

# **SOUTH AFRICAN PATENT LAW AND PRACTICE**

## **EXAMINATION PAPER - JUNE 2017**

(PAPER SET UNDER THE AUSPICES OF  
THE SOUTH AFRICAN INSTITUTE OF INTELLECTUAL PROPERTY LAW AND  
THE PATENT EXAMINATION BOARD)

### EXAMINER:

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### NOTES TO CANDIDATES:

1. There is no choice of questions to be answered. All questions should be answered.
2. The paper consists of a total of 6 pages (including this cover page) and a total of 13 questions.
3. The duration of the exam is 4 hours.
4. Total marks of the exam is 215 marks
5. All references to the Act are references to the South African Patents Act, No 57 of 1978.
6. Wherever possible, your answers should refer to the relevant sections of the Act, the content of the section should be set out and only then should a conclusion be reached.
7. Write neatly and legibly.

**QUESTION 1 [54 MARKS]**

- 1.1 Referring to section 25(2), mention the things which are not an invention in terms of the Act. How are these exclusions countered by section 25(3)?  
(9 marks)
- 1.2 You consult with a new client on the possible protection of an invention in South Africa through the filing of a patent application. The client advises you that there has been some prior use of the invention. Advise the client fully on:  
(i) what type of use may be excused in terms of the Act, and  
(ii) the type of use that would be deemed novelty destroying. Refer to the Act.  
(12 marks)
- 1.3 What are the extrinsic characteristics for an invention to be patentable in terms of the Act?  
(3 marks)
- 1.4 When is an invention deemed to be new?  
(2 marks)
- 1.5 When is an invention deemed to involve an inventive step?  
(3 marks)
- 1.6 Discuss the state of the art with reference to section 25 of the Act. (12 marks)
- 1.7.1 A client comes to you with a new invention comprising a new type of improved mop that cleans floors without streaks and which dries faster and easier compared with existing mops on the market. He advises that he has been using it for his own personal use, secretly for about 2 years and has now decided to file a patent application for his new mop. Advise whether it will be possible to file a valid patent application, in South Africa.  
(2 marks)
- 1.7.2 It later comes to light that he has in fact been using the mop secretly and commercially in Namibia and not merely using it secretly for his own personal use locally. Would your advice in 1.7.1 differ?  
(3 marks)
- 1.7.3 What if the client has been selling it commercially in South Africa?  
(2 marks)
- 1.7.4 The client then advises that he really hasn't sold that many mops, only one or two in South Africa to test the market. He enquires whether there is any possible way to file a patent application in South Africa for his new mop, as he really needs protection before marketing it.  
(4 marks)
- 1.8 Is the state bound by a patent?  
(1 mark)
- 1.9 According to section 27, in the absence of an agreement to the contrary, joint inventors may apply for a patent in \_\_\_\_\_ shares.  
(1 mark)

**QUESTION 2 [12 MARKS]**

Your client's patent application is to be granted soon. There may be a need to amend the claims of the patent application. In terms of section 51, advise your client on whether to amend the patent application prior or after grant. (12 marks)

**QUESTION 3 [12 MARKS]**

Your client has made some changes to his invention after an application for a patent accompanied by a complete patent specification has already been filed. Explain the options available to your client under sections 39 and 51(8) respectively for the case (i) where the application is still pending and (ii) has already proceeded to grant. Comment on any exceptions in so far as rights or obligations are concerned.

(12 marks)

**QUESTION 4 [8 MARKS]**

- 4.1 The correction of which errors may the registrar or the commissioner of patents authorise in terms of section 50 of the Act? (3 marks)
- 4.2 When is an applicant for amendment of a patent obliged to apply to court for the amendment and what may the court do on receipt of an application for amendment? (4 marks)
- 4.3 When may the commissioner of patents not set aside an amendment made in conflict with the provisions of section 51 of the Act? (1 mark)

**QUESTION 5 [21 MARKS]**

- 5.1 List the grounds of revocation. Give a very brief explanation where a ground refers to another section. The other sections need not be discussed at length, only give an overview of what the other section relates to. (19 marks)
- 5.2 Who may bring an application for revocation and when may such an application be brought? (2 marks)

**QUESTION 6 [2 MARKS]**

In deciding to restore a patent, the registrar has to be satisfied that certain requirements have been met. List the requirements. (2 marks)

**QUESTION 7 [6 MARKS]**

Your client has applied for a patent, the working of which would result in the infringement of a prior patent. Your client is intending to obtain a compulsory licence. In terms of section 55, what should your client prove? (6 marks)

**QUESTION 8 [48 MARKS]**

You have a client in the pharmaceutical industry who specifically produces generic medicines and wants to start manufacturing and testing a new drug. You advise that patent searches should first be conducted in order to establish whether or not there may be an existing patent which may be infringed by the exploitation of their new drug.

8.1 Your client instructs you to continue with South African patent searches in order to reveal any patents which may be infringed by the exploitation of his new medicine. You reveal a relevant patent that you believe would be infringed by your client.

What is the effect of a patent? (8 marks)

8.2 You warn your client that the patentee could institute proceedings for infringement. What relief would the patentee be able to claim? (6 marks)

8.3 In certain circumstances, a patentee will not be entitled to the relief in proceedings for infringement. Discuss these restrictions, relevant periods concerned, and rights of a potential infringer in terms of section 66. (8 marks)

8.4 Your client is adamant that he wants to proceed with launching his new generic medicine, even although it is basically a copy of the patented medicament, as he is convinced that the patentee is abusing his patent rights. In this regard, advise your client on the requirements in order to obtain a compulsory licence? (13 marks)

8.5 After advising your client about the possibility of obtaining a compulsory licence and the success rate of such type of applications, your client decides against this route. However, he wants to know whether or not he can start developing his new drug even though the patent is still in force. Advise (13 marks)

**QUESTION 9 [12 MARKS]**

South African patent application no. 2004/01234 (ZA 2004/01234) was filed on 13 February 2004, accepted on 8 January 2005 and proceeded to grant on 26 March 2005. The patent claims priority from South African provisional patent application 2003/01544 (ZA 2003/01544) filed on 5 March 2003.

South African patent application no. 2005/07765 (ZA 2005/07765) was filed as a national phase application on 17 July 2005. ZA 2005/07765 was based on a PCT patent application with a filing date of 18 February 2004. The PCT patent application claimed priority from US provisional patent application no. 60/073,255 which was filed on 22 February 2003. ZA 2005/07765 was accepted on 24 April 2006 and proceeded to grant on 26 June 2006.

In respect of (1) ZA 2004/01234 and (2) ZA 2005/07765

- 9.1 When is/was the first renewal fee due? (2 marks)
- 9.2 Are extensions available in terms of the renewal fees? (1 mark)
- 9.3 If all the renewal fees are paid, when will the terms of the patents expire?  
(2 marks)
- 9.4(a) What was the final deadline for filing a complete patent application from ZA 2003/01544? (1 mark)
- 9.4(b) Would your answer have differed if the priority application was filed in another convention country? (1 mark)
- 9.5 What was the deadline, including any extensions, for filing the national phase patent application based on the PCT patent application? (1 mark)
- 9.6 The inventions disclosed in ZA 2004/01234 and ZA 2005/07765 relate to exactly the same invention. Which patent would be valid against the other in terms of novelty requirements? First set out the relevant section in the Act and then provide your answer. (4 marks)

**QUESTION 10 [7 MARKS]**

Your client expresses an interest in filing a PCT application. Advise your client on the advantages and disadvantages of doing so. (7 marks)

**QUESTION 11 [10 MARKS]**

Section 90 of the Act nullifies certain conditions in contracts relating to the sale of patented articles or to licence under patents. Elaborate on these nullified conditions. (10 marks)

**QUESTION 12 [3 MARKS]**

12.1 What signed documents that are not signed by a patent attorney must be filed with a provisional patent application? (2 marks)

12.3 What is the opposition period for a patent application? (1 mark)

**QUESTION 13 [20 MARKS]**

List 10 differences between a provisional patent application and a complete patent application. (20 marks)