

THE JOINT EXAMINATION BOARD

P5 BASIC OVERSEAS PATENT LAW AND PROCEDURE

20th November 2001

2.00 p.m. - 5.00 p.m.

Please read the following instructions carefully. Time Allowed **THREE HOURS**

1. You should attempt **five** questions. The number of marks allotted to each question is placed in brackets at the end of the question.
2. Where a question permits, reasons should be given for the conclusions reached.
3. Unless specifically requested answers are NOT required in letter form.
4. Write on **one** side of the paper only using BLACK ink. You must **NOT** staple pages together.
5. 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. You must **NOT** state your name anywhere in the answers.
6. NO printed matter or other written material of any kind 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 papers, 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 them in the envelope provided.

THIS PAPER CONSISTS OF FIVE PAGES INCLUDING THIS PAGE.

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Question 1

(a) Your UK-based client filed a UK application for an invention eleven months ago, then last week started selling products incorporating the invention and from which it is possible to derive the invention. Your client wants protection for the invention in the United States, France, Germany, Norway, Greece, Poland, Canada, Taiwan and Hong Kong. How could protection in these countries be obtained? Could any application be filed outside the Convention year of the UK application?

(12 Marks)

(b) Indicate the extent to which European Patent Applications can claim priority from applications filed in countries which are World Trade Organisation (WTO) countries but which are not signatories to the Paris Convention. Explain your answer.

(4 Marks)

(c) Indicate the extent to which PCT Patent Applications can claim priority from applications filed in countries which are World Trade Organisation (WTO) countries but which are not signatories to the Paris Convention. Explain your answer.

(4 Marks)

Question 2

You reported to your clients in connection with EP Application X a communication under Rule 51(4) from the EPO proposing a text for grant.

- (a) Your clients write back stating that they seek to make amendments to the claims proposed for grant. You consider your clients' proposed amendments and note that independent Claim 1 is proposed to be narrowed by combining it with dependent Claim 2, and another independent claim is proposed to be broadened by deleting a feature from it. Write notes that will form the basis of a letter of advice to your clients and which also identify any important points you need to bear in mind.

(10 Marks)

- (b) Your clients also tell you that the claims of Application X, while covering their product, do not cover a product just launched by their German arch rival. You discover that there is basis for broader claims in the published Application that will cover the rival's product. Advise your clients how they could go about obtaining a patent which covers the rival's product.

(6 Marks)

- (c) In relation to the broader claim(s) referred to in paragraph (b) above, what would be the fastest way to get granted protection with which to stop the rival manufacturing their product in Germany? The designation fee for Germany was paid when due on Application X.

(4 Marks)

Question 3

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, what steps must be taken and the relevant time periods, and what conditions must be fulfilled before the requested action will be taken by the EPO.

(20 Marks)

Question 4

Your client has a European Application designating GB, FR, DE, NL, SE, AT, IT with a priority date of 16 July 2000 and a filing date of 4 June 2001. The priority application describes only one embodiment, whereas the European Application describes two embodiments but includes one independent claim which covers both embodiments. You receive a search report. The following documents are said to be relevant to novelty and/or inventive step.

- a. European application A which designates DE, NL, SE and AT with a priority date of 28 January 1999, a filing date of 28 January 2000 and a publication date of 28 July 2000.
- b. A paper in a science journal dated 15 August 2000 which purports to be the paper publication of a presentation made at a conference which ran from 14 to 18 July 2000.
- c. A Derwent abstract of South African Patent Application B which was filed on 16 January 1999 and published on 19 July 2000.
- d. PCT Patent Application C which designates inter alia EP for all states and has a filing date of 22 May 1999 and a publication date of 26 November 2000.
- e. A UK patent application filed on 10 December 1999 without priority claim and published on 17 June 2001.

Summarise the applicability of each citation.

(20 Marks)

Question 5

On what basis are claims fees calculated in the following Offices? There is no need to mention the amounts of the fees.

- (a) European Patent Office
- (b) United States Patent and Trademark Office
- (c) Japanese Patent Office

(12 Marks)

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

- (d) Canada
- (e) United States?

(8 Marks)

Question 6

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

- (a) For each country, indicate the form and structure of the claim set, and what points you would 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)**