

THE JOINT EXAMINATION BOARD

PAPER P5

Basic Overseas Patent Law and Procedure

Friday 9th November 2012

3.00 p.m. – 6.00 p.m.

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

1. You should attempt **five** questions. There are six questions altogether.
2. Each question carries 20 marks. If more than the required number of questions is answered only 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;
 - g. You must number all the pages of your answer script. Once the exam finishes, an additional 5 minutes will be allowed for you to do this.
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). **NOWRITING 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, number all the pages 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 5 pages including this one.

Question 1**[20 marks]**

Your client Brightlite Limited writes:

"We have been very impressed with your work on our portfolio and would like you to assume responsibility for the patent portfolio for our sister company Fasttech Limited. Regrettably, the person responsible for managing their portfolio was taken seriously ill in May 2012. No action has been taken on the portfolio since he was taken ill.

I enclose a schedule of the pending European applications in the portfolio. Please let us know the status of the applications, what actions need to be taken and any associated deadlines".

You check the schedule and the status of the applications and note that there are three European applications:

EP1 was filed on 1 November 2011 claiming priority from a GB application dated 5 November 2010. EP1 was published on 8 May 2012 with the search report.

EP2 was filed on 15 May 2009 without a priority claim. An examination report dated 5 July 2012 raised inventive step objections and set a four-month deadline for response.

EP3 was filed on 17 December 2008 without a priority claim. EP3 was filed with 15 claims. During prosecution, the number of claims was increased to 20. A communication under Rule 71(3) EPC dated 6 May 2012 indicated that the case was in order for allowance.

Write notes for a meeting with the client.

Question 2**[20 marks]****Part A [8 marks]**

You filed an International (PCT) application for your client with claims to a new toothbrush and a method of making the new toothbrush. The application was filed on 9 July 2010 without a priority claim. Your client is interested in seeking protection in China. He has heard that it is possible to file both utility model applications and patent applications in China and has the following questions:

- a) Can both types of applications be filed from the PCT application and if so, is there any deadline for filing the applications?
- b) Can all the claims from the PCT application be included in both applications?
- c) Can I obtain both a granted utility model and a granted patent from the PCT application?
- d) What is the maximum term of protection for both?

Part B [12 marks]

Outline the procedure from filing through to grant for both Chinese utility model and Chinese patent applications. Are there any notable differences or similarities in the procedure?

Question 3

[20 marks]

Part A [10 marks]

- a) What are the minimum elements that an International application must contain to obtain a filing date under the PCT system?
- b) What fees need to be paid for an International (PCT) application?
- c) When must these fees be paid and are there any extensions available?

Part B [10 marks]

Your US client filed an International (PCT) application. The application contains:

- i) Claims 1 to 10 to a compound consisting of a mixture of X and Y
- ii) Claims 11 to 15 to a compound consisting of a mixture of X and Z

A partial International search report covering claims 1 to 10 has issued together with an invitation to pay an additional search fee for claims 11 to 15.

Your client has confirmed that the compound covered by claims 11 to 15 has been well received in the European and US markets. Accordingly, he may be interested in seeking protection in these countries for only this compound.

What are the advantages and disadvantages of paying the additional search fee at this stage, if the International Searching Authority was

- i) the European patent office or
- ii) the US patent and trademark office

In particular, please consider the impact of non-payment on any national/regional phase applications to be filed in Europe and US.

Question 4

[20 marks]

Part A [15 marks]

For each of the following countries:

- India
- Israel and
- Japan

- 1) What are the official language(s) for the application process?
- 2) If the application is not filed in an official language, what is the deadline for filing a translation?
- 3) What is the deadline for requesting examination?
- 4) What information is an applicant obliged to file regarding prosecution in other countries for related applications?
- 5) What steps must a patentee take after grant to maintain their patent in force?

Part B [5 marks]

For Japan, outline the steps that can be taken to invalidate a granted patent.

Question 5**[20 marks]****Part A [10 marks]**

You filed a UK patent application for your client on 30 November 2011. Your client is interested in seeking patent protection in Argentina, Australia, Brazil, Canada, Saudi Arabia and US.

For each of these countries,

- a) Can you file national applications claiming priority from the UK patent application and if so, what is the deadline?
- b) Which can be designated in an International application under the PCT system?
- c) Where applicable, what is the deadline for entering the national phase at the end of the International phase?
- d) Can these deadlines for entering the national phase be extended as of right?

Part B [10 marks]

A Japanese attorney writes:

We filed an International (PCT) application on 14 February 2011 on behalf of our local client. The PCT application was filed in Japanese at the Japanese patent office and claimed priority from a Japanese application filed on 18 February 2010. There are 12 claims in the application. The Japanese Patent Office acting as International Searching Authority identified only prior art which they considered to be of background relevance. International Preliminary Examination was not requested and no amendments were filed during the International phase.

Our client has only recently been successful in attracting funding and he is now very interested in pursuing protection in Europe.

- Is it still possible to enter the European regional phase?
- If so, what steps must be taken and by what deadline?

Question 6**[20 marks]**

With regard to the EPC, write comments on the potential patentability of subject matter described in the following situations.

- a) Client A informs you that he has bred a new variety of grape that will flourish within Scandinavia. **[2 marks]**
- b) Client B informs you that he has developed a novel, non-lethal, man-trap for protecting orchards from thieves. The trap has a spike that passes through a thief's foot and restrains him until he is released. **[3 marks]**
- c) Client C has invented a new method of treating rabies in cats by the topical application of an iodine solution. An iodine solution has not been used in this way before. **[5 marks]**
- d) Client D informs you that he has invented a new method of contraception, including a device used in implementation of the method. Prototypes of the device have been manufactured by a third party contractor, but no devices have yet been tested or sold. **[6 marks]**
- e) Client E informs you that one of their team of inventors has recently left the company. Without authorisation, he has disclosed details of a new invention he had developed for your client on a blog. **[4 marks]**