Question 1

When does the period in which priority can be claimed from a first-filed patent application end?

1 mark

Answer

12 months from filing of the first-filed application [Candidates must give both the period (12 months) and that it starts from the filing date to get this mark.]

1 mark

Question 2

List 3 routes through which a GB patent can be sought.

3 marks

Answer

Any three of the following. First three answers only to be marked.

- i) A direct GB filing
- ii) A convention (priority-claiming) GB filing
- iii) A divisional of a GB application
- iv) A national phase filing of a PCT application [designating GB]

(or a GB designation of a PCT application)

v) Validation of a European application [designating GB]

(or a GB designation of a European application)

3 marks

Question 3

You filed a first (priority-founding) GB patent application for your client on 28 December 2020. On 20 January 2022, your client tells you that they would like to file a convention (priority-claiming) application at the UK IPO.

a) What would you need to show for this priority to be accepted? Explain your answer.

2 marks

b) By when would the convention (priority-claiming) application need to be filed? Show your calculations.

2 marks

Total: 4 marks

Answer

a) You have missed the 12-month deadline to file the convention application (of 28 December 2021 – *this date not needed to gain the mark*)

1 mark

You would need to show that the failure to file by this deadline was unintentional

1 mark

b) [If candidate shows knowledge of the deadline being 14 months from the priority date, but shows no (or incorrect) calculations: award a maximum of 1 mark.]

Within 14 months of the priority date 28 December 2020 + 14 months

1 mark

= 28 February 2022 (Monday)

1 mark

Question 4

You filed a first GB patent application on 14 October 2021. On 11 January 2022 you filed a divisional patent application from that first GB patent application.

a) What is the deadline for requesting a search on the divisional patent application? Show your calculations.

5 marks

b) What is the deadline for filing a PF7 on the divisional patent application? Show your calculations.

3 marks

Total: 8 marks

<u>Answer</u>

a)

[If candidate shows knowledge of the deadline being the later of 12 months from the priority date or 2 months from the date of filing the divisional application, but shows no (or incorrect) calculations: award a maximum of 1 mark.]

Later of 12 months from (i) priority date or (ii) 2 months from date of filing the divisional application

i) 12 months from priority date14 October 2021 + 12 months

1 mark

= 14 October 2022 (Friday)

1 mark

ii) 2 months from date of filing the divisional

11 January 2022 + 2 months

1 mark

= 11 March 2022 (Friday)

1 mark

Later of these two dates:

14 October 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

b) [If candidate shows knowledge of the deadline being the later of 16 months from the priority date or 2 months from the date of filing the divisional application, but shows no (or incorrect) calculations: award a maximum of 1 mark.]

Later of (i) 16 months from priority date or (ii) 2 months from date on which the divisional application is filed

i) 16 months from priority date 14 October 2021 + 16 months

1 mark

= 14 February 2023 (Tuesday)

1 mark

ii) 2 months from date of filing the divisional11 January 2022 + 2 months = 11 March 2022 (as above)

[no separate mark here, since mark awarded above for this point. Marks can be awarded if this is correct here, but these marks were not awarded above.]

Later of these two dates:

= 14 February 2023

1 mark

Question 5

A GB patent application was filed, without claiming priority, on 12 May 2021. The application was filed with informal drawings.

By when will formal drawings need to be filed? Show your calculations.

2 marks

Answer

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

12 May 2021 + 15 months

1 mark

= 12 August 2022 (Friday)

1 mark

Question 6

List four requirements to obtain a filing date for an international patent application that does not claim priority.

4 marks

Answer

[1 mark for each (up to a maximum of 4; only the first four answers are to be marked);

if candidate lists 'specification' <u>without</u> specifying individual components award 1 mark:

note: "file drawings" is not included. A filing date can be obtained whether or not drawings are filed.]

- i) the applicant has the right to file an international application (the applicant is a resident or national of a PCT contracting state)
- ii) the filing contains an indication that it is intended as an international patent application
- iii) the filing designates at least one contracting state to the PCT
- iv) the filing contains details of the applicant (accept: name of the applicant)
- v) the filing contains something that at least appears to be a description
- vi) the filing contains something that at least appears to be a claim (or claims)

4 marks

Question 7

A PCT application was filed on 17 May 2020. The application claims priority from a US application filed on 28 July 2019.

a) When does the international phase end for this PCT application? Show your calculations.

2 marks

b) What is the latest (unextended) date for entering the European regional phase for this PCT application? Show your calculations.

2 marks

c) What is the due date for the first renewal fee due at the European Patent Office for the European regional phase application? Show your calculations.

3 marks

Total: 7 marks

Answer

a) [If candidate shows knowledge of the end of the international phase being 30 months from the priority date (= earliest filing date), but shows no (or incorrect) calculations: award a maximum of 1 mark.]

28 July 2019 + 30 months

1 mark

= 28 January 2022 (Friday)

1 mark

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

28 July 2019 + 31 months

1 mark

= 28 February 2022 (Monday)

1 mark

c) [If candidate shows knowledge of the deadline being the second anniversary of the PCT filing date (in respect of the third year), but shows no (or incorrect) calculations: award a maximum of 1 mark.]

17 May 2020 + 2 years

1 mark

= 17 May 2022

1 mark

31 May 2022 (Tuesday) [accept: end of May 2022]

1 mark

Question 8

A client of your firm wishes to oppose a granted European patent application. The European Patent Office issued a communication dated 2 May 2021 informing the applicant that the patent would grant on 10 May 2021.

What is the deadline for filing a notice of opposition? Show your calculations.

2 marks

Answer

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

10 May 2021 + 9 months

1 mark

= 10 February 2022 (Thursday)

Question 9

A GB patent application, GB1, was filed on 25 October 2017. The application claims priority from an earlier GB application filed on 11 September 2017. A first examination report was issued in respect of GB1 on 20 October 2021.

a) By when must the later patent application (GB1) be put in order for grant? Show your calculations.

5 marks

The deadline calculated in a) can be extended without needing to rely on the discretion of the UK IPO.

b) Outline the procedure for extending the deadline, and give the extended deadline. Show your calculations.

3 marks

Total: 8 marks

Answer

- a) [If candidate shows knowledge of the deadline being the later of (i) 4.5 years from the earliest priority date and (ii) 12 months from the issuance of the examination report, but shows no (or incorrect) calculations: award a maximum of 1 mark.]
- i) 4.5 years from the earliest priority date:
- 11 September 2017 + 4 years 6 months

1 mark

= 11 March 2022 (Friday)

1 mark

ii) 12 months from the date of issuance of the examination report:

20 October 2021 + 12 months

1 mark

= 20 October 2022 (Thursday)

1 mark

[Later of these two dates – to get this mark, the later of the calculated dates must be highlighted in a way showing that the candidate has selected it]
20 October 2022

1 mark

b) Procedure: file a form (*PF52* – not needed for the mark) and pay a fee (fee amount not needed)

1 mark

Deadline = 20 October 2022 (or date calculated by the candidate in a)) + 2 months

1 mark

= 20 December 2022

Question 10

A European patent application is published without the search report on 18 August 2021. The search report is issued dated 26 August 2021. The search report is published on 9 September 2021.

By when must examination of the European patent application be requested? Show your calculations.

2 marks

<u>Answer</u>

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

9 September 2021 + 6 months

1 mark

= 9 March 2022 (Wednesday)

1 mark

Question 11

A Rule 71(3) communication (an intention to grant communication) is issued on a European patent application. The communication is dated 24 November 2021. You receive the communication in your office on 25 November 2021.

a) By when must a response be filed, including any available extensions of time? Show your calculations.

4 marks

b) If a response is not filed by the date given in a), what actions can be taken to continue with the application, and by when?

3 marks

Total: 7 marks

Answer

a) [If candidate shows knowledge of the deadline being 4m from notification of the communication, but shows no (or incorrect) calculations: award a maximum of 1 mark.]

Notification of the communication in this case occurs 10 days from the date of the communication

24 November 2021 + 10 days

1 mark

= 4 December 2021 (Saturday [NB date does not roll over to the next working day])

4 December 2021 + 4 months

1 mark

= 4 April 2022 (Monday)

1 mark

- b) 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 [mention of fee necessary to get this mark]

1 mark

- completing the missing action(s) [filing claims translations and paying the required fees]

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 12

A decision to refuse a European patent application is dated 20 December 2021. You receive the decision the same day. You file a notice of appeal in due time.

What is the deadline for filing the grounds of appeal? Show your calculations.

5 marks

Answer

[If candidate shows knowledge of the deadline being 4 months from notification of the decision to refuse, but shows no (or incorrect) calculations: award a maximum of 1 mark.]

20 December 2021 + 10 days

1 mark

= 30 December 2021 (Thursday)

1 mark

30 December 2021 + 4 months

1 mark

= 30 April 2022 (Saturday)

1 mark

= 2 May 2022 (Monday)

Question 13

A European patent application was filed on 5 June 2018, claiming priority from a GB application filed on 5 July 2017. Mention of grant of the European patent will publish in the European Patent Bulletin on 8 February 2022. The patent is to be validated in the UK, France and Germany.

a) By when must the next renewal fee(s) be paid? Show your calculations.

2 marks

b) Where must the next renewal fee(s) be paid? Explain your answer.

2 marks

Total: 4 marks

Answer

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

Anniversary of the filing date = 5 June 2022

1 mark

= 30 June 2022 (Thursday, end of the month)

1 mark

b) In the UK, France and Germany / at the national patent offices in the UK, France and Germany

1 mark

because the patent will have granted by the renewal date

1 mark

Question 14

What are the minimum filing requirements to obtain a filing date for a UK registered design application?

3 marks

Answer

Provide applicant details (sufficient to identify the applicant – name alone is not sufficient)

1 mark

Provide at least one representation of the design

1 mark

Pay the registration (or filing) fee

Question 15

What is the maximum term of protection for a registered design in the UK (assuming all renewal fees are paid on time)?

1 mark

Answer

25 years from filing

[Candidates must give both the period (25 years) and that it starts from the filing date to get this mark.]

1 mark

Question 16

A GB patent application was filed on 31 August 2017, and was granted on 4 March 2020. The priority date is 1 September 2016.

a) By when must the next renewal fee be paid without incurring a surcharge? Show your calculations.

3 marks

b) What is the latest date by which the next renewal fee can be paid with surcharge? Show your calculations.

2 marks

Total: 5 marks

Answer

a) [If candidate shows knowledge of the deadline being one month after the end of the month containing the filing anniversary, but shows no (or incorrect) calculations: award a maximum of 1 mark.]

Standard period in which renewal fee can be paid (end of month containing filing anniversary)

31 August 2022 (Wednesday)

1 mark

First month's extension of time is free

31 August 2022 + 1 month

1 mark

= 30 September 2022 (Friday)

1 mark

b) [If candidate shows knowledge of the deadline being six months after the end of the month containing the filing anniversary, but shows no (or incorrect) calculations: award a maximum of 1 mark.]

Six months extension of time available 31 August 2022 + 6 months

= 28 February 2023 (Tuesday)

1 mark

Question 17

You receive a memo from Shalanda, an attorney at your firm. Shalanda writes, Good morning. Our client, Cheap'n'Cheerful Limited, would like us to file a priority-claiming GB patent application on the latest date possible. The new application is entitled "Webcam magnifier", and will claim priority from their earlier application filed on 12 February 2021. As a reminder, the application number for that earlier application is GB 2172941.5.

The new application has:

- 15 pages of description,
- 4 claims on a single page,
- a 1-page abstract and
- 3 figures on 2 pages of drawings.

Our reference is CNC55-GB.

We'll file a search request too, and will pay the application fee and search fee at the time of filing. Please pay all the fees using the PF9A. The application fee is £60 and the search fee is £120. We will pay these fees from our IPO deposit account number 150008.

The client's details are: Cheap'n'Cheerful Limited Unit K, Woodland Trading Estate Glasgow G23 7ER

Please can you prepare the forms for filing, listing me as agent, and providing my details wherever needed. Many thanks!

Shalanda Gibbs, Eureka IP Services LLP sgibbs@eurekaips.com
80, The Square, Glasgow, G1 9RB, UK

Prepare the forms required.

12 marks

Answer

See completed forms:

PF1

6 marks

PF9A

6 marks

Question 18

A GB patent application comprises 40 pages of description, 27 claims over 5 pages, a 1-page abstract and 10 pages of drawings.

a) When requesting search, for how many excess claims are fees payable?

1 mark

b) When requesting examination, for how many excess pages are fees payable?

1 mark

Total: 2 marks

Answer

a) 27 - 25 = 2

[calculations not needed for the mark]

1 mark

b) 40 - 35 = 5

[calculations not needed for the mark]

1 mark

Total: 80 marks



Concept House Cardiff Road Newport South Wales NP10 8QQ

Patents Form 1

Patents Act 1977 (Rule 12)

Request for grant of a patent

(An explanatory leaflet on how to fill in this form is available from the office)

Ap	plication number GB		
1.	Your reference: (optional)	CNC55-GB	1
2.	Full name, address and postcode of the applicant or of each applicant (underline all surnames): The name(s) and address(es) provided here will be published online as part of the application process (see warning note below)	Cheap'n'Cheerful Limited Unit K, Woodland Trading Estate Glasgow G23 7ER	
	Patents ADP number (if you know it):		
3.	Title of the invention:	Webcam magnifier]1
4.	Name of your agent (if you have one):	Shalanda Gibbs Surname can optionally be in capitals or underlined	
	"Address for service" to which all correspondence should be sent (including postcode). This may be in the United Kingdom, Gibraltar or Channel Islands: (see warning note below)	Eureka IP Services LLPCompany name needed for the mark 80, The Square Glasgow G1 9RB	
	Patents ADP number (if you know it):		
5.	Priority declaration: Are you claiming priority from one or more earlier-filed patent applications? If so, please give details of the application(s):	Country Application number (if you know it) Date of filing (day/month/year) 2172941.5 12/02/2021 Accept 12-2-2021 or 12.2.2021	1
6.	Divisionals etc: Is this application a divisional application, or being made following resolution of an entitlement dispute about an earlier application? If so, please give the application number and filing date of the earlier application:	Number of Date of filing earlier UK application (day/month/year)	
7.	Inventorship: (Inventors must be individuals not companies)	(Please tick the appropriate boxes)	
	Are all the applicants named above also inventors?	Yes No	
	If yes, are there any other inventors?	Yes No	
8.	Are you paying the application fee with this form?	Yes No	

•	accompanying this form:				
Continuation	Continuation sheets of this form:				
Description:		15			
Claim(s):	Claim(s): Abstract:		1		
Abstract:					
Drawing(s):		2			
	t filing a description, please give previous application you are upon:	Country	Application number	Date of filing (day/month/year)	
	If you are also filing any of the following, state how many against each item.				
Priority docu	ments:				
	Statement of inventorship and right to grant of a patent (Patents Form 7):				
Request for	Request for search (Patents Form 9A): Request for substantive examination (Patents Form 10):				
Request for (Patents Form 1					
Any other do	ocuments: (please specify)				
11. I/We request	I/We request the grant of a patent on the basis of this application.				
Signature(s):	MUST BE BLANK	Date:	14 February 2022		
an analytic according if any of a contact		Shalanda Gibsgibbs@eure	bbs	e in capitals or underlined	

Warning

9. Accompanying documents:

After an application for a patent has been filed, the Comptroller will consider whether publication or communication of the invention should be prohibited or restricted under section 22 of the Patents Act 1977. You will be informed if it is necessary to prohibit or restrict your invention in this way. Furthermore, if you are resident in the United Kingdom and your application contains information which relates to military technology, or would be prejudicial to national security or the safety of the public, section 23 of the Patents Act 1977 prohibits you from applying for a patent abroad without first getting written permission from the Office unless an application has been filed at least 6 weeks beforehand in the United Kingdom for a patent for the same invention and either no direction prohibiting publication or communication has been given, or any such direction has been revoked. Until such time or until the revocation of any direction, for any such application the address for service referred to at part 4 above must be in the United Kingdom.

In all other cases, the name of the applicant will be published online shortly after we receive your application, together with the title of the invention. Later, when the whole application is published, most information and documents filed in relation to the application will become publicly available online. The name and address of the applicant will be published on our website and are likely to appear in external search engine results. You should provide a business or PO Box address if you do not want your home address published online.

Although you may have an address for service in the Channel Islands or Gibraltar, any agent you appoint to act for you must reside or have a place of business in the United Kingdom, the Isle of Man or the European Economic Area.

Notes

A leaflet on how to fill in this form is available from the Office. If you would like a copy of the leaflet it is available on our website at https://assets.publishing.service.gov.uk/government/uploads/system/uploads/attachment_data/file/893060/Form-1-guidance.pdf or alternatively you could telephone 0300 300 2000 or send an email to information@ipo.gov.uk to request a copy.

Fees and payment page.

Explicit instructions to pay using PF9A, so this page should be left blank. Marks are not to be deducted for anything on this page.

Please note you only need to complete this form if paying the Application Fee for Patents Form 1

to check t	the correct lee for this ic	rm, search on GOV.UK for 'patent forms and fees'		
Total Fee F	Paying (£)			
Your own	reference (Optional)			
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How wou	ld you like to pay?			
Tick one				
	Using a debit or cre	edit card – you will need the internet to pay by card		
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	2 Enter your nam	e, email address and total amount to pay from above		
online payment so		ment, write below the 16-digit reference number displayed from the screen. your debit/credit card number		
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	Bank transfer			
Reference – use your IPC application number or yo Use the following bank as		r IPO deposit account number if you have one or an or your name if you don't.		
		nk account details		
	Sort code Account number Account name SWIFT code IBAN number	20-18-23 80531766 Intellectual Property Office BARCGB22 GB92 BARC 2018 2380 5317 66		



Concept House Cardiff Road Newport South Wales NP10 8QQ

Patents Form 9A

Patents Act 1977 (Rule 27)

Request for search

(Se	ee the notes on the back of this form)			
1.	Your reference: (optional)	CNC55-GB	1	
2.	Patent application number (e.g. GB765432	21.0):		
3.	Full name of the applicant or of each appli	licant: Cheap'n'Cheerful Limited		
4.	Is this request for (please tick one box):			
	a) A search under Section 17(1) for an international application which has been searched in the international phase?			
	b) A search under Section 17 (1) for any other application?			
	c) A supplementary search under Section 17(8)? (See note (b) for help choosing which search you require)			
	d) A search of a further invention under Section 17(6)?			
	If your answer is (d), identify which invention you would like to be searched by referring to the claims to be searched (See note (c)):			
	(we will automatically send you a paper copy of any	cited non-patent documents, see note (d))		
5.	Are you paying the application fee with thi (See note (e))	is form? YES No		
6.	Number of claims in your application: Only relevant for options (a) and (b) above. See note (f)			
7.	(please see note (g)) Signature	MUST BE BLANK Date 14 February 2022	1	
	Mark can be awarded where this date is incorre but is the same as the date given on form PF1			
8.	Your name and full address: Shalanda Gibbs Surname can optionally be in capitals or underline Eureka IP Services LLP 80, The Square Glasgow G1 9RB			

 Name, email address, telephone and/or mobile number, if any, of a contact point for the applicant: Shalanda Gibbs Surname can optionally be in capitals or underlined sgibbs@eurekaips.com

Notes

- a) Please type or write your answers using black ink. If you need help to fill in this form or you have any questions, please contact the Office on 0300 300 2000.
- b) Identifying the type of search you require:
 - Option a) choose this option if your application is a PCT application.
 - Option b) choose this option if your application is a UK national application, and this is the first search you have requested for your application.
 - Option c) this option is used if you have already had a search done, but the claims have since been amended or corrected so that the defined invention has changed, and was not covered by the original search. An examiner will tell you if you need to request a supplementary search.
 - Option d) sometimes an examiner will tell you that your claims relate to more than one invention. In such circumstances the examiner will only search the first invention of the claims. If you wish other inventions to be searched you should use this option, filing a separate form with this option ticked for each invention you wish to be searched. You should also indicate on the form(s) the claims relating to the invention to be searched. You will need to pay a fee for each further invention to be searched.
- c) If you do not identify an invention, the second invention specified in the search report previously made under Section 17(5) will be searched.
- d) We will supply one copy of each non-patent document such as journal articles cited in the search report or during the substantive examination process. Patent documents cited during the application process are usually accessible for free on the internet (particularly from http://worldwide.espacenet.com/) and you will not be issued with a copy of them. For copyright reasons, all copies of citations supplied by the Office must be used for the sole purpose of processing the patent application.
- e) Before your application is searched you must pay an application fee, as well as the search fee required with this form. If you have not already paid the application fee you can do so when filing this form. Note that the application fee is higher when paid after the date you filed your application. For details of the fees and ways to pay them, please contact the Office.
- f) If you have selected option (a) or (b) in part 4 of this form, please indicate the current number of claims in your application. The search fee increases if your application includes more than 25 claims. Such an increase does not apply to searches under option (c) or (d). For details of the fee payable with this form and ways to pay, please contact the Office.
- g) In order to promote efficient and high quality patent processing internationally, we are cooperating with other patent offices to share the results of searches and examinations. We are obliged to provide some information before publication to the European Patent Office. We may also provide the results of the search and any examination that has been carried out to other patent offices, even if this is prior to publication of your application. Any sharing prior to publication of your application will be carried out on a confidential basis and the results will not become publicly available through the other patent office before publication takes place in the UK.
- h) Once you have filled in this form remember to sign and date it.

Data Privacy: https://www.gov.uk/government/organisations/intellectual-property-office/about/personal-information-charter

Email your form to us:

Send your form, saved as a PDF to:
forms@ipo.gov.uk
For help saving your form as a PDF see:
how-to-file-documents-with-the-intellectual-property-office

If you cannot email your form, post to:

Intellectual Property Office Concept House Cardiff Road Newport South Wales NP10 8QQ

Fees and payment

We will only process the form with this section completed (one form per payment)

To check the correct fee for this form, search on GOV.UK for 'patent forms and fees'

Search fee		£180 ['£' not needed for mark]	Both fee amounts need to be present for this mark. If a currency indication is given, it must be correct,		
Application fee (only if not paid with Patent Form 1)		£90 ['£' not needed for mark]	e.g. '£' or 'GBP'		
Excess claims fee Total fee paying		BLANK			
		This box to be disregarded for the purposes of this mark scheme	If reference given, it must be correct. For purposes of this mark scheme, this box can be		
Your own	reference (Optional)	CNC55-GB or BLANK	left blank. (Candidates should in future note and follow any instructions in the question.)		
Your cont	act details should we h	nave a query			
Name	Shalanda Gibbs	urname can optionally be in capitals or underlined			
Email	sgibbs@eurekaips.co	om			
Phone					
How wou	ld you like to pay?				
Using a debit or credit ca		edit card – you will need the internet to re website – https://fees.ipo.gov.uk/pay	pay by card		
	2 Enter your name, email address and total amount to pay from above				
As proof of payment, write below the 16-digit reference number disp online payment screen. DO NOT write your debit/credit card number Deduct from IPO deposit account		screen.	number displayed from the		
	IPO deposit account	number			
	150008				
	Cheque - make paya	able to 'Intellectual Property Office'			
	Bank transfer				
	Reference – use your IPO deposit account number if you have one or an application number or your name if you don't.				
	Use the following bank account details				
	Sort code Account number Account name SWIFT code IBAN number	20-18-23 80531766 Intellectual Property Office BARCGB22 GB92 BARC 2018 2380 5317 66			