

Patent Administrators Certificate
Mock Exam Jan 2005
Marking Schedule

		Section Marks	Question Marks	Cumulative Total
1	You are asked to prepare a new United Kingdom patent application based on the annexed incoming letter, which is provided to you here without its enclosures.			
1a.	Please prepare Patents Form PF1/77 for the new case. Please note that the application and search fees are to be paid, but that no request for examination is to be filed. All of the documents made available to you, as set out in the incoming letter, will be filed, together with Patents Forms 7/77 and 9A/77. Please complete sections 9 and 10 of PF1/77 appropriately.			
	<u>1a. Marking of completed PF1/77 (January 2005 version)</u> <u>Referring to the numbered sections on the form</u>			
	1 half a mark for correct reference = UKP/2564	0.5		
	2 half a mark for correctly copying applicant details	0.5		
	half a mark for giving KR or otherwise correctly showing nationality	0.5		
	3/4. one mark for completing sections 3 and 4 correctly	1		
	5. one mark for completing correctly = KR 2004-12435 19. 02. 04	1		
	6 half a mark for leaving blank	0.5		
	7 one mark for ticking the no box on first line ie "no" to "are all the applicants named above also inventors" this mark is only available if all other boxes in section 7 remain blank	1		
	8 half a mark for ticking "yes" (If consistent with 9A/77). See comments below	0.5		
	9 half a mark for 4 pages of description, 1 page each of claims, abstract & drawing	0.5		
	10 one mark for marking priority documents, 7/77 and 9A/77 as all present	1		
	7			

RE Application Fee It would be appropriate to indicate on one only of 1/77 and 9A/77 that the application fee is being paid. The other form can say simply "no" or "paid on PF1/77", for example. It doesn't appear to be wrong for both forms to say "yes" as the fee sheet will clearly show payment of a single application fee. So the half mark on 1a is available for any such scenario. What is wrong is neither form indicating that the application fee is paid.

1b. Please prepare a Patents Form 9A/77 for the same case.

1b. Marking of completed PF9A/77 (January 2005 version)

Referring to the numbered sections on the form

	1/3. one mark for accurately including the same reference and applicant as on PF1/77	1		
	2 half a mark for leaving blank	0.5		
	4 one mark of adding "(b)" at the top of section 4 or adjacent section 4(b)	1		
	5 half a mark for internal consistency, ie if "NO" copies ringed or ticked, next line blank	0.5		

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if "YES" copies ringed or ticked, a number in next line
6 Note if this is consistent with section 8 of PF1/77

3

1c. Please prepare a Patents Form 7/77 for the same case.

You may assume that a Korean applicant company who employs the inventor is entitled to the rights to the invention by virtue of that employment.

1c. Marking of completed PF7/77

Referring to the numbered sections on the form

- | | |
|--|-----|
| 1/3. one mark for accurately including the same reference and applicant as on PF1/7 | 1 |
| 2 half a mark for leaving blank | 0.5 |
| 4 half a mark for accurately including the same title as on PF1/77 | 0.5 |
| 5 one mark for including something like
"by virtue of the applicant's employment of the inventor" | 1 |
| 6 half a mark for leaving blank or indicating zero | 0.5 |
| box one mark for correctly incorporating inventor details, both name and address
in full in box on rear | 1 |
| half a mark for underlining "LEE" | 0.5 |

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15

15

2. We are going to consider now the further progress of the application filed in response to the instructions of question 1.

For each question set out below, you are required to explain the period allowed and any base date from which the term is calculated.

Please note that none of these questions re term require you to calculate a particular calendar date.

2a. When will the application be published?

- | | |
|--|-----|
| 2a. half a mark for "after eighteen months from priority date" | 0.5 |
|--|-----|

2b. What would you need to do to prevent publication, and within what timescale?

- | | |
|---|-----|
| 2b. half a mark for "withdraw application" | 0.5 |
| half a mark for "before preparations for publication are completed" | 0.5 |

1

2c. Assuming the application continues, what is the term within which examination is to be requested?

- | | |
|--|-----|
| 2c. half a mark for "six months from publication (of application)" | 0.5 |
|--|-----|

2d. For some applications there is an alternative term set for filing the examination request. What is it?

- | | |
|--|---|
| 2d. one mark for within 24 months of the priority date | 1 |
|--|---|

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2e.	What are the two possible terms within which an application should be placed in condition for grant?			
	2e. <i>half a mark for "4 years and six months from priority date"</i>	0.5		
	<i>half a mark for "12 months from the date of first examination report"</i>	0.5		
	<i>whichever is the later.</i>			
			1	
2f.	Give the two possible terms within which the first renewal fee becomes payable on a granted British Patent. Ignore any grace periods or available extensions.			
	2f. <i>half a mark for "4 years from filing date"</i>	0.5		
	<i>half a mark for "3 months after date of grant"</i>	0.5		
			1	
				5
				20
3	Name three differences you would expect to find on a granted 'B' spec in the UK that wouldn't appear on a published 'A' spec. <i>Answer – any three of the following:-</i> <i>No abstract is published with the B spec</i> <i>There is 'B' on the front rather than an 'A'</i> <i>Any amendments made during prosecution would be published with the 'B' spec</i> <i>The term applicant is replaced by proprietor</i> <i>The date of publication of the granted patent is included on the B spec</i> <i>The Term application is replaced by patent.</i> <i>Any other things that are logical differences that are not mentioned above should also be allowed.</i>			
			3	
				3
				23
4	What do the following abbreviations stand for? EPC, EPO, PCT, WIPO <i>A half mark for each of the following:</i> <i>EPC - European Patent Convention</i> <i>EPO - European Patent Office</i> <i>PCT - Patent Co-operation Treaty</i> <i>WIPO - World Intellectual Property Organisation</i>			
		0.5		
		0.5		
		0.5		
		0.5		
			2	
				2
				25

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5	Give four ways of filing a GB patent application. <i>Half Mark for each of the following:</i> <i>By hand or courier at the Patent Office</i> <i>in London</i> <i>or Newport</i> <i>By post to the Patent Office</i> <i>By fax filing to the Patent Office</i> <i>By electronic filing to the Patent Office</i>	0.5 0 0 0.5 0.5 0.5		
		2	2	27
6	Your office has received from the EPO a Communication pursuant to Article 96(2) EPC – i.e. a “Substantive Examination Report” - dated 26 October 2004. A term of four months has been set for response.			
i)	By what date must a reply be received by the EPO? <i>7 March 2005</i>	1		
ii)	Exactly how did you calculate the due date? <i>26 October plus 10 days gives 5 November 2004</i> <i>plus 4 months gives 5 March 2005</i> <i>But 5 March is a Saturday so due date is next working day - Monday 7 March 2005</i>	1 1 1		
		3		
	The inventor is currently considering the Report but has advised your office that he will not be able to provide instructions for response before the deadline.			
iii)	What action should be taken, and by when, to safeguard the application at minimum cost? <i>A request for an extension</i> <i>of two months</i> <i>should be made in writing</i> <i>before expiry of the deadline</i>	1 1 1 1		
		4		
iv)	If no action is taken, what will happen next? <i>The EPO will deem the application withdrawn</i>	1		
v)	What could then be done to recover the application, and by when? <i>Request Further Processing</i>	1		

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	<i>within the period set by the EPO for doing so – 2 months</i>	1		
	<i>pay the Fee for Further Processing</i>	1		
	<i>and complete the omitted act</i>	1		
		4		
			13	40
7	This question is about “restitutio in integrum” or “Re-establishment of rights” at the European Patent Office.			
a.	In what general circumstance is re-establishment available?			
	a. <i>One mark for “when rights are lost by failure to meet a time limit”</i>	1		
b.	What is the time limit for requesting re-establishment? What is the overall term within which re-establishment must be requested?			
	b. <i>One & one half marks for “within 2 months of the removal of the cause for non-compliance”</i>	1.5		
	<i>(One mark only for “within 2 months of notice”)</i>			
	<i>One mark for “within 1 year of the expiry of the unobserved time limit”</i>	1		
		2.5		
c.	What actions need to be taken in an application for re-establishment?			
	c. <i>One half mark for request re-establishment</i>	0.5		
	<i>One half mark for complete the omitted acts</i>	0.5		
	<i>One half mark for pay any fees and fines</i>	0.5		
		1.5		
d.	To achieve re-establishment, what does the applicant need to show?			
	d. <i>One mark for something like “applicant took all due care required by the circumstances”</i>	1		
e.	Give four elements of a “normally satisfactory monitoring system”			
	e. <u><i>Four marks, one each for any of the following:</i></u>			
	<i>There has to be a proper reminder system</i>			
	<i>Personnel should have detailed knowledge of EPC</i>			
	<i>Office should have relevant literature, eg, Official Journal</i>			
	<i>Personnel must be trained, experienced & reliable</i>			
	<i>Personnel should be adequately supervised</i>			
	<i>Cross-checks for fatal dates</i>			

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Redundancy or failsafe requirements or other duplication
Check that documents have left the office
No reliance placed on documents ex EPO

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8 A European Patent application was filed on 16 June 2003 claiming priority of 14 July 2002.

a When is the first renewal fee due to be paid?

a *The first renewal is due to be paid at the end of the second year from the filing date (not the priority date) and is payable at the end of the month – Thursday 30 June 2005*

2
1
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b When does the grace period for payment of the renewal fee with surcharge expire?

b *The grace period runs to the end of the month six months hence ie Saturday 31 December 2005*

The period for payment is extended to the day when the EPO is next open for business, which (I think) will be Tuesday 3 January 2006

3
1
4

7
57

9 A PCT Application has been filed at a Receiving Office which is not competent to receive the Application.

a What action does that Office take?

a *The Application is forwarded to the International Bureau which then acts as Receiving Office. Rule 19.4 PCT.*

1
1
2

b What is the filing date?

b *Provided all the other requirements of Article 11 are met the Application takes as its filing date*

the date on which it was received by the non-competent office.

1
1
2

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			4	61
10	A PCT Application has been filed but has not yet entered the EPO Regional phase. What are the earliest and latest stages by which you can file a Divisional application <i>There is no provision for Division in the PCT.</i> <i>Divisional will have to be filed after entry into National/Regional Phase</i> <i>No later than the date on which the mention of grant is mentioned or</i> <i>until the application is refused or (deemed) withdrawn. Rule 25(1)</i>	1 1 1	3	64
11	What is the time limit for filing a demand (i) on a PCT Application filed after 1st January 2004? <i>(i) The later of 22 months from priority or</i> <i>3 months from transmittal of ISA and WO. Rule 54bis.1(i) and (ii) PCT.</i>	1 1	2	
	(ii) on a PCT Application filed before 1st January 2004? <i>(ii) No time limit.</i>	1	3	67
12	Who can make a PCT Application? <i>The Resident or National of a Contracting state alone</i> <i>or together with another person who need</i> <i>not be a resident or National of a Contracting state. Article 9 PCT.</i>	1 1 1	3	70
13	Where there are two or more Applicants for a PCT Application (i) Who should sign the request form? <i>One Applicant's signature is sufficient. Rule 26.2bis.</i>	1		
	(ii) Who must sign a notice of withdrawal of the Application?			

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All the Applicants must sign. Rule 90bis.5 PCT

		1			
			2		72
14	What is meant by each of the following on an EPO Specification:- A1 A2 A3				
	14 A1 [Application published with search report]	1			
	A2 [Application published without search report]	1			
	A3 [Publication of search report after A2 publication]	1			
		3			
			3		75
15	On an EPO Application you have received an A2 publication dated 3rd November 2004 and an A3 publication dated 17th December 2004. What is the deadline for requesting examination? How do you calculate the date? <i>6 months from the date of the search report (A3)</i> <i>i.e. exam should be requested by 17th June 2005</i>				
				1	
				1	
		2			
			2		77
16	Rule 51(4) of the EPC sets out what the applicant is required to do once the Examining Division decides to grant a European Patent.				
a.	What things must an applicant do following receipt of the communication within the period given under Rule 51(4). a <i>File translations of the claims</i> <i>into the two other official languages of EPC</i> <i>Pay grant and printing fee</i>			1	
				2	
				1	
		4			
b.	A European Patent Application originally contained 9 claims, but on issue of the notice under Rule 51(4) EPC it contains 11 claims. What will be the consequence? b. <i>Pay claims fee for extra claim over 10</i>				
		1			
			5		82

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17 On 8 October 2004, EPO issued a Rule 51(4) Communication (Intention to Grant) on an Application filed at EPO on 20 December 2000 and claiming priority of 5 January 2000. The Application designates UK. You paid all Grant and Printing Fees on 8 November 2004. Grant is expected in February 2005.

i. Are Renewal Fees due:

- a in 2004
- b in 2005?

i.a Yes 0.5
i.b Yes 0.5

1

ii. To which Patent Offices, if any, should Renewal Fees be paid:

- a in 2004
- b in 2005?

ii.a EPO 0.5
ii.b GB 0.5

1

iii. What are the due dates of payment, before extension:

- a in 2004
- b in 2005?

NB. Take no account of potential changes in UK Law.

ii.a [EPO] Monday 3 January 2005 1
EPO is closed on Friday 31 December 2004 - last day of month 2
ii.b [GB] Tuesday 20 December 2005 1

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18 You have been asked to act as agent and address for service in respect of the UK national phase of a European patent which was prosecuted in German according to the following details:-

Priority date: 2nd September 1998
EPO Filing date: 1st September 1999
Rule 51(4) date: 11th July 2003
Mention of grant in the Official Bulletin: 21st November 2004
Designating: DE,FR,GB,IT

a) What needs to be filed where and by when in order to ensure the European patent is effective in the UK,

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	noting any forms and fees which are applicable but ignoring any extensions of time?			
	<i>a) File Form 54/77 (no fee)</i>		1	
	<i>with an English translation of the EP spec at the UKPO</i>		1	
	<i>within 3 months of mention of grant</i>		1	
	<i>i.e. by 21st February 2005</i>		0.5	
		3.5		
b)	When will this patent expire in the UK?			
	<i>b) 31 Aug 2019</i>		0.5	
	<i>(20 yrs from filing date)</i>		0.5	
		1		
c)	What is an address for service?			
	<i>The address to which all correspondence relating to the patent should be sent.</i>	0.5		
			5	93
19	Which four of the following are essential to establish the filing date for a new UK Patent Application not claiming priority?			
i.	Request for Grant of Patent.			
ii.	Filing Fee			
iii.	Statement of Inventorship			
iv.	Specification			
v.	Drawings			
vi.	Claims			
vii.	Identity of Applicant			
viii.	Request for Examination			
	<i>i. Request for Grant of Patent;</i>			
	<i>iv. Specification</i>			
	<i>v. Drawings</i>			
	<i>vii. Identity of Applicant.</i>	4		
			4	97
20	You filed a new UK patent application on 6th January 2005 consisting of Form 1/77 plus a description of the specification. No fees were paid. Today, your client has instructed you that he would like to receive the formalities report before the search is requested.			
i	What must you do next taking into account any forms and fees payable?			
	<i>i File new Form AF1 plus the application fee of £30.00. This is a trigger</i>			

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	<i>for the UKPO to begin the preliminary examination on this application.</i>	2		
	<i>NB Preliminary examination can only begin when the application fee is paid.</i>			
ii	<i>When can you request preliminary (formalities) examination?</i>			
	<i>ii There is no set deadline as long as it is within the priority year</i>	1		
			3	100

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Cell: G40

Comment: Michael Berkson:
What happens if not consistent?