

**P5 – Basic Overseas Patent Law and Procedure
Mark Scheme 2014**

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

Answer

Part A

Any sensible points – **one mark each**:

Advantages

- lower standard inventiveness,
- formal examination only,
- fast registration of enforceable right,
- lower cost registration,
- lower lifetime renewal costs

Disadvantages

- shorter term protection,
- no harmonised laws between countries,
- available in fewer countries than patents,
- restricted subject matter that can be protected

4 marks

Part B (maximum of 16 Marks from following)

Cannot take action until rights granted	1 mark
EPC (Covers all countries)	1 mark
Enter regional phase early – request early processing	1 mark
Request PACE	1 mark
File national translations of claims in German, French, Dutch – damages	1 mark
Notify infringer	1 mark
Claims novel but not inventive – thus may be difficult to obtain protection	1 mark
Claims may need to be amended/arguments filed when enter regional phase	1 mark
Add claims to charging station	1 mark
Interrelated product and thus can argue unity	1 mark
But such claims relate to unsearched subject matter (NB new law on this)	1 mark
Likely to need a divisional application	1 mark
Separately request PACE on divisional application	1 mark

Germany

Also file a utility model asap	1 mark
Add claims to a charging station	1 mark
Lower bar for inventive step (0.5 marks) so valid protection can be obtained quickly (0.5 marks)	1 mark

France

Not possible to enter French national phase so need to file EPC application (0.5 marks) No utility model (0.5 marks)	1 mark
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Netherlands

Not possible to enter Dutch national phase so need to file EPC application (0.5 marks) No utility model (0.5 marks)	1 mark
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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**

Answer

- a) Only those patents issuing from application subject to first inventor to file provisions of AIA, i.e. US applications filed on/after 16 March 2013 under AIA (NB – Post AIA is the key point for the mark) **1 mark**
- b)
- i. US - 9 months from grant of patent **1 mark**
or grant of reissue patent **1 mark**
- ii. Europe – 9 months from grant **1 mark**
- Total: 3 marks**

- c)
- i. US - person who is not the patent owner **1 mark**
and has not previously filed a civil action challenging the validity of a claim of the patent **1 mark**
 - ii. Europe – any person but not patent owner **2 mark**
- Total: 4 marks**
- d)
- i. US - novelty **(0.5 marks)**, obviousness **(0.5 marks)**, written description **(0.5 marks)**, enablement **(0.5 marks)**, indefiniteness **(0.5 marks)** but not best mode
 - ii. Europe – patentability – novelty **(0.5 marks)**, inventive step **(0.5 marks)** and inherent patentability **(0.5 marks)**, insufficiency **(0.5 marks)**, added subject matter **(0.5 marks)** **5 marks**
- e)
- i. Any possible objection; e.g. US - best mode, restriction, entitlement **1 mark**
 - ii. Europe – clarity, unity, 2 part form **1 mark**
- Total: 2 marks**
- f)
- i. US - yes **(0.5 marks)** any dissatisfied party may appeal **(0.5 marks)**
 - ii. Europe – yes **(0.5 marks)** any person adversely affected by the decision may appeal **(0.5 marks)** **2 marks**
- g)
- i. US - No **(0.5 marks)** estoppel created so cannot raise same issue **(0.5marks)**
 - ii. Europe – Yes **(1 mark)** infringement would be before national court and not before EPO so same issue can be raised again depending on national law **(1 mark)** **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

Answer

Part A

Answer – ½ mark each

	Computer programs	Business Methods	Treatment Human Body	Plant variety
Australia	Yes	Yes	Yes	Yes
Japan	Yes	Yes	Yes	No
S Korea	No	Yes	Yes	No
Taiwan	No	Yes	No	No
USA	No	Yes	Yes	Yes

Part B

- a) 31 months from priority or filing **(1 mark)**; no extension **(1 mark)** **2 marks**
- b) Korean **(1 mark)**, on National phase entry **(1 mark)**? **2 marks**
- c) Five years from international filing date **1 mark**
- d) Flat fee plus fee for each claim **1 mark**
- e) Yes **(1 mark)** applicant outside Korea must appoint an agent and file a power of attorney **(1 mark)** **2 marks**
- f) If requested **(1 mark)**. Can also file a statement that application is identical to priority document **(1 mark)** **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

Answer

Part A

- a) 30 months so 4 December 2015

1 mark

- b) English

1 mark

- c) 30 months

1 mark

Part B

- a) **Any of the following – up to a maximum of 9 marks**

Request local search and examination

1 mark

within 36 months of priority

1 mark

Examiner issues written opinion	1 mark
5 months to respond	1 mark
Possible 2 nd written opinion (1 mark) & 5 months respond (1 mark)	
Examiner's report (1 mark) issues 18 months from 1 st written opinion (1 mark)	
Examiner's report is either:	
Notice of eligibility	1 mark
or	
Notice of intention of refuse	1 mark
Within 2 months of notice of eligibility pay grant fee	1 mark
Within 2 months of intention to refuse, apply to review	1 mark
Thereafter either notice of eligibility or refusal	1 mark

b) Any of the following – up to a maximum of 8 marks

Rely on positive IPRP (0.5 marks) or acceptance/grant of application in Australia (0.5 marks) , Canada (0.5 marks) (English language) (0.5 marks) , Japan (0.5 marks) , New Zealand (0.5 marks) , Korea (0.5 marks) , UK (0.5 marks) , US (0.5 marks) EPO (0.5 marks) (English)	5 marks
Request filed within 54 months from priority	1 mark
Examiner issues written opinion	1 mark
3 months to respond	1 mark
No 2 nd written opinion	1 mark
Check for constraints within SG laws	1 mark
and that claims relate to corresponding application	1 mark
If rejected, 1 chance to respond	1 mark
If eligible as above, i.e. 2 months for grant fee	1 mark
	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

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

Answer

Part A

EP – disclosure to selected clients is likely to be a public disclosure.

1 mark

Disclosure is prior to priority date, therefore not novel

1 mark

USA – priority date of UK application will be effective filing date of the US application

1 mark

publicity material published less than 1 year before effective filing date

1 mark

Disclosure derived directly or indirectly from inventor

1 mark

therefore the disclosure is not prior art for the US patent application

1 mark

US application is novel over the disclosure.

1 mark

Part B

US03 and US04 both US applications that have been published

1 mark

and have earlier effective date than US01 and US02.

1 mark

At filing date of US01 US03 was owned by a different company

1 mark

US03 will be novelty prior art for US01

1 mark

Therefore US 01 not novel

0.5 mark

At filing date of US02, US04 was owned by the same company

1 mark

Therefore not prior art.

1 mark

US02 is novel.

0.5 mark

Part C

Longer than 6 months ago, so no.

1 mark

Argentina - Yes

0.5 marks

Canada – Yes

0.5 marks

China – No	0.5 marks
Mexico – Yes	0.5 marks
Taiwan – No	0.5 marks
Poland – No	0.5 marks

Details of the poultry feeder were publically disclosed by another who had obtained the subject matter from the inventor before the effective filing date of the third party application.

1 mark

Thus the third party application is not prior art.

1 mark

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

Answer

Part A

Four Answers from five options below. Maximum of 16 marks awarded

1 - Amended claims art 19

1 mark

2 months from search report

0.5 marks

Or 16 months from priority if later

0.5 marks

claims published

0.5 marks

written opinion doesn't change

0.5 marks

can't amend description

0.5 marks

may not be appropriate objection is that claims lack inventive step

0.5 marks

2 - Demand ipr	1 mark
latest of 3 months from isr	0.5 marks
or 22 months from priority	0.5 marks
can amend both description and claims	0.5 marks
enter dialogue with examiner, can obtain a positive iprp,	0.5 marks
expensive	0.5 marks
iprp non-binding.	0.5 marks
3 - File informal comments	1 mark
placed on file and communicated to national offices	0.5 marks
no response from the ISA/ no dialogue	1 mark
no official fee (but attorney costs)	0.5 marks
no time limit	0.5 marks
opportunity to explain a clear error on part of isa	0.5 marks
4 - Do nothing	1 mark
no need to respond	0.5 marks
address issues when entering national phases	0.5 marks
low cost option in short term	0.5 marks
but need to address issues with each national office so may be more expensive in long term	1 mark
30 and 31 month deadline.	0.5 marks
5 – Request a Supplementary Search	1 mark
19 months from priority	0.5 marks
Must file with IB and specify desired search authority	0.5 marks
Reduces risk of further prior art	0.5 marks
Must be filed in English or French	0.5 marks
Not published	0.5 marks

Few options of Supplementary search authority

0.5 marks

Part B

a) A plurality of interrelated products

0.5 marks

Different uses of a product or apparatus

0.5 marks

Alternative solutions to a particular problem, where it is inappropriate to cover these Alternatives by a single claim.

0.5 marks

b) While the application is pending

1 mark

Total: 20 marks