

Question 1 : D

Both statements are not correct

Today; 21 May 2019

Priority; 16 October 2016

30 months; 16 April 2019

31 months; 16 May 2019

Statement I is not correct because EA = 31 months

Statement II is not correct because CN = 30 months or 2 months grace after 30 months; 16 June 2019

Not possible to withdraw outside 30 months even if so, the 30/31 month time limit do not change.

Question 2: A

The time limit the pay the fee ended 15 May 2019.

This letter is an invitation according to R16bis.1.sub(a). This sets a time limit of 1 month from that date of invitation, so the time limit ends on 15 May 2019. If there is a delay in delivering the letter Rule 80.6 second sentence may apply. However, this provision requires the delay to be at least 7 days. In this case the delay was only 5 days. So there is no extension under this rule. The only option you have is to call the receiving office and check whether the case is already declared withdrawn – if not, payment could still be considered in time under R.16bis.1 sub(e)

Question 3: C

Applicants guide international phase appendix C nationality

The main issue is which office may be competent receiving office for IA. Nationality/residence of the applicant determine whether an rO is competent or not. NL and EP are both not competent.

Dutch or EP attorney does not play a role,

It is possible to file at WIPO/IB

Question 4: B

The 2 month time limit is calculated from the date of the communication and ends on 13 July 2019; Saturday so Monday 15 July 2019.

The EPO is acting here as receiving office under PCT thus PCT Rule 80.5 applies, not the EPC-10 day rule.

Question 5: B

You can request restoration at the receiving office within 2 months of the priority period (R.26bis.3 c) i.e. 14 months after the priority date, which is 7 July 2019.

At the EPO restoration can only be requested based on all due care, not intent (AG-IP Annex C for rOs)

Question 6: C

- a. False - Where no priority is claimed, the translation of an international application has to be supplied within thirty-one months from the date of filing.
- b. False - If the translation is not filed in due time, the European patent application is deemed to be withdrawn (Rule 160(1) and (2) EPC), and further processing can be requested, Article 121(1) EPC and Rule 135(1) EPC.
- c. True - In proceedings before the EPO, Antonio Riba must be represented by a professional representative, Article 133(2) EPC.
- d. False – Antonio Riba is not entitled to a reduction of the examination fee, since he is neither resident in nor a national of a contracting state of the EPC, Rule 6(4) EPC and Article 14(4) EPC.

Question 7: C

Statement 1 is correct. The priority application was filed at 22 December 2017. The 12 month priority period therefore expires at 22 December 2018. However, 22 December a EPO non-working day. If time limit expires at a non-working day, the applicable time limit is extended to the first working day, which is 2 January 2019.

Statement 2 is correct. A copy of the priority application needs to be furnished either at the rO or the IB within 16 months of the priority date, i.e. 22 December 2017 plus 16 months, is 22 April 2019. PCT AG-1 5.070. However if it is received at the IB before publication of the International patent application, it is considered to be received by the IB at the last day of that 16 month period (PCT AG-I, 5.070)

Question 8: C

PCT AG-I 5.07

C is only available if the priority application and the PCT application are filed at the same patent office.

Question 9: D

Art 61(2)

If the first renewal fee is due within 2 months counting from the date of grant;

31 May versus 2 April - Payment can be done on the last day of the month in which this term ends

June 30, 2019; Sunday so July 1, 2019; Monday

Question 10: C

It is possible to file amendments until the application is registered (18 months from filing date) provided that the applicant has at least two months from the date of the Search Report.

11 January 2018 + 18 months; 11 July 2019

Today is 21 May 2019 + 2 months; 21 July 2019 (Sunday) so Monday 22 July 2019

Question 11: D

Rule 52: The declaration of priority shall preferably be made on filing the European patent application. It may still be made within sixteen months from the earliest priority date claimed. The European patent application was filed within 12 months from the Dutch patent application.

Question 12: B

After filing, the EPO examines whether an application satisfies the requirements for the accordance of a date of filing: Art. 90(1) EPC.

If it is revealed that the drawings referred to in the description are missing, the EPO will invite the application to file the missing drawings within two month (Rule 56(1) EPC), but then the application will be re-dated to the date on which the drawings are filed (Rule 56(2) EPC).

The applicant can also file the missing drawings within two months from filing the application, if he discovers that they are missing himself, the application will then also be re-dated the date on which the drawings are filed (Art. 56(2) EPC).

Rule 56 (4) if the applicant fails to timely file the missing drawings any references to the drawings shall be deemed to be deleted.

Question 13: A

Further processing: Art. 121(1)+(2) and Rule 135(1) EPC

- a. True: Further processing cannot be requested for failure to file a translation of the application within the prescribed time limit (Art. 14 (2), time limit: Rule 6(1), Rule 58 and Rule 135(2) EPC)
- b. False: Further processing can be requested for failure to file a request for examination within the prescribed time limit (Art. 94(1), time limit: Rule 70(1) EPC)
- c. False: Further processing can be requested for failure to file a response to a communication under Art. 94(3) (Art. 94(3), time limit: Rule 71(1) EPC)
- d. False: Further processing can be requested for failure to pay the fee for grant and publishing within the prescribed time limit (Rule 71(3) EPC)
- e.

Question 14: C

25 April 2019 (Thursday) : + 10 days + 6 months → 5 May (Sunday) + 6 months → 5 November (Tuesday)

Question 15: D

Notice of appeal shall be filed within two months of notification of the decision (Art. 108 EPC)

- a. notice of appeal shall contain name and address of appellant (Rule 99 EPC)
- b. The notice of appeal shall contain indication of the decision impugned (Rule 99 EPC)
- c. Notice of appeal shall not be deemed to have been filed until the fee for appeal has been paid (Art. 108 EPC)
- d. statement setting out the grounds of appeal within four months of notification of the decision (Art. 108 EPC)

Question 16: A

The registration date applicable to international trademark applications designating the Benelux is the date on which the International Bureau (WIPO) publishes the statement of grant of protection sent by the Office (BOIP).

(Rule 1.8.1 Implementing Regulations under the Benelux Convention on Intellectual Property (trademarks and designs))

Question 17: A

From 1 October 2017, along with the User Area (e-filing), fax falls within the definition of communication by 'electronic means', meaning that the **discounted fee** for EUTM applications and renewals by electronic means in Annex I EUTMR will apply to fax.

From 1 January 2018, however, fax will **no longer be accepted for filing EUTM applications or renewals** except as a **backup** system if technical malfunctions prevent e-filing.

(Decision No EX-17-4 of the Executive Director of EUIPO of 16 August, 2017)

Question 18: B

Upon registration by the Office, a design which meets the requirements under Section 1 shall be protected by a registered Community design for a period of five years as from the date of the filing of the application.

The request for renewal shall be submitted and the renewal fee paid within a period of six months ending on the last day of the month in which protection ends.

As 31 March 2019 was a Sunday, the last day for renewal of the RCD was Monday 1 April 2019.
(Article 12 and 13.3 of the Community Design Regulation)

Question 19: A

The fees should be paid within a period of six months immediately preceding the expiry of the registration or of the subsequent renewal thereof.

Renewal six months prior to the renewal deadline is possible.

(Article 2.9.4. Benelux Convention on Intellectual Property (trademarks and designs))

From January 2019 the basic fee for trademark applications and renewals will no longer cover three classes of goods or services. A basic fee will cover one class and a fee per for each extra class of goods or services will be added.

There is no mention of a transitional phase by BOIP. The client had the option to renew before 1 January 2019 under the old fee schedule or has the option to renew after 1 January 2019 under the new fee schedule.

(Website BOIP – news – 6 November 2018 (<https://www.boip.int/en/entrepreneurs/news/changes-to-fees-from-1-january-2019>))

There is no mention of a refund of excess renewal fees by BOIP.

(Website BOIP – news – 6 November 2018 (<https://www.boip.int/en/entrepreneurs/news/changes-to-fees-from-1-january-2019>))

Question 20: C

The registry is a database of all domain names. The registrar is the accredited party that may reserve or sell domain names. The registrant is the person, company or entity that holds the rights to a domain name.

(www.sidn.nl, www.icann.org)

CASE 1

a. Four kinds of fees which must be paid in connection with every IA (PCT AG-I 5.184)

- i) Transmittal fee: EUR 130 (Fee code 019)
- ii) Search fee for an international search: EUR 1775 (Fee code 003)
- iii) International filing fee: EUR 1169 (Fee code 225),
Filing fee reduction for XML filing EUR 264 (Fee code 319)

In addition a page fee must be paid for each page in excess of 30

- iv) Page fee for each page in excess of 30: 10x EUR 13 = EUR 130 (Fee code 222)

Total : 2940,--

https://www.epo.org/applying/international/guide-for-applicants/html/e/ga_b_44.html

The international filing fee may be reduced by CHF 100, 200 or 300 where the international application, or part of the international application, is filed in electronic form, as prescribed under Item 4(a), (b) and (c) of the Schedule of Fees (annexed to the Regulations under the PCT) and the PCT Applicant's Guide, paragraph 5.189

PCT AG-I 5.187: Amounts in PCT AG-I Annex C-EP, and Annex D-EP for search fee

<https://www.wipo.int/export/sites/www/pct/en/fees.pdf>

b. The following defects do not influence the International filing date PCT AG-I 6.032:

<https://www.wipo.int/pct/en/guide/ip06.html>

The international application is not signed

The International application does not contain the name of the applicant in the prescribed form

The IA does not contain a title

The IA does not contain an abstract

The IA, and where applicable the translation of the IA does not comply with the physical requirements (specified in R. 11 PCT)

Any element of the IA, other than the description and claims, is not in an admitted language fees

c. The rO invites the applicant to correct such defects.

The time limit for filing the correction is **two months** from the date of the invitation PCT AG-I 6.032

d. 26 September 2016

PCT AG-I 5.191: all fees can be paid as much as one month from the date of receipt of the IA by the rO. Filing date 26 August 2016. Ultimate date is: 26 August 2016 (Fri)+ 1M = **26 September 2016 (Mon)**.

e.

pay protest fee,

accompanied by reasoned statement that IA complies with unity requirement,

pay 2 additional search fees (ISA identified 3 inventions).

PCT AG-I 7.019:

f.

PCT AG-I 7.023 The International search report must be established within 3 months from the receipt for the search copy by the ISA or 9 months from the priority date, whichever time limit expires later. In this case EPO both rO and ISA, so search copy was directly available at ISA, 9 month from priority date is applicable time limit. So International search report should be established by **26 April 2017**.

g.

Yes.

The EPO has acted as the International Searching Authority. The EPO will, among others, invite the applicant to amend the description and claims in accordance with Rule 161(1) EPC soon after Euro-PCT-M enters the European phase. Any amendment or comment can be filed within six months of that communication.

h.

Yes.

If in the application documents which are to serve as the basis of the examination an invention is claimed that was not searched by the EPO as the International Searching authority, the applicant will be invited to pay further search fees in respect of any such invention, Rule 164(2)(a) EPC.

i.

No.

The present set of claims includes at present 35 claims, and therefore claims fees are due in accordance with Rule 162(1) EPC: however, the legal consequence of not paying claims fees for some claims is that these claims shall be deemed to be abandoned, Rule 162 (4) EPC.

j.

No.

The application is not deemed to be withdrawn, if the applicant fails to comment today, since he may do so within the period set in accordance with Rule 161(1) EPC.

CASE 2

A.

File a German and French translation of the claims
Pay the fee for grant and printing

Next step: Issuance of the decision to grant

Rule 71(3) the examining division invited the applicant to pay the fee for grant and publishing and to file a translation of the claims in the two official languages of the European Patent Office other than the language of the proceedings.

B.

File the relevant pages of the documents which contain the amendments or corrections
File a German and French translation of the claims
Pay the fee for grant and printing
Waive your rights to receive a further communication under rule 71(3) EPC

Next step: Issuance of the decision to grant (if EPO agrees with amendments)
or communication under Art. 94(3) EPC (if EPO does not agree with amendments)

Official journal June 2015 Notice to waive the right to a further communication under rule 71(3) EPC.

C.

File a request for reasoned amendments or corrections to the communication text.

Next step: Depends on whether the examining division consent. If they consent a new communication under rule 71(3) will be given.

If they do not consent the examination proceedings will be resumed / communication under Art. 94(3) EPC.

Rule 71(6) If the applicant requests reasoned amendments or corrections to the communicated text of keeps to the latest version submitted by him, the Examining Division shall issue a new communication under paragraph 3 if it gives its consent; otherwise it shall resume the examination proceedings.

D.

16 November 2018

Three months for the mention of grant is 16 November 2018.

Article 65 The period for supplying the translation shall end three months after the date on which the mention of is published in the European Patent Bulletin.

E.

16 May 2019

Article 99 within 9 months from the publication of the mention of the grant of the European Patent any person may give notice to the European Patent Office of opposition to the European patent granted. 16 August 2018 plus 9 months is 16 May 2019

F.

Any person (Article 99)

G.

Since the patent will be maintained no action from the patent owner has to be taken / no time limits apply.

H.

Pay the fee for publishing of a new specification of the European patent and

file translations of the amended claims in French and German within 3 months of notification of the communication.

File translations of the amended claims in The Netherlands and

pay the fee within 3 months of publication of maintenance of the patent in amend form. (Art. 65(1) EPC + Rule 6(6) and (23(3) uitvoeringsreglement ROW1995)

rule 82(2)

If a party disapproves of the text communicated by the Opposition Division, examination of the opposition may be continued. Otherwise, the Opposition Division shall, on expiry of the period under paragraph 1, invite the proprietor of the patent to pay the prescribed fee and to file a translation of any amended claims in the official languages of the European Patent Office other than the language of the proceedings, within a period of three months. Where, in oral proceedings, decisions under Article 106, paragraph 2, or Article 111, paragraph 2, have been based on documents not complying with Rule 49, paragraph 8, the proprietor of the patent shall be invited to file the amended text in a form compliant with Rule 49, paragraph 8, within the three-month period.

Text article 101

(3) If the Opposition Division is of the opinion that, taking into consideration the amendments made by the proprietor of the patent during the opposition proceedings, the patent and the invention to which it relates meet the requirements of this Convention, it shall decide to maintain the patent as amended, provided that:

(a) it is established, in accordance with the provisions of the Implementing Regulations, that the proprietor of the patent approves the text in which the Opposition Division intends to maintain the patent;

(b) the fee for the printing of a new specification of the European patent is paid within the time limit prescribed in the Implementing Regulations.

I.

File notice of appeal and appeal pay fee within 2 months of notification of the decision and
File grounds of appeal within 4 months of notification of the decision.

CASE 3

A. Dutch, French or English

An application for registration of a Benelux trademark should be filed in the Dutch, French or English language.

(Rule 1.1 Implementing Regulations under the Benelux Convention on Intellectual Property (trademarks and designs))

B. The implementing regulation does not mention 'language preference' as a requirement for admissibility.

(The document requesting opposition should contain, amongst others, the information set out in Rule 1.13 (1) (a)-(g) in order to be found admissible according to Rule 1.15. Rule 1.13 (1)(h) concerns the language preference and is not included in Rule 1.15 as a requirement for admissibility - Implementing Regulations under the Benelux Convention on Intellectual Property (trademarks and designs))

C. Dutch, French or English.

In principle the language of proceedings is the same as the language of the trademark application. In case of a trademark application in the English language an exception applies since English is a working language of the Benelux Office for Intellectual Property. No party can be forced to use English. Besides English, the opponent can therefore also choose Dutch or French.

(Rule 1.17 Implementing Regulations under the Benelux Convention on Intellectual Property (trademarks and designs))

D. Within one month after the date of the notification (of admissibility)

(Rule 1.17 Implementing Regulations under the Benelux Convention on Intellectual Property (trademarks and designs)): If the opponent chooses one of the Office's official languages, the defendant may state within a period of one month after the date of the notification of admissibility that it does not agree with the choice of language and may choose the Office's other official language. If the opponent chooses the English language, the defendant may state within a period of one month after the date of the notification of admissibility that it does not agree with the choice of language and may choose one of the Office's official languages)

E. The examination of the opposition will be 'abandoned'

Arguments that have not been submitted in one of BOIP's working languages will be **deemed not to have been submitted**.

The opponent has a period of two months from the notification of commencement of the procedure to provide arguments and supporting documents substantiating the opposition. In the absence thereof, examination of the opposition will be abandoned

(Rule 1.14 and 1.18 Implementing Regulations under the Benelux Convention on Intellectual Property (trademarks and designs))

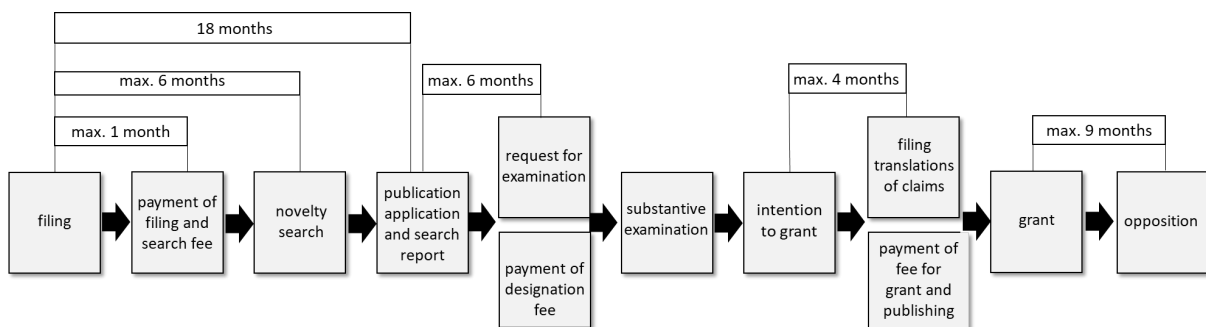
F. One of the parties

G. Yes.

Upon request BOIP will translate the opposition decision into the other working language. The working languages of BOIP are English, Dutch and French.

(Rule 1.18 Implementing Regulations under the Benelux Convention on Intellectual Property (trademarks and designs): At a party's request, the Office will translate the opposition decision into the other working language of the Office)

CASE 4



Procedural steps:

1. *Payment of filing and search fee*
2. *Publication application and search report*
3. *Request for examination or Payment of designation fee*
4. *Payment of designation fee or Request for examination*
5. *Intention to grant*
6. *Filing translations of claims or Payment of fee for grant and publishing*
7. *Payment of fee for grant and publishing or Filing translations of claims*
8. *Opposition*

Time periods:

- A. *Max. 1 month*
- B. *Max. 6 months*
- C. *Max. 4 months*
- D. *Max. 9 months*