

THE JOINT EXAMINATION BOARD

PAPER P5

Basic Overseas Patent Law and Procedure

Monday 6th November 2006

2.00 p.m. – 5.00 p.m.

*Please read the following instructions carefully. **Time Allowed – THREE HOURS***

1. You should attempt **five questions**. If more than five questions are answered, the first five will be marked and the sixth ignored.
2. Each question carries 20 marks. The marks attributable to individual parts of each question are shown.
3. Please note the following:
 - a. Start each question (but not necessarily each part of each question) on a fresh sheet of paper;
 - b. Enter the Paper Number (P5), the question number and your Examination number in the appropriate boxes at the top of each sheet of paper;
 - c. The scripts are photocopied for marking purposes. Please write with a **dark inked pen** on one side of the paper only and within the printed margins, and do not use highlighters in your answer;
 - d. Do not staple or join pages together in any way;
 - e. Do not state your name anywhere in the answers;
 - f. Write clearly, as examiners cannot award marks to scripts that cannot be read;
 - g. Reasoning should always be given where appropriate.
4. Under the Examination Regulations **you may be disqualified from the examination and have other disciplinary measures taken against you if:**
 - a. you are found with unauthorised printed matter or other unauthorised material in the examination room;
 - b. your mobile phone is found to be switched on;
 - c. you copy the work of another candidate, use an electronic aid, or communicate with another candidate or with anyone outside the examination;
 - d. you continue to write after being told to stop writing by the invigilator(s). **NO WRITING OF ANY KIND IS PERMITTED AFTER THE TIME ALLOTTED TO THIS PAPER HAS EXPIRED.**
5. **At the end of the examination assemble your answer sheets in question number order and put them in the WHITE envelope provided.** Any answer script taken out of the examination room will not be marked.

This paper consists of seven pages, including this page.

Question 1:

A. What are the minimum requirements for obtaining a filing date under the European Patent Convention (EPC)?

[5]

B. In relation to a priority claim in a European patent application:

(i) From which of the following can a European Patent Application claim priority?

- (a) An application for registration of a utility model in France
- (b) An application for a patent in Thailand
- (c) An application for registration of a design in the USA

(ii) What information is required for a valid declaration of priority at the time of filing? What additional information is required, and by when?

(iii) By when must a copy of the priority document normally be filed? Need it be certified? Need it be on paper?

(iv) Under what circumstances is a priority document not required?

(v) What are the consequences of failing to provide a copy of the priority document in time?

(vi) What may an applicant file in place of a translation of the priority document? What is the time limit?

[10]

C.

(i) Can two European patents with the same priority date and designated States, and claims to the same invention, be granted to the same applicant?

(ii) Can a parent and divisional contain claims of substantially identical scope when the parent and divisional are granted and in force? If the parent has an independent claim to A and the divisional an independent claim to B, can each include a dependent claim to A+B? Can an independent claim of a divisional patent be broader than any independent claim in its parent?

(iii) In many EPC States, including France and Germany, simultaneous protection of the same invention by the same proprietor in a European patent and a national patent is not allowed. In general, what provisions does the national law make to address this?

[5]

Question 2:

A. Write notes on the novelty requirements for patents in the USA having regard to the following types of prior art. Do not consider entitlement or interference.

- a) printed publications
- b) prior use
- c) sale/offer for sale
- d) prior patenting
- e) co-pending applications

[10]

B. You have a UK-based client with a business method invention which, though apparently new, you consider would be inherently unpatentable in Europe. Your client would like to file a national application first in the USA. Can this be done?

At the end of the priority year the client, a UK national, decides to file a PCT application. Where can this be filed?

[4]

C. You have filed a US utility patent application, claiming priority from an earlier UK filing. You discover a published US patent application with a US filing date before that of your UK priority application and with a publication date after your US filing date.

Can this be cited against your application for a) novelty, b) obviousness?

What if the published US patent application has a filing date between your UK priority date and US filing date (the published US patent application does not claim priority from any earlier application)? (Do not consider any potential interference proceedings).

[4]

D. Does statutory US patent law have any provisions for prior user rights independent of the inventor, and if so, what are they?

[2]

Question 3:

A. Compare and contrast utility model protection in Germany and Japan. Consider, in particular, the following:

What can be protected?

What are the novelty requirements?

How do the inventive step requirements compare to national patents?

Is there any examination process, and any opposition?

What is the term?

Can they be converted from or into patent applications, and when?

Can third parties request examination?

What steps must be taken before enforcing the utility model?

Can they be designated in a PCT application?

Can they claim priority from a local national patent application?

[12]

B. Write brief notes on the provisions relating to employee inventions in Germany.

[4]

C. What is the deadline for requesting examination of a standard patent application in a) Germany and b) Japan?

[2]

D. What is the time limit for filing an Opposition in Germany?

[2]

Question 4:

Your UK client has filed a PCT application at the UK Patent Office. The International Search Report (ISR) has been issued together with a written opinion on patentability, and your client would like to know more about the international examination process.

- (i) When is the deadline for filing a demand for international preliminary examination (IPE)? Does requesting IPE have any effect on the national phase deadline for the EPO, the USA and Japan? [3]
- (ii) Does the applicant have a choice of International Preliminary Examination Authority (IPEA)? Would the situation be any different for a US-based applicant? [2]
- (iii) Give three reasons for and three reasons against requesting IPE. [6]
- (iv) Briefly describe the IPE procedure (do not consider non-unity). What options does the applicant have to disagree with the examiner? Is there an Appeal process? [4]
- (v) The client would like to begin IPE early. Can this be done, and if so how? By when should the International Preliminary Examination Report (IPER) be received? [4]
- (vi) After requesting IPE the client changes his mind and wants to withdraw the request for examination. What proportion, if any, of the official fee will be refunded? [1]

Question 5:

Write notes on:

- A. The use of disclaimers before the EPO [6]
- B. Third party observations before the EPO [6]
- C. The patentability at the EPO of methods of treatment by surgery. [4]
- D. The patentability of software and business method inventions in the USA and at the EPO. [4]

Question 6:

You filed a PCT application in English for your UK-based client on 1st September 2006, without a priority claim and designating all possible states. The enthusiastic client has expressed an interest in seeking protection for the invention in the following countries:

UK
USA, Canada
Norway, Sweden, Iceland, Russia
Israel, Saudi Arabia, United Arab Emirates
S. Korea, Japan, India, People's Republic of China (PRC), Singapore, Hong Kong, Taiwan
South Africa

(i) What filing programme would you recommend? [10]

(ii) Excluding the European countries, which of the above are PCT States having a 31 months deadline for entering the national phase?

(iii) Excluding the European countries, which of the above are PCT States requiring translations of the PCT application into the local language when entering the national phase? For which of these countries must a translation into the local language be filed by the deadline for national phase entry?

(iv) Your client tells you that the entire subject matter of the application was presented by him at a conference on 1st June 2006 and published on the same day as an academic paper. Name two of the above countries which, for standard patents, have a 6 months grace period and three which have a 12 months grace period in respect of disclosures by the applicant or his predecessor in title.

[10]