

1. (3 points)

On 22 December 2022, Italian company X filed an international patent application PCT-X at the EPO as receiving Office. PCT-X claims priority from European patent application EP-X filed on 11 January 2022.

The EPO as International Searching Authority issued a search report, together with a negative written opinion (WO-ISA) and transmitted them to the applicant on 11 May 2023. Company X would like to overcome the objections raised in the WO-ISA before deciding on national phase entry.

What acts should be performed before which authority, and by when?

2. (5 points)

A large US company filed an international patent application with the USPTO, without claiming priority. The International Bureau published the application on 16 March 2023, together with the international search report drawn up by the USPTO. The published international patent application comprised 2 pages of bibliographic data, 30 pages of description, 15 claims on 2 pages, and 6 drawings on 4 pages. The claims have not been amended under Article 19 PCT. The US company now wants the supplementary European search at the EPO to start as soon as possible but believes that it has to wait until the end of 31 months from the date of filing.

Please explain whether the supplementary European search can start earlier and list the necessary steps to ensure the earliest possible start at minimum cost. You should identify the fees due to be paid, but you do not need to specify their amounts.

3. (5 points)

The applicant filed a US patent application US-A on 23 November 2021. This patent application is currently under examination and a notice of allowance is not expected before 2024.

On 20 November 2022, your law firm validly filed a European patent application EP-A in the applicant's name, claiming priority from US-A.

A communication under Rule 64(1) EPC is issued on 5 September 2023, indicating a lack of unity because application EP-A comprises three inventions: A1, A2 and A3.

1. What is the deadline for responding to this communication? Show your calculations.
2. What steps need to be taken to receive the final search report for invention A1 only?
3. What steps need to be taken to receive the final search report covering all three inventions?
4. What steps need to be taken to enable the applicant to obtain examination of inventions A1 and A3 by the EPO?

The applicant informs your law firm that it wants to accelerate examination of invention A1 by using Form 1009 or Form 1005.

5. Can you use these forms to accelerate the proceedings? Please explain your answer.

Following a successful request for accelerated examination, a communication under Article 94(3) EPC is issued on A1, but the applicant needs more time to formulate a response and requests an extension of the time limit.

6. What effect will this request for an extension of the time limit have on the prosecution of A1?

4. (8 points)

A large German company filed a German patent application on 10 April 2022 and received a search report for it on 20 October 2022.

The same company filed a European patent application on 10 June 2022, claiming priority from the German application. The minimum amount of fees was paid on filing. The European application was published yesterday, 11 October 2023, together with the search report.

1. After having analysed the search report issued by the EPO, the applicant wants to maintain its application and obtain a patent. Set out all procedural steps and actions that must be taken to get the first communication under Article 94(3) EPC or Rule 71(3) EPC as soon as possible. Fee amounts need not be specified.

2. By when must these actions be taken at the latest? Show your calculations.

3. Let us now assume that the response to the search opinion did not include any amendment or correction of the application, and the first communication from the examining division is a communication under Rule 71(3) EPC sent in December 2023 without any proposed amendment. The applicant confirms that it agrees with the text set out in the communication and files the required translations of the claims.

The applicant would like to have the broadest possible territorial scope of protection.

Which fees will you pay if the applicant would like to obtain the grant of the patent as soon as possible? Please also specify the fee amounts.

4. If, however, the applicant is interested in delaying the grant without incurring any additional expenses, what is the latest date for paying each of the fees listed in your answer to question 3?

5. (4 points)

Your French employer applied for a European patent in French on 12 October 2021, without claiming any priority; the application as filed contained 10 claims. All fees that fell due before publication of the application with the search report were paid in time. In response to the search opinion, your employer immediately requested examination and filed a set of 20 claims. The application and the amended claims were published on 19 April 2023, together with the search report.

The EPO examining division has issued a communication under Rule 71(3) EPC dated 12 October 2023; it has not proposed any amendments. Your employer agrees to the text communicated under Rule 71(3) EPC and asks you to "obtain the patent" as soon as possible and at the lowest cost with a view to starting infringement proceedings in Belgium, Latvia and Malta. What actions will you take to ensure that the European patent takes effect in Belgium, Latvia and Malta? (Fee amounts need not be specified.)

6. (5 points)

Your client XYZ was granted a European patent; the language of proceedings was German. XYZ requested validation in Italy, Germany, France and the United Kingdom. During the 9 month opposition period, an opposition to the granted patent was filed, citing Article 100(a) EPC. During the opposition proceedings, a new set of claims was filed. The outcome of the opposition proceedings was that XYZ's patent was maintained in amended form. No appeal was filed by the parties. The opposition division has now issued a communication under Rule 82(2) EPC (Form 2328), setting a 3-month period for response.

1. What acts need to be performed in response to the communication under Rule 82(2) EPC?
2. What are the consequences if the acts are not performed in time? In this case, what steps shall you take to maintain the patent in amended form?
3. Let us now imagine that you have received a decision revoking the patent because the required acts were not performed in time. Is any means of redress available?
4. The patent maintained in amended form is published as EP-B2. XYZ wants to maintain patent protection via EP-B2 in Italy, Germany, France and the UK but also wants to add patent protection in Poland. Explain how this can be achieved.