

THE JOINT EXAMINATION BOARD

PAPER P5

Basic Overseas Patent Law and Procedure

Monday 9 November 2009

2.00 p.m. – 5.00 p.m.

*Please read the following instructions carefully. **Time Allowed – 3 HOURS***

1. You should attempt **five questions**.
2. Each question carries 20 marks. If more than the required number of questions are answered the first five will be marked and the sixth will be ignored.
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 state your name anywhere in the answers;
 - e. Write clearly, examiners cannot award marks to scripts that cannot be read;
 - f. 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.** Do not staple or join your answer sheets together in any way. Any answer script taken out of the examination room will not be marked.

This paper consists of six pages including this page.

Answer five of the following Questions 1-6

Question 1

a) Where can a European patent application be filed? Under what circumstances is this choice limited?

[2 marks]

b) With regard to a European patent application filed on 31st March 2009 explain briefly the system of designating States under the European Patent Convention (EPC). Briefly, what is an EPC extension State?

[3 marks]

c) i) Briefly explain the procedure if a European patent application is found to lack unity. (Do not consider Euro-PCT applications).

ii) Can claims be amended to relate to unsearched subject matter?

iii) Can a lack of unity objection be challenged before grant?

iv) Is lack of unity a ground for Opposition?

[4 marks]

d) i) What is the latest date for filing a divisional application under the EPC?

ii) What limitation is there on the scope of claims of a divisional?

iii) Must the claims of a divisional be within the scope of the claims of the parent application?

iv) Can a divisional patent have a claim of identical scope to its parent patent?

[4 marks]

e) A European divisional application is to be filed more than two years after the parent application was filed. What types of official fees are due on filing the divisional application, and what are the time limits for paying them? You need not quote fee amounts.

[7 marks]

Question 2

A UK inventor approaches you having filed his own US utility patent application, without claims, just under a year ago. He now wishes to pursue protection of the invention in at least Europe

a) Can priority for a European patent application validly be claimed from the US application? Would the situation be different if the inventor's initial application had been an application for a US design patent rather than for a utility patent?

[2 marks]

b) The priority deadline expires on a Saturday. The following Monday is a bank holiday in the UK but not in any countries where the EPO has a filing office. Can a European priority claiming application be filed on the following Tuesday? If the client wishes to file directly in Israel, what is the deadline?

[2 marks]

c) Outline the conditions for claims of a European application to be entitled to their priority date.

[4 marks]

Give answers to this question for each of the following scenarios:.

d) There is no basis in the US application for a valid claim to priority for broad later-filed claims. Moreover, the invention was disclosed shortly after the US filing, although a search reveals no other relevant prior art. What is your advice regarding the claims to be filed in i) Europe and ii) the USA?

[3 marks]

e) Further investigation then reveals that around three months before the US application was filed the inventor filed an identical application in the UK IPO. What effect does this have on any priority claiming applications you will now file? Give reasons. How could this effect have been avoided?

[4 marks]

f) Instead of the scenario at d) and e) above, you discover that an equivalent UK application was filed by the inventor before he filed the US application, when the UK application was published, around 3 months after you have filed an equivalent European patent application. What is the status of the published UK application as prior art under the European Patent Convention? What effect does it have on the pending European application? What is your advice to the inventor?

[3 marks]

g) If the inventor had approached you earlier and you had filed a PCT application within 14 months of the UK application date, briefly, how would the situation be different?

[2 marks]

Question 3

a) i) Who is entitled to file a PCT application?

ii) Where must a PCT application having applicants who are solely UK residents and nationals be filed?

iii) Can a PCT application be filed if a would-be joint applicant is not entitled to file a PCT application?

[3 marks]

b) i) Under what conditions can a PCT application whose Request form was signed by the applicant's patent attorney be deliberately withdrawn?

ii) What happens if the Request is not validly signed?

iii) What happens if a deadline for filing formal drawings is missed?

iv) How and, preferably, when should an assignment of the application be recorded?

[4 marks]

c) Name two countries mentioned on the PCT Request form which may be explicitly not designated for any kind of national protection. Under what conditions may these exclusions be made? What is the main purpose of this provision?

[3 marks]

d) i) What is the deadline for requesting International Preliminary Examination of the application?

ii) Give three reasons for or against requesting International Preliminary Examination.

[4 marks]

- e) i) What is a utility model?
 - ii) In which of the following countries is utility model protection available: Canada, USA, Japan, China?
 - iii) Name two European countries in which utility model protection is available via the PCT route. How is this done? .
- [6 marks]

Question 4

With regard to *US patent law*, briefly explain the following:

- a) Grace period [2 marks]
- b) IDS [2 marks]
- c) Best mode [2 marks]
- d) Prior use [2 marks]
- e) Offer for sale [2 marks]
- f) Swearing behind [2 marks]
- g) Proof of an invention date [2 marks]
- h) The effect of an earlier filed US patent application as prior art against a later filed US patent application (do not consider interference). What is the effect of each on the other if the later filed US application has an earlier UK priority date than the earlier filed US application? [3 marks]
- i) Use of a terminal disclaimer [2 marks]
- j) US provisional applications [1 marks]

Question 5

In relation to EPO Oppositions:

- a) i) Who can file an opposition?
 - ii) What is the time limit for filing the notice opposition?
 - iii) Is it possible to oppose only in respect of some designated States?
 - iv) What is required for a valid opposition to be filed?
- [5 marks]
- b) i) What are the available grounds for an Opposition?
 - ii) Give an example of a ground for objection to an EP application which is not a ground for opposition to a granted EP patent.
 - iii) What is the deadline for filing a statement of grounds?
- [3 marks]

- c) i) Is it possible to file the Opposition anonymously?
ii) The Opponent alleges that the patentee disclosed the invention non-confidentially to them by prior use; can the Opponent rely on this?
[2 marks]

- d) Your client has filed an Opposition. Part way through the proceedings, before the decision, they discover a new, very relevant prior art document.
i) Briefly explain whether submissions based on this document are likely to be taken into account in the proceedings.
ii) The EPO set a deadline of four months for the Opponent to respond, which is missed. What effect does this have?
[2 marks]

- e) Can a third party intervene in the Opposition proceedings after the deadline for filing an Opposition, and, if so, under what conditions? If the parties reach an agreement and the sole Opponent withdraws, do the Opposition proceedings end?
[2 marks]

- f) i) What are the possible outcomes of the opposition procedure?
ii) Who may appeal? What are the deadlines?
iii) If one party appeals, must the other(s) in order to participate in the appeal procedure?
iv) Can a Board of Appeal decision be appealed?
[6 marks]

Question 6

Your UK client has an English language PCT application and is interested in seeking protection in the following countries:

China, Japan, S. Korea, Australia, Singapore, India, USA, Canada, Taiwan, Hong Kong

- a) Which of these countries are not members of the PCT? For these non-member countries, could a local application claiming priority from the PCT application validly be filed within the 1 year priority period?
[3 marks]

- b) i) Which of the above PCT countries have a 31 month deadline for national phase entry?
ii) For those countries in which a translation into the local language is needed, in which is the effective deadline later than that for national phase entry, and by how much?
[3 marks]

- c) What additional steps are generally required for national phase entry?
[2 marks]

- d) i) What is the deadline for requesting examination for: China, Japan, S. Korea, Australia, India, and Canada?
ii) If your client is short of funds, what would be your advice for Japan?
[8 marks]

e) Your client asks if late national phase entry is possible for the USA and Canada?
Mention any time limits and outline any conditions if so.

[4 marks]