

October 2018: Candidate Cover Sheet

Exam Paper: FC3 International Patent Law

Candidate No:

Venue:

At the end of the examination:

1. Count up the number of sheets you have used which you wish to be marked.
2. Use the boxes on each sheet of the answer script to number the sheets: '1 of 25', '2 of 25' etc.
3. If you have used extra sheets, please add your candidate number and the examination reference to these sheets too.
4. Do not staple the sheets, or use adhesive tape or treasury tags.
5. Write the number of sheets of paper you have put in this envelope here (do NOT include this cover sheet in your calculations).

No. of Sheets

6. Place the answer sheets that you wish to be marked in order in the white envelope provided with this sheet uppermost and the examination paper detail and your candidate details **showing through the envelope window**.
7. Seal the envelope and leave it on your desk face up.
8. Leave any spare answer script paper on your desk.
9. You may take the examination paper with you.

For examiner's use only:

	Section A						Section B				Total
	Qu 1	Qu 2	Qu 3	Qu 4	Qu 5	Qu 6	Qu 7	Qu 8	Qu 9	Qu 10	
Marks available	8	7	4	8	10	3	20	20	20	20	
Marks awarded											



Foundation Certificate

FC3 International Patent Law

Friday 05 October 2018 10:00 to 13:00

INSTRUCTIONS TO CANDIDATES

1. You should attempt **all** questions in Section A and any **three** questions in Section B.
2. The marks for each question in Section A are shown next to the question. Each question in Section B carries **20** marks.
3. If more than the required three questions are answered in Section B, only the first three 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 will be photocopied for marking purposes.
 - a) Use only **black ink**.
 - 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 six sheets, including this sheet.

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

Question 2

An examination report under *Article 94(3) EPC* was issued to the applicant on 31 July 2018 providing a period of four months for the applicant to respond.

- a) **By when should a response to the examination report be filed with the European Patent Office assuming that no extensions of time are requested?**

1 mark

- b) **Explain how the applicant could delay responding to the examination report.**

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

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

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

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.

5 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

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

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

Total: 20 marks

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 be 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

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) **explains 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

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