

P5 2013 Examiner's Comments

While many candidates managed to gain in excess of 70% in this examination, there were a few extremely low scores. I can only imagine that some candidates are attempting to sit the exam a short time after starting out in the profession. If so, it would seem to be a waste of everybody's time.

Question 1

This question related to International Search Reports and partial International Search Reports. It is hoped that most trainees would have an opportunity to report at least one such Search Report prior to taking the P5 examination. The overall marks for this question were low, however.

Part A

This part required candidates to prepare a memo explaining all options available following receipt of an International Search Report and Written Opinion. The question noted that the client intended to enter the National Phases in a large number of territories. While most candidates identified that claims may be amended under Article 19, and that International Preliminary Examination may be demanded, very few candidates spotted that informal comments may be filed or that the client may simply do nothing. For each of the options candidates needed to explain what actions needed to be taken, what time limits were involved, and identify any advantages or disadvantages. The actions to be taken, and the relevant time limits, may be found in the PCT Applicant's Guide.

Part B

Your client had received a partial International Search Report stating that the application has three separate inventions, only the first of which has been searched. Applicants were expected to identify that one, or two, extra search fees may be paid in order to have the separate inventions searched and that the extra fees may be paid under protest along with payment of a protest fee. Alternatively, the applicant may simply do nothing, in which case the International Search Report will be established based only on the first invention.

Question 2

This question required knowledge of filing procedures in a small number of countries. Such information is found in reference works such as the Brown Book. Although this was a straightforward question very few candidates attempted to answer it.

Candidates are expected to have learned information such as the language(s) in which an application be filed/prosecution, whether a Power of Attorney is required and the formal requirements for claiming priority, for each of the countries identified in the syllabus. If the material has been learned, such questions are an easy source of marks.

In Question 2 candidates were expected to know that an Australian patent application may be filed in English, an Indian application in Hindi or English, a Norwegian application in English, Swedish, Danish, or Norwegian, a Polish application in Polish, and a Brazilian application in Portuguese. The Norwegian application must be translated into Norwegian. Powers of Attorney are required in Norway, Poland, Brazil and India. A certified copy of the priority document is required in Poland, and India within three months of filing, and in Brazil within 180 days of filing. A certified copy of the priority document is only required in Australia if requested. Translations of the priority document are required in Brazil, India, Poland and, if requested, in Australia.

Question 3

This question related to the new US laws on novelty (35 USC Section 102). It is important for P5 candidates to be able to determine whether an invention is novel under the US law and they should know section 102 well.

Part A

This part required the applicant to determine whether an invention directed to a mousetrap is novel if the mousetrap itself was sold by the applicant prior to the date of the patent application. The sale by the applicant occurred more than a year before the applicant filed the US patent application (although many candidates missed this). Thus, the claimed invention is not novel.

There is no difference if the sale occurs in Taiwan rather than in the USA. Sale of goods anywhere in the world more than 12 months before the effective filing date of a claimed invention will be prior art to a US patent application.

Part B

JP02 is not prior art to the US patent application. JP02 was published after the date on which the US patent application was filed. The situation does change for US02 which claims priority from CN01. In this case US02 has been published and can be full prior art to novelty and inventive step, if US02 is entitled to its priority.

Part C

The earlier US patent application is unpublished. The other application does not name a different inventor, therefore it is not prior art. It is OK for both applications to be pursued at the same time. The US Patent Office may raise double patenting issues, but these can be dealt with by means of terminal disclaimers.

Part D (i)

The disclosure by the inventor was less than 12 months ago, so the US grace period applies to this disclosure. The competitor's disclosure is not prior art as it occurred after the client's disclosure (USC 102(b)(i)(B)). Thus a US patent is still a possibility.

Part D (ii)

Your client's competitor was the first to file a US patent application. However, the competitor application is not published, and was filed after your client's disclosure. Even though the client is not the first to file, they were the first to disclose and, thus, can still obtain a US patent.

Question 4

This question related to European patent law and was answered well by many candidates.

Part A (i)

This part required knowledge of the procedure for granting a patent under the EPC. The actions needed to obtain a decision to grant include payment of the grant fee, payment of the publication fee, filing of translations of claims into French and German, and payment of excess claims fees. The deadline should be worked out using the 10 day rule to gain full marks.

Part A (ii)

Notes advising a client on the procedure for making amendments should include the fact that you can file reasonable amendments, that a new Communication under Rule 71(3) would issue, that deadlines would be re-set, and that examination proceedings may be resumed.

Part B

This part required a knowledge of the translation requirements for granted patents in European EPC contracting states, and particular knowledge of the London Agreement. Candidates who had learned this scored.

Question 5

Part A

This part is a straightforward question regarding PCT status and time limits for National Phase entries. Along with the PCT member states China and Mexico, and the non-PCT state of Taiwan, candidates should note that protection in Hong Kong may be applied for based on a national UK application, an EP application designating the UK, or a Chinese patent application. Protection in Hong Kong can be applied for within six months of publication of the GB, EP or Chinese application. Applicants should also note that a French patent application cannot be filed directly from the PCT and that the applicant would need to file a European patent application and then maintain the French designation once granted.

Part B

This part required an understanding of the right to file an International patent application. The PCT provides that a resident or national of a contracting state may file an International patent application. The Argentinean inventor is not the national of a PCT contracting state. The Argentinean inventor may, however, be resident in a contracting state and, if so, she can still file an International patent application. Saudi Arabia is now a PCT contracting state.

Part C

The remaining extension states are Bosnia & Herzegovina and Montenegro. Extension states are non-EP states that have concluded an extension agreement with the EPO. On extension to the states, protection is provided by national patent law of the extension state and not by the EPC. The deadline for paying extension fees is the same as the deadline for paying designation fees. Thus, the deadline for a Regional Phase entry of an International patent application is 31 months from the date of filing, or the date of priority if earlier than the date of filing. The deadline for a non PCT European patent is six months from the date that the Bulletin mentions publication of the European Search Report.

Question 6

Part A

This required knowledge of Australian patent procedure. The deadline for requesting examination is five years from filing the application or two months from a direction issued by the Australian Patent Office. The acceptance term is 12 months from the date of the first adverse Examination Report. It is possible to accelerate Examination in Australia. Modified examination is no longer possible in Australia. A patent of addition is a patent granted for an improvement or modification of a main patent. The main patent must not be an innovation patent. A patent of addition is not invalid on the ground that it is obvious over the main patent. The term is that of the unexpired term of the main patent. A patent of addition may be applied for by the owner of

the main patent or by a third party authorised by the owner. A granted Australian patent cannot be opposed. However, there is a pre-grant opposition procedure.

Part B

This part required knowledge of the new US laws relating to micro-entity status. The main reason for wishing to file as a micro-entity is the 75% reduction in many US Patent Office fees.

An individual inventor who personally filed more than a dozen US patent applications will not qualify, as there is an experience criteria. An inventor must have filed no more than four previous US applications.

The successful city trader will not qualify for micro-entity status, as there is an earnings criteria.

A university that is developing and patenting a device for a large multi-national company is unlikely to be able to qualify as a micro-entity because it is likely that there will be some obligation to licence or assign to the large company.