

THE JOINT EXAMINATION BOARD

PAPER P5 – Basic Overseas Patent Law and Procedure

Friday 11th October 2013

10.00am – 1.00pm

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

1. You should attempt **five** questions. There are six questions altogether.
2. Each question carries 20 marks. If more than the required number of questions is answered only 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;
 - g. You must number all the pages of your answer script. Once the exam finishes, an **additional** 5 minutes will be allowed for you to do this.
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, number all the pages 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 6 pages including this one.

Question 1

[20 marks]

Part A

[16 marks]

On 2 January 2012 your client filed a UK patent application. On 2 January 2013 an International application was filed claiming priority from the UK patent application. The client intends to enter the national/regional phase in a large number of territories.

You have now received an International Search Report bearing a mailing date of 20 September 2013. The Written Opinion accompanying the search report objects that the claims lack novelty.

Prepare a memo to explain all options available to your client following receipt of the International Search Report and Written Opinion. For each option, explain what actions need to be taken, what time limits are involved, and explain any advantages or disadvantages.

Part B

[4 marks]

You receive a Partial International Search Report relating to a second International patent application owned by your client. The Partial International Search Report was mailed on 20 September 2013 and states that the application has three separate inventions. Only the first of these has been searched.

Explain the options available to your client following receipt of the Partial International Search Report.

Question 2

[20 marks]

Your client wishes to pursue national patent applications in Norway, Poland, Australia, Brazil and India. All applications are to claim priority from a Chinese patent application filed on 3 December 2012.

For each of these territories answer the following questions;

- a) In what languages can the application be filed?
- b) If filing is allowed in a language other than the language of prosecution, what language must the application be translated into?
- c) Is a power of attorney required?
- d) Is a certified copy of the priority document required? If so, what is the time limit?
- e) Is a translation of the priority document required?

Question 3

[20 marks]

Part A

[4 marks]

An applicant filed a US patent application directed to a mousetrap on 4 June 2013. There is no priority claim.

- i) Discuss whether the claimed invention is novel if a mousetrap having all features of the claimed invention was sold by the applicant in the USA on 4 May 2012.
- ii) Discuss whether the situation would be different if the sale occurred in Taiwan rather than the USA.

Part B

[4 marks]

An applicant filed a US patent application on 1 August 2013. There is no priority claim.

A Japanese patent application [JP02] owned by a third party is published on 2 August 2013. This application [JP02] claims a priority from an earlier Chinese patent application [CN01] filed on 2 August 2012.

- i) Discuss whether the JP02 publication is prior art to the US patent application.
- ii) Discuss whether the situation changes if the third party also has a US patent application [US02] that claims priority from CN01 and was also published on 2 August 2013.

Part C

[6 marks]

Your client, who is an individual inventor, has a new idea for an ice-cream dispenser. The new ice-cream dispenser is very similar to an ice-cream dispenser described in your client's earlier unpublished US patent application filed on 3 September 2012. Despite the similarity, your client is keen to pursue a new US patent application for the new idea as well as maintaining their earlier US patent application.

Discuss the options available to your client for pursuing both US patent applications.

Part D

[6 marks]

Your client disclosed a new weedkiller composition at a publicity event in the USA on 1 April 2013. The weedkiller composition is popular and your client wants to file a new US patent application. However, one of your client's competitors disclosed an identical weedkiller at their own publicity event on 2 April 2013.

- i) Discuss whether a US patent application filed by your client today would be novel over the disclosures at the publicity events.
- ii) Discuss whether a US patent application filed by your client today would be novel if the competitor had filed its own US patent application on 2 October 2013 describing and claiming the weedkiller composition?

Question 4

[20 marks]

Part A

[12 marks]

You have received a communication under Rule 71(3) EPC indicating the text on which the Examining Division of the European Patent Office intends to grant a patent in relation to a European patent application for one of your clients. The communication was issued on 1 October 2013. The application was filed and prosecuted in English. The application was originally filed with 15 claims but was amended during examination such that there are now 21 claims in the text intended for grant.

- i) What actions need to be taken to obtain a decision to grant? State any applicable deadlines.

When reviewing the text intended for grant, you notice several errors in the text.

- ii) Write notes advising your client on the procedure for making amendments to the text after receipt of the communication under Rule 71(3) EPC.

Part B

[8 marks]

According to the EPC, any contracting state may require that a translation of a granted patent is supplied in one of that state's official languages (where it is not already in an official language of that state). The proprietor may also be required to pay a fee for publishing the translation.

- i) What time limit is given in the EPC for supplying the translation, where required?
- ii) What is the effect if the proprietor fails to supply the translation or pay a required fee?

An applicant filed and prosecuted a European patent application in English and now wishes to obtain granted patent rights in Denmark, France, Germany, Latvia, Sweden, Switzerland, Spain and Turkey.

- iii) For each identified country, state what translations need to be filed with the respective National patent office.

An Italian applicant has filed and prosecuted a European patent application in the German language. The European patent was granted last week.

- iv) Explain whether any translations need to be filed to bring the granted patent into force in the UK.

Question 5

[20 marks]

Part A

[12 marks]

You have recently reported the publication of your client's International patent application. Your client now informs you that it is interested in obtaining patent protection in China, Mexico, France, Taiwan and Hong Kong. For each identified country advise whether protection may be obtained. For each country explain your reasoning and any options available. State any applicable deadlines.

Part B

[4 marks]

An Argentinean inventor approaches you and asks to file an International application. She is the sole inventor.

- i) Is it possible for her to file an International application as sole inventor and applicant? Explain your reasoning.
- ii) Is the answer different if the inventor is a national of Saudi Arabia?

Part C

[4 marks]

There are currently two EPC extension states. Identify these two states and explain what an EPC extension state is.

What is the deadline for paying fees for the extension states on:

- a) A European patent application which is the regional phase entry of an International patent application?
- b) A European patent application that is not derived from an International patent application?

Question 6

[20 marks]

Part A

[15 marks]

- a) What is the deadline for requesting Examination of an Australian patent application?
- b) What is the acceptance term for an Australian patent application?
- c) Is it possible to request accelerated examination in Australia?
- d) If your client has a UK patent, is it possible to request modified examination of the corresponding Australian application?
- e) Write notes explaining what is meant by a Patent of addition under Australian patent law and explain the benefits compared with a standard Australian patent.
- f) Who may apply for a Patent of addition?
- g) Can you oppose a granted Australian patent?

Part B

[5 marks]

Why may an applicant for a US patent wish to qualify as a micro-entity?

Explain whether or not the following qualify as micro-entities for the purposes of US patent law:

- (a) An individual inventor who has personally filed more than a dozen US patent applications.
- (b) A successful city trader, earning over US\$500,000 per year, who wishes to file his first US patent application.
- (c) A university that is developing and patenting a device for a large multinational company.