

THE JOINT EXAMINATION BOARD

PAPER P5

BASIC OVERSEAS PATENT LAW AND PROCEDURE

15th November, 1995

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. In the appropriate boxes at the top of each sheet please enter the designation of the paper, the question number, and your Examination number. Write on one side of the paper only using BLACK ink. 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.
7. Answers MUST be legible. If the examiners cannot read a candidate's answer no marks will be awarded.

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1. Comment on the changes to United States patent law consequent upon the implementation of the GATT Agreement under the headings of:-
- |  |            |
|--|------------|
| Term   | [10 marks] |
| Provisional applications   | [5 marks]  |
| Establishment of proof of invention date outside the United States | [5 marks]  |
2. What do you understand by the following terms:-
- |  |           |
|--|-----------|
| a) Extension countries (EPC); name two such countries  | [5 marks] |
| b) Parallel imports (Europe)   | [5 marks] |
| c) Deferred examination (Japan)  | [5 marks] |
| d) Gebrauchsmuster (Germany). Give one example of invention for which such right is not obtainable | [5 marks] |
3. a) Outline the provisions of the Dutch Patents Act, 1995 [10 marks]
- b) Why was the "Mobil Oil" decision of the Technical Board of Appeal of the EPO seen as such a landmark? Discuss the possible interpretation of the "second chemical use" claims allowed in that Appeal [10 marks]

4. What is:-

- a) Modified Examination (Australia)? [2 marks]
- b) A restriction requirement (USA) [2 marks]
- c) The "problem and solution approach" (EPO) [5 marks]
- d) An enabling disclosure (USA) [4 marks]
- e) The term for filing a Japanese translation of a specification initially filed in a language other than Japanese [2 marks]
- f) "Entry into the National Phase" (PCT). What is the maximum term for this in the EPO? [3 marks]
- g) A registration country and give one example [2 marks]

5. In what circumstances would publication of an invention not prejudice an application filed subsequently for that invention in

- a) Japan      b) United States      c) EPO [20 marks]

6. a) Set out with the help of a diagram if necessary the steps past which a European Patent Application passes from first filing to grant after an Appeal from a Decision of the Opposition Division. [10 marks]
- b) What are the pre-conditions for liability for damages for infringement before grant of a European Patent [10 marks]