

# **PATENT EXAMINATION BOARD**

## **PATENT ATTORNEYS' PRACTICE – GROUP 2(g)**

**June 2025**

Examiner: R. van Niekerk

Moderator: J. Luterek

Time: 4 hours

Total marks: 100

This paper consists of 6 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** (15 marks)

- a) What is the purpose of a patent's claims and what requirements apply specifically to the claims? (5)
- b) What is the Gillette defence? (2)
- c) What are the requirements for restoration of a lapsed patent? (2)
- d) Explain the difference between the grounds for revocation referred to as inutility and insufficiency (3)
- e) Explain the difference between exclusive, non-exclusive and sole licences (3)

**Question 2** (5 marks)

A patent is in the name of three joint patentees, one of whom is your client. Your client asks you what they are allowed to do in respect of the patent without referring to the other two patentees, and whether they are obliged to inform the other two patentees of any such actions. Advise your client. (5)

**Question 3** (15 marks)

On 25 April 2025 you filed patent application No. 2025/03344 for your client, Myloop Industries. Application no. 2025/03344 is a national phase entry of a PCT application filed on 1 January 2024, with the PCT application claiming priority to a US patent application filed on 1 January 2023. Prior to acceptance of application no. 2025/03344 you filed a fresh application in terms of section 37 (i.e. a divisional application) based on application no. 2025/03344 ("the parent application").

- a) To what date would you have ante-dated the divisional application and why? (2)
- b) In what way must the claims of the divisional application differ from the claims of the parent application (2025/03344)? Explain with reference to case law. (5)
- c) Assume that parent application has been granted but the divisional application has not yet been accepted. Myloop Industries asks you whether the filing of a further divisional application is possible. Advise your client. (8)

**Question 4** (5 marks)

What is the doctrine of unclean hands and is it available as a defence in patent law? (5)

**Question 5** (10 marks)

You filed a provisional application for a client 10 months ago. Your client wants to obtain patent protection in South Africa, the United States and in Europe but expects to have the funds to do so only in 6 months' time.

- a) Assume that the client plans to first disclose the invention at a trade show in 2 weeks' time. What are your client's options, what preliminary step(s) would you need to take (if any) in following the various options, and which of the available options would you recommend? (7)
- b) Assume instead that the invention was disclosed 6 months ago. What are your client's options now? (3)

**Question 6** (8 marks)

Can a South African patent application claim priority to an earlier application (the "second application"), where the second application itself claims priority to an even earlier application (the "first application")? Explain what the answer depends on.

**Question 7** (10 marks)

You file a patent application as a national phase entry in South Africa of a PCT application. The PCT application includes the following claim which you advise the client will be invalid if granted as it is a method of treatment of the human body:

1. A method of treatment of a patient suffering from glaucoma, the method comprising applying a therapeutically effective amount of a substance containing composition X to an eye of the patient.
  - a) Write out the claim(s) that you would substitute the above claim for and briefly explain what the relevant claim form(s) are. (6)
  - b) Assuming this is a valuable technology, what else could you do to place the client in the best position to enforce its rights against competitors in South Africa and reduce the chance of a successful attack on the validity of the claims? (4)

**Question 7** (7 marks)

On 1 June 2025 you are instructed to advise your client on the status of a competitor's patent application. The official register (form P2) indicates the following:

Patent Appl No.	2023/04334
Priority claimed:	ZA patent application no. 2022/01234 filed on 5 March 2022
Date of lodging:	3 March 2023
Date of acceptance:	3 January 2025
Date of publication & grant:	None, not granted

You obtain a full file copy from the patent office. The Forms P3 and P26 were late lodged on form P5 by the applicant on 12 October 2024. No requests to the Registrar on Form P4 have been filed by the patentee.

What is the status of this patent application and can it still be granted? Discuss with reference to case law.

**Question 8** (10 marks)

Your client's competitor, Straw King®, has a South African patent for a method of making biodegradable drinking straws. The patent only has one independent claim, which reads:

A method of manufacturing biodegradable drinking straws comprising:

- (i) extruding a heated mixture of polylactic acid (PLA) and cornstarch through a cylindrical die at a temperature between 160°C and 180°C to form a continuous tubular strand,
- (ii) passing the tubular strand through a water-cooled chamber to solidify the material,
- (iii) applying surface embossing to the outer wall of the tubular strand using a rotating patterned roller while the strand is semi-rigid, and
- (iv) cutting the strand into straw-length segments of 200 mm ± 5 mm.

You do a worldwide search and determine that Straw King® has an equivalent patent in China but nowhere else. Your client wishes to use the same process for manufacturing their drinking straws.

- a) Your client says one option is for them to manufacture their straws in Vietnam and import them into South Africa. Will this infringe the patent? (3)

- b) Another option is for your client to purchase the straws from Straw King's Chinese manufacturer and import them into South Africa. Is this permissible under any circumstances? (7)

**Question 9** (15 marks)

Assume your client invented and patented the Waffle Trainer, a shoe with a sole that has a pattern of studs inspired by a waffle iron, depicted below:



This shoe offers improved stability compared to previous training shoes.

Claim 1 of your client's patent reads:

1. An athletic shoe including:

an outer sole of resilient material including a bottom surface having a plurality of studs formed integral with the remainder of the bottom surface and projecting downward from the bottom surface of the sole, the studs being of a rectangular shape, and the studs forming the entire ground contacting surface of said shoe.

The closest prior art is shoes with soles that have patterns more akin to car tyres (such as the example below) and, of course, waffle irons:



Comment on the validity of your client's patent in the light of the prior art, discussing the approach courts take in determining such ground(s).