

THE JOINT EXAMINATION BOARD

PAPER P5

Basic Overseas Patent Law and Procedure

Monday 5th November 2007

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 state your name anywhere in the answers;
 - e. Write clearly, examiners cannot award marks to scripts that cannot be read;
 - f. 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.**
 - e. **At the end of the examination assemble your answer sheets in question number order and put them in the WHITE envelope provided.** Do not staple or join your answer sheets together in any way. Any answer script taken out of the examination room will not be marked.

This paper consists of five pages, including this page.

Question 1:

A (i) Which of the following countries are not European Patent Convention (EPC) contracting states?

Norway, Sweden, Switzerland, Iceland, Turkey, Croatia, Romania, Slovakia, Albania.

A (ii) Outline the European Patent Office (EPO) rules relating to:

- a) Notification by post
- b) Late receipt of documents sent by post/courier
- c) Extensions of time limits when national or EPO filing offices are closed

[10]

B. Your client has filed a European patent application, in English, with no priority claim and designating all EPC Contracting States. What is the status as prior art of the following?

Assume in each case that the filing date of the prior art document predates that of your client's application but publication took place after your client's filing date.

- i) a pending European patent application, in French, which has only recently been published under Article 93 (Publication of a European patent application)
- ii) a European patent application, published twelve months ago under Article 93, presently under examination, and designating only the UK and Germany
- iii) a European patent granted with designations of all contracting states but the procedure for putting the European patent into effect in the designated states was completed only for the UK, Germany and France
- iv) a German national patent application
- v) a PCT application, in Chinese, which has only recently published, designating the EPO in respect of all EPC Contracting States
- vi) a published US patent application
- vii) an Australian application containing a reference to what was regarded as common general knowledge at the filing date of the Australian application

[10]

Question 2:

- A.** Excluding the UK, name three contracting states of the European Patent Convention (EPC) whose patent law requires substantive examination of a national patent application and three which do not require substantive examination [3]
- B.** Excluding the UK, name three EPC contracting states whose national law provides for opposition to a national patent or application and three which do not [3]
- C.** Excluding the UK, name an EPC contracting state whose national patent law does not provide the option of utility model protection [1]
- D.** Write brief notes on the procedure for prosecuting a national patent application through to grant in France and Germany [6]
- E.** Write notes on the rights provided to a proprietor in respect of the infringement of his European patent application prior to grant (EPC Article 67) [7]

Question 3:

Write notes on the procedural aspects of applying for and prosecuting a US patent application (there is no need to discuss the changes in practice which came into force on 1 November 2007).

Consider, in particular:

- i. The difference between provisional and non-provisional applications
- ii. Whether and when fees are payable for claims, search, examination, extensions of time and renewal (amounts are not required)
- iii. Documents and signatures required to complete the filing of an application
- iv. Publication
- v. Responding to Office Actions, including non-final and final rejections and restriction requirements (do not consider substantive matters such as dealing with prior art references, interference, and the like);
- vi. Continuation practice, divisionals and (briefly) appeal
- vii. Allowance

[16]

What do you understand by the phrase “teaching, suggestion, or motivation”?

[4]

Question 4:

A. Write notes on the requirements relating to filing divisional applications under the EPC. Consider in particular:

- i. When a divisional application can be filed, where it can be filed, who can be the applicant and what states can be designated
- ii. What fees must be paid and when (amounts are not required)
- iii. Restrictions on the content of the description or claims of the divisional application

[10]

B. Explain the meaning of the following terms under the European Patent Convention:

- a) Further processing
- b) Restitutio in integrum

For each, give an example of a situation in which the procedure could be used.

[10]**Question 5:**

Your client has filed an application under the Patent Cooperation Treaty (a PCT application) for a new widget.

A. In response to the following, what actions should be taken, where, and by what time? What is the result of not taking those actions?

- a) an invitation to correct the application by adding a missing applicant's name
- b) an invitation to correct formal defects in the drawings
- c) a notification concerning the submission of priority documents listing the priority claims and documents, and showing one priority document as not received
- d) you realise approximately 2 months after PCT application's filing date that you accidentally omitted one priority claim from the application form
- e) a letter from an applicant company advising you that it has changed its name

[10]

Question 5 continues overleaf

Question 5 continued

B. You receive an International Search Report and Written Opinion from the European Patent Office (EPO) and respond to the EPO with patentability arguments, but without paying the Demand fee. What happens?

C. Whilst the PCT application is still in its international phase your client informs you that he has become aware of an infringer based in Germany. He would like to sue for infringement in Germany as soon as possible. What do you advise? What if the national phase deadline had passed and the EP regional phase had been entered?

D. Your client sees that the infringer has a PCT application which was filed at the EPO as receiving office and is close to the end of its international phase. He would like to find out more about the EPO's view on the patentability of the claims. What do you advise?

E. Some time after the deadline for EP regional phase entry your client rings up very concerned that he received a letter last week from the EPO stating that the application is deemed withdrawn. He wanted to enter the EP regional phase. You investigate and find that the deadline for EP national phase entry was missed. What can be done?

[10]**Question 6:**

Write notes on the patentability of the inventions below in each of the following jurisdictions:

- a) European Patent Convention
 - b) United States of America
 - c) Japan
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- i) a method of using a laser beam for eye surgery, laser apparatus for performing the surgery, and software for enhancing an image of the eye to facilitate the surgery
 - ii) a method of funding derivatives trading using an insurance scheme, which could be implemented using a computer system
 - iii) use, for tumour suppression, of a known substance found in a tropical plant, the plant having been previously used as a traditional medicine for treatment of headaches in an isolated region of Indonesia.

[20]