Patent Examination Board

FC3 – International Patent Law
FINAL Mark Scheme 2021

SECTION A

Question 1

An examination report under Article 94(3) EPC setting a four month period for response was issued on 22 June 2021. The applicant has previously requested accelerated examination of the application.

a) **By when should a response to the examination report be filed at the European Patent Office assuming no extensions of time are requested.**

1 mark

b) **Explain how the applicant could delay responding to the examination report without payment of an official fee, and the consequences of this on the accelerated examination the application.**

3 marks
Total: 4 marks

Answer

a) *02 November 2021 including the 10 day postal rule.*

1 mark

b) *The applicant could (in writing) request a (two month) extension of time **(0.5 marks)** on or before 02 November 2021 **(0.5 marks)**. As a result of the request for the extension of time, the application will re-enter the standard examination queue (loss of pace status) **(1 mark)**, and accelerated examination can no longer be requested **(1 mark)**. (Guidelines E—VIII 4)*

3 marks
Total: 4 marks

Question 2

A United Kingdom patent application was filed on 01 September 2020, with the applicant making an enabling public disclosure of the contents of that application shortly after. The applicant now wishes to seek patent protection in Hong Kong.

Explain how the applicant may obtain patent protection in Hong Kong. Assume that the applicant is considering standard protection. Do not consider short term patents.

6 marks

Answer

*The applicant cannot make a direct filing in Hong Kong **(1 mark)** as it is too late to claim priority **(0.5 marks)** and there has been an enabling disclosure of the invention to the public **(0.5 marks)**. Protection for the invention in Hong Kong should be obtained based on the United Kingdom patent application **(1 mark)**. A request to record must be filed within 6 months of the publication of the United Kingdom patent application **(1 mark)**. Once the*

*United Kingdom patent application has granted, a request for registration and grant **(1 mark)** must be filed within six months of the date of grant **(1 mark).***

Total: 6 marks

Question 3

For a European patent application, a first communication under Rule 71(3) EPC was issued alongside the text intended for grant in September 2021. The European patent application was filed in German with 12 claims. During examination, the number of claims in the application increased to 17.

a) **What acts must be taken for the application to progress to grant?**

3 marks

b) Assume none of the required acts is completed before the deadline. Explain with reasoning the number of further processing fees that should be paid.

1 mark

c) The applicant proposes minor amendments to the text intended for grant. Explain the process for requesting these amendments at the European Patent Office, and the possible responses of the Examining Division.

4 marks

Total: 8 marks

Answer

*a) File translations of the claims in French **(0.5 marks)** and English **(0.5 marks)**. Pay the fee for grant and printing **(1 mark)**. Pay two **(0.5 marks)** excess claim fees **(0.5 marks)**.*

3 marks

*b) One **(0.5 marks)**, the further processing fee consisting of the amount for the unitary acts (grant fee, accepting text and providing translations) and the amount for the excess claims **(0.5 marks)** (Guidelines E VIII, 2)*

OR

*Two **(0.5 marks)**, the further processing fee for the acts (grant fee, accepting text and providing translations) and the further processing fee for the excess claim fees **(0.5 marks)** (see Art. 2(1), item 12, second and first indent, RFees)*

OR

*Three **(0.5 marks)**, the further processing fee for the acts (grant fee, accepting text and providing translations) and the further processing fee for **each** of the excess claim fees **(0.5 marks)** (see Art. 2(1), item 12, second and first indent, RFees)*

1 mark

c) *Before the deadline for response, file a response to the communication under Rule 71(3) **(0.5 marks)** disapproving the text for grant and requesting the minor amendments **(0.5 marks)**. The request for amendment should be reasoned **(1 mark)**. If the Examining Division gives its consent to the amendments, a further communication under Rule 71(3) will be issued **(1 mark)**. If the Examining Division does not consent to the amendments, examination will be resumed **(1 mark)**. (Guidelines C-V 4)*

4 marks
Total: 8 marks

Question 4

A new client contacts you in relation to a previously filed PCT patent application. The PCT patent application does not claim the priority of an earlier application, and was filed on 01 October 2019.

You take the necessary steps to appoint yourself as the representative. Upon reviewing the file wrapper of the application, you notice a typographical error in the applicant's name.

a) With a reason, state the competent authority to decide on the request for correction?

2 marks

b) Outline the criteria that must be met for the request for correction to be accepted, and the documents that would be considered by the competent authority.

5 marks

c) What is the deadline for submitting the request for correction?

2 marks
Total: 9 Marks

Answer

a) *The Receiving Office **(1 mark)**, as the error is in the request part of the international application **(1 mark)**.*

2 marks

b) *The request for correction will be accepted if it is obvious **(0.5 marks)** to the competent authority that, at the filing date **(0.5 marks)**, something else was intended than what appears in the document concerned **(1 mark)** and that nothing else could have been intended than the proposed rectification **(1 mark)**. The competent authority will take into account the content of the international application itself **(0.5 marks)**, the correction concerned **(0.5 marks)**, any other document submitted with the request **(0.5 marks)** and any other document contained in the international application file at the applicable date/filing date **(0.5 marks)**.*

5 marks

c) *26 months from the priority date **(1 mark)**, so 01 December 2021 **(1 mark)**. (Rule 91.2)*

2 marks
Total: 9 Marks

Question 5

A client attends your office and explains that it disclosed a new pump mechanism at an online product launch. No patent applications have been filed to date, but your client is now interested in obtaining patent protection for the new pump mechanism.

Explain to your client whether it will be possible to obtain valid patent protection in Japan, Singapore and South Africa.

6 marks

Answer

*Protection would be possible in Japan **(1 mark)**. In Japan, a disclosure by the inventor (or his/her employer) will not count as a novelty destroying disclosure if a patent application is filed within 12 months of the disclosure **(1 mark)**.*

*Protection would be possible in Singapore **(1 mark)**. In Singapore, a disclosure by the inventor (or his/her employer) will not count as a novelty destroying disclosure if a patent application is filed within 12 months of the disclosure **(1 mark)**.*

*It would not be possible to obtain protection in South Africa **(1 mark)**. There is no relevant grace period in South Africa, so the disclosure is novelty destroying **(1 mark)**.*

Total: 6 Marks

Question 6

The grant of a Japanese patent is published in the official gazette on 01 August 2021. Your client wishes to oppose the grant of this Japanese patent.

a) **By when by when must the opposition be filed?**

1 mark

b) **What are the possible grounds for opposition?**

2 marks

The grant of a European patent was published on 30 July 2021. After review, your client also wishes to oppose the grant of this European patent.

c) **By when must the opposition be filed?**

1 mark

d) **What are the possible grounds for opposition?**

2 marks

Your client wishes to remain anonymous when opposing both the European and Japanese patents.

e) **Explain to your client if it will be possible to oppose both patents anonymously.**

1 mark

Total: 7 Marks

Answer

a) *6 months from the date of publication of grant* ***(0.5 marks)****, so 01 February 2022* ***(0.5 marks)***

1 Mark

b) *Added matter* ***(0.5 marks)*** *enablement and description requirements (i.e. sufficiency)* ***(0.5 marks)****, mistakes in the translation* ***(0.5 marks)****, patentability* ***(0.5 marks)****; and, double patenting* ***(0.5 marks)*** *(any up to 2 marks)*

2 marks

c) *9 months for the date of publication of grant* ***(0.5 marks)****, so 30 April 2022* ***(0.5 Marks)***

1 Mark

d) *Added matter* ***(0.5 marks)****, sufficiency* ***(0.5 marks)****, lack of novelty* ***(0.5 marks)****, lack of inventive step* ***(0.5 marks)****, is not susceptible of industrial application* ***(0.5 marks****), is not regarded as an invention under Art. 52(1) to (3)* ***(0.5 marks****), is not patentable under Art. 53* ***(0.5 marks****)* ***(Up to 2 Marks)***

2 marks

e) *The opponent must be identified when filing the opposition in Japan* ***(0.5 marks)****. In Europe, the opposition must be filed by a named party, but the client could remain anonymous with use of a strawman (or similar)* ***(0.5 marks)****.*

1 mark

Total: 7 Marks

SECTION A TOTAL: 40 Marks

SECTION B

Question 7

Freeze GmbH, a German company, has recently acquired Chilly Inc, based in the USA. Before the acquisition, Chilly Inc developed technology that dramatically increases the efficiency of air conditioning units and filed a provisional patent application (US1) for this technology at the USPTO on 01 December 2020. The technology was subsequently disclosed to the public for the first time in July 2021.

Freeze GmbH now wishes to file a PCT application (PCT1) in its own name.

a) **Advise Freeze on what action it should take, and by when it in order for PCT1 to claim priority validly from US1.**

3 marks

b) **Identify the competent International Searching Authority (ISA)**

1 mark

In the acquisition, Freeze GmbH also acquired PCT2, with an earliest priority date of 22 April 2019, and an international filing date of 22 April 2020.

c) **Advise Freeze GmbH on the deadline for filing national phase patent applications and the deadline for requesting examination in:**

i) Brazil
ii) China
iii) South Korea
iv) The USA
v) New Zealand

Do not consider any extensions of time that may be available.

11 marks

Freeze GmbH also own European patent application (EP1). EP 1 was filed at the European Patent Office without a claim to priority in November 2019, and was published with a copy of the search report on 21 May 2021. The written opinion accompanying the search report identified a number of objections to the novelty of the application. Only fees due to date have been paid, and no action has been taken since the search report was issued.

d) **Advise Freeze GmbH on the actions that should be taken before the end of 2021, and the deadline for taking each action. Freeze GmbH informs you that late payment and penalty fees must be avoided at all costs.**

5 marks

Total: 20 Marks

Answer

a) *The **right to claim priority** from US1 must be assigned to Freeze GmbH from Chilly Inc **(1 mark)** before PCT 1 is placed on file **(1 mark)**. The deadline for filing PCT 1 is 12 months from the filing date of US1 **(0.5 marks)**, so file PCT 1 on or before 01 December 2021 **(0.5 marks)**.*

3 marks

b) *The European Patent Office **(1 mark).** (PCT Applicant's Guide – International Phase – Annex C – Germany)*

1 mark

c) ***Brazil** – Deadline for national phase entry is 30 months from earliest claimed priority date **(0.5 marks)**, so 22 October 2021 **(0.5 marks)**. The deadline for requesting examination is 36 months from the international filing date **(0.5 marks)** so 22 April 2023 **(0.5 marks)**.*
China** - Deadline for national phase entry is 30 months from earliest claimed priority date **(0.5 marks)**, so 22 October 2021 **(0.5 marks)**. The deadline for requesting examination is three years from the earliest priority date **(0.5 marks)** so 22 April 2022 **(0.5 marks).
***South Korea** - Deadline for national phase entry is 31 months from earliest claimed priority date **(0.5 marks)**, so 22 November 2021 **(0.5 marks)**. The deadline for requesting examination is three years from the international filing date **(0.5 marks)** so 22 April 2023 **(0.5 marks)**.*
***The USA** - Deadline for national phase entry is 30 months from earliest claimed priority date **(0.5 marks)**, so 22 October 2021 **(0.5 marks)**. The deadline for requesting examination is 30 months from the claimed priority date **(0.5 marks)** so 22 October 2021 **(0.5 marks)**.*
***New Zealand**- Deadline for national phase entry is 31 months from earliest claimed priority date **(0.5 marks)**, so 22 November 2021 **(0.5 marks)**. The deadline for requesting examination is five years from the international filing date **(0.5 marks)** so 22 April 2025 **(0.5 marks)**. If the Office issues a direction to the applicant to request examination then examination must be requested within two months of the date of the direction **(1 mark)**.*

11 marks

d) *The renewal fee for the third year must be paid **(1 mark)** before 30 November 2021**(1 mark)**.*
*The request for examination **(0.5 marks)**, examination fee **(0.5 marks)**, designation fee **(0.5 marks)** and a response to the written opinion **(0.5 marks)** including comments and/or amendments on the novelty objections **(0.5 marks)** must be filed/paid before 21 November 2021 **(0.5 marks)**.*

5 marks
Total: 20 marks

Question 8

Your client, Ms Jones, is a serial inventor who has developed a number of new inventions.

a) **Advise Ms Jones on when an application cannot be filed outside of the United Kingdom according to section 23 of the United Kingdom Patents Act.**

5 marks

Ms Jones has developed a new lawnmower that significantly increases the ease of cutting grass to a predetermined length. Ms Jones publicly demonstrated the new lawnmower last week, and everyone who saw it was very impressed, especially when they were shown the details of how it worked.

b) **Explain to Ms Jones whether it will be possible to obtain valid patent protection in the USA, Australia and via the European Patent Convention.**

6 marks

Ms Jones has also developed a hedge trimmer. She informs you that while the hedge trimmer is new, it is a simple combination of two existing products. As such, she does not wish to apply for patent protection.

c) **Describe another form of intellectual property right that Ms Jones could apply for, and list two advantages and two disadvantages of this alternative intellectual property right. Do not discuss designs, copyright, trade marks or trade secrets.**

5 marks

Ms Jones is an individual previously named on seven patent applications at the USPTO. She is looking to file a new US patent application for an invention that has recently been exclusively licenced to a not for profit research foundation.

d) **Advise Ms Jones on which entity status should be used for this filing at the USPTO. Provide the justification for your recommendation.**

4 marks
Total: 20 marks

Answer

a) *An application cannot be filed outside of the United Kingdom where the person is resident in the United Kingdom **(1 mark)** and the application contains information which relates to military technology **(0.5 marks)** or for any other reason publication of the information might be prejudicial to national security **(0.5 marks)**, or the application contains information the publication of which might be prejudicial to the safety of the public **(0.5 marks)**, without written authority granted by the comptroller **(0.5 marks)**, unless:*
*an application for a patent for the same invention has been filed in the Patent Office **(0.5 marks)** not less than six weeks before the application outside the United Kingdom **(0.5 marks)**; and*
*either no directions have been given under section 22 in relation to the application **(0.5 marks)** in the United Kingdom or all such directions have been revoked **(0.5 marks)**.*

5 marks

b) *Protection will be possible in the USA **(1 mark)**. In the United States disclosure by the inventor/applicant will not count as a novelty destroying disclosure if a patent application is filed within 12 months of the disclosure **(1 mark)**. Protection will be possible in Australia **(1 mark)** as Australia offers a 12 month grace period for disclosures made by the inventor/applicant **(1 mark)**. Protection will not be possible via the European Patent Convention **(1 mark)**, as the demonstration was a novelty destroying disclosure **(0.5 marks)** and there is no applicable grace period **(0.5 marks).***

6 marks

c) *The client should seek utility model protection **(1 mark)***

*Any sensible points **(1 mark each)**:*

Advantages
- lower standard inventiveness,
- formal examination only,
- fast registration of enforceable right,
- lower cost registration.
(up to 2 marks)

Disadvantages
- shorter term protection,
- no harmonised laws between countries,
- available in fewer countries than patents,
- restricted subject matter that can be protected
(up to 2 marks)

5 marks

d) *Small entity status should be claimed **(1 mark)**. Micro entity status cannot be claimed as the client is named on more than four previously filed applications **(1 mark)**. As an individual the client is not a large entity **(1 mark)**, and licencing the invention to a not for profit research foundation is compatible with small entity status **(1 mark)**.*

4 marks

Total: 20 marks

Question 9

On 10 July 2020 you filed a PCT application, PCT 1, with abstract, claims, description pages and drawings. The PCT application did not claim priority. You have received an international search report bearing a mailing date of 29 January 2021. The written opinion objects that the claims lack novelty over the prior art.

You review the objections with your client, and believe the objections are correct. Your client wishes to amend the application in response to the objections raised.

a) **Explain the two options available to your client during the international phase. For each option, explain the amendments that can be made, the time limits involved, and explain any advantages or disadvantages.**

12 marks

Your client is also the named applicant of a second pending PCT patent application, PCT 2. PCT 2 has an earliest priority date in January 2020 and was published, in English, in June 2021. PCT 2 includes claims that focus on a mobile phone charger. The written opinion issued by the European Patent Office accepts the novelty of the claims, but raises strong inventive step objections. However, your client believes the inventive step objections are incorrect.

You client has become aware that a third party is selling an identical mobile phone charger to that claimed in PCT 2 in Germany and France. Your client wishes to take action against the third party as soon as possible.

b) **Advise your client on any steps that should be taken.**

8 marks
Total: 20 marks

Answer

a) *Amend under Article 19* ***(1 mark)****. Article 19 amendments due later of 16 months from priority date or 2 months from the mailing date of the international search report* ***(1 mark)****, so 10 November 2021* ***(1 mark)****. Only the claims of the application can be amended* ***(1 mark)****. An advantage of Article 19 amendments is that there is no official fee due* ***(1 mark)****. A disadvantage of Article 19 is that you cannot enter into a dialogue with the Examiner.* ***(1 mark)*** *(Other reasonable advantages/disadvantages accepted)*

Amend under Article 34 ***(1 mark)****. Article 34 amendments due later of 22 months from priority date or 3 months from the mailing date of the international search report* ***(1 mark)****, so 10 May 2022* ***(1 mark)****. The claims and the description can be amended* ***(0.5 marks)****. The drawings, can also be amended* ***(0.5 marks)****. An advantage of Article 34 amendments is that you can enter a dialogue with the Examiner to attempt to obtain a positive IPRP* ***(1 mark)****. A disadvantage of Article 34 amendments is that you must pay an official fee.* ***(1 mark)*** *(Other reasonable advantages/disadvantages accepted)*

12 marks

b) *Not possible to enter French national phase **(0.5 marks)**, so file a European Patent application to cover both France and Germany **(0.5 marks)**. Enter regional phase early by completing all acts required **(0.5 marks)** and specifically requesting early processing **(0.5 marks)**. Respond to inventive step objections with arguments and/or amendments at regional phase entry **(1 mark)** and waive right to a communication under Rule 161(1) EPC **(1 mark)**. Request accelerated examination/PACE **(1 mark)**. File translations of claims into French and German **(0.5 marks)** and put third party on notice **(0.5 marks)**.*

*In Germany, file a utility model **(1 mark)** as lower bar for inventiveness **(1 mark)**.*

8 marks

Total: 20 marks

Question 10

Your client has invented a new and inventive medical procedure for treating broken bones within the human body. For each of following four countries, indicate whether your client can obtain patent protection for this medical procedure, and why.

a) **The USA**
b) **China**
c) **Australia**
d) **Germany**

4 marks

Your client has also developed a bone fixing plate, the shape of which is new and inventive.

e) **For each of the four countries listed above, indicate whether your client can obtain patent protection for this new and inventive bone fixing plate, and why.**

2 marks

Separately, your client holds a granted European patent application (**EP-A**) with a single claim directed towards a screw for connecting metal girders. **EP-A** was filed in January 2018, and claims priority from a German patent application (**DE-1**) filed in February 2017.

EP-A specifies it is essential the screw is at least 1 cm long to ensure it can adequately grip the girders, else the screw is completely ineffective. As such, the single claim of **EP-A** includes the limitation that the screw must be at least 1 cm long. **DE-1** does not mention screw length anywhere in the application. Otherwise the subject matter of **EP-A** and **DE-1** is identical.

Third party observations relevant to the patentability of **EP-A** have been filed at the European Patent Office. These observations state that **EP-A** lacks novelty over a journal article published in December 2017. The journal article was published by your client and describes a screw identical to that claimed in **EP-A**, including specifying that the screw must be at least 1 cm long. Your client informs you that it was very difficult to identify the minimum screw length, hence this information was not available at the time **DE-1** was filed.

Advise your client regarding:

f) **The validity of EP-A's priority claim.**

4 marks

g) **The relevance of the journal article as prior art.**

3 marks

h) **Removing the limitation whereby the screw has a length of at least 1 cm from the claim of EP-A.**

3 marks

i) **The prospect of EP-A proceeding to grant, in its present form or with amendments.**

3 marks

j) **The prospect of DE-1 proceeding to grant.**

1 mark

Total: 20 marks

Answer

a) *The USA: Yes, **(0.5 marks)** because methods of treating the human body are patentable subject matter. **(0.5 marks)***

b) *China: No, **(0.5 marks)** because method of treating the human body are not patentable subject matter. **(0.5 marks)***

c) *Australia: Yes, **(0.5 marks)** because methods of treating the human body are patentable subject matter (**0.5 marks)**.*

d) *Germany: No, **(0.5 marks)** because methods of treating the human body are not patentable subject matter. **(0.5 marks)**.*

4 marks

e) *Yes in all four **(1 mark)**. Obtaining patent protection for the device/apparatus is not excluded. **(1 mark)***

2 marks

f) ***EP-A** was filed within 12 months of **DE-1 (1 mark)**. However, **EP-A**'s claim to the priority date of **DE-1** is invalid **(1 mark)** as **DE-1** and **EP-A** are not the same invention/**DE-1** insufficiently discloses the invention **(1 mark)**. As such, **EP-A** can only validly claim January 2018 as its earliest date **(1 mark)**.*

4 marks

g) *The journal article was published before **EP-A**'s earliest date **(1 mark)**, and the journal article is available as prior art to challenge the novelty **(0.5 marks)** and inventiveness **(0.5 marks)** of **EP-A**. The journal article discloses a screw identical to that claimed in **EP-A**, so the claim of **EP-A** lacks novelty **(1 mark)**.*

3 marks

h) *The limitation of the screw having a length of at least 1 cm can only be removed from the claim if **EP-A** as filed contains basis for this amendment **(1 mark)** (Article 123(2) EPC). In any event, the screw length of 1 cm is described as being an essential feature of the invention, so its removal would render the claims unclear **(1 mark)** (Article 84 EPC). Therefore, the claim cannot be validly amended to remove this limitation **(1 mark)**.*

OR

*The limitation of the screw having a length of at least 1 cm can only be removed from the claim if **EP-A** as filed contains basis for this amendment **(1 mark)** (Article 123(2) EPC). In any event, removing the limitation of the screw having a length of at least 1 cm broadens the scope of the claim post grant, so its removal is not allowable (Article 123(3) EPC) **(1 mark)**. Therefore, the claim cannot be validly amended to remove this limitation **(1 mark)**.*

3 marks

a) ***EP-A*** *will not proceed to grant in its present form* ***(1 mark)****. The description of* ***EP-A*** *may include features that are novel and inventive over the journal article* ***(1 mark)****. This should be reviewed* ***(0.5 marks)*** *and the claim amended into a novel and inventive form if possible* ***(0.5 marks)****.*

OR

Any reasonable comments (up to ***3 marks****).*

3 marks

b) ***DE-1*** *will not proceed to grant as it is insufficient* ***(0.5 marks)*** *and cannot be validly amended into a sufficient form* ***(0.5 marks)****.*

1 mark

Total: 20 marks