

FC3 (P5) – International Patent Law
FINAL Mark Scheme 2020

SECTION A

Question 1

Your client has instructed you to file a PCT application that will not claim priority. You are expressly instructed to file the PCT application on 1 November 2020.

- i) **What will the deadline be for filing a Canadian national phase patent application?** 1 mark
- ii) **Will any extensions be available?** 3 marks
- Total: 4 marks**

Answer

- i) *The deadline for filing a Canadian national phase patent application is 30 months from the PCT filing date (0.5 marks) so by 1 May 2023 (0.5 marks).*
- ii) *An extension of up to 42 months from the PCT filing date is potentially available (0.5 marks), so until 1 May 2024 (0.5 marks), but the applicant must submit a declaration that the delay was unintentional (1 mark) along with a statement of reasons setting out why the application was filed late (0.5 marks) and payment of a late filing fee (0.5 marks).*

Total: 4 marks

Question 2

Following a protracted examination procedure at the EPO, your client's patent application was refused after oral proceedings before the Examining Division. An appeal against refusal was duly filed. During the appeal proceedings, you filed written submissions including a new auxiliary request and supporting arguments that had not previously been filed during examination proceedings.

Explain the factors that the EPO Board of Appeal will consider when deciding whether to admit the new auxiliary request and supporting arguments.

Based on the facts, should the new auxiliary request and supporting amendments be admitted?

4 marks

Answer

Under the new Rules of Procedure of the Boards of Appeal, a party's appeal case shall be directed to: "the requests, facts, objections, arguments and evidence on which the decision under appeal was based" (1 mark). Any requests, facts, objections, arguments or evidence that should have been filed, or that were filed but not then maintained, during the first instance proceedings (i.e., examination proceedings) shall not be admitted during the appeal

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proceedings (1 mark) “unless the circumstances of the appeal case justify their admission” (1 mark).

Based on the facts given, the Board of Appeal should not admit the auxiliary request and supporting amendments (1 mark).

Total: 4 marks

Question 3

Your client, ABC Ltd, is the proprietor of a European patent application ('EP1'). The R.71(3) EPC communication has issued in respect of EP1.

Identify three options for responding to the R.71(3) communication.

3 marks

Answer

Any three marks from the below will be accepted:

- *Accept the text for grant, file claims translations and pay the grant and publication fees (1 mark).*
- *Disapprove the text for grant making at least one amendment to the description or claims (1 mark).*
- *Disapprove the text for grant, file claims translations, pay the grant and publication fees and waive the right to a further R71(3) communication (1 mark).*
- *Do nothing and respond through further processing (1 mark).*

Total: 3 marks

Question 4

Your client filed a PCT application having a priority date of 3 June 2018 and now wishes to seek protection in several countries, including the United States. Your client is a UK limited company having seven employees and is pre-revenue generating. It has not filed any previous patent applications in the United States. It has, however, licensed the invention claimed in the PCT application to a not-for-profit research organisation.

a) Identify the deadline for filing a national phase application in the United States.
1 mark

b) Identify the types of entity status at the USPTO and describe the requirements for each.
8 marks

c) Conclude which entity status applies to your client.
1 mark

Total: 10 marks

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Answer

- (a) *The deadline for filing the US national phase application is 30 months from the priority date (0.5 marks), i.e., 3 December 2020 (0.5 marks).*
- (b) *The USPTO will assign one of micro entity, small entity or large entity to your client (1 mark for listing all three). To be a small entity your client must be an individual, a small business concern, a university or a not for profit organisation (1 mark), have less than 500 employees (1 mark) and not have assigned, licensed or otherwise conveyed an interest in the invention to a non-small entity (1 mark). To be a micro entity, the client must: i) qualify as a USPTO-defined small entity (1 mark); ii) Not be named on more than four previously filed applications (1 mark); iii) Not have a gross income more than three times the median household income in the previous year from when the fee(s) is paid (1 mark); and iv) Not be under an obligation to assign, grant, or convey a license or other ownership to another entity that does not meet the same income requirements as the inventor (1 mark).*
- (c) *On the facts, the client is a micro entity (1 mark).*

Total: 10 marks

Question 5

Ms Jones, a serial inventor, visits your office to discuss seeking IP protection for a new hosepipe attachment. She explains that it is a combination of two well-known products in a new application. She does not want to apply for patent protection as she does not feel that there is an inventive step in her invention.

Explain whether there is any other form of intellectual property right that Ms Jones could apply for and list four countries where she could obtain protection for her hosepipe attachment. Do not discuss designs, copyright, trade marks or trade secrets.

5 marks

Answer

Ms Jones should seek utility model protection (1 mark).

*She could file utility model applications in Germany (1 mark), Mexico (1 mark), Argentina (1 mark), Korea (1 mark) and Japan (1 mark), for example**

**any four correct answers will be accepted*

Total: 5 marks

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Question 6

Busair, LLC wishes to file a single, direct European patent application as a first filing for an invention relating to aircraft undercarriage. The United States counsel drafting the application sends you a claim set having three independent claims, each defining a different apparatus invention, and 51 claims in total.

Claims 1–15 relate to invention A. This is the most important invention to the client.

Claims 16–35 relate to invention B.

Claims 36–51 relate to invention C.

- | | | |
|------|---|----------------|
| i) | Explain how claims fees would be assessed. | 3 marks |
| ii) | What steps you can take to eliminate such claims fees? | 3 marks |
| iii) | When would claims fees, if any, be payable? | 1 mark |

Total: 7 marks

Answer

1 mark per correct answer:

- i) *Every claim above 15 attracts a fee (1 mark). Claims 16-50 attract a first level of fee per claim (1 mark). Claim 51 attracts a higher level of fee (1 mark).*

- ii) *Given that three inventions are claimed and a European patent can only include a single set of claims in a single category (1 mark) you should delete the independent claims covering inventions B and C and any claims dependent thereon (1 mark) leaving 15 claims such that no claims fees will be payable (1 mark).*

- iii) *Claims fees must be paid within one month of the filing date (1 mark).*

Total: 7 marks

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Question 7

List four types of subject matter that are not regarded as inventions within the meaning of *Article 52(1) EPC*.

4 marks

Answer

- (a) discoveries, scientific theories and mathematical methods (1 mark);*
- (b) aesthetic creations (1 mark);*
- (c) schemes, rules and methods for performing mental acts, playing games or doing business, and programs for computers (1 mark);*
- (d) presentations of information (1 mark).*

Total: 4 marks

Question 8

Super Pants Ltd is a manufacturer of electro muscle stimulation undergarments that provide a heated tingling sensation to a user's stomach and gluteus maximus muscles. They wish to file for patent protection but inform you that they first sold the undergarment nine months ago.

List three countries where patent protection may still be filed and the period within which patent applications must be filed.

3 marks

Answer

Any three correct countries from the syllabus will be accepted.

Total: 3 marks

PART A Total: 40 marks

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SECTION B

Question 9

Hover Power Ltd has recently received a notice of allowance from the USPTO in respect of its United States patent application, US1, which was filed on 19 April 2015. Azam, the managing director of Hover Power Ltd, informs you that he has, just yesterday, become aware of two published patents (XX1 and XX2) having an earlier publication date than the priority date of US1. The issue fee has not yet been paid. Upon review you determine that both of these patents are highly relevant to the patentability of US1.

- a) Azam asks you what, if anything, should be done to bring these published patents to the attention of the USPTO.**

6 marks

After following your advice, US1 issues on 18 October 2020, following payment of the issue fee. Azam then tells you that after the issue date of US1, he becomes aware of a magazine publication (XX3) that pre-dates the priority date of US1. XX3 discloses an identical propulsion system to that claimed in US1.

- b) Advise Azam what, if anything, should be done to bring the magazine publication to the attention of the USPTO.**

1 mark

Notwithstanding your answer to b), Azam is concerned that XX3 could be used to invalidate US1. XX3 discloses a hover propulsion system that is identical to the invention claimed in US1.

- c) Advise Azam (including a brief description of any relevant procedure) how XX3 may be used, if at all, by a competitor to attack the validity of US1 at the USPTO.**

13 marks

Total: 20 marks

Answer

- a) *Both you and Azam have a duty of candour to the USPTO (1 mark) and this continues until the patent has issued (1 mark). As the issue fee has not yet been paid you have an obligation to bring the prior art references to the attention of the USPTO (1 mark). This should be done by filing an information disclosure statement (1 mark) together with a statement certifying that the prior art references were not cited in any patent application any longer ago than three months (1 mark). A fee is also payable (1 mark).*

6 marks

- b) *Azam does not need to do anything (1 mark) as once the patent has issued there is no further obligation to bring prior art to the attention of the USPTO.*

1 mark

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- c) *There are two options for attacking the validity of US1: (a) Post Grant Review (PGR) (1 mark) and Inter Partes Review (IPR) (1 mark). Post grant proceedings are only available in respect of patents with an effective filing date of 16 March 2013 or later (1 mark) and within 9 months of issue of the patent being attacked (1 mark). US1 was filed after the requisite date and issued within the past 9 months so PGR is potentially available (1 mark). PGR can be used to attack a granted patent on the grounds of lack of novelty (0.5 marks) and obviousness (0.5 marks) including where the prior art relied upon is printed, non-patent subject matter (1 mark). PGR could be used to attack US1 (1 mark).*

For IPR, The only grounds available are lack of novelty (0.5 marks) or obviousness (0.5 marks) based on earlier patents (0.5 marks) and other printed subject matter (0.5 marks) only. IPR may only be used where the granted patent to be attacked granted at least months previously (1 mark).

A competitor could use PGR to attack validity of US1 now as US1 was issued within the past 9 months (1 mark). A competitor could only use IPR after 18 June 2021 (1 mark).

13 marks

Total: 20 marks

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Question 10

Frytech Ltd manufactures and sells commercial frying equipment. It has recently developed a dry-frying technology that drastically reduces the amount of saturated fat in fried food. Frytech believes that its new technology will be a game changer in terms of reducing the health effects of eating fried food.

To scale up operations to manufacture a new range of dry fryers in significant volumes, Frytech spoke to several investors under obligations of confidentiality. One of those conversations was with VC Futures on 8 June 2020. Several months later, Frytech noticed that its main competitor, Triple Fry, LLC, displayed a frying system remarkably like that developed by Frytech. Even more suspiciously, the new CFO of Triple Fry was on the board of VC Futures.

Upon approaching the CFO of Triple Fry, he laughed and said, “You should be more careful who you speak to” and “You wouldn’t have been in this position if you had filed a patent application.” Frytech entered into a non-disclosure agreement with VC Futures prior to disclosing any information. The non-disclosure agreement specifically applied to the individual members of the board of VC Futures.

Frytech has not yet filed its patent applications in respect of its new dry-frying technology. They had planned on waiting for investment to come in before proceeding.

i) Advise Frytech on its options for seeking patent protection in the following territories:

- a) Europe;**
- b) United States;**
- c) China;**
- d) Australia.**

15 marks

ii) Would your answer be any different if Frytech had launched its new product prior to the disclosure by the investor?

4 marks

iii) Identify ONE territory, other than those listed above, that provides a grace period in respect of disclosures at recognised exhibitions.

1 mark

Total: 20 marks

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Answer

- i) *Each of the mentioned countries are party to the Patent Cooperation Treaty (PCT) so a PCT application could be filed (1 mark) together with a declaration (1 mark) stating that the application is being made within 6 months of a breach of confidence (1 mark) and filing supporting evidence (1 mark). Not all countries will accept such a declaration though (1 mark).*
- a) *A patent application could be filed directly in Europe (1 mark) within 6 months of a breach of the unauthorised disclosure by the investor (1 mark).*
- b) *A patent application could be filed directly in the US (1 mark) within 12 months of the date of disclosure by Frytech so by 8 June 2021 (1 mark) as the USPTO provides a 12 month grace period in respect of disclosures by the inventor, or the applicant (1 mark).*
- c) *A patent application could be filed directly in China (1 mark) within 6 months of the unauthorised disclosure by the investor (1 mark).*
- d) *A patent application could be filed directly in Australia (1 mark) within 12 months of the date of disclosure by Frytech so by 8 June 2021 (1 mark). Australia provides a 12 month grace period in respect of disclosures by the inventor, or the applicant (1 mark).*

15 marks

- ii) *If Frytech had launched its product prior to the unauthorised disclosure by the investor it would not be able to obtain patent protection in China (0.5 marks) or Europe (0.5 marks) who require absolute novelty (1 mark). They would still be able to obtain patent protection in Australia (0.5 marks) and the US (0.5 marks) as the grace period is in respect of disclosures by the applicant or inventor (1 mark).*

4 marks

- iii) *Any correct answer on the syllabus will be accepted*

1 mark

Total: 20 marks

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Question 11

Alpha Therapeutics, LLC, headquartered in Delaware, United States, is developing testing kits for cancer. Alpha boasts that the testing kits will enable diagnosis of multiple cancer types within 90 seconds of the test being performed. The inventors of the testing kit filed a United States provisional patent application (US1) on 3 December 2019, prior to founding Alpha. Alpha now wishes to file a PCT application (PCT1) in its own name. Alpha has an in-house IP team that handles patent families for all companies in its group structure.

a) Advise Alpha on what it needs to do in order for its priority claim to be recognised by the European Patent Office.

8 marks

b) Identify three patent office(s) that may be designated as the International Search Authority for PCT1.

3 marks

Alpha's European subsidiary, Alpha Therapeutics Ltd, is the proprietor of a pending European patent application (EP1) filed on 4 December 2019. Alpha wishes to file a PCT application (PCT2) before the relevant deadline.

c) Explain whether PCT2 can be filed at the USPTO.

2 marks

Alpha Therapeutics Ltd is also the proprietor of another pending European patent application (EP2), in respect of which the EPO has issued summons to oral proceedings before the Examining Division. The due date for filing a response to the written opinion accompanying the summons is 4 November 2020.

d) Advise Alpha how you would prepare the response considering the updated Board of Appeal Guidelines issued in January 2020.

4 marks

e) Identify three alternatives to filing written submissions.

3 marks

Total: 20 marks

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Answer

- a) *A person who has filed a patent application (0.5 marks) or their successor in title (0.5 marks) shall enjoy a right of priority (1 mark). The deadline for claiming priority is 12 months from the filing date of the first patent application so 3 December 2020 (1 mark). If Alpha wishes to file the PCT application in its own name it needs to secure assignment of the right to claim priority (1 mark) before the filing date of the PCT application (1 mark). It is not sufficient just to assign the patent application itself (1 mark). The assignment document would need to be signed by all of the inventors (1 mark). If the right to claim priority is not assigned prior to the filing date of the PCT application it will not benefit from the priority date of US1 (1 mark).*
- 8 marks**
- b) *The available ISAs are: IP Australia, European Patent Office, Korean Intellectual Property Office, Rospatent, Intellectual Property Office of Singapore, Israel Patent Office, Japan Patent Office, Korean Intellectual Property Office or USPTO (1 mark for each correct answer up to 3 marks).*
- 3 marks**
- c) *The USPTO will act as a receiving office for US residents and nationals only (1 mark). The application can be filed at the USPTO to obtain a filing date but the application will be remitted to the IB as the USPTO is not a competent receiving office (1 mark).*
- 2 marks**
- d) *The response should include all reasonable claim sets (1 mark) in a convergent manner (1 mark) and supporting arguments (0.5 marks) and evidence (0.5 marks) that Alpha might seek to rely on during any subsequent appeal. This is important as amendments and arguments not introduced during examination proceedings may not be allowed during appeal proceedings (1 mark).*
- 4 marks**
- e) *Alpha could: withdraw its request for oral proceedings and request a decision according to the state of the file (1 mark); or do nothing until the application is refused and then file an appeal (1 mark) or file a divisional application before refusal of the application (1 mark).*

3 marks

Total: 20 marks

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Question 12

Dog's Day, Inc., based in Michigan, manufactures and sells a range of toys and accessories for dogs. The Innovation Director, Tracey, calls you because the company's largest customer has cancelled its orders, which is of serious concern to Dog's Day. This is going to have a big impact on Dog's Day's short-term cash flow. To avoid laying staff off, Tracey informs you that she needs to cut the company's IP spend back to an absolute minimum over the next 15 months.

Dog's Day has a well-defined IP strategy in place to determine where patent protection is required.

Rank 1 patents are filed in the United States, Europe, Australia and China.

Rank 2 patents are filed in the United States and Europe.

Rank 3 patents are filed in the United States only.

Dog's Day has recently undertaken an IP audit and identified several innovations that they would like to protect:

Dog leash – rank 1

Bonearang – rank 2

Tooth sharpener – rank 3.

Advise Tracey how she can protect each of the above innovations through patents and/or utility models, while keeping costs to an absolute minimum during the next 15 months. Assume that Tracey will sanction any costs that are necessary to ensure that patent applications can be validly filed in accordance with Dogs Day's ranking system.

Total: 20 marks

Answer

Given that Dog's Day is a corporation registered in the United States, it should first file all 3 applications in the United States (1 mark) to negate the need for a foreign filing licence (1 mark). The cheapest option for a first filing would be to file provisional US patent applications as the official fees are significantly less than for full utility patent applications (1 mark).

The Dog Leash and Bonearang patents should be filed before the innovations are disclosed or sold due to the absolute novelty requirements in Europe and China (1 mark). The Tooth Sharpener patent can be filed within 12 months of disclosure by Dog's Day, as successor in title to the inventor (1 mark) due to only being filed in the United States (1 mark).

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Dog Leash

A PCT application should be filed 12 months after the filing date of the US provisional application (**1 mark**). This would allow Dog's Day to defer the national filing costs until 30/31 months from the filing date of the US provisional patent application (**1 mark**)

Bonearang

The US provisional patent application should be converted to a full, utility patent application within 12 months of the filing date of the US provisional patent application (**1 mark**). A European patent application should also be filed within 12 months of the filing date of the US provisional patent application (**1 mark**). The filing and search fee for the European patent are due on filing (**1 mark**) but can be filed within one month of the filing date (**0.5 marks**). If the fees are not paid by that date, a notice of loss of rights will be issued (**0.5 marks**). Dog's Day will have 2 months from the date of that communication (**0.5 marks**) to request further processing (**0.5 marks**) and pay the further processing fee (**0.5 marks**) in respect of each late fee (**0.5 marks**). The US utility patent filing, search and examination fees may also be paid after the date of filing (**1 mark**) within such time period as notified by the USPTO (**1 mark**).

Instead of/in addition to filing patents, Dog's Day could file utility models in Australia and China (**0.5 marks for each country**). Utility models can claim priority from a US provisional patent application (**1 mark**) and are generally cheaper than filing patent applications (**1 mark**). Utility model protection is not available in the US or Europe (**0.5 marks for each country**).

Tooth Sharpener

As patent protection is only required in the United States, the only action required is to convert the US provisional patent application into a full, utility patent application within 12 months of the filing date of the US provisional patent application (**1 mark**).

20 marks