

2022 ICPA Mock Mark Scheme

Question 1

What is the Convention filing deadline (end of priority period) for a patent application filed on 25 January 2021? Show your calculations.

2 marks

Answer

[If candidate shows knowledge of the deadline being 12 months from the filing date, but shows no (or incorrect) calculations: award a maximum of 1 mark.]

12 months from the filing date of the application

25 January 2021 + 12 months

1 mark

= Tuesday, 25 January 2022

1 mark

Question 2

A European patent application was filed on 10 June 2021, claiming priority from a UK patent application filed on 12 June 2020. The minimum amount of fees was paid on filing to secure the filing date. The European A2 publication was published on 16 December 2021. The European A3 publication was published on 12 January 2022.

a) What are the next actions to be taken to ensure that the European patent application is not deemed withdrawn?

3 marks

b) By when must these actions be taken? Show your calculations.

2 marks

Total: 5 marks

Answer

a) Respond to the search opinion (if required/if negative)

1 mark

Pay the designation fees

1 mark

Pay the examination fees

1 mark

[No separate mark for 'request examination'; this will have been done on filing since the box on the EPO form is pre-checked.]

2022 ICPA Mock Mark Scheme

- b) *[If candidate shows knowledge that the deadline is 6 months from publication of the search report (A3) but shows no (or incorrect) calculations: award a maximum of 1 mark.]*

12 January 2022 + 6 months

1 mark

= Tuesday 12 July 2022

1 mark

Question 3

You filed a first (priority founding) GB patent application on 13 April 2020. The application was published on 20 October 2021.

- a) **By when must examination be requested? Show your calculations.**

2 marks

- b) **What form should be used to request examination?**

1 mark

Total: 3 marks

Answer

- a) *[If candidate shows knowledge of the deadline being 6 months from the publication date, but shows no (or incorrect) calculations: award a maximum of 1 mark.]*

6 months from publication date

20 October 2021 + 6 months

1 mark

= Wednesday, 20 April 2022

1 mark

- b) Form PF10

1 mark

Question 4

A GB patent application was filed on 27 August 2018. The patent was granted on 17 November 2021.

- a) **By when is the first renewal fee due? Show your calculations.**

3 marks

- b) **What is the last date for late payment? Show your calculations.**

2 marks

Total: 5 marks

Answer

- a) *[If candidate shows knowledge of the deadline being the last day of the month containing the 4th anniversary of filing, but shows no (or incorrect) calculations: award a maximum of 1 mark.]*

Renewal fee is due by the last day of the month containing the 4th anniversary of filing (in respect of the 5th year).

27 August 2018 + 4 years

1 mark

= 27 August 2022

1 mark

Payable to the end of the month: Wednesday, 31 August 2022

1 mark

- b) *[If candidate shows knowledge that the renewal fee can be paid until the end of the 6th month from the end of August 2022 (or the date given in the answer to part a)), but shows no (or incorrect) calculations: award a maximum of 1 mark.]*

Renewal fee can be paid up to 6 months from the end of August 2022

31 August 2022 + 6 months

1 mark

= Tuesday, 28 February 2023

1 mark

Question 5

A GB divisional patent application was validly submitted to the IPO on 5 January 2022, based on a parent GB patent application with a filing date of 16 August 2021.

What is the filing date of the divisional application? Explain your answer.

1 mark

Answer

16 August 2021. The filing date of the divisional application is the same as the filing date of the parent application.

[Both the date and the explanation are required for this mark.]

1 mark

Question 6

A GB patent application was filed without an abstract on 17 August 2021. The GB patent application claimed priority from a US patent application filed on 22 January 2021.

By when must the abstract be filed? Show your calculations.

7 marks

Answer

[If candidate shows knowledge that the abstract must be filed the later of 12 months from priority or 2 months from filing date, but shows no (or incorrect) calculations: award a maximum of 1 mark.]

The abstract must be filed by the later of 12 months from the priority date or 2 months from the filing date.

12 months from priority:

22 January 2021 + 12 months

1 mark

= Saturday, 22 January 2022

1 mark

Non-working day, so deadline rolls over to Monday 24 January 2022

1 mark

2 months from filing

= 17 August 2021 + 2 months

1 mark

= Sunday, 17 October 2021

1 mark

Non-working day, so deadline rolls over to Monday 18 October 2021

1 mark

Therefore, the abstract must be filed by Monday, 24 January 2022

[An identification of the later date, or that the later date is the deadline, must be given for this mark to be awarded.]

1 mark

Question 7

A PCT application was filed on 20 April 2021 claiming priority from a US patent application filed on 13 May 2020. The International Search Report was issued on 9 September 2021. National phase entry will be required in EP and US.

What is the final deadline for filing a Demand? Show your calculations.

6 marks

Answer

[If candidate shows knowledge of the deadline being the later of 22 months from the priority date or 3 months from the date of issuance of the Search Report, but shows no (or incorrect) calculations: award a maximum of 1 mark.]

2022 ICPA Mock Mark Scheme

22 months from priority date

13 May 2020 + 22 months

1 mark

= Sunday, 13 March 2022

1 mark

Non-working day, so deadline rolls over to Monday, 14 March 2022

1 mark

3 months from International Search Report

9 September 2021 + 3 months

1 mark

= 9 December 2021 (Thursday)

1 mark

Therefore, the deadline for filing a Demand is 14 March 2022

[An identification of the later date, or that the later date is the deadline, must be given for this mark to be awarded.]

1 mark

Question 8

The EPO performed the international search for a PCT application and prepared the associated Written Opinion (which raised objections). The European regional phase of this PCT application was entered in due time, paying all necessary fees. A Rule 161/162 communication was issued dated 29 July 2021. This communication was received in your office on 27 July 2021. Notification of this communication sets a 6-month time limit to file a response to the Written Opinion.

a) By when must the response be filed? Show your calculations.

3 marks

b) If no response is filed by the date calculated in a), what actions can be taken to continue with the application and by when?

3 marks

Total: 6 marks

Answer

a) *[If candidate shows knowledge of the 10 day rule but shows no (or incorrect) calculations: award a maximum of 1 mark.]*

29 July 2021 + 10 days

1 mark

= (Sunday) 8 August 2021

1 mark

8 August 2021 + 6 months

= Tuesday, 8 February 2022

1 mark

b) *[If candidate shows knowledge that no extension of time is available and further processing will be required: award a maximum of 1 mark.]*

The EPO will issue a notice informing the applicant of a loss of rights. In response the applicant can continue by requesting further processing:

by paying the further processing fee

1 mark

and by completing the missing actions/responding to the Written Opinion

1 mark

within two months *[of notification]* of the loss of rights

[indication of two months is sufficient to gain this mark; no need to explicitly say 'notification' or '10 days']

1 mark

Question 9

You work as a Paralegal for the attorney Shani Barwick at the firm Ingleby Barwick. The firm's details are:

Ingleby Barwick
52 Ocean View
Ambridge
Surrey KT54 7DD
United Kingdom
Telephone: 0123 456489

You have been asked to prepare a PCT Request for an application in English entitled "Concrete Surface Retarder" for your client Barn Stomp Limited. Barn Stomp Limited will be the applicant and is a UK company. The reference will be BSL/WO252 and Shani will be the attorney named as agent. All communications for the application are to be exclusively in electronic form to Ingleby Barwick at the main email address: ip@inglebybarwick.com.

Priority is to be claimed from Barn Stomp Limited's GB patent application no. 2101234.5, filed on 1 February 2021. The DAS Access Code to be provided to the IB is FE31.

The inventor is a British citizen: Charles Snell, c/o Barn Stomp Limited, 64 Industrial Way, Ambridge, Surrey, KT54 5BZ.

There are

25 pages of description,
15 claims on 3 pages,
a 1 page abstract, and
5 drawings on 2 pages.

Figure 2 should accompany the abstract.

2022 ICPA Mock Mark Scheme

The accounts department will prepare the fee calculation sheet to accompany the application.

Prepare the PCT Request form (form PCT RO/101).

10 marks

Answer

See completed form PCT RO/101.

10 marks

Question 10

The EPO issued an examination report dated 17 August 2021, setting a 4-month period for response. The examination report was received in your office on 19 August 2021. A 2-month extension of time was obtained.

By when must a response be filed? Show your calculations.

5 marks

Answer

[If candidate shows knowledge of the 10 day rule but shows no (or incorrect) calculations: award a maximum of 1 mark.]

17 August 2021 + 10 days

1 mark

= 27 August 2021 (Friday)

1 mark

+ 6 months

1 mark

= Sunday, 27 February 2022

1 mark

Non-working day, so deadline rolls over to Monday, 28 February 2022

1 mark

Question 11

A UK Design was registered on 7 January 2017. The UK design claimed priority from a US Design application filed on 8 July 2016.

a) By when must the first renewal fee be paid, including any available extensions of time? Show your calculations.

4 marks

b) If all renewal fees are paid, when will this design registration expire? Show your calculations.

2 marks

Answer

- a) *[If candidate shows knowledge that the renewal fee is due 5 years from the registration date but shows no (or incorrect) calculations: award a maximum of 1 mark.]*

5 years from the registration date

7 January 2017 + 5 years

1 mark

= 7 January 2022 (Friday)

1 mark

A 6 month grace period is available

7 January 2022 + 6 months

1 mark

= Thursday, 7 July 2022

1 mark

- b) *[If candidate shows knowledge that the design will expire a maximum of 25 years from the registration date but shows no (or incorrect) calculations: award a maximum of 1 mark.]*

25 years from the registration date

7 January 2017 + 25 years

1 mark

= 7 January 2042

1 mark

Question 12

You filed a first (priority-founding) GB patent application on 11 January 2022 without a description or a reference to an earlier application. The error was noticed on 14 January 2022, and a description was filed on the same date to complete the application.

What will happen to your application? Explain your answer.

2 marks

Answer

The UK IPO will redate the application to 14 January 2022

1 mark

because a description (or reference to one) is required to obtain a filing date.

1 mark

2022 ICPA Mock Mark Scheme

Question 13

The UKIPO issued an examination report dated 24 November 2021. The examination report sets a 2-month deadline for filing a response. It will not be possible to file the response by the deadline.

Without relying on any discretionary decisions by the UK IPO, what should be done to ensure the application remains pending and by when? Show your calculations.

4 marks

Answer

[If candidate shows knowledge of availability of a 2-month extension as-of-right, but shows no (or incorrect) calculations: award a maximum of 1 mark.]

For this application to continue, you should:

File the response and a retrospective request for an extension of time

1 mark

By the end of the extended period:

The original deadline is

24 November 2021 + 2 months

= 24 January 2022

1 mark

The extended deadline is

24 January 2022 + 2 months

1 mark

[Award both marks immediately above where the candidate adds 4 months to the original deadline, and all dates are correct.]

= 24 March 2022 (Wednesday)

1 mark

Question 14

A priority-founding (first filed) GB design application was filed on 21 October 2021.

What is the Convention priority deadline? Show your calculations.

2 marks

Answer

[If candidate shows knowledge of the 6-month convention period, but shows no (or incorrect) calculations: award a maximum of 1 mark.]

21 October 2021 + 6 months

1 mark

= Thursday, 21 April 2022

1 mark

Question 15

A communication pursuant to Rule 71(3) EPC dated 7 December 2021 is received in your office on 10 December 2021. The communication informs you of the EPO's intention to grant a patent on a European patent application. The 30-page specification is in English. During prosecution the claims increased in number from 14 to 20.

- a) **What steps must be taken in response to this communication?** 3 marks
- b) **By when must these steps be taken? Show your calculations.** 5 marks

Total: 8 marks

Answer

- a) File French and German claims translations 1 mark
- Pay grant and printing fee 1 mark
- Pay (5) additional claims fees
[It is not necessary to specify the number of excess claims fees to gain this mark, but candidates must demonstrate knowledge that excess claims fees need paying; i.e. this mark is not to be awarded for generic statements such as "Pay any excess claim fees or excess page fees that are due.] 1 mark
- b) *[If candidate shows knowledge of the deadline being 4 months from notification of the communication, but shows no (or incorrect) calculations: award a maximum of 1 mark.]*

Deadline is 4 months from the date of notification of the communication

7 December 2021 + 10 days 1 mark

= 17 December 2021 1 mark

17 December 2021 + 4 months 1 mark

= Sunday, 17 April 2022 (Easter Sunday) 1 mark

Non-working day, so deadline rolls over to the next working day:
Tuesday, 19 April 2022 1 mark

2022 ICPA Mock Mark Scheme

Question 16

A PCT application was filed on 12 January 2021. The PCT application has an earliest priority date of 14 January 2020. The PCT application was published in Japanese. You are now entering the European regional phase of this PCT application.

- a) In which language(s) may the translation of the specification be filed? 1 mark
- b) By when must the translation be filed without incurring penalty fees? Show your calculations. 3 marks

Total: 4 marks

Answer

- a) English, French or German
[All three are needed for this mark] 1 mark

- b) *[If candidate shows knowledge of the deadline being 31 months from the earliest priority date but shows no (or incorrect) calculations: award a maximum of 1 mark.]*

31 months from earliest priority
14 January 2020 + 31 months 1 mark

= Sunday, 14 August 2022 1 mark

Non-working day, so deadline rolls over to Tuesday 16 August 2022 (Monday 15 August is Assumption Day) 1 mark

2022 ICPA Mock Mark Scheme

Question 17

You file an international patent application in Korean, claiming priority from a Korean patent application. The applicant is an English company, which is entitled to file the application. You file the international patent application at the UK Intellectual Property Office.

What will happen? Explain your answer.

4 marks

Answer

The UK IPO will forward the application to the International Bureau (which will become the Receiving Office)

1 mark

This will happen because the UK IPO is not a competent Receiving Office

1 mark

for applications filed in Korean.

[An indication that the reason the IPO is not a competent RO due to the language of filing is sufficient to gain this mark.]

1 mark

The application will retain its original filing date

1 mark

Total: 80 marks

PCT

REQUEST

The undersigned requests that the present international application be processed according to the Patent Cooperation Treaty.

For receiving Office use only

International Application No.

International Filing Date

Name of receiving Office and "PCT International Application"

Applicant's or agent's file reference (*if desired*) (25 characters maximum)

Box No. I TITLE OF INVENTION	
Box No. II APPLICANT <input type="checkbox"/> This person is also inventor	
Name and address: (<i>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.</i>)	Telephone No.
	Facsimile No.
	Applicant's registration No. with the Office
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. <input type="checkbox"/> as advance copies followed by paper notifications; or <input type="checkbox"/> exclusively in electronic form (no paper notifications will be sent). E-mail address:	
State (<i>that is, country</i>) of nationality:	State (<i>that is, country</i>) of residence:
This person is applicant for the purposes of: <input type="checkbox"/> all designated States <input type="checkbox"/> the States indicated in the Supplemental Box	
Box No. III FURTHER APPLICANT(S) AND/OR (FURTHER) INVENTOR(S)	
<input type="checkbox"/> Further applicants and/or (further) inventors are indicated on a continuation sheet.	
Box No. IV 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: <input type="checkbox"/> agent <input type="checkbox"/> common representative	
Name and address: (<i>Family name followed by given name; for a legal entity, full official designation. The address must include postal code and name of country.</i>)	Telephone No.
	Facsimile No.
	Agent's registration No. with the Office
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. <input type="checkbox"/> as advance copies followed by paper notifications; or <input type="checkbox"/> exclusively in electronic form (no paper notifications will be sent). E-mail address:	
<input type="checkbox"/> 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.	

1

1

1

1

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: <i>(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.)</i>	This person is: <input type="checkbox"/> applicant only <input type="checkbox"/> applicant and inventor <input type="checkbox"/> inventor only <i>(If this check-box is marked, do not fill in below.)</i>
Applicant's registration No. with the Office	

State <i>(that is, country)</i> of nationality:	State <i>(that is, country)</i> of residence:
---	---

This person is applicant for the purposes of:	<input type="checkbox"/> all designated States	<input type="checkbox"/> the States indicated in the Supplemental Box
---	--	---

Name and address: <i>(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.)</i>	This person is: <input type="checkbox"/> applicant only <input type="checkbox"/> applicant and inventor <input type="checkbox"/> inventor only <i>(If this check-box is marked, do not fill in below.)</i>
Applicant's registration No. with the Office	

State <i>(that is, country)</i> of nationality:	State <i>(that is, country)</i> of residence:
---	---

This person is applicant for the purposes of:	<input type="checkbox"/> all designated States	<input type="checkbox"/> the States indicated in the Supplemental Box
---	--	---

Name and address: <i>(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.)</i>	This person is: <input type="checkbox"/> applicant only <input type="checkbox"/> applicant and inventor <input type="checkbox"/> inventor only <i>(If this check-box is marked, do not fill in below.)</i>
Applicant's registration No. with the Office	

State <i>(that is, country)</i> of nationality:	State <i>(that is, country)</i> of residence:
---	---

This person is applicant for the purposes of:	<input type="checkbox"/> all designated States	<input type="checkbox"/> the States indicated in the Supplemental Box
---	--	---

Name and address: <i>(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.)</i>	This person is: <input type="checkbox"/> applicant only <input type="checkbox"/> applicant and inventor <input type="checkbox"/> inventor only <i>(If this check-box is marked, do not fill in below.)</i>
Applicant's registration No. with the Office	

State <i>(that is, country)</i> of nationality:	State <i>(that is, country)</i> of residence:
---	---

This person is applicant for the purposes of:	<input type="checkbox"/> all designated States	<input type="checkbox"/> the States indicated in the Supplemental Box
---	--	---

<input type="checkbox"/> Further applicants and/or (further) inventors are indicated on another continuation sheet.

1

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 Germany **is not designated** for any kind of national protection
- JP Japan **is not designated** for any kind of national protection
- KR Republic of Korea **is not designated** for any kind of national protection

(The check-boxes above may only be used to exclude (irrevocably) the designations concerned if, at the time of filing or subsequently under Rule 26bis.1, the international application contains in Box No. VI a priority claim to an earlier national application filed in the particular State concerned, in order to avoid the ceasing of the effect, under the national law, of this earlier national application.)

Box No. VI PRIORITY CLAIM AND DOCUMENT

The priority of the following earlier application(s) is hereby claimed:

Filing date of earlier application (day/month/year)	Number of earlier application	Where earlier application is:		
		national application: country or Member of WTO	regional application: regional Office	international application: receiving Office
item (1)				
item (2)				
item (3)				

Further priority claims are indicated in the Supplemental Box.

Furnishing the priority document(s):

The **receiving Office** is requested to prepare and transmit to the International Bureau a certified copy of the earlier application(s) (only if the earlier application(s) was filed with the receiving Office which, for the purposes of this international application, is the receiving Office) identified above as:

- all items item (1) item (2) item (3) other, see Supplemental Box

The **International Bureau** is requested to obtain from a digital library a certified copy of the earlier application(s) identified above, using, where applicable, the access code(s) indicated below (if the earlier application(s) is available to it from a digital library):

- item (1) access code _____ item (2) access code _____ item (3) access code _____ other, see Supplemental Box

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), or an element or part of the description, claims or drawings referred to in Rule 20.5bis(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/ _____



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	This international application is accompanied by the following item(s) (<i>mark the applicable check-boxes below and indicate in right column the number of each item</i>):	Number of items
(a) request form PCT/RO/101 (including any declarations and supplemental sheets)		1. <input type="checkbox"/> fee calculation sheet.	
(b) description (excluding any sequence listing part of the description, see (f), below)		2. <input type="checkbox"/> original separate power of attorney	
(c) claims		3. <input type="checkbox"/> original general power of attorney	
(d) abstract		4. <input type="checkbox"/> copy of general power of attorney; reference number:	
(e) drawings (if any)		5. <input type="checkbox"/> priority document(s) identified in Box No. VI as item(s)	
(f) sequence listing part of the description (if any)		6. <input type="checkbox"/> Translation of international application into (<i>language</i>):	
		7. <input type="checkbox"/> separate indications concerning deposited microorganism or other biological material	
		8. <input type="checkbox"/> (<i>only where item (f) is marked in the left column</i>) copy in electronic form (Annex C/ST.25 text file) on physical data carrier(s) of the sequence listing, not forming part of the international application, which is furnished only for the purposes of international search under Rule 13ter (<i>type and number of physical data carriers</i>).	
		9. <input type="checkbox"/> (<i>only where item (f) (in the left column) and item 8 (above) are marked</i>) a statement confirming that “the information recorded in electronic form submitted under Rule 13ter is identical to the sequence listing as contained in the international application” as filed on paper	
		10. <input type="checkbox"/> copy of results of earlier search(es) (Rule 12bis.1(a))	
		11. <input type="checkbox"/> other (<i>specify</i>):	
Total number of sheets :			
Figure of the drawings which should accompany the abstract:		Language of filing of the international application:	

Box No. X SIGNATURE OF APPLICANT, AGENT OR COMMON REPRESENTATIVE

Next to each signature, indicate the name of the person signing and the capacity in which the person signs (if such capacity is not obvious from reading the request).

For receiving Office use only	
1. Date of actual receipt of the purported international application:	2. Drawings: <input type="checkbox"/> received: <input type="checkbox"/> not received:
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):	6. <input type="checkbox"/> 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: