

Patent Administrators' Course

MOCK EXAMINATION 2009

1. You are employed by the firm of Morrison Densmore & Kreiger, European Patent Attorneys. Complete the attached patents forms according to the information and instructions contained in the accompanying client's letter and memorandum from your supervising attorney James Morrison.

(15 marks)

2. What options are available for filing the application described in Question 1 so as to receive today's date as its date of filing?

(3 marks)

- By hand (1mark)
- By fax (1 mark)
- Online (1 mark)

3. You receive instructions from a West Coast US attorney to file a UK patent application claiming priority of a US application filed on 29th January 2008, but due to the eight hour time difference these instructions do not arrive in your office until 10 p.m. on 29th January 2009, when your office is closed. You learn that the US attorney received written filing instructions from the applicant on 22nd January 2009.

(a) What can you do to file the application claiming priority?

(4 marks)

(b) What is the last date on which the application can be filed with this priority claim?

(2 marks)

(a) Normal priority term expired 29/01/2009 – too late to file within this term (1 mark)

Late filing was unintentional – applicant intended to file and instructed in good time (1 mark)

File evidence of intention to file timely + request for late claim to priority on PF3 + fee

(2 marks)

(b) Priority term extended by 2M to 29/03/2009 (1 mark)

A Sunday. So can file up to 30/03/2009.

(1 mark)

4. (a) At what stage in the application procedure are UK, European and PCT applications published?

(2 marks)

(b) What do A1, A2 and A3 publications signify?

(3 marks)

- (a) 18M from priority
- (b) A1: as-filed spec + search report; A2: as-filed spec; A3: search report

5. Which of the A1, A2 or A3 publications determines the deadline for requesting examination of a European patent application?

(2 marks)

A1, A3.

6. How is the deadline in question 5 calculated?

(2 marks)

6M from publication of search report.

7. The EPO issued a Communication pursuant to Article 94(3) EPC (a substantive examination report) dated 11th November 2008. This communication arrives at your office on 14th November 2008. The communication provides a term of 4 months from notification in which to file a response.

(a) On what date is the response due? Explain how you arrived at your answer.

(4 marks)

(b) What are the consequences if the response is not filed by this date?

(1 mark)

Today your patent attorney tells you that she will not be able to prepare the response until 30th April 2009 as she is waiting for some information from the inventor.

(c) What action should you take?

(3 marks)

(a) Deemed date of receipt (notification) = 11/11/2008 + 10 days = 21/11/2008. (2 marks)

Add 4M term = 21/03/2009 (1 mark)

A Saturday, so term extended to 23/03/2009 (1 mark)

(b) App deemed withdrawn (1 mark)

(c) File written request for 2M ext, before original time limit expires (3 marks)

8. (a) Who can file a European divisional application?

(1 mark)

(b) Where and when can you file a European divisional application?

(3 marks)

(c) What fees must be paid to file a European divisional application and when will they be due?

(4 marks)

- (a) Applicant or successor in title entered in Register (1 mark)
- (b) EPO branches in Munich, Berlin or The Hague (1 mark)
- Before the date on which the mention of grant is published or the application is refused or (deemed) withdrawn (2 marks)
- (c) Filing and search fees due 1M from filing (2 marks)
- Any renewal fees paid on parent must also be paid on divisional. 4M from filing divisional. (2 marks)

9. A European patent application was filed on 1st September 2006, claiming a priority of 1st October 2005.

- (a) On what date was the first renewal fee due? (3 marks)
- (b) On what date does the grace period for late payment expire? (2 marks)
- (c) What would be the time limit for re-establishment of rights if the grace period is missed? (2 marks)

- (a) End of month containing 2nd filing anniversary = 30/09/2008 (3 marks)
- (b) End of 6th month after (a) = 31/03/2009 (2 marks)
- (c) 2M from removal of cause of non-compliance, or 12M from missed time limit (= 30/09/2009), whichever earlier (2 marks)

10. You received a communication from the EPO dated 5th January 2009 notifying you of the decision to refuse an application. When must the notice of appeal and grounds of appeal be filed? (5 marks)

Notification of the decision refuse deemed to have occurred on 15/01/2009 (10-day rule) (1 mark)
 Notice of appeal must be filed 2M from notification of decision to be appealed = 15/03/2009, which is Sunday. Due date is therefore Mon 16 Mar 2009 (2 marks)
 Grounds of appeal must be filed 4M from notification of decision to be appealed = 15/05/2009 (2 marks)

11. Who may file a PCT application? (3 marks)

- A citizen or resident (1 mark)
- of a PCT contracting state (1 mark)
- alone or together with other persons who need not be citizens/residents of a PCT contracting state (1 mark)

12. (a) What are the competent receiving offices for a UK citizen who wishes to file a PCT application?

(3 marks)

(b) What happens if the application is filed at an office of a PCT contracting state which is not competent to receive it?

(1 mark)

(a) UKIPO [GB], EPO [EP], International Bureau [IB] (3 marks)

(b) App is forwarded to IB (1 mark)

13. The UKIPO acting as receiving office for an international application issues a letter dated 10th February 2009 calling for formal drawings to be supplied within a time limit of two months. What is the latest date for filing a response? (Ignore requests for extension of time).

(3 marks)

10/02/2009 + 2M = 10/04/2009 (1 mark)

Which is Good Friday [office closed] (1 mark)

Office next open 14/04/2009, so this is latest date. (1 mark)

14. What is the time limit for filing a "Demand" for an international application?

(2 marks)

3M from date of transmittal of ISR or 22M from priority, whichever later.

15. A PCT application was filed on 24th August 2007, claiming a priority of 24th August 2006. Without extensions, what is the last date for:

(a) entering the European regional phase

(3 marks)

(b) entering the US national phase?

(2 marks)

(a) 31M from priority = 24/03/2009 (3 marks)

(b) 30M [from priority] = 24/02/2009 (2 marks)

16. In the context of the PCT, what is the meaning of the following abbreviations?

IPEA

IB

ISA

IPRP

(4 marks)

International Preliminary Examination Authority
International Bureau
International Search Authority
International Preliminary Report on Patentability

17. What elements must an international application contain in order to obtain a filing date under the Patent Co-operation Treaty?

(5 marks)

Name of applicant
Indication that application is a PCT application
Designation of at least one PCT contracting state
A description
A claim

18. A UK based client comes to you with an invention concerning a nuclear warhead which he wishes to patent in the USA. What, if any, are the restrictions on filing the application?

(3 marks)

Must seek permission from UKIPO to file abroad or (1 mark)
Must file UK pat app and wait 6 weeks before filing abroad (2 marks)

19. You have received a Communication pursuant to Rule 71(3) EPC dated 29th January 2009 informing you of the EPO's intention to grant a patent on a European patent application. What steps must be taken, and by when?

(6 marks)

File claims translations into the two other EPO languages [French and German] (1 mark)
Pay grant and printing fee (1 mark)
Pay supplementary printing fee (if any) (1 mark)
Pay additional claims fees (if any) (1 mark)
Four months from the date of notification = four months from 08/02/2009 = 08/06/2009 [inextensible]
(2 marks)

20. For a European patent application, which of the following can be corrected by further processing?

- (a) Failure to pay the filing and search fee
- (b) Failure to pay a renewal fee
- (c) Failure to file a translation of the claims under Rule 71(3) EPC 2000 (formerly rule 51(4) EPC 1973)
- (d) Missing the date for applying for further processing

(4 marks)

(a) and (c). 1 mark for each correct answer. Given the wording of the question, omission of (b) and (d) from the answer is a correct response and therefore earns the mark(s).