

Question 1: A

PCT Rule 20.5bis enables applicants to request confirmation of incorporation by reference of the correct elements and parts in the case where an element or part was erroneously-filed and the correct element or part is completely contained in the earlier application, the priority of which is claimed in the PCT application at the time of filing. This also applies where there is more than one priority claim, provided that each drawing is completely contained in one or more of the earlier applications.

In the situation where the correct set of drawings has been incorporated by reference under PCT Rule 20.6(b), the erroneously filed set of drawings cannot be removed from the file of the application (PCT Rule 20.5bis(d)). The receiving Office will mark those erroneously filed sheets as “ERRONEOUSLY FILED (RULE 20.5bis)”, move those sheets to the end of the drawings (without repagination), and will transmit them to the International Bureau (IB). The IB will publish those sheets on PATENTSCOPE as part of the international application.

Question 2: A

Today = 31 May 2022

Priority 16 November 2019

30 months = 16 May 2022

31 months = 16 June 2022

CA: deadline for entry is 30 months. Up to 12 months after the 30-month deadline (30 months from the priority date) the applicant can request reinstatement of rights provided that he/she pays the fee for reinstatement of rights and meets the other requirements outlined in subsection 154(3) of the Canadian Patent Rules for the reinstatement of rights (late entry into the national phase).

ID: deadline for entry is 31 months. This time limit may be extended provided the applicant pays an additional fee for late entry into the national phase.

Rule 90bis.3 (a) The applicant may withdraw a priority claim, made in the international application under Article 8(1), at any time prior to the expiration of 30 months from the priority date.

Question 3: D

30 months from priority date 11 March 2020 is 11 September 2022 (Sunday) → 12 September Monday

The priority can be withdrawn at any time prior to expiry of 30 months from priority (Rule 90bis.3(a) PCT).

In the absence of the priority claim the time limit for national entry becomes 30m from the filing date of the International patent application (Rule 90bis.3(d) PCT) which is 10 September 2023 (Sunday) → 11 September 2023

Question 4: C

CNIPA competent rO for CN nationals and the EPO is competent ISA for applications with CNIPA as rO (PCT Applicant Guide Annex C - CN).

For EPO as ISA no agent is needed, but allowed. If appointed he/she must be qualified to practice (Rule 90 PCT), so he/she has to be a European patent attorney.

Question 5: D

PCT Newsletter On 10 Feb 2022 the PCT became into force on Jamaica. Consequently, any international application filed on or after 10 feb 2022 will automatically include Jamaica

Question 6: C

The applicant is entitled, under [Article 19](#), to one opportunity to amend the claims of the international application in the international phase.

Further opportunities to amend the claims, and also the description and the drawings, are available during the international phase under [Article 34](#) if, and only if, the applicant files a demand for international preliminary examination.

[Paragraphs 1.10 and 2.01](#) and PCT Applicant's Guide paragraphs [10.024 to 10.028](#), and [10.067 to 10.070](#)).

Any amendment to the claims under [Article 19](#) **must be filed** with the International Bureau – not with the receiving Office nor the International Searching Authority.

The amendments **must be** in the language in which the international application is published (Arabic, Chinese, English, French, German, Japanese, Korean, Portuguese, Russian or Spanish – see PCT Applicant's Guide [paragraphs 9.017 to 9.019](#)).

Rule 59.3 PCT demand and amendments under Article 34 do not need to be filed with the International Bureau. If the demand is submitted to a receiving Office, an International Searching Authority, or an International Preliminary Examining Authority which is not competent for the international preliminary examination of the international application, that Office or Authority shall mark the date of receipt on the demand and, unless it decides to proceed under paragraph (f), transmit the demand promptly to the International Bureau. If the demand is submitted to the International Bureau, the International Bureau shall mark the date of receipt on the demand transmit the demand to that Authority and inform the applicant accordingly, or if two or more International

Preliminary Examining Authorities are competent, invite the applicant to indicate, within the time limit applicable under Rule 54bis.1(a) or 15 days from the date of the invitation, whichever is later, the competent International Preliminary Examining Authority to which the demand should be transmitted.

Question 7: D

Chapter 13.2, EUIPO guidelines: If the earlier registration had lapsed at the time the claim was made, seniority cannot be claimed, even if the relevant national trade mark law provides for a 6-month 'grace' period for renewal. While some national legislation allows for a grace period, if the renewal is not paid, the mark is considered to be not registered from the day it was due for renewal. Therefore, the claim is not acceptable, unless the applicant shows that it has renewed the earlier registration(s).

Chapter 13.4, EUIPO guidelines: Applicants may claim seniority for only some of the goods and services of the earlier registration(s). Effectively, the claim to seniority will be valid to the extent that there is an overlap between the goods and services of the EUTM application and the registration relied on.

Question 8: A

1 = Nice classification : international classification of goods and services for trademarks with under I – class 24 so therefore 1 + B + I

2 = Locarno classification – international classification for registration of designs with class 5 so therefore 2 + C + II

3 = Vienna classification – international classification of figurative elements of marks so therefore 3 + B + III

Question 9: A

Article 17(4); Hague Agreement : The renewal of the international registration may be effected for any or all of the designated Contracting Parties and for any or all of the industrial designs that are the subject of the international registration.

Guide to the International Registration of Marks no. 643

No change in the name or address of the holder or in the list of goods and services may be made as part of the renewal procedure.

Question 10: D

EUIPO Guidelines – Part C Guidelines Opposition - paragraph 2.1.1:

An opposition against an international registration designating the EU (IR) may be filed within a period of 3 months starting 1 month after the date of first republication. For example, if first republication is on 15/04/2016, then the opposition period starts on 15/05/2016 and ends on 15/08/2016. Here: the first republication is on 28 April 2022 + 1 month + 3 months = 28 August 2022 which is a Sunday -> therefore Monday 29 August 2022

Question 11: D

Official Journal November 2015

A request for participation in the PACE program (PACE request) may be filed only once during each stage of the procedure, i.e. search and examination, and for one application at a time. A PACE request filed during search will not trigger accelerated examination. A request for accelerated examination may be filed once the examining division becomes responsible for examining the European patent application.

Question 12 : C

National law Chapter VIA

Germany renewal fee due from 3rd year last day of the month containing the anniversary of the date of filing -> 31 August 2022

France renewal fee due from 2nd year last day of the month containing the anniversary of the date of filing -> 31 August 2022

United Kingdom renewal fee due from 5th year last day of the month containing the anniversary of the date of filing -> 31 August 2024

Italy renewal fee due from 5th year last day of the month containing the anniversary of the date of filing -> 31 August 2024

The Netherlands renewal fee due from 4th year last day of the month containing the anniversary of the date of filing -> 31 August 2023

Question 13: C

The right to priority can only be claimed by the applicant of the priority application, or by a person to whom the right to priority has been transferred (Art. 87(1) EPC, J 19/87, J 11/95, Guidelines A-III 6.1).

This right can be transferred independently from the priority application itself, but it cannot be transferred to two different persons.

The earlier application or the right to priority must have been transferred before the filing of the European application claiming priority. If there are multiple applicants, it suffices that one of them was applicant of the priority application or has had the right to priority transferred to him (Guidelines A-III 6.1).

Question 14: C

Rule 84, Rule 132, Guidelines for examination, Part E , chapter VIII, 1.6 Extension of a time limit

...for any communication raising a matter of substance, a request for extension, even if filed without reasons, is normally allowed if the total period set does not thereby exceed six months.

- Original time limit: 5 May 2022+10 days+2 months = 15 July 2022
- Extended time limit, if you only ask for 2 months extra: 5 May 2022 +10 days+4 months =Thursday 15 September 2022
- Correct Extended time limit, if you ask for 4 months extra: Wednesday 5 May 2022+10 days+6 months =thuesday 15 November 2022

Question 15: D

Art. 87(2): A European patent application shall be subject to the payment of the filing fee and the search fee. If the filing fee or the search fee is not paid in due time, the application shall be deemed to be withdrawn.

Rule 38: The filing fee and search fee shall be paid within one month of filing the European patent application.

€ 1390,00. (search fee).

€ 1665,00. (search fee 1390 euro + further processing fee van 275 euro).

€ 2085,00. (1390 euro search fee + further processing fee van 50% (695 euro)).

Question 16: C

Rule 19 (amended per 1 April 2021)

Designation of the inventor

(1) The request for grant of a European patent shall contain the designation of the inventor. However, if the applicant is not the inventor or is not the sole inventor, the designation shall be filed

in a separate document. The designation shall state the family name, given names and country and place of residence of the inventor, contain the statement referred to in **Article 81** and bear the signature of the applicant or his representative.

(2) The European Patent Office shall not verify the accuracy of the designation of the inventor.

Question 17: D

Decision of the Administrative Council CA/D 11/09 of 28.10.2009 (OJ EPO 2009, 594) dispensing with the supplementary European search report in the case of an international application where the international search report or supplementary international search report was drawn up by the EPO.

Question 18: C

Art. 65 ROW + leidraad inschrijving in het octrooiregister

1. The transfer required for the assignment of the patent or the rights arising from a patent application shall be effected by means of a deed containing a declaration by the patent holder that he assigns the patent or the rights arising from the patent application to the assignee and a declaration by the assignee that he accepts the assignment.

2. Any reservation relating to the assignment must be specified in the deed; in the absence of any such reservation, the assignment shall be deemed to be unrestricted.

3. The assignment shall take effect towards third parties only after an entry has been made concerning the deed in the patent register. Both parties shall be equally entitled to have the entry made in the register.

Question 19: D

a = correct, 26 April 2020+16 months= Friday 26 August 2022, art 9(6) ROW.

b = correct, art. 9(8) ROW

c = correct, art 9(8) ROW

d = incorrect, deadline is 3 months after invitation, art. 24(3) + 29(1c), 30(1+2) ROW

Question 20: B

Request must be filed within a period of 1 year after the lapse and within 2 months after express knowledge of the lapse. Validation had to be filed within 3 months from date of grant, 5 January 2022 + 3 months = 5 April 2022, + 1 year = 5 April 2023. Knowledge of the lapse is 2 May 2022, + 2 months = Saturday 2 July 2022 - > therefore Monday 4 July 2022

art. 52(1) ROW + 23(1) Uitvoeringsbesluit

art. 23(3) ROW

Case 1

a.

i. Yes

EPO is competent ISA. EPO accepts Dutch as search language for International patent applications filed in Dutch at the Netherlands Patent Office. Dutch is however not a publication language. In that case a translation in a publication language needs to be filed (at the rO) within 14 months after the priority date.

The Netherlands Patent Office accepts translations in English, German, and French

ii. Yes. The PCT application claims no priority, so the filing date of the PCT application is the priority date, which means the due date for submitting the translation is: Friday 03 March 2023.

PCT-AG-I Annex C-NL: EPO is competent ISA. If the language in which the international application is filed is not a language of publication and no translation is required for the purposes of international search (PCT Rule 12.3(a)), the applicant will have to furnish a translation of the application into English, French or German (PCT Rule 12.4(a)).

PCT-AG-I Annex D-EP: Dutch is accepted as search language.

R.48.3(a) PCT: If the international application is filed in a language which is not a language of publication but is a language accepted by the International Searching Authority which is to carry out the international search, the applicant must furnish to the receiving Office a translation of the international application into a language of publication which the receiving Office accepts for that purpose.

PCT AG-I 6.021. The translation of the international application must be furnished to the receiving Office within 14 months from the priority date.

b.

The request should be submitted to the receiving office – which is in this case the Netherlands Patent Office (0.5 pt) – or the International Bureau (0.5pt)

PCT AG-I 6.038.

c.

The filing date of HBV-21DE is 05 July 2021. This will be new priority date of HBV22-PCTNL. The due date for submitting the request to add the priority claim will then be 16 months after 05 July 2021: 05 November 2022. 05 November 2022 is a Saturday, so the due date will be extended to Monday 07 November 2022.

PCT AG-I 6.038.

d.

The new due date for submitting the translation of HBV22-PCTNL is 14 months after the new priority date: Monday 05 September 2022

e.

If translation not filed within 14 months, receiving Office will invite the applicant to furnish the required translation within 16 months from the priority date

If 16 months due date missed translation will be considered to have been filed in time if filed before 17 months from the priority date

PCT AG-I 6.021. and PCT AG-I 6.022.

f.

- I. In case there is no demand filed there is one opportunity to amend the claims
- II. Any amendments must be filed with the International Bureau
- III. The amendments can be submitted until 16 months from the priority date or 2 months after the transmittal of the International Search Report and the Written Opinion

PCT AG-I 9.004.

g.

No, because:

Rights to HBV21-DE have been transferred to Hatsekidee B.V. before International patent application HBV22-PCTNL was filed, so both have the same applicant at the time of filing of the International patent application.

Art. 4.A.(1) PC: Any person who has duly filed an application for a patent, or for the registration of a utility model, or of an industrial design, or of a trademark, in one of the countries of the Union, or his successor in title, shall enjoy, for the purpose of filing in the other countries, a right of priority during the periods hereinafter fixed.

h.

No

AG-I 11.018: Where there is a change in the person, name, residence, nationality or address of the applicant, or in the person, name or address of the inventor, agent or common representative, the applicant or the receiving Office should ask the International Bureau to record the change.

AG-I 11.018B: Where the applicant or agent of record requests a change, it is not necessary to produce any documentary evidence relating to the change.

i.

No

EPO Guidelines for Examination

A.III-7.5.6 An incorrect designation may be rectified provided a request is received accompanied by the consent of the wrongly designated person and by the consent of the applicant for or the proprietor of the patent where the request is not filed by that party. If a further inventor is to be designated, the consent of the inventor(s) previously designated is not necessary (see J 8/82). The provisions of A-III, 5.3 and 5.4 apply to the corrected designation mutatis mutandis. Rectification may.

Case 2

a.

1. the applicant's name and address (if the applicant is a legal entity, the legal form thereof should be stated – this could be a 6th possible requirement);
2. the representation of the trademark (in accordance with Article 2.1 (b) BCIP);
3. a list of the goods and services for which the trademark is intended (in accordance with Article 2.5bis BCIP);
4. a specification of the trademark describing whether it is a word mark, a figurative mark, a combined word / figurative mark, a three-dimensional mark or another type of mark. In the latter case, the type of mark should also be specified;
5. payment of the basic fees due for filing the trademark

BOIP Implementing Regulations, Part I, Chapter 1, Rule 1.1 and Rule 1.3

b.

A period of at least one month will be granted for meeting the other requirements (as referred to in Article 2.5 (2) BCIP).

BOIP Implementing regulations Rule 1.3(2)

c.

Six months

Counting from the date on which the first notification was sent.

BOIP Implementing regulations Rule 1.3(2)

d.

The Office shall reject the application (in respect of indications or terms which are unclear or imprecise, where the applicant does not suggest an acceptable wording within a period set by the Office to that effect).

BCIP – article 2.5bis (4)

e.

- 1) Withdraw a trademark application after receiving a provisional refusal (In this way, publication of the final refusal can be avoided).
- 2) No action (if the trademark applicant no longer wishes to respond to the provisional refusal and therefore defers to BOIP's refusal decision, the withdrawal of the application for administrative reasons is also desirable. However, the withdrawal of a trademark application does not lead to a refund of the statutory fees paid)
- 3) Filing an objection against the provisional refusal

BOIP Guidelines on Examination of Absolute Grounds – Course of the procedure – no. 16/17/27

f.

Yes (even if the applicant has not submitted an objection against the provisional refusal decision, it is still possible to appeal against the final refusal decision)

BOIP Guidelines on Examination of Absolute Grounds – Course of the procedure – no. 38

g.

This decision can be appealed to the Benelux Court of Justice on the basis of Article 1.15bis(1) BCIP.

BOIP Guidelines on Examination of Absolute Grounds – Course of the procedure – no. 38

Case 3

a.

1. Pay the fee for grant and publishing

2. file a translation of the claims in the two official languages of the European Patent Office other than the language of the proceedings.

Rule 71(3) EPC

b.

Application shall be deemed to be withdrawn. Rule 71(7) EPC

c.

14 July 2021 (9 months from 14 October 2020, Art. 99 EPC)

d.

Payment of the opposition fee (Art. 99 EPC)

e.

Particulars of the opponent / number of opposed patent / name of the proprietor / title of the invention / extend of opposition / grounds of opposition / indication of facts and evidence / particulars representative if appointed. Rule 76 EPC

f.

Yes, 14 July 2021 (9 month time limit for opposition). Rule 77(1) EPC

g.

No

Rule 79(1) EPC: response is possible but not required.

h.

Opposition is rejected

Patent is maintained in amended form

Patent is revoked

Art 101(1) and (2) EPC

i.

Pay the fees for publishing (Rule 82(2) EPC)

File translation official languages of the EPO (Rule 82(2) EPC)

File translation amended claims NL (National Law, Chapter IV)

Fee in NL