

International Patent Law FC3 (P5)

Friday 16 October 10:00 to 13:00

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. The total number of marks available for this paper is 100.
5. Start each question (but not each part of each question) on a new sheet of paper.
6. Enter the question number in the appropriate box at the top of each sheet of paper.
7. Do not state your name anywhere in the answers.
8. Write clearly as examiners cannot award marks to answer scripts that cannot be read.
9. The scripts may be photocopied for marking purposes.
 - (a) Use only **black ink**.
 - (b) Write on one side of the paper only.
 - (c) Write within the printed margins.
 - (d) Do not use highlighter pens on your answer script.
10. Instructions on what to do at the end of the examination are on the Candidate Cover Sheet.
11. This question paper consists of 8 sheets, including this sheet.

Question 1

Part A

Your client has invented a new and inventive procedure (P) to treat severely damaged ligaments in the human body. He has also invented a new and inventive mechanical anchorage system (S) for reconnecting severed ligaments in the human body.

Your client has heard that a PCT application provides applicants with international protection. He comes to you today and proposes that you prepare a new patent application disclosing and claiming P and S, and that you first file a PCT patent application for the inventions.

a) **For each of the following four countries, indicate whether your client can obtain patent protection for P, and why:**

- i. **USA;**
- ii. **China;**
- iii. **Australia;**
- iv. **Germany;**

4 marks

b) **For each of the four listed countries, indicate whether your client can obtain patent protection for S, and why.**

2 marks

c) **List two potential advantages and two disadvantages relating to your client's proposed filing strategy.**

4 marks

Part B

Following your advice, the client decides to file a new German patent application (DE1) as first filing for both inventions and only later to file a PCT patent application (PCT1) claiming priority from DE1. Your client is German, and has a place of business in Australia.

a) **With which receiving Offices can he file PCT1? Provide the reasons.**

4 marks

b) **For each competent receiving Office, state the competent International Searching Authority or Authorities, and International Preliminary Examining Authority or Authorities.**

4 marks

c) **If PCT1 related to a 'business method' invention, in which of the competent receiving Offices identified above would you advise that PCT1 be filed assuming that your client wants the ISA to search the business method-related invention? Provide the reasoning.**

2 marks

Total: 20 marks

Question 2

Your client filed a PCT patent application (PCT2) claiming priority from a Spanish patent application (ES1) written in Spanish. The deadline for entering PCT2 in the national phase is 26 October 2015, and your client informs you that he is interested in obtaining patent protection in Brazil, Australia, South Africa, China, Mexico and Israel.

- a) **Is a translation required in each of the listed countries, and in what language, to validly enter PCT2 in the respective national phases? If so, please specify what will need to be translated by 26 October 2015.**

6 marks

- b) **In the countries requiring a translation, can your client rely on any extensions of time to delay the filing of the translation? If so, please provide a brief description of the nature and duration of the extension.**

5 marks

After PCT2 has entered the national phases in the listed countries, your client lets you know that he is also interested in achieving protection in Hong Kong.

- c) **What steps do you need to take to achieve patent protection in Hong Kong? What are the associated deadlines?**

2 marks

- d) **The application has validly entered the national phase in South Africa as PCT2-ZA. Prepare a brief memo for your client outlining the local prosecution procedure.**

3 marks

- e) **The application has validly entered the national phase in Australia as PCT2-AU. Prepare a brief memo for your client outlining the local prosecution procedure.**

4 marks

Total: 20 marks

Question 3

Part A

Your US patent attorney sent you a Restriction Requirement issued by the US Patent and Trademark Office (USPTO) in relation to US patent application US1 owned by your UK client Raceway Components Limited.

- a) **What is a Restriction Requirement? What are the options available in response to a Restriction Requirement? Provide basic details.**

3 marks

Later in the course of the prosecution of US1, a Final Office Action is issued by the USPTO.

- b) **Briefly compare a Final Office Action with a Non-Final Office Action.**

2 marks

- c) **What are the options to overcome a Final Office Action?**

3 marks

- d) **After a Notice of Allowance has been issued by the USPTO, give one situation in which you wish to file a Request for Continued Examination (RCE). Provide one advantage of filing an RCE.**

2 marks

A patent is eventually granted on the basis of US1.

- e) **When are annuities due in the US, and when can they be paid (with no surcharge)? What is the grace period for the payment of annuities (with surcharge)?**

4 marks

Part B

US1 as filed discloses and claims two independent inventions: a mechanical component for suspensions (MC1), and a motorcycle suspension system (SS2). US1 also discloses, but does not claim, a method of controlling the stability of a motorcycle (MCS3).

US1 was amended during prosecution to include only independent claims directed to the mechanical component MC1. The USPTO has notified the applicant that a patent will shortly be issued on the basis of US1, on 27 October 2015, with the above claims.

Your client has phoned you earlier today to advise that they have also just invented a new and inventive test rig (TR4) for testing motorcycle suspension systems. The new test rig has similar features to those of the motorcycle suspension system SS2.

- a) **Set out a strategy for protecting the mechanical component, MC1; the motorcycle suspension system, SS2; the method of controlling the stability of a motorcycle, MCS3; and the new test rig, TR4, in the US. Highlight any important deadlines.**

4 marks

- b) **Is it possible to achieve protection outside the US for the new test rig, TR4, on the basis of any patent application filed therefor in the US? Provide the reason.**

2 marks

Total: 20 marks

Question 4

Part A

You work in the IP department of a company which builds ships. As part of your duties, you routinely monitor the patent and commercial activities of your main competitor.

Your competitor has a PCT application, PCT3, which has recently been published as an A1 publication with a search report issued by the Korean Intellectual Property Office (KIPO) acting as the International Searching Authority. PCT3 discloses and claims apparatus for moving heavy naval engines across a shipyard. You are aware of prior art relevant to the application which, however, is not cited by KIPO.

What is the tool which you can use in the international phase of PCT3 to bring the prior art to the attention of the examiner? What is achieved by using this tool? What are the associated deadlines, for you and for the competitor?

4 marks

Part B

Regional/national phase applications derived from PCT3 eventually grant in Europe, the US and Japan with the same claims. The patents are infringed by your planned commercial activities. After grant, you become aware of additional, relevant prior art which is very likely to invalidate or at least significantly restrict the patents as granted.

a) **Describe Opposition before the European Patent Office (EPO): what is the deadline for filing an Opposition? How is the Opposition filed? Who may file? Can it be filed anonymously? What are the grounds for Opposition? Are third parties allowed to participate in the Opposition after the deadline, and if so why and how?**

4 marks

b) **Describe Post Grant Review (PGR) before the US Patent and Trademark Office (USPTO): what is the deadline for filing a Petition for PGR, who may file it and can it be filed anonymously? What are the available grounds? Is it necessary for court proceedings to have been instituted, and what is the criterion that the USPTO will use to decide whether to institute PGR?**

3 marks

c) **Describe Inter Partes Review (IPR) before the USPTO: what is the deadline for filing a Petition for IPR, who may file it and can it be filed anonymously? What are the available grounds and what prior art can be relied upon? Is it necessary for court proceedings to have been instituted, and what is the criterion that the USPTO will use to decide whether to institute IPR?**

3 marks

d) **Provide one advantage and one disadvantage of Opposition at the EPO over IPR at the USPTO which may be relevant to the present scenario.**

2 marks

e) **Briefly describe the recently introduced Opposition procedure before the Japanese Patent Office (JPO): what is the period for filing an Opposition, and who may file it? How is the fee calculated? What are the available grounds? Is the applicant required to respond to an Opposition and, if so, what must he do?**

4 marks

Total: 20 marks

Question 5

Part A

A large US company is co-applicant of a PCT patent application, PCT4, which was filed in English with the US Patent and Trademark Office (USPTO) on 14 January 2014.

PCT4 claims priority from an earlier US provisional patent application US-P-1, filed on 26 April 2013, and from an earlier US non-provisional patent application US2, filed on 12 June 2013.

The US company wants to enter PCT4 in the regional/national phases in Canada, China, South Korea, Brazil and at the EPO. However, at present the US company is facing budgetary issues which prevent the in-house patent attorney from taking any actions. He is evaluating how to best deal with the situation, knowing that the budgetary issues will soon be resolved.

- a) **What is the deadline for entering PCT4 in the regional/national phase in each of the jurisdictions listed above? Show your calculations. You are not required to take into account any patent office closed days.**

5 marks

- b) **For each of the above-listed countries is late as-of-right regional/national phase entry possible for PCT4? What would be the deadline for late entry where available? Do not take into account any patent office closed days.**

4 marks

- c) **For each jurisdiction providing for late as-or-right regional/national phase entry, set out in detail those requirements for PCT4 which would be in addition to those for regional/national phase entry by the standard due date.**

3 marks

- d) **Provide two disadvantages of entering the regional/national phase late.**

2 marks

Part B

Upon reviewing PCT4 in light of the most recent commercial developments, the in-house patent attorney realises that an important invention disclosed and claimed in PCT4 only validly claims the priority of US2. He is thus contemplating withdrawing the priority claim to US-P-1.

- a) **Is it possible to withdraw the priority claim to US-P-1 in the International phase and, if so, how can the patent attorney do so?**

3 marks

- b) **Give one advantage and two disadvantages of performing such an action.**

3 marks

Total: 20 marks

Question 6

The European Patent Office (EPO) acting as the International Searching Authority (ISA) found the 20 claims of a PCT patent application to cover two separate inventions, A (claims 1 to 10) and B (claims 11 to 20). Since invention A was first presented in the claims, the EPO initially only searched invention A. However, a further search fee was paid to have the EPO, as the ISA, search invention B.

In the written opinion relating to invention A, the EPO objected to the novelty and inventiveness of the claims. In the written opinion relating to invention B, the EPO raised no objections to the claims.

The application will, in due course, be entered into the European phase, and the EPO will in due course issue a Rule 161(1)/162 communication.

- a) **What must you do when you receive the Rule 161(1)/162 communication issued by the EPO in the European phase? State any applicable time limits. What would be the consequence of failing to perform such an action?**

2 marks

- b) **Explain in detail what excess claim fees are payable in the European phase of the application. When do they fall due? Assuming that no payable excess claim fees are paid, can the deemed withdrawn claims still be pursued during prosecution and, if so, on what conditions?**

3 marks

The applicant wishes to amend the claims to include a third invention, C, which is disclosed but not claimed in the PCT patent application, while keeping A and B. It is now too late to amend the claims in the international phase.

- c) **What options do you have to amend the claims as desired by the applicant in relation to the European processing of the application? What are the time limits associated with these options? Describe the nature of the amendment desired by the applicant.**

5 marks

Since the applicant is undecided about which invention to pursue in the European phase of the application, you have ensured that all three inventions, A, B and C, are covered by the claims.

- d) **What is the consequence of including invention C in the claims? Inform the applicant about what the EPO will do next. State how you will need to react, assuming that the applicant will eventually choose to pursue invention C and that the EPO will raise patentability objections against invention C. State any applicable time limits.**

7 marks

- e) **What options are available to the applicant for extending the applicable time period for deciding which invention to pursue in the European phase of the application? Provide the details.**

2 marks

Cont...

- f) **Assuming that the applicant has chosen to pursue invention C in the European phase of the application, state suitable strategies for pursuing protection for inventions A and B, stating any applicable time limits.**

1 mark

Total: 20 marks