

Introduction

The patent attorney profession has an International dimension and this paper is designed to test the underlying knowledge required to assist clients/employers in relation to the European and PCT systems, and to at least orient clients/employers in relation to national patent and utility model systems in a number of jurisdictions.

It can generally be expected that a relatively high portion of the available marks will be in response to questions relating to the EPC, PCT and the US patent systems. However, candidates are expected to complement their knowledge of these main areas of International patent law with adequate knowledge of the law relating to the countries listed in the syllabus. It is risky to take this exam when candidates have not adequately covered the syllabus geographically.

78% of the candidates scored 60 marks or more, which means that they passed this test comfortably. This is encouraging. However, 16% of the candidates scored between 50 and 59 marks and 6% failed.

Questions

Question number	Comments on questions
Question 1	<p>This question was attempted by 72% of the candidates and was answered generally very well.</p> <p>Part A's main motives were patentability and filing strategy. In particular, it was required to identify that the inventive procedure was a method of treating the human body and, as such, not patentable in some jurisdictions. The client proposed an unusual filing strategy, i.e. to first file a PCT application. Candidates who scored well would have been confident as to the implications of such an unusual (but perfectly possible) filing strategy.</p> <p>Part B assumed that the client had been convinced not to first file the application as a PCT, and consequently tested the knowledge of the PCT provisions regarding the identification of the competent receiving, searching and examining authorities. Worryingly, some candidates did not recognise the EPO as the competent ISA and IPEA when the German patent office is the receiving office. Some candidates did not know on which ground the EPO can act as receiving Office for German applicants, i.e. these applicants are nationals of a member state to the EPC. The USPTO, which searches business method inventions, was not among the possible ISA/IPEA. The Australian and Korean patent offices will also search business</p>

	method inventions, and were available.
Question 2	<p>This question was attempted by 66% of the candidates and was answered generally well.</p> <p>The main themes of the question were national phase entry from a PCT application and patent prosecution in selected national jurisdictions (HK, Australia and South Africa). In particular, section a) focussed on language of translation and parts of the application to be translated on entry; section b) on extensions of time for filing translations; section c) was about the patent registration procedure in HK; section d) about patent prosecution in South Africa and section e) about patent prosecution in Australia.</p> <p>No candidates knew that it is necessary to file at least a translation of the claims into Portuguese to successfully enter the application nationally in Brazil. Most candidates knew the language possibilities in Israel. Australia does not provide for as-of-right extensions of time. Candidates who pointed out that it may be possible to file the translation later by showing 'due care' did not generally score marks. In China, it is necessary to file a translation on entry, but entry into the national phase can be delayed as-of-right 2 months by paying an appropriate fee. Most candidates knew the double-step registration process in Hong Kong and most were also aware of the lack of substantive examination in South Africa. Candidates who identified the presence of a compliance period in Australia scored marks, but this lasts 12 months from the issuance of the first examination report.</p>
Question 3	<p>This question was attempted by 78% of the candidates and was answered generally very well.</p> <p>Part A focussed mainly on US prosecution and enquired about 'staples' of this system such as Restriction Requirement, Final/Non-Final Office Action and Notice of Allowance. Candidates were at ease with the procedure of filing RCEs to allow relevant art to be made of record. Many candidates, however, did not know that annuities in the US are calculated from the date of grant, not the filing date.</p> <p>Part B focussed mainly on prosecution strategy, and required an appreciation of the US continuation/divisional practices. Candidates who suggested that TR4 could be covered by a new application could also score full marks if an appropriate discussion on novelty and inventive step was included. The answer sought by the examiner, however, was to file a continuation-in-part (CIP) for TR4. Many but not all candidates knew that a CIP application can validly be the basis for priority-claiming foreign filings according to the Paris Convention.</p>

Question 4	<p>This question was attempted by 90% of the candidates and was answered generally very well.</p> <p>Part A focussed on the PCT third party observation provisions. Most candidates recognised the course of action of filing third party observations but many did not know the applicable deadlines. Many candidates unnecessarily speculated on Article 19 and 34 amendments, but these are optional procedures in the International phase. The observations do not make the third party a party to the proceedings (therefore it would be impossible to control the outcome of submitting them).</p> <p>Part B concerned various procedures for opposing granted patents in Europe, the USA and Japan. Candidates showed pertinent knowledge of the relevant procedures, i.e. Opposition in Europe and Japan, and Post Grant Review and Inter Partes Review in the US. This probably meant that most candidates studied these topics comparatively across the different jurisdictions. It is suggested that this technique is particularly useful in preparing for this exam, and could be applied to various topics covered in the syllabus. The new Opposition regime in Japan appeared to have been well known by most candidates.</p>
Question 5	<p>This question was attempted by 96% of the candidates and was answered generally well.</p> <p>Part A had to do with national phase entry in various jurisdictions that apply different time limits. Most candidates calculated the deadlines well. The deadlines are calculated from the earliest priority date. Some jurisdictions allow applicants to enter the national phase late as of right. Knowledge of these provisions was required. Many candidates, however, failed to identify that a late fee is payable to enter applications late.</p> <p>Part B was about withdrawing a priority claim in the International phase. While most recognised that this is possible, many failed to identify that the withdrawal must be filed in writing with WIPO, and at least a power of attorney is required (consent in case of co-applicants).</p>
Question 6	<p>This question was attempted by 96% of the candidates. The question explored aspects of European patent law, which is of course in addition practiced by most UK patent attorneys. A relatively lower number of candidates answered the question well. While many candidates scored highly, a perhaps worrying number of candidates appeared to have not appreciated what the question was asking and did not score well. 25% of those who attempted the question did not score more than 10 marks.</p> <p>Section a) was straightforward, and concerned the Rule 161(1)/162</p>

	<p>practice. Section b) was about excess claims fees. Candidates generally knew the subject, but many did not appreciate the legal consequences of not paying any excess claims fees which are due at the end of the Rule 161 period, and the possible remedies. Amendment on entry into the European phase is often performed, and the related options should have been well known by the candidates but many failed to identify that amendments are also possible on entry in the regional phase in Europe as well as in response to the Rule 161 communication. Many failed to indicate that any amendments carried out at this stage to introduce a new and unsearched invention are voluntary. The EPO's new practice under Rule 164 EPC allows newly introduced inventions to be searched in the European phase. This is welcome news for applicants, but most candidates did not understand the new procedure. Many candidates failed to collect the 'easy' marks reserved for discussing certain possibilities for extending time periods in Europe, and the possibility to file divisional applications.</p>
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