PATENT ADMINISTRATORS COURSE 2006/7 FINAL EXAMINATION

Thursday 26th April 2007

Exam Starts: 2.00pm UK Time Reading Time: 2.00 pm – 2.15 pm Writing Time: 2.15 pm – 5.15 pm

- 1. This is a three-hour Paper with an additional 15 minutes for reading only.
- 2. You should attempt all questions.
- 3. The number of marks allotted to each question is indicated on the paper.
- 4. Please write clearly, as it is difficult to award marks to illegible answers.
- 5. The paper consists of 5 pages of questions plus Annexes 1 of one page and Annex 2 of one page.
- 6. In addition, you are provided with:
 - A blank Form PCT/RO/101 with completed fee calculation sheet
 - A 2007 Calendar
 - A reproduction of the EPO notice indicating the dates in 2007 on which the branch offices are closed.
- 7. Additional blank Forms PCT/RO/101 are available from the invigilators.
- 8. Please ensure your candidate number is written on each page of your answers and any forms submitted. Please do NOT write your name on the answer sheets.
- **9.** At the end of the exam please ensure that your answer papers are placed in **the brown envelope with only your candidate number on** and sealed.

Page 1 of 5

1.	Please see attached Annex 1 and Annex 2, and follow the instructions provided.
	(20 marks)
2.	What fees must be paid on filing an International Application and when? What is the procedure if the fees are not paid in time? (5 marks)
3.	You filed a PCT application at the UK Patent Office on 3 November 2006. You claimed a priority date of 4 November 2005. You have received Form PCT/ISA/200 dated 12 March 2007.
(a)	What form must you file to request International Preliminary Examination? (1 mark)
(b)	What is the latest date on which you may file this Form? Explain how you calculate this due date.
	(3 marks)
(c)	What fees must be paid for International Preliminary Examination and when are they due?
	(6 marks) (10 marks in total)
4.	Who issues the following:
(a)	IPRP Chapter I (1 mark)
(b)	IPRP Chapter II (1 mark) (2 marks in total)
5.	You filed a PCT Application on 22 nd September 2005, claiming priority from a UK Patent Application dated 29 th September 2004. What is the deadline for entry into the regional phase in Europe? Please calculate the date. (3 marks)

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6. Today your client instructs you to enter its PCT application into the European regional phase, eventually wishing to obtain protection in:

DE ES FR GB HR IE IT MK NL PT SE SI SK.

Which fee(s) need to be paid specifically to maintain protection in these countries at the European regional phase entry stage? (Monetary amounts of the fee(s) are not required in your answer).

(3 marks)

- 7. In general, when is the examination fee due on an EP(PCT) application? (2 marks)
- 8. Your office receives from the EPO a Communication pursuant to Article 96(2) and Rule 51(2) a substantive examination report dated 27 December 2006. The term for response is stated to be 4 months from notification of the communication.
- (a) What is the last date that a response may be filed within the existing term?

 (3 marks)
- (b) Your patent attorney tells you that he will be unable to prepare a response before the due date. What action should you take?

 (3 marks)
- (c) If no action is taken, what will happen next, and how can the situation be rectified?

(6 marks) (12 marks in total)

9. You have received a communication from the European Patent Office under Rule 51(4) in relation to your European Patent Application dated 12th March 2004 claiming priority from a UK Patent Application dated 20th March 2003, informing you of the text in which the EPO intends to grant the Patent. The contracting states are AT, BE, CH, CY, DE, DK, ES FI, FR, GB, GR, IE, IT, LU, MC, NL, PT, SE, TR.

What types of fees are now payable to the EPO and what documents must be filed?

(4 marks)

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- 10. Referring to the EP application in Question 9, you have now received the Decision to Grant Form 2006 from the EPO and mention of grant will be published in the European Bulletin on 19th June 2007.
- (a) By when must the national phase be entered in Ireland?

(2 marks)

(b) When is the next renewal fee due in the Irish national phase and to whom should it be paid?

(2 marks)

(c) What other time limit runs from the publication of the mention of the grant of a European Patent?

(1 mark) (5 marks in total)

11. On 2nd April 2007 a UK patent application is filed relying for its technical content on a reference to a regular (i.e. non-provisional) US utility patent application filed on 3rd April 2006. The US filing date is the only priority date claimed in the UK application.

Excluding official forms, and ignoring any extensions of time that may be available, which application documents must be filed, and by which dates, in order to maintain the UK application?

(5 marks)

- 12. A UK patent application is filed on 30th April 2004, with an earliest claimed priority of 2nd May 2003. Without any requests for extension of time:
- (a) On which date does the "acceptance period" expire, if the first substantive examination report was sent on 2nd November 2005, and (1 mark)
- (b) On which date does the acceptance period expire, if the first substantive examination report was sent on 4th December 2006?

(1 mark) (2 marks in total)

13. What extensions of time are available for the acceptance periods mentioned in Question 12? Outline the requirements and procedures for obtaining them.

(4 marks)

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14. (a)	When is the first renewal fee due on a UK Registered Design?	(1 mark)
(b)	What is the maximum term of a UK Registered Design? (2 marks)	(1 mark) s in total)
15. (a)	What do you understand by the term "grace period" in the cor UK Registered Designs?	itext of 2 marks)
(b)	•	1 mark) ss in total)
16.	Which three of the following statements are true? A trade mark must be a word A trade mark must be a sign A trade mark must be novel A trade mark must be a logo A trade mark must be capable of being graphically represented A trade mark must be distinctive	(3 marks)
17.	You are filing a new British Patent Application naming three invento many copies of PF 7/77 Statement of Inventorship and of Right to G Patent are required if the application claims priority from:-	
(a) (b)	An earlier GB patent application; An earlier US application? Explain your reasoning.	(3 marks)
18.	What supporting material is required to register (record) a change o ownership of a British patent at UKIPO?	f (3 marks)

Page 5 of 5

19.	The invoices each include charges for the following items:
	Professional time (PT) Typing, copying etc (TC) Official Fees (OF)
	On which of the above items (PT), (TC) and (OF) should VAT at 17.5% be charged:
(a) (b) (c) (d)	If the bill is sent to a UK client? If the bill is sent to a client in the Irish Republic who is not registered for VAT? If the bill is sent to a client in Germany who is registered for VAT? If the bill is sent to a client in Japan? (4 marks)
	(4 marks)
20.	Fill in the most appropriate words and phrases from the list below:
(a)	A breach of may constitute a commission of the tort of
	Choose from the following: Confidence, contract, duty of care, dispute, damage, negligence, theft, infringement.
	(3 marks)
(b)	List TWO examples of what should be required to be in place in a firm of patent attorneys handling European patent applications in order to provide a competent service and to enable recovery of rights if a mistake is made. (2 marks) (5 marks in total)

ANNEX 1

DRAFT & HUGHFEE INTERNAL MEMO Tel 0207 405 3214 Fax 0207 405 4123

Date: 20th April 2007

Case: UN/46

Please prepare the PCT request form PCT/RO/101 for a new PCT application for our client The University of Neasden. A copy of the client's letter of instructions is attached.

I have drafted the description (42 pages), the claims (4 Pages) and abstract (1 Page). There are ten sheets of drawings. I propose that Figure 4 should accompany the abstract.

Details of the inventors are contained in the client's letter.

The fee sheet will be prepared by the accounts department and added to the application papers.

The declaration pages in the request form will not be completed and have been removed.

The application is to be filed at the UK Patent Office with fees paid from our deposit account No D12345.

ACS

ANNEX 2

The University of Neasden

Dollis Hill Campus London N73 1RL

Tel: 0207 547 9823 Fax: 0207 547 9825

19 April 2007

Arthur Charles Smart Draft & Hughfee Patent Attorneys 7 Chancery Court London WC1 1BB

Dear Mr Smart,

We have now decided to go ahead with a PCT application directed to our new invention – "A Plasma Torch" – which we discussed with you recently. Priority is to be claimed from our UK Patent Application No. 0608739.3, which was filed on 23 May last year.

All possible countries are to be designated.

The inventors are:

Professor Ivan Idea 25 The Sidings Crewe Cheshire CR61 8QR British Nationality Mlle Elizabeth Fromage Flat 6A, George Mansions 106 Water Street

Neasden London N73 6RQ

French Nationality

We would like you to act as out agent in connection with this application.

Yours sincerely,

P. Strobes
Director of University Administration

PCT

REQUEST

The undersigned requests that the present

inte accord	ernational ap ling to the P	pplication be proces atent Cooperation	ssed Freaty.	Name of receivi	ng Offi	ce and "PCT Inte	ernational Application"		
				Applicant's or a (if desired) (12 o	's or agent's file reference () (12 characters maximum)				
Box No. I	TITLE OI	FINVENTION							
Box No. II	APPLICA	NT	This person	n is also inventor					
The address m	ist include posto	name followed by given al code and name of coun at is, country) of residenc	itry. The country of t	he address indicated	l in this	Telephone No.			
						Facsimile No.			
						Applicant's regi	stration No. with the Office		
State (that is,	country) of n	ationality:		State (that is, c	ountry)	of residence:			
This person if for the purpor		all designated States	all designate the United S	d States except tates of America		the United States of America only	the States indicated in the Supplemental Box		
Box No. III	FURTHE	R APPLICANT(S)	AND/OR (FURT	HER) INVENTO	OR(S)				
Further	r applicants a	nd/or (further) invent	ors are indicated o	on a continuation	sheet.				
Box No. IV	AGENT C	R COMMON REP	RESENTATIVE	; OR ADDRES	s for	CORRESPONI	DENCE		
The person io	dentified belo ant(s) before t	w is hereby/has been the competent Interna	appointed to act of actional Authorities	on behalf as:		agent	common representative		
Name and ad	dress: (Family The ada	name followed by given bress must include posta	name; for a legal ent I code and name of	ity, full official desig country.)	nation.	Telephone No.			
						Facsimile No.			
						Agent's registra	tion No. with the Office		
Addre space a	ss for corresp above is used	pondence: Mark this instead to indicate a	check-box where special address to	no agent or com which correspon	non rep dence s	oresentative is/has should be sent.	s been appointed and the		

Sheet	No				

Box No. III FURTHER APPLICANT(S) AND/OR (FURTHER) INVENTOR(S) If none of the following sub-boxes is used, this sheet should not be included in the request.							
Name and address: (Family name followed by given name; for a legal entit The address must include postal code and name of country. The country of the Box is the applicant's State (that is, country) of residence if no State of residen	e address indicated in this	This person is: applicant only applicant and inventor inventor only (If this check-box is marked, do not fill in below.) Applicant's registration No. with the Office					
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This person is applicant all designated for the purposes of:	States except tes of America	the United States the States indicated in the Supplemental Box					
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This person is applicant all designated for the purposes of:		the United States the States indicated in the Supplemental Box					
Further applicants and/or (further) inventors are indicated or	another continuation s	sheet.					

	Sheet N	lo						
Box No. V DESIGNATION	S							
The filing of this request constitution filing date, for the grant of every However,								
DE Germany is not design	ated for any kind of national p	rotection						
JP Japan is not designated	for any kind of national protec	ction						
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Box No. VI PRIORITY CLA	IM							
The priority of the following earli	er application(s) is hereby clai	med:						
Filing date	Number	Whe	ere earlier application is	s:				
of earlier application (day/month/year)	of earlier application	national application: country or Member of WTO	regional application: regional Office	international application: receiving Office				
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item (3)								
Further priority claims are in	dicated in the Supplemental B	ox.	<u> </u>	<u></u>				
Transmit certified copy: the recearlier application(s) (only if the is the receiving Office) identified	earlier application was filed w							
	tem (1) item (2)	item (3)	other, see Supp	lemental Box				
Restore the right of priority: the above or in the Supplemental Box information must be provided to	as item(s) (application(s) identified to Box No. VI; further				
Incorporation by reference: which description, claims or drawing completely contained in an earlied Article 11(1)(iii) were first receincorporated by reference in this	ngs referred to in Rule 20.5(a er application whose priority ived by the receiving Office.	 is not otherwise cor is claimed on the date that element or part 	ntained in this internat on which one or more is, subject to confirm	tional application but is elements referred to in				
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Box No. VIII DECLARATION	IS							
The following declarations are c check-boxes below and indicate in				Number of declarations				
	claration as to the identity of the		,	:				
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Box No. VIII (iii) D	eclaration as to the applicant's te, to claim the priority of the	s entitlement, as at the	international filing					
Box No. VIII (iv) Do	eclaration of inventorship (only nited States of America)	**	e designation of the					
	med States of America)	disclosures or exception	ons to lack of novelty	•				

Box No. IX CHECK LIST; LANGUAGE OF FILING							
This international application contains: (a) on paper, the following number of sheets: request (including declaration and	This international application is accompanied by the following item(s) (mark the applicable check-boxes below and indicate in right column the number of each item): 1. fee calculation sheet 2. original separate power of attorney	Number of items :					
supplemental sheets) : description (excluding	 3. original general power of attorney 4. copy of general power of attorney; reference number, 	:					
sequence listing and/or tables related thereto) : claims :	if any:	:					
abstract :	6. priority document(s) identified in Box No. VI as	•					
drawings :	item(s):	:					
Sub-total number of sheets: 0	7. Translation of international application into (language):	:					
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Figure of the drawings which should accompany the abstract:	Language of filing of the international application:						
Box No. X SIGNATURE OF APPLICAN' Next to each signature, indicate the name of the person signature.	T, AGENT OR COMMON REPRESENTATIVE ning and the capacity in which the person signs (if such capacity is not obvious fre	om reading the request).					
Date of actual receipt of the purported international application:	For receiving Office use only	2. Drawings:					
Corrected date of actual receipt due to later l timely received papers or drawings completi the purported international application:		received:					
Date of timely receipt of the required corrections under PCT Article 11(2):		not received:					
International Searching Authority (if two or more are competent): ISA /	6. Transmittal of search copy delayed until search fee is paid						
	For International Bureau use only						
Date of receipt of the record copy by the International Bureau:							

This sheet is not part of and does not count as a sheet of the international application.

PCI	For receiving Office use only
FEE CALCULATION SHEET	
Annex to the Request	International Application No.
Applicant's or agent's file reference UN/46	Date stamp of the receiving Office
Applicant THE UNIVERSITY OF NEASDEN et al.	
CALCULATION OF PRESCRIBED FEES	
1. TRANSMITTAL FEE	<u>55 T</u>
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(Applicants from certain States are entitled to a reduction of 75 international filing fee. Where the applicant is (or all applicant entitled, the total to be entered at I is 25% of the international filing.	s are) so
4. FEE FOR PRIORITY DOCUMENT (if applicable)	22 P
5. TOTAL FEES PAYABLE	2003 TOTAL
MODE OF PAYMENT (Not all modes of payment may be available at	all receiving Offices)
authorization to charge deposit account (see below) postal money order	cash coupons
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January 2007

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December 2007

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Holidays and Observances

1 Jan New Year's Day6 Apr Good Friday8 Apr Easter Sunday

9 Apr Easter Monday7 May Early May Bank Holiday28 May Spring Bank Holiday

27 Aug Summer Bank Holiday25 Dec Christmas Day26 Dec Boxing Day

More holidays are available - customize "Display holidays" or enable all holidays

Mitteilungen des Europäischen Patentamts

Korrigendum

Die Mitteilung des Präsidenten des Europäischen Patentamts vom 14. Juli 2006 über die Tage, an denen die Annahmestellen des EPA im Jahr 2007 geschlossen sind, veröffentlicht in ABI. EPA 8-9/2006, 445, ist zu berichtigen.

Information from the European Patent Office

Corrigendum

The Notice from the President of the European Patent Office dated 14 July 2006 concerning the days on which EPO filing offices are closed in 2007, published in OJ EPO 8-9/2006, 445, is to be corrected.

Communications de l'Office européen des brevets

Corrigendum

Le Communiqué du Président de l'Office européen des brevets, en date du 14 juillet 2006, relatif aux jours de fermeture des bureaux de réception de l'OEB en 2007, publié dans le JO OEB 8-9/2006, 445, est à corriger.

Tage / Days / Jours		München Munich	Den Haag The Hague La Haye	Berlin
Neujahr – New Year's Day – Nouvel An	01.01.2007	×	х	х
Karfreitag – Good Friday – Vendredi Saint	06.04.2007	×	х	×
Ostermontag – Easter Monday – Lundi de Pâques	09.04.2007	х	x	х
Nationalfeiertag – National Holiday – Fête nationale	30.04.2007		х	
Maifeiertag – May Day – Fête du Travail	01.05.2007	х	х	х
Christi Himmelfahrt – Ascension Day – Ascension	17.05.2007	x	х	×
Pfingstmontag – Whit Monday – Lundi de Pentecôte	28.05.2007	Х	х	×
Fronleichnam – Corpus Christi – Fête-Dieu	07.06.2007	х		
Mariä Himmelfahrt – Assumption Day – Assomption	15.08.2007	х		
Tag der deutschen Einheit – Day of German Unity – Fête nationale	03.10.2007	x		×
Allerheiligen – All Saints' Day – Toussaint	01.11.2007	х		
Heiliger Abend – Christmas Eve – Veille de Noël	24.12.2007	х	х	×
1. Weihnachtstag – Christmas Day – Noël	25.12.2007	х	х	x
2. Weihnachtstag – Boxing Day – Lendemain de Noël	26.12.2007	x	x	x
Silvester – New Year's Eve – Saint-Sylvestre	31.12.2007	х	х	х