

THE JOINT EXAMINATION BOARD

PAPER P5

BASIC OVERSEAS PATENT LAW AND PROCEDURE

17th November, 1993

2.00 p.m. - 5.00 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 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. In the appropriate boxes at the top of each sheet please enter the designation of the paper, the question number, and your Examination number. Write on one side of the paper only using BLACK ink. You must NOT staple pages together. 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.
7. Answers MUST be legible. If the examiners cannot read a candidate's answer no marks will be awarded.

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1. You write to your client, reminding him that the twelve-month priority period generated by a British patent application which you prepared for him expires in three months' time and asking for his instructions for any foreign filings. Your client responds that, before he can give instructions, and as this is the first of a number of such patent applications, he would welcome your general advice on the considerations he should bear in mind when constructing a geographical filing scheme.

Write a letter to your client in reply.

(20 marks)

2. (a) What are the essential elements of a declaration of priority according to the provisions of the EPC?

What measures can be taken if any of these essential elements are either

- (i) omitted
- (ii) incorrectly stated?

(5 marks)

- (b) What is the period allowed according to the provisions of the EPC for

- (i) filing a priority document
- (ii) filing a translation of the priority document, and under what circumstances is a translation required?

(5 marks)

- (c) Under what circumstances can a claim to priority be withdrawn in a European application?

(2 marks)

- (d) What provisions exist under the national law of

- (i) Germany
- (ii) Austria
- (iii) Switzerland

for the circumstance in which an applicant proceeds with national applications and a corresponding European application designating these countries (Double protection)?

(6 marks)

(e) Which of the following applications can form the basis of a valid priority claim under Article 87 (1) EPC.

- (i) a utility model application
- (ii) an ornamental design application
- (iii) an application for an inventors certificate?

(2 marks)

3. All parts of this question relate to PCT

(a) What can be done to prevent publication of an international application, and what conditions can be applied.

(4 marks)

(b) What can be done to delay publication of an international application?

(3 marks)

(c) Which three of the following countries are PCT members?

Brazil  
South Africa  
Canada  
India  
Saudi Arabia  
Malaysia  
Mexico

(3 marks)

(d) Write notes on

(i) Chapter I

(5 marks)

(ii) Entry of an international application into the National Phase in the European Patent Office

(5 marks)

4. Your client has designed a new plastics bottle for a shower-gel. The particular feature of the bottle which the client sees as important is the combination of a hook formed in the bottle allowing it to be hung upside down and of a translucent strip in the moulding allowing the level of gel remaining to be viewed by the user. Both of these features are known separately, but not in combination.

Write notes on the protection you judge would be obtainable in France, Germany, Italy and Spain. Do not discuss any aspects relating to design registration, copyright and unfair competition.

State the initial term of protection granted, where appropriate.

(20 marks)

5. What do you understand by five of the following terms used in US practice?

- (1) - best mode requirement
- (2) - reduction to practice
- (3) - continuation-in-part application
- (4) - an election requirement
- (5) - an interference
- (6) - a terminal disclaimer
- (7) - a re-issue

(20 marks)

6. Outline the major features of the patent law and procedure in Japan  
and

(12 marks)

utility model law and procedure in Japan

(8 marks)