

THE JOINT EXAMINATION BOARD
PAPER P5
BASIC OVERSEAS PATENT LAW AND PROCEDURE
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EXAMINER'S COMMENTS

General comments:

Like last year's paper, each question had some parts on which any candidate with a basic level of knowledge could pick up easy marks, and from that base there were not that many more marks which had to be gained to pass. The question on priority (Question 4) was generally well done, which was encouraging, and the PCT procedures were also (mostly) known thoroughly. Questions 2 and 6 were least popular.

Question 1:

Any person may apply for a European patent (entitlement and the need for a representative are different matters) - some candidates thought that only EPC State nationals/residents could apply. A non-exhaustive list of subject matter which is not patentable as such can be found in Article 52 EPC.

Broadly speaking, for a disclosure to be enabling, the information made available to the public must be sufficient (in the sense of Article 83 EPC – sufficiently clear and complete) for a person skilled in the art to work the invention. The use of common general knowledge is permitted (EPO Guidelines for Examination C-IV-5.2, 7.3a)

The EPO takes the problem and solution approach to inventive step. Details of this approach are set out in, for example, C-IV-9.8 and in the White book of EPO BoA Case Law. Most candidates knew this, but fewer clearly explained all the steps and, in particular, there was frequently no specific reference to the invention as claimed.

When determining the deadline for responding to an EPO exam report, take into account the EPO 10 day (post) rule; if no response is filed in time the application is deemed withdrawn.

The question on Further Processing was based on Article 121 EPC, which provides the answer. Note that for FP to apply there must be complete loss of the application; this was often missed. The answer to the question on restitutio can be found in Article 122 EPC (application of which is not restricted to renewal fees, as some appeared to think). Note that it applies to any loss of rights or means of redress (with some specific restrictions), and not just to complete loss; it is also available post grant (except in one circumstance, to the proprietor only). The last part of the question, on Art. 122, was not well done.

Question 2

The Brown Book is a good source of material on the Australian Innovation Patent. Marks were given for each significant feature of the system that was mentioned. In the context of the question it was pertinent to mention that an innovation patent is granted after a formalities examination only, although it cannot be enforced until after certification. The particular case of patenting the wheel was (allegedly) misrepresentation on the part of the applicant.

Much material for the law and practice under the EPC on claim amendment can be found in Article 123 and Rules 86-88 EPC, as well as the case law (*ibid*). Many candidates focussed on procedural aspects but half the marks were allocated to the substantive law pre- and post-grant (Art 123(2),(3)). Few explained that the added matter test is strict or that impermissible amendment is a ground of invalidity. Surprisingly no-one mentioned the added subject matter trap (G1/93). Candidates could also have commented on claim broadening (C-VI,5.3.10, T331/87), disclaimers (G1/3, G2/3), change of category (eg apparatus-method), when amendment is permitted (most candidates commented on this), corrections (R.88), and other points (eg R.86(4), R.87).

The last part of the question, which related to public prior use, was not well answered. The point arises most commonly in Opposition proceedings (but can be an issue pre-grant, for example with Art.115 observations). A basic point is that there is absolute novelty under the EPC, and some mentioned the need for an enabling disclosure. However, what was expected was a discussion of what counts as public (essentially not bound by a secrecy agreement), and of the need for a high standard of proof - for example proof must be “up to the hilt” according to T472/92 and full details of must be provided (T194/84). Further information can be found in D-V-3.1 *et seq*. Candidates could also have commented further on the meaning of availability to the public (eg G1/92, T952/92, D-V-3.1.3.1) and on novelty of purpose (G2/88). Little credit was available for a discussion of the effect of display at an International Exhibition or evident abuse.

Question 3

This question was generally well answered. The PCT Newsletter is a useful source of information on how the PCT operates and explanations of changes in the rules.

Filing requirements for a PCT application can be found in Rule 19 PCT; the procedure if the application is filed with a non-competent office is set out in Rule 19.4. Germany (South) Korea, and the Russian Federation can be excluded from the Request (because their national law results in automatic withdrawal of the priority application, as also does Japan’s). These first parts of the question provided easy marks.

The extended Chapter I procedure is covered by Rule 43bis – 44ter. Article 19 amendments can be filed to the claims only, optionally with a statement explaining the

amendments which is published with the amendments (Article 19 and Rule 46 PCT). Very few candidates mentioned the statement. Informal observations (which are not published, but which are publicly available at 30m) can also be filed. Comments as to what is published/publicly available when were expected. Further information can be found in the PCT Newsletters of Nov and Dec 2003.

Question 4

On the whole this was an easy question on which most scored good marks.

The answers to the first parts of this question can mostly be found in Article 4C of the Paris Convention. The status of intervening disclosures was decided by G3/93.

If priority is to be validly claimed from a second application, the first must have been withdrawn etc at the time the second application was filed. This point was frequently missed. Application of Art 4C(4) PC led to the conclusion that a priority claim from the US application would not have been possible where the first application was filed in the UK (a Convention country) more than 12m ago, but would have been possible where the US application was the first in a Convention country (Taiwan is not a Convention country and the EPO does not recognise Taiwan for convention purposes).

The remaining parts of the question were straightforward, although several candidates who apparently guessed which countries belonged to the PC/PCT were not aware that a country must belong to the Paris Convention to belong to the PCT (Article 62). Some candidates lost easy marks in the questions on national phase deadlines by not saying from when the deadlines were measured.

Question 5

The Brown Book provides background material for a good answer, particularly to the last part of the question, but for a complete answer this would need to be supplemented by other knowledge, for example from lectures.

Almost everybody explained small entity status well and most noted the effect of a licence/assignment with a non-small entity and of a wrongful claim. Most also gave a good explanation of patent term guarantee, although for full marks it was necessary to make some comment about the applicant's need to use reasonable efforts to prosecute the application ie the extension is offset by the applicant's delays.

Fewer candidates could give a good explanation of a terminal disclaimer and, in particular, the point that the two applications/patents need to be (and must remain) commonly owned was often missed. To obtain full marks on the IDS explanation there needed to be some comment on the consequences of not meeting the duty of candour and good faith (patent invalid/unenforceable).

There were many points that could be made in the final part of the question.

Some examples include, for the description: best mode (almost all mentioned this), stricter sufficiency requirements, drawings for claims, review term usage (eg US vs. UK), headings. In relation to the claims, many candidates mentioned means/step + function claims but few explained why (narrow statutory interpretation under 35USC112). Festo and its implications was rarely mentioned (no doctrine of equivalents for amended claims implies file some broad and some narrow independent claims). Other points included (not an exhaustive list and not in any particular order): different claim categories allowable (eg methods of treatment/business methods), fees (almost every candidate mentioned these), dependency, alternatives, format (two-part Jepson format is permitted but has drawbacks), positive recitation/definiteness, omnibus claims.

Question 6

This question was primarily about novelty and grace periods.

Marks were awarded for commenting on the existence of grace periods in the USA, Canada, Australia and Japan and on their duration. There was a question as to the applicability of the grace period in Japan arising because the disclosure was by the subsidiary. In Germany there is a possibility of obtaining utility model (Gebrauchsmuster) protection (because the invention is a mechanical device), for which there is a 6m grace period. In Ireland there is no grace period, even for a utility model. However the better candidates discussed the possibility of the disclosure by the subsidiary being an evident abuse in relation to the parent – it would depend upon details of their relationship – in which case an application should be filed within 6m. New Zealand is one of the few countries left which still has local rather than absolute novelty (although this is likely to change soon). In all cases the grace periods run to the filing rather than priority date and it would therefore be convenient to file a PCT application.

The system of invalidation trial in Japan has replaced the former opposition procedure. Foreign agents' newsletters would be one source of information on this. In a nutshell, anyone can seek trial for invalidation at any time after grant; the proceedings are inter partes at the JPO and either party can appeal to the (Tokyo) High Court.

The main options for invalidating a US patent are inter-partes and ex-parte re-examination. There is also the possibility of invalidity proceedings in Court but these only can only be asserted as a defence to infringement - they cannot be commenced independently. Interference proceedings are only an option if the UK company has its own pending application.

Inter-partes re-examination proceedings are relatively quick and cheap and the "judge" will have a technical background. However the third party participates in writing only, and the patentee has an opportunity to amend. The requestor must show a substantial

new question of patentability (although re-examination may be based on a previously cited reference). Estoppels are created (eg. art cannot be reconsidered) but there is no presumption of validity (claims are given their broadest reasonable interpretation). Inter-partes re-examination is only available for patents filed after 29 November 1999. Ex-parte re-examination is a cheaper alternative but a poor option, primarily because of the very limited third party participation (and no third party right of appeal), so strong prior art is desirable. However it is available against any patent, and may be filed anonymously. There was often more detail on procedure than discussion of the pros and cons of the options.