

1. Complete the European Request Form using Annexes 1 and 2.
(20 Marks)

2. What fees will be payable on the European Patent Application to be filed as required by Question? When must the fees be paid? What happens if the date is missed?
A. Filing and Search fees. One month from filing. The application is deemed abandoned. Further processing is possible.
(4 Marks)

3. What must be done to effect further processing?
A. Within 2 months of notification of loss of rights

*Request further processing
Pay the further processing fee and
Complete the omitted act.
(Note, payment of the fee is deemed to be a request for further processing)*
(4 marks)

4. You have received Form PCT/IB/206, Invitation to pay additional search fees dated 2nd February 2008 indicating that the ISA considers that there are two inventions in the application. You have to diary the deadline by which the Patent Attorney you work for must pay the additional search fee.

Please advise on the following:-

- a) The deadline date for payment of the additional search fee?
- b) Where does the search fee have to be paid?

(4 marks)

Answers:

A) One month eg: 2nd March which falls on a Sunday so Monday 3rd March.

3 Marks

B) Direct to the ISA.

1 Mark

5. Your PCT application can be published in any one of the 8 languages. Please list four of them.

Answers:

English, French, German, Spanish, Chinese, Japanese, Russian and Arabic.

(1/2 mark for each one)

(2 marks)

6. You have just received instructions from a US Attorney to enter the European Regional Phase claiming priority from a US application filed 15th July 2005. Your PCT International Filing Date is 14th July 2006. Please advise :-

- a) the normal date for entering the European Regional Phase including your calculations of how you arrive at this date.
- b) What happens if you miss the date?

Answers:

A) *31m from priority = 15 February 2008*

3 marks

B) *Further Processing.*

1 mark

(2 Marks)

7 A UK Patent Application has been filed and the search report has identified two inventions. Which invention has been searched?. What must be done to secure a search of the other invention?

A. The invention first mentioned in the claims. File form 9A and pay the search fee.

(3 Marks)

- 8 When is a UK patent Application published? What happens if the search report is not available? Are amendments published with the search report?

A. ASAP after 18 months from the filing date or priority date if claimed. Publication is delayed until the search report is available. Only amendments to the claims are published.

(3 Marks)

9. By when must a UK Patent application be in order for grant?

A. 4 Years and 6 Months from the filing date or priority date if claimed.

12 months from first examination report if later than 4 years 6 months from filing/priority.

(4 Marks)

- 10 UK Application was filed on 5 January 2005 claiming priority of 6 June 2004. A patent was granted on the application on 6 February 2006. When is the first renewal fee due? What is the last date the fee can be paid with surcharge?

A. 2 February 2009 (31 January 2009 is a Saturday). 31 July 2009

(5 Marks)

11. A UK Patent lapsed due to accidental non-payment of a renewal fee. What can be done and by when to correct this? (Ignore fee payments) What must be shown to be successful? .

A. Request restoration within 13 months of the end of the grace period of 6 months. Failure to pay must have been unintentional on the part of the Patentee.

(3 Marks)

12. True or false?

a) Patent rights are always broader in scope than registered design rights.

b) You cannot register a sound as a trademark.

c) Copyright is not a “true” monopoly right.

d) There is no unregistered monopoly right equivalent to a patent.

e) To keep your UK trade mark registration in force for ever, all that is needed is to pay the renewal fees when they become due every 10 years.

(5 marks)

- A. a) F. *The two rights are different in nature, so occasionally a RD will give more worthwhile protection than a patent. Alternatively, the Q is meaningless, as the two rights are not directly comparable.* [1]
- b) F. *E.g. "Intel inside" chimes, and recent publicity over Tarzan yodel. Must be capable of graphical representation, e.g. as musical score or sonogram.*
[1]
- c) T. *Proof of copying needed in infringement action.* [1]
- d) T. *Tort of breach of confidence is not a monopoly right.* [1]
- e) F. *Must use TM properly.* [1]

Note: full marks available for correct bare T/F answers.

13. What are the minimum requirements needed to obtain a filing date for a UK patent application?

(4 marks)

A13.

- *Docs filed indicate a patent is sought* [1]
- *Docs filed identify applicant sufficiently to enable them to be contacted*
[1]
- *(Docs filed contain a purported description of the invention* [1]
OR
- *Docs filed refer to an earlier application*
[1])

14. Here is a passage from the judgement given in *Donoghue v Stevenson* [1932] AC 562, a leading case concerning the tort of negligence. Please fill in the blanks using the correct words and phrases from the list below. You will have to use some of the words/phrases more than once.

In English law there must be, and is, some general conception of relations giving rise to a (1)_____. You must take reasonable care to avoid (2)_____ which you can

reasonably (3)_____ would be likely to injure your
 (4)_____. Who, then, in law, is my (5)_____?
 The answer seems to be – persons who are so closely and directly
 affected by my (6)_____ that I ought reasonably to have
 them in contemplation as being so affected when I am directing
 my mind to the (7)_____ which are called in question.

acts or omissions, duty of care, act, foresee, neighbour

(5 marks)

A14. (1) *duty of care* [1] (2,7) *acts or omissions* [1]
 (3) *foresee* [1] (4,5) *neighbour* [1] (6) *act* [1]

15. You have made a UK patent application and obtained a filing date, but the documents making up the application are deficient. List five documents or kinds of information that you may need to file before publication (depending upon the particular circumstances of the case), and the normal (i.e. unextended and without incurring additional fees) time limits for providing them, if the applicant is not to lose any rights.

(10 marks)

A15. (*Examples only. One mark for each item, 1 mark for each corresponding time limit*):

Translation if app. not in English (2M from PO request)
Ref. to earlier app: Description (2M from filing, or 12M from prio., whichever later)

Ref. to earlier app: cert. copy of earlier app. (4M from PO request)

Ref. to earlier app (not in English): translation, or declaration that descr. is complete trans. of earlier app. (4M from PO request)

Complete applicant details (2M from PO request)

Claims)
Abstract) (2M from filing, or 12M from prio.)

from prio.

Request for search) *whichever later)*

Cert copy prio. doc. (16M from prio.)

File no. of priority case (16M from prio.)

[filing date and country must be given in initial UK app. docs, else additional fees payable]

Address-for-service

(2M from PO request)

Formal drgs/spec. pages

(time limit specified in PO request - usually 15M from prio, approx.)

Statement of inventorship (PF 7[/77])

(16M from prio.)

16. When can a European Divisional Patent Application be filed?
What is the effective filing date of the Divisional Application?
What language must be used for the divisional application? Where must the Divisional Application be filed? What states can be designated?

A. .Prior to grant of the parent. The filing date of the parent. The language of the proceedings of the parent. Must be file at the EPO. Designations limited to states designated in the parent.

(5 Marks)

- 17 An EP Application was filed on 10 November 2003 and granted on 9 November 2007. Where must the next renewal be paid and on what date?

A National Offices.. 30 November 2007

(3 Marks)

- 18 A notification from the European Patent Office advising of loss of rights is dated 9 November 2007. What is the time limit for requesting Further Processing?

A. Notification is deemed received on 19 November 2007. Two months from 19 November 2007 is 19 January 2008 which is a Saturday. Time limit extended to Monday 21 January 2008.

(5 Marks)

19. a) In what circumstances might there be criminal sanctions against you if you cause a patent application, having an inventor who is a UK resident or national, to be first filed outside the UK?

(2 marks)

b) Whose responsibility is it to determine whether prior security clearance might be needed for such an application?

(1 mark)

A19. a) *If the application relates to military technology [1] OR
If for any other reason publication of the application might be
prejudicial to national security [1]*

b) *Anyone who could be said to have caused the application to be filed.
[That could include you!]*

20. (a) Assuming that the applicant has the right to file a PCT application and has an application in a prescribed language, what are the additional 5 basic elements needed to establish an International Filing Date?
(5 marks)

(1) Name of applicant, (2) indication that application is a PCT application, (3) designation of at least one state, (4) a description, and (5) a claim or claims.

(b) If the PCT application is filed without any claims, and these are then filed at a later date, what effect will this have on the filing date of the application?
(1 mark)

The PCT application will take the later date, when the claims are filed, as its International Filing Date.