

**Question 1**

a)

- EPO – 31 months from priority – 2 December 2016.
- Japan – 30 months from priority – 2 November 2016.
- China – 30 months from priority – 2 November 2016.
- USA – 30 months from priority – 2 November 2016.

b) Can request further processing in EPO. This provides an extra 2 months from notification, i.e. 10 days (postal rule) + 2 months, of the loss of rights to file a regional phase application.

China provides a two month late entry as of right extension, extending the deadline to 2 January 2017. An additional fee is payable.

c) USA requires an English translation of the entire specification, request for exam, any fees due and oaths and declarations on entry to the national phase, i.e. 2 November 2016. It also requires that an IDS is filed within 3 months of national phase entry, 2 February 2017. So plan to provide translation into English, request exam, any fees due and submit oaths and declarations by 2 November 2016 and submit an IDS on 2 February 2017.

Japan requires the requisite form and fees to be filed on NP entry, i.e. on 2 November 2016, so action this by that date.

China requires filing fees and publication fee to be filed and paid on NP entry, i.e. 2 November 2016, so action this at that point. Must also provide a translation of the specification into Chinese. This can be done by 32 months from priority with surcharge i.e. by 2 January 2017, so provide the translation at this time.

Japan also requires a complete translation of the specification into Japanese. However, this can be provided 2 months after NP entry with surcharge. This means that the translation can be provided by 2 January 2017 with surcharge.

No need to file a translation for the EPO as the specification is in German and German is one of the official languages of the EPO.

Must file on regional entry phase:

- Full specification
- Request for examination including examination fee
- Designation fee
- Renewal fee for 3<sup>rd</sup> year
- Application fee

This must be completed by 2<sup>nd</sup> November 2016. However, as mentioned before, it is possible to request further processing for regional phase entry. This means that the requirements mentioned above do not need to be filed until 2 months from notification, i.e. 10 days + 2 months, of the loss of rights. A surcharge is payable for further processing. This surcharge is due on all the fees payable mentioned above.

d) EPO – Only 1 independent claim is allowed in each category and excess claims fees are due on any claims over 15. These would be payable on claims 16 to 30. Excess fees are due within 6 months of notification (10 days + 6 months) of the K.161. communication issued by the EPO, as the EPO was the ISA.\*

Japan – excess claims fees are due on any claims over 1. Therefore, claims fees would be due on claims 2 to 30. These are due at examination.

China – excess claims fees are due on any claims over 10. Therefore, excess claims fees are due on claims 11 to 30. These are due at examination.

USA – excess claims fees are due on any independent claims over 3, any claims over 20, and any multiply dependent claims that depend on multiply dependent claims. Therefore, excess claims fees due on 1 independent claim, claims 21 to 30 and the 26 multiple dependent claims. These are due at grant, at the same time the issue fee is paid.

\* If any claims over 15 are left after the close of examination, when a Rule 71 (3) communication is issued, the excess claims fees must be paid within 4 months of notification of the Rule 71 (3) communication.

**MARKS AWARDED 14.5/20**

## **Question 2**

a. I would argue that either:-

- They are a plurality of interrelated products; or
- Are so linked as to form a simple inventive concept.

I would do this by filing informal comments. No fees are required for this.

b. It would record the informal comments and keep them on file and would forward the comments to the national offices at the national phase.

c. Informal comments may be filed up to 30 months from priority, i.e. 2 February 2016 + 30 months = 2 August 2018.

d. These are Article 19 amendments. Only the claims can be amended and a full claim set must be submitted to the receiving office (RO). Have the later of 2 months from notification of the search report or 16 months from priority to submit the amendments.

2 months from I.S.R = 3 October 2016 + 2 months = 3 December 2016.

16 months from priority = 2 February + 16 months = 2 June 2017.

So have until 2 June 2017 to submit an amended claim set. The amendments must be submitted on replacement sheets with a cover letter to the RO. No further searches are carried out on the amended claims and no further examination takes place. The amended claims are forwarded to the national/regional offices on national/regional phrase entry. The amended claims are not published but are kept on file. No arguments have to be filed regarding the novelty or inventive step of the amended claims, but informal comments can be filed.

e. Have later of:-

- 2 months from receipt of the international search report, or
- 16 months from priority,

To submit Article 19 amendments. Considering this example,

2 months from I.S.R = 3 October 2016 + 2 months = 3 December 2016.

16 months from priority = 2 February + 16 months = 2 June 2017.

f. No, the amendments are not published, but are kept on the IB's file.

g. Chapter refers to when a 'demand' is filed and the international application enters an examination phase. In other words, it is when the applicant enters into a dialogue with the IPEA and examination takes place.

h. A demand must be filed by the later of:-

- 3 months from receipt of the international search report; or
- 22 months from priority.

In this case:-

- 3 months from receipt of ISR = 3 October 2016 + 3 months – 3 January 2017.
- 22 months from priority = 2 February 2016 + 22 months = 2 December 2017.

So, must file a demand by 2 December 2017 at the latest. An examination is also due when filing the demand. It is possible to amend the claims, drawings and description with Article 34 amendments.

The applicant, when filing a demand, must respond to the objections in the written opinion. This must be done in writing (in a letter) and claim amendments must be provided as a complete claim set.

The IPEA (normally the ISA) will then consider the amendments and issue a further written opinion giving a term to respond. The applicant can then respond as before. This dialogue can continue until the final IPRP is issued 28 months from priority 2 June 2018. This is then forwarded to the relevant national offices.

i. BS in PCT2 considered to be new and inventive so no point requesting Article 34 amendments.

FAB in PCT1 is considered new but not inventive so it may be worth requesting Chapter II processing. This depends on how many countries the applicant wants to enter though.

**MARKS AWARDED 9/20**

### **Question 3**

#### Part A

a. Utility models are of a shorter term than patents, typically having a term of between 6 and 15 years from filing compared to patents which typically have a period of 20 years from filing.

Patents are often subject to substantive examination. Many utility models are art and operate on a registration system so are easier to obtain.

Patents have to be inventive in order to be patentable. The inventive step requirements for utility models is lower.

b. France – yes 6 years.

The Netherlands – no.

Italy – yes, 10 years.

Spain – yes, 10 years.

Poland – yes, 10 years.

Norway – no.

c. Utility models cannot be derived from PCT applications for France and Italy as the national route has been closed, i.e. it is not possible to enter the national phase of France or Italy from a PCT application.

Utility models can be derived from PCT applications for Spain and Poland because it is possible to file national phase applications in Spain and Poland from a PCT application.

#### Part B

a. The applicant could instead file a European patent application. This would allow the applicant to pursue protection in each of the countries mentioned, if it can be successfully argued that the invention is inventive. It may be possible to obtain utility model protection when validating the European patent.

b. Can still obtain utility model protection in Germany because a 6 month grace period is available prior to filing. Since the disclosure was 4 months ago, we are still the grace period to file a utility model application.

c. D1 would be citeable as novelty only, 54 (3) EPC prior art. This means that D1 was filed before but published after the client's application. So D1 can be cited in examination reports but only with regard to the novelty of the invention.

**MARKS AWARDED 9.5/20**

#### **Question 4**

##### Part A

a. No – Italy has a requirement to first file inventions relating to military applications, i.e. prejudicial to national security, in Italy. They must, therefore, file a first application in Italy. They cannot first file at the EPO because the invention was made by an Italian at an Italian R&D centre.

b. Yes. There are no requirements for Japanese nationals to first file in Japan. Similarly, there is no requirement to first file applications not prejudicial to national security in Germany, so it is possible to first file an EPO application. If it was military technology then there would be an obligation to first file in Germany, and they would not be able to first file at the EPO.

c. No. The US requires any inventions made by a US inventor, or any invention where part of the invention came from the US to be first filed in a US application. The applicant is then free to file other applications 6 months after the US filing. It is possible to obtain a foreign filing license from the US, however, which would allow a first filing at the EPO. The answer is unchanged in the US if it relates to military technology.

### Part B

a. 13 July 2016 + 10 days = 23 July 2016 + 4 months = 23 November 2016 is the latest date by which a response must be filed.

b. You can get a 2 month, as of right extension. It must be requested in writing and in advance of the original deadline. This would extend the date to respond to 23 January 2017.

It would be possible as well, if you did not respond in this time to request further processing. Once you receive the notification of loss of rights you have 10 days (postal rule) + 2 months to request further processing and respond to the Art 94 (3) communication.

c. To get the two month as of right extension you must request a two month as of right extension, in writing, from the EPO in respect of the application and the Art 94 (3) communication in advance of the originally set deadline of 23 November 2016. This would extend the term to respond to 23 January 2017. There are no official fees for doing this.

If you do not respond to the Art 94 (3) communication, the EPO will issue a loss of rights notification. You can respond to this, paying a further processing fee, to respond to the Art 94 (3) communication. The response period is 2 months from notification of loss of rights, i.e. 10 days + 2 months. It is also possible to further process the extended deadline of 23 January 2017 if no response is filed to the Art 94 (3) communication.

d) If the two part form is appropriate, then within 4 months of notification i.e. 10 days + 4 months, of receiving the Rule 71 (3) EPC communication need to:-

- Approve the text.
- File English and German translations of the claims, and
- Pay the grant and publication fees, and any renewal fees due.

After this, the EPO will mention grant of the patent in the European Patent Bulletin.

If the two part form is incorrect, then you can make reasonable amendments to the application to put it in order for grant, providing arguments for your amendments and requesting that a new Rule 71 (3) EPC communication is issued. Amendments should be made in the language of proceedings and replacement pages should be provided. Arguments should be made in a letter in writing. This must be done within 4 months of notification of Rule 71 (3) EPC communication.

If the new Rule 71 (3) EPC communication is correct then can follow process mentioned above if the two-part form is appropriate with regard to accepting the text.

**MARKS AWARDED 10.5/20**

**Question 5**

a. Assignment required by:-

- USA
- India
- Canada (entitlement evidence)

Inventor's declaration required by:-

- USA
- India
- Canada
- Brazil

b.	Country	Substantive Exam needed?	When must it be filed by?
	Brazil	Yes	3 years from filing
	USA	Yes	On filing
	Mexico	Yes	Included in examination fee on filing
	India	Yes	48 months from filing
	Japan	Yes	3 years from filing
	China	Yes	3 years from priority date
	South Africa	No	n/a
	Saudi Arabia	Yes	6 months from publication of the application
	Canada	Yes	5 years from filing

