INTERNATIONAL & COMPARATIVE PATENT LAW
FINAL EXAMINATION
Fall 2002
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Instructions:
This is a two-hour, multiple choice open book examination. You may consult any written material yet your examination must be your own work. Consideration of the problems outside the exam roo or discussion with any other persons during the exam period is not permitted.

You are provided with a SCORE SHEET (Scantron Sheet) by the test administrator. Please fill in your three digit exam number under "I.D. Number", flush right, and complete the sheet according t the information provided on the sheet "How to Complete a Scantron Sheet". Do not put your name anywhere on the SCORE SHEET. Grading will be anonymous by computer check.

The session of the examination consists of 35 multiple choice Problems numbered 1 to 35. Eac Problem is followed by up to five (5) statements (A), (B), (C), (D) and (E) in form of question Only one statement thereof is correct. Of the correct responses 30 are worth 3 points each, and 1 are worth 2 points each. If all the responses are correct, the maximum of 100 points is obtaine Mark the correct bubble on the Scantron answer sheet with the soft pencil supplied. Darken th correct bubbles completely. Keep your mark within the bubble. Erase completely all marks exce your correct responses.

Organize your answers before you begin to mark the bubbles..

PROBLEM 1 (3 Points)

You client heard some type of convention exists governing patent matters. You tell him that such convention exists which is called "The International Convention for the Protection of Industrial Property", also called the Paris Convention (PC), the member countries of which form a Union. In producing advice to your client which of the following statements is correct?

(A) Taiwan is a member of this Union.
(B) All members of the Union recognize a Taiwanese priority date.
(C) The recognition of a priority date is restricted to nationals of the countries which are members of the Union.
(D) The recognition of a priority date is available for nationals of countries which are not members of the Union, however which are domiciled in the territory of one of the countries of the Union.
(E) The recognition of a priority date is available for nationals who are not domiciled in and have no effective industrial establishment in the territory of one of the countries of the Union.

PROBLEM 2 (3 Points)

Select the correct answer as to whether the International (or Paris) Convention for the Protection of Industrial Property requests the grant of the following rights?

(A) All countries on earth enjoy the same priority rights as the member countries of the Union.
(B) With respect to copyrights all members of the Union shall provide the same rights to nationals

of other member countries as they provide for their nationals.
(C) By industrial property are also to be understood copyrights.
(D) Priority rights are based on the filing date.
(E) The twelve month period of priority is limited to patents.

PROBLEM 3: (3 Points)
The Agreement on Trade Related Aspects of Intellectual Property Rights was signed by the Member Countries. Which of the following statements may have been most acceptable as a reason for signing?
(A) All member countries had to establish the same patent rights.
(B) The Agreement includes and takes care also of copyrights.
(C) No country was requested to provide enforcement procedures for intellectual property.

PROBLEM 4: (3 Points)

Your client is a Professor at the MIT. He isolated and purified from a seldom plant a novel promising compound C for curing malaria. He has published his invention on September 15, 2002. A pharmaceutical company is interested to take a license in the USA. The Professor 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. Which of the following statements which you offered to him is correct?
(A) Patent protection for C is not possible because the compound is a natural product.
(B) Isolation and purification of C and establishing the anti-malaria activity are not of inventive nature.
(C) Filing a PCT application would guaranty him novelty in all PCT countries.
(D) Filing a US application will grant him a US priority right.
(E) A US priority right after the publication allows validly filing a PCT application designating all countries.

PROBLEM 5: (3 Points)

Your client of Problem 4 would like to have as soon as possible a national patent for US, EP, JP and certain malaria countries. Which of the following statements is correct?
(A) A national US patent may not be available in view of his prior publication.
(B) A PCT patent may be available for EP and JP in view of the grace periods.
© A Japanese patent may be available based on an application filed before March 15, 2003.
(D) An EP patent may be available based on a PCT application, filed immediately after the publication of C
(E) All statements are false.

PROBLEM 6: (2 Points)

An invention was not pre-published and a priority application was filed on October 27, 2001 in the USA. Which is the correct latest date for filing a regional European patent application if the PCT application designating EP was filed October 25, 2002?
(A) October 25, 2002.
(B) May 27, 2004.
(C) May 25, 2004.

(D) April 25, 2003.
(E) October 27, 2003.

PROBLEM 7: (2 Points)

Which is the correct normal expiration date of the European patent emerging from a PCT application designating EP filed on October 25, 2002, according to Problem 6?
(A) October 25, 2022.
(B) May 27, 2024.
(C) May 25, 2024.
(D) April 27, 2023.
(E) October 27, 2023.

PROBLEM 8: (2 Points)

The European Patent Office EPO has a seat and a branch. Which of the following statement is correct?
(A) The EPO has its seat in Geneva.
(B) The EPO has its seat in Berlin and Vienna
(C) The EPO has its seat in Munich and a branch at The Hague.
(D) The EPO has its seat at The Hague and a branch in Berlin
(E) The EPO has its seat in Paris and a branch at The Hague

PROBLEM 9: (2 Points)

As to languages of prosecutions of European patent applications of nationals of member countries of the EPC: Are the following languages prosecution languages accepted by the European Patent Office?
(A) Danish, if filed by a Danish national
(B) Spanish, if filed by a Spanish national
(C) German, if filed by a French national
(D) Italian, if filed by an Italian national
(E) Italian, if filed by a Swiss national

PROBLEM 10: (2 Points)

As to the filing in other than the official languages at the European Patent Office: is it correct that the following filings are accepted?
(A) A Mexican national files in the Spanish language.
(B) A Spanish company files in the French language.
(C) A Norwegian national files in the Norwegian language.
(D) A Greece company files in the Italian language.
(E) A Japanese company files in the Japanese language.

PROBLEM 11: (3 Points)

Applicant B has filed a patent application for a novel compound active against allergy. Sometime later he becomes aware that applicant A has been granted a European Patent eleven month before his filing. The claims of A's patent cover B's compound, however for use as an anticonvulsant agent. B analyzed the compound described in A's patent. B finds A's compound to be in fact another compound as described in A's patent, the structure being different from the structure of B's compound.

Are the following advices correct in securing B to sell his anti-allergic product without infringing the patent rights of A?

(A) B should file an opposition and attack the patent of A at the European Patent Office.
(B) B should write a letter to the Examiner of A's patent, declaring the patent of A is invalid for reasons of false statement and inoperability.
(C) B should submit a showing to the EPO that he has invented his compound before A.
(D) B should initiate an invalidation process before the national courts of the countries where the European patent of A was validated, and where B has commercial interests.
(E) B should file a nullity process with the European Patent Office.

PROBLEM 12: (3 Points)

Your client would like to have an answer which of the following statements is correct?

(A) A PCT application after substantial examination on novelty, inventive step and industrial applicability can be filed via the national route in Belgium.
(B) A PCT application can only be filed by a national of a PCT member state.
(C) A person being a national of a non-member state to the PCT is entitled to file a PCT application if he has a business in a PCT member state.
(D) A person being a national of a non-member state to the PCT is not entitled to file a PCT application even if he is domiciled in a PCT member state.
(E) A PCT application can only be filed at the European Patent Office in Munich, at the WIPO in Geneva, at the US, Chinese or Japanese Patent Office.

PROBLEM 13: (3 Points)

Which of the following statements is correct?

(A). An opposition to a European Patent must be lodged within 12 month after the publication of the grant.
(B) A new business method as such can be granted under the EPC.
(C) Agricultural inventions are recognized under the EPC as having industrial application.
(D) Treatments of farm animals are recognized under EPC as having industrial applications.
(E) The State of the art should be considered even if there was an evident abuse within six month preceding the filing of the European Patent application.

PROBLEM 14: (3 Points)

Inventor A has invented a new compound and B has discovered a use for this compound. For most of the countries which of the following statements is correct?

(A) There is no unity of invention because there are two inventors.
(B) The claim covering the compound must be in another patent application as the claim covering the use.
(C) It is possible to file one patent application naming A and B as co-inventors, and file two

independent claims, one covering the compound per se and the other covering the use.

(D) If one application is filed, it must be restricted during prosecution to cover only one independent claim while the other is to be claimed and further prosecuted in a divisional application.

PROBLEM 15: (3 Points)

A US inventor A has invented in the USA a first compound with antibacterial activity. He filed a US patent application on December 30, 2001, claiming the compound, a method for its preparation and a pharmaceutical formulation comprising this first compound for antibacterial use. He invented 6 month thereafter in France similar compounds with the same activity with additional antiviral activity. He immediately files on June 30, 2002, a second application in France. Which of the following statements is correct?

(A) The inventor is entitled to file a second application in France claiming the first US priority of December 30, 2002, and the second French priority of June 30, 2002.

(B) The inventor is not entitled to file a second application in France claiming both priorities.

(C) The inventor has to file a second application in the USA covering only the new compounds, the method of their preparation and the pharmaceutical formulation for antiviral use and can only claim the second priority.

(D) Multiple priorities are not allowed to be claimed if they originate in different countries.

PROBLEM 16: (3 Points)

Company A has a US patent of improvement claiming a new device for allowing aircrafts to more safely land. A Chinese aircraft comprising this device temporarily lands at Kennedy Air Port. Which of the following statements is correct considering the agreement under TRIPS?

(A) Company A can request that the device is dismantled.

(B) The Chinese aircraft is infringing the US patent of company A.

(C) The US customs can request that the Chinese aircraft has to pay a tax of importation.

(D) The USA are entitled to create a law preventing temporarily importation of patented devices by aircrafts landing at a US airport.

(E) All statements above are incorrect.

PROBLEM 17: (3 Points)

Under the Agreement on TRIPS a patent on a product shall give the patent owner specific rights and duties in most countries where patents exist. Which of the following statements is correct?

(A) The patent owner shall have the exclusive right to use the product in the country were he has a patent.

(B) The patent owner shall not have the right to license the product to a party located in a patent-free country.

(C) The patent owner shall have the right to prevent third parties from using the compound also in countries where no patent exist.

(D) The patent owner shall have the duty to file an infringement action if his patent is infringed.

(E) The patent owner shall have the right to prevent third parties from importing the product from a patent-free country.

PROBLEM 18: (3 Points)

Company A is accused for infringing the patent of company B which covers the process X for the production of compound Y. Company B argues they use a different process for the production of Y. Which of the following statements is correct if the doctrine of reversal of proof applies?

(A) Company A has not to present reasonably sufficient evidence to support its claim that company B uses the patented process. It suffices to accuse B of infringing.
(B) Company B has to present evidence that their process is different from A's process.
(C) The evidence to be presented by B must be made available without ensuring the protection of confidential information.
(D) Company B may stop the production of Y thereby keeping its process secret.

PROBLEM 19: (3 Points)

The Patent Cooperation Treaty has a number of advantages over the patent systems before said treaty. Some of the advantages are very welcome to applicants and patent attorneys. Select the correct statement:

(A) The PCT provides very well examined patents if the international preliminary examination is chosen.
(B) The PCT provides also for design patents.
(C) PCT patents are granted by the World Intellectual Property Organization (WIPO) in Geneva.
(D) A PCT application may be filed up to 12 month after the priority application.
(E) The PCT application has a 20 year term.

PROBLEM 20: (3 Points)

Your Chinese client would like to be informed about some dates of the timelines A and B available for a PCT application. Which of the following statements is correct?

(A) Under timeline A the PCT fees must be paid at the end of the priority year when the PCT application is filed.
(B) Under timeline A the application is published 18 month after the filing date of the PCT application.
(C) Under timeline B the Demand for the International Preliminary Examination must be latest filed nineteen month after the priority date.
(D) Under timeline B the entry into the national and regional phases are for all countries 30 month after the PCT filing date
(E) The PCT application can be filed in any language of any of the member countries.

PROBLEM 21: (3 Points)

The International Searching Authorities issue an International Search Report. The prior art presented therein must be carefully checked and explained to your clients. In particular you will inform them which of the following statements is correct?

(A) In the International Search Report every written disclosure made available to the public prior to the filing date of the international application anywhere in the world and which is capable of being of assistance in determining lack of novelty or inventive step will be cited.
(B) Oral disclosures, also if they were not made available to the public in written form, will be cited if they are relevant to the applicant's invention.
(C) Patent applications or patents published after the international filing date of applicant's international filing date but having a filing or priority date earlier than your clients

international filing date will not be cited.

(D) Applicant himself has to relate the cited prior art to the claims, which means he himself has to find out which citation is prior art for which claim.

(E) Applicant has to submit now any prior art he is aware of which was not yet cited.

PROBLEM 22: (3 Points)

Your clients have reviewed the International Search Report and believe a part of their invention lacks novelty. They are afraid they must now withdraw the entire application. You have not enough time for carefully checking all of the citations. With respect to this problem which statement of the followings is correct?

(A) Your clients have to withdraw the application and file a restricted version avoiding the cited prior art.

(B) A prolongation of time must be filed to provide you with sufficient time for studying the citations, whereupon an argument must be filed explaining that the prior art is not of sufficient relevance for destroying the novelty of the invention.

(C) Your clients must file an amendment restricting the claims to the novel subject matter

(D) It is not necessary at this stage of the prosecution to file an answer to the search report.

PROBLEM 23: (3 Points)

It is possible to demand an international preliminary examination of applicant's PCT application Which of the following statements is correct?

(A) The Demand for the international preliminary examination has to be filed 20 Month after the priority date.

(B) The international preliminary examination report is issued by any one of the receiving offices.

(C) This report is submitted to applicants one month after the demand was filed.

(D) A written opinion is issued by the international preliminary examination authority one month after the international preliminary examination report was issued.

(E) The international preliminary examination provides an opinion on novelty, inventive step and industrial applicability

PROBLEM 24: (3 Points)

After the written opinion was received your clients were at a loss what to do with the information. Which of the following advices is correct?

(A) The written opinion must be answered within the time limit fixed by the examiner.

(B) There is no chance of an oral interview with the examiner.

(C) Any amendment is only possible for the claims.

(D) Additional subject matter may be entered into the description

(E) It is not necessary to file a response to the written opinion at all.

PROBLEM 25: (3 Points)

Claiming of priority in a PCT application may not be possible for all applicants. There was a change of rules in this respect. Which of the following statements is correct?

(A) The respective rules are in effect since January 1, 2002

(B) The priority of an application filed in a country which is not a member of the WTO and not party to the Paris Convention can now also be claimed.

(C) The priority of an application filed in a country which is a member of the WTO and not party

to the Paris Convention can now also be claimed.

(D) The priority of an application filed in a country which is a party to the Paris Convention and not member of the WTO can not be claimed.

PROBLEM 26: (3 Points)

The world Intellectual Property Organization issues a fast number of publications which in part are free of charge. Are the following statements correct?

(A) The leaflet "Basic facts about the Patent Cooperation Treaty" is free of charge.
(B) This leaflet is also available in Korean language against a charge.
(C) The "PCT Applicant's Guide" is available from WIPO free of charge.
(D) Some publications can be inspected free of charge on the Internet http://www.wipointer.
(E) The "PCT Applicant's Guide" is not available for inspection on the Internet.

PROBLEM 28: (3 Points)

Under the European Patent Convention EPC exist several Boards of Appeal and an Enlarged Board of Appeal. Your client is not satisfied with the decision of the Examining Division refusing the European patent application on the grounds that the invention lacks an inventive step. Which of the following statements is correct?

(A) Your client can bring an appeal directly before the Enlarged Board of Appeal.
(B) The Enlarged Board of Appeal is only responsible for deciding points of law referred to it by any of the Boards of Appeal.
(C) Your client can file an appeal against the decision of the Examining Division before one of the Boards of Appeal.
(D) The Board of Appeal would have to consist in the case of appeals from the Examining Division of three technical qualified members.
(E) The Boards of Appeal are not responsible for the examination of appeals from Opposition Divisions.

PROBLEM 28: (3 Points)

A craftsman has invented a new tool for screwing into wood various types of devices with a thread. He filed a patent application on December 15, 2001, at the European Patent Office. During prosecution of this application he was confronted with practically the same invention filed by his neighbor on November 1, 2001. He claims that he has talked to this neighbor and has proudly shown him his invention hoping they might commercialize the device together. He was clever enough to have his neighbor sign a confidentiality agreement. Which of the following statement is correct?

(A) The neighbor has the earlier filing date and is entitled to the invention.
(B) The invention was at the filing date not anymore new, because the craftsman had disclosed the invention by showing it to a member of the public.
(C) The neighbor is entitled to the invention, however has to give to the craftsman a nonexclusive free license.
(D) The craftsman cannot rely on an evident abuse, because they discussed commercializing the invention together.
(E) The craftsman can claim evident abuse and is entitled to the invention.

PROBLEM 29: (3 Points)

The European search report of the patent application of the craftsman claiming the tool for screwing into wood various types of devices with a thread, cites a patent application describing and claiming a similar tool. This is not exactly the same however it is deemed to be equivalent to the tool of the craftsman. The priority of the cited patent application is August 30, 2001. Which of the following statements is correct?

(A) The patent application of August 30, 2001, after publication, is not to be considered in deciding whether the invention of the application of the craftsman with the filing date of December 15, 2001, is based on an inventive step.
(B) The craftsman has to file a showing of superiority over the tool of the citation.
(C) The citation was not published before the filing date of the craftsman. Accordingly it is not a valid reverence.
(D) The citation is also not a valid prior art reference with respect to novelty.
(E) The tool of the craftsman lacks inventive step over the prior art. It is for this reason not patentable.

PROBLEM 30: (3 Points)

An inventor having a lot of experience with quite a number of his own inventions all over the world feels strong enough for prosecuting his patent applications in the European Patent Office on is own in particular as he cannot further afford the fees of his patent attorneys. Which of the following statement is correct?

(A) The inventor can prosecute his patent application on his own if he is a national of a member country to the EPC
(B) The inventor can prosecute his patent application on his own if he is domiciled in one of the member countries.
(C) The inventor can prosecute his patent application on his own if he has a regular business in one of the member countries.
(D) The inventor has to pay an extra fee for being allowed to prosecute his patent aplications on his own.
(E) All statements above are incorrect.

PROBLEM 31: (3 Points)

A pharmaceutical company feels his business may go down if the European patent granted on August 15, 2002, to a competitor claiming a similar pharmaceutical formulation as their block buster on the market is not invalidated, nullified and revoked. Which of the following statements is correct?

(A) The European patent can only be opposed within 9 month after publication of the mention of the grant in the European Bulletin.
(B) The pharmaceutical company is the only legal person which can file the opposition in view of their special interest.
(C) The European patent cannot be opposed any more after it has been withdrawn in all countries.
(D) The opponents need not be party in the opposition procedure and can leave a decision entirely to the Board of Opposition.
(E) The opposition applies only to the country which is named by the opponent.

PROBLEM 32: (3 Points)

The pharmaceutical company files an opposition timely. The European Patent Convention requests a number of ground for which an opposition may be filed. Which of the following grounds for filing an opposition is correct?

(A) The subject matter of the claims comprises a therapeutic use for treating a farm animal.
(B) The subject matter of the claims is too broad.
(C) The inventors mentioned are not the true inventors.
(D) The patent owner has stolen the invention.
(E) The issue fee was not timely paid.

PROBLEM 33: (3 Points)

Company A newly puts on the market a device for curling hair, which they had already sold 25 years ago. They were now accused by company B for infringing their valid patent the claims of which cover a similar device for curling hairs. B argues the device of A is equivalent to their claimed device. An expert opinion comes to the same conclusion. Are the following statements correct?

(A) The expert opinion is binding and A's device is infringing under the doctrine of equivalence.
(B) A must withdraw the device from the market and pay damage to B.
(C) A would not be able to defend commercializing their device because they agree their device is indeed equivalent.
(D) There is no chance for A of wining in any court.
(E) A has a chance of wining the contest by arguing their device is prior art.

PROBLEM 34: (3 Points)

The European Patent Convention regulates the extent of protection conferred by a European patent. Which of the following statements is correct?

(A) The extent of the protection conferred by a European patent is only determined by the terms of the claims.
(B) What is not claimed is disclaimed.
(C) The description may be used for interpreting the terms of the claims.
(D) In opposition proceedings only the claims as patented shall determine the scope of protection.
(E) The drawings shall not be used to interpret the claims as there are only figures and numbers and no terms shown.

PROBLEM 35: (3 Points)

A number of inventions, in particular in the computer and the medical field, are not patentable under the European Patent Convention. Which of the following inventions would not be excluded from patentability?

(A) A new device for more exactly measuring the number of white blood cells in a blood sample of an animal comprising a computer program for fast counting of the number of said cells.

(B) A method of treating a surplus of white blood cells of a human patient which comprises measuring the number of white blood cells in the blood of said patient by means of a device attached to the vein of said patient and administering a calculated amount of a medicament based on the result of the said measurement.

(C) A computer program allowing the counting of the number of white blood cells in the blood of an animal and immediately calculating the correct amount of a medicament necessary for treatment of the said animal.

End of Exam