Paper Ref	Sheet	Percentage Mark Awarded
FC3	1 of 16	64%

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Question 1:

a) Under normal circumstances the applicant would have 10 days + 4 months to respond to the communication (ie. 2 November 2021); however, in order to remain under "accelerated examination", the applicant should not use the 10-day postal rule and should file a response within the 4 month deadline (ie. 22 October 2021).

b) The applicant could request an as-of-right 2 month extension by writing to the EPO before 2 November 2021. This will extend the deadline until 2 January 2022. The application will no longer be part of the PACE program and examination will occur at the "normal" speed (ie. no obligation for EPO to respond within 3 months of a response filed by the applicant).

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Question 2:

To obtain standard patent protection in Hong Kong, the applicant must enter via either the GB, CN or EPO(GB) route. Because the applicant has made an enabling disclosure, it important that a subsequent application is filed claiming priority from the UK application. The filing date was more than 12 months ago but within 14 months. Therefore, the right to priority must be restored in order to avoid the enable disclosure becoming part of the state of the art and therefore being novelty destroying. Therefore, before 1 November 2021 the applicant should file another patent application supported by the earlier disclosure of the UK application in China, UK or Europe and apply for restoration of priority by paying a fee and providing a reason/ evidence for the delay. The applicant must then complete HK Stage 1 registration within 6 months of the publication of the application and Stage 2 registration within 6 months of the grant. Associated fees for the two stages will be due.

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Question 3:

a) Within the next 10 days + 4 months (by January 2022), the applicant muts:

- Approve the text intended for grant (DruckExemplar)
- Pay the grant fee and printing fee — 1
- Pay any outstanding renewal fees, designation fees and excess page fees
- Provide a translation of the claims in English and in French — 0.5 0.5
- Pay 2 excess claim fees (due on the set of 17 claims) — 0.5 0.5

b) In the scenario, the number of further processing fees would be:

1. Omitted act (non-approval of text) → flat fee

2. Omitted act (not providing the translations) → flat fee

3. Unpaid fee (Print fee) →Surcharge (fee + 50%)

4. Unpaid fee (Grant fee) →Surcharge (fee + 50%)

5. Unpaid fee (Excess claim fees) →Surcharge (fee + 50%)

c) If the applicant wants to request changes, then he should respond to the R71(3) communication within the 10 days + 4 months deadline and disapprove — 0.5
the text intended for grant and provide his an amended version of the text with — 0.5
clear mark-up. He can also provide a short response to explain the amendments — 1
and must specify the basis for these changes in the application as filed. These amendments must not add matter. If the ED is satisfied that these amendments are acceptable, they will issue another Notice of Intention to grant (R71(3)) and — 1
the process is reset (ie. further 4 months to fulfil the requirements for grant). If the ED is not satisfied that the amendments are acceptable then they will issue

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an examination report (Art. 94(3)) communication and set a deadline for response (usually 4 + 2 months). Previously, the applicant would have been allowed to waive the right to receive a subsequent R71(3) communication when re-submitting minor amendments, but this is no longer the case.

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Question 4:

a) The competent authority is the International Bureau (IB) because the timeline is now in the later stages of the international application (ie. 24-25 months from the filing date) and the application has been transmitted to the IB and they will be preparing the IPRP.

b) The criteria for correcting an error is that the error must be obvious meaning that nothing other than what is provided as a correction could have been intended. However, here the typographical error is in a document related to the application, the application itself and therefore this criteria doesn't necessarily apply. The documents required would be evidence of the correct identity of the applicant and providing evidence that this was done unintentionally.

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c) The deadline for submitting the request for correction would be 26 months from the filing date (ie. 1 December 2021).

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Question 5:

In Japan, there is a twelve month grace period for the applicant's own disclosure, providing that the disclosure was not published in a patent journal. In this situation the disclosure is an "online product launch" and therefore it doesn't appear to have been published in a patent journal. However, we are not told how long ago the disclosure occurred. Providing that the online product launch was less than a year ago, the client can obtain valid patent protection in Japan. To do so he must provide details of the disclosure to the JPO within 30 days of filing the patent application.

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In Singapore, there is no grace period for an applicant's own disclosure and therefore even though the client can file a Singapore patent application, the disclosure at the online product launch would be treated as novelty-destroying prior art.

In South Africa, there is grace period for the applicant's own disclosure providing the disclosure related to experimentation and happened in South Africa. There is no time limitation of the grace period and therefore the disclosure could have happened at any point before the filing date. Moreover, South African patent applications does not undergo substantive examination however basic novelty will be assessed. As the online product launch is not an experiment that happened in South Africa, it would be novelty- destroying.

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Question 6:

a) An opposition in Japan must be filed within 6 months from the grant date (ie. 1 February 2022). //

b) The possible grounds for opposition are:

- that the patent does not meet the requirements of patentability (novelty, inventive step, industrial applicability) /

- that the subject matter of the patent is not disclosed in a way that this clear enough and complete enough for the person skilled in the art to work the invention (sufficiency/ enablement/ written disclosure) /

- that there is an issue of double-patenting /

- that the scope of protection extends beyond disclosures in the application as filed (Added matter) /

c) An opposition in Europe must be filed within 9 months of the grant date (ie. 30 April 2021). //

d) The possible ground for opposition are:

- that the patent does not meet the requirements of patentability (novelty, inventive step, industrial applicability) ///

- that the subject matter of the patent is not disclosed in a way that this clear enough and complete enough for the person skilled in the art to work the invention (sufficiency) /

- that the scope of protection extends beyond disclosures in the application as filed (Added matter)

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- that amendments have widened the scope of protection that was allowed at garnt (broadening amendments)

- that the proprietor is not entitled to own the patent (Entitlement)

e) In Europe, it is possible to remain unidentified when opposing a patent by filing the request to oppose under a "nominal" status (ie. as a strawman). In Japan the opponents are not allowed to remain anonymous and must provide their identity when requesting opposition.

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Question 7:

a) For PCT1 to validly claim priority from US1, PCT1 must be filed before the end of the twelve-month priority period (ie. 1 December 2021) and the priority must be declared by 16 months from priority or 4 months from the international filing (ie. 1 April 2022). To validly claim priority, the applicant on the subsequent filing (PCT1) must the same as the applicant on the earlier application (US1). Therefore, because Freeze GmbH wishes to file PCT1 in its own name, Chilly Inc. must assign their rights as sole applicant over to Freeze. A valid assignment must be recorded before the filing of the international application. //

b) Freeze GmbH is a German company and competency is assessed on the nationality/ residence of the natural or legal person. Therefore the competent ISA is the European Patent Office (EPO). //

c) The deadlines are as follows:

	Deadline for NPE	*Deadline for requesting examination*
Brazil	30 months from priority (22 October 2021)	International filing date + 48 months (22 April 2024)
China	30 months from priority (22 October 2021)	International filing date + 3 years (22 April 2023)
South Korea	31 months from priority	Priority date + 5 years

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	(22 November 2021)	(22 April 2024)
USA	30 months from priority (22 October 2021)	On entering national phase (22 October 2021)
New Zealand	31 months from priority (22 November 2021)	International filing date + 3 years (22 April 2023)

d) Freeze GmbH need to:

A) (i) Express their wish to continue prosecution and (ii) respond to the objections raised in the written opinion in response to the Rule 70 communication which will set a 10 days + 6 months deadline for responding (not 6 months from publication of the search report, as this is not a divisional). This will likely fall before the end of 2021, as the Rule 70 communication is issued shortly after publication of the ESR. Freeze GmbH can also make amendments to the application during this period.

B) (i) Request substantive examination and (ii) pay the examination fee within 6 months from the publication of the search report (ie. 21 November 2021).

C) Pay the designation fee for all the contracting states selected and any extensions and/or validation states.

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Question 8:

a) An application which is made by a natural or legal person residing or whose primary place of business is inside the UK and wherein the subject matter of the application relates to military equipment/ techniques or is relevant to public safety or national security cannot be filed outside of the UK as a first filing, without prior permission from the Secretary of State. Such applications must be first in the UK and only after 6 weeks, can the applicant apply for permission if they wish to file overseas. Only once the permission has been granted, can a foreign filing be made. If the applicant does not respect this, it is considered a criminal offence.

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b) It is possible to obtain valid patent protection in the USA and in Australia as they both have a grace period of twelve month for the applicant's own disclosure. Because Ms Jones publicly disclosed this last week, it is well within twelve month period.

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The EPC has a 6 months grace period for abusive disclosure made by someone other than the applicant or an applicant's own disclosure at recognised international exhibition. There is no twelve month grace period for an applicant's own disclosures (like there is in the US or Australia). Therefore if Ms Jones can show that the disclosure happened at a recognised exhibition and provides a certificate on filing, she could obtain valid patent protection as the disclosure happened last week (so still within the 6-month grace period). However, if the public disclosure was at not non-recognised trade show, then she will not be able to obtain valid patent protection, as the earlier disclosure/ use will be treated as novelty-destroying prior art.

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c) Another form of IP that Ms Jones could apply for is a utility model, which she could apply for in China, Brazil, Germany among others. Type of IPP right allows for protection of a new innovative product and/or process (depending on the territory) which is an "incremental" change to a pre-existing product or process. //

Two advantages of utility models are that registration/ prosecution is much faster than for patents (usually because there is no substantive examination. Another advantages is that the threshold for inventive step is much lower than it is for patents. //

Two disadvantages of utility models are that their term is shorter (eg. 10 years) compared to a patent term (ie. 20 years). Another disadvantage is that, in some territories, the duration of grace period for applicant's own disclosure is usually shorter as well (6 months for utility models vs. 12 months for patents). Therefore the intervening prior art for assessing novelty may be different. //

d) I would advise Ms Jones to use the "small" entity status when filing her application at the USPTO, as will receive a 50% reduction on the fees. One requirement for eligibility as a small entity status is a company (and its subsidiaries) of less than 500 employees. Ms Jones is a lone applicant (perhaps sole trader) and therefore satisfies this. Another requirement is that the application must not have been or be intended to be assigned, conveyed, granted, or licensed to a body that does not satisfy the criteria of small or micro entity status. In this case, the application was recently exclusively licensed to a not-for-profit research foundation. The fact it was exclusively licensed indicates that a future license agreement would not occur and the body it was licensed to would satisfy the criteria for a micro entity. //

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Had Ms Jones had less than four previously filed patent applications the USPTO she currently has seven), I would have suggested here using the micro entity status for filing her new patent application in order to get a further 25% reduction of the feed. She would likely be satisfy the other criteria for micro entity status (satisfying the small entity status, having a gross income of 3X less than the median household income of the preceding year, not having licenced to any other body who doesn't satisfy the micro entity status).

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Question 9:

The first option available for amending the application in response to the objection raised during the international phase is the Chap I Article 19 amendments. Amendments to the claims only and short observations (<500 words) may be filed within the latest of 16 months from priority or 2 months from the transmittal of the ISR-WO. In this case, PCT1 does not claim priority to an earlier application, therefore the deadline is 29 March 2021. This is not a hard deadline, as the IB is quite lenient as will accept if the Art. 19 amendments are submitted before the technical preparation for publication (15 days before the first Thursday following priority date + 18 months). The advantages of Art.19 amendments is that they will be included in the published version of the PCT application. This is particularly useful when planning on entering the national phase in countries where excess claims fees are calculated based on the published version of the application. Another advantage is that no further (potentially negative) opinion is provided by the ISA in relation to these amendments. A disadvantage of Art.19 amendments, is that you can only amend the claims and not the rest of the application. If you want to amend the application it is necessary to file a demand and use the Article 34 amendment provision (see below). Another disadvantage is that there is very little time (only 2 months) between the transmittal of the search report and written opinion and the deadline for filing the claim amendments.

The second option available for amending the application in response to the objection raised during the international phase is the Chap II Article 34 amendments. These allow for amendments the whole application to be made, as

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well as responding to objections in the ISR-WO and can very useful when a negative written opinion has been raised (for example, in our client's case). To be allowed to file these amendments, a demand for preliminary examination must be filed by the latest of 22 months from priority or 3 months from the transmittal of the ISR-WO. In this case, PCT1 does not claim priority to an earlier application, therefore the deadline is 29 April 2021. Article 34 amendments can be filed at any time during the Chap II preliminary examination, but if filed close to the deadline for establishment of the International preliminary report on patentability (at 28 months from priority or 6 months from the demand) they may not be considered. The advantages of the Art.34 amendments is that you can amend any part of the application (not just the claims), you also have more time (~6 months) to file the amendments, and multiple rounds of amendments can filed (taking into accounts the written opinion of the international preliminary examination report). Another advantage of these amendments is that you may get opinion from the international preliminary examination authority in reponse to the amendments. If these are positive, you could use them in subsequent prosecution but these if these are negative, it is not too important as they are non-binding. Disadvantages of Art.34 amendments are that the whole Chap II demand procedure can become very expensive and because the IPEAs opinion is non-binding, it may not be worth the extra expense. Additionally, because different national patent offices have different standard for added matter, there is a risk that amendment may be deemed inadmissible.

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b) Because France cannot be entered directly through the PCT route, I would advise the client to enter the regional EP phase by 31 months (ie. August 2022), ideally sooner. Patent protection could be obtained for both Germany and France. The application has been published which marks the start of provisional protections. I would advise the client to translate the claims of the patent application in both French and German and send these to the suspected in infringers saying that the clients has rights conferred under a patent application. I would ensure that the client is not threatening the suspected infringers in case they file for a actionable unjustified threat.

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