

2023 ICPA LIVE Mark Scheme

Question 1

Explain 'Duty of Care'.

3 marks

Answer

All the points below must be included in the answer to get full marks, however expressed. That:

- a person acts towards others and the public [*accept: "clients"*]
with 1 mark
- the watchfulness, attention, caution and prudence that 1 mark
- a reasonable person in the circumstances would. 1 mark

Total: 3 marks

Question 2

State the three required parts of a patent specification, assuming there are no drawings.

3 marks

Answer

[Only the first three parts to candidates' answers are to be marked. Any further parts are not to be marked.]

- Description 1 mark
- Claims 1 mark
- Abstract 1 mark

Total: 3 marks

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Question 3

State three main procedural stages of a GB patent application, after filing. **3 marks**

Answer

[Only the first three parts to candidates' answers are to be marked. If candidates clearly break their answers into 3 (or more) parts (e.g. using bullet points), then only the first part of each will be marked. Any further parts are not to be marked. Candidates are expected to provide 3 of the 4 answers below. Award up to 3 marks.]

Search	1 mark
Publication	1 mark
Examination	1 mark
Grant	1 mark
Total: 3 marks	

Question 4

A first patent application was filed in South Korea on 8 March 2023. The applicant wishes to file a GB patent application claiming priority from the South Korean patent application.

What is the deadline for filing the GB patent application? Show your calculations. **2 marks**

Answer

8 March 2023 + 12 months	1 mark
= 8 March 2024 (Friday)	1 mark
Total: 2 marks	

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Question 5

A US patent application was filed on 18 April 2023. A GB patent application was filed on 16 January 2024, claiming priority from the US patent application. The application includes 20 pages of description and 10 claims.

No fees were paid on filing the GB application, and no search or examination requests were made.

a) What is the deadline for paying the application fee for the GB patent application? Show your calculations. 6 marks

b) What is the deadline for requesting a search on the GB patent application? Show your calculations. What actions must be taken by this date? 2 marks

Total: 8 marks

Answer

a)

[If candidate shows knowledge that the deadline is the later of (i) 12 months from the earliest priority date or (ii) two months from filing the GB application, but gives no, or incorrect, calculations, award a maximum of 1 mark.]

The later of (i) 12 months from the earliest priority date or (ii) two months from filing the GB application.

i) 18 April 2023 + 12 months 1 mark

= 18 April 2024 (Thursday) 1 mark

ii) 16 January 2024 + 2 months 1 mark

= 16 March 2024 (Saturday) 1 mark

= 18 March 2024 (Monday; next working day) 1 mark

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The later of these dates is 18 April 2024 1 mark

[An identification of the later of the two dates is needed for the above mark. It follows that where only a single date is given, this mark is not awarded.]

b)

18 April 2024 1 mark

[Accept the date given as the final answer to part a). If the calculations given in part a) are incorrect, and are repeated here, a follow-on mark can only be awarded where candidates indicate that this is the same answer as in part a). Where calculations are given, they will otherwise be marked separately from part a). NB, repeating calculations here is not necessary or desired – this note should not be taken as suggesting that calculations of the same thing should be repeated in a single question. It is acceptable (and preferable) for candidates to simply give the same answer as in part a).]

Request a search and pay the search fee 1 mark

[accept: file a form and pay a fee]

Total: 8 marks

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Question 6

A GB patent application is published on 10 January 2024.

What is the deadline for requesting examination of the application?

Show your calculations.

2 marks

Answer

[If candidate shows knowledge that the deadline is 6 months after publication, but shows no, or incorrect, calculations, award a maximum of 1 mark.]

10 January 2024 + 6 months

1 mark

= 10 July 2024 (Wednesday)

1 mark

Total: 2 marks

Question 7

A GB patent application comprises 45 pages of description, 30 claims over 6 pages, a 1-page abstract and 12 pages of drawings.

a) A search request is to be filed. **For how many excess claims are fees payable?**

1 mark

b) An examination request is to be filed. **For how many excess pages are fees payable?**

1 mark

Total: 2 marks

Answer

a) 5 claims *[for each claim over 25]*

1 mark

b) 10 pages *[for each description page over 35]*

1 mark

Total: 2 marks

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Question 8

A GB patent application was filed on 28 June 2019. The patent granted on 5 November 2023.

By when is the first renewal fee due? Show your calculations.

5 marks

Answer

[If candidate shows knowledge that the deadline is the last day of the month containing the 4th anniversary of filing, in respect of the 5th year, and is at least 3 months from date of grant, but gives no, or incorrect, calculations, award a maximum of 1 mark.]

28 June 2019 + 4 years

1 mark

= 28 June 2023 (before grant date)

1 mark

[Where candidates express knowledge that the patent has granted "late", i.e. that this is a "late grant", or otherwise express that the grant has occurred more than 3 years and 9 months from the filing date, but there are no date calculations, award a maximum of 1 mark (out of 2) for the above first part of the answer.]

Renewal fees are not due until after grant – this is late grant therefore renewal fee is due 3 months from the date of grant

5 November 2023 + 3 months

1 mark

= 5 February 2024

1 mark

Payable to the end of the month (29 February 2024 (Thursday))

1 mark

Total: 5 marks

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Question 9

A Decision to Grant communication has been received in your office in respect of a pending European patent application. The Decision to Grant communication gives the expected date of grant as 7 February 2024.

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

b) Where must the European divisional patent application be filed? **1 mark**

Total: 3 marks

Answer

a) The day before grant. **1 mark**

= 6 February 2024 (Tuesday) **1 mark**

b) At the European Patent Office **1 mark**

Total: 3 marks

Question 10

An A2 publication of a pending European patent application was made on 15 November 2023. An A3 publication of the same European patent application was made on 10 January 2024.

What is the deadline for requesting examination of the European patent application? Show your calculations. **3 marks**

Answer

[If candidate shows knowledge that the deadline is 6 months after publication of the A3 document, but shows no, or incorrect, calculations, award a maximum of 1 mark.]

10 January 2024 **1 mark**

+ 6 months **1 mark**

= 10 July 2024 (Wednesday) **1 mark**

Total: 3 marks

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Question 11

A Decision to Grant communication is received in your office in respect of a pending European patent application. The expected date of grant is 28 February 2024.

The applicant wishes the European patent to have unitary effect (i.e. to apply for a unitary patent).

a) What is the deadline for requesting that the granted European patent has unitary effect? Show your calculations. 2 marks

b) Where must renewal fees be paid in respect of a unitary patent? 1 mark

c) What is the unextended deadline for validating the granted European patent in Spain? Show your calculations. 2 marks

Total: 5 marks

Answer

a) 28 February 2024 + 1 month 1 mark

= 28 March 2024 (Thursday) 1 mark

b) At the EPO 1 mark

c) 28 February 2024 + 3 months 1 mark

= 28 May 2024 (Tuesday) 1 mark

Total: 5 marks

Question 12

State the maximum term of protection for a UK registered design. 1 mark

Answer

25 years / from the registration date [*accept: from the filing date*] 1 mark

[*both parts of this answer are needed for the mark*]

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Question 13

Your office is handling a European application filed in English. The EPO issued a communication under Rule 71(3) EPC (a Notice of Intention to Grant communication) dated 1 December 2023. The communication was received in your office the same day. The allowed text is acceptable to the client.

a) What steps must be taken by the applicant for the patent to grant?

By when must those steps be taken? Show your calculations.

5 marks

b) No response is made to the communication by the deadline. What will happen to the application? To keep the application pending, what steps can be taken and by when?

4 marks

Total: 9 marks

Answer

a) Pay the grant and printing fees

1 mark

[It must be stated that the fees are “grant fees” or “print and grant fees” or similar; simply saying “pay fees” or “pay any required fees” is not sufficient for this mark. Candidates do not need to say “approve text” or similar to gain this mark.]

File translations of the claims into French and German

1 mark

[Explicit mention of the two languages, i.e. French and German, is needed for this mark.]

Within 4 months of notification of the communication:

1 December 2023 + 4 months

1 mark

= 1 April 2024 (Easter Monday)

1 mark

= 2 April 2024 (Tuesday; next working day)

1 mark

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b) The application will be deemed withdrawn / the EPO will issue a communication noting a loss of rights 1 mark
[Either point on its own is acceptable for this mark.]

To keep the application pending, the applicant can:

Request further processing by paying the further processing fee 1 mark
[Mention of the further processing fee is necessary to obtain this mark; "request further processing" on its own does not gain the mark; mention of "paying a fee" without more is insufficient to gain the mark – there must be a clear indication that it is the further processing fee.]

Complete the omitted acts / file a response to the communication / pay the grant and printing fees and file claims translations 1 mark
[Any of these points is sufficient to gain this mark.]

Within 2 months of notification of the EPO communication noting the loss of rights 1 mark
[Accept: within 2 months of the loss of rights communication, or similar.]

Total: 9 marks

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Question 14

An examination report is issued by the EPO in respect of a pending European patent application. The examination report is dated 30 November 2023. The examination report is received in your office on 4 December 2023. The examination report sets a four-month period for response.

a) What is the deadline for response, without requesting an extension of time? Show your calculations. 2 marks

The applicant will not be in a position to instruct you in time to meet the unextended deadline for response.

b) What is the deadline for requesting an extension of time at the EPO? 1 mark

c) What will the extended deadline be? Show your calculations. 3 marks

Total: 6 marks

Answer

a) The examination report is deemed notified on the date of the document, i.e. on 30 November 2023.

30 November 2023 + 4 months = 30 March 2024 (Saturday) 1 mark

= 2 April 2024 (Tuesday; next working day since 1 April is Easter Monday) 1 mark

b) 2 April 2024 [*Accept: by the date given in part a).*] 1 mark

c) 30 November 2023 + 6 months 1 mark

= 30 May 2024 (Thursday, Corpus Christi) 1 mark

= 31 May 2024 (Friday) 1 mark

Total: 6 marks

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Question 15

A PCT application was filed on 3 June 2022, claiming priority from a GB application filed on 11 June 2021.

- a) What is the deadline for entering the national phase in the United Kingdom? **3 marks**
- b) What is the deadline for entering the national phase in the US? **3 marks**
- Total: 6 marks**

Answer

[If candidate shows knowledge of the deadline of 31m (GB) and 30m (US) from the earliest priority date, but shows no (or incorrect) calculations, award a maximum of 1 mark.]

- a) 11 June 2021 **1 mark**
+ 31 months **1 mark**
= 11 January 2024 (Thursday) **1 mark**
- b) 11 June 2021 **1 mark**
+ 30 months **1 mark**
= 11 December 2023 (Monday) **1 mark**
- Total: 6 marks**

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Question 16

You work as a paralegal at Potters Patents LLP and receive the following instruction from one of the attorneys with whom you work.

Our client wants to file a demand for international preliminary examination, relating to our case reference: ENV/P532PC. I'm the representative for the PCT and the details are as given below.

Application No.: PCT/EP2022/052131
Application date: 28 January 2022
Priority claim: GB 2101227.1, filed on 29 January 2021
Title of the invention: Energy Cell
Applicant: Environmental Effects LLP
A GB company of: 4 Brown Lane, Fakenham NR21 0HX, UK
Language of PCT proceedings and PCT text: English
Receiving Office: EPO

Please prepare the PCT demand form. I have emailed you four pages of amended claims, which should be submitted under Article 34 PCT, together with a two-page letter accompanying the amendments. There are no other changes to the text and no postponement of examination is required. As usual, we prefer to receive communications via e-mail only and please include a copy of our general PoA, with reference PoA-Env1.

Our accounts team have prepared the fee calculation sheet, which will be included with the filing.

Kind regards
Louise Cahill
Potters Patents LLP
19 Holdenby House
Ipswich IP1 1AN
United Kingdom
info@potters.com
Tel: 01473 55 22 33

Total: 8 marks

Answer

See completed form

Total: 8 marks

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Question 17

One of your clients has changed its name. Your client is the applicant for international application number PCT/GB2022/059211. This application was filed on 12 August 2022, claiming priority from GB 10453212.9, which was filed on 16 August 2021.

What is the latest date the change can be recorded at the International Bureau of WIPO?

3 marks

Answer

16 August 2021

1 mark

+ 30m

1 mark

= 16 February 2024 (Friday)

1 mark

Total: 3 marks

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Question 18

A GB registered design application was filed on 8 October 2019 and registered on 10 October 2019. The registered design claims priority from an earlier GB registered design application filed on 8 August 2019.

a) When is the first renewal fee due? Show your calculations. 3 marks

b) What is the latest date by which the first renewal fee can be paid without surcharge? Show your calculations. 2 marks

c) What is the latest date by which the first renewal fee can be paid with surcharge? Show your calculations. 2 marks

Total: 7 marks

Answer

[This question mentions domestic design priority in the UK. In practice, this is not allowed. This question should have stated that the GB registered design claims priority from an earlier registered design in a different country. This does not affect the answer, but may have confused some candidates. All answers were reviewed to ensure that no candidate was penalised as a result.]

a) Renewal fee is due 5 years from filing date.

8 October 2019 1 mark

+ 5 years 1 mark

= 8 October 2024 (Tuesday) 1 mark

b) First month of grace period is free.

8 October 2024 +1 month 1 mark

= 8 November 2024 (Friday) 1 mark

c) 6-month grace period

8 October 2024 + 6 months 1 mark

= 8 April 2025 (Tuesday) 1 mark

Total: 7 marks

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Question 19

How long is the period in which priority can be claimed for a registered design application?

1 mark

Answer

6 months / from the filing date [*accept: registration date*]

1 mark

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

Paper total: 80 marks

The demand must be filed directly with the competent International Preliminary Examining Authority or, if two or more Authorities are competent, with the one chosen by the applicant. The full name or two-letter code of that Authority may be indicated by the applicant on the line below:

IPEA/ BLANK or EP [accept: EPO]

PCT DEMAND

CHAPTER II

under Article 31 of the Patent Cooperation Treaty:
The undersigned requests that the international application specified below be the subject of international preliminary examination according to the Patent Cooperation Treaty.

For International Preliminary Examining Authority use only

Identification of IPEA	Date of receipt of DEMAND
------------------------	---------------------------

Box No. I IDENTIFICATION OF THE INTERNATIONAL APPLICATION

Applicant's or agent's file reference ENV/P532PC	International application No. PCT/EP2022/052131
International filing date (<i>day/month/year</i>) 28 January 2022	(Earliest) Priority date (<i>day/month/year</i>) 29 January 2021
Title of invention Energy Cell	

Box No. II APPLICANT(S)

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>) Environmental Effects LLP 4 Brown Lane Fakenham NR21 0HX United Kingdom [Post code and country name needed for the mark] ["UK" is acceptable here]	E-mail address*
	Telephone No.
	Facsimile No.
	Applicant's registration No. with the Office

* **E-mail authorization:** Indicating an e-mail address above authorizes the International Bureau and the International Preliminary Examining Authority, if they provide such a service, to send notifications exclusively by e-mail to that address, unless the following box is marked:

notifications are requested to be sent exclusively by postal mail.

State (<i>that is, country</i>) of nationality: GB or United Kingdom, not UK	State (<i>that is, country</i>) of residence: GB or United Kingdom, not UK
------------------------------------------------------------------------------------------	----------------------------------------------------------------------------------------

Name and address: (*Family name followed by given name; for a legal entity, full official designation. The address must include postal code and name of country.*)

State (<i>that is, country</i>) of nationality:	State (<i>that is, country</i>) of residence:
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Further applicants are indicated on a continuation sheet.

Box No. III AGENT OR COMMON REPRESENTATIVE; OR ADDRESS FOR CORRESPONDENCE

The following person is agent common representative
 and has been appointed earlier and represents the applicant(s) also for international preliminary examination.
 is hereby appointed and any earlier appointment of (an) agent(s)/common representative is hereby revoked.
 is hereby appointed, specifically for the procedure before the International Preliminary Examining Authority, in addition to the agent(s)/common representative appointed earlier.

Name and address: *(Family name followed by given name; for a legal entity, full official designation. The address must include postal code and name of country.)*

Cahill, Louise
 Potters Patents LLP
 19 Holdenby House
 Ipswich IP1 1AN
 United Kingdom

Name must be family name first

Post code and country required
 UK or United Kingdom ok here

E-mail address*

info@potters.com

+44 1473 552233 or
 01473 552233

Facsimile No.

Agent's registration No. with the Office

Where details are given in the question, they must be provided here for full marks

* **E-mail authorization:** Indicating an e-mail address above authorizes the International Bureau and the International Preliminary Examining Authority, if they provide such a service, to send notifications exclusively by e-mail to that address, unless the following box is marked:

notifications are requested to be sent exclusively by postal mail.

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.

Box No. IV BASIS FOR INTERNATIONAL PRELIMINARY EXAMINATION

Statement concerning amendments:* Where checked, boxes must be correct to gain the mark

1. The applicant wishes the international preliminary examination to start on the basis of:

- the description as originally filed, ← This box need not be checked for the mark
 as amended under Article 34
- the sequence listing (if any) as originally filed, or
 as amended under Article 34
- the claims as originally filed, or
 as amended under Article 19, and/or
 as amended under Article 34 ← This box need not be checked for the mark
- the drawings (if any) as originally filed, or ← This box need not be checked for the mark.
 as amended under Article 34

2. The applicant wishes any amendment to the claims under Article 19 to be considered as reversed.

3. Where the IPEA wishes to start the international preliminary examination at the same time as the international search in accordance with Rule 69.1(b), the applicant requests the IPEA to **postpone** the start of the international preliminary examination until the expiration of the applicable time limit under Rule 69.1(d).

4. The applicant expressly requests to **postpone** the start of the international preliminary examination until the expiration of the applicable time limit under Rule 54bis.1(a).

* Where no check-box is marked, international preliminary examination will start on the basis of the international application as originally filed or, where a copy of amendments to the claims under Article 19 and/or amendments of the international application under Article 34 are received by the International Preliminary Examining Authority before it has begun to draw up a written opinion or the international preliminary examination report, as so amended.

Language for the purposes of international preliminary examination: English

- which is the language in which the international application was filed.
 which is the language of a translation furnished for the purposes of international search.
 which is the language of publication of the international application. ← Mark still awarded if this box checked
 which is the language of the translation (to be) furnished for the purposes of international preliminary examination.

Box No. V ELECTION OF STATES

The filing of this demand constitutes the election of all Contracting States which are designated and are bound by Chapter II of the PCT.

Box No. VI CHECK LIST

The demand is accompanied by the following elements, in the language referred to in Box No. IV, for the purposes of international preliminary examination:

- | | | | |
|-----------------------------------------------------------------------------------------------|---|--------------------------|--------|
| 1. translation of international application | : | | sheets |
| 2. amendments under Article 34 | : | 4 | sheets |
| 3. amended sequence listing under Article 34 | : | <input type="checkbox"/> | |
| 4. letter accompanying the amendments under Article 34 (Rule 66.8) | : | 2 | sheets |
| 5. copy (or, where required, translation) of amendments under Article 19 | : | | sheets |
| 6. copy of the letter accompanying the amendments under Article 19 (Rules 46.5(b) and 53.9) | : | | sheets |
| 7. copy (or, where applicable, translation) of any statement under Article 19 (Rule 62.1(ii)) | : | | sheets |
| 8. other (<i>specify</i>) | : | | sheets |

For International Preliminary Examining Authority use only
received not received

<input type="checkbox"/>	<input type="checkbox"/>
<input type="checkbox"/>	<input type="checkbox"/>
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<input type="checkbox"/>	<input type="checkbox"/>
<input type="checkbox"/>	<input type="checkbox"/>
<input type="checkbox"/>	<input type="checkbox"/>

The demand is also accompanied by the item(s) marked below:

- | | |
|---------------------------------------------------------------------------------------------------------------------|-------------------------------------------------------------------------------------------------------------------------------------------------------------|
| 1. <input checked="" type="checkbox"/> fee calculation sheet | 5. <input type="checkbox"/> sequence listing for the purposes of international preliminary examination (Rule 13ter) |
| 2. <input type="checkbox"/> original separate power of attorney | 6. <input type="checkbox"/> a statement to the effect that the sequence listing does not go beyond the disclosure in the international application as filed |
| 3. <input type="checkbox"/> original general power of attorney | 7. <input type="checkbox"/> other (<i>specify</i>): _____ |
| 4. <input checked="" type="checkbox"/> copy of general power of attorney; reference number, if any: PoA-Env1 | |

Box No. VII 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 demand).

Louise Cahill

[Any correct name format here is ok. No need to add designations like EPA, but acceptable if present.]

For International Preliminary Examining Authority use only

1. Date of actual receipt of DEMAND:

2. Adjusted date of receipt of demand due to CORRECTIONS under Rule 60.1(b):

3. The date of receipt of the demand is AFTER the expiration of 19 months from the priority date and item 4 or 5, below, does not apply.

The applicant has been informed accordingly.

4. The date of receipt of the demand is WITHIN the time limit of 19 months from the priority date as extended by virtue of Rule 80.5.

5. Although the date of receipt of the demand is after the expiration of 19 months from the priority date, the delay in arrival is EXCUSED pursuant to Rules 82 or 82quater.

6. The date of receipt of the demand is AFTER the expiration of the time limit under Rule 54bis.1(a) and item 7 or 8, below, does not apply.

7. The date of receipt of the demand is WITHIN the time limit under Rule 54bis.1(a) as extended by virtue of Rule 80.5.

8. Although the date of receipt of the demand is after the expiration of the time limit under Rule 54bis.1(a), the delay in arrival is EXCUSED pursuant to Rules 82 or 82quater.

For International Bureau use only

Demand received from IPEA on: