

PLATFORM FORMALITIES OFFICERS
EXAMINATION CERTIFIED FORMALITIES OFFICER
EXAMINATION REQUIREMENTS

SECTION 1

GENERAL INTRODUCTION TO INTELLECTUAL PROPERTY RIGHTS

OBJECTIVE

Basic knowledge of the importance and value of IP Rights, what are the different types of IP Rights, including what can be protected and why companies are interested in protection. In particular, an understanding of the various patenting routes, the application procedure(s) and the role of the Formalities Officer in the procedure.

TOPICS

The participant has a basic knowledge of the following topics:

1.1 Introduction to patents.

- What is a patent?
- What can be patented?
- Background of the patenting system;
- Understanding the structure of patent specifications, e.g. description, claims, abstract, drawings (if any), sequence listings (if any);
- Patentability criteria: invention, novelty and inventive step and industrial applicability.

1.2 Introduction to the patent application procedure.

- First filing;
- (claiming) Priority;
- Choosing a patenting route: NL, EP, PCT and national;
- Outline of the patent procedure: filing, formalities, search and search report, publication, examination, grant/refusal, the need to pay official fees, including renewal fees;
- Outline of the other procedures: oral proceedings, opposition, appeal, limitation/revocation, further processing, re-establishment of rights procedure;
- Patenting authorities;
- The duties and responsibilities of the Patent attorney and the Formalities officer. An awareness of the duty of care, importance of deadlines and diary keeping;
- Specific costs, e.g. official fees, agent's disbursements, attorney fees.

SECTION 2

THE CORE EPC PROCEDURES: FILING AND PRIORITY

OBJECTIVE

The participant has to be able to file a (priority) European patent application (on paper and/or electronic filing), invoke priority, to ensure that a filing date is accorded, and handling the formalities examination. Further, the participant has to be able to perform and monitor the main procedural steps during these phases.

TOPICS

The participant has knowledge of the following topics:

2.1 The priority system.

- Patenting routes using priority, effect of priority;
- Priority under EPC, i.e. duly filed, Paris Convention state, person or his successor in title, adding/removing applicants, “first application”;
- Claiming priority, e.g. declaration of priority, correction/addition of priority claims, certified copy, translation.

2.2 Filing a European patent application.

- Where to file, how to file, i.e. on paper, electronic/online; filing by reference;
- Filing date requirements;
- EPC member states, extension states, validation states;
- Outline of EPC patent procedure.

2.3 Filing a European patent application. Formal requirements.

- Content of the application, formal requirements, request-for-grant;
- Language (translation);
- Payment of required fees, e.g. filing fee, search fee, claims fee, designation fee, extension and/or validation fees, examination fee, renewal fee;
- Designation of inventor;
- (claiming) Priority;
- Description, claims, abstract, drawings;
- Sequence listings;
- Certificate of exhibition;
- Information on deposit of biological material.

2.4 Filing a European divisional application.

- Where to file, how to file i.e. on paper, electronic/online, until when to file;
- Designation of states;
- Payment of required fees, e.g. filing fee, search fee, claims fee, designation fee, examination fee, renewal fees.

2.5 Addressing deficiencies.

- Missing parts;
- Erroneously filed application documents or parts;
- Any deficiency noted under Rule 57 EPC;
- Deficiencies in claiming priority;
- Subsequent designation of the inventor;
- Late furnishing sequence listing;
- Fees.

SECTION 3

THE CORE EPC PROCEDURES: FROM SEARCH TO GRANT

OBJECTIVE

The participant has knowledge of the EPC procedure from search to examination and grant, as well as of the validation procedure including translations according to the London Agreement. The participant has to be able to perform and monitor the main procedural steps during the phases from search to examination and grant, and the national entry and unitary effect.

TOPICS

The participant has knowledge of the following topics:

3.1 European search and search report.

- When is the search expected?
- Accelerated search (PACE);
- Contents of the search report;
- Incomplete search, non-unity;
- Amending the patent application after receipt search report.

3.2 European publication of the patent application.

- When published; Types of publication;
- Content and form publication;
- European patent register;
- Opt out / withdrawal of opt out of the jurisdiction of the Unified Patent Court (UPC);
- Withdrawal of application before publication.

3.3 (Substantive) Examination and grant.

- Requesting examination and payment of examination fee;
- Accelerated examination (PACE);
- (Compulsory) reply to European Search Report;
- Payment of designation fees;
- Receipt of notification(s) Rule 71(1);
- Filing amendments;
- Third party observations;
- Stay and interruption of proceedings, including calculation of time limits;
- Rule 71(3) Communication “Druckexemplar”;
- Decision to Grant;
- Application refused;
- Pre-grant appeal;
- Request unitary effect and unitary patent;
- National entry of designated states (London Agreement)
- Opt out / withdrawal of opt out of the jurisdiction of the UPC after grant.

3.4 Opposition/Appeal proceedings.

- How to file a request for opposition/appeal incl. fees;
- Post grant opposition and appeal.

3.5 Time Limits.

- Types of periods/time limits, triggers;
- Calculation of time limits;
- Possibility of extension of time limits;
- Further processing (requirements, exclusions);

- Loss of rights communication;
- Re-establishment of rights procedure (requirements, “all due care”, exclusions).

3.6 EPO fees (general) and when to be paid.

- (required) Fees for filing applications;
- Calculation of renewal fees (EP application, divisional application, and national entry designated states);
- Appeal fee, opposition fees;
- Further processing fee;
- Fee for re-establishment of rights;
- Refund of fees;
- Automatic debit order;
- Deposit account.

SECTION 4

THE PCT PROCEDURE: CHAPTER I, CHAPTER II, NATIONAL AND REGIONAL ENTRY

OBJECTIVE

The participant has to be able to file a (priority) PCT application (on paper and/or electronic filing), invoke priority, to ensure that a filing date is accorded, and handling the formalities as well as the prosecution of the application procedure, EP regional entry and national entry (CN, IN, JP and US). Further, the participant has to be able to perform and monitor the main procedural steps during these phases.

TOPICS

The participant has knowledge of the following topics:

4.1 Introduction, overview of the PCT procedure.

- Structure of the PCT (PCT time line);
- PCT Chapter I and II;
- International and national phase;
- Role of the International Bureau (IB, WIPO);
- PCT States;
- Receiving Office, designated Office, elected Office;
- Time limits, fees, remedies.

4.2 Filing an International patent application.

- Where to file, how to file, i.e. on paper, electronic/online; which receiving office;
- PCT Request;
- Designation of states, applicant, inventor;
- Signature, representatives;
- Language and translations;
- Claiming priority, restoration of the right to priority, and adding, correcting, withdrawing priority claim;
- Formalities, e.g. missing elements and parts, erroneously filed elements and parts, deficiencies, invitation to correct deficiencies;
- Time limits, whether extensible or fatal.

4.3 International search.

- International search: non-unity, International Search Authority (ISA);
- International search report (ISR), written opinion of ISA;
- Amendment of the claims after receipt of ISR;
- Payment additional search fee (non-unity).

4.4 International Publication.

- When published;
- PCT Gazette;
- Content and form publication;
- Withdrawal of application before publication.

4.5 International preliminary examination.

- Filing Demand including payment of fees;
- Written Opinion of IPEA;
- Response to Written Opinion;
- When to file amendments;

- IPRP

4.6 Entry national/regional phase.

- Time limit for entry (in the various states/regions);
- Translation international application;
- Foreign agents and their role in the national procedure;
- Requirements in key countries; CN, IN, JP and US.

SECTION 5

NL PATENT PROCEDURE INCLUDING VALIDATION

OBJECTIVE

The participant has to be able to file a (priority) NL application, on paper and/or electronic filing, invoke priority, to ensure that a filing date is accorded, and handling the formalities as well as the prosecution of the application procedure and validation of the EP patents in the Netherlands. Further, the participant has to be able to perform and monitor the main procedural steps during these phases.

TOPICS

The participant has knowledge of the following topics:

5.1 Introduction, overview of the NL procedure.

- Ownership and representation;
- Claiming priority, restoration of the right to priority and adding, correcting, withdrawing priority claim;
- Time limits and whether extensible or fatal;
- NL procedure (time limits);
- Remedies.

5.2 Filing a Netherlands patent application or a divisional application

- Where to file, how to file, i.e. on paper, electronic;
- Fees to be paid;
- NL Request form;
- Language and translations.

5.3 Search.

- Filing the request and payment of fees;
- Types of search and search report, searching authorities;
- Special procedures: non unity, subject matter unclear;
- Amendment(s) after receipt of Search report;
- Refund of search fee.

5.4 Publication and Grant (registration).

- Publication of application: early publication, preventing publication;
- Granting application, early grant;
- Duration of protection;
- Renewal fees.

5.5 Supplementary Protection Certificate (basic information).

- Supplemental protection and conditions;
- How to file request for SPC;
- Duration.

5.6 Validation of European patent in the Netherlands.

- Overview requirements according to EPC;
- Overview requirements according to ROW 1995;
- Validation request; time limit;
- How to file and fees to be paid;
- Formal requirements;
- Invitation to correct deficiencies;
- Time limits;

- Lapse of patent and remedies;
- Filing corrected translations;
- Renewal fees.

SECTION 6

FOREIGN PATENT PROCEDURES

OBJECTIVE

The participant has to be able to ensure that a foreign patent application is duly filed. The Formalities Officer has an insight in what might be expected to encounter regarding formality procedures and documents when patent applications are filed in various countries (USA including the role of IDS, Japan, China and India) throughout the world and how to deal with local representatives.

TOPICS

The participant has knowledge of the following topics:

6.1 General knowledge of Foreign Patent Procedures.

- General knowledge of IP laws;
- General knowledge of the required formality steps;
- How to deal with local representatives;
- Duty of disclosure and filing of IDS in USA.

SECTION 7

CHANGES OF OWNERSHIP (Patents, Designs, Trademarks, Domain names)

OBJECTIVE

The understanding of IP rights as property, establishing inventorship and ownership, and documents required by the Official Authorities. Basic requirements for foreign countries (i.e. US, Japan, China, India). Recording a change of name or ownership and the legalisation and notarisation of documents (if any).

TOPICS

The participant has knowledge of the following topics:

7.1 General Knowledge of Ownership.

- What is ownership?
- What is recordal?
- Documents and requirements of the Official Authorities with respect to a transfer of right, change of address, ownership (name change, assignment);
- Notarisation and legalisation aspects.

SECTION 8

TRADEMARKS, DESIGNS AND DOMAIN NAMES

OBJECTIVE

Knowledge of the concepts Trademarks and Designs and Domain Names. The participant has knowledge about the scope of protection and the differences in the registration of such rights. Furthermore, the participant has knowledge about the frequently used filing routes based on the Benelux, European and International Treaties. The participant has to be able to file a Trademark- and Design application on paper or by electronic filing, invoke priority and handle frequently occurring issues for getting a filing date and handling the formalities in the registration procedures from application to registration and related procedures, including trademark refusals on absolute grounds, from refusals to decision in appeal, oppositions from filing an opposition till decision in appeal and Designs nullification actions. Further the participant has to be able to perform and monitor the main procedural steps during these phases.

The participant has knowledge of the following topics in procedures at the BOIP, EUIPO and WIPO:

8.1.1 Introduction, overview of the Trademark procedure.

- What is a Trademark?
- Outline of the Trademark procedure, priority and duration registration;
- Calculation of deadlines and payment of required fees.

8.1.2 Filing a Trademark application.

- Where to file, how to file i.e. on paper, fax or electronic;
- Use of forms and language;
- Payment of required fees;
- Claiming priority; benefiting from earlier filed applications or registrations
- Classification;
- Filing route, i.e. difference between the Benelux Trademark, the European Trademark and the International Registration of a Trademark and the differences in requirements in the respective filing routes;
- Renewal and fees.

8.1.3 Other Procedures.

- Refusals on absolute grounds. From refusals to decision in appeal.
- Oppositions. From filing an opposition till decision in appeal.
- Recordal (changes of ownership). See section 7.

8.2. Designs

8.2.1 Introduction, overview of the Design procedure.

- What is a Design?
- Outline of the Design procedure, priority and duration registration;
- Calculation of deadlines and payment of required fees;

8.2.2 Filing a Design Application.

- Where to file, how to file i.e. on paper, fax or electronic;
- Use of forms and language;
- Payment of required fees;
- Claiming priority; benefiting from earlier filed applications or registrations
- Classification;

- Filing route, i.e. difference between the Benelux Design, the European Design and the International Registration of a Design and the differences in requirements in the respective filing routes;
- Renewal and fees.

8.2.3 Other Procedures.

- Nullification actions and calculation of deadlines
- Recordal (changes of ownership). See section 7.

8.3 Domain Names.

8.3.1 Introduction, overview of Domain Names Procedure.

- Where and how to register a Domain name;
- Payment of required fees, including renewal fees;
- Differences between tld's: .com, .nl, .eu and their respective entities.