

Examiner's  
use only**Question 1**

- can defer examination for up to 5 years from filing date (4 May 2023) i.e. can request exam as late as 4 May 2023 ✓1
- may be requisitioned to request exam earlier by Australian patent office ✓1
- renewals not due until 5 years from filing 4 May 2023
- can convert to (utility model) innovation patent which is not examined and a lower standard for inventiveness (innovative not inventive) – must certified if not to enforce – innovation patent has 8 year term
- claim fee for every claim over 20
- business methods and computer programs are patentable
- 12 month grace period for inventor's own disclosure (i.e. inventor's disclosure between 4 May 2017 & 4 May 2018 not a bar to patentability)
- absolute novelty requirement
- you have 1 year after 1<sup>st</sup> exam report to put application into condition for allowance ✓1 (i.e. 1<sup>st</sup> exam report on 1 July 2020 – must be accepted by 1 July 2021) – can file divisional if not accepted by then
- may apply for extension of acceptance period
- as many exam reports as needed during 1 year ✓1 period
- local search and examination
- app must be filed in English
- patent has 20 year term (from filing date)
- omnibus claims are allowed
- multiply dependent claims are allowed
- no requirement to submit power of attorney

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- formal and substantive exam – has inventive step / obviousness as part of examination (unlike France, but this is likely to change in 2020 for France)

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MARKS AWARDED 4/5

**Question 2**

## a) USI NFOA 2 October 2019

- standard deadline is 3 months from issuance of Na. Final Office Adition (2 Oct 2019 + 3 months = 2 Jan 2020) ✓1
- can extend by up to 3 months (2 April 2020) 1 ✓1 month at a time
- do not need to request before hand simply pay additional 1 month /2 month /3 month extension fee when filing response
- extension fee are escalating (ie. 3month fee > 2 month ✓1 fee → 1 month fee)
- respond with arguments with or without amendments to claims, description and/or drawings
- can also respond after this deadline by filing petition for reinstatement, paying fee, paying extension & submitting response

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## b) Notice of Allowance (NOA) 9 Sep 2019

- pay grant fee – 4 months from NOA 9 Jan 2020
- file any continuations (or continuation-in part) applications if they are desired (before issuance of US2, but good practice to do w/ payment of grant fee so patent does not issue & miss chance)
- file any assignment & identify assignee on grant fee payment form (actually part of NOA) to ensure patent issues in the name of assignee.
- file any divisionals if had restriction during prosecution

- c) file an Information Disclosure Statement (IDS) within 3 months of discovery of prior art (e.g. if discovered on 3 Oct 2019 [after US1 OA] submit by 3 Jan 2020) along with statement that only became aware within last 3 months
- identify prior art on IDS

- do not need include copy of prior art if U.S. utility patent or patent application/or design patent
- need to provide copy of non-patent references in whole (& translation if applicable)
- need to provide translation of abstract of foreign patent or patent app if they are in a language other than English
- need to file prior **✓1** art in IDS **✓** to meet your duty of candour at the US PTO**✓**
- if filing outside 3 month time frame, e.g. after 3 January 2020 if made aware of prior art on 3 Oct 2019, then will have to pay a fee when submitting IDS

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**MARKS AWARDED 6/8**

**Question 3**



- a) Later **✓** of 22 months from **✓** the priority filing date ( 8 Feb 2018 + 22 months = 8 December **✓** 2019 and 3 months from issuance **✓** of the International Search Report (ISR) ( 6 Sep 2019 + 3 months = 6 Dec 2019 **✓** ) so last possible deadline to request Chapter II is 8 December **✓** 2019
- b) Chapter II demand may be filed at the UKIPO, the International Bureau (IB) or the EPO as the **✓1** ISA and IPEA (International Preliminary Exam Authority) **✓1**
- c) May amend the claims and/or description under Article 34 of the PCT **✓1**
  - time limit is the same as Chapter II request – later of 22 months from priority & 3 months from issuance of ISR (8 December 2019)
  - can also amend to correct obvious errors up to 26 months from priority ( 8 Feb 2018 + 26 months = 8 April 2020)
  - can file with Chapter II request or seperately, but must be before 8 Dec 2019 for Article 34 amendments

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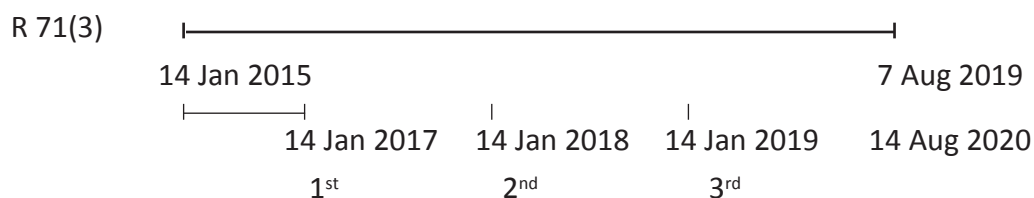
- can include comments on amendments & art, but there is a word limit (500 words)
- cannot amend to add matter not supported by application as originally filed
- may get further response from IPEA and further opportunity to respond with arguments

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**MARKS AWARDED 7/8**

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**Question 4**



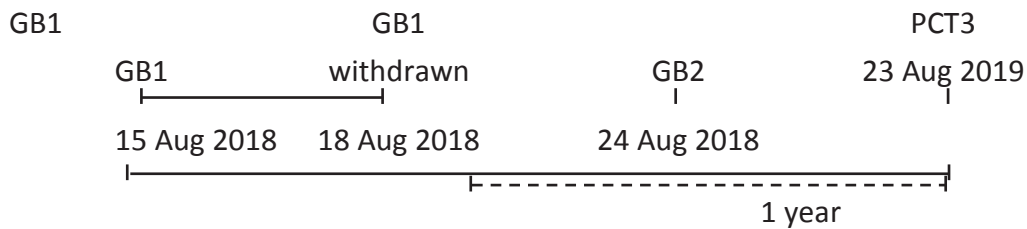
- generally have 4 months to respond with acceptance of 71(3) [Drückexemplar text] & translation of claims into 2 other EPC languages; i.e 2 of English, French & German – may also not accept & suggest alternate, may reenter prosecution if not accepted by Examiner
- this deadline is 7 December 2019 (7 Aug + 4 months) ✓0.5
- however, next renewal is 14 Jan 2020 which can be paid 3 months before (3<sup>rd</sup> renewal period paid 6 months before, all others 3 months before)
- so could pay renewal up to 3 months before 14 Jan 2020 (14 October 2019)
- so pay renewal fee at the same time accepting 71(3) ( assuming drückexemplar text is acceptable) & giving claim translations – allow pay any excess claim fee (for fees over 15 not paid or over amount of claim fees already paid if increased during exam) & excess pages fees (>35 pages if not paid or if greater than fee previously paid)
- then will not have to pay renewals in each member state of the EPC in which you validated in 2020. (may become due afterwards, e.g. 2021)
- so pay renewal & accept drück emplar of 71(3) on 18 October 2019 (after 14 October 2019) to cover 4<sup>th</sup> renewal due 14 January 2020

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**MARKS AWARDED 0.5/4**

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**Question 5**

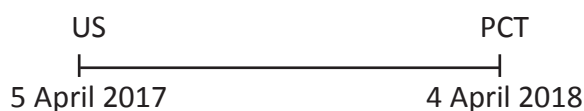


- first PCT3 can validly claim priority to GB2 because with 1 year of PCT3 filing (23 Aug 2018)
- also GB2 can be considered 1<sup>st</sup> app b/c filed in same country as GB1 (UK) & GB1 was unambiguously withdrawn leaving no rights outstanding, without forming the basis of a priority claim, and without being published (assume GB1 not used for other priority claim) before GB2 filed.
- to correct declaration of priority on PCT3 have up to 16 months from priority which is 15 Aug 2018 (GB1) so 15 Feb 2020 ✓1
- can file request at IB (International Bureau)
- note PCT3 filed within 12 month priority for GB2 (24 Aug 2018 + 12 months = 24 Aug 2019 after 23 Aug 2019) so priority claim is valid

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**MARKS AWARDED 1/5**

**Question 6**



Japan – 3 years from filing (exam fee pay per claim examined)  
 – 4 April 2018 + 3 years = 4 April 2021 ✓

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India – 4 years from priority date  
 – 5 April 2017 – 4 years = 5 April 2021 ✓

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South Korea – automatic examination upon filing  
 – pay exam fees upon entering national phase in South Korea  
 – deadline in Korea is 31 months for NPE  
 = 5 April 2017 + 31 months  
 = 5 April 2019 + 7 months  
 = 5 November 2019

Brazil – 3 years from PCT filing  
– 4 April 2018 + 3 years = 4 April 2021 ✓

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Europe – at filing (entering National Phase) ✓  
– deadline is 31 months from priority for NPE (National Phase Entry)  
– 5 November 2019

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**MARKS AWARDED 4/6**

**Question 7**

- identification that grant of patent is sought ✓
- information identifying the applicant ✓
- something that appears to describe an invention or a reference to an earlier filed application (number, date of filing, and country of filing of earlier filed application) ✓
- can file in any language
- 1 month to file translation into English, French or German
- 4 months to give copy of priority app / or 16 months from priority filing if later
- 16 months from priority, if claimed, or filing for inventorship
- if priority claimed need app number, date of filing & country of filing of priority at time of filing EPO application.
- claims within 2 months of filing
- request for search & search fee within 2 months of filing
- claim fee within 1 month of providing claims
- 1 month from notification to rectify any deficiencies.

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**MARKS AWARDED 3/4**

**Question 8**

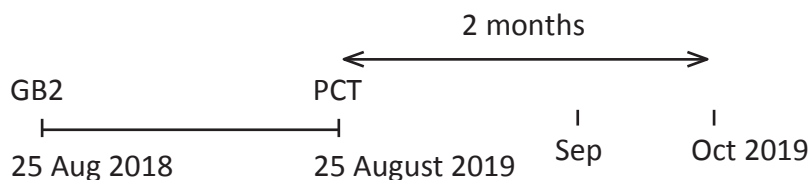
Family 1

US1 grant 14 July 2016

- renewals payable 3.5 ✓ years; 7.5 years; and 11.5 years from grants
- payable up to 6 months after w/ additional fee
- 14 July 2016 + 3.5 years 14 Jan 2020 ✓
- next renewal for US1 due 14 January 2020
- payable up to 6 months late ✓, i.e. 14 July 2020 with additional late fee ✓
- check if any pay at regular, small entity, or micro entity rate
- update patentee information at USPTO assignment database
- cannot file PCT since filing date of US must be before 14 July 2016 which is more than 12 months ago for a priority date & patent is published & ∴ available to the public so no novelty for PCT for same subject matter.

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Family 2



- PCT app not filed with 12 month priority period as per ✓1 Paris Convention (25 August 2019) ✓1
- can file up to 2 months late (25 October 2019) ✓1 with evidence of why missed (managing director sick, assuming he was responsible for making filing instructions) ✓1
- PCT will be filed, but different member states may not accept late priority filing (e.g. Canada will ✓2 not accept)
- also different states may have different evidentiary standards e.g. EPO in spite of all due care & U.S. unintentional ✓1
- ∴ might not get benefit of UK priority (GB2) date (25 Aug 2018) for all countries

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- 31 months to enter national phase at EPO ✓0.5 (4 January 2020), note DE4 German which is language of EPO so no translation needed if PCT German, English or French, otherwise translation after entry
- 30 months to enter national phase at CNIPA (China) (not SIPC anymore) (4 December 2019); ✓0.5
- translation into Chinese required upon filing
- However, can request entry and pay additional fee to file translation late, up to 2 months from 30 months, ie. ✓1 32 months, 4 February 2020.

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14

MARKS AWARDED 14/20

**Question 9****11** Invention relating to method of treating blood clots

- note that details of devices in public domain since as early as 2007
- therefore cannot pursue patent ✓1 protection solely to the devices
- pursue patent protection for method of treatment
- note medical research organisation due to publish on ✓1 1 Nov 2019
- unknown if at internationally recognized exhibition (would get 6 month in EPO), does not appear to be abusive disclosure
- assume citable prior art if app filed after 1 Nov 2019
- ∴ must file before ✓1
- However, methods of treatment on the human or animal body by surgery or therapy & methods of diagnosis on the human or animal body are not patentable at the EPO ✓1
- a method of breaking up a blood clot by simultaneously modulating a laser & applying a vibration of particular characteristics to the blood clot is likely a method of treatment on a human by therapy and therefore not permitted for patent protection
- may be able to reword to method of operating a laser to get patent ✓1 protection

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② Algorithm

- Note that schemes, rules, methods for performing mental acts, doing business, playing a game and programs for a computer, as such, are not patentable in the EPO as per the EPC ✓1
- the algorithm used is implemented in operating software which is either a scheme or a program a computer and therefore may be excluded from patent protection ✓1
- However, the wording “as such” ✓0.5 means could craft application and claims to include physical computer components which may result in some technical ✓1 benefit (e.g. increased speed or reduced computational resources required to determine modulating frequency & vibration characteristics composed to previous algorithm
- may therefore be able to protect in this manner ✓1
- appears that algorithm is not in organisation soon to publish papers so not concerned with filing before 1 November 2019 unless application will be for both inventions

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General Notes

- if you file both inventions in 1 single application likely get unity objection and need to file divisional although this may defer payment of government (EPO) fees
  - can file divisional anytime before grant of app (ie. day before publication of mention of grant)
  - inventions appear to be developed “in conjunction” with medical research organization
  - question of who are the inventors & who owns the rights of the inventors
  - could be that company & organization are joint applicants.
  - may want to get assignment from organization to company (in writing signed by both parties) so company owns all of the rights before filing.
- b) assignment needs to be signed by both assignor (organization) and assignee (company) ✓ and be in writing since organization signed without Amy's knowledge, likely company did not sign assignment & will need to sign or get a new assignment and both parties sign.

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- need to register assignment for each application ✓1 (appears to be only 1 for both inventions) at the EPO
- need to register before granted into a bundle of national rights
- language of proceedings is German so assignment ✓1 must be in German or if another language, file in other language with translation into German at the same time)
- organization (or their representative, if any) can register assignment at the EPO

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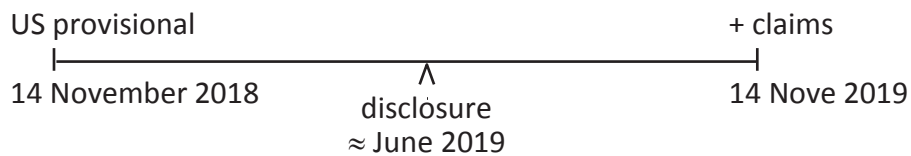
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MARKS AWARDED 11.5/20

**Question 10**

a) Bob designer



- U.S provisional applications cannot directly become patents, but lapse after 1 year (14 November 2019) ✓1 without being published.
- since infringement is possibly occurring in the U.S. need a U.S. utility patent to enforce (might ✓1 also pursue design patent)
- can claim priority to provisional if U.S. utility patent filed before 14 November 2019
- need to add claims ✓1 when filing U.S. utility patent (“patent”)
- ensure claims are supported by Provisional application
- also could craft claim to ensure they are specific to drill bits that are advertised for sale ✓1
- could file continuation with claims having broader scope.
- disclosure by Bob in summer (≈June2019) not a bar to patentability since after priority date of 14 Nove 2018
- also likely Bob’s own disclosure (since it was his product launch so covered under 12 month grace period in the U.S.)

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- once U.S. patent app is filed, request early publication (normally 18 months 14 May 2020) so alleged infringer is on notice – consider sending alleged a copy of published application (check w/ U.S. associate)
- then request expedited exam on basis of ongoing infringement in the U.S. ✓1
- once patent grants can go after alleged infringer & seek damages as far back as publication.
- ensure priority claim is valid & Bob is named on patent app since now has company, may be assigned to company, unclear if board existed when provisional filed

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b) EP2

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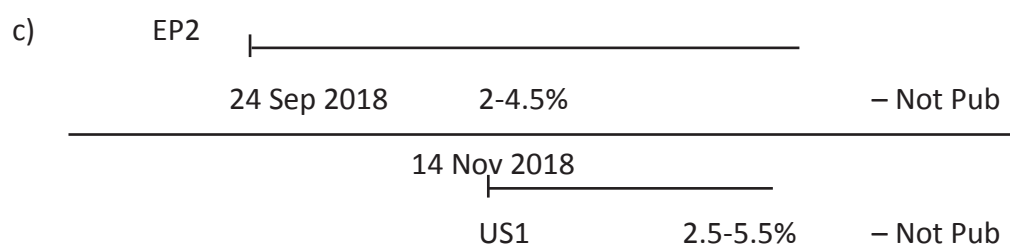
24 Sep 2018

- unclear if claims priority, assume none
- normally publishes 18 months from filing (24 March 2020), request early publication
- assume search fee paid & search already requested since filed 28 Sep 2018 (more than 2 months after 24 Oct 2018 so should be paid) one unclear word
- since not yet publish, exam likely not yet requested
- normally exam must be requested & exam fee paid with 6 months of publication (24 Sep 2020)
- request early publication & request exam, pay exam fee and pay designation fee (validation states fee & extension states fee normally due @ some time, but get 2 month grace period 24 Nove 2020 – pay @ same time if one unclear word)
- request expedited search through PACE ✓1.5
- no fee to request
  - request expedited exam through PACE, also no fee ✓0.5

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- if have to go into Further Processing for any action will be removed from accelerated PACE system ✓1 and cannot rerequest so do not miss any deadlines. ✓1
- also pay 2<sup>nd</sup> anniversary renewal, which is due 2 yers 24 Sep 2020, but payable up to 3 months before 24 June 2020 as soon as this date comes to ensure grant is not held up because of an outstanding renewal
- note sale by Bob happened ~ June 2019 so after EP2 filed so not a bar to patentability.
- provide the EPO with the results of any search or exam report of counterpart cases.
- also can amend claims voluntarily after search report so ensure claims are fewer than 15 & only 1 independent claim per category to ensure faster exam, may also narrower claims to expedite exam, but need to ensure supported & covers searched subject-matter.

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- US1 will not have an affect on EP3 because an earlier filed (i.e. 14 Nove 2018 is before EP3 filing date), but published after EP3 filing date (ie. 14 May 2020 publish date of possible U.S. non-provisional to claim priority from US1 is after EP3 filing date, presumably today 18 Oct 2019) is not citable if it is a U.S. application.

∴ (therefore) US1 will have no effect on the patentability of EP3 ✓1

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- EP2 will have an effect on the patentability of EP3 because it was filed before EP3 (24 Sep 2018 is before 18 Oct 2019) and published after EP3 was filed (24 March 2020 after 18 Oct 2019), but EP2 is only citable for novelty not inventive step. ✓1 (in the U.S a similar U.S. app would be citable for novelty & obviousness)
- EP2 discloses 2 – 4.5%

- EP3 will claim 5% (discovered 4-5% advantage)
- EP2 does not disclose and/or enable 5% and therefore EP3 should be novel in view of EP2 ✓1
- note if EP2 publishes early (as per part b)) or not and EP3 is filed after EP2 publishes (e.g. after 24 March 2020), EP2 will be citable for inventive step as well.
- would then to consider if obvious in view of EP2 to choose 5% instead of somewhere between 2-4.5%.
- also if file EP3 after 14 May 2020 or whenever US1's regular patent application publishes, if early publication requested, then US1 will be prior art for novelty & inventive step & will real problem since US1 discloses 2-5.5% & 5% within range.
- likely difficult to overcome novelty & inventive step objecting in view of US1.

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**MARKS AWARDED 12/20**