

PATENT ATTORNEY'S PRACTICE

GROUP 2G – 2017

(100 marks) Time: 4 hours

Instructions:

Where necessary, please cite relevant sections of the Patent's Act. Please do not re-write the sections however in your answer.

Please cite relevant case law where you deem it to be appropriate.

QUESTION 1

Answer "yes" or "no" to the following:

- (a) Can one ask for an extension of time to file a counterstatement in a revocation application after the expiry of the regulation two month period?
- (b) Is a claim to "a method of diagnosing paranoia by considering the reaction of a patient to being shown a photograph with a violent scene" patentable subject matter?
- (c) Can one enforce a patent that has expired?
- (d) Is secret and commercial use novelty-destroying if such use takes place overseas?
- (e) Can a licensee ever institute infringement proceedings (as opposed to merely intervening as a co-plaintiff)?

(5 marks)

QUESTION 2

Your client asks you to file a South African patent which claims priority from a United States continuation-in-part application which was filed ten (10) months ago, and which discloses and claims compounds A and B. Your client tells you that the continuation-in-part application is based on an earlier United States patent application which was filed eighteen (18) months ago, and which discloses only compound A. Advise your client on the options available for protecting compound A and compound B in South Africa.

(5 marks)

QUESTION 3

Your client wishes to exploit an invention which he has patented and which deals with an improvement to a valve spindle. The spindle forms part of a valve which your client wishes to

produce. The valve has, however, been patented by your client's competitor. What steps would you take, and what evidence would you require from your client in order to obtain a licence to enable your client to exploit his invention?

(10 marks)

QUESTION 4

Your client calls you in a panic as he has been informed that Copycats R Us are gearing up to manufacture his patented product and distribute it into the South African market. He refers you to South African Patent No. 2006/5973. You see from the status report that the patent lapsed due to non-payment of the renewal fees on 21 February 2013 and, on telling your client this, he says that he is utterly astounded because he instructed your firm to look after the renewal fees and left a deposit with them to cover the renewal fees until at least 2020.

Advise your client on the restoration of his patent, prospects of success and the enforcement thereof against Copycats R Us.

(15 marks)

QUESTION 5

Mr E, a design engineer, was employed by Apple to improve upon the current Apple Iphone, which is manufactured and sold by Apple. Mr E has been working on the improvements for quite a while and as a result a specialist, Mr S, was contracted to assist with the development. The new generation Iphone has now been tested and functions unexpectedly well.

i) Apple wishes to patent the improvements to the Iphone, but Mr E who recently left in acrimonious circumstances, refuses to sign any document. Advise your client.

(3 marks)

ii) The parties agree that the patent application should be filed jointly in the names of Mr S and the sole shareholder of Apple, namely, Mr CEO. What would you require from Mr S and Mr CEO to enable you to file?

(3 marks)

iii) A provisional patent application is filed as in (ii) above, and Mr CEO wishes to licence the provisional application to his company, Apple, to exploit the invention. Advise your client about the current position (i.e. that the application is only a provisional) and the situation once a patent is granted.

(4 marks)

iv) Your client, Apple, advises that it has heard that Mr S has made a further significant improvement to the Iphone, and further tells you that Mr S left the employ of Apple about 4

months ago. Client wants to use the improvement and shows you the following clause in the contract Mr S signed:

“Any developments, additions and improvements made by yourself to the Iphone shall belong to Apple and shall, accordingly, be assigned thereto. This clause shall survive the termination of the contract of employment.”

Advise Apple as to the enforceability of this clause.

(5 marks)

TOTAL: 15 MARKS

QUESTION 6

You are approached by the patentee of South African patent ZA 2003/9827 who wants to institute infringement proceedings against Zen (Pty) LTD, a South African company.

Claim 1 of the patent reads:

“A system for determining whether an application is compatible with a smart phone, the system comprising a server including a first database of applications and a second database of smart phone brands and associated smart phone brand models and a software module for comparing an application to the smart phone brand model and communicating to a cell phone user whether the application is compatible with a cell phone user’s smart phone”.

Your client, tells you that it has written the software module for the above and has licensed it to AppCompare Inc, who provides the system, in the form of a phone app, on a global scale. The server of AppCompare Inc is located in the Cayman Islands.

Advise the patentee on the question of patent infringement, ignoring whether the claim itself is patentable.

(25 marks)

QUESTION 7

Your SA resident client (X) of a chemical company sends you an email telling you that he went on a USA marketing visit during which he had a very friendly dinner discussion with the Managing Director (Y) of a USA competitor. The facts disclosed to each other were as follows:

(Y) filed a GB provisional patent application on 21 March 2014 and then filed a GB complete patent (which is still being examined and hasn’t been published) and a South African non convention application thereafter. (Y)’s South African application was granted on 28 December 2016. In it, the compound paraxol is claimed as well as its use as a blood thinner.

Your client (X) tells you that he filed a South African complete patent application, in the first instance, on 16 August 2015, after having conducted public clinical trials in the Eastern Cape from

January 2015. X's patent claims paraxol as a compound and a method of treating diabetes using paraxol.

(X) wants to know (with reasons):

- (a) if his patent has any validity problems and why with reference to the patent itself and Y's patent?;
- (b) if there are any validity problems, can he rectify them, and how and what procedure would it entail?

(25 marks)
