

Foundation Certificate

FC3 International Patent Law

Thursday 21 October 2021

10:00 to 13:20 UK British Summer Time (GMT + 1 hour)

Examination time: 3 hours 20 minutes plus 10 minutes upload time

The 3 hours 20 minutes is allocated as follows:

10 minutes – Downloading and printing the question paper;

3 hours – Answering the questions;

10 minutes – Two screen breaks of 5 minutes each:

At 13.20 you MUST immediately stop answering the questions. You then have **10 minutes** in which to upload your Answer document to the PEBX system.

You MUST upload your Answer document to the PEBX system by 13.30. After 13.30 you will not be able to upload it and your examination will be void.

INSTRUCTIONS TO CANDIDATES

1. You should attempt **ALL** questions in Section A and any **three** questions in Section B.
2. The marks for each question in Section A are shown next to the question. Each question in Section B carries **20** marks.
3. If more than the required three questions are answered in Section B, only the first three presented will be marked.
4. The total number of marks available for this paper is 100.
5. You must use the Answer document for your answers.
6. Do not attempt to change the font style, font size, font colour, line spacing or any other preset formatting in the Answer document.
7. Start each question on a new page. To begin a new page, press the control key and the enter key simultaneously.
8. When you begin a new question, type in the question number at the top of the page.
9. Do not state your name anywhere in your answers.

This question paper consists of **8 sheets** in total, including this sheet.

AT THE END OF THE EXAMINATION

10. Upload your Answer document to the PEBX system. You should upload it as a Word document. PEBX will automatically convert it to PDF.

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 of the application.

3 marks

Total: 4 marks

Question 2

A United Kingdom patent application was filed on 1 September 2020, with the applicant making an enabling public disclosure of the contents of that application shortly after. No other patent applications have been filed. 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

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

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 1 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

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

Question 6

The grant of a Japanese patent is published in the official gazette on 1 August 2021. Your client wishes to oppose the grant of this Japanese patent.

a) 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 unidentified when opposing both the European and Japanese patents.

e) Explain to your client if it will be possible to oppose both patents without revealing their identity. **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 1 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, 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; and**
 - v) **New Zealand.**

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

11 marks

Freeze GmbH also own European patent application (EP1). EP1 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

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 *UK 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 in major markets, 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

Question 9

On 10 July 2020 you filed a PCT application, PCT1, 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, PCT2. PCT2 has an earliest priority date in January 2020 and was published, in English, in June 2021. PCT2 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.

Your client has become aware that a third party is selling an identical mobile phone charger to that claimed in PCT2 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

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