

## International Patent Law FC3 (P5)

Friday 21 October 2016 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. Any candidate script removed from the examination room will not be marked.
12. This question paper consists of 9 sheets, including this sheet.

### Question 1

Your client has a *PCT* patent application filed on 29 April 2015 and claiming an earliest priority date of 2 May 2014. The application is in German, has been searched by the EPO in the *PCT* phase, and has 30 claims, including four independent claims and 26 multiple dependent claims.

Your client is interested in filing regional/national phase patent applications at/in:

the EPO,  
Japan,  
China, and  
the USA.

Your client would prefer to spread the cost over at least a few months, even if this ultimately costs more.

- a) **Calculate the standard deadline for filing regional/national phase applications derived from the PCT patent application in each jurisdiction.**  
2 marks
- b) **Identify any jurisdictions which provide for an as-of-right late entry, including how long the procedure can be delayed in any such jurisdictions**  
2 marks

Your client asks you to complete, on the due dates or late due dates wherever possible, only the minimum requirements for validly entering the applications in the regional/national phases in the above jurisdictions.

- c) **What actions do you plan to take? Do not consider any requirements relating to power of attorneys and certified copies of any priority documents.**  
8 marks
- d) **For the listed countries that require excess claim fees, state when such fees are payable and briefly describe their structure in relation to the current application (do not state any fee amounts).**  
8 marks

**Total: 20 marks**

## Question 2

Your client has filed two *PCT* patent applications, PCT1 and PCT2, each having an earliest priority date of 2 February 2016. PCT1 discloses and claims an automotive front airbag (FAB) and side airbag (SAB). PCT2 discloses and claims a new braking system (BS).

The EPO acted as ISA and you have received the search reports for PCT1 and PCT2, each dated 3 October 2016.

The search report for PCT1 is partial and only covers the claims directed to FAB. The accompanying written opinion indicates these claims to be new but not inventive.

The search report for PCT2 covers all the claims. The accompanying written opinion indicates BS to be new and inventive.

- a) **How would you argue for unity of invention between FAB and SAB in the International phase? State any applicable fees (amounts not required).**  
2 marks
- b) **How would the ISA respond to the arguments referred to in a) above?**  
2 marks
- c) **Discuss any deadlines associated with a) above.**  
1 mark

With regard to *PCT* 'Chapter I':

- d) **Describe the procedure for filing amendments to the claims for PCT1 and PCT2.**  
3 marks
- e) **Discuss any deadlines associated with d) above.**  
3 marks
- f) **Are the amendments in d) above published by the International Bureau (IB)?**  
1 mark

With regard to *PCT* 'Chapter II':

- g) **Explain what it is meant by 'Chapter II'.**  
2 marks
- h) **Briefly discuss the Chapter II procedure, including any relevant deadlines and fees (amounts not required).**  
5 marks
- i) **Advise your client whether or not to request Chapter II processing in relation to PCT1 and PCT2.**  
1 mark

**Total: 20 marks**

### Question 3

#### PART A

- a) Write brief notes for your clients on utility models, including discussing differences between utility models and patents.

**5 marks**

- b) Can utility models be obtained in France, the Netherlands, Italy, Spain, Poland and Norway?

**3 marks**

- c) In the countries where utility models can be obtained, can they be derived from a *PCT* patent application, and why?

**4 marks**

#### PART B

A Chinese company contacts you today because they require protection in the above European countries, and further in Germany, for a new cigarette lighter. They have a pending *PCT* patent application, which is soon due for regional/national phase entry. They are worried that a competitor may in due course import a similar lighter into these countries.

You review the *PCT* patent application and conclude that the invention, defined as a lighter having a striker wheel with optimised dimensions for ease of use, is new but probably not inventive over the prior art cited by the ISA, and advise that in due course your client may wish to proceed with utility model protection, where possible.

- a) **What action can your client take to avoid filing their *PCT* application separately in the relevant countries? Where possible, explain on what basis utility model protection can be achieved.**

**5 marks**

The *PCT* application does not claim priority and you now learn that it was filed four months after your client publicly distributed samples of the new cigarette lighter for marketing research.

- b) **Where can utility model protection still be obtained, and why?**

**2 marks**

The International Search Report (ISR) lists a document, D1, in category 'E'. D1 is a *PCT* publication of a patent application that validly entered the regional phase in Europe.

- c) **If your client filed a European regional phase application based on their *PCT* application, how and why would D1 be citable prior art?**

**1 mark**

**Total: 20 marks**

## Question 4

### PART A

A UK company is a manufacturer of composites and has R&D subsidiaries worldwide, where new products are invented. Patent applications are preferably filed in the name of the company. Where possible, the applications are first filed, as a matter of company policy, as European patent applications at the EPO.

A new honeycomb structure (HC-X) for advanced military applications relevant to national security was invented by an Italian inventor in an Italian R&D centre.

A new filament winding machine (FW-Y) for reinforcing pipes was invented by a Japanese inventor in a German R&D centre.

A new thermoplastic resin (TR-Z) to be used as a matrix in composite materials was invented by a US inventor in a US R&D centre.

- a) **Can the company first file a European patent application for HC-X directly with the EPO, or where else could the company file it? Explain your answer.**  
3 marks
- b) **Can the company first file a European patent application for FW-Y directly with the EPO, or where else could the company file it? Explain your answer. Would your answer be different if FW-Y related to advanced military technology relevant to national security?**  
3 marks
- c) **Can the company first file a European patent application for TR-Z directly with the EPO, or where else could the company file it? Explain your answer. Would your answer be different if FW-Y related to advanced military technology relevant to national security?**  
3 marks

### PART B

The company recently acquired the patent portfolio of another company that designs lightweight composite pipes for marine risers.

European patent application EP1 is under examination at the EPO and a communication under Article 94(3) *EPC* was issued dated 13 July 2016. The EPO set a response period of four months. You need time to familiarise yourself with the technology.

- a) **By when must a response be filed?**  
1 mark
- b) **What extensions of time are available, if any?**  
2 marks
- c) **Describe how you can obtain any such extensions, and calculate any extended deadlines (you need not take into account EPO closed days).**  
2 marks

Cont...

A second European patent application, EP2, is also under examination at the EPO. EP2 is in French. The last communication from the EPO was under Rule 71(3) *EPC*. The 'Druckexemplar' proposes that claim 1 be reformatted using the two-part form over prior art document D1.

- d) **What action should you take if the two-part form is appropriate? What action should you take if the two-part form is inappropriate? In each case, provide details of the procedure up to and including grant of a patent based on EP2, including any deadlines.**

**6 marks**

**Total: 20 marks**

### Question 5

Your client is an industrial machinery company and employs inventors worldwide to devise ingenious solutions. Your client routinely submits details of these inventions to you for assessing patentability. When a new patent application is filed, your client collects executed patent assignments from the inventors.

Recently, a *PCT* patent application has entered the national phase in the following countries:

- 1) Brazil
- 2) USA
- 3) Mexico
- 4) India
- 5) Japan
- 6) China
- 7) South Africa
- 8) Saudi Arabia
- 9) Canada, and
- 10) Germany.

- a) **Which countries require an assignment to be filed with the local patent offices? Which countries also require an inventor's declaration?**

**4 marks**

- b) **For each country, indicate whether a request for substantive examination must be filed and by when, ignoring any possible extensions of time.**

**5 marks**

A granted European patent, written in English, is about to be validated in the following countries:

- 1) Germany
- 2) Italy
- 3) Poland
- 4) Netherlands, and
- 5) Norway.

- c) **In which countries do you need to file a translation? Which parts of the patent have to be translated and into what languages? Explicitly state any countries where no translation is required.**

**5 marks**

- d) **State any differences in the answer to c) above, had the patent been written in French.**

**2 marks**

**Cont...**

Your client has recently acquired an Argentinian machinery company. A first patent application for an invention was filed by this Argentinian company at the Argentinian patent office on 5 November 2015.

- e) Quoting any applicable deadlines, outline and justify a suitable strategy to protect the invention in Argentina, Israel, New Zealand, Saudi Arabia and Taiwan, including filing a new *PCT* application.**

**4 marks**

**Total: 20 marks**

## Question 6

### PART A

- a) Provide an example of prior art or other disclosure citable by the USPTO which would not be citable in prosecution at the EPO.

**1 mark**

- b) Provide an example of prior art or other disclosure citable by the EPO which would not be citable in prosecution before the USPTO.

**1 mark**

Mr R is first to devise an invention and reduce it to practice. Independently, Mr T later devises the same invention and publishes it. Mr R later files a US patent application, US-R, for his invention, and subsequently also publishes the invention. Within a year of his own publication, Mr T also files a US patent application, US-T, for his invention.

- c) **Under the US ‘first-inventor-to-file’ system, who gets a patent for the invention, and why?**

**2 marks**

### PART B

Comparing German and Japanese opposition procedures:

- a) Who may file an opposition, and can opposition proceedings be instituted anonymously?

**2 marks**

- b) What are the grounds for opposition?

**4 marks**

- c) What is the period for requesting opposition and how is the opposition fee structured?

**2 marks**

### PART C

Indicate whether the quoted subject matter is, in principle patentable, under patent law in each of Brazil, China, the US and Australia. State any applicable caveats.

- a) computer programs as such,
- b) business method inventions as such,
- c) plant varieties, and
- d) gene sequences.

**8 marks**

**Total: 20 marks**