

LAW AND PRACTICE OF PATENTS

EXAMINATION PAPER 2022

Time Allowed: 3 Hours and 20 minutes

Answer SIX questions only. Any additional answers will be disregarded and NOT marked.

Candidates MUST answer Question Number 1 and Question Number 2.

In the event of a Candidate failing to answer Question Number 1 and Question Number 2 or in the event of a candidate failing to be awarded any marks for an answer to either Question 1 or Question 2, the examination paper of that Candidate will NOT be considered valid and the candidate will have failed the examination

1. Harvester Limited has been conducting research in the area of biofuels for the last ten years. It has discovered that particular microbes, often found in peat in Irish boglands, are capable of being genetically modified so as to be particularly useful in the breakdown of compostable household waste which can then be used in the production of biofuel. The biofuel ultimately produced has the same properties as that currently available on the market, but the rapid breakdown of biomass achieved by means of the genetically modified microbes leads to a far faster and cheaper production process.

Harvester Limited is anxious to obtain as much patent protection as possible in respect these innovations and seeks your detailed advice as to how it should proceed and such options as are available to it.

2. Explain each of the following grounds of invalidity:
 - (a) *AgrEvo* obviousness (T-939/92 *AgrEvo/Triazoles* [1996] EPOR 171);
 - (b) Insufficiency; and
 - (c) Added matter.
3. Set out the procedural steps to be followed within the European Patent Office in order to bring an appeal from a decision of the Opposition Division and outline how and by whom such an appeal is heard.
4. With reference to decided case law and relevant statutory provisions, discuss the principles governing patentability in the event of a new medicinal use being found for a known substance that is already being used in medical treatment.
5. Discuss the decision of the Irish Supreme Court in *Merck Sharp and Dohme Corporation v. Clonmel Healthcare Ltd* [2020] 2 IR 1 and consider what implications, if any, this decision has for the availability of interlocutory injunctions in actions concerning the infringement of patents and supplementary protection certificates.
6. Outline the concept of priority in the context of patent applications and set out the means by which priority is claimed.

7. Set out the requirements that have to be satisfied in order to obtain a short term patent, discuss the advantages and disadvantages of such a patent as compared with a standard patent, and identify any fields within which you believe that a short term patent would be particularly suitable or unsuitable.
8. Discuss the circumstances in which an Irish patent can be amended after grant and the means by which such an application can be brought.
9. You have been consulted by a client who has presented what she believes is a new means of fixing conventional polystyrene external insulation panels to existing buildings as part of retro-fitting directed to energy saving. Outline the resources and techniques that you would use in conducting searches to determine whether there is a basis for seeking patent protection.