

## ANSWERS FOR MOCK EXAM JANUARY 2007

- (1) Your patent attorney, Paul Revere of Revere & Co, 100 Lexington Way, York, YO14 7BJ asks you to prepare and file the necessary forms for a UK patent application, in accordance with the information on the attached data sheet.

(15 marks)

**See filled out forms – deduct ½ mark for each mistake**

- (2) A UK patent application was filed on 8 April 2003 claiming priority from two earlier US patent applications filed on 10 June 2002 and 19 August 2002. The UK application was granted on 14 September 2005.

(a) When is the first renewal fee payable? (3 marks)

**4<sup>th</sup> anniversary of the filing date(1) i.e. 8 April 2003 + 4 years = 8 April 2007 (1) payable at the end of the month = 30 April 2007 (1)**

(b) If the renewal fee is not paid and the client contacts you on 18 May 2007 indicating that he would like to renew the patent, what action can be taken, including a note of any fees, and by when?

(3 marks)

**Pay renewal (with surcharge) (1)  
within 6 months grace period - i.e. by 31<sup>st</sup> October 2007 (1)**

**There is no surcharge if renewal fee is paid by the end of the first overdue month ie by 31 May 2007 (1)**

Deleted: (1)

(c) What fee is payable if the client contacts you on 18 July instead, and you act immediately?

(2 marks)

**Two further months' surcharge (1)  
plus the outstanding £30 renewal fee (1)**

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(d) What can be done if the client contacts you on 19 November 2007 instead?

(3 marks)

**As the patent will have lapsed (1)  
you can apply for restoration (1)  
but need to show that non-payment was unintentional (1)**

(11 marks in total)

- (3) List four methods of filing a new patent application at the UK patent office.

(4 marks)

**Hand (1) courier (1) post (1) fax (1)**

- (4) List 3 of the following would be examined in the Preliminary Examination of a UK patent application.

(A) Margin Sizes

- (B) Reproducibility of Drawings
- (C) Novelty of Claims
- (D) Paper Sizes
- (E) Inventive Step of Claims
- (F) Industrial Applicability
- (G) Identification of Applicant

(3 marks)

**A (1) B (1) D (1) G(1)**  
**(Three out of four)**

(5) What will happen if:

- (a) A handwritten patent specification is filed with a UK patent application. Will there be any consequence? If so, what?

(2 marks)

**You will be asked to file replacement pages (1) within a term set (1)**

- (b) The Form 1/77 was also handwritten. Will there be any consequence? If so, what?

(1 mark)

**No consequence (1)**

N.B. In both cases the documents are written legibly in black ink.

(3 marks in total)

(6) What is the grace period for payment of the following fees for a European Patent Application:

- Filing Fee **1 month from notification (1)**  
 Extension State Fee **2 months from the due date (1)**  
 Examination Fee **1 month from notification (1)**  
 Further Processing Fee **No grace period (1)**

(4 marks)

(7) You have received a communication dated 4 December 2006 from the EPO under Rule 51(4) EPC calling for the payment of the grant and printing fees within 4 months.

When does this time limit expire?

(3 marks)

**4<sup>th</sup> December 2006 + 10 days = 14<sup>th</sup> December 2006 (1)**  
**14<sup>th</sup> December 2006 + 4 months = 14<sup>th</sup> April 2007 (1)**  
**This is a Saturday so Monday 16<sup>th</sup> April 2007 (1)**

(8) You have filed a divisional European patent application on 7 December 2006. The parent application has a priority date of 7 February 2003 and a filing date of 6 February 2004.

What renewal fees must be paid on the divisional and when?

(7 marks)

**3<sup>rd</sup> renewal due 06/02/06 (1)**  
**(2<sup>nd</sup> ann of filing date of parent appln) within 4 months of filing of the divisional (1)**  
**4th renewal due 06/02/07 (1)**  
**within 4 months of filing of the divisional (1)**  
**Therefore both fees due 7<sup>th</sup> April 2007 this is a Saturday, (1)**  
**Monday 9<sup>th</sup> April 2007 is Easter Monday (1)**  
**so fees due Tuesday 10<sup>th</sup> April 2007 (1)**

(9) You received an examination report on a European application dated 21st October 2006, with a four month response period.

a) When is the last day on which the response can be filed to be considered in time?

(2 marks)

**21<sup>st</sup> October 2006 + 10 days = 31<sup>st</sup> October 2006 (1)**  
**31<sup>st</sup> October 2006 + 4 months = 28<sup>th</sup> February 2007 (1)**

b) Your client informs you that he will be unable to send instructions prior to the deadline. What should be done, how and by when?

(3 marks)

**Request a 2mth extension of time (1) in writing (1) before the term expires (1)**

c) No instructions have been received and the deadline passes. What will happen next and what, if anything, can be done to remedy the situation?

(6 marks)

**EPO send notification that application is deemed withdrawn (1)**  
**Should request further processing (1) in writing (1) within 2 months of notification (1) Need to pay the fee (1) and complete the omitted act (1)**

(11 marks in total)

(10) Which patent offices are competent for a UK citizen to file a PCT application?

(3 marks)

**UK (1) EPO (1) IB (1)**

(11) What is the deadline for filing a Demand on an International Application?

(3 marks)

**3 months from receipt of Written Opinion (1) or 22 months from priority (1) whichever later (1)**

- (12) What are the minimum filing requirements for a PCT application?  
(5 marks)  
**Name Applicant (1) Indication that it is a PCT application (1)  
Designation (1) Description (1) Claim (1)**
- (13) In the context of a PCT application what is meant by:  
the letters ISA? (1 mark)  
**International Searching Authority**  
who will be the ISA for a PCT filed by a UK resident/citizen?  
(1 mark)  
**EPO**  
In the context of a PCT application what is meant by the letters IPEA?  
**International Preliminary Examination Authority**  
(1 mark)  
In the context of a PCT application what is meant by the letters IPRP?  
**International Preliminary Report on Patentability**  
(1 mark)  
(4 marks in total)
- (14) A European patent application was published on 15 March 2006 without a Search Report. The Search Report was communicated to the Applicant's representative on 11 May 2006 and published on 30 August 2006.  
When must the fee for substantive examination be paid? Give reasons for your answer? (3 marks)  
**6 months (1) from publication of the search report (1) = 28<sup>th</sup> February 2007 (1)**
- (15) You see a European patent application with a number EP 1234567A2. What is the significance of the suffix A2? (2 marks)  
**Published (1) without a search report (1)**
- (16) What is the deadline for entering the European Regional Phase of a PCT application designating the EPC? (2 marks)  
**31 months (1) from the priority date (1)**
- (17) Name two examples each of registered and unregistered intellectual property rights? (4 marks)  
**R – Any two of Patent, Registered Trade Mark, Registered Design  
UR – Any two of Copyright, UDR, Unregistered trade mark**

- (18) What is a trade mark? (3 marks)  
**A sign (1) capable of distinguishing the goods or services (1) of one proprietor from those of another (1)**

**Note from R. Greenshields: Answer should be:  
'any sign capable of being represented graphically which is capable of distinguishing goods and services of one undertaking from those of other undertakings'**

- (19) What do you understand by the term "Duty of Care"? (4 marks)

(20) Answer the following:

- a) Name 2 states where the 20/21 month Chapter I deadline still applies (2 marks)

**Any 2 from CH, LU, SE, TZ or UG**

- b) Name 3 official PCT Publication languages (3 marks)

**Any 3 from English, French, German, Arabic, Chinese, Japanese, Russian or Spanish**

- c) When can you file PCT divisional application? (1 mark)

**You can't – there is no provision for divisional applications**