

THE JOINT EXAMINATION BOARD

PAPER P5

BASIC OVERSEAS PATENT LAW AND PROCEDURE

16th November 1999

02.00 p.m. -05.00 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, reasons should be given for the conclusions reached.
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.
8. **NO** writing whatsoever, including number of papers, is allowed prior to the commencement of the examination or after it has finished.
9. Please put your answers in QUESTION NUMBER ORDER before placing in the envelope provided.

This paper consists of **six** pages including this page

Question 1

When the European Patent Office informs the applicant of the text in which it intends to grant the patent, there are various procedures that must be followed and actions to be completed within certain time limits at both the EPO and before the National Offices of the designated states.

Write an information sheet suitable for sending to clients which explains these procedures and gives an idea of the likely time scales. Your information sheet may include a flow chart. You do not need to include the values of any applicable fees.

(20 marks)

Question 2

Write notes on the following aspects of United States practice:

- (a) duty of disclosure requirements **(5 marks)**
- (b) re-issue procedure **(5 marks)**
- (c) provisional applications **(5 marks)**
- (d) terminal disclaimers **(5 marks)**

Question 3

On 1 April 1998 you filed a UK application for your client. Close to the first anniversary your client presented you with some new developments relating to this invention and you prepared a European application incorporating these developments. On 1 April 1999 you filed the European application designating GB, FR, DE, NL, SE, AT and IT and claiming the priority of the British application. You now receive the EPO search report. It lists the following applicable documents. Without considering the contents of these documents, write notes on the applicable principles to be taken into account when reporting the search report to your client. Include any actions to be taken and briefly outline future procedure. Also make a brief note of any further investigations you would undertake relating to the documents listed and why.

- (a) A European 'A' publication in French which gives a priority date of 8 April 1997 and a filing date of 7 April 1998. The publication date was 14 October 1998. The front cover of the publication gives FR, NL, AT and IT as the designated countries.
- (b) A PCT WO publication which gives a priority date of 31 March 1998, a filing date of 31 March 1999 and a publication date of 6 October 1999. The front cover of the specification indicates that at filing all available countries and regions were designated.
- (c) An abstract published in the Journal "Chemical Abstracts" on 6 August 1998. This abstract referred to the original paper which was in a Hungarian chemical journal dated March 1998.
- (d) A Derwent abstract of JP 112233/1999 which was filed on 17 October 1997 and published on 24 February 1999.

(20 marks)

Question 4

- (a) PCT procedure consists of two main phases. Write short notes on the 'International Phase' and the 'National Phase' mentioning any actions to be completed within certain time limits.

(6 marks)

- (b) Fees are payable in connection with the filing of PCT applications. Name these fees, state what they are payable for and to whom. Also state the date by which these fees are due for PCT applications which (i) make no priority claim and (ii) make a priority claim. What happens if the fees are not paid or not paid in full?

(8 marks)

- (c) (i) Where could a Dutch applicant/inventor living in Italy file a PCT application?

(ii) Where could a Taiwanese applicant/inventor living in Canada file a PCT application? What if he lived in Taiwan?

(iii) In relation to the naming of the applicant, what factors need to be taken into account when you are intending to file a PCT application which designates EP, CA, US, JP and AU at the UK Patent Office as Receiving Office?

(6 marks)

Question 5

For any two of the countries Australia, France and Germany make brief notes on:

- (i) kinds of protection available for new technically useful products and processes;
(6 marks)
- (ii) procedures for examination of national patent applications including reference to any relevant time limits;
(8 marks)
- (iii) opportunities for third parties to attack patent applications and/or patents including reference to any relevant time limits.
(6 marks)

Question 6

- (a) You reported to your client a communication under Rule 5 1(4) from the EPO proposing a text for grant. Your client writes back stating that (a) they seek to file two divisional applications and (b) they seek to make amendments to the claims proposed for grant. You consider your client's proposed amendments and note that they are quite substantial.

Write notes that will form the basis of a letter of advice to your client and which also identify any important points you need to bear in mind.

(10 marks)

- (b) You have reported a Rule 5 1(4) communication to your client who writes to tell you that the claims, while covering their product, do not cover a product just launched by their arch rival. You discover that there is basis for broader claims in the published application that will cover the rival's product. Advise your client how they could go about obtaining a patent which covers the rival's product.

(10 marks)