

THE JOINT EXAMINATION BOARD
PAPER P5
BASIC OVERSEAS PATENT LAW AND PROCEDURE
10th November 2008

EXAMINER'S COMMENTS

Question 1:

There are many sources of information on EPC2000 including various commentaries and information on the EPO website.

With regard to further processing, notwithstanding the above some candidates did not appear to be aware of the new provisions.

With regard to central limitation, it was frequently overlooked that a request for limitation is examined for clarity/support (Art 84 EPC) and added matter (Art 123 EPC) as well as to check that it is in fact a limitation (Rule 95(2) EPC). The ab initio effect (as from grant) of limitation was also sometimes missed. Material from the description and can used, and new claims can be added, provided the other requirements are met. Although it was not required in the answer, the EPO Guidelines state that limitation may be requested even after expiry of a patent.

Privilege applies to communications between the EP representative and the client. Classes of documents privilege applies are listed in Rule 153(2) EPC.

Question 2.

Part A generally referred to the new EPC provisions relating to filing by reference, and to the new remedies. The answers are basically in Rule 40 EPC. Points which were commonly overlooked include the need for a certified copy (Rule 40(3) EPC) unless a certified copy is available (Rule 53(2) EPC), and the need to file a translation within 2 months. Also it is necessary to state that the reference replaces the claims (Rule 57(c) EPC).

Where (in Part (ii)) amended claims were provided, these should have been filed, again followed by a translation. There was some confusion over when the amended claims could be filed, but if the amended claims were not filed with the application there could be difficulties with added matter in introducing them later.

Part (iii) related to re-establishment (Art 122 EPC); there are special provisions relating to the priority period (Rule 136(1) EPC). The requirement of all due care looked likely to have been met.

There are new provisions relating to missing drawings (Rule 56 EPC) which allow the drawings to be added without re-dating of the application. This applies under certain

conditions, in particular that the drawing(s) are completely contained in the priority application. It needs to be stated where the documents can be found in the priority document and a translation of any text in the drawing is needed (the Japanese priority documents are available to the EPO so these are not required).

Part B related to similar PCT provisions (Rule 26bis.3 PCT). However it was important to note here that not all countries will recognise restoration of a priority right in this way, because countries are permitted to make reservations if their national law is incompatible (even if the Receiving Office allows the restoration). Details for each country can be found on the WIPO web site, although these were not required for the answer.

In Part C, there are two requirements (intervening prior art and no declaration that the application is a complete translation of the previous application – Rule 53(3) EPC).

For Part D there are many sources of information on the London Agreement. There was some confusion relating to member countries without English, French or German as a local language – a translation of the claims into the local language may be needed but no translation of the description is needed if the language of the proceedings is their chosen official language.

Question 3.

Part A (i) – there are statutory interpretations under US law for “means plus function” and “step plus function” language in a claim, as set out in 35 USC 112 para 6. This language covers the corresponding structure, material, or acts described in the specification and equivalents thereof (it is generally viewed as narrow).

For Part (ii), if a joint inventor cannot be found after diligent effort (the bar is high), the application may continue. A petition should be filed supported by a declaration and accompanying evidence.

The USPTO requirements for extensions of time can be found in the USPTO MPEP. The main options following a final action are RCE/continuation, appeal, and abandonment of the application, although there is a possibility of having minor amendments considered. Thus (Part (vi)), if amendments are filed within 2 months of the Office Action the Examiner must respond (and issue an advisory action or notice of allowance). However the Examiner can refuse to consider the amendments if they raise new issues or require a further search. Typically this is the case, and an RCE is needed to proceed.

The situation in Part B (i) is not uncommon; the client could retain the allowed claims and file a continuation application to prosecute the broader claims in slower time.

The Patent Prosecution Highway is explained on the UK IPO and USPTO web sites; detailed knowledge of the procedure was not required. However in broad terms, the process may be used to bring forward examination of a US application, which needs to have the same or similar claims to the granted UK; it is not a “registration” process.

Question 4.

The ISA options include the EPO and USPTO (and KIPO); the EPO can be used as IPEA if they were the ISA (PCT Applicant's Guide). On entry into European Regional Phase of the application, if the EPO was the ISA, no supplementary search is performed (the ISR takes the place of the EPO search report); if the USPTO was the ISA a supplementary search is performed on the first invention mentioned in the claims.

With regard to Part (iv), it is too late to change ISA. If the USPTO is the ISA the claims can be amended at EP regional phase entry (or under Rule 161 EPC) to put second invention first (and to save fees on the other claims), so that the supplementary search report is drawn up on the claims to the second invention. If the EPO is the ISA, the first invention will be searched in the international phase and a non-unity objection raised, when the second invention must be searched (or a divisional filed after EP regional phase entry) – the EP claims may not relate to unsearched subject matter (Rule 137(4) EPC).

Re Part B, in the EPO the claims can be amended (reduced in number) at European regional phase entry or within 1 month of the Rule 161/162 EPC communication to reduce the fees. In Japan claims can be amended (reduced in number) when requesting examination to reduce claims fees. In the USA a preliminary amendment can be filed at national phase entry (candidates generally mentioned the types of amendment which are desirable). In China no fee reduction is possible by amending the claims – the fees are determined by the number of claims in the original PCT application.

Re Part C, the deadline for filing a divisional can be of significant practical importance. In brief, in the EPO and USA the deadline is actual grant/issuance, in China the deadline is within two months from the Notice of Grant (Articles 42 and 54 of the Implementing Regulations of the Patent Law of the PRC), in Japan it is 30 days from the grant/rejection decision.

Question 5.

Material for the answers can be found in, for example, the “Brown Book” (Kluwer Manual of IP), and the national phase section of the PCT Applicant's Guide (on the WIPO web site). Knowledge of the grace periods available in the common jurisdictions is particularly useful in day-to-day practice.

Question 6.

Inventive step in Australia has been the subject of a relatively recent decision (*Lockwood Security Products Pty Ltd v Doric Products Pty Ltd*), which held that a mere “scintilla” of invention is sufficient for an inventive step. This can be contrasted with the EPO’s problem and solution approach. There are various pros and cons of modified vs ordinary examination including, for example, simplicity of portfolio management (an advantage for modified examination) and the risk of unnecessary claim limitations of various types (a con for modified examination). Australian law does permit third party observations; details can be found, for example, in the Brown Book.

The (less important) possibility of short term (petty) patent protection was sometimes overlooked. A preferred route and reasons were requested. Any sensibly argued reasons were acknowledged, but in general it is preferable to base an HK registration on an UK or EP(UK) patent because the claims obtained are often broader than those obtained in China and because English is the preferred language (of patent lawyers/judges) in which to litigate.

For obtaining patent protection in Singapore/Taiwan, reference may be made for example to the Brown Book, although in depth knowledge was not required.