

Examiner's
use only**Question 1**

The application must be filed in English or a translation should be supplied.

The deadline for requesting an Examination is 5 years from filing. – 4 May 2023. ✓1

Examination report will be issued with a deadline for filing a response, in Australia patent applications are substantively examined for novelty and inventive step.

Business methods, methods of treatment, computer programs and plant varieties are considered patentable subject matter in Australia.

Once intent to grant is issued, period of 3 months to file a divisional and pay fee.

The deadline for getting the application in order to grant is 12 months from the first exam report. ✓1

Patents of addition can be filed to cover non-inventive improvements/changes to a patent.

Claims fees are payable for over 20 claims at time of requesting Exam.

There is no post-grant opposition procedure in Australia.

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MARKS AWARDED 2/5

Question 2

a) The standard deadline for responding to a US non-final office action is a total of 6 months. An initial shortened period of three months is set to respond without paying a fee and response within the subsequent three months ✓0.5 incurs a fee. ✓0.5

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b) Any continuation or continuation-in-part applications should be filed when the application is still pending. Issue fee ✓1 should be paid within 3 months. ✓0.5

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c) In the US there is an ongoing duty of disclosure ✓1 for pending applications, an IDS ✓1 disclosing the prior art should be filed ✓1 within

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3months of discovering the prior art along with a statement that the applicant was only made aware of the prior art within the past 3months. No fee is payable in this scenario. If the IDS is filed after 3months of being aware of the prior art, the IDS must be filed with a fee. IDS should be filed with copies of the cited documents, if not in English a patent family member in English may be supplied or if not available, a translation.

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MARKS AWARDED 6/8

Question 3

- a) The deadline for filing a Chapter II demand for International Preliminary Examination is the later ✓ of 22 months ✓ from priority and 3 months ✓ from the date of transmittal of the International Search Report + Written Opinion. 22 months from priority is 8 Decmeber 2019 ✓
3 months from date of transmittal of ISR/WO is 6 December ✓ 2019 so the deadline for filing a Chapter II demand is 8 December 2019. ✓
- b) At the UKIPO as they are recieving office, EPO as they will be ISA/IEA or 1B.
- c) When filing a demand for Chapter II IPE, amendments can be filed by the deadline for demanding Chapter II exam, 22 months from earliest priority date or 3 months from date of transmittal of the ISR/WO. Amendments can be made to the description, drawings and claims provided ✓1 they have basis in the application as filed and do not add matter. Amendments can be filed voluntarily until the International Preliminary Report on Patentability is issued, but to be considered by IPEA, they must be filed with 1 ✓1 month of the deadline for filing a Chapter II demand.

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MARKS AWARDED 5/8

Question 4

Renewal fees are due with respect to European Patent Applications from the third year of filing and fall to the end of the month. The third year renewal fee would have fallen due 31st January 2018 and the forth on 31st January 2019, the fifth on 31st January 2020.

The 71(3) communication sets a deadline of responding for 4 months. The deadline to respond by filing translations of claims, issue + print fee + excess

claims/pages fees is 7 August 2019 + 10 days – 17th August 2019 + 4 months 17th December 2019. ✓1 After this, publication of notice of grant will issue which will set a 3month deadline to validate the patent in the EPC member states.

In order to reduce renewal costs in 2020, ✓1 the central EPO renewal fee should be paid prior to validation. The client should wait to respond to the 71(3) communication to delay grant from publishing . This would mean the European renewal fee would fall due before validation and preventing the need to pay renewal fees in each individual member state in 2020. It should be noted that in future, once validation occurs, renewal fees will be payable to the national offices.

Optionally, the response to 71(3) communication can be filing amendments for the text intended for grant, if these are acceptable a ✓1 further 71(3) communication will be issued setting another 4 months to respond, this can also be done if there are any problems with the text, or if the client wishes to amend.

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MARKS AWARDED 3/4**Question 5**

The deadline for correcting a priority claim in the international phase is the later of 16 months from priority (24th December ✓1 2019) and 4 months from filing (23rd December 2019) ✓1 therefore the deadline is 24th December 2019. This is may be a closed day, depending on the recieving office and therefore the deadline may roll to the next open day.

As GB1 was withdrawn with no rights outstanding before the date of filing the PCT application, this priority claim is invalid. A written request should be filed along with a fee identifying the error and providing the details of the correct priority document. The deadlines for the application will be recalculated from the new priority date (24 August 2018)

Priority claims can also be corrected during the national phase and will be re-examined by national patent offices according to national law.

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MARKS AWARDED 2/5

Question 6

The deadline for filing examination requests are as follows:

Japan	– 36 months from International filing date = 4 April 2021 (4 April 2018 + 36 months) ✓	1
India	– 48 months from International filing date = 4 April 2022 (4 April 2018 + 48 months)	0
China	– 36 months from International filing date = 4 April 2021 (4 April 2018 + 36 months)	0
South Korea	– 60 months from International filing date = 4 April 2023 (4 April 2018 + 60 months) ✓	1
Europe	– the deadline is 6 months after date of publication of search report. Add 10 days to date of transmittal of search report – date notification deemed received and add 6 months to that date for the deadline.	0
Brazil	– 36 months from International filing date ✓ = 4 April 2021 (4 April 2018 + 36 mo).	1

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MARKS AWARDED 3/6

Question 7

The minimum requirements for obtaining a filing date at the European Patent Office are : indication that a European patent is sought ; ✓ some description of the ✓ invention or a reference to an earlier filed Application and identification of the Applicant or a means of contacting them ✓ .

The EPO will write to the Applicant informing them of any deficiencies and give 2 months from the date of receipt of that notification to file any missing parts. ✓

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MARKS AWARDED 4/4

Question 8

Family 1 is a granted US patent, in the US renewal fees fall due 3.5 years ✓ , 7.5 years and 11.5 years from grant date. US1 granted 14th July 2016 and therefore the 3.5 year renewal date is 14th January 2020 ✓ . Renewal fees can be paid 6 months before the renewal date i.e. from 14 July 2019 until the due

date (14th January 2020) with no additional fee. Renewal fees can be paid in the 6 months following ✓ due date i.e. 14th July 2020 with the payment of an additional late fee. ✓

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Family 2 is a pending GB application filed on 25 August 2018, the deadline for claiming priority from this application is 25 August 2019 ✓1 and this deadline has ✓1 expired. A request for restoration of ✓1 priority can be filed with a PCT application upto 2months after the missed deadline i.e. 25 October 2019. ✓1 A request for restoration of priority should be filed in advance of this deadline along with the PCT application. Evidence should also be filed demonstrating that the deadline was missed unintentionally. The death of the previous MD + recent assignment should suffice. However, it is important to note that the restoration of priority will be assessed in the national phase and some territories such as China may not accept the restoration. ✓1 The filing + transmittal + search fees should be paid within 1month of filing and the priority documents filed within 4 months of filing.

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The deadline for completing the GB app was also 12 months from filing i.e. 25 August 2019 so should check the correct actions have been taken : claims, abstract, search request + search fee. If not, request 2mo. extension on PF52 + pay fee + complete missing action at same time

In family 3, the pending German application may have renewal fees due. Renewals are due each year from the third year of filing for German Patents + Patent applications. First renewal falls due 4 June 2020.

The 30 month from priority deadline for entering the national phase is approaching on 4 December 2019 ✓0.5 for Canada, China and the US. ✓0.5 The deadline can be extended by 12 months in Canada ✓1 with payment of a fee, 2 months in China ✓1 with payment of a fee and it can't be extended in the US. Translations will be due on filing in China (Chinese)and US (English) + Canada (French or English). An assignment, inventor declaration and power of attorney are also due on National Phase Entry in the US as well as filing an Examination request.

The deadline for regional phase entry in Europe is 31months from priority – 4 January 2020. ✓1 This can be extended by 2 months with afee. The filing and search fee will be due 1month from filing. No translation is required as German is an official EPO language.

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For all patents and patent applications, assignment should be recorded on the national registers within 6 months of assignment. Also take steps to record ourselves as agents.

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MARKS AWARDED 11/20

Question 10

- a) File a complete utility patent application ✓1 by 14 November 2019 ✓1 claiming priority to US1, including claims. ✓1 Rights can only be enforced if a patent is granted. ✓1 Send a copy of US1 to potential infringers to put them on notice and prevent a good faith defense being used in future infringement proceedings. Request examination of US patent application and respond to all official communications promptly to expedite prosecution. Make sure claims have basis in ✓1 the description of US1. Request early publication.
- b) Accelerated examination of EP patents is possible at the EPO through the PACE scheme. ✓1 PACE can only be accepted once the application is with the Examining Division and as search has not yet been issued, it is not yet with the Examining Division. Once search report has published, sets a 6 month deadline for requesting examination. Once with Examining Division, PACE can be requested. ✓0.5 When requesting PACE, you must give a reason for wishing to Expedite prosecution. Stating that accelerated prosecution to achieve grant for investment is likely to be seen as a suitable reason for accelerating. Once approved for PACE, the EPO will issue their subsequent communication within 3 months. ✓1 The EPO will then respond to any responses filed by the applicant within 3 months ✓1 of receipt. If a deadline extension ✓1 is requested on a PACE application, the application will be removed from PACE and will go back to normal ✓1 examination.
- Can write to EPO requesting an estimate of when the next communication will be issued.
- c) US1 discloses 2–5.5% however as it has not yet been published, it is not prior art. ✓1 In Europe, prior art documents filed before but published after the filing date are prior art for novelty only ✓1 if they validly enter Europe. The purpose of this is to prevent double patenting. If US1 was to serve as the basis for a future EP application then that EP application

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would be prejudicial to the novelty of EP3. Since EP2 discloses a different percentage 2–4.5% and it is relevant only for the novelty of EP3, it will not affect the patentability of EP3 as novelty is an absolute test in Europe. ✓1

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MARKS AWARDED 12.5/20

Question 11

- a) The UK has foreign filing restrictions for UK residents filing patent applications related to military technology and inventions likely to affect public safety or public order. Patent applications relating to these subject matters should be first filed in the UK or ✓1 foreign filing permission should be sought ✓1 in advance of filing. As the assault rifle clearly relates to military technology, it should either be filed in the UK for a period of 6 weeks ✓1 before it's filed in the US or permission should be sought before filing in the US. The penalties for contravening these restrictions are up to £1000 fine and/or 2 years imprisonment. As the Company is registered in the UK, these restrictions apply. Can only be first filed in US if permission is given from UK in advance.
- b) The US states that inventions made in the US should first be filed in the US. If there is risk that it may be military technology, as Company is registered in the UK, should seek permission from UK IPO to first file in the ✓1 US. Germany also has foreign filing restrictions for applications containing state secrets however that does not seem relevant here so requesting permission from UKIPO (if Secondary Business is resident in UK) to first file in the US appears most appropriate. To keep costs to a minimum, within 12 months of first filing in the US, a PCT application should be filed ✓1 claiming priority from the US application. As Argentina + Taiwan ✓1 are likely to be important markets and are not contracting states to the PCT, ✓1 protection should also be sought in these states. Within 12 months of filing the US application, priority claiming applications should be filed directly in Taiwan + Argentina via the national route, these could be patent or utility model applications since both are available. Filing a PCT application at 12 months instead of filing national applications allows costs and decisions to be postponed until the national phase which begins 30 months from priority. ✓1

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As the relevant territories for protection are : South Africa, Argentina, Taiwan, India, New Zealand, Germany, USA and Brazil, the remaining countries can be protected via PCT route. ✓3

South Africa, India, New Zealand and EPO deadline for entering the national/regional phase is 31 months from priority. ✓0.5

Germany can be protected via EPC ✓0.5 and subsequent validation or it can be entered directly 30 months from priority. Either patent or utility model protection can be pursued from the PCT in Germany. Patent will offer stronger protection against potential infringers but will be slower to grant than a utility model.

Brazil national phase can be entered upto 30 months from priority through the PCT route and either patent or utility model protection can be pursued. As there is a potential infringement issue, directly filing a utility model application through the national route claiming priority from the US application may be a better alternative to obtain granted rights sooner which can be enforced. ✓1

- c) Patents are only examined for formal requirements ✓1 in South Africa, there is no substantive examination. No ✓1 examination request is required as a result and patent applications are examined automatically for formal requirements only. If they meet formal requirements, the patent is granted.

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MARKS AWARDED 15/20

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