2023 ICPA Mark Scheme

Question 1

What is a patent? Explain your answer.

3 marks

Answer

A monopoly (usually granted by a state) for a period of time (20 years) [an indication of a time period / 20 years is needed for this mark]

1 mark

... to an inventor [accept 'applicant'] ...

1 mark

... in exchange for disclosing an invention.

1 mark

Total: 3 marks

Question 2

What is the term of protection in the UK, assuming all relevant renewal fees are paid, for

a) a patent? 1 mark

b) a registered design? 1 mark

Total: 2 marks

Answer

a) 20 years / from the filing date [both parts of the answer needed for the mark]

1 mark

b) 25 years / from the filing [or registration] date [both parts of the answer needed for the mark]

1 mark

Total: 2 marks

Question 3

A priority (first filed) GB patent application was filed on 18 January 2022 with very rough hand-drawn figures and with no abstract.

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

2 marks

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

2 marks

Total: 4 marks

Answer:

a) [If candidate shows knowledge of the deadline of 15 months from filing date but shows no (or incorrect) calculations: award a maximum of 1 mark.]

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

Question 4

A first GB patent application was filed on 29 September 2018, without claiming priority. A first examination report was issued in respect of this application on 14 March 2022.

What is the deadline for filing a divisional application? Show your calculations.

7 marks

Answer

[If candidate shows knowledge of the divisional deadline being 3 months before the end of the compliance period, <u>and</u> that the compliance period is the later of

- i) 4.5 years from the earliest filing date, and
- ii) 12 months from the issuance of the first examination report, but shows no (or incorrect) calculations: award a maximum of 1 mark for this question.]

Compliance date is the later of

i) 4.5 years from the earliest filing date

29 September 201	18 + 4 years 6 months	1 mark
= 29 March 2023 ((Wednesday)	1 mark

or

ii) 12 months from the issuance of the first examination report

14 March 2022 + 1	12 months	1 mark
= 14 March 2023 ((Tuesday)	1 mark

Therefore the compliance date is 29 March 2023. **1 mark** [A separate identification of this date is needed to gain this mark. It follows that this mark can only be awarded where candidates show both calculations.]

The divisional deadline is 3 months before the compliance date.

29 March 2023 – 3 months

1 mark

= 29 December 2022 (Thursday)

1 mark

Total: 7 marks

Question 5

An examination report dated 3 October 2022 is issued on a GB patent application. The examination report sets a deadline for response of 5 December 2022.

a) What is the latest date for response, without needing to rely on 3 marks the discretion of the UK IPO?

b) What must you file by the date calculated in part a)? 1 marks

Total: 4 marks

Answer

a) 5 December 2022 + 2 months 1 mark

= 5 February 2023 (Sunday) 1 mark

Next working day is 6 February 2023 (Monday) 1 mark

b) A request for an extension of time and a response to the examination **1 mark** report

[Both parts of this answer are needed to gain the mark.]

Total: 4 marks

Question 6

You work as a paralegal at Peter Rabbyt Limited. One of the partners, Lorna Ingleby, sends you the following instructions.

Please prepare the form for filing an international patent application naming me as agent, details as follows:

Client: Foundling Technology Ltd a UK company based at

The Stable Yard, Dingle Lane, London, SE3 5QQ, UK

(applicant for all States)

Our reference: FTL/PCT01

This application will claim priority from their earlier GB application, which was filed in English.

Title: BRIDLE CLIP RETAINER

We'll use the same specification documents for filing the international application.

The details of the priority application are:

Application No: GB 2205432.1 Filing date: 28 January 2022

Description: 18 pages

Claims: 3 pages - 15 claims

Abstract: 1 page (accompanied by Figure 2)

Drawings: 5 pages - 8 figures (PDAS) Digital library access code: ABC1

Inventor: Sienna DOBBINS (a UK citizen) - address c/o Foundling Technology Ltd

Please request that we receive all notifications by email only. We won't file a certified copy of the priority document, but will make use of the PDAS code.

There's no need to fill in a fee sheet. Finance will do this. The fee sheet will be included on filing.

Many thanks, Lorna

Lorna Ingleby, CPA, EPA Peter Rabbyt Limited, 45 Fleet Lane South London SE23 1ZZ, UK Tel: 020 801 6565 Lingleby@prabbyt.com

Complete form PCT/RO/101.

10 marks

Question 7

You file an International patent application in Spanish, claiming priority from a Spanish patent application, for a Spanish applicant at the European Patent Office.

What will happen? Explain your answer.

3 marks

Answer

The EPO is not a competent Receiving Office	1 mark
They will forward it to the International Bureau (IB) who will become the RO	1 mark
It will keep the original Receiving Office filing date	1 mark

A PCT application was filed on 06 May 2021 claiming priority from a GB application filed on 10 June 2020.

What is the latest date for filing an EP Regional Phase application? Show your calculations.

2 marks

Answer:

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

10 June 2020 + 31 months 1 mark

= 10 January 2023 (Tuesday) 1 mark

Question 9

You filed a PCT application on 29 April 2022 claiming priority from a GB application filed on 30 April 2021. The International Search Report and Written Opinion dated 06 October 2022 was received in your office on 11 October 2022. Your client wishes to request International Preliminary Examination.

By what date must the Demand be filed? Show your calculations.

5 marks

Answer

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

The later of the two, so <u>28 February 2023</u> **1 mark**

[A separate identification of this date is needed to gain this mark. It follows that this mark can only be awarded where candidates show both calculations.]

Your client wishes to oppose European Patent No. 3459876, which was filed on 23 April 2020 and granted on 16 November 2022.

What steps must be taken and by what date? Show your calculations.

5 marks

Answer

[If candidate shows knowledge of the deadline being 9 months from the publication of grant, but shows no (or incorrect) calculations: award a maximum of 1 mark.]

File Notice of Opposition (accept "file an opposition")	1 mark
File Grounds of Opposition (accept "file reasons/arguments")	1 mark
Pay opposition fee (accept "pay fee")	1 mark
Within 9 months of the date of grant / 16 November 2022 + 9 months	1 mark
= 16 August 2023 (Wednesday)	1 mark

Question 11

You received a Decision to refuse European Patent application No. 07654321.0 in your office on 13 January 2023. The communication is dated 06 January 2023. Your client wishes to appeal the decision, taking advantage of using the latest dates available.

What steps must be taken and by what date? Show your calculations. 8 marks

Answer

[If candidate shows knowledge of

• the deadline to file the notice of appeal being 2 months from the date of notification of the decision,

but shows no (or incorrect) calculations: award a maximum of 1 mark.]

File Notice of Appeal (accept "file appeal")	1 mark
Pay the Appeal fee (accept "pay fee")	1 mark
06 January 2023 + 10 days = 16 January 2023	1 mark
16 January 2023 + 2 months	1 mark
= Thursday 16 March 2023	1 mark

[If candidate shows knowledge of

• the deadline to file the grounds of appeal being 4 months from the date of notification of the decision,

but shows no (or incorrect) calculations: award a maximum of 1 mark.]

File Grounds of Appeal (accept "file reasons/arguments")	1 mark
[06 January 2023 + 10 days =] 16 January 2023 + 4 months	1 mark
= Tuesday 16 May 2023	1 mark

A European Patent Application was filed on 04 January 2019. The "Decision to Grant" (EP2006) was issued on 30 November 2022 advising that mention of the grant will be published in the European Patent Bulletin on 19 January 2023.

a) What is the final date for payment of the 2023 renewal fee? Show your calculations.

2 marks

b) To which office must the fee be paid? Explain your answer.

2 marks

Total 4 marks

Answer

a) The renewal fee can be paid up to the last day of the month containing the filing anniversary (04 January 2023)
 1 mark
 31 January 2023
 1 mark

[If candidates state that a 6-month grace period is available, for this second mark above, accept:

[31 January 2023 + 6 months] = 31 July 2023]

b) The fee must be paid to the EPO
The application is still pending on the due date which is the filing anniversary of
4 January 2023
1 mark

Question 13

A Notice of Intention to Grant under Rule 71(3) EPC is dated 21 December 2022. The attorney with whom you work notices typographical errors in the allowed claims of the EDREX (Druckexemplar) and cannot approve the text.

What actions should be taken and by what date to ensure the application is not deemed withdrawn? Show your calculations.

4 marks

Answer

[If candidate shows knowledge of the deadline to file the response being 4 months from date of notification of the Rule 71(3) EPC communication but shows no (or incorrect) calculations: award a maximum of 1 mark.]

File a response disapproving the text for grant
[accept: file amendments/arguments [in response to the R71(3) EPC
communication]]
4 months from the date of notification:
21 December 2022 + 10 days = 31 December 2022
31 December 2022 + 4 months = 30 April 2023 (Sunday)
Next working day is Tuesday 02 May 2023
1 mark
1 mark

A communication under Art 94(3) EPC (an examination report) is dated 29 August 2022. The communication is received in your office on 26 August 2022. The communication sets a 4-month period from notification for filing a response.

a) What is the non-extended deadline for filing a response? Show your calculations.

4 marks

The applicant will not be able to file a response by this deadline.

b) By when must a request for an extension of time be filed?

1 mark

c) What will be the extended deadline for filing a response once a request for extension is filed? Show your calculations.

4 marks

Total: 9 marks

Answer

a) 29 August 2022 + 10 days

1 mark

= 8 September 2022

1 mark

8 September 2022 + 4 months = 8 January 2023 (Sunday)

1 mark

9 January 2023 (next working day)

1 mark

b) By the non-extended deadline / by 9 January 2023 (accept the answer given in part a))

1 mark

c) 29 August 2022 + 10 days = 8 September 2022

1 mark

8 September 2022 + 6 months

1 mark

= 8 March 2023 (Wednesday; International Women's Day – EPO holiday in Berlin)

1 mark

Next working day is 9 March 2023 (Thursday)

1 mark

Total: 9 marks

You receive a communication under R161 EPC from the EPO, dated 17 June 2022. The communication refers to a negative search opinion. The communication sets a period of 6 months for response. There are 15 claims in your application, and you will not increase the number of claims.

a) What is the deadline for response? Show your calculations. 4 marks

b) If no response is filed by the deadline calculated in part a), what actions must be taken to keep the application pending, and by when must these actions be taken?

2 marks

Total: 6 marks

Answer

a) 17 June 2022 + 10 days 1 mark

= 27 June 2022 1 mark

27 June 2022 + 6 months = 27 December 2022 **1 mark**

Next working day is 2 January 2023 (Monday) 1 mark

b) [The following two parts are both needed for this mark to be awarded:]

- File response to negative search opinion (accept "complete omitted act" / "file response")
- Pay further processing fee (accept "request further processing and pay the fee" what is needed here is a clear link between the 'fee' and 'further processing')

[1 mark]

Within 2 months (of notification) of the EPO communication [1 mark]

Total: 6 marks

You receive a decision to grant a European patent application, informing you that mention of the grant of the European patent will be published on 17 May 2023.

What is the deadline for filing a European divisional application? 2 marks Explain your answer.

Answer

16 May 2023 1 mark

"the day before grant" or "whilst the application remains pending" 1 mark

Total: 2 marks

Question 17

A UK registered design was filed on 21 July 2018, and is now registered.

What is the next renewal date? Show your calculations. 2 marks

Answer

[If candidate shows knowledge of the renewal deadline being 5 years from the filing (or registration) date, but shows no (or incorrect) calculations: award a maximum of 1 mark for this question.]

21 July 2018 + 5 years 1 mark

= 21 July 2023 (Friday) 1 mark

(This second mark is not to be awarded where the candidate moves the deadline to the end of the month.)

Total: 2 marks

PCT	For	receiving Office use only	
101	International Application	on No	
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REQUEST			
	International Filing Da	te	
The undersigned requests that the present			
international application be processed according to the Patent Cooperation Treaty.	Name of receiving Offi	ce and "PCT International Application"	
according to the Fatent Cooperation Treaty.	-		
	Applicant's or agent's file FTL/PCT01	e reference (if desired) (25 characters maximum)	
Box No. I TITLE OF INVENTION			
BRIDLE CLIP RETAINER			4
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Box No. II APPLICANT This person	n is also inventor		F
Name and address: (Family name followed by given name; for a legal enti 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 residen	he address indicated in this	E-mail address*	
Foundling Technology Ltd		Telephone No.	ı
The Stable Yard			ı
Dingle Lane		Facsimile No.	ı
London, SE3 5QQ			ı
United Kingdom		Applicant's registration No. with the Office	11
[accept: UK or GB; post code & country need	led for mark]		Ι΄
* E-mail authorization: Indicating an e-mail address above author International Bureau, if they provide such a service, to send notific marked:	rizes the receiving Office cations exclusively by e-r	the International Searching Authority and the mail to that address, unless the following box is	
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This person is applicant for the purposes of:	the States indicate	d in the Supplemental Box	ᆫ
Box No. III FURTHER APPLICANT(S) AND/OR (FURTH	HER) INVENTOR(S)		1
Further applicants and/or (further) inventors are indicated or	on a continuation sheet.		Ľ
Box No. IV AGENT OR COMMON REPRESENTATIVE;	OR ADDRESS FOR	CORRESPONDENCE	Г
The person identified below is hereby/has been appointed to act o of the applicant(s) before the competent International Authorities		agent common representative	
Name and address: (Family name followed by given name; for a legal enti The address must include postal code and name of a	ity, full official designation.	E-mail address*	
Ingleby, Lorna [Family name must be given f	• •	Lingleby@prabbyt.com	
capitalisation does not matter for this mark]	1131,	Telephone No.	
Peter Rabbyt Limited		[+44 (0) / 0]20 801 6565	
45 Fleet Lane South		Facsimile No.	11
London, SE23 1ZZ, United Kingdom		A di di di di di di	'
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Address for correspondence: Mark this check-box where r		esentative 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 (FURTH	IER) INVENTOR(S)	
If none of the following sub-boxes is used, this sheet should no	t be included in the red	quest.
Name and address: (Family name followed by given name; for a legal entity 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 residenty DOBBINS, Sienna [Family name must be gived capitalisation does not matter for this mark] Foundling Technology Ltd, The Stable Yard, London, SE3 5QQ, United Kingdom [accept: UK or GB; post code & country need state (that is, country) of nationality: BLANK [or GB/United Kingdom (not "UK") This person is applicant all designated States Name and address: (Family name followed by given name; for a legal entity 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 residenty that is, country) of residence if no State of residenty that is, country of the Box is the applicant's State (that is, country) of residence if no State of residenty that is, country of the Box is the applicant is State (that is, country) of residence if no State of residenty that is, country of the Box is the applicant is State (that is, country) of residence if no State of residenty that is, country of the Box is the applicant is State (that is, country) of residence if no State of residenty that is, country of the Box is the applicant is State (that is, country) of residence if no State of residenty that is the applicant is the applicant is State (that is, country) of residence if no State of residenty that is the applicant is t	e address indicated in this ce is indicated below.) en first; Dingle Lane, led for mark] State (that is, country BLANK [or GE the States indicate ty, full official designation. e 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 Of residence: Compared to the Supplemental Box 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
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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 pate. 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 subseque under Rule 26bis.1, the international application contains in Box No. VI a priority claim to an earlier national application filed in 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: Number Where earlier application is: of earlier application of earlier application is:	nts.
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[or 28 January 2022]	
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