PATENT EXAMINATION BOARD

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

27 JUNE 2025

09h00 – 13h00

Examiner: K. Barnard

Moderator: K.C. Truter

Time: **4 Hours**

Total marks: **200**

This paper consists of **6** pages

(including this cover page and an answer sheet for Question 1)

Instructions:

- Answer **all** questions.
- Write legibly.

Question 1 Refer to the Answer Sheet appended to the end of this question paper. Complete Tables 1A and 1B by inserting one of the given symbols into each empty table cell. An example row is given for South Africa. Remember to detach your completed Answer Sheet from the question paper and enclose it in your answer book.	**[20]**
Question 2 On 5 February 2025, on behalf of your client, you filed a PCT application claiming priority from a South African provisional application dated 5 February 2024. 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 2025 you received an International Search Report (ISR) and a Written Opinion (W/O) from the European Patent Office as International Searching Authority (ISA). 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 timelines: 2.1 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; 2.2 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; 2.3 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.	**[30]** **(14)** **(12)** **(4)**
Question 3 You have received a Rule 71(3) Communication from the EPO in respect of your client's European patent application. Your client wishes to obtain patent protection in France, Germany, the Netherlands, Portugal, Spain, Sweden, and the United Kingdom. Draft a brief note explaining the available options for obtaining protection in these countries after a decision to grant the application, the steps that must be taken following the Rule 71(3) Communication, and the relevant time limits and requirements for each option.	**[17]**

Question 4 In terms of 35 USC § 101, what subject matter is eligible for patenting in the United States?	**[6]**
Question 5 Briefly explain how a Continuation, a Continuation-in-Part, and a Divisional application differ from one another under United States patent law.	**[6]**
Question 6 A South African inventor publicly disclosed their invention at a conference in Cape Town on 10 March 2024. They filed a U.S. patent application on 5 March 2025. 6.1 Is this disclosure prior art under 35 USC § 102(a)? 6.2 Would § 102(b) provide an exception? 6.3 How would the outcome differ under EPC law?	**[6]** **(2)** **(2)** **(2)**
Question 7 Which of the following categories of subject matter are eligible for patenting in Japan (JP) and which are not? • Methods of treatment • Plant & animal varieties • Computer programs • A new use of a known foodstuff • Semiconductor chips • Beverages	**[6]**
Question 8 Your client filed a Japanese (JP) convention application on 1 June 2025. 8.1 When must examination be requested? 8.2 What are the two main types of official action which are issued by the Japanese Patent Office? 8.3 From which date are renewals calculated?	**[4]** **(1)** **(2)** **(1)**
Question 9 List the types of patent applications which would be suitable for accelerated examination in Japan.	**[6]**
Question 10 Your client wants to disclose an invention relating to a new and inventive security system on 1 August 2025 and requires protection in various countries including Argentina, Australia, Canada, China, countries of the EPC, India, Japan, South Africa, Taiwan and the USA. Advise	**[11]**

your client on a cost-effective filing strategy to start obtaining patent protection in the aforementioned countries.	
Question 11 Briefly summarise 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.	**[18]**
Question 12 On 1 July 2024 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 2022. Your client consults with you and asks you to explain the main aspects of the prosecution and possible opposition procedures in India. Your explanation must take into account the law changes which became effective on 15 March 2024. Include a discussion of the revised requirements and timelines for submitting Form 3 statements disclosing the particulars of corresponding applications filed outside India in terms of Section 8(1) of the Indian Patents Act.	**[22]**
Question 13 13.1 What is patentable and what is not patentable in a standard Australian (AU) patent? It is not necessary to discuss extrinsic legal requirements such as novelty, inventive step, or industrial applicability. 13.2 When must examination of an Australian convention application be requested? 13.3 What is the time limit to get the Australian application in order for acceptance? 13.4 At which point in time are excess claim fees payable?	**[16]** **(7)** **(5)** **(2)** **(2)**

Question 14 14.1 What subject matter that is excluded in other jurisdictions, is eligible for patenting in Canada? 14.2 What is the time limit for entering the National Phase into Canada? 14.3 When must examination be requested for a Canadian Patent Application?	**[12]** **(6)** **(4)** **(2)**
Question 15 15.1 Which regional African system provides for a single (supranational) patent that automatically covers all the member countries? 15.2 Name two regional systems which do not result in a single patent automatically covering all the member states but where designation is required.	**[3]** **(1)** **(2)**
Question 16 Your client is the applicant of a South African provisional patent application having a priority date of 31 August 2024. Your client wants protection in the following countries only, Botswana, Gambia, Mozambique, Namibia, 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.	**[12]**
Question 17 17.1 What law change relating to patent examination did the *Organisation Africaine de la Propriété Intellectuelle* (OAPI) introduce in 2023? 17.2 Excess fees may be payable for OAPI Applications in certain circumstances, name these circumstances and state when the excess fees are payable. 17.3 What is the time limit for National Phase entry into OAPI?	**[5]** **(1)** **(3)** **(1)**

APPROVED BY ME:

Keenan-Jay Barnard

30 May 2025

APPROVED BY ME:

K. Colin Truter: Moderator

30 May 2025

N.B. See next page for ANSWER SHEET for Question 1

ANSWER SHEET

For Question 1

Insert one of the given symbols into each empty table cell of Tables 1A and 1B below. An example row is given for South Africa.

N.B. *Detach your completed sheet from the Question Paper and enclose it in your answer book.*

TABLE 1A

Insert one of the following symbols into each empty cell of Table 1A in your answer paper:

- **Y** Yes
- **N** No
- ▲ Encouraged "wherever appropriate"

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

* **MD-MD** means a multiple dependent claim which is dependent on another multiple dependent claim

** **Fee Multiplier** means an additional fee payable for each additional higher-ranking claim mentioned in a multiple dependent claim

*** **EPO** means the European Patent Office (14)

TABLE 1B

Insert one of the following symbols into each empty cell of Table 1B in your answer paper:

- **Y** Yes
- **N** No
- ▲ Depends on the national law of each country

Patent Office	Can you designate this Patent Office in a PCT patent application?	Is Absolute Novelty Required?	Does this Patent Office provide a <u>supranational</u> Patent?	Are "Methods of Treatment" patentable at this Patent Office?
ARIPO				
EPO				
OAPI				

(6)