

2025 FC3 International Patent Law MS

Question 1

You work in-house for Company X, registered in the United Kingdom. They wish to file a direct PCT application that does not claim priority from an earlier patent application.

- a) **Identify the minimum requirements to obtain a filing date for the PCT application.**
5 marks
- b) **What are three competent receiving offices for filing this PCT application?**
3 marks
- c) **What fees are due in respect of the PCT international application within one month of filing?**
3 marks

Total: 11 marks

Answer

a)
At least one applicant, is entitled to file a patent application under the Patent Cooperation Treaty at the Receiving Office **(1 mark)**,
The description and claims are in a language accepted by the Receiving Office **(1 mark)**,
An indication that the application is intended to be an international application **(1 mark)**,
Identification of the applicant **(1 mark)**,
A description **(0.5 marks)**, and one or more claims **(0.5 marks)**.

5 marks

b) At the UK Intellectual Property Office **(1 mark)**, European Patent Office **(1 mark)** or International Bureau of WIPO **(1 mark)**.

3 marks

c) Transmittal fee **(1 mark)**, search fee **(1 mark)**, and filing fee **(1 mark)**.

3 marks

Total: 11 marks

Question 2

An inventor informs you that they have disclosed their new invention on their website. No patent applications have been filed to date, but they are now interested in obtaining patent protection for their new invention.

Explain to the inventor whether it will be possible to obtain valid patent protection for their invention in China, Japan and Singapore.

4 marks

Answer

Patent protection possible in Japan **(0.5 marks)**. In Japan, a disclosure by the inventor will not count as a novelty destroying disclosure if a patent application is filed within 12 months **(0.5 marks)** of the disclosure.

Patent protection possible in Singapore **(0.5 marks)**. In Singapore, a disclosure by the inventor will not count as a novelty destroying disclosure if a patent application is filed within 12 months **(0.5 marks)** of the disclosure.

Patent protection not possible in China **(0.5 marks)**. There is a six month grace period **(0.5 marks)** but only for permitted disclosures **(0.5 marks)** which do not apply here **(0.5 marks)**.

Total: 4 marks

Question 3

State the period for which the following procedures can be carried out:

- a) Filing an opposition to a granted Japanese patent.
- b) Filing an opposition to a granted German patent.
- c) Requesting ex parte re-examination of a claim of a granted US patent.

3 marks

Answer

Filing an opposition to a granted Japanese patent - within six months of publication of grant of the patent **(1 mark)**.

Filing an opposition to a granted German patent – within nine months of publication of grant of the patent **(1 mark)**.

Requesting ex parte re-examination of a claim of a granted US patent – at any time during the lifetime of an issued patent **(1 mark)**.

Total: 3 marks

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Question 4

An opposition was filed by Mr A against a European patent, owned by Ms B. In the decision notified on 1 October 2025, the Opposition Division rejected the opposition, and the patent was maintained as granted.

- a) For each of Mr A and Ms B, explain whether they can appeal this decision, giving reasons for your answer.

4 marks

- b) Calculate the deadlines for filing a notice of appeal and statement of grounds of the appeal. You are not required to take into account any patent office closed days.

4 marks

Total: 8 marks

Answer

a)

Mr. A is adversely affected by the decision (**1 mark**), and can therefore appeal the decision (**1 mark**).

Ms. B is not adversely affected by the decision (**1 mark**), and therefore cannot appeal the decision (**1 mark**).

4 marks

b)

Notice of appeal – two months from notification of decision (**1 mark**), so 1 December 2025 (**1 mark**).

Statement of grounds of appeal – four months from notification of decision (**1 mark**), so 1 February 2026 (**1 mark**).

4 marks

Total: 8 marks

Question 5

Your client wishes to file a single, direct European patent application as a first filing for three inventions. They have proposed the following claim set, in which:

Claims 1–15 relate to invention A;
Claims 16–36 relate to invention B; and
Claims 37–51 relate to invention C.

Your client informs you that invention C is most important to them. They also inform you that they are not particularly interested in Inventions A and B at this stage, but this may change in the future.

a) Explain how claims fees would be assessed.

3 marks

b) Advise an appropriate way of eliminating such claims fees, in light of your client's comments on inventions A–C. Given reasons for your answer.

5 marks

c) When would claims fees, if any, be payable?

1 mark

Total: 9 marks

Answer

a)

No claim fees up for claims 1-15 (**1 mark**). Claims 16-50 attract a first level of fee per claim (**1 mark**). Claim 51 attracts a higher level of fee (**1 mark**).

3 marks

b)

Since the client is only presently interested in Invention C (**1 mark**), renumber claims 37-51 as claims 1-15 (**1 mark**), thereby bringing the claim number to 15 and avoiding all claim fees (**1 mark**). We should however retain the subject-matter of claims 1-36 in the description (**1 mark**), since the client may wish to pursue protection for this subject-matter in the future (**1 mark**).

5 marks

c)

Payment of claims fees are due within one month of the date of receipt of the claims (will accept one month of filing) (**1 mark**).

1 mark

Total: 9 marks

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Question 6

Your client filed a PCT application on 18 September 2025 that claims priority from a US provisional patent application filed on 15 October 2024. National phase applications were validly filed in Canada, China, India, Japan and Republic of Korea.

Calculate the deadline for requesting examination in each country. You are not required to take into account any patent office closed days.

5 marks

Answer

Canada = 4 years from the PCT filing date **(0.5 marks)**, i.e. 18 September 2029 **(0.5 marks)**

China = 3 years from the priority date **(0.5 marks)**, i.e. 15 October 2027 **(0.5 marks)**

India = 31 months from the priority date **(0.5 marks)**, i.e. 15 May 2027 **(0.5 marks)**

Japan = 3 years from the PCT filing date **(0.5 marks)**, i.e. 18 September 2028 **(0.5 marks)**

Republic of Korea = 3 years from the PCT filing date **(0.5 marks)**, i.e. 18 September 2028 **(0.5 marks)**

Alternatively 1 mark awarded per country, if correct deadline is provided.

Total: 5 marks

SECTION B

Question 7

Company A has asked you to be their new representative in handling the following portfolio of patent and patent applications, which are as follows:

EP-1: a European patent application filed on 18 June 2022, claiming a priority date of 18 June 2021. According to the EPO register, the last renewal fee was paid on 30 June 2024.

EP-2: a European patent application filed on 20 March 2023, without claiming priority. According to the EPO register, a notice of loss of rights was received on 10 October 2025, for failure to pay the third-year renewal fee.

EP-3: a European divisional application of EP-2, and which was filed at the EPO on 10 September 2025. There is no record in the previous representative's notes that any renewal fees were paid.

US-1: a US patent that was granted on 31 December 2021. According to the US patent office's online database, no renewal fee has been paid yet.

Company A informs you that their previous representative was very disorganised and may have carelessly handled the portfolio. They seek your advice in evaluating the renewal fee status of the portfolio.

- a) **Write a memo that explains the renewal fee status on each of the above patents and patent applications, and advise on any action that must be taken, and any associated deadlines. You are not required to take into account any patent office closed days.**

15 marks

Company A also owns EP-4, for which the date of publication of mention of grant was 2 October 2025. They inform you that they want to validate EP-4 in Spain and via a unitary patent.

- b) **Outline the steps required to validate EP-4 in Spain and to obtain a unitary patent.**

5 marks

Total: 20 marks

Answer

a)

EP-1: The renewal fee deadline in respect of the fourth year was 30 June 2025 **(1 mark)**. This deadline has been missed, so the client should pay the renewal fee, with surcharge **(0.5 marks)**, in the six month grace period **(0.5 marks)**, i.e. by 31 December 2025 **(1 mark)**.

EP-2: The renewal fee deadline in respect of the third year was 31 March 2025 **(1 mark)**, and the six month grace period expired on 30 September 2025 **(1 mark)**. Both deadlines have been missed. While the client could request re-establishment (with discussion of December 2025 deadline / within two months of the removal of non-compliance / if more information is needed from client to calculate deadline) **(1 mark)**, it does not appear likely

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that this will be granted (**1 mark**), since the previous representative was badly organised and did not appear to take all due care (**1 mark**). This application therefore appears to be irrevocably lost (**1 mark**). Protection of the subject-matter of EP-2 might be possible via EP-3 (**0.5 marks**), or a further divisional application filed from EP-3 (**0.5 marks**).

EP-3: Since the previous representative was disorganised, double check with the EPO whether any renewal fees have been paid on EP-3 (**0.5 marks**). Assuming no renewal fees have been paid on EP-3, the deadline for paying the third year renewal fee is four months from the filing of EP-3, i.e. 10 January 2026 (**1 mark**). The client should pay the renewal fees by this deadline.

US-1: A renewal fee was due 3.5 years (**0.5 marks**) from the date of grant of US-1, i.e. by 30 June 2025 (**1 mark**). This renewal fee can still be paid within the six-month grace period (**0.5 marks**) by 31 December 2025 (**1 mark**), with surcharge (**0.5 marks**).

15 marks

b)

File a request for unitary effect at the EPO (**0.5 marks**) no later than one month after publication of the mention of grant of EP-4 (**0.5 marks**), so 2 November 2025 (**0.5 marks**). File a translation of the entire specification into another official language of the EU (**1 marks**). Provide particulars of the proprietor (**0.5 marks**). Provide the patent number of EP-4 (**0.5 marks**). Provide the particulars of the appointed representative (**0.5 marks**).

Spain: An entire translation of the specification will need to be submitted (**1 mark**), because Spanish is not an official language of EPO.

5 marks

Total: 20 marks

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Question 8

Your client is the owner of a PCT patent application, WO-1. The international search report issued in relation to the PCT application contained a number of objections your client would like to address at the time of national phase entry.

- a) **Advise your client whether it is possible to amend the application at the time of national phase entry in each of the following countries: India, New Zealand and Republic of Korea.**

3 marks

Your client is also considering entering WO-1 into the US national phase. The application contains 4 independent claims and 32 claims in total. None of the claims are multiple dependent.

- b) **Advise your client regarding the excess claims fees payable to the USPTO (monetary values are not required).**

3 marks

Your client also owns another PCT patent application, WO-2, filed on 25 March 2024 and claiming a priority date of 25 March 2023, and published in French. Your client informs you that they were awaiting the results of a market analysis to decide whether to enter the Canadian national phase, and recently decided that they should.

- c) **Advise your client whether it is still possible to enter the Canadian national phase, and what steps need to be taken in order to achieve this.**

7 marks

Your client is considering filing a utility model in Germany for a separate invention.

- d) **Prepare notes for a meeting with your client outlining the registration procedure in Germany for utility models and the term of protection.**

7 marks

Total: 20 marks

Answer

a)

Yes (**1 mark each**): New Zealand, Republic of Korea

No (**1 mark**): India

3 marks

b)

At the USPTO, excess claim fees are due for each claim in independent form in excess of three (**1 mark**) and for each claim, independent or dependent, in excess of 20 (**1 mark**). Therefore it is necessary to pay 1 excess claim fee for the excess independent claim (**0.5 marks**) and 12 excess claim fees for the total claim number (**0.5 marks**).

3 Marks

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c)

The deadline for entering the Canadian national phase was 30 months from the priority date **(0.5 marks)**, i.e. 25 September 2025 **(0.5 marks)**, which has been missed. We should request reinstatement **(0.5 marks)**, within 12 months of the national phase deadline **(0.5 marks)**, i.e. 25 September 2026 **(0.5 marks)**. Must pay a reinstatement fee **(0.5 marks)** along with the basic national fee **(0.5 marks)**. No translation needs to be filed **(0.5 marks)**.

Must submit a statement **(0.5 marks)** that the failure to enter the Canadian national phase was unintentional **(0.5 marks)**. Sensible discussion on if the “unintentional” criterion is met **(2 marks)** – e.g. should ask client what date they decided that they should enter the Canadian national phase / when the marked analysis was complete; should discuss with Canadian local agent.

7 Marks

d)

Any of the following up to 7 marks:

The application must be furnished with a description and claims, and drawings (if any) **(1 mark)**, and an application fee must be paid **(1 mark)**. A utility model can be split off from a patent application **(1 mark)**. The application will be subject to examination on completeness of the application and compliance with formal requirements **(1 mark)**. There is no substantive examination during registration **(1 mark)**. A grace period applies, in which the applicant's published invention is not part of the opposing state of the art **(1 mark)**. Registration typically occurs within weeks of application **(1 mark)**, and the utility model specification will be published approximately four weeks after registration **(1 mark)**. The term of protection is up to 10 years **(1 mark)**.

7 Marks

Total: 20 Marks

Question 9

Your client is a UK pharmaceutical company. They are struggling to handle two of their PCT applications and seek your advice. They are the sole applicant for WO-1 and WO-2.

WO-1 was filed on 2 September 2025 without claiming priority. The client filed WO-1 at the German national patent office, and is worried that this was a mistake.

- a) **Write a note for the client, outlining the procedure that will be taken by the German national patent office with respect to WO-1, and if any remedial action must be taken.**

7 marks

WO-2 was filed on 14 July 2025, claiming priority to P1, which was filed on 10 January 2025. WO-2 contains one claim directed to their key commercial product, compound X. The client informs you that they had filed an earlier application with a claim to compound X on 28 August 2024, and that they publicly disclosed compound X on 1 January 2025 on their website. The client is unsure if WO-2 is currently able to protect compound X in Europe.

- b) **Write a note for the client, explaining whether WO-2 is currently able to protect compound X and if any remedial action must be taken.**

8 marks

Your client has also invented a method of treating diseases, and a computer-based financial system for hospitals. They are interested as to whether patent protection can be obtained for these inventions.

- c) **Provide advice on whether these inventions can be protected by patents in China, Europe, India, Japan and USA.**

5 marks

Total: 20 marks

Answer

a)

The client is a UK company and therefore should have filed WO-1 at the UK Intellectual Property Office (**0.5 marks**), European Patent Office (**0.5 marks**) or International Bureau of WIPO (**0.5 marks**).

Any of the following **up to 4 marks**:

The German national patent office is not a competent RO (**0.5 marks**). In this situation, WO-1 will be considered to have been received by the Office with which it was filed on behalf of the International Bureau as receiving Office (**0.5 marks**). WO-1 will be date-stamped by the German national patent office and promptly transmitted to the International Bureau (**0.5 marks**). That transmittal may be subjected by the German national patent office to the payment of a fee equal to the transmittal fee (**0.5 marks**), but other fees paid will be refunded (**0.5 marks**) and the applicable fees will then have to be paid to the International Bureau as receiving Office (**1 mark**). WO-1 will be considered to have been received by the International Bureau as receiving Office on the date on which it was received by the German national patent office (**0.5 marks**), except that, for the purposes of calculating the time limits for paying the fees due on filing (**0.5 marks**), the date of receipt of the international application is considered to be the date on which the international

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application was actually received by the International Bureau as receiving Office **(0.5 marks)**.

We will need to pay the applicable fees to the IB. Assuming the German national patent office promptly transmitted WO-1 to the IB, it is likely we are over one month from the filing date of WO-1, so a surcharge will also be payable / sensible discussion on whether a surcharge is payable, or if more information is needed **(1 mark)**. We should check with the International Bureau that all is in order with the filing of WO-1 **(0.5 marks)**.

7 marks

b)

As is stands, the public disclosure of compound X before the priority date of WO-2 **(0.5 marks)** is novelty destroying for the claim of WO-2 in Europe **(0.5 marks)**. No grace period applies under these circumstances in Europe **(0.5 mark)**. WO-2 therefore cannot presently be used to protect compound X **(0.5 marks)**.

This situation can be remedied by adding to WO-2 a priority claim to the earlier application **(1 mark)**. This can be done by via a notice submitted to the receiving Office **(0.5 marks)** or the International Bureau **(0.5 marks)**. The time limit for adding a priority claim is 16 months **(1 mark)** from the earlier **(1 mark)** of the filing date of P1 or the earlier application, i.e. 28 December 2025 **(1 mark)**. Once the priority claim is added, the public disclosure of compound X will no longer be novelty-destroying for the claim of WO-2 **(0.5 marks)**, and WO-2 will be capable of protecting compound X **(0.5 marks)**.

8 marks

c)

Method of treatment

Yes: USA **(0.5 marks)**

No: China, Europe, India, Japan **(0.5 marks each)**

Computer-based financial system

Yes: Japan, USA **(0.5 marks each)**

No: China, Europe, India, **(0.5 marks each)**

5 marks

Total: 20 marks

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Question 10

Your client, Ms C, is a serial inventor who has developed a number of new inventions.

- a) **Advise Ms C on when an application cannot be filed outside the United Kingdom according to Section 23 of the UK *Patents Act 1977*.**

5 marks

Ms C has developed a new lawnmower that significantly increases the ease of cutting grass to a predetermined length. Ms C publicly demonstrated the new lawnmower last week, and everyone who saw it was very impressed, especially when they were shown the details of how it worked.

- b) **Explain to Ms C whether it will be possible to obtain valid patent protection in the USA, Australia and via the European Patent Convention.**

6 marks

Ms C has also developed a hedge trimmer. After conducting a prior art search, you believe that the hedge trimmer is new, but that it might not meet patent inventiveness requirements in the jurisdictions of interest to Ms C.

- c) **Describe another form of intellectual property right that Ms C could apply for, and list two advantages and two disadvantages of this alternative intellectual property right. Do not discuss designs, copyright, trade marks or trade secrets.**

5 marks

Ms C is an individual previously named on seven patent applications at the USPTO. She is looking to file a new US patent application for an invention that has recently been exclusively licensed to a not-for-profit research foundation.

- d) **Advise Ms C on which entity status should be used for this filing at the USPTO. Provide the justification for your recommendation.**

4 marks

Total: 20 marks

Answer

a)

An application cannot be filed outside of the United Kingdom where the person is resident in the United Kingdom **(1 mark)** and the application contains information which relates to military technology **(0.5 marks)** or for any other reason publication of the information might be prejudicial to national security **(0.5 marks)**, or the application contains information the publication of which might be prejudicial to the safety of the public **(0.5 marks)**, without written authority granted by the comptroller **(0.5 marks)**, unless: an application for a patent for the same invention has been filed in the Patent Office **(0.5 marks)** not less than six weeks before the application outside the United Kingdom **(0.5 marks)**; and either no directions have been given in relation to the application **(0.5 marks)** in the United Kingdom or all such directions have been revoked **(0.5 marks)**.

5 marks

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b)

Protection will be possible in the USA **(1 mark)**. In the United States disclosure by the inventor/applicant will not count as a novelty destroying disclosure if a patent application is filed within 12 months of the disclosure **(1 mark)**. Protection will be possible in Australia **(1 mark)** as Australia offers a 12 month grace period for disclosures made by the inventor/applicant **(1 mark)**. Protection will not be possible via the European Patent Convention **(1 mark)**, as the demonstration was a novelty destroying disclosure **(0.5 marks)** and there is no applicable grace period **(0.5 marks)**.

6 marks

c)

The client should seek utility model protection **(1 mark)**

Any sensible points **(1 mark each)**:

Advantages: lower standard inventiveness; formal examination only; fast registration of enforceable right; lower cost registration. **(up to 2 marks)**

Disadvantages: shorter term protection; no harmonised laws between countries; available in fewer countries than patents; restricted subject matter that can be protected **(up to 2 marks)**.

5 marks

d)

Small entity status should be claimed **(1 mark)**. Micro entity status cannot be claimed as the client is named on more than four previously filed applications **(1 mark)**. As an individual the client is not a large entity **(1 mark)**, and licencing the invention to a not for profit research foundation is compatible with small entity status **(1 mark)**.

4 marks

Total: 20 marks