EXAM # .....

INTERNATIONAL & COMPARATIVE PATENT LAW
FINAL EXAMINATION

IPSI 2003

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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 person during the exam period is not permitted.

Organize your answers before you begin to write and try to keep yours answers concise and clear.

Write your answers in the blue book 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 (5 points)

What are the main important aspects which speak in favour of using the PCT instead of the direct regional/national route?

Problem 2 (12 points)

You represent a Swiss company which asks you to file a PCT application (in English) made by three inventors in the company's name. The inventors all live in Switzerland, but one has Peruvian nationality, one is German and one has Czech nationality.

a) Where can you file the PCT application?
b) You file designating all possible PCT states. Who is applicant?
c) Where do you get the request form?
d) Who signs the request form?
e) The figures of the invention as you received them from the company contain a legend in English. What do you do?
f) The papers of the invention as you received them from the company do not contain claims. When you ask for the claims you are told that the priority document (a US provisional application) did not contain claims, and that you should proceed with filing without claims. What do you do?

Problem 3 (5 points)

In the PCT application you filed as a representative of the Swiss company as described in Problem 2, the International Search Authority sends you a letter indicating that the application covers three distinct inventions, and that you should pay two more search fees.

a) What is the consequence if you do not answer and do not pay any additional fee?
b) You believe that the Search Examiner did not apply the proper standard of unity of invention. What can you do to have the whole invention searched *and* to avoid paying additional fees?

Problem 4 (5 points)

In the PCT application you filed as a representative of the Swiss company as described in Problem 2, your client is interested in an early preliminary examination.

a) When do you file the demand for preliminary examination?
b) Where do you file the demand for preliminary examination?

Problem 5 (5 points)

What is the *basic* difference between the US and the rest of the world when deciding patentability in view of prior art?

Problem 6 (18 points)

Indicate for each of the following (independent) cases whether a patent can be obtained for an invention in the US, in Japan and in Europe (i.e. under the European Patent Convention) under the following circumstances:

a) The invention has been in use by a third party in Australia.
b) The invention was presented orally by one of the inventors at a Congress in Australia 2 months before filing.
c) An oral presentation by one of the inventors was summarized in a printed abstract published in Australia 10 days before filing.
d) Almost identical results were presented by another research group at a Congress in Australia 2 months before the invention is filed. These researchers developed the invention totally independent from the inventors filing a patent application.
e) Almost identical (but independently obtained) results were filed in a PCT application based on an Australian priority by another research group, but this PCT application (designating the US, Japan and the member states of the European Patent Convention) was only published 7 months later than the filing date of the invention in question.
f) Almost identical (but independently obtained) results were filed 13 months earlier in a German patent application by another research group, and the German application published 5 months after the filing date of the invention in question. No other (equivalent) patent applications were filed.

Problem 7 (3 points)

If your invention differs from the prior art just in the temperature range applied, the Examiner will probably reject it as obvious. What is required to demonstrate inventive step/non-obviousness?

Problem 8 (5 points)

Explain the meaning of "selection invention". Under what circumstances may a selection be a patentable invention?

Problem 9 (5 points)

Compare the exclusions for living matter and biotech inventions in the EPC and TRIPs. What does the difference mean?

Problem 10 (3 points)

You have invented a new chemical compound. It is prepared in analogy to a known process. Will you be able to get a claim for this process of manufacture?

a) In the US?
b) In Europe under the EPC?

Problem 11 (3 points)

In many countries, a method for medical treatment is not patentable. It is, however, patentable in the US. Can a claim for such a method in a US patent be enforced against a doctor using the method and thereby infringing the patent?

Problem 12 (5 points)

Explain the difference between "continued processing" and "reinstatement of rights".

Problem 13 (5 points)

Explain the principle of "National Treatment".

Problem 14 (6 points)

A European farmer buys patented seed. May he plant and use the obtained seed for

a) Sale for consumption by humans or animals?
b) Replanting the following year?
c) Sale to his neighbouring farmer for replanting the following year?

Problem 15 (5 points)

You are going to collect plants for research for a new medicament. What are you required to do under the Convention of Biological Diversity?

Problem 16 (5 points)

If a patent was not "worked" (e.g. a product manufactured and sold) in a country, this country usually issued compulsory licenses before 1995.

a) Is this still possible now under TRIPs?
b) If yes, under which Article?
c) If the patentee imports the patented product instead of manufacturing in the country, can a compulsory license still be issued?

Problem 17 (5 points)

Some countries did not issue patents for pharmaceuticals before 1995, but this is no longer possible under TRIPs.

a) When does the transitional period for pharmaceutical product protection end for developing countries (e.g. India)?
b) When does the transitional period end for least developed countries (e.g. Bangladesh)?