

**2016**

**PATENT ATTORNEYS**

**EXAMINATION**

PAPER C

Foreign Patent Law

Regulation 158 (1) (c)

Duration: 3 hours (plus 10 minutes for reading)

Question 1

(8 marks total)

- (a) Your client has received a restriction requirement for its US patent application which also includes an election of species requirement. Explain to the client what this means and what the options are to reply, including time limits. **(4 marks)**
- (b) Your client later receives an Office Action marked "Final". Explain to the client what this means and the options available. Include any time limits that your client has to meet. **(4 marks)**

Question 2

Your client has a pending PCT application that was filed on 1 December 2014 claiming priority from a NZ application filed on 1 December 2013. Despite numerous reminders you did not hear until today that they want to pursue patent protection in France, UK, Germany, Hong Kong, Japan, South Korea, Canada, Australia, the USA, Taiwan, China and India. Advise your client whether or not patent protection can be validly obtained including deadlines and extensions that may be available. **(8 marks)**

Question 3

(16 marks total)

You filed a New Zealand patent application accompanied by a provisional specification on 5 June 2015 for your client. The invention relates to a method of detecting contaminants in ground water. You obtained an assignment from the sole inventor to his company and filed the NZ patent application in the name of the company.

You have just filed a PCT patent application on 5 June 2016 claiming priority from the New Zealand application. You are about to report the filing of the PCT application to your client.

- (c) Outline the general procedure your client's PCT application will follow from the filing date through to the national phase and/or regional phase entry. Include any deadlines for performing the required tasks. Advise your client of any options available to him and the advantages/disadvantages of those options. **(8 marks)**
- (d) Explain the circumstances under which a Power of Attorney may or may not be required. **(2 marks)**
- (e) Assume that 3 months after filing the PCT application, an International Search Report (ISR) and written opinion issues citing 5 prior art documents, two category A citations, one category X citation and two category Y citations against all of the claims. Report this to you client and advise what options are available and the time frames. **(4 marks)**
- (f) Would your advice be different if the ISR issued 11 months after filing the PCT application? **(2 marks)**

#### Question 4

Your client's PCT application has just entered national phase in the USA and Canada.

Explain to her the main events that will occur during prosecution of each application up until grant, and any obligations she has during this period. Include any deadlines for examination requests, responses to office actions and extensions available. **(12 marks)**

#### Question 5

(8 marks total)

- (a) Recently both the High Court in Australia and the Supreme Court in the USA handed down decisions against Myriad Genetics Inc for their BRCA patents on the grounds of subject matter ineligibility. Explain the different reasoning each Court developed in reaching their Decisions. **(4 marks)**
- (b) How have each of the Australian and US Patent Offices interpreted the Court Decisions and implemented such interpretation into patent Office guidelines for examiners. **(4 marks)**

#### Question 6

IP Australia has issued a Direction to Request Examination for your client's Australian standard patent application. Assuming your client wants to proceed with the application, advise your client on the options to respond, what these involve and what deadlines apply. Also explain any advantages or disadvantages of each option. Can examination be accelerated and if so what is involved? **(8 marks)**

#### Question 7

Your client has a pending PCT application that was filed on 3<sup>rd</sup> March 2016 claiming priority from a New Zealand provisional application filed on 3 March 2015. The invention is for a new type of solar panel that is proving very popular. The solar panel is being manufactured in China and Taiwan. Your client is in negotiations with potential licensees in the USA and Australia. Your client would like to secure granted patents as soon as possible in Australia, Canada, Japan, the USA, China, Taiwan, Hong Kong, Republic of Korea, India, Brazil, Singapore, and the EPO, but is experiencing cash flow problems so needs to spread the patent costs out as much as possible. Advise your client of the options available and the advantages/disadvantages of each. **(12 marks)**

Question 8

(18 marks total)

You filed a divisional application in Australia for your client Supabio Inc on 25<sup>th</sup> October 2015 and antedated it to the filing and priority dates of the parent application (17 February 2010 and 17 February 2009, respectively).

- (a) The divisional application has now been examined and a "PX" category document raised, WO2009/080972 in the name of ACME Biosciences AG (D1). D1 was published on 1 September 2009 and has a priority date of 23 February 2008. The relevant information in D1 was sourced from your client Supabio Inc and was published in D1 without their consent.

What arguments can you put forward when responding to the examination report to overcome the objection? Support your answer with any relevant sections of the Australian Patents Act, Regulations and/or case law. **(6 marks)**

- (b) The divisional application has now been accepted. Acceptance was published on 1 May 2016. You have today received a Notice of Opposition filed by ACME Bioscience AG opposing the grant of your client's divisional application. Supabio Inc have asked for your advice regarding the best strategy to maintain broad claims pending while the opposition proceedings are on-going. Advise your client. **(2 marks)**
- (c) Outline the opposition proceeding to your client including time frames and extensions available. **(6 marks)**
- (d) Supabio Inc has come to you for advice on another Australian patent AU2010123456 for an isolated DNA sequence filed by a major competitor of theirs, Bigbio Ltd. Acceptance of this patent was published on 1 December 2012 and it was granted on 12 March 2013.

Your client informs you that they have been carrying out for the past three years a commercial process for isolating DNA that is described in AU2010123456 but is not claimed in the granted claim set. Your client has now been made aware of a pending divisional application that Bigbio Ltd filed out of AU2010123456 on 8 March 2013 with claims to the DNA isolation process. Your client wants to know what they can do to invalidate the divisional claims.

Advise your client. **(4 marks)**

Question 9

Explain the features of the Australian innovation patent system, its benefits, limitations and processes involved in obtaining an enforceable Australian innovation patent, including the differences between an innovation patent and a standard Australian patent. **(10 marks)**