

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

27 June 2018

Time: 4 hours

EXAMINER: Mr A Krüger

MODERATOR: Mr L van der Walt

Answer **all** questions.

Total Marks: 200

<u>Question 1</u>	
1.1 You have filed a USA patent application claiming two distinct inventions. The USPTO has issued a restriction action setting a response deadline of 15 August 2018. Advise your client on how to go about procuring protection for both inventions claimed and indicate any deadlines that must be met.	(6)
1.2 What is patentable in the USA?	(10)
1.3 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.	(7)
1.4 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).	<u>(7)</u> (30)

<p><u>Question 2</u></p> <p>Your South African (ZA) client made an invention during October 2017. On 1 December 2017, he disclosed the invention in a paper he delivered at a public conference in Munich. 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 each of Canada, Europe and USA and give brief reasons for your answers.</p> <hr/>	(11)
<p><u>Question 3</u></p> <p>You are acting for a client in a pending PCT application comprising 10 claims. Claim 1 is an independent claim and claims 2 to 10 are dependent on claim 1. Client recently, and at 16 months from the earliest priority date, received a WO raising well-founded objections to the novelty of claim 1, but client and you are confident that any objection to claim 1 would be overcome by incorporating the matter of current claim 6 into current claim 1. Client instructs you not to file an Art 19 amendment, but to take the necessary steps to convert the negative WO into a positive IPRP. Advise client what steps should be taken and by when, including what documents must be filed and their relevant contents, to achieve the above objective.</p> <hr/>	(20)
<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>	(7)

<p>4.2 On 1 February 2015, you filed a convention application in AU. When must examination be requested?</p> <p>4.3 A first official action issued in the above application. By when must a response be filed?</p> <hr/>	<p>(4)</p> <p>(4)</p> <p>(15)</p>
<p><u>Question 5</u></p> <p>Write a note on normal examination in 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.</p> <hr/>	<p>(25)</p>
<p><u>Questions 6</u></p> <p>6.1 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.</p> <p>6.2 What are the main differences between your answer to question 6.1 and the procedure in a Euro-PCT application (European regional phase of a PCT application) wherein the EPO also acted as the international searching and examination authority.</p>	<p>(18)</p> <p>(8)</p>

<p>6.3 What are the main differences between your answer to question 6.1 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>_____</p>	<p>(8) (34)</p>
<p><u>Question 7</u></p> <p>Briefly summarize the prosecution process following filing of a convention patent application in India (IN).</p> <p>_____</p>	<p>(20)</p>
<p><u>Question 8</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> <p>_____</p>	<p>(18)</p>
<p><u>Question 9</u></p> <p>Reproduce the table below in your examination paper and complete the table according to the example in the first row by indicating “Y” (for YES) and “N” (for NO) whether the conventions in the first column are designatable in PCT, has absolute novelty requirements, is a supranational system and is a designation system.</p>	<p>(16)</p>

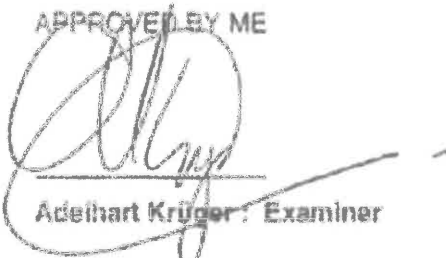
	Designatable in PCT	Absolute Novelty	Supranational	Designation System
EPC	Y	Y	N	Y
ARIPO				
OAPI				
GCC				
EURASIA				

Question 10

Your client wants to disclose an invention relating to a new and inventive security system on 1 August 2018 and requires protection in various countries including Argentina, Australia, Canada, China, countries of the EPC, India, Japan, South Africa, Taiwan and the USA. Advise your client on a cost-effective filing strategy to start obtaining patent protection in the aforementioned countries:


(11)

APPROVED BY ME



Adelhart Krüger: Examiner

APPROVED BY ME:



Louls van der Walt: Moderator