

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

General comments:

This was a fairly standard paper – following the syllabus and doing some past papers should have been enough to get through. Candidates could effectively secure a pass with good answers to questions 1 and 5; there were also easy marks to be had on question 6(a), and with good marks on these a candidate had to do very poorly on the other questions to fail. As always the question on Japan was unpopular; of those candidates who did attempt it, it appeared that some had learnt the topic whereas others gave the impression that they thought this question was their best chance of picking up marks by guessing. On occasions candidates were given a little credit for sensible, practical comments even when the precise answer was not known.

Question 1:

Virtually all candidates attempted this question and most did well. Getting high marks on the question made passing the rest of the paper significantly easier.

a) Advantages of the EPO route include: a single procedure to grant/protection uniform, no translations until grant (cost deferred), no separate national representatives until grant/single agent for all countries, a good search and examination (in some circumstances this could be a disadvantage), and a cost advantage if more than ~3 countries.

Disadvantages of the EPO route include: Central attack - post grant opposition, central attack pre grant - possibility of losing rights for all states, speed, protection may be less than obtainable with national filing, cost if <~3 countries, renewal fees, foreign language prosecution if filed from a non- official language country.

All sensible points got marks and virtually everybody got high marks.

b) Countries where simultaneous protection of the same invention by a national patent and a European patent is available are Austria, Denmark, Finland and Sweden. The answer can be found in the EPO booklet “National Law Relating to the EPC”, Table X.

Countries for which the PCT route cannot be used to obtain a national patent directly (rather than via the EPC) are BE,CY,FR,GR,IE,IT,MO,NL,SI. This was generally well done.

c) Points for which marks were given when describing a utility model included: shorter term, lower level of inventive step, different novelty requirements, often only examined for formalities/examined on request, not all types of invention protectable in some countries, faster grant. EPC Contracting States where utility model (or equivalent) protection is available are FR, AT, DE, CZ, SK, TR, PT, IT, ES, and Slovakia. Most candidates got close to full marks on this part of the question.

d) Points for which marks were given when explaining an extension state included: Not EPC States, extension agreement, based on national law in the relevant State, extension fee payable (equivalent to designation fee), provisional protection provided, translation and publication fee needed at grant, revocable in opposition. The extension states were AL, LT, LV, MK. Again, most candidates got close to full marks.

e) The UK application is not prior art for the EP and is only relevant to the EP(UK) (once this is granted and effective in UK), and then for novelty only. The two main options are: (1) do nothing, in which case the EP(UK) revoked under s.73(1), although there is an opportunity to amend first; and (2) file different claims for the UK part of the EP (see EPO Guidelines for Examination C-III-8.4, C-IV-6,6a). Most candidates mentioned the second option but few were aware of the first. Some candidates thought the UK application Art.54(3) prior art.

Question 2:

Most candidates who attempted this question did fairly well overall – although some lost some marks re the USA in part (a) these were often recovered in part (b).

a) The client can still proceed with the EP application because they are still within the 31m deadline – so enter EP regional phase as usual. The client can also proceed in Canada as the deadline is 42m from the priority date on payment of an additional fee for late entry of national phase. In the US it is probably still possible to enter national phase although the 30m deadline has passed. The client needs to petition the USPTO in writing (and perform the omitted act), with a fee, and explain why the delay was unavoidable or unintentional – the delay is likely to be excused.

Almost everyone got the EP correct; a significant proportion of candidates thought that the national phase deadline in Canada was 31m from filing/earliest priority date. Few candidates knew about the US late entry possibilities although details can be found in, for example, the PCT Applicant's Guide. (The question wasn't meant to be about new PCT Rule 49.6 although a candidate knowing about this rule would have got at least some of the points).

b) The Australian system of modified examination is based on a granted patent in the US, CA, NZ, or EP (any country signatory to EPC), in English. Points for which marks were given when explaining this system also included: the foreign patent must be for same invention; amend to make specification of the AU case the same; deferred

examination is possible if the foreign patent is not yet granted; up to 9m extension is possible if directed to request examination, if foreign patent grant expected soon; must request within 5y of filing/6m of request by AU Patent Office; certified copy of granted patent needed; can convert between modified and full examination. Benefits include no need to disclose results of searches of foreign Patent Offices (protects from consequences of non-disclosure), cheaper, simpler administration; disadvantages include a risk of unnecessary claim limitations (methods of treatment, A54(3) prior art, unity etc), harder to amend if there is a need to (eg if new prior art comes to light), the need for a granted patent and the time limit for examination. Almost everyone scored highly; the disadvantages were least well done.

c) Patent protection in Hong Kong is based on a corresponding UK, EP(UK), or CN application (and except for the HK petty patent can only be based on foreign application). A request to register must be filed within 6m of foreign publication, with a fee; a request to grant must be filed within 6m of foreign grant, with a fee and a certified copy of the granted patent. A petty patent available by applying direct. The petty patent option was often forgotten; the need for registration was generally known but not the details.

Question 3:

Overall this question was fairly well done although some candidates didn't read/answer the part of the question relating to record keeping.

a) Obtaining an early US filing date in addition to a UK priority date is useful mainly to establish early 35USC102(b) and 102(e) dates. The former is useful as swearing behind prior art is limited to 1 year behind the US filing date; the latter is useful for blocking later filed US applications and because the assignee with the earlier US filing date become the senior party in interference proceedings. No mark was given for mentioning the US grace period as the question says that the invention was kept secret. This part of question 3 was generally not well done.

b) The US grace period runs for 1 year up to the US filing date (not the foreign priority date). To take advantage of the grace period a regular full US application, US provisional or PCT application may be filed – many candidates didn't know this. (There is also a 1 year grace period for US design patents). Use overseas is not novelty destroying for a US patent application – almost all candidates knew this.

c) The criteria derived from US statute that must be met to prove a date of invention are: conception – of the result and the means to achieve it, reduction to practice– actual or constructive, reasonable diligence – it is necessary to work continuously to reduction to practice, and the invention must not have been abandoned, suppressed or concealed (many candidates missed this last point).

Points in relation to record keeping include records signed and dated by inventor and witnessed regularly by a witness who has "read and understood" their contents, preferred

use of permanently bound lab book, with records in chronological order and entries in ink, electronic records should be printed out for signing and should have appropriate custodial controls, provisions apply to WTO countries after 1/1/96. This part of the question was generally fairly well done.

Question 4:

Not many candidates chose this question. Those that attempted it did reasonably, but tended to lose marks on parts (b) and (c).

a) Both the Chapter I and II deadlines are 30m from earliest priority/filing date. To enter national phase file a request in writing (Form 53) and pay the national fee (reduced for electronic filing); a translation is needed, this can be filed 2m after entering national phase; if there are amendments a translation of these is needed or the amendments are considered not made; an agent must be appointed, by filing power of attorney (a translation is required if this is not in Japanese). Most candidates did reasonably well but few remembered everything.

b) File a request for examination (form) by 3 years from the PCT filing date and pay the fee (reduced where there is an ISR); there are claims fees (per claim), which can be heavy - amended claims can be filed; there are no additional fees for multiple dependency; a third party can request examination. Most candidates knew "3 years" but fewer that it runs from filing; even fewer knew about claims fees.

c) Prosecution can be accelerated; there is no fee. Conditions are a corresponding foreign application (here the JP is based on a PCT application), and it is normal to file the request with copy of a foreign search report - here we should have an ISR. The request is filed (specific form required) with arguments/amendments; there is a need to respond promptly to office actions; a face-to-face interview can be requested; it is helpful if the claimed product/process used in Japan (eg file copy of a licence agreement); grant/rejection should follow within 36m from a request for accelerated examination. Most candidates knew that examination could be accelerated although most thought that there was a fee; few knew the conditions. A little credit was given for checking with a Japanese attorney.

d) Opposition can be filed within 6m from publication of grant; any person (including a straw man) can oppose; there is a fee; alternatively invalidation proceedings can be started before the JPO or in Court. Most candidates knew of the possibility of opposition, and the option of invalidation proceedings was guessable.

Question 5:

This was a popular question. Marks could be picked up quite easily, especially on parts (a), (b) and (d), so most candidates scored well.

- a) Examples of countries in which patent protection cannot be obtained by the PCT route include Thailand, Taiwan, Pakistan, Nepal, Saudi, Malaysia and a number of S. America countries (Hong Kong didn't get a mark as one can get protection in HK by filing a PCT application.) Most candidates did well.
- b) The applicant must be a national or resident of PCT Contracting State (possessing a real and effective industrial or commercial establishment counts as residence); only one applicant need meet the condition. Almost all candidates knew this.
- c) Add own name as applicant, for example for an unwanted state such as Sudan, or for all states and assign back. There is no need for an assignment to the UK patent attorney before filing. The application can be assigned back in international phase after filing (but correction after filing doesn't work as this reinstates a non-entitled applicant). One or two candidates thought that being a UK agent was enough.
- d) Fees due: Transmittal fee, by 1m from filing; the international filing fee consisting of (at the time of the examination) the basic fee and designation fees; the basic fee is due by 1m from filing (there is an additional per sheet fee for >30 sheets); the designation fees (max. 5) are due by the later of 1m from filing/1y from the priority date; search fee by 1m from filing; fee for UK PF23/77 for priority document. This part was mostly well answered.
- e) The application is not lost. The RO request signature within not less than 1m. This was well answered.
- f) To record the change of address write to the RO or IB; no evidence is needed.
- g) Countries for which the Chapter I deadline was still 20 months at the relevant time included Norway, Singapore, Brazil, Tanzania, Yugoslavia, Uganda, Zambia. Most candidates were able to name one of these.
- h) The applicant has at least up to 4m from the filing date; the correction must be within 16m of the priority date as corrected. The applicant should write to the RO or IB (no evidence is needed and there is no fee). Only a few candidates knew this.

Question 6:

Poor candidates often wrote screeds of irrelevant material. Part (a) was generally well done but the answers to part (c) were poor.

- a) Within the Rule 51(4) time limit of (2 to) 4m (extendable by 2m) pay grant and printing fees, file a translation of claims into other two EPO official languages, pay claims fees not already paid (for claims >10 R.51(7)), and file a translation of the priority document(s) (or a declaration) (R.38(5)). Pay the renewal fee if due before the next

possible date for grant (R.51(9)) - due by the last day of month containing the anniversary filing date of the application (R.37(1)). These actions imply approval – there is no need to explicitly approve text proposed for grant. Most candidates did well though some forgot the translation of the con docs and/or renewal fees, and few correctly gave the deadline for renewal fees.

b) The minimum period between issue of the Rule 51(4) Communication and publication of the mention of grant is 5m if no request for accelerated prosecution has been made (A.97(5)). Few candidates got this right. Options for extending the time period for responding to the Rule 51(4) Communication are request an extension, (max. 2m - R.51(4)); and further processing under A.121, which provides not less than 2m extension. Restitutio cannot be used to deliberately extend a time limit as some candidates thought. Extending the time period for responding to the Rule 51(4) Communication delays national validation costs, in particular translation costs, and can enable the payment of a further renewal fee (instead of potentially larger national renewal fees).

c) The applicant does not have a right to amend the claims of the text intended for grant attached to the Rule 51(4) Communication – this is at Examining Division's discretion (minor amendments are generally accepted), except where the R.51(4) Communication is the first from the Examining Division (R.86(3)). This last point was often forgotten. To make such amendments file a translation of the amended claims and pay the fees and perform actions required when responding to the Rule 51(4) Communication. Only the better candidates knew this. If the amendments are not acceptable the Examining Division provides an opportunity to submit observations and any amendments considered necessary (within a specified period), and claim translations, before taking a decision; the EPO may then grant (the applicant is deemed to have approved the amended text) or refuse the application (R.51(6)). Few candidates knew this.