

SECTION A

Question 1

- a) State two advantages of seeking patent protection via the EPO compared with filing separate national patent applications.
2 marks
- b) State two disadvantages of seeking patent protection via the EPO compared with filing separate national patent applications.
2 marks
- c) In relation to the EPC, describe the procedure for requesting further processing.
2 marks
- d) In relation to the EPC, describe the procedure for requesting re-establishment of the deadline for payment of a renewal fee with the additional fee.
3 marks

Total: 9 marks

Answer

- a) *Any sensible points (1 mark each)*
a single process to grant;
uniform protection across Europe;
single agent for all countries until grant;
potentially cost effective.
(up to 2 marks)
2 marks
- b) *Any sensible points (1 mark each)*
opposition means possibility of losing rights for all states;
can be slower than national grant proceedings;
prosecution/application must be in English, French or German.
(up to 2 marks)
2 marks
- c) *The applicant makes a request for further processing of the application under article 121 EPC in writing (0.5 marks). Further processing must be requested by payment of the prescribed fee (0.5 marks) within two months of the communication concerning either the failure to observe a time limit or a loss of rights (0.5 marks). The omitted act must be completed within the period for making the request (0.5 marks). Article 121 EPC*
2 marks
- d) *Any request for re-establishment of rights under Article 122 EPC shall be filed in writing (0.5 marks) within two months of the removal of the cause of non-compliance with the period for paying the renewal fee with additional fee (0.5 marks), but at the latest within one year of expiry of the unobserved time limit (0.5 marks). The request for re-establishment of rights shall not be deemed to have been filed until the prescribed fee has been paid (0.5 marks). The request shall state the grounds on which it is based and shall set out the facts on which it relies (0.5 marks). The request*

will only be allowed if it is shown the deadline was missed despite 'all due care' (0.5 marks).

3 marks
Total: 9 marks

Question 2

a) State whether utility model protection is available in the following countries: Canada, USA, Japan, Germany and China.

5 marks

b) How is utility model protection requested via the PCT route?

1 mark

Total: 6 marks

Answer

a) *Canada – Utility model protection is **not** available (1 mark).*

*USA – Utility model protection is **not** available (1 mark).*

Japan – Utility model protection is available (1 mark).

Germany – Utility model protection is available (1 mark).

China – Utility model protection is available (1 mark).

5 marks

b) *So long as all contracted states are designated for 'all kinds of protection' when the PCT is filed (0.5 marks), utility model protection can be requested at the time of national phase entry (0.5 marks).*

1 mark

Total: 6 marks

Question 3

a) Briefly outline the search/examination procedure in Germany. Include any applicable deadlines.

5 marks

b) Are renewal fees due on a pending French application?

1 mark

Total: 6 marks

Answer

a) *In Germany there is provision for an optional novelty search (0.5 marks) which can only be requested by the applicant (0.5 marks). A search fee is payable (0.5 marks). If a novelty search is requested the subsequent examination fee is reduced (0.5 marks). Substantive examination must be requested and a fee paid (0.5 marks). The request may be made by the applicant or a third party, but a third party does not become party to the proceedings (0.5 marks). The deadline for requesting examination is 7 years from the date of application (0.5 marks). The examination consists of actions issued by the German patent office with deadlines for reply (0.5 marks). Extensions to the deadlines are available (0.5 marks). An oral hearing must be granted if applied for (0.5 marks).*

5 marks

b) Yes, renewal fees are payable whilst the French application is pending (1 mark).

1 mark

Total: 6 marks

Question 4

a) Where a PCT patent application claims priority, what is the un-extended deadline for entering the national phase in Singapore?

1 mark

b) Where a PCT patent application claims priority, what is the deadline for late entry into the national phase in Singapore?

1 mark

c) Describe three search and examination routes available to your client when filing a priority founding, national patent application in Singapore. Include any applicable deadlines.

6 marks

Total: 8 marks

Answer

a) 30 months from the **priority** date (1 mark).

1 mark

b) 48 months from the **priority** date (1 mark).

1 mark

c) Option 1 – File a search request (0.5 marks) within 13 months of the earliest claimed priority date (0.5 marks). Additionally, file an examination request (0.5 marks) within 36 months of the earliest claimed priority date (0.5 marks).

Option 2 – File a **combined** search and examination request (1 mark) within 36 months of the earliest claimed priority date (0.5 marks).

Option 3 – Where an **applicable** foreign search result is available (1 mark), request examination of the application (0.5 marks) on the basis of the foreign search result (0.5 marks) within 36 months of the earliest priority date (0.5 marks).

6 marks

Total: 8 marks

Question 5

- a) Who can file an opposition against a granted European Patent, and what is the time limit for doing so?
1 mark
- b) Explain if it is possible to oppose a European patent only in respect of some designated states.
1 mark
- c) Describe the form and content of a validly filed notice of opposition at the European Patent Office?
6 marks

Total: 8 marks

Answer

- a) Any person **except the proprietor** may file an opposition against a granted patent (Article 99(1) EPC) (**0.5 marks**). The time limit filing the notice of opposition is 9 months from publication of the mention of grant (Art 99 EPC) (**0.5 marks**).
1 mark
- b) It is not possible to oppose only in respect of some designated states (**0.5 marks**). The opposition shall apply to the European Patent in all the contracting states in which that patent has effect (Article 99(2) EPC) (**0.5 marks**).
1 mark
- c) In a reasoned written statement (**0.5 marks**), the notice of opposition should contain:
the particulars of the opponent (**1 mark**);
the number of the European patent against which opposition is filed (**0.5 marks**);
the name of the proprietor of the patent (**0.5 marks**);
the title of the invention (**0.5 marks**);
a statement of the extent to which the European patent is opposed (**1 mark**) and of the grounds on which the opposition is based (**1 mark**), as well as an indication of the facts and evidence presented in support of these grounds (**1 mark**).

6 marks

Total: 8 marks

Question 6

What are the respective deadlines for requesting examination for national applications derived from a PCT application in China, Japan, South Korea, Australia, India and Canada?

3 marks

Answer

China	<i>3 years from the earliest claimed priority date. (0.5 marks)</i>
Japan	<i>3 years from the International filing date. (0.5 marks)</i>
S. Korea	<i>3 years from the International filing date. (0.5 marks)</i>
Australia	<i>Within two months from receiving a Direction from the Commissioner of IP Australia, or within 5 years from the International filing date, whichever is earlier. (0.5 marks)</i>
India	<i>4 years from the earliest claimed priority date. (0.5 marks)</i>
Canada	<i>4 years from the International filing date. (0.5 marks)</i>

Total: 3 marks
Total for SECTION A: 40 marks

SECTION B

Question 7

Your UK-based client is collaborating with an Argentinian University which is keen to present its recent findings at a conference shortly. Individuals at both your UK-based client and the Argentinian University have contributed to the development of the invention.

Due to a long-term absence of personnel in the technology transfer team, a contract has not yet been signed and the ownership of any patents as a result of the collaboration is yet to be decided. Drawings relating to the research findings have been drawn by hand as informal sketches.

Your client would like to file a PCT application.

- a) **Explain whether a PCT application can be filed in the joint names of your client and the Argentinian University.**
1 mark
- b) **What happens if the PCT Request form is not validly signed?**
1 mark
- c) **What happens if a deadline for filing formal drawings is missed?**
2 marks
- d) **If the Argentinian University wants to assign its rights in the PCT application to the UK-based client, how and when should such an assignment of the application be recorded?**
1 mark

Sometime later, and unrelated to the collaboration with the Argentinian University, your UK-based client files a PCT application and then receives a search report which is negative. The claims appear to lack novelty over two citations.

- e) **Explain the actions your client may undertake under Article 19 PCT. Include any applicable deadlines in your answer.**
5 marks
- f) **Your client is now considering requesting International Preliminary Examination (IPE). Outline the procedure and include any deadlines.**
5 marks
- g) **State two reasons for and two reasons against requesting International Preliminary Examination.**
2 marks

Cont...

An international patent application has been found by the EPO, acting as the International Search Authority, to contain claims relating to two inventions that are not linked so as to form a single inventive concept. During the international phase, only the first invention was searched. Your client wishes to enter the European Regional Phase, the deadline of which is at the end of this week and he now tells you that he would like to pursue the second of the two inventions in a European patent application.

h) Explain the steps that need to be taken to pursue the second of the two inventions in a European patent application.

3 marks

Total: 20 marks

Answer

a) Yes; only a single applicant need be entitled to file a PCT application (Article 9, Rule 18.3 PCT) (0.5 marks), and your UK-based client is so entitled (0.5 marks).

1 mark

b) The receiving office will request that the form is corrected (0.5 marks) and set a deadline of two months from the date of the communication for this correction to be completed (Article 14, Rule 26 PCT) (0.5 marks).

1 mark

c) Provided the RO has not deemed the application withdrawn under Rule 26.5 PCT the deadline may be extended by the RO (Rule 26.2 PCT) (1 mark). Alternatively, if the drawings comply to the extent necessary for the purpose of reasonably uniform international publication, the application may have been published anyway (1 mark).

2 marks

d) An assignment should be recorded in writing (0.5 marks), during the international phase (i.e. before 30 months from the earliest priority) date of the application (Rule 92bis PCT) (0.5 marks).

1 mark

e) Under Article 19 PCT, amendment may be made to the claims of the application (1 mark). The deadline for filing any such amendments is within 2 months of the transmittal of the search report (1 mark) or 16 months from the earliest claimed priority date (1 mark), whichever is later (1 mark). Amendments are filed with the International Bureau (1 mark).

5 marks

f) The deadline for requesting International Preliminary Examination is the latest (1 mark) of 3 months from transmission of the International Search Report (1 mark) and 22 months from priority (1 mark). The applicant can respond to the written opinion that accompanied the International Search Report (0.5 marks), and the International Preliminary Examination Authority draws up a report taking the applicant's response and any amendments into consideration (0.5 marks). Amendments can be made to the description, drawings or claims (1 mark).

5 marks

**g) Any two from:
to amend or deal with objections in the international phase to reduce cost/time later (0.5 marks),
to obtain a better indication of likely protection, for example for licensing (0.5 marks)
to inform the national phase decision (0.5 marks),**

to accelerate EP grant (0.5 marks);

*and any two from
different definitions of prior art/different requirements for inventive step in different
jurisdictions (0.5 marks),
the risk of creating estoppels (0.5 marks),
the limited time for the IPE procedure/time pressure on the Examiners (0.5 marks),
increased costs, at least in the short term (0.5 marks).*

2 marks

- h)** *The Examining division will invite the applicant to pay a search fee (1 mark) within a period of two months, (Rule 164(2)(a) EPC) (1 mark). The applicant has to pay the search fee and elect to continue with the second invention (Rule 164(2)(b)(c) EPC) (1 mark).*

3 marks

Question 8

- a) Explain the qualification requirements for claiming small entity status for US patent applications. **5 marks**
- b) Explain one benefit of claiming small entity status in the US. **1 mark**
- c) What would be the consequences of fraudulently claiming small entity status? **2 marks**

Your client, FARMI, filed a US patent application, US-A, with claims directed to a novel compound, Compound X, on 15 January 2023. There is no priority claim. Compound X was disclosed by FARMI in a journal published in Europe on 25 September 2022.

- d) **Explain if US-A would be considered novel over the journal disclosure by the USPTO.** **3 marks**

It is subsequently discovered that one of FARMI's competitors independently filed a US patent application, US-B, disclosing Compound X in October 2022. There is no priority claim.

- e) **Explain whether the claims of your client's US patent application, US-A, would be considered novel over US-B by the USPTO.** **3 marks**

Separately, FARMI filed a UK patent application to a different compound, Compound Y, on 1 August 2022, with the applicant making an enabling public disclosure of the contents of that application shortly after. The applicant now wishes to seek patent protection in Hong Kong.

- f) **Explain how the applicant may obtain patent protection in Hong Kong.** Assume that the applicant is considering standard protection. Do not consider short term patents. **6 marks**

Total: 20 marks

Answer

- a) *Small entity status may be claimed by: small business concerns (1 mark) employing fewer than 500 people (1 mark); Individuals (1 mark); and certain non-profit organisations (e.g. certain universities, foundations, charities etc) (1 mark); so long as that entity has not licensed, assigned or agreed to assign the application to a large entity (1 mark).*
- 5 marks**
- b) *Small entity status entitles the applicant to a reduction in some official fees (0.5 mark). The fee reduction is 60% (also accept 50%) (0.5 mark)*
- 1 marks**
- c) *It may result in the patent being unenforceable (1 mark) and a fine being issued (1 mark).*
- 2 marks**
- d) *The disclosure by the inventor occurred less than 12 months before the applicant filed the US patent application (1 mark) and so the US grace period applies (1 mark). Thus, the claimed invention is novel over the journal disclosure (1 mark).*
- 3 marks**
- e) *US-B was filed after the journal article was published (1 mark). As such, despite US-B being the first filed application it can be discounted from the prior art (1 mark), and US-A will be considered novel over US-B (1 mark). (AIA 35 U.S.C. 102(b)(2))*
- 3 marks**
- f) *The applicant cannot make a direct filing in Hong Kong (1 mark) as it is too late to claim priority (0.5 marks) and there has been an enabling disclosure of the invention to the public (0.5 marks). Protection for the invention in Hong Kong should be obtained based on the United Kingdom patent application (1 mark). A request to record must be filed within 6 months of the publication of the United Kingdom patent application (1 mark). Once the United Kingdom patent application has granted, a request for registration and grant (1 mark) must be filed within six months of the date of grant (1 mark).*

6 marks

Total: 20 marks

Question 9

Your UK client develops skiing goggles. The client would like to have a granted European patent as quickly as possible.

- a) **Set out details of the PACE system and mention if any extra fees are payable?**
- 5 marks**
- b) **Morocco and Cambodia are examples of Validation States. What is a Validation State?**
- 2 marks**
- c) **Describe the process of obtaining patent protection in any of the Validation States via a European patent application.**
- 3 marks**

In the rush to file the application, you mistakenly use the word 'Googgles' instead of 'Goggles' in the claims.

- d) **Outline the provision of the EPO rule relating to correction of errors in patent claims, and if a request to correct 'Googgles' to 'Goggles' is likely to be successful.**

5 marks

You eventually receive the Rule 71(3) communication indicating the text on which the Examining Division of the EPO intends to grant the patent. The next day, you are notified that anonymous third-party observations have been filed relating to this application. The third-party observations were filed in English.

- e) **Explain if the EPO will consider the content of the third-party observations.**

5 marks

Total: 20 marks

Answer

- a) *It is possible to accelerate proceedings at the search stage (1 mark) and/or the substantive examination stage (1 mark). No reason need be given for requesting accelerated search/examination (1 mark) and no extra fees are due for accelerating search/examination (1 mark). The applicant must deal with all issues on time (no extensions or further processing) to remain under PACE (1 mark).*

5 marks

- b) *A Validation State is not an EPO contracting state (1 mark) but is one that has entered into a validation agreement with the EPO (1 mark).*

2 marks

- c) *Within six months of the date on which the European Patent Bulletin mentions the publication of the European search report (1 mark), you must pay the validation fee (1 mark). After grant, formalities must be completed in the validation state to ensure the European patent comes into force in that territory (1 mark).*

3 marks

- d) *Errors in documents filed at the EPO may be corrected (Rule 139 EPC) (1 mark). As the error is in the claims, for the correction to be allowed it must be obvious that an error is in fact present in the document filed with the EPO (1 mark), and immediately evident that nothing else would have been intended than what is offered as the correction (1 mark). The proposed correction is likely to be accepted (1 mark), as it is an obvious typographical error and immediately evident that 'goggle' is the correct term (1 mark).*

5 marks

- e) *The third party observations are timely filed (1 mark), as proceedings are still pending/the decision to grant has not been handed over to the EPO's internal mail service (1 mark). They are also acceptable as filed in an official language of the EPO (1 mark). Therefore, the content of the third party observations will be considered (1 mark). If the content of the submissions is relevant, the examining division will resume examination (0.5 marks). Otherwise, brief substantive feedback will be provided in the file (0.5 marks).*

5 marks

Total: 20 marks

Question 10

Discuss the patentability of the inventions below in the EPO and USA.

- a) A method of treating itchy skin using a compound that has previously been used for headaches. **3 marks**
- b) A house alarm that gives potentially lethal electric shocks to intruders. **3 marks**
- c) A method of doing business. **3 marks**
- d) An invention that was disclosed last week in breach of a non-disclosure agreement. **6 marks**

Your client has developed a new watering can which they would ideally like to protect in major foreign markets. They inform you that while the watering can has new features, it is an obvious combination of two existing products. As such, your client does not wish to apply for patent protection.

- e) **Describe another form of intellectual property right that your client could apply for, and list two advantages and two disadvantages of this alternative intellectual property right.** Do not discuss designs, copyright, trade marks or trade secrets.

5 marks

Total: 20 marks

Answer

- a) *Method of treatment claims are not patentable in Europe (1 mark). However, protection could be obtained via a second medical use claim (1 mark). Method of treatment claims are allowed in the US (1 mark).* **3 marks**
- b) *Sensible comments about patentability in view of (Art 53(a)), inventions the publication or exploitation of which is contrary to ordre public or morality (Art 53(a)) (1 mark). Even if an invention is prohibited by law in EPC states, it may still be patentable (1 mark). Sensible discussion round invention likely being patentable in the USA Section 101(1) (1 mark).* **3 marks**
- c) *Methods of doing business are not patentable in Europe (1 mark) (Article 52(2)(c)). Methods of doing business are not explicitly excluded from patentability in the USA (1 mark), though in practice it may be difficult to obtain a patent in the USA as it may be considered an 'abstract idea' (1 mark).* **3 marks**
- d) *In Europe, an earlier disclosure is non-prejudicial if it occurs no earlier than 6 months preceding the **filing** date of the European patent application (1 mark) and was due to an evident abuse in relation to the applicant (1 mark). This appears to be the case here (1 mark), so the disclosure is non-prejudicial and the idea is patentable (1 mark). In the US an earlier publication occurring less than a year before the effective filing date is not prior art to the invention if the subject matter was obtained from the inventor or a joint inventor (1 mark). So the invention is patentable if application is filed within 12 months of unauthorised disclosure (1 mark).* **6 marks**

e) *The client should seek utility model protection (1 mark)*

Any sensible points (1 mark each):

Advantages

- lower standard inventiveness,*
- formal examination only,*
- fast registration of enforceable right,*
- lower cost registration.*

(up to 2 marks)

Disadvantages

- shorter term protection,*
- no harmonised laws between countries,*
- available in fewer countries than patents,*
- restricted subject matter that can be protected*

(up to 2 marks)

5 marks

Total: 20 marks