

IP BRIEFS®

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FROM THE EDITOR



Dr. MM Kleyn
Madelein.kleyn@outlook.com

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As a child I would wait up all night on 31 December to watch the beautiful fireworks announcing the New Year at midnight as the waning candle would flicker its last light on another year.

In reflection I once again embraced the privilege of being an intellectual property attorney.

There are many noble and fulfilling pursuits within the field of law, but undoubtedly Intellectual Property law remains at the top of the list. No other legal profession covers such a wide range of human effort, innovation and creativity. No other legal profession provides the opportunity to work with movie and sport stars, cultural icons, or popular brands and slogans. Intellectual Property attorneys are exposed to creative minds and innovation continuously and have the opportunity to protect intellectual assets, like a patent of a formula for a new drug that lessens the effects of leukemia; or the design for an efficient battery for electric cars. There is a constant evolution of creative ideas in a diverse range of industries, and as intellectual property attorneys we have the opportunity to work with companies and creative minds that are changing the direction of civilisation around the globe through groundbreaking innovation. We protect 5G solar, biotech, artificial intelligence, eCommerce, fintech and food technology. We even have the opportunity to be creative and innovative through arguments in prosecution and litigation. We make deals through licensing and commercialization; we lend a hand in making the world a better place. Truly a career I do not regret pursuing.

Wishing all our readers a healthy, safe and successful 2023!

"The pessimist sees difficulty in every opportunity. The optimist sees opportunity in every difficulty."

— Winston Churchill



Ignorance Is
NO Excuse

IP: Threats, theft and ignorance

by Jeremy de Beer

THREATS - BREACH OF CONFIDENCE / PRIVATE INFORMATION

Clearcourse Partnership and others v Jethwa (2022) is an interesting UK court decision dealing with breach of confidence. In this case, a party involved in a business sale heard and used information that he was not supposed to hear or use.

The facts

Clearcourse was instructed to handle the sale of a company of which Mr Jethwa was the part-owner and then CEO. To discuss the deal, two directors of Clearcourse met with Mr Jethwa at his in a conference room that was monitored by CCTV cameras. During the meeting Mr Jethwa left the conference room to go to his own office adjacent to the conference room. In his absence the two Clearcourse directors had “unguarded and candid” conversation.

They discussed their strategy for the negotiations and their views on Mr Jethwa, predicting that he would probably be fired if the transaction proceeded.

Mr Jethwa overheard the conversation, and although he claimed that what he heard came through the wall rather than through the CCTV camera footage, he did take a screenshot of the footage. Mr Jethwa made no mention of the conversation he overheard, as he (apparently) wanted the deal to go ahead.

The sale was concluded but a dispute subsequently arose. Mr Jethwa presented the screenshot he had taken to Clearcourse, adding these words: “*You should know this doesn’t do you any favours...what you both say should be interest for social [sic].*” Clearcourse interpreted this as a threat to disclose what had been discussed privately on social media, and brought an action in the High Court seeking an interim non-disclosure order.

Breach of confidence

Clearcourse alleged breach of confidence. The judge accepted that Mr Jethwa's screenshot and message was a threat and he found in the company's favour. The judge said that to succeed with a breach of confidence claim you need to establish three things, namely that:

- the discussion had the necessary quality of confidence;
- the defendant came to know of what was being said in circumstances importing an obligation of confidence; and
- there had been unauthorised use, or a threat to use, that information to the detriment of the owner of the information

The judge found that the requirements had been met, saying "there is no reason why a person overhearing a private discussion through a window or a wall, and who is aware of the context and private nature of the discussion, should not come under a duty of confidence. The fact that he makes no specific effort to eavesdrop is not determinative in this regard."

Misuse of private information

On the claim for misuse of private information, the judge accepted this in stating that Clearcourse "*would regard their conversation, behind closed doors, as giving rise to a reasonable expectation of privacy*". The judge said

that there was no general interest or justification for its disclosure.

South Africa

It's worth noting that South African law would also offer a remedy in a case like this, under the general ground of unlawful competition. The onus of proof is on the plaintiff to prove that the information was indeed confidential and that it was wrongfully applied/used to the detriment of the plaintiff.

THEFT: HERALDRY

Heraldry is a rather obscure area of the law that is loosely linked to IP. We don't get to write about it much.

The SA flag

When South Africa became a democracy in 1994, the old flag was replaced with the "horizontally oriented Y-shape flag" that comprises six colours: blue, green, black, white, yellow and red. It's always been accepted that the flag was created by Harold Frederick Brownell, a man who was the State Herald at the National Archives for the period 1982 - 2002.

Alleged theft

There is now a claim that the design for the South African flag was stolen¹. Them bani Hastings Mqhayi, a manager at the Eastern Cape Department of Arts and Culture, claims that he submitted five potential designs for the new flag to

¹ [Artist claims he is the rightful designer of SA's flag, takes Nathi Mthethwa to court | News24](#)

the Department of Sport, Arts and Culture in 1994. The suggestion is that Mr Brownell, who was part of the committee that made the final decision, took Mr Mqhayi's designs and submitted them as his own. Mr Mqhayi has filed an action at the Gauteng High Court in Pretoria, citing Sports, Arts and Culture Minister Nathi Mthethwa as the First Respondent and the State Herald as the Second Respondent.

The claims

Mr Mqhayi alleges that Minister Mthethwa failed to disclose pertinent information about the creation of the flag, and that a request made under the Promotion of Access to Information Act, 2000, in July 2021 was ignored. He is seeking a great deal of information about how the flag was created, including:

- the identities and capacities of all those who made up the committee;
- minutes of meetings about the designs;
- details of all those who submitted designs;
- details regarding the selection process; and
- the committee's final recommendation that was sent to the president for approval

Unfortunately, Mr Brownell can't be consulted because he died in 2019. It will be interesting to see how this matter plays out.

IGNORANCE: DENEL

According to recent news reports, the arms company Denel sold intellectual property relating to the RG35 armoured vehicle's developed version, the N35, to a company called NIMR – a subsidiary of UAE government-linked Tawazun. This sale occurred in 2015 and the purchase price was USD16-million (ZAR208-million at the time of writing). Reports suggest that if Denel had not sold this IP, it could have earned some ZAR480-million in the period 2013-2018. More worryingly, the report says that projections for the N35 vehicle for the period 2015-2021 were some ZAR4.1-billion.

The news reports are vague. But what the story certainly does do is highlight the need for proper IP valuation, and an understanding of the value of IP and the revenue it can generate. This is particularly important in the context of mergers and acquisitions, where the target company's IP may be sold to the acquirer as part of the merger, or sold separately to a third party (which could significantly affect the target's value to the acquirer).

About the Author:

Jeremy de Beer is a Trainee Associate in ENSAfrica's intellectual property practice. He specialises in trade mark litigation, copyright, passing off, company name objections and domain name complaints.

Intellectual Property protection in the video gaming industry

By Corrie Jonker

Over recent years a greater focus has been placed on intellectual property, specifically copyright in the digital environment as it relates to the development of gaming software. The most recent example of this being the invention of the Metaverse and an expansion of human presence in digital spaces. With that in mind, software creators, especially video game developers, should be attentive to how they can protect their IP.

The two forms of intellectual property that are most applicable to the video gaming industry are trade marks and copyright. One serves to protect the developer's brand whereas the other protects the actual source code being developed, as well as the outputs resulting from such source code.

Protecting your video game with trade marks

Video game developers usually contribute a large portion of the game's budget towards marketing, as the relevant consumer places a great deal of emphasis on the packaging and the name as a source identifier. The main characteristic of a successful trade mark is that it serves as a source identifier and badge of origin for the product. That being said, game developers should inherently put an equal amount of effort into the development and protection of their brand, being the identifier of their software.

An example of such a source identifier would include popular fictional characters that make up and live the game story. Although fictional characters, as well as other in-game creations, are protected as copyrightable works, it is also possible to protect such in-game creations in terms of trade marks, if such creations are considered source identifiers or used in relation to marketing or merchandise. Practically illustrated, if one considers the *Mario Bros.* franchise, a number of the characters and their likenesses form the subject of a number of registered trade marks globally, as such characters are used in the marketing of the franchise, as well as being used in relation to clothing and toys. Nevertheless, they could also be registered as source identifiers, as consumers would associate *Mario* and *Luigi* with Nintendo.



CORRIE JONKER

Corrie is a candidate attorney in the trade mark department. He obtained his BA(Law) degree in 2017, his post-graduate LLB degree in 2019, as well as his Master of Laws in Intellectual Property Law in 2020.

Corrie is an avid gamer and wrote his dissertation for his Master of Laws on copyright in the gaming industry, with a specific case study on the MOBA genre, comparing Defence of the Ancients with DOTA2 and League of Legends.

Corrie's further interest areas include end-user agreements, domain name disputes and trade mark prosecution.

Protecting your video game with copyright

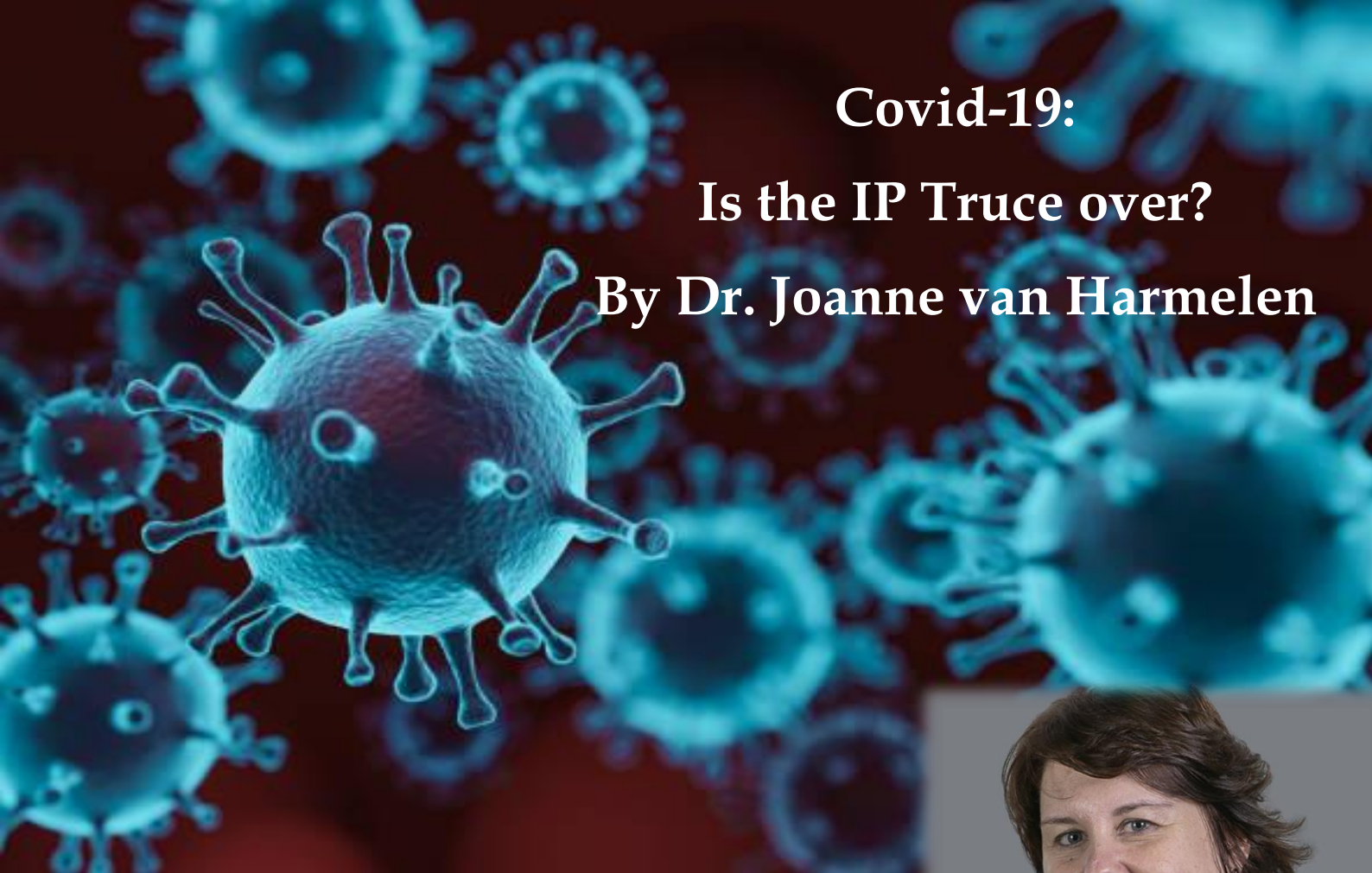
A number of elements that make up computer software, and specifically video games, fall within the scope of copyright protectable works. These include the source code itself, as well as the output of such source code. The output could be artistic works, such as the characters or terrain seen during the gameplay; the musical score or sound effects of the video game; or literary components, such as the story, to name a few. That being said, it is important to be aware of the types of copyright protected works present in a video game and, further, aware of the ways in which these rights can be protected, transferred and commercialised to the benefit of the developer.

While having to identify all of the protectable works present in a video game may seem daunting, it is important to note that copyrights vest automatically and no registration is necessary before the copyright owner may enforce these rights.

Conclusion

Although navigating the subject of IP protection in the realm of video games can be challenging, especially when it relates to the protection of in-game characters and creations, video game developers should not be discouraged from enforcing their protected creations through trade marks, copyrights or both, where applicable.

Covid-19: Is the IP Truce over? By Dr. Joanne van Harmelen



Joanne leads the Biotechnology and Life Sciences Cluster in ENSafrica's Intellectual Property department. She is a qualified patent attorney specialising in patent filing and prosecution in the biotech and pharmaceuticals sectors. Joanne holds a PhD in medical microbiology and vaccine development. She has extensive experience in the field of biotechnology and life sciences, having prepared and filed patent applications locally and in foreign jurisdictions in the fields of microbiology, biochemistry, molecular medicine, agrobiolgy, bioremediation, bioprocessing, biopharmaceuticals, nutraceuticals, cosmetics, and food sciences. Joanne is also experienced in the preparation and filing of plant breeders' rights applications.

The COVID-19 pandemic brought with it something of an IP truce, with major pharmaceutical companies seemingly happy to co-exist.

Now, there seems to be trouble in paradise! A battle is about to commence with three of the major players in the COVID-19 vaccine industry now in dispute.

Moderna v Pfizer/BioNTech

Moderna

Moderna, a company based in Cambridge, Massachusetts, USA (and founded as recently as 2010) was an early developer of the mRNA technology. The company's vaccine comprises mRNA that expresses a viral protein and generates an immune response training the body to fight off a real virus when it comes into contact with it.

Moderna obtained approval for its vaccine in a matter of months when the US Food and Drug Administration¹ ("FDA") granted "emergency use authorisation" for the company's COVID-19 vaccine in December 2020. At the same time, the FDA had already also granted authorisation to Pfizer/BioNTech (just one week earlier).

Moderna's action against Pfizer/BioNTech

Moderna is now suing Pfizer and its German partner BioNTech for patent infringement. Actions have been brought in both the USA and Germany. Moderna claims that Pfizer/BioNTech copied two key elements of its patented technology. The first involves a "chemical modification", which has the effect that the vaccine does not provide an "undesirable immune response". The second is to do with the way both vaccines target the distinctive spike protein on the outside of the virus.

Moderna alleges that Pfizer/BioNTech, without permission, copied the mRNA technology that Moderna had patented between 2010 and 2016, well before COVID-19 emerged in 2019. Moderna's chief executive Stéphane Bancel is quoted as follows:

"We are filing these lawsuits to protect the innovative mRNA technology platform that we pioneered, invested billions of dollars in creating, and patented during the decade preceding the COVID-19 pandemic."

Moderna's explanation for its action

No doubt alive to the sensitivities surrounding COVID-19 vaccines, Moderna has seen fit to explain its action in some detail. In a statement, it said that Pfizer/BioNTech's alleged IP theft related to two things.

1. An mRNA structure that Moderna claims it started developing in 2010 and that was validated in human trials in 2015. It said that Pfizer/BioNTech took "four different vaccine candidates into clinical testing, which included options that would have steered clear of Moderna's innovative path". Yet it chose "to proceed with a vaccine that has the same exact mRNA chemical modification to its vaccine."
2. The coding of a full-length spike protein that Moderna claims it developed in the creation of a Middle East Respiratory Syndrome ("MERS") vaccine. The MERS vaccine was, in fact, never commercialised, but its development helped Moderna rapidly roll out its COVID-19 vaccine.

Pfizer's response to the action

Pfizer, in a statement, said that it was "'surprised' by the patent claim because its vaccine was based on its own proprietary mRNA technology".

¹ [U.S. Food and Drug Administration \(fda.gov\)](https://www.fda.gov)

It went on to say: “We remain confident in our intellectual property supporting the Pfizer/BioNTech vaccine and will vigorously defend against the allegations of the lawsuit.”

The times they are a-changing

In the early days of the pandemic, Moderna undertook that it would not enforce its patent rights, so that other companies could develop their own jabs, particularly in poorer countries. But in 2022, Moderna said that companies like Pfizer and BioNTech would need to respect its patent in higher-income countries, although it did undertake that it would not claim damages for any activity that had occurred 2022.

Essentially, what this means is that Moderna has changed course on its public commitment not to enforce the patents. It has been suggested that perhaps Pfizer might argue that the court should hold Moderna to its public pledge. However, it is questionable whether or not this would be a successful approach given the dearth of legal precedents for such a circumstance.

Is it all about the money?

Moderna is, in its court action, seeking unspecified monetary damages. That is perhaps no surprise because there is a lot of money at stake. Moderna’s COVID-19 vaccine – its lone commercial product – has brought in revenue of USD10.4-billion in 2022, whereas Pfizer’s vaccine has brought in some USD22-billion.

Other litigation

It’s worth noting that both Pfizer/ BioNTech and Moderna are involved in other disputes.

BioNTech is facing a claim from a company called CureVac, which claims infringement of patents linked to the engineering of certain mRNA molecules, and is demanding financial compensation. Pfizer and BioNTech have responded by filing a complaint with a US district court, to seek a declaratory judgment that there was no infringement of the CureVac US patents and also recently filed similar proceedings at the High Court of England and Wales seeking a non-infringement declaration of CureVac's European patents.

Pfizer and Moderna have both been in the firing line from Alnylam Pharmaceuticals who has filed an action in the USA seeking damages for infringement of its patent relating to the use of its lipid nanoparticle technology in the mRNA COVID-19 vaccines.

Moderna is in a dispute with Canadian-based Arbutus Biopharma and its licensee, Genevant over six key patents relating to lipid nanoparticles that protect mRNA that Arbutus claims have been infringed by Moderna. In response, Pfizer's Canadian partner Acuitas Therapeutics counter-sued Arbutus.

That truce? Well, it was nice while it lasted!



by Dr Madelein Kleyni¹

File wrapper estoppel

Patent law differs in each country, but there are some important equitable doctrines that apply across borders. One such a doctrine is prosecution history estoppel.

The term Estoppel¹ is derived from the Middle French word *estoupail* and refers to the principle which precludes a person from asserting something contrary to what is implied by a previous action or statement of that person or by a previous pertinent judicial determination:

"the case had been one of estoppel" · "that fact is not sufficient to raise an estoppel"

File wrapper estoppel (also known as *prosecution history estoppel*) is an estoppel in patent law barring an applicant who has acquiesced in the rejection of a broad claim in the application for a patent, from later asserting that a claim deliberately more restricted, is equivalent to the original claim. Prosecution history estoppel thus acts as a limitation on the scope of a patent claim, preventing inventors from claiming monopoly over a space.

This doctrine limits the extent to which a patent can be broadened by the doctrine of equivalents.

Why is Prosecution History Estoppel relevant

The patent prosecution process is a form of conversation between the patent applicant or inventor and the patent examiner. The patent examiner will examine the patent claims and issue an office action(s) (or examination report) considering the relevant jurisdiction's patent law and objecting to the patent claims in application on various grounds available. The inventor then has the opportunity to respond to objections, arguing in favor of the patent claims as drafted, or to amend the patent claims to overcome the examiner's objections.

¹ Definitions are from the *Merriam-Webster's Dictionary of Law* ©1996

When drafting patent applications, it is important to think ahead and consider potential patent litigation. Patent lawsuits for infringement and validity inevitably considers the claims of the granted patent. The perfect patent application is extremely rare without further amendment and patent amendments are par for the course and virtually all complex inventions only receive grants after amendment, or at least significant arguments aiming at convincing a patent office examiner of the validity of the claims. As a consequence of this reality, it is important to consider the reasons and ways patent claims and specifications are drafted, and patent applicants should take care to limit potentially negative effects of narrowing statements and amendments in order ensure their patents are as broad as possible.

Patent amendments during the prosecution of the patent may include, adding a mistakenly omitted name of a co-inventor, amending patent specification to bring it into conformity with the patent act in each country where the application is filed; amending the claims to combine a dependent claim with an independent claim, to describe them more clearly, or to remove claims over unpatentable material, and amending the drawings to further illustrated the invention.

When amending patent applications, no new matter may be added, and claims may not be broadened. Patent applicants and inventors may also face restriction requirements from the patent examiner as a prerequisite to receiving their patent grant, which may further narrow the scope of the patent's claims.

In drafting the initial patent specification and claims it is essential to minimize the extent amendments may be necessary. These can be avoided by conducting a detailed prior art before drafting and submitting the patent application and to pay careful attention to the language used in the patent specification and claims, including whether nouns are plural and how structure, function, and relationships are described. Carefully consider the limitations you include in claims. Simple language like "A" or "an" may inadvertently mean "one," when you do not intend to write this limitation into the claims. The patent application will not only be read by the examining attorney - it will become part of the public record, searchable as prior art, and potentially subject to interpretation by a judge that does not necessarily have a technical background.

Paying equal, if not greater, attention to how eventual amendments may be read. Do not simply amend a patent to meet the examiner's requirements to have a patent granted but consider each amendment and argument strategically. Be careful not to create contradictory arguments in prosecuting the same patent in different jurisdictions. Amendments should be treated with the same care as the original patent application in terms of editing and review before submission. Before submitting an amendment consider whether there are foreseeable ways to draft amendment language that would broaden the scope of the proposed patent claims.

Remembering that all parts of the prosecution history are, after 18 months from date of filing, public record and will play into opposing counsel's arguments when raising

prosecution history estoppel as an affirmative defense to an infringement claim. Be deliberate in communications with the patent examiner when discussing the intention behind a patent application as well as the language used. Disclaimers made to the patent examiner regarding the intended scope of protection can be used later by defendants in infringement actions to prevent the patent owner from obtaining relief.

Prosecution history estoppel can act as a bar to enforcement of patent rights, it is important that patents and their amendments be drafted carefully. Always consider the ramifications of narrowing original patent claims before committing to a more limited invention than originally filed.

Application of the Doctrine of Patent Estoppel

Not all countries apply this doctrine. Some countries allow foreign patent prosecution history estoppel and others not. Some countries do not apply this doctrine at all. Below follows a brief overview of some of the jurisdiction's application of the file wrapper estoppel.

USA

The doctrine of file wrapper estoppel was developed in the case *Festo Corp. v. Shoketsu Kinzoku Kogyo Kabushiki Co.*, 128 S. Ct. 2903 (USA 2008) in the USA. File wrapper estoppel essentially means that when an inventor during prosecution narrows down his/her invention to escape prior art by some amendment, s/he cannot claim that someone else infringed his/her patent under the doctrine of equivalence.

The following are the two types of file wrapper estoppels:

1. **Amendment Estoppel** which functions to limit the doctrine of equivalents by preventing a patentee from capturing through equivalents subject matter surrendered during prosecution.
2. **Argument Estoppel** which means that unmistakable declarations to the USPTO in favour of patentability, whether or whether they were necessary to win acceptance of the claims, will prevent the patentee from receiving protection for the subject matter relinquished under the theory of equivalents. In *Caterpillar Tractor Co. v. Berco, S.p.A.*, 714 F.2d 1110, 1116 (Fed. Cir. 1983), the Federal Circuit noted that assertions made to foreign patent offices may also be considered for establishing the application of prosecution history estoppel. Representations to foreign patent offices should be considered where they contain relevant evidence." When a court considers comments made in a foreign prosecution:

- The statement was made in an official procedure in which the patentee had every incentive to be careful in describing the scope of its invention;
- the patents are related and/or contain an identical claim; and the remark had nothing to do with distinctive elements of foreign patent law.

The principle is thus well entrenched in US patent law.

Canada

Since December 13, 2018, the Canadian Patents Act expressly provides that patent prosecution histories are admissible as evidence in any action or proceedings respecting a patent. Section 53.1(1) reads as follows:

In any action or proceeding respecting a patent, a written communication, or any part of such a communication, may be admitted into evidence to rebut any representation made by the patentee in the action or proceeding as to the construction of a claim in the patent if

- (a) it is prepared in respect of
 - (i) the prosecution of the application for the patent,
 - (ii) a disclaimer made in respect of the patent, or
 - (iii) a request for re-examination, or a re-examination proceeding, in respect of the patent; and

- (b) it is between
 - (i) the applicant for the patent or the patentee; and
 - (ii) the Commissioner, an officer or employee of the Patent Office or a member of a re-examination board.

Europe

The scope of protection is defined in Article 69 EPC and the Protocol on the Interpretation of Article 69 EPC. It requires that reasonable protection must be afforded to the patentee and at the same time a reasonable degree of legal certainty must be provided to third parties. In Article 2 of the Protocol it is stated that due account shall be taken of any element which is equivalent to an element specified in the claims.

The doctrine of file wrapper estoppel is however applied differently in the EPO member states.

In the **Eli Lilly v. Fresenius Kabi AB v/Fresenius Kabi and Fresenius Kabi Oncology Plc.** Case different European courts considered this doctrine. This case concerned the infringement of Eli Lilly's patent EP 1 313 508B1.

Denmark

In relation to the question of infringement by equivalence, the Danish Maritime and Commercial High Court found that the decisive questions in this regard are:

- (1) whether the essential or significant part of the invention can be found in the alleged infringing product;
- (2) whether deviations only are less significant; and
- (3) whether the scope of the claims has been limited during the prosecution history against the prior art.

The Danish Maritime and Commercial High Court then went on to assess whether the prosecution file history eliminated a possible infringement by equivalence. The Danish Maritime and Commercial High Court stated that the change from “pemetrexed” to “pemetrexed disodium” was due to the EPO’s formality objection to added matter in accordance with Article 123(2) EPC, and that the objection did not relate to lack of novelty or inventive step.

UK

In 2016 in a UK Supreme Court decision in *Activis v Eli Lilly* Lord Neuberger effectively introduced the doctrine of equivalents and also referred to certain circumstances where it would be appropriate to consider prosecution history to assist in claim interpretation.

However, in 2018 in the *L’Oréal v RN Ventures* case² in response to a contention that the prosecution history of an application should be used to interpret the scope of protection, the UK Patents Court has recently observed that reference to the prosecution history is the exception and not the rule.

The Patents Court case in question was *L’Oréal v RN Ventures* before Mr Justice Carr. At the European Patent Office, L’Oréal obtained a patent directed to an apparatus for treating acne

Lord Neuberger had stated that reference to the prosecution file would only be appropriate in two circumstances where:

- the point at issue is truly unclear if one confines oneself to the specification and claims of the patent, and the contents of the file unambiguously resolve the point; or
- it would be contrary to the public interest for the contents of the file to be ignored.

Ireland

File wrapper estoppel does not apply. In the *Ranbaxy* – case³ the court ruled that reliance on the inventor or patentee evidence or arguments as to the construction of the claims is inadmissible.

Netherlands

Dutch law does not expressly recognise file wrapper estoppel. The Dutch Supreme Court⁴ has ruled that a defendant in infringement proceedings can derive arguments from the file wrapper.

² *L’Oréal Societe Anonyme & Anor v L’Oréal (UK) Ltd* | [2018] EWHC 391 (Ch) | England and Wales High Court (Chancery Division) | Judgment | Law | CaseMine

³ *Ranbaxy Laboratories Ltd & ors -v- Warner Lambert Company* [2005] IESC 81 (02 December 2005) (bailii.org)

⁴ *Dijkstra versus Saier Verpackungstechnik Gmbh & Co. Kg*, Supreme Court of the Netherlands. 22 December 2006. [Dijkstra vs. Saier: File wrapper estoppel \(ie-forum.nl\)](#)

Germany

File wrapper estoppel was introduced in German patent law in 2016. Formerly, was confirmed by the Federal court in the *BGH, judgment of 12.3.2002 – X ZR 43/01 – plastic pipe part; OLG Düsseldorf (lexetius.com/2002,247)* found that the determination of the conferral of protection of a patent does not depend on events in the grant procedure which preceded the grant of the patent and specifically that issues derived from prosecution history cannot be taken into account in the assessment of the scope of protection of a patent, even with regard to the requirement of legal certainty. The Federal Court of Justice ruled on 14 June 2016⁵ that arguments made during prosecution may indicate how the skilled person construes a patent claim but that such indications must not readily be relied on as the sole basis of claim construction.

Italy

In hearing the Eli Lilly case in Italy. The Court considered Article 52(3)bis of the Industrial Property Code, which requires that “to determine the scope of the protection granted by the patent, every element that is equivalent to an element indicated in the claims must be considered”

The court, based on file wrapper estoppel, found that it was unnecessary to enter into the merits of the issue, as the patent file history excluded infringement entirely. The court concluded that the applicant was bound by the description statements and the Claim 1 amendments during prosecution, which unambiguously referred only to the disodium salt, regardless of the reasons behind those statements and amendments.

Australia

File wrapper estoppel does not apply in Australia. In the *Bradken Resources Pty Ltd v Lynx Engineering Consultants Pty Ltd* [2015] FCA 1100⁶ case Judge Nicholas judgment reiterated the following:

1. Construction of patent claims under Australian law is ultimately a matter for the court.
2. Construction of patent claims may be assisted by evidence from a person skilled in the art and recourse may be had to earlier versions of the patent specification, to assist interpretation.
3. Whilst it needs to be borne in mind that foreign and domestic prosecution history may be used when interpreting the scope of US patent claims, there are considerable obstacles to applying the doctrine of file wrapper estoppel in Australia.
4. In view of these considerable obstacles, it is highly unlikely that the doctrine of file wrapper estoppel will be applied in Australia in the foreseeable future.

⁵ Urteil des X. Zivilsenats vom 14.6.2016 - X ZR 29/15 - (bundesgerichtshof.de)

⁶ *Bradken Resources Pty Ltd v Lynx Engineering Consultants Pty Ltd* [2015] FCA 1100 (20 October 2015) (austlii.edu.au)

South Africa

In the recent Bayer vs Villa Crop case⁷, the courts considered the doctrine of unclean hands in a patent infringement matter and a related application for further evidence. At issue in the application briefly was the allegation that Bayer had made certain representations during proceedings in various countries in the European Union when it applied for a Supplementary Protection Certificate (“SPC”) with reference to the active substance spirotetramat in respect of which Bayer now seeks to impose a monopoly in the pending action. Villa relied on the doctrine of unclean hands, which concerns the honesty of a party's conduct. It holds that where a party seeks to advance a claim that was obtained dishonestly or mala fide, that party should be precluded from persisting and enforcing such a claim. The matter landed in the constitutional court, where it was found by the majority of Constitutional Court, that the invocation of unclean hands doctrine was not reducible to the statutory claim for revocation but a distinct cause of action. It is the author's interpretation that the doctrine of file wrapper estoppel now applies in South Africa.

¹Madelein is the Chief Legal Officer of Omnicient (Pty) Ltd a company that protects consumer privacy by anonymizing and tokenizing personally identifiable information (PII) before sharing 1st party data sets in a secure, privacy-compliant and risk-free manner through their proprietary data platform. She is also the CEO and Founder of Mad K IP Consulting (Pty) Ltd. She is a registered patent attorney and RTTP and specialises in intellectual property commercialisation. She often authors academic and business articles and is the co-editor of the Lexis Nexis publication International Pharmaceutical Law and Practice. She is a director of LES SA and a Vice President of LESI. She is the past Chair of the LES International's Patent and Technology Licensing Committee.

⁷ [Villa Crop Protection \(Pty\) Ltd v Bayer Intellectual Property GmbH \(2005/00230\) \[2020\] ZACCP 2; 2021 BIP 1 \(COP\) \(14 October 2020\) \(saflii.org\)](#)



From the Juta Law Reports

The following judgments were reported September to December 2022

Patent – Procedure – Abuse of process – Doctrine of unclean hands in patent law in the context of an application for leave to appeal to the Constitutional Court – In the Court of Patents and subsequently the High Court, Villa Crop was refused permission to amend its particulars by introducing a special plea of unclean hands due to earlier statements by Bayer in European courts that were in direct contradiction to the case it was advancing here – Whether there exists a common-law doctrine of unclean hands that can deprive a plaintiff of its claim for patent infringement in the absence of a finding of the invalidity under the Patents Act – Bayer claiming that proposed special plea was an attempt at introducing a novel ground of revocation – Majority of Constitutional Court finding that Villa Crop's invocation of unclean hands doctrine was not reducible to the statutory claim for revocation but a distinct cause of action – Accordingly, the refusal of the Court of Patents to allow Villa Crop to introduce the special plea raised an arguable point of law of general public importance such that leave to appeal ought to be granted – Moreover, appeal should be upheld on ground that amendment ought to have been granted by Court of Patents – Order of the Court of Patents set aside and replace with one granting Villa Crop leave to amend by the introduction of its special plea. *Villa Crop Protection (Pty) Ltd v Bayer Intellectual Property GmbH* Constitutional Court case No CCT 237/21, Juta 2022 JDR 3648 (CC) (Unterhalter J for the majority of the court) 2022 December 8, 21 pages.

Trademark – Infringement – SOUL and SOUL FOOD by SOUL SOUVLAKI in food sector – High Court found no infringement but also dismissed counterapplication for removal of SOUL and SOUL FOOD for lack of distinctiveness – On appeal, Supreme Court of Appeal noted that only the word 'soul' was identical in the two marks and that 'souvlaki', which was at least as significant, was the only difference – According to the SCA, when the marks were directly compared, the word 'Souvlaki' clearly distinguished the respondents' mark from SOUL, such that the likelihood of deception or confusion was remote – Moreover, the fact that 'Soul' had social meaning beyond the distinctive meaning of the appellant's mark served to dilute any likelihood of confusion between the marks – Since the respondents' SOUL SOUVLAKI mark sufficiently distinguished their services from those of the appellant in the context of the restaurant and food sector, the appellant failed to establish infringement under s 34(1)(a) of the Trade Marks Act 194 of 1993. *Golden Fried Chicken (Pty) Ltd v Vlachos* Supreme Court of Appeal case No 497/2021, Juta 2022 JDR 3158 (SCA) (Gorven JA, unanimous), 2022 November 3, 9 pages.



Trademark – Distinctiveness – Shape mark – Shape mark in respect of a water bottle (see fig 1) – High Court having granted counterapplication for the cancellation of mark in respect of Tupperware’s pictured ‘Eco’ bottle for lack of distinctiveness – The High Court found that registered trade mark was neither inherently distinctive nor had acquired distinctiveness as from prior use, as envisaged in s 9(2) of the Trade Marks Act 194 of 1993 – Tupperware US and its SA branch appealing – Supreme Court of Appeal pointing out that since containers are not usually perceived to be source indicators, a container mark must, in order to be able to fulfil a trade mark function, at least differ significantly from the norm or custom of the sector – There were in addition considerable difficulties in the path of traders who contend that the shape of their goods itself has trade mark significance – SCA ruling that ‘Eco’ bottle not differing sufficiently from the norm or custom of the sector to be able to fulfil a trade mark function – In addition, the bottle as trademark faltered even on the low-threshold 'recognition and association' test – The High Court therefore correctly ordered cancellation – But Tupperware was able to establish that it had acquired goodwill deriving from the reputation it had built in respect of its Eco bottle since 2011 and that the similarities between it and the respondent’s bottle (see fig 2) meant that potential customers would perceive the respondent’s bottle to be a Tupperware bottle, with the result that the respondent was guilty of passing-off. *Dart Industries Incorporated and Another v Bottle Buhle Brands (Pty) Ltd and Another* Supreme Court of Appeal case No 636/2021, Jura 2022 JDR 3629 (SCA) (Makgoka JA, unanimous), 2022 December 1, 15 pages.

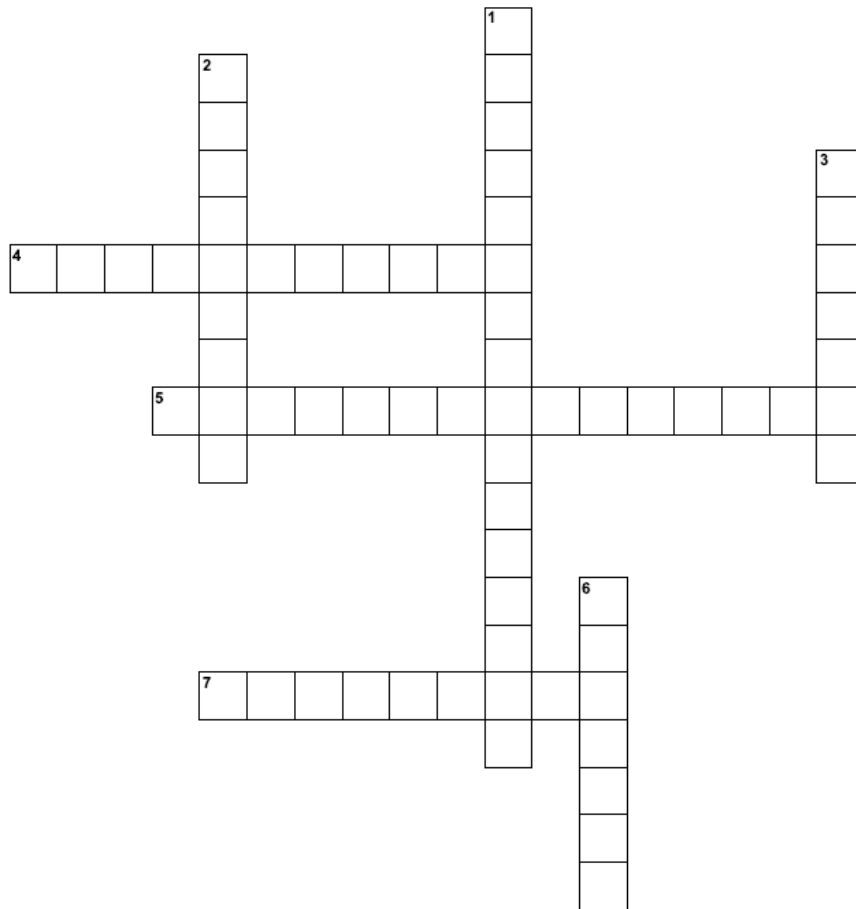


Figure 1



Figure 2

Intellectual Property Crossword puzzle



Across

[4] a type of intellectual property that comprise formulas, practices, processes, designs, instruments, patterns, or compilations of information that have inherent economic value because they are not generally known or readily ascertainable by others, and which the owner takes reasonable measures to keep secret

[5] is an American non-profit organization and international network devoted to educational access and expanding the range of creative works available for others to build upon legally and to share

[7] provides authors and creators of original material the exclusive right to use, copy, or duplicate their material

Down

[1] protects the shape, configuration, pattern or ornamentation of a product

[2] a symbol, word, or words legally registered or established by use as representing a company or product

[3] is a doctrine in United States law that permits limited use of copyrighted material without having to first acquire permission from the copyright holder

[6] a property right for an inventor that's typically granted by a government agency such as the Patent and Trademark Office

Sudoku challenge

					4			
							5	2
			2	5		4	1	
3	4		1		8	5		
	8						6	
		2	4		3		8	9
	3	1		7	2			
9	7							
			6					

5				8	6			1
		2	7		1	6		
	7	1				2	5	
9	1			2			7	
3			1	4	5			6
	6			9			2	4
	5	3				4	6	
		8	9		3	5		
2			5	1				7