

Basic Overseas Patent Law and Procedure

Paper P5

Examiner's Comments

Question 1

Question 1 required candidates to have an appreciation of the existence of utility model systems in various territories around the world, and an appreciation of their advantages and disadvantages.

A: Marks were given for any three sensible advantages and any two sensible disadvantages. Three advantages that are typically found in utility model protection are swifter registrability compared with patents, which allows an earlier enforcement, a lower cost associated with obtaining a registered right, and a lower standard of inventive step to be applied when assessing validity of a utility model. Two typical disadvantages are a shorter term of protection compared with patents, and a lack of a robust search and examination procedure, meaning that there is a lower presumption of validity associated with granted utility models than is the case for granted patents. Marks were given for other reasoned advantages and disadvantages.

Of the listed territories, utility model protection is available in Germany, Argentina, Mexico, China, and Japan. In all of these territories the maximum term of protection is currently 10 years.

Although the UK does not have a utility model system, a UK patent application filed in the UK may serve as a priority application for a utility model filed in one of the identified territories.

Some of the identified territories allow a utility model application to be filed at the National phase of an International patent application. However, this does not apply to all of the identified territories. Marks were awarded for identifying that utility models could be filed from an International application in some territories, noting which of the identified territories could not pursue utility model protection via the International patent application route, noting that the client's mechanical device is already being copied, and advising whether or not to proceed with direct national utility model filings or filing of an International patent application.

Candidates were required to know that many countries having utility model systems apply some form of grace period allowing a valid utility model for protection to be obtained after an initial public disclosure. The question was ambiguous as to when the disclosure was made. If made after the UK patent application was filed then utility model protection could be pursued by claiming priority from the UK patent application. If the disclosure occurred before the UK patent application was filed then Germany, Argentina and Japan have a 6 month grace period within which utility model protection can be pursued and Mexico has a 12 month grace period within which utility model protection may be pursued.

B: This section required notes to be written on the procedure for obtaining a German utility model registration. Filing procedures are set out in various reference works, and marks were given for any relevant points for the procedure for obtaining registration of a utility model in Germany. Such points included appointing a German attorney, filing an application in duplicate at the German Patent Office including the applicant's contact details, filing a translation in German (if required) within 3 months, claiming priority (if required) within 16 months of the priority date or 4 months of filing, noting that the examination of a German utility model is for formal requirements only, noting that the applicant or a third party may request a novelty search, noting that the application may be amended up to the point of registration, and noting that it takes of the order of 8 weeks from filing to obtain a registration.

Question 2

A: In Europe excess claim fees are due for each claim in excess of 15. A higher rate of excess claim fee is payable for each claim in excess of 50. It is possible to amend the claims to reduce the number, and therefore any claims fees due, either on regional phase entry or in response to a Rule 161/162 Communication. Claims fees are due on the number of claims left after such amendment.

In the US, excess claims fees are due for every claim in excess of 20 and for each independent claim in excess of 3. Furthermore, fees are due for multiply dependent claims and each effective claim in a multiply dependent claim counts as an individual claim for the purposes of fees. A preliminary amendment may be filed within 3 months of US national phase entry to amend claims for the purposes of claims fees.

In Japan there are no claims fees on national phase entry. It is possible to amend claims after national phase entry in order to reduce the number of claims and this may be desirable as the examination fee is based on the number of claims.

In China excess claims fees are due for every claim in excess of 10 claims. These claim fees are determined on the basis of the claims present in the published PCT application. Although it is possible to file voluntary amendments after entry into the Chinese national phase, any such amendment will not reduce claims fees.

B: Section B set out a problem. Candidates were expected to analyse the facts presented in the problem and propose solutions.

All excess claims fees were paid on regional phase entry but a refund will be due if amended claims are filed to reduce the claim numbers. The EPO will issue a Rule 161/162 Communication setting a term within which amended claims may be filed. Thus it may be advisable to file an amended claim set with fewer claims and receive a, potentially substantial, refund.

Marks were awarded for any reasoned proposals for the reduction of the claims. Candidates should have spotted that a number of claims were directed to methods of treatment of a human being, which are not patentable in Europe. Paying claims fees for such claims would be wasted money. Claims 1 and 25 are independent claims defining medical devices. The EPO prohibits multiple independent claims in the same claim category, unless such claims fall into one of the specifically allowed exceptions. Thus, candidates should at least consider reviewing the claims to determine whether one of the independent claims and its dependent claims could be deleted from the application and perhaps filed in a divisional application. Claims may perhaps be reviewed to determine whether there are any unwanted claims that do not provide a sensible commercial scope for your client. It may be possible to delete claims where explicit support for those claims is found in the description, with the view to introducing such subject matter later (care should be taken to explicitly note that deleted subject matter is not abandoned). It may be possible to redraft some dependent claims with multiple dependencies in order to reduce claim numbers, particularly if claims 1 and 25 serve as independent claims to similar sets of dependent claims. It may be possible to merge claims using language such as “optionally”, “preferably”, or “and/or”.

C: The EPO will not examine subject matter that has not been searched at the International stage. Thus, if the applicant wishes to pursue the second of the two inventions, the patent application must validly enter the European regional phase and then a divisional patent application must be filed in respect of the second invention.

Question 3

Very few candidates attempted question 3.

The Singapore patent system provides four possible search and examination procedures:

1. The applicant may, within 13 months from priority, file a request for a Search Report and then subsequently (21 months from the declared priority) file a request for an Examination Report. These procedures are only available under the “fast track” option;
2. The applicant may, within 20 months from the declared priority (or 39 months under slow track), file a request for combined Search and Examination Report;
3. The applicant may, within 21 months from the declared priority date (or within 39 months under the slow track option), file a request for an Examination Report based on a Search Report issued on a corresponding International or national application filed at a prescribed Patent Office;
4. The applicant may, within 42 months from the declared priority (or within 60 months under the slow track option), file information setting out the final results of search and examination of a corresponding national application filed at the prescribed Patent Office.

Prescribed Patent Offices include those in Australia, Canada (for applications filed in English), Japan, New Zealand, Republic of Korea, the UK, the US, and the EPO (for applications filed in English).

B: If your client has filed a European patent application for an invention, it is still possible to pursue patent protection for the invention in Hong Kong if it is not more than 6 months since the publication of the European patent application and if the application still designates the UK.

A request for registration and grant of a Hong Kong patent application must be filed by the latest of 6 months from grant of a UK patent or 6 months from publication in Hong Kong of the request to record. In the given circumstances the request for registration and grant must be filed by 30 March 2012. Fees are due within 1 month of filing the request for registration and grant and these may be paid within 1 month of a communication appointing a failure to observe the time limit.

Question 4

A: This section asked candidates to assess the requirements of Section 23 of the UK Patents Act relating to restrictions on filing applications abroad. Candidates were expected to assess the requirements of the Act, set out the procedures that need to be followed, and make a reasoned assessment as to whether a missile guiding system and a sandwich toaster would be subject to the same restrictions.

B: Small Entity Status may be claimed by individual, small business concerns, and certain non-profit organisations, providing that they have not assigned, granted, conveyed or licensed and are under no obligation to assign, grant, convey or licence rights in the invention to any entity that is not qualified for small entity status. Small business concerns are those having fewer than 500 employees. Small entity status must be asserted by the entity in a written declaration and if so asserted entitles the claiming entity to a reduction in certain official fees.

Any attempt to fraudulently establish status as a small entity or the improper establishment as a small entity with the intention to deceive will be considered a fraud on the Patent Office and may result in any patent being unenforceable. Small entity status must be asserted by written declaration, and this may result in clerical headaches for some applicants.

Small entity status in Canada has different qualification requirements from that in the US, and cannot be claimed by any company employing more than 50 people.

C: Both Canada and the USA benefit from a 12 month grace period for the applicant's own disclosure. Thus patent protection may still be pursued in these territories despite the publication in a Technical Journal 4 months previously.

Question 5

A: The deadline for filing a European divisional patent application is set by Article 76 and Rule 36 EPC. Thus, the parent application must still be pending. Furthermore, the divisional application must be filed before the expiry of a time limit of 24 months from the Examining Division's first communication in respect of the earliest application for which a communication has been issued, or before the expiry of a time limit of 24 months of any communication in which the Examining Division has objected that the earlier application does not meet the requirements of plurality of invention, providing it was raising that specific objection for the first time.

A divisional application must be filed by the applicant of the parent application.

The fees and time limits in respect of European patent applications are set out in Rules 36, 45, and 51 EPC. Thus, filing fees (including page fees) and search fee must be paid within 1 month of the filing of the divisional application. Designation fee must be paid within 6 months of the date on which the European Patent Bulletin mentions the publication of the European Search Report drawn up in respect of the divisional application. Claims fees, if due, should be paid within 1 month of filing. Any claims fees may still be paid within 1 month of a communication pointing out the failure to observe this time limit. Renewal fees in respect of any renewal due on the parent application are due on filing of the divisional application. These fees and any further renewal fee due within 4 months of filing the divisional application may be paid within 4 months of filing the divisional application. Any required extension fees are due within the same deadline as the designation fees.

B: The earliest communication from the Examining Division is that issued on 1 December 2009 in relation to EP1. This communication is deemed to have been notified to the applicant on Friday 11 December 2009. According to Rule 36(1)(a), a divisional application must be filed by the expiry of 24 months from this first communication, i.e. by 11 December 2011. However, there is a communication relating to EP2 stating that the date of mention of grant in the European Patent Bulletin will be Tuesday 6 December 2011. A divisional patent application may only be filed from a pending earlier application. Thus, the deadline for filing a divisional patent application will be Monday 5 December 2011.

Question 6

A: The deadline for opposing a granted European patent is set out in Article 99 EPC as within 9 months of the publication of the mention of the grant of the European patent in the European Patent Bulletin. Notice of opposition must be given in a written reason statement. The Notice of Opposition must contain details identifying the opponent, the number and title of the European patent being opposed, the name of the Proprietor of the patent, a statement to the extent to which the European patent is opposed and grounds on which the opposition is based, along with an indication of facts and evidence presented in support of the grounds, and particulars of the opponents representative. The Notice of Opposition is not deemed to have been filed until the opposition fee has been paid.

The EPO's further processing procedure may only be used by an applicant for a patent application. Thus a third party opposing a patent may not use further processing should one of the deadlines be missed.

Any person may file an opposition to a European Patent. However, case law has determined that the proprietor of patent may not oppose their own patent in order to improve their patent position.

An opposition to a European patent must be filed directly with the EPO at one of its official offices in Munich, The Hague, or the sub-office in Berlin.

An opposition must be filed in an official language of the EPO. The notice of opposition may be filed in the official language of an EPC contracting state as set out in Article 14(4) EPC and then translated into one of the official languages.

The grounds of opposition are set out in Article 100 EPC and are that:

- (a) the subject matter of the European patent is not patentable under Articles 52 to 57,
- (b) the European patent does not disclose the invention in a manner sufficiently clear and complete for it to be carried out by a person skilled in the art,
- (c) the subject matter of the European patent extends beyond the content of the application as filed, or, if the patent was granted on a divisional application or on a new application filed under Article 61, beyond the content of the earlier application as filed.

If party A opposes a patent granted to party B but then subsequently withdraws their opposition proceedings do not automatically terminate. The Opposition Division of the EPO may pursue the matter of their own motion.

B: Decisions of the Opposition Division may be appealed. Appeals may be filed by any party adversely affected by a decision. In the circumstances set out in this question, party D is adversely affected but party C is not, as their opposition has succeeded in its entirety. Thus D may appeal. C cannot appeal, but would be party to any subsequent appeal proceedings. The deadline for filing the appeal is 2 months from notification of the decision. A notice of appeal must be filed and the fee paid within this time limit. The deadline for filing substantive grounds of appeal is 4 months from the notification of the decision.