

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

1 July 2022

**Time:** 4 hours

**EXAMINER:** Mr Rory Moore

**MODERATOR:** Mr Louis van der Walt

Answer **all** questions.

Total Marks: 200

**Question 1**

Write a note on Unitary Patents (UP) and the proposed Unified Patent Court (UPC) dealing with their current legal status, the nature of the UP, how a UP may be obtained, and the jurisdiction and “opt out” provisions of the UPC. Also discuss possible benefits and risks of a UP compared to a traditional European patent.

**(38)**

**Question 2**

Reproduce the following two tables 2 (a) and 2 (b) in your answer paper and complete them according to the example given for South Africa, by inserting one of the given symbols into each empty table cell. The meaning of each symbol is given in brackets. Ensure that your answers reflect all recent law changes.

**TABLE 2 (a)**

*(See next page)*

**Symbols for Table 2 (a):**

Insert one of the following symbols into each empty cell of Table 2 (a) in your answer paper:

- Y** (= Yes)
- N** (= No)
- ▲** (= Encouraged “wherever appropriate”)

**Table 2 (a)**

Patent Office	Multiple Dependent (MD) Claims			Two-Part Claim Form Required?	Reference Numbers Required in Claims?	Omnibus Claims Allowed?	1-Year Grace Period for Novelty?
	MD claims allowed?	MD dependent on MD allowed?	Fee Multiplier**				
South Africa	Y	Y	N	N	N	Y	N
USA							
EPO*							
China							
Japan							

(28)

\* EPO = European Patent Office

\*\* "Fee multiplier" refers to an additional fee payable for each additional claim mentioned in the dependency statement of a multiple dependent claim.

**TABLE 2 (b)**

Symbols for Table 2 (b):

Insert one of the following symbols into each empty cell of Table 2 (b) in your answer paper:

**Y** (= Yes)

**N** (= No)

● (= Depends on the national law of each country)

**Table 2 (b)**

Patent Office	Designatable in PCT?	Absolute Novelty Required?	Supranational Patent?	Methods of treatment patentable?
EPO				
ARIPO				
OAPI				

(12)

(40)

**Question 3**

Describe the normal examination procedure in Japan (JP) following on filing a convention application in JP, including official actions, available appeals and also referring to applicable time periods and possible extensions therefor. Do not deal with opposition or Trials for Invalidation.

**(26)****Question 4**

Answer **EITHER** Question 4A **OR** Question 4B:

**4A:** You have filed and are prosecuting an application for a patent under the European Patent Convention (EPC) at the European Patent Office (EPO) on behalf of your client. Assuming that you have successfully addressed all outstanding objections and rejections raised in a recent official action, your client now requires your advice on future steps to be expected and undertaken and their deadlines, until the patent that will be granted is validated in each of Great Britain (GB), Spain (ES) and the Netherlands (NL).

**OR**

**4B:** On 1 July 2022 you enter the national phase in India (IN) of a PCT application that you filed on behalf of your client. The IN application has an earliest priority date (epd) of 1 January 2020. Your client consults with you and asks you to explain the main aspects of the prosecution and possible opposition procedures in IN.

**(17)**

**Question 5**

On 22 February 2022 you filed on behalf of your client a PCT application claiming priority from a South African provisional application dated 23 February 2021. 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 1 June 2022 you received from the European patent office as International Searching Authority (ISA), an International Search Report (ISR) and a Written Opinion (WO). The ISR and WO 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:

- 5.1 The only objection in the WO is that claim 1 clearly lacks novelty over D1, but the WO also indicates that by incorporating claim 2 into claim 1, this objection would be overcome. You and your client agree with this assessment; (14)
- 5.2 The only objection in the WO 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)
- 5.3 The WO 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 WO 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 6**

Your client is the applicant of a South African provisional patent application having a priority date of 30 September 2021. Your client wants protection in the following countries only, Malawi, Mozambique, Namibia, Uganda, Zambia 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. Ensure that advice takes account of recent law changes.

(12)

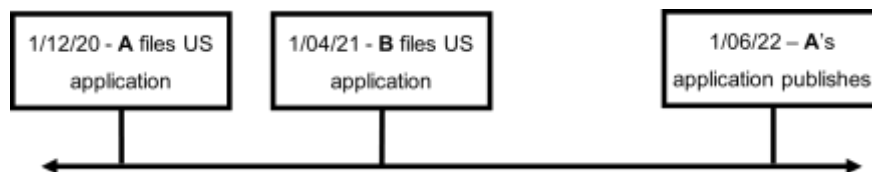
**Question 7**

7.1. Set out the provisions of only the following subsections of 35 USC 102, namely 102(a)(1), 102(a)(2), 102(b)(1) and 102(b)(1)(A).

(21)

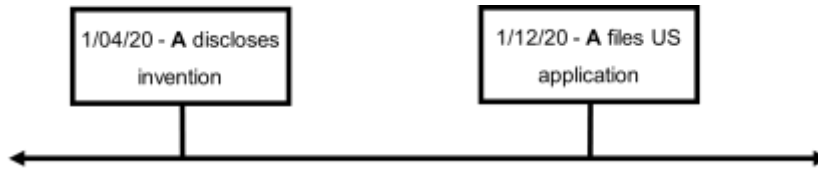
7.2. Consider each of the following separate scenarios and give your answers based on the conditions for patentability under 35 USC 102, assuming all other requirements for patentability are met:

7.2.1. Inventor **A** filed a US patent application on 1 December 2020. Inventor **B** filed a US application for the same invention on 1 April 2021. **A**'s US application was published on 1 June 2022. Can **B** get a patent? State the applicable subsection/s of 35 USC 102.



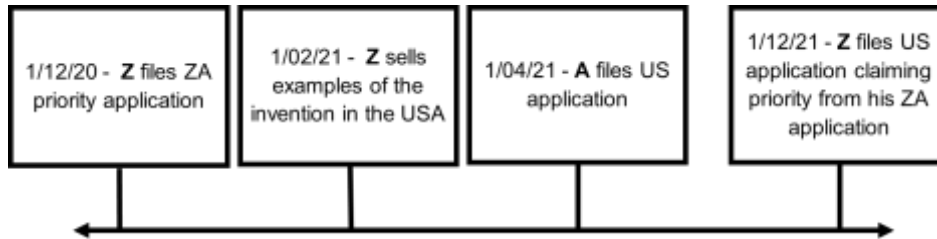
(2)

7.2.2. Inventor **A** disclosed an invention on 1 April 2020 and filed a US patent application for it on 1 December 2020. Can **A** get a patent? State the applicable subsection/s of 35 USC 102.



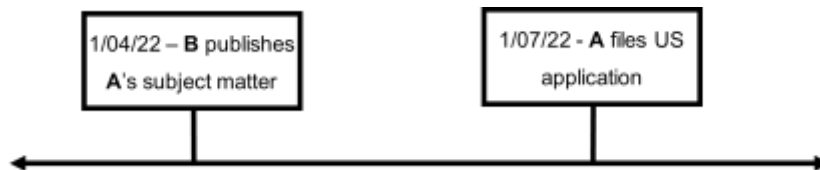
(2)

7.2.3. Inventor **Z** filed a ZA provisional patent application on 1 December 2020, then sold examples of his invention in the United States on 1 February 2021. On 1 December 2021, **Z** filed a US patent application claiming priority from his ZA application. Meanwhile, Inventor **A** had independently developed the same invention and filed a US application for it on 1 April 2021. Can **Z** get a patent? Explain your answer with reference to 35 USC 102(a)(1).



(3)

7.2.4. Inventor **B** published certain subject matter on 1 April 2022. Subsequently, on 1 July 2022, Inventor **A** filed a US patent application for the same subject matter. **B** had obtained the subject matter from **A**. Can **A** get a patent?



(2)

(30)

**Question 8**

Write a note on Australian (AU) opposition proceedings dealing with when they are available, the period and grounds of opposition.

(7)