INTERNATIONAL & COMPARATIVE PATENT LAW
FINAL EXAMINATION

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Instructions:
This is a two-hour, open book exam. You may consult any written materials, yet your examination must be your own work. Consideration of the problems outside the exam room or discussion with any other persons during the exam period is not permitted.
Organize your answers before you begin to write and try to keep your answers concise and clear. Write your answers in the blue books supplied, but please use only one side of the page and observe the margins. Please write **as legibly as possible!**
Grading will be anonymous; please do not put your name on anything you turn in. Be sure your examination number is on each blue book you turn in.

PROBLEM 1 (10 Points)

The International (or Paris) Convention for the Protection of Industrial Property requests
a) all countries on earth?
b) all members of the Union?
to recognize as the priority date:
c) the conception date?
d) the due filing date?
e) the first publication date?
f) of an invention?
g) of a patent application?
The provision are
h) restricted to nationals of the countries which are members of the Union?
i) are also available for nationals of countries outside the Union which are not domiciled in the territory of one of the countries of the Union?
j) are also available for nationals who have an effective industrial establishment in the territory of one of the countries of the Union?

[answer questions a) to j) with yes or no]

PROBLEM 2: (10 Points)

Name some reasons, why the Agreement on Trade-Related Aspects of Intellectual Property Rights was signed by the Member Countries

PROBLEM 3: (10 Points)

TRIP's requests the Member Countries to provide enforcement procedures for intellectual property
a) What is to be understood by the term "enforcement procedures"?
b) Name some of the requested enforcement procedures.

PROBLEM 4: (15 Points)

Your client is a Professor at Harvard. He invented a novel promising compound for curing malaria. He wants to publish his inventions as soon as possible to attract potentially licensors in the USA and other States. He has heard about the advantages of a PCT application and suggests immediate filing of such application. He realizes that a couple of more years of further testing would be required until the product can be marketed. On the other hand he fears that his colleague, a Professor at Stanford University, has filed either the same or at least a similar compound. You explain to your client the advantages and disadvantages of several options:

1. File a national patent application in the USA soonest possible.
2. File a PCT-Application as priority application soonest possible, provisionally naming all countries, including EP.
3. File a PCT-Application within the priority year of the US-application naming provisionally all countries, including EP.
4. Request national entry of the PCT-application after PCT Chapter I national entry.
5. Request a Demand for International Preliminary Examination and request filing of the national applications after PCT Chapter II national entry.

Considering that the date of marketing a medicinal product is delayed and the effective commercial exploitation should be as long as possible; considering further that the chances of getting a valid patent should be better estimated before the major amount of money is to be spent, which option(s) would you recommend: a) 1., 2., 3., 4., and/or 5, and b) why?

PROBLEM 5: (5 Points)

Your client of Problem 4 would like to have as soon as possible a PCT-Patent for US, EP, JP and certain malaria countries.

What would you have to explain to him?

Answer: The PCT provides only for patent applications and does not grant patents (F2).

PROBLEM 6: (5 Points)

Assume the priority application of your client of Problem 4 is filed on October 10, 2000:
What would be the latest date for filing the regional European patent application if the above options

a) 1., 3., and 5. are chosen?
b) 2. and 5. are chosen?

PROBLEM 7: (5 Points)

What would be the expiration dates of the European patent

a) if option 2. and 5. is chosen?
b) if option 1., 3. and 5. is chosen?

PROBLEM 8: (15 Points)

The European Patent Office EPO

a) In which cities are branches of the EPO located
b) Which are the official languages of the EPO
c) Is it possible for a Spanish company to file an EP application in Spanish language
d) Name the departments of the EPO and with which procedures they are charged

PROBLEM 9: (15 Points)

Your client, applicant B, just before filing of a patent application for a novel medicine against allergy becomes aware that the applicant A has obtained a European Patent the claims of which cover compounds which are disclosed as anticonvulsant agents, which claims, however, comprise his novel anti-allergic product. He observes that the invention as described in this patent is so badly written that it cannot be repeated, but instead results in another product.
Which possibilities has he to secure that his anti-allergic product does not fall under the claims of applicant A's European Patent?

a) If the patent has not yet matured into national patents?
b) If the publication of the grant of the European Patent has been 10 month before he became aware of it?
c) If the patent has already matured into national patents?
d) Can applicant B still file a patent application covering somehow the different new use?
e) How would such claim under d) have to be phrased?

PROBLEM 10: (10 Points)

Are the following statements correct? **(answer with yes or no)**

1. A PCT application after substantial examination on novelty, inventive step and industrial applicability can be filed via the national route in Belgium.
2. A PCT application can only be filed by a national of a PCT member state.
3. A PCT application based on a national priority application is published 18 month after the filing date of the priority application.
4. A person being a national of a non-member State to the PCT is entitled to file a PCT application if he is domiciled in a PCT member state.
5. An EP application can only be filed at the European Patent Office in Munich.
6. An opposition to an European Patent must be lodged within 9 month after the publication of the grant.
7. A new business method as such can be granted under the EPC.
8. Agriculture inventions are recognized under the EPC as having industrial application.
9. Treatments of farm animals are recognized under EPC as having industrial applications.
10. The State of the art should not be considered if there was an evident abuse within six month preceding the filing of the European Patent application.

End of Exam