IPSI 2000

EXAM #_____

INTERNATIONAL & COMPARATIVE PATENT LAW
FINAL EXAMINATION

Professor Hans Goldrian

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 bluebook 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 bluebook you turn in and on the exam itself.

Question I, [15 points]

1. A, a resident of Paris, France, has made an invention and explains it to B. B suggests a patent application, but A is not interested.
B believes that a patent would be useful and files a European patent application desiqnating France, Belgium, and Luxemburg, and naming A as inventor.

When A notices the published applicaiton, he is not pleased. He did not authorize B to file, and in his opinion the designations are incomplete: if at all worth patenting, at least Great Britain, Italy, and the Netherlands are missing.

As A's attorney, what would you recommend to do with respect to

— the right to the patent
— the designations

Question II, [5 points]

2. If your client has demonstrated an invention in the US in a local TV report does this affect a later application in

— the United States
— Japan
— European P.O.

Question III, [5 points]

3. For filing a patent application, you will have to turn in a request for grant, identification of the applicant, and the application documents (specification, drawings, claims if required).

For filing in the EPO, a characteristic item is necessary to get an application date.

Which item is that?

Question IV, [10 points]

4. In a national invalidation suit filed against the national part of a European patent, the court has to consider Art 138 and other articles (the "European core") which act in favor of the patent.

What could be a basis for invalidation?

Question V, [10 points]

5. The first - to - file system comprises cases where an inventor other than the first to file has benefits or rights from activities before the filing date of the other party.

   Give some examples.

Question VI, [15 points]

6. Company C and company D are competitors, both doing business in the United States and Europe. Company C has developed a new product in the United States. It starts a production line in the United States on February 10, 1999 and in Germany for the European market on March 18, 1999. The first sales of the new product started March 29, 1999 in the United States and April 28, 1999 in Germany. On May 11, 2000 Company C receives a letter from Company D informing C that D had filed a patent application in the United States on March 24, 1999 and a subsequent European patent application, designating GB,FR,DE,BE,IT, and claiming United States priority, on March 24, 2000. D asserts that its patent application claims the features of C's product and the method to make it and offers a license.

Assume that D's applications meet the requirements for patentability and that their claims actually cover C's product.

C asks its patent attorney; What chances do we have to continue our business without a license, and in which countries?

Question VII, [10 points]

7. Novelty of an invention can only be destroyed by information which was public before the application date (some countries even have a grace period). There is, however an exception. Under specific circumstances, information is construed as state of the art though it was not previously known.

   Explain this exception.

Question VIII, [5 points]

8. If a country, like the United States, has a grace period, when should it be avoided to make use of it?

Question IX, [10 points]

9. Under the EPC, can an applicant residing outside the member states of the EPO assign his or her local attorney to act before the EPO? If yes, for which actions?

Question X, [15 points]

The term "patent exhaustion" refers to a legal situation where the patent can not be enforced against specified patented products.

Explain this, and define national, regional and international exhaustion.

Is the patent then worthless, or can you enforce it, and for what purpose?