Patent Administrators Course 2009/10

Mock Exam 28th January, 2010

(1)	Please see the attached Annex 1 and Annex 2, and follow the instructions.	
		(20 marks)
(2)	Are renewal fees payable in respect of the following? (Where renewal fees are when the first fee is due, the frequency of payment and when the renewal fees	• •
a)	A pending PCT application	
	No fees	(1 mark)
b)	A pending UK patent application	
	No fees	(1 mark)
c)	A pending European patent application	
	Annually from 2nd anniversary of filing date until grant.	(3 marks)
(3)	A European patent application was filed on 20 October 2008 claiming a pr October 2007. What is the last day that the first renewal fee can be paid w Give your reasons.	*
		(3 marks)
	End of the month containing the second filing anniversary = 31 October 2010 November 2010. (3 marks)), a Sunday, so 01
(4)	For the European application in Question 3, what is the earliest possible date for first renewal fee? Give your reasons.	or payment of the
		(3 marks)

3 months before the due date. Due date is 31 October 2010 so earliest payment date is 01 August 2010 [a Sunday; EPO open for electronic payments, but do not deduct marks for

"Monday 02 August 2010"] (3 marks)

(5)	You have received Form PCT/IB/206, Invitation to pay additional search fees, indicating that the ISA considers that there are two inventions in the application of the deadline by which the additional search fee must be paid.	
a)	What is the deadline date for payment of the additional search fee? Give you	r reasons.
		(4 marks)
	One month from the date of the invitation: 23/01/2010 which falls on a Sat 25/01/2010. (4 marks)	turday, so Monday
b)	Where does the additional search fee have to be paid?	
		(1 mark)
	Direct to the ISA. (1 mark)	
(6)	A PCT Application was filed on 02 February 2009 claiming priority from a UK A 07 February 2008. The search report and Written Opinion were issued on 05 to	
a)	When should the Demand be filed? Give your reasons.	
		(5 marks)
	Later of 22 months from priority (= 07 December 2009) or 3 months from February 2010, which therefore governs). (5 marks)	ISR and WO (= 05
b)	Can an extension of time be obtained?	
		(1 mark)
	No extension can be obtained. (1 mark)	
c)	Where should the Demand be filed?	
		(1 mark)
	Demand should be filed at IPEA. (1 mark)	
(7)	A UK patent application was filed on 1 February 2007, claiming a priority da 2006.	ate of 03 February
(a)	When must the application be in order for grant? Give your reasons.	
		(3 marks)

4½ years from priority [or filing if no priority] = 03 August 2010 (3 marks)

(b) How would your answer differ if the first substantive examination report has been delayed until 01 December 2009? Calculate the new date.

(3 marks)

12 months from date of issue of 1st exam report = 1 December 2010 (3 marks)

(8)

a) What is the deadline for filing Patents Form 9A to request a search if an application includes a declaration of priority?

(3 marks)

The later of 2 months from filing date or 12 months from priority date. (3 marks)

b) What is the deadline for filing Patents Form 10 for a request for substantive examination?

(2 marks)

No later than six months from the date of publication of the application. (2 marks)

(9) The deadline for reply to an examination report on a UK patent application is 08 December 2009. Is it possible to extend this deadline and if so how is this done? What is the new deadline?

(5 marks)

Yes. Request the extension of time in writing before the end of the extended period, which is two months from the end of the original period, i.e. 08 February 2010 [Monday]. (5 marks)

(10) On a different UK application, after responding to the first examination report, for commercial reasons the client wants to file amendments to the claims. Can your attorney file another set of claim amendments? If so, under what conditions?

(2 marks)

Yes, but at the discretion of the Examiner. (2 marks)

(11) The attorney you support receives a section 18(4) examination report explaining that the client's UK application is in order for grant. However, the client would like to amend the claims currently on file. Is this possible? If so, under what conditions?

(2 marks)

Yes, but only within the 2 month period specified in the examination report. (2 marks)

(12) You do not receive instructions as to whether your client wishes to file a new UK patent application claiming priority of a first UK application filed on 22 December 2009, despite sending several reminders. On 04 January 2010 you receive instructions to file the new application, which the client had posted to you on 14 December 2009. What must be done to file the new application with the desired priority claim?

(5 marks)

File by 14 months from priority = 22 February 2010

Requesting late claim to priority

Together with fee [on PF52] and evidence that the applicant intended to file within the 12 month priority term

Reminders and mailed instructions are evidence of this. (5 marks)

(13) A declaration of inventorship for a European Patent Application was due to be filed by 15 December 2009. The EPO informs the applicant that the declaration was received only on 05 January 2010 and therefore the application is deemed withdrawn. The applicant tells you that the declaration was sent to the EPO by a recognised delivery service, who were given the document on 9 December 2009. What is the position?

(3 marks)

The declaration is deemed to have been received in time because it was given to a recognised delivery service more than five days before 15 December 2009. (3 Marks)

(14) If the application in Question 13 had been a UK application, what is the position? How would you remedy the situation?

(3 marks)

Date of receipt is the actual date of receipt, i.e. 05 January 2010. To prevent the application from being deemed withdrawn, request as-of-right extension [on PF52 and which can be up to 2 months] and pay fee. (3 marks)

(15) A European Patent Application was filed on 06 January 2010 in a language which is not an official language of the EPO. Into which language must the Application be translated?

(3 marks)

English, French or German. (3 Marks)

(16)

a) By when must the translation referred to in Question 15 be filed?

2 months from filing, i.e. 06 March 2010, which is a Saturday. Time extended until 8 March 2010. (4 Marks)

b) Is there any extension of the time limit? If so, by how much?

(2 marks)

2 months from invitation by EPO. (2 Marks)

- (17) A European Patent Application has been filed without claims on 04 December 2009. Subsequently, on 04 January 2010 a set of 129 claims is filed.
- a) For which claims must a claims fee be paid and with what time limit?

(5 marks)

Claims fee for the 16th to 50th claim and an increased claims fee for the 51st to 129th claim. (2 Marks)

To be paid within 1 month of filing the claims i.e. 4 February 2010 or one month from invitation by the EPO (3 marks).

b) What happens if the claims fee is not paid?

(1 mark)

If the claims fee is not paid or not paid in full the claims for which fees have not been paid are deemed abandoned. (1 mark)

(18) A European Patent Application was filed in February 2007. You have been informed of the text on which the EPO intends to grant the Patent. There are 43 pages. What action must be taken to secure grant?

(4 marks)

Translate the claims into the other two official languages

Pay the grant fee

Pay the printing fee for pages 36 to 43

Pay claims fees if not already paid. (4 Marks)

(19) What difference would there be in your answer to Question 18 if the application had been filed after 1 April 2009?

(1 Mark)

No need to pay the printing fees for pp 36-43. (1 Mark)

(20) Because of a mistake in your office, you have missed a renewal date on a European patent application. Describe six things relating to your office and its organisation, which affect whether or not re-establishment of rights is likely to be successful.

(6 marks)

Any reasonable answers accepted - see e.g. those listed in "The Professional Role" section of the notes. (6 marks)

ANNEX 1

WANGLE WHEEDLE & BLOCH INTERNAL MEMO Tel 020 7821 2345 Fax 020 7821 5432 Email pats-r-us.co.uk

Case ref: UDC-027

Dear Administrator,

Please fill in a PCT request form PCT/RO/101 for a new application for our client, The Urgent Detergent Co. Ltd., in accordance with Mr. Soap's instructing letter as attached [Annex 2].

I have prepared a revised specification with 18 pages description, 2 pages claims and an abstract. There are no drawings.

Mr. Soap is the only inventor. Official correspondence should be sent to him at the R&D Department address on his letter, but the address for the main applicant should be the company headquarters as given on the Companies Register, which is:

Port Moonlight Greater Bermondsey London SE20 0DM

The application is to be filed at the UK Intellectual Property Office, with fees paid by cheque from our firm's bank account. For safety, any shortfalls can be debited to our deposit account no. D04321. The cheque and fee calculation sheet will be prepared by our accounts department and added to the application papers.

Priority is to be claimed from the existing UK case, with the priority document prepared by the IPO and forwarded to the IB. A copy of the UK search report is similarly to be prepared and forwarded.

Copies of general powers of attorney for all applicants are available on our earlier file UDC-023.

There is no need to complete the Declaration pages in the Request form and these have been removed.

AW 27-01-2010

ANNEX 2

The Urgent Detergent Co. Limited

Research & Development Department 1 Bath Road Washington Tyne and Wear SU12 3QQ United Kingdom

21st January 2010

Andrew Wangle
Wangle Wheedle & Bloch
Patent Attorneys
22 Blue Lion Court
Holborn
London
WC2A 1AZ

Dear Andrew,

Re: UK Patent Application No. GB0900723.4 "Cleaning Materials"

Thank you for your recent reminder. I am amazed that the above initial UK application for this invention was filed as long ago as 28th January 2009. How time flies! We are very excited by this project, which looks like it will be commercially important. We therefore want to file a PCT application to keep our options open in all available PCT territories; with the minor changes to the specification that you have recommended, to take account of the IPO search results and the further refinements to our invention.

Please could you handle this application for us. I confirm that I am a UK national and resident.

With thanks and best wishes,

Joe Soap

Joseph Soap Research Director

For receiving Office use only PCT International Application No. REQUEST International Filing Date 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 file reference (if desired) (12 characters maximum) UDC-027 Box No. I TITLE OF INVENTION Cleaning Materials Box No. II APPLICANT This person is also inventor 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.) Telephone No. The Urgent Detergent Co. Limited Facsimile No. Port Moonlight Greater Bermondsey Applicant's registration No. with the Office London SE20 0DM United Kingdom E-mail authorization: Marking one of the check-boxes below authorizes the receiving Office, the International Searching Authority, the International Bureau and the International Preliminary Examining Authority to use the e-mail address indicated in this Box to send, notifications issued in respect of this international application to that e-mail address if those offices are willing to do so. exclusively in electronic form (no paper notifications will be sent). as advance copies followed by paper notifications; or State (that is, country) of nationality: State (that is, country) of residence: GB GB the States indicated in the Supplemental Box the United States of America only This person is applicant for the purposes of: all designated States all designated States except the United States of America Box No. III FURTHER APPLICANT(S) AND/OR (FURTHER) INVENTOR(S) Further applicants and/or (further) inventors are indicated on a continuation sheet. AGENT OR COMMON REPRESENTATIVE; OR ADDRESS FOR CORRESPONDENCE The person identified below is hereby/has been appointed to act on behalf of the applicant(s) before the competent International Authorities as: common representative agent 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.) Telephone No +442078212345 [Wangle, Andrew] Facsimile No. Wangle Wheedle & Bloch +442078215432 Patent Attorneys Agent's registration No. with the Office 22 Blue Lion Court Holborn, London WC2A 1AZ

E-mail authorization: Marking one of the check-boxes below authorizes the receiving Office, the International Searching Authority, the International Bureau and the International Preliminary Examining Authority to use the e-mail address indicated in this Box to send, notifications issued in respect of this international application to that e-mail address if those offices are willing to do so.

as advance copies followed by paper notifications; or

exclusively in electronic form (no paper notifications will be sent).

E-mail address: pats-r-us.co.uk

United Kingdom

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 no	ot be included in the rec	quest.		
Name and address: (Familyname 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 residence is no State of residence if no State o	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: GB) of residence:			
This person is applicant for the purposes of: all designated the United States all designated the United States		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 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	he 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		
State (that is, country) of nationality: State (that is, country) of residence:				
This person is applicant all designated for the purposes of:	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 ent. The address must include postal code and name of country. The country of I Box is the applicant's State (that is, country) of residence if no State of residen	he 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		
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		
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 i Box is the applicant's State (that is, country) of residence if no State of reside	he 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		
State (that is, country) of nationality: State (that is, country) of residence:				
This person is applicant all designated all designated States except the United States of America only the States indicated in the United States of America only				
Further applicants and/or (further) inventors are indicated on another continuation sheet.				

Box No. V DESIGNATIONS				
The filing of this request constitutes u filing date, for the grant of every kind	nder Rule 4.9(a) the desi of protection available an	gnation of all Contract d, where applicable, for	ing States bound by the r the grant of both region	PCT on the international onal and national patents.
However,				
DE Germany is not designated	for any kind of national p	rotection		
JP Japan is not designated for a	any kind of national protec	etion		
KR Republic of Korea is not do	e signated for any kind of a	national protection		
(The check-boxes above may only be us Rule 26bis.1, the international applica State concerned, in order to avoid the	ition contains in Box No. VI	l a priority claim to an e	earlier national applicat	tion filed in the particular
Box No. VI PRIORITY CLAIM				
The priority of the following earlier ap	oplication(s) is hereby clai	med:		
Filing date	Number of carlier application	Where earlier application is:		
of earlier application (day/month/year)	of carrier approaction	national application: country or Member of WTO	regional application: regional Office	international application: receiving Office
item (1) 28/01/2009	0900723.4	GB		
item (2)				
item (3)				
Further priority claims are indica	ted in the Supplemental B	ox.		
The International Bureau is rea application(s) is available to it fr	quested to obtain from a di rom a digital library) iden	igital library, a certified tified above as:*	l copy of the earlier app	olication(s) (if the earlier
all items item (1)	item (2)	item (3)	other, see Suppler	nental Box
The receiving Office is requested to prepare and transmit to the International Bureau a certified copy of the earlier application(s) (if the earlier application(s) was filed with the Office which for the purposes of this international application is the receiving Office) or to obtain a certified copy of the earlier application(s) from a digital library and transmit a copy of it to the International Bureau (if the earlier application(s) is available to the receiving Office from a digital library), identified above as:* all items item (1) item (2) item (3) other, see Supplemental Box				
* 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.)				
Incorporation by reference: where an element of the international application referred to in Article 11(1)(iii)(d) or (e) or a part of the description, claims or drawings referred to in Rule 20.5(a) is not otherwise contained in this international application but is completely contained in an earlier application whose priority is claimed on the date on which one or more elements referred to in Article 11(1)(iii) were first received by the receiving Office, that element or part is, subject to confirmation under Rule 20.6, incorporated by reference in this international application for the purposes of Rule 20.6.				
Box No. VII INTERNATIONAL SEARCHING AUTHORITY				
Choice of International Searching Authority (ISA) (if more than one International Searching Authority is competent to carry out the international search, indicate the Authority chosen; the two-letter code may be used):				
ISA/ EP				

Continuation of Box No. VII USE OF RESULTS OF EARLIER SEARCH, REFERENCE TO THAT SEARCH					
X	The ISA indicated in Bo Notes to Box VII; use of	ox No. VII is requested to take into account the results of the fresults of more than one earlier search).	e earlier search(es) indicated below (see also		
Filing date (day/month/year) Application Number Country (or regional Office			Country (or regional Office)		
28/0	1/2009	0900723.4	GB		
\boxtimes	Statement (Rule 4.12(ii)): this international application is the same, or substantially the same, as the application in respect of which the earlier search was carried out except, where applicable, that it is filed in a different language.				
	do not need to be subm a copy of the resu a copy of the earli a translation of the a translation of the	ents: the following documents are available to the ISA in a faitted by the applicant to the ISA (Rule 12bis.1(f)): lts of the earlier search,* ier application, e earlier application into a language which is accepted by e results of the earlier search into a language which is accument cited in the results of the earlier search. (If known, pleasance)	the ISA, bepted 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).				
Filing	g date (day/month/year)	Application Number	Country (or regional Office)		
	Availability of docume do not need to be submarcopy of the resurrance a copy of the earling a translation of the attranslation of the submarcopy.	ii)): this international application is the same, or substantion was carried out except, where applicable, that it is filled ents: the following documents are available to the ISA in a faitted by the applicant to the ISA (Rule 12bis.1(f)): lts of the earlier search,* ier application, e earlier application into a language which is accepted by e results of the earlier search into a language which is accument cited in the results of the earlier search. (If known, plane)	in a different language. Form and manner acceptable to it and therefore the ISA, septed 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 searches are indicated on a continuation sheet.					
Box No. VIII DECLARATIONS					
The following declarations are contained in Boxes Nos. VIII (i) to (v) (mark the applicable check-boxes below and indicate in the right column the number of each type of declaration): Number of declarations					
	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 int date, to apply for and be granted a patent	ernational filing :		
	Box No. VIII (iii)	Declaration as to the applicant's entitlement, as at the ir date, to claim the priority of the earlier application	ternational filing :		
	Box No. VIII (iv)	Declaration of inventorship (only for the purposes of the United States of America)	designation of the		
	Box No. VIII (v)	Declaration as to non-prejudicial disclosures or exception	ns 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	followi	ternational application is accompanied by the ng item(s) (mark the applicable check-boxes below licate in right column the number of each item):	Number of items	
(a) request form PCT/RO/101		l. 🛛	fee calculation sheet	: 1	
(including any		2. 🗖	original separate power of attorney		
declarations and		3. 🗆	original general power of attorney	:	
supplemental sheets):	5	4. 🛛	copy of general power of attorney; reference		
	J	4. 🔼	number:	; 2	
(b) description (excluding any		5. 🗆	statement explaining lack of signature		
sequence listing				•••••	
part of the		6.	priority document(s) identified in Box No. VI as item(s)		
description, see (f), below):	18	7. 🗆	Translation of international application into		
			(language):	:	
(c) claims	2	8. 🗖	separate indications concerning deposited		
(d) abstract:	1		microorganism or other biological material	:	
(e) drawings (if any):		9. 🗖	copy in electronic form (Annex C/ST.25 text file)		
(e) drawings (if any)			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 any)		_		:	
<u> </u>		10.	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 :	26		as contained in the international application"		
			as filed on paper		
		11. 🔲	copy of results of earlier search(es) (Rule 12bis.1	• • •	
		12. 🛛	other (specify): Cheque	: 1	
Figure of the drawings which should accompany the abstract:			age of filing of the English tional application:		
Box No. X SIGNATURE OF APP	LICANT, AG	ENT O	R COMMON REPRESENTATIVE		
Next to each signature, indicate the name of the p	person signing an	d the capa	city in which the person signs (if such capacity is not obvious	from reading the request).	
[An indication of the name and capacity of the signatory must be given here in accordance with the italicised note above, e.g. "Andrew Wangle, Partner, Wangle, Wheedle & Bloch", or simply "Andrew Wangle", if he was also named in Box IV above. If this form is being signed for the applicants by Joe Soap, the indication would be "Joseph Soap, Research Director, The Urgent Detergent Co. Limited (obvious that he is inventor and US applicant).]					
1. Date of actual receipt of the purported international application: 2. Drawings:					
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):				not received:	
5. 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:					