

1. (6 points)

On 12 August 2022, a divisional European patent application EP-F3 is filed in Italian per fax by three joint applicants: A, B and C. On 12 September 2022, a translation of EP-F3 in the language of the proceedings of its parent application is filed.

EP-F3's parent application is EP-F2, which is a divisional application of EP-F1.

EP-F3 comprises 1 page abstract, 40 pages description and 2 pages with 13 claims.

A is an Italian university.

B is an Italian enterprise which employs 500 persons, and which has an annual turnover of EUR 40 million and an annual balance sheet total of EUR 40 million.

C is an Italian national resident in the USA.

On 4 October 2022, a noting of loss of rights is sent because no fees have been paid.

A transfer of rights is planned for 19 December 2022: Applicant B will transfer its rights in respect of EP-F3 to applicant C.

- a. What procedural steps must be taken for the transfer of rights to be recorded?
- b. Under what circumstances is the filing in Italian valid? What steps need to be taken and what fees need to be paid to ensure that EP-F3 remains pending?
- c. What needs to be done if the applicants want to pay the examination fee at the reduced rate provided for in Article 14(1) of the Rules relating to Fees?

2. (5 points)

On 22 May 2020, applicant B filed US application US-B in English. Despite all due care being taken by applicant B, international application PCT-B claiming priority from US-B was only filed on 7 June 2021. The USPTO, acting as receiving Office, granted the applicant's request for restoration of the right of priority on the basis that the failure to file PCT-B within the priority period was unintentional.

On 9 December 2022, applicant B took all the steps required under Rule 159 EPC for PCT-B to enter the European phase before the EPO.

When did the time limit for filing the request for restoration of the right of priority at the USPTO acting as receiving Office expire?

What must be done before the EPO as designated Office, and by when, to ensure that the restoration of the right of priority is effective in the European phase?

3. (7 points)

Your client CoffeeBreak filed a European patent application claiming a new type of coffee maker on 20 December 2021 but withdrew it before search. CoffeeBreak then asked you to file an international patent application claiming priority of the European patent application and with no amendments compared to that application. The priority application contains drawings that are essential for understanding the invention.

On 5 December 2022, you filed an international patent application claiming priority of the European patent application at the International Bureau, using PCT/RO/101. Your colleague handling a patent application for shoe soles left by mistake his drawings in your filing folder. Therefore, you filed the wrong drawings with the international patent application claiming the coffee maker instead of the correct drawings.

- a. You discover your mistake today, 12 December 2022. Assuming that the International Bureau does not detect the wrong drawings, what actions can you take of your own volition to ensure that the correct drawings are included in the international patent application while maintaining the original filing date? What is the applicable time limit for performing these actions? Please give reasons for your answer.
- b. You do not discover your mistake until receiving a PCT/RO/107 notification dated 4 January 2023 from the International Bureau. What actions can you take to ensure that the correct drawings are included in the international patent application while maintaining the original filing date? What is the applicable time limit for performing these actions? Please give reasons for your answer.
- c. What would be your answer to previous questions (a) and (b) if, at your client's request, you had not claimed priority of the European patent application? Please give reasons for your answer.

You do not discover your mistake on filing the wrong drawings, and completely miss the notification dated 4 January 2023 from the International Bureau. You only find out about the mistake on 27 April 2023 after receiving the written opinion. The invention has not been and will not be made public by any means other than publication by the International Bureau. You intend to withdraw the international patent application before publication and file a new international patent application with the correct drawings.

- d. Will you still be in time to prevent publication of the first international patent application? Please give reasons for your answer.

4. (6 points)

On 10 December 2021, your client, a large Romanian company, filed a Romanian national patent application RO-H. RO-H is drafted in Romanian and comprises 32 pages of description and drawings, and four pages with 15 claims. Your client has informed you that they will prepare and forward an English translation of RO-H in due course. This will comprise 29 pages of description and drawings, four pages with 15 claims and an abstract comprising two pages. Your client wants you to file today, 12 December 2022, a European patent application EP-H drafted in Romanian and claiming priority of RO-H.

- a. What fees have to be paid and what would be the last date for paying them?
- b. You filed an automatic debit order for EP-H. On the decisive payment date, you receive an email from the EPO informing you that there are insufficient funds in your deposit account to cover any of the fees to be paid (as identified in your answer to question (a)). You replenish the account two days after receiving the email. Do you have to take any further action to ensure these fees are paid?
- c. What is the time limit for filing an English translation of the application via the EPO's online services? What is the consequence for the time limit if, on the last day of the period for filing the translation, there is an unplanned outage of the EPO's online services which prevents you from filing it? The outage lasts for the whole of that day.

5. (6 points)

Applicant A filed European patent application EP-A1 in English in May 2019. It describes two different inventions, X and Y, and claims invention X only. The European search report was drawn up for invention X only.

A communication pursuant to Article 94(3) EPC setting a time limit of four months for response was issued by the EPO on 16 May 2022. A two-month extension of this time limit was granted on 26 September 2022. As of today's date, no response has been filed.

Applicant A is now interested in invention Y.

Today, 12 December 2022, he files a European divisional application EP-A2 based on EP-A1 and describing invention Y. No fees were paid, and no claims were submitted at the time of filing.

What does applicant A have to do to have invention Y searched by the EPO?