

Question 1

a)

EPO – 31 month national phase entry

EPO = 2 December 2016

Japan – 30 month national phase entry

Japan = 2 November 2016

China – 30 month national phase entry

China = 2 November 2016

USA – 30 month national phase entry

USA = 2 November 2016

b)

EPO – further processing as of right. Delays by approximately 3 months i.e. 2 month from notification of loss of rights.

Japan – 2 month delay to 32 month entry.

China – 2 month as of right delay to 32 month entry.

USA – No delays as of right.

c)

EPO

- Do nothing until loss of rights notification received (further processing period).
- Then have + 10 days + 2 months for national phase entry (further processing deadline).
- By further processing deadline, request national phase entry, indicate application number (IB should have provided the documents to relevant offices already), pay

designation fee, pay renewal fee, request examination and pay examination fee, pay further processing fee, pay application fee.

- No translation required.
- No excess claims fees:
- Excess claims fees not required until after Rule 161/162 communication deadline.

Japan

- Request entry by 32 months, with late entry fee (2 January 2017)
- Provide translation of application into Japanese.
- Indicate which PCT application number is entering national phase.
- Pay application fee.

China

- Request entry at 32 month deadline (2 January 2017)
- Pay excess claims fees.
- Provide translation of application into Chinese
- Pay late entry fee and application fee.
- Give indication of application number to enter national phase.

USA

- Request entry by 30 month deadline (2 November 2016)
- Provide translation into English.
- Pay national application fee.
- Pay excess claims fees.
- Amend claims to remove multiple dependency.

d) EPO – excess claims fees for claims over 15. Therefore required to pay for 15 excess claims, each extra claim has a single fee. They do not need to be paid until 6 months from notification of Rule 161/162 communication. Up to that deadline, the claims may be amended and reduced to reduce the payable excess claims fees.

Japan – no excess claims fees, but examination fee is dependent on the number of claims. Examination fee required by 3 years from priority date i.e. 2 May 2017. Can be amended on entry to reduce claims to reduce examination fee.

China – excess claims fees for claims over 10. Therefore excess claims fees are payable on 20 claims. Not possible to reduce payable claims fees by amending claims because they are calculated on claims published in PCT application. Required to be paid on national phase entry.

US – excess claims fees required for claims over 3 independent claims and over 20 claims in total. Therefore fees payable on 1 independent claim and 10 dependent claims. Multiple dependent claims which are dependent on multiply dependent claims increase the total claims fees for every combination. Therefore, the excess claims fees would be very high if multiple dependents are not removed. Claims fees are required to be paid on national phase entry, but can be amended to remove multiple dependencies and to reduce total number of claims before national phase entry.

MARKS AWARDED 18.5/20

Question 2

a) FAB and SAB have the same inventive concept. Therefore, they have a 'single general inventive concept' which means that they have unity. However, the IB will require an additional search fee to be paid for the SAB claims and just in case they do not accept the argument that the claims have unity, I would pay the search fee under protest and submit the above argument.

b) If the ISA accepts the arguments, they will refund the search fee and conduct a search for SAB and issue a further search report and written opinion. If they do not agree, they will keep the search fee and conduct the search for SAB and issue the further search opinion.

c) The search fee and protest argument should be paid and filed respectively within 1 month of the invitation to pay further search fees.

d) Article 19 amendments may be filed within 2 months of the ISR (search report) or 16 months from the filing/priority date, whichever is later. Only amendments to the claims may be filed and they are voluntary amendments i.e. they do not have to respond to an objection. They must be filed in writing, showing the basis of any amendments and if they do not add subject matter, will be accepted.

e) Article 19 amendments may be filed by the later of 2 months from issue of the search report i.e. 3 December 2016 or 16 months from earliest priority date i.e. 2 June 2017. Therefore they may be filed up to 2 June 2017 but will be accepted if filed before preparations for publication are complete.

f) Yes, they will be published with the application and search report at 18 months from the earliest priority i.e. around 2 August 2017.

g) Chapter II is the phase of an international application if a demand is filed. For some countries e.g. Luxembourg and Tanzania, filing a demand and entering chapter II delays national phase entry to 30 or 31 months from 22 months. In chapter II the application is examined by the international preliminary examining authority (IPEA) and an international

preliminary report on patentability (IPRP) is issued. Before examination the applicant is entitled to submit amendments to description, claims and drawings in response to the written opinion of the search report.

h) A demand must be filed by the later of 3 months from receipt of the search report or 22 months from the priority date (2 December 2017) of the application and the demand fee must be paid by this deadline i.e. 2 December 2017. On filing the demand or after filing the demand, up to the deadline for filing a demand, the applicant may submit Article 34 amendments to the claims, description and drawings. The IPEA will examine the application with the amendments and will issue a new written opinion in the IPRP. The application may submit a reply but there will not likely be any further dialogue between the applicant and IPEA.

i) PCT2 – would not file a demand as it is not necessary, already have a good preliminary opinion for BS.

PCT1 – would not file as the search report and written opinion indicate that the invention is new, so may be limiting unnecessarily if amendments are filed now, as some jurisdictions may find it inventive.

MARKS AWARDED 15/20

Question 3

PART A

a) Utility models are usually a way of obtaining enforceable protection for an invention much faster than for a patent. Not all countries which have a patent system also have a utility model system, so utility model protection is available in fewer countries than for patents. Most utility model systems only allow protection for devices or mechanical/physical products with novel shapes or mechanisms, therefore they do not allow as much patentable subject matter as patents (which will also protect substances and compositions for example). Utility model protection term is also usually shorter (mostly 10 years from filing), but this is offset by the fact that the inventive step barrier is much lower for many places than for patents. Therefore, smaller changes may be protectable under utility models.

It is also often much cheaper to file and obtain a granted utility model due to the fact that it is often not examined substantively. While this may make it cheaper at first, it also means that the proprietor cannot be sure of its validity until it has been examined, and some jurisdictions do require it to be examined before it can be properly enforced. However, even unexamined, it can serve as a useful deterrent to competitors.

b)

France – Yes, utility models are available.

Netherlands – No, utility models are not available.

Italy – Yes, utility models are available.

Spain - Yes, utility models are available.

Poland - Yes, utility models are available.

Norway – No, utility models are not available.

c) (All are members of the PCT)

France – No, the national route in France is closed for a PCT application.

Italy – No, the national route in Italy is closed for a PCT application.

Spain – Yes, can enter the national phase in Spain for a utility model.

Poland – Yes, can enter the national phase of a PCT application in Poland for a utility model.

PART B

a) The applicant can enter the European regional phase from the PCT to try to obtain patent protection for all of the countries. Further, they can enter the German, Spanish and Polish national phases for utility models in each. In France and Italy a separate utility model can be filed, even though the application will have been published at 18 months, since the international phase ends at 30 months, and has not ended yet, the French and Italian applications would still be in the 12 months grace period for utility model filings.

b) It can now only be obtained in Spain, Poland and Germany as they can enter the national phases from the PCT application, and they have a 6 or 12 month grace period for inventor disclosures for filing applications.

c) D1 would be citeable as Article 54 (3) prior art against the application. This means that it was filed before, or priority date before but published after the filing or priority date of the application and can only be cited for novelty against the application. It is citeable since it has validity entered the EP regional phase.

MARKS AWARDED 12.5/20

Question 4

PART A

a) No, cannot be filed directly at the EPO but it could be filed at the EPO as long as the Italian Patent Office is the receiving office, since any inventions invented by residents of Italy and related to national security must be filed in Italy first. Therefore the company could also file in Italy first, instead of at the EPO. Similarly a PCT application may be filed provided that the Italian patent office is the Receiving Office. If not filed in Italy or with Italian Patent Office as receiving office, the inventors risk a fine or imprisonment in Italy.

b) Yes, the company may file first at the EPO. There are no provisions in Japan or Germany which oblige inventors to file there first. Therefore, the company can file anywhere first. If FW-Y related to advanced military technology, then they would have to file in Germany first.

c) TR-Z may not be filed directly at the EPO. The US requires any inventions where any contribution was made in the US to be filed at the USPTO first. Therefore, they must file at the USPTO first or risk losing enforceability of any US patent which is subsequently filed. Can get a foreign filing license to file overseas first. If related to military technology, must still file in US first and getting a foreign filing license to file abroad first may not be possible.

PART B

a) The response must be filed by 23 November 2016.

b) A 2 month extension is available as of right provided that it is requested before 23 November 2016 i.e. expiry of the deadline. Further processing is also available as of right if the deadline is missed. This will give 2 months from the notification of loss of rights sent by the EPO.

c) As of right 2 month extension must be requested in writing before expiry of the deadline i.e. 23 November 2016. The extended deadline would therefore be 23 January 2017. Additionally or alternatively, further processing is available after a deadline has been missed which results in loss of rights. It must be requested within 2 months from notification of the loss of rights and the omitted act must also be completed as well as payment of the further processing fee. Payment of the fee is deemed to be a request for further processing, so a separate request is not necessary.

d) If the two-part form is appropriate, then the client should proceed with the actions required for grant. Therefore, within 4 months from notification of the intention grant (i.e. + 10 days + 4 months), the grant fee and printing fee must be paid, the claims must be

translated into German and English and submitted and the client must pay any renewal fees that are due before the end of the period for reply.

If the two-part form is not appropriate, the client may submit reasoned amendments to the EPO before the end of the 4 month period for reply. If the examiner is not happy with these, he will resume examination. If he is happy, he will issue another Rule 71 (3) communication, setting a new 4 month period for reply and for all the granting acts to be completed i.e. pay grant and printing fee and submit translated claims in German and English.

Alternatively, the client may waive the right to a new Rule 71 (3) communication in which case, if the examiner believes the amendments are acceptable and if all the fees have been paid and translated claims submitted, the application will proceed directly to grant.

MARKS AWARDED 12/20

Question 6

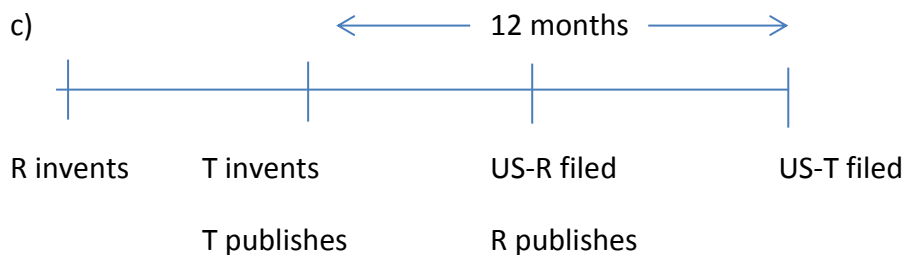
PART A

a) A US application for a patent which was filed before, and published after the filing or priority date of the invention.

b) An inventor disclosure before the filing or priority date of the invention.

Or

EP application which was filed before or has an earlier priority date, and published after the filing or priority date of the application.



Mr T gets the patent because his publication invalidates US-R as Mr T invented it independently or Mr R. However, Mr R's publication does not invalidate US-T because Mr R published after Mr T published, so Mr T is operating in his 12 month grace period, so any subsequent publications are not prior art.

PART B

a)

Germany – anyone may file an opposition and it can be done using a straw man which is effectively anonymous.

Japan – Any person may file an opposition which may be filed anonymously.

b)

Germany – grounds of opposition are lack of patentability i.e. lack of novelty, lack of inventive step, lack of industrial applicability, excluded subject matter, added subject matter, enablement.

Japan – grounds of opposition are lack of patentability i.e. lack of novelty, inventive step, excluded subject matter, added subject matter, double patenting, written description.

c)

German – period for requesting opposition is 9 months from grant of the patent, and fee is a single fixed fee for opposition.

Japan – period for requesting opposition is 6 months from grant of the patent and fee is based on the number of opposed claims i.e. fee for every claim being opposed.

PART C

a)

Brazil – no

China – no

US – yes

Australia – yes



Computer programmes as such

b) Business methods

Brazil – no

China – no

US – yes

Australia – yes

c) Plant varieties

Brazil – No

China – No

US – Yes (plant patents)

Australia – No

d) Gene sequences

Brazil – No

China – No

US – No

Australia – No

MARKS AWARDED 14.5/20