

LAW AND PRACTICE OF PATENTS

EXAMINATION PAPER 2021

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. Pavos Limited wishes to obtain a patent for a fire-resistant paint which has been named PYROGUARD. The paint was developed over the course of two years, during which it was tested in Germany by Amzut GmbH ("Amzut"), a company with whom Pavos Limited planned to enter a joint venture agreement. The tests included the making of sample batches of the paint by Amzut and the testing of its fire resistance in a laboratory owned by Amzut and on a number of specially-constructed structures which were placed by Amzut on waste land, coated with the paint and then set on fire. No joint venture agreement was ever concluded and the relationship with Amzut was brought to an end last year following a disagreement regarding profit-sharing.

You have been asked to advise Pavos Limited on the extent to which the foregoing matters may affect its ability to obtain a valid patent for PYROGUARD.

(20 marks)

2. Analyse and discuss **EACH** of the following decisions of the Irish Court of Appeal insofar as they concern Article 3(a) of Regulation (EC) No. 469/2009 on Supplementary Protection Certificates:

(a) *Gilead Sciences Inc v. Mylan SAS* [2021] IECA 22;

AND

(b) *Merck Sharp and Dohme Corporation v. Clonmel Healthcare Ltd* [2021] IECA 54.

(20 marks)

3. Set out the procedural steps to be followed within the European Patent Office in order to pursue an opposition to the grant of a European patent and any appeal pertaining thereto. (20 marks)

4. Explain:

(a) *AgrEvo* obviousness (T-939/92 *AgrEvo/Triazoles* [1996] EPOR 171);

AND

- (b) The European Patent Office's "*problem and solution approach*" to obviousness.

(20 marks)

5. Discuss the decision of the UK Supreme Court in *Actavis UK Ltd v Eli Lilly and Co.* [2017] UKSC 48 and consider whether the Irish courts should follow it when applying the equivalents provision contained in the Second Schedule to the Patents 1992 Act (as amended).
(20 marks)
6. You have been consulted by a client who has presented what he believes is a new means of avoiding the excessive pooling of water around the drain in shower cubicles and wet-rooms through the use of channels and grooves cut into the shower tray or wet-room floor. Outline the resources and techniques that you would use in conducting searches to determine whether there is a basis for seeking patent protection.
(20 marks)
7. Explain the purpose of a know-how licensing agreement, the circumstances in which one might find recourse being had to such an agreement and the provisions that one would expect to see in a properly drafted know-how licensing agreement.
(20 marks)
8. Discuss the decision of the Irish Supreme Court in *Merck Sharp and Dohme Corporation v. Clonmel Healthcare Ltd* [2019] IESC 65 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.
(20 marks)
9. Set out the advantages and disadvantages of seeking a declaration of non-infringement pursuant to section 54 of the Patents Act 1992.
(20 marks)
10. Explain the nature and purpose of divisional patents.
(20 marks)