

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

July 2016

Time: 4 hours

EXAMINER: Mr A Krüger

MODERATOR: Mr L van der Walt

Answer **all** questions.

Total Marks: 200

Question 1

- 1.1 Your South African (ZA) client made an invention during October 2015. On 1 December 2015, he disclosed the invention in a paper he delivered at a public conference in London. Your client advises you that the same invention was independently made by a Japanese inventor, who immediately thereafter in January 2016 disclosed it in the Japanese language in a printed publication in Japan (JP). 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: **(24)**
- 1.1.1 Europe (EP)
 - 1.1.2 Australia (AU)
 - 1.1.3 India (IN)
 - 1.1.4 Japan (JP)
 - 1.1.5 China (CN)
 - 1.1.6 Canada (CA)
 - 1.1.7 USA.
- 1.2 What would the situation have been, were it not for the invention by the JP inventor and the disclosure in JP? **(16)**
- 40**
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Question 2

On 1 October 2015 you filed a PCT application on behalf of your client in respect of his invention relating to an automatic swimming pool cleaner. The PCT application claims priority from a South African (ZA) provisional application dated 1 October 2014. Claim 1 of the PCT application relates to "Apparatus for cleaning a swimming pool". Claims 2 to 9 are dependent on claim 1. A search report and written opinion ("W/O") issued on 2 February 2016. The W/O indicates that claim 1 is not new, but that claims 2 to 9 meet the requirements for novelty, inventive step and industrial applicability.

(21)

Today, you are consulting with your client and your client instructs you to take the matter forward and to work towards a positive International Preliminary Report on Patentability ("IPRP"). Your client confirms that the matter of claim 2 must be incorporated into claim 1. Client also wants you to add a further dependent claim, basis for which can be found on page 7 lines 20-25 of the PCT specification as filed. Advise your client on the next steps to be taken, including applicable time periods, and the documents to be submitted, including to whom they must be submitted.

Question 3

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.

(27)**(9)****36**

Question 4

- 4.1 What is patentable and what is not patentable in a standard Australian patent? (7)
- 4.2 When must examination of an Australian convention application be requested? (5)
- 4.3 Recently you received a first examiner's report dated 1 June 2016 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. (5)
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- 17

Question 5

- 5.1 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"). Do not deal with the filing requirements or accelerated procedures. (19)
- 5.2 What are the main differences between your answer to question 5.1 and the procedure in a Euro-PCT application (European regional phase of a PCT application) wherein the EPO also acted as the international searching authority. (8)
- 5.3 What are the main differences between your answer to question 5.1 above and the procedure in a Euro-PCT application wherein the USPTO (and not the EPO) acted as the ISA and the IPEA. (8)
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- 35

Question 6

- List the filing requirements for a convention patent application in China. (12)
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Question 7

Briefly summarize the prosecution process following filing of a convention patent application in India (IN). (14)

Question 8

8.1 Distinguish in principle between the intrinsic patentability requirements/ definitions in the European Patent Convention (EPC) and in the USA Patents Act. (4)

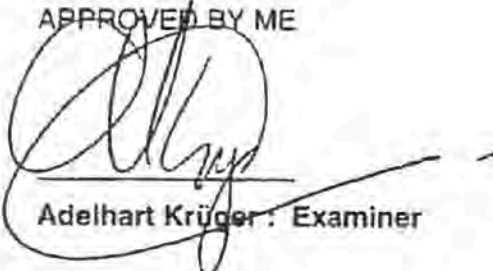
8.2 What is patentable in the USA? (10)

8.3 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. Your client wants to proceed with the application. Explain to your client the available next steps and applicable time periods, if in the action there are:

a) only a few minor objections which require no amendment and wherein argument or remarks would suffice to overcome the final action; and (6)

b) a number of serious and well founded objections to which substantive claim amendments are required. (5)

APPROVED BY ME



Adelhart Krüger: Examiner

APPROVED BY ME:



Louis van der Walt: Moderator