

THE REGISTRAR OF PATENTS

South African patents 85/7642 and 86/1323

In the matter between:

MONSANTO COMPANY

Southern BY ADAMS
ADAMS

APPLICANT

and

MDB ANIMAL HEALTH (PTY) LTD

OPPONENT

IN THE MATTER of patent application for recordal of change of name and assignment against SA Patent Nos. 85/7642 and 86/1323, by Monsanto Company and opposition by MDB Animal Health (Pty) Ltd.

JUDGMENT

The applicant, Monsanto Company, a company duly incorporated in terms of the company laws of the United States (hereinafter to be referred as "the Applicant") of 800N Lindbergh Boulevardt, St Louis, Missouri, United States, filed on 24 January 2002 a request for the recordal of change of name of the patentee of SA Patents Nos. 85/7642 ("the 1985 patent"), and 86/1323/ ("the 1986 patent") and the subsequent assignment of these two patents.

The opponent MDB Animal Health (Pty) Ltd., duly incorporated in accordance with South African companies laws, (hereinafter to be referred

to as "the Opponent"), of Morningside, Gauteng, is opposing the application for recordal of the change of name and the subsequent assignment of the two patents.

The Applicant also avers that the Opponent does not have a *locus standi* in the matter.

During the hearing before the Registrar of Patents, Counsel for the Applicant submitted that he is no longer pursuing the *locus standi* of the Opponent, and the matter was accepted as such.

On 24 January 2002, the Applicant lodged with the Registrar of Patents, a letter, a form relating to assignment, a form relating to an extension of time for filing the assignment, a form calling for the recordal of a change of name and a form relating to an extension of time for recording the change of name for each of the two patents.

The Applicant avers that it relies on four documents that assignments and changes of name took place during 2000 and such documents are:

- a) the Intellectual Property Transfer Agreement of 1 September 2000;
- b) the Confirmation of Assignment dated 15 January 2002;
- c) the Assignment and Assumption Agreement dated 1 September 2000; and
- d) the Confirmation of Assignments of Patent Rights dated 16 May 2002.

The Opponent avers that no assignment took place because the alleged assignments were not in writing as required by section 60 of the Patents Act, (Act No. 57 of 1978). According to the Opponent, it is mandatory that the assignment must be in writing and failure to do that is as good as not

having an assignment at all. The Opponent submit that the requirement for an assignment of a patent in terms of section 60 of the Patents Act, is akin to the provisions of the Formalities of Sale of Land Act, No. 71 of 1969 as amended.

The first question to decide is whether or not an assignment of a patent must or may be in writing.

Section 60(1)(a) of the Patents Act read thus:

“An applicant for a patent or a patentee may in writing assign his rights in an application or patent to any other person”.

The correct reading of section 60(1)(a) is that the assignment may be in writing. It is not mandatory that the assignment must be in writing.

Section 60(1)(b) reads as follows:

“Upon application in the prescribed manner and a payment of the prescribed fee to the registrar, such assignment shall be recorded in the register”.

The requirement in this regard is that the assignment must be recorded in the register. This does not mean that the assignment itself must be in writing, but only that the assignment must be recorded in the register.

Section 60(1)(c) reads as follows:

“Unless such assignment is so recorded it shall not be valid, except as between the parties thereto”.

The correct reading of section 60(1)(c) is that the assignment which may or may not in writing must be recorded. If it is not recorded, it is only binding to the parties to the unwritten or written assignment. I must hasten to say that even if an assignment is written but not recorded in the register, it will only be valid *inter partes*.

In view of the above, one has to decide whether or not an assignment of "the 1985 patent" and "the 1986 patent" from Pharmacia Corporation to Monsanto (2) Company.

Having listened to all parties' arguments, I disagree with the submission of the Opponent's Counsel that no assignment ever took place. I am of the view that the assignment took place in accordance with the Intellectual Property Transfer Agreement of 1 September 2000. (**Record: P10**). The fact that Mr. George R. Beck initial erred in his founding affidavit does not assist the Opponent's Counsel. The mistake was rectified and nobody suffered any prejudice and it must be accepted as such.

The Applicant applied for the recordal of the assignment and a change of a name in accordance with the patents Act.

It is alleged that the patent expired on 21 February 1991 but the renewal fee was paid only on 6 March 1991.

The fact that the registrar's office accepted the payment of the renewal fee means that there was a condonation on the part of the registrar's office.

Having heard arguments of both parties in this matter, I come to the following conclusion:

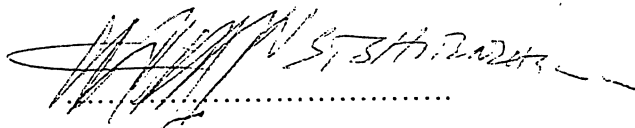
- a) that the Applicant's application for recordal of a change of name and assignment against South African Patents Nos. 85/7642 and 86/1323 succeed; and
- b) that Opponent's opposition is dismissed.

In view of the above, the following orders are made:

- a) the application for recordal of the change of the name of the patentee of SA Patent No. 85/7642 from Monsanto Company to Pharmacia Corporation succeed;
- b) the application for recordal of the change of name of the patentee of SA Patent No. 86/1323 from Monsanto Company to Pharmacia Corporation succeed;
- c) the change of name of the patentee of SA Patent No. 85/7642 from Monsanto Company to Pharmacia Corporation must be entered in the patent register against SA Patent No. 85/7642;
- d) the change of name of the patentee of SA Patent No. 86/1323 from Monsanto Company to Pharmacia Corporation must be entered into the patent register against SA Patent No. 86/1323;
- e) the application for the recordal of the assignment of SA Patent No. 85/7642 from Pharmacia Corporation to the new Monsanto Company succeeds;
- f) the application for the recordal of the assignment of SA Patent No. 86/1323 from Pharmacia Corporation to the new Monsanto Company succeeds;

- g) the assignment of SA Patent No. 85/7642 from Pharmacia Corporation to the new Monsanto Company is to be entered into the patent register against SA Patent No. 85/7642;
- h) the assignment of SA Patent No. 86/1323 from Pharmacia Corporation to the new Monsanto Company is to be entered into the patent register against SA Patent No. 86/1323.

No order as to costs is made and each party is to bear its own costs.



NETSHITENZHE MM
REGISTRAR OF PATENTS
03 MARCH 2003