

THE JOINT EXAMINATION BOARD

PAPER P5

BASIC OVERSEAS PATENT LAW AND PROCEDURE

Monday 10th November 2008

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 a total of 20 marks.
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:**
 - g. you are found with unauthorised printed matter or other unauthorised material in the examination room;
 - h. your mobile phone is found to be switched on;
 - i. you copy the work of another candidate, use an electronic aid, or communicate with another candidate or with anyone outside the examination;
 - j. 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.** 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 six pages, including this page.

Question 1:

With regard to EPC2000:

A. What are the requirements for establishing a filing date?

[2]

B (i). Under what general circumstances is further processing available? What is the deadline for requesting further processing? Must further processing be explicitly requested? In the case of requesting further processing following failure to pay a relevant fee, what is the additional charge when paying the fee?

[4]

B(ii). For which of the following is further processing available?

- a) Failure to pay filing fee
- b) Failure to pay designation fees at national phase entry from a PCT application
- c) Failure to file a priority document in time
- d) Failure to request examination
- e) Failure to file an appeal in time
- f) Failure to pay search fee
- g) Failure to request re-establishment of rights
- h) Failure to file an application within the priority period
- i) Failure to file designation of inventorship
- j) Failure to pay additional search fees where non-unity

[5]

C. Who can request central limitation of a granted European Patent? What is the time limit? Are there any prohibitions on when central limitation can be requested? Must reasons be given when requesting central limitation? To what extent is the request examined? Can third persons intervene? From when does the limitation take effect? Can features from the description be incorporated into an amended claim? Can new claims be added? Can central revocation be requested?

[6]

D. Briefly, what are privileged documents? Under EPC2000, between which parties are communications legally privileged? To what classes of documents does this privilege apply?

[3]

Question 2.

A. You receive urgent instructions from a Japanese associate to file a new European Patent application. What would you do in the following circumstances in order to secure the filing date and priority claim (do not discuss the need to file ancillary documents such as the designation of inventor and formal drawings):

i. The instructions are received on the last day of the 12 month priority period. They mention the filing number, date and applicant of the earlier Japanese application, but no more.

[2]

ii. The instructions are received on the last day of the 12 month priority period. They mention the filing number, date and applicant of the earlier Japanese application, and a set of replacement claims, in Japanese, is also attached.

[2]

iii. The instructions are received one month after expiry of the 12 month priority period, having been sent in good time before the deadline, due to a problem with the courier service.

[2]

iv. The instructions are received together with an English translation of the application, which you properly file shortly before the end of the priority period. However after filing you receive a communication from the EPO stating that one of the drawings is missing, although you can see that it is present in the Japanese priority document.

[3]

B. Instructions are received from Japan to file a PCT application at the EPO as receiving office, together with all the necessary information and an English translation of the specification. However the instructions are received one month after expiry of the 12 month priority period, due to a problem with the courier service. What would you do?

[4]

C. Under what circumstances will the EPO request a translation of a Japanese priority document?

[1]

D. Explain the provisions of the London Agreement on translations.

[6]

Question 3.

- A. Write notes for a client on the following aspects of US law and practice:
- i. The interpretation of “means plus function” and “step plus function” language in a claim [3]
 - ii. The Declaration (of inventorship) and Power of Attorney needs to be signed. One of the inventors has left the client’s company; they are not sure where she has gone. [3]
 - iii. You have received a First Action setting a 3 month period for reply. The client wishes to delay responding [2]
 - iv. Your application includes independent claims to a device and to a method of making the device. The USPTO has issued a restriction requirement. [2]
 - v. What are the three main options following a final office action rejecting all the pending claims? [3]
 - vi. You have just received a Final Office action with some claim rejections. The client has some minor amendments to the claims and would like to ensure that they are considered. What would you do? [2]
- B. What would you do in the following circumstances:
- i. You have received an office action with some narrower independent claims allowed and some broader independent claims rejected. The client would like to obtain a granted US patent quickly, but also wishes to pursue the broad claims. [2]
 - ii. The client’s US application has not yet been examined. The client has a granted UK patent corresponding to the US application and has asked about the Patent Prosecution Highway. Briefly explain this to the client. [3]

Question 4.

A. A PCT application for a mechanical device is filed by US attorneys for a US-based inventor. What (if any) options are there for choosing:

- i. the international searching authority (ISA) [1]
- ii. the international preliminary examining authority (IPEA), for international examination including filing amended claims and supporting arguments in response to the Written Opinion of the ISA [2]
- iii. on entry into European Regional Phase of the application, explain whether a supplementary search will be conducted [3]
- iv. the claims of the PCT application relate to two different inventions under European law. Before the International Search Report (ISR) is received, the US attorneys inform you that, for the EPO, they are not interested in pursuing the first invention mentioned in the claims, but would like to pursue the second instead. What is your advice? [6]

B. Your client has a PCT application filed with a large number of claims. The national phase deadline is imminent and the client would like to reduce the fees for entering national processing in the following jurisdictions. What is your advice?

- a. EPO
- b. Japan
- c. USA
- d. China

[4]

C. When is the final date for filing a divisional application in the following jurisdictions (assume no appeal procedure has been entered into):

- a. EPO
- b. Japan
- c. USA
- d. China

[4]

Question 5.

Your client has a UK priority application and is filing applications in the following jurisdictions:

Japan
China
South Korea
Australia
Europe (EPO)
Canada
USA

- a) In which (if any) is utility model protection available?
- b) In which (if any) is there a grace period for a prior disclosure by the inventor (ignore disclosures in breach of confidence or at a designated international exhibition)? Give the period where applicable.
- c) In which (if any) is a translation into the local language needed, and by when?
- d) In which (if any) are renewal fees due whilst the application is pending?
- e) In which (if any) is there provision for opposition?
- f) In which (if any) can grant be based upon or examination accelerated based upon the examination or grant of the UK application?

[20]

Question 6.

A.

- i. Briefly discuss inventive step in Australia, contrasted with the EPO
- ii. Explain the pros and cons of ordinary and modified examination in Australia
- iii. Does Australian law permit third party observations? Give brief details.

[10]

B.

What routes are available for seeking patent protection in Hong Kong? What are the procedures? Which would you recommend, and why?

[6]

C.

Write brief notes on obtaining patent protection in **one** of either Singapore or Taiwan.

[4]