

THE JOINT EXAMINATION BOARD

PAPER P5

BASIC OVERSEAS PATENT LAW AND PROCEDURE

21<sup>st</sup> NOVEMBER, 2000

2.00 p.m. – 5.00 p.m.

*Please read the following instructions carefully. Time allowed - THREE hours.*

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, reasons should be given for the conclusions reached.
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** 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. **NO** writing whatsoever, including numbering of pages, is allowed prior to the commencement of the examination or after it has finished.
9. Please put your answers in **QUESTION NUMBER ORDER** before placing in the envelope provided.

This paper consists of **three** pages including this page

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**PAPER PS**

**BASIC OVERSEAS PATENT LAW AND PROCEDURE**

**21st NOVEMBER, 2000**

**2.00 p.m. – 5.00 p.m.**

**Answer FIVE questions only**

1. In response to the following:  
What actions should be taken, and by what time, to maintain these applications in force? What is the result of not taking those actions?
  - a) receipt of an EPO notice under Rule 69(1) EPC, notifying you of the deemed withdrawal of an application, due to the failure to respond on time to an Official Communication pursuant to Art 96(2) & Rule 51(2) EPC (Examination Report);
  - b) receipt of a PCT invitation to correct defects in the international application (PCT/RO/106), requesting correction of prescribed data regarding the applicant;
  - c) receipt of a Communication pursuant to Rule 51(6) EPC; and
  - d) receipt of an EPO notice of the filing of an opposition by a third party.

(Total 20 marks-5 marks each)
  
2. Comment on the patentability of, and possible objections to, the following, under the EPC:
  - a) a means of classifying users of an internet service so as to enable targeted marketing;
 

(7 marks)
  - b) an attachment to a shotgun to enable its repeated use without reloading; and
 

(6 marks)
  - c) software that enables a user to present information on a computer screen more quickly than was previously possible.
 

(7 marks)
  
3. Outline the major features of patent application procedure and the opportunities for attack by third parties in any **two** of France, Japan and the USA.
 

(20 marks)

**PAPER P5**

4. a) One British national and one US national collaborate in the UK for three weeks, while employed by a UK company, where they produce an invention. The UK company wishes to disclose the invention in two days and asks you to protect their invention.

Where would you choose to file a patent application? State your options and give reasons for your choice.

(6 marks)

- b) In an unrelated case, you are requested to file a PCT application, claiming priority from a UK application, designating all states. However, one applicant/inventor refuses to sign the PCT Request (PCT/RO/10 1).

What action would you take to ensure that the PCT application is validly filed and that the PCT application can subsequently enter the US national phase?

(6 marks)

- c) You are instructed to enter the regional phase of a PCT application at the EPO.

What steps will you be required to take in order to enter the regional phase at the EPO, assuming you requested international preliminary examination during the international phase of the PCT application?

(8 marks)

- 5 Write brief notes on each of the following aspects of foreign patent law and procedure:

- a) US continuation-in-part applications;
- b) PCT international phase;
- c) EPO opposition; and
- d) Australian examination.

(Total 20 marks-5 marks each)

- 6 Discuss:

- a) the patentability of both software inventions and business method inventions and their implementations, as viewed by the European Patent Office and compare this with the view taken by the US Patent Office

**OR**

- b) the patentability of a drug which was previously used for high blood pressure, which is shown to be an effective treatment for anaemia.

(20 marks)