

Foundation Certificate

FC3 International Patent Law

Friday 16 October 2020

10:00 to 13:00 UK British Summer Time (GMT + 1 hour)

Total time allowed: 3 hours 30 minutes

Starting from the time when you download the question paper, you have 3 hours 30 minutes in which to:

- Print this question paper (if wished)
- Answer the questions
- Take two screen rest breaks of 5 minutes each
- Save your Answer document to your hard drive as a pdf
- Upload your answer document to the PEBX system.

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. You must use the Answer document for your answers.
6. Do not attempt to change the font style, font size, font colour, line spacing or any other pre-set formatting in the Answer document.
7. Start each question on a new page. To begin a new page, press the control key and the enter key simultaneously.
8. When you begin a new question, type in the question number at the top of the page.
9. Do not state your name anywhere in your answers.
10. **Candidates who have been granted approval to handwrite their answers:** Instructions on what to do at the end of the examination are on the Candidate Cover Sheet.

This question paper consists of **7 sheets** in total, including this sheet.

AT THE END OF THE EXAMINATION

11. Save your Answer document to your hard drive and follow the instructions for uploading your document onto the PEBX system.

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

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

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

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

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

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

Question 7

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

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

Section A Total: 40 marks

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

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.

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

- i) Europe;**
- ii) United States;**
- iii) China;**
- iv) Australia.**

15 marks

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

4 marks

c) 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

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

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