

Question 2

A

- a) The Examination can be accelerated at any time after search but before Examination has begun. No additional fee is required 0
- b) The accelerated examination may be request by filing a PACE form ✓1 by specifying acceleration of Examination is required and the application number. No additional fee required. 1
- c) The EPO will issue the Examination Report within period of 2 months after receiving PACE 0
- d) The application will fall out of the accelerated Examination procedure if an extension of time limit is requested. ✓1 The deadlines have to be met without extension for PACE to continue. 1

B

- a) I would recommend filing a response to the objections raised in the International Search Report by EPO. ✓1 Since EPO is acting as the ISA if a response is not filed by the due date as per the Rule 161(1) and 162 communication the application will be treated as withdrawn. 1
- b) The deadline for filing a response is 6 months ✓0.5 (plus 10 ✓0.5 days according to the EPO 10 day rule) for filing a response to Rule 161(1) and 162 communication. The deadline cannot be extended and if a response is not filed by the due date the application will be treated as withdrawn. It is possible to request further processing ✓1 after the application is deemed withdrawn by paying further processing fee, requesting further processing and completing the omitted act. (FP due date is 2 months (+ 10 days) from notice of loss of right). 2
- c) Yes the applicant could request accelerated processing by requesting PACE and waiving the right to be issued Rule 161(1) and 162 EPC. ✓1 However the request for waivers of 161 and of accelerated processing will be accepted only if response to the objections raised in the ISR has already been filed. otherwise 161 communication will be issued. 1

C

- a) Deadline for filing a divisional application is during the pendency of the patent application i.e. the divisional application can be filed till the day before grant of EP1 or day before the publication of grant of EP1 in the official Journal. ✓1 1

Examiner's
use only

- | | Examiner's
use only |
|---|------------------------|
| b) For the divisional application filing fee and search fee or payable on filing or within one month of filing. If it is not filed it can still be filed using further processing. For every second generational divisional an additional fee also has to be paid on filing. ✓0.5+0.5 | 1 |
| c) Filing fee, search ✓0.5 fee, renewal fee has to be filed if renewal fees are due on the patent application i.e. if divisional was filed later than two years after the patent application was filed. ✓0.5 Renewal fees have to be paid within a period of 4 month from filing of the divisional application, if not filed within this 4 month can be paid within a period of 6 month from the end of the 4 month due date.

Designation fee ✓0.5, Extension ✓0.5/validation fee, Examination fees can be paid before publication or 6 month after the European Search Report on the divisional application has issued. Claim fees can be paid on filing or after one month from filing first set of claims. ✓0.5 | 2.5 |
| d) If the divisional is withdrawn before Examination has started examination fee may be partially refunded | 0 |

10.5

MARKS AWARDED 10.5/20

Question 3

- | | |
|---|-----|
| <p>a) A request for a grant of a patent ✓0.5
 Name and details of the applicant ✓0.5
 A description or reference to a previous application. ✓0.5</p> | 1.5 |
| <p>b) A priority can be claimed from DE0 only if the PCT application was also filed in the client' name. i.e. a priority for a new application can only be claimed from a convention application which was filed either by applicant or his predecessor in title. In this case priority cannot be claimed if PCT is filed in the name of company as the company was not the applicant of DE0. ✓1

 He can rectify this problem by either filing the PCT in his name. He is a person competent to file PCT as he has a place of business in a contracting state of PCT and also nationality of a contracting state of PCT.</p> | 1 |
| <p>c) Two competent Receiving Offices are European Patent Office and German Patent Office. A competent receiving office for PCT is the national office of the contracting state of which the applicant is a resident or a national. He is a resident of Germany. ✓1 He can also file at EPO, as for all the residents and nationals of member states of EPC. EPO is a competent receiving office. ✓1</p> | 2 |

- d) European Patent Office. ✓1
- e) The new PCT application can claim priority from DE0, if the PCT application is filed within a period of 12 months from the filing date of DE0✓0.5 i.e. in this case if the PCT application is filed by 26 September 2017.✓0.5 A late declaration of priority is possible within a period of 2 months from the 12 month deadline.✓0.5 Provided a late declaration of priority is requested within 2 months, stating the reason for late declaration✓0.5 and also filing the application. PCT application has to be filed by the same applicant as DE0. Late claim of priority can be made till 26 November 2017.✓0.5 However late declaration of priority may not be allowed in some contracting states during the national phase so there is a chance that priority may become lost.
- Priority in the PCT application can also only be claimed by matter in the PCT application that was disclosed in the DE0 application. A certified copy of the priority document also has to be submitted for the PCT application at international Bureau within 16 months of the priority date (26 January 2018). Any disclosure made between the period between filing of priority application and filing of PCT claiming priority from DE0 will not affect for in part of the state of the art for the invention if valid priority can be claimed.
- f) i) USA provides a grace period of 12 months for any disclosure made by the inventor before filing of the US application. USA allows late declaration of priority. Therefore patentable✓0.5
- ii) In China, valid protection cannot be obtained✓0.5, as there is not grace period in China. and extension of priority claim is not possible. Therefore the filing date of PCT will be considered for determining state of the art
- g) Australia✓1, Japan✓1, Singapore. ✓1
- h) United States of America✓1, Canada✓1, South Korea✓1
- i) No EPO acting as IS will not search claims to software-implemented business methods, as software✓0.5 and business methods✓0.5 as such are not patentable as such.

Examiner's
use only

1

2.5

1

3

3

1

16

MARKS AWARDED 16/20

Question 4

- a) USA✓0.5, Canada✓0.5, Mexico✓0.5, Brazil✓0.5 South Korea✓0.5, Australia✓0.5 all provide grace period that allows applicants to obtain valid patent protection for an invention after their own disclosures. These grace periods are available unconditional. ✓0.5 x 6

6

- b) Japan✓0.5 provides a grace period of 6 months✓0.5 for any disclosure carried out for experimental purposes from the filing date.

UK✓0.5 provides a grace period of 6 months✓0.5 from filing for applicants disclosure at an international exhibition recognised by UKIPO provide the statement of such disclosure is made at the time of filing.

India provides a grace period of 6 months for disclosures carried out for experimental purposes.

2

Part B

- a) The invention will not be patentable in EPO as EPO does not provide a grace period for disclosure by the inventor unless the disclosure was obtained by unlawful means or breach of confidence. or at an international exhibition recognised by EPO ✓1

The invention will be patentable in USPTO✓0.5 as there is a grace period of 12 months preceding the date of filing in US for inventors own disclosure✓0.5. ie Provided the disclosure occurred 12 months before date of filing of the application for patent for the invention the disclosure will fall within the grace period and can be patented.

2

- b) The invention will be patentable in EPO provided the disclosure occurred 6 months prior to the filing of application at the EPO✓0.5 and a statement is made at the time of filing about such a disclosure and within 4 months the certificate of exhibition is furnished at the EPO. The international exhibition however must be one recognised by the EPO. ✓0.5

In USPTO the client's invention will be patentable✓0.5. if application filed within a period of 12 months from disclosure.✓0.5

2

- c) The invention will be patentable in Europe✓0.5 provided the disclosure occurred as a result of a breach of confidence within a period of 6 months immediately preceding the date of filing of an application for the invention in Europe.✓0.5

In USPTO the invention will be patentable✓0.5 if application filed within a period of 12 months from the disclosure.

- d) The invention will not be patentable either in Europe or US. In US because the 12 month grace period has passed. In Europe because the disclosure was not in breach of confidence ✓2
- e) The invention will not be patentable in Europe ✓1. The invention can be patented in US if an application is filed within a period of 12 months from disclosure.

2

1

15

MARKS AWARDED 15/20

Question 5

- a) i) A German national patent application may be filed at the German national patent office. The request for substantive Examination in Germany has to be made 7 years from filing ✓1. A German national patent should have a request for grant of a patent, a description or a reference to a previous application and details of the applicant. If a translation is not filed in any of the official languages accepted by the German patent office, the translation can be filed 3 months from filing. A formal examination is carried out, to check if the minimum requirements are fulfilled. A search is carried out to find the document relevant to determine the patentability of the invention. A substantive Examination is carried out following the search to determine the patentability of the invention. The Examination Report is issued and the applicant is allowed an opportunity to respond to the objections raised in the Examination Report ✓1. If the party has been successful in responding to the Examination Report the application will proceed to grant.
- ii) In Italy a national patent application can be obtained via the EPC route.
- b) In Germany patent protection can be obtained via PCT by designating Germany in the PCT application. National Phase entry in Germany is 30 months from priority date or filing date of the PCT application ✓0.5. This deadline is not extendable. Patent Protection in Germany can also be obtained via designating EPO is the PCT application and entering Germany national phase from EPO. ✓0.5
- In Italy, patent protection can be obtained via PCT, through the EPC route. ✓0.5
- c) i) In Germany the first renewal fee is payable on the 4th anniversary of the filing date.
- i) In Italy first renewal fee payable 2nd anniversary of filing date.

2

1.5

0

Examiner's use only	
d) i) Germany – 15 years is the term of utility model. Protection starts from filing	
ii) Italy – 15 years is the term of utility model from filing.	0
e) The deadline for filing opposition in Germany 9 months from date of grant of the patent. ✓1	1
f) Two grounds of opposition.	
* Added matter ✓0.5	1
* Insufficiency ✓0.5	1
Part B	
a) Excess claim fee will be payable for every claim in excess of 15 claims.	0
b) EPO allows only one independent claim per category. ✓0.5 In this case there are two independent claims per category. The independent product and apparatus claim and the independent method and independent use claim.	
The EPO allows more than one independent claim per category only if	
1) The claims relate to two interrelated products (such as plug and socket) ✓1	
2) The claims relate to different inventive ways for carrying out the invention ✓1	
3) Or if the claims are alternative solution to the same technical problem ✓1	
If it can be proved that the claims fall within the criteria set out above they can be pursued in the European application	3.5
(10) MARKS AWARDED 10/20	
Question 6	
a) Filing fees ✓0.5 and search fees ✓0.5 have to be paid when filing a PCT application. If the RO with which the PCT application was filed was not a competent RO the application is deemed as received on behalf of IB and a transmittal fee ✓0.5 set by the RO will also be charged. Search fees will be transmitted to international searching authority ✓0.5	2

Examiner's use only	
<p>b) If the filing fee is not paid at the time of filing the RO will issue a notification to pay the fees, the fees can be paid within 1 month of such notification✓0.5 with surcharge✓0.5. If the fee is paid before the notification of non-payment is issued, then the filing fee can be validly paid without surcharge. If the filing fees are not paid within one month after invitation with surcharge the application is deemed abandoned. However if the fees are paid with surcharge before the notification is issued the fees will be considered validly paid and application will not be considered abandoned provided its paid before 15 months from priority if there is priority.</p>	1
<p>c) An International search can be requested 3 months from filing or 19 months from priority.</p> <p>The deadline for responding to ISR is one month from issue of ISR.</p>	0
<p>d) A demand✓0.5 has to be filed by the applicant who is a resident or national of the member state that is bound by Chapter II.</p> <p>The demand has to be made either 3 months from issue of ISR✓0.5 or if priority is claimed 22 months from priority✓0.5 whichever is later. A preliminary Examination will be carried out by a competent IPEA based on the receiving office of the PCT. If there are more than one IPEA eligible for conducting the preliminary examination the applicant can chose the IPEA. A preliminary exam report will be issued by the IPEA with regard to the substantive merits of the application. The applicant can file amendments in response to the International Preliminary Examination Report.✓0.5</p>	2
<p>e) The elected offices are not bound by any results or objections raised in the IPE. ✓0.5</p>	0.5
Part B	
<p>a) Australia, Brazil, Canada, China and EPO✓1</p>	1
<p>b) A national application✓0.5 claiming priority from the UK application✓0.5 can be filed in Argentina before 28 October 2017.</p>	1
<p>c) In Australia the national phase deadline is 31 months✓0.5 from priority date and this deadline cannot be extended i.e. 28 May 2019</p> <p>In Brazil, the national phase deadline is 30 months from priority date✓0.5, 28 April 2019</p> <p>In Canada, the national phase entry deadline is 30 months from priority date✓0.5, 28 March 2019. This deadline is extendible as of right✓0.5 for a period of 12 months, i.e. 28 April 2019, could be extended to 28 April 2020</p>	

In China, the national phase entry deadline is 30 months from priority date ✓0.5, this deadline is extendible by 2 months. ✓0.5 28 April 2019 could be extended to 28 June 2019.

In EPO, the national phase entry deadline is 31 months from priority ✓0.5 date, 28 May 2019. This due date is not extendible

3.5

- d) In China the deadline can be extended for a period of 2 months ✓0.5 from the 30 month from priority period national phase due date i.e. the national phase entry can be postponed to 32 month as of right by paying the late entry fees ✓0.5 i.e. the extended deadline for national phase entry is 28 June 2019. Any translation if the application (PCT) is not filed Chinese has to be also submitted during this national phase entry. A power of Attorney is required for representative for national phase entry into China.

In Canada the national phase entry deadline can be extended as of right by a period of 12 months ✓0.5 from the 30 month deadline i.e. the national phase entry in Canada can be extended up to 28 April 2020 by requesting such extension. Any translation required also has to be filed by this date.

1.5

12.5

MARKS AWARDED 12.5/20