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

Question 1:

This was a popular question and most candidates did reasonably well, although a few had gaps in their knowledge and/or misunderstandings. A sizeable proportion of candidates thought that computer programs were not patentable.

To score high marks candidates not only had to mention the relevant parts of the EPC, but also had to apply them to the questions at issue. Some reasoning was expected, and a conclusion.

Several number of candidates did not read the question carefully enough – answers were only needed to five parts of the question.

a) A method of using life assurance to fund a pension scheme:

This is similar to T931/95 Pension Benefits. Candidates were expected to mention the exclusion for a method of doing business [(Art 52(2)(c) EPC), (Art 52(3))] and to discuss how these could be applied. Computer software/programmed computer implementation of the method could also be discussed.

b) A computer program to control traffic lights for improved traffic flow.

Candidates were expected to mention the exclusion to programs for computers as such [(Art 52(2)(c)EPC), (Art 52(3))]. However many candidates were not aware that a claim to a computer program by itself or on a record carrier may be allowable (EPO Guidelines for Examination C-IV-2.3.6). Candidates were expected to consider the need for technical character [(Rules 27(1), 29(1) EPC)] , and also the possibility of the invention falling into another excluded category, such as a business method exclusion. There is UK and EPO case law (T16/83; Lux Traffic v Pike Signals, 1993 RPC 107).

c) A device for electrifying door handles to prevent burglaries.

The main consideration here was that European patents will not be granted for inventions the publication or exploitation of which is contrary to ordre public or morality (Art 53(a)), although not merely because they are prohibited by law. Candidates were expected to discuss whether the invention might fall into this category, for example depending upon the degree of harm inflicted, and could also consider the possibility of dual use (Guidelines C-IV-3.3).

d) A process for modifying the germ line genetic identity of a human being.

The considerations which may be discussed include Article 53(a) and those relating to Implementation of the EU Biotechnology Directive for patents relating to biotech inventions [(Rule 23b(1),(2)), in particular Rule 23d EPC (although specific knowledge of the Biotech Directive was not expected)]. The method of treatment exclusion could also have been mentioned.

e) A partial gene sequence whose function is unknown.

The considerations which may be discussed include the need to disclose the industrial application of a sequence or partial sequence of a gene [(Rule 23e; Art 57 and Rule 27(1)(f))], although a plausible function may be suggested. If no function is provided then refusal may be on inventive step grounds. The Guidelines for Examination also note that where a partial sequence of a gene is used to produce a protein or a part of a protein, it is necessary to specify which and what function this protein or part of a protein performs (C-IV-4.5).

f) A genetically modified plant, not confined to a specific plant variety.

The considerations which may be discussed here include Art 53(b), which states European patents shall not be granted in respect of plant varieties, Rule 23c(c), which implements Article 53(b), and Rule 23b(4) which defines "plant variety" and states that biotech inventions concerning plants are patentable if the technical feasibility is not confined to a particular plant variety. This follows G1/98 which decided that a claim wherein specific plant varieties are not individually claimed is not excluded from patentability under Article 53(b) EPC even though it may embrace plant varieties and further noted that if there are claims to a process there may also be product-by-process protection under Art 64(2) EPC.

g) A method of operating an internet auction involving more efficient data storage and communication.

The considerations which may be discussed here include the scheme, rule or method of doing business as such exclusion. Marks were available for a reasoned discussion of technical contribution (the question hinted at this), the lack of any significant difference between the form of claim in this respect (apparatus, method, software). The Hitachi case (T258/03) could also have been mentioned.

h) A process for genetically modifying a mouse so as to be suitable for testing cosmetics, the method involving a painful operation on the animal.

The considerations which may be discussed include Article 53(a) and the factors specified in Rule 23d (suffering, substantial medical benefit, and the relation between the two). Here there was no suggestion of medical benefit (although if there were the claims might have been limited in this way). The Oncomouse decision (T315/03) and the possibility of non-animal alternatives could also have been mentioned. Again specific knowledge of the Biotech Directive was not expected.

Question 2:

This question was generally well done by those who attempted it; the part of the question relating to China could be answered from basic knowledge and general principles. The comments below outline the main points; further details can, for example, be found in the Brown Book.

A. In Australia before grant there is informal opposition (3rd party observations); the grounds are limited to lack of novelty/inventive step. The procedure is cheap and simple but the opponent does not become a party to proceedings.

After grant opposition is available; this must be filed within 3m of (date of) advertisement of acceptance. The grounds include entitlement, and support/sufficiency, broader than informal opposition; the opponent must watch for advertisement of acceptance.

Other options include re-examination (which must be based on documents rather than, for example prior performance of acts), and revocation in Court (where any grounds can be raised).

B. The PCT national phase entry deadlines in Japan are 30m from earliest priority/filing date for both Chapters I and II.

The main actions needed are: request national phase entry in writing, file a translation of the application by 2m from national phase entry (or 30m from priority if this is later) and of any amendments made during international phase, and file power of attorney/appointment of agent.

C. Points which could be made in relation to patent protection in China include

China is a member of Paris Convention and a member of the PCT (with a 30m national phase deadline). A translation into Chinese needed and an agent must be appointed. Separate protection is needed for the Hong Kong Special Administrative Region (this can be based on a CN application), and for Taiwan. A Chinese patent has a maximum duration of 20y from filing. China has absolute novelty (but local use), 18 month publication, full substantive examination (an exam request and fee is due 3y from filing/earliest priority); renewal fees are due for an application (for the 3rd year onwards). There is no opposition; utility model protection is available.

Question 3:

A. Candidates were expected to discuss the possibility of security considerations here. The change in the UK regime does not mean that defence/security considerations no longer apply – rather the onus is on the attorney to give thought to this. Further, candidates were expected to propose a solution which a) did not lose the priority of the US provisional, and b) which captured the new developments.

The filing options are separate US, GB and DE national applications, separate US national and EP applications, and a PCT application (which automatically designates all three relevant countries). The options for where to file are, respectively, in the US, GB and DE, in the US and in the UK PO or at the EPO, and in the US, GB or DE or at WIPO (competent Receiving Offices are each RO of a state for which an applicant is national or resident – Art 10, Rule 19 PCT).

The question does not specify whether the invention is related to national security or public safety, and this possibility must be considered. No foreign filing licence is required for the US work because the US provisional application was first filed in the US more than 6 months ago and there was no further inventive contribution in the US or by the US inventor. In the UK if security considerations apply inventors resident in the UK (irrespective of nationality) must file first in the UK. No security clearance is required for Germany (but security considerations go with residency anyway).

The preferred filing option is therefore a PCT application, which should be filed, at the UK PO as RO. Some candidates mentioned the need for a German translation at short notice; some credit was given for considering this, but more for knowing that an application can be filed in English at the German PO with a translation later.

B. Non-publication of an EP application is guaranteed if it is withdrawn before the termination of the technical preparations for publication (Rule 48(2)EPC). These are deemed complete 7w before expiry of the 18m period from filing/earliest priority (Guidelines A-VI-1.2), although withdrawal may be effective if later than this (so that it is possible, though not necessarily recommended, to use notification of publication as a trigger).

A refund of examination fees is available (Fees Rules 10b), either 100% or 75%, depending on whether an examination division has assumed responsibility (which generally happens when an exam request/proceed confirmation is made after receipt of the search report).

Non-publication of a PCT guaranteed if it is withdrawn before the termination of the technical preparations for publication (Art 21(5); Rule 90bis.1(c) PCT). These are deemed complete 15d prior to due date of publication (PCT Applicant's Guide Vol I, Ch VIII, section 305). No refund of fees is available.

Publication of a US application can be prevented (other than if it is withdrawn) if a non-publication request made on filing, declaring that the invention is/will not be the subject of a patent application filed outside the USA. (If the US application is more extensive than corresponding foreign applications the applicant may file a redacted copy for US publication).

C. This part of the question was generally very well done, perhaps because of the recent landmark UK judgement in Kirin-Amgen v TKT. Details of the answer can be found in Art 69 EPC and the Protocol to Article 69.

D. The main point here is that infringement and validity are determined by different courts in separate proceedings: validity (nullity) is determined by the Federal Patent Court (in Munich), and infringement determined by district Courts, of which there are several. (However a district Court may take a prima facie view on validity if there is serious doubt and stay proceedings). Appeal possible for both (two levels). Damages are generally low and proceedings fairly quick and relatively inexpensive with (currently) very limited discovery. Other points can be found in the Brown Book.

Question 4

This question was popular and generally the answers very good. Reissue was the least well known of the topics. Sources of information on US law and practice include the Brown Book and the USPTO MPEP (which is available on the internet). The comments below provide a non-exhaustive summary of the more significant points.

a) Fees due at filing include a basic filing fee, search fee and examination fee, an application size fee (if total specification exceeds 100 sheets), a fee for each independent claim in excess of three, for each claim in excess of 20, and a fee for multiple dependent claims. These are reduced by 50% if the applicant is entitled to small entity status (broadly, an individual, small business or non-profit organization). Maintenance fees are due at 3.5, 7.5, 11.5 years from grant, and can be paid up to 6m late with a surcharge.

b) Re-examination may be ex parte (MPEP 2200) or inter partes (MPEP 2600). It may be requested at any time after issue by any person, but can only be based on printed publications. There must be a substantial new question of patentability of a claim. Claim broadening is not allowed and if claim scope changed intervening rights may be available.

Ex-parte re-examination is available against any patent but inter-partes re-examination is only available only against patents filed after 28 Nov, 1999. Ex-parte re-examination is useful, for example, to ensure validity over newly discovered prior art and a request may be may be filed by a representative (attorney); there is a duty of disclosure and a right of appeal for the patentee.

Inter-partes re-examination is a written procedure. Both parties have a right of appeal (and the real identity of a third party requester cannot be kept secret). A disadvantage of inter-partes re-examination is that it creates estoppels – a third party requester cannot again raise invalidity issues on any ground which was raised or which could have been raised in re-examination.

c) Reissue is only available when there is an error or defect in a patent (for example arising from discovery of new relevant prior art or failure to claim the full scope of

protection). This must have arisen without any deceptive intention and must cause the patent to be wholly or partly inoperative or invalid.

Claim broadening is allowed provided the re-issue application is filed within 2 years of grant of the original patent (but not recapture of claim scope surrendered during prosecution of the original application in order to secure grant). A normal examination procedure applies (with a duty of disclosure) and re-issue is granted after surrender of the original patent, for the unexpired term. Intervening user rights may be available where the claim scope has changed.

d) This part of the question was almost always very well done. 35 USC 102 (g) forms the basis of the proceedings and a summary of the main points (and some procedural detail) can be found in the Brown Book.

Question 5

A. Some candidates confused the EP and PCT non-unity procedures.

The applicant cannot contest the opinion of the search division (until the examination stage - Rule 46(2) EPC). The consequences of not paying any additional fees are that a partial search report is drawn up on the invention first mentioned in the claims. The non-unity finding is reviewed at the examination stage (Rule 46(2)EPC, Guidelines for Examination C-III-7.10), although under BEST/the new Rule 44a procedure the review may be by the same person. The applicant can contest the non-unity opinion at the examination stage, by submitting arguments for unity to the Examiner (Guidelines for Examination C-III-7.10, B-II-4.2; for example, arguments based on Art 82, Rule 30(1) EPC).

If the non-unity opinion is confirmed, the claims must be limited to the searched invention (Guidelines C-III-7.10; G2/92). Further, amended claims may not relate to unsearched subject matter which does not combine with the searched invention to form a single inventive concept (Rule 86(4)EPC Guidelines C-VI-5.2). One or more divisionals may be filed. To appeal the examiner's view the applicant must obtain an adverse decision on non-unity, for example refusal of the application (or of a main request) (Art 107). This last point was rarely appreciated.

B. A European divisional application can be filed as soon as the application is pending (Rule 25(1)EPC). (Some candidates mentioned that a filing receipt takes some time to come through, but with e-filing a filing receipt is received immediately).

The last day a divisional can be filed is the day before the publication of the mention of grant (Guidelines A-IV-1.1.1). A divisional can be filed during Appeal proceedings following refusal of an application by an Examining Division because the appeal has suspensive effect (Art. 106(1)EPC). (Candidates were not expected to know about J28/03, which in any case refers to an appeal against a decision to grant, not refuse, an application). A divisional cannot be filed during Opposition proceedings, because the application is no longer pending at that stage (Rule 25(1)EPC).

A divisional can only be filed at (a filing office of) the EPO, in particular Munich, The Hague or Berlin (Art 76(1) EPC; Guidelines A-IV-1.3.1 and A-II-1.1). When filing a divisional application the subject matter may not extend beyond the content of the earlier application as filed (Art. 76(1)EPC). The established practice of the EPO is to allow amendment of the divisional application, by removal of the additional subject matter, to meet the requirements of Art 76(1) EPC (T39/03 and Guidelines C-VI-9.1.4). (This has now been questioned and the matter has been referred to the Enlarged Board of Appeal as G1/05, although candidates were not expected to know this at the time of the examination).

A second divisional can be filed from a first divisional (if the first divisional is validly filed - T1158/01), but only to subject matter in the first divisional. (Candidates were not expected to discuss in detail the question of how the subject matter in the first divisional is assessed – for more information see recent decisions T720/02 and T797/02).

The filing, search, and claims fees are due within 1m of filing (Rule 25(2)EPC, Rule 31(1)EPC); designation and examination fees are due within 6m of the date of publication of the search report on the div (Rule 25(2)EPC; Art. 94(2) EPC). It was disappointing that many candidates did not know the due date for the designation fees.

When a divisional is filed more than two years after the parent is filed the "back renewal" fees may be paid within 4m from filing of the divisional (without additional fee) (Rule 37(3) EPC). However the back renewal fees fall due when the divisional application is filed and this starts the late payment period (Rule 37(3) EPC).

Question 6

Candidates generally scored well on this question.

a) Utility model (or similar) protection is available in France (6y), Germany (10y), Ireland (10y), Italy (10y) and The Netherlands (6y).

b) Canada has a grace period of 1y before the date of filing of the application in Canada. The European countries are harmonised with the EPC and have no grace periods (except under the very limited circumstances of evident abuse or similar, and disclosure at certain international exhibitions).

c,d) France, Ireland, Italy and The Netherlands cannot be obtained as national patents via the PCT route. The same countries lack full substantive examination.

e) Opposition is available in Germany (within 3m from publication of grant), and Sweden (within 9m from publication of grant).