

Foundation Certificate

FC3 International Patent Law

Thursday 20 October 2022

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 **9 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

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 licensing 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

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 1 January 2018, and the renewal fee due on 1 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

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, ignoring any extensions?

3 marks

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

3 marks

Total: 10 marks

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

Question 5

Your client is concerned by a competitor's European patent, EP-Z. EP-Z was filed on 1 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 claims of EP-Z:

- US-X, a US patent application with an earliest priority date of 1 February 2017 and a publication date of 1 August 2018.
- EP-X, a European patent application with an earliest priority date of 1 January 2016 and a publication date of 1 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

SECTION A Total: 40 marks

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 7 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

Cont...

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.

- e) **Advise Ms Day on the immediate steps necessary to seek the desired patent protection.**

5 marks

Total: 20 marks

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

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

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