

Examiner's
use only**Question 1.**

a) 3 months ✓0.5 from the date of the notice of allowance.

b) Germany

- No translation ✓0.5 to claims/description
- Official language of Germany is German, which is also one of 3 official languages of the EPO. ✓0.5

Italy

- Full translation of both claims & description into Italian ✓0.5
- Italy is not a member of the London Agreement ✓1 & Italian is not one of the official languages of the EPO.

Netherlands

- claims into Dutch only ✓1 ⇒
description can be in English ✓1
- Netherlands is state to the London Agreement ✓1 & therefore disposes with translation requirements for the description if English is the language
- Netherlands prescribed English.

0.5

5.5

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MARKS AWARDED 6/8**Question 2.**

a) 31 July 2018 + 10 days

10 August 2018 + 4 months

file response by 10 December 2018. ✓1

- b) – the applicant could use further processing ✓0.5 – further processing fee would be payable; ✓0.5 the deadline would be extended by 2-5 months – a period would be specified by the examiner, starting from the date of the loss of rights communication. ✓0.5

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- The applicant could also ask the examiner for a discretionary extension. ✓0.5
- c) – The amendments must not broaden the scope of the claims; ✓1
 - The amendments must be supported by the application as filed – cannot add subject – matter; as such, basis for the amendments should be indicated;
 - The amendments should aim to address the objections raised in the Exam. Report; ✓1
 - the amendments should be clear,
 - must not extend the scope of protection

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MARKS AWARDED 5/7**Question 3.**

Hong Kong protection – cannot be directly filed. Must stem from an earlier Chinese, GB or EP(GB) application.

The procedure involves two stages:

- stage 1 – 6 months ✓1 after the publication of the GB publication Must be applied for by 3 January 2019. Apply in HK national patent office.
- stage 2 – 6 months after grant ✓1 of the GB publication. Must be applied for by 6m from grant of the GB application.

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MARKS AWARDED 2/4**Question 4.**

- AFCP – after final consideration program ✓1 – indicate willingness to conduct a telephone interview with the examiner; file a request & pay the fee; include a reasoned attempt to address the examiner's objections by substantial amendment to at least one independent claim; within 2m from the final OA. ✓1

- RCE – Request for continued ✓1 examinations – file a request & pay the fee within 2m from the final OA; include amendments to the claims or arguments; written request. ✓1
- file an appeal – an appeal has suspensive effect; as such, the rights will remain pending for the duration of the appeal proceedings. ✓1 Deadline: 3m from the date of the Final Office Action. ✓1

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MARKS AWARDED 7/8

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Question 5.

a) Filing date minimum requirements:

- the applicant must be eligible to file a PCT application; ✓1
- a request for registration of an international patent; ✓0.5
- description ✓0.5, as there is no earlier application so there will be no reference to an earlier application;
- details of the applicant – name & address of the applicant ✓1
- must be in a prescribed language; ✓1
- must include a designation of at least contracting state.

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b) PCT can be filed:

- directly at WIPO; ✓1
- at a national intellectual property office of a PCT contracting state (office of origin); so in this case, UKIPO; ✓1
- at EPO. ✓1

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c) Article 19 amendments:

later of 2 ✓1 months of the receipt of the International Search Report or 16 months from priority date. ✓1

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MARKS AWARDED 9/10

Question 6.

a) China

- Following recent changes, patentable subject matter
 - Before changes, no

Japan

- No; ✓0.5 not patentable

India

- No; ✓0.5 not patentable

b) China

- Following recent changes to the law, yes; ✓0.5 Before that, No.

Japan

- Yes, ✓0.5 patentable

India

- Yes, patentable.

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MARKS AWARDED 2/3**Question 8.**

a) UK filing date – 6 November 2017

- Both China & UK are in the PC/WTO – can validly claim priority from the UK filing. Subsequent CN application should be filed by 6 November 2018 (12 months)
- Utility model: term 10 years ✓1
- Lower inventiveness threshold
- Advantage: utility models are quicker to register than patents are, ✓1

As such:

- file a national patent application in China, claiming priority from the earlier UK application;

- metal detector likely to be a leader for 12 years
 - ⇒ utility model only lasts 10;
 - ⇒ patent lasts 20 years from filing date;
 - patent application published after 18 months (PCT) – By that time, the Chinese company would already be selling the metal detector; accelerate publication?
 - utility model will be faster to obtain than the patent;
 - for utility models, formalities & substantive examination;
- Claim priority, from the earlier UK filing, for the utility model;
- Patent will offer protection for the whole 12 year period, but a utility model will be registered before the chinese company starts selling.

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b) Most cost effective strategy

- ⇒ file a PCT application ✓1, Claiming priority from earlier GB filing, designate Germany, Mexico, Israel & Saudi Arabia
- File the PCT application by 6 November ✓1 2018.
- Deadline for national phase entry:
 - Germany – 30m ✓0.5 from International Filing Date (IFD)
 - Mexico – 30m ✓0.5 from IFD
 - Israel – 30m ✓0.5 from IFD
 - Saudi Arabia – 30m ✓0.5 from IFD
- ⇒ So by 6 May 2021 (for all)
- Claim fees due?
 - Germany – upon entry ✓0.5 into national phase (NP);
 - Mexico – upon entry into NP;
 - Israel – 3 months from entry ✓0.5 into NP; extendable by further 3m by fee.
 - Saudi Arabia – upon entry into NP

Utility model protection available?

Germany – Yes ✓0.5

Mexico – Yes ✓0.5

Israel – No ✓0.5

Saudi Arabia – No ✓0.5

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MARKS AWARDED 9/20

Question 9.

a) Renewals due:

3.5 years, 7.5 years ✓1, and 11.5 ✓1 years after grant

as such:

11 Dec 2011 + 42 months = 11 June 2015

11 Dec 2011 + 90 months = 11 June 2019

11 Dec 2011 + 11.5y = 11 June 2023

Expires 20 years from filing ⇒ 8 October 2027 ✓1

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b) Option 1: Local search & examination:

deadline = 13 months from filing

- If any deficiencies are found, the applicant is notified by means of a written opinion from the intellectual property office; ✓0.5
- the applicant is given a chance to reply within 5 months; ✓0.5
- reply can constitute comments or amendments;

Option 2: Local search, overseas examination

Request by: 36 months from filing

- the application is searched by the Singapore intellectual property office, but overseas examination is used to aid it;
- Deficiencies indicated by a written opinion; applicant can respond within 3 months.

Third option – overseas examination & overseas search – deadline: 54 months.

- c) – Client disclosed “inadvertently”; as such, it does not seem like the disclosure was a result of abuse;
- Local trade show in the UK – international exhibition exemption does not apply; ✓1
 - It does not seem like a breach of confidentiality occurred.

As such:

- Australia – yes; ✓1 12 month grace period for self-disclosure applies ✓1, so yes if it happened within the last 12 months.

China – No; ✓1 see discussion above – usually 6m grace for abuse/
international exhibition ⇒ does not apply;

US – possibly – did the disclosure occur in the last 12 months? ✓1 See
Australia

- 12m grace period for self disclosure. ✓1

EPC ✓1 – No. Absolute novelty required; 6m grace for abuse/
international exhibition. ✓1

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MARKS AWARDED 12/20

Question 10.

a) Inter-partes review: (IPR)

- Pay a fee & File a request for IPR
- can be instigated by anyone;
- can be instigated after the expiry of the period in which a post grant review could be initiated, i.e. after 9 months from the mention of grant
✓1 ⇒ has it been 9 months since the US patent was granted? Ask
client.
- can only be instigated on the grounds of (lack of) novelty ✓0.5 and
obviousness ✓0.5; must be based on printed publications ✓0.5 – as
such, could use the publication in the journal;

USPTO will only allow an inter partes review if it is more than likely that the claimant will succeed in an attack with respect to at least one claim ✓0.5;

- likely to be allowed in this case – if the core principles were disclosed 2 years before the filing date, in a printed publication, US granted patent would lack novelty or be obvious.
- ex parte re-examination – must be requested by the proprietor; usually done in an effort to maintain validity;

Fee has to be paid; the examiner re-examines a granted US application. Can be done at any time after grant ✓1. Cheaper than Post Grant Review. Provides legal certainty, especially after a new piece of prior art emerges. 4

b) Yes – anyone can oppose a Japanese patent; ✓1

Deadline – 6 months from the date of grant ✓1 – need to file opposition by 3 January 2019. 2

c) Opposition period in Europe lasts 9 months from grant; as such, it is too late for opposition ✓0.5 – deadline was 6 September 2018 ✓0.5, not extendable;

Revocation possible ✓1 – anytime after grant; request the EPO's opinion regarding validity; obtain, from the EPO, a declaration of non-infringement. 2

Deadline for opposition in Germany:

9 months from grant of the patent;

i.e., 6 September 2018:

Grounds of revocation:

patentability ✓0.5 (lack of novelty, lack of inventive step); sufficiency ✓0.5, entitlement ✓0.5 (lack of), scope of protection extended after grant. ✓0.5

Procedure:

- apply at the German Patent Office;
- anyone can oppose
- proceedings can be instigated anonymously;

- d) – Pay the opposition fee;
- File a written statement indicating grounds for opposition with reasoned comments.
- Opposed patent can be revoked ✓0.5, maintained ✓0.5 in current form, or amended.
- Appeal possible to the German Court. ✓0.5
- German opposition works retroactively.

3.5

MARKS AWARDED 11.5/20

11.5