Paper Ref	Sheet	Percentage Mark Awarded
FC3	1 of 21	67%

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1.

a)

- Centralised prosecution at the EPO as opposed to multiple national patent application prosecutions, which is easier to manage and saves money.

- Centralised renewal fees due at the EPO whilst European patent application pending rather than multiple renewal fees before each national jurisdiction where protection is sought (before converting validating EP patent in separate jurisdictions), which saves significant amount of money.

b)

- If patent protection is only sought in a few European countries that are members to the EPC, then it will be more expensive to prosecute the European patent application as opposed to separate national prosecution in the European countries of interest.

- Limited to prosecution in either French, German or English. If, for example, you are an Italian patent attorney, you will be forced to undergo prosecution (and hence any potential oral proceedings) before the EPO in one of these languages, which is inconvenient if you are not a native speaker.

c)

First, there must be a deadline that must have passed in relation to a European patent application, by which date there must have been an act or a fee (or both) that have been omitted by the applicant.

Page sub-total

The EPO will issue a notification of loss of rights to the applicant in respect of the patent application. The date of notification of loss of rights + 10 days (for EPO postal rule [applicable only before 1 November 2023]) + 2 months sets the deadline by which further processing should be requested, the omitted act(s) completed, and the further processing fee paid. The further processing fee is a flat fee in terms of omitted acts, and for omitted fees is a 50% surcharge of that relevant fee.

d)

Re-establishment of the deadline for payment of a renewal fee before the EPO can validly be requested up to a year after the renewal fee period has passed.

Under the EPO, renewal fees are due at the end of the month containing the anniversary of the filing date of the patent. The first EPO renewal fee is due on the second anniversary of filing (in respect of the third year). Further annual renewal fees are due whilst the EP patent application is pending.

The period for paying the renewal fee late is 6 months after the end of the month containing the anniversary of filing date, plus an additional fee.

After this has expired, the application will be deemed withdrawn. Within a year of this, the applicant must request re-establishment of rights. They will have to pay the renewal fee plus additional fee, alongside evidence that the non-payment of renewal fee in the prescribed period was both unintentional, and that all due care was taken to ensure that the renewal fee was paid, yet was still missed.

5

MARKS AWARDED: 5/9

Page sub-total

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2.

a)

Canada: No, utility model protection is not available.

USA: No, utility model protection is not available.

Japan: Yes, utility model protection is available.

Germany: Yes, utility model protection is available.

China: Yes, utility model protection is available.

b)

Utility model protection may be requested via the PCT in a very similar way to a patent application. In the countries where utility models may be validly protected via the PCT (note utility model protection via PCT not available in France and Italy, for example), upon reaching 30/31 months from priority date (or in absence of priority date, international filing date), when entering the national phases, the relevant documentation should be filed requesting a Utility model, and relevant fees paid to the national offices.

5.5

MARKS AWARDED: 5.5/6

Page sub-total

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3.

a)

The search and examination procedure in Germany is optional.

Typically, the patent application is subject to examination for formalities only (i.e. checking relevant fees paid, documents are in order and there are no obvious defects in the application).

Such a search/examination procedure may be requested either by the applicant or by a third party.

If such a search is requested, the fees during examination are significantly reduced.

The deadline for requesting search/examination in Germany is 7 years from the filing date of the application.

The examination procedure will consist of written opinions issued by the German patent office on substantive defects within the application (if any), relating to the patentability of the application, to which the applicant must respond.

b)

It is not possible to file a national French patent application from the PCT, as this must be granted through the EPO and then validated in France. If this is the case, then the renewal fees would be payable to the EPO, not the French Patent Office.

However, if filing directly with the French Patent Office, renewal fees are due in respect of the 2nd year from filing.

2.5

MARKS AWARDED: 2.5/6

Page sub-total

4.

a)

The unextended deadline for entering the national phase in Singapore from a PCT application is 30 months from the priority date.

b)

The extended deadline for entering the national phase in Singapore from a PCT application is 32 months from the priority date, subject to the payment of an additional fee.

c)

In Singapore, there are different routes available for search and examination.

1.

The first option is that you could request local search and examination within 36 months of the priority claim.

The Singapore Intellectual Property Office (SIPO) will then issue a first written opinion in relation to the application and substantive defects relating to the patentability of the application (if any).

This first written opinion will set the applicant a 5 month term for response, wherein they must respond to SIPO with argumentation and/or amendments.

It will then be down to the discretion of the examiner whether they issue any further written opinions, which set further 5 month terms for response.

The local search and examination must reach a conclusion by 18 months from the issuance date of the first written opinion, whereby SIPO will issue notification of intention to grant, or a notice of intention to refuse.

If notification of intention to refuse is issued, the applicant has 2 months to file a divisional application before the application is irrevocably refused.

2.

The second option is that you could not request local search and examination, and file a PCT application at a competent receiving office (SIPO, International Bureau of WIPO, if Singapore national) using the Singapore application as the priority filing. You would then be able to select a competent International Searching Authority (ISA), and address using Article 19 PCT any issues they raise regarding the claims of the international application (must be made by the later of 16 months from priority of 2 months from transmittal of the International Search Report). Upon entering the Singapore national phase from the PCT international phase (see deadline above, 30 months from priority), use the search results of a highly regarded ISA (such as the EPO), and your amendments to address such issues to achieve a grant of a Singapore national patent.

3.

The third option is that you could, within 12 months of the filing of the priority application Singapore, file an application claiming priority on the Singapore application in a jurisdiction such as the EPO. You may then request accelerated search and examination before the EPO (PACE scheme), and should be able to

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achieve a reasonably speedy grant (provided all deadlines are met). Once this has been obtained, you may mirror the granted EP claims in the Singapore application and use Patent Prosecution Highway (PPH) to obtain an expedient grant of a Singapore patent. The request for PPH must be requested within 36 months of priority date.

MARKS AWARDED: 2.5/8

2.5

Page sub-total

5.

a)

Any person may file an opposition against the granted European Patent (EP), but not the proprietor of the patent in question. The time limit for filing an opposition before the EPO is 9 months from the mention of the grant of the patent in the European Patent Bulletin.

b)

No, this is not possible. A European patent will designate a set of states. The European patent must be opposed as a whole, not picking certain sets of states.

If only certain states (jurisdictions are of interest), it may be possible to file invalidation proceedings of the national patents once validated in their respective jurisdictions.

c)

A notice of opposition must be filed in writing at the EPO within 9 months of mention of the grant of the European Patent in the European Patent Bulletin, and the opposition fee paid.

This notice of opposition must comprise:

- Details of the patent opposed (such as the publication number)
- Grounds of opposition (must identify all that are relevant now, as further grounds of opposition cannot be raised at a later date), selected from
    - Patentability (novelty, inventive step, industrial applicability, exclusions to patentability);

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- Sufficiency of disclosure (not clearly and completely disclosed such that the skilled person can work the invention without undue burden);
- Added matter (subject matter extends beyond the content of the application as originally filed);
- Added matter (protection to which the patent confers has been extended by an amendment which is not allowable).

- Statement backing up the grounds of opposition, such as a brief explanation, evidence and argumentation of how the application is not allowable (not full written submissions at this stage of proceedings – this is invited at a later date).
- Identification of any relevant prior art that the opponent wishes to make use of (must be submitted now as may not be admissible at a later date).

The identity of the opponent may be kept anonymous at this stage of proceedings, but must supply details of a contact (for example, could be a straw man).

MARKS AWARDED: 5/8

5

Page sub-total

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6.

Deadlines for requesting examination for national applications derived from a PCT application in:

China: 3 years from priority date (international filing date in the absence of any priority date).

Japan: 3 years from international filing date.

South Korea: 3 years from international filing date.

Australia: 5 years from international filing date, or earlier if directed by Australian Patent Office (usually must be requested within 2 months of notification of direction).

India: 4 years from priority date (international filing date in the absence of any priority date).

Canada: 4 years from international filing date.

MARKS AWARDED: 3/3

3

Page sub-total

8.

a)

To qualify as a small entity status in the US:

- The entity must have fewer than 500 employees.
- The entity must not have any agreement in place to grant, assign, or licence the right in the patent application to an entity that does not meet these same requirements.
- The entity may be a higher educational institution (such as a university) or may be a not-for-profit organisation.

Also, the entity must not qualify as a micro-entity status or a large entity status.

b)

A benefit for claiming small entity status in the US is that fees for small entities are discounted by 50% in comparison to the fees paid by large entities.

c)

If an entity fraudulently claims small entity status, they may be ordered to pay the fees that are missing under a large entity status, plus additional fees if so ordered by the court.

It may also be decided that their patent or patent application should be revoked.

d)

FARMI file US-A, relating to compound X, on 15 January 2023, without a claim to priority.

Compound X is also disclosed by FARMI, in Europe through a journal article published 25 September 2022 (thus before the filing date of US-A).

The US has a 12 month grace period for inventor disclosures, wherein such a disclosure will not count as novelty destroying prior art, given that an application for a patent in respect of the disclosed invention is filed within 12 months of the disclosure.

It does not matter that the disclosure was made in Europe or the US.

We are told that the applicant of the US patent application is FARMI, and that the article is disclosed by FARMI.

As long as FARMI is the named inventor on US-A, then such disclosure will not be novelty destroying, as US-A is filed within a year of the journal article publication.

If FARMI is not the named inventor on US-A, then the disclosure will be novelty destroying.

e)

FARMI's competitor independently filed a US patent application US-B, disclosing Compound X in October 2022 with no priority claim.

The US operates a first to file system in establishing prior art (as opposed to the first to invent system that was employed prior to 2012).

October 2022 (filing date of US-B) falls after the journal publication in Europe by FARMI on 25 September 2022, but before the filing date of US-A of 15 January 2023.

In this case, US-B will not count as novelty destroying prior art, due to the disclosure of Compound X in the journal publication.

This is because, the competitor could have read the journal article and immediately filed a patent application in respect of compound X.

As there is no priority claim from US-B, this means the first filing falls after the journal disclosure.

However, if the competitor can show that they used a grace period themselves in respect of a disclosure that predates the European journal article, then US-B will be novelty destroying in relation to US-A.

f)

As the UK patent application in relation to Compound Y was filed 1 August 2022, and as the applicant has made an enabling public disclosure, there is no possibility of the applicant filing a Hong Kong patent application either as a first filing (no grace period for enabling disclosure, so this will count as novelty destroying disclosure), or claiming priority on the UK application (as more than 12 months has passed).

However, it is possible to use the publication and grant of the UK patent in order to obtain patent protection in Hong Kong, as Hong Kong recognises publication and grant of UK, EP(GB), and CNIPA patents.

Firstly, within 6 months of publication of the UK patent application (which will occur around 18 months after 1/8/22 – so roughly February 2024), the applicant must file a request to record the UK patent application in Hong Kong, and pay the relevant fee.

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Secondly, within 6 months of the grant of the UK patent, the applicant must file a request to register and grant the UK patent in Hong Kong, and pay the relevant fee.

MARKS AWARDED: 16/20

16

Page sub-total

Examiner's use only

9.

a)

At the EPO, it is possible to request accelerated search and examination in respect of the European patent application under the PACE system.

Such a request should be made on filing for accelerated search (or within 1 month of filing the European patent application), and for accelerated examination should be made within 6 months of mention of publication of the European Search Report (ESR) in the European Patent Bulletin (but in reality need to do as soon as possible from publication of the ESR).

A request for accelerated search and examination does not require the payment of a fee (on top of the typical search and examination fees).

However, if PACE is requested, and a deadline for responding to a communication (for example, a deadline set under 94(3)) is missed by the applicant, and an extension is requested (either as of right 2 months [if 4 month term set] or using further processing), then the application will fall out of the PACE system, and will not be able to be requested again in relation to this application.

b)

A Validation State is a state that recognises that European Patents are subject to rigorous prosecution. Therefore, such States have adapted their national law to require that any application deemed allowable under the EPO is considered allowable under their national jurisdiction.

Page sub-total

Cambodia and Morocco are not member states of the EPC, but have adapted their national law to recognise granted European Patents as allowable under their respective jurisdictions.

c)

To obtain patent protection in any of the validation states via a European Patent application, one must, within 3 months of notification of grant of the EP patent from the EPO file any translations necessary, and pay any renewal fees that may be due in that jurisdiction.

The translations that are required depend on the jurisdiction. For example, those party to the London agreement accept an EPO language as the description, and require translation of claims only into their language (Norway, Netherlands: although both of these are contracting states of EPO). Others require full translations of title, specification, claims, text matter of drawings (E.G. Spain, Italy: although both of these are contracting states of the EPO).

d)

The EPO does have a provision for the correction of errors, but it is extremely strict in this regard.

Firstly, it must be immediately obvious that there is an error. In this case, "Googgles" does appear to be spelt wrong, and would meet the requirement for being an immediately obvious error.

Secondly, it must be immediately apparent what the correction should be, and that nothing else could have been intended instead. Looking to this example, there are two potential corrections in my opinion. The first is a correction to

"Googles", deleting a single "g". The second is a correction to "Goggles", deleting a single "o".

Admittedly, the EPO will use the context of the application in considering the correction, which could sway them in deciding whether or not. As the invention is in relation to skiing goggles, it is clear that "goggles" was intended.

Therefore, I think that the EPO will accept the correction to "goggles", as long as it is not possible that "googles" make sense in the context.

Perhaps this is being too pedantic, but the EPO have become extremely strict in relation to correction of errors recently.

e)

Third party observations may be validly filed at the EPO at any point from publication of the European patent application up until grant of the European patent (mention of grant in European Patent Bulletin).

As the conditions for grant of a European Patent have not yet been met (within date of R71(3) communication + 10 days (EPO postal rule) + 4 months: approve text for grant, file translations of the claims into the other two languages of the EPO, i.e., if proceedings in English, translations into French and German, and the payment of the grant and publication fee), third party observations may still validly be filed.

As we fall within this period, the EPO will likely have to consider the content of the third-party observations.

The third party observations may not be admitted at the discretion of the European examiner, if they feel as if the objections have been sufficiently

addressed in prosecution, if they feel the observations are vexatious or frivolous in nature or if they have been submitted in bad faith.

As the third-party observations are in English, if admitted, the European examiner will forward these observations on to the applicant (assuming the proceedings are in English, otherwise they may provide a translation).

The applicant may then have an opportunity to respond to the observations.

The examiner consequently considers the third party observations, and issues an opinion to both the applicant and the third party.

If the examiner deems the application to be allowable in view of the third party observations, a new R71(3) communication will be issued, setting a further deadline for the acts mentioned above.

If the examiner deems the application not to be allowable in view of the third party observations, they will remit the case back to the examining division.

MARKS AWARDED: 9.5/20

9.5

10.

a)

A method of treatment of the human or animal body is not considered a patentable invention under the EPO.

However, this exclusion does not apply to substances or compositions for use in such methods. Thus, as the compound has only previously been utilised for headaches, and is now being used for treating itchy skin, a second medical use claim should be drafted for the EPO along the lines of "Compound X for use in the treatment of itchy skin".

A method of treatment of the human or animal body is a patentable invention before the USPTO.

The applicant could also submit the second medical use claim before the USPTO too, in order to obtain as broad a scope of protection as possible.

b)

A house alarm that gives potentially lethal electric shocks to intruders will likely be excluded from patentability under both the EPO and the USPTO.

Such an invention would be prejudicial to the safety of the public, or ordre morale, and, as the intruder would fall under the public bracket, this would not be patentable before the EPO or the USPTO.

c)

A method of doing business per se, is not a patentable invention under the EPO, However, this exclusion relates only to the method of doing business as such. If

there is some additional benefit associated with the method, this may be patentable.

Methods of business are considered patentable inventions before the USPTO.

d)

If an invention is disclosed last week in a breach of a non-disclosure agreement, then this may still be patentable before the EPO.

It needs to be shown that there has been a breach of a duty of care for the disclosure not to count as novelty destroying. In this case, there clearly existed a duty of care, as there was a non-disclosure agreement between the parties.

Provided the non-disclosure agreement was in respect of the invention, as the non-disclosure agreement was breached, then there has been a breach of the duty of care, and therefore the invention may still be regarded as patentable before the EPO.

Consequently, a patent application in respect of the disclosed invention should be filed as soon as possible before the EPO, and may also require evidence of such a breach (for example the non-disclosure agreement). In any case this should be done within 6 months of the disclosure.

Now, in relation to the US, there exists a 12 month grace period, both for inventor disclosures and for disclosures made against the inventor's will.

Provided the inventor is still the applicant, then a patent in respect of the disclosed invention will still be obtainable if filed before the USPTO within 12 months of the disclosure, as the disclosure as a result of the non-disclosure

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agreement breach will not be regarded as novelty destroying against the application.

e)

Another form of Intellectual Property that my client could pursue is Utility Models.

Advantages:

- Utility models often have a lower threshold to inventive step than that required in patent applications. Therefore, provided the combination of the two existing products is novel over the prior art, this is probably enough to ensure a utility model can be obtained.
- The time taken to obtain a registered utility model is significantly shorter than the time taken to obtain a granted patent, usually attributed to lack of substantive examination for utility models. Thus can enforce registered utility model rights faster from filing than enforcing patents from filing.

Disadvantages:

- Utility models have shorter lifetime than patents (10 years from filing date [utility model] rather than 20 years from filing date [patents]).
- Utility model protection not as widespread as patent protection, as not all jurisdictions offer utility model protection.

MARKS AWARDED: 18/20

18

Page sub-total