

Question 1: B

According to PCT Rule 90.5 (d) a power of attorney for each applicant shall be submitted with a notice of withdrawal, while the power of attorney may be waived in case of a request, a demand or separate notice (Rule 90.5 (c)). In other words: a power of attorney is only mandatory for a withdrawal.

Question 2: C

If a PACE request has been withdrawn it will not be possible to restore the application to the PACE program, i.e. a second request for that application during the same stage of the procedure will not be processed.

Source: Official Journal November 2015

Question 3: D

In principle a renewal fee is due on the last day of the month containing the anniversary of the date of filing of the European patent application. So this this case that would mean 30 June 2016.

However, if the first renewal fee is due within 2 months counting from the date of grant of the European Patent (which is the case here, as 30 June 2016 is within 2 months from 18 May 2016), then payment can be done on the last day of the month in which this term ends: In this regard July 31, 2016 = Sunday, so payment can be made on August 1, 2016 ROW, Art. 61 (2)

Question 4: C

A second representative need not file a signed authorization, if the EPO is notified that the previous representative's authorization has terminated, Article 1(1) and (2) of the Decision of the President of the EPO dated 12 July 2007, Special edition No. 3, OJ EPO 2007, L.1.

Question 5: D

Request for examination has to be filed:

China: 3 years from priority date

Japan: 3 years from filing date of the International Application

India: 4 years from priority date

Question 6: D

Renewal fees may not be validly paid more than three months before they fall due, Rule 51(1) EPC, second sentence.

Question 7: A

Where, by the time they are due under Rules 14.1(c), 15.3 and 16.1(f), the receiving Office finds that no fees were paid to it, or that the amount paid to it is insufficient to cover the transmittal fee, the international filing fee and the search fee, the receiving Office shall, subject to paragraph (d), invite the applicant to pay to it the amount required to cover those fees, together with, where applicable, the late payment fee under Rule 16bis.2, within a time limit of one month from the date of the invitation.

Question 8: B

The European Patent Office shall include in the file a copy of the search results referred to in Rule 141(1) EPC, thus exempting the applicant from filing said copy, where the priority is a first filing made in Austria, **Denmark**, Japan, the United Kingdom, the United States of America or the Republic of Korea. Official Journal January 2015 and Rule 141(1) and 141(2).

Question 9: B

Within 13 months of:

a. the date of filing referred to in Article 29(1); or

b. if the application relates to one or more rights of priority that have been claimed, the first date of priority, the applicant shall request the Office to perform a search of the state of the art with respect to the subject matter of the patent application prior to the grant of the patent.

A fee in accordance with the rate stipulated under or by virtue of a general order in council for the Kingdom shall be paid together with the request submitted to the Office. The request shall not be handled until the Office has received that amount.

2. If a divisional application as provided for in Article 28 is involved, the request referred to in paragraph (1) shall be made within 13 months of the date of filing referred to in paragraph (1) or priority of the original application or within two months after the filing of the divisional application if that date is later.
ROW. 32(1), (2)

Question 10: B

For applications with an international filing date on or after 16 September 2012 the submission of an “application data sheet” identifying each inventor and providing each inventor’s residence or mailing address will permit the applicant to postpone the submission of the oath or declaration of the inventor until the application is otherwise in condition for allowance. The USPTO will issue a notice of Acceptance with the indication that the oath or declaration requirement has not yet been satisfied. PCT applicant’s Guide – National Phase – US – US.26 –

Question 11: C

The applicant is entitled, under Article 19, to one opportunity to amend the claims of the International patent application in the international phase. 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.

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 – see paragraphs 1.10 and 2.01 and PCT Applicant's Guide paragraphs 10.024 to 10.028, and 10.067 to 10.070).

The applicant is entitled to file a demand (claims amended under Art 34) at the competent IPEA; not limited to only IB. Art 31(6).

The amendments must be in the language in which the International patent 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).

Question 12: A

The notification of an electronic document is governed by two legal fictions. The first one is laid down in R127(2), according to which the notification of an electronic document is deemed to have been effected on the tenth day after transmission of the document to the Mailbox of the recipient. The second legal fiction is established by the Decision of the President (OJ 2015 A28 Art 9(4), stating that when the document is available in the Mailbox on the date of the document, the transmission is deemed to have occurred on the date of the document..

Thus when the document has become available on or before the date of the document, both legal fictions apply and the date of the document triggers the ten day period. Hence, the document is deemed notified on the tenth day following the date of the document (OJ 2015 A36 paragraph 3.31-2).

Rule 127 (2), Article 94(3), Rule 71(1).

16 March 2016 + 10 days = 26 March 2016 + 2 months = 26 May 2016, office closed in Munich and Vienna → Friday 27 May 2016.

Question 13: A

An application abandoned for failure to comply with a time limit during the international phase may be revived as a pending application if it shown to the satisfaction of the USPTO that the delay was unintentional. Any petition to revive an abandoned application must be filed in writing and be accompanied by a petition fee and a statement indicating that the entire delay was unintentional. PCT applicant's Guide – National Phase – US – US.42.

Question 14: D

If the fee for grant and publishing is not paid or if the translation of the claims is not filed in time: the patent application is deemed to be withdrawn [R.71(7) EPC]. The deemed withdrawal can be remedied by requesting further processing [Art.121(1) and R.135(1) EPC]. The flat fee for further processing in the event of the late performance of all the acts required under R.71(3) EPC is given in RFees 2(1).12, 2nd item.

Question 15: A

All filing date requirements are fulfilled on 2 May 2016 (Art.80, R.40):

- R.40(1)(a): Request Form indicates that EP patent is sought
- R.40(1)(b): your fax number allows to contact the applicant (via you)
- R.40(1)(c): description

These requirements are checked under the examination of R.55.

- Claims are required for the application, but not for a filing date (claims are a 'formal requirement'). You will be invited if not supplied at own motion. [Art.78(1)(c), R.57(c), R.58, GL A-III, 15]
- Idem filled-in Request Form [R.41(1), R.57(b), R.58; GL A-III, 4.1 & 4.2]

Question 16: A

According to chapter 6 (Leidraad Inschrijvingen in het Octrooiregister) from The Netherlands Patent Office concerning entries in the patent register the request for recordal of assignment needs to be accompanied by an original deed of assignment or by a certified copy of a notary.

According to rule 3.1 paragraph 4 of the Implementing Regulations of the Benelux Convention on Intellectual Property (Trademarks and Designs) it is sufficient to produce a copy of the document proving the assignment.

Question 17: D

According to article 4 paragraph c of the Paris Convention for the Protection of Industrial Property The periods of priority referred to above shall be twelve months for patents and utility models, and six months for industrial designs and trademarks.

Question 18: B

Statement I is correct. As of the date of entering into force of the amended EU Trademark Regulation the reference date to calculate the renewal period will be the date of expiry of the registration (instead of the last day of the month in which protection ends). There is a transitional arrangement when the basis period for renewal started before the entry into force of Regulation No 2015/2424. The provision contained in the former Article 47(3) CTMR, in the version prior to amendment, will apply for calculating both the basic period and, where applicable, the grace period. (Art. 47(3) EUTMR)

Statement II is wrong. As regards the calculation of the amount of the renewal fees, the due date for the renewal fees is the date of expiry of the registration (Article 47(5) EUTMR, which is not modified by the reform). Consequently, EUTMs expiring before 23 March 2016 will pay the renewal fee according to the old fee schedule. Those EUTM's expiring on or after 23 March 2016 will pay it according to the new fee schedule. This principle applies regardless of the moment in which renewal is actually requested and paid for. Owners who have already paid for the renewal of an EUTM expiring on or after 23 March 2016 (according to the old fee schedule) will be refunded the excess fee they have paid (difference between the old and the new fee schedule) Article 47(3), Annex I A (11), (12), (13), (14), (15), (16), (17) and (18) EUTMR Communication No 2/2016 of the President of the Office of 20 January 2016 concerning the calculation of the amount of renewal fees in view of the entry into force of Regulation (EU) 2015/2424.

Question 19: D

The BOIP carries out a substantive assessment of a trademark, the so-called assessment on absolute grounds. If the sign you have filed cannot be a trademark, for example because it is not distinctive, the BOIP is obliged to refuse its registration. You have a maximum of six months to submit a written objection against the refusal. If the BOIP upholds the refusal, it will then take a definitive refusal decision. An appeal can be made against this definitive decision within two months before the court of appeal in The Hague (Gerechtshof), in Brussel (Hof van Beroep) or in Luxembourg (Cour d'Appeal). The court having territorial jurisdiction shall be determined by the address of the applicant or the address of its representative or by the correspondence address as indicated in the application. In the application the address of the applicant and the address of the representative are in the Netherlands so the appeal has to be made before the Court of Appeal in The Hague. (Art. 2.11 and 2.12 BVIE).

Question 20: D

Statement I is wrong. In case a design is to be published immediately, you have to pay the registration fee and the publication fee immediately with the filing. For each design for which deferred publication is requested you have to pay immediately with the filing the registration fee and the deferment fee. The publication fee has to be paid later (maximum 27 months) Art. 36(4), 37(2) CDR; Art. 6, Art. 15 CDIR.

Statement II is wrong. The maximum period for deferment is 30 months from the date of filing or if priority is claimed 30 months from the date of priority. Thus not ALWAYS 30 months from the date of filing.

Case 1

a. Saturday 15 October 2016 → Monday 17 October 2016

Rule 17.1 PCT: Where the priority of an earlier national or International application is claimed under Article 8, the priority document shall be submitted by the applicant to the International Bureau or to the receiving Office not later than 16 months after the priority date or before the date of international publication of the International application (it is then considered to have been received on the last day of the 16 time limit). .

b. 15 January 2018 (Monday)

The national phase in India has to be entered not later than at the expiration of 31 months from the priority date. .

c. Sunday 15 January 2017 → Monday 16 January 2017

Rule 45bis (a) PCT: The applicant may, at any time prior to the expiration of 19 months from the priority date, request that a supplementary international search be carried out in respect of the International application by an International Searching Authority that is competent to do so under Rule 45bis.9.

d. not applicable (priority claim withdrawn)

e. 19 December 2018 (Wednesday)

See explanation under b, but the 31m period has now to be calculated from the filing date of the International application as the priority claim has been withdrawn

f. 19 December 2017 (19m from filing date)

See explanation under c, but the 19m period has now to be calculated from the filing date of the International application as the priority claim has been withdrawn

Case 2

A: Confirm to the International Bureau that the drawings of the priority application are included in the International patent application through incorporation by reference and send a copy of these drawings to the International Bureau together with the confirmation. Time limit 18 July 2016 (2 m from the original filing date = 17 July 2016 (Sunday) → 18 July 2016). R. 20(6) PCT

B: Same as under A, but the applicable time limit is 22 August 2016 (RO/107 notification bears a 2m time limit, 20 August 2016 = Saturday).

C: The requirement for incorporation by reference is that priority of the earlier application must also have been claimed on filing. So no remedy possible in this case. R. 20(6).

D. Yes, you can withdraw the application and prevent publication until completion of technical preparations for the publication. Publication is due on or just after 18m from the priority date, which is after 20 November 2016. The technical preparations for publication are completed by the 15th day prior to the date of publication. (see paragraph 9.013).

Case 3

A: Due date = 31m from 27.10.2013 = 27.05.2016 (Friday) (Rule 159(1)); and, if applicable, extension under Rule 134(1) for Saturdays, Sundays, holidays).

B: filing fee (R159(1)(c)), designation fees (R159(1)(d)), examination fee (R159(1)(f)), renewal fee for the 3rd year (R159(1)(g)).

Note: search fee under R159(1)(e) is NOT applicable since EPO has acted as ISA and therefore no supplementary search report has to be drawn up.

C: Since the filing fee, designation fees and examination fee are not paid by the due date, the application is deemed withdrawn, R160(1). You will receive a loss of rights communication, R160(2). Further processing is possible as a remedy, Art 121. To cure the nonpaid filing fee, designation fees and examination fee, these fees can be paid together with a further processing fee amounting to 50% of these fees, see R160(1) and Rfees2(12).

To cure the nonpaid 3rd year renewal fee, the 3rd year renewal fee can be paid within 6 months from the 31m term together with the 50% additional fee for belated payment of this renewal fee, R 51(2).

D: To accelerate the grant procedure as much as possible, you will have to perform the following acts on entry into the EP phase:

- waive the Rule 161(1)/162 communication.
- request accelerated prosecution under the PACE program.

E: Send a request to European Patent Office correcting the spelling mistakes, while waiving the right to receive a further Rule 71(3) communication. Information and additional details about the Rule 71(3) waiver can be found in the Notice from the European Patent Office dated 8 June 2015 concerning the possibility to waive the right to a further communication under Rule 71(3) EPC (OJ EPO 2015, A52).

Case 4

A: Yes, it is possible to renew with regard to one designated country only. In that case the payment of fees must be accompanied by a statement listing the Contracting Parties for which no renewal is to be recorded

Paragraph 76.03 of the Guide to the International Registration of Marks: The international registration may however be renewed for some only of the Contracting Parties covered. This is not regarded as a change which, according to Article 7(2) of the Agreement and Article 7(2) of the Protocol, may not be included in the renewal. In that case the payment of fees must be accompanied by a statement listing the Contracting Parties for which no renewal is to be recorded

B: It is possible to add Japan by means of subsequent designation, since Japan is a member of the Madrid Protocol.

According to the list of members of the Madrid Agreement Concerning the International Registration of Marks and Protocol Relating to the Madrid Agreement Concerning the International Registration of Marks, Japan is a member

http://www.wipo.int/export/sites/www/treaties/en/documents/pdf/madrid_marks.pdf

C: It is possible to file the request for subsequent designation at both WIPO and BOIP.

Paragraph 35.01 of the Guide to the International Registration of Marks.

Subject to the exceptions mentioned below, the holder may present the subsequent designation either directly to the International Bureau or through the Office of the Contracting Party of the holder.

However, the subsequent designation must be presented to the International Bureau by the Office of the Contracting Party of the holder where any of the Contracting Parties to which it relates is a country which is designated under the Agreement.)

Common Regulations under the Madrid Agreement Concerning the International Registration of Marks and the Protocol Relating to that Agreement

Rule 24 paragraph 2 subparagraph a

(a) A subsequent designation shall be presented to the International Bureau by the holder or by the Office of the Contracting Party of the holder; however,

(i) [Deleted]

(ii) where any of the Contracting Parties are designated under the Agreement, the subsequent designation must be presented by the Office of the Contracting Party of the holder;

(iii) where paragraph (7) applies, the subsequent designation resulting from conversion must be presented by the Office of the Contracting Organization.

D: The registration date of the international trademark registration will stay the same (the subsequent designation will take effect from the date of application of this subsequent designation).

Or

There are no consequences. The filing date stays the same.

Paragraph 38.01 of the Guide to the International Registration of Marks A subsequent designation which is presented by the holder directly to the International Bureau will bear the date on which it was received by the International Bureau.

Paragraph 32.01 of the Guide to the International Registration of Marks

If the effects of an international registration do not extend to a Contracting Party (for example, because protection in that Contracting Party was not requested at the time of international registration or because the mark is no longer protected in that Contracting Party as a result of a final decision subsequent to a refusal, an invalidation or a renunciation), the extension of protection to that Contracting Party may be effected by filing a subsequent designation. The holder may wish to do this where, for example, the grounds for such refusal, invalidation or renunciation no longer exist.

Common Regulations under the Madrid Agreement Concerning the International Registration of Marks and the Protocol Relating to that Agreement

Rule 24 paragraph 6 subparagraph a

A subsequent designation presented by the holder direct to the International Bureau shall, subject to subparagraph (c)(i), bear the date of its receipt by the International Bureau.

The International trademark registration expires on Monday 6 June 2016, according to WIPO's notification, but can already be renewed as you may know, since renewal is possible 6 months prior to the actual expiration date. Today the client has instructed you to renew the International trademark registration and to add Japan by means of subsequent designation to the International trademark registration.

E: The renewal request should be filed first. In case the subsequent designation would be filed first, the client will also need to pay renewal fees with regard to the subsequent designation. It is more cost efficient to first request for renewal and request for subsequent designation later.

Paragraph 37.21 of the Guide to the International Registration of Marks:

These fees are in respect of the remainder of the 10 years for which the fees have already been paid for the international registration concerned. In other words, the amount of the fees is the same irrespective of the number of years during which the subsequent designation will have effect until the renewal of the international registration.

Paragraph 38.04 of the Guide to the International Registration of Marks

In general, the possibility of being accorded an earlier date will be of advantage to the holder. In certain circumstances however, this new possibility can cause complications, and may have even disadvantages. For example, a subsequent designation which is presented through an Office shortly before renewal of the international registration is due but reaches the International Bureau after that date will nonetheless bear a date earlier than the renewal date. It will therefore expire on that date and, in order to maintain it in force, it will be necessary to pay again the complementary fee or (where appropriate) the individual fee required in respect of the newly designated Contracting Party.

Paragraph 41.01 of the Guide to the International Registration of Marks

The period of protection under the subsequent designation expires on the same date as the

international registration. For example, if an international registration has already been registered for eight years (or the last instalment of fees was paid eight years ago), the fees to be paid for a subsequent designation will cover a period of only two years. This means that the date of renewal of the international registration (or the date of payment of the renewal fees) is the same for all designations contained in the international registration, irrespective of the date on which the designations were recorded (see also paragraph B.II.38.04).

F: 6 December 2016.

Paragraph 77.05 of the Guide to the International Registration of Marks: The fees should be paid to the International Bureau by, at the latest, the date of expiry. Any payment received by the International Bureau earlier than three months before the due date is considered as having been received three months before that date. The payment can still be made up to six months after the date on which the renewal was due, provided that a surcharge (which amounts to 50% of the basic fee for renewal) is paid at the same time.)

G: 50% of the basic fee for renewal.

Paragraph 77.05 of the Guide to the International Registration of Marks: The payment can still be made up to six months after the date on which the renewal was due, provided that a surcharge (which amounts to 50% of the basic fee for renewal) is paid at the same time.)

Case 5

A:

Monday 5 September 2016.

Rule 9.1 of the opposition guidelines of the Benelux Office for Intellectual Property. The suspension by mutual request is free the first three times, when filed before the commencement. The fourth time and onwards, costs will be charged.

B: 4 months

Rule 9.1 of the opposition guidelines of the Benelux Office for Intellectual Property. Parties may request joint request for an extension. This extension will last 4 months and may be renewed for a 4-m period.

C: Three times (12 months total)

Rule 8.3 of the opposition guidelines of the Benelux Office for Intellectual Property. The cooling-off period may be extended three times for free. After this third extension a fee needs to be paid of 150 euro.

D: Request for opt-out / opting out

Rule 9.1 of the opposition guidelines of the Benelux Office for Intellectual Property. Any party can, during the suspension, at any time request in writing to stop the suspension. This is the so-called opt-out of the suspension.