

## THE JOINT EXAMINATION BOARD

## PAPER P5

## Basic Overseas Patent Law and Procedure

Monday 8 November 2010

2.00 p.m. – 5.00 p.m.

*Please read the following instructions carefully. Time Allowed – 3 HOURS*

1. You should attempt **five questions**.
2. *Each question carries 20 marks.* If more than the required number of questions are answered the first five will be marked and the sixth will be ignored.
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.**
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 **5** pages including this page.

**Question 1**

- A.**
- a) What is the deadline for requesting examination of a European patent application (an application)?
  - b) You receive an examination report from the EPO dated 21 October 2010 and giving a four month term to respond. By when is a response due (ignore weekends and official holidays)? If this period is extended by 2 months, what is the extended deadline? Give brief reasons.
  - c) If the extended deadline is missed, what acts must be completed by what deadline(s) for further processing of the EP application?
  - d) When responding to an examination report how can the possibility of refusal of the application without a further opportunity to comment be avoided?
  - e) For an EP application in English, how can provisional protection in France and Germany be obtained?
  - f) For an EP application in English, once the patent is granted, taking into account the London Agreement what translations are required for the following countries: France, Germany, Netherlands, Italy?

**[10]**

- B.** Answer the following questions with regard to national patent procedure in a) France and b) Germany. (Do not consider protection via the EPO route).
- a) Briefly outline the search/examination procedure, including deadlines
  - b) Is it possible to file a national application via the PCT?
  - c) Are renewal fees due on a pending application?
  - d) Is utility model protection available?
  - e) Is there an opposition procedure? If so give the deadline.

**[10]****Question 2**

**A.** You receive instructions from a US associate to file an EP regional phase application from a PCT application. You see that the application has 60 claims including three independent method claims and four independent device claims.

On the basis that the International Searching Authority was (i) the USPTO and (ii) the EPO, in each case answer a) and b) below:

- a) Write notes on the procedure for amending the claims at or just after regional phase entry, and its impact on the claims fees due.
- b) The US attorney says he would like to continue with the second independent method claim in the regional phase. Under what circumstances will there be an opportunity to do this?

**[10]**



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**B.** What is the deadline for filing a European (EPO) divisional application on which an examination report (Article 94(3) communication) has yet to issue? (Do not consider any transitional provisions)

Who can file a divisional application?

When will a divisional application not be entitled to the priority date of the parent case?

[7]

**C.** A Hong Kong patent application can be based on an EP application by filing a request to register publication of the EP application and, when the EP is granted, a request to grant to HK application.

What is the deadline for filing the request to register publication and the request to grant? For a PCT-derived EP application does this run from the PCT publication date or from the EP publication date?

[3]

### Question 3

**A.** Your client has invented a device and is interested in seeking patent protection at the European Patent Office and in the USA. For each of the situations below explain what is the impact of the disclosure on each application, giving reasons.

a) The client built the device and took an order for it at a trade fair in Taiwan last week. The device was exhibited but without disclosing any technical details of the device (these were not apparent from seeing the device). The client has not yet delivered the device.

b) The client exhibited a prototype of the device at a local trade fair in Germany last week but was not taking orders for the device. He explained verbally how it worked to a purchaser but did not provide any documentation. He has not yet delivered the device.

c) The client built the device and provided it 18 months ago, non-confidentially, to a French laboratory for evaluation.

d) The client provided documentation for the device to a potential business partner two months ago under a non-disclosure agreement. However the potential business partner afterwards made technical details of the device publicly available.

e) The client wrote a paper describing the device and submitted this to a journal for publication last month. The journal has a confidential peer review process but in the meantime an online printout of the paper has been published on a document server in Australia.

[10]

**B.** Write notes on preparing a set of claims for US prosecution.

[10]

**Question 4**

You filed a UK patent application on 1 July 2009 and a year later a PCT and a Taiwan application.

- A.**
- a) Can the Taiwanese application validly claim priority from the UK application? Give reasons.
  - b) The UK priority document discloses and claims invention A. The PCT application discloses and claims inventions A, B and A+B. What are the priority dates of A, B, A+B?
  - c) For a European Patent Application, would your answer be different if the UK priority document had no claims at all but had equivalent statements of invention in the description? Give reasons.
  - d) Would your answer to iii) above be different if the UK priority document lacked claims and statements of invention, and only disclosed a preferred embodiment of A? Give reasons.
  - e) What are the conditions on the applicant for a patent application to be entitled to its priority date?
- [10]**
- B.**
- a) Explain briefly the how priority dates are assigned to the subject matter of a US continuation-in-part application.
  - b) You receive instructions from a US attorney to file an EP regional phase application from a PCT application. On inspection you see that the PCT application claims priority from an identical US continuation-in-part application filed less than a year earlier and disclosing and claiming inventions A and B. The original US application was filed three years ago and disclosed and claimed invention A and had been published when the CIP was filed. The original US application is cited in the International Search Report. What is your advice so far as the EP is concerned? Give reasons.
- [7]**
- C.** Briefly explain what is "novelty only" prior art under Art 54(3)EPC. Why might it be important to check the priority date of a document which is prior art under Art 54(3)EPC? What conditions must be met for a PCT originating EP to have a prior art effect under Art 54(3)EPC?
- [3]**

**Question 5**

**A.** The national/regional phase entry deadline of a PCT application is approaching. The client would like wide geographical protection, in particular covering:

Europe, USA, Canada, Australia, Israel, India, China, Japan, Singapore, S. Korea, S. Africa

- a) (Excluding extensions of time) Which of these countries have a 30 month deadline for entering the national phase, and which a 31 month deadline? Are they the same under Chapter I and II, should we specify Chapter II?
  - b) For which of these countries is a translation required? For which is a translation required at national/regional phase entry (assume the PCT application is in English)?
  - c) Which of these countries have IDS (information disclosure statement) or equivalent requirements?
  - d) Which of these are effectively "registration" countries (that is where there is effectively no substantive examination)?
  - e) Which of these countries have provisions allowing grant as a mere registration process based on a granted patent in another jurisdiction? (Ignore the "Patent Prosecution Highway")
- [12]**



B. For i) Japan, ii) Australia iii) China

- a) What is the deadline for filing a divisional application?
- b) Is there an opposition procedure, and if so what is the deadline for filing an opposition?

[8]

### Question 6

You have filed a PCT application, in English, for your UK-based client.

A.

a) The International Search Report and PCT publication has issued. What are Article 19 amendments? What is the deadline for filing Art 19 Amendments? Where are they filed? Is there a fee? What action does WIPO take when they are filed?

b) What is the deadline for requesting International Preliminary Examination? Outline the IPE procedure. Who is the examining authority? Give one reason for and two reasons against filing a Demand for IPE.

c) With which authority (Receiving Office, International Search Authority, International Preliminary Examination Authority, Substantive Examination Authority) can/must the following documents to be filed?

- a) a request to correct the name of an applicant (or do you mean 'change the applicant, or both....)
- b) an invitation to provide a missing abstract
- c) a request to add an inventor
- d) a certified copy of a priority document
- e) a response to a Written Opinion of the EPO
- f) a change of agent
- g) a request to withdraw the application
- h) a request to make a correction to the specification

[14]

B. Your client has asked you to amend the claims on EP regional phase entry and has requested the following amendments. Are they allowable? Give reasons.

- a) Narrowing of an independent claim by adding a feature from one of a list of patent specifications referred to as "incorporated by reference"
- b) Adding a disclaimer to a compound shown in the prior art but not described in the specification, to avoid "accidental anticipation" of a claim
- c) Amending the specification to describe features in a prior art document where these features were not previously described in the application

Later in the procedure the following additional situations arise. Give your advice.

- d) The Examining Division suggests a limitation to an independent claim. You see that the amendment has no basis in the specification as filed but the Examining Division tell you that if you make the amendment the patent will be granted
- e) After grant you wish to change a claim to a device to a claim to a method of using the device.

[6]