

PATENT ADMINISTRATORS - EXAMINATION

29 March 2000

1. This is a three-hour Paper
2. You should attempt all questions
3. The number of marks allotted to each question is placed in brackets at the end of the question
4. Please write clearly, as it is difficult to award marks to illegible answers
5. A UK diary and list of UK bank holiday dates in 2000 and 2001 is provided, together with a European Patent Office diary with dates on which the branch offices are closed
6. A list of current UK Forms is also provided
7. The Paper contains 6 sheets plus Annexes A1, A2, B and C
8. Additional blank forms for Question 1 are available from the invigilators

1. The Patent Attorney, Mr A T Turney, for whom you work has sent you the memorandum at Annex A1. A copy of the front sheet, UK application 9901212.6, is at Annex A2.

Please complete the **first page only** of Form 1/77 (a blank first page is provided) as you would to enable the divisional application to be made.

(7 marks)

2. a. On the basis of the information given in Question 1, in addition to the Application Form (Form 1/77), you will need to complete and file certain other forms. Which are these?

(4 marks)

[NOTE: A list of current forms is provided]

- b. Give three methods by which you can ensure that papers for the divisional application are filed with the UK Patent Offices.

(3 marks)

3. You are preparing bills for clients in respect of work before the UK Office.

The bills are each as follows:

Professional time:	£900
Typing, photocopying etc:	£100
Official Fees:	£100

How much value added tax (at 17.5%) should be charged?

- a. If the bill is sent to a UK client?

(1 mark)

- b. If the bill is sent to a client in Belgium registered for VAT?

(1 mark)

- c. If the bill is sent to a client in Japan?

(1 mark)

4. You received on 1 March 2000 a search report and official letter relating to a UK Application. The letter states that preparation for publication will be complete on 3 April 2000. The client concerned has instructed that the description and claims should be amended.

- a. What should you do to ensure that the amended claims are published with the application?

(2 marks)

- b. How is it recommended that the letter to the Patent Office be marked in this circumstance?

(1 mark)

- c. Will the amended description be published with the application?

(1 mark)

5. The attorney for whom you work has just taken over a number of UK Patent Applications formerly handled by another firm. What should you do to ensure that you receive all future correspondence from the UK Patent Office? (2 marks)

6. Two of the following are not essential for the grant of a valid UK patent:
 Novelty, a priority claim, inventive step, industrial applicability, actual use of the invention.
 Which are they? (2 marks)

7. A UK patent has been assigned to your client, you are preparing a form 21/77 to record the assignment. Who must sign the Form 21/77 to register the assignment, if the assignment document is not to be produced? (2 marks)

8. Within what period should an assignment of a UK patent be recorded on the patent register if the assignee is to avoid the risk of monetary loss if an infringement arises? (2 marks)

9. You have just received a standard letter (P Ren 5 - Overdue Renewal) in respect of a UK patent whose renewal date was 15 March 2000, noting that the renewal fee had not been paid in time:
 - a. By which date can the renewal fee still be paid with an additional fee? (1 mark)

 - b. If that date is missed, how long a period is given to apply for restoration under Section 28? (2 marks)

10. Are renewal fees payable in respect of the following. Where renewal fees are payable indicate when the first fee is due, the frequency of payment and when renewal fees cease:
 - a. A pending PCT patent application
 - b. A pending European patent application filed direct at the EPO
 - c. A pending UK patent application
 - d. A UK patent granted 4 years after its application date (10 marks)

11. a. What claim fees are payable for a new European Application? (2 marks)
- b. For a new European Patent Application by when should the filing fees, search fees and claim fees be paid? (2 marks)
- c. If the filing fee is not paid in time, how can the application be saved? (3 marks)
12. A European Patent Application was filed on 20 September 1999 having a priority date 12 months earlier. The application was published with search report (the A1 publication) on 23 March 2000. The Application designates France, Germany and the United Kingdom:
- a. What must be done next and by what date, noting which fees should be paid? (3 marks)
- b. Why the date given in the answer was chosen? (2 marks)
- c. Would your answer to a. have been different if all European Patent Convention contracting states had been designated, if so how? (1 mark)
13. EPO sent the letter at Annex B:
- a. On what date should the reply by the EPO have been received? (1 mark)
- b. Explain exactly why you chose that date (2 marks)
- c. If the reply had not been ready for that date, what could have been done to avoid difficulty, and what would the new deadline have been? (5 marks)
- d. As no reply has been sent, explain what will have happened, what should be done to recover the situation and by when? (4 marks)
14. You receive, today, the notice "Decision to Grant a European Patent" at Annex C.
- The patent specification is in English, what needs to be done next and by what date to ensure that the patent is given effect in the designated countries? (4 marks)

15. The Patent Attorney for whom you work has prepared and left you a patent specification and claim ready for filing as a PCT and has just gone abroad for two weeks. Your Client, London Pumps plc now wants the PCT application filed today: all PCT countries are to be designated. All rights in the invention, which was made by a James Silverman, belong to the client.

- a. Who should be named as applicants for the PCT Request Form and for which countries? (4 marks)
- b. What would happen if the Request Form is filed unsigned by the attorney? (4 marks)
- c. Will you need anything to be signed by the client and/or the inventor, if so what? (3 marks)

16. A PCT application is to be filed at the UK Receiving Office. The application does not claim priority and is made up as follows:

- description 20 sheets
- claims (20 claims) 2 sheets
- abstract 1 sheet
- drawings (9 figures) 5 sheets
- request 5 sheets

The applicant wishes to designate 10 countries:

What fees will have to be paid in respect of this application? (Amounts are not required but please note any factors which will determine the amount. Please note fees even if they are not payable immediately) (6 marks)

17. You have just received a filing receipt for a new PCT Application filed on 10 March 2000 claiming priority from a UK Application filed on 23 March 1999. The applicant intends to seek an international preliminary examination report and then subsequently enter the European regional phase:

What would be the two key dates for you to diary to ensure that the client's request is acted upon and the European regional phase is entered in time? (4 marks)
[Give the dates and action to be taken on or before those dates]

18. A patent has lapsed irretrievably (ie beyond any possibility of recovery) as a result of a record keeping error: your firm's client was hoping to earn £500,000 a year in royalties from the patent. What action might the client take? (2 marks)

19. a. What is a statement of novelty in an application for a design registration? (1 mark)
- b. What purpose is served by the blue colouring which is sometimes applied to parts of a drawing of a design in an application for registration? (1 mark)
20. a. When is the first renewal fee payable for a design registration? (2 marks)
- b. How frequently are renewal fees payable on design registrations? (1 mark)
- c. What is the maximum life of a registered design (assuming renewals are paid)? (1 mark)

ANNEX A1

A T Turney & Co
Staple Inn Building
High Holborn
London WC1V 7PZ

Tel: 020 7405 9450
Fax: 020 7430 0471
E-mail: mail@turney.com

29 March 2000

To: The Candidate

PROPOSED DIVISIONAL APPLICATION - REF: PAT 99.001 DIV
FROM UK PATENT APPLICATION 9901212.6 - REF: PAT 99.001

Unfortunately the last official action on this case leaves no alternative but to file a new divisional application. I attach a copy (Annex A2) of the original application 9901212.6 (publication number 2900000). All the key information, including the applicant and the priority claim, will be the same for the Divisional Application. Our client has approved the action. I have sent the final draft of the Divisional Specification to the client, he has approved the text and wants us to proceed immediately.

Please:

1. (For Question 1) prepare an Application Form (Patents Form 1/77) for my signature today.
2. (For Question 2) please let me know which other forms need to be filed with the Divisional Application to ensure the application proceeds immediately and priority is preserved.
[Note: A list of all current forms is provided]

A T TURNEY

(12) UK Patent Application (19) GB (11) 2 900 000 (13) A

(43) Date of A publication 07.07.99

(21) Application No 9901212.6

(22) Date of filing 05.01.99

(30) Priority Data [GB] 9801514.1 05.01.98

(71) Applicant
London Pumps plc
Creekmouth Lane
Barking, London E12 5ET, United Kingdom

(72) Inventor
J Silverman

(73) Agent and/or Address for Service
A T Turney & Co
Staple Inn Building
High Holborn
London WC1V 7PZ

(51) INT CL³
A41D 1/00

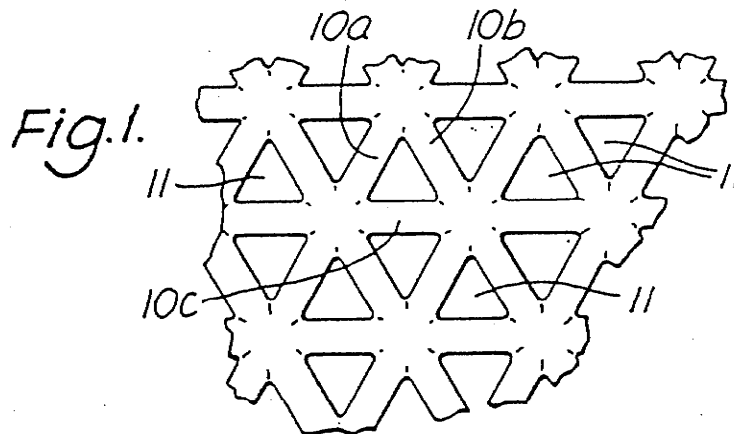
(52) UK CL (Edition K)
A3V V1A6D V5J

(56) Documents cited
US 3771170 A

(58) Field of search
UK CL (Edition K) A3V
INT CL³ A41B, A41D

(54) Material for clothing

(57) Material suitable for clothing which provides variable thermal insulation is formed from a plurality of interconnecting inflated tubes 10a, b, c defining, in an uninflated state, a plurality of air spaces 11 and, in an inflated state, a substantially closed configuration (Fig. 2). An article of clothing (12, Fig. 3) made from the material is connected to an inflation device (13). Inflation means may comprise frozen carbon dioxide or compressed air supplies, a hand pump or a blow-to-inflate arrangement. Deflation means in the form of a relief valve may be provided.



ANNEX B

European Patent Office
D-80298
Munich

Turney, Alan Trevor
A T Turney & Co
Staple Inn Building
High Holborn
London WC1V 7PZ
GRANDE BRETAGNE

Application No/Patent No. 98 308080.6-2214	Ref. PAT 97.015	Date: 22.10.99
Applicant/Proprietor: LONDON PUMPS PLC		

COMMUNICATION PURSUANT TO ARTICLE 96(2) AND RULE 51(2) EPC

The /further/ examination of the above-identified application has revealed that it does not meet the requirements of the European Patent Convention for the reasons enclosed herewith.
If the deficiencies indicated are not rectified the application may be refused pursuant to Article 97(1) EPC.

You are invited to file your observations and insofar as the deficiencies are such as to be rectifiable to correct the indicated deficiencies within a period

of 4 months

from the notification of this communication, this period being computed in accordance with Rules 78(3) and 83(2) and (4) EPC.

Amendments to the description, claims and drawings are to be filed where appropriate within the said period in three copies on separate sheets (Rule 36(1) EPC)

Failure to comply with this invitation in due time will result in the application being deemed to be withdrawn (Article 96(3) EPC).

K Conrad von Heydendorff
Primary Examiner
for the Examining Division

NOTE TO CANDIDATES: ENCLOSURE OMITTED

ANNEX C

European Patent Office

D-80298

Munich

Turney, Alan Trevor
A T Turney & Co
Staple Inn Building
High Holborn
London WC1V 7PZ
GRANDE BRETAGNE

Date:

24/03/00

Reference:

PAT 96.016

Application No/Patent No:

96307398. 7-2215 0978131

Applicant:

LONDON PUMPS PLC

DECISION TO GRANT A EUROPEAN PATENT PURSUANT TO ARTICLE 97(2) EPC

Following examination of European patent application No. 96307398. 7 a European patent with the title and the supporting documents indicated in the communication pursuant to Rule 51(4) EPC dated 12.07.99 is hereby granted in respect of the designated Contracting States. Any modifications which were subsequently requested have been approved by the Examining Division. Any corrections requested by the applicant after receipt of the communication under Rule 51(6) and received at the EPO on 00.00.00 have been taken into account.

Patent No.	: 0978131
Date of filing	: 12.08.96
Priority claimed	: 29.08.95 GB 9520071. 7
Designated Contracting States and Proprietors(s)	: DE-FR-GB-IT London Pumps plc Creekmouth Lane Barking London E12 5ET/GB

This decision will take effect on the date on which the European Patent Bulletin mentions the grant (Art. 97(4) and (5) EPC).

The mention of the grant will be published in European Patent Bulletin 00/16 of 20.04.00

Examining Division
WEBER V G E

La GIOIA C

JOHANSSON U C

FORM TITLE/SUBJECT

NP1	Entry to GB National Phase of PCT
1/77	Request for grant of a patent (Application Form)
2/77	Miscellaneous requests for exercise of jurisdiction
7/77	Statement of inventorship and right to grant of patent
8/77	Authorising release of micro-organism
8A/77	Notifying intention to restrict availability of micro-organism samples
9/77	Search and preliminary examination request
10/77	Request for substantive examination
11/77	Request for amendment before or after grant and correction of error or mistake
12/77	Renewal fee and/or fee for late payment of renewal
15/77	Various oppositions
16/77	Application to restore a patent
20/77	Request to alter a name on a Patent Application
21/77	To register or give notice of rights acquired in a Patent Application
23/77	Request for certificate or certified copy from a file OR Request for an uncertified copy from a file
28/77	Notification of availability of licence of right
30/77	Cancellation of an entry under Section 47(1)
49/77	Caveat
51/77	Appointment or change of agent
52/77	Request for extension of time under Rule 110
53/77	Additional fee on extension time under Rule 110(6) or on restoration
54/77	Filing translation of European Patent (UK) etc.
58/77	On declaration that licences of right do not extend to excepted uses

CALENDER

YEAR 1999

JANUARY					FEBRUARY					MARCH					APRIL							
M	4	11	18	25	M	1	8	15	22	M	1	8	15	22	29	M	5	12	19	26		
Tu	5	12	19	26	Tu	2	9	16	23	Tu	2	9	16	23	30	Tu	6	13	20	27		
W	6	13	20	27	W	3	10	17	24	W	3	10	17	24	31	W	7	14	21	28		
Th	7	14	21	28	Th	4	11	18	25	Th	4	11	18	25		Th	1	8	15	22	29	
F	1	8	15	22	29	F	5	12	19	26	F	5	12	19	26	F	2	9	16	23	30	
Sa	2	9	16	23	30	Sa	6	13	20	27	Sa	6	13	20	27	Sa	3	10	17	24		
Su	3	10	17	24	31	Su	7	14	21	28	Su	7	14	21	28	Su	4	11	18	25		
MAY					JUNE					JULY					AUGUST							
M	3	10	17	24	31	M	7	14	21	28	M	5	12	19	26	M	2	9	16	23	30	
Tu	4	11	18	25		Tu	1	8	15	22	29	Tu	6	13	20	27	Tu	3	10	17	24	31
W	5	12	19	26		W	2	9	16	23	30	W	7	14	21	28	W	4	11	18	25	
Th	6	13	20	27		Th	3	10	17	24		Th	1	8	15	22	Th	5	12	19	26	
F	7	14	21	28		F	4	11	18	25		F	2	9	16	23	F	6	13	20	27	
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Su	2	9	16	23	30	Su	6	13	20	27		Su	4	11	18	25	Su	1	8	15	22	29
SEPTEMBER					OCTOBER					NOVEMBER					DECEMBER							
M	6	13	20	27	M	4	11	18	25	M	1	8	15	22	29	M	6	13	20	27		
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W	1	8	15	22	29	W	6	13	20	27	W	3	10	17	24	W	1	8	15	22	29	
Th	2	9	16	23	30	Th	7	14	21	28	Th	4	11	18	25	Th	2	9	16	23	30	
F	3	10	17	24		F	1	8	15	22	29	F	5	12	19	26	F	3	10	17	24	31
Sa	4	11	18	25		Sa	2	9	16	23	30	Sa	6	13	20	27	Sa	4	11	18	25	
Su	5	12	19	26		Su	3	10	17	24	31	Su	7	14	21	28	Su	5	12	19	26	

YEAR 2000																							
JANUARY					FEBRUARY					MARCH					APRIL								
M	3	10	17	24	31	M	7	14	21	28	M	6	13	20	27	M	3	10	17	24			
Tu	4	11	18	25		Tu	1	8	15	22	29	Tu	7	14	21	28	Tu	4	11	18	25		
W	5	12	19	26		W	2	9	16	23		W	1	8	15	22	29	W	5	12	19	26	
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Sa	1	8	15	22	29	Sa	5	12	19	26		Sa	4	11	18	25		Sa	1	8	15	22	29
Su	2	9	16	23	30	Su	6	13	20	27		Su	5	12	19	26		Su	2	9	16	23	30
MAY					JUNE					JULY					AUGUST								
M	1	8	15	22	29	M	5	12	19	26	M	3	10	17	24	31	M	7	14	21	28		
Tu	2	9	16	23	30	Tu	6	13	20	27	Tu	4	11	18	25		Tu	1	8	15	22	29	
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Th	4	11	18	25		Th	1	8	15	22	29	Th	6	13	20	27	Th	3	10	17	24	31	
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Sa	6	13	20	27		Sa	3	10	17	24		Sa	1	8	15	22	29	Sa	5	12	19	26	
Su	7	14	21	28		Su	4	11	18	25		Su	2	9	16	23	30	Su	6	13	20	27	
SEPTEMBER					OCTOBER					NOVEMBER					DECEMBER								
M	4	11	18	25		M	2	9	16	23	30	M	6	13	20	27	M	4	11	18	25		
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Sa	2	9	16	23	30	Sa	7	14	21	28		Sa	4	11	18	25		Sa	2	9	16	23	30
Su	3	10	17	24		Su	1	8	15	22	29	Su	5	12	19	26		Su	3	10	17	24	31

YEAR 2001

JANUARY						FEBRUARY						MARCH						APRIL						
M	1	8	15	22	29	M	5	12	19	26	M	5	12	19	26	M	2	9	16	23	30			
Tu	2	9	16	23	30	Tu	6	13	20	27	Tu	6	13	20	27	Tu	3	10	17	24				
W	3	10	17	24	31	W	7	14	21	28	W	7	14	21	28	W	4	11	18	25				
Th	4	11	18	25		Th	1	8	15	22	Th	1	8	15	22	Th	5	12	19	26				
F	5	12	19	26		F	2	9	16	23	F	2	9	16	23	F	6	13	20	27				
Sa	6	13	20	27		Sa	3	10	17	24	Sa	3	10	17	24	Sa	7	14	21	28				
Su	7	14	21	28		Su	4	11	18	25	Su	4	11	18	25	Su	1	8	15	22	29			
MAY						JUNE						JULY						AUGUST						
M		7	14	21	28	M		4	11	18	25	M		2	9	16	23	30	M		6	13	20	27
Tu	1	8	15	22	29	Tu	5	12	19	26	Tu		3	10	17	24	31	Tu		7	14	21	28	
W	2	9	16	23	30	W	6	13	20	27	W		4	11	18	25	W	1	8	15	22	29		
Th	3	10	17	24	31	Th	7	14	21	28	Th		5	12	19	26	Th	2	9	16	23	30		
F	4	11	18	25		F	1	8	15	22	29	F		6	13	20	27	F	3	10	17	24	31	
Sa	5	12	19	26		Sa	2	9	16	23	30	Sa		7	14	21	28	Sa	4	11	18	25		
Su	6	13	20	27		Su	3	10	17	24		Su	1	8	15	22	29	Su	5	12	19	26		
SEPTEMBER						OCTOBER						NOVEMBER						DECEMBER						
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Sa	1	8	15	22	29	Sa	6	13	20	27		Sa	3	10	17	24		Sa	1	8	15	22	29	
Su	2	9	16	23	30	Su	7	14	21	28		Su	4	11	18	25		Su	2	9	16	23	30	

Bank and Public Holidays in England and Wales

	2000	2001
Bank holiday	January 3	January 1
Good Friday	April 21	April 13
Easter Monday	April 24	April 16
May Day holiday	May 1	May 7
Spring Bank Holiday	May 29	May 28
Summer Bank Holiday	August 28	August 27
Christmas Day	December 25	December 25
Boxing Day	December 26	December 26

MITTEILUNGEN DES EUROPÄISCHEN PATENTAMTS

Mitteilung des Präsidenten des Europäischen Patentamts vom 30. September 1999 über die Tage, an denen die Annahmestellen des EPA im Jahr 2000 geschlossen sind

1. Nach Regel 85(1) EPÜ erstrecken sich Fristen, die an einem Tag ablaufen, an dem zumindest eine Annahmestelle des EPA zur Entgegennahme von Schriftstücken nicht geöffnet ist (geschlossene Tage), auf den nächstfolgenden Tag, an dem alle Annahmestellen zur Entgegennahme von Schriftstücken geöffnet sind und an dem gewöhnliche Postsendungen zugestellt werden.

2. Die Annahmestellen des EPA in München, Den Haag und Berlin sind an allen Samstagen und Sonntagen zur Entgegennahme von Schriftstücken nicht geöffnet. Die weiteren geschlossenen Tage des Jahres 2000 werden in der nachfolgenden Übersicht bekanntgegeben.

INFORMATION FROM THE EUROPEAN PATENT OFFICE

Notice from the President of the European Patent Office dated 30 September 1999 concerning the days on which EPO filing offices are closed in 2000

1. Under Rule 85(1) EPC time limits expiring on a day on which at least one of the filing offices of the EPO is not open for receipt of documents (closing days) are extended until the first day thereafter on which all the filing offices are open for receipt of documents and on which ordinary mail is delivered.

2. The EPO's filing offices in Munich, The Hague and Berlin will be closed for the receipt of documents on every Saturday and Sunday. The other closing days in 2000 are listed below.

COMMUNICATIONS DE L'OFFICE EUROPEEN DES BREVETS

Communiqué du Président de l'Office européen des brevets, en date du 30 septembre 1999, relatif aux jours de fermeture des bureaux de réception de l'OEB en 2000

1. Conformément à la règle 85(1) CBE, les délais qui expirent un jour où l'un au moins des bureaux de réception de l'OEB n'est pas ouvert pour recevoir le dépôt des pièces (jours de fermeture) sont prorogés jusqu'au premier jour suivant où tous les bureaux de réception sont ouverts pour recevoir ce dépôt et où le courrier normal est distribué.

2. Les bureaux de réception de l'OEB à Munich, à La Haye et à Berlin ne seront ouverts ni le samedi, ni le dimanche, pour recevoir le dépôt des pièces. Les autres jours de fermeture au cours de l'année 2000 sont énumérés dans la liste ci-après.

Tage/Days/Jours		München Munich	Den Haag The Hague La Haye	Berlin
EPA geschlossen ¹ – EPO closed ² – OEB fermé ³	03.01.2000	x	x	x
EPA geschlossen ¹ – EPO closed ² – OEB fermé ³	04.01.2000	x	x	x
Heilige Drei Könige – Epiphany – Epiphanie	06.01.2000	x		
Karfreitag – Good Friday – Vendredi Saint	21.04.2000	x	x	x
Ostermontag – Easter Monday – Lundi de Pâques	24.04.2000	x	x	x
Maifeiertag – May Day – Fête du Travail	01.05.2000	x	x	x
Tag der Befreiung – Liberation Day – Journée de la Libération	05.05.2000		x	
Christi Himmelfahrt – Ascension Day – Ascension	01.06.2000	x	x	x
Pfingstmontag – Whit Monday – Lundi de Pentecôte	12.06.2000	x	x	x
Fronleichnam – Corpus Christi – Fête-Dieu	22.06.2000	x		
Mariä Himmelfahrt – Assumption Day – Assomption	15.08.2000	x		
Tag der Deutschen Einheit – Day of German Unity – Fête Nationale	03.10.2000	x		x
Allerheiligen – All Saints' Day – Toussaint	01.11.2000	x		
1. Weihnachtstag – Christmas Day – Noël	25.12.2000	x	x	x
2. Weihnachtstag – Boxing Day – Lendemain de Noël	26.12.2000	x	x	x

¹ Siehe ABl. EPA 1999, 572.

² See OJ EPO 1999, 572.

³ Cf. JO OEB 1999, 572.