Paper Ref	Sheet	Percentage Mark Awarded
FC3	1 of 10	65%

Examiner's use only

Question 1

a) Communication under Rule 71(3) EPC is a Notice of allowance; we need basically approve the text (Druxexemplar) by just filing German and French translations[1] of claims[1], and pay printing[1] and grant fees to the EPO within 4 months[1] from the date of issuance of 71(3) EPC communication (4)

b) Spain→ Spanish translation[1] of the whole specification (title, abstract, description, claims) because Spain is not part of London agreement

France→ we do not need[1] to file any translations, because the claims are already being translated to French in order to getting grant, and France is part of London agreement[1]

Netherlands→ because description is already in English and[1] Netherlands is part of London agreement, we just need to translate[1] claims to Dutch (5)

c) We need to file a request for Unitary patent using a[0.5] form, pay fee, indicate what patent[0.5] we want unitary[0.5] effect for and file the whole specification into any other language of a[1] EPC member state. We do request unitary patent within 1 month[0.5] of the date when EPO has published the grand date in EP bulletin. However, the translations do not need to be filed right away, they can be filed when given notice from the EPO (3)

12

MARKS AWARDED: 12/15

Question 2

Grace period for self disclosure is not available in: Israel

Grace period for self disclosure is available in: Australia, Mexico, Singapore, S. Korea, and United states

3

MARKS AWARDED: 3/3

Page sub-total

Question 3:

Opposition needs to be requested[1] within 6 months after the date of grant, by filing a notice of opposition, stating[1] grounds for opposition, and identifying the applicant for the opposition→ cannot file for opposition in Japan anonymously; and also a fee needs[1] to be paid

Grounds for opposition: double patenting, patentability (novelty, inventive step), added matter, mistakes in translations, and insufficient disclosure (3)

MARKS AWARDED: 3/3

Question 4:

a) Receiving office (RO) is the competent[1] authority, as this error relates to a formality information of the patent application

b) The mistakes must be obvious[0.5] to the competent authority (not just anyone) and it needs to be clear that nothing[1] else could have been intended at the time of filling; RO will consider the application[0.5] from which priority is claimed to compare with current application with faulty name to see whether it is really an error

c) The deadline is 24 months from the priority date → 27 August 2025

3

MARKS AWARDED: 3/9

Question 5:

a) Deadline for filing[0.5] a national phase in the USA is 30 months from the priority date (18 Sep 2022)→ 18 March 2025[0.5]

b) There are 3 types:[1]

Small entity status: independent inventor or any other individual, or business with less than 500[1] employees, or a non-profit organization and

Page sub-total

1 they have not assigned, licenced, or any other way conveyed the right of the invention to a non-small entity, and are not under any contractual obligation to do

Micro entity status: same as 1 small entity status plus an employee of higher education (i.e. University), who has assigned, conveyed, licensed the rights under the invention to the higher education employer or is under the contractual obligation to do so; or an individual who has not been named on more than 4 1 previous national patent applications filed at USPTO and his annual income is not 3 1 times larger than the gross median income of a household in the previous financial year and has not assigned, granted, licensed the right of the invention to a person who also do not satisfy these income requirements and is not under contractual obligation to do so

Large entity status: everybody else but micro entity status and small entity status 1 (6)

c) Client is a small company with just 7 employees (less than 500) and they have not generated any income yet; plus they have not filed any patent applications in USPTO (less than 4)→ therefore client would be considered to have micro entity status (3) 10

MARKS AWARDED: 10/10

Question 6:

a) The state of art is basically any 1 disclosure of a subject matter that is relevant to the patentability of our application and that has been available to the 1 public at least a day 0.5 before the priority date of our patent application or before the filing 1 date of application, if the subject matter is disclosed for

the first time. The state of art can be an earlier patent application, utility models journals, scientific papers, and so on…does not need to be just earlier patent or patent application. The prior art which is filed and published (made available to public) before the filing/priority date of our application is considered as full prior art and therefore can be considered for both novelty or inventive step

Novelty only prior art also exists, where the prior art[1] has been filed (in the same jurisdiction) before priority/filing date[1] of our application, but the prior art has been published after the filing date of our application. This type of prior art is only relevant to access novelty so to prevent double patenting. (5.5)

b)

- Opponent's application priority EP-X 5 Sep 2020
- EP-1 can be considered as full prior art to asses both novelty and inventive step because[1] it was both filed and published before the priority date of the competitor's[1] application; and it does not matter that the application has been withdrawn because it was already published and therefore available to the public
- EP-2 has the same priority date as the[1] competitor's EP-X, therefore EP-2 cannot be considered as prior art because[1] it has to be filed at least one day prior to the priority date of EP-X
- DE-1 has an earlier filing date than EP-X priority date but DE-1 was published after the priority date of EP-X so DE-1 could be considered as novelty only prior art if EP-X is also designated in Germany (4)

c)

- To be able to conduct opposition, the opposition request needs to be filed within 9 months after the grand of the patent, the applicant wants to oppose→ 10 April 2025 is the deadline 0.5 0.5
- We need to state the grounds for opposition→ so in this case novelty and inventive step are both relevant grounds 0.5
- We need to pay the fee 0.5
- And we may provide identity the person who is opposing; however we do not need to as you can also bring opposition incognito (2) 11.5

MARKS AWARDED: 11.5/20

Question 7

Today is 24 October 2024

GB-1 related deadlines:

- UK application filed on 20 September 2023
- Therefore, to file a PCT application which can claim priority from the UK application, we have to file the PCT application within 12 months from the filing date of GB-1→ deadline is 20 September 2024 and therefore missed 1 0.5 0.5
- There is an extension available for late filing which is 2 months after initial deadline of 12 months→ so new deadline is 20 November 2024 1
- So by 20 November 2024, we need to file a PCT(GB-1) application, file request for restoration, pay restoration fee, and file evidence/disclosure/witness statements that missing the deadline was unintentional and all due care 1 (4)

Page sub-total

- Restoration is a discretionary right but if proper evidence is given than it should be accepted by RO
- If this is accepted, within 1 month of the filing: we need to pay filing fee, and request search plus pay search fees
- And within 16 months from the priority date→ by 20 January 2025 we also need to file declaration of inventorship
- No translations are required as the application is in English and we are filing the PCT application at UKIPO

WO-2 related deadlines:

- Priority date is 5 June 2022
- 30 months from 5 June 2022→ 2 December 2024
- 31 months from 5 June 2022→ 2 January 2025
- China, Japan, and USA have all national entry deadlines of 30 months from the priority date 1.5
- Therefore, by 2 December 2024 we need to enter:
    - China→ file national processing request, pay national fee, and file Chinese translations of the application (assuming that the application is written in German) on entry;
    - Japan→ file national processing request, file the fee on entry
    - USA→ file national processing request, file fee, request examination and pay the examination fee, and also provide English translation of the application

- Within 31 months from the priority date, so by 2 January 2025, we need to enter EP regional phase and: 0.5
    - Pay filing fee,
    - Request search and pay search fee if the search was not carried by EPO during the international phase (this is not needed if EPO was acting as international search authority (ISA))
    - Request examination and pay examination fee
    - Pay designation/extension fees
    - We also need to pay renewal fee on entry (3rd year renewal fee) (2)

US patent related deadlines:

- So it has been granted on 30 March 2021 so we have to pay a renewal fee 3 ½ years after the date of grant → 20 Sep 2024 was deadline 0.5
- However, there is a 6 month grace period from the deadline → 20 April 2025 by when we can pay the renewal fee with a surcharge fee 0.5 (1)

7

MARKS AWARDED: 7/20

Question 8

<u>WO-1</u>

- Filing date: 10 February 2023
- Full ISA was issued 15 September 2024
- We can amend claims during international phase with Art. 19 amendments
- These needs to be filed later of:
    - 2 months after the issuance of full ISR → 15 November 2024; or
    - 16 months after the priority/filing date → 16 June 2024

- Therefore, we need to file Art. 19 amendments directly at IB by 15 November 2024
- These amendments can be only done to claims and we cannot introduce subject matter and we need to provide basis for this amendments→ therefore we cannot amend claim 1 to include a feature which is not supported by the description but can amended claim 2, as it is supported by description to overcome clarity objection 1
- Because client wants only positive patentability opinion, I would recommend cancelling claim 1 and amend claim 2 to include the supported feature with Art. 19 amendments 0.5 0.5
- Can also file comments justifying the amendments to help to overcome the objections
- After we file Art. 19 amendments, we can request demand, which is basically examination of the claims on file (with Art. 19 amendments if filed), wherein International Preliminary Examination Authority (IPEA) provides a non-binding opinion on the patentability of the claim during the international phase 1
- Deadline for requesting demand is later of:
    - 3 months from issuance of full ISR→ 15 December 2024 1
    - 22 months from the priority/filing date→ 10 December 2024
    - Therefore, deadline to request demand is 15 December 2025
- And we need to file the demand directly at IPEA
- And pay the demand fee 1
- IPEA will start examining the application right after they receive the fee

- And because of the amendments, I believe the issued preliminary opinion will be positive→ this opinion will then be forwarded to the national offices, and they can assess it however they want (opinion is non-binding)
- Afterwards in 30/31 months from 10 February 2023, we need to start national/regional phase (6)

<u>WO-2:</u>

Priority date: 4 December 2022→ 4 July 2025

- No objections have been raised for WO-2 in international phase
- Client wants to only pursue claim 2 in Europe
- Official deadline to enter EP regional phase is 4 July 2025 however, because client wants to pursue the protection as soon as possible, we can request early regional phase entry at EPO 1 where we file on entry:
  - Request and pay filling 0.5 fee, with a request of early processing
  - File English or german or french translation of the PCT application 0.5
  - Waive the right to receive 161/162 communication of the filing form 0.5
  - We can amend the claims on entry 1→ so we file amended set of claims where we delete 1 claim 1 and we keep claim 2 and we file them in English or german or french
  - Request search and pay 0.5 search fee → this is required because EPO was not the international search authority
  - Request examination 0.5 and pay examination fee (5.5)

- Pay designation fee

b) Client can alternatively apply for a[1] utility model (UM), which is IP protection that usually requires novelty but does not require to be inventive (if yes[1] then inventiveness requirement is less stringent), so the client's modified product would be protectable by UM. Registration of UM is a lot faster and cheaper than obtaining a patent (as only formal examination is carried) and also UM has lower renewal fees. However, with UM you cannot protect every type of invention, mostly just product inventions (so suitable for client) and the term for UM is usually 10 years, wherein for patents it is 20 years. UM is available in[1] Germany but not in Australia.[1] (4)

MARKS AWARDED: 15.5/20

15.5