

Answers Examination 2013

Question 1: B

See Art. 17 (Geneva Act) + WIPO Guide to the Registration of International Designs, Part B, Ch. II, 11.12

Question 2: A

See Art. 29 (1) ROW'95. Required are: an indication (explicit or implicit) that the documents are a patent application; data identifying the applicant or allowing the office to contact the applicant; data which at first sight appear to be a description of the invention, irrespective of the language.

In this case, the contact details of the patent attorney are sufficient to contact the applicant and thus a filing date can be assigned based on the faxed documents.

Question 3: C

See Applicant's Guide International Phase Appendix C.

The main issue is which office(s) may be competent receiving Office for the IA. Nationality / residency of the Applicant determine whether an rO is a competent rO or not, thus NL and EP are both not competent receiving Offices as the Applicant is national of / resident in the USA.

Answer D is incorrect because it is possible to file with WIPO/IB in addition to USPTO. Also, other receiving Offices such as OCNL and EPO would forward the application to WIPO/IB under Rule 19.4 so it is not true that the application "must be filed with the USPTO".

According to the Applicant's Guide, before IB, the rules who can act as agent are the same as for the country where the Applicant is national/ resident, i.e. the United States. This rO requires a US agent, and therefore your attorney cannot represent the Applicant before the IB in this case. Your attorney being qualified for NL but not for EP is irrelevant here.

Question 4: B

It is indeed possible to renew an international design registration for certain contracting parties and/or designs only, see Article 17(3); Rule 24(2)(a) Geneva Act. Statement I is correct

The renunciation of an international registration always concerns all industrial designs in the registration (Art 16(1)(iv); Rule 21(1)(a)(iii) Geneva Act). Statement II is thus incorrect, choosing this option would cause the client to lose D1 in France and D2 in Italy, as well

Note that it would also be possible to request limitation of the international registration to designs D1 and D2 to achieve the desired result.

Question 5: A

The letter received is an invitation according to R. 16bis.1 sub(a). This sets a time limit of one month from the date of the invitation, so the time limit ends on 17 May. If there is a delay in delivering the letter, Rule 80.6 second sentence may apply, however this provision requires the delay to be at least 7 days. In this case, the delay was only 6 days, so there is no extension under this Rule.

Thus, the only option you have is to call the receiving Office and check whether the case is already declared withdrawn – if not payment could still be considered in time under R. 16bis. 1 sub(e).

Question 6: C

The communication under R.161 is not a first communication according to R. 36(1)(a). Thus, the twenty-four month period is set off by the R. 71(3) communication. In this case, the application is granted (i.e. is no longer 'pending' in accordance with Art. 76 EPC) before the end of the 24 months. The application is pending up to but not including the day of the grant, so the last day for filing the divisional is the day before the grant date.

Question 7: D

I Priority can be claimed at the time of filing, or for a short period thereafter. For a Benelux application, this period is one month (Art 2.6 BVIE). So this statement is incorrect. Note that for a CTM, the period would in fact be two months.

II It is generally not possible to add classes to a pending trademark application / registration. If any trademark is to be extended to additional classes, this requires filing a new application. This statement is also incorrect.

Question 8: C

The translation requirement is laid down in Art. 14(2) EPC. An EPO formalities officer checks whether the translation is provided (R. 57(a) EPC) and, if not, an invitation is sent under R. 58 EPC giving 2 months to correct the deficiency (missing translation).

Further processing is not available; both the initial 2 month period to submit the translation of R.6 (1) EPC and the time limit of R.58 are excluded from further processing under R. 135(2) EPC. While re-establishment may be available, it is not the only remedy.

Question 9: B

I An International design application can contrary to an International trademark application be filed directly with the International Bureau of WIPO - Art. 4(1)(a) Geneva Act

II This is incorrect; Rule 7(3) of the Common Regulations also mentions "products" (plural). The only limitation is that the different products belong to a single class of the international classification, see Rule 7(7).

Question 10: D

In this question, one has to be aware that amending the international application under Art. 19 PCT is limited to an amendment of the claims. That is, in the international phase, amendments to the description are only possible together with filing a demand. Thus, the client's request could not be met with at any time.

Question 11: B

In the NL procedure, the time limit of 1 month starts on the date of the letter sent by the office, thus the time limit expired yesterday (22 May).

The text of the question indicates that reestablishment will fail, as one will not be able to prove all due care under the circumstances.

However, the patent can still be saved as the letter from NLOC is regarded as a decision (“besluit”) under general Dutch administrative law (“Algemene wet bestuursrecht”), In accordance with the provisions of that law an appeal may be filed within 6 weeks of the date of the decision.

See also Raad van State, decision of 24 October 2012 (Philips vs NLOC): confirms that the letter from NLOC (“termijnbrief”) is indeed an appealable decision (“besluit in de zin van artikel 1:3 Awb”).

Question 12: A

Art. 2.17 Benelux IP Treaty (BVIE) . The term to file the appeal is two months after the opposition has been ruled on in accordance with Art. 2.16(4) BVIE. The parties may address the appeal to the Appeal Court of Brussels, the Court of The Hague or the Appeal Court of Luxembourg in order to obtain a decision for nullification of the decision of the Office. The territorially competent Court will be determined by the original defendant’s address, the attorney’s address or the address for correspondence as indicated in the application. As Leonidas is a Belgian company the appeal has to be filed with the Court of Brussels. (Art. 2.17)

Question 13: A

Taiwan is not a PCT contracting State; the Taiwanese office is not participating in WIPO DAS. This eliminates options C and D. As to option B, there is no legal basis for WIPO to provide this service.

Question 14: C

Art 87(1) EPC “Any person or his successor in title”. Thus, for validly claiming priority, either the original applicant should also be an applicant in the later application claiming priority, or an additional action is required, namely, an assignment of priority rights to a “successor in title”. Therefore, statement I is incorrect (not same person, while no further action is taken, meaning there is no successor in title).

Under EP practice, it is sufficient if the applicant of the priority application is one of joint applicants in the later application (but not the other way around!). Thus, statement II is correct.

See also Visser, notes to Art. 87, paragraph 5.

Question 15: B

I This is correct, see BBIE website (www.boip.int), section Juridical -> Opposition -> File an opposition -> Minimum requirements -> Fees

The first part has to be paid at the time of filing the opposition, and the second part has to be paid at least one day before the start of the adversarial part of the opposition (legal basis: "Uitvoeringsreglement Beneluxverdrag IE", UR-BVIE, Rule 1.17 (1.b) and Rule 1.18 (2) and Rule 1.18 (3)).

II This is incorrect, see BBIE website, section Juridical -> Opposition -> Language regime

Arguments may be exchanged in English if the defendant agrees, but the decision will always be in one of the procedural languages (French or Dutch) (legal basis: UR-BVIE Rule 1.20 (1) and Rule 1.20 (4))

Question 16: C

The trademark to be opposed is a CTM. The term for filing an opposition against a CTM is 3 months from its publication (Art. 41(1)(a) CTMR) i.e. 22 June. However, since this is a Saturday, the term will be extended automatically to the next working day, Monday 24 June (Rule 72(1) CTM-IR).

Question 17: D

See R.90bis.3 PCT, sub (a).

Question 18: D

For a withdrawal of the application, the requirement to submit a power of attorney cannot be waived (R. 90.4(e)). Due to the change of ownership, the present power of attorney is no longer valid as it is not signed by the current Applicant, Banda Verde. Thus, statement I is incorrect

As an Argentinean company, Banda Verde is not a national or resident of a PCT Contracting State and thus not entitled to file a demand (R. 54.2). In this case, the demand is deemed not to have been submitted (R. 54.4). Thus, statement II is also incorrect

Question 19: C

See Art. 61(2) ROW'95, taking into account that the filing date of the divisional is deemed to be the same as that of the parent in accordance with Art. 76 EPC = 10.04.2008

As the divisional was granted on 2 May, it is clear that the 6th year annuity (which fell due on 30.04.2013) must still have been paid to the EPO (also follows from R. 71a(4) EPC). Thus, the first annuity payable to NLOC will be for the annuity for the 7th patent year, falling due on 30 April 2014.

Due to the replacement of Queen's Day by King's Day in the Netherlands, 30 April 2014 will be a working day so the time limit will not be extended to 1 May.

Question 20: D

See PCT Newsletter May 2009, Practical Advice ("PA5-09").

Answer A is not correct; from Art. 17(2)(a) PCT it follows that, in this situation, "no international search report will be established". So Art.19 cannot apply as Art. 19(1) states "... after having received the international search report ..." See also fourth paragraph of the answer in PA5-09.

Answer B is not correct; the situation is not mentioned in R. 16.2 thus no refund can apply (cf. second paragraph of the answer in PA5-09).

Answer C is not correct; see R. 66.1 (e). If no ISR has been established, an office is not required to carry out international preliminary examination of the application.

Thus, Answer D remains. PA5-09 mentions the possibility of requesting a supplementary international search in the third paragraph of the answer, and indeed it may be confirmed through the PCT Applicant's Guide, Annex SISA (RU) that the Russian office in this specific situation would carry out the search, in English.

Question 21: A

See Communication No.4/12 of the President of the Office of 12 12 2012 concerning the enlargement of the European Union to Croatia

<http://oami.europa.eu/ows/rw/resource/documents/CTM/legalReferences/decisionPresident/co4-12-en.pdf>

Case 1

National entry:

China = 30 + 2 months, Sat 26 Oct 2013, next working day: Mon 28 Oct 2013

United States = 30 months, Mon 26 Aug 2013

India = 31 months, Thu 26 Sep 2013

Examination:

China = 3 years from priority, Wed 26 Feb 2014

India = 48 months from priority, Thu 26 Feb 2015

United States = not applicable, no examination request needs to be filed.

For the USA, there is no specific request, but an examination fee is due upon filing. If you don't pay an examination fee, you will get a 'notice of missing parts' with a time limit to correct. As the examination request is implicit with the filing (national entry), "Together with filing", or the date of national entry, were considered partially correct answers.

Case 2

Question 1

No, Rule 132(2) EPC refers to "a period specified by the European Patent Office", i.e. only "office time limits" are extendable, whereas the four months in this case is laid down in the EPC itself (see R. 71(3), second sentence – this is an example of a "convention time limit").

Question 2

One has to pay a further processing fee of **240 euro**, Rfees 2(1) sub 12.

In case of amendments under R. 71(6), the grant and printing fee is not considered to be due, which follows from R. 71a(5). However, the answer 1115 euro is also accepted as the fee will be refunded.

Question 3

1115 euro, namely the grant and printing fee of 875 euro (Rfees 2(1) sub 7) and the flat fee of Rfees 2(1) sub 12 for further processing.

Question 4

No, further processing is excluded for the time limit to request further processing itself, see Art. 121(4) EPC.

Case 3

Question 1

Time limit is the longer of 4 months from the international filing date or 16 months from the priority date (Rule 26bis.1 (a)).

3 May 2013 + 4 months -> 3 September

7 May 2012 + 16 months -> 7 September (Saturday) -> (R.80.5) **Monday 9 September 2013**.

Question 2

America Invents Act (AIA), effective for international applications filed on or after 16 September 2012. Legal entities can be applicants for US; it is no longer required to file a US application in name of the inventor(s).

Question 3

Under Rule 92bis PCT, a change of applicant should be requested with the International Bureau of WIPO. The inventors may be removed as applicants for US, and Kollegg Inc. should be made applicant for all designated States, including US.

Question 4

Yes, a declaration of inventorship is still necessary.

The declaration may be added to the PCT application using standardized wording in accordance with R. 4.17, item (iv), as prescribed in the PCT Administrative Instructions, Section 214. The date for doing so is determined by R. 26ter.1: this is again 16 months from the priority date, however in this case the request will be deemed to have been received in time if it reaches

WIPO/IB **before the completion of technical preparations for the publication** (unlike the addition of a priority claim).

Calculation: 18 months from priority date = Thu 7 November 2013. Earliest possible publication will be on the Thursday after end of the 18 months period, i.e Thu 14 November 2013.

Preparations for publication completed on 15th day prior to this date, i.e. on Wed 31 October 2013.

Latest date to add declaration is **Tuesday 30 October 2013** (until midnight).

Full marks were also given if a candidate gave the answer Monday 9 September 2013 (16 months from the priority date, see calculation under answer 3.1)

Case 4

Question 1

30 August 2012 + 9 months (Art. 99(1) EPC) = 30 May 2013, EPO (München) is closed. Extended to next working day, **Friday 31 May 2013**

Question 2

See example form and voucher

Question 3

If no payment voucher is submitted, no payment of the opposition fee will have been made. The consequence is that, under Art. 99(1), the **opposition is deemed not to have been filed**.

Question 4

No, neither remedy can be used by an opponent.

According to Art. 121(1) EPC further processing is only available to an applicant

Under Art. 122(1) EPC, reestablishment is only available to an applicant or a proprietor. (See also Board of Appeal T 702/89 – a request for reestablishment in this situation will be inadmissible).



Notice of opposition to a European patent

I. Patent opposed

Patent No.	1850318
Application No.	06020833.7
Date of mention of the grant in the European Patent Bulletin (Art. 97(3), Art. 99(1) EPC)	30.08.2012
Title of the invention	Storage medium having music playing program stored therein and music playing apparatus thereof

II. Proprietor of the patent

first named in the patent specification	Nintendo Co., Ltd.
Opponent's or representative's reference (max. 15 keystrokes)	O307/EP

III. Opponent

Name	Floor Management B.V.
Address	De Kade 12 4588 EN Nijmegen
State of residence or of principal place of business	The Netherlands (NL)
Nationality	The Netherlands (NL)
Telephone/Fax	
Multiple opponents (see additional sheet)	<input type="checkbox"/>

IV. Authorisation

1. Representative (name only one representative or name of association of representatives to whom notification is to be made)	Guus Hetebrij
Address of place of business	(Future Patents B.V.) Hoofdstraat 25 (NL-)1029 CM Amsterdam The Netherlands
Telephone/Fax	+31 20 9545222 +31 20 9545223
Additional representative(s) on additional sheet/see authorisation	<input type="checkbox"/>
Opponent's reference	O307/EP

2. Name(s) of employee(s) of the opponent authorised to act in these opposition proceedings under Art. 133(3) EPC

Authorisation(s) to 1./2. not considered necessary

has/have been registered under No.

is/are enclosed

V. Opposition is filed against

• the patent as a whole

• claim(s) No(s).

VI. Grounds for opposition:

Opposition is based on the following grounds:

(a) the subject-matter of the European patent opposed is not patentable (Art. 100(a) EPC) because:

• it is not new (Art. 52(1); Art. 54 EPC)

• it does not involve an inventive step (Art. 52(1); Art. 56 EPC)

• patentability is excluded on other grounds, i.e. Article

(b) the patent opposed does not disclose the invention in a manner sufficiently clear and complete for it to be carried out by a person skilled in the art (Art. 100(b) EPC; see Art. 83 EPC).

(c) the subject-matter of the patent opposed extends beyond the content of the application/of the earlier application as filed (Art. 100(c) EPC, see Art. 123(2) EPC).

VII. Facts (Rule 76(2)(c) EPC)

presented in support of the opposition are submitted herewith on a separate sheet (annex 1)

VIII. Other requests:

Opponent's reference

O307/EP

IX. Evidence presented

Evidence is enclosed
will be filed at a later date

A. Publications:

1
Particular relevance (page, column, line, fig.):

2
Particular relevance (page, column, line, fig.):

3
Particular relevance (page, column, line, fig.):

4
Particular relevance (page, column, line, fig.):

5
Particular relevance (page, column, line, fig.):

6
Particular relevance (page, column, line, fig.):

Continued on additional sheet

B. Other evidence

Continued on additional sheet

Opponent's reference O307/EP

X. Payment of the opposition fee is made

- as indicated in the enclosed voucher for payment of fees and costs (EPO Form 1010)
- via EPO Online Services

XI. List of documents

Enclosure No.

- 0 Form for notice of opposition
- 1 Facts (see VII.)
- 2 Copies of documents presented as evidence (see IX.)
 - a Publications
 - b Other documents
- 3 Signed authorisation(s) (see IV.)
- 4 Voucher for payment of fees and costs (see X.)
- 5 Additional sheet(s)
- 6 Other

Number of sheets

Please specify here:

XII. Signature of opponent or representative

Place

Date

Signature

Name (block capitals)

In case of legal persons, signatory's position within company

Opponent's reference **O307/EP**



Payment of fees and expenses

European Patent Office
 Treasury and Accounts
 80298 München
 Germany
 Fax +49(0)89 2399-4465

Please complete in typescript only

01	Name of payer	Future Patents B.V. (and/or Guus Hetebrij)	Payer's reference	O307/EP
	Address	Hoofdstraat 25 1029 CM Amsterdam	Mode of payment	Name of bank where EPO account held
02			<input type="checkbox"/> Bank payment/transfer to ¹	
			<input type="checkbox"/> Debit from deposit account with the EPO is requested ²	Deposit account No.

Patent application / patent No. (please use a separate form for each application)				
03	EP	1850318	PCT	03

	Code		Currency	Amount
04	001	Filing fee – EP direct ³	EUR	
05	002	Search fee	EUR	
06	005	Designation fee(s) ⁴	EUR	
07	015	Claims fee(s) (Rules 45(1), 162(1) EPC) ⁵	EUR	
08	055	Additional copy	EUR	
09	006	Examination fee	EUR	
10	007	Fee for grant ⁶	EUR	
11	008	Additional fee for printing specification (more than 35 pages) ⁷	EUR	
12	033	Renewal fee for the 3rd year	EUR	
13	034	Renewal fee for the 4th year	EUR	
14	035	Renewal fee for the 5th year	EUR	
15	020	Filing fee – entry EP phase ³	EUR	
16		Extension fee(s) for ⁸ : _____	EUR	
17	010	Opposition fee	EUR	745.00
18		_____	EUR	
19		_____	EUR	
20		_____	EUR	
21		_____	EUR	
22		Total	EUR	745.00

Signature

Place, date