



**CIPA ADVANCED PATENT
PARALEGAL COURSE
MODULE 1
ASSESSMENT ANSWERS 2025**

To pass this Module, candidates would need to fully or partially demonstrate achievement of a majority of the tasks in the assessment.

Candidates were asked to indicate their sources of information. Where appropriate relevant legislation should have been quoted if this forms part of the source of the information.

The suggested answers provided below are not exhaustive, as alternative answers may be valid and would be acceptable.

Question 1

- a) Describe the circumstances under which a UK patent may lapse or expire, leading to the need for restoration. When is it not possible to restore a patent? What aspects of a patent paralegal's role may be relevant in a client being able to apply for restoration?

(4 tasks to include sources of information)

Answer:

- A UK patent may lapse as a result of the non-payment of renewal fees. This could arise because of an error on the part of the agent, the patent owner or – possibly - an administrative error by the IPO.
- To apply for restoration, the lapsing of the patent must have occurred unintentionally.
- It is not possible to apply for restoration if the lapsing of a granted patent occurs as a result of a decision to allow the patent to lapse and because the patent owner has simply changed their mind.
- It is important that, upon grant of a patent, the client be advised that renewal fees be paid regularly to maintain their patent. If client retains the service to pay renewal fees, then deadlines be entered into the diary system and attorney retained as address for service. Client should be reminded of deadlines as they arise and, if instructions are not received in time, then client should be contacted and advised about the impact of non-payment. Records of all communications need to be kept, as this may be relevant in terms of evidence as to reason for non-payment.

- b) Explain the legal framework governing the restoration of UK patents.

(1 task)

Answer: The legal framework for restoring UK patents primarily revolves around the Patents Act 1977 and the Patents Rules 2007. In particular Section 28 of the UKPA 77 and Rule 40. The Manual of Patent Practice provides guidance and case law from time to time may be relevant.



**CIPA ADVANCED PATENT
PARALEGAL COURSE
MODULE 1
ASSESSMENT ANSWERS 2025**

- c) Discuss the role of a patent paralegal in the restoration process of their UK patents. What tasks and responsibilities may a paralegal typically handle during the restoration process?

(1 Task)

Answer: Responsibilities may include:

- **Eligibility Assessment:** Paralegals may be involved in the process of determining whether the lapsing was unintentional, for example, if that arose as a result of processes within the place of work. This could involve reviewing relevant documents and circumstances.
- **Documentation Preparation:** They may assist in preparing the restoration application, ensuring that all necessary documents and statements are correctly completed and submitted.
- **Timeline Management:** Paralegals track important deadlines, including the filing date of the restoration application and any opposition periods.
- **Publication Monitoring:** They keep an eye on the publication of the restoration application, allowing time for any potential third-party opposition.
- **Communication:** Paralegals may liaise with the IPO, provide updates to clients, and respond to inquiries regarding the restoration process.
- **Compliance Oversight:** After restoration, they ensure compliance with any remaining requirements e.g., paying of outstanding renewal fees.
- **Record-Keeping:** Paralegals maintain accurate records of all activities related to the restoration case and ensure that any past record-keeping errors are not replicated.
- **Invoicing:** paralegals may be involved in generating and checking invoices and liaising with clients in relation to queries and settlement of invoices.

- d) Explain the significance of maintaining accurate records and deadlines in patent restoration cases. How can patent paralegals ensure that they meet all relevant deadlines and avoid procedural errors?

(1 Task)

Answer: Accurate record-keeping and adherence to deadlines are critical in patent restoration cases. Missing a deadline or filing the incorrect documents could mean that the application fails. This could give rise to significant reputational and financial loss to the firm handling the case. Paralegals can ensure compliance by:

- **Deadline Management:** Use appropriate diary systems such as a document and records management system to track deadlines, ensuring no critical dates are missed. This means ensuring that all deadlines are correctly entered.
- **Document Management:** Maintain a well-organized system for storing and retrieving case-related documents.
- **Regular Updates:** Communicate regularly with clients and internal teams to provide updates on case progress and upcoming deadlines.



**CIPA ADVANCED PATENT
PARALEGAL COURSE
MODULE 1
ASSESSMENT ANSWERS 2025**

- Double-Checking: Conduct routine reviews of case files to ensure all documents are complete and up to date.



**CIPA ADVANCED PATENT
PARALEGAL COURSE
MODULE 1
ASSESSMENT ANSWERS 2025**

Question 2

(1 task)

Your client, Westmoreland Optical Systems Limited, is the owner of UK patent GB2785432. They have become aware of a potential infringement of their patent and wish to have an opinion on infringement from the IPO. They believe that the possible infringer is a company called Optical Importers Limited who import the potentially infringing system from overseas. Their address is 75 Flexton Road, Norwich NR5 3PP. Your client has also recently been made aware of some prior art which may impact on the validity of the patent. Your client's address is Unit 7, Big Business Park, Long Road, IPSWICH, IP17 8AB. Tilly Field, a registered patent attorney is handling the case and they have asked you to handle the filing of an infringement and a validity opinion request.

Please prepare the documentation for filing. Tilly has prepared the relevant supporting documentation for use with this case. You work for Patents&Stuff, 22 Regents Road, London WC2 4FF, UK. Tilly's email is tilly@p&s.co.uk. The file references are C1234GB1 for the infringement opinion and C1234GB2 for the validity opinion. Your deposit account number at the IPO is D11111.

Identify the deadlines that should use in your management system to ensure smooth running of the process? Include a suitable realistic timeline for these deadlines.

Answer:

Completed forms attached. Candidates could supply one form for each of the infringement and validity opinion requests or use a single form for both.

Suggested deadlines to be identified:

- Application filed?
- Acknowledgment from IPO
- 3rd parties advised?
- 3rd party comments received?
- Deadline to respond to 3rd party comments?
- Has a decision from the IPO been received?



**CIPA ADVANCED PATENT
PARALEGAL COURSE
MODULE 1
ASSESSMENT ANSWERS 2025**

Question 3

(1 Task)

Provide a written reflection on **your learning** during this module. This should include a discussion on the level of your knowledge and skills at the start of this module, and what you were hoping to learn during this part of the course. You should also describe what specific learnings you have made and how you see this assisting your work in future, and how you would like to continue your learning going forward. Maximum 1-page A4, double spaced.



Patents Form 17

Patents Act 1977 (Rule 93)

Request for opinion as to validity or infringement

(See the notes on the back of this form)

1. Your reference.	C1234GB1		
2. Number of patent on which an opinion is sought.	GB2785432		
3. Your full name, address and postcode.	Westmoreland Optical Systems Limited Unit 7 Big Business Park, Long Road IPSWICH, IP17 8AB United Kingdom		
Patents ADP number. (if you know it).			
4. Full name of the or of each patent proprietor (see note (d))	Westmoreland Optical Systems Limited		
5. Are you requesting: (see note (e))			
an opinion in relation to infringement (section 74A(1)(a)).	☒		
an opinion in relation to validity (section 74A(1)(b)).	☐		
6. Relevant information concerning related proceedings and interested parties (see note (f)).	Optical Importers Limited 75 Flexton Road, NORWICH, NR5 3PP United Kingdom		
7. Name of your agent (if you have one):	Patents&Stuff		
Address for Service in the United Kingdom, Gibraltar or the Channel Islands to which all correspondence should be sent: (see note (g)) (including the postcode).	22 Regents Road LONDON WC2 4FF United Kingdom		
Patents ADP number. (if you know it).			
8. Signature This can be typed or handwritten	BLANK	Date	Assessment Date
9. Name, email address, telephone and/or mobile number, if any, of a contact point for the applicant.	FIELD, Tilly tilly@p&s.co.uk		

Warning

Any material that you submit with this form will be made available to the public. A copy will also be sent to the patent proprietor (unless you are the proprietor) and to other interested parties. These will include anyone you mention in your request, any registered licensees of the patent in question, and others. You should be careful not to make any statement that constitutes an unjustified threat to sue for patent infringement (see section 70 of the Patents Act 1977).

Notes

- a) If you need help to fill in this form or you have any questions, please contact the Office on 0300 300 2000.
- b) Write your answers in capital letters using black ink or you may type them.
- c) If there is not enough space for all the relevant details on any part of this form, please continue on a separate sheet of paper and write "see continuation sheet" in the relevant part(s) of the form. Any continuation sheets should be attached to this form.
- d) If you are the sole proprietor of the patent to which this request relates, you should leave section 4 blank. If you own the patent jointly with others, you should identify your co-proprietors in section 4. If you are not the proprietor of the patent to which this request relates, you should identify the proprietor or proprietors in section 4.
- e) You may request either an opinion under section 74A(1)(a) in relation to patent infringement or under section 74A(1)(b) in relation to patent validity. An opinion relating to validity may consider only issues of novelty or inventive step.
- f) You should use section 6 to identify any relevant proceedings which relate to the patent in the UK or at the European Patent Office - either under way or completed - of which you are aware. You should also disclose the name and address of any person, of whom you are aware, having an interest in the question upon which an opinion is sought. You do not need to name people with no more than a marginal interest in the issue. If the request concerns an opinion on infringement, you should if possible give the name and address of the alleged primary infringer (eg, the manufacturer or importer of the product in question). Having done so, it may not be necessary to identify alleged secondary infringers (such as retailers who are merely selling the product in question).
- g) 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.
- h) You must file this form in duplicate.
- i) You must file two copies of a statement at the same time as you file the form. You must also provide two copies of any evidence or other document which is referred to in the statement. A translation into English should be provided of any document not in English or Welsh.
- j) Once you have filled in the form remember to sign and date it.
- k) For details of fees and ways to pay, please contact the Office.

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'.

Total Fee Paying (£).

Your own reference (Optional).

Your contact details should we have a query.

Name.

Email.

Phone.

How would you like to pay?

Tick one.

☐

Using a debit or credit card – you will need the internet to pay by card.

- 1 Go to our secure website – <https://fees.ipo.gov.uk/pay>.
- 2 Enter your name, email address and total amount to pay from above.
- 3 As proof of payment, write below the 10-character reference code displayed from the online payment screen.
DO NOT write your debit/credit card number.



Deduct from IPO deposit account.

IPO deposit account number.

☐

Cheque – make payable 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	20-18-23
Account number	80531766
Account name	Intellectual Property Office
SWIFT code	BARCGB22
IBAN number	GB92 BARC 2018 2380 5317 66

Before you send us your form

Make sure you have:

- ☒ Answered all applicable questions.
- ☒ Provided a signature and date. This can be typed or handwritten.
- ☒ Made payment by card, cheque, bank transfer or IPO deposit account.
- ☒ Completed the payment sheet above.

**Email your completed PDF form to:
forms@ipo.gov.uk**

**If you cannot email us your form, you can print and post your form to:
Intellectual Property Office, Concept House, Cardiff Road, Newport, South Wales, NP10 8QQ.**

Please note: It takes longer to process paper forms sent by post.

Data Privacy: <https://www.gov.uk/government/publications/intellectual-property-office-privacy-notices/privacy-notice-for-personal-data-processed-for-the-administration-of-ip-rights>



Patents Form 17

Patents Act 1977 (Rule 93)

Request for opinion as to validity or infringement

(See the notes on the back of this form)

1. Your reference.	C1234GB2		
2. Number of patent on which an opinion is sought.	GB2785432		
3. Your full name, address and postcode.	Westmoreland Optical Systems Limited Unit 7 Big Business Park, Long Road IPSWICH, IP17 8AB United Kingdom		
Patents ADP number. (if you know it).			
4. Full name of the or of each patent proprietor (see note (d))	Westmoreland Optical Systems Limited		
5. Are you requesting: (see note (e))			
an opinion in relation to infringement (section 74A(1)(a)).	☐		
an opinion in relation to validity (section 74A(1)(b)).	☒		
6. Relevant information concerning related proceedings and interested parties (see note (f)).			
7. Name of your agent (if you have one):	Patents&Stuff		
Address for Service in the United Kingdom, Gibraltar or the Channel Islands to which all correspondence should be sent: (see note (g)) (including the postcode).	22 Regents Road LONDON WC2 4FF United Kingdom		
Patents ADP number. (if you know it).			
8. Signature This can be typed or handwritten	BLANK	Date	Assessment Date
9. Name, email address, telephone and/or mobile number, if any, of a contact point for the applicant.	FIELD, Tilly tilly@p&s.co.uk		

Warning

Any material that you submit with this form will be made available to the public. A copy will also be sent to the patent proprietor (unless you are the proprietor) and to other interested parties. These will include anyone you mention in your request, any registered licensees of the patent in question, and others. You should be careful not to make any statement that constitutes an unjustified threat to sue for patent infringement (see section 70 of the Patents Act 1977).

Notes

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- e) You may request either an opinion under section 74A(1)(a) in relation to patent infringement or under section 74A(1)(b) in relation to patent validity. An opinion relating to validity may consider only issues of novelty or inventive step.
- f) You should use section 6 to identify any relevant proceedings which relate to the patent in the UK or at the European Patent Office - either under way or completed - of which you are aware. You should also disclose the name and address of any person, of whom you are aware, having an interest in the question upon which an opinion is sought. You do not need to name people with no more than a marginal interest in the issue. If the request concerns an opinion on infringement, you should if possible give the name and address of the alleged primary infringer (eg, the manufacturer or importer of the product in question). Having done so, it may not be necessary to identify alleged secondary infringers (such as retailers who are merely selling the product in question).
- g) 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.
- h) You must file this form in duplicate.
- i) You must file two copies of a statement at the same time as you file the form. You must also provide two copies of any evidence or other document which is referred to in the statement. A translation into English should be provided of any document not in English or Welsh.
- j) Once you have filled in the form remember to sign and date it.
- k) For details of fees and ways to pay, please contact the Office.

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'.

Total Fee Paying (£).

200

Your own reference (Optional).

C1234GB2

Your contact details should we have a query.

Name.

Tilly FIELD

Email.

tilly@p&s.co.uk

Phone.

How would you like to pay?

Tick one.

☐

Using a debit or credit card – you will need the internet to pay by card.

- 1 Go to our secure website – <https://fees.ipo.gov.uk/pay>.
- 2 Enter your name, email address and total amount to pay from above.
- 3 As proof of payment, write below the 10-character reference code displayed from the online payment screen.
DO NOT write your debit/credit card number.



Deduct from IPO deposit account.

IPO deposit account number.

D11111

☐

Cheque – make payable 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	20-18-23
Account number	80531766
Account name	Intellectual Property Office
SWIFT code	BARCGB22
IBAN number	GB92 BARC 2018 2380 5317 66

Before you send us your form

Make sure you have:

- ☒ Answered all applicable questions.
- ☒ Provided a signature and date. This can be typed or handwritten.
- ☒ Made payment by card, cheque, bank transfer or IPO deposit account.
- ☒ Completed the payment sheet above.

**Email your completed PDF form to:
forms@ipo.gov.uk**

**If you cannot email us your form, you can print and post your form to:
Intellectual Property Office, Concept House, Cardiff Road, Newport, South Wales, NP10 8QQ.**

Please note: It takes longer to process paper forms sent by post.

Data Privacy: <https://www.gov.uk/government/publications/intellectual-property-office-privacy-notices/privacy-notice-for-personal-data-processed-for-the-administration-of-ip-rights>



CIPA ADVANCED PATENT PARALEGAL COURSE

MODULE 2

ASSESSMENT 2025

Candidates were provided with the following information for the questions in this assessment of this module:

For the questions below you work for Patents & Stuff LLP of 4 Long Road, Short Meadow, EX22 2BB. Your correspondence email is mail@p&s.co.uk. The attorney with whom you work is Tilly Field. Their email is tilly@p&s.co.uk and your firm's phone number is 01333651234. Your UK deposit account number is D11111 and your EP deposit account number is 1234.

Candidates were told that, if they needed to complete any forms in response to these tasks, they should use the date that they complete the form as the date for the form.

Candidates were told that in their answers they should provide details of your sources of information.

The suggested answers provided below are not exhaustive, as alternative answers may be valid and would be acceptable.

Question 1

(3 tasks: one task per country)

Your client, Stratfield Minerals Limited, has a pending PCT patent application number PCT/GB2024/123456 filed on 16 May 2024. Your case reference is WO554677. The application claims priority from GB2312366.5 dated 17 May 2023. The title of the invention is METHOD OF MINERAL EXTRACTION. Inventors' details were not included in the initial PCT application. The client wishes to pursue patent applications in China, Uruguay and Saudi Arabia.

Draft a file note outlining the required steps to ensure correct actions to take in order to ensure that patent applications are filed in these countries.

The file note should identify steps that need to be taken, deadlines to be met and whether extensions are available, documentation required, any further information needed to support the application as well as fees required to be paid (although amounts are not needed) as well as anything else that the client should be aware of or needs to do. If documents are required to be officiated, for example, by notarization, you should outline the steps to be followed for ensuring that the correct procedure is followed.

Also identify any ongoing fees after filing.



CIPA ADVANCED PATENT PARALEGAL COURSE

MODULE 2

ASSESSMENT 2025

Answer

Saudi Arabia

Deadline for filing: 30 months from priority – 17 November 2025

There are filing fees

Documents due on filing, but if not submitted will be asked to supply within three months.

Needs translation of International Application and any supporting application into Arabic, so there will be translation costs.

Need to appoint an SA agent and a Power of Attorney is required and must be legalised using the Apostille procedure. Deadline is three months from filing.

Apostille process: This process certifies the signature on the document is authentic. The agent in Saudi Arabia will provide the required PoA. You will need to get it signed by your client and then it is submitted to the Foreign, Commonwealth & Development Office (FCDO). Check if an e-Apostille is possible, otherwise needs to be submitted in paper form. There is a cost for this (£64). You can use an agent for this. Extra cost, but less likely to make any errors.

The following details are also required:

- Name and address of the inventor if not indicated in the “Request” part of the international application
- Declaration as to the applicant’s entitlement to apply for and be granted a patent
- Declaration as to the applicant’s entitlement to claim priority of the earlier application.

Certified copy of the priority document must be within three months of filing, with details provided on filing. No translation required.

Ongoing fees: maintenance fees and request for substantive exam within three months.

*Candidate should have looked at the requirements generally and decided which are relevant for this case i.e. should not have just copied and pasted from the PCT applicants guide.

*Exemplar sources: PCT Applicants Guide, websites of country-based associates or UK-based companies doing NPE (e.g. RWS); Gov.UK for apostille process, “Brown Book”.



CIPA ADVANCED PATENT PARALEGAL COURSE

MODULE 2

ASSESSMENT 2025

China

Deadline for filing – 30-months from priority – 17 November 2025

extendible to 32-months from priority - to 17 January 2026 (with surcharge)

There are filing fees, including excess claims fees (where applicable)

Documents due on filing, translated into Chinese

same extension period as above applies, so there will be translation costs
and potentially urgency fees for quick translation

Drawings can be filed in colour

Need to appoint a CN agent and a Power of Attorney is required. No legalisation necessary. Specific Powers of Attorney and Assignment forms can be faxed or scanned to the Patent Office. However, the original General Power of Attorney must still be mailed to the agent for submission.

The following details are also required:

- Name of the inventor if it has not been furnished in the 'Request' part of the international application
- Instrument of assignment if applicant is not the same as the one in the priority claim
- Instrument of assignment if the applicant has changed after the PCT international filing date
- Furnishing (where applicable) of a nucleotide and/or amino acid sequence listing in electronic form

Ongoing fees:

- request for examination and payment of examination fee must be affected within 3 years of the priority date
- Annual fees must be paid within 2-months of the receipt of the notice from the CN office of grant of the patent. All subsequent fees must be paid in advance within the month before the international filing date. This can be paid late, by invitation, within 6-months of the time limit due, with a surcharge

Uruguay

Cannot request NPE as Uruguay only acceded to the PCT in 2025.

*Candidate should have looked at the requirements generally and decided which are relevant for this case i.e. should not have just copied and pasted from the PCT applicants guide.

*Exemplar sources: PCT Applicants Guide, websites of country-based associates or UK-based companies doing NPE (e.g. RWS); "Brown Book".



CIPA ADVANCED PATENT PARALEGAL COURSE

MODULE 2

ASSESSMENT 2025

Question 2

(2 Tasks: identifying and discussing options, and completing form(s))

Your client, a company BIGGAR AUTOMATED MACHINES Inc. of 1234 Brown Street, Exton, CA 91234, United States wants to file a PCT application claiming priority from a US patent application number 2024712345 filed 18 July 2024. The priority document has a PDAS code: A2B4.

You allocate this a file reference WO555666

The specification has 20 pages of description, 3 pages of claims with 17 claims, 1 page of abstract and 6 pages of drawings (1/6 to 6/6). The title is; "PRINTING MACHINE". Figure 1 is to be used with the Abstract.

The inventors are John Smith and Ravinder Singh, both US citizens and employed by Biggar Automated Machines.

They have assigned the rights to the patent in Germany to a related company: BIGGAR MACHINEN GmbH of Hauptstrasse 10, 10115 Berlin, GERMANY.

Discuss the various options for the client for validly filing a PCT application. If there is an option for you to do this for your client, please complete any documentation required for filing.

Answer

Issues: Candidates need to identify that there is a second applicant: the German company. Candidates needed to identify the possible competent Receiving Offices: USPTO, DE, IB and EPO (as one of the applicants is a DE national). Patents & Stuff could instruct a US attorney to file at USPTO, or German Attorney at the German Patent Office, but this adds complexity to the process. Using the IB as an option, as is the EPO: both of these are preferred. Candidate should then identify that their firm (Patents & Stuff) can act as representatives and file at the EPO or the IB with dual applicants. The application would include the US company for all states apart from Germany and the German Company would be an applicant for Germany.

See attached form which shows the form for filing at the EPO using the details provided in the question.



CIPA ADVANCED PATENT PARALEGAL COURSE
MODULE 2
ASSESSMENT 2025

Question 3

(1 Task)

Provide a written reflection on your learning during this module. This should include a discussion on the level of your knowledge and skills at the start of this module, and what you were hoping to learn during this part of the course. You should also describe what specific learnings you have made and how you see this assisting your work in future, and how you would like to continue your learning going forward.

Maximum 1-page A4, double spaced.

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 ☐ 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>)		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 receiving Office, the International Searching Authority and the International Bureau, 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:		State (<i>that is, country</i>) of residence:	
This person is applicant for the purposes of: ☐ all designated States ☐ the States indicated in the Supplemental Box			
Box No. III FURTHER APPLICANT(S) AND/OR (FURTHER) INVENTOR(S)			
☐ 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:		☐ agent	☐ 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>)		E-mail address*	
		Telephone No.	
		Facsimile No.	
		Agent's registration No. with the Office	
* E-mail authorization: Indicating an e-mail address above authorizes the receiving Office, the International Searching Authority and the International Bureau, 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. 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: ☐ applicant only ☐ applicant and inventor ☐ inventor only <i>(If this check-box is marked, do not fill in below.)</i>
State <i>(that is, country)</i> of nationality:		Applicant's registration No. with the Office
State <i>(that is, country)</i> of residence:		
This person is applicant for the purposes of: ☐ all designated States ☐ 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: ☐ applicant only ☐ applicant and inventor ☐ inventor only <i>(If this check-box is marked, do not fill in below.)</i>
State <i>(that is, country)</i> of nationality:		Applicant's registration No. with the Office
State <i>(that is, country)</i> of residence:		
This person is applicant for the purposes of: ☐ all designated States ☐ 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: ☐ applicant only ☐ applicant and inventor ☐ inventor only <i>(If this check-box is marked, do not fill in below.)</i>
State <i>(that is, country)</i> of nationality:		Applicant's registration No. with the Office
State <i>(that is, country)</i> of residence:		
This person is applicant for the purposes of: ☐ all designated States ☐ 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: ☐ applicant only ☐ applicant and inventor ☐ inventor only <i>(If this check-box is marked, do not fill in below.)</i>
State <i>(that is, country)</i> of nationality:		Applicant's registration No. with the Office
State <i>(that is, country)</i> of residence:		
This person is applicant for the purposes of: ☐ all designated States ☐ 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: ☐ applicant only ☐ applicant and inventor ☐ inventor only <i>(If this check-box is marked, do not fill in below.)</i>
State <i>(that is, country)</i> of nationality:		Applicant's registration No. with the Office
State <i>(that is, country)</i> of residence:		
This person is applicant for the purposes of: ☐ all designated States ☐ the States indicated in the Supplemental Box		
☐ Further applicants and/or (further) inventors are indicated on another continuation sheet.		

Supplemental Box*If the Supplemental Box is not used, this sheet should not be included in the request.*

1. If, in any of the Boxes, except Boxes Nos. VIII(i) to (v) for which a special continuation box is provided, **the space is insufficient** to furnish all the information: in such case, write "Continuation of Box No...." (indicate the number of the Box) and furnish the information in the same manner as required according to the captions of the Box in which the space was insufficient, in particular:
 - (i) **if more than one person is to be indicated as applicant and/or inventor** and no "continuation sheet" is available: in such case, write "Continuation of Box No. III" and indicate for each additional person the same type of information as required in Box No. III. 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;
 - (ii) if, in Box No. II or in any of the sub-boxes of Box No. III, the indication **"the States indicated in the Supplemental Box"** is checked: in such case, write "Continuation of Box No. II" or "Continuation of Box No. III" or "Continuation of Boxes No. II and No. III" (as the case may be), indicate the name of the applicant(s) involved and, next to (each) such name, the State(s) (and/or, where applicable, ARIPO, Eurasian, European or OAPI patent) for the purposes of which the named person is applicant;
 - (iii) if, in Box No. II or in any of the sub-boxes of Box No. III, **the inventor or the inventor/applicant is not inventor for the purposes of all designated States**: in such case, write "Continuation of Box No. II" or "Continuation of Box No. III" or "Continuation of Boxes No. II and No. III" (as the case may be), indicate the name of the inventor(s) and, next to (each) such name, the State(s) (and/or, where applicable, ARIPO, Eurasian, European or OAPI patent) for the purposes of which the named person is inventor;
 - (iv) if, in addition to the agent(s) indicated in Box No. IV, there are **further agents**: in such case, write "Continuation of Box No. IV" and indicate for each further agent the same type of information as required in Box No. IV;
 - (v) if, in Box No. VI, there are **more than three earlier applications whose priority is claimed**: in such case, write "Continuation of Box No. VI" and indicate for each additional earlier application the same type of information as required in Box No. VI.
2. If the applicant intends to make an indication of the wish that the international application be treated, in certain designated States, as an application for a patent of addition, certificate of addition, inventor's certificate of addition or utility certificate of addition: in such case, write the name or two-letter code of each designated State concerned and the indication **"patent of addition," "certificate of addition," "inventor's certificate of addition" or "utility certificate of addition,"** the number of the parent application or parent patent or other parent grant and the date of grant of the parent patent or other parent grant or the date of filing of the parent application (Rules 4.11(a) (i) and 49bis.1(a) or (b)).
3. If the applicant intends to make an indication of the wish that the international application be treated, in the United States of America, as a continuation or continuation-in-part of an earlier application: in such case, write "United States of America" or "US" and the indication **"continuation" or "continuation-in-part"** and the number and the filing date of the parent application (Rules 4.11(a)(ii) and 49bis.1(d)).

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

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 filing – only to be used when filing on PAPER			
This international application contains the following:		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 sheets (a) request form PCT/RO/101 (including any declarations and supplemental sheets) : (b) description : (c) claims : (d) abstract : (e) drawings (if any) : Total number of sheets :		1. ☐ fee calculation sheet. : 2. ☐ original separate power of attorney : 3. ☐ original general power of attorney. : 4. ☐ copy of general power of attorney; reference number: : 5. ☐ priority document(s) identified in Box No. VI as item(s) : 6. ☐ Translation of international application into (language): : 7. ☐ separate indications concerning deposited microorganism or other biological material : 8. ☐ copy of results of earlier search(es) (Rule 12bis.1(a)) ... : 9. ☐ other (specify): :	
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: ☐ received: ☐ 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. ☐ 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:

PCT

FEE CALCULATION SHEET

Annex to the Request

For receiving Office use only

International Application No.

Date stamp of the receiving Office

Applicant's or agent's file reference

Applicant

CALCULATION OF PRESCRIBED FEES

(Applicants may be entitled to a reduction of certain fees as indicated in the PCT Fee Tables (www.wipo.int/pct/en/fees.pdf))

1. TRANSMITTAL FEE: T

2. SEARCH FEE: S

International search to be carried out by: _____

3. INTERNATIONAL FILING FEE

Enter total number of sheets indicated in Box No IX: _____

i1 Fixed amount for the first 30 sheets i1

i2 _____ x _____ = i2
number of sheets fee per sheet
in excess of 30

Add amounts entered at i1 and i2 and enter total at I: I

(Applicants from certain States are entitled to a reduction of 90% of the international filing fee (see www.wipo.int/pct/en/fees/fee_reduction.pdf). Where the applicant is (or all applicants are) so entitled, the total to be entered at I is 10% of the international filing fee.)

4. FEE FOR PRIORITY DOCUMENT (if applicable): P

5. FEE FOR RESTORATION OF THE RIGHT OF PRIORITY (if applicable): RP

6. FEE FOR EARLIER SEARCH DOCUMENTS (if applicable): ES

7. TOTAL FEES PAYABLE

Add amounts entered at T, S, I, P, RP and ES, and enter total in the TOTAL box

TOTAL

MODE OF PAYMENT (Not all modes of payment may be available at all receiving Offices)

- ☐ credit card (details should not be included on this sheet) ☐ authorization to charge deposit or current account (see below) ☐ bank transfer ☐ cash
- ☐ postal money order ☐ check ☐ revenue stamps ☐ other (specify): _____

AUTHORIZATION TO CHARGE (OR CREDIT) DEPOSIT OR CURRENT ACCOUNT

(This mode of payment may not be available at all receiving Offices)

- ☐ Authorization to charge the total fees indicated above.
- ☐ (This check-box may be marked only if the conditions for deposit or current accounts of the receiving Office so permit) Authorization to charge any deficiency or credit any overpayment in the total fees indicated above.
- ☐ Authorization to charge the fee for priority document.

Receiving Office: RO/ _____

Deposit or Current Account No.: _____

Date: _____

Name: _____

Signature: _____



CIPA ADVANCED PATENT PARALEGAL COURSE

MODULE 3

ASSESSMENT 2025

Candidates were asked to provide details of their sources of information in their answers.

The suggested answers provided below are not exhaustive, as alternative answers may be valid and would be acceptable.

Question 1

(1 Task)

A PCT application claims priority from two applications: a US application filed on the 31 October 2022, and a European Patent Application filed on the 23 January 2023. The applicant is a US company, which is a wholly owned subsidiary of a French company based in Paris. The PCT application was filed using a US patent attorney firm at the USPTO on 31 October 2023.

The French company also has another subsidiary (Firm B) which has an in-house patent department, including European Patent Attorneys

The applicant wishes to file a European Patent Application as a Regional Phase entry of the PCT application

a) What is the deadline for filing a European Regional Phase entry?

Deadline was 31 May 2025 (Saturday) so extended to next working day 2nd June 2025.

The US attorney handling the PCT application instructs a third-party filing service to file the regional phase entry, appointing a firm of European Patent Attorneys (Firm A) as representatives on the 15 May 2025. The Form 1200 includes instructions for the fees to be debited from a deposit account in the name of the third-party filing service.

Firm A receives correspondence on the 27 May 2025 from the EPO stating that the request for entry into regional phase cannot be accepted because regional phase was requested on the 13 May 2025 by Firm B. It states that observations should be filed within 2 months of the date of notification.

Further enquiries confirm that Firm B did request regional phase entry on the 13 May 2025 and appointed themselves representatives before the EPO. Fee payment was requested by an automatic debit request.

b) Who will be the current appointed representative? How can you check this?

The representative will be Firm B as they validly filed the RPE request and were appointed representatives. This can be checked in the EPO Register, but an enquiry could be made by phone to the EPO Help Desk.

c) What is meant by an automatic debit request? What does this mean for the payment of the fees in this case? Will fees have been paid twice? Who is likely to have paid the fees?



CIPA ADVANCED PATENT PARALEGAL COURSE
MODULE 3
ASSESSMENT 2025

An automatic debit request is where the fees are effectively deferred until the last possible date i.e. the 2 June 2025, so fees will not have been paid at the time the second request was made by the third-party filing service on the 15th May. The fees will probably have been paid though when the second request was filed as the EPO do not require that the fees be paid by the party making the request. If the fees are paid at the time of the second request, then the fees should not be debited again later under the automatic debit request. However, this can be checked using the Register and also by making a direct enquiry to the EPO.

A suggestion is made to withdraw the “second” application.

d) Is this approach correct? What might be the implications if this approach?

Any request to withdraw should not be made as there are not two applications (only one) and a request to withdraw risks withdrawing the application.

Going forward, the applicant wishes for Firm B to be the representative before the EPO.

e) What further action needs to be taken to ensure this happens and that the application is in order to proceed?

As Firm B are the appointed representative, then no further appointment is required, but both Firm A and Firm B should confirm in writing, ideally within 2 months of the correspondence from the EPO (27 July 2025), to confirm representation.



CIPA ADVANCED PATENT PARALEGAL COURSE

MODULE 3

ASSESSMENT 2025

Question 2

(1 Task)

Your client, Big Picture Ltd, a company registered in England and Wales, is a large company with a significant patent portfolio. They filed a European patent application on the 20 December 2019. The application was filed in English. A communication from the EPO under Rule 71(3) EPC has been issued and dated 19 September 2025. The subject matter of this application is no longer of interest to your client and they have advised that they have assigned the patent application to a small Spanish company which employs 9 members of staff and whose annual turnover is EUR 1 million. They have never filed a patent application before. The assignment is dated 1 October 2025. Your client has advised that the assignee wishes to retain you as Authorised Representative and wishes to obtain a Unitary Patent once the patent is granted.

- a) What steps need to be taken? You should detail: deadlines for completing these steps (where known); what fees need to be paid (no need to give the exact amounts: and any documentation that needs to be submitted.

Steps required:

The EPO may request an authorisation from the Spanish company and, if so, this should be filed with the EPO.

Request to register the assignment. A copy of the assignment signed by both parties will be required to be filed. An administrative fee is payable, however this will be waived if filing the request via MyEPO Portfolio.

Pay the seventh renewal fee due 31 December 2025 i.e. end of the month of the anniversary of filing.

Need to obtain translation of claims in to French and German and pay require grant and printing and any excess claims fees. A response to the Rule 71(3) is not necessary, as filing the claims translations and payment of the grant and printing fee implies approval. Deadline is 19 January 2026 (Monday).

Once the decision for grant is issued, within one month of date if grant file of request for unitary effect (in English) with translation into any other EU official language.

- b) Will the new applicant benefit from any reduced official fees? Explain your answer and provide details of any documentation required.

The Spanish company has less than 10 employees and a turnover of less than Euro 2M and has filed fewer than 5 EP applications and is therefore considered a micro-entity and entitled to fee reductions. It is not entitled to a language-related reduction as the application is in English. The reduction will be those related to grant i.e. grant and printing; filing of translations of the claims in German and French.

A declaration regarding requirements for a reduction of fees will need to be filed (Form 1011). The renewal fee will also be at a reduced rate.



CIPA ADVANCED PATENT PARALEGAL COURSE

MODULE 3

ASSESSMENT 2025

Question 3

(1 Task)

Applicant ABC Ltd filed European patent application EP22123456.7 in English on 20 May 2022 and paid the official filing and search fees at the time of filing. It describes two different inventions, X and Y, and claims invention for a first of the two inventions. The European search report was drawn up for the first invention only.

A communication pursuant to Article 94(3) EPC, setting a time limit of four months for response, was issued by the EPO, dated 16 March 2025. A two-month extension of this time limit was granted on 10 July 2025. A response has yet to be filed. Applicant ABC Ltd is now interested in the second invention described in the original patent application. A European divisional application EP25987654.2, based on EP22123456.7, was filed on the 29 September 2025 and describes invention Y. No fees were paid, and no claims were submitted at the time of filing. What steps need to be taken to have the second invention searched by the EPO? Explain your answer.

Answer

A divisional application can only be filed if the parent application is still pending. Currently, EP22123456.7 is deemed to be withdrawn because no response to the communication under Article 94(3) EPC was filed. The time limit for filing a response expired on 16 September 2025. In order to revert the application to a pending status, further processing by paying the further processing fee and file a response to the communication under Article 94(3) EPC. This can be done before a notification that the application has been deemed to be withdrawn has been received: it is not necessary to wait for the notification of loss of rights to be issued. If you do wait, you need to diarise to check for issue of this so the request can be timely filed.

Requesting Further processing means that the parent application will be deemed as never been withdrawn - and therefore pending - so the divisional application will have been validly filed in that regard.

The filing fee and search fee for EP25987654.2 are due on filing. They may be paid within one month of the date of filing of the divisional application (Rule 36(3) EPC) i.e. by 29 October 2025. The third renewal fee and the fourth renewal fee for the divisional become due on filing. They can be validly paid without surcharge within four months of the date of filing of the divisional application (Rule 51(3) EPC) i.e. 29 January 2026 (otherwise with surcharge within six months of the same date). The EPO will issue a communication under Rule 58 EPC setting a time limit of two months from the date of receipt to supply claims. This date must be diarised and the claims filed within this deadline.



CIPA ADVANCED PATENT PARALEGAL COURSE

MODULE 3

ASSESSMENT 2025

Question 4

(1 Task)

You are asked to enter the European Regional Phase from a PCT application filed at the Chinese Patent Office on 1 April 2024, claiming priority from a Chinese originating patent application filed on the 2 April 2023. The application was filed and published in Chinese and comprised 30 pages of description and 7 pages of drawings, and four pages with 20 claims. You have been advised that an English translation of the PCT application will be sent to you in due course. This will comprise 29 pages of description and drawings (unchanged from the filed and published application), and three pages with 15 claims and an abstract comprising two pages. Your client wants you to file the application straight away and file the translation later, which you do.

- a. What fees have to be paid and what would be the last date for paying them?

The deadline for paying the fees is 31 months from the earliest priority date. Therefore, the deadline is 2 November 2025. This is a Sunday, so the deadline rolls over to Monday 3 November 2025.

The fees to be paid are the filing fee, search fee, designation fee, examination fee, and excess page fees. To calculate the excess page fees, the published Chinese text is used as the text would be filed unamended. There are 30 pages of description, 4 pages of claims, 1 page for the abstract, and 7 pages of drawing. This comprises 42 pages, which means 7 excess pages.

These are a requirement and if not paid, can be paid under further processing. Official fees incur a 50% surcharge in this case.

Since the regional phase was filed immediately without the translation or amendments, it would be assumed that the filing, search, examination, and designation fees are to be paid/are paid. The excess page fee can be paid later with the amended specification as long as it is paid by the 31-month deadline. See also the response to question 4(c) below in relation to filing the translation.

There are currently 20 claims on file. However, excess claims fees are not due until a response to the Communication under Rule 161 is filed. No excess claims fees will be due in due course because there will be only 15 claims in the amended claim set.

If the client provided the promised amendments and translation before the deadline, they could be filed upon entry. To calculate the excess page fees, there are 30 pages of description and 7 pages of drawing from the as published specification, plus 3 pages for the claims and 1 page of abstract as these are being amended and we use the English translation. In this case there are 41 pages which means 6 excess page fees.

There are optional fees for available extension and validation states.

The 3rd year renewal fee is not due until 30 April 2026.

- b. You filed an automatic debit request for the European Regional Phase entry. After filing the application, you receive an email from the EPO informing you that there are insufficient funds in your deposit account to cover any of the fees to be paid (as identified in



CIPA ADVANCED PATENT PARALEGAL COURSE

MODULE 3

ASSESSMENT 2025

your answer to question 4(a) above. You replenish the account two days after receiving the email. Do you have to take any further action to ensure these fees are paid??

An automatic debit request is where the fees are effectively deferred until the last possible date. The payment is deemed to have been made on the date on which the account was duly replenished (point 8 AAD). Since this is after the due date for paying the fees, the application is deemed to be withdrawn (Article 78(2) EPC). Further processing will therefore be necessary in order to progress the application. No action is required as long as there are sufficient funds in the deposit account (the EPO will automatically debit all the required fees, including the further processing fee, the search fee and the filing fee (which includes the page fee)).

c. What is the time limit for filing an English translation of the application via the EPO's online services? What is the consequence for the time limit if, on the last day of the period for filing the translation, there is an unplanned outage of the EPO's online services which prevents you from filing it? The outage lasts for the whole of that day.

A translation must be filed within 31 months of the priority date (see above for date).

If documents to be filed by one of the means of electronic communication permitted by the President of the European Patent Office (under Rule 2(1) EPC) cannot be received on the day on which a period for performing procedural acts expires, the period shall extend to the first working day on which all means of electronic filing are available (Rule 134(1) EPC and OJ EPO 2020, A120).



CIPA ADVANCED PATENT PARALEGAL COURSE
MODULE 3
ASSESSMENT 2025

Question 5

(1 Task)

Provide a written reflection on your learning during this module. This should include a discussion on the level of your knowledge and skills at the start of this module, and what you were hoping to learn during this part of the course. You should also describe what specific learnings you have made and how you see this assisting your work in future, and how you would like to continue your learning going forward.

Maximum 1-page A4, double spaced.