

MARKING GUIDE

Question 1 was a typical national phase entry and restoration question that was generally well handled.

Question 2: Most candidates identified ways in which examination could be sped up, although many were not aware of patent term extensions for patent office delays and discussed extensions of term for pharmaceuticals, which were not applicable to the situation.

Question 3: This question on European law was generally well handled but many candidates lost marks by not knowing the basics.

Question 4: This question relating to options for a first patent filing, was intended to test candidates' knowledge of factors such as the availability of provisional applications, the section 102(e) advantage in the US, the disadvantage of translation costs etc, in different jurisdictions. A second filing, such as a PCT application was contemplated. Unfortunately, many candidates focussed on the differences in protectable subject matter, which was not a relevant consideration for a first filing.

Question 5: Most candidates had some knowledge of the changes to US patent law, although few had a good understanding of proceedings that could be used to challenge a US patent or patent application before the USPTO. A few candidates misread the question and discussed changes to US law in general.

Question 6: Most candidates were very familiar with the Raising the Bar 2012 Act, although a few were confused about the inventive step provisions, suggesting that Act would soon allow non-Australian documents to be considered for the purposes of inventive step. Of course, the changes specifically related to documents that can be used to establish what is general common knowledge. Non-Australian documents have always been considered for the purposes of inventive step. Question 6(b) related to the changes in the utility provisions, which could have consequences for gene patents in particular. Unfortunately, candidates who had discussed utility in 6(a) (where it was not particularly relevant for the fact scenario) did not think of it for 6(b).

Question 7: Most candidates had a basic understanding of the small entity provisions but many were unsure about how small entity status could be affected by commercial relationships with other parties.

Question 8: Most candidates were aware of the new exemptions from infringement but many did not question whether market research would qualify as an infringing act in the first place, such that no exemption would be necessary.

Question 9: This question was generally well handled although many candidates sought a statutory exclusion to infringement to exclude (c) without considering that market research might not in itself infringe the claims in the first instance.