






| Paper Ref  | Sheet          | Percentage Mark Awarded |
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| <b>FC3</b> | <b>1 of 13</b> | <b>65%</b>              |

Examiner's use only

Q1

- a) The client is a company that have less than 500 employers (75 people) and no licence or assignment of any patent or patent application to a non-small entity. So the client qualifies as small entity status at USPTO. 
  
- b) A micro entity status also need to fulfill the requirement of small entity. Besides, a micro entity status is an individual or non-profit organization or university that previously owns less than 4 patents. A micro entity does not have any licence or assignment to any entity. The gross income is not exceed double of the average income level.   

  
- c) The applicant has the duty of candour to submit any noticed relevant state of arts via an information disclosure statement to draw USPTO's attention. 
  
- d) Copies of the article from scientific journal, the US patent application, and the European patent application together with an English translation. 

**MARKS AWARDED: 6.5/9**

6.5

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Q2

- a) Divisional application can be filed as long as the application is pending, including the period for request an appeal.

An appeal can be requested within 2 month from the date of issuance of a decision of refusal. Here is, 1 November 2022 including 10-day postal period for EP-1.

- b) The divisional application shares the same description and drawings as the parent application so it should have the same support and scope as the parent application. Only claims would be different. Adding new information containing new features would result in broadening the original scope of the application, which is inadmissible to European Patent Office.

- c) The deadline of renewal fee of EP-2 is 31 January 2022 and the final deadline is 31 July 2022 after 6-month grace period. EP-3 is filed between the deadline of renewal fee and the final deadline after 6-month grace period. To make EP-3 effective, the renewal fee of EP-2 must be paid before 31 July 2022 to keep EP-2 pending. If not, EP-2 is deemed to withdrawal. A re-establishment should be requested within 2 months from the notification of deem to withdrawal. So without paying the renewal fee of EP-2, EP-3 was not validly filed.

**MARKS AWARDED: 3/8**

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Q3

a)

1. An indication that intends to file an international patent application /
2. Identifying the applicant /
3. At least one applicant is entitled to file PCT patent application at the selected receiving office. //
4. The language used for the application is accepted by the receiving office. //
5. The application should include at least a description and one or more claims. //

b)

Japan: within 30 months from the filing date of PCT patent application //

Mexico: within 30 months from the filing date of PCT patent application //

Australia: within 31 months from the filing date of PCT patent application //

c)

Japan: Japanese //

Mexico: no translation required as English is one of the local language of Mexico

Australia: no translation required as English is one of the local language of Australia //

**MARKS AWARDED: 9/10**

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Examiner's  
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Q4

Argentina: It is possible to obtain a valid patent in Argentina. If an application is filed in Argentina within 12-month grace period from the disclosure by the applicant, the disclosure does not destroy the novelty of the application.

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Japan: It is possible to obtain a valid patent in Japan. If an application is filed in Japan within 12-month grace period from the disclosure by the applicant, the disclosure does not destroy the novelty of the application. The evidence should be filed within 30 days of the disclosure.

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China: It is not possible to obtain a valid patent in China as the disclosure would destroy novelty and no grace period is permitted.

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South Africa: It is not possible to obtain a valid patent in South Africa as the disclosure would destroy novelty and no grace period is allowed.

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Australia: It is possible to obtain a valid patent in Australia. If an application is filed in Australia within 12-month grace period from the disclosure by the applicant, the disclosure does not destroy the novelty of the application.

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**MARKS AWARDED: 4.5/5**

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Examiner's  
use only

Q5

- a) Third party can file an opposition within 9 months from the publication of the grant of EP-Z. So, the deadline is 23 June 2023.
- b) The novelty of European patent can be assessed by the state of art including, any publication published before its filing date, or European patent applications filed before and published after its filing date. The inventiveness of European patent can be assessed by any publication published before its filing date.

US-X: a US patent application published after EP-Z's filing date. It is not the state of the art, which cannot be used for challenging the novelty or inventiveness.

EP-X: a European patent application filed before and published after EP-Z's filing date. So it can be used to challenge the novelty of EP-Z and cannot be used for inventiveness combined with other arts.

PCT-X: a PCT patent application published after EP-Z's filing date without entering EP regional phase in spite of filed before. It is not the state of the art, which cannot be used for challenging the novelty or inventiveness.

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GB-X: a UK patent application published before the filing date of EP-Z. It can be used to challenge novelty, or inventiveness combined with common general knowledge or other arts.



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Examiner's use only

Q7

a)

China: business method is patentable in China.

Singapore: business method is patentable in Singapore.

EPO: business method is not patentable before EPO.

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b)

China: a method for treatment of the human body is not patentable in China.

Singapore: a method for treatment of the human body is not patentable in Singapore.

EPO: a method for treatment of the human body is not patentable before EPO.

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c)

China: a scientific theory is not patentable in China.

Singapore: a scientific theory is not patentable in Singapore.

EPO: a scientific theory is not patentable before EPO.

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d) United Kingdom Intellectual Property Office, European Patent Office and International Bureau

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Examiner's  
use only

e) The competent international searching authority for PCT-Y is European Patent Office. However, business method is excluded from patentability as subject matter in European patent. EPO will not search PCT-Y, and issue the communication that the search cannot be conducted.

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f) A Chapter II Demand can be filed by the applicant for international preliminary examination by the later of 3 month from the transmittal of International Search Report (ISR) or 22 months from the filing/priority date and the official fee should be paid. After the demand is filed, International preliminary examination authority (IPEA) will conduct an examination, taking into account the ISR and any amendment filed and issue a more comprehensive opinion and an examination report. The applicant can file amendments to entire application after request the demand according to Article 34.

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Examiner's  
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Q8

- a) Unity of invention requires the claims filed in the same invention are in the same category. The claims share the same technical feature that have contributory technical effect to the invention. The subject matter of claims 1-5 is a pogo stick and its feature is being folded away and stored. The subject matter of claims 6-10 is a method and its feature is manufacturing a rubber ball. The two claim sets do not share the technical feature in common, so they are not in unity. EP-M does not meet the requirement of unity.
- b) If there are more than one set of claims in European invention that are not in unity, the examiner will only search for the first set of claims. So claims 1-5 have been searched. The applicant can pay the additional search fee to request search for claims 6-10.
- c) The designation of inventor shall be filed within 16 months from the filing date. So the deadline here is 17 November 2023.
- d) The grounds of appeal is first sent to the examining division for the re-confirmation. If the examiner accepts the grounds, the prosecution would be resumed. If the examiner still refuses the application, the appeal request will be remitted to technical Board of Appeal as soon as possible.

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As the grounds of appeal filed by Bouncy GmbH are identical to their final submissions to the examining division before EP-N was refused, it would most likely be refused by the previous examiner again. After that, a panel of three new members is formed and examine the appeal grounds. The previous examiner is not permitted to become one of the panel. So a new decision may be raised or the refusal may be insisted by the panel.

Thus, it is important to file the grounds of appeal in convergent manner. And no new grounds or arguments would be accepted in appeal if it had not been submitted during the examination before, or it had been given up after submitting.

e)

RCE – file a request for continued examination to pursue the examiner to resume the prosecution and file the response to the final office action, and pay the fees.

This would be an efficient and direct way to continue the prosecution.

AFAC 2.0: file an amendment including at least one independent claim that is not broadened and the arguments and evidences for examiner's consideration. If the examiner accepts them, the applicant may not need to file RCE.

This would save money of RCE and be accepted by examiner with once filing.

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Continuation application: file a continuation application of this to restart the application process and wait in queue to be examined.

Continuation application may have chance to be allocated to a new examiner, so a different decision may be made on the invention.

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Examiner's  
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Q9

a)

i) New Zealand: Yes, it is possible to amend the application at the time of national phase entry

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ii) Republic of Korea: Yes, it is possible to amend the application at the time of national phase entry

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iii) Canada: Yes, it is possible to amend the application at the time of national phase entry

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iv) China: Yes, it is possible to amend the application at the time of national phase entry

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v) India: No, it is not possible to amend the application at the time of national phase entry

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b)

i) New Zealand: Yes, a power of attorney is required

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ii) Republic of Korea: Yes, a power of attorney is required

iii) Canada: Yes, a power of attorney is required

iv) China: Yes, a power of attorney is required

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v) India: Yes, a power of attorney is required

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c)

If more than 20 claims and/or more than 3 independent claims are filed in a US patent application, excess fees shall be paid. So the excess fee shall be paid for two matters, one additional independent claim and 12 additional claims. The applicant can delete the claims to avoid paying excess claim fee.

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d)

The utility model in China is a quicker and cheaper method to acquire patent protection. The Chinese utility model can only protect the product, not the method or use. It only requires formality and rough examination on novelty and inventiveness. With a much lower threshold of novelty and inventiveness, the utility model can be granted more easily.

After filed a Chinese utility model, a preliminary examination on formality is conducted. The novelty and inventiveness are considered as well. The examiner will issue the office action to the applicant if any formality matters exist. After overcoming the objections raised by the examiner, the utility model will be granted and published. So Chinese utility model is published only once when it is granted.

The patent term of Chinese utility model is 10 years from the filing date.

**MARKS AWARDED: 13/20**

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