

PATENT EXAMINATION BOARD

PATENT ATTORNEYS' PRACTICE – GROUP 2(g)

June 2024

Examiner: R. van Niekerk

Moderator: V. Williams

Time: 4 hours

Total marks: 100

This paper consists of 7 pages (including this cover page)

Instructions:

- Answer all questions.
- Write legibly and succinctly. Bullet points are acceptable; you do not need to write everything in full sentences.
- Marks are awarded for correctly identifying and explaining the relevant legal principles and applying them to the facts. Cite relevant case law where appropriate.
- Unless the question states otherwise, assume that all patents/applications referred to are South African patents/applications and that all activities occur within South Africa.

Question 1 (20 marks)

- a) What are the requirements for obtaining an interim interdict? (4)
- b) What matter forms part of the state of the art for the purposes of assessing the novelty of an invention but is not considered for the purposes of assessing inventive step? (3)
- c) What is meant by making a mosaic of prior art references and can such a mosaic constitute a novelty-destroying anticipation? (2)
- d) What is the Gillette defence? (2)
- e) Is any approval required when assigning a patent held by a South African company entity to a foreign entity? (2)
- f) Can a patent be revoked on the ground that it includes more than one invention? (2)
- g) What is the difference between an exclusive licence and a sole licence? (2)
- h) Explain the difference between the grounds for revocation referred to as inutility and insufficiency. (3)

Question 2 (10 marks)

Your firm's renewal department sent two renewal fee reminder emails which went unanswered by your client and the client's patent has now lapsed. Referring to the requirements for restoration, advise your client whether or not it is entitled to restore the patent if the facts are as follows:

- a) Your renewals department had the wrong email address for the client and the client did not receive the renewal reminders. The client learned about the lapsing a week ago when it enquired as to what the status of the patent is. (3)
- b) The client received both emails but was in hospital during the time and unable to attend to any work. The client found the emails a week ago and then contacted you to ask what they could do. (2)
- c) The client responded to your first renewal reminder email to say they will likely abandon the application but had not yet made up their minds. They ignored the second reminder email. 6 months have passed since the date of lapsing. (2)
- d) Assuming your client successfully restores the patent, will they be able to prevent their competitor from selling the patented invention where the competitor has, before the date on which the patent is restored, built a factory to commence making a product covered by the patent but had not yet done anything which would be an act of infringement under section 45? (3)

Question 3 (10 marks)

You represent HealthTech, a start-up company that has developed a technology that enables a smartwatch to do pulse oximetry, which is a test that measures the oxygen saturation level in your blood. HealthTech have their own brand of smart watches called the Oxi-Watch® which has a specially developed sensor capable of performing the pulse oximetry test. However, your client informs you that Samsung holds a patent on smart watch sensors and that the Oxi-Watch sensor likely infringes the Samsung patent.

- a) Assuming that HealthTech has a patent for the Oxi-Watch sensor, advise them on what to do if Samsung refuses to give HealthTech a licence under the patent on reasonable terms, and what the requirements they would have to show. (8)
- b) Would your advice change if HealthTech did not have a patent for the Oxi-Watch sensor? (2)

Question 4 (10 marks)

The University of Pretoria wishes to file a patent application for a technology developed by one of their chemistry researches, which is fully set out in the researcher's PhD thesis.

- a) If the PhD thesis was uploaded to the University's public digital library one week ago, but the University has confirmed that nobody has yet accessed or downloaded the thesis, has the novelty of the invention been destroyed? (2)
- b) Assume that only the abstract of the thesis has been published in the library. The abstract contains a summary of what the invention achieves without giving details of how it is achieved. Is the invention still patentable? (4)
- c) Assume the PhD thesis is still confidential. However, the laboratory in which the researcher was testing the technology has been visited by several other researchers from different universities, who saw how the technology works. One of those other researchers also posted a detailed blog post online a week ago fully describing the technology. Is the invention still patentable? (4)

Question 5 (10 marks)

Your client requests your advice on what actual or potential patent rights its competitor has. You do a search of the CIPC patent records. Comment on the competitor's patent rights in

the following different situations, assuming the only results mentioned are the only results found. If your answer depends on additional information, then discuss what would determine the answer:

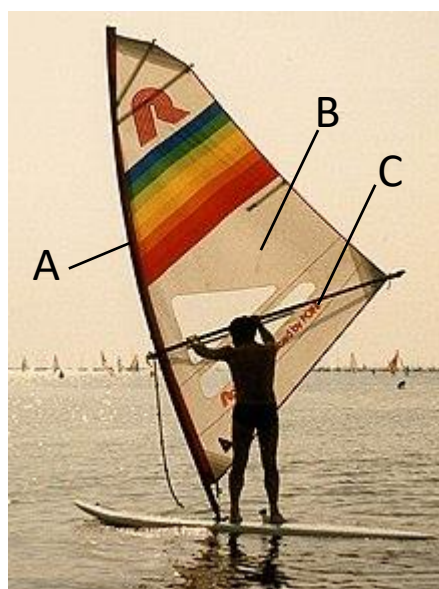
- a) A provisional patent application was filed 14 months ago. (2)
- b) A complete patent application was filed. Two years have passed from the filing date and the application has not yet been accepted. No extensions of time have been applied for. (3)
- c) A complete patent application was filed. It was accepted 4 months ago but has not been published. No extension of time has been applied for. (3)
- d) A granted patent is found. The first renewal fee, calculated as 3 years from the filing date of the complete application, was 4 months ago and no renewal fee has been paid. (2)

Question 6 (15 marks)

Assume the windsurfer was invented in 2010 and the patent has not yet expired. Claim 1 of the patent reads:

1. A wind-propelled vehicle comprising a board and a spar connected to the board through a universal joint, with a sail attached to the spar and held taut by a pair of arcuate booms mounted on the spar at one end and joined together at the other.

A picture of a windsurfer made according to the patent is shown below.



Your client wishes to compete in this market and plans to sell only the rigging comprising the spar (A), sail (B) and booms (C), but will not supply the board. Customers will be able to buy compatible boards from other sources and connect these to the rigging.

Advise your client on:

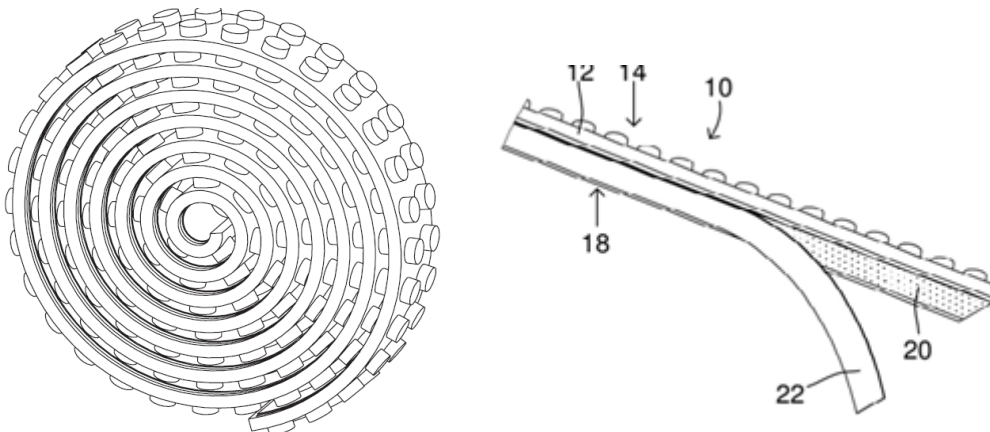
- a) Whether its proposed actions will infringe the patent, addressing each step in reaching your conclusion as to whether there is infringement or not. (8)
- b) Whether there is any other doctrine that may impact your client's liability, and what would have to be proved. (7)

Question 7 (5 marks)

Explain to your client what the purpose of the claims of a patent is, and the requirements that apply to the claims.

Question 8 (20 marks)

Your client invented a Lego-compatible building block base shown below.



The base is flexible, cuttable with scissors, and includes an adhesive (20) with a removable cover (22) on one side so that you can stick down the base and build Lego structures in various ways. The base is long (up to 1m) and packaged in a roll.

Claim 1 of the patent reads:

A toy building block base comprising a strip with an array of projections along the strip on one side thereof that form a mating arrangement for cooperating toy building blocks, and an adhesive on an opposite side of the strip, wherein the strip is flexible, has a length of at least 50cm and has no more than four projections across its width.

Assume that the closest prior art includes the following three pre-existing products -

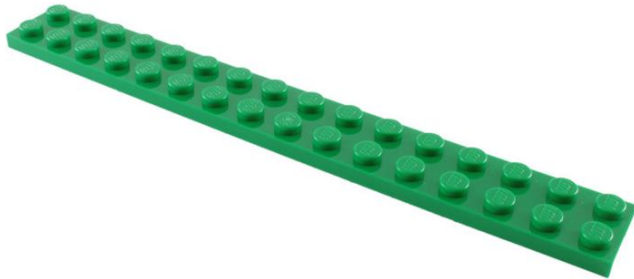
Prior art reference 1: Flexible building block mats. On the one side it has small projections for regular Lego and on the opposite side large projections for the larger Lego blocks for younger kids called Duplo. It has a length of about 1m.



Prior art reference 2: Lego base plates. These plates are relatively rigid and have adhesive on the bottom surface thereof.



Prior art reference 3: Lego blocks. Standard Lego blocks come in up to 16 projections long. They are rigid blocks. The underside is compatible with other Lego blocks and includes recesses that fit the projections as are well known.



Comment on the validity of your client's patent in the light of the prior art, referring to the Patents Act, case law and comparing the prior art to the claim of the patent.