

## Part 1

### **Question 1: C**

The question was which of the following statements is not correct. Statements A, B, D are correct.

Statement C is not correct because further processing can be requested later than 19 June 2023, namely within two months of a loss-of-right communication.

### **Legal basis**

#### **Rule 126(2) EPC**

Where notification is effected by registered letter, the letter shall be deemed to be delivered to the addressee on the tenth day following its handover to the postal service provider unless it has failed to reach the addressee or has reached him at a later date.

#### **Rule 135(1) EPC**

Further processing under Article 121, paragraph 1, shall be requested by payment of the prescribed fee within two months of the communication concerning either the failure to observe a time limit or a loss of rights. The omitted act shall be completed within the period for making the request.

#### **Rule 132(2) EPC**

In special cases, the period may be extended upon request, presented before the expiry of such period.

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### **Question 2: A**

### **Legal basis**

#### **Rule 30(3) EPC**

Where the applicant has not filed a sequence listing complying with the requirements under paragraph 1 at the date of filing, the European Patent Office shall invite the applicant to furnish such a sequence listing and pay the late furnishing fee. If the applicant does not furnish the required sequence listing and pay the required late furnishing fee within a period of two months after such an invitation, the application shall be refused.

#### **Decision of the President of the EPO dated 9 December 2021 on the filing of sequence listings, Article 1(1)**

If nucleotide or amino acid sequences are disclosed in a European patent application, the description must contain a sequence listing in XML format complying with WIPO Standard ST.26.

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### **Question 3: A**

### **Legal basis**

#### **Board of Appeal decision G12/91**

#### **Guidelines for Examination in the EPO, H-VI, 2.1:**

The decision-making process is terminated on the date of handing over of the decision to grant to the EPO's postal service.

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## **Question 4: C**

### **Legal basis**

**States party to the PCT and the Paris Convention and members of the World Trade Organization (wipo.int):**

Argentina is not a PCT contracting state

#### **Article 58 EPC**

A European patent application may be filed by any natural or legal person, or anybody equivalent to a legal person by virtue of the law governing it.

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## **Question 5: A**

### **Legal basis**

#### **Rule 51(1) EPC**

A renewal fee for the coming year is due on the last day of the month containing the anniversary of the date of filing, i.e. on 31 August 2022.

#### **Rule 51(2) EPC**

If a renewal fee is not paid on the due date under paragraph 1, the fee may still be paid within six months of the said date, i.e. on 28 February 2023, provided that an additional fee is also paid within that period.

#### **Rule 51(3) EPC**

Renewal fees already due for an earlier application at the date of filing a divisional application are due on its filing, i.e. on 26 September 2022. These fees and any renewal fee due within four months of filing the divisional application may be paid within that period without an additional fee, i.e. until 26 January 2023.

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## **Question 6: D**

The invitation was received ten days after the mailing date, i.e. three days later than the seven days stipulated in Rule 80.6 PCT, so the period expires three days later than two months from the mailing date, that is, on 5 February 2023, which is a Sunday. The final date for responding is therefore 6 February 2023 (Monday).

### **Legal basis**

#### **Rule 80.6 PCT**

[...] Irrespective of the date on which such a document or letter was mailed, if the applicant offers to the national Office or intergovernmental organization evidence which satisfies the national Office or intergovernmental organization that the document or letter was received more than seven days after the date it bears, the national Office or intergovernmental organization shall treat the period starting from the date of the document or letter as expiring later by an additional number of days which is equal to the number of days which the document or letter was received later than seven days after the date it bears.

**Rule 80.5(i) PCT**

If the expiration of any period during which any document or fee must reach a national Office or intergovernmental organization falls on a day [...] on which such Office or organization is not open to the public for the purposes of the transaction of official business [...] the period shall expire on the next subsequent day on which [no such circumstance] exists.

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**Question 7: B****Legal basis****Rule 54bis(a) PCT**

A demand may be made at any time prior to the expiration of whichever of the following periods expires later:

- (i) three months from the date of transmittal to the applicant of the international search report or the declaration referred to in Article 17(2)(a), and of the written opinion established under Rule 43bis.1 [i.e. 10 September 2022 (Sunday), extended to 12 September 2022]; or
- (ii) 22 months from the priority date [i.e. 17 December 2022 (Saturday), extended to 19 December 2022].

**Rule 80.5(i) PCT**

If the expiration of any period during which any document or fee must reach a national Office or intergovernmental organization falls on a day [...] on which such Office or organization is not open to the public for the purposes of the transaction of official business[, the time limit is extended to next open day].

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**Question 8: B****Legal basis****Rule 90.4(b) PCT**

[A] separate power of attorney shall be submitted to either the receiving Office or the International Bureau, provided that, where a power of attorney appoints an agent under Rule 90.1(b), (b-bis), (c) or (d)(ii), it shall be submitted to the International Searching Authority, the Authority specified for supplementary search or the International Preliminary Examining Authority, as the case may be.

**Rule 90.4(d) PCT**

[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 [...].

**Rule 90.4(e) PCT**

Where the agent or the common representative submits any notice of withdrawal [...], the requirement under paragraph (b) for a separate power of attorney shall not be waived under paragraph (d).

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**Question 9: C**

The designation of inventor is not listed in Rule 159(1) EPC.

**Legal basis**

### **Rule 159(1) EPC**

In respect of an international application under Article 153, the applicant shall perform the following acts within thirty-one months from the date of filing of the application or, if priority has been claimed, from the priority date:

- (a) supply, where applicable, the translation of the international application required under Article 153, paragraph 4;
  - (b) specify the application documents, as originally filed or as amended, on which the European grant procedure is to be based;
  - (c) pay the filing fee provided for in Article 78, paragraph 2;
  - (d) pay the designation fee if the period under Rule 39 has expired earlier;
  - (e) pay the search fee, where a supplementary European search report has to be drawn up;
  - (f) file the request for examination provided for in Article 94, if the period under Rule 70, paragraph 1, has expired earlier;
  - (g) pay the renewal fee in respect of the third year provided for in Article 86, paragraph 1, if the fee has fallen due earlier under Rule 51, paragraph 1;
  - (h) file, where applicable, the certificate of exhibition referred to in Article 55, paragraph 2, and Rule 25.
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### **Question 10: D**

#### **Legal basis**

#### **G 4/08 of the Enlarged Board of Appeal**

If an international patent application has been filed and published under the PCT in an official language of the EPO, it is not possible, on entry into the European phase, to file a translation of the application into another EPO official language.

**Article 14(1) EPC, Article 14(3) EPC** (language of proceedings)

**Rule 36(2) EPC:** A divisional application shall be filed in the language of the proceedings of the earlier application.

**Euro-PCT Guide, Chapter 5, points 5.1.013 and 5.1.014**

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### **Question 11: C**

#### **Legal basis**

#### **PCT contracting states for which a regional patent can be obtained via the PCT (wipo.int):**

A national patent can be obtained for Italy in respect of international applications filed on or after 1 July 2020. Only a European patent can be obtained for France and Lithuania.

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### **Question 12: A**

#### **Legal basis**

**Notice from the EPO dated 21 February 2013 concerning the request for early processing, OJ EPO 3/2013, 156 ff**

It depends on the date on which early processing is requested which further requirements stipulated in Rule 159(1) EPC must be complied with, since the (regular) time limits for paying the designation fee (Rule 39(1) EPC) and the renewal fee (Rule 51(1) EPC) and for filing the request for examination and paying the examination fee (Rule 70(1) EPC) may not have expired on the date the request for early processing is filed. Therefore, if any of these time limits is still running on that date, the request will be effective without the requirements concerned having been complied with (Article 153(2) EPC, Article 11(3) PCT).

Claims fees can be paid up to expiry of the period under Rule 162(2) EPC.

In the present case, the (regular) time limits for paying the designation, examination and renewal fees are still running.

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### **Question 13: D**

#### **Legal basis**

##### **Guidelines for Examination in the EPO, E-VIII, 8.1, A-IV, 1.1.1**

Applicants may withdraw their application at any time as long as the application is pending.

An application is pending up to (but not including) the date that the European Patent Bulletin mentions the grant of the patent (OJ EPO 2002, 112).

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### **Question 14: B**

#### **Legal basis**

##### **Guidelines for Examination in the EPO, H-VI, 6, C-V, 10**

Errors in publication occur where the content of the printed specification differs from the documents (Druckexemplar) transmitted to the applicant with the communication under Rule 71(3) (Form 2004), if these documents form the basis of the decision to grant. The above errors in publication can be corrected at any time.

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### **Question 15: B**

Statement A is not correct because Rule 56 does not apply to missing claims (the application was filed in 2021, i.e. before the entry into force of the new Rule 56a EPC).

Statement B is correct (Rule 56(3) EPC).

Statement C is not correct because it is not possible to amend the claims before search (Rule 137(1) EPC).

Statement D is not a good solution because the date of a priority claim would precede the date of filing of the European patent application by more than twelve months.

#### **Legal basis**

**Rule 56(1) EPC**

If the examination under Article 90, paragraph 1, reveals that parts of the description, or drawings referred to in the description or in the claims, appear to be missing, the European Patent Office shall invite the applicant to file the missing parts within two months.

**Rule 56(3) EPC**

If the missing parts of the description or missing drawings are filed [...] and the application claims priority of an earlier application, the date of filing shall, provided that the missing parts of the description or the missing drawings are completely contained in the earlier application, remain the date on which the requirements laid down in Rule 40, paragraph 1, were fulfilled, where the applicant so requests and files, [...].

**Rule 137(1) EPC**

Before receiving the European search report, the applicant may not amend the description, claims or drawings of a European patent application unless otherwise provided.

## Part 2

Note: the legal basis and the information in parenthesis were not needed to get full marks.

### **Question 1**

- (a) The application EP-F3 to be transferred has to be pending at the time of transfer (see steps under (b)).  
File a request for a transfer of rights (EPO Form 5050 can be used) and submit written evidence suitable for proving the transfer (with the signature of both the assignor and assignee). Pay the transfer fee.
- (b) The filing in Italian is valid only if the previous applications were also filed in Italian.  
Request further processing by paying the fee for further processing (50% of the relevant fees) by 14 December 2022 and pay the search fee, filing fee (without reduction) according to Rule 6(4) EPC including page fee (for eight pages) and additional fee for divisional second generation.
- (c) After the transfer of rights (at the latest by the time of payment of the reduced examination fee) the representative of the joint applicants should send a letter to the EPO stating that both applicants A and C are entities or natural persons covered by Rule 6(4) EPC (Form 1011 can be used).  
Request examination in Italian, a translation of the request for examination in the language of the proceedings must be refiled (Guidelines A-X, 9.2.3).

### **Question 2**

- (a) The request for restoration had to be filed within two months of the date on which the priority period expired, which is 26 July 2021.  
(The priority period expired on 22 May 2021 extended to 24 May 2021.  
24 May 2021 + 2 months => 24 July 2021, extended to 26 July 2021).
- (b) (The restoration granted by the USPTO as receiving Office will not automatically be effective before the EPO because the EPO is not bound by the decision of any receiving Office under the "unintentional criterion".)  
To ensure that priority is restored during the European phase, the applicant should request restoration of priority within one month of the date on which the time limit for entry into EPO regional phase expires (Article 22 PCT)  
(Rule 49ter.2(b)(i) PCT; Rule 159(1)) EPC sets a 31-month deadline  
22.05.2020 + 31 months = 22.12.2022  
22.12.2022 + 1 month = 22.01.2023 (Sunday) extended to 23.01.2023 (Monday).

The fee for restoration of priority must be paid within the same time limit (Rule 49ter.2(b)(iii), (d) PCT).

The request for restoration of priority must be accompanied by a statement of reasons for the failure, despite meeting the due-care requirement, to file the international application within the priority period (Rule 49ter.2(b)(ii) PCT).

### **Question 3**

- (a) Confirm to the receiving Office (International Bureau) that the drawings of the priority application are included in the international patent application through incorporation by reference (Rule 20(6) PCT).

Send a copy of these drawings to the receiving Office (International Bureau) together with the confirmation.

Within two months of the original filing date

5 December 2022 + 2 months => 5 February 2023 (Sunday) => extended to 6 February.

- (b) Same as (a) / (Confirm to the International Bureau that the drawings of the priority application are included in the international patent application through incorporation by reference, send a copy of these drawings to the International Bureau together with the confirmation).

RO/107 notification bears a two-month time limit,

4 January 2023 + 2 months => 4 March 2023 (Saturday) => extended to 6 March 2023

- (c) The requirement for incorporation by reference is that the priority of the earlier application must also have been claimed on filing (Rule 20(6) PCT).

Thus, no remedy is possible in this case.

- (d) Yes, you can withdraw the application and prevent publication before completion of technical preparations for the publication.

Publication is due promptly after the expiration of 18 months from the priority date, which is after 20 June 2023 (in practice Thursday, 22 June).

The technical preparations for publication are completed by the 15th day prior to the date of publication (see paragraph AG 9.014; in practice, withdrawal at the latest on Tuesday, 6 June).

### **Question 4**

- (a) The filing fee and the search fee shall be paid within one month of filing, i.e. by 12 January 2023, (Article 78(2) EPC and Rule 38(1) EPC).

The filing fee includes the additional fee for two pages (36 pages plus one page of abstract (even if abstract is two pages) minus 35 pages = 2 pages, Rule 38(2), (3) EPC, Article 2(1), item 1a, RFees and Guidelines A-III, 13.2).

- (b) The payment is deemed to have been made on the date on which the account was duly replenished (point 8 AAD).

Since this is after the due date for paying the fees, the application is deemed to be withdrawn (Article 78(2) EPC).

No action is required as long as there are sufficient funds in the deposit account (the EPO will automatically debit the further processing fee, the search fee and the filing fee (which includes the page fee)).

- (c) A translation must be filed within two months of the filing of the application  
12 Dec 2022 + 2 months = 12 Feb 2023 (Sun) = 13 Feb 2023;  
or within two months of notification of a communication under Rule 58 EPC.

If documents to be filed by one of the means of electronic communication permitted by the President of the European Patent Office (under Rule 2(1) EPC) cannot be received on the day on which a period for performing procedural acts expires, the period shall extend to the first working day on which all means of electronic filing are available (Rule 134(1) EPC and OJ EPO 2020, A120).

## **Question 5**

A divisional application can only be filed if the parent application is still pending. Currently, EP-A1 is deemed to be withdrawn because no response to the communication under Article 94(3) EPC was filed. The time limit for filing a response expired on 28 November 2022 (26 Saturday > Monday 28).

In order to revert application EP-A1 to pending status, the applicant must request further processing by paying the further processing fee and file a response to the communication under Article 94(3) EPC.

The filing fee and search fee for EP-A2 are due on filing. They may be paid within one month of the date of filing of the divisional application (Rule 36(3) EPC).

The third renewal fee and the fourth renewal fee for the divisional become due on filing. They can be validly paid without surcharge within four months of the date of filing of the divisional application (Rule 51(3) EPC) (otherwise with surcharge within six months of the same date).

The applicant should file claims directed to invention Y (Rule 40(1) EPC) in response to a communication from the EPO (under Rule 58 EPC setting a time limit of two months from the date of receipt to supply claims) at the latest.