

THE JOINT EXAMINATION BOARD

PAPER P5

BASIC OVERSEAS PATENT LAW AND PROCEDURE

11th November, 1997

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. In proceedings before the European Patent Office, what is meant by:

- (a) Reinstatement ("*restitutio in integrum*")
- (b) Appeal
- (c) Further processing

In particular, for each of these, explain when it would be appropriate to make the relevant application, and what conditions must be fulfilled before the requested action will be taken by the EPO.

(20 marks)

2. (i) Describe what is required to enter Chapter II PCT, and what is the subsequent procedure.

(10 marks)

(ii) What terms are available under both Chapter I and Chapter II of the PCT, for entry into the national phase of an international application in:

- (a) Australia
- (b) the Czech Republic
- (c) Japan
- (d) Norway
- (e) New Zealand

(10 marks)

3. Under what circumstances are claims fees payable in respect of applications filed in the:

- (a) European Patent Office
 - (b) United States Patent and Trademark Office
- (8 marks)

What are the criteria which must be fulfilled by an applicant to meet the definition of a "small entity" in:

- (c) Canada
 - (d) United States
- (12 marks)

4. Outline the procedure for obtaining a patent in the Netherlands by the national route.

(16 marks)

Excluding the Netherlands (and the United Kingdom), name one country whose national patent grant procedure includes substantive examination of the application, and one country whose national patent grant procedure excludes substantive examination.

(4 marks)

5. Write short notes on the following aspects of United States practice:

- (a) Duty to disclose material relevant to patentability. (5 marks)
- (b) Provisional applications (5 marks)
- (c) Continuation-in-part applications (5 marks)
- (d) First-to-invent (5 marks)

6. (a) Explain what is meant, in proceedings before the European Patent Office, by the term "extension state". (8 marks)

(b) Name four extension states. (4 marks)

(c) Describe the procedure for obtaining patent protection in an extension state using the EPO route. (8 marks)