

Basic Overseas Patent Law and Procedure**Paper P5****Friday 9 November 2012****Examiner's Comments**Question 1

Question 1 required candidates to assimilate information relating to three European patent applications, determine what any actions if any that may have been due since May 2012, and advise how to proceed.

EP01 was published on 8 May 2012 with a Search Report. Within six months of the this publication, i.e. by 8 November 2012, the applicant was required to pay designation fees, pay examination fees, and respond to any objections in a Written Opinion accompanying the Search Report. The deadline expired yesterday.

Candidates were expected to state that further processing was available, the missing acts should be completed, and a request for further processing should be made. In addition to paying the examination fee and designation fee, further processing fees in respect of these acts would be payable at a rate of 50% of the fee that was not paid. The further processing fee for the overdue response is a standard flat fee.

The Examination Report that issued on 5 July 2012 on EP02 set a four month deadline for response. This deadline runs from notification of the Examination Report, and notification is deemed to be ten days after the date on the communication. Thus, the response to the Examination Report was due on 15 November 2012. As "today" was 9 November 2012 the applicant was still within the normal term for response. However, rather than rush a response, it may be good advice to request the two-month extension that is available of this term as-of-right provided that the extension is requested by 15 November 2012. In addition to the examination response, the maintenance fee for the fourth year would have fallen due on 31 May 2012. You should check whether this fee has been paid. Payment would be available within the grace period on payment of a late fee. The deadline for payment of the maintenance fee would be the end November, i.e. 30 November 2012.

A maintenance fee was due to be paid on EP03 on 31 December 2012. The case will not be granted without payment of this fee, so you should ensure that it is paid.

The response to the Communication under Rule 71(3) was due on 16 September 2012 (including a ten day notification period). Thus, a response is overdue. Further processing is available within two months of a Communication indicating that there has been a loss of rights. As we are still within two months of the due date we know that further processing will be available, thus we will be able to respond. In order to complete further processing the further processing fee needs to be paid, further processing needs to be requested, translations of the claims need to be filed, the grant fee needs to be paid, and the additional claims fees, due as a result of the increased number of claims from 15 to 20, need to be paid.

Most candidates missed the fact that renewals would need to be paid and may be overdue. Many candidates correctly identified response terms (i.e. six month or four month response terms) but then failed to calculate the dates correctly.

Question 2 - Part A

The client can file either a utility model application in China derived from the International patent application, or a patent application in China derived from the International patent application, but not both. The deadline is 30 months from the filing date (as there is no priority application), which is 9 January 2013. In China a two-month extension is available to the National Phase entry deadline on payment of fees.

All of the claims from the PCT application may be included in a patent application. However, utility models in China are only available for features of shape and structure. Therefore, claims to a method of making a new toothbrush would not be allowable.

It is not possible to obtain both the granted utility model and a granted patent derived from the PCT application, as the applicant must choose one or the other type of protection. Patents have a maximum term of protection of 20 years from filing, and utility models have a maximum term of protection of 10 years from filing.

Question 2 - Part B

This portion of the question asked for an outline of the procedure from filing through to grant for both Chinese utility models and Chinese patent applications. Marks were available for the identification of relevant procedural steps for both types of protection. This information may be found in reference works such as the "Brown Book". For example, marks were available for stating what documentation needed to be filed in order to initiate the application, what language the application needed to be filed in, whether or not a representative needed to be appointed, whether formal examination was carried out, and if so, what would happen if defects were found, whether search or examination needed to be requested and whether any fees were paid, and if so, what were the deadlines for requesting search and/or examination, what opportunities the applicant had to amend the applications and any time limits that applied, whether the application was published before grant or not, and the grant procedure including any fees payable. Actual amounts of fees were not required.

Question 3 – Part A

The minimum elements that an International application must contain, the fees that need to be paid for an International application, and the deadlines for payment of those fees, are set out in the Patent Cooperation Treaty. Most candidates scored high marks on this section.

Question 3 – Part B

This question required an understanding that the European Patent Office will only proceed with examination of claims that have been searched and that, if the European Patent Office has acted as the International Searching Authority, the applicant will have no further opportunity to search claims during the European Regional Phase (other than by filing a divisional application). Thus, the applicant was required to advise whether or not the second invention of claims 11 to 15 should be searched during the International stage. The question required a discussion of advantages and disadvantages of paying the additional search fee, given the two situations stated in the question. Most candidates were able to make sensible comments.

Question 4 – Part A

Question 4 Part A is a standard question regarding patent procedure in India, Israel and Japan. Answers to the questions are readily available in works such as the "Brown Book", and most candidates scored high marks.

Question 4 – Part B

Many candidates did not attempt Part B of this question, although those that did scored well. In Japan there is no opposition procedure in relation to the patent, but at any time any person may file for invalidation of the patent before the Japanese Patent Office. The invalidation proceedings are heard before a panel of JPO Examiners and the proceedings become inter-partes. After a request for validation has been filed, and fees paid, the owner is given an opportunity to respond. Any adverse decision may be appealed to the High Court in Tokyo. There is no limit to the number of invalidation procedures that may be filed or carried out on any single Japanese patent.

Question 5 – Part A

This portion of Question 5 asked some basic questions regarding patent protection in Argentina, Australia, Brazil, Canada, Saudi Arabia and the US. It is possible to file applications claiming priority from the UK patent application in all territories by a deadline of 30 November 2012. The majority of candidates realised that Argentina and Saudi Arabia are not part of the PCT. Canada allows the National Phase deadline to be extended as-of-right on payment of a fee.

Question 5 – Part B

This was another question that required calculations of deadlines and advice as to how to proceed. In this case candidates needed to determine that the Regional Phase deadline for the European application fell on 18 September 2012, realise that this deadline had passed, and that further processing would be available. The candidates needed to identify the missing acts to be completed and to state that the request for further processing must be filed. In addition to identifying the various fees that needed to be paid, candidates were expected to identify that a separate further processing fee is required for the late filing of the translation of the application into English, French or German.

Question 6

- a) There is no prohibition on patenting plants as such under the EPC, but plant varieties are specifically excluded from patentability under Article 53(b). Client A may wish to consider other forms of protection that specifically relate to plant varieties.
- b) The man trap is a simple mechanical device and therefore technical in nature. However, it is likely to be prohibited from patentability under Article 53(a) "ordre public". The exclusion here is based on the concept of public morality rather than rule of law. The fact that man traps may be illegal in one or more states of the EPC does not prevent the patentability, but the suffering required is likely to result in disapproval from the public, and thus a prohibition from patentability.
- c) Method of treatment of animals is specifically excluded under Article 53. Iodine solution itself is a known product. There are, however, possible new medical uses of the substance or further medical uses of the substance. Any new or further medical use needs to be novel and inventive.
- d) A method of contraception is not a method of treatment. However, methods of contraception are generally excluded from patentability under Article 57 as lacking an industrial application. Industry involves performing a process for financial gain, whereas contraception is generally considered to be in the private sphere of the user and not for financial gain. There may be arguments that a method of contraception could be industrially applied.

The device for contraception is not excluded and may be patentable if novel and inventive.

The question notes that prototypes have been manufactured. Questions should be asked as to whether they were manufactured by the third party contractor under conditions of confidentiality.

Confidentiality is likely to be implied, however, and manufacture of the device without sale or testing is unlikely to be a public disclosure and unlikely to prevent patentability.

e) It is noted that one of the inventors has left and, without authorisation, has disclosed details of a new invention. This would appear to be an abusive disclosure under Article 55 EPC. If it is, then the disclosure would not count as a disclosure if it occurs no earlier than six months preceding the filing of a European patent application. Although the client can overcome the disclosure by filing a European patent application, it should be noted that the blog publication may be prior art in other countries. The six month period for filing an application under the EPC due to an abusive disclosure is only relevant with regards to the European patent application. Therefore, the invention may not be patentable in other territories unless similar abusive disclosure exemptions apply and are taken advantage of. In general such exemptions only apply from the filing date (not the priority date) of the local application.