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FC3	1 of 10	57%

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Section A

Answer 1

- a. 2 advantages of seeking patent protection via the EPO are –
 - 1. Consolidated payment of renewal fees until patent is granted.
 - 2. Lower cost of prosecution when compared to filing in individual countries.

- b. 2 disadvantages of seeking patent protection via the EPO are –
 - 1. National validations granted via the EP application are vulnerable to central revocation during the opposition period if the patent is challenged at the EPO.
 - 2. Different translation requirements for validating in different member states.

- c. Further processing can be requested where a time limit for responding to a Communication or performing certain actions has been missed in relation to a pending European Patent application. Further processing must be requested within two months from the issuance of the notice of loss of rights. The omitted act must be completed, any missed fees paid including a late fee.

- d. Re-establishment is requested retroactively i.e after the patent application or patent has lapsed. It may be requested in relation to the non-payment of renewal fees. In order to re-establish such a deadline, the application must submit a request for re-establishment in writing to the EPO. Additionally, the applicant must satisfy the EPO that the deadline was missed in spite of 'all due care' being taken during prosecution of the

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application or maintenance of the patent to ensure that payment would not be missed. The applicant must also pay the missed fee alongside a late payment surcharge.

MARKS AWARDED: 4.5/9

4.5

Answer 2

- a. Canada – No, utility model protection is not available in Canada.
- USA – No, utility model protection is not available in USA.
- Japan – Yes, utility model protection is available in Japan.
- Germany – Yes, utility model protection is available in Germany.
- China – Yes, utility model protection is available in China.
- b. Utility model protection via the PCT route is only available in a limited number of countries. It may be requested during national phase entry by converting the international patent application into a national utility model.

MARKS AWARDED: 6/6

6

Answer 3

- a. The deadline for requesting examination of a patent application in Germany is 7 years from the filing date of the application.
- A search in relation to a German patent application may be requested by the applicant or by a third party. A third party does not become involved in proceedings by requesting a search. If a search is requested, the patent office will provide a reduction in the examination fees. If no search/examination is requested by the applicant or by a third party, the application is examined for formal requirements only.
- b. No, renewal fees are not due on a French application until it is granted.

MARKS AWARDED: 2.5/6

2.5

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Answer 4

- a. The unextended deadline for entering national phase in Singapore is 30 months from the earliest priority date.
- b. Late entry into national phase in Singapore may requested within 2 months from the expiry of the statutory deadline to enter national phase i.e a total of 32 months from the earliest priority date.
- c. Grant of a Singaporean patent may be requested on the basis of search and examination of the patent that has been carried out by a foreign patent office.
Search and examination may also be requested directly from the national patent office of Singapore.

MARKS AWARDED: 2/8

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Answer 5

- a. Any third party may file an opposition against a granted European Patent.
The time limit for filing a request for opposition is up to 9 months after grant of the European Patent, more specifically, after the mention of grant in the European patent bulletin.
- b. No, opposition of a European Patent is a central act that will apply to all member states designated in the European Patent.
- c. A validly filed notice of opposition must be in writing and contain –
 1. A request to file opposition.
 2. Statement of grounds on which the opposition is being filed.
 3. Name of the opposing party, although a straw man may be used if the true opposing party wishes to remain anonymous.

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4. Detailed reasoning and arguments as to why the patent is being opposed.

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5. Any documentary evidence to support the opposition claim.

MARKS AWARDED: 5/8

5

Answer 6

China – 3 years from priority date.

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Japan – 36 months from filing date.

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South Korea – 36 months from filing date.

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Australia – 5 years from filing date or 2 months from invitation to request examination.

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India – 48 months from international filing date.

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Canada – requested upon entry into national phase.

MARKS AWARDED: 2.5/3

2.5

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Section B

Answer 7

- a. Yes, a PCT application can be validly filed as long as any one of the applicants is eligible to request an International patent at a Receiving Office by virtue of being a national of or having a habitual residence or real and effective commercial or industrial establishment in a State that is party to the PCT. In this case, even though the Argentinian University itself is not eligible, the UK-based client is. /
- b. If the PCT request form is not validly signed, the application will not be given a filing date until the deficiency is rectified. /
- c. If the deadline for filing formal drawings is missed, the Receiving Office will issue a notice informing the applicant. /
- d. Such an assignment should be recorded in writing by filing a request for recordal at the Receiving Office. /
- e. Amendment under Article 19 may be filed by the later of 16 months from priority or 2 months from the issuance of the International Search Report. Under Article 19, only the claims in a patent application may be amended. There is no fee required to file Article 19 amendments. However, the applicant will not get an opportunity for dialogue with the Examiner. /
- f. International Preliminary Examination may be requested within 22 months from priority. It must be requested in writing to Receiving Office. The request for International Preliminary examination must identify a competent International Preliminary Examining Authority (IPEA) and the relevant fees must also be paid when requesting examination. /

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g. 2 reasons for –

1. May be useful for obtaining a favorable International Preliminary Report on Patentability (IPRP).
2. May expedite prosecution in the country where the IPEA is based.

2 reasons against –

1. Most countries will perform their own search and/or examination when the application enters national phase anyway.
2. Increase in costs related to prosecution.

h. Enter European regional phase with claims relating to both inventions.

Then, file voluntary amendments withdrawing the claims related to the second invention from the patent application. Then, file a divisional application for the claims relating to the second invention and pay the relevant filing fees and any renewal fees that are due. A divisional application may be filed in relation to a European patent application as long as the EP application is pending.

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MARKS AWARDED: 7.5/20

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Answer 8

- a. In order for an applicant to qualify for small entity status –
 - 1. It must employ no more than 500 employees.
 - 2. It must not be bound by any assignment, transfer or licensing obligations with any entity that does not qualify for small entity status.
- b. One benefit of claiming small entity status is that the fees relating to the prosecution of a US patent application are discounted by 50% in comparison with a large entity.
- c. If small entity status is claimed fraudulently –
 - 1. The patent application to which the claim relates will be refused.
 - 2. The applicant may be subject to punitive measures in accordance with US federal law.
- d. Yes. US-A would be considered novel over the journal disclosure. This is because the USPTO grants a 12-month grace period for non-prejudicial disclosures by the applicant. Since the journal was published 25th September 2022 the grace period will last until 25th September 2023. The patent application filed on 15th January 2023 thus, application was filed within the 12-month grace period.
- e. Yes, this is because the journal was published before the competitor's application US-B was filed. The competitor's claims to compound X will not be considered novel due to prior disclosure in the journal. However, since the disclosure in the journal was made by the applicant, on account

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of the grace period identified above, the applicant's claims will still be considered novel.

f. Generally, there are two ways of obtaining patent protection in Hong Kong

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1. Direct Filing – Direct filing will no longer be possible in relation to the patent application for Compound Y since it has already been publicly disclosed. Hong Kong does not offer the applicant any grace period in relation to non-prejudicial disclosures.

2. Re-registration on the basis of the UK application – This is a 2-stage process through which it is still possible to obtain protect for the patent application for Compound Y in Hong Kong.

Stage 1 – Submit a Request to Record at the HK patent office within 6 months from publication of the UK patent application. Since the application was filed on 1st August 2022 in the UK, it will be published 18 months from the filing date i.e 1st February 2024. Thus, the request to record must be filed no later than 1st August 2024. The relevant UK patent application must be identified as part of the request.

Stage 2 – Submit a Request for Registration and Grant within 6 months from the grant of the UK patent application.

MARKS AWARDED: 12.5/20

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Answer 10

- a. EPO – Method of treatment of humans or animals is not considered to be a patentable invention. Since the present invention relates to a method of treatment of skin, it will be excluded from patentability by the EPO.
USA – Methods of treatment are not patentable in the US. Therefore, the present invention will also be excluded from patentability in USA.
- b. EPO – Any invention that is prejudicial to public safety is not patentable via the EPO. Since the present invention involves delivering lethal shocks, it is likely to be extremely prejudicial to public safety and as such, will be excluded from patentability.
USA - Any invention that is prejudicial to public safety is not patentable via the USPTO. Since the present invention involves delivering lethal shocks, it is likely to be extremely prejudicial to public safety and as such, will be excluded from patentability in USA.
- c. EPO – Methods of doing business are excluded from patentability at the EPO. Therefore, the invention is not patentable.
USA – Methods of doing business are not excluded from patentability in USA. Therefore, the invention is patentable in USA.
- d. EPO – The EPO provides a 6-month grace period for disclosure of an invention that was not disclosed by the applicant, but rather a third party in violation of a confidentiality agreement. Since the invention was only disclosed last week, it is still eligible for patent protection via the EPO.
USA – The USPTO allows a 12-month grace period in relation to all disclosures of the invention including disclosure by a third party in

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violation of a confidentiality agreement. Therefore, the invention is still patentable in USA.

e. Another form of intellectual property that could be applied for is a Utility Model.

2 advantages –

1. Generally, a lower bar, if any, for novelty and inventiveness as compared to a patent.
2. Usually lower is cost as compared to a patent.

2 disadvantages –

1. Not all countries of interest may offer utility model protection.
2. Protection usually last for a shorter term between 8 to 15 years as compared to a patent that generally lasts for 20 years.

MARKS AWARDED: 14/20

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