

Foundation Certificate

FC3 International Patent Law

Thursday 24 October 2024

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 preset 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 **7 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

You are the appointed representative for your client, who is the owner of EP-1, a European patent application that was filed in English. The Examining Division has issued a communication under Rule 71(3) EPC, informing you of the text in which it intends to grant EP-1 as a European patent.

- a) **Outline the steps that need to be taken before the EPO, in order to bring EP-1 to grant. Include any deadline(s) by which the steps need to be taken. You are not required to take into account possible extensions of the deadline(s).**
4 marks

- b) **Identify what translations (if any) are required as part of validation of EP-1 in the following EPC member states. Explain why translations are (or are not) needed:**

**Spain;
France;
Netherlands.**

7 marks

- c) **Outline the steps required to request a unitary patent, including the deadline by which the steps need to be taken.**
4 marks

Total: 15 marks

Question 2

For each of the following countries, state whether a grace period for the applicant's own prior disclosure is available: Australia, Israel, Mexico, Singapore, South Korea and the United States.

3 marks

Question 3

Outline the procedure for filing an opposition to a granted Japanese patent.

3 marks

Question 4

Your client contacts you in relation to a previously filed PCT patent application, WO-1.

The PCT patent application was filed on 27 August 2024, and claims a priority date of 27 August 2023. Upon reviewing the filing receipt of the application, you notice a typographical error in the applicant's name.

- a) **State the competent authority to decide on the request for correction. Give a reason for your answer.**

2 marks

- b) **Outline the criteria that must be met for the request for correction to be accepted, and the documents that would be considered by the competent authority.**

5 marks

- c) **What is the deadline for submitting the request for correction? You are not required to take into account any patent office closed days.**

2 marks

Total: 9 marks

Question 5

Your client filed a PCT application having a priority date of 18 September 2022, and now wishes to seek protection in several countries, including the United States. Your client is a UK limited company having seven employees and is pre-revenue generating. It has not filed any previous patent applications in the United States. It has, however, licensed the invention claimed in the PCT application to a not-for-profit research organisation.

- a) **Identify the deadline for filing a national phase application in the United States. You are not required to take into account any patent office closed days.**

1 mark

- b) **Identify the types of entity status at the USPTO and describe the requirements for each.**

6 marks

- c) **Conclude which entity status applies to your client. Give reasons for your answer.**

3 marks

Total: 10 marks

Total for SECTION A: 40 marks

SECTION B

Question 6

According to Article 54 EPC and Article 56 EPC, novelty and inventive step of an invention is assessed with regard to the state of the art.

- a) Discuss what is comprised by the state of the art, and the relevant date by which the state of the art is assessed.

7 marks

Your client owns the following IP portfolio:

EP-1, a European patent application. EP-1 was filed on 4 April 2018, without a priority claim. It was published on 25 October 2019, and subsequently deemed withdrawn for failure to respond to an examination report.

EP-2, a European patent application. EP-2 was filed on 1 April 2021, and claims a priority date of 5 September 2020. It was published on 10 March 2022.

DE-1, a German national patent application. DE-1 was filed on 27 August 2020, without a priority claim. It was published on 1 March 2022.

Your client is very concerned about their main competitor's key European patent, EP-X, and wonders if their IP portfolio could be used to oppose EP-X. EP-X was filed on 5 September 2021, and claims a priority date of 5 September 2020. Publication of mention of grant of EP-X occurred on 10 July 2024.

- b) Prepare notes for a call with your client, explaining whether each of EP-1, EP-2 and DE-1 can be cited against EP-X for novelty and/or inventive step, in an EPO opposition. Explain your reasoning and state any assumptions that you make.

9 marks

- c) Discuss the requirements and time limit for opposing EP-X at the EPO. You are not required to take into account any patent office closed days.

4 marks

Total: 20 marks

Question 7

You are the patent attorney for a company that has recently acquired the following patents and patent applications:

A UK patent application (GB-1), filed on 20 September 2023.

A PCT application (WO-2), claiming priority from a German patent application (DE-3), filed on 5 June 2022.

A granted US patent (US-4) only. The grant date was 30 March 2021.

Your company wishes to pursue protection in China, Europe, Japan and the United States, via GB-1 and WO-2. Your company asks you to assess if there are any upcoming deadlines to meet for all three cases, in order to avoid any loss of rights.

Discuss, in relation to GB-1, WO-2 and US-4, what deadlines will fall due in the next six months. Include in your answer any actions that might be taken to mitigate missed deadlines. You are not required to take into account any patent office closed days.

20 marks

Question 8

Your client asks you to review two of their PCT applications, WO-1 and WO-2.

WO-1 was filed on 10 February 2023, without claiming priority. It only has 2 claims, which are both independent.

WO-1 received the Written Opinion of the International Searching Authority (WOISA) on 15 September 2024. The WOISA objects that claim 1 lacks novelty, and that claim 2 lacks clarity. Your client tells you that the WOISA objection to claim 1 is certainly correct, but asks if you can amend this claim to include a new feature that was not disclosed in the application as filed. They inform you that the objection to claim 2 can be easily overcome by introducing a feature from the description.

WO-2 was filed in Chinese on 4 December 2023, claiming a priority date of 4 December 2022. It has only two claims, which are both independent. WO-2 received the WOISA on 5 November 2023. The WOISA raised no objections to the claims. The ISA was the China National Intellectual Property Administration (CNIPA).

For WO-1, your client is considering a very wide national phase entry programme. However, in order to avoid unnecessary costs, they only want to proceed with this if they are able to obtain an entirely positive patentability opinion during the international phase.

For WO-2, your client is no longer interested in claim 1, and believes claim 2 is only commercially important for Europe. They want to pursue protection for claim 2 as quickly as possible.

- a) Devise an international/national prosecution strategy for WO-1 and WO-2, over the next twelve months, that achieves the stated aims for the client. You are not required to take into account any patent office closed days.**

16 marks

Your client has also developed a new product that they believe is commercially valuable, but is only a minor modification over what is already known. They are only interested in marketing the product in Germany and Australia.

- b) Discuss a suitable intellectual property right that could be used to protect the new product, giving a reason for your answer. State whether the intellectual property right is available in each of the countries of interest.**

4 marks

Total: 20 marks

Question 9

Your client filed a United Kingdom patent application for a cooking utensil with a filing date of 5 December 2023. The cooking utensil is manufactured and sold in China. Your client informs you that their biggest competitor is planning to manufacture a similar cooking utensil in China that would be covered by the claims of the UK patent application. Your client predicts that the cooking utensil is likely to be a market leader for at least 12 years.

- a) Devise an appropriate strategy for obtaining patent and utility model protection in China, including outlining the registration procedure in China for utility models and the term of protection. Explain one advantage of a utility model over a patent. You are not required to take into account any patent office closed days.**

10 marks

At a subsequent the meeting, your client informs you that they wish to pursue protection for a second cooking utensil in Canada, Mexico, Israel and Saudi Arabia.

- b) Outline a cost-effective strategy for obtaining protection in these countries, including any associated deadlines, whether or not claims fees are due and whether utility model protection is available or not.**

10 marks

Total: 20 marks