EXAM # .....

INTERNATIONAL & COMPARATIVE PATENT LAW
FINAL EXAMINATION

IPSI 2004

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

Problem 2 (18 points)

Indicate for each of the following (independent) circumstances whether a valid patent can be obtained for an invention in the US, in Japan and in Europe (i.e. under the European Patent Convention) [3 answers for each fact situation!]:

a) The invention has been in use by the inventors in Japan for 4 months.
b) The invention was published in a Japanese journal 4 months ago by a third party.
c) The invention has been in use by a third party (not connected with the inventors in question) in Japan for 4 months.
d) The subject matter of a patent application filed by a third party in the UK (as the priority country) and then as a PCT application 12 months later is identical with the invention. However, this PCT (and UK) application will only be published in 2 months.
e) Results that are different from the invention in question, but make this invention obvious, are filed by a third party as a US provisional application, and then refiled 12 months later as a US application and at the same time as a European application. Both the US and the European application will be published in 5 months.
f) The basic aspects of the invention were published 2 weeks ago by a former coworker of the inventors without permission from the inventors. This coworker cannot be considered an inventor, and learned from the invention in a seminar which was given in-house to participants which had the obligation to keep their knowledge confidential.

Problem 3 (3 points)

Your invention relates to new chemical compounds, however, their structure is very similar to prior art compounds. The Examiner in the European Patent Office rejects it as obvious. What is required to demonstrate inventive step/non-obviousness?

Problem 4 (5 points)

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

Problem 5 (12 points)

You represent a German company which asks you to file a PCT application (in English) made by four inventors in the company's name. Three of the inventors live in Germany (one of Japanese nationality, one of Argentine nationality, one of German nationality), one inventor is of Austrian nationality and lives in Austria.

a) Where can you file the PCT application? [list all possibilities]
b) Where can you file the PCT application if you are not intending to translate the application? [list all possibilities]
c) Who is applicant?
d) Who signs the request form?
e) Do you have a choice of International Search Authorities? If yes, which ones?
f) Is there an option to file the documents in electronic form? If yes, what is the required electronic format?

Problem 6 (5 points)

In the PCT application that you filed as a representative of the German company as described in Problem 5, 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 pay any additional fee?
b) You have good reasons to 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 finally paying additional fees?

Problem 7 (5 points)

In the PCT application you filed as a representative of the German company as described in Problem 5, your client is interested in a preliminary examination. The application has been published after 18 months (calculated from the priority date) without International Search Report. Your received the International Search Report only after 21 month.

a) Which is the International Preliminary Examination Authority for your application?
b) Can you still ask for Preliminary Examination after 21 months? If yes, until when?
c) Where do you file the demand for Preliminary Examination?

Problem 8 (5 points)

Explain the meaning of "international exhaustion".

Problem 9 (5 points)

You have invented a new plant with beneficial properties through genetic engineering, and file a patent application at the European Patent Office. You get a rejection based on Article 53(b) excluding plant varieties from patent projection. What is you argument in favor of patentability?

Problem 10 (3 points)

You have invented a new protein. It is prepared in analogy to a known process, e.g. by expressing the corresponding nucleic acid in a suitable host cell. Will you be able to get a valid claim for this (known) process of manufacture for a new protein?

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

Problem 11 (3 points)

You are a medical doctor, and you learned about a new method of treatment. You would like to use this method, but you are told that the method is patented in all the countries of the world where protection is possible for methods of treatment. Are you allowed to practice this method in

a) the USA?
b) France?
c) Russia?

Problem 12 (5 points)

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

Problem 13 (5 points)

Explain the principle of "most-favoured-nation" of TRIPs.

Problem 14 (6 points)

A Dutch plant breeder develops a new plant variety having high pest resistance. His breeding program started with seeds for highly pest resistant plants bought from a seed company. These plants (used as starting material) are protected by a European patent validated also in Holland.

a) Can the patentee stop the breeder from using the seeds in a breeding program?
b) The new plant variety still contains and expresses the gene for pest resistance being the subject of the patent. The breeder tried to get a licence from the patentee, but was denied such a license. What can the breeder do if he wants to commercialise his plant variety?
c) Can the breeder protect his plant variety by a patent (a selection patent)?

Problem 15 (5 points)

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

Problem 16 (5 points)

Before a compulsory license can be issued, all the conditions laid down in Art. 31 TRIPs have to be taken care of. What are the circumstances and necessary conditions for exporting (all) pharmaceutical products produced under a compulsory license in spite of Art. 31(f) prescribing that manufacture has to be predominantly for the domestic market?

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