

Question 1

Explain the term “Prior Art”.

2 marks

Answer

Any 2 of the following:

- Anything published/publicly used before the priority date ... **[1 mark]**
- ... that discloses inventions that are the same/similar, or
... that is relevant for novelty **[1 mark]**
- Examples include other patent specifications, journal articles etc. **[1 mark]**

Total: 2 marks

Question 2

A first GB patent application was filed on 30 May 2019 without details of the inventors.

By what date must the details of the inventors be filed without requesting an extension of time? Show your calculations.

2 marks

Answer

(If no, or incorrect, calculations: award 1 mark where the candidate demonstrates knowledge that the deadline is 16 months from the filing date of this application.)

30/05/2019 + 16 months **[1 mark]**
= 30/09/2020 **[1 mark]**

Total: 2 marks

Question 3

A GB patent application was filed on 18 March 2016. The application was granted on 9 May 2018.

- a) **When is the first renewal fee due? Show your calculations.** **4 marks**
- b) **If the renewal fee is not paid by this date, what is the latest date for paying the renewal fee without an additional fee?** **1 mark**
- c) **How often are renewal fees due on the granted patent?** **1 mark**

Total: 6 marks

Answer

- a) *(If no, or incorrect, calculations: award 1 mark where the candidate demonstrates knowledge that the deadline is*
- i. *at the end of the month*
 - ii. *containing the fourth anniversary of the filing date.)*

18/03/2016 (or otherwise identifying filing date as the start date for the calculation)

[1 mark]

+ 4 years

[1 mark]

= 18/03/2020

[1 mark]

To end of the month = 31/03/2020 (or 'end of March 2020')

[1 mark]

- b) *(The following mark is to be awarded where the candidate demonstrates knowledge that the deadline is 1 month after the deadline given as the answer to part a), and at the end of the month.)*

First month of grace period is free, so deadline is 30/04/2020 (or 'end of April 2020')

[1 mark]

- c) Annually

[1 mark]

Total: 6 marks

Question 4

A PCT application is published in Japanese.

a) What are the minimum requirements for entering the GB national phase? **2 marks**

b) What is the deadline for entering the GB national phase? **1 mark**

Total: 3 marks

Answer

a) *(Only the first two items to be marked, but treat elements of specification as a single item even if listed separately (e.g. translation of description, translation of claims etc.). All relevant parts of the specification needed for the mark if listed separately.)*

Paying the national processing fee **[1 mark]**

Filing a translation of the specification into English **[1 mark]**

b) 31 months from the earliest priority date of the PCT application **[1 mark]**

Total: 3 marks

Question 5

What are the official languages of the EPO?

1 mark

Answer

(All three languages needed for the mark to be awarded.)

English, French and German **[1 mark]**

Total: 1 mark

Question 6

A decision to refuse a European patent application is dated 9 December 2019.

a) What is the deadline for filing a notice of appeal? Show your calculations. **4 marks**

b) What is the deadline for filing the grounds of appeal? Show your calculations. **5 marks**

Total: 9 marks

Answer

- a) *(If no, or incorrect, calculations: award 1 mark where the candidate demonstrates knowledge that the deadline is*
- i. *2 months*
 - ii. *from the date of notification (i.e. including the 10 days allowed for postal delivery)*
- of the decision to refuse.)*

09/12/2019 + 10 days	[1 mark]
= 19/12/2019	[1 mark]
19/12/2019 + 2 months	[1 mark]
= 19/02/2020	[1 mark]

- b) *(If no, or incorrect, calculations: award 1 mark where the candidate demonstrates knowledge that the deadline is*
- i. *4 months*
 - ii. *from the date of notification (i.e. including the 10 days allowed for postal delivery)*
- of the decision to refuse.)*

09/12/2019 + 10 days	[1 mark]
= 19/12/2019	[1 mark]
19/12/2019 + 4 months	[1 mark]
= 19/04/2020	[1 mark]
Sunday; next working day is 20/04/2020	[1 mark]

Total: 9 marks

Question 7

A communication under Rule 71(3) EPC allowing a European patent application is dated 23 October 2019. The communication is received in your office on 1 November 2019. The European application is in English and contains 12 claims. No amendments are needed.

a) For this application to proceed to grant, what actions must be completed?

2 marks

a) What is the deadline for completing these actions? Show your calculations.

5 marks

Total: 7 marks

Answer

a) *(Approval of the text/bibliographic info is effected by taking the actions below, and stating “approval” etc. does not attract a separate mark.)*

Pay grant and printing fees

[1 mark]

File translations of the claims in French and German

[1 mark]

b) *(If no, or incorrect, calculations: award 1 mark where the candidate demonstrates knowledge that the deadline is*

i. *4 months*

ii. *from the date of notification (i.e. including the 10 days allowed for postal delivery)*

of the communication.)

23/10/2019

[1 mark]

+ 10 days

[1 mark]

= 02/11/2019

[1 mark]

02/11/2019 + 4 months

[1 mark]

= 02/03/2020

[1 mark]

Total: 7 marks

Question 8

An A2 publication is issued in respect of an international patent application.

a) What is an A2 publication?

1 mark

b) What publication will follow the A2 publication, and what will it include?

2 marks

Total: 3 marks

Answer

a) *(Need to specify that the search report is not included to gain the following mark.)*

Publication of the application / specification without the search report

[1 mark]

b) The A3 publication

[1 mark]

The international search report (ISR)

[1 mark]

Total: 3 marks

Question 9

A second GB patent application is filed claiming priority from an earlier GB patent application. Informal drawings are filed as part of the second GB application.

a) What is the deadline for filing formal drawings?

2 marks

b) The deadline mentioned in part a) is missed. To validly file the formal drawings, what must you do and by when?

2 marks

Total: 4 marks

Answer

a) 15 months

[1 mark]

from the priority date

[1 mark]

ICPA 2020 – MOCK MARK SCHEME

- b) *(Need to include the concept of the extension being 2 months to get both of the following marks.)*

Request an (as-of-right) 2 month extension of time
Within the extended period

[1 mark]

[1 mark]

Total: 4 marks

Question 10

A GB patent application is filed in the name of the sole inventor.

Is it necessary to file a PF7 at the UK IPO?

1 mark

Answer

No

[1 mark]

Total: 1 mark

Question 11

A GB patent application is filed that does not claim priority. No request for early publication is made. All relevant forms are filed, and all relevant fees are paid.

- a) **What is the earliest that the application will be published?**

1 mark

- b) **What could delay the publication of the application?**

1 mark

- c) **How can the applicant avoid the application being published?**

1 mark

Total: 3 marks

Answer

- a) 18 months from filing

[1 mark]

- b) *(Accept other reasonable causes of delay, e.g. late filing of formal drawings.)*

A delay in the drawing up of the search report by the UK IPO

[1 mark]

- c) By withdrawing the application before the technical preparations for publication are completed

[1 mark]

Total: 3 marks

Question 12

An official communication from the EPO noting a loss of rights is dated 14 January 2020. You receive the communication the same day.

- a) What is the deadline for responding to the communication? Show your calculations.

4 marks

- b) What actions must be taken by the deadline calculated in part a)?**

2 marks

Total: 6 marks

Answer

- | | | |
|----|---|----------|
| a) | 14/01/2020 + 10 days | [1 mark] |
| | = 24/01/2020 | [1 mark] |
| | 24/01/2020 + 2 months | [1 mark] |
| | = 24/03/2020 | [1 mark] |
| b) | <i>(‘Pay fee’ without an indication in the answer that the fee is for further processing is not enough to get this second mark; ‘request further processing’ does not attract a separate mark.)</i> | |

Complete the missing/omitted act
Pay the further processing fee

[1 mark]
[1 mark]

Total: 6 marks

Question 13

An application for a registered Community design is to be filed that claims priority from a GB design application. The applicant wishes to defer publication of the registered Community design.

a) What is the maximum time period for which the publication can be deferred?

1 mark

b) By when does the applicant need to request publication and pay the publication fee?

1 mark

Total: 2 marks

Answer

a) 30 months from the priority date

[1 mark]

b) 27 months from the priority date/ 3 months before the end of the deferred period

[1 mark]

Total: 2 marks

Question 14

When is the first renewal fee due in respect of a registered Community design?

2 marks

Answer

The end of the month
containing the 5th anniversary of the filing/registration date

[1 mark]

[1 mark]

Total: 2 marks

Question 15

An attorney in your office sends you the following memo.

Our client, Ninja Securities Limited, would like to request search and examination of their GB patent application, which was filed without claiming priority. We have already paid the application fee on filing, and the application has been assigned application number GB 2022044.6 (our reference is NSL-GB1).

The application contains the following documents:

description:	32 pages;
claims:	18 claims over 5 pages;
abstract:	1 page;
drawings:	3 figures over 3 pages.

There is no need to request paper copies as we keep electronic files.

I'll sign the form once you have prepared it. Thanks for your help with this.

Bea Trice, CPA
0161 012 3344

Complete forms PF9A and PF10.

8 marks

Answer

See completed PF9A and PF10.

[8 marks]

Total: 8 marks

Question 16

You work as a paralegal at Stechert Partners LLP. One of the partners, Laura Stechert, sends you the following memo.

Good morning. Please can you prepare the form for filing an international patent application for our client, Seating Technology Limited (a UK company based at 12 Russel Street, London W15 8TT, UK), naming me as agent. This application will claim priority from their earlier GB application entitled Reclining Mechanism. We'll use the same documents for filing the international application. Our reference for this new application is SeatTech01.

The details of their current application are:

Application no.:	GB 1912345
Filing date:	14 February 2019
Description:	14 pages
Claims:	6 claims over 2 pages
Abstract:	1 page (accompanied by figure 3)
Drawings:	7 figures over 6 pages

Digital library access code (PDAS): 123A

Inventor:	Tob DERRY (a UK citizen) 20 Portcullis House, Plymouth PL36 0LR, UK
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Please request that we receive notifications only by email. We won't file a certified copy of the priority document, but will make use of the PDAS code received for the current GB application.

There's no need to fill in a fee sheet. Finance will do this. The fee sheet will be included on filing.

Many thanks, Laura

Laura Stechert, CPA, EPA
Stechert Partners LLP, 4 South Drive, London, W20 6PO, UK
Tel: 02020 657483; Fax: 02020 657482
stechert@spartners.co.uk

Complete form PCT/RO/101.

10 marks

Answer

See completed PCT/RO/101.

[10 marks]

Total: 10 marks

Question 17

A European patent is granted on 8 November 2019.

- a) What is the deadline for opposing the patent? Show your calculations. 3 marks
- b) What actions must be taken by the date in part a) to validly oppose the patent? 3 marks

Total: 6 marks

Answer

- a) *(If no, or incorrect, calculations: award 1 mark where the candidate demonstrates knowledge that the deadline is 9 months from the date of grant.)*

08/11/2019 + 9 months	[1 mark]
= 08/08/2020 (Saturday)	[1 mark]
Deadline is 10/08/2020 (next working day)	[1 mark]

- | | |
|--------------------------------|----------|
| b) File a notice of opposition | [1 mark] |
| File grounds of opposition | [1 mark] |
| Pay the opposition fee | [1 mark] |

Total: 6 marks

Question 18

A GB patent application is filed. After 18 months, a new divisional GB application is filed based on the earlier parent GB application.

When is the abstract due in respect of the new (divisional) GB application? Explain your answer.

2 marks

Answer

The abstract is due on filing ...	[1 mark]
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... because the deadline for filing the abstract on the earlier (parent) application has passed	[1 mark]
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Total: 2 marks

Question 19

What is a patent? Explain your answer.

3 marks

Answer

A monopoly (granted by a state) for a period of time (20 years)
... to an inventor (accept '*applicant*') ...
... in exchange for disclosing an invention.

[1 mark]

[1 mark]

[1 mark]

Total: 3 marks

Total Marks: 80 marks



Intellectual Property Office

Patents Form 9A

Patents Act 1977 (Rule 27)

Concept House
Cardiff Road
Newport
South Wales
NP10 8QQ

Request for search

(See the notes on the back of this form)

1	Your reference: (optional)	NSL-GB1	1
2	Patent application number (e.g. GB7654321.0):	GB 2022044.6	
3	Full name of the applicant or of each applicant:	Ninja Securities Limited	1
4	Is this request for (please tick one box):		
	a) A search under Section 17(1) for an international application which has been searched in the international phase? ☐	b) A search under Section 17 (1) for any other application? ☒	
	c) A supplementary search under Section 17(8)? ☐ (See note (b) for help choosing which search you require)	d) A search of a further invention under Section 17(6)? ☐	
	If your answer is (d), identify which invention you would like to be searched by referring to the claims to be searched (See note (c)):		
5	If you wish to opt in to receive a paper copy of any patent document cited in the search report please tick the box. (we will automatically send you a paper copy of any cited non-patent document see note (d))	☐	1
6	Are you paying the application fee with this form? YES ☐ NO ☒ (See note (e))		
7	Number of claims in your application: Only relevant for options (a) and (b) above. See note (f)	18	1
8	(please see note (g))	Signature	Date
			[today]
9	Name, e-mail address, telephone, fax and/or mobile number, if any, of a contact point for the applicant:	Bea Trice 0161 012 3344	1



Intellectual Property Office

Patents Form 10

Patents Act 1977(*Rule 28*)

Concept House
Cardiff Road
Newport
South Wales
NP10 8QQ

Request for a substantive examination

(*See the notes on the back of this form*)

1	Your reference (optional):	NSL-GB1
2	Patent application number (e.g. GB7654321.0):	GB 2022044.6
3	Full name of the applicant or of each applicant:	Ninja Securities Limited
4	Number of pages of description in your application: (<i>see note (c)</i>)	32
5	(<i>please see notes (d) and (e)</i>)	I/We request substantive examination of this application. Signature Date [today]
6	Name, e-mail address, telephone, fax and/or mobile number, if any, of a contact point for the applicant:	Bea Trice 0161 012 3344

1

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PCT

REQUEST

The undersigned requests that the present international application be processed according to the Patent Cooperation Treaty.

For receiving Office use only

International Application No.

International Filing Date

Name of receiving Office and "PCT International Application"

Applicant's or agent's file reference (if desired) (25 characters maximum)
SeatTech01

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Box No. I TITLE OF INVENTION	
Reclining mechanism	
Box No. II APPLICANT ☐ This person is also inventor	
Name and address: (Family name followed by given name; for a legal entity, full official designation. The address must include postal code and name of country. The country of the address indicated in this Box is the applicant's State (that is, country) of residence if no State of residence is indicated below.) Seating Technology Limited 12 Russel Street London W15 8TT United Kingdom (GB or UK ok here; both post code and country needed)	Telephone No. Facsimile No. Applicant's registration No. with the Office
E-mail authorization: Marking one of the check-boxes below authorizes the receiving Office, the International Searching Authority, the International Bureau and the International Preliminary Examining Authority to use the e-mail address indicated in this Box to send, notifications issued in respect of this international application to that e-mail address if those offices are willing to do so. ☐ as advance copies followed by paper notifications; or ☐ exclusively in electronic form (no paper notifications will be sent). E-mail address:	
State (that is, country) of nationality: GB or United Kingdom (not UK)	State (that is, country) of residence: BLANK (or GB, United Kingdom, not UK)
This person is applicant for the purposes of: ☒ all designated States ☐ the States indicated in the Supplemental Box	
Box No. III FURTHER APPLICANT(S) AND/OR (FURTHER) INVENTOR(S)	
☒ Further applicants and/or (further) inventors are indicated on a continuation sheet.	
Box No. IV AGENT OR COMMON REPRESENTATIVE; OR ADDRESS FOR CORRESPONDENCE	
The person identified below is hereby/has been appointed to act on behalf of the applicant(s) before the competent International Authorities as: ☒ agent ☐ common representative	
Name and address: (Family name followed by given name; for a legal entity, full official designation. The address must include postal code and name of country.) Stechert, Laura (order of names is important here) Stechert Partners LLP 4 South Drive London W20 6PO United Kingdom (GB or UK ok here; both post code and country needed)	Telephone No. 02020 657483 Facsimile No. 02020 657482 Agent's registration No. with the Office
E-mail authorization: Marking one of the check-boxes below authorizes the receiving Office, the International Searching Authority, the International Bureau and the International Preliminary Examining Authority to use the e-mail address indicated in this Box to send, notifications issued in respect of this international application to that e-mail address if those offices are willing to do so. ☐ as advance copies followed by paper notifications; or ☒ exclusively in electronic form (no paper notifications will be sent). E-mail address: stechert@spartners.co.uk	
☐ Address for correspondence: Mark this check-box where no agent or common representative is/has been appointed and the space above is used instead to indicate a special address to which correspondence should be sent.	

Box No. III FURTHER APPLICANT(S) AND/OR (FURTHER) INVENTOR(S)

If none of the following sub-boxes is used, this sheet should not be included in the request.

Name and address: *(Family name followed by given name; for a legal entity, full official designation. The address must include postal code and name of country. The country of the address indicated in this Box is the applicant's State (that is, country) of residence if no State of residence is indicated below.)*

Derry, Tob (order of names is important here)

20 Portcullis House

Plymouth PL36 0LR

United Kingdom

(GB or UK ok here; both post code and country needed)

This person is:

☐ applicant only

☐ applicant and inventor

☒ inventor only *(If this check-box is marked, do not fill in below.)*

Applicant's registration No. with the Office

State *(that is, country)* of nationality:

BLANK (or GB, United Kingdom, not UK)

State *(that is, country)* of residence:

BLANK (or GB, United Kingdom, not UK)

This person is applicant for the purposes of:

☐

all designated States

☐

the States indicated in the Supplemental Box

Name and address: *(Family name followed by given name; for a legal entity, full official designation. The address must include postal code and name of country. The country of the address indicated in this Box is the applicant's State (that is, country) of residence if no State of residence is indicated below.)*

This person is:

☐ applicant only

☐ applicant and inventor

☐ inventor only *(If this check-box is marked, do not fill in below.)*

Applicant's registration No. with the Office

State *(that is, country)* of nationality:

State *(that is, country)* of residence:

This person is applicant for the purposes of:

☐

all designated States

☐

the States indicated in the Supplemental Box

Name and address: *(Family name followed by given name; for a legal entity, full official designation. The address must include postal code and name of country. The country of the address indicated in this Box is the applicant's State (that is, country) of residence if no State of residence is indicated below.)*

This person is:

☐ applicant only

☐ applicant and inventor

☐ inventor only *(If this check-box is marked, do not fill in below.)*

Applicant's registration No. with the Office

State *(that is, country)* of nationality:

State *(that is, country)* of residence:

This person is applicant for the purposes of:

☐

all designated States

☐

the States indicated in the Supplemental Box

Name and address: *(Family name followed by given name; for a legal entity, full official designation. The address must include postal code and name of country. The country of the address indicated in this Box is the applicant's State (that is, country) of residence if no State of residence is indicated below.)*

This person is:

☐ applicant only

☐ applicant and inventor

☐ inventor only *(If this check-box is marked, do not fill in below.)*

Applicant's registration No. with the Office

State *(that is, country)* of nationality:

State *(that is, country)* of residence:

This person is applicant for the purposes of:

☐

all designated States

☐

the States indicated in the Supplemental Box

☐ Further applicants and/or (further) inventors are indicated on another continuation sheet.

Box No. V DESIGNATIONS				
The filing of this request constitutes under Rule 4.9(a) the designation of all Contracting States bound by the PCT on the international filing date, for the grant of every kind of protection available and, where applicable, for the grant of both regional and national patents. However, ☐ DE Germany is not designated for any kind of national protection ☐ JP Japan is not designated for any kind of national protection ☐ KR Republic of Korea is not designated for any kind of national protection <i>(The check-boxes above may only be used to exclude (irrevocably) the designations concerned if, at the time of filing or subsequently under Rule 26bis.1, the international application contains in Box No. VI a priority claim to an earlier national application filed in the particular State concerned, in order to avoid the ceasing of the effect, under the national law, of this earlier national application.)</i>				
Box No. VI PRIORITY CLAIM AND DOCUMENT				
The priority of the following earlier application(s) is hereby claimed:				
Filing date of earlier application <i>(day/month/year)</i>	Number of earlier application	Where earlier application is:		
		national application: country or Member of WTO	regional application: regional Office	international application: receiving Office
item (1) 14/02/2019	1912345	GB		
item (2)				
item (3)				
☐ Further priority claims are indicated in the Supplemental Box.				
Furnishing the priority document(s): ☐ The receiving Office is requested to prepare and transmit to the International Bureau a certified copy of the earlier application(s) <i>(only if the earlier application(s) was filed with the receiving Office which, for the purposes of this international application, is the receiving Office)</i> identified above as: ☐ all items ☐ item (1) ☐ item (2) ☐ item (3) ☐ other, see Supplemental Box ☒ The International Bureau is requested to obtain from a digital library a certified copy of the earlier application(s) identified above, using, where applicable, the access code(s) indicated below <i>(if the earlier application(s) is available to it from a digital library)</i> : ☒ item (1) access code <u>123A</u> ☐ item (2) access code _____ ☐ item (3) access code _____ ☐ other, see Supplemental Box				
Restore the right of priority: the receiving Office is requested to restore the right of priority for the earlier application(s) identified above or in the Supplemental Box as item(s) (_____). <i>(See also the Notes to Box No. VI; further information must be provided to support a request to restore the right of priority.)</i>				
Incorporation by reference: where an element of the international application referred to in Article 11(1)(iii)(d) or (e) or a part of the description, claims or drawings referred to in Rule 20.5(a) is not otherwise contained in this international application but is completely contained in an earlier application whose priority is claimed on the date on which one or more elements referred to in Article 11(1)(iii) were first received by the receiving Office, that element or part is, subject to confirmation under Rule 20.6, incorporated by reference in this international application for the purposes of Rule 20.6.				
Box No. VII INTERNATIONAL SEARCHING AUTHORITY				
Choice of International Searching Authority (ISA) <i>(if more than one International Searching Authority is competent to carry out the international search, indicate the Authority chosen; the two-letter code may be used):</i> ISA/ <u>BLANK (or EPO or EP)</u>				

Box No. IX CHECK LIST for PAPER filings – this sheet is only to be used when filing an international application on PAPER			
This international application contains the following: (a) request form PCT/RO/101 (including any declarations and supplemental sheets) (b) description (excluding any sequence listing part of the description, see (f), below) (c) claims (d) abstract (e) drawings (if any) (f) sequence listing part of the description (if any) Total number of sheets	1 - left hand column Numbering consistent with candidate pages submitted to gain mark	Number of sheets 4 14 2 1 6 27	This international application is accompanied by the following item(s) (<i>mark the applicable check-boxes below and indicate in right column the number of each item</i>): 1. ☒ fee calculation sheet. : 1 2. ☐ original separate power of attorney : 3. ☐ original general power of attorney : 4. ☐ copy of general power of attorney; reference number: : 5. ☐ priority document(s) identified in Box No. VI as item(s) : 6. ☐ Translation of international application into (<i>language</i>): : 7. ☐ separate indications concerning deposited microorganism or other biological material : 8. ☐ (<i>only where item (f) is marked in the left column</i>) copy in electronic form (Annex C/ST.25 text file) on physical data carrier(s) of the sequence listing, not forming part of the international application, which is furnished only for the purposes of international search under Rule 13ter (<i>type and number of physical data carriers</i>) : 9. ☐ (<i>only where item (f) (in the left column) and item 8 (above) are marked</i>) a statement confirming that “the information recorded in electronic form submitted under Rule 13ter is identical to the sequence listing as contained in the international application” as filed on paper : 10. ☐ copy of results of earlier search(es) (Rule 12bis.1(a)) . . . : 11. ☐ other (<i>specify</i>): :
Figure of the drawings which should accompany the abstract:		3	Language of filing of the international application: English (or EN)
Box No. X SIGNATURE OF APPLICANT, AGENT OR COMMON REPRESENTATIVE <i>Next to each signature, indicate the name of the person signing and the capacity in which the person signs (if such capacity is not obvious from reading the request).</i>			
Laura Stechert (or Stechert, Laura)			

For receiving Office use only	
1. Date of actual receipt of the purported international application:	2. Drawings: ☐ received: ☐ not received:
3. Corrected date of actual receipt due to later but timely received papers or drawings completing the purported international application:	
4. Date of timely receipt of the required corrections under PCT Article 11(2):	
5. International Searching Authority (if two or more are competent):	6. ☐ Transmittal of search copy delayed until search fee is paid

For International Bureau use only
Date of receipt of the record copy by the International Bureau: