2015

PATENT ATTORNEYS

EXAMINATION

PAPER C

Foreign Patent Law

Regulation 158 (1) (c)

Duration: 3 hours (plus 10 minutes for reading)

Question 1

Discuss the patentability of computer implemented inventions in Europe, Australia and the USA referring to case law and statutory provisions where appropriate.

(12 marks)

Question 2 (20 marks total)

A client comes to you for advice regarding a weight loss drug he and his team have developed, named "FatBGone" by the team. The drug has huge commercial potential but the client has limited funds and can only afford to draft and file a single application.

The main markets are the USA, Europe, Canada, Australia and Japan. Your client suspects that others may have patented similar drugs but has not carried out any patent searching. Your client wants to file an application as soon as possible so that he can talk to potential investors.

(a) To satisfy potential investors, the first application must be filed in one of the main markets listed above. Advise your client of any advantages or disadvantages associated with making a first filing in each country.

(7 marks)

(b) You discover that a journal article describing "FatBGone" and its amazing properties was published a few days before you client came to see you. Advise the client how this will affect his filing options. (3 marks)

(c) An application for patent protection was filed in one of the main market countries, followed by a PCT application one year later with five types of claims, as set out below:

(i) Claims to the compound "FatBGone"
(ii) Claims to the pharmaceutical composition comprising "FatBGone"
(iii) Claims to "FatBGone" for treating obesity
(iv) Claims to the use of "FatBGone" in the manufacture of a medicament for treating obesity, and
(v) Claims to a method of treating obesity using "FatBGone".

There are 55 claims in total. Your client wants to proceed with national phase filings in each of the countries identified above in the most cost effective way possible. Advise your client of the factors to consider when framing the claim set for each jurisdiction. (For this part of the question assume that there has been no prior disclosure of the invention) (10 marks)

Question 3 (8 marks total)

You have a client who is about to move to China to start a new business there. He has developed a device that can detect contaminants in infant milk formula. The device is intended for home use. You drafted and filed a New Zealand patent application accompanied by a provisional specification in July 2014. Your client is now only interested in pursuing patent protection in China.

(a) Advise him of the documents and any other information he will need to file in China and when they are required.

(2 marks)

(b) Advise your client on the examination process he can expect in China from filing the patent application up until grant. (4 marks)

(c) Your client enquires about extending patent protection to Hong Kong. How can this be done after the Chinese application has been filed? (2 marks)

Question 4

You have filed an Australian patent application claiming priority from a patent application filed at the European Patent Office on behalf of your client. The Australian patent application has not yet been examined. Now it seems that a competitor is selling copies of your client's product in Australia. Your client is eager to get the Australian patent granted as soon as possible.

Advise your client of the options available for obtaining enforceable patent protection quickly in Australia. (4 marks)

Question 5

Your client is preparing to launch a new product throughout Asia. Unfortunately, he has recently learned that a competitor filed an application in Japan, Taiwan, Singapore and the Republic of Korea that his product is likely to infringe, if these patents were granted.

Your client does not yet know the status of these applications and whether any have been granted yet but wishes to challenge them on the basis of prior art published years before the earliest application was filed.

Advise your client on the procedures available for challenging his competitors patents/patent applications in each jurisdiction. (8 marks)

Question 6 (10 marks total)

Your client has a pending US patent application for a chemical process.

The US Patent and Trademark Office issued a final office action dated 10 March 2015. On 8 May 2015 your US associate filed a response to that office action.

The associate now advises that the examiner has rejected all the claims in an advisory action dated 25 June 2015.

You discover that your client is happy to limit the chemical process claims to specify that the process is carried out at a temperature range of 20-25 degrees C. The rejected claims are not currently limited in this way. You believe that the examiner would accept the claims if they were so amended.

(a) Describe to your client the actions that you and your US attorney should now take to put the amended claim set before the examiner. Include in your answer any deadlines for the actions (and any extensions). (4 marks)

The claims have now been accepted and the Notice of Allowance issued, however the issue fee has not been paid. You review the claims and, in addition to the temperature range limitation, the claims are restricted to a salt concentration of 1-10mg/ml. The client now advises that the process will work with a salt concentration of up to 20mg/ml. You check the specification and find that there is basis for this higher salt concentration.

Your client now wishes to protect the process with the higher salt concentration.

(b) Discuss the feasibility of protecting the process in the USA with the higher salt concentration using the existing application, referring to any relevant case law. (2 marks)

(c) Your client may decide to file a new US application for the process with the higher salt concentration. Advise what options are available and make a recommendation giving reasons. (4 marks)

Question 7 (12 marks total)

A client who filed their own PCT application has come to see you. You check the status of the PCT application and see that national phase entry has been initiated in China, Japan, the USA, Australia and the regional phase initiated before the EPO. The IPRP raised a clarity objection to claims 1-10 as not being fairly based on the description.

(a) What can you do, if anything, to amend the description to address the clarity issue in each national/regional phase application; what are the limitations; when can you do it? (8 marks)

The client is also aware of a product on the market that is similar to his invention and he is worried that the company that produces the product (company Z) may try to oppose some of his patent applications. He is particularly worried about Europe and the USA.

(b) Advise him what patent office procedures, if any, are available to challenge the patent/patent application at the EPO or in the USA and, if so, whether they are available pre-grant or post-grant. (4 marks)

Question 8 (10 marks total)

You are acting on behalf of a client who has filed an Australian patent application accompanied by a provisional specification on 13 April 2015.

(a) Explain the terms "nominated person" and "eligible person" (2 marks)

(b) Your client has asked about the examination process before IP Australia and time frames before he could expect to obtain a granted patent. Explain the process to your client, including any deadlines. (5 marks)

(c) After carrying out his own search your client now thinks that his invention may not be inventive, but he wants to obtain some form of protection for his invention if this is available. He has also found out through the grape vine that a competitor is working on a similar invention and is considering filing for patent protection in Australia. What can your client do to gain protection for his invention in Australia, and at the same time prevent his competitor from gaining protection. List any advantages and disadvantages associated with your proposed strategy. (3 marks)

Question 9 (16 marks total)

Explain the meaning of the following terms under USA patent law:

(a) File wrapper estoppel (2 marks)

(b) Derivation proceedings (2 marks)

(c) Restriction requirement (2 marks)

(d) Doctrine of equivalents (2 marks)

(e) Difference between a "rejection" and an "objection" in an Office Action (2 marks)

(f) Terminal disclaimer (2 marks)

(g) Jepson claim (2 marks)

(h) Markush-type claim (2 marks)