

PAC Final Exam 2010

[Materials to be supplied to candidates:

Exam paper

Annexes

Blank EPF1001

Notes to EPF 1001

Blank EPF1002

2010 Calendar showing Days of Week and Bank Holidays only

Notice from the President of the EPO dated 28 July 2009 concerning the days on which EPO filing offices are closed in 2010; equivalent notice showing days closed in 2009]

Q1. You are an in-house administrator for Anglo-Spanish Enterprises, Ltd., and the attorney you work for has asked you to prepare a new European patent application. Please prepare a new European patent application, based on the information given in Annex A. Forms 1001 and 1002 are enclosed. (20 marks)

A1. (Deduct 0.5 marks for any omitted or incorrect information on the form).

Q2. Assuming that the application in Q1 is filed on 29 April 2010, what documents must be filed, and by when, to complete the filing formalities? (Ignore fees.) (6 marks)

A2. i) Certified copy of the Spanish application (1)

Within 2 months of filing (1)

By 29 June 2010 (1)

ii) English translation of the Spanish application (1)

Within 2 months of filing (1)

By 29 June 2010 (1)

3. A decision refusing a European Patent Application was notified to the Applicant by the European Patent Office by a letter dated 21 October 2009. The applicant wishes to appeal.

(a) By what date must the Notice of Appeal have been filed?

- (5 Marks)
- (b) Is there any extension of time available? (1 Mark)
- A3. (6 marks total)
- (a) The notice is due two months after notification of the decision (2 marks)
- 21 October 2009 + 10 Days = 31 October 2009 (1 mark)
- 31 October 2009 + 2 months = 31 December 2009 (1 mark)
- The EPO is closed on 31 December 2009 and on 1, 2 and 3 January. So due date was 4 January 2010 (1 mark)
- (b) No. (1 mark)
4. Today your office has taken over responsibility for UK patent no. GB2123456. On checking the online register, you discover that the patent claims a priority date of 26th September 2005, was filed on 1 April 2006, was granted on 3 February 2010 and has been marked "Licences of Right" since grant.
- (a) What is the deadline for the payment of any renewal fee(s) now due, without surcharge? Give your reasons. (7 marks)
- (b) What effect does the marking "Licences of Right" have on the renewal fee payable? (1 mark)
- A4. (8 marks total)
- (a) 4th filing anniversary has passed so renewal fee for 5th year is due. (1 mark)
- But as grant has taken place more than 3yrs 9M after filing [= after a date 3M before expiration of the 4th year], (1 mark)
- payment deadline for fee for 5th yr (w/o surcharge) is end of month (1 mark)
- containing the date 3M (1 mark)
- after the grant date (1 mark)

= 31st May 2010 (1 mark)

which is a bank holiday, so final date is 1st June 2010. (1 mark)

(b) The amount of each renewal fee is halved. (1 mark)

5. For the patent in question 4:

(a) What is the deadline for *late payment* of the renewal fee(s) due, as of right (“for the asking”), with surcharge? Give your reasons.

(3 marks)

(b) What effect does the marking “Licences of Right” have on the amount of the surcharge due?

(1 mark)

A5. (4 marks total)

(a) Payment may be made with additional fee

up to the end of the sixth month (1 mark)

following the due date (1 mark)

= 30 November 2010 (1 mark)

(b) Amount of additional fee unchanged [no effect, none]. (1 mark)

6.

(a) Which day of the week are UK patent applications published on?

(1 mark)

(b) If amended description and claims pages are filed after receipt of the search report, will those pages be published with the “A” specification?

(2 marks)

(c) Under what circumstances will “A” publication of a UK patent application be delayed?
(1 mark)

(d) Does a published “A” specification show the date of grant of the patent?
(1 mark)

A6 (5 marks total)

(a) Wednesday (1 mark)

(b) Only the claims pages will be published, (1 mark)
if those are received at the IPO before preparations for publication are complete.
(1 mark)

(c) If there is a delay in carrying out the search at the IPO. (1 mark)
[No legal mechanism for applicant to delay publication].

(d) No. (1 mark)

7. A UK patent application was filed on the 14th December 2009 claiming priority from an earlier application filed on 14th December 2008. You have to diary the deadline for filing a Statement of Inventorship form (form 7). Please state the deadlines for filing this document. Give your reasoning.
(3 marks)

A7. 16m [1] from earliest priority [1] = 14th April 2010 [1]. (3 marks)

8. For the application in Question 7, please state the deadline for filing formal drawings. Give your reasoning.
(4 marks)

A8. 15m [1] from earliest priority [1] = 14 March 2010 [1] which falls on a Sunday, so Monday 15th March 2010 [1]. (4 marks)

9. The attorney you work for has just received instructions today 29th April 2010 from a new

client to take over a PCT International Application originally filed by the client's previous German Attorney. The International Application was filed on 8th January 2008 directly at the EPO as receiving office. No priority was claimed. Your attorney has asked you to diary the national phase deadline for filing in the USA. Please state this deadline indicating in your answer how you arrived at this date. (3 marks)

A9. 30m [1] from priority [= filing date in this case] [1] i.e. 8 July 2010 [1]. (3 marks)

10. For the PCT application in Question 9, what is the normal date by which the application must enter the regional phase in the European Patent Office? Again, show how you arrived at this date in your answer. (4 marks)

A10. 31m [1] from priority [1] i.e. 8 August 2010 [1] which is a Sunday so 9th August 2010 [1]. (4 marks)

11. A European patent application filed directly at the EPO on 14th December 2007 has its search report published on 15th January 2010. By what date must the examination fee be paid? Give your full reasoning. (3 marks)

A11. 6m [1] from publication of the search report [1] = 15th July 2010 [1] (3 marks)

12. By mistake, the examination fee for the application in Question 11 is not paid in time. What is the consequence of this? What does the EPO do next? What can be done to ensure that the application will continue? Mention any time limits that apply, but there is no need for you to calculate actual dates in your answer. (8 marks)

A12.
The application is deemed withdrawn [1].
A Notice of Loss of Rights is issued [1].
This sets a deadline of 2m [1]
from notification of the Notice [1]
(i.e. 10-day rule applies) [1]
for requesting further processing [1],
paying the examination fee [1]
and paying the further processing fee [1]. (8 marks)

13. State whether the following kinds of IP rights *in the UK* are registered or unregistered or both.
- a) Passing-off
 - b) Patents
 - c) Designs
 - d) Copyright

(4 marks)

A13.

- a) Unregistered [1]
- b) Registered [1]
- c) Both [1]
- d) Unregistered [1]

(4 marks)

14. What is a trade mark?

(2 marks)

A14. Badge of origin, [1], distinctive of proprietor [1]

[Or words to that effect, e.g. a sign [1] capable of distinguishing g/s of one proprietor from those of another [1]]

(2 marks)

15. Which of the following, if new, can be registered as a UK trade mark?

(2 marks)

- (a) An invented word
- (b) A descriptive slogan
- (c) A three-dimensional object
- (d) A generic name

A15. (a) Yes. (b) No. (c) Yes. (d) No. [Max. 2 marks; deduct 0.5 marks for each mistake.]

16. Your client Monsieur Cleverclog is a French national who is resident in the UK. He is the inventor and intended applicant in a PCT application in English which he has asked you to file for him.

- (a) Can you file the PCT application at the UK Patent Office as Receiving Office? (2 marks)
- (b) What happens if the application is filed at the US Patent Office? Ignore any national security issues.

(4 marks)

Please explain your reasoning in each case.

A16.

- (a) Yes, the UK Patent Office is a competent receiving office [1]

because the applicant/inventor is resident in the UK [1]. (2 marks)

- (b) The US is a non-competent RO [1]
as Monsieur Cleverclog is neither a resident nor a national of the USA [1].
However the application will be forwarded to the International Bureau (IB) [1]
and you will keep the filing date that it was received at USPTO [1]. (4 marks)

17. You work for an in house patent department. The deadline for filing patent applications claiming priority from a UK patent application is approaching. Protection is required in Italy and Germany. What are your options for filing the convention applications to preserve the option of protection in these two countries? (3 marks)

A17. Protection in Italy and Germany can be obtained by either a European application [1]
or a PCT application [1].
National applications in each country could also be filed [1]. (3 marks)

18. Your client Candleford Limited, has recently sold a small portfolio of patents to Dorcas Limited. On checking the UKIPO register, you discover that the proprietor of the relevant patents is still shown as Lark Rise Limited, which was the company name when the applications were filed. Your paperwork shows that Candleford Limited and Lark Rise Limited have the same registration number at UK Companies House. List the series of transactions which need to be recorded at the UKIPO. (2 marks)

A18.
[PF 20] Name change Lark Rise Limited → Candleford Limited [1]
[The more astute candidates will caution to check with client for possible intervening transactions, but the above is sufficient for full marks]

[PF 21] Assignment Candleford Limited → Dorcas Limited [1] (2 marks)

19. What documents must be filed to support registration of a patent assignment at the UKIPO? At minimum, what must these documents contain to be registrable? (6 marks)

A19.
Official form [PF21, no fee before 06/04/2010, but now with fee] [1]
[Extract from] *written* [1] assignment
signed by assignor [1]
and listing patent numbers [1]

OR

Signature of assignor [including new representatives] [1]
on application form [1]

(6 marks)

[For either option, full marks awarded for saying signature required by both parties, but that is probably an abundance of caution.]

20. A UK design application was filed on 26th April 2010, claiming priority of a Benelux design application filed on 4th January 2010.

(a) Ignoring extensions, by when must the first renewal fee be paid on the resulting UK design registration?

(1 mark)

(b) Assuming all renewal fees are paid, when will the resulting UK design registration expire?

(1 mark)

A20.

(a) 26th April 2015 [= filing date + 5 years]

(1 mark)

(b) 26th April 2035 [= filing date + 25 years]

(1 mark)

Anglo-Spanish Enterprises , Ltd.

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Internal memo (file: ABD/1234)

Dear Administrator

Our Barcelona office filed a Spanish national patent application to comply with Spanish national security requirements. We are now clear to file outside of Spain, and wish to apply for patent protection in Europe by way of a European patent application.

The bibliographic data of the Spanish application are as follows:

Application No.	ES 09987654.3
Filing Date:	30 April 2009
Applicant:	Anglo-Spanish Enterprises, Lda. 402 Plaza de Catalunya Barcelona 1001 Spain
Inventor:	Jose Martinez

(Employee - use applicant address)

Title: Improvements relating to wine production

Please prepare a new European patent application claiming priority from the Spanish application. EPO forms 1001 and 1002 are enclosed for completion. There has been no assignment of any rights in the Spanish application. Fees will be paid later by our Accounts Department, from our deposit account no. 28001111. The application documents are to be filed by hand at the UK IPO.

For commercial reasons, we wish to file the application today. It is not necessary to make any amendments to the Spanish description, claims (14 in total) or drawings (1 figure) when filing the European patent application. However, we do not have a copy of the Spanish application, and our Barcelona office is shut for the rest of the week. Please take the appropriate action to secure today's filing date. We will request any supporting documents from the Barcelona office when they open next week

Regards.

John Smith

European Patent Attorney