

Foundation Certificate

International Patent Law FC3

Friday 13 October 2017 10:00 to 13:00

INSTRUCTIONS TO CANDIDATES

1. You should attempt **five** of questions 1 to 6.
2. Each question carries **20** marks.
3. If more than five questions are answered, only the first five presented will be marked.
4. The total number of marks available for this paper is 100.
5. Start each question (but not each part of each question) on a new sheet of paper.
6. Enter the question number in the appropriate box at the top of each sheet of paper.
7. Do not state your name anywhere in the answers.
8. Write clearly, as examiners cannot award marks to answer scripts that cannot be read.
9. The scripts may be photocopied for marking purposes.
 - a) Use only **blackink**.
 - b) Write on one side of the paper only.
 - c) Write within the printed margins.
 - d) Do not use highlighter pens on your answer script.
10. Instructions on what to do at the end of the examination are on the Candidate Cover Sheet.
11. Any candidate script removed from the examination room will not be marked.
12. This question paper consists of ten sheets, including this sheet.

Question 1

Part A

Your UK-based client, NC Ltd, employs 50 people and is about to file a new US patent application, US1, claiming priority from a GB patent application, GB0. US1 is not subject to any licensing.

- a) Explain whether your client qualifies for 'small entity status' in the US.**
2 marks
- b) Define 'micro entity status' according to US law.**
3 marks
- c) How do the USPTO official fees for micro and small entities compare with those for large entities? (Do not provide fee amounts.)**
2 marks

Part B

GB0 received a combined search and examination report from the UKIPO. This report cites a GB patent application, a US patent application, a European patent application in French, and a Chinese utility model.

- a) What is the purpose of filing an Information Disclosure Statement (IDS) at the USPTO?**
1 mark
- b) What documents should accompany the IDS filed in support of US1?**
4 marks
- c) By when should NC Ltd file an IDS in support of US1 if NC Ltd wishes the IDS to be considered by the USPTO?**
1 mark

Cont...

Part C

In addition to US1, NC Ltd also files counterpart national patent applications in Japan (JP1) and China (CN1). During subsequent prosecution, the following events occur:

New prior art is cited by the Chinese Examiner against CN1 after US1 received its first Office Action from the USPTO.

New prior art is cited by the Japanese Examiner against JP1 just after US1 received a Notice of Allowance.

- a) **Give one reason for filing an IDS in the US in response to the events in China and Japan.**

1 mark

- b) **In order to have the IDS considered by the USPTO, what are the requirements (including fees and deadlines) for filing the IDS in response to the events in:**

- i) **China?**

3 marks

- ii) **Japan?**

3 marks

Total: 20 marks

Question 2

Part A

With respect to accelerated examination of patent applications at the EPO as part of the European PACE programme:

- a) **When can examination be accelerated?**

1 mark

- b) **How must accelerated examination be requested?**

1 mark

- c) **How does the EPO accelerate examination?**

2 marks

- d) **What are the consequences of requesting an extension of time to a deadline set in a communication issued by the EPO during accelerated examination?**

2 marks

Cont...

Part B

A Euro-PCT application was searched in the international phase by the EPO acting as the International Searching Authority. No amendments to the Euro-PCT application were filed when entering the European regional phase. The EPO communication under Rules 161(1) and 162 EPC inviting the applicant to file amendments has recently issued.

- a) **What would you recommend filing in response to the EPO communication and why?**
3 marks
- b) **What is the deadline for filing a response to the EPO communication, and can the deadline be extended?**
2 marks
- c) **How could the applicant have accelerated processing of the Euro-PCT application on entry into the European regional phase, including preventing the issue of the EPO communication under Rules 161(1) and 162 EPC?**
2 marks

Part C

European patent application EP1 claims two distinct inventions. During prosecution, only the first invention was searched and examined and EP1 was limited to the first invention. The Rule 71(3) communication has just been issued with a single independent claim.

The applicant contacts you today to inform you that he wishes to file a divisional application based on EP1 and directed to the second invention.

- a) **What is the deadline for filing a divisional application of EP1?**
1 mark
- b) **Describe the structure of the filing fee payable for first- and subsequent-generation divisional applications at the EPO (fee amounts are not required).**
2 mark
- c) **What other official fees must be paid to the EPO before the publication of the divisional application?**
3 marks
- d) **Why would any such fees be at least partially refunded?**
1 mark

Total: 20 marks

Question 3

A new client calls you today to inform you that last year he filed a German patent application himself, DE0.

- a) What are the minimum requirements for obtaining a filing date at the German Patent Office?**

2 marks

DE0 was filed in your client's own name. He is Luxembourgish, and owns a German company with a single place of business in Germany. He wants you to file a new PCT application in the name of his company, claiming priority from DE0.

- b) What problem could arise from the proposed priority claim and what can be done to rectify the problem?**

2 marks

- c) Name two competent receiving Offices for the new PCT application and explain why the PCT application may be filed at these Offices.**

2 marks

- d) What is the competent International Search Authority (ISA)?**

1 mark

You notice that DE0 has a filing date of 26 September 2016.

The client tells you that he disclosed the invention to the public the day after filing DE0. He says his patent rights are very important to him.

- e) Explain the requirements which must be met for the new PCT application to claim priority from DE0.**

4 marks

- f) Explain whether valid protection for your client's invention based on the PCT application can be obtained in:**

- i) USA; and**
- ii) China.**

2 marks

Cont...

The invention concerns a software-implemented business method.

- g) Identify three PCT contracting states where software-related inventions are potentially patentable as such.**

3 marks

- h) Identify three PCT contracting states which are different to those identified in g) and in which business-method inventions are potentially patentable as such.**

3 marks

- i) Explain whether the European Patent Office acting as ISA searches claims to software-implemented business methods.**

1 mark

Total: 20 marks

Question 4

Part A

- a) Identify six countries whose national law provides a grace period that allows applicants to obtain valid patent protection for an invention after their own disclosure of the invention, and, where appropriate, note any restrictions on the type or purpose of the disclosure for the grace period to apply.**

6 marks

- b) Identify three countries having a grace period which does not last 12 months (or one year) and give the term for each grace period.**

3 marks

Part B

For each of the following independent scenarios, explain whether your client's inventions would be patentable at:

- i) the EPO; and
- ii) the USPTO.

Assume there is no other relevant prior art and there are no other patentability issues.

- a) Your client disclosed the invention two weeks ago at a local trade fair.**

2 marks

- b) Your client disclosed the invention a few months ago at an international exhibition.**

2 marks

Cont...

- c) Your client talked in confidence about the invention to his employees about five months ago and was disappointed to find out this morning that one of his employees has posted the invention on social media.

2 marks

- d) The invention was disclosed in a magazine article which was written about 15 months ago.

2 marks

- e) The invention was described in a specialist printed publication 11 months ago. The article was authored by one of your client's peers, to whom your client had disclosed the invention in absolute confidence. Your client cannot recall whether the printed publication disclosed only your client's invention or an improvement which was developed by your client's peer and which included the invention.

3 marks

Total: 20 marks

Question 5

Part A

- a) Briefly outline the search procedure and the substantive examination procedure for:

- i) A German national patent application.

4 marks

- ii) An Italian national patent application.

2 marks

- b) How can patent protection be obtained via the PCT in:

- i) Germany?
ii) Italy?

2 marks

Cont...

- c) When is the first renewal fee payable for:
- i) A German national patent application?
1 mark
 - ii) An Italian national patent application?
1 mark
- d) What is the initial term and the maximum duration of a utility model registration in:
- i) Germany?
1 mark
 - ii) Italy?
1 mark
- e) What is the deadline for filing an opposition in Germany?
1 mark
- f) Give two grounds of opposition in Germany.
1 mark

Part B

You receive instructions from a US attorney to file a European regional phase application from a PCT application. The application has 55 claims, including an independent product claim, an independent apparatus claim, an independent method claim, and an independent use claim.

- a) **Assuming the number of claims is not reduced, detail the excess claims fees payable to the EPO (fee amounts are not required).**
2 marks
- b) **Explain whether all four independent claims can be pursued in the European application.**
4 marks

Total: 20 marks

Question 6

Part A

Your client has asked you to file an International (PCT) application.

- a) What fees must be paid on filing for a PCT application and which part of the organisation benefits from each fee (fee amounts are not required)?**

3 marks

- b) What is the deadline for payment of the fees mentioned in a) and how can the deadline be extended?**

2 marks

An International Search Report (ISR) has issued and cites relevant prior art. Objections have been raised in a Written Opinion accompanying the ISR.

- c) What is the deadline for responding to the ISR?**

1 mark

- d) Outline the International Preliminary Examination (IPE) procedure. Provide any applicable deadlines and any output from this procedure.**

3 marks

- e) What is the effect of the output from the IPE on the elected offices?**

1 mark

Part B

You filed a new PCT application on 29 September 2017, claiming priority from an earlier UK application dated 28 October 2016. Your client is seeking patent protection in Argentina, Australia, Brazil, Canada, China and the EPO.

- a) Which of the above countries are designated in the PCT application?**

1 mark

- b) Advise how to get protection in any countries which are not designated in the PCT application.**

1 mark

Cont...

- c) In each applicable country, what is the deadline for filing a national phase application based on the PCT application and which deadlines are extendable as of right?

4 marks

- d) Where appropriate, explain how the deadline can be extended. Give details of any relevant procedures and the extended deadline.

4 marks

Total: 20 marks