

**FC3 International Patent Law
Question Paper – Sample Assessment Material**

SECTION A

Question 1

- a) List six facts relating to utility models, at least one of which should relate to a difference between utility models and patents. **3 marks**
- b) Can utility models be obtained in Germany, Israel, Japan, Brazil, India and Canada? **3 marks**
- c) In France, Italy, Spain and Poland, explain whether or not a utility model can be derived from a *PCT* application. **4 marks**

Total: 10 marks

Question 2

Recently, a *PCT* 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) Identify three countries which require a signed document of assignment from the inventor to the applicant to be filed with the local patent office. **3 marks**
- b) Identify one country which requires an inventor's declaration signed by the inventor. **1 mark**
- c) For each country, what is the deadline for requesting substantive examination, if any (ignoring any possible extensions of time)? **5 marks**

Total: 9 marks

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Question 3

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.

a) **For each country, state which parts of the patent have to be translated and into what languages. Explicitly state any countries where no translation is required.**
5 marks

b) **State any differences in the answer to (a) above, had the patent been written in French.**
2 marks

Total: 7 marks

Question 4

A first patent application for an invention was filed by an Argentinian company at the Argentinian patent office on 6 November 2017.

Quoting any applicable deadlines, provide advice to the Argentinian company outlining and justifying a suitable strategy to protect the invention in Argentina, Israel, New Zealand, Saudi Arabia and Taiwan, including filing a new *PCT* application.

4 marks

Question 5

In relation to German and Japanese opposition procedures:

a) Who may file an opposition?
1 mark

b) Can opposition proceedings be instituted anonymously?
1 mark

c) What are the grounds for opposition?
4 marks

d) What is the period for requesting opposition?
1 mark

e) How is the opposition fee structured?
1 mark

Total: 8 marks

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Question 6

For each of USA and Australia, indicate whether the subject matter below is in principle patentable:

- a) computer programs as such;
- b) plant varieties.

2 marks

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Question Paper – Sample Assessment Material**

SECTION B

Question 7

Your client has a *PCT* application filed on 28 April 2017 and claiming an earliest priority date of 2 May 2016. The application is in German and has been searched by the EPO in the international phase. It has 30 claims, including four independent claims and 26 multiple 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.

Draft a memo to your client advising her of:

- a) **the standard deadline for filing regional/national phase applications derived from the *PCT* application in each jurisdiction;** **2 marks**

- b) **any jurisdictions which provide for an as of right late entry; and** **1 mark**

- c) **the length of any extensions in the jurisdictions identified in part (b).** **1 mark**

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.

Draft a memo to your client advising her:

- d) **of the actions you plan to take (do not consider any requirements relating to powers of attorney and certified copies of any priority documents);** **8 marks**

- e) **how the claims fees are calculated for each of the countries; and** **4 marks**

- f) **when these claims fees are payable.** **4 marks**

Total: 20 marks

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Question 8

Your client has filed two *PCT* applications, PCT1 and PCT2, each having an earliest priority date of 2 February 2018.

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 2018.

The search report for PCT1 is partial and only covers the claims directed to FAB, as the claims to FAB and SAB are found to lack unity of invention. 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.

Prepare notes for a meeting with your client in which you:

- a) **explain the procedure to contest the finding of non-unity between FAB and SAB in the international phase, stating any applicable fees (amounts not required) and relevant deadlines; and**
3 marks

- b) **explain the subsequent procedure by the ISA;**
2 marks

- c) **explain the procedure for filing amendments to the claims for PCT1 and PCT2 with regard to *PCT* 'Chapter I', including any relevant deadlines.**
6 marks

- d) **explain whether the amendments in (c) above are published by the International Bureau (IB);**
1 mark

- e) **briefly discuss the *PCT* 'Chapter II' procedure, including any relevant deadlines and fees (amounts not required);**
7 marks

- f) **advise your client whether or not to request Chapter II processing in relation to PCT1 and PCT2.**
1 mark

Total: 20 marks

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Question 9

PART A

Your client has invented a new and inventive procedure (P) to treat severely damaged ligaments in the human body. He has also invented a new and inventive mechanical anchorage system (S) for reconnecting severed ligaments in the human body.

Your client has heard that a *PCT* application provides applicants with international protection. He comes to you today and proposes that you prepare a new patent application disclosing and claiming P and S, and that you first file a *PCT* patent application for the inventions.

Write a memo of advice to your client which includes:

a) an indication, for each of the following four countries, of whether your client can obtain patent protection for P, and why:

- USA
- China
- Australia
- Germany.

4 marks

b) an indication, for each of the four listed countries, of whether your client can obtain patent protection for S, and why; and

2 marks

c) one potential advantage and two disadvantages relating to your client's proposed filing strategy.

3 marks

Total for PART A: 9 marks

Cont...

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PART B

A client company recently acquired the patent portfolio of another company that designs lightweight composite pipes for marine risers. The patent portfolio includes two European patent applications EP1 and EP2.

European patent application EP1 is under examination at the EPO and a communication under Article 94(3) *EPC* was issued dated 13 July 2018. The EPO set a response period of four months. You need time to familiarise yourself with the technology.

The 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.

Write notes for a meeting with the client company explaining:

In relation to EP1:

- a) **by when must a response be filed;** **1 mark**

- b) **what extensions of time are available, if any; and** **2 marks**

- c) **how you can obtain any such extension(s) (include any extended deadlines in your notes (you need not take into account EPO closed days)).** **2 marks**

In relation to EP2:

- d) **what response should be filed to the EPO communication and by when (do not discuss any possible extensions of time); and** **3 marks**

- e) **the procedure through to grant following a response in part (d).** **3 marks**

Total for PART B: 11 marks

Total: 20 marks

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Question 10

Your US patent attorney sent you a Restriction Requirement issued by the US Patent and Trademark Office (USPTO) in relation to US patent application US1 owned by your UK client, Raceway Components Ltd. US1 discloses and claims two independent inventions: a mechanical component for suspensions (MC1), and a motorcycle suspension system (SS2). US1 also discloses, but does not claim, a method of controlling the stability of a motorcycle (MS3).

Write a memo to the UK client explaining:

a) what a Restriction Requirement is; and **2 marks**

b) two options for responding to the Restriction Requirement. **2 marks**

Later in the course of the prosecution of US1, a Final Office Action is issued by the USPTO.

Write a further memo to the UK client which:

c) briefly compares a Final Office Action with a Non-Final Office Action; and **2 marks**

d) gives two options for responding to a Final Office Action. **2 marks**

US1 was amended during prosecution to include only independent claims directed to the mechanical component MC1. The Notice of Allowance has recently issued.

e) Advise your UK client of one situation in which filing a Request for Continued Examination (RCE) after the issue of the Notice of Allowance is beneficial and explain why. **2 marks**

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The USPTO has notified the applicant that a patent will be issued on 27 October 2018. The patent will be granted with claims to MC1 only.

Your client has phoned you earlier today to advise that they have also just invented a new and inventive test rig (TR4) for testing motorcycle suspension systems. The new test rig has similar features to those of the motorcycle suspension system SS2.

Prepare notes of advice for a meeting with your client setting out:

f) a strategy for protecting in the US each of:

- the mechanical component MC1;
- the motorcycle suspension system SS2;
- the method of controlling the stability of a motorcycle MS3; and
- the new test rig TR4.

Make sure you highlight any important deadlines.

4 marks

g) Whether it is possible to obtain protection for TR4 outside the US on the basis of any patent application filed for TR4 in the US.

2 marks

A patent is eventually granted on the basis of MC1.

Write a further memo to the UK client which advises:

h) when annuities are due in the US;

2 marks

i) when they can be paid (with no surcharge); and

1 mark

j) what the grace period is for the payment of annuities (with surcharge). 1 mark

Total: 20 marks