Paper Ref	Sheet	Percentage Mark Awarded
FC3	1 of 17	56%

Examiner's use only

Q1

a) Response should be filed at EPO within 4 months of notification of the report, i.e. the issue date + 4 months + 10 days for "postal delays".

So, the response must be filed by 1 November 2021 [not a weekend day, and so no next-working-day adjustment].

b) File a written request for an extension of time (which incurs no official fees). The applicant is entitled to an extension of 2 months as of right, if requested within 2 months of the expiry of the (original) time limit. Further extensions may be made upon request, at the discretion of the examiner (and so reasoning for a request for such a further extension should be provided), but this is in no way guaranteed and should not be employed if possible to avoid.

0.5

The extension may be requested with the response.

The consequence of requesting an extension is that the application will no longer be accelerated. Furthermore, acceleration may only be requested once at the examination stage (and once at search), so acceleration cannot be "restored" following this request.

1

1

2.5

MARKS AWARDED: 2.5/4

Page sub-total

Examiner's use only

Q2

'Standard' patent protection in Hong Kong may be obtained using Standard Patents "(R)" and "(O)".

A Standard Patent (R) is obtained by registration in HK of one of i) a UK patent application, ii) a CN patent application, or iii) an EP(UK) application.

Such registration takes place in two "stages"; registration of the application, and subsequently registration of the granted patent. In this way, the fate of a Hong Kong Standard Patent (R) is the same as the fate of its 'parent'.

The deadline for the first stage is within 6 months of publication of the application. The deadline for the second stage is within 6 months of publication of the decision to grant.

1

1 1

A Standard Patent (O) is obtained by direct filing with the Hong Kong IPD and involves a search and (substantive) examination. This route to protection is relatively recent.

However, to pursue a Standard Patent (O), the applicant would need to claim priority. The priority deadline fell due on 1 September 2021. Restoration is available in Hong Kong, but the applicant merely "now wishes" to seek protection in Hong Kong and so is unlikely to be eligible for restoration even under the "due care" standard.

0.5

Since the client has a UK application, they should pursue a Standard Patent (R).

1 4.5

Protection conferred by granted Standard Patents (R) and (O) are the same, and for the same term (20 years).

MARKS AWARDED: 4.5/6

Page sub-total

Q3

a)

- File translations of the claims (only) into English and French (the EPO languages, except German, which the application was filed in). 0.5 0.5
- Pay the grant and printing fees 1
- Pay the excess claims fees (there are 2 fees due, since fees are incurred for each 16th and subsequent claims) 0.5 0.5
- Approve the text for grant (in practice, this is considered done when the above acts are completed). ✓

… within 4 months of the R. 71(3) EPC communication, i.e. by January 2021.

b) Further processing fees are due in respect of each act that was not performed. In this case, four fees. The FP fee for non-payment of a fee is a further 50% of said fee. The fee for other acts is a flat charge.

c) The minor amendments must be submitted in writing by the deadline (4 months; January 2021). The amendments must be indicated and reasoned (of course, they must meet the normal requirements – no added matter, for instance). 0.5 0.5 1

It is no longer possible to waive further R. 71(3) EPC communications, so the Examining Division will either

i) if they are satisfied with the amendments, issue a further R. 71(3) EPC communication (with an updated Druckexemplar, possibly of course with yet further minor amendments); or 1

Examiner's use only

ii) resume examination of the application, issuing an examination report raising objections to the specification; or

1

iii) refuse the application (relatively rare)

7

MARKS AWARDED: 7/8

Page sub-total

Examiner's use only

Q4

a) Corrections must be dealt with centrally (the rO/ISA/IPEA may only have the application for a period of time) and so the competent authority is the International Bureau.

b) The competent authority will consider all of the documents available to it. They will also consider evidence submitted. 0.5

The correction must be obvious in light of the documents available. 0.5

The correction must be requested within the relevant time period.

c) Within 30 months of the international filing date.

MARKS AWARDED: 1/9

1

Page sub-total

Examiner's use only

Q5

The client may have not disclosed the mechanism if, for instance, the "result" of the mechanism was disclosed without revealing the inner workings. Also to be considered is the viewership and availability to the public of the disclosure: if the event had no attendees and the launch was not stored anywhere, then certain jurisdictions may not consider the mechanism disclosed for the purposes of obtaining valid patent protection

Further, in those jurisdictions that may *de jure* consider it disclosed, it may in fact be impossible to prove and so the client may be able to obtain patent protection. However, this would not consist of valid patent protection.

Japan: disclosures by the client will be covered by the grace period (within 1 year), but patent publications would not be (no problem in this instance). Valid patent protection will be possible to obtain. 1 1

Singapore: there is no grace period for disclosure in Singapore and so valid patent protection will not be possible to obtain.

South Africa: disclosures by the client will be covered by the grace period (1 year) and so valid patent protection will be possible to obtain.

2

MARKS AWARDED: 2/6

Page sub-total

Examiner's use only

Q6

a) Within 3 months from the date of grant of the JP patent.

b) Entitlement to the patent; novelty; inventiveness; contrary to public morality

c) Within 3 months of the date of grant (published in EP Bulletin).

d) Not clarity, not unity …

Patentability (novelty/inventive step); entitlement; sufficiency of disclosure; contrary to public policy/morality. ////

e) Yes (in principle), for both. Opposition can be filed on their behalf by a local agent. /

However, context may of course reveal who they are. 2.5

MARKS AWARDED: 2.5/7

Page sub-total

Examiner's use only

Q8

a) Applications for inventions of particular categories (military, nuclear power, naval ships, etc) must be first filed in the United Kingdom. If notice is received (within 6 weeks of application), then it cannot be filed outside of the UK. Notice may be withdrawn, however. /

Applications otherwise under a secrecy order must also not be filed outside of the UK.

b) Ms Jones demonstrated the details of how the lawnmower worked (herself; a non-abusive disclosure), and so has likely disclosed the invention for the purposes of considering prior art. /

Unless Ms Jones disclosed the lawnmower at an approved international exhibition, she will be unable to obtain valid patent protection via the EPC, since the EPC does not (otherwise) provide a grace period for disclosures by the applicant. If the disclosure was at such an exhibition, it must be declared on filing to the EPO. //

In the USA, Ms Jones can make use of a grace period of 12 months from disclosure to file an application. This must be declared. //

In Australia, Ms Jones can make use of a grace period of 12 months from disclosure to file an application. This must be declared. //

c) Many major markets (but excluding the UK and the EPO; although including many EPO member states) allow for utility patents (or equivalent). //

Utility patents normally have a lower "bar" for examination/inventiveness and so simple combinations of existing products are likely to achieve protection. Utility //

Page sub-total

patents also proceed to grant typically much quicker than "full" patents – even under a year in some jurisdictions – and are therefore more convenient for products in markets that "move quickly". Shorter prosecution time and a lower bar for examination inevitably means that they are cheaper, too, due to fewer attorney fees. //

However, utility patents typically last much less time than "full" patents – e.g. 8 years. Additionally, the protection conferred is often less (narrower) than that conferred by a "full" patent, given the lower bar for examination/inventiveness. // //

d) SMALL entity status, since she is named on 7 previous patent applications at the USPTO (disqualifying her from Micro status). // //

She will receive a 50% reduction in official fees.

She is eligible since she is an individual (not a business of 500 or more people) and she has not disqualified herself in her licence, since it was to a not-for-profit organisation. If it had been to an organisation that did not itself qualify for small entity status (not-for-profit, business >500 employees, individual), she would not be eligible. // //

16.5

MARKS AWARDED: 16.5/20

Examiner's use only

Q9

a)

Client may either proceed with PCT Chapter I (no international examination) or Chapter II (file a demand; international examination by IPEA).

PCT Chapter I will permit the filing of A. 19 PCT amendments. These are amendments to the claims only, but are not further considered by the ISA (i.e. no further written opinion must be issued). //

A. 19 PCT amendments must be filed by 22 months from the priority date, i.e. 22 months from the filing date for PCT1, or 10 May 2022. //

PCT Chapter II requires the filing of a demand by 22 months from the priority date (10 May 2022). Following this, the elected IPEA will examine the application.

PCT Chapter II will permit the filing of A. 34 PCT amendments, which can include amendments to the claims, description and drawings. These amendments must be filed after filing of a demand (but before the international phase ends). However, the IPEA does not have to take them into account if they have already begun examination. As such, if the applicant wishes for these amendments to be examined, they should be submitted promptly after the demand is filed. //

Filing A. 19 PCT amendments under Chapter I allows response without risk of further negative feedback at the international phase, if that is of concern. Such A. 19 amendments may then be taken forward into the national phase (although this must often be specified). However, if feedback in response to amendment is //

Page sub-total

likely to bolster your case at the national phase, then this may actually be a disadvantage, since national authorities will not be influenced by such feedback.

Filing A. 34 PCT amendments under Chapter II allows such further feedback, which provides an opportunity for an early positive opinion to be declared. This can influence national examiners in their own examination procedures. It can also be, simply, an opportunity for the applicant to receive early feedback (which may influence their decision to pursue the application at the national stage, or to pursue it in certain 'stricter' territories). //

However, examination under Chapter II (and, of course, the issued opinion under Chapter I) is non-binding on national offices. A positive response by the IPEA (or ISA) does not guarantee a positive response by a national office (even if that office is the same as IPEA/ISA that issued the original examination/opinion!). //

As such, Chapter II may also be seen as an unnecessary expense and, in the context of early entry into the national phase, an unnecessary delay.

b)

French and German translations of the claims should be obtained and either sent directly to the third party or submitted to the IB. This will allow damages to begin accruing in respect of the published application, assuming the claims infringed are substantially the same as they are when eventually granted (which is likely to be true IF the client's beliefs are correct). / /

In order to actually take action, however, the client must have a granted patent in the territories concerned.

Examiner's use only

One cannot directly enter the national phase in France; only through a Euro-PCT filing. You can directly enter the national phase in Germany. /

/

In light of this, we should enter the European Regional Phase early and explicitly request early entry (otherwise EPO will take no action until 31-month date), as well as completing the required acts and paying the required fees (no translations required, since English is an official language of the EPO – however, aforementioned French and German claims should be forwarded to the EPO). /

/

Acceleration should be requested once for search and subsequently for examination and the client should avoid employing any extension periods to maintain the accelerated status. //

This should lead to a (relatively) quick grant at the EPO, allowing subsequent validation in Germany and France and infringement action to be taken against the third party.

Another consideration should be the location of manufacture of the mobile phone charger – perhaps the client should also pursue early entry into the country of manufacture.

The client could also consider sending notice to the third party that the PCT application (and any subsequent national/region phase applications as discussed above) exists. Care should be taken to avoid this being classed as an unjustified threat.

The client may also benefit, prior to all of this, from considering whether their mobile phone charger is in fact inventive, and whether the third party arrived at the identical design independently (and therefore might have the right to

Page sub-total

Examiner's use only

continued use – or worse, might have published material which comprises prior art not found by the EPO as ISA).

12

MARKS AWARDED: 12/20

Page sub-total

Examiner's use only

Q10

A medical procedure amounts to a method.

a) Yes. Methods of treatment of the human body are not excluded from being patented in the USA. //

b) Yes. Methods of treatment of the human body are not excluded from being patented in China.

c) No. Methods of treatment of the human body are excluded from being patented in Australia.

d) No. Methods of treatment of the human body are excluded from being patented in Germany (mirroring EPC). //

e) Yes to all of them – those countries that exclude methods of treatment of the human body (or animal body, in some jurisdictions) exclude only methods, not products. The bone fixing plate is a product. // //

f) EP-A's priority claim is valid, since it was filed within the priority period (12 months from earliest claimed priority), but only for the portion of the subject matter that is identical to DE-1. Since EP-A specifies that "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", this portion of the specification does not benefit from the priority claim. //

Page sub-total

However, the limitation in the claim is not additional subject matter per-se, since it is narrower than the original claim which included screws of all lengths. As such, the claim benefits from the claimed priority.

Partial priority is allowed at the EPO.

g) The journal article was published after the priority date but before the filing date of EP-A. As such, it is relevant only to any subject matter that is not covered by the claimed priority (DE-1), i.e. matter that was added on filing. //

Since the specification of EP-A has additional matter compared with DE-1 (that "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"), the journal article is relevant as prior art to this subject matter.

The journal article is not relevant to the claim as prior art.

h) EP-A is a granted European Patent, according to the question.

Amendments post-grant must 1) not introduce additional matter and 2) not extend the protection of the patent.

The limitation that the screw has a length of at least 1 cm is, as stated, a limitation. A claim that allows a screw of any length is broader. While this claim amendment would not add matter to the specification as filed (and would benefit from priority), it would extend the protection conferred by the patent and as such is not allowed under the EPC. //

i) Once again, EP-A is a **granted** European Patent, according to the question. The prospect of EP-A proceeding to grant is nothing – it has already granted.

For the sake of not losing points, proceeding of a hypothetical un-granted application of the current form, without amendment, is unlikely since there would be added matter in the application (compared with the priority claim).

Proceeding of a hypothetical un-granted application of an amended form might be possible, since (as discussed in h) the claim does not add matter by specifying "at least one 1 cm long, and since it is not granted it does not need to avoid extending protection of the patent. The description would need to be amended to exclude the statement that "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" to avoid an added matter objection.

While such an invention might be "completely ineffective", it may nonetheless proceed to grant since "do all potential permutations of this invention actually work?" is not examined. Indeed, the skilled person will under that a screw for connecting metal girders will be of considerable length – I suspect the metal used in a girder is of such thickness to require screws in excess of 1 cm anyway, for instance.

However, the application might lack support for such a limitation, since the description would have been amended to exclude the supporting paragraph. An argument based on common general knowledge would need to be made – a difficult argument, given the client told us "it was very difficult to identify the minimum screw length …".

//

Examiner's use only

j) For the reasons in i), particularly that whether or not all of the particular permutations of the invention work is not examined, it is likely to proceed to grant if it fulfils patentability requirements. This is backed up by the fact that EP-A has already proceeded to grant.

8

MARKS AWARDED: 8/20

Page sub-total