

Examiner's
use only**Question 1**

- a) Deadline for validating granted European patent in EPC –
– six months after the publication of European search report

- b) i) Germany –

Germany is party to the London Agreement. ✓0.5 Germany has German as official language which is common with one of official language of EPO i.e. English, French, German.

The states which are party to London Agreement and has at least one language common with one of the official language of EPO, is exempt from translation requirement.

Hence, in Germany, translations are not required as part of validation of a granted European patent. ✓0.5

- ii) Italy:

- Italy is a party to the London Agreement
- Italy does not have a language common to one of the official languages of EPO i.e. English, French, German.
- Italy requires a translation in Italian.
- As Italy is a part of London Agreement but does not have EPO's one of official language in common, at least the translation of claims in Italian is required as part of validation of granted European patent.

- iii) Netherlands:

- Netherlands is a party to London Agreement. ✓1
- Netherlands requires translation in Dutch or English.
- Netherlands does not have official language language in common with EPO's official languages i.e. English, French, German. ✓1

0

0

- Hence, Netherlands requires full translation in Dutch or English and translation of claims in Dutch ✓1, as part of validation of granted European patent
- If the European patent is published in English, Netherlands requires only translation of claims in Dutch, as part of validation of granted European patent.

4

4

MARKS AWARDED 4/8

Question 2

- a) 31 July 2018 + 10 days = 10 August 2018
 10 August 2018 + 4 months = 10 December 2018 ✓1

Assuming, 10 December is not a Saturday, Sunday or EPO holiday, the response to examination report be filed by 10 December 2018.

If is an official holiday, response can be filed on the next working day.

1

- b) – Applicant has an as of right extension of two months ✓0.5 to reply to examination report. Hence, response can be validly filed within two months (as of right extension) after four months deadline. No reason required. No fee.
- If applicant failed to respond in as of right two months extension, he can request further processing. ✓0.5 No reason and required for further processing. Applicant can request it while filing the response. ✓0.5 The applicant should file the response within two months further processing deadline, pay the further processing fee ✓0.5, and request further processing.
 - Further, if applicant miss the further processing deadline, application will be deemed withdrawn but applicant can file for re-establishment of rights.
 - Re-establishment of rights can be filed within two months of awareness of missing deadline or within 12 months of missing the deadline.
 - Requires reasoning of non-compliance although due care is taken of circumstances.
 - Require to pay fee.

- If applicant misses the four months deadline, the European Patent office may issue notice and applicant can respond within the timeline set by the office in the notification. Usually 2-4 months.
- c) – cannot broaden claims.
- Amendments should be based on the issues raised in the Examination report.
 - Cannot add matter ✓1
 - the claims which were cancelled and has no basis in the description, cannot be re-introduced.

2

1

4

MARKS AWARDED 4/7

Question 3

Patent protection in Hong Kong:

- The patent protection can be obtained in Hong Kong based on the patent application published in United Kingdom.
- Request must be filed in writing.
- Request must be filed within six months of publication of patent application or patent in United Kingdom. ✓1 In this case, upto 3 January 2018.
- A certified copy of UK application, application number, name of inventor, copy of search results if any, country of application, need to file in Hong Kong.
- In Hong Kong, only formality examination is done and it relies on the substantive examination of country from which the protection is applied for in Hong Kong.
- Within two months of filing application in HongKong, the issue notification is sent and the patent is issued thereafter.

1

1

MARKS AWARDED 1/4

Question 4

After final office action issued in respect of a US utility patent application, following courses of action are available to the applicant to keep patent protection pending in US without loss of rights.

- 1) File arguments and/or amendments in response to final office action ✓1
- 2) File request for continued examination (RCE) ✓1
- 3) After final consideration program request (AFCP20) ✓1
- 4) Appeal
- 5) QPIDS (Quick Path Information Disclosure Statement).

File request for continued examination (RCE)

- Applicant can request RCE and pay the fee.
- RCE gives an option to the applicant to continue with the examination after rejection in final office action. ✓1
- RCE can also be filed if an issue fee is paid and before the issuance of patent, so as to file IDS (Information Disclosure Statement).
- RCE can be filed any time as long as patent application is pending.
- RCE re-opens the proceedings
- With RCE, applicant can file the amendments and/or arguments.
- RCE is expensive.

After Final Consideration Program [AFCP(2.0)]

- After Final Consideration Program has been extended to 30 September 2019
- It gives an opportunity to applicant to file amendments and/or arguments and also gives an opportunity to the Examiner to explain his rejection grounds and prior art. Examiner may do further search.
- For AFCP, it is required to make amendment to at least one claim.
- AFCP can be requested by applicant if rejection is received in the final office action. ✓1

- It is possible to arrange an interview with Examiner under AFCP.
- Once the final office action is received, there was no other option than filing the RCE but with AFCP, now applicant can request the examiner to reconsider their application and consider new arguments and/or amendments.
- Can be filed any time by applicant as long as application is pending

Appeal

- Applicant can appeal the decision in final office action to the Board of Appeals.
- PTAB considers the appeal

File arguments and/or amendments:

- After the issuance of final office action, applicant can submit arguments and/or amendments within three months of final office action.
- Chances are Examiner may not consider these arguments and/or amendments.

QPIDS (Quick Path Information Disclosure Statement)

- To keep the application pending, applicant can file for QPIDS.
- QPIDS is filed to submit any prior art which is relevant to patentability and applicant is aware of that not more than 3 months of filing QPIDS.
- Can submit the search results from corresponding application's search reports.

5

MARKS AWARDED 5/8

5

Question 5

a) Minimum requirements to obtain a filing date:

- 1) The applicant is entitled to file PCT application i.e. applicant is either national or resident of PCT contracting state. ✓1
- 2) Application is in prescribed language i.e. accepted by receiving office, accepted by International Search Authority and is a language of publication. ✓1

3) To include

- request that the PCT patent application is sought ✓1
- designation of at least one contracting state
- description of/identification of inventor ✓1
- description ✓0.5 and/or one or more claims. ✓0.5

The applicant i.e. company A is registered in England hence has a place of business in PCT contracting state. Hence, company A is entitled to file PCT application

For (2) requirement, note that International Bureau accepts application in any language.

5

b) The PCT application can be filed at receiving office or at International Bureau. In this case, company is registered in England hence can file PCT application at

1) at UKIPO (United Kingdom Intellectual Property Office) as registered in England ✓1. and has place of business in England.

2) at EPO (European Patent Office) as company A is registered in England ✓1 which means has principle place of business in England which is a EPC contracting state.

3) at IB (International Bureau) as any PCT application can be filed at International Bureau. ✓1

3

c) - Claim amendments can be filed, later of -

- within two months of receipt of International search report ✓1
- or within 16 months of earliest filing or priority date ✓1

2

10

MARKS AWARDED 10/10

Question 6

	Methods of treatment of human body	Business Methods
China	No ✓0.5	No as such
Japan	No ✓0.5	Yes ✓0.5
India	No ✓0.5	No ✓0.5

(2.5)

MARKS AWARDED 2.5/3

2.5

Question 7

a) Options for responding to Rule 71(3) communication:

- 1) – Review the text intended for grant and amendments made by examiner.
 - Approve the text for grant ✓1
 - Pay printing fee, issue ✓0.5 fee, excess claims fee ✓0.5, excess page claims if any due ✓0.5. In this case, as application includes 15 claims and 25 pages of text, no excess fee is required.
 - File the translation of claims in other two languages of EPO. For e.g. if filed patent application is in English, submit claims translations in French and German. ✓0.5
 - All above can be done within 4 months deadline i.e. 3 September 2018 + 10 days + 4 months = 13 January 2019. ✓1
 - Once the text is approved for grant, cannot make any amendments.
- 2) – File the amendments and for claim amendments, specify where the basis can be found in the European patent application. ✓1
 - Amendments can also be filed within 4 months deadline i.e. 13 January 2019 as above.
 - If amendments are filed, the application again goes into the Examination pool and amendments are examined. as to requirement of claims clear & concise, do not go beyond the scope of application as filed. , patentability. etc. ✓0.5
 - In the amendments, applicant can also add new claims of unsearched invention. Claims will be examined to the patentability and unity of invention criteria.

- In case of claims in excess of 15, the applicant may have to pay excess claims fees.
 - Also, if the pages of text exceeds 35, have to pay excess page fee.
 - The above claim amendment to include unsearched invention gives the possibility of adding protection of patent.
- 3) Do not approve the text intended to grant and file divisional application to the unsearched invention. Do not pay issue fee.
- Divisional application can only be filed for pending European patent application and can be filed upto the day before grant. Once the issue fee is paid, patent will be granted within 3 months. Hence, by not paying the issue fee, applicant can gain extra time to file divisional application.
 - First generation divisional application does not have extra cost but second & further generation divisionals incur increasing filing cost. Flat after fifth generation.
 - Pay any due renewal fee.
- b) – Divisional application can only be filed at the EPO. (the Hague, Munich) ✓1
- Divisional application is filed as long as the patent application is pending i.e. upto the day before grant as mention of grant in patent bulletin. ✓1
 - Fees due – Filing fee ✓0.5 for divisional which increases from second generation of divisional, claims fees, excess page and excess ✓0.5 claims fee, search fee ✓0.5, examination fee ✓0.5, renewal fee ✓0.5 which could be backdated if divisional application is filed after two years of filing a patent application.
 - claims fee, search fee, examination fee – within one month of filing ✓0.5 (can be extended)
 - Filing fee – on filing
 - Renewal fee – designation fee.
 - The subject matter of divisional should not go beyond the subject matter of parent application. ✓1
 - The different scope of claims can be filed for divisional

5.5

- May be result of unity of invention objection. Hence, can pursue second invention in divisional.
- All the countries designated in parent applications will be designated in divisional.
- the patent term of divisional is same as the patent term of parent application. i.e. 20 years from date of filing.

11.5

MARKS AWARDED 11.5/20

6

Question 9

- a) US-1 Filing date = 8 October 2007
Grant date = 11 December 2011

In US, the renewal fee is due on 3.5 years, 7.5 years ✓1 and 11.5 ✓1 years after grant.

Hence in this case, renewal fees must be paid –

- i) First renewal fee due at 3.5 years hence 11 December 2011 + 3.5 years = 11 June 2015
- ii) Second renewal fee due at 7.5 years hence 11 December 2011 + 7.5 years = 11 June 2019
- iii) Third renewal fee due at 11.5 years hence 11 December 2011 + 11.5 years = 11 June 2023.

Further the renewal fee can be paid within 6 months grace period ✓0.5 after the due date of renewal fee. The surcharge has to pay to use grace period hence renewal can be validly paid with surcharge at 4 years, 8 years at 11 years after grant. Hence, by 11 December 2015, 11 December 2019 and 11 June 2023, in this case.

If the grace period of six months is missed, can request for re-instatement of patent.

Expiry date of US1 is,
20 years from filing date hence, 8 October 2007 + 20 years = 8 October 2027 ✓1

3.5

b) SG-2 filing date = 3 November 2017.

Local search and examination procedure for SG2

i) First option – separate search and examination

Can request search 13 months of filing of SG-2 hence, 3 November 2017 + 13 months = 3 December 2017. Hence, in this case can request search by 3 December 2017.

Can request examination 36 months of filing of SG-2 i.e. 3 November 2017 + 36 months = 3 November 2020. Therefore can request examination by 3 November 2020.

ii) Second option – combined search and examination

- can request search and examination combined by 36 months of filing of SG-2 Hence, by 3 November 2017. ✓1
- combined search and examination is cheaper.

c) Some countries provide the patent protection for inventions even if they are inadvertently disclosed by the applicant. This is called as a grace period for filing patent applications which are results of previous disclosures by applicant or absuvie disclosures by third party who illegally obtained invention disclosure from applicant or inventors.

Australia – provides 12 months grace period for disclosures by applicant ✓1 prior to filing. In this case, at trade show.

China – provides 6 months grace period for disclosures by applicant prior to filing. In this case, at trade show. However, it is required to file the certificate of disclosure from trade show and declaration of disclosure at the time of filing the application for a new baby bottle. But need to check details of trade show as it may not be covered by requirement of Chinese grace period. ✓1

the United States – provides 1 year grace period for the disclosures by applicant. In this case, at trade show. ✓1

1

- d) European Patent convention – provides 6 months grace period for disclosures by applicant. In this case at trade show. Also, as the trade show was local trade show in UK, as it was in the European Patent Convention contracting state, the grace period of 6 months applies.

7.5

MARKS AWARDED 7.5/20

3

Question 10a) Inter-partes review at the USPTO

- After the expiry of nine-months period of post grant review ✓1 or after the termination of any pending post-grant review, any party can apply for inter-partes review.
- Inter partes review must be on the basis of novelty ✓0.5 and obviousness ✓0.5 and based on printed publications. ✓0.5
- Can apply against any patent granted on or after 16 September 2012.
- Grounds of inter-partes review are restricted.
- While filing the application must include the patent number of which claims will be opposed, extent of review i.e. which claims to be opposed, grounds of opposition, evidence, facts and arguments based on evidence. Must specify how the claims are anticipated by prior art, which part is anticipated by which prior art and where basis can be found in prior art.
- USPTO will consider inter-partes review only if the appellant can show that “he is reasonably to prevail with at least one claim being challenged.” ✓1

Ex-parte re-examination

- Any party can file for ex-parte re-examination ✓1 based on the prior art which is relevant to patentability of the granted patent.
- Also, on the ground of double patenting, if the inventors or applicant is same and patents are granted for same invention. In this case, applicant may file terminal disclaimer.

<ul style="list-style-type: none"> – PTAB reviews the validity of patent based on “preponderance of evidence” instead of “clear and convincing evidence” as for other cases. 	4.5
<p>b) Yes the client can oppose grant of Japanese patent as any party can oppose granted Japanese patent. ✓1</p> <p>The deadline to file opposition to granted Japanese patent is 6 months ✓1 after the publication of granted patent. i.e. in this case 3 July 2018 + 6 months = 3 January 2019. Hence, client can file opposition to JP granted patent by 3 January 2019.</p>	2
<p>c) – Past grant opposition can be filed to attack validity of granted European patent.</p> <ul style="list-style-type: none"> – Past grant opposition can be filed within 9 months ✓0.5 of mention of publication of grant. In this case by 6 September 2018. ✓0.5 – Past grant opposition can be based on lack of patentability, insufficiency, added subject matter. – Can also file appeal to attack validity of granted European patent – Central limitation may be filed. – If central limitation is not filed, may have to deal with invalidity case in national patent courts ✓1 in this case UKIPO, France Patent Office, Germany Patent Office. ✓1 	3
<p>d) <u>Revocation in Germany</u></p> <ul style="list-style-type: none"> – After the nine months deadline of filing opposition, any party can file for revocation in Germany. ✓0.5 – Grounds for revocation <ul style="list-style-type: none"> – Patentability ✓0.5 – Insufficiency ✓0.5 – Added subject matter ✓0.5 – Usurpation/infringement of party – any adversely affected party can file revocation based on this ground – patent goes beyond the scope of protection. – The revocation can be handled by Federal patent court ✓0.5 	

- Based on the mentioned grounds and evidence & facts and arguments, the Patent court decides on the revocation case.
- Patent applicant is given an opportunity to file his comments/arguments or amendments.
- Any party adversely affected may appeal to high court. ✓1

3.5

13

MARKS AWARDED 13/20