

THE JOINT EXAMINATION BOARD

PAPER P5

Basic Overseas Patent Law and Procedure

Friday 4th November 2011

3.00 p.m. – 6.00 p.m.

Please read the following instructions carefully. **Time Allowed – 3 HOURS**

1. You should attempt **five questions**.
2. Each question carries 20 marks. If more than the required number of questions are answered only the first five will be marked and the sixth will be ignored.
3. Please note the following:
 - a. Start each question (but not necessarily each part of each question) on a fresh sheet of paper;
 - b. Enter the Paper Number (P5), the question number and your Examination number in the appropriate boxes at the top of each sheet of paper;
 - c. The scripts are photocopied for marking purposes. Please write with a **dark inked pen** on one side of the paper only and within the printed margins, and do not use highlighters in your answer;
 - d. Do not state your name anywhere in the answers;
 - e. Write clearly, examiners cannot award marks to scripts that cannot be read;
 - f. Reasoning should always be given where appropriate.
 - g. You must number all the pages of your answer script. Once the exam finishes, an additional 5 minutes will be allowed for you to do this.
4. Under the Examination Regulations **you may be disqualified from the examination and have other disciplinary measures taken against you if:**
 - a. you are found with unauthorised printed matter or other unauthorised material in the examination room;
 - b. your mobile phone is found to be switched on;
 - c. you copy the work of another candidate, use an electronic aid, or communicate with another candidate or with anyone outside the examination;
 - d. you continue to write after being told to stop writing by the invigilator(s). **NO WRITING OF ANY KIND IS PERMITTED AFTER THE TIME ALLOTTED TO THIS PAPER HAS EXPIRED.**
5. **At the end of the examination assemble your answer sheets in question number order, number all the pages and put them in the WHITE envelope provided.** Do not staple or join your answer sheets together in any way. Any answer script taken out of the examination room will not be marked.

This paper consists of 7 pages including this page.

Question 1**[20 marks]**

A. Three months ago you drafted and filed a UK patent application directed to a simple mechanical device on behalf of your client. A UK Search Report has now issued. After reviewing the Search Report you advise your client that, while appearing to be novel over the documents cited in the Search Report, the invention probably lacks the inventive step required for patentability. Your client informs you that their mechanical device is already being copied by a competitor in Germany, Argentina, Mexico, Israel, China, Japan and India. Your client is interested in obtaining protection for the device.

- (a) Identify three typical advantages, and two typical disadvantages, of seeking utility model protection rather than patent protection for an invention.
- (b) For each country identified by your client, state whether utility model protection is available and what the maximum term of protection is.
- (c) Is it possible to claim priority for a utility model application from the UK patent application that you filed three months ago?
- (d) Your client asks whether it is possible to file an international patent application now and wait to file utility model applications later. Is this an option and would you advise taking it?
- (e) Your client now informs you that the invention was recently disclosed in a printed publication in the UK. Given this new information, explain whether valid utility model protection is still available in any of the identified countries.

[16]

B. Write notes on the procedure for obtaining registration of a German utility model.

[4]

Question 2

A. Your client has applied for an international patent application. For each of the following National/Regional territories:

- (i) Europe
- (ii) USA
- (iii) Japan
- (iv) China

- (a) Explain how claims fees are calculated on national/regional phase entry.
- (b) Can the claims of the international application be amended at National/Regional phase entry to reduce or eliminate any fees due?

[9]

B. One of your client's international patent applications entered the European Regional phase last week with 53 claims and all excess claims fees were paid. Claims 1 and 25 are separate independent claims defining medical devices, and claims 32 and 37 are separate independent claims defining methods of treatment of a human being. All 53 claims were searched during the international phase. Your client has now received a profits warning and has queried whether it is possible to reduce the cost associated with the filing of the European regional phase application.

Suggest amendments to the claims and explain your reasoning.

[8]

C. An international patent application has been found by the European patent Office, acting as the International Search Authority, to contain claims defining two inventions that are not linked so as to form a single inventive concept. Only the first of the two inventions has been searched during the international phase. The 31 month deadline for European Regional Phase entry falls next week and the applicant wishes to pursue the second of the two inventions in a European patent application.

Explain the steps that need to be taken to pursue the second of the two inventions in a European patent application.

[3]

Question 3

A. Your client is considering patent protection in Singapore.

There are four search and examination options available for processing a Singapore patent application.

- (a) Briefly explain these four options including any applicable deadlines. Where appropriate, consider time limits applicable under both the fast track procedure and the slow track procedure.

A Singapore patent can be obtained on the basis of a corresponding foreign patent granted by a prescribed patent office.

- (b) Name four of these prescribed offices.

[12]

B. Your client is also considering patent protection in Hong Kong.

Your client has filed a European patent application (EP1) for an invention.

- (a) Under what circumstances is it still possible to obtain patent protection for the invention in Hong Kong?

Your client also has a UK patent application (GB2) relating to a different technology. GB2 was published on 30 January 2011 and has been used as a designated application on which to base a standard Hong Kong patent. A request to record the designated application was made on 30 June 2011, and this request was published in Hong Kong on 30 September 2011. GB2 was granted on 30 July 2011.

- (b) What is the latest date that a request for registration and grant can be filed?
(c) When are the filing and advertisement fees payable?

[8]

Question 4**[20 marks]**

A. You are a UK patent attorney resident in the UK and your client is a UK citizen also resident in the UK. You have drafted two patent applications describing your client's new inventions relating to:

- 1) a missile guidance system and
- 2) a sandwich toaster.

Your client instructs you to file both of the applications directly in the USA as he perceives this to be the main market for these technologies.

Advise your client on any steps that should be taken prior to filing each of the US patent applications and explain why.

[9]

B. Your client works for a small UK based company employing 100 people.

- (a) Explain the qualification requirements for claiming small entity status for US patent applications.
- (b) Explain one benefit of claiming small entity status in the US.
- (c) Are there any risks involved in claiming small entity status?

Your client wants to pursue patent protection in Canada as well as the US.

- (d) Does your client qualify for small entity status in Canada?

[9]

C. Your client's sandwich toaster was inadvertently disclosed in a technical journal 4 months ago. Can patent protection for the toaster still be obtained in the following countries?

- 1) Canada
- 2) USA.

[2]

Question 5

A. For a European divisional patent application:

- (a) When can the application be filed?
- (b) Who can apply?
- (c) What fees need to be paid and
- (d) What time limits apply for payment of the fees?

[14]

B. A first European patent application (EP1) was filed on Tuesday 2nd January 2007. A first communication from the examining division in relation to EP1 issued on Tuesday 1st Dec 2009. EP1 was granted on Monday 1st February 2010.

A divisional patent application (EP2) was filed from EP1 on Monday 4th January 2010. A first communication from the examining division in relation to EP2 issued on Monday 1st March 2010. A communication notifying a decision to grant informs you that the date of mention of grant in the European Patent Bulletin will be Tuesday 6th December 2011.

What is the deadline for filing any divisional applications from EP2?
Explain your calculation.

[6]

Question 6**[20 marks]**

- A.** Party A is considering opposing a European patent granted to party B.
- (a) What is the deadline for opposing a granted European patent?
 - (b) What actions must be taken by the deadline in order for the opposition to be validly filed?
 - (c) If any of the actions are not completed by the deadline, explain whether the EPO's further processing procedure can be used to redeem the situation including any time limits that may apply.
 - (d) Who may file an opposition to a European patent?
 - (e) Where can an opposition to a European patent be filed?
 - (f) Are there any restrictions on the language in which an opposition to a European patent may be filed?
 - (g) What are the available grounds of opposition to a European patent?
 - (h) If Party A opposes the patent granted to party B and subsequently withdraws their opposition, do proceedings terminate?

[14]

- B.** Party C opposes a patent granted to party D. After opposition proceedings the Opposition Division issues a decision revoking the patent in its entirety.

- (a) Can this decision be appealed?

If so:

- (b) Who can appeal against the decision?
- (c) What is the deadline for filing the appeal?

[6]