

P5 – Basic Overseas Patent Law and Procedure

**Friday 3 October 2014
10.00 a.m. – 1.00 p.m.**

Time allowed – THREE hours

INSTRUCTIONS TO CANDIDATES

1. You should attempt **five** of questions 1 to 6.
2. Each question carries **20** marks.
3. If more than five questions are answered only the first five presented will be marked.
4. Start each question (but not necessarily each part of each question) on a fresh sheet of paper.
5. Enter the question paper reference number (P5), the question number and your candidate number in the appropriate boxes at the top of each sheet of paper.
6. The scripts are photocopied for marking purposes.
 - a. Use **black** ink.
 - b. Write on one side of the paper only.
 - c. Write within the printed margins.
 - d. Do not use highlighter pen on your answer script.
7. Do not state your name anywhere in the answers.
8. Write clearly: examiners cannot award marks to scripts that cannot be read.
9. Reasoning should always be given where appropriate.

INFORMATION FOR CANDIDATES

1. The total number of marks for this paper is 100.
2. At the end of the examination the invigilator will instruct you to:
 - a. count the number of pages you have used;
 - b. use the boxes on each page of the answer script to number pages in the format “1 of 25, 2 of 25 etc”;
 - c. place your answer sheets in order in the white envelope, seal the envelope and leave the envelope on the desk.
3.
 - a. Do not staple the pages, or use sellotape or treasury tags.
 - b. You may take the examination paper with you.
4. This question paper consists of 7 pages including this one.

Question 1

Part A

Outline two typical advantages and two typical disadvantages of seeking utility model protection rather than patent protection for an invention.

4 marks

Part B

Your client has developed a cordless beer cooler and a solar-powered charging station for the beer cooler. A PCT application was filed on 4 January 2013 without a priority claim. The PCT application fully describes both the beer cooler and the charging station. The PCT application contains claims to the beer cooler but not the charging station.

The PCT application was published on 10 July 2014 with the International search report. The Written Opinion accompanying the International search report indicated that the claims to the beer cooler were novel but not inventive.

Your client has become aware of a third party who has started selling an identical beer cooler and charging station in Germany, France and Netherlands. Your client wishes to take action against the third party as soon as possible with respect to infringement of both the cooler and the charging station.

Advise your client on any steps that should be taken. Do not consider any aspects of design or copyright.

16 marks

Total: 20 marks

Question 2

The America Invents Act introduced a Post Grant Review process for a third party to challenge the validity of a granted US patent.

- a) Which patents may be the subject of a Post Grant Review process? **1 mark**

The Post Grant Review process has been compared to the Opposition process for challenging the validity of a granted European patent.

Answer the following for both the:

- i) Post Grant Review process in the US
ii) Opposition process in Europe
- b) What is the deadline for initiating the relevant process? **3 marks**
- c) Who may file? **4 marks**
- d) What are the available grounds? **5 marks**
- e) Give one objection which may be raised while the application is still pending but is not available as a ground. **2 marks**
- f) Can a decision at the end of the process be appealed? **2 marks**
- g) Can a ground which was raised during the process be raised again during subsequent infringement proceedings? **3 marks**
- Total: 20 marks**

Question 3

Part A

For each of the following countries:

- i) Australia
- ii) Japan
- iii) South Korea
- iv) Taiwan
- v) US

Indicate whether or not the following subject matter is considered patentable *per se*:

- a) Computer programs
- b) Business methods
- c) Treatment of the human body
- d) Plant varieties.

10 marks

Part B

Your client has filed a PCT application and is now interested in obtaining patent protection in South Korea.

- a) What is the deadline for entering the national phase in South Korea and can the deadline be extended?

2 marks

- b) When must a translation of the application be filed and into what language?

2 marks

- c) When must examination be requested?

1 mark

- d) How is the examination fee calculated?

1 mark

- e) Is a power of attorney required?

2 marks

- f) Is a translation of the priority document required?

2 marks

Total: 20 marks

Question 4

Part A

Your client has filed a PCT application claiming priority from a UK application which was filed on 4 June 2013. Your client is particularly interested in obtaining protection in Singapore.

- a) What is the deadline for entering the Singapore national phase?
- b) In what language must the application be filed?
- c) When must a translation of the application be filed, if required?

3 marks

Part B

Once the Singapore National phase application has been filed, your client has the option of requesting:

Local search and examination
or
Supplemental examination.

- a) Outline the procedure that will apply for this application if your client chooses to request local search and examination. Include any relevant deadlines.
- b) Outline the procedure that will apply for this application if your client chooses to request supplemental examination. Include any relevant deadlines.

9 marks

8 marks

Total: 20 marks

Question 5

Part A

On 1 April 2012 your client forwarded publicity material to a selected group of clients in the USA disclosing technical details of a new tool for extracting dandelion roots. The tool was invented by one of your client's employees. On 30 March 2013 a UK patent application (GB01) was filed directed to the tool. On 30 March 2014 a PCT application was filed for the same invention, claiming priority from GB01. Your client wishes to obtain a European patent and a US patent.

Given this information, explain whether a patent application at a) the US Patent and Trademark Office and b) the European Patent Office would be novel.

7 marks

Part B

On 1 June 2014 another client filed a US patent application [US01] directed to a root vegetable peeler. US01 does not claim priority. The same client also filed a second US patent application [US02] on 1 July 2014 directed to a citrus fruit juicer.

On 15 June 2014 your client purchased all assets of a rival company [Company B]. Company B had previously filed a patent application disclosing a carrot peeler [US03]. The technical details of the carrot peeler of US03 are identical to the technical details of the root vegetable peeler of US01 although different inventors independently developed both inventions. Company B had also previously filed a patent application disclosing a lime juicer [US04]. The technical details of the lime juicer of US04 are identical to the technical details of the citrus juicer of US02 although different inventors independently developed both inventions. Both US03 and US04 were filed on 1 March 2013 and then published on 1 September 2014.

Given this information, discuss the novelty of both US01 and US02 in light of US03 and US04.

7 marks

Part C

Another client revealed, in confidence, details of a new poultry feeder to a business associate in August 2013. On 1 February 2014 details of the poultry feeder were inadvertently published in a trade catalogue in the UK.

- a) Explain whether your client can file a European patent application now and invoke breach of confidence provisions to exclude the catalogue from the prior art.

1 mark

- b) For each of the following countries identify whether there is a grace period that may be used to exclude the trade catalogue from the prior art?

Argentina, Canada, China, Mexico, Taiwan, Poland.

3 marks

Cont...

- c) Explain whether a US patent for your client would be precluded if a rival company filed, on 1 March 2014, their own US patent application describing an identical poultry feeder.

2 marks

Total: 20 marks

Question 6

Part A

On 5 March 2013 you filed a PCT application, in English, for a UK-based client. No priority was claimed. You have now received an International Search report bearing a mailing date of 25 September 2014. The Written Opinion objects that the claims lack inventive step over the cited prior art.

You believe that the inventive step objections are wrong. Your client will want to proceed with the application.

Prepare a memo that explains four options available to your client prior to entering the National/Regional phases. For each option, explain what actions need to be taken, what time limits are involved, and explain any advantages or disadvantages.

16 marks

Part B

You enter a PCT application into the European Regional phase. The application contains three independent device claims. All of the claims were searched during the international phase.

The EPO has now issued a communication objecting that the application contains more than one independent claim in the same category.

- a) What exceptions are available that would allow all of the independent claims to proceed in the same application?

3 marks

- b) When is the deadline for filing a divisional patent application?

1 mark

Total: 20 marks