

FC3 (P5) – International Patent Law 2
FINAL Mark Scheme 2018

SECTION A

Question 1

A European patent application, written in English, was granted on 4 September 2018.

- a) Identify the deadline for validating the granted European patent in the EPC member states (excluding Ireland).

1 mark

- b) Identify what translations (if any) are required as part of validation of a granted European patent in the following EPC member states and explain why translations are/are not needed:

Germany
Italy
Netherlands

7 marks

Total: 8 marks

Answer

- a) 4 December 2018 (0.5 mark) – three months from grant (0.5 mark).

1 mark

- b) Germany – i) no translation requirements (0.5 mark); ii) as Germany is a London agreement country and shares an official language with the EPO or German claims are filed as part of the grant process (0.5 mark)

1 mark

Italy – title, description, claims and drawings are to be translated into Italian (1 mark). Italy is not party to the London agreement hence a full translation into Italian is required (1 mark).

2 marks

Netherlands –claims are to be translated into Dutch (1 mark). The Netherlands is a London agreement country (1 mark) which permits the Netherlands to also require that all or part of the patent document is translated into an EPO official language (1 mark). The description and title are already in English so no translation of those elements is required (1 mark).

4 marks

Total: 8 marks

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Question 2

An examination report under Article 94(3) EPC was issued to the applicant on 31 July 2018.

- a) **By when should a response to the examination report be filed with the European Patent Office** **1 mark**
- b) **Explain how the applicant could delay responding to the examination report (do not consider the postal rule).** **4 marks**
- c) **Describe any limitations on the nature of amendments that can be made to the claims of a European patent application at this stage of proceedings.** **(2 marks)**

Total: 7 marks

Answer

- a) 10 December 2018 including 10 day postal rule (**1 mark**). **1 mark**
- b) The applicant could request a 2 month extension (**0.5 marks**) in writing (**0.5 marks**) on or before 10 December 2018 (**0.5 marks**). If neither a response or a request for an extension of time is filed on or before 10 December 2018, the applicant can request further processing (**0.5 marks**) within 2 months (**0.5 marks**) of issuance of the notification of loss of rights (**0.5 marks**) together with filing the response to the examination report (**0.5 marks**) and paying the further processing fee (**0.5 marks**). **4 marks**
- c) Amendments are allowable at the discretion of the Examining Division (**1 mark**). The application may not be amended in such a way that it contains subject matter which extends beyond the content of the application as filed (**1 mark**).

Credit will be awarded for other reasonable answers.

2 marks

Total: 7 marks

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Question 3

A United Kingdom patent application was published on 3 July 2018. The applicant now wishes to seek patent protection in Hong Kong. Assume that the applicant is considering standard patent protection. Do not consider short-term patents.

Explain the procedure by which patent protection can be obtained in Hong Kong based on the current United Kingdom patent application.

4 marks

Total: 4 marks

Answer

File a request to record the United Kingdom patent application (**1 mark**) within six months of publication, i.e. by 3 January 2019 (**1 mark**). Once the United Kingdom patent has been granted, file a request for registration and grant (**1 mark**) within six months of the date of grant of the United Kingdom patent application (**1 mark**).

4 marks

Total: 4 marks

Question 4

A final office action has been issued in respect of a US utility patent application. Describe three courses of action available to the applicant to keep patent protection pending in the US without any loss of rights, including any relevant deadlines and extensions. Do not describe procedural details in your answer.

8 marks

Answer

The applicant could file a request for continued examination (RCE) (**1 mark**). RCE is a request for continued examination, which allows the applicant to continue to pursue a utility patent on an application for which the USPTO has closed prosecution (**1 mark**).

The applicant could file a continuation application (**1 mark**). A continuation application is a patent application filed by an applicant who wants to pursue additional claims to an invention disclosed in an earlier application of the applicant that has not yet been issued or abandoned or who wishes to effectively restart examination (**1 mark**).

The applicant may appeal to the Patent Trial and Appeal Board (PTAB) (**1 mark**). The applicant must first file a Notice of Appeal and pay the associated fee.

Each action must be done while the present application is still pending (**1 mark**) The time period for responding to the final office action may be extended by up to three months (**1 mark**).

Credit will be given for other reasonable answers.

Total: 8 marks

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Question 5

Company A, registered in England, wishes to file a direct PCT application that does not claim priority from an earlier patent application.

- a) Identify the minimum requirements to obtain a filing date **6 marks**
- b) Where could the PCT application be filed? **3 marks**
- c) What is the deadline for filing amendments to the claims following receipt of the International Search Report? **2 marks**

Total: 10 marks

Answer

- a) (i) At least one applicant, is entitled to file a patent application under the Patent Cooperation Treaty at the Receiving Office (**1 mark**), (ii) the description and claims are in a language accepted by the Receiving Office (**1 mark**) (iii) an indication that the application is intended to be an international application (**1 mark**), (iv) identification of the applicant (**1 mark**), (v) a description (**0.5 marks**), and (vi) one or more claims (**0.5 marks**). **5 marks**
- b) At the UK Intellectual Property Office (**1 mark**), European Patent Office (**1 mark**) or International Bureau of WIPO (**1 mark**). **3 marks**
- c) Two months from transmittal of the International Search Report (**1 mark**) or 16 months from the priority date (**1 mark**), whichever is later. **2 mark**

Total: 10 marks

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Question 6

For each of China, Japan and India, indicate whether the subject matter below is in principle patentable:

- a) Methods of treatment of the human body;
- b) Business methods.

3 marks

Total: 3 marks

Answer

	a)	b)
China	No	Yes
Japan	No	Yes
India	No	No

Each correct answer, **0.5 marks**.

Total: 3 marks

PART A Total: 40 marks

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SECTION B

Question 7

Your client has a European patent application filed on 15 April 2014 that includes 15 claims and 25 pages of text (including claims). A rule 71(3) communication was issued on 3 September 2018. The text intended for grant includes several amendments made by the Examiner. The GB designation has been withdrawn during prosecution.

Your client also wishes to obtain patent protection for a second, unsearched invention that is sufficiently described in the patent application as filed, but not claimed.

Draft a memo to your client advising her of:

- a) **three options for responding to the rule 71(3) communication together with associated deadlines and cost**
8 marks

- b) **the process for filing a divisional application, including where and when the divisional application should be filed, any fees due on filing or before issuance of a rule 71(3) communication and the associated deadlines, including extensions and any restriction on claim scope and country coverage.**
12 marks

Answer

a) 13 January 2019 including 10 day postal rule (**1 mark**). Approve the text communicated in the R71(3) communication (**1 mark**), file French and German translation of the claims (**0.5 marks**) and pay the grant fee (**0.5 marks**); ii) disapprove the grant text (**1 mark**) and request that the text submitted by the applicant forms the basis for grant (**0.5 marks**). Iii) do nothing (**1 mark**) and request further processing (**0.5 marks**) within 2 months of issuance of a notification of loss of rights (**0.5 marks**) together with paying the grant fee (**0.5 marks**) and surcharge (**0.5 marks**). No claims fees are due (**0.5 marks**).

8 marks

b) Divisional application due the day before grant of the current European patent application (**1 mark**). Divisional applications must be filed direct with the EPO (**1 mark**). Pay the filing fee (**0.5 marks**), search fee (**0.5 marks**) and any claims/pages fees (**0.5 marks**) within 1 month of filing (**0.5 marks**). Pay back renewal fees (**0.5 marks**) within 4 months of filing (**0.5 marks**). Examination (**0.5 marks**) and designation (**0.5 marks**) must be paid within 6 months of the date on which the European Patent Bulletin mentions publication of the European search report on the divisional application (**0.5 marks**). Annual renewal fees will be payable each year the European Divisional application remains pending (**0.5 marks**). If the applicant fails to pay the fees due upon filing the divisional application, further processing is available (**0.5 marks**) within two

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months of notification of a communication of loss of rights (**0.5 marks**). The applicant would need to request further processing and pay a further processing fee (**0.5 marks**) in respect of each missed action (**0.5 marks**). Divisional protection cannot be obtained in the United Kingdom (**1 mark**) as the GB designation was withdrawn during before the divisional application was filed (**1 mark**). Amendments to the claims must find basis in the parent application as filed (**1 mark**).

Credit will be given for other reasonable answers.

12 marks

Total: 20 marks

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Question 8

Your client has filed a United Kingdom patent application for a metal detector with a filing date of 6 November 2017. The metal detector is manufactured in China but is sold globally. You have been informed by your client that a Chinese company is planning to develop a similar metal detector that would infringe the claims of the UK patent application. Your client anticipates that it will take 12 months before the Chinese company is ready to launch its metal detector on the Chinese market. Your client also predicts that the metal detector is likely to a market leader for at least 12 years.

a) Prepare notes for a meeting with your client in which you explain an appropriate strategy for obtaining patent and utility model protection in China, including outlining the registration procedure in China for utility models, the term of protection and one advantage of a utility model over a patent.

10 marks

At the meeting, your client informs you that his most important markets are: Germany, Mexico, Israel and Saudi Arabia.

b) Outline a cost effective strategy for obtaining protection in these countries, including any associated deadlines, whether or not claims fees are due and whether utility model protection is available.

10 marks

Total: 20 marks

Answer

a) In China it is possible to obtain protection via both an invention patent and utility model (**1 mark**) if both applications are filed at the same time and within 12 months of the priority date of the UK patent application (**1 mark**). Utility models are subject to preliminary examination only (**1 mark**). This includes examination of the application documents (**0.5 marks**), ensuring the relevant fees are paid (**0.5 marks**) and a cursory examination of obvious substantive defects (**0.5 marks**). If no objections are raised during preliminary examination, the utility model will be registered (**0.5 marks**). Any person (the applicant or a third party) (**1 mark**) can request substantive examination following registration (**1 mark**). The utility model will be revoked if objections are raised and not overcome as part of substantive examination (**1 mark**). Term is 10 years (**1 mark**).

1 mark for providing any reasonable advantage of seeking utility model protection.

Credit will be given for other reasonable answers.

10 marks

b) File a PCT application (**1 mark**) at one year anniversary 6 November 2018 (**1 mark**). PCT deadlines (**1/2 mark each**): *Germany – 30 months, Mexico – 30 months, Israel 30 months, Saudi Arabia – 30 months.

*Will also accept Europe – 31 months

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Germany (**0.5 marks**) and Israel (**0.5 marks**) require payment of excess claims fees. Mexico (**0.5 marks**), Saudi Arabia (**0.5 marks**) do not. Reduce number of claims to avoid claims fees (**1 mark**)

*Will also accept Europe requires claims fees

Utility model protection is available in Germany (**0.5 marks**) and Mexico (**0.5 marks**) but not in Israel (**0.5 marks**) or Saudi Arabia (**0.5 marks**). Can file as either a utility model or patent at national phase entry in Germany and Mexico (**1 mark**).

Total: 20 marks

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Question 9

Your client has been offered the opportunity to purchase a patent portfolio relating to an innovative freeze drying process. The portfolio includes US-1 which is a granted US patent with a filing date of 8 October 2007 and a grant date of 11 December 2011 and SG-2 with a filing date of 3 November 2017. Your client wishes to proceed with both cases.

A check reveals that all actions are up-to-date on both cases

Write a memo of advice to your client which:

- a) **Outlines the renewal fee procedure for and expiry date of US-1** **4 marks**
- b) **Explain the local search and examination procedure for SG-2** **8 marks**

A client attends your office and explains that it inadvertently disclosed its new baby bottle at a local trade show in the UK. No patent applications have been filed but your client is interested in exploring where it would still be possible to obtain patent protection notwithstanding the inadvertent disclosure.

- c) **Write a memo for your client explaining whether it will be possible to obtain valid patent protection in Australia, China, the United States and via the European Patent Convention.** **8 marks**

Total: 20 marks

Answer

- a) The US patent granted on 11 December 2011 hence the next renewal payment is due 7.5 years from the grant date on 11 June 2019 (**1 mark**). The next renewal is due 11.5 years at 11 June 2023 (**1 mark**). Renewal fees can be validly paid up to 6 months before the renewal due date (**0.5 marks**) and up to 6 months after the renewal date (**0.5 marks**). Expiry will be 20 years from filing, i.e. 8 October 2027 (**1 mark**). **4 marks**
- b) Local search and examination must be requested within 36 months of the filing date of SG-2 (**1 mark**). The examination procedure lasts 18 months (**1 mark**) and includes at least one written opinion on patentability (**0.5 marks**) that the applicant may respond to

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within 5 months (**0.5 marks**). A further written opinion may be issued at the Examiner's discretion (**0.5 marks**) setting a further 5 month period to respond (**0.5 marks**). At the end of the 18 month period either a notice of eligibility (**0.5 marks**) or notice of intention to refuse (**0.5 marks**) is issued. If a notice of intention to refuse is issued, the applicant may apply for a review of the examination report (**1 mark**) within 2 months of receipt of the notice (**1 mark**). If a notice of refusal is issued, the applicant has a period of 2 months to file a divisional application before the application is irrevocably refused (**1 mark**).

8 marks

c) Protection would be possible in Australia (**1 mark**). In Australia disclosure by the inventor (or his/her employer) will not count as a novelty destroying disclosure if a patent application is filed within 12 months of the disclosure (**1 mark**). Protection would not be possible in China (**1 mark**) as China requires absolute novelty for an invention to be patentable (**1 mark**). Protection would be possible in the United States (**1 mark**). In the United States disclosure by the inventor (or his/her employer) will not count as a novelty destroying disclosure if a patent application is filed within 12 months of the disclosure (**1 mark**). In Europe it is possible to validly file a patent application within 6 months of a recognised trade show (**1 mark**). If the trade show was one of the few that is recognised then it would be possible to obtain protection in Europe for both the disclosed features and non-disclosed features (**1 mark**).

8 marks

Total: 20 marks

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Question 10

A new client comes to see you and expresses concern that a granted US patent owned by a competitor would block your client's plans for entering the US and Japanese markets with his new wound treatment product. Your client informs you that the core principles behind the competitor's patent were published in a university journal two years before the US patent application was filed. Your client is manufacturing in Germany.

You undertake a search and locate corresponding patents which were granted in Japan on 3 July 2018 and Europe on 6 December 2017. The European patent was validated in the United Kingdom, France and Germany. Your client has a good understanding of patent rules and procedures in the UK but wishes to find out how he might attack his competitors patents in the United States, Japan, Europe and Germany.

Prepare a memo for your client explaining:

- a) **The basics of inter partes review and ex parte re-examination at the USPTO. Assume that a post grant review has not been instituted;**
9 marks
- b) **Whether your client can oppose grant of the Japanese patent and identify the deadline by which an opposition must be filed;**
2 marks
- c) **Options for attacking the validity of the granted European patent;**
3 marks
- d) **The deadline, procedure and grounds for revocation in Germany.**
6 marks

Total: 20 marks

Answer

- a) Inter partes review would result in your client becoming party to proceedings (**1 mark**) through filing a petition with the USPTO (**1 mark**) and demonstrating a likelihood of success in respect of at least one claim challenged (**1 mark**). Inter partes review can be requested after 9 months from grant, issue or re-issue of a patent (**1 mark**) Ex-parte examination would not result in your client becoming party to proceedings (**1 mark**) and he would not be able to file further observations in addition to his original submission (**1 mark**). Ex partes re-examination can be requested at any time (**1 mark**) In either case, the USPTO may maintain the claims as granted (**0.5 marks**), order amendments to the claims (**0.5 marks**) or revoke the patent entirely (**0.5 marks**). Both inter partes review and ex parte re-examination require the petitioner to

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demonstrate a substantial and new question being raised in respect of validity of the claims **(0.5 marks)**.

Credit will be awarded for other reasonable answers.

9 marks

b)

An application to oppose a granted Japanese patent must be filed with the Japanese Patent Office within 6 months of publication of the granted patent **(0.5 marks)**. The Japanese patent granted on 3 July 2018 hence an opposition can be filed on or before 3 January 2019 **(0.5 marks)**. An opposition can be filed by any person **(1 mark)**.

2 marks

c)

It is no longer possible to file an opposition in respect of the granted European patent **(0.5 marks)**. The deadline for doing so was 6 September 2018 **(0.5 marks)**. The only option for your client is to seek revocation **(1 mark)** of the granted European patent in each designated contracting state **(1 mark)**.

3 marks

d)

An action for revocation of a German patent can be brought before the Federal Patent Court **(0.5 marks)** because more than 9 months have passed since publication of grant of a German patent (including the German part of a European patent) **(0.5 mark)**. The European patent was granted on 6 December 2017 hence revocation was available from 6 September 2018 **(0.5 marks)** and no opposition proceedings are pending **(0.5 marks)**. The potential grounds for revocation are: lack of patentability **(0.5 marks)**, insufficiency **(0.5 marks)** inadmissible extension of the patent's subject matter or scope **(0.5 marks)**, entitlement **(0.5 marks)**. The Federal Patent Court may maintain the patent **(0.5 marks)** or revoke in part or in full **(0.5 marks)**. Either party may appeal a revocation decision to the Federal Court of Justice **(1 mark)**.

6 marks

Total: 20 marks