Paper Ref	Sheet	Percentage Mark Awarded
FC3	1 of 17	56%

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Question 1

(i) The Canadian deadline for national phase is 30 months from filing, i.e. 1 May 2023. ✓0.5 ✓0.5

1

(ii) Canada previously had an extension of up to 42 months from priority (in this case filing) as of right, with payment of fee however, this is no longer available. Therefore for late entry into national phase in Canada, the applicant will be required to apply for reinstatement of rights if longer up to 6 months after the deadline, with the requirement of all due care and payment of a fee. ✓0.5

0.5

MARKS AWARDED: 1.5/4

1.5

Page sub-total

1.5

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Question 2

The Board of appeal will hear decisions concerning the refusal of an EP application. This is final as of right. The board of appeal only reviews the decision of the case. However, the board will be inclined to admit new evidence if it is within the remit of the case. This may not be the case with the auxiliary amendments if they are too different than the amendments provided before. The appeal may not introduce new documents/additional evidence, ✓1 but if the arguments are within the scope of the appeal, then they may do so. ✓1 In this scenario, they should file arguments, but whether or not the board will accept the auxillary amendments are at its' own discretion and should be proceeded with caution.

2

2

MARKS AWARDED: 2/4

Page sub-total

2

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Question 3

In response to the R.71(3) communication the, proprietor has the option to:

(1) Approve the text communicated in the R71(3) communication and file French and German translation of the claims and pay the grant fee (assuming that the patent is written in English). ✓1

(2) They can reject the grant text provided by the EPO and provide a new body of text, requesting that this forms the basis of the granted text. ✓1

(3) Do nothing. This would result in a loss of rights, which will be issued to the proprietor. They can request further processing within 2 months of this issuance and when requesting, pay the issue fee and a penalty fee.

(This is assuming that no excess claims fees are due, in which case, these will also have to be paid in response to the R71(3)). ✓1

MARKS AWARDED: 3/3

3

Page sub-total

3

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Question 4

(a) The deadline for filing in the US is 30 months from earliest priority date, i.e.3 June 2020. ✓0.5 0.5

(b) There are two entity status available at the USTPO to get discounted fees. These are either small entity or micro entity. ✓0.5

Small Entity status is available for independent individuals or lone inventors who are seeking patent protection. Non-profit organisations, charities and businesses with fewer than 500 employees also qualify for small entity protection. However, in order to qualify for protection, it must not be under no legal obligation, by licence or assignment, to give/licence the patent to a company that does not meet the requirements, or is a place of higher education, such as a university. If they successfully meet the requirements, they receive discounted fees from the USTPO. ✓0.5 ✓1 ✓0.5 3.5

In contrast, to be eligible for micro-entity status, the company must first and foremost satisfy the criteria for being a small entity company. However, to be eligible for microentity status, the company needs to meet further requirements - it must not be named on more than 4 previous patent applications and it should have a revenue that is greater than the median revenue in the standard household in the USA in the preceding year. It should also not be under any obligation to licence the patent out to a company or organisation that does not meet the micro-entity status requirements, which includes universities and other areas of higher education. Micro entity status has greater discounted fees available at the USTPO in comparison to the small entity. ✓1 ✓1 ✓1 3

Page sub-total 7

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(c) As the company is 'pre-revenue generating', it is unlikely to meet the money requirements for a micro-entity, therefore the client is a small entity status.

MARKS AWARDED: 7/10

7

Page sub-total

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Question 5

(a) Yes, Ms Jones could apply for protection by use of a Utility Model. ✓1 Utility models generally have a lower standard of inventiveness required – some only require novelty, while others may need to show an innovative step as opposed to a fully inventive step. These typically do not undergo substantive examination and are often purely registration processes. Because of this, these typically are registered much quicker than patents, but have a shorter term of protection.

Can be sought in China ✓1, Germany ✓1, Hong Kong ✓1 and Japan ✓1.

MARKS AWARDED: 5/5

5

Page sub-total

5

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Question 6

(i) The claims fees payable would be:

claims 1-15 would not incur excess claim fees ✓1. However, the remaining 36 claims would incur excess claims fees. There are two tiers of claims fees available – for this claim set, claims 16-50 ✓1 would be on the lower tier of claims fees, while claim 51 would incur the higher tier of fees. ✓1 3

(ii) European patent applications are only allowed to relate to one inventive concept. There are three inventive concepts in this one application, so they will need to be split into three separate applications through divisionals ✓1. Furthermore, only one independent claim in each category is allowed in a European patent application ✓1, unless it meets the exceptions (i.e. interrelated product, different uses, alternate solutions to a problem). Therefore, the best way to eliminate such claims fees is to file divisional applications for Invention B (which will have 19 claims) and then another for invention C (which will have 15 claims). In order to reduce the claims fees for invention B, the claims will have to be reconstructed by either adding subject matter together for specific embodiments, or removing claims that are not essential, or providing alternatives for features. 2

(iii) Excess claims fees are payable within one month of filing. ✓1 1

MARKS AWARDED: 6/7

6

Page sub-total 6

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Question 7

Article 52(1) lists the exclusions for patentability for an EPC patent. These include:

(1) discoveries, scientific methods, mathematical methods, ✓1

(2) any musical, literary, artistic or aesthetic creation, ✓1

(3) method of doing a scheme, rule, performing a mental act, playing games, doing business and computer programs, ✓1

(4) presentation of information, as such. ✓1

Anything that is contrary to public policy or accepted principles or morality.

4

MARKS AWARDED: 4/4

Page sub-total

4

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Question 8

As they have sold the undergarments, this is a prior disclosure that has originated from the inventor. This does not appear to be an abusive disclosure. The application also relates to human bodies – it provides stimulation to the stomach and to the gluteus maximus, which may be used for diagnostic or methods of treatment (we are not told the technical use of the undergarments).

Protection could be gained in:

Australia – within 12 months. ✓1

Canada – 12 months ✓1

USA – 12 months ✓1

MARKS AWARDED: 3/3

3

Page sub-total

3

Question 9

(a) There is a requirement for US patent prosecution for the legal representatives and the applicants to act with a duty of candor to the USTPO ✓1. This means, that they must disclose anything that is potentially prejudicial to the patentability of the invention as soon as they become aware ✓1 of it. Failure to do so may result in the patent application becoming invalidated. In this scenario, Azam has just become aware of highly relevant documents to the patentability of the application yesterday. The issue fees have not been paid, but the notice of allowance have been issued. In this scenario, the US attorney must pay a ✓1 fee and provide a certificate to the USTPO and file an updated ✓1 IDS providing these two documents. The certification will state that anyone involved in the case (either in the US or in corresponding applications) did not become aware of the two published patents, XX1 and XX2 more than 3 months prior to filing the new IDS. This certification can state that it was identified by a foreign patent office for a counter application no more than 3 months prior, or that it no one involved in the case knew about it more than 3 months prior. In this scenario, it would be the latter: that no-one involved in the case knew about these documents prior.

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(b) The magazine publication must be assessed to see whether it counts as valid prior art, i.e. if it is an enabling disclosure of the invention. If the magazine is capable of teaching the skilled person how to create the claimed propulsion system, then it needs to be brought to the attention of the USTPO. However, if it does not qualify as an enabling disclosure, then there is no need to alert the USTPO of it, as it is not prejudicial to the patentability of the application. Especially as the issue fees have been paid, there is no simple provision to

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submit new documents to the USTPO (e.g. through RCE/QPIDS) unless the application is re-issued, which places the patent application back into examination and the scope of the claim is made narrower if possible.

0

(c) Post grant of a US patent application, there are is a 9 month ✓1 period in which a competitor may bring opposition proceedings against Azam's patent (i.e. until 18 July 2020) In this 9 month period, a third party can request a 'post-grant ✓1 review' (which is equivalent to the EPO's opposition procedure) on his patent. They may use any published ✓1 document (in which case, XX3, can be used) to oppose his patent on the grounds of lack of ✓0.5 novelty. His patent can also be attacked on grounds of sufficiency, enablement, double patenting, ✓0.5 obviousness and the opposing party may use any type of evidence to bring their arguments. In this case, the magazine XX3 can be used. However, the USTPO will only consider a PGR to be admissible in the event that there is a successful chance of the opposition being valid, or if the challenged claim is likely to be ✓1 invalidated. This depends entirely on the disclosure made in XX3 and how impactful it could potentially be.

5

After the 9 month period has expired, the application may be subject to an inter-partes ✓1 review, in which the client may become party to the proceedings and files a petition to the USPTO. However, this can only be brought on the issues of patentability of ✓0.5 novelty and ✓0.5 inventive step, and can only be brought using patent applications. Therefore, in this case, the magazine cannot be used to validly attack US1 after the 9 month period has ✓1 expired. This will only be counted as being admissible if there is a likelihood that there is success against the challenged claims.

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Page sub-total

8

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In either case, USTPO may maintain the patent as it was issued, in an amended form or completely invalidate the patent.

MARKS AWARDED: 12/20

Page sub-total 0

Question 10

(a) Frytech had conversations with VC Futures on 8 June 2020, under a NDA agreement. This is a conversation, where the inventor (Frytech Ltd) disclosed their invention in a circumstance of confidence to a third party. The NDA was directed to the members of the board of VC futures, of which, one (the CFO) has moved across to a new company, Triple Fry LLC. In this scenario, there appears to be a breach of confidence by Triple Fry LLC.

As these have been consequence to an abusive disclosure, it appears that separate applications will need to be filed in order to gain patent protection.

(i) Europe

Under European law, abusive disclosures which are made in breach of confidence to the inventor/someone who was under confidence (with an obligation of keeping informational confidential) provides a grace period of 6 months to file the patent application. ✓1 Therefore, as the CFO of FryTech has acted in breach of confidence, this would qualify as a non-prejudicial disclosure and FryTech needs to file their application by the 8 December 2020 ✓1 to qualify for protection. To establish a filing date they need to provide:

2

(i) An indication that a patent is ought

(ii) Information identifying the applicant and

(iii) A description of the invention.

As we are based in the UK, as representatives, can act for them when filing a European patent application. To minimise fees, will need to keep the claims below 15.

Page sub-total

2

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(ii) USA

Frytech is still capable of gaining patent protection in USA, as the disclosure was derived from the inventor. Under US law, this prejudicial disclosure of the invention still provides on year grace period for FryTech, i.e. they have until 8 June 2021 to file their application. ✓1 They should file their application and claim priority back to the EP application, but within the 1 year grace period. ✓1

Excess claim fees are due for claims >20 and any more than 3 independent claims. 2

(iii) China

China has a provision for abusive disclosures, but they need to ensure that it is filed within 6 months, ✓1 i.e. 8 December 2020. However, to establish a filing date in China, they will be required to appoint a Chinese agent, and file the application in Chinese. ✓1 This should be done ASAP, and fees, such as filing, publication are due on filing, so it will be costly. They should claim priority back to the EP filing. 2

Excess claim fees are due when claims are over 10, so will need to minimise to avoid paying excess fees.

(iv) Australia

Australia also has provision for abusive disclosures, and provides a 12 month grace period to file an application. ✓1 They have until 8 June 2021 to file the application, ✓1 and to claim priority to the EP application. They will need to appoint an Australian agent with an address of service in order to validly file an application. Excess claim fees are due when claims are over 20, so will need to make sure that these are kept down to minimise costs. 2

(b) Yes, in the case that Frytech had applied for patent protection prior to the

Page sub-total 6

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abusive disclosure, they would be inclined to minimise costs (as indicated by their intention to wait for investment before proceeding). In this scenario, I would have recommended either filing a GB application, and filing a PCT within the year that claims priority from that original application. If it can be claimed from GB, it can be allowed to lapse while still validly claiming priority. The PCT system would then allow them to defer costs while still trying to navigate which markets may be of interest to them. Then, they could enter the territories that interested them.

e.g. EP – 31 month entry

USA - 30 month entry

Australia – 31 months entry and

China is 30 months entry.

This would not only help delay costs for the procedure but would also establish an earlier filing date. The original GB application could also provide an indication of what prior art existed prior to filing the application so as to indicate how the patent may need to be amended.

0

(c) Grace period at exhibit: Japan. ✓1

1

MARKS AWARDED: 9/20

9

Page sub-total

1

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Question 11

(a) In order for the priority claim to be valid, Alpha Therapeutics will need to file a full patent application in the US, either on or before 2rd December 2020. This is because a provisional application cannot be granted. The full application needs a claim set that covers the subject matter that was disclosed in the provisional application. As the provisional application was filed originally by the inventors and not by Alpha, in order for the priority claim to not be invalidated, the provisional application will need to be assigned to Alpha prior to Alpha filing the new patent application in the US. Assuming that the priority claim will be from a newly filed PCT that claims priority from the US application, the PCT applicant needs to be entitled to file at the competent receiving office, in the designated language that has been prescribed by the competent receiving office. There needs to be an indication that an international patent is sought, as well as information identifying the applicant and some description of some sort and at least one claim. In order for the priority claim to be identified by the EPO, assuming that the priority claim will be based on the US application but entry into the EP national phase will be from the PCT filing, they will need to file certified copy of the priority application from 16 months of priority. They will need to ensure that the name on the original provisional application and the US patent filing are the same (i.e. both now are Alpha).

0

(b) The searching authority that can be determined by the USA as a competent RO are either:

✓1 ✓1

USA, Australia or New Zealand.

2

Page sub-total

2

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(c) No, the PCT application has be filed at the competent receiving office, i.e. where the applicant is entitled to file. This is either determined by the place of business of the applicant or the nationality of the applicant. As they are a European subsidiary, they may only file the application at either the EPO or directly to the IB itself, before 4 December 2020 to claim priority. 0

✓0.5

(d) They should file all their arguments and in the best case scenario of winning, as well as any auxiliary request as there is a chance of the decision being made without proceeding to oral proceedings (and made purely on written submissions). After the deadline of written submissions, no more new evidence may be permitted in to proceedings unless for exceptional circumstances. ✓1 1.5

(e) Only provide auxiliary amendments to be allowable before the Board of Appeal.

Can simply indicate that they will attend the hearing (i.e. provide no written submissions). 0

Concede the patent to revocation.

MARKS AWARDED: 3.5/20

3.5

Page sub-total 1.5