

THE JOINT EXAMINATION BOARD

PAPER P5

BASIC OVERSEAS PATENT LAW AND PROCEDURE

8 NOVEMBER 2004

2.00 P.M. – 5.00 P.M.

*Please read the following instructions carefully. Time Allowed – **THREE HOURS***

1. You should **attempt FIVE questions**. If more than five questions are answered, the first five will be marked and the sixth ignored.
2. Each question carries 20 marks. The marks attributable to individual parts of each question are shown.
3. Where a question permits, reasons should be given for the conclusions reached.
4. Please note the following:
 - Start each question (but not necessarily each part of each question) on a fresh sheet of paper.
 - Enter the Paper Number, the question number and your Examination number in the appropriate boxes at the top of each sheet of paper.
 - Write on one side of the paper only, within the printed margins using a **BLACK** pen.
 - **DO NOT** use coloured pens or highlighters within the answers – they will not photocopy.
 - **DO NOT** staple or join pages together in any way.
 - **DO 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. **ALL** mobile phones and electronic equipment **must be** switched off and stored away.
7. Answers **MUST** be legible. If the examiners cannot read a candidate's answer no marks will be awarded.

NO WRITING OF ANY KIND WILL BE PERMITTED AFTER THE TIME ALLOTTED TO THIS PAPER HAS EXPIRED. At the end of the examination assemble your answer sheets in question number order and place in the WHITE envelope provided.

This paper consists of five pages, including this page.

Question 1

Who may apply for a European Patent? The EPC provides a non-exhaustive list of subject matter that is not patentable as such. Give three examples.

[2]

Briefly explain the concept of an enabling disclosure under the EPC.

[2]

Explain the approach taken by the EPO to the assessment of inventive step.

[4]

You receive an Examination Report from the EPO dated 30-10-2004 and setting a time limit of 4 months to reply. When is the normal deadline for responding? (Ignore Saturdays and Sundays).

[1]

You fail to respond in time. What is the legal consequence?

[1]

What does the EPC require for Further Processing under A.121 to be available? What three actions must an applicant take to obtain further processing and by what deadline?

[4]

Under what conditions is restitutio under A.122 available? By what deadline(s)? Is restitutio available for failing to request further processing in the period allowed?

[6]

Question 2

Some time ago a friend saw a headline in Melbourne Age: "Melbourne man patents the wheel". Explain the main features of the Australian innovation patent system to him.

[6]

Write notes for a US attorney on the law and practice under the EPC relating to:

a) Claim amendment;

[8]

b) Public prior use in relation to novelty.

[6]

Question 3

Where must a PCT application be filed?

[1]

If the application is filed with a non-competent national patent office what happens to the application? What filing date (if any) does it receive?

[2]

By default all PCT member states are automatically designated but the Request Form lists three countries for which this automatic designation can be excluded. Name two of them.

[2]

Explain the search procedure that applies under extended Chapter I.

[5]

Does the applicant have an opportunity to amend and/or comment on the results? Assume no Demand is filed.

[8]

When is the deadline for filing a Demand on a PCT application? (Assume that the applicant is not interested in seeking protection in any countries that have not implemented the extended Chapter I procedure).

[1]

Question 4

Under the Paris Convention what is the period for claiming priority from a) a patent application, b) a utility model application? If the priority period for a UK patent application ends on a Sunday can an application filed in the US on the following Monday validly claim priority?

[3]

Your client wrote an academic paper and filed it as a patent application at the UK patent office. Shortly afterwards the paper was published. The client then came to you asking you to draft and file a corresponding European patent application. You see that the UK application will not be adequate to establish a priority date for the claims that are needed. Can the paper be cited as a prior disclosure against the client's own European application? Give brief reasons.

[2]

When an applicant files two applications in a convention country for the same invention, one later than the other, from what date is the priority period calculated? In what circumstances could the second application be used as a basis for a valid priority claim?

[4]

A Taiwanese client filed a UK patent application on 1 September 2003 and a (provisional) application on 1 December 2003 without claiming convention priority. The client decided not to file any priority-claiming applications by 1 September 2004. The client has now had a change of mind and asks whether a European application can be filed validly claiming priority from the US application. Is this possible? Would a valid priority claim have been possible if the first application had been filed in Taiwan instead of the UK? Give reasons.

[4]

You have a client who wishes to seek protection in the following:

Korea, Japan, China, Australia, Canada, USA, EPO, Singapore, Malaysia, Thailand, Norway, Turkey, Russia, Brazil, India, United Arab Emirates.

- (a) Which are not members of the Paris Convention
- (b) Which are not members of the PCT

[3]

Your client has filed a PCT application designating all States and wishes to proceed in a) the EPO, b) USA, c) Canada, d) Japan. What are the national phase deadlines in these countries? What is the deadline for filing a translation in Japan? What are the deadlines for requesting examination in Canada and Japan?

[4]

Question 5

In the context of US patent law write notes explaining the following terms:

- a) Small entity status
- b) Patent term guarantee
- c) Terminal disclaimer
- d) Information disclosure statement

[12]

You filed a UK patent application just over 6 weeks ago. Write notes on the points you need to consider when preparing the specification for filing at the US patent office (do not consider the formal documentation required to support the application).

[8]

Question 6

A UK engineering company with a new mechanical device approaches you for advice regarding patent protection. The device had been kept secret but 2 days ago a subsidiary of the Company released publicity material describing the device in detail. The company wishes to seek patent protection for the device in the USA, Canada, Australia, New Zealand, Ireland, Germany and Japan. What is your advice?

[8]

A competitor has a Japanese patent (on a different invention) which the UK wishes to attack. Explain the system of invalidation trial in Japan, noting parties who can attack, when and in what forum, whether they take any further part in the proceedings, and rights of appeal.

[6]

A competitor has a corresponding US patent which the UK company also wishes to attack. Briefly outline the main options in the USA and their pros and cons.

[6]