Patent Examination Board

FC3 (P5) International Patent Law
Final Mark Scheme 2016

Question 1

Your client has a PCT patent application filed on 29 April 2015 and claiming an earliest priority date of 2 May 2014. The application is in German, has been searched by the EPO in the PCT phase, and has 30 claims, including four independent claims and 26 multiply dependent claims.

Your client is interested in filing regional/national phase patent applications at/in:

the EPO;
Japan;
China; and
the USA.

Your client would prefer to spread the cost over at least a few months, even if this ultimately costs more.

a) Calculate the standard deadline for filing regional/national phase applications derived from the PCT patent application in each jurisdiction.

2 marks

USA, Japan and China +30m from earliest priority date = 2 November 2016 (0.5 x 3 = 1.5)
EPO +31m from earliest priority date = 2 December 2016 (0.5)

b) Identify any jurisdictions which provide for an as of right late entry, including how long can the procedure be delayed in any such jurisdictions.

2 marks

China (0.5) and EPO (0.5) each provide for an as of right late entry
China, until 32 months from the earliest priority date (0.5)
EPO, + around 2 to 5 months from the standard 31m due date, more specifically within two months from notification of loss of rights (by paying further processing fee) (0.5)

Your client asks you to complete, on the due dates or late due dates wherever possible, only the minimum requirements for validly entering the applications in the regional/national phases in the above jurisdictions.

c) What actions do you plan to take? Do not consider any requirements relating to power of attorneys and certified copies of any priority documents.

8 marks

USA: request national processing (0.5) and pay the filing fee (0.5).

Japan: request national processing (0.5) and pay the filing fee (0.5).

EPO: request European processing (0.5) and pay the filing fee (0.5), request examination (0.5) and pay the examination fee (0.5 marks), pay the designation fee (0.5), request further processing (0.5) and pay the further processing fee (1),

China: request national processing (0.5), pay the filing fee (0.5) and file the Chinese translation upon late entry (1).

d) For the listed countries that require excess claim fees, state when such fees are payable and briefly describe their structure in relation to the current application (do not state any fee amounts).

8 marks

USA: > 3 independent claims, and/or > 20 claims overall, and/or for multiply dependent claims, as excess claims fee (1), payable on filing or shortly after if claims furnished later (1).

Japan: for each claim, i.e. proportionally to the number of claims, as part of the examination fee (1) therefore payable when examination fee is due, i.e. + 3 years from filing date i.e. by 29 April 2018 (1).

EPO: excess claims > 15, first tier of cost, so for claims 16 to 30 in the application (1). Payable at expiry of Rule 162 period, if excess claims not removed (1).

China: excess claims for each claim in excess of 10 in the PCT publication (1). Payable on filing (1).

Total: 20 marks

Question 2

Your client has filed two PCT patent applications, PCT1 and PCT2, each having an earliest priority date of 2 February 2016.

PCT1 discloses and claims an automotive front airbag (FAB) and side airbag (SAB).

PCT2 discloses and claims a new braking system (BS).

The EPO acted as ISA and you have received the search reports for PCT1 and PCT2, each dated 3 October 2016.

The search report for PCT1 is partial and only covers the claims directed to FAB. The accompanying written opinion indicates these claims to be new but not inventive.

The search report for PCT2 covers all the claims. The accompanying written opinion indicates BS to be new and inventive.

a) How would you argue for unity of invention between FAB and SAB in the International phase? State any applicable fees (amounts not required).

2 marks

In response to a partial search report issued in the International phase it is possible to pay one or more further search fee(s) (1). Can pay further search fee(s) under 'protest' (0.5). Protest must be accompanied by reasoned statement as to unity of invention (0.5).

b) How would the ISA respond to the arguments referred to in a) above?

2 marks

The ISA decides on protest (1). If the protest is successful, search is extended as appropriate (0.5) and further search fee(s) is/are reimbursed (0.5).

c) Discuss any deadlines associated with a) above.

1 mark

Pay fees and file protest within a time period (usually one or two months) set in the corresponding invitation issued by the IB together with the partial search report (1)

With regard to PCT 'Chapter I':

d) Describe the procedure for filing amendments to the claims for PCT1 and PCT2.

3 marks

Under Article 19 PCT, amendments to the claims may be filed in response to the ISR (1). Will have to file the amendments directly with IB, not with RO (if different than IB), or with EPO (0.5). Will need to identify any amendments (1) in letter, and can optionally file comments in support of patentability of invention (0.5).

e) Discuss any deadlines associated with d) above.

3 marks

Filing amendments will be possible within 2 months from the issuance of the complete ISR or within 16 months from the priority date (1).

PCT2: will have until the later of 3 December 2016 which is +2m from mailing date of the complete ISR and 16m from priority date i.e. 2 June 2017, so answer is until 2 June 2017 (1).

PCT1: this application was so far only searched partially thus an opportunity for further searches has been offered to the applicant by the IB. Note that a final/complete ISR has not yet been issued for PCT1 (0.5). Deadline will be later between 2 June 2017 and 2 months from issuance of complete SR (0.5).

f) Are the amendments in d) above published by the International Bureau (IB)?

1 mark

Yes (0.5). The IB will normally publish the amendments/comments with the application. Amendments are still accepted if received after time limit, but in time before preparations for publication have been completed (0.5 marks for relevant commentary that qualifies the Yes answer).

With regard to PCT 'Chapter II':

g) Explain what it is meant by 'Chapter II'.

2 marks

PCT applicants have possibility to undertake an examination of the application in the International phase which is known as Chapter II procedure (1). This procedure is started with the filing of a 'demand' (1).

h) Briefly discuss the Chapter II procedure, including any relevant deadlines and fees (amounts not required).

5 marks

A maximum of 5 marks taken from the following:

Time limit for filing Demand is later of three months from mailing of (complete) ISR, or 22m from priority (0.5), so client has at least until 2 December 2017 for both applications (0.5).

Demand must be accompanied by appropriate fee (0.5). Fee is high/demand is expensive (0.5).

Demand filed directly with competent IPEA, not the IB (0.5). Based on documents as on file at the moment of filing a demand, or can file amendments and/or arguments (1).

Will get an examination report which will form basis of IPRP (0.5), normally within 28 months from earliest priority date (0.5), otherwise IPRP will still be issued but containing (negative) written opinion (0.5). Possibility of interview with examiner (0.5). Further amendments and/or arguments can be filed in the Intl phase in response to objections of the IPEA (0.5).

If successful, can persuade national examiners and save on prosecution costs nationally (0.5). However, not binding on the national offices (1).

i) Advise your client whether or not to request Chapter II processing in relation to PCT1 and PCT2.

1 mark

Can potentially be useful for PCT1 by virtue of negative written opinion (0.5), but seemingly unnecessary for PCT2 (0.5).

Total for Question 2: 20 marks

Question 3

PART A

a) Write brief notes for your clients on utility models, including discussing differences between utility models and patents.

5 marks

Generally, lower standard of inventiveness, or novelty only (0.5). Generally, formal examination only (0.5). Generally, faster registration than patents (0.5). Generally, enforceable against third parties just like patents (0.5), but note generally narrower scope of protection (this mark is covered below). Generally, lower cost, both for registration and/or maintenance than patents (0.5). Shorter term of protection (0.5). Different countries have different laws (0.5). Not available in all countries where patents are available (0.5). Usually not available for the breadth of subject matter which can instead be patented (candidates might say not available for methods/processes, and this would still attract the mark) (0.5). However, note the comparatively wider availability of grace periods (0.5).

b) Can utility models be obtained in France, the Netherlands, Italy, Spain, Poland, and Norway?

3 marks

France Yes in the form of Certificates of Utility (Yes gets 0.5), the Netherlands N (0.5), Italy Y (0.5), Spain Y (0.5), Poland Y (0.5) and Norway N (0.5).

c) In the countries where utility models can be obtained, can they be derived from a PCT patent application, and why?

4 marks

Italy N since direct PCT route is precluded (same applies to patents) (1),
France N since direct PCT route is precluded (same applies to patents) (1)
Spain Y (1), Poland Y (1), give full mark provided reasoning is given that PCT application is for any protection available in the PCT designated states.

Total for Part A: 12 marks

PART B

A Chinese company contacts you today because they require protection in the above European countries, and further in Germany, for a new cigarette lighter. They have a pending PCT patent application, which is soon due for regional/national phase entry. They are worried that a competitor may in due course import a similar lighter into these countries.

You review the PCT patent application and conclude that the invention, defined as a lighter having a striker wheel with optimised dimensions for ease of use, is new but likely not inventive over the prior art cited by the ISA, and advise that in due course your client may wish to proceed with utility model protection, where possible.

a) What action can your client take to avoid filing his PCT application separately in the relevant, listed countries? Where possible, explain on what basis utility model protection can be achieved.

5 marks

Enter regional phase in Europe then convert European application into national utility models (1).
Germany: can register based on pending EP application or granted EP patent (1);
Italy: can register based on refused or withdrawn EP application, or revoked EP patent (1);
Spain: can register based on pending EP application (1); and
Poland: refused or withdrawn EP application (1).

The PCT application does not claim priority and you now learn that it was filed four months after your client publicly distributed samples of the new cigarette lighter for marketing research.

b) Where can utility model protection still be obtained, and why?

2 marks

Only in Germany (0.5) and Spain (0.5) because they have a 6 months grace period for utility models so disclosure will not be part of prior art (0.5 marks for each of DE and ES, as long as candidates make it clear to which countries the reasoning applies).

The International Search Report (ISR) lists a document D1 in category "E". D1 is a PCT publication of a patent application that validly entered the regional phase in Europe.

c) If your client filed a European regional phase application based on his PCT application, how and why would D1 be citable prior art?

1 mark

"E" means earlier document i.e. having an earlier effective date, but published on or after the International filing date of the PCT application.
D1 is prior art under Art 54(3) EPC (i.e. novelty only prior art) (0.5) because D1 validly entered the regional phase into Europe (so the filing fee must have been paid) (0.5).

Total for Part B: 8 marks

Total for Question 3: 20 marks

Question 4

PART A

A UK company is a manufacturer of composites and has R&D subsidiaries worldwide where new products are invented. Patent applications are preferably filed in the name of the company. Where possible, the applications are first filed, as a matter of company policy, as European patent applications at the EPO.

A new honeycomb structure (HC-X) for advanced military applications relevant to national security was invented by an Italian inventor in an Italian R&D centre.

A new filament winding machine (FW-Y) for reinforcing pipes was invented by a Japanese inventor in a German R&D centre.

A new thermoplastic resin (TR-Z) to be used as a matrix in composite materials was invented by a US inventor in a US R&D centre.

a) Can the company first file a European patent application for HC-X directly with the EPO, or where else could the company file it? Explain your answer.

3 marks

Cannot first file directly with EPO, since subject matter seems pertinent to national security (0.5). Italian patent law provides for an obligation to first file with the Italian authority based on the residency of the applicant and if the invention was invented in Italy, thus should file in Italy (0.5). UK patent law provides for an obligation to first file with the UK Patent Office based on the residency of the applicant, thus should also first file at the UK-IPO (0.5). It is likely not to be possible to first file an application in two distinct countries (0.5). Could first file in Italy in the name of the Italian subsidiary to comply with Italian law (0.5), then assign application to UK company (section 23(2) UK Patents Act) (0.5).

b) Can the company first file a European patent application for FW-Y directly with the EPO, or where else could the company file it? Explain your answer. Would your answer be different if FW-Y related to advanced military technology relevant to national security?

3 marks

Can first file at the EPO to comply with company's policy (0.5), since both Germany and Japan do not provide for restrictions to file abroad or with International authorities such as EPO (0.5 marks for Germany) (0.5 marks for Japan), and section 23(1) UK Patents Act does not apply for UK company since subject matter is not related to military company (0.5). Yes, answer would be different in that section 23(1) UK Patents Act would then apply for UK company (0.5) so would have to first file at UK-IPO (0.5).

c) Can the company first file a European patent application for TR-Z directly with the EPO, or where else could the company file it? Explain your answer. Would your answer be different if TR-Z related to advanced military technology relevant to national security?

3 marks

Cannot first file application with EPO (0.5), because US laws provide for restrictions to first file abroad relating to US citizens and/or inventions invented in US territory, irrespective of whether the invention relates to national security (0.5). Thus, file application with USPTO (0.5). Yes, answer would be different in that section 23(1) UK Patents Act would then apply for UK company, so would also have to first file at UK-IPO first (0.5). It is likely not to be possible to first file an application in two distinct countries (0.5), so either file in the name of US subsidiary then assign to UK company or seek leave to apply at UKIPO from US government by filing a corresponding petition (at least one of these two possible solutions to gain 0.5marks).

Total for PART A: 9 marks

PART B

The company recently acquired the patent portfolio of another company that designs lightweight composite pipes for marine risers.

European patent application EP1 is under examination at the EPO and a communication under Article 94(3) EPC was issued dated 13 July 2016. The EPO set a response period of four months. You need time to familiarise with the technology.

a) By when must a response be filed?

1 mark

13 July > 23 July deemed notification + 4m = 23 November 2016 (1).

b) What extensions of time are available, if any?

2 marks

A 2 month extension is generally available as of right (1).
Longer extensions of time may exceptionally be granted by the EPO at discretion (0.5) or further processing will also be available (0.5)

c) Describe how you can obtain any such extension(s), and calculate the extended deadlines (you need not take into account EPO closed days).

2 marks

For as of right extension or discretionary extension, need to write to the EPO requesting it before the 23 November deadline; the new deadline would be 23 January 2017 (0.5); for discretionary extension, act similarly but show that it would have not been possible to provide a response in the shorter period (e.g. attorney seriously ill etc..) (0.5).
FP but requires a fee (0.5), deadline is calculated as two months from notification of a communication noting a loss of rights (0.5).

A second European patent application, EP2, is also under examination at the EPO. EP2 is in French. The last communication from the EPO was under Rule 71(3) EPC. The 'Druckexemplar' proposes that claim 1 be reformatted using the two-part form over prior art document D1.

d) What action should you take if the two-part form is appropriate? What action should you take if the two-part form is inappropriate? In each case, provide details of

the procedure up to and including grant of a patent based on EP2, including any deadlines.

6 marks

If appropriate – or from the moment text proposed for grant is agreeable to applicant: within four months from notification of (eventual) 71(3) communication (0.5), file translation of claims in EN and DE (0.5), pay the printing/publishing fee and pay any excess claims and/or pages fees (0.5). EPO will then issue a decision to grant letter for the applicant (0.5), unless renewal fee soon due, in which case they will wait until this is paid (0.5). Grant has effect from date of publication of the mention of grant on EP bulletin (0.5), which date is also mentioned on the decision to grant.

If not appropriate: write a letter to EPO with comments in support of claim 1 as is (0.5), or propose different two-part format (0.5) or revert to one-part form if necessary (0.5). If EPO is convinced, they will issue a new 71(3) communication (0.5) otherwise a new examination report will be issued under Article 94(3) with further objections (0.5). The right to receive a further communication under Rule 71(3) EPC can be waived by the applicant (0.5).

Total for PART B: 11 marks

Total for Question 4: 20 marks

Question 5

Your client is an industrial machinery company and employs inventors worldwide to devise ingenious solutions. Your client routinely submits details of these inventions to you for assessing patentability. When a new patent application is filed, your client collects executed patent assignments from the inventors.

Recently, a PCT patent application has entered the national phase in the following countries:

1) Brazil
2) USA
3) Mexico
4) India
5) Japan
6) China
7) South Africa
8) Saudi Arabia
9) Canada, and
10) Germany.

a) Which countries require an assignment to be filed with the local patent offices? Which countries also require an inventor's declaration?

4 marks

India, South Africa and USA are the only countries requiring assignments (1 mark each)
USA is the only country to require an inventor's declaration (1)

b) For each country, indicate whether a request for substantive examination must be filed and by when, ignoring any possible extensions of time.

5 marks

Brazil +36m from International filing date (IFD) (0.5);
USA on entry in the national phase (0.5);
India +48m from IFD (0.5);
Japan +36m from IFD (0.5);
China, +36m from IFD (0.5);
Canada +60m from IFD (0.5);
Mexico, not necessary but application will be examined (0.5);
Saudi Arabia +3m from national phase entry (0.5);
Germany, +7years from international filing date (0.5); and
South Africa not necessary since formal examination only (0.5).

A granted European patent, written in English, is about to be validated in the following countries:

1) Germany
2) Italy
3) Poland

4) Netherlands, and
5) Norway

c) In which countries do you need to file a translation, which parts of the patent have to be translated and into what languages? Explicitly state any countries where no translation is required.

5 marks

1) Germany, no translation (1)
2) Italy, full spec in Italian (1)
3) Poland, full spec in Polish (1)
4) Netherlands, only claims in Dutch (1)
5) Norway, only claims in Norwegian (1)

d) State any differences in the answer to c) above, had the patent been written in French.

2 marks

If in French, differences would have been

4) Netherlands, full spec in Dutch or English but claims in Dutch (1 mark for complete answer or 0.5 mark for at least identifying Netherlands)
5) Norway, full spec in Norwegian or English (1 mark for complete answer or 0.5 mark for at least identifying Norway)

Your client has recently acquired an Argentinian machinery company. A first patent application for an invention was filed by this Argentinian company at the Argentinian patent office on 5 November 2015.

e) Quoting any applicable deadlines, outline and justify a suitable strategy to protect the invention in Argentina, Israel, New Zealand, Saudi Arabia and Taiwan, including filing a new PCT application.

4 marks

Argentina is part of the PC, so AR application gives rise to valid right of priority (0.5). Priority year ends 5 November 2016 (0.5). File PCT application claiming priority from AR patent application by deadline (0.5), to cover NZ, SA and IL. This leaves out Taiwan, since TW not contracting state to the PCT (0.5). Taiwan will however recognise right of priority from AR patent application since AR is member of WTO (0.5). So file national application in TW, claiming priority from AR patent application (0.5). Continue with underlying AR application since cannot get AR back from PCT (0.5) application since AR not party to PCT either (0.5).

Total for Question 5: 20 marks

Question 6

PART A

a) Provide an example of prior art or other disclosure citable by the USPTO which would not be citable in prosecution at the EPO.

1 mark

Any correct example will attract a mark, for example:
The English publication of a PCT patent application i) filed earlier but published later than the filing date of the patent application, ii) which did not enter the regional phase in Europe, will be part of the state of the art in US proceedings (irrespective as to whether the US national phase was also entered) but not in EPO proceedings (1).

b) Provide an example of prior art or other disclosure citable by the EPO which would not be citable in prosecution before the USPTO.

1 mark

Any correct example will attract a mark, for example:
The public use or sale of the invention by the applicant within 1 year from the filing of the first application (grace period) (1).

Mr R is first to devise an invention and reduce it to practice. Independently, Mr T later devises the same invention and publishes it. Mr R later files a US patent application US-R for his invention, and subsequently also publishes the invention. Within a year of his own publication, Mr T also files a US patent application, US-T, for his invention.

c) Under the US "first-inventor-to-file" system, who gets a patent for the invention, and why?

2 marks

The correct answer is Mr T (0.5). This is because Mr T's publication counts as fully citable prior art against Mr R's application (0.5); Mr T's publication does not affect Mr T's own application due to the grace period (0.5). Mr R's application and publication do not count against Mr T's application (USC 35 §102(b)(2)(B) and §102(b)(1)(B)) (0.5).

Total for PART A: 4 marks

PART B

Comparing German and Japanese opposition procedures:

a) Who may file an opposition, and can opposition proceedings be instituted anonymously?

2 marks

In Germany any person can file an opposition (but self-opposition is not possible) and only a party that challenges ownership can do so on this ground (0.5). The proceedings can be instituted anonymously, eg straw-man or in the name of an attorney/agent (0.5).

In Japan, any person can file an opposition – even the patentee (but ownership is not a ground for opposition) (0.5). The proceedings cannot be filed anonymously (0.5).

b) What are the grounds for opposition?

4 marks

In Germany: added matter (0.5); sufficiency (0.5); patentability (0.5); and 'unlawful deprivation' of subject matter from inventor (0.5).
In Japan: added matter; enablement and description requirements (i.e. sufficiency); mistakes in the translation; patentability; and, double patenting (mention at least four to get the available 2 marks at 0.5 mark for each correct ground of opposition identified).

c) What is the period for requesting opposition and how is the opposition fee structured?

2 marks

In Germany, the opposition period is nine months from the date of issuance of the patent (0.5). There is a flat opposition fee (0.5).
In Japan, the opposition period is six months from the date of issuance of the patent (0.5). An opposition can be filed against any or all of the claims, and there is a flat fee plus a variable fee dependent on the number of claims opposed (0.5).

Total for PART B: 8 marks

PART C

Indicate whether the quoted subject matter is in principle patentable, stating any applicable caveats:

i) computer programs as such;
ii) business method inventions as such;
iii) plant varieties; and,
iv) gene sequences,

under patent law in each of Brazil, China, the US and Australia.

8 marks

	i)	ii)	iii)	iv)
Brazil	**No**	**No**	**No**	**Yes, if not naturally occurring**
China	**No**	**Yes if they comprise technical features**	**No**	**Yes, if not naturally occurring**
US	**No**	**Yes**	**Yes**	**Yes, if not naturally occurring**
Australia	**Yes**	**Yes**	**Yes**	**Yes**

Each correct answer, 0.5 marks

Total for PART C: 8 marks

Total for Question 6: 20 marks