

Foundation Certificate

FC3 International Patent Law

Thursday 12 October 2023

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 pre-set 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 **8 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

- 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**

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**

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**

Question 4

- a) Where a PCT patent application claims priority, what is the unextended 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

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

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

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

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

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

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