

LAW AND PRACTICE OF PATENTS

EXAMINATION PAPER 2011

Time Allowed: 3 Hours

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 the examination paper of that Candidate will **NOT** be considered valid.

1. Carlo has owned and operated an Italian coffee shop and pizzeria in Clontarf, Dublin 3, since 1968. During the 1970s he devised a method of preparing pizza dough in such a way that when the pizza was baked in a conventional gas oven it nevertheless had the taste and consistency of one baked in a traditional wood-burning stone oven. As a result, Carlo's pizzas were extremely popular and this enabled his business to thrive long before the spread of pizza chains in this country. While Carlo told family members who worked in his business about his technique for preparing pizza dough, it was always on the strict understanding that it was secret and they were not to disclose it to anyone else.

Over the last three months Carlo has been negotiating a sale of his business to Maria (who has recently moved to this country from Sicily) and plans to operate from Carlo's premises, as well as opening a number of other outlets in the Dublin area under the name "*Carlo's*" which will be operated through franchisees. The sale will include Carlo's technique for preparing pizza dough, but Carlo has made it clear that he will not give Maria the information until she has handed over the purchase money. However, last week (before the sale was completed) Carlo received a letter from solicitors acting for Eskimo Pizzas Limited which informed him that their client owned a patent (granted in 2004) for a technique for preparing pizza dough which, Carlo acknowledges, is virtually identical to the one that he has been using.

You have been asked to advise Carlo and, in particular, as regards whether (on the assumption that the patent is valid) he has a liability for patent infringement and whether Maria and/or her franchisees would have such an exposure in the event of the sale to her being completed and her plan being implemented.

2. While making appropriate reference to relevant case law, discuss the principles to be applied when considering whether an innovation involving the use of a computer program is patentable.
3. Identify the principles to be applied in determining the entitlement to apply for a patent as between employer and employee and the means by which a dispute on this issue can be determined.

4. With particular reference to the following cases:
 - (a) *Ranbaxy Laboratories Ltd v. Warner-Lambert Company* [2006] 1 ILRM 377 (Supreme Court);
 - (b) *Schneider (Europe) GmbH v. Conor Medsystems Ireland Ltd* [2007] 2 ILRM 300 (Finlay Geoghegan J);
 - (c) *Medtronic Inc v. Guidant Corporation* [2007] IEHC 37 (Kelly J); and
 - (d) *Medinol Ltd v. Abbott Ireland* [2010] IEHC 6 (Finlay Geoghegan J)

discuss the purpose and likely scope of permissible discovery in the context of:

- (i) A claim of patent infringement; and
 - (ii) A claim (or counterclaim) that a patent should be revoked by reason of a lack of novelty and/or inventive step.
5. Discuss the circumstances in which an Irish patent can be amended after grant and consider whether decisions of the courts of the United Kingdom in this area are likely to be followed in Ireland.
6. Set out in detail the procedural steps which have to be taken in order to oppose the grant of a European patent (including the bringing of an appeal).
7. Outline and discuss the criteria to be applied when deciding whether an alleged invention involves an inventive step.
8. Analyse the contribution which the Patent Co-operation Treaty has made to the process of applying for patent protection and explain how one goes about taking advantage of it.
9. You have been consulted by a client who has presented what he believes is a new technique for reconditioning suede clothing and footwear. Describe in detail the various stages of the process whereby you would obtain information from him and investigate (by means of searches or otherwise) whether the technique or aspects thereof are patentable.