

THE JOINT EXAMINATION BOARD
PAPER P5
BASIC OVERSEAS PATENT LAW AND PROCEDURE
5th November 2007

EXAMINER'S COMMENTS

Question 1:

(References to the EPC are to the old Articles and Rules unless otherwise stated)

Useful sources of reference material are the EPC, the EPO Guidelines for Examination (both online), and textbooks such as "The Annotated EPC [2000]" by Visser and also (for the coming year) "A Guide to the EPC2000" by Fox.

A. A list of EPC Contracting States with dates of joining the European Patent Organisation can be found, for example, on the EPO website. Candidates were expected to note that Croatia and Albania were extension states.

B. The answers to this part of the question can be found in Rules 78, 82, 84a and 85EPC (now, broadly, Rules 125, 126, 133 and 134). The 10-day rule was, in general well known; the EPO uses registered letters.

The rules relating to late receipt of documents were less well known; there were also two cases to consider: late receipt at the EPO and late receipt of letters sent by the EPO to the recipient. In the former case, for excusal, one of a specified list of delivery services must be employed. In the latter case it was not well known that the onus is on the EPO to prove date of notification (Rule 78(2), Rule 82EPC; new Rule 125(4)) – which they should be able to do since registered post is used.

Regarding extensions when national or EPO filing offices are closed, there were again two cases to consider. Many candidates knew that if a time limit expires on a day when any filing office of the EPO is closed then the time limit is extended to the first day when all the EPO filing offices are open. However few knew that the only case when a national filing office is considered is when filing a priority claiming application [Rule 85(3); new Rule 134(3)].

C. Many candidates did not properly know or understand the application of Article 54(3). In part (i), the use of French is irrelevant, but candidates were expected to mention checking for payment of designation fees to determine overlap (this will no longer apply under EPC2000). In part (iii), the after-grant validation countries chosen are irrelevant. In part (iv) candidates were expected to mention the possibility of different claims for Germany (Rule 87 (new Rule 138), with Article 139). The answer to part (v) can be found in Article 158EPC (new Article 153); and currently the prior art effect is only for states for which designation fees are paid. The reference in the Australian application is a prima facie indication of the common general knowledge when the client's application was filed, but this would need to be confirmed.

Question 2:

This question was generally well done. Candidates were expected to have a general knowledge and appreciation of the relatively wide variation in procedure in the patent systems across Europe.

Answers can be found, for example, in the Kluwer Manual of IP (the “Brown Book”), or in its equivalent online version. Almost all candidates had an excellent knowledge of the patent application procedure in France and Germany.

Details of provisional protection can be found in Article 67 EPC. Further details were not required for the answer, but can be found in the EPO publication "National law relating to the EPC".

Question 3:

There were many very good to excellent answers to this question. Again the Kluwer Manual of IP is a good starting point for material on the topic. Of those who did less well, in some cases it was apparent that a more structured approach would have helped: the question specified some points to be considered, and taking care to address each of these could have helped some weaker candidates to avoid missing points to which they perhaps knew at least a partial answer.

The phrase “teaching, suggestion, or motivation” is used in connection with assessing obviousness. The emphasis on this has been lessened since the U.S. Supreme Court case *KSR Int’l Co. v. Teleflex Inc.*, 127 S. Ct. 1727 (2007). Candidates are referred to this case, and to the extensive commentary available online, for further information.

Question 4:

A. Article 76 EPC and Rule 25 (new Rule 36) provide most of the answers to this part of the question. For further details reference can be made to the EPC Guidelines for Examination Part A, Chapter IV. For examination fees, Article 94(2) refers (new Rule 70); for back renewal fees (these are often forgotten and yet they can add significantly to the cost of a divisional), see Rule 37(3) (new Rule 51(3)). The better candidates mentioned the possibility of a refund of the search fees if a relevant search had previously been requested on the parent application.

With regard to the permitted applicant for a divisional, see the EPO Guidelines at A-IV-1.1.2. In a case where there are multiple applicants, the divisional should be filed by all the applicants (not just some of them) unless a transfer has been registered first (see J2/01). For details on the “no added matter” requirements candidates are referred to G1/05 and G1/06.

Details of the Further processing and Restitutio in integrum procedures can be found in Article 121 and Article 122 EPC, respectively, and also in the EPO Guidelines for Examination at Part E, Chapter VIII, Section 2.

Question 5:

A. This part of the question asked for specific details of actions to be taken, not just for an explanation of the relevant law.

With regard to part (a) candidates were expected to know that if the applicant is not identified no filing date is accorded, and thus this should be corrected as quickly as possible. Re part (b), the deadline for filing formal drawings is generally extendable, but eventually, if none are provided, the application will be deemed withdrawn. For part (c), most candidates knew that a receiving office must provide an opportunity to submit a priority document within a reasonable time limit (Rule 17.1(c)PCT). The rules for addition of a missing priority date, part (d), are set out in the PCT Applicants Guide.. In part (e) no action is needed but recordal during the international phase of the application is recommended (to save costs).

B. The IB treats the response as informal comments and these are communicated, with the IPRP, to the designated offices (not before 30m from priority).

C. Candidates were expected to consider early national phase entry, and the possibility of a German utility model (Gebrauchsmuster). After European national phase entry, as well as acceleration of the EP application a Gebrauchsmuster could be branched-off the European application (this can also be done post grant if an opposition is filed). The infringer should be put on notice.

D. A significant number of candidates thought that the ISR would only be available after EP national phase entry. Correspondingly, some thought that the EPO’s Written Opinion would be available before national phase entry (which it is not – Rule 44ter PCT). The possibility of an indicative view from an equivalent, in particular a possible German priority application, could also have been mentioned. National phase entry could be monitored using the EPO’s WebRegMT service.

E. Surprisingly few candidates knew that EP national phase can be entered late, up to 2 months from notification that the deadline has been missed, on payment of a fees surcharge of ~50% (Rule 108(3)EPC; (different) new Rule 160(3)).

Question 6:

This question was generally well done. Good marks given for consideration of different possible claim categories and for thoughtful answers. Reasons for (non)patentability were expected.

In Part (i) candidates were expected to know that software with technical character is patentable under the EPC; the reference to image enhancement was intended to bring to mind Vicom (T208/84). In Japan, methods of treatment of the human body are not patentable (but methods of treatment of the animal body are). Although methods of treatment are patentable in the USA there are limitations on their enforceability (35 USC 287(c)).

In Part (ii) candidates were expected to consider the “pure” business method, the computer system, and the associated software. Again reasons were expected – for example for the USA reference could be made to the “useful, concrete and tangible” result test or to a decision such as State Street or Lundgren; the software should be claimed on a computer-readable medium or carrier (Beauregard). In Japan, a claim to a “pure” business method (divorced from any technology) is not patentable, but a business method implemented on a computer system is patentable.

In Part (iii) candidates were expected to mention second medical use claims for the EPO and Japan (currently the “Swiss style” is required in the EPO) whereas in the USA a method of treatment claim would suffice. For the USA there is local novelty as regards prior use (those who are interested can look up the Neem Tree and Turmeric cases). A few candidates considered the possible patentability of the isolated active element; candidates could also have considered whether such a claim would be enabled, and potential dosage form/pharmaceutical composition claims.