

FC3 (P5) – International Patent Law
Mark Scheme 2015

Question 1

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.

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

a) **USA;**

b) **China;**

c) **Australia;**

d) **Germany;**

4 marks

b) **For each of the four listed countries, indicate whether your client can obtain patent protection for S, and why.**

2 marks

c) **List two potential advantages and two disadvantages relating to your client's proposed filing strategy.**

4 marks

Part B

Following your advice, the client decides to file a new German patent application (DE1) as first filing for both inventions and only later to file a PCT patent application (PCT1) claiming priority from DE1. Your client is German, and has a place of business in Australia.

a) **With which receiving Offices can he file PCT1? Provide the reasons.**

4 marks

b) **For each competent receiving Office, state the competent International Searching Authority or Authorities, and International Preliminary Examining Authority or Authorities.**

4 marks

c) **If PCT1 related to a 'business method' invention, in which of the competent receiving Offices identified above would you advise that PCT1 be filed assuming that your client wants the ISA to search the business method-related invention? Provide the reasoning.**

2 marks

Total: 20 marks

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Answer

Part A

- a) USA, Yes (**0.5 marks**), because methods of treating the human body are patentable subject matter (**0.5 marks**); China, No (**0.5 marks**), because methods of treating the human body are not patentable subject matter (**0.5 marks**); Australia, Yes (**0.5 marks**), because methods of treating the human body are patentable subject matter (**0.5 marks**); and Germany, No (**0.5 marks**), because methods of treating the human body are not patentable subject matter (**0.5 marks**).

4 marks

- b) USA, Yes (**0.5 marks**); China, Yes (**0.5 marks**); Australia, Yes (**0.5 marks**); Germany, Yes (**0.5 marks**), because applicants can always get patent protection for mechanical systems or devices.

2 marks

- c) Any sensible **two** potential advantages from, for example:

PCTs can be seen favourably in due diligence or by investors (**1 mark**);
once filed, no further actions may be required, or costs incurred, until at least 30m from filing date (**1 mark**); and,
potential choice of receiving office (rO), International Searching Authorities (ISAs) (**1 mark**)

Any sensible **two** disadvantages (**1 mark** each):

more expensive than national filings;
potentially more complex initial draft;
shorter patent term compared to filing a PCT application claiming priority from earlier non-PCT patent application;
loose opportunity to incorporate any significant technical developments into application before filing a PCT application;
P not patentable in all countries, so potential waste of resources
PCT delays grant (can also be interpreted as an advantage)

Note above list is not exhaustive; candidates awarded marks for pertinent answers.

4 marks

Cont...

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Part B

- a) German Patent Office (**0.5 marks**) since German citizen (**0.5 marks**).
EPO (**0.5 marks**), since citizen of a contracting state (Germany) to the EPC (**0.5 marks**).
IB/WIPO (**0.5 marks**) as citizen of a contracting state (Germany) to the PCT (**0.5 marks**). Australian Patent Office (**0.5 marks**), since client has a place of business (residency) there (**0.5 marks**).

4 marks

- b) German patent Office as rO > EPO is competent as ISA (**0.5 marks**) and IPEA (**0.5 marks**)
EPO as rO > EPO is competent as ISA (**0.5 marks**) and IPEA (**0.5 marks**)
Australian Patent Office > Australian Patent Office and Korean Patent Office are competent as ISA (**0.5 marks**). Australian Patent Office and Korean Patent Office are also respectively competent as IPEA (**0.5 marks**).
IB as rO > choice of any ISAs and IPEAs which would have been competent had the applicant filed the application in any of the possible rOs, namely EPO, Australian Patent Office or Korean Patent Office (**1 mark**).

4 marks

- c) Australian patent office or IB (**1 mark**), so that Australian patent Office or Korean patent Office can be chosen as ISA as these offices will search business methods subject matter (**1 mark**)

2 marks

Total: 20 marks

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Question 2

Your client filed a PCT patent application (PCT2) claiming priority from a Spanish patent application (ES1) written in Spanish. The deadline for entering PCT2 in the national phase is 26 October 2015, and your client informs you that he is interested in obtaining patent protection in Brazil, Australia, South Africa, China, Mexico and Israel.

- a) **Is a translation required in each of the listed countries, and in what language, to validly enter PCT2 in the respective national phases? If so, please specify what will need to be translated by 26 October 2015.**

6 marks

- b) **In the countries requiring a translation, can your client rely on any extensions of time to delay the filing of the translation? If so, please provide a brief description of the nature and duration of the extension.**

5 marks

After PCT2 has entered the national phases in the listed countries, your client lets you know that he is also interested in achieving protection in Hong Kong.

- c) **What steps do you need to take to achieve patent protection in Hong Kong? What are the associated deadlines?**

2 marks

- d) **The application has validly entered the national phase in South Africa as PCT2-ZA. Prepare a brief memo for your client outlining the local prosecution procedure.**

3 marks

- e) **The application has validly entered the national phase in Australia as PCT2-AU. Prepare a brief memo for your client outlining the local prosecution procedure.**

4 marks

Total: 20 marks

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Answer

- a) Brazil: yes, in Portuguese (**0.5 marks**) at least claims by 26th October (**0.5 marks**).
Australia: yes, in English (**0.5 marks**), full specification by the date (**0.5 marks**).
South Africa: yes, in English (**0.5 marks**), full specification by the date (**0.5 marks**).
China: yes, in Chinese (**0.5 marks**), full specification by the date (**0.5 marks**).
Mexico: no (**1 mark**).
Israel: yes, in English or Hebrew (**0.5 marks**), full specification by the date (**0.5 marks**).
- 6 marks**
- b) Brazil: you would have to file the claims by the deadline, but the description, abstract and drawings can be filed within 2 months from the deadline i.e. by 26 December 2015 (**1 mark**).
Australia: no (**1 mark**).
South Africa: +3 or +6 months to file translation (**1 mark**).
China: yes, can enter national phase late by paying a surcharge within 32 months from filing date of PCT2, at which time applicant will have to furnish the translation (**1 mark**).
Israel: yes, if the translation is not furnished in time, an invitation is issued by the patent Office inviting the applicant to file the translation within 3 months (**1 mark**).
- 5 marks**
- c) Within 6 months from publication of the national phase application in CN (**0.5 marks**), register publication of the Chinese application with HK patent office (**0.5 marks**).
Within 6 months from publication of granted patent in CN (**0.5 marks**), register grant with HK patent office (**0.5 marks**)
- 2 marks**
- d) **A maximum of 3 marks** can be awarded taken for example from:
Patent office will carry out formal examination, but not substantive examination (**1 mark**). Once entered, +1 year standard period for allowance (**1 mark**). However, Registrar can grant case before that discretionally (**1 marks**). Can delay grant up to 15 months post national phase entry (**1 marks**), and further if good cause is shown (**1 marks**)
- 3 marks**
- e) **A maximum of 4 marks** can be awarded taken for example from:
The Australian patent office will carry out both a formal and a substantive examination on the application (**1 mark**). The period for requesting examination is 5 years from the International filing date (**1 mark**). Request for examination must be filed within 2 months from a corresponding Direction received from the Australian patent office (**1 mark**). However, applicant can request examination earlier (**1 mark**). Mention presence of a pre-grant opposition procedure (**1 mark**). Mention presence of compliance period (**1 mark**) which in AU is 12 months from issuance of first examination report. In Australia applicants have up to 3m from NoA to file any divs and pay the issue fee (**1 mark**). Mention availability of accelerated examination (**1 mark**).
- 4 marks**

Total: 20 marks

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Question 3

Part A

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 Limited.

- a) **What is a Restriction Requirement? What are the options available in response to a Restriction Requirement? Provide basic details.**

3 marks

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

- b) **Briefly compare a Final Office Action with a Non-Final Office Action.**

2 marks

- c) **What are the options to overcome a Final Office Action?**

3 marks

- d) **After a Notice of Allowance has been issued by the USPTO, give one situation in which you wish to file a Request for Continued Examination (RCE). Provide one advantage of filing an RCE.**

2 marks

A patent is eventually granted on the basis of US1.

- e) **When are annuities due in the US, and when can they be paid (with no surcharge)? What is the grace period for the payment of annuities (with surcharge)?**

4 marks

Part B

US1 as filed 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 (MCS3).

US1 was amended during prosecution to include only independent claims directed to the mechanical component MC1. The USPTO has notified the applicant that a patent will shortly be issued on the basis of US1, on 27 October 2015, with the above claims.

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.

- a) **Set out a strategy for protecting the mechanical component, MC1; the motorcycle suspension system, SS2; the method of controlling the stability of a motorcycle, MCS3; and the new test rig, TR4, in the US. Highlight any important deadlines.**

4 marks

- b) **Is it possible to achieve protection outside the US for the new test rig, TR4, on the basis of any patent application filed therefor in the US? Provide the reason.**

2 marks

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Answer

Part A

a) **Up to a maximum of 3 marks** from:

- i. a Restriction Requirement is a letter in which the USPTO informs the applicant that more than one inventions have been identified in the claims (**1 mark**), and requests that the applicant choose only one invention for prosecution (**1 mark**).
- ii. The applicant can choose an invention for prosecution in the application with or without “traverse” (**1 mark**).
- iii. A “traverse” requires arguments in support of unity of invention (**1 mark**).

3 marks

b) A final Office action is an Office action which brings prosecution to a close whereas a non-final Office action sets a period for responding to objections (**1 mark**). A final OA action issues when the applicant's response to a previous non-final Office action fails to address or overcome previously raised issues (**1 mark**).

2 marks

c) **Up to a maximum of 3 marks** from: the applicant has generally four options for overcoming a final OA:

- i. he may file an amendment which complies with the requirements set forth in the final OA, e.g. where one or more of the dependent claims have been found allowable by the examiner the applicant may respond cancelling the claims that have been objected to (**1 mark**);
- ii. the applicant can file an ‘amendment after final’, touching upon the merits of the case explaining why the amendment was not earlier submitted and still have it considered by the examiner (**1 mark**);
- iii. the applicant can file a Request for Continued Examination (RCE) to continue with the prosecution of the application (**1 mark**);
- iv. the applicant may appeal the rejection of the claims (**1 mark**).

Other pertinent answers such as filing a continuation application and/or request an interview with the examiner could potentially attract **1 mark**, depending on the merit of the candidate's answer.

3 marks

d) **1 mark** is given for identifying a correct situation, and **1 mark** for mentioning a related advantage (i.e. total of maximum 2 marks), examples as follows:

Situations:

The applicant would like to keep prosecution open to pursue broader claims (**1 mark**).

The applicant would like to keep prosecution open to allow a prior art document of relevance to be considered by the examiner (**1 mark**).

Advantage:

RCE avoids having to file a continuation application, which would be more expensive (**1 mark**).

Gain time to file any continuations/divisionals (**1 mark**)

Creation of a presumption of validity over prior art filed in IDS (**1 mark**).

2 marks

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- e) Annuities on US patents are due at: 1) 3.5 years (**0.5 marks**); 2) 7.5 years (**0.5 marks**); and 3) 11.5 years (**0.5 marks**), due dates not computed from filing date of patent application but from date of issuance of patent (**0.5 marks**). There is a payment window of 6 months before due date (**1 mark**). The grace period is 6 months from the due date (**1 mark**).

4 marks

Park B

- a) Candidates should not be penalised for using “continuation” or “divisional” terminology (a “divisional” is in the US a particular type of continuation application) – both equally accepted by marking examiner:

The mechanical component MC1 can be protected by simply allowing US1 to grant shortly (**0.5 marks**). Suspension system SS2 was already claimed in US1, so file divisional application directed to SS2 (**0.5 marks**). Method of controlling stability MCS3 was disclosed but not claimed in US1, so file a continuation application directed at MCS3 (**0.5 marks**). Deadline for filing divisional and continuation applications based on US1 is before a patent is issued on US1, i.e. before 27 October 2015 (**0.5 marks**). Test rig TR4 is a related development, so it is possible (and convenient) to file a continuation-in-part (CIP) application (**1 mark**). Also, need to file CIP before the patent grants on 27 October 2015 (**0.5 marks**). It is possible to file just one divisional, continuation or CIP application, and ‘chain’ the others (**0.5 marks**).

4 marks

- b) Yes (**0.5 marks**), insofar as novel and inventive (**0.5 marks**) over the prior art, since CIP application discloses new matter not previously disclosed in US1, so CIP application constitutes a valid priority application for subsequent foreign applications (**1 mark**).

Filing foreign applications on the basis of a new, non-CIP US application can also be accepted as an answer.

2 marks

Total: 20 marks

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Question 4

Part A

You work in the IP department of a company which builds ships. As part of your duties, you routinely monitor the patent and commercial activities of your main competitor.

Your competitor has a PCT application, PCT3, which has recently been published as an A1 publication with a search report issued by the Korean Intellectual Property Office (KIPO) acting as the International Searching Authority. PCT3 discloses and claims apparatus for moving heavy naval engines across a shipyard. You are aware of prior art relevant to the application which, however, is not cited by KIPO.

What is the tool which you can use in the international phase of PCT3 to bring the prior art to the attention of the examiner? What is achieved by using this tool? What are the associated deadlines, for you and for the competitor?

4 marks

Part B

Regional/national phase applications derived from PCT3 eventually grant in Europe, the US and Japan with the same claims. The patents are infringed by your planned commercial activities. After grant, you become aware of additional, relevant prior art which is very likely to invalidate or at least significantly restrict the patents as granted.

a) **Describe Opposition before the European Patent Office (EPO): what is the deadline for filing an Opposition? How is the Opposition filed? Who may file? Can it be filed anonymously? What are the grounds for Opposition? Are third parties allowed to participate in the Opposition after the deadline, and if so why and how?**

4 marks

b) **Describe Post Grant Review (PGR) before the US Patent and Trademark Office (USPTO): what is the deadline for filing a Petition for PGR, who may file it and can it be filed anonymously? What are the available grounds? Is it necessary for court proceedings to have been instituted, and what is the criterion that the USPTO will use to decide whether to institute PGR?**

3 marks

c) **Describe Inter Partes Review (IPR) before the USPTO: what is the deadline for filing a Petition for IPR, who may file it and can it be filed anonymously? What are the available grounds and what prior art can be relied upon? Is it necessary for court proceedings to have been instituted, and what is the criterion that the USPTO will use to decide whether to institute IPR?**

3 marks

d) **Provide one advantage and one disadvantage of Opposition at the EPO over IPR at the USPTO which may be relevant to the present scenario.**

2 marks

e) **Briefly describe the recently introduced Opposition procedure before the Japanese Patent Office (JPO): what is the period for filing an Opposition, and who may file it? How is the fee calculated? What are the available grounds? Is the applicant required to respond to an Opposition and, if so, what must he do?**

4 marks

Total: 20 marks

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Answer

Part A

Up to a total of 4 marks from:

- i. It is possible to file third party observations (novelty and/or inventive step) on the application in the International phase to bring the prior art to the attention of the examiner (**1 mark**).
- ii. The third party observations are made public (**0.5 marks**), forwarded to the applicant (**0.5 marks**) and in due course transmitted to the designated offices after the expiry of the 30/31 month deadline (**0.5 marks**).
- iii. The applicant can respond up to 30m from priority date (**0.5 marks**). The period for filing third party observations is from publication of PCT3 (**0.5 marks**) until 28m from the priority date of PCT3 (**0.5 marks**).
- iv. The third party observations are not binding on national offices (**1 mark**). The third party has no right to be made party to the procedure (**1 mark**).
The above is a non-exhaustive list whereby pertinent answers will still be awarded marks based on their relevance to the question.

4 marks

Part B

- a) +9m from effective date of patent (**0.5 marks**); need to pay an opposition fee and file notice of opposition with arguments (**0.5 marks**); anyone can oppose (**0.5 marks**); can file anonymously as a 'straw-man' opposition (**0.5 marks**); grounds available: added matter (**0.5 marks**), novelty/IS/patentable subject matter (**0.5 marks**), say at least novelty/IS to get the half mark), sufficiency (**0.5 marks**); opposition in Europe is an 'inter-partes' procedure before the opposition division of the EPO but third party 'interveners' are allowed if they have been put 'on notice' (**0.5 marks**).
- b) +9m from grant of patent, or reissue patent, anyone can file, may not be filed anonymously i.e. the opposing party must be identified (**1 mark**). Grounds available: novelty/IS/patentable subject matter (mention at least novelty and IS to get **0.5 marks**); lack of description (i.e. invention not fully described, skilled person not fully enabled); but 'best mode' not disclosed in the application not a ground (mention at least one of these to get **0.5 marks**). Need not have started court action to challenge patent (**0.5 marks**), but requirement to show claims are 'more than not' (i.e. >50%) likely to be invalid to have proceedings instituted (**0.5 marks**).
- c) Anyone can file, cannot file anonymously, can be filed after the later of 9m from issuance of patent or re-issue patent, or after termination of PGR proceedings (**1 mark**). More limited grounds for petition: novelty & IS (**0.5 marks**), and prior art that petitioner can use is only limited to patents and printed publications (**0.5 marks**). Need not have started court action to challenge patent (**0.5 marks**), petitioner must demonstrate that is a reasonable likelihood that claims are invalid (i.e. a lower standard than PGR) (**0.5 marks**).

4 marks

3 marks

3 marks

Cont...

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- d) Examples are provided below, but pertinent answers will still attract marks based on their relevance to the question (**1 mark** for advantage; **1 mark** for disadvantage):
Advantage: anonymous (**1 mark**). Broader grounds (**1 mark**).
Disadvantage: Opposition only available for first 9m post grant (**1 mark**). Opposition typically lasts longer (**1 mark**).

2 marks

- e) Period for filing an opposition is 6 months from date of issuance of the patent (**0.5 marks**) and anyone can file a notice of opposition (**0.5 marks**). The fee is calculated 'per claim' opposed (**1 mark**). The available grounds for Opposition are: lack of novelty/IS (mention at least these to get **0.5 marks**); added matter; lack of description; double patent; translation does not correspond to original text of patent application (mention at least one to get **0.5 marks**). The applicant must respond by filing a remark and/or correction (**1 mark**).

4 marks

Total: 20 marks

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Question 5

Part A

A large US company is co-applicant of a PCT patent application, PCT4, which was filed in English with the US Patent and Trademark Office (USPTO) on 14 January 2014.

PCT4 claims priority from an earlier US provisional patent application US-P-1, filed on 26 April 2013, and from an earlier US non-provisional patent application US2, filed on 12 June 2013.

The US company wants to enter PCT4 in the regional/national phases in Canada, China, South Korea, Brazil and at the EPO. However, at present the US company is facing budgetary issues which prevent the in-house patent attorney from taking any actions. He is evaluating how to best deal with the situation, knowing that the budgetary issues will soon be resolved.

- a) **What is the deadline for entering PCT4 in the regional/national phase in each of the jurisdictions listed above? Show your calculations. You are not required to take into account any patent office closed days.**
5 marks
- b) **For each of the above-listed countries is late as-of-right regional/national phase entry possible for PCT4? What would be the deadline for late entry where available? Do not take into account any patent office closed days.**
4 marks
- c) **For each jurisdiction providing for late as-or-right regional/national phase entry, set out in detail those requirements for PCT4 which would be in addition to those for regional/national phase entry by the standard due date.**
3 marks
- d) **Provide two disadvantages of entering the regional/national phase late.**
2 marks

Part B

Upon reviewing PCT4 in light of the most recent commercial developments, the in-house patent attorney realises that an important invention disclosed and claimed in PCT4 only validly claims the priority of US2. He is thus contemplating withdrawing the priority claim to US-P-1.

- a) **Is it possible to withdraw the priority claim to US-P-1 in the International phase and, if so, how can the patent attorney do so?**
3 marks
- b) **Give one advantage and two disadvantages of performing such an action.**
3 marks

Total: 20 marks

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Answer

Part A

- a) Canada, 30m from earliest priority date **(0.5 marks)** > 26 October 2015 **(0.5 marks)**
 China, 30m from earliest priority date **(0.5 marks)** > 26 October 2015 **(0.5 marks)**
 Brazil, 30m from earliest priority date **(0.5 marks)** > 26 October 2015 **(0.5 marks)**
 South Korea, 31m from earliest priority date **(0.5 marks)** > 26 November 2015 **(0.5 marks)**
 EPO, 31m from earliest priority date **(0.5 marks)** > 26 November 2015 **(0.5 marks)**
5 marks
- b) Canada, late as of right (aor) entry possible **(0.5 marks)**. +12 months, so deadline pushed to 26 October 2016 **(0.5 marks)**
 China, late aor entry possible **(0.5 marks)**. + 2 months, so deadline pushed to 26 December 2015 **(0.5 marks)**
 South KR, no late aor entry possible **(0.5 marks)**.
 Brazil, no late aor entry possible **(0.5 marks)**.
 EPO, late entry possible **(0.5 marks)**. Deadline is 2 months from notification date of loss of rights letter **(0.5 marks)**.
4 marks
- c) Canada: pay a late fee **(0.5 marks)**.
 China: pay a late fee **(0.5 marks)**.
 EPO: request further processing of the application **(0.5 marks)**; pay the further processing fee **(0.5 marks)**, which is 50% of the fees due on regional phase entry, i.e. for PCT4 filing, designation and examination fees **(0.5 marks)**. Pay in addition also 50% of the search fee, if due **(0.5 marks)**.
3 marks
- d) Late fees will add to cost, and can be considerable as for example in the case of further processing at the EPO **(1 mark)**.
 National procedure may be delayed as a result of late entry **(1 mark)**.
2 marks

Part B

- a) Yes, this can be done in the International phase **(1 mark)** by writing to the IB directly **(1 mark)**. A Power of Attorney will need to be signed by all co-applicants to consent to withdrawal **(1 mark)**.
3 marks
- b) The below are merely examples. Adequate answers pertinent to the question will still attract marks:
 Pro: Deadlines for regional/national phase entry would be recalculated with base date 12 June 2013 which will gain the attorney time and allow company to sort out finance **(1 mark)**
 Cons: Since consent from all co-applicants is needed, this step in practice can be very difficult, for example because a co-applicant is not convinced **(1 mark)**.
 Potential adverse effect from any resulting intervening prior art **(1 mark)**.
3 marks

Total: 20 marks

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Question 6

The European Patent Office (EPO) acting as the International Searching Authority (ISA) found the 20 claims of a PCT patent application to cover two separate inventions, A (claims 1 to 10) and B (claims 11 to 20). Since invention A was first presented in the claims, the EPO initially only searched invention A. However, a further search fee was paid to have the EPO, as the ISA, search invention B.

In the written opinion relating to invention A, the EPO objected to the novelty and inventiveness of the claims. In the written opinion relating to invention B, the EPO raised no objections to the claims.

The application will, in due course, be entered into the European phase, and the EPO will in due course issue a Rule 161(1)/162 communication.

- a) **What must you do when you receive the Rule 161(1)/162 communication issued by the EPO in the European phase? State any applicable time limits. What would be the consequence of failing to perform such an action?**

2 marks

- b) **Explain in detail what excess claim fees are payable in the European phase of the application. When do they fall due? Assuming that no payable excess claim fees are paid, can the deemed withdrawn claims still be pursued during prosecution and, if so, on what conditions?**

3 marks

The applicant wishes to amend the claims to include a third invention, C, which is disclosed but not claimed in the PCT patent application, while keeping A and B. It is now too late to amend the claims in the international phase.

- c) **What options do you have to amend the claims as desired by the applicant in relation to the European processing of the application? What are the time limits associated with these options? Describe the nature of the amendment desired by the applicant.**

5 marks

Since the applicant is undecided about which invention to pursue in the European phase of the application, you have ensured that all three inventions, A, B and C, are covered by the claims.

- d) **What is the consequence of including invention C in the claims? Inform the applicant about what the EPO will do next. State how you will need to react, assuming that the applicant will eventually choose to pursue invention C and that the EPO will raise patentability objections against invention C. State any applicable time limits.**

7 marks

- e) **What options are available to the applicant for extending the applicable time period for deciding which invention to pursue in the European phase of the application? Provide the details.**

2 marks

Cont...

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- f) Assuming that the applicant has chosen to pursue invention C in the European phase of the application, state suitable strategies for pursuing protection for inventions A and B, stating any applicable time limits.

1 mark

Total: 20 marks

Answer

- a) **Up to a maximum of 2 marks** from:
Must file comments and/or amendments in response to the existing objections in relation to invention A (**1 mark**) within 6 months from notification of communication (**1 marks**) (marks still awarded whether or not “from notification” is specified, i.e. whether or not 10-day rule is accounted for). If comments and/or amendments not filed, application will be deemed withdrawn (**1 mark**).
- 2 marks**
- b) Claims 16 to 20 attract excess claims fees (**1 mark**). Pay the excess claim fees (to maintain all claims in the application) within the expiry of the period for responding to the R161(1)/162 period (**1 mark**). Can reintroduce in the prosecution of the application any deemed abandoned claims if subject matter present in description, with consent of the examining division (**1 mark**).
- 3 marks**
- c) 1. Can amend the claims directly on entry into the EP regional phase (**1 mark**); alternatively, 2. in response to R161(1)/R162 communication (**1 mark**). Amendment directly on entry into the European phase is usually carried out together with entry of the application in the EPO i.e. at the 31m deadline (**1 mark**). Amendment in response to R161(1)/162 communication is within 6 months from date of notification of communication (**1 mark**). Either way, the amendment requested by the client is a voluntary amendments which at this stage of the procedure can be carried out as of right, so does not require consent of examining division (**1 mark**).
- 5 marks**
- d) Since the claims cover the three inventions, and only A and B have been searched by the EPO, the EPO will issue an invitation to pay an additional search fees for C (**1 mark**). The EPO will set a time limit for paying the additional search fee of 2 months from notification of the invitation (**1 mark**). You will need to pay the additional search fee in response to the invitation (**1 mark**). The EPO will then issue a communication enclosing the search results, written opinion and cited documents for invention C (**1 mark**) (this is the communication under Rule 164(2)(b)(c)). You will need to respond to this communication within a time limit set by the EPO which should be no less than 4 months (**1 mark**). Your response will need to address a non-unity objection in the communication by choosing which invention to have examined by the EPO (i.e. invention C as stated in the question) (**1 mark**). Your response will also need to address the objections by filing comments and/or amendments (**1 mark**).

7 marks

Cont...

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- e) A +2 months as of right extension of time for responding to the communication can be requested (**1 mark**), the communication being the one under Rule 164(2) (b) (c) (no need to correctly identify rule to obtain mark).

Further processing is also be available to delay choice further of around 3 or 4 months since FP due date computed from date of notification of loss of rights letter; pay the further processing fee and perform the required acts (**1 mark**).

2 marks

- f) Maximum of 1 mark awarded for identifying an appropriate strategy, for example:
File a first generation divisional application for A and B, before the present application grants, then later file a second generation divisional for one of A and B, before the first generation divisional grants (**1 mark**); or
File a first generation divisional application for each of inventions A and B before the present case grants (**1 mark**).

1 mark

Total: 20 marks