

THE JOINT EXAMINATION BOARD

PAPER P5

Basic Overseas Patent Law and Procedure

Monday 7 November 2005

2.00 p.m. – 5.00 p.m.

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

1. You should attempt **five questions**. If more than five questions are answered, the first five will be marked and the sixth ignored.
2. Each question carries 20 marks. The marks attributable to individual parts of each question are shown.
3. Please note the following:
 - a. Start each question (but not necessarily each part of each question) on a fresh sheet of paper;
 - b. Enter the Paper Number (P5), the question number and your Examination number in the appropriate boxes at the top of each sheet of paper;
 - c. The scripts are photocopied for marking purposes. Please write with a **dark inked pen** on one side of the paper only and within the printed margins, and do not use highlighters in your answer;
 - d. Do not staple or join pages together in any way;
 - e. Do not state your name anywhere in the answers;
 - f. Write clearly, examiners cannot award marks to scripts that cannot be read;
 - g. Reasoning should always be given where appropriate.
4. Under the Examination Regulations **you may be disqualified from the examination and have other disciplinary measures taken against you if:**
 - a. you are found with unauthorised printed matter or other unauthorised material in the examination room;
 - b. your mobile phone is found to be switched on;
 - c. you copy the work of another candidate, use an electronic aid, or communicate with another candidate or with anyone outside the examination;
 - d. you continue to write after being told to stop writing by the invigilator(s). **NO WRITING OF ANY KIND IS PERMITTED AFTER THE TIME ALLOTTED TO THIS PAPER HAS EXPIRED.**
5. **At the end of the examination assemble your answer sheets in question number order and put them in the WHITE envelope provided.** Any answer script taken out of the examination room will not be marked.

This paper consists of five pages, including this page.

Question 1:

Write notes on patentability under the EPC of five of the following:

- a) A method of using life assurance to fund a pension scheme.
- b) A computer program to control traffic lights for improved traffic flow.
- c) A device for electrifying door handles to prevent burglaries.
- d) A process for modifying the germ line genetic identity of a human being.
- e) A partial gene sequence whose function is unknown.
- f) A genetically modified plant, not confined to a specific plant variety.
- g) A method of operating an internet auction involving more efficient data storage and communication.
- h) A process for genetically modifying a mouse so as to be suitable for testing cosmetics, the method involving a painful operation on the animal.

[20]

Question 2:

A. Your client wishes to attack an Australian patent application. The application is currently pending. Describe the options before and after grant and their pros and cons and the relevant procedures

[8]

B. Describe the actions needed, fees to be paid (not amounts) and deadlines for PCT national phase entry in Japan of a PCT application filed in English at the UK patent office.

[8]

C. Write notes on obtaining patent protection in China.

[4]

Question 3:

A. A US inventor files a US provisional application. Subsequently she moves to the UK and works here with British and German researchers to develop the idea. The British and German researchers contribute further to the inventive idea but the US inventor does not. All three researchers contact you explaining that they want to get patent protection in the UK, USA and Germany. The deadline for claiming priority from the US provisional is tomorrow.

What filing options do you have? Where would you file and why?

[6]

B. What is the latest date for withdrawal of i) a European patent application and ii) a PCT application to ensure non-publication? Is any refund of fees available? Can publication of a US patent application be prevented, and if so under what circumstances?

[4]

C. The protection conferred by a granted European patent in EPC Member States is governed by the Protocol to Article 69. Summarise the main points of this protocol.

[6]

D. Briefly describe the Court system for assessing the validity and infringement of patents in Germany.

[4]

Question 4:

Write notes on the following in relation to US patent law and practice:

- a) Filing and maintenance fees
- b) Re-examination
- c) Reissue
- d) Interference

[20]

Question 5:

A. Your client has filed a European patent application. When the application was initially searched a non-unity objection was raised. The Applicant disagreed but did not contest the opinion or pay any additional search fees.

- i) Could the applicant have contested the opinion of the search division?
- ii) What are the consequences of not paying any additional fees?
- iii) Is the non-unity finding reviewed at the examination stage?
- iv) Can the applicant contest the non-unity opinion at the examination stage, and if so, how?
- v) If the non-unity opinion is confirmed, what are the consequences for the further prosecution of the application?
- vi) How can the Applicant appeal the examiner's view as to non-unity?

[8]

B. In respect of divisional applications from European patent applications:

- i) How soon can a European divisional application be filed?
- ii) When is the last day a divisional can be filed? Can a divisional be filed during Appeal proceedings following refusal of an Application by an Examining Division?
- iii) Can a divisional be filed during Opposition proceedings?
- iv) Where can a divisional be filed?
- v) What are the added subject matter conditions relating to filing a divisional application? If these are contravened, can the divisional be saved? How?
- vi) Can a second divisional be filed from a first divisional?
- vii) When are the filing, search, claims and designation fees payable on a divisional application? When is the examination fee payable on a divisional application?
- viii) In the case when a divisional is filed more than two years after the parent is filed, by when must the 'back' renewal fees be paid on the divisional application? There is provision for a 6 months late payment period for late payment of the renewal fees due on filing the divisional; from when does this run?

[12]

Question 6:

For the following countries:

France
Germany
Ireland
Italy
Sweden
Netherlands
Canada

- a) Is utility model protection available, and, if so, what is its maximum term?
- b) Which have a grace period for standard patents, and of what duration?
- c) Which cannot be obtained as national patents via the PCT route?
- d) Which lack full substantive examination?
- e) In which is opposition available, and within what period must the opposition be filed?

[20]