

Part 2

Note: the legal basis was not needed to get full marks.

Question 1

- (a) X should file a demand (using Form PCT/IPEA/401) (mention of Art 34 accepted) at the EPO and specifying the EPO as IPEA.
- (b) The time limit for filing the demand is 22 months from priority (11 November 2023 (Saturday) extended to 13 November 2023 (Monday)) or 3 months from SR (11 August 2023 (Friday)).
- (c) File a reply (with amendments) to the written opinion and pay the fee for preliminary examination and the handling fee (to the EPO).

Question 2

- (a) Request early processing and perform all necessary steps in accordance with Rule 159 EPC: pay the filing fee (including two page fees (30+2+4+only 1 for abstract) and the search fee.
- (b) Request examination (or use Form 1200) and pay the fee. Pay the designation fee and the renewal fee for the third year.
- (c) Waive the right to receive a communication pursuant to Rule 161(2) and Rule 162(2) EPC.
- (d) Appoint a representative.

Question 3

- (a) (Rule 64(1)) has a deadline of 2m from the notification of the communication, therefore the 10-day rule still currently applies. 5 September 2023 + 10d = 15 September 2023 + 2m = 15 November 2023.
- (b) No action is required. If no response is filed to the R64(1) communication, the published search report will be based on the first mentioned invention (i.e., A1).
- (c) Pay two additional search fees (before the calculated deadline of 15 November 2023). A further search report will be issued covering all three inventions.
- (d) Request examination for EP-A and file a divisional application for the second invention.

- (e) A PPH request based on the US-priority application with the USPTO as OEE cannot be filed by using Form 1009 (as the US priority is still under substantive examination). EPO Form 1005 can be used to request accelerated examination (PACE).
- (f) EP-A will be taken out of the PACE programme due to the request for extension of time.

Question 4

- (a) The applicant must respond to the search opinion if required/if negative or confirm that the applicant desires to proceed further with his application in case no response to the search opinion is required (Rule 70(2); Gui C-II, 1.1), pay the examination fee, send a copy of the search results on the priority application (without waiting for a communication from the Examining Division (Gui C-II, 5)) and file a PACE request.
- (b) 6 months from publication of the search report (or application), i.e. 11 October 2023 + 6 months = Thursday 11 April 2024. The copy of the search results must be filed within two months from notification of the invitation (Rule 141(3) EPC).
- (c) Designation fee: 660 EUR.
- Extension fee Montenegro: 102 EUR (Montenegro became a contracting state on 1.10.2022, thus was not designated on 10.6.2022 (extension)).
 - Extension fee for Bosnia and Herzegovina: 102 EUR
 - Validation fee for Morocco: 240 EUR
 - Validation fee for the Republic of Moldova: 200 EUR

Fee for grant: 1040 EUR

- (d) The fee for grant must be paid within 4 months from notification of the communication under Rule 71(3). All other fees must be paid 6 months from the publication of the application: (11 Oct 2023 + 6m = Thursday 11 April 2024).

Question 5

- (a) The mention of grant will be published if you pay the fee for grant and printing, file translations of the claims (in English and in German), pay the fees for 5 claims, pay the designation fee (which falls due on publication of the search report and needs to be paid within 6 months from that publication i.e., by 19 October 2023) and pay the renewal fee for the 3rd year at the EPO (due 31 October 2023).

- (b) The following actions are needed for the patent to take effect in BE, LV and MT:
- no action is required for validation in BE
 - appoint and instruct a national professional representative to validate in LV
 - validate in MT by filing the English translation

Question 6

- (a) Paying the fee for publishing a new specification and filing a translation of sets of claims in in the official languages of the European Patent Office other than the language of the proceedings.
- (b) Within two months of a communication [(pursuant to Rule 95(3) EPC) in conjunction with Rule 82(3) EPC (Form 2386)] pointing out the failure to observe the time limit, the omitted acts must be performed and the surcharge for late performance of the acts required to maintain the European patent in amended form must be paid.
- (c) The only possibility is re-establishment of rights.
- (d) Within 3 months of the mention of the publication of the B2, a translation in Italian of the patent specification as maintained in amended form must be filed at the Italian Patent Office. No action is required in DE, FR and GB and it is no longer possible to extend protection to Poland.