

PATENT ADMINISTRATORS - EXAMINATION

5 April 2001

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. The Paper contains 5 sheets plus Annexes A, B and C and Form 1/77
6. A UK diary and list of UK bank holiday dates in 2001 and 2002 is provided, together with dates on which the European Patent Office branch offices are closed
← not enclosed
7. Additional Forms 1/77 are available from the invigilators

1. Your employer, Jennifer Case, for whom you work has sent you the memorandum at Annex A.
 - a. Please complete the Patents Form 1/77 provided. *(7 marks)*
 - b. For each item which you have listed in Section 10 of Patents Form 1/77 what would be the normal deadline for filing – if it was not to be filed with the application? *(4 marks)*
2. Assuming that you have met all the formal requirements to enable the application mentioned in question 1 to proceed, what dates would you expect to have to diary (and roughly when) in the next 18 months, to ensure that to case proceeds smoothly. *(4 marks)*
3. You are preparing bills for clients in respect of a new European Patent Application.

The bills each include charges for the following:

Professional time
Typing, photocopying etc.
Official Fees

On which items (if any) should 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 the Irish Republic registered for VAT? *(1 mark)*
 - c. If the bill is sent to a client in the USA? *(1 mark)*
4. You note in reviewing your database of UK applications, that instruction from clients had not been received in three cases. As a result actions were overdue:

Case A: A request for preliminary examination (Form 9/77) had not been filed when due on 5 March 2001.

Case B: A request for substantive examination (Form 10/77) had not been filed when due on 15 January 2001.

Case C: An official action dated 9 May 2000 on an application filed on 14 June 1996 had not been answered within the 2 month period allowed.

The clients today instruct you to complete the overdue actions (including payment of all necessary fees).

In each case what, if anything, can be done? Note any relevant deadlines. *Case A: (3 marks)*
Case B: (3 marks)
Case C: (3 marks)

5. The attorney for whom you work has been asked to file an English translation of a European Patent granted in German. Details are below:

Application No: 96107561.9
Priority date – 14 October 1995
Filing date - 10 October 1996
Rule 51(4) date - 6 February 2000
Rule 51(6) date - 10 August 2000
Mention of Grant in Official Bulletin - 4 April 2001

- a. What action is required by when to file the English translation, and where should it be filed? *(4 marks)*
- b. By when is the next renewal fee payable in respect of the UK designation, for which year is it and to whom is it payable? *(3 marks)*
- c. When will this patent expire assuming all renewal fees are paid? *(1 mark)*
6. Two of the following are not reviewed as part of the preliminary examination of a patent application.

Spelling
Margins
Reproducibility of drawings
Presence of Form 7/77
Nationality of applicants.

Which are they? *(2 marks)*

7. You have been asked to draft a letter to advise a foreign associate on how formally to register assignment of UK patents. The client does not want copies of the assignment to be filed. What would you recommend? *(2 marks)*
8. Within what period should an exclusive licence under a UK patent be recorded on the patent register if the exclusive licensee 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 13 March 2001, 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? If so indicate when the first fee is due, the frequency of payment and when renewal fees cease:
- a. A pending PCT application
 - b. A pending European patent application filed direct at the EPO
 - c. A pending UK patent application *(6 marks)*
11. a. What are designation fees in connection with a European application today and are they limited in any way? *(3 marks)*
- b. By when should designation fees be paid? *(2 marks)*
- c. If a designation fee is not paid in time, what happens next and what can be done to retrieve the situation? *(3 marks)*
12. a. You have just received a notice under Rule 51(6) that the European Patent Office intends to grant a European Patent Application containing 7 claims. What two things must be done within the time limit set out in the notice. *(2 marks)*
- b. Would it make any difference to your answer to a. if the notice under Rule 51(6) indicates that the Application contains 13 claims, the number of claims having increased from 7 to 13 during prosecution. *(2 marks)*
13. The EPO has sent the letter at Annex B:
- a. By what date should a response have been filed at the EPO? *(1 mark)*
 - b. Explain exactly why you chose that date *(2 marks)*
 - c. If the reply was not ready for that date, what could have been done to avoid difficulty, and what would the new deadline have been? *(5 marks)*
 - d. Assuming no action had been taken under c. how can the situation still be recovered? *(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. A new PCT application for a UK client to be filed on 10 April 2001 claims no priority and is made up as follows:

- description 30 sheets
- claims (26 claims) 3 sheets
- abstract 1 sheet
- drawings (2 figures) 1 sheet
- request 5 sheets

The applicant wishes to designate 10 countries:

What fees will have to be paid in respect of this application? When are they due? (Please note fees even if they are not payable immediately)

(7 marks)

16. You have just received a filing receipt for a new PCT Application filed on 30 March 2001 claiming priority from a UK Application filed on 31 March 2000. 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]

17. a. What is a trade mark? *(2 marks)*
- b. An unregistered design right? *(2 marks)*
18. What do you understand by the expression “duty of care”? *(2 marks)*
19. What two things might be done in an application for a registered design to distinguish the new features? *(2 marks)*
20. a. When are renewal fees payable on design registrations? *(2 marks)*
- b. What is the maximum life of a registered design (assuming renewals are paid)? *(1 mark)*

ANNEX A

Jennifer Case & Co
Oak House
Lime Street
Liverpool L1 6NL

Tel: 0151 667 7000
Fax: 0151 667 7100
E-mail: jennifer@case.co.uk

5 April 2001

To: The Candidate

PROPOSED NEW APPLICATION BASED ON - REF: JC4161 GB
UK PATENT APPLICATION 010215.7 - REF: JC4161 AA
FILED 11 APRIL 2000

I have just received our clients instructions on this case. The client has asked for a new UK application to be filed claiming priority from the first application. All the key information, including the applicant and the priority claim, is on the attached information sheet (Appendix 1) which is correct. I sent the final draft of the new specification to the client on 1 March and he has approved the text and wants us to proceed immediately. At this stage the client wishes only to receive the results of the search and preliminary examination.

Please:

1. prepare an Application Form (Patents Form 1/77) for the new application for my signature today.
2. indicate on the application form which other forms or other documents are needed to be filed to ensure the application is published and priority is preserved – [do not fill in these forms but assume that they will all be ready for filing].

[Note: A list of all current forms is provided at Appendix 2]

JENNIFER CASE

**ANNEX A
APPENDIX 1**

CASE 4161 – AGENT JC

Client: Smokey River Products Ltd
High Road
Ormskirk
Lancashire L40 2BX

Title of Invention: Method of curing pork and like meat products

Inventor: Technical Director
Peter Rabbit
175 Low Ridge Road
Stanlow
Cheshire CH62 4AL

UK 1st Application: 010215.7

Filed: 11 April 2000

Claims: Not filed

Drawings: 4 sheets (hand drawn)

Specification: 9 pages

Abstract: Not filed

Priority Claim: None

Forms and Documents filed: 1/77 with application

UK 2nd Application: [to be filed]

Claims: 7

Drawings: 4 sheets (hand drawn)

Specification: 9 pages

Abstract: 1 page

Priority Claim: 010215.7 dated 11 April 2000

Forms and documents filed: [to be filed]

Overseas Application: Client requests UK only

**ANNEX A
APPENDIX 2**

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

European Patent Office

D-80298

Munich

Jennifer Case & Co
Oak House
Lime Street
Liverpool L1 6NL
GRANDE BRETAGNE

Application No/Patent No. 99 301086.6-2214	Ref. JC 3000	Date: 22.10.00
Applicant/Proprietor: SMOKEY RIVER PRODUCTS LTD		

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).

L von Beethoven
Primary Examiner
for the Examining Division

NOTE TO CANDIDATES: ENCLOSURE OMITTED

European Patent Office

D-80298

Munich

Jennifer Case & Co
Oak House
Lime Street
Liverpool L1 6NL
GRANDE BRETAGNE

Date:

29/03/01

Reference: JC 1414	Application No/Patent No: 97301611. 4-2203 0901422
Applicant: SMOKEY RIVER PRODUCTS LTD	

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

Following examination of European patent application No. 97301611. 4 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 21.02.01 have been taken into account.

Patent No. : 0901422
Date of filing : 12.08.97
Priority claimed : 29.08.96 GB 9619269.0
Designated Contracting States
and Proprietors(s) : DE-FR-GB-IT
Smokey River Products Ltd
High Road
Ormskirk
Lancashire L40 2BX/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 01/16 of 26.04.01

Examining Division
PALMERES J M K

BASTIA M G

MAGNUSSON G F

Candidate Number

Request for grant of a patent

(See the notes on the back of this form. You can also get an explanatory leaflet from the Patent Office to help you fill in this form)

The Patent Office

Cardiff Road Newport Gwent NP9 1RH

1. Your reference

2. Patent application number (The Patent Office will fill in this part)

3. Full name, address and postcode of the or of each applicant (underline all surnames)

Patents ADP number (if you know it)

If the applicant is a corporate body, give the country/state of its incorporation

4. Title of the invention

5. Name of your agent (if you have one)

"Address for service" in the United Kingdom to which all correspondence should be sent (including the postcode)

Patents ADP number (if you know it)

6. If you are declaring priority from one or more earlier patent applications, give the country and the date of filing of the or of each of these earlier applications and (if you know it) the or each application number

7. If this application is divided or otherwise derived from an earlier UK application, give the number and the filing date of the earlier application

8. Is a statement of inventorship and of right if to grant of a patent required in support of this request? (Answer 'Yes' if: a) any applicant named in part 3 is not an inventor, or b) there is an inventor who is not named as an applicant, or c) any named applicant is a corporate body. See note (d))

Patents Form 1/77

9. Enter the number of sheets for any of the following items you are filing with this form. Do not count copies of the same document

Continuation sheets of this form

Description

Claim(s)

Abstract

Drawing(s)

10. If you are also filing any of the following, state how many against each item.

Priority documents

Translations of priority documents

Statement of inventorship and right to grant of a patent (*Patents Form 7/77*)

Request for preliminary examination and search (*Patents Form 9/77*)

Request for substantive examination (*Patents Form 10/77*)

Any other documents
(*please specify*)

11. I / We request the grant of a patent on the basis of this application.

Signature

12. Name and daytime telephone number of person to contact in the United Kingdom
-

Warning

After an application for a patent has been filed, the Comptroller of the Patent Office will consider whether publication or communication of the invention should be prohibited or restricted under Section 22 of the Patents Act 1977. You will be informed if it is necessary to prohibit or restrict your invention in this way. Furthermore, if you live in the United Kingdom, Section 23 of the Patents Act 1977 stops you from applying for a patent abroad without first getting written permission from the Patent Office unless an application has been filed at least 6 weeks beforehand in the United Kingdom for a patent of the same invention and either no direction prohibiting publication or communication has been given, or any such direction has been revoked.

Notes

- a) *If you need help to fill in this form or have any questions, please contact the Patent Office on 0645 500505.*
- b) *Write your answers in capital letters using black ink or you may type them.*
- c) *If there is not enough space for all the relevant details on any part of this form, please continue on a separate sheet of paper and write "see continuation sheet" in the relevant part(s). Any continuation sheet should be attached to this form.*
- d) *If you have attached 'Yes' Patents Form 7/77 will need to be filed.*
- e) *Once you have filled in the form you must remember to sign and date it.*
- f) *For details of the fee and ways to pay please contact the Patent Office.*

**EUROPEAN PATENT OFFICE – CLOSED DAYS 2001
(FROM OFFICIAL JOURNAL 1/2001)**

New Year	1 January
Epiphany	6 January
Good Friday	13 April
Easter Monday	16 April
Holiday	30 April (Den Haag only)
May Day	1 May
Ascension Day	25 May
Whit Monday	6 June
Corpus Christi	14 June (only Munich)
Assumption Day	15 August (only Munich)
Holiday	3 October (Berlin and Munich only)
All Saints Day	1 November (only Munich)
Christmas Eve	24 December
Christmas Day	25 December
Boxing Day	26 December
New Year's Eve	31 December
All Saturdays and Sundays	