

PATENT EXAMINATION BOARD

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

26 JUNE 2026

09h00 – 13h00

Examiner: K. Barnard

Moderator: K.C. Truter

Time: **4 Hours**

Total marks: **200**

This paper consists of **9** pages including this cover page.

Instructions:

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

Question 1 [20]

Your client approaches you to discuss their new invention and their strategy for obtaining foreign patent protection. They want to secure patent rights in the following jurisdictions: USA, Europe, China, Argentina, DRC (Democratic Republic of Congo), Taiwan, and Venezuela.

Advise your client on the most practical strategic framework to achieve this. In your answer, explain the initial steps to secure priority and defer costs, and then detail the specific filing route (e.g., Direct, Paris Convention, PCT, or Regional) and relevant deadlines applicable for each of the requested jurisdictions. You may group jurisdictions with similar options.

Question 2 [4]

What are the two main benefits of filing a PCT Application?

Question 3 [4]

Distinguish between Article 19 amendments and Article 34 amendments (filed with a Chapter 2 demand) specifically regarding the allowable changes and the applicant's ability to address examiner objections.

Question 4 [27]

Your client filed a PCT application on 20 February 2026 with 10 claims and you received the International Search Report & Written Opinion from the Austrian Searching Authority on 24 June 2026. The priority date is 20 February 2025. Considering the different circumstances mentioned below, advise your client as to which option is best and give reasons for your advice. Provide the relevant deadlines on which to take the relevant actions. If you believe a scenario provides for more than one option, please indicate that this is so and provide your reasoning.

(a) The examiner has taken the view that the subject matter of claims 1 to 9 lack novelty and inventive step and that the subject matter of claim 10 is both novel and inventive. You agree with the examiner's findings. [9]

(b) The examiner has taken the view that the subject matter contained in all the claims is neither novel nor inventive. In particular, the examiner has specified that the subject matter contained in claim 3 can be found in cited document D1 – however, you notice that the examiner

has in fact erred in this finding and that the subject matter of claim 3 contains a strong technical feature that is not disclosed in the cited documents. [8]

(c) The examiner has taken the view that the subject matter of all the claims is novel, but that none involve an inventive step. You notice that the examiner's reasoning is potentially flawed and there are arguments to be made. However, you are not certain that these arguments will successfully overcome the examiner's objections. [10]

Question 5 [7]

With specific reference to the exceptions and inclusions in Australian patent law, list three types of subject matter that are notably patentable (types of inventions that are patentable in Australia despite not being patentable in other jurisdictions), and four types of subject matter that are unpatentable.

Question 6 [10]

- (a) When must examination of an Australian convention application be requested? [4]
 - (b) What is the time limit to get the Australian application in order for acceptance? [2]
 - (c) At which point in time are excess claim fees payable and what is the maximum number of claims allowed before excess claim fees are due? [3]
 - (d) In relation to the grant of an Australian Patent, when are renewals payable? [1]
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Question 7 [6]

List the types of patent applications which would be suitable for accelerated examination in Japan.

Question 8 [17]

Answer the following specific questions regarding the substantive examination and post-grant phases of a Japanese National Phase patent application (stemming from a PCT filing):

- (a) What are the requirements regarding requesting substantive examination, and what is the consequence if this is not done? [3]
- (b) The examiner issues a "Notification of Reasons for Refusal". Detail the standard deadline to respond and the specific extensions of time available to the applicant. [4]
- (c) Following the applicant's response, what are the three possible actions/decisions the examiner can issue? [3]
- (d) Detail the procedures and respective deadlines subsequent to a Decision to Grant, including opposition, revocation, and the subsequent judicial appeal route if the patent is invalidated. [7]
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Question 9 [3]

State the three official languages of the European Patent Office (EPO). Furthermore, briefly explain the translation requirement that an applicant must fulfil when accepting the text for grant in response to a Rule 71(3) communication.

Question 10 [4]

The EPC applies a standard of absolute novelty. Briefly explain whether the EPC provides for a general "grace period" for prior disclosures made by an inventor. State the two specific circumstances under Article 55 where a prior disclosure will not be taken into consideration and state the time limit for filing an application following such a disclosure.

Question 11 [18]

Your client filed a Euro-PCT application which proceeded to grant. The grant of the European Patent is published in the European Patent Bulletin today. The application was filed and prosecuted in English.

Your client instructs you that they are highly cost-conscious but require patent protection in the following countries: Germany, France, Italy, Spain, and the United Kingdom (UK).

- (a) Advise the client on whether a Unitary Patent (UP) can cover all the requested countries. Identify which of the requested countries can be covered by the UP and which cannot, providing brief reasons based on their status. [5]

(b) State the deadline to request a Unitary Patent, and contrast this with the general deadline for standard national validations under the EPC. [4]

(c) What are the specific translation requirements your client must meet in order to successfully request the Unitary Patent within the deadline? Provide a strategic recommendation on which language they should choose for the translation to save costs, based on the countries they wish to protect. [7]

(d) Assuming they choose the Unitary Patent for the eligible countries, how will renewal fees be paid compared to standard national validations, and why is this financially beneficial? [2]

Question 12 [3]

When filing an ARIPO patent application, at what stage must the member states be designated? Furthermore, state whether it is possible to add or remove designated states after the application has been filed.

Question 13 [3]

Following the rule changes that came into effect on 1 January 2022, what is the deadline to request substantive examination for an ARIPO patent application claiming priority, and from which date is this calculated? State the consequence of failing to meet this deadline.

Question 14 [4]

Regarding the drafting of the specification and claims for an ARIPO application, answer the following:

- (a) What is the required language of the patent specification? [1]
 - (b) What specific format must be used when drafting the claims? [1]
 - (c) Are reference numerals required in the claims? [1]
 - (d) At what threshold do excess claim fees become payable? [1]
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Question 15 [3]

Explain the fundamental nature of the OAPI patent system concerning the selection of member states and the resulting effect of the granted patent across its member countries.

Question 16 [4]

Important changes were introduced to the OAPI patent prosecution process in 2023. List three major procedural developments that occurred as a result of these changes. Furthermore, state the deadline for filing a pre-grant opposition under these new rules.

Question 17 [3]

State the deadline for filing an OAPI national phase application stemming from a PCT application. Furthermore, indicate the thresholds at which excess claims and excess page fees are incurred, and state exactly when these fees are payable.

Question 18 [4]

State the standard deadline for entering the Chinese National Phase from a PCT application and indicate whether any extensions of time are available. Furthermore, state the specific language requirement for the specification and the deadline for filing this translation.

Question 19 [4]

Your client's PCT application has received a completely positive International Preliminary Report on Patentability (IPRP) with no objections raised.

(a) How can your client use this positive IPRP to speed up prosecution during the Chinese National Phase? [2]

(b) The client is concerned that a competitor might try to file an opposition against their Chinese application before it grants. Advise your client on whether this is possible, and what alternative mechanism the competitor might use. [2]

Question 20 [3]

Section 3(d) of the Indian Patents Act contains a unique exclusion from patentability that creates significant difficulties for pharmaceutical and chemical inventions. Explain this exclusion regarding "known substances," and state the specific commercial practice this clause attempts to prevent.

Question 21 [7]

Important legal updates came into effect in India on 15 March 2024 regarding procedural deadlines and formalities.

(a) State the new deadline to request substantive examination. Furthermore, explain the practical implication this new deadline has for an applicant filing an Indian National Phase application stemming from a PCT application. [3]

(b) Prior to the 2024 amendments, applicants had to continuously update the Indian Patent Office regarding their foreign family applications. Under the new rules, in which three specific circumstances must an applicant file a Form 3 (Section 8) detailing their foreign applications?

[4]

Question 22 [3]

Under Canadian patent law, indicate whether the following types of subject matter are patentable or not patentable:

(a) A method of surgically treating a human patient. [1]

(b) A diagnostic method (that does not involve surgery or treatment). [1]

(c) A new and distinct plant variety. [1]

Question 23 [4]

Regarding the prosecution and drafting of a Canadian patent application, answer the following:

(a) What is the deadline to request substantive examination? [2]

(b) When amending claims for Canadian practice, which specific phrasing should be used to replace the European-style "characterized in that" language? [1]

(c) While a Canadian application is still pending, who is the only party authorised to validly pay the annual maintenance fees? [1]

Question 24 [2]

Although Canada applies an absolute novelty standard at the date of application, it does provide a grace period for prior disclosures. State the duration of this grace period and the specific condition regarding who must have made the disclosure for the grace period to apply.

Question 25 [21]

Your client's PCT application has received a positive International Preliminary Report on Patentability (IPRP) with no objections relating to novelty or inventiveness. The client now wishes to enter the United States National Phase.

The current PCT claim set contains 4 independent claims, 24 claims in total, and includes several multiple dependent claims.

(a) To avoid paying massive official penalty and excess claim fees upon filing in the USA, what three specific claim amendments/adjustments must you make to the claim set before or upon entry? [3]

(b) How can you utilize the positive IPRP to expedite the US prosecution? [2]

(c) The client anticipates developing improvements to their invention and wants to understand US "continuing" applications. Distinguish between a Continuation application, a Continuation-in-Part (CIP) application, and a Divisional application, specifically highlighting the trigger/purpose of each and whether new matter can be added. [6]

(d) Assume the application proceeds, but the examiner eventually issues a "Final Office Action." The client is panicked because they assume "Final" means the application is dead. Briefly explain whether a US Final Office Action is truly the end of the road, and list the specific procedural options the client has to respond and keep the application alive or move it forward.

[10]

Question 26 [12]

Your client is preparing to file a patent application in the United States and wishes to know if they qualify for reduced official fees based on entity size.

Provide all possible factors that would satisfy the requirements to qualify as:

(a) a small entity; and [5]

(b) a micro entity. [7]

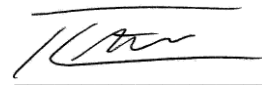
APPROVED BY:



Keenan-Jay Barnard

Date: 16 June 2026

APPROVED BY:



K. Colin Truter: Moderator

Date: 16 June 2026