

THE JOINT EXAMINATION BOARD
PAPER P5
BASIC OVERSEAS PATENT LAW AND PROCEDURE
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EXAMINER'S COMMENTS

Question 1

All candidates attempted this question and it was generally well done. Where a European patent application can be filed is defined in Article 75 EPC - at filing offices of the EPO and at national patent offices (except for the Netherlands - see National Law Relating to the EPC). Article 75(2) allows Contracting States to mandate local filing where national security is concerned - this was often overlooked. Article 76(1) EPC requires a divisional application to be filed at the EPO.

The system of designating States is defined in Article 79 EPC and the related rules. All States are deemed designated at filing. Most candidates could explain the extension state system; extension states are listed on the EPO web site.

The EPC non-unity procedure is governed by Article 84 and Rule 64 - only the first invention is searched and additional search(es) are invited.

Claims may not be amended to relate to unsearched subject matter (Rule 137(4)(5) EPC), unless this subject matter is unitary the searched subject matter. Unity can be challenged at the substantive examination stage (but not with the Search Division); it is not a ground of opposition.

A European divisional application must be filed whilst the parent application is pending ie. by (the day before) grant (or refusal). Article 76(1) prevents the divisional from extending beyond the subject matter of the parent at filing; Article 123 governs subsequent amendment of the divisional. A divisional can have broader claims than its parent but, when granted, cannot have claims of identical scope to the parent.

The fees due on filing a divisional are defined by Rule 36(3)EPC, Rule 45(1)EPC, and Rule 51 EPC (back renewal fees may be paid within 4m from filing of the divisional without additional fee; there is a 6 months from filing late payment period). The filing fee has a per-page component. Later, designation and examination fees are due (Rule 36(4)EPC, Art. 94(1)(2), Rule 70(1) EPC).

Question 2

This question was unpopular and some candidates had difficulty.

Priority for the European patent application can validly be claimed from the US

application, provided the US application established a filing date (it would have to have been a US provisional if no claims were filed (Article 87(2),(3) EPC). Priority cannot be validly claimed from a design patent - this is defined by Article 87(1) EPC (the Paris Convention is ambiguous on this point).

Where the priority deadline expires on a Saturday and the following Monday is a bank holiday in the UK a European priority claiming application be filed on the following Tuesday, but only at the UKIPO (Rule 134(3) EPC). In Israel the Patent Office is shut on Friday and Saturday, but is open on Sunday (candidates who did not know the answer could have extrapolated from their general knowledge, but few did).

The conditions for an EP application to be entitled to a priority date are set out in Article 87 EPC.

In the situation posed where there was no basis in the US application for a valid claim to priority for broad later-filed claims: In Europe write narrow claims, which are entitled to the priority claim; and in the US write narrow claims (as in Europe - this point was often missed) and also broad claims since the 1 year grace period applies. (The applicant also needs to re-file a regular US application, or convert the provisional).

Since around three months before the US application was filed the inventor filed an identical application in the UK IPO the priority claim is invalid because date runs from first application in a convention country (thus any further applications are limited to countries with a 12 month grace period in the circumstances posed). This could have been avoided by getting instructions earlier, abandoning UK without leaving priority rights and re-filing (in the UK) before US filing, or potentially by converting the US provisional to a regular US and within the relevant 4m/16m time period and adding in the priority date (though candidates were not expected to know this latter point).

In the situation of part (f) advice was asked for but often not given. The UK is a national prior right and is not part of the state of the art under Art 54(3) EPC, though it will be relevant for the EP(GB) under Art139 EPC. It has no direct effect on the pending EP. Thus the advice is to maintain the UK to grant and withdraw UK designation (otherwise the UKIPO will revoke the UK patent to prevent double patenting. The question implies that the EP describes the same invention as the UK so that in practice amending the claims of the EP is unlikely to be an option (except to cover any new material added at EP filing), even though the EPC makes provision for this.

In part (g), the PCT procedure allows restoration of the priority right within 2 months of the missed priority deadline under Rule 26bis.3 PCT. Not all Receiving Offices permit this but those relevant for this PCT case do (the PCT would have been filed at the UKIPO, EPO or IB). The RO applies either an "all due care" or an "unintentional" criterion (or both, or neither if a reservation has been made). all Designated Offices accept this restoration but the EPO does provided "all due care" is proved (although the USPTO does not); details are on the WIPO web site.

Question 3

This question was popular and the answers were in the main good.

Entitlement to file a PCT application is defined in Article 9 and Rule 18 PCT; where a PCT application must be filed is defined in Article 10 and Rule 19 PCT. Only a single applicant need be entitled to file (Article 9, Rule 18.3 PCT).

Where a patent attorney withdraws a PCT application t attorney must submit a general power of attorney with the withdrawal request if this has not previously been submitted (Rule 90.5(d); Rule 90bis PCT).

If the Request is not validly signed the application is not lost: the RO requests a signature within an extendable time limit of not less than 1 month (Article 14, Rule 26 PCT). Many candidates thought, incorrectly, that the application filing date did not receive a filing date.

la deadline for filing formal drawings is missed again the application is not lost - this deadline is generally not critical (Rule 26.5 PCT): Provided the RO has not deemed the application withdrawn under Rule 26.5 PCT the deadline may be extended by the RO (Rule 26.2 PCT). Some candidates overlooked the reference to formal drawings in the question and considered instead late-filed drawings under Article 14.

An assignment should be recorded in writing (by letter) to the IB [or RO], preferably during the international phase of the application (Rule 92bis PCT).

Countries mentioned on the PCT Request form which may be explicitly not designated for any kind of national protection are DE, JP, KR, RU. The check-boxes are used (irrevocably) to exclude the designations concerned where the international application contains a priority claim to an earlier national application filed in the State concerned. This is to avoid this earlier national application ceasing to have effect by operation of the relevant national law.

The deadline for requesting International Preliminary Examination of the application is the later of 22 months from the filing date/earliest priority date and 3 months from the ISR and Written Opinion (Rule 54bis PCT). The latter point was often missed.

There are many reasons for and against requesting IPE and there were easy marks here. Reasons include: The opportunity for Article 34 amendments; the time constraints of international examination, the possibility of saving money on examination later; the possibility of obtaining a favourable result before the EPO quickly; the need for repeated examination (for example the USPTO will generally ignore EPO view and vice-versa); the possible creation of estoppels in the US; the application of European law on inherent patentability; the result can be late; one can amend at regional phase entry anyway; bringing costs forward.

Almost every candidate knew what a utility model was (shorter term; often a lower level of inventive step; generally different novelty requirements; not all types of invention

protectable; generally no substantive examination; generally quick/cheap grant). model protection is available in Japan and China and in around half the countries in Europe. It can be requested at national phase entry from a PCT application (it does not need to be designated separately in the Request).

Question 4

Material for the answers to this question can be found in, for example, the “Brown Book” (Kluwer Manual of IP), and in the USPTO MPEP (Manual of Patent Examining Procedure). Much of the question was effectively asking about 35 USC 102(a)-(e).

In the US there is a 1 year grace period for disclosure by the applicant by local sale/use or printed publication anywhere. The 1 year period is measured from the filing (not priority) date of regular or provisional US application or PCT application.

In brief an information disclosure statement is part of a general duty of candour and good faith and imposes a duty to disclose (to the USPTO) all information material to patentability (not just clearly relevant documents). It is a list of prior art known to those involved in the patent prosecution, on every individual involved with filing and prosecution of the application, including inventors and attorney(s). Breach of this duty is considered inequitable conduct and, inter alia, makes a patent invalid and/or unenforceable. Time limits for submission of an IDS are provided; translations of foreign language documents may be needed.

The specification must disclose the best mode known to (any of) the inventor(s) at the time of filing the application. The best mode disclosure must be sufficient to be practiced by a person skilled in the art, but need not be explicitly identified. The penalty for non-compliance is invalidity. Best mode should be described in a foreign priority application. More details can be found in the MPEP s.2165.

The effect of prior use on novelty is set out in 35 USC 102(a),(b); further information can be found, for example, in MPEP s.2133.03. Broadly, use overseas is not novelty destroying; the use must be public. Secret commercial use of a process by the inventor/patentee more than 1 year prior to filing the US application date deemed to be novelty destroying. For business methods only, prior commercial use is a defence to infringement.

Similarly to prior use, as set out in s102(b), offer for sale is novelty destroying, even if non-public, if more than 1 year before the US application date (unless the use was "experimental"). There is complex case law concerning the relevant dates which candidates were not expected to be aware of (broadly, the 1 year clock starts when the invention is both the subject of a commercial offer for sale and “ready for patenting”).

Swearing behind is used to address rejection under s102(a) (or (e)): The USPTO treat the applicant’s filing date as the prima facie invention date, but prior art can be overcome by establishing an earlier date of invention. An affidavit or declaration (under s.131) is needed, with evidence (to show actual reduction to practice, or conception and

diligence). Since 1996 a proven date of invention in any WTO country counts.

Proof of an invention date requires showing actual reduction to practice before the relevant date (eg a working model or demonstration); or constructive reduction to practice (filing a patent application in the US or a Paris Convention country); or conception and continuing diligence to actual/constructive reduction to practice. The invention must not have been suppressed or concealed (eg kept secret with no patent application filed or commercialisation). Evidence is needed.

An earlier filed US patent application is relevant for both novelty and obviousness a later filed US patent application (s.102(e)). This applies for published applications and patents, and also for published PCT applications (filed after 29 Nov 2000), if US designated, and if the publication was in English.

An earlier UK priority date than the US filing date of the relevant reference overcomes a 102(e) rejection based on the reference but does not an earlier prior art date (ie a foreign priority date cannot be used as an effective 102(e) date for a US or PCT application - the Hilmer doctrine).

A terminal disclaimer is used to overcome a USPTO “non-statutory-type” double patenting rejection, that is where a claim in one is same or an obvious variation of a claim in the other (the claims are not patentably distinct). The two applications/patents must be commonly owned (though the inventors need not be identical). A written statement (and fee) is needed to disclaim the terminal part of the term of the later patent, ie. that part which would extend beyond the earlier patent (together with a provision that the patents are only enforceable if commonly owned).

A provisional application establishes a US filing date but automatically dies after a year. It does not publish and never becomes a patent, but it can be converted to a regular application. It is inexpensive; claims are not required, but contrary to what some candidates thought, may be included. There are no provisions for divisionals, continuations, and the like.

Question 5

This was not a popular question but candidates who attempted it generally knew the answers - which were mainly based on the relevant provisions of the European Patent Convention - and scored well.

Any person can file an opposition (but a patentee is not permitted to oppose their own patent); a representative may be needed. The time limit filing the notice opposition is 9 months from publication of the mention of grant (Art 99 EPC). It is not possible to oppose only in respect of some designated States - the opposition applies only for all states. (see Article 99EPC). The for a valid opposition to be filed are set out in Article 99 and Rule 76 EPC.

The available grounds for an Opposition are set out in Article 100EPC. Non-unity, lack

of clarity and lack of a two-part form for an independent claim are not grounds of opposition. The deadline for filing a statement of grounds is the same as that for the Notice of Opposition.

An Opposition can be filed effectively anonymously at both first and second instance by using a "straw man" (G3/97). Use can be relied on by the Opponent (many candidates thought not), but only if there is sufficiently good evidence (D-V-3.2.1; T472/92 - proof "up to the hilt").

Submissions based on late-filed documents may be disregarded (Art 114(2)) if it is prima facie very relevant it will generally be considered (even if this raises a new ground for Opposition (Rule 76(2); T1002/92). If a deadline for responding is missed the Opponent can file observations "late" (Art 101; E-VIII).

A third party can file observations in opposition proceedings (Article 115EPC). An alleged infringer can intervene in the Opposition proceedings after the deadline for filing an Opposition (Art 105EPC). If the parties reach an agreement and the sole Opponent withdraws, the Opposition proceedings do not necessarily end - the Opposition Division is able to continue of own motion, in particular if limitation/revocation is likely (Rule 84(2)EPC); however they are not obligated to, as some candidates thought. Possible outcomes of the opposition procedure are that the patent is revoked, maintained unamended, or maintained in amended form (Art 101(2)(3)EPC).

Any party adversely affected by the decision may appeal (Art 107EPC). The deadline for filing Notice of Appeal is 2 months from notification of the written decision; the grounds must be filed within 4 months from notification of the written decision. Non-appealing parties become parties as of right (Art 107EPC).

A Board of Appeal decision cannot be appealed but can be reviewed by the Enlarged Board of Appeal under very limited circumstances (Art 112a EPC).

Question 6

This was a question where marks could be picked up fairly easily.

Taiwan, Thailand and Hong Kong are (were) not covered by the PCT. Taiwan and Thailand are both WTO countries and priority could be claimed from the PCT application (if within the 1 year period). In Hong Kong a priority claim cannot be made for a regular patent application (though it can for a petty patent) - instead protection in HK is based on an equivalent UK, EP(UK) or CN application.

India, Australia, and South Korea have a 31 month deadline for national phase entry. In Japan, and effectively China, an additional 2 months is available for filing a translation into the local language (no translation is needed for India, Singapore and Malaysia). In general at national phase entry one must request national phase entry, pay a fee, and appoint a local agent (file a Power of Attorney), and file a translation if necessary (including of any amendments made during the international phase or new amendments). There are other potential requirements and all sensible answers were

rewarded.

The deadlines for requesting examination for China, Japan, S. Korea, Australia, India, and Canada can be found, for example, in the Brown Book or in the National Phase section of the PCT Applicant's Guide (online). Many candidates lost easy marks by not specifying from when the deadline ran (sometimes the international filing date, sometimes the earliest priority date).

In Japan it has been possible to defer examination fees as of 1 April 2009; one can also reduce number of claims to reduce the examination fee (when deferring if to act on the deferred fees).

Late national phase entry is possible in USA if this was unavoidable or unintentional, via a petition to revive the abandoned application. Additional fees are required and for the unavoidable basis (and in general for the unintentional basis) a detailed explanation and evidence; there is no statutory no time limit. Late national phase entry is possible in Canada up to 12 months beyond the 30 month deadline; there is a small additional fee.

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