THE JOINT EXAMINATION BOARD

PAPER P5

BASIC OVERSEAS PATENT LAW AND PROCEDURE

6th November, 1991

2.30 p.m. - 5.30 p.m.

Please read the following instructions carefully. This is a THREE HOUR Paper.

1. You should attempt no more than five questions.

2. The number of marks allotted to each question is placed in brackets at the end of the question.

3. Where a question permits of reasons being given for the conclusions reached, such reasons should be given.

4. Start each question (but not necessarily each part of each question) on a fresh sheet of paper and number it clearly in the margin. Write on one side of the paper only using BLACK ink. You must write your examination number and the designation of the Paper in the top right hand corner of the sheet. You must NOT state your name anywhere in the answers.

5. Unless specifically requested answers are NOT required in letter form.

6. NO printed matter or other written material may be taken into the examination room.

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6th November, 1991 - 2.30 p.m. - 5.30 p.m.

1. You act for a UK-based conglomerate which has recently made a major investment by purchase of a US-based but international cosmetics company. The US business of this company is expanding rapidly and to help supply this market, some products are made in Canada for sale both there and in the USA.

Write notes on:

a) 1) the novelty requirements in USA and Canada for a pharmacologically-active anti-wrinkle cream to be patentable,

2) the term of any patents obtainable,

3) export from Canada of the cream, which is made by a process the subject of a US patent, to the USA and Germany;

b) the protection which could be obtained for the appearance of an eyeliner applicator which an associate company has used for a different product in the UK and which has been advertised in women's magazines in Britain;

c) the protection which could be obtained for a computer program intended for stock-control in your client's warehouses in the USA and Canada.

(20 marks)

2. The patent law of a number of countries provides circumstances in which the novelty of an invention is deemed to be retained despite public disclosure of the invention before a patent application is filed.

State what those circumstances are in the case of Japan and Australia, including any grace periods which may be appropriate.

State, giving reasons, whether you would expect a US patent application claiming priority from a Japanese or Australian application made in the circumstances referred to, to mature into a valid US patent.

(20 marks)

3. Discuss the pros and cons from the point of view of a British applicant wanting protection in Britain, France, Germany, Italy and Spain of applying for a patent using the European Patent Office, both directly and by the PCT route, or using individual national patent offices.

(20 marks)

4. Write short notes on four of the following:

a) "Reduction to Practice" in the U.S.A;

b) "Modified Examination" in Australia;

c) "Re-examination" of a patent in the U.S.A;

d) The Community Patent Convention;

e) Gebrauchsmusters;

f) Opposition proceedings in the European Patent Office

(20 marks)

5. In 1990 you filed on behalf of your client a series of patent applications with identical claims in USA, Japan, Australia and at the EPO, designating Austria, Germany and Switzerland. The applications were based on a Swiss priority and, in addition to the designation of Switzerland in the European application, the Swiss national application was proceeded with. The US, Japanese and Australian applications have now been granted and the European application is about to enter into the national phase.

You receive in the mail a letter from your client, drawing attention to a document which he believes is relevant to the invention and which they have had in their possession since 1978. You confirm that the document is indeed relevant and that it anticipates claim 1, but none of the other claims, in all of the specifications.

Write a letter to your client advising him of the action you recommend.

(20 marks)

6. Review the implications for patent law behind the following recent decisions:

"Onco-mouse" (USA)

"Harvard mouse" (EPO)

Mobil Corporation - 2nd Chemical Use (EPO)

K K Toshiba (Overlapping Rangers) (EPO)

(20 marks)