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Question 1

- a) In order to bring EP-1 to grant, the applicant need to respond to the communication under Rule 71(3) EPC by accepting the text for grant, translating the patent application into French and German and paying the grant and publication fee. The deadline for this action is 3 month since the date of issue of the communication under Rule 71(3) EPC. (a - 2)
- b) For the following member states:
- Spain: EP-1 needs to be translated into Spanish, because Spanish is the language required by the Spanish Intellectual Property Office and EP-1 is only available in English, French and German.
 - France: EP-1 does not need any further translation, since EP-1 is already available in French and French is the language required by the French Intellectual Property Office.
 - Netherlands: EP-1 needs to be translated into Dutch, because Dutch is the language required by the Dutch Intellectual Property Office and EP-1 is only available in English, French and German.
- c) After grant from the European patent, the applicant or the successor in title can request a unitary patent by submitting a request to the Unitary Patent Court within 3 months since the publication of grant of EP-1. (c - 1)

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Question 2

For each of the following countries:

- Australia: There exists a grace period of 12 months.
- Israel: There does not exist a grace period.
- Mexico: There exists a grace period of 12 months.
- Singapore: There exists a grace period of 12 months.
- South Korea: There exists a grace period of 12 months.
- United States: There exists a grace period of 12 months.

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Question 3

In order to file an opposition to a granted Japanese patent, the applicant needs to file the opposition within ¹6 months since the date of grant of the Japanese patent. The opposition party needs to be showed to the opposed party, no straw man situation can be used and the opposition party needs to pay an opposition ¹fee. Possible ¹grounds for opposition are added subject matter and double patenting.

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Question 4

- a) The competent authority to decide on the request for correction is the International Bureau, because the application is a PCT application and it is submitted to the IB. (a - 0)
- b) The criteria that must be met for the request for correction to be accepted are:
- 0.5
 - Mistakes must be obvious, which means that what is intended must be obvious¹
 - The name and the address of the applicant or owner can be changed.
 - No changes can be applied to:
 - Abstract
 - Priority claims if the change shall affect the priority date.
- The applicant need to submit the following documents in the current scenario: A request for making a correction, a written statement explaining the changes and a changed applicant's name. (b - 2)
- c) The deadline for submitting the request for correction is 26 months since the priority date of the PCT application, which is 27 October 2025. (c - 2)

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Question 5

a) The deadline for filing a national phase application in the United States is 30 months since the priority date of the PCT application, which shall be 18 March 2025. (a - 1)

b) Definitions for a small, micro and large entity are shown below:

- A small entity needs to be either a person, a small business with no more than 500 employees, a university or a non-profitable organisation. A small entity cannot license, grant, assign, and convey the right of the intellectual property to another entity that is not a small entity.
- A micro entity needs to satisfy the conditions of the small entity. A micro entity needs to have four or fewer patent applications. The gross income of a micro entity needs to be less than three times of the last year median household income. A micro entity cannot license, grant, assign, and convey the right of the intellectual property to another entity that is not a micro entity.
- A large entity is the entity that does not satisfy the conditions for either a small entity or a micro entity.

(b - 6)

(c - 3)

c) My client is a small business with no more than 500 employees, this satisfies the condition of a small entity. My client also has no gross income currently and less than four patents in the US. The entity status applied to my client depending on the entity status of the non-profit research organisation that my client license the invention to. If the non-profit research organisation is a micro entity, then my client can apply for a

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micro entity. On the other hand, if the non-profit research organisation is a small entity, then my client can only apply for a small entity.

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Question 6

- a) A state of the art comprises everything¹ (which can be written, orally or through the use of it) made to public before the filing date¹ of the European patent application.

If the state of the art is filed and published before the filing date of the later application, the state of the art can be cited against the later application for both novelty and inventive step. If the state of the art is filed before the filing date¹ of the later application but is published after the filing date of the later application, then the state of art can only be cited against the later application for novelty only. (a - 4)

- b) Notes are prepared for the following patent application:

- EP-1: Due to the fact that the filing date (4 April 2018) and the publication date (25 October 2019) of EP-1 are both earlier than the priority date of EP-X (5 September 2020), EP-1 can be cited² against EP-X for novelty and inventive step. It does not matter that the EP-1 is deemed withdrawn for failure to respond to an examination report.
- EP-2: Since the priority date of EP-2 (5 September 2020) is the same as the priority date of EP-X (5 September 2020), EP-2 cannot² be cited against EP-X for novelty or inventive step.
- DE-1: DE-1 is a German national patent application and is within EP region. DE-1 has an earlier filing date (27 August 2020) than the priority date (5 September 2020) of EP-X, but DE-1 has a later

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publication date (1 March 2022) than the priority date (5 September 2020) of EP-X, hence DE1-1 can cited against EP-X for novelty only.

(b - 4)

0.5

- c) The deadline for opposing EP-X at the EPO is within 9 months since the publication of mention of grant of EP-X in the EPO Bulletin, which is 10 April 2025. The requirements to oppose EP-X at the EPO are filing a request for opposition to the EPO, paying opposition fee and the possible grounds for opposition are subject matter of the patent being not patentable and the subject matter of the patent is not disclosed clearly and precisely in order for a skilled person to carry out the patent.. The applicant might not need to be indicated to the opposed party, which a straw man situation can be applied.

(c - 2)

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Question 8

- a) In order to devise an international/national prosecution strategy for WO-1 and WO-2, I would divide the notes below into two sections: WO-1 and WO-2.

WO-1

WO-1 has a filing date of 10 February 2023 with no priority date and WO-1 receives the Written Opinion of the International Searching Authority (WOISA) on 15 September 2024. Claim 1 of WO-1 lacks of novelty and it can be addressed by introducing a new feature into the application. Claim 2 of WO-1 lacks clarity and this can be address by introducing a new feature into claim 2 from the description.

For WO-1 at the international phase, I would recommend to file a demand¹ to request for an International Preliminary Examination with an Article 34 amendment, because a new feature that is not previously disclosed in the application needs to be added. The demand is filed to the International Preliminary Examination Authority. The A34 amendment enables the applicant to amend description, claims and drawings. The deadline for this action is later of 3 months¹ since the date of receiving the WOISA, which is 15 December 2024 or 22 months since the filing date of the application, which is 10 December 2024. In this scenario, the deadline would be 15 December¹ 2024.

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During the A34 amendment, the client can amend the description to introduce the new feature that is needed to address the novelty objection of claim 1. The client can then amend the claims 1 and 2 to address their objections accordingly.

By doing so, the client can obtain an entirely positive patentability opinion during the international phase before entering the national phase entry worldwide.

(WO1 - 3)

WO-2

WO-2 was filed in Chinese with a filing date of 4 December 2023 and a priority date of 4 December 2022. WO-2 received the WOISA on 5 November 2023 with no objections raised by CNIPA.

I might recommend my client to file an EP patent at the EPO while claiming priority from WO-2, the deadline for this action is 12 months since the filing date of WO-2, which is 4 December 2024. Before filing the EP application, an English translation of WO-2 is needed with claim 1 cancelled. Comparing to a national phase entry to EP from the PCT application which deadline is 31 months since the priority date of WO-2, (4 July 2025), a direct EP filing does not need to wait for a communication pursuant to R161(2) communication to be delivered to file a response with claim 1 cancelled. The client may also request for a PACE system to

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(WO2 - 0.5)

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accelerate the prosecution at EPO. In this way, my client can pursue protection as quickly as possible.

- b) Another suitable intellectual property right that could be used to protect the new product is a utility model. Because utility model has very low standard for inventive step, the product with a minor medication over what is already known suits perfectly well for this situation. Germany provides protection for a utility model, where Australia does not provide protection for a utility mode.

(b - 4)

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7.5

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Question 9

- a) In China, a utility model can be registered by either filing a Chinese utility model or requesting a Chinese utility model from a PCT application. It is worth noting that from a PCT application, an applicant can request either a Chinese utility model or a Chinese patent application from the PCT application, but not both. In China, a utility model will have a formality examination but not a substantive examination. In China, a utility model can protect a product but not the method of use. The protection for a utility model can last up to 10 years. An advantage of a utility model over a patent is that a utility model has a lower inventive step standard compares to a patent.

In this situation, I would divide patent and utility model protection in China into two sections.

Patent

For patent protection in China, I would recommend my client to file a PCT application and claim priority from the UK patent application. The deadline for this action is 12 month since the filing date of UK patent application, which is 5 December 2024. Once the PCT application is filed, the applicant can choose to enter national phase in China and request for a Chinese patent application, the deadline for this action is 30 months since the priority date of the PCT application, which is 5 June 2026. Before entering the national phase in China, a Chinese translation of the patent application is required.

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The reason for applying for a PCT application is that it allows us a longer time to request for a patent in China compare to filing a Chinese patent application claiming priority from UK application, where the deadline for this action is 12 month since the filing date of UK patent application, which is 5 December 2024.

Utility Model

For utility mode, I would recommend my client to directly file a Chinese utility model application at the CNIPO with priority claimed from the UK patent application. The deadline for this action is 12 month since the filing date of UK patent application, which is 5 December 2024.

Conclusion

My client predicts that the cooking utensil is likely to be a market leader for at least 12 years, and the protection for a utility model is 10 years while the protection for a patent is 20 years. Based on the above factors, I recommend my client to have a better preparation when requesting a Chinese patent application, because it can provide a longer protection. Whereas, the utility model provides a shorter period of protection and the time pending for a utility model is considerably less than a patent, so the utility model can be filed as soon as possible in order to prevent my competitor from manufacturing the cooking utensil.

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b) For a cost-effective strategy for obtaining protection in Canada, Mexico,
Israel and Saudi Arabia, I would recommend to file a PCT application and
enter these countries during the national phase because they are all
members in the WIPO. In this way, instead of responding to objections
from four searching authorities, client only need to respond to objections
from one international searching authorities.

The deadline for entering national phases for these countries are all 30
months from the filing date or priority date if applicable, of the PCT
application. Utility model is available in Mexico and Israel and it is not
available in Canada and Saudi Arabia.

0.5

0.5

(4.5)

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9.5

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