

EXAMINATION FOR REGISTRATION AS A PATENT ATTORNEY

SEPTEMBER 2001

SUBJECT GROUP F

Patent Systems

Time Allowed : 4 hours

Instructions to Candidates

- ◆ *Standard required to pass:* 50%
- ◆ *Reading time:* 10 minutes
- ◆ *Candidates should attempt ALL questions*
- ◆ *The maximum marks for each question are indicated at the end of the question*

1. Your U.S. Associate writes to you as follows:

"We are writing to ask for your guidance regarding a U.S. Patent application, and the possibility of filing this application directly in your country based on the following facts:

The invention was disclosed in late August, 1999 (i.e. after August 18, 1999) under a non-disclosure agreement.

The invention was disclosed to a prospective customer in the U.S in September, 1999 without the non-disclosure agreement.

The invention was released to a customer in U.S. in June, 2000 under a non-disclosure agreement.

Provisional application filed August 18, 2000.

We would be most appreciative if you could please let us know immediately if there is still the possibility that this application can be filed in your country before the filing deadline of August 18, 2001."

- (a) Advise your associate explaining the novelty provisions of the Australian Patents Act 1990 against the Associate's understanding of U.S. novelty law.

Your associate writes back:

"The inventor has developed a variation on the invention which we believe may comprise patentable subject matter, but at worst shows an alternative embodiment to that embodiment which is the subject of the August 18, 2000 provisional application. What is the best way of dealing with this variation in your country?"

- (b) Advise your associate of their options including any disadvantages of your proposals.

(15 marks)

2. Your client requests advice as to whether it is possible to file a divisional patent application directed to a feature disclosed in the drawings of his granted patent which protects an apparatus. This feature is now recognised to contribute significantly to the efficiency of the apparatus. The patent was granted on 30 August, 2001.

- (a) What points would you discuss in providing your advice?

After receiving your advice the client replies that it is the particular array of ridges on one component shown in Figures 1 and 3, for which they would like specific protection, but without the use of a second component in conjunction therewith, as is claimed in the patent. Your review shows that the patent specification does not refer in any detail to the ridges but just provides a general description of the component, its co-operation with the second component, and their combined operation within the apparatus. Your clients asks how the particular array of ridges may be protected, whether there are any disadvantages in any of the recommended course of action, and what the time frame of costs would be over the next 5 years in respect of any available action.

- (b) Reply to your client setting out fully the basis for your advice.

(10 marks)

3. You receive a letter from an European Associate which reads as follows:

"My client is the owner of Australian Patent No. 199063421 filed 3 March, 1990. Our firm forwarded a reminder letter to the client in March, 2001 in relation to the annuity due 3 March, 2001 and we received a reply that future commercialisation of the subject matter protected by Patent No. 199063421 was currently under discussion but would not be finalised until the third quarter of 2001. If discussions failed to produce a licence, then the client was not interested in maintaining the patent. The client has previously used the 6 month period of grace for payment of annuities, and was aware of its existence in Australia.

.../3.

We received advice from our client today that due to a virus corrupting their patent reminder diary system some time in July, 2001, the reminder to review the need to instruct renewal of Patent No. 199063421 prior to 3 September, 2001 was lost, and it has only just been discovered missing by the re-construction of their computer reminder records.

What steps may be taken to pay the 2001 annuity fee and to restore the patent; what will the official procedure and time frame thereof be throughout the conduct of the restoration action; what documents will be required from the client and/or us, and will such steps be likely to gain restoration of the patent.

Costs do not need to be advised as a successful potential licensee has certainly been located."

Draft a reply to the European Associate which provides the advice sought.

(15 marks)

- 4.(i) After filing of an international patent application under the PCT, explain the options available to you to correct the following errors/defects in the application.
- (a) A sheet containing one of the drawing pages has been left out by mistake;
 - (b) The number of the priority patent application has been given incorrectly;
 - (c) The priority claim has been omitted altogether;
 - (d) The filing fee was not paid;
 - (e) Examples 1-3 of the application have been transposed from an unrelated patent application and the correct examples 1-3 have been omitted.

Comment on which if any of the above may be triggered by issuance of an invitation to correct a defect and any time limits that apply.

(10 marks)

- 4.(ii) Your client company has given you authority to prepare and lodge an international patent application claiming priority from an Australian provisional patent application filed 1 October, 2000. All states are to be designated including the United States. In the United States, the inventor, John Smith is to be the Applicant and needs to execute an assignment deed transferring his rights to your client company for the purposes of the USA.

.../4.

You prepare the request form and forward it together with the assignment documents to your client for signature by the inventor and by a representative of the company.

Today you receive a phone call from your client advising that the inventor fell into dispute with the client company shortly after the lodgement of the provisional patent application, now works for your client's competitor and is refusing to sign both the request and the assignment deed.

Advise your client what steps need to be taken to effect a valid filing of the international application.

(5 marks)

5. a) Discuss what is meant by a "continuing prosecution" application in the context of US patent law. Include in your answer when it is likely you would file such an application and the deadline for doing so.

(4 marks)

- b) Discuss the period for response to an exam report established by the European Patent Office and any extensions of time available. Include in your answer how these extensions, if any, can be obtained.

(4 marks)

- (c) Discuss the deadlines by which examination of a patent application filed in the Japanese Patent Office must be requested. Include in your answer a discussion of whether expedited examination is available and the basis upon which it may be requested.

(4 marks)

6. Your client has developed leading edge biotech technology at an Australian Research Institute in collaboration with an inventor at the Institute's sister organisation in Boston, USA. The Boston organisation is a start-up company which it is intended will have both research and commercialisation capacity. It is proposed that the U.S. company will be the beach head for the Australian developed technology in the USA where the particular science as a whole has received significant government assistance, and due to its commercial possibilities, is being researched by a number of competitor institutions. The patent literature, particularly that emanating from the United States, is expanding at a great rate. Your client explains however that animal trials, which are necessary to prove their technology, may take up to 18 months yet to complete and at the moment they have little spare cash. In order of priority they are keen to get protection for their invention in USA, France, Germany, Italy, Japan, Australia, Sweden and Russia.

Advise your client of their options as far as a patent filing strategy is concerned including advantages and disadvantages of each option, who should seek protection for the invention, deadlines and any possibilities for delaying the onset of costs.

(15 marks)

7. Select a second tier protection mechanism from one jurisdiction other than Australia and discuss it by comparison to the innovation patent system in Australia.

(8 marks)

8. In an opposition under the Patents Act 1990

- (a) What can the opponent do if the applicant serves evidence which contains hearsay material?
- (b) What rules govern the dismissal of an opposition under the Patents Act 1990?
- (c) What is a 'bar-to-sealing' action and when is it used?

(10 marks)