

PAPER C - 2010 - EXAMINER'S COMMENTS

General Comments

The paper was predominantly focused on patent law and procedure in the USA, Australia and at the European Patent Office, and PCT procedure. This accounted for 80% of the marks.

The strongest candidates demonstrated a good knowledge of foreign patent practice. The unsuccessful candidates were generally able to provide good answers on some aspects - but often appeared to have insufficient familiarity with some of the subject matter covered by the examination.

Question 1

The first question was designed to test knowledge of the requirements for filing of a PCT application, where there were a few complications. Most candidates recognized that an assignment would be needed if the application was to be eligible for filing in New Zealand. Most did not consider how they would provide the Australian priority document. Almost all overlooked the need to get a foreign filing licence for the US inventor.

Question 2

The second question was mainly about the novelty in several countries and included the different effects of grace periods. Most candidates scored reasonably well on this question.

Question 3

Many candidates did poorly on question 3 because of a lack of understanding of the knowledge of the options and time available once an advisory action is issued in the US.

Question 4

This question was mainly designed to test knowledge of how conflict between co-pending applications would be handled in Europe and the US. The marks for this question ranged from 0 out of 10 to 10 out of 10. Most candidates had difficulty with this question.

The question also tested knowledge of claim formats for protecting second medical uses in Europe and the US. Many candidates appeared unfamiliar with the fact that methods of medical treatment are patentable in the US. Also they were unfamiliar with the protection of second medical uses in Europe despite recent developments in this area. Fortunately for those candidates only 2 marks were at stake.

Question 5

This question was mainly designed to test the candidate's familiarity with patent examination procedures outside of Australia, the US and Europe. It focused on Singapore. Many candidates were poorly prepared for this question.

Question 6

This question related to the possibility of entering the national phase from a PCT application after the 30 or 31 month deadline. Almost all candidates scored highly on this question.

Question 7

This question related to European procedure following acceptance of an application. Despite publicity of recent changes to the procedure, candidates were not especially well prepared for this question.

Question 8

The candidates generally were aware of the requirement to file an information disclosure statement for the US application. Fewer suggested re-examination for the US patent.

Question 9

Question 9 was designed to test knowledge of the patentability of business methods and computer related inventions in the USA, Australia and at the European Patent Office. Most candidates were able to refer to the *Bilski* case and the requirements at the European Patent Office. A few were aware of the Australian *Grant* case.

Question 10

This question was largely about Australian practice – and was reasonably well done. The portion of the question comparing obviousness in Australia with that in at the European Patent Office was more difficult for most candidates.

Question 11

Question 11 was a question on European Patent Office procedure, including the timing for filing a divisional application. This was another question relating to recently changed procedures. Candidates did reasonably well on this question.

Question 12

The final question was relatively difficult and not well done. It required candidates to recognize the relevance to the scenario of the doctrine of equivalents, filewrapper estoppel and filing of a continuation-in-part application, and other factors relevant to a possible second US application.