

PATENT EXAMINATION BOARD
SELECTED INT. PATENT LAWS
SYSTEMS, CONVENTIONS AND TREATIES – GROUP 1(d)

July 2015

Time: 4 hours

EXAMINER: Mr A Krüger

MODERATOR: Mr G Kotze

Answer **all** questions.

Total Marks: 200

Question 1

In your client's PCT application, you received a negative Written Opinion ("W/O"). However, it is possible to overcome the objections in the W/O by incorporating the matter of claim 2 into claim 1, cancelling claim 2 and having claims 3 to 9 unchanged. Your client has instructed you to demand international preliminary examination and to file a response to overcome the objections as well as to add a new claim 10, basis for which can be found on page 10 lines 1 to 5 of the specification as filed. Write a note on the requirements for your response with emphasis on what must be communicated to the IPEA.

(13)

Question 2

Write a note on substantive examination procedure in Japan (JP). Deal with a) normal examination following on filing a convention application in JP (filing requirements must not be dealt with), including official actions and available appeals and also referring to applicable time periods and possible extensions therefor; and b) under what circumstances is preferential examination available and who may request same.

(36)

Question 3

Compare opposition proceedings in Australia, the EPC and JP with reference to when the proceedings are available, time period for and in each case three (3) grounds of opposition, including whether entitlement by the applicant is a ground.

(21)

Question 4

Your client has filed a PCT application in the English language having 20 claims, claiming priority from a ZA provisional application (also in English) and designating all member countries and extension states of the EPC. In the PCT application, the EPO was designated as ISA and IPEA. The IPRP noted a number of deficiencies in the specification and claims. After the international phase of the PCT application, your client instructed you to enter the regional phase in Europe with the view of obtaining patent protection in some member countries and extension states. Write a note on the entering, filing requirements (do not deal with information required on prescribed forms), fees payable and procedure with relevant deadlines or time periods until receipt of a communication under Rule 71(3) (EPC) informing client of the text in which the EPO intends to grant a European patent. You may assume that no official actions in terms of Rule 94(3) will issue before the above Rule 71(3) communication.

(22)

Question 5

Compare the two tier fee systems in each of USA, Canada and India, clearly distinguishing the two tiers from one another in each case.

(15)

Question 6

On behalf of your client you entered the national phases in USA, Japan (JP), India (IN) and China (CN) following a PCT application, which claimed priority from a South African provisional application which was filed on 10 April 2011. The current status of the applications is as follows: in the USA a first official action issued on 12 May 2015 and you have not yet responded to it; in each of JP, IN and CN substantive examination has been requested and on 20 May 2015, an adverse first official action issued in the CN application citing prior art comprising a US patent, an Australia (AU) patent, a technical paper in English and a Korean (KR) patent in Korea. Save for responding to the US and CN actions in the respective countries, what further action must be taken in respect of the USA action and the CN action in each of the countries, also indicating deadlines, if applicable.

(26)

Question 7

List the filing requirements for a convention patent application in China.

(12)

Question 8

Briefly summarize the prosecution process following filing of a convention patent application in India (IN).

(15)

Question 9

9.1 Your South African (ZA) client made an invention during September 2014. On 1 October 2014, he disclosed the invention in an article in a printed ZA

publication. Your client advises you that the same invention was independently made by a German inventor, who immediately thereafter in November 2014 disclosed it in the German language in a printed publication in Germany (DE). Your client consults with you today for the first time and wants to know whether he can still file applications in respect of his invention in the following countries/regions and give brief reasons for your answers:

9.1.1 Europe (EP)

9.1.2 Australia (AU)

9.1.3 India (IN)

9.1.4 Japan (JP)

9.1.5 China (CN)

9.1.6 Canada (CA)

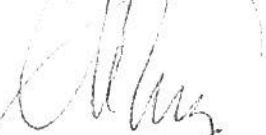
9.1.7 USA

(24)

9.2. What would the situation have been, were it not for the disclosure in DE?

(16)
200

APPROVED BY ME



Adelhart Krüger : Examiner

APPROVED BY ME:



Gavin Kotze: Moderator