FINAL EXAM APRIL 2007 - Answers

1. Please see attached Annex 1 and Annex 2.

(20 marks)

See filled out request form

2. What fees must be paid on filing an International Application and when? Is any extension of time possible? (5 marks)

Transmittal Fee Search Fee International Filing Fee

All Payable within one month of filing

Deadline of one month from invitation to pay

3. You filed a PCT application at the UK Patent Office on 3 November 2006. You claimed a priority date of 4 November 2005. You have received Form PCT/ISA/200 dated 12 March 2007.

(a) What Form must you file to request International Preliminary Examination?

DEMAND, PCT/IPEA/401

(b) What is the latest date on which you may file this Form? Explain how you calculate this due date.

(3 marks)

(1 mark)

4 September 2007 = 22 months from priority (as this is later than 12 June 2007, 3 months from search report/opinion)

(c) What fees must be paid for International Preliminary Examination and when are they due?

(6 marks) <u>Handling fee</u> due one month from filing of Demand or 22 months from priority date (4 September 2007), whichever is later (3 marks)

Preliminary Examination fee due one month from filing of Demand or 22 months from priority date (4 September 2007), whichever is later (3 marks) (10 marks in total)

4. Who issues the following:
(a) IPRP Chapter I (1 mark)
The IS(b) IPRP Chapter II (1 mark)
The IFEA (2 marks in total)

5. You filed a PCT Application on 22nd September 2005, claiming priority from a UK Patent Application dated 29th September 2004. What is the deadline for entry into the regional phase in Europe? Please calculate the date. **(3 marks)**

31 mths from pty date i.e. 29th April 2007, this is a Sunday so Monday 30th April 2007 but 30th April is a National Holiday in The Hague so Tuesday 1st May 2007.

6. Today your client instructs you to enter its PCT application into the European regional phase, eventually wishing to obtain protection in:

DE ES FR GB HR IE IT MK NL PT SE SI SK.

Which fee(s) need to be paid specifically to maintain protection in these countries at the European regional phase entry stage? (Monetary amounts of the fee(s) are not required in your answer).

(3 marks)

Designation fees for DE ES FR GB IE IT NL PT SE SI SK. (1 mark)

Designation fees are deemed paid for all contracting states upon payment of seven times the designation fee. (1 mark)

Extension fee x 2 for HR MK.

7. In general, when is the examination fee due on an EP(PCT) application? *(2 marks)*

By the 31 month deadline or within 6 months from the publication of the international search report, whichever is the later.

8. Your office receives from the EPO a Communication pursuant to Article 96(2) and Rule 51(2) – a substantive examination report – dated 27 December 2006. The term for response is stated to be 4 months from notification of the communication.

(a) What is the last date that a response may be filed within the existing term? *(3 marks)*

27-12-06 plus ten days = 6 January, plus four months = 6 May. But 6 May is a Sunday and 7 May EPO is closed, so final date is <u>8 May 2007</u>

(b) Your patent attorney tells you that he will be unable to prepare a response before the due date. What action should you take? (3 marks)

File a request for an extension in writing before expiry of deadline.

(c) If no action is taken, what will happen next, and how can the situation be rectified? (6 marks)

EPO will issue a communication stating that the application is deemed withdrawn. Request Further Processing in writing before expiry of term (2 months from notification of communication), complete the omitted act

(1 mark)

and pay the official fee for Further Processing.

(12 marks in total)

9. You have received a communication from the European Patent Office under Rule 51(4) in relation to your European Patent Application dated 12th March 2004 claiming priority from a UK Patent Application dated 20th March 2003, informing you of the text in which the EPO intends to grant the Patent. The contracting states are AT, BE, CH, CY, DE, DK, ES FI, FR, GB, GR, IE, IT, LU, MC, NL, PT, SE, TR.

What types of fees are now payable to the EPO and what documents must be filed? (4 marks)

Grant and printing fees – 1 mark Translation of the claims – 1 mark

Into two official languages - 1 mark Not used as the language of the proceedings - 1 mark Or French and German 2 marks

10. Referring to the EP application above, you have now received the Decision to Grant Form 2006 from the EPO and mention of grant will be published in the European Bulletin on 19th June 2007.

(a) By when must the national phase be entered in Ireland? (2 marks)

Within six months of publication of the mention of grant i.e. .by 19th December 2007

(b) When is the next renewal fee due and to whom should it be paid? (2 marks)

Next renewal fee due 12th March 2008, payable on 31st March 2008 to the Irish Patent Office

(c) What other time limit runs from the publication of the mention of the grant of a European Patent? (1 mark)

A nine month period during which other parties may file an opposition against the grant of the European patent

(5 marks in total)

11. On 2nd April 2007 a UK patent application is filed relying for its technical content on a reference to a regular (i.e. non-provisional) US utility patent application filed on 3rd April 2006. The US filing date is the only priority date claimed in the UK application.

Excluding official forms, and ignoring any extensions of time that may be available, which application documents must be filed, and by which dates, in order to maintain the UK application?

(5 marks)

Description

Any drawings)	
Claims)	(2 marks)
Abstract.)	
All due within 2 months of UK filing = 2 nd June 2007 [a Friday].		(1 mark)
Certified copy of US application.		(1 mark)
Due within 4 months of UK filing = 2^{nd} August 2007 [a Wednesday].		(1 mark)

A UK patent application is filed on 30th April 2004, with an earliest claimed 12. priority of 2nd May 2003. Without any requests for extension of time:

(a) on which date does the "acceptance period" expire, if the first substantive examination report was sent on 2nd November 2005, and

4 $\frac{1}{2}$ vears from priority = 2nd November 2007.

on which date does the acceptance period expire, if the first substantive (b) examination report was sent on 4th December 2006?

(1 mark)

(1 mark)

1 year from the date o/l1 was sent = 4th December 2007.

(2 marks in total)

What extensions of time are available for the acceptance periods mentioned 13. in Question 12? Outline the requirements and procedures for obtaining them.

(4 marks)

2 month eot as of right, by filing PF 52/77 with fee, within the extended period. (1 mark)

Further eot at Comptroller's discretion (reasons needed to justify grant of extension). (1 mark) (1 mark)

File PF 52/77 with fee + reasons

If extension is allowed, file PF 53/77 with fee, within specified time limit. (1 mark)

14. When is the first renewal fee due on a UK Registered Design? (a) (1 mark)

5 years from the date of filing

What is the maximum term of a UK Registered Design? (b) (1 mark)

25 years from the date of filing

(2 marks in total)

(a) What do you understand by the term "grace period" in the context of UK 15. **Registered Designs?** (2 marks)

The grace period is a maximum period of twelve months prior to the filing date (or priority date if there is one) of an application to register a design, within which a disclosure of the design by the designer (or his successor in title) cannot be used against the validity of the registration.

(This is slightly simplified but is sufficient for the 2 marks).

(b) What is the length of the priority term for UK Registered Designs?

(1 mark)

(3 marks)

Six months.

(3 marks in total)

16. Which three of the following statements are true:-

A trade mark <u>must</u> be a word A trade mark <u>must</u> be a sign A trade mark <u>must</u> be novel A trade mark <u>must</u> be a logo A trade mark <u>must</u> be capable of being graphically represented A trade mark <u>must</u> be distinctive (3 marks)

17. You are filing a new British Patent Application naming three inventors. How many copies of PF 7/77 Statement of Inventorship and of Right to Grant of Patent are required if the application claims priority from:-

(a) an earlier GB patent application;

4. One for each inventor plus one for UKIPO (2 marks)

(b) an earlier US application?

1. Inventors' copies not required when there is a foreign priority claim (1 mark)

Explain your reasoning.

18. What supporting material is required to register (record) a change of ownership of a British patent at UKIPO? (3 marks)

EITHER a written assignment or certified extract <u>signed by assignor</u> (2 marks) OR signature of <u>both</u> parties or representatives on PF21/77 (1 mark)

19. You are preparing invoices in respect of new European Patent Applications. The invoices each include charges for the following items:

Professional time (PT) Typing, copying etc (TC) Official Fees (OF)

On which of the above items (PT), (TC) and (OF) should VAT at 17.5% be charged:

(a) if the bill is sent to a UK client?

PT, TC

(b) if the bill is sent to a client in the Irish Republic who is not registered for VAT?

PT, TC

(c) if the bill is sent to a client in Germany who is registered for VAT?

None

(d) if the bill is sent to a client in Japan?

None

(4 marks)

20. Fill in the most appropriate words and phrases from the list below: (3 marks)

(a) A breach of , if it results in may constitute a commission of the tort of.....

Choose from:

Confidence, contract, duty of care, dispute, damage, negligence, theft, infringement.

A breach of duty of care, if it results in damage, may constitute a commission of the tort of negligence.

(b) List TWO examples of what should be required to be in place in a firm of patent attorneys handling European patent applications in order to provide a competent service and to enable recovery of rights if a mistake is made.

(2 marks)

1) detailed knowledge of provisions of EPC

2) availability of relevant literature (eg OJEPO, EPC)

3) office systems that are capable of ensuring that time limits are adhered to

4) proper instruction of employees in their duties

5) regular supervision of employees

Other suitable answers will be accepted.

(5 marks in total)

	For	receiving Office	use only	
PCT			, see a second se	
	International Application	on No.		
REQUEST				
REQUEST	International Filing Dat	te		
The undersigned requests that the present				
international application be processed		1 // 2 072 1		
according to the Patent Cooperation Treaty.	Name of receiving Offi			
	Applicant's or agent's i (<i>if desired</i>) (12 characte	file reference ers maximum) UN	J /46	
Box No. I TITLE OF INVENTION				
A PLASMA TORCH				
Box No. II APPLICANT This perso	n is also inventor			
Name and address: (Family name followed by given name; for a legal en	tity, full official designation.	Telephone No.		
The address must include postal code and name of country. The country of i Box is the applicant's State (that is, country) of residence if no State of reside THE UNIVERSITY OF NEASDEN	the address indicated in this ence is indicated below.)	+4420 7547 9823		
Dollis Hill Campus		Faccimila No		
London		Facsimile No.		
N73 1RL		+4420 7547 9825		
United Kingdom		Applicant's registration No. with the Office		
		Applicant sregis	tration No. with the Office	
State (<i>that is, country</i>) of nationality: GB	State (that is, country) GB	of residence:		
		the United States of America only	the States indicated in the Supplemental Box	
Box No. III FURTHER APPLICANT(S) AND/OR (FURT	HER) 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 of the applicant(s) before the competent International Authorities	on behalf x as:	agent	common representative	
Name and address: (Family name followed by given name; for a legal ent The address must include postal code and name of	tity, full official designation.	Telephone No.		
SMART, Arthur, Charles	+4420 7405 3214			
Draft & Hugfee		Facsimile No.		
7 Chancery Court London		+4420 7405 4123		
WC1 1BB		14420740	54125	
United Kingdom		Agent's registrati	on No. with the Office	
Address for correspondence: Mark this check-box where space above is used instead to indicate a special address to	e no agent or common rep which correspondence s	resentative is/has hould be sent.	been appointed and the	

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.) IDEA, Ivan 25 The Sidings Crewe Cheshire CR61 8QR United Kingdom	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, countryGBGB	<i>)</i> of residence:		
This person is applicant all designated all designated States except for the purposes of:	the United 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.) FROMAGE, Elizabeth Flat 6A, George Mansions 106 Water Street Neasden, London N73 6RQ United Kingdom	This person is: applicant only applicant and inventor inventor only (<i>If this check-box</i> <i>is marked, do not fill in below.</i>) Applicant's registration No. with the Office		
State (that is, country) of nationality:State (that is, countryFRGB	<i>)</i> of residence:		
This person is applicant all designated all designated States except for the purposes of:	the United 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)	<i>v)</i> of residence:		
This person is applicant all designated all designated States except the United States of America	the United 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:			
State (that is, country) of nationality: State (that is, country)) of residence:		
This person is applicant for the purposes of:	the United States indicated in the States indicated in the Supplemental Box		
Further applicants and/or (further) inventors are indicated on another continuation sheet.			

Sheet No. $\ldots 3 \ldots$				
Box No. V DESIGNATIONS				
The filing of this request constitute filing date, for the grant of every k However,	s under Rule 4.9(a), the design of protection available an	ignation of all Contract id, where applicable, for	ing States bound by the r the grant of both regio	PCT on the international onal and national patents.
DE Germany is not designa	ted for any kind of national p	protection		
	for any kind of national protect			
	t designated for any kind of a	-		
(The check-boxes above may only be	ot designated for any kind of e used to exclude (irrevocably	•	rned if, at the time of fili	ng or subsequently under
Rule 26bis. 1, the international appl State concerned, in order to avoid	lication contains in Box No. V	T a priority claim to an e	arlier national applicat	tion filed in the particular
Box No. VI PRIORITY CLAI	M			
The priority of the following earlie	r application(s) is hereby clai	imed:		
Filing date	Number	Whe	ere earlier application is	5:
of earlier application <i>(day/month/year)</i>	of earlier application	national application: country or Member of WTO	regional application: regional Office	international application: receiving Office
item (1) 23/05/2006	0608739.3	GB		
item (2)				
item (3)				
Further priority claims are inc	licated in the Supplemental F	Box.	I	1
Transmit certified copy: the rece		prepare and transmit to	the International Burea	an a certified copy of the
earlier application(s) (only if the earlier is the receiving Office) identified a	arlier application was filed w	with the Office which for	r the purposes of this in	nternational application
all items 🐹 ite	em (1) item (2)	item (3)	other, see Suppl	lemental Box
Restore the right of priority: the above or in the Supplemental Box <i>information must be provided to s</i>	as item(s) (application(s) identified to Box No. VI; further
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 INTERNATIONA	L SEARCHING AUTHOR	RITY		
Choice of International Searching Authority (ISA) (if two or more International Searching Authorities are competent to carry out the international search, indicate the Authority chosen; the two-letter code may be used):				ompetent to carry out the
ISA /				
Request to use results of earlier search; reference to that search <i>(if an earlier search has been carried out by or requested from the International Searching Authority):</i>				
Date (day/month/year)	Number	Country (or regional O	ffice)	
Box No. VIII DECLARATIONS				
The following declarations are contained in Boxes Nos. VIII (i) to (v) (mark the applicableNumber ofcheck-boxes below and indicate in the right column the number of each type of declaration):declarations				
Box No. VIII (i) Declaration as to the identity of the inventor :			:	
Box No. VIII (ii) Declaration as to the applicant's entitlement, as at the international filing date, to apply for and be granted a patent :				
Box No. VIII (iii) Declaration as to the applicant's entitlement, as at the international filing date, to claim the priority of the earlier application :				
Box No. VIII (iv) Declaration of inventorship (only for the purposes of the designation of the United States of America) :				
Box No. VIII (v) Dec	claration as to non-prejudicial	l disclosures or exception	ons to lack of novelty	:

Box No. IX CHECK LIST;	LANGUAGE (OF FILI	NG	
This international application con (a) on paper, the following num sheets:		item(s)	ternational application is accompanied by the following (mark the applicable check-boxes below and indicate in blumn the number of each item):	Number of items
request (including		0	fee calculation sheet	:
declaration and	. 4	2. 🗖	original separate power of attorney	:
supplemental sheets)	: 4	3. 🗖	original general power of attorney	:
description (excluding sequence listing and/or		4. 🗖	copy of general power of attorney; reference number,	
tables related thereto)	: 42	_	if any:	:
claims	: 4 · 1	5. 🗖	statement explaining lack of signature	:
abstract	: 10	6. 🗖	priority document(s) identified in Box No. VI as item(s):	
drawings Sub-total number of sheets		7. 🗖	translation of international application into <i>(language)</i> :	
sequence listing tables related thereto		8. 🗖	separate indications concerning deposited microorganism or other biological material	• •
(for both, actual number of sheets if filed on paper,		9. 🗖	sequence listing in electronic form	
whether or not also filed in electronic form;		(i)	(<i>indicate type and number of carriers</i>)	-
see (c) below) Total number of sheets	. 61	(ii)	Rule 13 <i>ter</i> only (and not as part of the international application $(only where check-box (b)(i) or (c)(i)$ is marked in left column) additional conjections including where applicable, the conv for the	·
(b) \square only in electronic form (Section 801(a)(i))		<u> </u>	additional copies including, where applicable, the copy for the purposes of international search under Rule 13 <i>ter</i>	:
(i) sequence listing		_	together with relevant statement as to the identity of the copy copies with the sequence listing mentioned in left column	or :
 (ii) □ tables related thereto (c) □ also in electronic form 		10.	tables in electronic form related to sequence listing (<i>indicate type and number of carriers</i>)	
(Section 801(a)(ii)) (i) ☐ sequence listing		(i)	copy submitted for the purposes of international search under Section 802(b-quater) only (and not as part of the internation application)	al
(ii) ☐ tables related thereto Type and number of carriers CD-ROM, CD-R or other) on	(diskette, which are	(ii)	(only where check-box (b)(ii) or (c)(ii) is marked in left column) additional copies including, where applicable, the copy for th purposes of international search under Section 802(b-quater)	e
contained the sequence listing:		(iii)	□ together with relevant statement as to the identity of the copy copies with the tables mentioned in left column	
tables related thereto: (additional copies to be indical items 9(ii) and/or 10(ii), in rig	ted under	11. 🗖	other (specify):	•
Figure of the drawings which should accompany the abstract:	Figure of the drawings which Language of filing of the			
1 5	FAPPLICAN		ional application: English	
			the capacity in which the person signs (if such capacity is not obvious from reading the capacity is not obvious from r	g the request).
SMART, Arthur, Charles				
1 Dete of extend models of the s		For 1	receiving Office use only	
1. Date of actual receipt of the purported international application: 2. Draw		C .		
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):			t received:	
5. International Searching Author (if two or more are competent	prity (): ISA /		6. Transmittal of search copy delayed until search fee is paid	
		For Inte	ernational Bureau use only	
Date of receipt of the record cop by the International Bureau:	у			

This sheet is not part of and does not count as a sheet of the international application.

PCT	For receiving Office use only
FEE CALCULATION SHEET Annex to the Request	International Application No.
Applicant's or agent's file reference UN/46	Date stamp of the receiving Office
Applicant THE UNIVERSITY OF NEASDEN et al.	
CALCULATION OF PRESCRIBED FEES	
1. TRANSMITTAL FEE	<u>55</u> T
2. SEARCH FEE	t to carry out the
 INTERNATIONAL FILING FEE Where items (b) and/or (c) of Box No. IX apply, enter Sub-total nu Where items (b) and (c) of Box No. IX do not apply, enter Total nu 	umber of sheets }61
i1 first 30 sheets	611 ii
$\boxed{i2} \underbrace{31}_{number of sheets}_{in excess of 30} x \underbrace{7}_{fee per sheet} = $	217 i2
i3 additional component (only if a sequence listing and/or tables related thereto are filed in electronic form under Section 801 or both in that form and on paper, under Section 801(a)(ii)):	(a)(i),
400 x =	i3
Add amounts entered at i1, i2 and i3 and enter total at I	828 T
(Applicants from certain States are entitled to a reduction of 7. international filing fee. Where the applicant is (or all applican entitled, the total to be entered at I is 25% of the international filing	ts are) so
4. FEE FOR PRIORITY DOCUMENT (<i>if applicable</i>)	<u>22 P</u>
5. TOTAL FEES PAYABLE	тоты
MODE OF PAYMENT (Not all modes of payment may be available at	t all receiving Offices)
authorization to charge deposit account (see below)	cash coupons
cheque bank draft	revenue stamps other (specify):
AUTHORIZATION TO CHARGE (OR CREDIT) DEPOSIT ACC (This mode of payment may not be available at all receiving Offices)	Receiving Office: RO/
Authorization to charge the total fees indicated above.	Deposit Account No.: D12345 Date: 26/04/2007
(<i>This check-box may be marked only if the conditions for deposit acco of the receiving Office so permit)</i> Authorization to charge any deficie or credit any overpayment in the total fees indicated above.	<i>unis</i>
Authorization to charge the fee for priority document.	Signature:

Form PCT/RO/101 (Annex) (April 2007)

See Notes to the fee calculation sheet