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Q.1.a) Small entity status US law –

50% fee reduction

Since the UK company has 75 Employees (less than the requirement), they can qualify. /

Not limited to US company – so company from any country (incl. UK) can qualify. /

Provides 50% fee reduction –

But, proof has to be provided (number of employee number) and if the status changes at a later date (company is no longer a small entity, or if it assigned to a another company which is not a small entity), the fee difference has to be paid.

Incorrect statement is penalised and US patent not enforceable.

Q.1.b) Micro entity in US:

Applicant should have

- Less than 4 patent
- Less than 3 times median US income /

Also available for applicant

- Entity which is primarily a Higher education entity /
- Or the rights are assigned to a higher education

75% fee reduction

If it is later assigned to entity that do not qualify, will lose the status, and have to pay the difference of fees.

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Q1.c) So the US examiner is aware of the documents cited in the corresponding applications in order to avoid duplication of work. It was also meant as earlier there was no sharing of work between the different offices.

Q1.d) Documents which are not readily available to the US Examiner should be provided.

The scientific document – as it is not always available.

US application – number is adequate

EP application – number is adequate, although in DE, abstract in EN is available

The applications are assumed to be published (since it was cited by UKPTO – and not a prior national application).

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Q2. a)

Divisional application at EPO can be filed as long as the parent is pending. //

After refusal, the parent application is still considered to be pending (decision of first instance is stayed) as long as the appeal proceedings are pending (or the deadline within which an admissible appeal can be filed). //

In this case, since the due date for filing the appeal fees is pending, it is possible to file divisional till this date. (2m from the notification – 10 day rule apply - for now).

Thus ,1-Nov-2022 (22-Aug + 10 days + 2m) is the deadline for filing divisional. //

Should the fees be paid, the deadline is extended for 2 months till the grounds of appeal are filed in time.

Q2.b)

According to Art.76(1) EPC – the divisional application should not extend beyond the disclosure of the original application (parent application). This applies to entire application (description, claims, drawings) //

Additional information (irrespective of where it is added – claims, description, or drawings) describing new features not contained in EP-1 (parent) would constitute added matter. Thus the amendments at the divisional application will not meet the requirement of the EPC (art 76(1)) and thus the application will not allowed. //

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Q2.c) The deadline for renewal fee was not paid during the Extended period (6m from due date). However, the applicant still has the chance to pay with the late fee, and if not request further processing after loss of rights.

Should the applicant validily pay the fees, the result would be that the renewal fees was deemed to have been filed in time within the grace period provided.

Since the divisional application was filed in May 2022, it is validilty filed, provided the renewal fees is paid and the parent application is restored.

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Q3.A)

Minimum requirement for PCT filing date

- Request at any RO
- Identity of the applicant
- Description
- At least one claim

Q3 b)Deadline for entry

JP – 31 months from the filing (or priority if any) date

MX – 30 months from the filing (or priority if any) date

AU – 31 - months from the filing (or priority if any) date

Q3 c) Translation requirement (in general – not just when entering – but also after with extension if any)

JP – translation of the PCT application (including any amendments when entering) to Japanese

MX – translation of the PCT application (including any amendments when entering) to Spanish

AU – no translation necessary (since PCT was already filed in EN)

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Q4 . Applicant can file in countries where grace period is available in case of own disclosure. (Sale is a disclosure)

AR – One year grace period , thus can file in Argentina

JP – 6 month grace period, so cannot file.

CN – No grace period fo patent, available for utility model.

SA – Grace period available – no specific limit – thus applicant can file in SA

AU – One year, so can file a patent

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Q5 a) deadline for opposition at EPO – 9 m from the date of mention of grant (i.e., publication of grant). 10 day rule does not apply.

- Deadline is 23 June 2022 (Friday).

Q5 b)

Art 54 (2) EPC – public disclosure (in any form) before the priority (or filing, if no priority) date. Both, novelty and inventive step.

Art 54(3) EPC – Application (EP, or PCT designating EP) with a earlier priority (or filing) date, but published after priority (or filing) date of the application. But only for assessment of novelty, cannot be used for lack of inventive step.

- US- X – Cannot be used for opposition . Although filed before the filing date of EP-Z, it is a US application, thus not a prior art under A.54(3) EPC. The publication of US – X is after the priority date, thus not a prior art u.A 54(2) EPC
- EP-X – Can be used in opposiition for lack of novelty only but not for lack of inventive step. Although published after the filing date of EP-Z, it is an EP application with earlier priority that EP-Z. Thus a prior art u.A 54(3) EPC.
- PCT-X – Cannot be used for opposition. Although the PCT application was filed before the filing date of EP-Z, it did not enter EP phase. This not a prior art u.A 54(3) EPC.
- GB-X – Can be used for opposition to challenge both novelty and inventive step. It is a prior art u.A 54(2) EPC, as it was a published document from the 1990 (before the filing date of EP-Z).

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Q.7.a) Business method

CN – Business method not allowed

SG – Business method patents are allowed

EPO – Not patentable if the claims relate to is business method “as such”.

Comvik approach is used for assessment if the distinguishing feature had any technical effect, and only those are considered for assessment for inventive step.

7.b)

CN – Method of treatment is allowed

SG – Method of treatment is allowed

EPO – Not patentable if it relates to diagnostic method or treatment “in vitro” (inn the human body).

7.c)

CN – Scientific theory not allowed.

SG – Scientific theory is not patentable

EPO – Scientific theory is not patentable, unless the claim relate to application of the scientific theory.

Q7.d

UK applicant can file with any one of UKPTO, EPO, or WIPO as the RO.

Q7.e

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EPO – The application PCT-Y will not be searched, as per PCT rules, the ISA does not have to search subject-matter which is not patentable under the searching office. Thus unsearched non-patentable subject-matter-

Q7.f

Mr.Biz can file a reasoned statement, and/or amend the claims (within the original disclosure) and request an International Preliminary Examination by paying the additional fees.

The request should be done by 22m from priority (or filing) date, or within 3 months from the ISR, whichever is later.

A protest can be filed.

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Q8a). Under A.82 EPC – An application should contain only one invention (principle that the applicant cannot get one than one invention protected with a single patent and paying single fees). The Lack of unity arises if the subject-matter of independent claims (or in case of “a posteriori” even dependent claims) have a different technical effect.

Claims 1 to 5 relate to a stick that is folded away, and claims 6 to 10 contain manufacturing method of a ball. Since both of them are not linked with a single technical effect, it lacks unity.

Q.8.b) The EPO Search Division will indicate if there is a lack of unity, and in such a case, the first group of invention is searched. Thus Claims 1 to 5 will have been searched. Unless the Examiner could have also searched the second group without much effort (which does not seem to be the case as the two groups have a vast difference in subject-matter of the protection claimed).

If a further search fee was paid within the deadline of request, the second group (claims 6-10) will also be searched. But during Examination, the applicant should limit the claim to one group.

The other group can be pursued in a divisional application.

Q8.c) Designation of inventor can be filed within 2 months from the date of notification for invitation to designate the inventor. Further processing is possible.

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Q.8.d)

A reasoned grounds of appeal have to be filed against the impugned decision.

Merely reiterating the same arguments without indicating how the first instance decision was flawed is not considered as a substantiated appeal.

If the reasons are identical this may not be successful in appeal, unless the reasons in the decision were identical to the preliminary opinion.

If there is still time (not yet 4m) then an addendum to the grounds can be made.

Otherwise, if there are adequate reasoning against the decision, new arguments within the framework of the appeal can be made. No new arguments or grounds can be raised which extend what was originally filed RPBA 13 (2020) .

Q.8.e)

RCE – Request for Continued Examination. This is not considered a new application and can continue with same claims. But any benefit of term extension will be lost.

APCE 2.0 – If the claims are amended then the request can be made to continue examination of the new claims. The claims should not raise new

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objections. The Examiner may review the claims and consider it again if they meet the requirements.

Appeal – Can appeal against the decision at the PTAB. Its an expensive option. But new group of people are looking at the case.

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Q.6.a .i) First renewal fees is due on third year. This can be paid by the end of the month on which is it due - 31. October 2022.

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Q.6.a.ii) Substantive examination can be requested within 7 years from filing. Thus deadline is 21.Oct.2027

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Q.6.b.i) – US-B – Patent Term is 20 years from filing date. Thus 12.August 2037

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Q.6.b.ii) US Renewal fees are due at 3.5y, 7.5y and 11.5y

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2.5

Q.6.c.i) product manual is a written document. Provided such a manual was available together with the product, and can be shown to be published in 2010, it forms a prior art as it was before the filing date of US-B.

Any printed document, irrespective of where it was published, can be used as prior art in the US.

Q.6.c.ii) public prior use – As the product was publicly available (i.e., not under confidentiality) it is a public use. However, it is unclear if the product was available and used in the US. Only such use within the jurisdiction can be used as prior art at the USPTO.

Q.6.d) File a request to withdrawal of the application at the EPO. This will ensure no further communications are sent and any fees which are due to be refunded, including renewal fees.

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Q.6.e) Today is 20 October 2022.

Since no earlier priority is claimed, GB-B is the “first application”.

A PCT application claiming priority from GB-B should be filed within 12m of GB-B. So PCT should be filed by tomorrow 21-Oct-2022.

Failure to do so will result in priority claim being lost. Since the product is already commercially successful, it is publicly available and thus a patent cannot be obtained in countries which don't have a grace period.

PCT application allows Ms.Day to decide later which market to enter during national phase, as major markets are signatory to the PCT.

To file PCT, a request along with the priority details, and the application and claims (same as that in the priority application if no changes are made) can be made at the RO (UKPTO, EPO, or WIPO). Filing fees of the RO can be paid already. A request to access the certified priority application can be made as the WIPO and UKPTO has priority application Exchange.

TW is not a PCT member state, thus in order to ensure protection, it is required to file an application under the Paris convention, within one year from the priority date to validly claim (i.e., by tomorrow).

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Q9. A)

v). IN - Claims can be amended to reduce the number of claims. No further amendment is possible during entry

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Q9.b)

i) NZ – Any person. No PoA required

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v) . IN - Yes

Q.9.c) Excess claim fees for US

Additional fees for US if the claims exceed 20 Claims and has more than 3 independent claims. Furthermore, multiple dependencies are considered for claim number.

In this case, fees for one additional independent claim, and 12 additional claim has to be paid.

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Q.9.d) Utility model in CN

Grace period of one year available for Utility model.

Can proceed in parallel to a patent application – as long as existence and progress of both are indicated to the CIPO.

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