

## Question 1: B

### Statement I:

In the present case, the day on which the mention of grant is published is 3 June 2024. Therefore, on 3 June 2024 is no longer pending (G1/09; Guidelines A-IV, 1.1.1). As such, no divisional application can be validly filed on 3 June 2024 (Rule 36(1) EPC), and Statement I is incorrect.

Rule 36(1) EPC: The applicant may file a divisional application relating to any **pending** earlier European patent application.

Guidelines for Examination, A-IV,1.1.1): The parent application must be pending when a divisional application is filed. Reference is made in this regard to the observations in G 1/09 and J 18/09 as to what constitutes a pending application. In the case of an application filed as a divisional application from an application that is itself a divisional application, it is sufficient that the latter is still pending on the second divisional application's date of receipt.

An application is pending up to (but not on) the date that the European Patent Bulletin mentions the grant of the patent (OJ EPO 2002, 112). Rule 134 does not apply in this case. It is not possible to validly file a divisional application when the parent application has been finally refused, withdrawn or is deemed withdrawn (see also the paragraphs below).

### Statement II:

Rule 36(2) EPC: (...) The divisional application shall be filed with the European Patent Office in Munich, The Hague or Berlin.

Thus, the divisional can be filed with the European Patent Office in Berlin.

## Question 2: C

Mr van Buren is a Dutch national, and the Netherlands are a Contracting State having a language other than English, French or German as an official language. He is a resident of the Netherlands living abroad (i.e. In Argentina). Thus, Mr van Buren is a natural person referred to in Article 14(4) EPC. Rule Rule 7a EPC indicates that where such a person files a European patent application or a request for examination in a language admitted in that provision, the filing fee or examination fee shall be reduced in accordance with the Rules relating to Fees.

## Question 3: C

### Statement I:

Dr Re had to appoint a professional representative after filing EP1, because she is a natural person not having her residence in a Contracting State, because Australia is not a Contracting State of the EPC. For filing the application, no professional representative had to be appointed (Article 133(2) EPC). Thus, Statement I is correct.

Article 133(2) EPC: Natural or legal persons not having their residence or principal place of business in a Contracting State shall be represented by a professional representative and act through him in all proceedings established by this Convention, other than in filing a European patent application; the Implementing Regulations may permit other exceptions.

### Statement II:

Mr Tent is the professional representative, and proceedings are interrupted upon the death of the professional representative (Rule 142(1) EPC).

Rule 142(1) EPC: Proceedings before the European Patent Office shall be interrupted

(c) in the event of the death or legal incapacity of the representative of an applicant for or proprietor of a patent, or of his being prevented for legal reasons resulting from action taken against his property from continuing the proceedings.

## Question 4: D

Docs KR: 35 + amended claims EN 2 + abstract 1 + Figures KR 18 = 56 – 35 = 21

### Guidelines (A-iii, 13.2)

An additional fee is payable as part of the filing fee for European patent applications which are filed on or after 1 April 2009 and comprise more than thirty-five pages. The amount of the fee is calculated according to the number of pages over thirty-five.

### Euro-PCT applications

For international (Euro-PCT) applications entering the European phase on or after 1 April 2009, the additional fee is payable as part of the filing fee within the 31-month period of Rule 159(1). It is calculated on the basis of the international application as published (even if published in a non-EPO language), any amended claims under Art. 19 PCT, which replace the claims as originally filed unless specified to the contrary (see OJ EPO 2017, A74), and one page for the abstract.

## Question 5: C

### guidelines-epc (E-viii, 1.6.1)

Other than in cases in respect of which the EPC specifies a fixed period which may not be extended, the duration of time limits may be extended on request. The request must be submitted in writing before expiry of the period that has been set. The extended period is to be calculated from the start of the original period.

A request for extension, even if filed without reasons, is normally allowed if it is for not more than two months and the total period set does not thereby exceed six months. A request for a longer extension, especially if the total period set exceeds six months, is allowed only exceptionally, when the reasons given are sufficient to show convincingly that a reply in the period previously set will not be possible.

Period to be specified = Office time limit [R.132]

can be extended upon request

- must be requested before expiry of specified period
- in most cases: no reason necessary
- total period may not exceed 6 months

## Question 6: D

### guidelines (A-x, 5.2.4)

The obligation to pay renewal fees terminates with the payment of the renewal fee due in respect of the (patent) year in which the mention of the grant of the European patent is published, see Art. 86(2). "Patent years" are calculated as from the date of filing of the application. This means that, for the last renewal fee payable to the EPO, it is not the due date but the beginning of the respective patent year that is decisive. If the mention of the grant of the European patent is published on the anniversary of the date of filing, the renewal fee in respect of the next patent year, which has not yet begun, is no longer payable to the EPO but to the national authorities.

Article 141 - Renewal fees for European patents

(1) Renewal fees for a European patent may only be imposed for the years which follow that referred to in Article 86, paragraph 2.

(2) Any renewal fees falling due within two months of the publication in the European Patent Bulletin of the mention of the grant of the European patent shall be deemed to have been validly paid if they are paid within that period. Any additional fee provided for under national law shall not be charged.

### Question 7: C

The time limit for filing submissions against a provisional refusal is a maximum of six months. In the first instance, a time limit of three months is set. This time limit is extended once *ex officio* by one month and can be further extended on request up to the maximum time limit of six months. When the period allowed for lodging objections has elapsed, BOIP makes a final decision based on all the facts and circumstances of which it was apprised on time.

Implementing regulations under the BCIP Chapter 3 Refusal and opposition Rule 1.12 Lid 1  
Guidelines on refusal BOIP : Response to the objection / Final refusal and appeal

### Question 8: B

3 months after publication: 09-05-24, but 09-05-24 is an official closing date of the EUIPO.

### Question 9

Excluded from the Exam

### Question 10: D

Filing date requirements:

- applicant's name and address [R 2.1(1)(a)]
  - if the applicant is a legal entity: the legal form
- image or images showing the appearance of the product [R. 2.1(1)(b)]
- indication of the product embodying the design [R. 2.1(1)(c)]
- payment of the fees due for filing the application to be paid within one month after the above requirements have been fulfilled [R. 2.3(1)] In practice, BOIP has made it very hard NOT to pay at filing

### Question 11: D

Art.7(2)

If the design has already been disclosed before filing the application, this disclosure is ignored for investigating novelty and individual character, provided:

- the disclosure took place during the **12-month** period preceding the date of filing of the application or, if a priority is claimed, the date of priority, and
- the disclosure was **by the designer**, his successor in title, or a third person as a result of information provided or action taken by the designer or his successor in title

## Question 12: D

Art 4(4): Failure to indicate in the request the name and other prescribed data concerning the inventor shall have no consequence in any designated State whose national law requires the furnishing of the said indications but allows that they be furnished at a time later than that of the filing of a national application. Hence, no obligation to file.

Rule 92bis.1:

- (a) The International Bureau shall, on the request of the applicant or the receiving Office, record changes in the following indications appearing in the request or demand:
  - (ii) person, name or address of the agent, the common representative or the inventor.
- (b) The International Bureau shall not record the requested change if the request for recording is received by it after the expiration of 30 months from the priority date.

## Question 13: D

Today is 28 May 2024

22 November 2021 + 30 months = 22 May 2024

22 November 2021 + 31 months = 22 June 2024

China = 30 months or 32 months with payment of additional fee

Japan = 30 months

EP = 31 months

## Question 14: D

Rule 54bis PCT: time limit for filing a demand, is the later of

- 3 months from transmittal of the ISR and of the written opinion or
- 22 months from the priority date

4 June 2024 is 3 months after date search report

24 June 2024 is 3 months after transmittal search report

12 August 2024 is 10 months after PCT date, i.e. 22 months from wrong priority date

13 August 2024 is 22 months after priority date (which is the latest)

## Question 15: D

Statement I:

PCT applicant's Guide: EPO is competent ISA for the CNIPA as Receiving Offices

USPTO is not a competent ISA

Statement II:

PCT Rule 12.3(a): Translation has to be filed within one month from filing date, but it has to be filed with the Receiving Office and not with the ISA.

## Question 16: D

Article 4(1)(ii) + Rule 4.5 PCT: Request must contain prescribed information concerning the applicant

Article 4(1)iv PCT: Request must contain title

Rule 4.1(d) + Article 14(1)(a)(i) PCT: request shall be signed

Rule 26.2bis(a) PCT: one signature is sufficient in case of multiple applicants

Rule 3.1 + 3.4 PCT + AG-IP 5.015: request form is form PCT/RO/101

The international application must be signed in Box No. X of the request by the applicant, or, where there are two or more applicants, by all of them. However, if there is more than one applicant, the receiving Office will not invite the applicant to furnish missing signatures when the request is signed by at least one of the applicants.

## **Question 17: C**

### Statement I

Portuguese is a language of publication, Rule 48.3(a) PCT:

“(a) If the international application is filed in Arabic, Chinese, English, French, German, Japanese, Korean, Portuguese, Russian or Spanish (“languages of publication”), that application shall be published in the language in which it was filed.”

### Statement II

Of the mentioned countries, only Brazil is a Contracting State of the PCT, so the PCT application can only be continued there.

For the other countries, it is also not possible to claim priority from the PCT application, because the priority year of the European application is over today. Thus, the PCT application would not be the “first” application, see Article 4C(4) of the Paris Convention:

“(4) A subsequent application concerning the same subject as a previous first application within the meaning of paragraph (2), above, filed in the same country of the Union shall be considered as the first application, of which the filing date shall be the starting point of the period of priority, if, at the time of filing the subsequent application, the said previous application has been withdrawn, abandoned, or refused, without having been laid open to public inspection and without leaving any rights outstanding, and if it has not yet served as a basis for claiming a right of priority. The previous application may not thereafter serve as a basis for claiming a right of priority.”

## **Question 18: B**

The duty to disclosure stands during the pendency of the application, and application is still pendant until moment of grant, so even if a notice of allowance is received the application is still pending and therefore the applicant is still obligated to disclosure prior art.

See USPTO > 2003-Disclosure When Made (uspto.gov) / **37 CFR 1.97**

## **Question 19: C**

ROW 28(1): De aanvrager kan zijn reeds ingediende aanvraag splitsen door voor een gedeelte van de inhoud daarvan een afzonderlijke aanvraag in te dienen. Deze aanvraag wordt, behalve voor de

toepassing van de artikelen 30, eerste lid, 31, derde lid, en 32, tweede lid, aangemerkt te zijn ingediend op de dag van de oorspronkelijke aanvraag.

## **Question 20: B**

A request to the NLPO to make an application available through the service may be made by checking the relevant box of the application form or by sending a letter clearly stating the relevant application number and indicating that it should be made available to WIPO Digital Access Service; To request the NLPO as accessing Office to retrieve the document from the service, the applicant should fill in the relevant box on the application form, or send a letter with the relevant details to the NLPO. The request should contain a statement that the fee can be charged from the deposition account.

## Case 1 ( points)

a.

Yes

Rupinchang Export Ltd Co. is based in China and has no presence or activities in Europe. So in principle a representative is needed at the EUIPO. However, for the filing as such no representative is needed.

Section 7.2 EUIPO trade mark guidelines and Art. 119(2) EUTMR representation mandatory for natural and legal persons having neither their domicile nor their principle place of business or a real and effective industrial or commercial establishment in the European in the European Economic Area, except for filing of an application for an EU trade mark.

b.

EUIPO trade mark guidelines section 11.1.1. and Art. 35(1) EUTMR: the formal requirements are:

- i. priority claims shall be filed together with the EU trademark application (or in a separate communication filed on the same date as the EU trademark application); and
- ii. should include date, number, and country of the previous application;
- iii. documentation in support of the priority claims shall be filed within three months of the filing date (unless such information is available through online official sources)

c.

EU-TM1 had goods and services in 2 classes (29 and 30), hence a basic fee covering one class of goods and services (class 29), and a fee for the second class (class 30).

The fees were due 1 month from the date of receipt of the trade mark application by the EUIPO. EU-TM1 was filed on April 12, 2023. So the fees were due on Friday May 12, 2023.

d.

No

Section 15 trade mark guidelines and Art. 49 EUTMR. The applicant may at any time withdraw its EUTM application or restrict the list of goods and services covered by it. Other changes are only contemplated to correct certain mistakes.

Adding the goods of class 30 is not restricting the list of goods and services, neither is a correction of a mistake. Therefore this is not possible.

e.

Yes.

English is one of the 23 official languages of the EU, so English as first language of a trademark application is allowed. (Art. 146(1) EUTM)

f.

French, German, Italian, and Spanish.

Art. 146(2) EUTM. Allowable second languages or languages of the office are English, French, German, Italian, and Spanish. The first language was English. So only the other 4 languages are acceptable as second language.

g.

Art. 46(1) EUTMR: Within a period of three months following the publication of an EU trade mark application, notice of opposition to registration of the trade mark may be given on the grounds that it may not be registered under Article 8.

h.

What are the requirements regarding goods and services of the divisional application?

Art. 50(1) The goods or services in the divisional application shall not overlap with the goods or services which remain in the original application or those which are included in other divisional applications.

i.

Yes, during a pending opposition, but the declaration of division is not admissible if (Art. 50(2)(a),(b)) if

1. such a divisional application has the effect of introducing a division amongst the goods or services against which the opposition has been directed, until the decision of the Opposition Division has become final or the opposition proceedings are finally terminated otherwise; or
2. during the opposition period



## Case 2

a.

Entry European phase (R.159 EPC):

- Request entry into European Phase / specify the application documents on which the European grant procedure is to be based
- Request examination
- Pay examination fee
- Pay designation fee
- Pay filing fee and if applicable page fee

(No search fee, as EPO was ISA and no translation as PCT1 is in English)

b.

1. Request early entry into the European phase (Art. 23.2 PCT + Rule 159(1) EPC).
2. Waive R161/162 EPC
3. File the amendments and reply to the written opinion, so that the R161 EPC can be waived.
4. File PACE request for accelerated examination.

c.

No 10 day rule, since communication is dated later than 1 November 2023.

Period is 4 months (Rule 71(3); also in relation to claims fees as R71(4) refers to Rule 71(3)).

9 January 2024 + 4 months is Thursday 9 May 2024 (Ascension day) > Friday 10 May 2024.

d.

- Further processing needs to be requested: A single fee for further processing needs to be paid, being the sum of one flat fee and 50% of the claims fees.

Approval of the text communicated under Rule 71(3) requires paying the fee for grant and publishing and, where applicable, claims fees (Rule 71(4)) and filing the translations of the claims within a four-month period (Rule 71(5)). As these actions have the same legal basis, they form a unitary procedural act subject to a unitary time limit. By way of exception to the principle that the single fee for further processing is computed on the basis of the number of omitted acts, Art. 2(1), item 12, second indent, RFees stipulates that only one flat fee for further processing is due in the event of late performance of any or all of the acts required under Rule 71(3), i.e. paying the fee for grant and publishing and filing the translations of the claims. If in addition claims fees were not paid in due time, the single fee for further processing amounts to the sum of the flat fee and 50% of the claims fees (see Art. 2(1), item 12, second and first indent, RFees).

- Omitted acts that need to be completed:

1. file claim translations in German and French (R71(3)).
2. pay fee for grant and publishing (R71(3)).
3. pay the claims fees for claims 16-20.

e.

EUR 3.442,50

Fee for grant and publishing. – EUR 1.080

Claims fee for claims 16-20. – 5x275 = EUR 1.375

Fee for further processing is:

1. one fixed fee for omitted acts under R71(3), RFees 2(1)(12) - EUR 300
2. 50% of claims fees - EUR 687,50

f.

- Validate in each country separately (classical validation).
- Request a Unitary Patent, which covers protection in NL, FR and DE. And validate separately in the UK.

g.

For validation in NL the time limit is three months from the date on which the mention of the grant is published.

NL: file translation of the claims in Dutch and pay fee (of EUR 25)

For DE, FR and UK no steps for validation have to be taken (only timely payment of renewal fees needed).

For obtaining a UP:

- File request for Unitary Effect ((Rule 5(1) UPR))
- File full translation of the specification into any other language of the European Union (Article 6(1) Regulation (EU) No 1260/2012:)

The time limit for requesting a UP is one month from the date on which the mention of the grant is published. (Rule 6 UPR)

## Case 3

a.

The application is not and will not be treated as an international application. Art. 11 PCT + PCT Rule 20.3 + 20.4

b.

Claims are required for a filing date, abstract and fees are not. The date on which all filing date requirements are fulfilled is 12 October 2023 (received at IB). Art. 11 PCT

c.

File a request at the IB to register your IP law firm as agent together with a Power of Attorney signed by Mr. X. AG IB, Annex C

d.

No, because the international filing date of 12 October 2023 is still within two months from the date on which the priority period expired (18 August 2023). PCT Rule 26bis.2(c)(iii)+26bis.3. Guidelines AG 5.062

e.

File a reasoned statement with the EPO, pay the additional search fee and pay the protest fee. PCT Rule 40.1 + 40.2(c), Euro-PCT Guide 3.3.020

f.

Yes, the additional search fee and the protest fee will be refunded. Euro-PCT Guide 3.3.022

g.

File a signed request for a change of applicant under PCT Rule 92bis at the IB before expiration of 30 months from the priority date, which is 18 August 2022 + 30m = Tuesday 18 February 2025 → . (IB has waived PoA requirement). PCT Rule 92bis, AG 11.018, AG IB, Annex C

h.

Yes, in that case the new agent needs to file evidence of the transfer of ownership (written consent of current applicant, or copy of signed assignment) and a Power of Attorney signed by the new applicant. AG 11.018B, AG IB, Annex C