THE JOINT EXAMINATION BOARD
PAPER P5
BASIC OVERSEAS PATENT LAW AND PROCEDURE
8th November 2010
EXAMINER'S COMMENTS

Question 1

A - Rule 70(1) EPC provides that the deadline for requesting Examination of an EP application is 6 months from the date on which the European Patent Bulletin mentions publication of the European Search report.

Calculation of deadlines is an essential part of patent attorney practice. Candidates were expected to be able to apply the ten day rule relating to notification by post (Rule 126(2) EPC) and how periods expressed in terms of months are calculated (Rule 131(4) EPC). A surprising number of candidates believed February and April to have 31 days.

Rule 135 EPC provides that further processing is requested by paying the prescribed fee within 2 months of a communication noting loss of rights. The omitted act (i.e. the response to the examination report) must be completed within the period for making the request.

Oral proceedings shall take place at the request of any party to the proceedings (Art 116(1) EPC). Most candidates recognised that a request for oral proceedings included in their response would guarantee a further opportunity to comment.

Provisional protection in France and Germany may be obtained by filing appropriate translations of the claims with the French and German Patent Offices, requesting that the translated claims are published and paying any fees due. A translation of the claims may also be sent directly to a person using the invention in France or Germany.

An EP application in English is only granted after claims translated into German and French have already been filed. Many candidates identified this in their answers. Under the London Agreement no translations are required post-Grant for France and Germany and a translation of the claims into Dutch is required for the Netherlands. Italy is not a signatory of the London Agreement and a full translation of the description and claims is required into Italian.

B - Question 1, part B required a rudimentary knowledge of the National patent procedure in France and Germany.

In France the procedure involves a formalities Examination and a Novelty search. A preliminary search report is communicated to the applicant along with a patentability opinion. If the preliminary search contains X or Y citations the applicant must comment or file amendments with 3 months. This period is extendible by a further 3 months. The applicant's response is Examined for formality and for manifest lack of novelty. The preliminary search is open to public inspection and third party observations may be filed within a period of three months. The patent is granted after payment of issue fees. The patent specification is published along with a search report based on the preliminary search report and the applicant's reply.

A French National patent application cannot be obtained via the PCT route, renewal fees are payable on a pending application, a certificate of utility is available (of 6 years duration) and there is no provision for opposition.

In Germany there is provision for an optional novelty search which may be requested by either the applicant or a third party. If a novelty search is requested the subsequent examination fee is reduced. The application is otherwise only examined for formalities. Substantive examination must be requested and a fee paid. The request may be made by the applicant or a third party, but a third party does not become party to the proceedings. The deadline for requesting examination is 7 years from the date of application. The examination consists of actions issued by the German patent office with deadlines for reply. Extensions to the deadlines are available. An oral hearing must be granted if applied for.

It is possible to obtain a German National application via the PCT route, renewal fees are payable on pending applications, utility model protection is available (10 year duration), and oppositions may be filed within 3 months of the date of Grant.

Question 2

A - Question 2, part A presented the candidate with a typical EP Regional phase entry situation and requested advice dependent on whether the ISA was the USPTO or the EPO. There was much that could be said, but the question was answered poorly by most candidates.

Knowledge was required of the claims for which excess claims fees were due, the deadline for payment, the opportunities for filing amendments (e.g. on Regional Phase entry or in response to the Rule 161/162 Communication), the effect of filing amended claims on the claims fees due (R 162(2) & (3) EPC), and the effect of not paying excess claims fees (Rule 162(4) EPC).

Claim numbers could be reduced, preferably to less than 16 to reduce or eliminate claims fees. Consideration of the following questions gained marks. Do the claims contain multiple inventions? Are there multiple independent claims and, if so, are they allowable under European practice? Could the claims be re-written more concisely using multiple dependencies? Do the claims contain subject matter that would not be patentable in Europe (e.g. method of treatment claims)? Were all of the claims searched during the international phase? Could dependent claims be joined together as alternative clauses to reduce the number of claims while still maintaining all of the subject matter in the claim set? Is the subject matter of any deleted claims in the description, and should an amendment to the description be considered?

During the International phase claims of an application are searched by the appropriate ISA. On entry to the European Regional phase the EPO draws up a supplementary search report for Euro-PCT applications for which the USPTO was the ISA, but dispenses with a supplementary search report for Euro-PCT applications for which the EPO was ISA.

If the EPO was the ISA, the EP Regional phase may only pursue claims that were searched during the international phase. Claims that were not searched during the international phase may only be pursued in a divisional patent application. The second independent claim may be pursued if it was searched during the international phase, either because it was unified with the first independent claim or because a second international search fee was paid.

If the USPTO was the ISA, claims not searched at the international phase may still be pursued. The supplementary search will search the first invention set out in the claims. Thus, a re-ordering of the claims may allow such subject matter to be pursued.

B - The deadline for filing a European divisional patent application is set out in Rule 36 EPC. Only the applicant of record can file a divisional.

A divisional application filed with added subject matter is not entitled to claim the priority of the parent. Priority cannot be claimed if it has lapsed or has been withdrawn on the parent. If priority documents have not been filed in relation to the parent at the time a divisional is filed, priority documents will also be required to be filed for the divisional. Failure to file such documents leads to a loss of priority.

C - A Hong Kong application must be registered within 6 months of publication and a request for grant must be submitted within 6 months of Grant. The publication is the EP mention of publication after Regional Phase entry.

Question 3

A - This section required a logical analysis of the nature of disclosure in each case and an explanation of whether a patent could be pursued in the US and Europe. Knowledge was required of Articles 54 and 55 EPC and 35 USC 102. Some candidates scored very high marks on this section.

a) Sale and exhibition in Taiwan are not prior art under USC 102.
Technical details have not been disclosed, so there has been no enabling disclosure to enable the device to form part of the state of the art under Art 54 EPC. Thus, patent protection may still be pursued in both US and Europe.

b) The verbal explanation in Germany does not form part of the state of the art according to USC 102. The verbal explanation does form part of the state of the art under Art 54(2) EPC. Thus, patent protection can be pursued in the US but not in Europe.

c) The supply of the device to a laboratory in France does not form the state of the art under USC 102. As the supply is non-confidential, it can be presumed that the French laboratory are free to do as they wish with the device, which includes determining how the device works. Thus, the supply forms part of the state of the art under Art 54(2) EPC. Patent protection can be pursued in the US but not in Europe.

d) Providing documentation under an NDA is not a disclosure. The technical details made public would be a disclosure for the purposes of the USA if they are written details. This disclosure would only prejudice novelty if made more than 1 year prior to the date of filing a US patent application (USC 102 (b)). Thus, a US patent application can still be filed within 1 year from the disclosure (The US "grace period").

For Europe, it would appear that the disclosure is an evident abuse and therefore a non-prejudicial disclosure (Art 55 EPC). A European application can be filed as long as it is on file within 6 months from the date of the abusive disclosure.

e) The online printout of the paper counts as a written disclosure under USC 102. The disclosure is only prejudicial to novelty if made more than one year prior to the date of filing of a US application. Thus, a US patent application can still be filed within 1 year from the disclosure.

The disclosure forms part of the state of the art in Europe. Patent protection could not be pursued in Europe.

B - This portion of question 3 was not answered well. Marks were given for any information that may guide the drafting of claims for prosecution in the US. Marks were given for:
Identifying that some subject matter that is not patentable in the UK or Europe may be patentable in

the USA, for example methods of treatment or business methods;
Identifying subject matter that may not be patentable in the US, e.g. signal structures;
Describing different claims formats, for example Markush claims, Beauregard claims, Jepson claims;
Noting that means-plus-function claims are allowable, but that there may be a limitation in scope when such claims are interpreted by a court;
Noting that Omnibus claims are not allowed;
Noting that multiple independent claims in the same category are allowed and explaining why the presence of an independent claim that can be granted without amendment may be desirable;
Explaining the claims fee structure (independent, dependent, multiply dependent) and how this influences claim drafting;
Noting that multiply dependent claims based on multiply dependent claims are not allowed;
Noting that features defined in a claim must be illustrated in a figure; and
Explaining that certain terms have a recognised meaning, e.g. "consisting of".

Question 4

This question required an understanding of the concept of priority. The more able candidates obtained high marks.

A - A Taiwanese application can claim priority from an earlier UK application by virtue of Taiwan and the UK being WTO members. There is also a reciprocal agreement on patent priority that was established before Taiwan became a WTO member.

A takes the priority date of the UK application (i.e. 1 July 2009), both B and B+C have the PCT filing date as their priority date (i.e. the date on which the subject matter of B and the combination of B+C was first disclosed.

The lack of claims in the UK priority document would make no difference to the answer as long as invention A was fully disclosed. If the priority document only disclosed a preferred embodiment of A, it is possible that the subject matter of A as claimed in the PCT application is not entitled to priority. In this case, only a claim to the specific embodiment would be entitled to priority and the priority date for the broader claim to A would have the filing date of the PCT as its priority date.

The applicant must be the same applicant that filed an earlier application, or his successor in title, for priority to be validly claimed.

B - This portion of the question required a systematic analysis of the situation and some advice based on the analysis.

For a CIP material in the original case gets the original priority date. New material gets the filing date of the CIP as the priority date.

Construction of a time-line may assist candidates answering this type of question. The applications currently on file are a PCT (discloses and claims invention A and invention B), a CIP (filed within the last year, discloses and claims invention A and invention B) and an original US patent (filed three years ago, discloses and claims invention A). The PCT claims priority from the CIP and the CIP is a CIP based on the original US application. The original US application had published before the CIP was filed.

For invention A; the first application for the subject matter is the original US application. The PCT cannot validly claim priority to the subject matter of invention A as the CIP is not the first

application for the subject matter. The original US application is published and is full prior art to invention A. If invention A was pursued in the EP Regional phase it would be found to lack novelty over the publication of the original US application. Advice is, therefore, do not proceed with invention A in Europe.

For invention B; the priority date is the date of filing the CIP. The CIP is the first application for this subject matter. The PCT was filed within a year of the CIP. Thus, the priority claim is prima facie valid. The original US application published prior to the filing date of the CIP, therefore before the priority date for invention B. Advice, pursue invention B in Europe if it is novel and inventive over the subject matter of the original US application.

C - Novelty only prior art refers to earlier European patent applications as defined by Art 54(3) EPC. According to Art 56 EPC, such prior art is not to be considered for the evaluation of inventive step. Earlier EP applications may fall under Art 54(3) by virtue of an early priority date. If this priority date is invalid, such documents may not constitute prior art at all. A PCT is only state of the art under Art 54(3) EPC if the EP filing fee has been paid and a translation into an official language has been filed (if a translation is required).

Question 5

This question required the candidates to provide some basic information relating to some popular patent territories.

A - The National Phase entry deadlines may be determined from the PCT applicant's Guide. Most candidates scored well.

Translations are required in China, Japan and South Korea. Japan allows 2 months for filing the translation, for China the deadline is the same as National phase entry but this may be extended by a period of 2 months. The translation for South Korea is required at National phase entry.

USA, Israel and India have IDS type requirements. South Africa is a registration country and Singapore, Australia and Israel allow grant based on grant in another jurisdiction.

B - In Japan a divisional patent application may be made at any time before a first office action is issued, within three months of the date of notification of reasons for rejection (extendible by three months), within 30 days from Notice of Allowance, or within 4 months of a Decision of Rejection. There is no provision for Opposition.

In Australia a divisional patent application must be filed while the parent is pending. The deadline for filing a divisional directed to any subject matter contained in the application is within 3 months of the publication of a Notice that the application has been accepted. A divisional application may be filed after the expiry of 3 months from the Notice of Acceptance, and while the parent is pending, provided that the claimed invention was claimed in the parent when it was Accepted. There is a provision for opposition. This is a pre-grant opposition process, and the opposition must be filed within three months from the publication of the Notice of Acceptance.

In China a divisional patent application may be filed within 2 months of receiving a Notification to Grant a patent right. If rejected, a divisional may be filed within 3 months of receiving a Rejection Decision. There is no provision for opposition.

Question 6

A - Section A required a knowledge of the PCT Applicant's Guide – International Phase. Many candidates scored high marks.

Article 19 amendments are amendments allowed to the claims in response to the search report. The deadline for filing is within 2 months of the transmittal of the search report or 16 months from priority if later. Amendments are filed with the IB, there is no fee, and the amendments are published.

The deadline for requesting IPE is the latest of 3 months from transmission of the ISR and 22 months from priority. The applicant is invited to submit comments, usually based on the written opinion that accompanied the ISR, and the IPEA draws up a report taking the applicant's response and any amendments into consideration.

Question 6, A, c), a) contained an error. The question could be read as "which authority would you correct the name of the applicant on the Request" (Answer rO – Rule 91.1 (b)(i)) or "which authority would you file a change of name" (Answer rO or IB – Rule 92bis PCT). A mark was given for either interpretation of the question.

A missing abstract is filed with the rO – Rule 38 PCT.
A request to add an inventor can be made to the rO or IB – Rule 92bis PCT
A certified copy of the priority document may be filed with the rO or the IB – Rule 17.1 (a) PCT
A response to a written opinion may be file with the IPEA (EPO) or IB if Art 19 amendments.
A change of agent is filed with the IB – Rule 92 bis PCT.
A request to withdraw the application can be made to the rO, IB or the IPEA if applicable – Rule 90bis.1 (b) PCT
A request to make a correction may be made to the ISA or IPEA depending on competence – Rule 91.1 (b) ii and iii.

B - Narrowing a claim by adding a feature from a patent application incorporated by reference is not allowed.

Disclaimers are allowed as long as they are drafted according to the rules of G 1/03.

A purely factual description of the prior art is allowed to be added to the description.

If subject matter is added to a claim then the claim is invalid. A claim cannot be amended after grant if the amendment broadens the scope of the claim. A claim granted with a limitation that has no basis may be incurably invalid. It does not matter that the Examiner has suggested the amendment.

It is theoretically possible to change the category of a claim after grant, as long as the scope of the claim is not broadened and subject matter is not added. Care should be taken if there is any product by process protection that may arise from the change of claim category.