

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

26 June 2019

Time: 4 hours

EXAMINER: Mr Adelhart Krüger

MODERATOR: Mr Louis van der Walt

Answer **all** questions.

Total Marks: 200

<u>Question 1</u>	
1.1 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.	(10)
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?	(23)
1.2 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).	(17)
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<u>Question 2</u>	
Write a note on:	
a) normal examination in Japan (JP) (formal and substantive) starting with the request for grant (do not deal with the filing requirements) and dealing with the steps thereafter, including official actions, available appeals and applicable time periods and possible extensions thereof up to grant. (Do not deal with payment of fees and oppositions)	(22)

<p>b) in which circumstances can preferential examination be requested; and</p>	<p>(8)</p>
<p>c) what kind of applications qualify for accelerated examination.</p> <hr style="width: 40%; margin-left: 0;"/>	<p><u>(5)</u> 35</p>

<p><u>Question 3</u></p> <p>You filed corresponding convention patent applications for your client in the USA, China (CN), (JP), India (IN) and South Africa (ZA). The current status of each of the applications is as follows: in the USA, a first official action issued two months ago; in JP, substantive examination has not yet been requested; in IN, substantive examination has been requested; the ZA patent was granted at the end of last month and in CN, an adverse official action citing prior art comprising: a US patent; a United Kingdom (UK) patent; a technical paper in English; and a CN patent (no corresponding patent elsewhere) in Chinese issued last week. What action must be taken in respect of the CN official action in all the <u>other</u> countries and in respect of the ZA grant in all the <u>other</u> countries, also indicating deadlines where applicable.</p> <hr style="width: 40%; margin-left: 0;"/>	<p>(15)</p>
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<p><u>Question 4</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> <hr style="width: 40%; margin-left: 0;"/>	<p>(18)</p>
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<p><u>Question 5</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.</p> <p>_____</p>	<p>(24)</p>
<p><u>Question 6</u></p> <p>Briefly summarize the prosecution process following filing of a convention patent application in India (IN) up to publication of grant.</p> <p>_____</p>	<p>(20)</p>
<p><u>Question 7</u></p> <p>7.1 What is patentable and what is not patentable in a standard Australian (AU) patent?</p> <p>7.2 When must examination of an AU convention application be requested?</p> <p>7.3 Recently you received a first examiner's report dated 1 June 2019 in an Australian patent application which you are handling on behalf of one of your clients. Explain to your client the applicable future time scales to get the application in condition for acceptance.</p> <p>_____</p>	<p>(7)</p> <p>(5)</p> <p><u>(5)</u></p> <p>17</p>

Question 8

Exactly 23 months ago, you filed on behalf of your client, a provisional application which was later followed by a PCT application. The specification in the latter application comprises 15 claims of which claim 1 is independent, claim 2 is dependent on claim 1, claim 3 is dependent on claim 2, claim 4 is dependent on claim 3, claim 5 is dependent on claim 4 and claims 6 to 15 are directly or indirectly dependent on claim 5. Today, you received the ISR and W/O which indicate that claims 1 to 4 are not new, but that claim 5 is new and inventive. You and your client agree with the examiner's assessment, but your client requires a positive IPRP. Advise your client what steps should be taken and by when.

(7)**Question 9**

You have prepared a set of sixty-six claims for a client. In the set, claim 1 is an independent apparatus claim, claims 2 to 9 are directly or indirectly dependent on claim 1, claim 10 is an independent method claim and claims 11 to 29 are directly or indirectly dependent on claim 10, claim 30 is an independent apparatus claim and claims 31 to 44 are directly or indirectly dependent on claim 30, claim 45 is an independent method claim and claims 46 to 62 are directly or indirectly dependent on claim 45. There are various multiple dependencies amongst the dependent claims and claims 63 to 66 are omnibus claims. Write a note on how this set may be customized for and optimized in terms of cost, for filing in each of ZA, AU, JP, USA and under EPC and give brief reasons for your answers.

(14)