

**Question 1 A**

- a) The client does qualify ✓0.5(i) as the number of employees must be 50 or fewer 0
- b) A micro entity must be an individual with 4 or fewer patents granted in their name or/and an annual turnover of fewer than three times the median ✓(iv) income per capita. They must also not licence the application to any larger entities. 0.5
- c) For small entities, the fees are reduced by 50%. ✓1(i)  
For micro entities, the fees are reduced by 75% ✓1(ii) 2


**Question 1 B**

- a) The IDS details all the cited documents from applications in the same family. It must state all documents that haven't already been cited by the USPTO in the last 6 months. The USPTO need not do detailed searches, or review these documents in detail. ✓1 1
- b) Copies of the documents ✓1 relevant applications not specified so only a single mark awarded as well as their application numbers, priority date, country in which they're filed. A translation of each document must also be filed and a certified copy / translation of each patent / application. The GB and US applications do not need translating, as they are already in English. The European ✓0.5(ii) application and the Chinese utility ✓0.5(iii) model will require translations into English on filing of the IDS. 2
- c) On filing or when the search fee is paid and search is requested which can be up to 2 months after filing. 0

**Question 1 C**

- a) New prior art has been cited in both China and Japan, so the USPTO must be informed as these are patents in the same family as the filed US application. ✓1 1
- b) i) A translation into English of the prior art must be obtained and certified copies or certified translations of the documents must be filed. These must be filed before the deadline for responding to the first office action in the US, or alongside the response to the office action, provided the deadline is not more than 3 months ahead. 0

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<p>ii) A translation into English of the prior art along with certified copy/ translation certificate must be filed before the date of response to the notice of allowance and the date of fees due. It must be filed before the allowance fees paid.</p>		0
<p style="text-align: center;">  <b>MARKS AWARDED 6.5/20</b> </p>		
<b>Question 2 A</b>		
a) Examination can be accelerated on request of PACE and payment of a fee. When all the deadlines have been met & no extensions requested. It can be requested after publication of the application (or on filing?)		0
b) The PACE request must be filed to the EPO and the fee paid		0
c) The EPO aims to examine the application as quickly as possible. The application gets sent through the PACE system where only PACE applications get sent and put in the queue alongside other PACE applications		0
d) The application can no longer be examined in line with the PACE request and no further PACE ✓1(i) requests can be filed for that application during prosecution ✓1(ii)		2
<b>Question 2 B</b>		
a) Amendments in response to the written opinion of the international searching authority. ✓1(i) The issues raised in the written opinion must be addressed through either amendments or arguments in response.		1
b) The deadline for filing a response is usually 4 months, extendible by 2 months as of right and extendible further by entering into further processing. ✓1(iii)		1
c) They could have filed a demand at 22 months from priority and article 34 amendments in response to the written opinion of the ISA. On issue of the IPRP, they could have also responded within 2 months.		0
<b>Question 2 C</b>		
a) The deadline for filing divisionals is the day before the mention of grant in the EP bulletin. ✓1		1
b) The fee for filing of additional divisionals gets more expensive, the more subsequent divisionals are filed. ✓0.5(i)		0.5
c) Additional search fees must be paid if the second invention for which the divisional was filed was not originally ✓0.5(i) searched. Maintenance fees will be due ✓0.5(v) from 2 years of filing ✓0.5(vi) of the parent, so backdated fees need to be paid. Examination fees may also be payable on filing.		1.5

- d) They would be partially refunded if the search was originally performed on the parent application for the second invention that the divisional is now filed for, and the search fee was paid on the divisional. The search fee would be refunded, as the invention would have already been searched previously. ✓1

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### Question 3

- a) An indication that a patent is sought, name ✓0.5(i) and address of applicant (or some means of contacting them), and a description (or something that purports to a description). ✓0.5(iii)
- b) The client is a national of Luxembourg which is not part of the PCT (except through the EP route). He therefore cannot file a PCT application in his own name as he is not entitled because of his nationality. He could assign the rights of his application to his business ✓0.5(iii) which could then therefore file a PCT application claiming priority from the earlier application because German applicants can file a PCT.
- c) The receiving offices could be either the EPO or the German patent office. They are qualified to forward the applications onto WIPO and perform initial formalities checks and communicate with the applicant if necessary
- d) The competent ISA is the EPO and they perform the search on the application. ✓1
- e) 26 Sept 2016 → priority 26 Sept 2017

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The PCT must only claim priority to the matter disclosed in the earlier application. It cannot contain any information that was disclosed to the public that was not included in the originally filed DE0.

To file a PCT claiming priority, the PCT application must be filed late. ✓0.5(i)  
The original deadline (12 months) was 26 September 2017. ✓0.5(ii)  
However, a late declaration of priority can be made, whereby the application must be filed no later than 2 months ✓0.5(iii) after the 12 month deadline, i.e. 14 months from priority → 26 ✓0.5(iv) Nov 2017. On filing, the applicant must show that the failure to meet the deadline was unintentional despite all due care. A fee ✓0.5(vi) must be paid & evidence ✓0.5(viii) to support the late declaration must be filed alongside the late declaration and the PCT application.

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- f) i) USA – yes ✓0.5(i) as they accept late declarations of priority
- ii) China – no ✓0.5(i) as they do not accept late declarations of priority

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- g) The USA✓1, Canada✓1, and Australia✓1 all may allow software related patents as such 3
- h) Business methods are potentially patentable in Mexico✓1, Germany (if they provide a technical effect), and Singapore.✓1 2
- i) The EPO does not search claims directed to software-implemented business methods if it is the ISA, as it does not allow software✓0.5 or business methods✓0.5 to be patented. 1

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#### Question 4 A

- a) The following countries allow a grace period of 1 year for the applicant's own disclosure of the invention: Australia✓0.5, US✓0.5, Canada✓0.5, Mexico✓0.5, Singapore✓0.5 and Brazil. ✓0.5 3
- b) Israel has a 'reasonably sufficient' time period for filing the application after the applicant discloses the invention.

The UK✓0.5 and Germany✓0.5 have grace periods of 6✓1 months but only for abusive disclosures or ones at a recognised international exhibitions 2

#### Question 4 B

- a) i) No – The EPO would count the local trade fair as a novelty destroying disclosure, so would not allow it as patentable. ✓1
- ii) Yes – ✓0.5The USPTO would allow the invention to be patented as it allows inventor to disclose their invention in a 12 month✓0.5 period before filing. 2
- b) i) EPO – if the international exhibition was an officially recognised one, then yes the EPO would deem it patentable. If not officially recognised, then no. ✓0.5
- ii) USPTO – yes✓0.5 as inventor can disclose within 12m grace period. ✓0.5 1.5
- c) i) EPO – yes the EPO would see this as an abusive disclosure in breach of ✓0.5confidence, so would allow 6 months✓0.5 for the inventor to file with proof evidence. Have 1 month to file. 1
- ii) USPTO – yes – the USPTO would see this as an invention being derived from✓0.5 the inventor and also under abusive circumstances so the grace period applies & the invention can still be patented✓0.5 1

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| d) i) EPO – no, as it is a novelty destroying disclosure (unless obtained abusively – but 6m deadline would have passed anyway) ✓1   |                        |
| ii) USPTO – no, as the grace period is only 12 months and is not extendible, so this would not be patentable ✓1  | 2                      |
| e) i) EPO – the disclosure is abusive as the invention was discussed in confidence, but as the 6 month grace period is over, the invention is not patentable over this publication. ✓1   |                        |
| ii) USPTO – as it was in breach of confidence, the client can file within 12 months. However if the additional feature was disclosed, it might be cited against the client's application in terms of inventive step or ✓1 novelty. The first aspect however, was obtained unlawfully and the client can still file their application. ✓1 | 2                      |

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#### Question 6 A

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| a) The filing ✓0.5 and search fees ✓0.5 must be paid as well as the transmittal ✓0.5 fees. The transmittal fees are received by the receiving office ✓0.5, the filing fee is transferred to WIPO ✓0.5, and the search fees are transferred to the international searching authority. ✓0.5  | 3 |
| b) The filing, search transmittal fees can be paid on filing of the application. The deadlines can be extended by not paying the fees and waiting for a notice to file missing parts which sets a 2 month deadline for filing the missing parts (paying the fees).   | 0 |
| c) The ISR does not need responding to until the 30 month national phase deadline  | 0 |
| d) At 22 months ✓0.5 from priority, a demand can be filed to enter Chapter II examination ✓0.5. The IPEA will be sent the application and any article 34 amendments to examine. Article 34 amendments and any arguments may be filed on filing a demand ✓0.5 in response to the written opinion of the ISA. The IPEA will examine these amendments and will issue an IPRP (international preliminary report ✓0.5 on patentability), at around 28 months from priority. The applicant may respond within 2 months of receipt but it is unlikely the IPEA will enter into further dialogue with the applicant. | 2 |
| e) The elected offices at the national phase will often expect the applicant to respond to the issues raised in the IPRP before they engage in any communications or undertake their own examination on entry to the national phase.   | 0 |

**Question 6 B**

- a) Australia, Brazil, Canada, China and the EPO are designated in the PCT.  
Argentina is not. ✓1
- b) The 12 month priority deadline is not until 28 October 2017. As Argentina is a member of the WTO, and Paris Convention, an application can be filed ✓0.5 claiming priority ✓0.5 from the UK application before 28 October 2017.
- c) Australia – 30 months – can extend to 32 months.  
Argentina – not part of PCT.  
Brazil – 31 months – extendible to 31 months,  
Canada – 31 months but can extended to 42 ✓0.5 for part (d) months from priority  
China – 31 months but no extension ✓0.5  
EPO – 31 months – can be extended by 3-5 months (depending on issue of loss of rights notification) ✓0.5
- d) Canada – pay fee on late filing  
EPO – wait for loss of rights notification which provides 2 month deadline to pay further processing. ✓0.5  
Australia – pay fee on filing and request extension  
Brazil – request extension & pay fee before national phase deadline.

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