x 25kg Fastbrick each @ R 650,00

Sub Total: R3 250,00

VAT @ 15% R 487,50

TOTAL **R3 737,50**

Payment due COD

Directors: MK James; LP Right

www.copychem.co.za

“Annexure Q.1.B”

FORM P.2

REPUBLIC OF SOUTH AFRICA		REGISTER OF PATENTS		PATENTS ACT, 1978	
OFFICIAL APPLICATION NO.		LODGING DATE: PROVISIONAL		ACCEPTANCE DATE	
22	01	2015/01234		22	
INTERNATIONAL CLASSIFICATION		LODGING DATE: National Entry Date		GRANTED DATE	
C04B		1 September 2015		27 JULY 2016	
FULL NAME(S) OF APPLICANT(S)/PATENTEE(S)					
71					
GLOBAL CEMENT INC.					
APPLICANTS SUBSTITUTED:				DATE REGISTERED	
71					
ASSIGNEE(S)					
71					
DATE REGISTERED					
FULL NAME(S) OF INVENTOR(S)					
72					
JOHN C. STANKUS and JOHN G. OLDSEN					
PRIORITY CLAIMED AND PCT INTERNATIONAL APPLICATION		COUNTRY		NUMBER	
N.B. Use International Abbreviation for country (See Schedule 4)		33		PCT US	
		31		PCT/US2017/016543 10/687,960	
		32		24 FEBRUARY 2014 25 FEBRUARY 2013	
TITLE OF INVENTION					
54 CEMENTITIOUS PRODUCT AND MANUFACTURING PROCESS					
ADDRESS OF APPLICANT(S)/PATENTEE(S)				83 7 TH AVENUE, PITTSBURGH, PENNSYLVANIA, US	
ADDRESS FOR SERVICE				Agent: PA0000ZA00	
74 SA PATENT INC., Pretoria					
PATENT OF ADDITION TO NO.		DATE OF ANY CHANGE			
61					
FRESH APPLICATION BASED ON		DATE OF ANY CHANGE			

