

Notes to trainers and students about the 2018 Foundation Certificate Sample Assessment Materials Mark Schemes

1. All Patent Examination Board mark schemes for live papers are subject to the standardisation process. This includes the examiners considering where alternative and legitimate answers provided by the candidate should be added to the mark scheme.
2. This sample assessment mark scheme has not been through a standardisation process and anyone consulting these Sample Assessment Materials' mark schemes should consider points 3 – 5 below.
3. Where a question contains several parts, the examiners may award marks for relevant points irrespective of whether the candidate has made the point in the same part of the question as the mark scheme.
4. Where the mark scheme indicates a whole mark is to be awarded for an answer or part of an answer, the examiners may award a half a mark if the answer is incomplete, not precise, or partially correct.
5. The Patent Examination Board operates a positive marking policy. Marks are not deducted for incorrect answers.

**FC3 – International Patent Law
Mark Scheme – Sample Assessment Material**

SECTION A

Question 1

- a) List six facts relating to utility models, at least one of which should relate to a difference between utility models and patents. **3 marks**
- b) Can utility models be obtained in Germany, Israel, Japan, Brazil, India and Canada? **3 marks**
- c) In France, Italy, Spain and Poland, explain whether or not a utility model can be derived from a *PCT* application. **4 marks**

Total: 10 marks

Answer

- a) Any six from the following (**0.5 marks** for each):

Lower standard of inventiveness, or novelty only.
Formal examination only.
Faster registration than patents.
Enforceable against third parties just like patents, but note generally narrower scope of protection (this mark is covered below).
Lower cost, both for registration and/or maintenance than patents.
Shorter term of protection.
Different countries have different laws.
Not available in all countries where patents are available.
Usually not available for the breadth of subject matter, which can instead be patented (candidates might say not available for methods/processes, and this would still attract the mark).
Compared to patents, wider availability of grace periods.

3 marks

- b) Germany, Y (**0.5 marks**); Israel, N (**0.5 marks**); Japan, Y (**0.5 marks**); Brazil, Y (**0.5 marks**); India, N (**0.5 marks**); and Canada, N (**0.5 marks**)

3 marks

- c) Italy, N, since direct PCT route is precluded (same applies to patents) (**1 mark**).
France, N, since direct PCT route is precluded (same applies to patents) (**1 mark**).
Spain, Y (**1 mark**), give full mark provided reasoning is given that PCT application is for any protection available in the PCT designated states.
Poland, Y (**1 mark**), give full mark provided reasoning is given that PCT application is for any protection available in the PCT designated states.

4 marks

Total: 10 marks

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Question 2

Recently, a *PCT* application has entered the national phase in the following countries:

1. Brazil
2. USA
3. Mexico
4. India
5. Japan
6. China
7. South Africa
8. Saudi Arabia
9. Canada, and
10. Germany.

a) Identify three countries which require a signed document of assignment from the inventor to the applicant to be filed with the local patent office.

3 marks

b) Identify one country which requires an inventor's declaration signed by the inventor.

1 mark

c) For each country, what is the deadline for requesting substantive examination, if any (ignoring any possible extensions of time)?

5 marks

Total: 9 marks

Answer

a) India (**1 mark**), South Africa (**1 mark**) and USA (**1 mark**) are the only countries requiring assignments.

3 marks

b) USA is the only country to require an inventor's declaration.

1 mark

c) Brazil +36m from International filing date (IFD) (**0.5 marks**).
USA on entry in the national phase (**0.5 marks**).
Mexico, not necessary, but application will be examined (**0.5 marks**).
India +48m from IFD (**0.5 marks**).
Japan +36m from IFD (**0.5 marks**).
China +36m from IFD (**0.5 marks**).
South Africa, not necessary, since formal examination only (**0.5 marks**).
Saudi Arabia +3m from national phase entry (**0.5 marks**).
Canada +60m from IFD (**0.5 marks**).
Germany +7yrs from international filing date (**0.5 marks**).

5 marks

Total: 9 marks

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Question 3

A granted European patent, written in English, is about to be validated in the following countries:

1. Germany
2. Italy
3. Poland
4. Netherlands, and
5. Norway.

a) **For each country, state which parts of the patent have to be translated and into what languages. Explicitly state any countries where no translation is required.**

5 marks

b) **State any differences in the answer to (a) above, had the patent been written in French.**

2 marks

Total: 7 marks

Answer

- a) Germany, no translation **(1 mark)**.
Italy, full spec in Italian **(1 mark)**.
Poland, full spec in Polish **(1 mark)**.
Netherlands, only claims in Dutch **(1 mark)**.
Norway, only claims in Norwegian **(1 mark)**.

5 marks

- a) If in French, differences would have been:

Netherlands, full spec in Dutch or English, but claims in Dutch **(1 mark** for complete answer or **0.5 mark** for at least identifying Netherlands).

Norway, full spec in Norwegian or English **(1 mark** for complete answer or **0.5 mark** for at least identifying Norway).

2 marks

Total: 7 marks

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Question 4

A first patent application for an invention was filed by an Argentinian company at the Argentinian patent office on 6 November 2017.

Quoting any applicable deadlines, provide advice to the Argentinian company outlining and justifying a suitable strategy to protect the invention in Argentina, Israel, New Zealand, Saudi Arabia and Taiwan, including filing a new *PCT* application.

4 marks

Answer

Argentina is part of the PC, so AR application gives rise to valid right of priority **(0.5 marks)**

Priority year ends 6 November 2018 **(0.5 marks)**.

File PCT application claiming priority from AR patent application by deadline **(0.5 marks)**, to cover NZ, SA and IL.

This leaves out Taiwan, since TW not contracting state to the PCT **(0.5 marks)**. Taiwan will, however, recognise right of priority from AR patent application since AR is member of WTO **(0.5 marks)**.

So file national application in TW, claiming priority from AR patent application **(0.5 marks)**.

Continue with underlying AR application since cannot get AR back from PCT **(0.5 marks)** application since AR not party to PCT either **(0.5 marks)**.

Total: 4 marks

Question 5

In relation to German and Japanese opposition procedures:

- a) Who may file an opposition? **1 mark**

- b) Can opposition proceedings be instituted anonymously? **1 mark**

- c) What are the grounds for opposition? **4 marks**

- d) What is the period for requesting opposition? **1 mark**

- e) How is the opposition fee structured? **1 mark**

Total: 8 marks

Answer

a) In Germany, any person can file an opposition (but self-opposition is not possible) and only a party that challenges ownership can do so on this ground **(0.5 marks)**.

In Japan, any person can file an opposition – even the patentee (but ownership is not a ground for opposition) **(0.5 marks)**.

1 mark

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- b) In Germany the proceedings can be instituted anonymously, e.g. straw-man or in the name of an attorney/agent **(0.5 marks)**.
In Japan, the proceedings cannot be filed anonymously **(0.5 marks)**.
1 mark
- c) In Germany: added matter **(0.5 marks)**, sufficiency **(0.5 marks)**, patentability **(0.5 marks)**, and 'unlawful deprivation' of subject matter from inventor **(0.5 marks)**.
In Japan: added matter, enablement and description requirements (ie sufficiency), mistakes in the translation, patentability, and double patenting (mention at least four to get the available 2 marks at **0.5 marks** for each correct ground of opposition identified).
4 marks
- d) In Germany, the opposition period is nine months from the date of issuance of the patent **(0.5 marks)**.
In Japan, the opposition period is six months from the date of issuance of the patent **(0.5 marks)**.
1 mark
- e) In Germany, there is a flat opposition fee **(0.5 marks)**.
In Japan, an opposition can be filed against any or all of the claims, and there is a flat fee plus a variable fee dependent on the number of claims opposed **(0.5 marks)**.
1 mark

Total: 8 marks

Question 6

For each of USA and Australia, indicate whether the subject matter below is in principle patentable:

- a) computer programs as such;
b) plant varieties.

2 marks

Answer

	a)	b)
USA	No	Yes
Australia	Yes	Yes

Each correct answer, **0.5 marks**.

Total: 2 marks

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SECTION B

Question 7

Your client has a *PCT* application filed on 28 April 2017 and claiming an earliest priority date of 2 May 2016. The application is in German and has been searched by the EPO in the international phase. It has 30 claims, including four independent claims and 26 multiple dependent claims.

Your client is interested in filing regional/national phase patent applications at/in:

the EPO;
Japan;
China; and
the USA.

Your client would prefer to spread the cost over at least a few months, even if this ultimately costs more.

Draft a memo to your client advising her of:

- a) **the standard deadline for filing regional/national phase applications derived from the *PCT* application in each jurisdiction;** **2 marks**

- b) **any jurisdictions which provide for an as of right late entry; and** **1 mark**

- c) **the length of any extensions in the jurisdictions identified in part (b).** **1 mark**

Your client asks you to complete, on the due dates or late due dates wherever possible, only the minimum requirements for validly entering the applications in the regional/national phases in the above jurisdictions.

Draft a memo to your client advising her:

- d) **of the actions you plan to take (do not consider any requirements relating to powers of attorney and certified copies of any priority documents);** **8 marks**

- e) **how the claims fees are calculated for each of the countries; and** **4 marks**

- f) **when these claims fees are payable.** **4 marks**

Total: 20 marks

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Answer

- a) USA, Japan and China +30m from earliest priority date = 2 November 2016 **(0.5 x 3 = 1.5 marks)**.
EPO +31m from earliest priority date = 2 December 2016 **(0.5 marks)**.
2 marks
- b) China **(0.5 marks)** and EPO **(0.5 marks)** each provide for an as of right late entry.
1 mark
- c) China, until 32 months from the earliest priority date **(0.5 marks)**.
EPO, + around two to five months from the standard 31m due date, more specifically within two months from notification of loss of rights (by paying further processing fee) **(0.5 marks)**.
1 mark
- d) USA: request national processing **(0.5 marks)** and pay the filing fee **(0.5 marks)**.
Japan: request national processing **(0.5 marks)** and pay the filing fee **(0.5 marks)**.
EPO: request European processing **(0.5 marks)** and pay the filing fee **(0.5 marks)**, request examination **(0.5 marks)** and pay the examination fee **(0.5 marks)**, pay the designation fee **(0.5 marks)**, request further processing **(0.5 marks)**, pay the applicable further processing fees **(0.5 marks)** and pay the excess pages fee **(0.5 marks)**.
China: request national processing **(0.5 marks)**, pay the filing fee **(0.5 marks)** and file the Chinese translation upon late entry **(1 mark)**.
8 marks
- e) USA: >3 independent claims, and/or >20 claims overall, and/or for multiply dependent claims, an excess claims fee **(1 mark)**.
Japan: for each claim, ie proportionally to the number of claims, as part of the examination fee **(1 mark)**.
EPO: excess claims >15, first tier of cost, so for claims 16 to 30 in the application **(1 mark)**.
China: excess claims for each claim in excess of 10 in the PCT publication **(1 mark)**.
4 marks
- f) USA: claims fee payable on filing or shortly after if claims furnished later **(1 mark)**.
Japan: payable when examination fee is due, ie +3 years from filing date, ie by 29 April 2018 **(1 mark)**.
EPO: payable at expiry of Rule 162 period, if excess claims not removed **(1 mark)**.
China: payable on filing **(1 mark)**.
4 marks
- Total: 20 marks**

Question 8

Your client has filed two *PCT* applications, PCT1 and PCT2, each having an earliest priority date of 2 February 2018.

PCT1 discloses and claims an automotive front airbag (FAB) and side airbag (SAB).

PCT2 discloses and claims a new braking system (BS).

The EPO acted as ISA and you have received the search reports for PCT1 and PCT2, each dated 3 October 2018.

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The search report for PCT1 is partial and only covers the claims directed to FAB, as the claims to FAB and SAB are found to lack unity of invention. The accompanying written opinion indicates these claims to be new but not inventive.

The search report for PCT2 covers all the claims. The accompanying written opinion indicates BS to be new and inventive.

Prepare notes for a meeting with your client in which you:

- a) **explain the procedure to contest the finding of non-unity between FAB and SAB in the international phase, stating any applicable fees (amounts not required) and relevant deadlines; and**

3 marks
- b) **explain the subsequent procedure by the ISA;**

2 marks
- c) **explain the procedure for filing amendments to the claims for PCT1 and PCT2 with regard to PCT 'Chapter I', including any relevant deadlines.**

6 marks
- d) **explain whether the amendments in (c) above are published by the International Bureau (IB);**

1 mark
- e) **briefly discuss the PCT 'Chapter II' procedure, including any relevant deadlines and fees (amounts not required);**

7 marks
- f) **advise your client whether or not to request Chapter II processing in relation to PCT1 and PCT2.**

1 mark

Total: 20 marks

Answer

- a) In response to a partial search report issued in the International phase it is possible to pay one or more further search fee(s) **(0.5 marks)** under 'protest' **(0.5 marks)**. Protest must be accompanied by reasoned statement as to unity of invention **(0.5 marks)** and a protest fee **(0.5 marks)**. The due date to pay fees and file protest is within a time period (usually one or two months) set in the corresponding invitation issued by the IB together with the partial search report **(1 mark)**.

3 marks
- b) The ISA decides on protest **(1 mark)**. If the protest is successful, search is extended as appropriate **(0.5 marks)** and further search fee(s) is/are reimbursed **(0.5 marks)**.

2 marks
- c) Under Article 19 PCT, amendments to the claims may be filed in response to the ISR **(1 mark)**. Will have to file the amendments directly with IB, not with RO (if different than IB), or with EPO **(0.5 marks)**. Will need to identify any amendments **(1 mark)** in letter, and can optionally file comments in support of patentability of invention **(0.5 marks)**.

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Filing amendments will be possible within two months from the issuance of the complete ISR or within 16 months from the priority date **(1 mark)**.

PCT2: will have until the later of 3 December 2018, which is +2m from mailing date of the complete ISR, and 16m from priority date, ie 2 June 2019, so answer is until 2 June 2019 **(1 mark)**.

PCT1: this application was, so far, only searched partially, thus an opportunity for further searches has been offered to the applicant by the IB. Note that a final/complete ISR has not yet been issued for PCT1 **(0.5 marks)**. Deadline will be later between 2 June 2019 and two months from issuance of complete SR **(0.5 marks)**.

6 marks

- d) Yes **(0.5 marks)**. The IB will normally publish the amendments/comments with the application. Amendments are still accepted if received after time limit, but in time before preparations for publication have been completed **(0.5 marks)** for relevant commentary that qualifies the Yes answer).

1 mark

- e) A maximum of 7 marks taken from the following:

PCT applicants have possibility to undertake an examination of the application in the International phase, which is known as Chapter II procedure **(1 mark)**. This procedure is started with the filing of a 'demand' **(1 mark)**.

Time limit for filing demand is later of three months from mailing of (complete) ISR, or 22m from priority **(0.5 marks)**, so client has at least until 2 December 2019 for both applications **(0.5 marks)**.

Demand must be accompanied by appropriate fee **(0.5 marks)**. Fee is high/demand is expensive **(0.5 marks)**.

Demand filed directly with competent IPEA, not the IB **(0.5 marks)**. Based on documents as on file at the moment of filing a demand, or can file amendments and/or arguments **(1 mark)**.

Will get an examination report which will form basis of IPRP **(0.5 marks)**, normally within 28 months from earliest priority date **(0.5 marks)**, otherwise IPRP will still be issued but containing (negative) written opinion **(0.5 marks)**. Possibility of interview with examiner **(0.5 marks)**. Further amendments and/or arguments can be filed in the International phase in response to objections of the IPEA **(0.5 marks)**.

If successful, can persuade national examiners and save on prosecution costs nationally **(0.5 marks)**. However, not binding on the national offices **(1 mark)**.

7 marks

- f) Can potentially be useful for PCT1 by virtue of negative written opinion **(0.5 marks)**, but seemingly unnecessary for PCT2 **(0.5 marks)**.

1 mark

Total: 20 marks

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Question 9

PART A

Your client has invented a new and inventive procedure (P) to treat severely damaged ligaments in the human body. He has also invented a new and inventive mechanical anchorage system (S) for reconnecting severed ligaments in the human body.

Your client has heard that a *PCT* application provides applicants with international protection. He comes to you today and proposes that you prepare a new patent application disclosing and claiming P and S, and that you first file a *PCT* patent application for the inventions.

Write a memo of advice to your client which includes:

a) an indication, for each of the following four countries, of whether your client can obtain patent protection for P, and why:

- USA
- China
- Australia
- Germany.

4 marks

b) an indication, for each of the four listed countries, of whether your client can obtain patent protection for S, and why; and

2 marks

c) one potential advantage and two disadvantages relating to your client's proposed filing strategy.

3 marks

Total for PART A: 9 marks

PART B

A client company recently acquired the patent portfolio of another company that designs lightweight composite pipes for marine risers. The patent portfolio includes two European patent applications EP1 and EP2.

European patent application EP1 is under examination at the EPO and a communication under *Article 94(3) EPC* was issued dated 13 July 2018. The EPO set a response period of four months. You need time to familiarise yourself with the technology.

The second European patent application, EP2, is also under examination at the EPO. EP2 is in French. The last communication from the EPO was under *Rule 71(3) EPC*. The 'Druckexemplar' proposes that claim 1 be reformatted using the two-part form over prior art document D1.

Write notes for a meeting with the client company explaining:

In relation to EP1:

a) by when must a response be filed;

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1 mark

b) what extensions of time are available, if any; and

2 marks

c) how you can obtain any such extension(s) (include any extended deadlines in your notes (you need not take into account EPO closed days).

2 marks

In relation to EP2:

d) what response should be filed to the EPO communication and by when (do not discuss any possible extensions of time); and

3 marks

e) the procedure through to grant following a response in part (d).

3 marks

Total for PART B: 11 marks

Total: 20 marks

Answer

PART A

a) USA:
Yes (**0.5 marks**), because methods of treating the human body are patentable subject matter (**0.5 marks**).

China:
No (**0.5 marks**), because methods of treating the human body are not patentable subject matter (**0.5 marks**).

Australia:
Yes (**0.5 marks**), because methods of treating the human body are patentable subject matter (**0.5 marks**).

Germany:
No (**0.5 marks**), because methods of treating the human body are not patentable subject matter (**0.5 marks**).

4 marks

Yes, in all countries (**1 mark**), because applicants can always get patent protection for mechanical systems or devices (**1 mark**).

2 marks

b) Any sensible potential advantage (**1 mark**):

PCTs can be seen favourably in due diligence or by investors.
Once filed, no further actions may be required, or costs incurred, until at least 30m from filing date.

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Potential choice of receiving office (rO), International Searching Authorities (ISAs).

Any sensible two disadvantages (**1 mark** each):

More expensive than national filings.

Potentially more complex initial draft.

Shorter patent term compared to filing a PCT application claiming priority from earlier non-PCT patent application.

Lose opportunity to incorporate any significant technical developments into application before filing a PCT application.

P not patentable in all countries, so potential waste of resources.

PCT delays grant (can also be interpreted as an advantage).

Note above list is not exhaustive; candidates should be awarded marks for pertinent answers.

3 marks

PART B

a) 13 July > 23 July deemed notification + 4m = 23 November 2018. **1 mark**

b) A two-month extension is generally available as of right (**1 mark**).
Longer extensions of time may exceptionally be granted by the EPO at discretion (**0.5 marks**) or further processing will also be available (**0.5 marks**).

2 marks

c) For as of right extension or discretionary extension, need to write to the EPO requesting it before the 23 November deadline; the new deadline would be 23 January 2019 (**0.5 marks**); for discretionary extension, act similarly but show that it would have not been possible to provide a response in the shorter period (eg attorney seriously ill) (**0.5 marks**).

FP but requires a fee (**0.5 marks**), deadline is calculated as two months from notification of a communication noting a loss of rights (**0.5 marks**).

2 marks

d) Within four months from notification of Rule 71(3) communication (**0.5 marks**).

If the proposed amendment is appropriate. File translation of claims in EN and DE (**0.5 marks**).

Pay the printing/publishing fee and pay any excess claims and/or pages fees (**0.5 marks**).

If proposed amendment is not appropriate:

File amendment to propose different two-part format (**0.5 marks**).

Or

Revert to one-part form (**0.5 marks**).

In either case, file amendments with accompanying arguments (**0.5 marks**).

3 marks

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e) If no amendments are filed:

EPO will then issue a decision to grant letter for the applicant **(0.5 marks)**.
Unless renewal fee soon due, in which case they will wait until this is paid **(0.5 marks)**.

If amendments are filed:

If EPO approves the amendments – a new Rule 71(3) communication issues **(0.5 marks)**.
Procedure is then as mentioned in (a) above **(0.5 marks)**.
The right to receive a further communication under Rule 71(3) EPC can be waived by the applicant **(0.5 marks)**.

Otherwise, a new examination report will be issued under Article 94(3) with further objections **(0.5 marks)**.

3 marks

Total: 20 marks

Question 10

Your US patent attorney sent you a Restriction Requirement issued by the US Patent and Trademark Office (USPTO) in relation to US patent application US1 owned by your UK client, Raceway Components Ltd. US1 discloses and claims two independent inventions: a mechanical component for suspensions (MC1), and a motorcycle suspension system (SS2). US1 also discloses, but does not claim, a method of controlling the stability of a motorcycle (MS3).

Write a memo to the UK client explaining:

a) what a Restriction Requirement is; and

2 marks

b) two options for responding to the Restriction Requirement.

2 marks

Later in the course of the prosecution of US1, a Final Office Action is issued by the USPTO.

Write a further memo to the UK client which:

c) briefly compares a Final Office Action with a Non-Final Office Action; and

2 marks

d) gives two options for responding to a Final Office Action.

2 marks

US1 was amended during prosecution to include only independent claims directed to the mechanical component MC1. The Notice of Allowance has recently issued.

e) Advise your UK client of one situation in which filing a Request for Continued Examination (RCE) after the issue of the Notice of Allowance is beneficial and explain why.

2 marks

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The USPTO has notified the applicant that a patent will be issued on 27 October 2018. The patent will be granted with claims to MC1 only.

Your client has phoned you earlier today to advise that they have also just invented a new and inventive test rig (TR4) for testing motorcycle suspension systems. The new test rig has similar features to those of the motorcycle suspension system SS2.

Prepare notes of advice for a meeting with your client setting out:

f) a strategy for protecting in the US each of:

- the mechanical component MC1;
- the motorcycle suspension system SS2;
- the method of controlling the stability of a motorcycle MS3; and
- the new test rig TR4.

Make sure you highlight any important deadlines.

4 marks

g) Whether it is possible to obtain protection for TR4 outside the US on the basis of any patent application filed for TR4 in the US.

2 marks

A patent is eventually granted on the basis of MC1.

Write a further memo to the UK client which advises:

h) when annuities are due in the US;

2 marks

i) when they can be paid (with no surcharge); and

1 mark

j) what the grace period is for the payment of annuities (with surcharge).

1 mark

Total: 20 marks

Answer

a) A Restriction Requirement is a letter in which the USPTO informs the applicant that more than one invention has been identified in the claims **(1 mark)** and requests that the applicant choose only one invention for prosecution **(1 mark)**.

2 marks

b) i) The applicant can choose one of the inventions identified by the Examiner as an invention for prosecution **(1 mark)**.

ii) The applicant can choose to argue in support of unity of invention, ie to select more than one invention in the application with 'traverse' **(1 mark)**.

2 marks

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- c) A Final Office Action is an Office action which brings prosecution to a close, whereas a Non-Final Office Action sets a period for responding to objections **(1 mark)**.
A Final Office Action issues when the applicant's response to a previous Non-Final Office Action fails to address or overcome previously raised issues **(1 mark)**.

2 marks

- d) Any two from the following:

- i) He may file an amendment which complies with the requirements set forth in the final OA, eg where one or more of the dependent claims have been found allowable by the examiner the applicant may respond cancelling the claims that have been objected to **(1 mark)**.
- ii) The applicant can file an 'amendment after final', touching upon the merits of the case explaining why the amendment was not earlier submitted and still have it considered by the examiner **(1 mark)**.
- iii) The applicant can file a Request for Continued Examination (RCE) to continue with the prosecution of the application **(1 mark)**.
- iv) The applicant may appeal the rejection of the claims **(1 mark)**.

(Other pertinent answers such as filing a continuation application and/or request an interview with the examiner could potentially attract **1 mark**, depending on the merit of the candidate's answer.)

2 marks

- e) **1 mark** is given for identifying a correct situation, and **1 mark** for mentioning a related advantage, examples as follows:

Situations:

The applicant would like to keep prosecution open to pursue broader claims **(1 mark)**.

The applicant would like to keep prosecution open to allow a prior art document of relevance to be considered by the examiner **(1 mark)**.

Advantage:

RCE avoids having to file a continuation application, which would be more expensive **(1 mark)**.

Gain time to file any continuations/divisionals **(1 mark)**.

Creation of a presumption of validity over prior art filed in IDS **(1 mark)**.

2 marks

- f) Candidates are not penalised for incorrect use of 'continuation' or 'divisional' terminology (a 'divisional' is in the US a particular type of continuation application):

The mechanical component MC1 can be protected by simply allowing US1 to grant shortly **(0.5 marks)**.

Suspension system SS2 was already claimed in US1, so file divisional application directed to SS2 **(0.5 marks)**.

Method of controlling stability MS3 was disclosed but not claimed in US1, so file a continuation application directed at MS3 **(0.5 marks)**.

Test rig TR4 is a related development, so it is possible (and convenient) to file a continuation-in-part (CIP) application **(1 marks)**.

Deadline for filing divisional and continuation applications based on US1 is before a patent is issued on US1, ie before 27 October 2018 **(0.5 marks)**.

Also, need to file CIP before the patent grants on 27 October 2018 **(0.5 marks)**.

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It is possible to file just one divisional, continuation or CIP application, and ‘chain’ the others **(0.5 marks)**.

4 marks

- g) Priority can be claimed in any non-US applications from a US application (either CIP or non-CIP) which is a first filing for the subject matter **(1 mark)**.
TR4 must be novel and inventive over the prior art available before priority date of US application **(1 mark)**.

2 marks

- h) Annuities on US patents are due at:
i) 3.5 years **(0.5 marks)**
ii) 7.5 years **(0.5 marks)**
iii) 11.5 years **(0.5 marks)**.

Due dates not computed from filing date of patent application but from date of issuance of patent **(0.5 marks)**.

2 marks

- i) There is a payment window of six months before due date. **1 mark**
- j) The grace period is six months from the due date. **1 mark**

Total: 20 marks