Model solution for part 1

Question 1: D

Legal basis

An incorrect designation of inventor shall be rectified upon request and only with the consent of the wrongly designated person and, where such a request is filed by a third party, the consent of the applicant for or proprietor of the patent (R. 21(1) EPC).

Question 2: A

Legal basis

Representative X is a representative according to article 134.1 EPC and is already registered as representative for the European patent application EP-A, so any registration of change in representation by a new European patent attorney necessitates an authorization for representation signed by the applicant to be validly registered by the EPO.
According to rule 152(1) EPC, The President of the European Patent Office shall determine the cases in which a signed authorization shall be filed by representatives acting before the European Patent Office.
In decision of the President of the EPO of 12.07.2007 on the filing of authorizations (Special edition No. 3, OJ EPO 2007, L.1), (2) If the European Patent Office is informed of a change of representative involving professional representatives who are not members of the same association, without being notified that the previous representative's authorization has terminated, the new representative must file, together with the notification of his appointment, an individual authorization (original and one copy) or a reference to a general authorization already on file
If an authorization for representation is not provided, any acts done by the “new” representative will be deemed to never have occurred by the EPO. R 152(6)
Representative Y shall file a change in representation with form 5060 to register before the EPO as the new representative, an authorization of representation signed by the applicant for the change in representation to be valid and a response to the written opinion before the EPO before:

Time limit to respond to the negative search opinion: publication date of the EESR: 12 April 2023 + 6 months (R 70a(1) + R 70(1) EPC) = 12 October 2023 (Tuesday)

Question 3: C

Legal basis

According to Art. 122 EPC and Rule 136(1) EPC it is possible to obtain re-establishment of rights in respect of the priority period (twelve months according to Art. 87(1) EPC).

A: Rule 136(3) EPC: Further processing is available
B: Rule 136(3) EPC: Further processing is available
D: Article 122(4) EPC Re-establishment of rights shall be ruled out in respect of the time limit for requesting re-establishment of rights

Question 4: B

Legal basis

Rule 90.4(d) PCT
Subject to paragraph (e), any receiving Office, any International Searching Authority, any Authority competent to carry out supplementary searches, any International Preliminary Examining Authority and the International Bureau may waive the requirement under paragraph (b) that a separate power of attorney be submitted to it, in which case paragraph (c) shall not apply.

Question 5: D

Legal basis

Art. 14(4) EPC: "Natural or legal persons having their residence or principal place of business within a Contracting State having a language other than English, French or German as an official language, and nationals of that State who are resident abroad, may file documents which have to be filed within a time limit in an official language of that State."
Article 14(1) RFees: 30% reduction of the application fee; Rule 6 RFees
A-X, 9.2.1; A-X, 9.2.2
A-X, 9.2.1 Conditions - Guidelines for Examination (epo.org)
A-X, 9.2.2 Reduction of the filing fee - Guidelines for Examination (epo.org)
Notice from the EPO dated 10 January 2014 concerning amended Rule 6 EPC and Article 14(1) RFees (EPO - Notice from the EPO dated 10 January 2014 concerning amended Rule 6 EPC and Article 14(1) RFees)

A. Not correct (Andorra is not an EPC contracting state); Art. 14(4) EPC relates to the applicant and not to his representative)

B. Not correct (the German company is not considered as SME – R. 6(4)a, R. 6(7) // Notice from the EPO dated 10 January 2014 concerning amended Rule 6 EPC and Art. 14(1) RFEES)
C. Not correct (French is an official language of the EPO Art. 14(1) EPC)
D. Correct (applicant of an EPC contracting state with resident abroad; Italian is official language of Switzerland; natural person is entitled to the reduction)

Question 6: D

Legal basis
R36(2), R135(2) EPC

The English translation of the application documents must be filed within 2 months of filing the DA.

If the English translation is not filed: The EPO will issue a communication pursuant to Rule 58 EPC setting a time limit of further 2 months for filing the translation.

If the English translation is not filed within the time limit set by the communication pursuant Rule 58 EPC: a loss of rights communication is issued: further processing is ruled out for the missing 2-month time limit of Rule 58 EPC -> re-establishment of rights.

Question 7: C

Legal basis

Art 86 EPC, Rule 51 EPC, Art 141 EPC

Due date of the renewal fee: 30 November 2023 = after grant of the patent →renewal fee must be paid to the national offices.
Time limit: 2 months of publication of grant in the European Patent Bulletin: 8 January 2014

Question 8: B

Legal basis

Guidelines D-VI, 7.2.3

A: incorrect because of the entire description
B: correct
C: incorrect; the invitation is not issued together with the interlocutory decision, but after the interlocutory decision has become final and can no longer be appealed
D: incorrect: 3 months is correct Rule 82(2) EPC

Question 9: D

Legal basis

R 91.2 PCT: the time limit for filing a request for rectification of an obvious mistake is 26 months from the earliest priority date

Question 10: C (the most correct answer), D (also possible)

Legal basis

Art. 121(1) (2), Rule 135(1) and (3) EPC, Art. 2(1), item 12 RFees
Guidelines for Examination E-VIII, 2 (Further processing) and E-VIII, 3.1.3
E-IX, 2.3.1 (Representation, address for correspondence)

Comment:
A good paralegal will perform all acts of C, including the appointment of the representative.

However, formally/grammatically D can also be considered as a correct answer to the question, because the appointment of the professional representative can be done later (if the translation is supplied and the fees are paid, but no professional representative has been appointed, the JP applicant may be invited to appoint a professional representative under R 163(5) EPC. The procedural acts of requesting examination and filing the translation could also be considered as unsigned documents, because the JP applicant is not entitled to sign. He might receive an invitation under R 50(3) EPC to supply a missing signature, which can be fulfilled by appointing a professional representative.

Question 11: B

Legal basis

Guide for applicants: PCT procedure before the EPO (Euro-PCT Guide) – 5.4 Amending the application – Rule 161/162 communication

Guidelines for examination
GL E-IX, 2.1.1 (2.1.1 Requirements for entry into the European phase (epo.org))
E-IX, 3.3.1 (https://www.epo.org/law-practice/legal-texts/html/guidelines/e/e_ix_3_3_1.htm)

"A reply to the communication under Rule 161(1) may not be necessary … If the applicant filed amendments according to Art. 19 and/or 34 PCT in the international phase, and if the EPO prepared the WO-ISA or SISR but no IPER (either because the applicant did not demand PCT Chapter II or because the IPEA was an office other than the EPO), then these amendments are considered to constitute a response to the WO-ISA or SISR, provided that the applicant has indicated on entry into the European phase that these amendments are maintained…"

Question 12: C

Legal basis

Explanation: Applicant's Guide – MX – Annex C – Receiving Office
PCT Applicant's Guide Mexico - Valid as from 13 Apr 2023 (wipo.int)

Competent International Searching Authority:
AT, CL, EP, ES, KR, SE, SG, US

Competent International Preliminary Examining Authority:
AT, CL*, EP**, ES, KR, SE, SG*, US*
* The Office is competent only if the international search is or has been carried out by that Office.
** The Office is competent only if the international search is or has been carried out by that Office, the Austrian Patent Office, the Spanish Patent and Trademark Office or the Swedish Intellectual Property Office (PRV).

Question 13: A

Legal basis

PCT Rule 26*bis.1*(a), stating:

"The applicant may correct a priority claim or add a priority claim to the request by a notice submitted to the receiving Office or the International Bureau within a time limit of 16 months from the priority date or, where the correction or addition would cause a change in the priority date, 16 months from the priority date as so changed, whichever 16-month period expires first, provided that such a notice may be submitted until the expiration of four months from the international filing date."

Question 14: D

Legal basis

An extension must be requested before expiry of the period for responding not the case here.

Further processing is only available to applicants (and thus before grant).

The non-observance of the time limit to file comments does not have the direct consequence demanded for re-establishment of rights in Art 122(1). [see G1/90]

Therefore, only D can be correct, and the Board will exercise its discretion. The Opponent/Respondent should thus submit reasons for submitting them late.

Question 15: B

Legal basis

Guidelines, E-Vii.1.5 Concerning renewal fees falling due during the period of interruption, Rule 142(4) has to be interpreted as deferring the due date for their payment until the date the proceedings are resumed (J 902/87). Thus, such renewal fees may be paid without additional fee at the date of resumption and in the amounts applicable on that date. They may also be paid within six months of said date, provided that an additional fee is also paid within said period (Rule 51(2)).