

THE JOINT EXAMINATION BOARD

PAPER P5

BASIC OVERSEAS PATENT LAW AND PROCEDURE

Monday, 18th November, 2002

2.00 p.m. – 5.00 p.m.

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

1. You should attempt **five** questions.
2. All questions carry twenty marks; the marks attributed to individual parts of each question are shown. If more than five questions are answered, they will be marked in the order presented and the sixth ignore.
3. Where a question permits, reasons should be given for the conclusions reached.
4. Please note the following:
 - Start each question (but not necessarily each part of each question) on a fresh sheet of paper.
 - Enter the Paper Number, the question number and your Examination number in the appropriate boxes at the top of each sheet of paper
 - Write on one side of the paper only, within the printed margins using a **BLACK** pen.
 - **DO NOT** use coloured pens or highlighters within the answers – they will not photocopy.
 - **DO NOT** staple or join pages together in any way
 - **DO 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. ALL mobile phones and electronic aids **must be** switched off and stored away.
7. Answers MUST be legible. If the examiners cannot read a candidate's answer no marks will be awarded.
8. **NO WRITING OF ANY KIND WILL BE PERMITTED AFTER THE TIME ALLOTTED TO THIS PAPER HAS EXPIRED. At the end of the examination assemble your answer sheets in question number order and place in the WHITE envelope provided.**

This paper consists of four pages, including this page.

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- 1 For
- Australia
 - Canada
 - France
 - Germany
 - the European Patent Office

give the following information in respect of patent applications, (do not discuss divisional applications or requests for regional/national processing):

- a. What is the time limit, if any, for requesting examination? [3 marks]
 - b. Are renewal fees payable while the application is pending, if so when. [3 marks]
 - c. To what extent is the applicant required to notify the patent office of
 - i known prior art, and
 - ii the results of examination elsewhere. [6 marks]
 - d. What is the term, if any, for lodging an opposition? [3 marks]
 - e. Can the application be filed in a 'foreign' or non-official language and, if so, when must a translation into the/an official language be filed. [5 marks]
- 2 a. What is meant by 'an extension state' under the European Patent system and how is the granted patent put into effect in an extension state. Name four extension states. [6 marks]
- b. Name the four states that became members of the European Patent organisation on 1 July 2002. [4 marks]
- c. i. When can a divisional application be filed on a European patent application.
- ii. What fees are normally payable on a divisional application in the European Patent Office and when (do not discuss extensions of time, restitution, the grant procedure, and the like).
- iii. What limitations, if any, are placed on the states which can be designated and the scope of the claims in the divisional application. [10 marks]

- 3 In United States patent practice:
- a. What is an information disclosure statement (IDS), when should one be filed is a fee payable, and what is the significance of the IDS.
[7 marks]
 - b. What is:
 - i a continuation application,
 - ii a continuation-in-part application.[4 marks]
 - c. How does a provisional patent application differ from a non-provisional patent application (the latter being a utility or 'normal' patent application) and what steps can be taken, and when, if a non-provisional patent application is required after a provisional has been filed.
[6 marks]
 - d. In what circumstances can an applicant request non-publication of a US patent application?
[3 marks]
- 4 a. Set out the significant features of utility models in Germany, including when they can be filed, the term, and what can be claimed.
[8 marks]
- b. Name three countries, in addition to Germany, in which utility models are available, give the maximum term for the utility model, and when are renewal fees payable.
[9 marks]
 - c. Can utility models as well as patents be designated in a PCT application? Explain your answer.
[3 marks]

- 5 a. A client has a PCT application designating the European Patent Office that has been filed in Japanese at the Japanese Patent Office. The International Preliminary Examination was carried out by the Japanese Patent Office. What steps must be taken, and by when, to enter regional processing of this application at the European Patent Office. Do not discuss extensions, restitution, and the like.
- [8 marks]
- b. For what subject matter will the European patent office not act as the International Search Authority or International Preliminary Examination Authority, for PCT applications filed by US applicants at the USPTO?
- [4 marks]
- c. What is the rationalised International Preliminary Examination procedure at the European Patent Office?
- [4 marks]
- d. Is it possible for the public to get copies of correspondence between an applicant and the International Preliminary Examination Authority of a PCT application? If so when and how?
- [4 marks]
- 6 a. What constitutes patentable subject matter under United States Patent Law and the European Patent Convention? Highlight any differences (do not set out or discuss the definitions of what constitutes prior art in the jurisdictions).
- [14 marks]
- b. Explain the fee structure (do not give the actual fees) for claims in the United States and under the European Patent Convention.
- [6 marks]