

THE JOINT EXAMINATION BOARD  
PAPER P5  
BASIC OVERSEAS PATENT LAW AND PROCEDURE  
6th November 2006

EXAMINER'S COMMENTS

The following comments include references to Article and Rule numbers for the convenience of candidates. Candidates are not expected to quote Article or Rule numbers in their answers.

Question 1:

This question was generally well answered, although many candidates thought that the consequences failing to provide a priority document in time were immediate loss of the priority date.

Useful sources of reference material in relation to European Law are the online versions of the EPC and EPO Guidelines for Examination, and the EPO publication "National law relating to the EPC".

A. The requirements for obtaining a filing date under the European Patent Convention are set out in Article 80 EPC. Several candidates thought that an abstract was required; some that fees were needed. The requirement for a prescribed language (an official language of a Contracting State) was often omitted as was (less often) the need for the designation of at least one Contracting State.

B. Most candidates knew that priority could be claimed from the application for registration of a utility model in France. However the EPC defines a self-contained system of priority so that even though Thailand is a member of the WTO priority cannot be validly claimed from an application for a patent in Thailand (G2,3/02). Priority cannot be claimed from an application for registration of a design in the USA (Art 87 EPC).

The relevant provisions for a valid declaration of priority are set out by Art 88(1) and Rule 38(1). At the time of filing only the date and country are required; the file number is needed by end of the 16<sup>th</sup> month after the date of priority.

The main requirements for filing a copy of a priority document can be found in Rule 38(3). It must be filed by end of the 16<sup>th</sup> month after the date of priority and it must be certified - although it need not be on paper - an electronic version will do (Guidelines for Examination A-III-6.7).

Where priority is claimed a priority document is not required if the priority document is

an earlier EP (or PCT filed at EPO), an earlier JP (or PCT filed at JPO), or in the case of a divisional (Rule 38(4); A-III-6.7; A-IV-1.2.2).

The consequences of failing to provide a copy of the priority document in time are not that priority is lost. The EPO write, typically setting 2 month deadline for responding (Art 91(1)(d)-(3); A-III-14.2, Rule 41(1) and Rule 84). If this deadline is missed then priority is lost.

In place of a translation of the priority document an applicant may file a declaration under Rule 38(5), by the time limit for the Rule 51(4) response (Rule 38(5); A-III-6.8).

C. Two European patents with the same priority date and designated States, and claims to the same invention, cannot be granted to the same applicant (C-IV-6.4). Similarly a parent and a divisional cannot 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, they cannot both include a dependent claim to A+B (C-VI-9.1.6). Provided that the requirements of Art 123(2) are met an independent claim of a divisional can be broader than any independent claim in its parent.

In, for example, France and Germany simultaneous protection of the same invention by the same proprietor in a European patent and a national patent is not allowed and the national patent ceases to have effect after a final grant/maintenance decision on the EP (Art 139(3) EPC; National law relating to the EPC, Chapter X).

Question 2:

A. This part of the question was, essentially, about 35 USC 102(a),(b),(d), and (e). Candidates were expected to demonstrate they knew and understood these provisions, although in-depth knowledge was not required and only the basics were needed for full marks. Few candidates knew the provisions of 102(d), which relates to prior patenting, albeit it is rare for this provision to bite for UK practitioners. The USPTO online MPEP can be helpful for understanding these provisions (eg. sections 706.02 and 2132 et seq.).

B. The UK-based client can file in the USA, although candidates needed to mention the (admittedly unlikely) possibility of security considerations to obtain full marks. For a UK national/resident the PCT application can be filed at the UK PO, EPO or IB (Rule 19 PCT).

C. In the first case the published US patent application can be cited for both novelty and obviousness - some candidates thought novelty only, perhaps extrapolating from the position in Europe. In the second case the published US patent application cannot be cited for novelty or obviousness (more precisely, it may be cited but the UK priority date can be used to get behind the published US application).

D. Unlike in Europe, US patent law only provides statutory prior user rights for business methods, and then only if there was commercial use at least 1 year prior to the application/priority date (apart from special circumstances, eg. when claim scope is altered on re-issue).

Question 3:

A. The majority of candidates who attempted this question achieved very high marks on this part. The 'Brown Book' is a convenient source of information on both DE and JP utility models. One common misconception, however, was that a JP utility model cannot be obtained via the PCT procedure (cf Box No V of the PCT Request form, and the PCT Applicant's Guide for JP national phase). There is a debate in Germany on the level of inventive step needed for a utility model there. The consensus is that the level of inventive step is probably similar to a conventional patent, but a lower level of inventive step was nevertheless marked as correct.

B. This part of the question was not well done and many candidates seemed to guess that Germany has similar provisions to the UK, which is not the case. Broadly, an employee must notify his employer of the invention and if the employer has a right to the invention (eg made in course of employment) he must claim this right (within 4 months) or lose it. Further, the employer must remunerate the employee eg. with an approximation to a reasonable royalty.

C. The deadline for requesting examination of a standard patent application in Germany and Japan is 7 years from filing and 3 years from filing, respectively.

D. As almost every candidate knew, the time limit for filing an Opposition in Germany is 3 months from publication of grant.

#### Question 4:

The deadline for filing a demand for IPE is the latest of 22 months from the earliest priority date and 3 months from transmittal of the ISR (Rule 54bis.1(a)) - except for the few countries which have not yet implemented extended Chapter I. This has no effect on the national phase deadline for the EPO, the USA and Japan.

The UK applicant does not have a choice of IPEA - the EPO must be used. However a US-based applicant has a choice, and can use the EPO if the EPO was the ISA (PCT Applicant's Guide Vol I, Annexes D, E).

There are many reasons both for and against requesting IPE. Some reasons for are: to amend or deal with objections in the international phase to reduce cost/time later, to obtain a better indication of likely protection, for example for licensing or to inform the national phase decision, to accelerate EP grant; some against are: the different definitions of prior art/different requirements for inventive step in different jurisdictions, the risk of creating estoppels, the limited time for the IPE procedure/time pressure on the Examiners, increased costs, at least in the short term.

The IPE procedure is described in the PCT Applicant's Guide Volume I; some relevant PCT provisions are: Article 34, Rule 66.1bis, Rule 66.2(d), Rule 66.4, Rule 66.4bis. Few candidates seemed to have practical experience of the procedure before the EPO. Details are set out in the EPO Guide for Applicants Part 2-D-142 et seq. In particular the Written Opinion attached to the ISR is considered as the first Written Opinion and, as a general rule, no second WO is issued. The first WO is not re-issued and thus before the EPO the applicant must respond to the WO attached to the ISR when requesting IPE. As most candidates knew, there is no appeal process.

IPE can be started early (providing the ISR has been established - Rule 69.1 PCT). The applicant must file the Demand, pay the fee, and expressly request that IPE start early (Rule 69.1 PCT). The time limit for establishing the IPE is set out in Rule 69.2 PCT (although there is no sanction for missing this).

If the request for examination is withdrawn before examination has started 75% of the examination fee is refunded (and the handling fee in some circumstances); otherwise there is no refund (PCT Applicant's Guide Vol I Annex E; EPO Guide for Applicants Part 2-D-II-136).

### Question 5:

Few candidates knew very much about disclaimers. Details can be found in EBA Decisions G1,2/03.

By contrast most candidates achieved very high marks on third party observations; inter alia Art 115 EPC and EPO Guidelines for Examination E-VI-3 refer.

For the patentability of methods of treatment by surgery reference can be made to Art 52(4) EPC, the EPO Guidelines for Examination at C-IV-4.2,4.2.1, and case law, eg. T0182/90 SEE-SHELL. Some candidates (erroneously) thought that cosmetic surgery is patentable in the EPO.

Most candidates made sensible comments on the patentability of software and business method inventions in the USA and at the EPO. Candidates were expected to set out the basic position in the USA and the EPO and to mention the EPO's requirement for technical character.

### Question 6:

Candidates were expected to recommend an EP for the UK, Sweden and Iceland (Sweden has not extended PCT Chapter I but the national route for SE would not normally be recommended). Some candidates did not know that Iceland is in the EPC; others thought that Norway is - which it is not (yet).

Most candidates knew that Taiwan is not in the PCT or in the Paris Convention; fewer however knew that it has a reciprocal arrangement with the UK so that priority could be claimed from the PCT first filing (further information can be found on the UK PO web site). Saudi Arabia is not in the PCT but is in the Paris Convention. Hong Kong is not in the PCT but protection can be based on a UK, EP(UK) or CN application.

Countries (outside Europe) having a 31 month deadline for entering the national phase are Russia, Korea and India. Outside Europe (Norway) English can be used for all the countries listed except Russia, Japan, China and Korea and, of these, only Korea requires a translation at national phase entry (marks were also given for China, although an extension is effectively available). Grace periods of 6m are available in Japan, Russia, South Korea, China (restricted), Taiwan, India, and of 12m in Canada, the USA, Singapore and Saudi Arabia.