Patent Administrators Course 2010/11

Mock Exam 27th January, 2011

	ed Annex 1 and Annex 2, and follow the instructions provided.	irosyne. Piease see
attatiit	ed Affilex 1 and Affilex 2, and follow the histractions provided.	(20 marks
2.	The PCT application of Question 1 is filed at the UK Intellectual Pring Office. What happens as a consequence of this?	operty Office as the
Receivi	ing Office. What happens as a consequence of this:	(2 marks
A2.	The application is forwarded to the IB [as GB is not a competent RO] The date of receipt by the UK IPO is retained as the filing date	(1 mark) (1 mark)
	A PCT application was filed on 11 th October 2010, claiming an earliest port. The international search report was transmitted to the International Search Port of the Internatio	onal Bureau on 19 ^{tl}
Where	must these amendments be filed?	(1 mark)
A3.	Due date is later of 16 months from earliest priority = 12 th February 2011 A Saturday, so possible due date is Monday 14 th February 2011 or 2 months from date of transmittal of search report = 19 th January 2011 So 14 th February 2011 date prevails. But amendments will still be published if received before preparations been completed. Amendments must be filed at the International Bureau.	(1 mark)
4. for?	In the context of the Patent Cooperation Treaty, what do the following	abbreviations stand
	WO-ISA, IPRP, SISA, RO	(2 marks
A4.	Written Opinion of the International Search[ing] Authority International Preliminary Report on Patentability Supplementary International Search[ing] Authority Receiving Office	(0.5 marks) (0.5 marks) (0.5 marks) (0.5 marks)

5. A PCT application was filed on 22^{nd} May 2009 and claimed priority from a UK application which was filed on 23^{rd} May 2008. What was the deadline for entering the PCT application into the				
Europe	an regional phase? Explain your answer.			
		(3 marks)		
A5.	Deadline is 31 months	(1 mark)		
	From priority	(1 mark)		
	= 23 rd December 2010			
6.	A European patent application was filed directly at the EPO on 15 th September 2	2008 and was		
publish	ed without a search report on 12 th March 2010. The search report was	subsequently		
•	ed on 1 st July 2010. What is the deadline for paying the examination fee withogension of time? Explain your answer.	ut requesting		
ally Ext	ension of time: Explain your answer.	(4 marks)		
		(4 marks)		
A6.	6 months	(1 mark)		
	From publication of the search report	(1 mark)		
	= 1 st January 2011	(1 mark)		
	Which is a Saturday, so deadline was Monday 3 rd January 2011	(1 mark)		
Examin	A non-unity objection was raised on 5 th May 2010 by the Search Division in a surropean patent application. The objection was repeated in a communicating Division dated 5 th October 2010. When does the time limit for filing that patent application expire? Explain your answer.	on from the		
		(4 marks)		
A7.	Date of first communication from the Examining Division + 10 days	(1 mark)		
	= 15 th October 2010	(1 mark)		
	+ 2 years	(1 mark)		
	= 15 th October 2012	(1 mark)		
8. applica	What are the (minimum) requirements for obtaining a filing date for a Euro	pean patent		
аррпса		(4 marks)		
A8.	an indication that a patent is sought;	(1 mark)		
	information identifying the applicant or allowing the applicant to be contacted	(1 mark)		
	a description	(1 mark)		
	or reference to a previously filed application.	(1 mark)		
		. ,		

9. A first substantive communication from the Examining Division pursuant to Article 94(3) issues on a European patent application. It is dated 16th August 2011. Calculate the deadline for filing a voluntary divisional application.

(3 marks)

A9.	Deemed date of receipt is 16th August 2011 + 10 days	(1 mark)	
	= 26th August 2011	(1 mark)	
	+ 24 months = 26th August 2013	(1 mark)	

10. You have received a communication dated 19th October 2010 from the Examination Division, concerning a European patent application. The communication specifies a period of four months for filing a response. Excluding requests for extension of time, what is the final date for filing the response?

(4 marks)

11. What is the meaning of the following codes in relation to publication of a European patent application?

A1, A2, A3, B1

(2marks)

- A11. A1: [specification of] application published with search report
 - A2: [specification of application] published without search report
 - A3: search report published separately
 - B1: published [specification of] granted patent (0.5 marks each)

- 12. A UK patent was applied for on 24th January 2005 claiming priority of a UK patent application filed on 26th January 2004. The patent was granted on 3rd November 2010. Giving your reasons:
 - a) What is the final date for paying the first renewal fee(s) on time? (5 marks)

	b)	What is the final date for paying the first renewal fee(s) with an but without an additional penalty fee?	extension of time (2 marks)
	c)	How many years' renewal fees will be payable on those dates?	(2 marks)
A12.	a)	First renewal "normally" due on 4th filing anniversary = 24/01/2009, but patent not granted So renewal due at end of the third calendar month after the month in which the patent was granted	(1 mark) (1 mark) (1 mark) (1 mark)
	b)	= 28th February 2011 There is no late payment fee for the first month in which renewal i	(1 mark) s overdue (1 mark)
	c)	so renewal can be paid on 31/03/2011 without penalty Renewals will be due for 2009, 2010 and 2011, i.e. 3 years (1 mark; full 2 marks for simply list (9	(1 mark) (1 mark)
instru	nber 20 ctions, d	eadline for requesting substantive examination for a UK patent ap 10. On 26 th January 2011, you realise that you have not rec despite sending numerous reminders. What action must be ta me on this deadline? Give the new deadline.	eived the client's
			(5 marks)
A13.	2 mon	th extension	(1 mark)
	Availa	ble as of right	(1 mark)
	-	ng official form [PF52]	(1 mark)
		aying official fee	(1 mark)
		ate is 28 th February 2011 [a Monday; no 30 th !]	(1 mark)
14. deadli		o an error in your office, the extended deadline in question 13 is rther extended? If so, what action must be taken?	missed. Can the
			(6 marks)
A14.	Furthe	er 2 month extension	(1 mark)
	Which	is discretionary	(1 mark)
	By filir	ng official form [PF52]	(1 mark)
	Paying	s official fee	(1 mark)
	And fil	ling evidence	(1 mark)
		pe requested before the end of the extended period [April 2010]	(1 mark)

15. Office.	List four different ways that you can file a patent application at the UK Intellectual Property		
			(2 marks)
A15.	Post, courier, har	nd, fax, electronically	(0.5 marks each)
	bstantive examina	ication was filed on 20 th July 2007, claimination report issued on 11 th June 2010. Wobjections must be answered)?	·
			(7 marks)
A16.	Compliance period 4 years 6 months		(1 mark)
	from earliest prio		(1 mark)
	= 21 st January 202	•	(1 mark)
	Or 1 year		(1 mark)
		substantive examination report	(1 mark)
	= 11 th June 2011	·	(1 mark)
	A Saturday, so co	mpliance date is Monday, 13 th June 2011	(1 mark)
17.	a) Trade mab) Communc) Patentsd) Passing-oi) Which of	ity Design off these rights is solely unregistered and ca	an be used to prevent one person
		representing their goods or services as the	•
	ii) Which of these rights is registrable, and provides broadly similar protection right identified in your answer to question ii)?		
	_	these rights does not have an unregistere	ed form?
	•	ontext of the above rights, explain wh	
	"unregistered".	-	(5 marks)
A17.	i) d) ii) a) iii) c) iv) Registere	ed rights must be applied for from gove	(1 mark) (1 mark) (1 mark) ernment authorities: unregistered
		natically without such applications.	(2 marks)

18.	You have missed a priority date for filing a patent application. What standard is applied by:					
	a)	the UK Intellectual Property Of				
	b)	The European Patent Office				
	in an	application to restore the priority	claim?			
				(2 marks)		
A18.	a)	Unintentionality		(1 mark)		
	b)	All due care [required in the cir	cumstances]	(1 mark)		
19.	Your	firm is asked to file a new PCT a	pplication for a UK ap	plicant, with no priority claim.		
	The su	ubject matter is an anti-tank missi	le.			
	a)	Where should the application b	e filed and why?	(2 marks)		
	b)	What measures have to be ta	ken if you wish to file	the application at a different		
	receiv	ring office?		(3 marks)		
A19.	a)	At UK IPO.		(1 mark)		
		Application relates to military t	echnology,	(1 mark)		
		so could be an offence to file el	sewhere.	(1 mark)		
	b)	File copy of spec and request f	oreign filing clearance	(1 mark)		
		OK to file if no prohibition orde	r issued in 6 weeks	(1 mark)		
20.	List fo	ur advantages of the Patent Coop	eration Treaty.	(2 marks)		
A20.	E.g.:					
	•	Single application				
	•	Preserves option for protection in many countries				
	•	Can file in English				
	•	ISR and written opinion give go	od idea of patentabilit	у		
	•	Can withdraw and save heavy unfavourable	nat. phase costs if in	terest wanes or search results		
	•	Delays national phase costs by	18 months (+)			
	•	Simplifies filing formalities	, ,			
	•	Some centralised prosecution				
	•	Etc	(0.5 marks ea	ch, to a maximum of 2)		

Liberté-Egalité-Gastronomie S.A.

Troisième Étage, 16 rue de singe d'or, 75018 Paris, France

Le premier nom en aliments à grignoter Françaises depuis 1978

Nancy Ann Stalwart Hubris & Sophrosyne Patent Attorneys 7 Chancery Court London WC1 1BB

25th January 2010

Dear Ms. Stalwart,

We have now decided to go ahead with a PCT application for our new invention – "A Freeze-Drying Process for Pot Noodle Production" – which we discussed when you visited us last month. Please take the necessary steps. Priority is to be claimed from our French Patent Application No. 2010005325, which was filed on 8th February last year. I confirm that I am the sole inventor.

If you need to contact me during the next two weeks, I am on holiday so please respond to my home address:

La Maison de Fromage Dur 59 rue de pont d'Avignon 74022 Paris France

Tel. & Fax +33 (0) 1 53 92 87 00 Email jules.huppert@interwebthingy.fr

We have our nephew and niece from Guyana staying with us, who are thrilled to see their ancestral home and the house in which I was born.

Kind regards,

Jules

Jules Huppert
Administrateur en Chef de Sauces

HUBRIS & SOPHROSYNE INTERNAL MEMO Tel 0207 405 3214 Fax 0207 405 4123 Email hands@interwebthingy.co.uk

Date: 26th January 2011

Case: NAS/102

Dear Administrator,

Please prepare the PCT request form PCT/RO/101 for a new PCT application for our client Liberté-Egalité-Gastronomie S.A. A copy of the client's letter of instructions is attached.

For filing I have drafted an updated English version of the description (38 pages), the claims (2 pages) and abstract (1 page). There are 16 sheets of drawings. I propose that Figure 2 should accompany the abstract.

Details of the inventor 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.

In this application I wish to make use of the search report prepared by the EPO on the French priority filing.

Fees are to be paid from our deposit account No. 2805 9999.

Regards, Nancy

PCI

REQUEST

For receiving Office use only	
Tot receiving office and only	
International Application No.	
International Filing Date	
Name of receiving Office and "PCT International Application"	

The undersigned requests that the present international application be processed according to the Patent Cooperation Treaty.	Name of receiving Office and "PCT International Application"				
	Applicant's or agent's f (if desired) (12 characte	ile reference NA	\S/02		
Box No. I TITLE OF INVENTION					
A FREEZE-DRYING PROCESS FOR SNAC	K FOOD PRODU	ICTION			
Box No. II APPLICANT This person	n is also inventor				
Name and address: (Family name followed by given name; for a legal ent. 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	he address indicated in this	Telephone No.			
LIBERTÉ-EGALITÉ-GASTRONOMIE S.A. Troisième Étage		Facsimile No.			
16 rue de singe d'or 75018 Paris France	Applicant's registration No. with the Office				
E-mail authorization: Marking one of the check-boxes below aut International Bureau and the International Preliminary Examinin notifications issued in respect of this international application to the as advance copies followed by paper notifications; or	g Authority to use the eat e-mail address if those	-mail address ind offices are willing	icated in this Box to send,		
E-mail address: State (that is, country) of nationality:	State (that is, country)	of residence:			
FR	FR				
This person is applicant for the purposes of: all designated States all designated the United States		he United States of America only	the States indicated in the Supplemental Box		
Box No. III FURTHER APPLICANT(S) AND/OR (FURT)	HER) INVENTOR(S)				
Further applicants and/or (further) inventors are indicated of	on a continuation sheet.				
Box No. IV AGENT OR COMMON REPRESENTATIVE	; OR ADDRESS FOR	CORRESPOND	ENCE		
The person identified below is hereby/has been appointed to act of the applicant(s) before the competent International Authorities	on behalf as:	agent	common representative		
Name and address: (Family name followed by given name; for a legal enti- The address must include postal code and name of a	ty, full official designation. country.)	Telephone No. +44207405	3214		
STALWART, Nancy Ann Hubris & Sophrosyne		Facsimile No.	1213		
[Patent Attorneys]		+442074054213 Agent's registration No. with the Office			
7 Chancery Court London WC1 1BB					
United Kingdom					
E-mail authorization: Marking one of the check-boxes below aut International Bureau and the International Preliminary Examinin notifications issued in respect of this international application to th as advance copies followed by paper notifications; or	g Authority to use the eat e-mail address if those	e-mail address ind offices are willing	licated in this Box to send.		
E-mail address: [You can fill these bits in or not, ac					
Address for correspondence: Mark this check-box where no agent or common representative is/has been appointed and the space above is used instead to indicate a special address to which correspondence should be sent.					

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 enter The address must include postal code and name of country. The country of Box is the applicant's State (that is, country) of residence if no State of resident HUPPERT, Jules La Maison de Fromage Dur 59 rue de pont d'Avignon 74022 Paris France	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					
State (that is, country) of nationality:	State (that is, country)	of residence:				
This person is applicant for the purposes of: all designated all designate the United States	d States except tates of America	the United States of America only the States indicated in the Supplemental Box				
Name and address: (Family name followed by given name; for a legal en The address must include postal code and name of country. The country of a Box is the applicant's State (that is, country) of residence if no State of reside	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					
State (that is, country) of nationality:	State (that is, country)	of residence:				
This person is applicant for the purposes of: all designated States all designated the United States	d States except tates of America	the United States of America only the States indicated in the Supplemental Box				
Name and address: (Family name followed by given name; for a legal entity, full official designation. The address must include postal code and name of country. The country of the address indicated in this Box is the applicant's State (that is, country) of residence if no State of residence is indicated below.) This person is: applicant only applicant and inventor inventor only (If this check is marked, do not fill in below) Applicant's registration No. with the						
State (that is, country) of nationality:	State (that is, country)) of residence:				
	ed States except tates of America	the United States of America only the States indicated in the Supplemental Box				
Name and address: (Family name followed by given name; for a legal entity, full official designation. The address must include postal code and name of country. The country of the address indicated in this Box is the applicant's State (that is, country) of residence if no State of residence is indicated below.) 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						
State (that is, country) of nationality: State (that is, country) of residence:						
	d States except tates of America	the United States of America only the States indicated in the Supplemental Box				
Further applicants and/or (further) inventors are indicated on another continuation sheet.						

Sheet No. ...3...

Box No. V	DESIGNATIONS						
The filing of this request constitutes under Rule 4.9(a) the designation of all Contracting States bound by the PCT on the international filing date, for the grant of every kind of protection available and, where applicable, for the grant of both regional and national patents.							
However,							
DE Ger	rmany is not designated	for any kind of national p	rotection				
☐ JP Japa	n is not designated for a	any kind of national protec	etion				
KR Rep	public of Korea is not de	esignated for any kind of r	national protection				
Rule 26bis.1,	the international applica	ed to exclude (irrevocably) tion contains in Box No. VI ceasing of the effect, und	l a priority claim to an e	arlier national applicat	tion filed in the particular		
Box No. VI	PRIORITY CLAIM						
The priority o	of the following earlier ap	oplication(s) is hereby clair	med:				
	ling date	Number	Whe	ere earlier application is	s:		
	er application month/year)	of earlier application	national application: country or Member of WTO	regional application: regional Office	international application: receiving Office		
item (1) 08	8/02/2010	2010005325	FR				
item (2)							
item (3)							
Further p	priority claims are indica	ted in the Supplemental B	ox.				
		quested to obtain from a di rom a digital library) iden		l copy of the earlier app	olication(s) (if the earlier		
all	items item (1)	item (2)	item (3)	other, see Suppler	nental Box		
(if the ed Office) o Bureau (arlier application(s) was or to obtain a certified co	d to prepare and transmit to silved with the Office who py of the earlier application (s) is available to the reconstitution (c) item (2)	ich for the purposes of on(s) from a digital libra	fthis international app ary and transmit a copy	olication is the receiving of it to the International ed above as:*		
* Where the certified copy of the earlier application (s) is not stored in a digital library under the number of the earlier application indicated above but under the application number of another application which also claims priority from it, indicate that number in the supplemental sheet (item 4).							
Restore the right of priority: the receiving Office is requested to restore the right of priority for the earlier application(s) identified above or in the Supplemental Box as item(s) (). (See also the Notes to Box No. VI; further information must be provided to support a request to restore the right of priority.)							
the descriptio completely co Article 11(1)(on, claims or drawings in contained in an earlier ap (iii) were first received	an element of the internat referred to in Rule 20.5(a plication whose priority i by the receiving Office, rnational application for the	a) 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	ional application but is elements referred to in		
Box No. VII	INTERNATIONAL	SEARCHING AUTHOR	RITY				
		Authority (ISA) (if more the ority chosen; the two-letter		Searching Authority is co	ompetent to carry out the		
ISA/	ISA/						

Continuation of Box No. VII USE OF RESULTS OF EARLIER SEARCH, REFERENCE TO THAT SEARCH						
\boxtimes		Box No. VII is requested to take into account the results of of results of more than one earlier search).	f the earlier search(es) indicated below (see also			
Filin	g date (day/month/year)	Application Number	Country (or regional Office)			
08/0	2/2010	2010005325	FR			
		(ii)): this international application is the same, or substach was carried out except, where applicable, that it is file				
	do not need to be subr a copy of the rest a copy of the ear a translation of the attranslation of the attranslati	nents: the following documents are available to the ISA in mitted by the applicant to the ISA (Rule 12bis.1(f)): ults of the earlier search,* dier application, he earlier application into a language which is accepted the results of the earlier search into a language which is a nument cited in the results of the earlier search. (If known,	by the ISA, accepted by the ISA,			
* W	indicated above but by prepare and transmit to a copy of the results of the ear	wults of earlier search and other documents (where the y the same Office as that which is acting as the receiving the ISA (Rule 12bis.1(c)): ults of the earlier search,* dier application, cument cited in the results of the earlier search. The search are neither available from a digital library nor to to the receiving Office (Rule 12bis.1(a)) (See item 11. in the search are neither available from the search ar	any Office): the receiving Office is requested to transmitted by the receiving Office, the applicant			
Filin	g date (day/month/year)	Application Number	Country (or regional Office)			
	Availability of documed on one need to be subromored a copy of the result a copy of the ear a translation of the attranslation of the a	(ii)): this international application is the same, or substach was carried out except, where applicable, that it is filements: the following documents are available to the ISA in mitted by the applicant to the ISA (Rule 12bis.1(f)): ults of the earlier search,* dier application, he earlier application into a language which is accepted the results of the earlier search into a language which is accepted the results of the earlier search. (If known, parent cited in the results of the earlier search. (If known, parent cited in the results of the earlier search. (If known, parent cited in the results of the earlier search. (If known, parent cited in the results of the earlier search.	ed in a different language. a form and manner acceptable to it and therefore by the ISA, accepted by the ISA,			
	Transmit copy of results of earlier search and other documents (where the earlier search was not carried out by the ISA indicated above but by the same Office as that which is acting as the receiving Office): the receiving Office is requested to prepare and transmit to the ISA (Rule 12bis.1(c)): a copy of the results of the earlier search,* a copy of the earlier application, a copy of any document cited in the results of the earlier search. * Where the results of the earlier search are neither available from a digital library nor transmitted by the receiving Office, the applicant is required to submit them to the receiving Office (Rule 12bis.1(a)) (See item 11. in the check-list and also Notes to Box No. VII).					
	Further earlier searche	es are indicated on a continuation sheet.				
Box	No. VIII DECLARAT	TIONS				
		are contained in Boxes Nos. VIII (i) to (v) (mark the app ate in the right column the number of each type of declarate				
	Box No. VIII (i)	Declaration as to the identity of the inventor	:			
	Box No. VIII (ii)	Declaration as to the applicant's entitlement, as at the date, to apply for and be granted a patent	international filing :			
	Box No. VIII (iii)	Declaration as to the applicant's entitlement, as at the date, to claim the priority of the earlier application	e international filing :			
	Box No. VIII (iv)	Declaration of inventorship (only for the purposes of t United States of America)	he designation of the :			
	Box No. VIII (v)	Declaration as to non-prejudicial disclosures or except	ions to lack of novelty :			

Box No. IX CHECK LIST for PAPER filings – this sheet is only to be used when filing an international application on PAPER						
This international application contains the following:	Number of sheets	follow	ternational application is accompanied by the ing item(s) (mark the applicable check-boxes below dicate in right column the number of each item):	Number of items		
(a) request form PCT/RO/101		1.	fee calculation sheet	: 1		
(including any		2. 🗆	original separate power of attorney	:		
declarations and		3. 🗆	original general power of attorney			
supplemental sheets)	: 5					
		9 4. ∐	copy of general power of attorney; reference number:	:		
(b) description (excluding any		5. 	statement explaining lack of signature	:		
sequence listing		6. 🗆	priority document(s) identified in Box No. VI			
part of the description,		°. _	as item(s)	:		
see (f), below)	: 38	3 7. 	Translation of international application into			
(-) -1-:			(language):	:		
(c) claims	: 2	8. 🗆	8 1			
(d) abstract	: 1		microorganism or other biological material	:		
(e) drawings (if any)		9. 🗖				
(c) thannigs (it ally)	: 16		physical data carrier(s) of the sequence listing, no part of the international application, which is furnis			
(f) sequence listing			for the purposes of international search under			
part of the description (if any)			(type and number of physical data carriers)			
description (if unly)	•	_		:		
		_ 10. L	a statement confirming that "the information recorded in electronic form submitted under			
			Rule 13 <i>ter</i> is identical to the sequence listing			
Total number of sheets	: 62	2	as contained in the international application"			
			as filed on paper			
		11.	copy of results of earlier search(es) (Rule 12bis.1	(a)) :		
		12. 	other (specify):	:		
Figure of the drawings which should accompany the abstract:	2		nage of filing of the English ational application:	ı		
l			R COMMON REPRESENTATIVE acity in which the person signs (if such capacity is not obvious	s from reading the request)		
Them to each signature, material me name of the	ic person signing a	на те сар	acity in which the person signs (y such capacity is not obvious	strom reading the request).		
STALWART, Nancy	Δnn					
OTALWART, Namey						
Date of actual receipt of the purpo international application:		For recei	ving Office use only	2. Drawings:		
ппотпанонат аррисацоп;						
3. Corrected date of actual receipt due to later but timely received papers or drawings completing the purported international application:						
	4. Date of timely receipt of the required corrections under PCT Article 11(2):					
5. International Searching Authority (if two or more are competent): ISA / 6. Transmittal of search copy delayed until search fee is paid						
	For	Internat	ional Bureau use only			
Date of receipt of the record copy by the International Bureau:	Date of receipt of the record copy					