

THE JOINT EXAMINATION BOARD

PAPER P5

BASIC OVERSEAS PATENT LAW AND PROCEDURE

19th November, 1996

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.

COMPRISES 4 PAGES (INCLUDING THIS PAGE)

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1. You receive a letter from your client on 13th November 1996, telling you about a PCT application which he has filed. The application describes and claims a new product. It had originally been decided that no action would be taken to proceed with the application, but it has now been realised that the application may have some considerable value.

Your client tells you that he now wishes to protect the invention, which is the subject of the PCT application, in Australia, France, Japan, Sweden, USA and the UK.

You see from the front page of the published PCT application that the application claims a priority date of 2nd March 1995 and has a filing date of 1st March 1996, and that the designated states are AU, GB, JP, US, European patent (DE, FR, GB).

Write notes on the action which can be taken to protect your client's rights in the countries of interest to him, and any time limits for taking such action. General notes only are required, rather than detailed lists of documents to be filed or fees to be paid.

(20 marks)

2. What documents need to be filed to support a European divisional application, and what fees need to be paid? What are the time limits for taking these steps, and where can the necessary documents be filed? What factors limit the extent of protection (geographically, and in terms of the scope of the claims) which can be obtained by means of the divisional application?

(20 marks)

3. You are the representative for a pending European patent application designating France, Germany, Italy, The Netherlands, Spain and the UK. You become aware of a published European patent application (designating France and Germany), which claims priority from, and has the same specification as, a published British patent application. The British application was filed before the priority date of your client's application, and the British and European applications were both published later than the filing date of your client's application. The disclosure of the published British and European applications falls within the broadest claims of your client's application.

Write a letter to your client, explaining the situation, and setting out your proposed course of action to maximise the protection for your client's invention.

(20 marks)

4. What terms are available for requesting examination of a patent application in:

- a) Germany
- b) Japan
- c) Canada
- d) United States
- e) European Patent Office

(8 marks)

What terms are available for filing a notice of opposition against a granted patent in:

- f) Japan
- g) European Patent Office

(4 marks)

h) Write notes on United States re-issue procedure

(8 marks)

5. You have filed a British patent application for an individual inventor, and, having considered the results of the novelty search, you are now preparing to file new applications, claiming priority from the British application, in the United States and the European Patent Office.

a) What points would you bear in mind when preparing claims for the new applications?

(14 marks)

b) What documents need to be filed to support the US application?

(6 marks)

6. Your client is interested in the protection which may be obtained by its competitor, who has filed a British patent application (allowed to become abandoned after 12 months), and a PCT application claiming priority therefrom. It is 29 months since the earliest claimed priority date of the application, which is proceeding via Chapter II of the PCT. Your client would like to see copies of various documents relating to the PCT application.

a) What is the effect of Chapter II PCT, and what action must be taken to initiate the process? What points would you bear in mind when advising a client as to whether or not to initiate the Chapter II process?

(11 marks)

b) How (if at all) would you most easily be able to obtain copies of:

the international search report;

the international preliminary examination report;

the application from which the PCT application claims priority?

(6 marks)

c) Name three of the following countries in which national patents (as well as European patents) can be obtained via the PCT?

France
Germany
Italy
Netherlands
Portugal
Spain

(3 marks)