

THE JOINT EXAMINATION BOARD

PAPER P5

BASIC OVERSEAS PATENT LAW AND PROCEDURE

17th November 1998

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.
8. Please put your answers in QUESTION NUMBER ORDER before placing in envelope provided.

THIS PAPER COMPRISES 3 PAGES (INCLUDING THIS FRONT SHEET)

## PAPER P5

## Answer FIVE questions only

1. a. A Japanese applicant filed a PCT application in Japan on 23 April 1997, claiming a Japanese priority of 24 April 1996 and designating inter alia the EPO for all EPC states. The PCT application has been properly subject to international search and international preliminary examination by the Japanese Patent Office.

What must be done to enter the EP “regional phase”, i.e. so that the EP designations in the PCT application proceeds to be handled by the EPO?

Your answer must specify any time limits involved, but only the basic time limits i.e. do not discuss extensions, restitution and the like.

(8 Marks)

- b. Your client writes to you as follows:

“You will recall that you recently approved the text for grant under Rule 51(4) EPC. However we have now identified two errors in the specification we would like to correct. Firstly on page 3 of the description reference is made to “between about 10 and 1000 mg/ml”. This is incorrect. Instead this passage should state “between about 10 and 1 000µg/ml”. The correct values were given in claim 4 as originally filed. Secondly on page 8 the reference to a published journal which sets out how to carry out step (b) of our method is missing. It was in the priority document and accidentally omitted when typing the specification for filing in Europe.

Please let me know if we can make the corrections.”

Please write a letter in reply to your client.

(12 Marks)

2. Write an information sheet suitable for UK clients about using the PCT. The information sheet should set out in general the PCT procedures and explain particular advantages of the system.

(20 Marks)

3. Write brief notes on **four** of the following aspects of US patent law and procedure.

- a. restriction requirements
- b. continuation-in-part applications
- c. file-wrapper estoppel
- d. re-examination
- e. interference proceedings

(total 20 Marks – 5 Marks each)

4. Comment on the possible patentability under the EPC of the following:
- a. A process for modifying the surface of an artificial bone in situ in a patient's limb by radiation treatment, to improve its compatibility with surrounding tissues. (5 Marks)
  - b. A new work schedule for co-ordinating the stages of a multistage operation in a factory to improve output. (5 Marks)
  - c. A method for opening locks without using a proper key. (5 Marks)
  - d. A method of traffic control. (5 Marks)

Make brief notes that will form the basis of letters to your clients.

5. Your client has a European application designating UK, FR, DE, NL, SE, AT, IT with a priority date of 5 February 1997 and a filing date of 4 February 1998. You receive a search report. It lists the following X category documents:
- a. A European application which designates DE, NL, SE and IT with a priority date of 28 January 1997, a filing date of 28 January 1998 and a publication date of 28 July 1998.
  - b. A paper in a science journal dated 15 May 1997 which purports to be the paper publication of a presentation made at a conference which ran from 3 to 5 February 1997.
  - c. A Derwent abstract of JP103225/1997 which was filed on 16 September 1995 and published on 19 March 1997.
  - d. A WO publication which designates EP for all states and has a filing date of 22 May 1996 and a publication date of 26 November 1997.
  - e. -A DE application filed on 10 December 1996 without priority claim and published on 17 June 1998.

Write a letter reporting the search report to your client.

(20 Marks)

6. Outline the major features of patent application procedure and the opportunities for attack by third parties in two of Japan, Australia, Canada. (20 Marks: 10 per country)