

PATENT EXAMINATION BOARD
SELECTED INT. PATENT LAWS
SYSTEMS, CONVENTIONS AND TREATIES – GROUP 2 (d)

25 June 2021

Time: 4 hours

EXAMINER: Mr Adelhart Krüger

MODERATOR: Mr Louis van der Walt

Answer **all** questions.

Total Marks: 200

Question 1

On 20 February 2021 you filed on behalf of your client a PCT application claiming priority from a South African provisional application dated 21 February 2020. The specification of your client's PCT application comprises 10 claims of which claim 1 is the only independent claim and claims 2 to 10 are directly or indirectly dependent on claim 1. On 1 June 2021 you received from the European patent office as International Searching Authority (ISA), an International Search Report (ISR) and a Written Opinion (W/O). The ISR and W/O cite prior art documents D1 and D2. Advise your client on a recommended next step (taking into account costs, a possible positive IPRP and preservation of rights) in each of the following separate cases. In your answer deal with the step, the reason(s) therefor, what documents need to be filed, with whom and the applicable time lines:

- 1.1 The only objection in the W/O is that claim 1 clearly lacks novelty over D1, but the W/O also indicates that by incorporating claim 2 into claim 1, this objection would be overcome. You and your client agree with this assessment;
- 1.2 The only objection in the W/O is that claim 1 lacks novelty over D1, but due to a misinterpretation, the examiner is wrong in this regard. You and your client agree that the objection would easily be overcome and a positive IPRP be obtained with suitable explanation and arguments;
- 1.3 The W/O acknowledges that all the claims are new, but there is an objection against claim 1 for lack of inventive step based on a problem solution approach and the disclosures in D1 and D2. The W/O indicates that an amendment to the claim may be required, but you and your client do not agree with this objection and view.

(14)

(12)

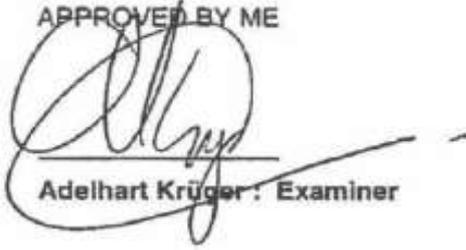
(4)

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| <p><u>Question 2</u></p> <p>Assuming that today you have lodged a response to a Rule 94(3) communication (official action) from an EPO examiner wherein you have assisted your client to bring her EPC application designating the United Kingdom (UK), Germany (DE), the Netherlands (NL), and Spain (ES) into a form wherein the application meets all the requirements of the EPC, advise your client on further official communications that will issue and further steps to be taken and the deadlines (where applicable) for those steps until the patent is granted and validated in each of UK, DE, NL and ES. Also deal with possible third-party post-grant procedures.</p> | <p>(24)</p> |
| <p><u>Question 3</u></p> <p>3.1 a) Write a note on subject matter eligibility in the United States (US), that is what is patentable and what is not patentable in the US.</p> <p>b) In terms of the 2019 Revised Patent Subject Matter Eligibility Guidance, what test steps are applied by US examiners to determine whether a claim satisfies the criteria for subject matter eligibility?</p> <p>3.2 Set out the provisions of <u>only</u> the following sub-sections of 35 U.S.C. 102, namely 102(a)(1), 102(b)(1) and 102(b)(1)(A).</p> | <p>(10)</p> <p>(23)</p> <p><u>(17)</u></p> <p>(50)</p> |
| <p><u>Question 4:</u></p> <p>4.1 Write a note on Australian (AU) opposition proceedings dealing with when they are available, the period and grounds of opposition.</p> <p>4.2 On 1 February 2018, you filed a convention application in AU. When must examination be requested?</p> <p>4.3 A first official action issued on 1 May 2021 in an Australian application. By when must a response be filed?</p> | <p>(7)</p> <p>(4)</p> <p><u>(4)</u></p> <p>(15)</p> |

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| <p><u>Question 5</u></p> <p>Write a note on normal examination (formal and substantive) in Japan (JP) starting with the steps <u>after</u> filing the request for grant (i.e. do not deal with the filing requirements), but deal with examination, official actions, available appeals and applicable time periods and possible extensions thereof up to grant. (Do not deal with payment of fees and oppositions)</p> | (22) |
| <p><u>Question 6</u></p> <p>Briefly summarize the prosecution process of a convention patent application in China (CN) assuming that two official actions will issue before a decision to grant issues, also indicating when the issue fee must be paid and whether any third-party opposition is available.</p> | (18) |
| <p><u>Question 7</u></p> <p>Briefly summarize the prosecution process following filing of a convention patent application in India (IN) up to publication of grant.</p> | (20) |
| <p><u>Question 8</u></p> <p>On 1 February 2020, your client filed a PCT application with an English specification and now requires protection in both ARIPO and OAPI for the invention. In respect of a) ARIPO and b) OAPI write a separate note dealing with:</p> <ul style="list-style-type: none">i) next step to be taken and deadline for the step;ii) nature of the relevant regional system;iii) language;iv) substantive examination and when must it be requested;v) when do maintenance fees become payable; andvi) strategy to limit costs in each case. | (21) |

APPROVED BY ME



Adelhart Krüger: Examiner

APPROVED BY ME:



Louis van der Walt: Moderator