

THE JOINT EXAMINATION BOARD

PAPER P5

BASIC OVERSEAS PATENT LAW AND PROCEDURE

11th November, 1992

2.00 p.m. - 5.00 p.m.

Please read the following instructions carefully. This is a THREE HOUR Paper.

1. You should attempt no more than five questions.
2. The number of marks allotted to each question is placed in brackets at the end of the question.
3. Where a question permits of reasons being given for conclusions reached, such reasons should be given.
4. Start each question (but not necessarily each part of each question) on a fresh sheet of paper and number it clearly in the margin. Write on one side of the paper only using BLACK ink. You must write your examination number and the designation of the Paper in the top right hand corner of the sheet. You must NOT staple pages together. You must NOT state your name anywhere in the answers.
5. Unless specifically requested answers are NOT required in letter form.
6. NO printed matter or other written material may be taken into the examination room.

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1. Your client, a small but extremely profitable UK-based manufacturer of household products, is preparing to re-launch one of his major products, a soap bar,

Although the soap composition is the same as that of the present product, one of the components is formed in-situ rather than being incorporated as an additive, and another has been discovered to have a new and hitherto unobserved effect in moisturising the skin during washing.

Because of the importance of the re-launch, your client has indicated that he will need all the protection that you can sensibly obtain for him, almost regardless of cost.

Say what patent applications would be appropriate for protection in

France
Germany
Japan
USA

commenting on their effect when granted and on any conditions which might be attached to obtaining grant or to enforcement.

(20 marks)

- 2.a) What are the minimum requirements which have to be fulfilled if an application is to receive a filing date at the EPO.⁸
- b) Explain what is meant by an "international deposit" under the Hague Agreement. What conditions have to be satisfied in order for a valid application to be made.
- c) Outline the protection given by a EP patent application (DE) at the various stages from filing at the EPO until grant. State what conditions, if any, have to be fulfilled before protection is given.

(20 marks)

3. The United States operates a "first to invent" patent system, with a procedure in which a patent is published only when it is granted.

Japan, by contrast, has a "first to file" system with early publication and the possibility of delayed examination.

Discuss the relative merits of the two systems under the headings

- (a) certainty for industry
- (b) speedy protection
- (c) cost

taking into consideration that both countries are members of PCT.

(20 marks)

4. Write short notes on five of the following, which are items commonly found in US patent practice:-

- (a) Markush claims
- (b) file wrapper estoppel
- (c) duty of disclosure
- (d) date of conception
- (e) export licence
- (f) due diligence

(20 marks)

5. What steps under EPC could you take which might improve your client's patent position if its European Patent Application

- (a) is the subject of an observation under Article 115 which contains an apparently inadvertent mis-representation of the facts;
- (b) has been refused, because a response to a communication relating to substantive examinations seems to have gone astray in the mail and was not received by the EPO;
- (c) has been rejected on a subject-matter ground by the Examining Division;
- (d) has lapsed, owing to a banking error which resulted in a cheque wrongly being returned to the EPO marked "refer to drawer" on a date three days after the time limit for payment had expired.

(20 marks)

6. There have been a number of recent changes in substantive patent law:

- (a) what changes have been implemented which affect the categories of invention which are patentable in Spain?

- (b) which two countries have become members of the EPC in 1992: name two eastern European countries which have become contracting states of the PCT: which EPC country has introduced a requirement that an EP patent should be translated in 1992.
- (c) what are the provisions regarding the applicability of patents obtained in the former separate states of East and West Germany to the new unified Federal Republic?
- (d) what changes have been made by Canada and the USA to their former practise of granting patents for the full term, without a requirement for payment of renewal fees?

(20 marks)