

### **Question 1 : D**

Answer a = false. Ruled out under Art. 121(4).

Answer b = false. Ruled out under Rule 135(2) EPC.

Answer c = false. Ruled out under Rule 135(2) EPC.

Answer d = correct. Not ruled out under any provision.

### **Question 2 : B**

Answer a = false. The 10-day fiction is applicable.

Answer b = correct. The communication is deemed notified on 21 December 2016 + 10 days = 31 December 2016 (Saturday). The non-working day extension is not applicable to the 10-day fiction.

Answer c = false. As mentioned, the non-working day extension is not applicable to the 10-day fiction.

Answer d = false

### **Question 3 : C**

Answer a = correct. There is no time limit for requesting rectification of the designation of the inventor under Rule 21(1) EPC.

Answer b = correct. There is no evidence requirement for requesting rectification of the designation of the inventor under Rule 21(1) EPC.

Answer c = false. If a further inventor is to be designated, the consent of the inventor previously designated is not necessary under Rule 21(1) EPC.

Answer d = correct. If the request is filed by Mr. Bernard, the consent of the applicant is required under Rule 21(1) EPC.

#### **Question 4 : D**

Answer a = correct. EP-A is considered to be filed within the priority period: 20 May 2016 + 12 months = 20 May 2017 (Saturday), extended to 22 May 2017.

Answer b = correct. A declaration of priority can be made within sixteen months from the earliest priority date claimed, Rule 52(2) EPC.

Answer c = correct. For Mr. Bernard to be considered the successor in title according to Article 87(1) EPC, the transfer of the application (or of the priority right as such) must have taken place before the filing date of EP-A. This is the case as 18 May 2017 is prior to 22 May 2017.

Answer d = false. Proof of the transfer of the priority right can be filed later, Guidelines, A-III, 6.1.

#### **Question 5 : B**

Answer a = correct. On 2 May 2017 it was possible to validly pay the renewal fee for EP-A together with the additional fee of Rule 51(2) EPC: due date 31 October 2016 + 6 months = 30 April 2017 (Sunday), extended to 1 May 2017 (Labour Day), extended to 2 May 2017.

Answer b = false. The 2-month period for filing the request for re-establishment of rights counts from the day the applicant became aware of the loss of rights. Hence, the request must be filed at the latest on 30 May 2017 + 2 months = 30 July 2017 (Sunday), extended to 31 July 2017. So 3 July 2017 is not too late.

Answer c = correct. In the present case, the omitted act that has to be completed (Article 122(1) EPC and Rule 136(2) EPC) includes the payment of the renewal fee for the third year (Article 86(1) EPC, Rule 51(1) and (2) EPC).

Answer d = correct. The applicant must show that he had exercised all due care required by the circumstances, Article 122(1) EPC and Rule 136(2) EPC.

#### **Question 6 : B**

A natural person as well as a legal person (also known as: legal entity) may file an EU trademark application. Examples of Dutch legal entities that are allowed to file an EU trademark application are 'Besloten Vennootschap' (BV), 'Naamloze vennootschap' (NV) and 'Vennootschap Onder Firma' (VOF).

Following article 5 of the European Trademark Regulation a natural person and a legal person may be the proprietor of an EU trademark. On 20 October 2016 the EUIPO has sent a communication informing users that a VOF does comply with article 3 of the EU Trade Mark Regulation and is in fact a legal person (entity), following arguments and evidence filed by applicants and their representatives (amongst which a ruling of the Dutch Supreme Court - Hoge Raad: ECLI:NL:HR:2009:BG7409).

### **Question 7 : B**

Only statement I is correct. To be able to obtain an International trademark registration the applicant must have already obtained an application or registration in the country of origin or at the office of origin, also known as basic application/basic registration.

Statement II is incorrect since it is possible to simultaneously use the EU trademark application as a priority claim and to use the Benelux trademark application as a basic application, when applying for an International trademark registration. The application used as a basis and the application used for the priority claim need not involve the same trademark application.

### **Question 8 : A**

Renewal is due 10 years after the filing date. As of the date of entering into force of the Amending Regulation (EU) 2015/2424, on 23 March 2016, the reference date to calculate the renewal period is the date of expiry of the registration (instead of the last day of the month in which protection ends). The renewal can be effected until 28 April 2017. 27 April 2017 is a closing day of the EUIPO due to Santa Faz.

### **Question 9 : A**

Upon receipt of a notification of EUIPO the trigger is receipt of the document: deemed notified after 10 days. (Rule 62(3) EUTMR). 10 days + 2 months = 28 June 2017.

### **Question 10 : B**

Only statement I is correct. To obtain a filing date for a Benelux trademark application it is required to file a document containing information identifying the applicant name, address and legal form (if applicable), a list of the goods and services in respect of which the application is requested and the trademark including a specification on the type of trademark.

Statement II is incorrect since a period of at least one month will be granted for meeting the other requirements. This period may be extended upon request but may not exceed a period of six months after the date on which the first notification was sent.

## Question 11 : D

First renewal fee needs to be paid before the start of the 4<sup>th</sup> year from filing date on the last day of the 'birthday month' unless application not yet granted.

First renewal fee due - 30 September 2016 (Friday)

Final date payment with surcharge – 30 September 2016 + 6 months = 31 March 2017

## Question 12 : C

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

14 December 2015 + 18 m= 14 June 2017

3 May 2017 + 2m= **3 July 2017**

## Question 13 : C

Art. 27 ROW 1995. Elke aanvraag om octrooi mag slechts op een enkele uitvinding betrekking hebben of op een groep van uitvindingen, die zodanig onderling verbonden zijn, dat zij op een enkele algemene uitvindingsgedachte berusten. Bij algemene maatregel van rijksbestuur kunnen daarover nadere regels worden gesteld.

Art. 34(3) ROW 1995. Indien bij het onderzoek blijkt, dat de ingediende aanvraag niet voldoet aan het bij of krachtens artikel 27 bepaalde, wordt het uitgevoerd ten aanzien van die onderdelen van de aanvraag die betrekking hebben op de uitvinding of op de groep van uitvindingen als bedoeld in artikel 27, die als eerste in de conclusies wordt genoemd.

Art. 36(4) ROW 1995. Indien toepassing is gegeven aan artikel 34, derde lid, heeft het octrooi uitsluitend betrekking op die uitvinding of groep van uitvindingen als bedoeld in artikel 27, die als eerste in de conclusies wordt genoemd.

## Question 14 : B

Statement I is correct

Statement II is not correct: According to 35 U.S.C. Section 184 (Section 184), a foreign filing license is required for a patent application if the claimed subject matter was made in the U.S.

CN

A foreign filing license is always required in China. It is necessary as long as an invention or utility model is developed in China even if a domestic filing has been made first.

According to Article 20.1 of Chinese Patent Law, the Chinese Patent Office must conduct a “Confidentiality Examination” of any invention or utility model developed in China in advance before an entity or individual files an application for a patent in a foreign country for the invention or utility model.

According to Rule 8 of the Implementing Regulations of the Patent Law (Implementing Regulations, an invention or utility model is considered to be “developed in China” if the “substantive contents” of the technical solution of the invention or utility model have been made or created by an inventor **within** China.

IN

Section 30 Indian Patents Act, 1970

Any person **resident** in India must obtain a written permission from the Controller of Patents before filing a patent application outside India unless a corresponding application is filed in India six weeks before the date of filing the foreign application.

The Indian Patent Office rules are unique in that the requirement for obtaining a foreign filing license is not necessarily based on the place of invention, but the resident status of the inventor. What constitutes “resident” status in India is also discussed in more detail herein.

If a person is considered to be resident in India, then a foreign filing license is needed in the cases of filing a patent application directly in a foreign country less than 6 weeks from filing the application in India or without a direct filing in India.

US

For inventions made in the US, an application shall be first filed in the USPTO, unless authorized by a license obtained from the USPTO.

According to 35 U.S.C. Section 184 (Section 184), a foreign filing license is required for a patent application if the claimed subject matter was made in the U.S. and (1) it has been less than 6 months after an application was first filed in the U.S., or (2) no application has yet been filed in the U.S. Specifically

### **Question 15 : C**

US: maintenance fee must be paid beyond four years after grant; the fees are due 3 ½ , 7 ½ and 11 ½ years from the date of grant. i.e. 25 August 2020

EPO: renewal fees are due in respect of the third and each subsequent year; i.e. 31 March 2016

Japan: Annual fees of first 3 years are paid as registration fee. Further annual fees are due yearly, in advance before the expiration of the previously paid year.

China: No renewal fees are due before grant.

### **Question 16 : D**

PCT Newsletter September 2016. On December 8, 2016 the PCT became into force on Cambodia. Consequently, any international application filed on or after 8 December 2016 will automatically include the designation of Cambodia.

### **Question 17 : A**

USPTO is competent rO for US nationals and the EPO is competent ISA for applications with USPTO as rO (PCT Applicant Guide Annex C - US). For EPO as ISA no agent is needed but allowed (R. 90 PCT). If so he must be qualified to practice, so he has to be a European patent attorney.

### **Question 18 : C**

The priority can be withdrawn at any time prior to expiry of 30 months from priority (Art. 8(1) 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 which is Monday 9 July 2018. (Sunday 8 July 2018)

## **Question 19 : A**

R.40.1 PCT: 1 month from invitation = 30 June 217 (Friday).

B is incorrect: based on 16 m from priority date = wrong rule

c is incorrect: 30 May + 10 days + 1 m is 9 July = Sunday → 10 July. 10 days notification however not applicable under PCT.

d is incorrect: 2 months from invitation = 30 July = Sunday → 31 July. Wrong rule.

## **Question 20 : B**

PCT Applicant's Guide, NL, Annex C. The languages accepted by The Netherlands Patent Office as rO are Dutch, English, French, and German.

PCT Applicant's Guide, International Phase, section 6.034 (Rule 19.4(a)(ii), (b), and (c) PCT). In case an application is filed in a language which is not accepted by the rO, but is in a language accepted by the International Bureau as receiving Office, that international application will be considered to have been received by that Office on behalf of the International Bureau as receiving Office. PCT Applicant's Guide, International Phase, IB, Annex C. The IB as receiving Office accepts any language.

## Case 1

a. Yes.

A multiple Benelux design application may contain different designs.

Rule 2.2 Implementing Regulations under the Benelux Convention on Intellectual Property (trademarks and designs).

b. No.

When several designs are combined in a multiple application, the application shall be divided if the products in which the designs are intended to be incorporated or to which they are intended to be applied belong to more than one class of the Locarno Classification.

Article 2 Community Design implementing regulation.

c. A maximum of fifty images.

Rule 2.2 Implementing Regulations under the Benelux Convention on Intellectual Property (trademarks and designs).

d. A maximum of seven images.

Article 4 Community Design implementing regulation.

e. Article 6 Community design implementing regulation – the following fees should be paid at the time of filing the Community design application: registration and publication fee.

f. Benelux

1 multiple design application.

5 different designs X 7 views of each design = 35 images

€ 108,- (filing the first design) + € 216,- (€ 54,- per additional design X 4 designs) + € 350 (€ 10,- per image X 35 images) = € 674,-

EU

1 multiple design applications.

€ 350,- (filing the first design) + € 700,- (€ 175,- per additional designs X 4 designs) = € 1.050,-

Filing a Benelux design application is the most cost-efficient

## Case 2

- a. 1 June 2017 (Thursday)

Entry into the European phase is 31 Months from the priority application

- b. By online filing, (CMS online filing, web-form filing), by fax, by post or by handing over the application.

(Online filing/CMS online filing and web-form filing will be counted as one answer)

- c. The filing date of the International application is 29 November 2015.

All of the agreement dates fall before the international application date

The extension agreement with Montenegro came into force on 1 March 2010.

The validation agreement with Morocco came into force on 1 March 2015

The validation agreement with Moldova came into force on 1 November 2015.

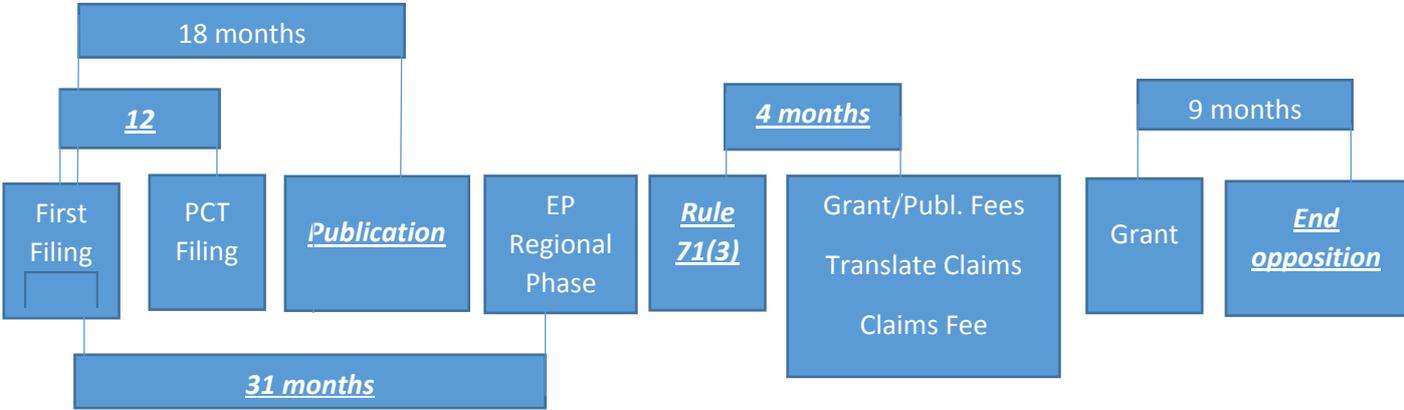
- d. According to article 153 paragraph 4, upon entry into the European regional phase an English, German or French translation of the international in patent application needs to be filed.

- e.

Filing fee	120
Designation fee	585
Extension fee Montenegro	102
Validation fee Moldova	200
Validation fee Morocco	240
Search fee	$1300 - 190 = 1110$
Examination fee	1635

**Case 3**

- 1 = 12 months
- 2 = 31 months
- 3 = 4 months
- a. = Publication
- b.= Rule 71(3)
- c. = End of Opposition period



## Case 4

1. BuenoMed S.A. is an AR legal entity. As AR is not a member of the PCT, BuenoMed S.A. is not entitled to file a PCT application.  
BuenoMed GmbH is a German legal entity and as DE is a member of the PCT it is entitled to file a PCT application.
2. 6 June 2017 Tuesday  
  
3 June 2016 + 12m = 3 June 2017 (Saturday)  
5 June 2017 Monday = Whit Monday
3. Transfer patent application AR-A from S.A. to GmbH or  
Transfer the right to claim priority from AR-A from S.A. to GmbH.
4. IB only.  
  
Not EPO (English, French or German) or GPTO (German) as application is in Spanish.  
Not in Spanish Patent Office as applicant GmbH is not entitled to file at Spanish Patent Office.
5. Need to be filed at IB (rO). Within 1 month from filing, R. 12(3): 1 June 2017 + 1 m = 1 July 2017 (Saturday) → 3 July 2017.
6. 7 September 2017  
  
1 month from invitation or 2 months from filing, whichever is later.  
  
2 months from filing is 1 August 2017 and 1 month from invitation is Thursday 7 September (Thursday)  
  
Late furnishing fee is 25% of filing fee =  $0.25 \times 1219 \text{ EUR} = 305 \text{ EUR}$ .
7. 22 months from the earliest priority date (Tuesday 3 April 2018) or 3 months from transmission of the International search report (Thursday 5 April 2018), whichever expires earlier. So 5 April 2018.
8. No, AR is not a member of the PCT
9. Make a specific request to start early, Art. 23(2)/40(2), Comply with all national requirements, i.e. perform all acts for national/regional entry). More detailed answers possible, e.g. pay fees, request for examination indicate basis for grant but these depend on the dO and the timing.