

**PATENT EXAMINATION BOARD**

**SELECTED INTERNATIONAL PATENT LAWS,  
SYSTEMS, CONVENTIONS AND TREATIES – GROUP 2 (d)**

**11 September 2020**

**Time: 4 hours**

**EXAMINER:** Mr Adelhart Krüger

**MODERATOR:** Mr Louis van der Walt

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Answer **all** questions.

Total Marks: 200

This paper consists of 5 pages including the cover page.

**WRITE LEGIBLY**

**Question 1**

On 20 April 2020 you filed on behalf of your client a PCT application claiming priority from a South African provisional application dated 21 April 2019. 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 29 August 2020 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;

(14)

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;

(12)

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.

(4)**(30)****Question 2**

2.1 Write a note on the prosecution of an Australian (AU) convention patent application, starting with filing through to grant and assuming that at least one official action will issue. Do not deal with filing requirements, but deal with renewal fees that may be payable.

(19)

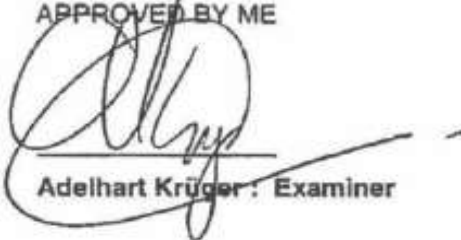
<p>2.2 Are excess claim fees payable in AU and if so, at what time and under what circumstances?</p>	<p><u>( 5)</u> <b>(24)</b></p>
<p><b><u>Question 3</u></b></p> <p>Your client made an invention and he caused it to be disclosed in an article in a Japanese (JP) journal. There is huge interest in the invention in Japan, Europe, Canada, Australia and JP and your client wants to obtain patent protection in these jurisdictions. Advise your client whether this would be possible in each of the above jurisdictions, what steps need to be taken and by when, if the journal was published on:</p> <p>3.1 8 October 2019; and</p> <p>3.2 15 May 2020.</p>	<p>(16) <u>( 7)</u> <b>(23)</b></p>
<p><b><u>Question 4</u></b></p> <p>4.1 Write a note on the procedure before the European Patent Office (EPO) from filing of a convention application in terms of the European Patent Convention (EPC) until issuance of a rule 71(3) Communication (“Decision to grant”). Assume that at least one official action will issue from the EPO. Do not deal with the filing requirements or accelerated procedures.</p> <p>4.2 What are the main differences between your answer to question 4.1 and the procedure in a Euro-PCT application (European regional phase of a PCT application) wherein the EPO also acted as the international searching (ISA) and examination authority (IPEA)?</p> <p>4.3 What are the main differences between your answer to question 4.1 above and the procedure in a Euro-PCT application wherein the USPTO (and not the EPO) acted as the ISA and the IPEA?</p>	<p>(18)  ( 8)  <u>( 8)</u> <b>(34)</b></p>


<p><b><u>Question 5</u></b></p> <p>Briefly summarize the prosecution process following filing of a convention patent application in India (IN) up to publication of grant.</p>	<p><b>(20)</b></p>
<p><b><u>Question 6</u></b></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>	<p><b>(18)</b></p>
<p><b><u>Question 7</u></b></p> <p>7.1 You have filed a USA patent application claiming two distinct inventions. The USPTO has issued a restriction action setting a response deadline of 15 November 2020. Advise your client on how to go about procuring protection for both inventions claimed and indicate any deadlines that must be met.</p> <p>7.2 What is patentable in the USA?</p> <p>7.3 You have just received a further official action in a US application for a patent which you are prosecuting on behalf of your client. The action is marked FINAL. List the options for responding to the action available to your client.</p> <p>7.4 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>( 6)</p> <p>(10)</p> <p>( 7)</p> <p><u>(16)</u></p> <p><b>(39)</b></p>

**Question 8**

Your client is the applicant of a South African provisional application with priority date of 30 September 2019. Your client wants relative urgent protection in the following countries only: Zambia, Botswana, Namibia, Uganda, Rwanda and Zimbabwe. Due to time and cost considerations, your client does not want to file a PCT application or national applications in the countries concerned. Advise your client on another reliable and cost-effective approach to obtain protection in the above countries. Do not deal with the filing requirements, but explain to your client the procedure from filing until publication and grant. Assume one official action will issue and that it will be overcome by you and your client.

**(12)**

APPROVED BY ME  
  
Adelhart Krüger: Examiner

APPROVED BY ME:  
  
Louis van der Walt: Moderator