

**INTERNATIONAL & COMPARATIVE PATENT LAW**  
**FINAL EXAMINATION**  
IPSI 2008  
Professor Konrad Becker

**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 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 (8 points)**

Explain the meaning of

- a) national treatment
- b) most-favoured-nation treatment

Which international agreements define these principles?

**Problem 2 (12 points)**

You represent a Canadian 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 Canada, but one has Chilean nationality, one is a U.S. citizen and one has French nationality.

- a) Where can you file the PCT application without translating it? [list all possibilities]
- b) Who is applicant?
- c) Do you have a choice of International Search Authorities? [list all possibilities] Are there any limitations in choosing one?
- d) The drawings of the invention as you received them from the company contain a legend in English written into the drawing. What do you do?
- e) The papers of the application as you received them from the company do not contain claims. When you ask for claims you are told that the priority document (a US provisional application) did not contain claims, and that you should proceed the way you think is correct. What do you do?

- f) The priority year is running out very soon, and there is no time left to get the signatures of a company official and of the inventors. Who signs in the corresponding box of the request form, and what will be the consequences of the missing signatures?

### **Problem 3 (6 points)**

In the PCT application you filed as the representative of the Canadian 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* the wrong decision of the Search Examiner be corrected?

### **Problem 4 (6 points)**

In the PCT application you filed as the representative of the Canadian company as described in Problem 2, you received the International Search Report 17 months after the priority date, just in time for publication together with the application. The Written Opinion that was sent together with the Search Report indicates that the invention is not patentable. Your client is interested in having an early grant as soon as possible after you will have entered the national/regional phase, and expects you to do now whatever is needed to correct the negative patentability opinion. What are you supposed to do? [list all reasonable steps, indicate where you send which kind of documents, and whether fees are payable and to which authority]

### **Problem 5 (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 indigenous people in Bolivia.
- b) The invention was presented orally by one of the inventors at a Congress in South Africa 2 months before filing. The presentation was summarized in the abstract book of the Congress.
- c) One of the inventors published the essential parts of the invention on the internet 10 days before filing the application. When his fellow inventors got aware of this, they told him to delete the information on the internet. He deleted it, and today you cannot find it on the internet.
- d) 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) Identical (but independently obtained) results were filed in a PCT application based on an Australian priority application by another research group, but this PCT application was only published 7 months later than the filing date of the invention in question. The PCT application entered the national/regional phase in Australia, the US, the European Patent Office, China and Japan.
- f) Identical (but independently obtained) results were filed 13 months earlier in a UK patent application by another research group, and the UK application published 5 months after

the filing date of the invention in question. No other (equivalent) patent applications were filed.

**Problem 6 (3 points)**

You invented an improved manufacturing process which differs from the prior art by the temperature range applied and the time needed for complete reaction. The Examiner will probably reject it as obvious. What is required to demonstrate inventive step / non-obviousness?

**Problem 7 (6 points)**

Explain the principle of “unity of invention”. You filed a patent application covering several embodiments of a new product, describing and claiming several applications of the new product, and a method of manufacture. Will it be possible to get patent protection for all these aspects in the same patent? If yes, what requirements have to be fulfilled?

**Problem 8 (3 points)**

You invented an improved microorganism by biotechnological methods. You described the invention thoroughly, but the description in your patent application cannot be reproduced without having access to the microorganism. What do you have to do to deal with this problem?

**Problem 9 (3 points)**

You have invented a new chemical compound. You manufacture it in analogy to a known process. Will you be able to get a valid claim for this process of manufacture applied to the new compound? In the US? In Europe? In Japan?

**Problem 10 (3 points)**

You invented an improved diagnostic method to be practiced on the human body. Is it possible to patent it? In the US? In Europe? In Japan? Are you able to stop a medical doctor applying this method when it is patented?

**Problem 11 (6 points)**

Because of a car accident, and further because of an unexpected illness of your administrative assistant, you missed the end of the priority year for timely filing your European patent application by one day. Can you still validly claim the priority date? If yes, what do you have to do and by when?

**Problem 12 (6 points)**

Because you had far too much work to do you were unable to send in a reply to a rejection of the claims of a patent application within the date set by the Examiner, and three weeks have passed since that date. What can you do about it? In the US? In the European Patent Office? In a member state of the Patent Law Treaty?

**Problem 13 (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 14 (5 points)**

You got a plant specimen from a friend who brought it from Brazil when he was visiting this country last year as a tourist. You now find that this plant contains a new chemical compound potentially useful as a drug. What are you supposed to do before you continue your research and file a patent application? What is the name of the international agreement dealing with such questions?

**Problem 15 (6 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 the TRIPS Agreement? If yes, under which Article?
- b) If the patentee imports the patented product instead of manufacturing it in the country, can a compulsory license still be issued based on “non-working”? Which is the corresponding Article in TRIPS dealing with this question?

**Problem 16 (3 points)**

You developed a new and inventive computer program which substantially improves the result of a chemical manufacturing process by controlling and adapting the conditions for the steps of the process. Is this computer program patentable in the US? In Europe? In Japan?

(End)