

THE JOINT EXAMINATION BOARD

PAPER P5

BASIC OVERSEAS PATENT LAW AND PROCEDURE

16th November, 1994

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. Write short notes on the following aspects of European (EPC) law and practice.
 - (1) The time limit for giving notice of opposition to grant of a European Patent and for giving notice of appeal from any decision received. (4 marks)
 - (2) The grounds for opposition to grant of a European patent. (6 marks)
 - (3) Procedure before the Technical Board of Appeal, following a decision of the Opposition Division. (6 marks)
 - (4) The function of the Enlarged Board of Appeal. (4 marks)
2. (i) In the past, for a patent claim to be anticipated by a prior use in contrast to a prior published document, the use had to be "local", i.e., use in the country under consideration. Many countries have now modernised their law to require absolute novelty.

What is the position now:

 - (a) in the USA, and what conditions are attached.
 - (b) in Canada.
 - (c) what was the position in Canada in respect of a patent application filed in 1989.
 - (d) in Japan. (12 marks)
- (ii) What is meant by "a prior user right"? Which of the above countries acknowledge such a right. (8 marks)

3. (i) What are the similarities and differences between the US procedures of Re-examination and Re-issue. (8 marks)
- (ii) What are the provisions in the US patent law regarding products made by a patented process. (4 marks)
- (iii) Under what circumstances can a valid US patent be obtained when the invention has been published in a document before the filing of the application. (8 marks)
4. (i) What is meant by a "modified examination" in Australian practice. (5 marks)
- (ii) What is the term of a Japanese patent?
Within what period must the request for examination of a Japanese patent be filed?
What is the period for opposing a Japanese patent? (10 marks)
- (iii) What do you understand by the term "legalisation" of a document. Give an example of a document necessary for a patent application, which is required to be legalised. (5 marks)
5. Write brief notes on:
- (i) File-wrapper estoppel (USA) (5 marks)
- (ii) Discovery (USA) (5 marks)
- (iii) Chapter II of the PCT (5 marks)
- (iv) A Gebrauchsmuster (Germany) (5 marks)
6. Your client wishes to protect a mechanical device in the following countries:

FRANCE
GERMANY
ITALY
SPAIN
U.K.
U.S.A.

What are the relative advantages and disadvantages of using (a) the EPC or national routes to protection for the European countries (b) the PCT, in either case, for all the countries.

(20 marks)