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SECTION A

Question 1

i)

30 months from the priority date (or filing date if no priority claimed).

1 May 2023. ✓1

ii)

12 month as of right extension no longer available.

Must now pay fee, and provide written evidence that the late filing was
 ✓0.5
 ✓1
 unintentional, for filing a Canadian national phase application within 42 months
 from the priority date. (i.e. a 12 month discretionary extension to the 30 month
 deadline). ✓1

MARKS AWARDED: 3.5/4

3.5

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Question 2

The Board of Appeal will consider whether the content of the request is new and substantial, including the new arguments.

Yes, it appears that the request and arguments should be admitted. ✓1

MARKS AWARDED: 1/4

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Question 3

Approve

Within 4 months of notification of communication of the R.71(3), taking account of the 10 day postal rule:

Approve the EDREX (proposed specification for grant).

Pay any outstanding excess claim/page fees.

File translations to the claims in the other two official EPC languages (e.g. German and French if the specification is in English)

Pay the grant fee.

✓1

Disapprove

Within 4 months of notification of communication of the R.71(3), taking account of the 10 day postal rule:

Disapprove the EDREX

Provide supporting arguments for why the previously submitted specification should be allowed for grant, or propose alternative amendments along with supporting arguments.

If the EPO agrees, they will issue another R.71(3) communication, the right to which can be waived by the applicant.

If the EPO disagrees, an Examination Report will issue setting out the objections to the proposed specification.

✓1

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The applicant will then have 4 months from notification of this Examination Report to respond.

Do nothing

Wait for the response period of 4 months + 10 days from issuance of R.71(3) to lapse.

EPO will thereafter issue a notification of loss of rights.

Within two months following such notification:

Request Further Processing and pay the Further Processing fee

✓1

Complete the omitted acts, outlined in the first option above.

Pay a surcharge (+50%) on the grant fee and any excess claim/page fees.

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Question 4

a)

30 months from the priority date of the PCT application. 3 December 2020. ✓1

1

b)

Small entity ✓0.5

Less than 500 employees ✓1

Has not licensed or assigned the application to a non-small entity. ✓1

2.5

The applicant is then eligible for a 50% discount on many of the official fees.

Micro entity ✓

✓1

Meets the requirements for small entity above, plus:

- Income in the year preceding filing was less than three times the median US household income. ✓1
- Has not previously filed more than 3 US patent applications.
- Has not licensed or assigned the application to a non-micro entity.
- Applicant is a not-for-profit or higher education institution, or the patent application has been assigned or exclusively licensed to such an institution.

2

Applicant then eligible for 75% discount on many of the official fees.

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c)

Less than 500 employees, no revenue and has licensed to a not-for-profit.

No previous patent applications in the US.

Therefore, micro-entity status. ✓1

MARKS AWARDED: 6.5/10

6.5

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Question 5

You could apply for a utility model. ✓1

Utility models protect inventions like patents, and are enforceable against third parties like patents.

It is not possible to apply for utility models in as many countries for which patents are available.

Different countries also apply differing rules (e.g. for examination) to utility models.

The term of protection also varies from country to country (e.g. 6 years for a Certificate of Utility in France and 10 years for a Utility Model in China).

They have a shorter term of protection (typically 10 years, versus 20 years for patents).

They tend to be quicker to register.

They are not usually substantively examined, or are examined for novelty only (and would therefore appear to be suitable for your hosepipe attachment which you are doubtful is inventive).

They are also cheaper to register than patents.

They are not available for methods or processes, which is not a problem for your hosepipe attachment (which is a device/apparatus).

Four countries where you could obtain protection:

- Japan ✓1
- Korea ✓1

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- Germany ✓₁
- Mexico ✓₁

MARKS AWARDED: 5/5

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Question 6

i)

Excess claim fees are due for claims 16-51. ✓1

The first tier of excess fees is for claims 16-50. ✓1

The second tier of excess fees is for claim 51. ✓1

ii)

Could amend claims to remove claims relating to inventions B and C, delete claims 16-51 and place subject matter in description. ✓1

However, the EPO may examine multiple independent apparatus claims if they relate to:

- a plurality of interrelated products;
- different uses of an apparatus; or ✓1
- alternative solutions to the same technical problem.

If this is true for inventions A, B and C, then we could delete a number of A's dependent claims and include claims relating to B and C in claims 14 & 15, for example.

However, if the multiple independent claims are unlikely to be allowed, and inventions B and C are removed from the claims, then we may file divisional applications for both B and C before the mention of grant of the parent in the EP Bulletin.

Alternatively, we could file a first divisional application for B before the mention of grant of the parent in the EP Bulletin, and 'chain' the divisional application for C.

3

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iii)

Claim fees are due within 2 months of filing, when the payment and request for search are also due.

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Question 7

A discovery, scientific theory or mathematical method. ✓

A literary, musical, dramatic or artistic work, or any aesthetic creation
whatsoever. ✓1

A scheme, rule or method for playing a game, doing business, performing a
mental act or a program for a computer. ✓1

The presentation of information. ✓ 1

Inventions in the EPC have to be technical in nature, i.e. they have to solve a
technical problem and make a technical contribution over the state of the art.

The above exclusions all relate to matter that is non-technical as such.

Methods of treatment on the human or animal body, whether by therapy or
surgery.

Methods of diagnosis on the human or animal body.

Processes for cloning human beings.

Industrial or commercial use of human embryos.

A process for modifying the genetic germ line of human beings.

All the above where the invention relates to that thing as such.

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Question 8

United States. Application must be filed within 12 month grace period for earliest public disclosure derived from inventor. ✓1

Argentina. Application must be filed within 12 month grace period for earliest public disclosure. ✓1

Australia. Application must be filed within 12 month grace period for earliest public disclosure. ✓1

MARKS AWARDED: 3/3

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Section B

Question 9

a)

Must file an information disclosure statement (IDS). ✓1

Before issuance of the patent, we have a duty of candour to disclose relevant prior art which we are aware of to the USPTO. ✓1

This must be done in writing, directly filed with the USPTO.

Payment of a fee is due, as the notice of allowance has already issued. ✓0.5

The IDS should be filed as soon as possible, within three months of when we became aware of the prior art, and before payment of the issue fee.

IDS should identify the patents.

Provide English translations of at least their abstracts if they are not in English.

If they are US patents, then the patent numbers will suffice.

b)

Azam does not have a duty of candour to the USPTO to notify of prior art he is made aware of after the issuance of the patent. ✓1

However, XX3 is identical and may therefore invalidate his patent if it is submitted by a third party. Should review to see if any amendments can be made to the patent that do not significantly limit its scope of protection, but make it new and non-obvious over XX3.

3.5

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c)

Post Grant Review (PGR) ✓1

Any party (not the patent proprietor) may apply for post grant review within 9 months of the date of issuance or re-issue of the patent. ✓1

It may be done on the following grounds:

- Patentability (novelty and obviousness) (XX3 could be used here).
- Lacking written description ✓1
- Enablement

The USPTO will notify you if a third party applies for PGR, and you will have the opportunity to respond with amendments and/or observations.

There is no requirement for court proceedings to have started for the third party to request PGR.

The third party is made party to the proceedings.

Must show that 'more than likely' claim(s) are invalid. ✓1

After PGR is concluded, the third party is 'estopped' from raising the same issue in subsequent proceedings.

Inter Partes Review (IPR) ✓1

After 9 months from the date of issuance or re-issue of the patent, or after PGR has terminated. ✓1

Any party may apply.

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More restricted grounds: novelty and obviousness alone. ✓1

Also limited to printed publications and patents/applications as citable prior art.

(XX3 is still allowable as it is printed). ✓1

No requirement for court proceedings to have started.

The third party is made party to the proceedings.

Must show that 'reasonably likely' claim(s) invalid.

Must provide reason for new and substantial challenge to validity of claim(s).

After IPR is concluded, the third party is 'estopped' from raising the same issue in subsequent proceedings.

Ex Parte Review (EPR)

A third party may apply at any time after issuance or re-issue of the patent.

Not made party to the proceedings before the USPTO.

Restricted to initial observations only.

Must provide reason for new and substantial challenge to the validity of claim(s).

After EPR is concluded, the third party is 'estopped' from raising the same issue in subsequent proceedings.

In all cases, the USPTO may order that the patent be amended, partially revoke the patent (i.e. limit to certain claims), or fully revoke the patent.

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Question 10

a)

i)

A 6 month grace period is available in Europe for public disclosures made in breach of confidence. ✓1

2

Should file application in Europe by 8 December 2020. ✓1

ii)

12 month grace period in the US for public disclosures derived from inventor (which this was, due to breach of confidence). ✓1

2

Should file application in US by 8 June 2021. ✓1

iii)

China applies an absolute novelty requirement.

Not possible to obtain protection in China if invention has already been publicly disclosed.

0

iv)

12 month grace period for public disclosures of invention. ✓1

2

File application in Australia by 8 June 2021. ✓1

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b)

i)

Product would have had to have been launched at a recognised exhibition to not count as prior art. Therefore, it appears a patent application would not be possible in Europe as the earlier product launch would count as prior art against the application. ✓1

ii)

Public disclosure can be made if derived from inventor, within 12 months of filing application. So can still file US application, as the product launch would not count as prior art against the application. ✓1

iii)

Still absolute novelty in China, so still no patent application possible, as earlier product launch would count as prior art against the application. ✓1

iv)

Grace period for public disclosure, so may still apply for patent application within 12 months of disclosure. Product launch would not count as prior art. ✓1

c)

India. ✓1

4

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Question 12

Leash

File a PCT application in English. ✓1

File description, claims and abstract.

Identify the applicant and indicate that an international application is sought.

File with the USPTO as Receiving Office (cheaper than IB(WIPO)).

Filing fee, transmittal fee and search fee should be paid within 1 month of filing, otherwise IB(WIPO) will issue a notification that the fees are unpaid, also requiring a surcharge (which will be more expensive).

No further fees are due during the international phase, if a Chapter II Demand is not made (i.e. there you do not require International Examination).

Next fees that will be due are:

National filing fees for US and China are due at 30 months from priority. ✓1

National filing fees for Europe and Australia are due at 31 months from priority.

Utility models (which tend to be cheaper than patents) are available in Australia and China, and can also be nationally filed from the PCT. ✓1 ✓0.5

4

Bonearang

First file a provisional US application in English. No claims required, only subject matter of invention as a description. ✓1

1

Only a minimal filing fee is due.

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A provisional application allows you to disclose subject matter and obtain a valid priority date.

It will not be possible to protect the invention with the provisional application, but it allows for an inexpensive way of gaining a priority date.

Within 12 months of US provisional application filing date, file European application claiming priority. ✓¹

On filing European application, pay filing fee and pay and request search within 2 months of filing.

Claims should be kept to no more than 15 to avoid excess claim fees.

Could not pay any fees on European filing, and wait for notification of loss of rights. ✓¹ This may take at least a month to issue, in which case the further processing fee and other fees would not be due until after 15 months from priority.

A Europe-wide utility model is not available, although utility models are available in some contracting states (e.g. Germany), and are cheaper than patents.

Also file US utility patent ✓¹ within 12 months claiming priority from provisional US application. (Could 'convert' provisional, but this is more expensive and you would have a shorter term of protection in the US).

Ensure that there are:

- maximum three independent claims;
- maximum 20 claims total; and
- no multiple dependencies.

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In order to minimise claim fees payable with request for search and examination.

Search and examination fees are due on filing, or shortly after if not paid on filing, in response to an invitation from the USPTO. ✓1

1

Tooth sharpener

✓1

First file US utility patent in English. Not worth first filing a provisional application, as the fees due for the utility patent would still be due within 15 months.

Search and examination fees are due on filing, or shortly after if not paid on filing, in response to an invitation from the USPTO.

Ensure that there are:

- maximum three independent claims;
- maximum 20 claims total; and
- no multiple dependencies.

In order to minimise claim fees payable with request for search and examination.

1

Utility models not available in the US.

MARKS AWARDED: 10/20

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