

FC3 – International Patent Law  
FINAL Mark Scheme 2022

SECTION A

Question 1

Your UK based client employs 75 people and is looking to file a new US patent application, **US-1**, claiming priority from a UK patent application, **GB-1**. **US-1** is not subject to any licencing agreements.

a) Explain whether your client qualifies for ‘small entity status’ at the USPTO.

2 marks

b) Define ‘micro entity status’ according to US law.

3 marks

The UKIPO issues a search report in relation to **GB-1**. This search report cites an article from a scientific journal, a US patent application and a European patent application in German.

c) What is the purpose of filing an information disclosure statement at the USPTO?

1 mark

d) What documents should accompany the information disclosure statement filed at the USPTO in relation to **US-1**?

3 marks

Total: 9 marks

Answer

a) *Happy Limited will qualify for small entity status (0.5 marks) as it employs less than 500 people (0.5 marks) and has not licensed, assigned or agreed to assign US-1 to a large entity (1 mark).*

2 marks

b) *A micro entity is an entity that qualifies as a small entity (0.5 marks) for each named applicant and inventor (0.5 marks). Additionally, each named applicant and inventor must not be named on more than four previously filed US applications (0.5 marks); have a gross income less than three times the median household income in the US in the preceding year (0.5 marks); not be under an obligation to assign, grant, or convey a license or other ownership to another entity that does not meet the same income requirements (0.5 marks); or, applicants who are employed by an institute of higher education (i.e. a university) and have assigned, or are obligated to assign, ownership to that institute of higher education (0.5 marks).*

3 marks

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- c) *To disclose all information relevant to the patentability of the application (0.5 marks) of which the applicant is aware (0.5 marks)*

**1 mark**

- d) *A copy of the article (0.5 marks), a copy of the EP patent application (0.5 marks) with an English translation of at least its abstract or a copy of an English language equivalent (1 mark), a copy of the US patent application **OR** the application number or publication number of the US patent application (1 mark).*

**3 marks**

**Total: 9 marks**

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**Question 2**

Your client is the owner of **EP-1**, a European patent application. The examining division issue a decision to refuse **EP-1** dated 22 August 2022. Your client instructs you not to pay the appeal fee, but to file a divisional patent application.

- a) **When is the deadline to file the divisional patent application? Explain your reasoning.**

**3 marks**

When filing the divisional patent application, your client wishes to include some additional information describing new features of the invention not contained in **EP-1**.

- b) **Explain to your client the consequences of including this additional information in the divisional patent application.**

**2 marks**

Your client is the owner of a separate European patent application, **EP-2**. **EP-2** was filed on 01 January 2018, and the renewal fee due on 01 January 2022 was not paid before the due date, or during the extended period. **EP-3**, a divisional of **EP-2** was filed in May 2022.

- c) **Explain, with reasons, if EP-3 was validly filed.**

**3 marks**

**Total: 8 marks**

**Answer**

- a) *EP-1 may be used to file a divisional patent application whilst it remains **pending** before the EPO (1 mark). EP-1 remains pending until the time limit for filing the notice of appeal (G1/09) (1 mark). Therefore, the deadline for filing the divisional is 22 August + 10 days + 2 months = 01 November 2022 (1 mark).*

**3 marks**

- b) *A divisional patent application cannot extend beyond the content of the earlier application as filed (Article 76(1) EPC) (1 mark). As such, the Examiner will object to the inclusion of this additional information in the divisional patent application (1 mark).*

**2 marks**

- c) *EP-3 was validly filed (1 mark). In the event of a renewal fee not being paid by the due date, the application is pending up to the last day of the six-month period for payment of the renewal fee with an additional fee (Rule 51(2), first sentence) (1 mark). Deemed withdrawal of the application takes effect on expiry of the six-month period (Rule 51(2), second sentence) (1 mark).*

**3 marks**

**Total: 8 marks**

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**Question 3**

Company A is seeking to file a PCT patent application that does not claim priority from an earlier application.

- a) **Identify the minimum requirements to obtain a filing date.**

**4 marks**

After filing the PCT patent application in English, Company A is interested in obtaining patent protection in Japan, Mexico and Australia.

- b) **What is the deadline for entering the national phase in each one of Japan, Mexico and Australia?**

**3 marks**

- c) **Into which language, if any, must a translation of the application be filed in each one of Japan, Mexico and Australia?**

**3 marks**

**Total: 10 marks**

**Answer**

- a) *At least one applicant is entitled to file a patent application under the Patent Cooperation Treaty (1 mark), the description and claims are in a language accepted by the International Bureau (1 mark), an indication that the application is intended to be an international application (0.5 marks), identification of the applicant (0.5 marks), a description (0.5 marks), and one or more claims (0.5 marks).*

**4 marks**

- b) *Japan - 30 months from the **filing** date (as no priority claimed) (1 mark).  
Mexico - 30 months from the **filing** date (as no priority claimed) (1 mark).  
Australia - 31 months from the **filing** date (as no priority claimed) (1 mark).*

**3 marks**

- c) *Japan – Japanese (1 mark)  
Mexico – Spanish (1 mark)  
Australia – **No translation required** as the PCT application was filed in English (1 mark)*

**3 marks**

**Total: 10 marks**

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**Question 4**

Steamy Ltd is a manufacturer that has developed an innovative new steam iron. Steamy Ltd wishes to apply for patent protection, but inform you that they first sold the new steam irons seven months ago.

**Advise, with reasons, Steamy Ltd on the possibility of obtaining valid patent protection for the steam iron invention in the following countries.**

- **Argentina**
- **Japan**
- **China**
- **South Africa**
- **Australia**

**5 marks**

**Total: 5 marks**

**Answer**

**Argentina** – Yes, valid patent protection could be obtained (**0.5 marks**) as Argentina has a 12 month grace period for disclosures made by the applicant (**0.5 marks**).

**Japan** - Yes, valid patent protection could be obtained (**0.5 marks**) as Japan has a 12 month grace period for disclosures made by the applicant (**0.5 marks**).

**China** - No, valid patent protection cannot be obtained (**0.5 marks**) as China has no relevant grace period (**0.5 marks**).

**South Africa** - No, valid patent protection cannot be obtained (**0.5 marks**) as South Africa has no relevant grace period **as the disclosure of the steam iron was not a reasonable trial** (**0.5 marks**).

**Australia** - Yes, valid patent protection could be obtained (**0.5 marks**) as Australia has a 12 month grace period for disclosures made by the applicant (**0.5 marks**).

**Total: 5 marks**

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**Question 5**

Your client is concerned by a competitor's European patent, **EP-Z**. **EP-Z** was filed on 01 March 2017 without a claim to priority, and the grant of **EP-Z** was published on 23 September 2022. Your client wishes to oppose **EP-Z**.

- a) **What is the deadline for filing an opposition against EP-Z at the European Patent Office?**

**1 mark**

In preparation for filing the opposition, you conduct a search and identify the following documents highly relevant to the patentability of **EP-Z**.

- **US-X**, a US patent application with an earliest priority date of 01 February 2017 and a publication date of 01 August 2018.
- **EP-X**, a European patent application with an earliest priority date of 01 January 2016 and a publication date of 01 July 2017.
- **PCT-X**, a PCT patent application with an earliest priority date of 10 February 2017 and a publication date of 10 August 2018. **PCT-X** did not enter the European regional phase.
- **GB-X**, a UK patent application published in 1990.

- b) **Advise your client to what extent each of US-X, EP-X, PCT-X and GB-X can be used to challenge the novelty and inventiveness of EP-Z in the forthcoming opposition proceedings. Explain your reasoning.**

**7 marks**

**Total: 8 marks**

**Answer**

- a) *23 September 2022 + 9 months = 23 June 2023. (1 mark)*

**1 mark**

- b) *US-X was published after the filing date (earliest priority date) of EP-Z (0.5 marks), so cannot be used in opposition proceedings. (0.5 marks).*

*EP-X has an earlier priority date than EP-Z (0.5 marks), but was published after EP-Z's filing date (earliest priority date) (0.5 marks). As a co-pending **European** patent application (1 mark), EP-X is relevant to the novelty (0.5 marks) of EP-Z, but not the inventive step of EP-Z (0.5 marks).*

*PCT-X has an earlier priority date than EP-Z (0.5 marks), but was published after EP-Z's filing date (earliest priority date) (0.5 marks). However, PCT-X did not enter the European regional phase so cannot be used in opposition proceedings (0.5 marks).*

*GB-X was published before the filing date (earliest priority date) of EP-Z (0.5 marks), so is relevant to both the novelty (0.5 marks) and inventive step of EP-Z (0.5 marks).*

**7 marks**

**Total: 8 marks**

**SECTION A TOTAL: 40 Marks**

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**SECTION B**

**Question 6**

Your client, Ms Day, has recently acquired several granted patents and patent applications. Among these rights is **DE-B**, a German patent application with a filing date of 21 October 2020.

- a) In relation to **DE-B**, advise Ms Day regarding:
- (i) the deadline for payment of the first renewal fee; and
  - (ii) the deadline for requesting substantive examination.

**2 marks**

Also among the acquired rights is a US patent, **US-B**. **US-B** has a filing date of 12 August 2017 and a grant date of 07 February 2021. You review the file and note **US-B** is not subject to a terminal disclaimer or patent term adjustment.

- b) In relation to **US-B**, advise Ms Day regarding:
- (i) the expiry date of **US-B**; and
  - (ii) the deadline for paying each of the renewal fees due before the expiry date.

**5 marks**

Ms Day reviews **US-B**, and states that **US-B** claims an invention almost identical to a product sold in 2010. Ms Day provides a printed copy of a manual describing the workings of the product in detail, and informs you the product would also have been used in public. Ms Day is concerned about the validity of **US-B**.

- c) Advise Ms Day how, if at all:
- (i) the product manual; and
  - (ii) the public prior use of the product;

**may be used by a competitor to attack the validity of US-B at the USPTO.**

**5 marks**

The new rights acquired by Ms Day include **EP-B**, a pending European patent application. Ms Day has reviewed **EP-B**, and considers it is of no commercial interest. A first examination report was issued in relation to **EP-B** on 28 September 2022, setting a four-month deadline for response. Ms Day instructs you to take any action required to terminate the prosecution of **EP-B** and obtain the maximum possible fee refund.

- d) Describe the actions you would undertake and the fee refund, if any, you would receive (no monetary amount is expected).

**3 marks**

- e) Finally, the rights acquired by Ms Day include a UK patent application, **GB-B** filed on 21 October 2021 without a claim to priority. **GB-B** protects a commercially successful product and your client wishes to seek protection in all major markets, including in Taiwan. Advise Ms Day on the immediate steps necessary to seek the desired patent protection.

**5 marks**

**Total: 20 marks**

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**Answer**

- a) *The first renewal fee is due at the end of the month containing the second anniversary of filing (0.5 marks), so 31 October 2022 (0.5 marks).*

*The deadline for requesting substantive examination (and paying the examination fee) is seven years from the filing date (0.5 marks), so 21 October 2027 (0.5 marks).*

**2 marks**

- b) *US-B will expire 20 years after the filing date (0.5 marks), so 12 August 2037 (0.5 marks).*

*The renewal fees are due 3.5 (0.5 marks), 7.5 (0.5 marks) and 11.5 years (0.5 marks) from grant (1 mark), so 07 August 2024 (0.5 marks), 07 August 2028 (0.5 marks) and 07 August 2032 (0.5 marks).*

**5 marks**

- c) *As it is more than nine months since the patent was issued (1 mark), the validity of US-B may be attacked using Inter Partes Review (or Ex Partes Reexamination) (1 mark). The validity of the patent may be attacked on the grounds of novelty (0.5 marks) and obviousness (0.5 marks). Only printed subject matter can be used in Inter Partes Review (or Ex Partes Reexamination) (1 mark). Therefore, the product manual may be used to attack the validity of US-B (0.5 marks), but the public prior use of the product may not (0.5 marks).*

**5 marks**

- d) *If EP-B is withdrawn (0.5 marks) before the deadline for response to the examination report (0.5 marks), then a 50% (0.5 marks) refund of the examination fee (0.5 marks) would be received. Therefore, withdraw EP-B before 28 September + 10 days +4 months - 08 February 2023 (1 mark)*

**3 marks**

- e) *File a PCT patent application (0.5 marks) claiming priority from GB-B (0.5 marks) on or before 21 October 2022 (1 mark). Taiwan is not a PCT state (1 mark), so file a Taiwanese patent application (0.5 marks) claiming priority from GB-B (0.5 marks) on or before 21 October 2022 (1 mark)*

**5 marks**

**Total: 20 marks**



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**Question 7**

For each of the following independent scenarios, explain whether your client's invention would be patentable:

- in China;
- in Singapore; and
- before the EPO.

In each case assume there is no relevant prior art and no other patentability issues.

- a) **Your client's invention is a business method.** **3 marks**
- b) **Your client's invention is a method for treatment of the human body.** **3 marks**
- c) **Your client's invention is a scientific theory.** **3 marks**

Your client, Mr Biz, is a UK national resident in the UK and is looking to file a new PCT patent application, **PCT-Y**, for a business method.

- d) **Name three competent receiving offices for PCT-Y.** **3 marks**
- e) **Name the competent international searching authority for PCT-Y, and explain if the application will be searched.** **3 marks**

Mr Biz has previously filed another PCT patent application, **PCT-W**. Mr Biz recently received the international search report, and was very dissatisfied with its thoroughness. Mr Biz has informed you he would like a further search performed before the deadline for filing any national phase patent applications.

- f) **Advise Mr Biz on how he may obtain a further search of PCT-W, and any associated deadlines.** **5 marks**

**Total: 20 marks**

**Answer**

- a) *No, business methods are not patentable in China (1 mark).  
Yes, business methods are patentable in Singapore (1 mark).  
No, business methods are not patentable at the EPO (1 mark).* **3 marks**
- b) *No, methods of treatment of the human body are not patentable in China (1 mark).  
No, methods of treatment of the human body are not patentable in Singapore (1 mark).*

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*No, methods of treatment of the human body are not patentable at the EPO (1 mark).*

**3 marks**

- c) *No, scientific theories are not patentable in China (1 mark).  
No, scientific theories are not patentable in Singapore (1 mark).  
No, scientific theories are not patentable before the EPO (1 mark).*

**3 marks**

- d) *The UKIPO (1 mark), the EPO (1 mark) and the International Bureau (1 mark).*

**3 marks**

- e) *The EPO is the competent ISA (1 mark). The application will not be searched (1 mark) as the EPO will not search an application to the extent that its subject-matter relates to no more than a method of doing business (1 mark) (PCT Applicant's Guide – International Phase – Annex D).*

**3 marks**

- f) *Mr Biz may obtain a further search of PCT-W by requesting a supplementary international search (1 mark). To request a supplementary international search, we must select a **suitable** supplementary international searching authority (0.5 marks) that did not perform the original international search (1 mark) and pay the necessary fee (0.5 marks). The request for supplementary international search must be filed within 22 months of the priority date (1 mark)(Rule 45bis.1(a)), and the fee paid within one month of filing the request (1 mark)(Rule 45bis.3(c)).*

**5 marks**

**Total: 20 marks**

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**Question 8**

Your client, Bouncy GmbH, self-filed a European patent application, **EP-M**, with no claim to priority on 17 July 2022. After appointing yourself as representative, you review the claims of **EP-M** as filed.

Claims 1 to 5 of **EP-M** focus on a pogo stick that can be folded away and stored.

Claims 6 to 10 of **EP-M** focus on a method of manufacturing a rubber ball.

- a) Explain to Bouncy GmbH the requirements for unity of invention at the EPO, and if the claims of EP-M meet this requirement.**

**3 marks**

You receive a first communication from the Examiner relating to the search of **EP-M**.

- b) Which, if any, of the claims have been searched? Explain your reasoning.**

**2 marks**

Upon further review of **EP-M** you note no designation of inventor has been filed.

- c) By when must a designation of inventor be filed at the EPO for EP-M?**

**1 mark**

Bouncy GmbH also has a second patent application pending before the EPO, **EP-N**. Bouncy GmbH recently filed grounds of appeal disputing the refusal of this patent application by the examining division. Upon review you notice the grounds of appeal filed by Bouncy GmbH are identical to their final submissions to the examining division before **EP-N** was refused.

- d) Advise Bouncy GmbH on the likelihood of the appeal against the refusal of EP-N being successful.**

**7 marks**

Finally, Bouncy GmbH owns a US patent application on which a final office action has recently been issued.

- e) Describe three courses of action available to progress this US patent application, and an advantage of each approach.**

**7 marks**

**Total: 20 marks**

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**Answer**

a) For the EPO to consider an application to be unified when it relates to one invention only (**1 mark**) or to a group of inventions so linked as to form a single inventive concept (**1 mark**). The claims of EP-M clearly do not all relate to the same inventive concept (**0.5 marks**), so the application is not unified (**0.5 marks**).

**3 marks**

b) Claims 1 to 5 will have been searched (**1 mark**). When an application lacks unity, the invention first mentioned in the claims will be searched (Rule 64(1) EPC) (**1 mark**).

**2 marks**

c) 16 months from the priority date (**0.5 marks**), so 17 November 2023 (**0.5 marks**)

**1 mark**

d) The primary object of appeal is to review the decision under appeal (**1 mark**). The statement of the grounds of appeal should set out why the decision under appeal should be reversed (**1 mark**), and should contain all the requests, facts, objections, arguments and evidence relied on (**1 mark**). Here, the grounds of appeal do not set out why the decision under appeal should be reversed (**1 mark**). As such, the Board of Appeal is unlikely to admit these submissions (**1 mark**). Additionally, the Board of Appeal is unlikely to accept a full response to the decision to refuse now, as it will be late filed (**1 mark**). As such, the chance of the appeal succeeding is low (**1 mark**).

**7 marks**

e) Bouncy GmbH could file a request for continued examination (**0.5 marks**). Filing a request for continued examination allows the applicant to continue the prosecution of a US patent application after a final office action has been issued (**0.5 marks**), and allows the widest range of possible amendments to the claims (**1 mark**).

Bouncy GmbH could file an amendment after final rejection (such as AFCEP 2.0) (**0.5 marks**), although only a narrow range of amendments may be accepted by the Examiner with this approach (**0.5 marks**). This approach has the advantage of being low cost (**1 mark**).

Bouncy GmbH could file an appeal to the Patent and Trial Appeal Board (PTAB) (**1 mark**). An appeal fee must be paid (**1 mark**). This approach has the advantage of allowing you to address the Examiner's position with an independent body (i.e. the PTAB is independent of the Examiner) (**1 mark**)

**7 marks**

**Total: 20 marks**

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**Question 9**

Your client is the owner of a PCT patent application. The international search report issued in relation to the PCT application contained a number of objections your client would like to address at the time of national phase entry.

**a) Advise your client if it is possible to amend the application at the time of national phase entry in each of the following countries:**

- i) New Zealand;**
- ii) Republic of Korea;**
- iii) Canada;**
- iv) China;**
- v) India.**

**5 marks**

**b) Advise your client if a power of attorney is required to pursue the national phase application in each of the following countries:**

- i) New Zealand;**
- ii) Republic of Korea;**
- iii) Canada;**
- iv) China;**
- v) India.**

**5 marks**

Your client is also considering entering the PCT application into the US national phase. The application contains four independent claims and 32 claims in total. None of the claims are multiply dependent.

**c) Advise your client regarding the excess claims fees payable to the USPTO (monetary values are not required).**

**3 marks**

Your client is considering filing a utility model in China for a separate invention.

**d) Prepare notes for a meeting with your client outlining the registration procedure in China for utility models and the term of protection.**

**7 marks**

**Total: 20 marks**

**Answer**

- a) New Zealand – Yes, the application can be amended upon entry into the national phase (1 mark)*
- Republic of Korea – Yes, the application can be amended upon entry into the national phase (1 mark)*
- Canada – Yes, the application can be amended upon entry into the national phase (1 mark)*

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*China – Yes, the application can be amended upon entry into the national phase (1 mark)*

*India – No, the application cannot be amended upon entry into the national phase (1 mark)*

**5 marks**

b) *New Zealand – No, no power of attorney is required (1 mark).*

*Republic of Korea – Yes, a power of attorney is required (1 mark).*

*Canada – No, no power of attorney is required (1 mark).*

*China – Yes, a power of attorney is required (1 mark).*

*India – Yes, a power of attorney is required (1 mark).*

**5 marks**

c) *At the USPTO, excess claim fees are due for each claim in independent form in excess of three (1 mark) and for each claim, independent or dependent, in excess of 20 (1 mark). Therefore it is necessary to pay 1 excess claim fee for the excess independent claim (0.5 marks) and 12 excess claim fees for the total claim number (0.5 marks)*

**3 marks**

d) *In China, utility models are only subject to preliminary examination (1 mark). Preliminary examination includes examination of the application documents (0.5 marks), ensuring the relevant fees are paid (0.5 marks) and a review for obvious substantive defects (1 mark). If no objections are raised, the utility model will be registered (1 mark). Any person (1 mark) can request substantive examination following registration (0.5 marks). The utility model will be revoked if objections are raised and not overcome as part of substantive examination (0.5 marks). Term is 10 years (1 mark).*

**7 marks**

**Total: 20 marks**