

LAW AND PRACTICE OF PATENTS

EXAMINATION PAPER 2017

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. Dakroda Inc. is a corporation existing under the laws of the United States which has manufactured and sold cars in North America for the last 70 years. Its best known model is an iconic sports car known as the “Comvar” which was first launched in 1968 and over 15 million of these vehicles have been sold in the United States since then. The current version, which was launched two years ago, has an engine super-charger that is the subject matter of US and European patents held by Spax Limited (an Irish company). Spax Limited granted Dakroda Inc. an exclusive licence to manufacture the super-charger and install it in Comvars for sale in the United States only. Comvars do not come in right-hand drive versions and are not sold new in Ireland.

Flash Cars Limited has started importing second-hand Comvars into Ireland, some of which are for sale in this country and others are for onward sale to car dealers in the Middle East.

Flash Cars Limited has not sought the consent of Dakroda Inc. or Spax Limited in respect of these activities and it seeks your advice as to whether there is any possibility of a claim for patent infringement being brought under Irish law.

2. While making appropriate reference to relevant case law, explain **EACH** of the following:
 - (a) The test for obviousness laid down by the English Court of Appeal in *Pozzoli SpA v. BDMO SA* [2007] EWCA Civ 588;
 - (b) The European Patent Office’s “*problem and solution approach*” to obviousness; and
 - (c) The concept of “*common general knowledge*” as applied in the context of obviousness.
3. While making appropriate reference to relevant legislative provisions and case law, define the criteria that must be satisfied in order to obtain a Supplementary Protection Certificate and the extent of the protection thereby conferred.
4. Outline the concept of priority in the context of patent applications and set out the means by which priority is claimed.
5. Explain the nature and purpose of divisional patents.

6. 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.
7. Discuss the circumstances in which an Irish patent can be amended after grant.
8. You have been consulted by a client who has presented what he believes is a novel means of unblocking drains by means of a non-corrosive and biodegradable de-greasing agent. Outline the resources and techniques that you would use in conducting searches to determine whether there is a basis for seeking patent protection.
9. Analyse **EACH** of the following cases:
 - (a) *Boehringer Ingleheim Pharma GmbH and Co KG v. Norton (Waterford) Ltd* [2016] IECA 16 (Court of Appeal); and
 - (b) *Bristol Myers Squibb Co. v. Merck Sharp and Dohme Corp* [2016] IEHC 540 (High Court - Costello J).
10. Outline the time limits and procedures to be followed in opposing the grant of a European patent (including any appeal pertaining thereto).