

FINAL EXAMINATION

PATENT ADMINISTRATORS - EXAMINATION

8 May 2003

Reading Time: 2.00 p.m. – 2.15 p.m.

Writing Time: 2.15 p.m. – 5.15 p.m.

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 2003 and 2004 is provided, together with a reproduction of a European Patent Office notice indicating the dates in 2003 on which the branch offices are closed
6. A list of current UK Forms is provided
7. The Paper contains 5 sheets plus Annexes A and B
8. Additional blank forms for Question 1 are available from the invigilators
9. Please ensure your candidate number is written on each page of your answer and the Patents Form. Please do not write your name on the answer sheets
10. At the end of the exam please ensure that your answer papers are placed in the envelope provided and sealed

FINAL EXAMINATION

1. The Patent Attorney, Amber Glow, for whom you work has sent you the memorandum at Annex A.

Please complete the PCT request form as instructed to enable the application to be made. *Note: box VIII is not part of the question and should be omitted.*

(7 marks)

2. Assuming the PCT application in question 1 is filed today (8 May 2003) what fees would need to be paid within the next 16 months, and by when? (the amount of each fee is not required)

(9 marks)

3. a. The PCT application to be filed in question 1, to which Patent Office should the International Preliminary Examination (IPE) Demand be sent?

(1 mark)

b. Assuming the PCT application eventually enters the European regional phase, by how much would the full examination fee be reduced as a result of the IPE being carried out by the Patent Office mentioned in a.

(1 mark)

4. You are preparing a bill for filing a UK application, made up as follows:

Professional time:	£900
Typing, photocopying etc:	£100
Fee for form 9/77:	£130

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

- a. If the bill is sent to a UK client?
- b. If the bill is sent to an established client in Luxembourg registered for VAT?
- c. If the bill is sent to a client in USA?

(1 mark)

(1 mark)

(1 mark)

5. A new patent application (without a priority claim) was filed on 6 May 2003 for your firm's UK client, North Wiltshire Electric Ltd. The application comprised form 1/77, a description and hand drawn sketches only. Make a list of the further documents you would need to file and by what dates in order that the application can proceed to publication. Ignore possible extensions of time.

(10 marks)

6. 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 £40,000 a year in royalties from the patent. What action might the client take?

(2 marks)

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7. Amber Glow, the Patent attorney for whom you work, has been asked to act as attorney for the UK aspects of a European Patent prosecuted in French. Details are below:

Application No: 99116225.7
Priority date: 14 October 1997
Filing date - 13 October 1998
Rule 51(4) date - 17 October 2002

Mention of Grant in Official Bulletin - 3 April 2003
The designations include GB.

- a. What needs to be filed where and by when to ensure the patent is effective in the UK, note any forms needed? Ignore any extensions. (4 marks)
- b. By when is the next renewal fee payable in respect of the GB designation and to whom is it payable? (2 marks)
- c. When will this patent expire? (1 mark)
8. You note in reviewing your database of UK applications that instructions from a client had not been received in three cases. As a result the following actions are overdue:

In Case A: A request for preliminary examination and search (Form 9/77) had not been filed when due on 14 April 2003. (4 marks)

In Case B: A renewal fee had not been paid when due on 15 January 2003. (2 marks)

In Case C: An official action dated 9 May 2002 on an application filed on 16 March 1999 had not been answered within the 2 month period allowed. The application had no priority claim. (3 marks)

The client instructs you today (8 May) to complete the overdue actions (including payment of all necessary fees).

In each case what, if anything, can be done? Note any relevant deadlines.

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9. Two of the following are not reviewed as part of the preliminary examination of a UK patent application.
- A. Spelling
 - B. Margins
 - C. Reproducibility of drawings
 - D. Presence of Form 7/77
 - E. Clarity of English
- Which are they? *(2 marks)*
10. You have been asked to arrange the recording of the assignment of a UK patent in the UK Patent Register. The client does not want any part of the assignment to be filed. How would you proceed? *(2 marks)*
11. 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 the renewal fees cease).
- a. A pending PCT application *(1 mark)*
 - b. A pending European patent application *(5 marks)*
 - c. A pending UK patent application *(1 mark)*
12. a. What is the basis for calculating the claims fees on a new European Patent Application? *(2 marks)*
- b. For a new European Patent Application by when should the filing fees, search fees and claim fees (if any) be paid. *(2 marks)*
- c. If the filing fee is not paid in time, what will happen next, could you save the application? *(3 marks)*
13. A European Patent Application was filed on 11 September 2002 having a priority date 12 months earlier. The mention of publication of the application with the search report (the A1 publication) in the European Patent bulletin was on 3 April 2003. The Application designates France, Germany and the United Kingdom:
- a. What actions must be taken next and what is/are the latest date by which these can be completed without surcharge? *(3 marks)*
 - b. Why did you choose the date given in the answer? *(2 marks)*
 - c. Would any fee payable be different if all European Patent Convention contracting states are designated? Explain your answer *(2 marks)*

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14. a. You have just received a notice under Rule 51(4) that the European Patent Office intends to grant a European Patent Application (in English) containing 7 claims. What two things must be done within the time limit set out in the notice if the application is to proceed to grants unchanged? *(2marks)*
- b. Would it make any difference to your answer to a. if the notice under Rule 51(4) indicates that the Application contains 13 claims, the number of claims having increased from 7 to 13 during prosecution. *(2 marks)*
15. The EPO has sent the letter at Annex B which was received in your office on the 6th January 2003:
- a. On which date should the reply to the letter be received by the EPO? Explain your answer. *(2 mark)*
- b. The reply will not ready in time, what can be done now to avoid difficulty, and extra costs to your client, and what will the new deadline be? *(4 marks)*
16. A deadline for answering an official action from the European Patent Office was 30 April 2003. No instructions were received from the client. What will happen next, could the case be saved, if so, how? *(5 marks)*
17. You plan to file a UK application claiming priority from an earlier UK application filed on 26 May 2002. What are the minimum requirements of rule 6(1) to ensure that the priority is properly claimed? *(2 marks)*
18. Your office filed a PCT application on 10 March 2002. It claims priority from a UK application filed on 23 March 2001. Your client wishes to enter the US national and European regional phases.
- What is the final deadline to ensure that the US national and European regional phases are entered in time? *(2 marks)*
19. a. In Section 1B of the Registered Designs Act 1949, what two characteristics should a design have to be registerable? *(2 marks)*
- b. What three things comprise the minimum requirements for a valid application for a design registration? *(3 marks)*
20. a. When is the first renewal fee payable for a design registration? *(1 mark)*
- b. What is the maximum life of a registered design (assuming renewals are paid)? *(1 mark)*

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ANNEX A

Amber Glow & Co
49 High Street
Malmesbury
WILTSHIRE SN7 4NQ

8 May 2003

Tel: 01666 900700
Fax: 01666 900800
E-mail: amber@glow.com

To: **The Candidate from Amber Glow**

PROPOSED PCT APPLICATION - REF: 03.097 PCT

Our client, North Wiltshire Electric Ltd, has given me instructions to file in its name (if possible) new PCT application. Unusually, they want the application filed without first filing a UK application. The applicant wants to designate all PCT countries (including the US) specifically listed on the current PCT Request Form.

For question 1, please prepare a PCT Request Form today for my signature. I will sign the form as agent for the applicants. Any necessary Powers of Attorney will be submitted later, also, we will pay the fees at the last possible moment. Key information that you will need is:

Client: North Wiltshire Electric Ltd
12 Bank Street
TETBURY
Gloucestershire
SN15 4AL
United Kingdom
(A Company incorporated in England and Wales)

Inventor: John Edward RENNIE
37 Compton Close
SWINDON
SN1 7QQ
United Kingdom
(A British subject)

Title of Invention: Dust Monitor

Priority Claim: None

No of sheets of specification: 30

No of sheets of drawings: 2 (Figure 1 should accompany the abstract)

No of sheets of claims: 2 (20 claims)

No of sheets of abstract: 1

Note: boxes VIII of the PCT application form and the fee calculation sheet are not part of the question and are omitted.

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ANNEX B

European Patent Office

D-80298
Munich

Amber Glow & Co
49 High Street
Malmesbury
Wiltshire
SN7 4NQ

Application No/Patent No. 0230219.6 2301	Ref. 02.076EP	Date: 03.01.03
Applicant/Proprietor: NORTH WILTSHIRE ELECTRIC 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).

D.R. Beckham
Primary Examiner
for the Examining Division

NOTE TO CANDIDATES: ENCLOSURE OMITTED

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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

DIARY 2003

JANUARY						
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Bank Holidays and Public Holidays in England and Wales 2003

January 1
 April 18
 April 21

May 5
 May 26
 August 27

December 25
 December 26

DIARY 2004

JANUARY						
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27	28	29	30	31		

Bank Holidays and Public Holidays in England and Wales 2004

January 1

May 3

April 9

May 31

December 25

April 12

August 30

December 26

EUROPEAN PATENT OFFICE

Under Rule 85(1), 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 on which all the filing offices are open for receipt of documents and on which ordinary mail is delivered.

DAYS		Munich	The Hague	Berlin
New Years Day	1 January 2003	x	x	x
Epiphany	6 January 2003	x		
Good Friday	18 April 2003	x	x	x
Easter Monday	21 April 2003	x	x	x
National Holiday	30 April 2003		x	
May Day	1 May 2003	x	x	x
Liberation Day	5 May 2003		x	
Ascension Day	29 May 2003	x	x	x
Whit Monday	9 June 2003	x	x	x
Corpus Christi	19 June 2003	x		
Assumption Day	15 August 2003	x		
Day of German Unity	3 October 2003	x		x
Christmas Eve	24 December 2003	x	x	x
Christmas Day	25 December 2003	x	x	x
Boxing Day	26 December 2003	x	x	x
New Years Eve	31 December 2003	x	x	x