

## **PATENT ADMINISTRATORS - MOCK EXAMINATION**

**January 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. 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. The Paper contains 6 sheets plus Annex A
7. Additional blank forms for Question 1 are available from the invigilators

1. Annex A is a letter of instruction from a Japanese Associate for you to enter the European Regional Phase of a PCT on behalf of their client. The PCT Application is in Japanese and an International Preliminary Examination has been carried out. Please complete the European Application Form (EP1200) provided.

Please note:

- a. you are in charge of formalities for C Ester, European Patent Attorney;
  - b. the invention is in the field of mechanical engineering;
  - c. fees are to be paid from (and credits refunded to) C Ester's European Deposit Account 2109.4121 *(7 Marks)*
2. You are asked to enter the European Regional Phase of a PCT Application relating to electronics filed in Russian for a new Russian client. The PCT application request contained the name and address of the sole inventor. The PCT application has been subject to an International Preliminary examination request:
- a. What is the last date by which fees for entering the regional phase should be paid to the European Patent Office without incurring a surcharge? *(3 Marks)*
  - b. In addition to payment of fees what is the minimum other documentation which must be provided to the European Patent Office to allow the PCT application for this new Russian client to proceed into the regional phase and by when must it be provided? *(4 Marks)*
3. What is:
- a. A Trade Mark *(2 Marks)*
  - b. An international filing date *(1 Mark)*
  - c. A convention date *(3 Marks)*

4. a. What are the minimum requirements to establish a filing date for a UK patent application, without a priority claim? (3 Marks)
- b. What date is the deadline for filing a substantive examination request (Form 10/77) on a UK patent application filed on 21 April 1999 (without priority claim) and published on 25 October 2000, explain why? (2 Marks)
- c. Assuming the patent application in b. is granted by the by the end of 2001, when is the first renewal payable and how frequently are fees to be paid? (2 Marks)
- d. What is the normal maximum life of a UK patent, when does it start? (2 Marks)
5. A UK patent application was filed on 13 April 2000 consisting of a description and application form (Form 1/77). The applicant does not want to pay any extension fees. The applicant wants to keep the case alive, what is the minimum he must do next and what is the latest date for doing this? (without an extension of time)
- Why did you choose the date in your answer? (8 Marks)
6. A patent examination request (Form 10/77) was due on 11 January 2001, it was sent with the fee by a courier company on 10 January 2001 and you have a receipt accordingly, but did not arrive until 12 January 2001.
- a. Would the request have been accepted by the Patent Office? Why?
- b. Would it have made any difference if the request has been sent, with proof of posting, to the Patent Office by first class post? (4 Marks)
7. You decide to file by facsimile a UK patent application claiming priority from two earlier US patent applications. What is the normal deadline for filing the confirmation copies of the UK application papers? (3 Marks)
8. Rule 6 of the Patent Rules 1995 sets out the requirements for claiming the priority date in a UK application of an earlier application made in Australia.
- a. What must an applicant furnish?
- b. By when? (4 Marks)

9. The UK patent office carries out a preliminary examination and search after filing Form 9/77. Write down only four of the following issues which the formalities examiner object to:
- Point A      A priority claim dating back 13 months
- Point B      The abstract makes no sense
- Point C      Reference number "7" had been used twice in a drawing
- Point D      The drawings were hand drawn with a blue ball pen
- Point E      "Necessary" was mis-spelt in the specification
- Point F      The margins in the specification were only 4mm wide
- Point G      The pages of the specification are numbered Sheet I, Sheet II etc. (4 Marks)
10. The substantive examination of a patent application is to assess whether a patent application meets the criteria for patentability. Name three of the criteria. (3 Marks)
11. a.      What is an abstract of a patent application and what is its purpose? (2 Marks)
- b.      What happens if an abstract is filed which is not clear? Is there any action the applicant should take? (2 Marks)
12. An invention, the subject of a UK patent application not claiming priority, was made by 4 inventors:
- a.      How many copies of the statement of inventorship (Form 7/77) are required? (1 Mark)
- b.      Why are the copies needed? (2 Marks)
- c.      In addition to the details of the applicant and inventors, and the title of the invention, what other important information is required on the Form 7/77? (2 Marks)
- d.      What is the normal deadline for filing a Form 7/77? (1 Mark)

13. What will happen if:
- a. I insert a hand written amendment in the margins of my UK patent specification and file it? (2 Marks)
  - b. I discover an omission on a typed UK patent application form (Form 1/77) before it was filed, and I insert the correct information by hand with a black ball point pen? (1 Mark)
14. A European patent application contains 45 sheets and 20 claims, are any additional fees payable on filing as a result? Why? (2 Marks)
15. In addition to the sequence number 070321, what other information could you derive if you saw the number WO01/070321 with the code A1 on a patent publication? (4 Marks)
16. What should be done if your UK client wishes to file a US patent application as soon as possible, the client has not filed in the UK. Are there any alternative courses open? (4 Marks)
17. a. An examination report dated 9 September 2000 was received on my European Patent Application. Four months was given for responding. Can I still reply (today)? Why? (2 Marks)
- b. I will not be in a position to reply until 1 March 2001, what should I do? (3 Marks)
- c. If I do nothing at all, what will happen next, how could I then recover the position? (4 Marks)
18. a. A first written opinion was issued by the EPO as the international preliminary examination authority on 9 November 2000 on my PCT application which was filed on 2 February 1999 (without priority claim). Two months was given to reply: can I still meet the deadline for replying. Why?
- b. If I do not reply, what will normally happen next and when? (4 Marks)
19. What language could you use for, and why?:
- a. A UK Patent Application to be filed at the UK Patent Office in Newport? (1 Mark)
  - b. A European Patent Application filed at the International Receiving Office at the UK Patent Office in Newport? (2 Marks)
  - c. A PCT application made at the International Receiving Office at the UK Patent Office in Newport? (2 Marks)

20. You act for a British applicant for a PCT filed on 10 January 2001 without claiming priority, precautionary designations have been filed for all PCT countries.

- a. Which Patent Office will act as the International Search Authority (ISA)? *(1 Mark)*
- b. By when should you file the international preliminary examination (IPE) request? Mention why you chose the date. *(3 Marks)*

**ANNEX A**

Nippon Patent Agents  
1-2-5 Gasumagaski  
Chiyoda-Ku  
Tokyo  
1000 JAPAN

To: Fax +44 113 297 5000  
C Ester and Associates  
Suite 101  
North Tower  
Pudsey Road  
LEEDS LE6 4JB  
(Confirm telephone +44 113 297 5010)

Dear Sirs

**PCT APPLICATION PCT/JP99/06162 DATED 18 JULY 1999**  
**ENTITLED "RAILWAY SLEEPER"**

I should be grateful if you would enter European Regional Phase of PCT Application PCT/JP99/06162 based on the following information:

Title:	Railway Sleepers
PCT Application:	PCT/JP99/06162 dated 18 July 1999
PCT Publication:	WO01/00206 published 7 February 2000
Japanese Applications on which the priority claims are based:	316061/99 dated 22 July 1998 427917/99 dated 20 December 1998
Allocated European Application No:	00901760.5
Applicant:	Keisei Railway Research KK 3-2-5 Toguguti Narita-Shi 1076-200 Japan
Designations Required:	United Kingdom France Germany Spain Italy Austria
Authorisation:	You already have a General Authorisation No. 35028 in favour of this applicant

A single copy of each of the abstract, specification, 5 claims and 1 PTO sheet of drawings as filed in Japanese is enclosed, please make the necessary number of copies. The claims as revised in the Preliminary Examination report are also enclosed (all in Japanese). We would like the European Examination to proceed on the basis of the claims as amended in the International Preliminary Examination. Prepare any necessary translation in good time.

Yours faithfully

# CALENDER

## YEAR 1999

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

### Mitteilung des Präsidenten des Europäischen Patentamts vom 18. Oktober 2000 über die Tage, an denen die Annahme- stellen des EPA im Jahr 2001 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 2001 werden in der nachfolgenden Übersicht bekanntgegeben.

## INFORMATION FROM THE EUROPEAN PATENT OFFICE

### Notice from the President of the European Patent Office dated 18 October 2000 concerning the days on which EPO filing offices are closed in 2001

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 2001 are listed below.

## COMMUNICATIONS DE L'OFFICE EUROPEEN DES BREVETS

### Communiqué du Président de l'Office européen des brevets, en date du 18 octobre 2000, relatif aux jours de fermeture des bureaux de réception de l'OEB en 2001

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 2001 sont énumérés dans la liste ci-après.

Tage / Days / Jours		München Munich	Den Haag The Hague La Haye	Berlin
Neujahr – New Year's Day – Nouvel An	01.01.2001	x	x	x
Karfreitag – Good Friday – Vendredi Saint	13.04.2001	x	x	x
Ostermontag – Easter Monday – Lundi de Pâques	16.04.2001	x	x	x
Nationalfeiertag – National Holiday – Fête nationale	30.04.2001		x	
Maifeiertag – May Day – Fête du Travail	01.05.2001	x	x	x
Christi Himmelfahrt – Ascension Day – Ascension	24.05.2001	x	x	x
Pfingstmontag – Whit Monday – Lundi de Pentecôte	04.06.2001	x	x	x
Fronleichnam – Corpus Christi – Fête-Dieu	14.06.2001	x		
Mariä Himmelfahrt – Assumption Day – Assomption	15.08.2001	x		
Tag der Deutschen Einheit – Day of German Unity – Fête Nationale	03.10.2001	x		x
Allerheiligen – All Saints' Day – Toussaint	01.11.2001	x		
Heiliger Abend – Christmas Eve – Veille de Noël	24.12.2001	x	x	x
1. Weihnachtstag – Christmas Day – Noël	25.12.2001	x	x	x
2. Weihnachtstag – Boxing Day – Lendemain de Noël	26.12.2001	x	x	x
Sylvester – New Year's Eve – Saint-Sylvestre	31.12.2001	x	x	x