

Answers Examination 2015

Question 1: C

The extended period of 6 months counts from original Communication. Date of receipt 26 February 2015 is not relevant. Date 24 February 2015 is relevant. The 10 days have to be added at the beginning. Thus one arrives with 10 days and 6 months at 6 September 2015, which is a Sunday. Monday 7 September 2015 is the correct answer.

Question 2: C

You can request restoration at the receiving Office within 2m of expiry of the priority period (R.26bis.3(c)), i.e. 14 months after the priority date, which is 7 July 2015. (So, the request must be filed 14 months after the priority date, not to be confused with 16 m period for adding priority claim when the application is filed in time.) At the EPO restoration can only be requested based on all due care, not intent (AG-IP Ann. C for rOs).

Question 3: D

You have 12 months to claim priority. The priority application NL1 was filed on 23 May 2014. The ultimate date to file patent application NL2 is 23 May 2015, but this is a Saturday. Monday 25 May 2015 is Whit Monday so the ultimate date for filing patent application NL2 is Tuesday 26 May 2015. The right to priority can be claimed upon filing or within 16 months after the date of filing of the priority application. Priority application NL1 was filed on 23 May 2014, 16 months after 23 May 2014 is 23 September 2015. (Art. 9.1 and 9.6 ROW 1995)

Question 4: D

The trademark can also be a 3D mark or a sound mark.

OHIM News website 18 November 2014: Starting on 24 November, OHIM will offer trade mark applicants the opportunity to have their applications examined and published faster. This accelerated procedure is known as Fast Track and will be available free of charge to applicants who comply with certain conditions, such as paying upfront and selecting their goods and services from OHIM's database of accepted terms

Fast Track conditions:

The applicant must be domiciled in the European Union (EU). Failing this, the applicant must identify a valid representative.

All the terms in the list of goods and services must be selected from the database of terms already accepted by OHIM.

There should be no mark description.

The trade mark must be one of the following types: word mark / figurative / 3D / sound.

Question 5: B

The invitation is a Rule 59 invitation. Missing the time limit set by this invitation results into loss of the right of priority, see Art. 90(5). Further processing is ruled out in the period of Rule 59, see Rule 135(2). The only available remedy is re-establishment of rights, provided all due care, etc., can be proven.

Question 6: C

Reduction is applicable, both for a Dutch national (even when resident abroad), and for a university if the request for examination is filed in Dutch (admissible non-EPO language) (GL AX 9.2.3). As the PCT application has entered the EP regional phase after 1 April 2014 (International filing date not relevant), reduction of 30% applies (instead of 20% before that date), R6(3)+Rfees 14(1). Entire application in English is not relevant for entitlement to the reduction on the examination fee.

Additionally where the EPO has drawn up the IPER in respect of the IA, the examination fee is further reduced by 50% if the EPO is the designated Office (elected Office), Rfees 14(2).

If both reductions 30% and 50% are used, the total reduction is 65% (GL A-X, 9.3.2. The examination fee is first reduced by 50%, then by a further 30%, i.e. the total reduction is 65 % of the full fee.

Question 7: C

If upon filing a Request for Novelty Search, a Search Report on a corresponding patent application previously made by the Netherlands Patent Office or the European Patent Office is submitted there is no need to pay the Search Fee (Article 6.5 UB ROW 1995).

If however the request for a "gratis" Novelty Search is rejected, the Netherlands Patent Office will send you a decision requesting you to pay the Search Fee. The term for paying the Search Fee is 13 months from the earliest priority date or 6 weeks from the date of the decision, whichever is later.

The priority date is 27 May 2014 + 13 months + 27 June 2015, which is a Saturday.

So the 13 m time limit is 29 June 2015. 6 weeks from 20 May 2015 is 1 July 2015 which is later than 29 June 2015 so the correct answer is answer c.

Question 8: C

Competency ISA and IPEA with Mexican Institute of Industrial Property as receiving Office

When the International patent application is filed with the Mexican Institute of Industrial Property competent ISAs are e.g. the USPTO, the EPO and the Spanish Patent and Trademark Office and competent IPEAs are e.g. the European Patent Office and the Swedish Patent and Registration Office (PCT Applicant's guide, International Phase, Annex C (MX)) → all statements correct

Language requirements

Required translations of the International patent application for ISA and IPEA: USPTO: English; EPO: English, French or German; Spanish Patent and Trademark Office: Spanish, Swedish Patent and Registration Office: Danish, English, Finnish, French, Norwegian and Swedish (PCT rule 12.3 and rule 552(b), PCT Applicant's Guide, Annex D (US, EP, ES), Annex E (EP, SE) → I-III correct, IV wrong (Use Spanish for ISA).

Other requirements

According to PCT Applicant's guide, Annex E (EP) note 1 the EPO is not competent as IPEA if the international search is or has been performed by the USPTO → Statement I is wrong.

Question 9: B

Renewal is due 5 years after the filing date, but can be effected until the last day of the month in which the 5 year period ends. As 28 February 2015 was a Saturday, the last day for renewal of the RCD was Monday 2 March 2015 (Art. 21 CDR and Art. 12 and 13 CDR).

Question 10: C

Answers a and d are wrong as the applications are not filed at the Chinese patent Office (SIPO), which is mandatory as several inventors are Chinese nationals, unless a request for secrecy examination has been requested at the SIPO (which is not the case as implied by the fact that here has been no interaction with the a patent office). Answer b is wrong as the SIPO does not accept a national Chinese filing in the English language.

According to Article 20 of the Chinese Patent Law, where any entity or individual intends to file an application in a foreign country for a patent for the invention or utility model made in China, it or he shall first request a secrecy examination by the Chinese patent office (SIPO). According to Rule 8 of the Implementing Regulations, the applicant may file a request for secrecy examination through the following manners:

(1) filing with the SIPO a request for secrecy examination and describe in detail the technical solution.

Note that this is not possible anymore as the patent application has to be filed today

(2) filing with the SIPO a patent application and submitting upon or after the filing a request for secrecy examination. Note that SIPO only accepts Chinese applications in the Chinese language: under Rule 3 of the Implementing Regulations of the Chinese Patent Law, any document submitted with the State Intellectual Property Office (SIPO) shall be in Chinese.

(3) filing with the SIPO as receiving Office a PCT application. It is allowed to file in English. PCT Applicant's Guide, Annex C (CN).

Question 11: C

The Spanish national is not resident in an EPO Contracting State. Morocco is only a "validation" state with effect from 1 March 2015 (OJEPO 2015, A20). Then, according to Art 133(2) he shall be represented

in all proceedings other than filing a European patent application. However, payments can be made by any person (GL A-X, 1).

Question 12: D

Amendments under Art.19 need to be filed 16 months from the earliest priority date or 2 months from the transmittal date of the International Search report, whichever is later (R. 46.1). Earliest priority date + 16 months = 5 October 2014 (Sunday) so 6 October 2014. 2 months from the date of transmittal of the international search report: 3 February + 2 months = 3 April 2015. 3 April = Good Friday: **7 April 2015**, which is later. 2 September is 16 months after the filing date (not the priority date) and therefore wrong.

Note: as the publication has already taken place in December 2014 (18 months from earliest priority date 5 June 2013) the following wording in R. 46.1 is not relevant: provided that any amendment made under Article 19 which is received by the International Bureau after the expiration of the applicable time limit shall be considered to have been received by that Bureau on the last day of that time limit if it reaches it before the technical preparations for international publication have been completed.

Question 13: D

Extension of the cooling-off period at joint request is four months (Rule 9.1 Opposition guidelines from the Benelux Office for Intellectual Property and 1.26 paragraph 3 Implementing Regulations¹ under the Benelux Convention on Intellectual Property (trademarks and designs))

Usually the language of the application is leading. An exception to this rule is when the application has been filed in English. In that case the opponent may choose between the English, Dutch or French language.

Rule 7 Opposition guidelines from the Benelux Office for Intellectual Property and rule 1.20 paragraph 1 sub b Implementing Regulations under the Benelux Convention on Intellectual Property (trademarks and designs).

Question 14: B

Third Party Observations may be submitted at any time after the date of publication of the International application (thus after 11.09.2014) and before the expiration of 28 months from the priority date (8.07.2015) (Administrative Instructions under the Patent Cooperation Treaty, section 802 (a) (ii)). So I is correct.

Third Party Observations must be submitted to the International Bureau through the third party observation system as provided in Section 801. Administrative Instructions under the Patent Cooperation Treaty, section 802 (a) (i). So II is not correct.

Question 15: D

Rule 21(1) EPC says that you only need the consent of the wrongly designated person. Neither Mrs. Right, nor Mr. Right is a wrongly designated inventor. Only Mr. Wrong is.

Question 16: A

A granted patent shall remain in force, barring earlier lapse, waiver or invalidation by the court, until the expiry of a term of 20 years from the date of filing date (Art. 36(6) ROW).

A supplementary protection certificate can provide an extra 5 years of protection after the patent has expired. (Art. 90 ROW).

Question 17: A

The fee for further processing in the event of late payment of a fee is 50% of the relevant fee, in the event of late performance of the acts required under Rule 71 paragraph 3, 250 euro and in all other cases 250 euro. The fee for grant is 915 euro + 250 euro is 1165 euro. Art. 2.12 915 + 250 euro.

Answer b is not correct (915 euro+ 457,50 (50%) of 915 euro), Answer c is not correct (915 + 457,50 euro + 250 euro) and answer d is not correct (915 euro + 250 + 250 euro).

Question 18: B

31 months after the intended priority date, even when the priority is not validly claimed. R. 26bis.2(c) (iii): the priority date is considered valid for the purpose of international search, calculation of time limit for Entry National/Regional Phase.

Question 19: C

Seniority does not need to be claimed within 6 months after filing the application for the Community trademark registration (priority needs to be claimed within 6 months). Seniority can be claimed at any time. The requirement, with regard to timing, is that the mark registered in the new Member State must be 'earlier' than the CTM. Article 33, 34 and 35 of the Community Trade Mark Regulation 207/2009.

Triple identity rule – The owners and trademarks should be identical. The description of goods and services in the earlier national trademark registration(s) should be identical to or contained within the Community trademark registration. Article 34 and 35 of the Community Trade Mark Regulation 207/2009.

Article 34: The proprietor of an earlier trade mark registered in a Member State, including a trade mark registered in the Benelux countries, or registered under international arrangements having effect in a Member State, who applies for an identical trade mark for registration as a Community trade mark for goods or services which are identical with or contained within those for which the earlier trade mark has been registered, may claim for the Community trade mark the seniority of the earlier trade mark in

respect of the Member State in or for which it is registered.

Question 20: B

Rule 80.6 PCT: Where a period starts on the day of the date of a document or letter emanating from a national Office or intergovernmental organization, any interested party may prove that the said document or letter was mailed on a day later than the date it bears, in which case the date of actual mailing shall, for the purposes of computing the period, be considered to be the date on which the period starts. 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.

Dispatch date + 2m = 2 June 2015 (answer a). However invitation not received within 7 days but within 11 days. 4 days delay, which can be added to this date: 6 June 2015. This is a Saturday so the last day to respond is 8 June 2015 (answer b). Answer c is wrong as this date is based on EPO 10-d rule. Answer d is wrong as this date is calculated 2 months from actual receipt date: 13 June = Saturday – 15 June.

Case 1A

European patent EP1	Need to file translation of granted French description? YES or NO	Need to file translation of granted French claims? YES or NO
DE (Germany)	NO	NO
LV (Latvia)	NO	YES
ME (Montenegro)	NO	YES
NL (Netherlands)	YES	YES

Case 1B

European patent EP2	Need to file translation of amended English description? YES or NO	Need to file translation of amended English claims? YES or NO
DE (Germany)	YES	YES
ES (Spain)	YES	YES
FR (France)	NO	NO
NL (Netherlands)	NO	YES

All answers can be found in National Law related to the EPC, Table IV.

Case 2

DESIGN RIGHT

Article 3.1 Benelux Convention on Intellectual Property

The appearance of the whole or a part of a product shall be regarded as a design.

The appearance of a product shall be imparted, in particular, through the features of the lines, contours, colours, shape, texture and/or materials of the product itself and/or its ornamentation.

A product shall mean any industrial or handicraft item, including inter alia parts intended to be assembled into a complex product, packaging, get-up, graphic symbols and typographic typefaces.

Computer programs shall not be regarded as a product.

Examples:

- Outer shape of the packaging;
- Figurative elements on the packaging (such as the bear device, the shield, the Nutrilon logo);
- The designed shape of the spoon and/or the holder of the spoon (as far as the shape is not merely technically determined).

TRADEMARK RIGHT

Article 2.1 Benelux Convention on Intellectual Property

Signs that may constitute a Benelux trademark

The names, drawings, imprints, stamps, letters, numerals, shapes of goods or packaging and all other signs that can be represented graphically and that serve to distinguish the goods or services of an undertaking shall be considered as being individual trademarks.

However, signs consisting solely of a shape which results from the nature of the goods, which gives a substantial value to the goods or which is necessary to obtain a technical result cannot be considered as

being trademarks.

Without prejudice to the provisions of ordinary law, a patronymic name may serve as a trademark.

Examples:

- PRONUTRA+;
- NUTRILON;
- NUTRICIA;
- Bear device;
- Shield device;
- Word/device mark NUTRILON NUTRICIA;
- Shape of the packaging;
- Whole package label (NL: etiket);
- Picture of the whole packaging (shape + label).

COPYRIGHT

Article 1 Copyright Act 1912

Copyright is the exclusive right of the author of a literary, scientific or artistic work or his successors in title to communicate that work to the public and to reproduce it. Subject to the limitations laid down by law.

Examples:

- Shape of the packaging;
- Figurative elements on the packaging;
- Shape of the spoon or the holder;
- Bear device;
- Shield device;
- Word/device mark NUTRILON NUTRICIA;
- Package label;
- User manual.

PATENT RIGHT

Article 2 Dutch Patent Act 1995

Inventions that are new, that involve an inventive step and that are susceptible of industrial application shall be patentable.

Example:

- Click method/technique for spoon in lid.

Case 3

Question 1

No

Art. 9 (1) PCT: Any resident or national of a Contracting State may file an international application. Where there are two or more applicants (for the same or different elected States) at least one of them must qualify.

The TW subsidiary is not national/resident of a PCT contracting state (PCT Applicant's Guide - International Phase – Annex A).

Possible solutions:

add a legal entity under the laws of a PCT contracting state (e.g. Happycook B.V.) as an applicant to the International patent application (i.e. file in both names).

(partially) transfer the right to claim priority to a legal entity under the laws of a PCT contracting state (e.g. Happycook B.V.) and file the International patent application in the name of this entity.

transfer the EP application to a legal entity under the laws of a PCT contracting state (e.g. Happycook B.V.) and file the International Application in the name of this entity.

Question 2

No

TW is not a PCT contracting state (PCT Applicant's Guide - International Phase – Annex A). Solution is to file national patent application in TW within the priority year, claiming priority of the European patent application.

Question 3

PCT Direct procedure (OJEPO A89, p 1-3).

Question 4

The European Patent Office both as rO and ISA.

The EPO in its capacity as receiving Office and International Searching authority (OJEPO, A89, 1) as PCT Direct is a service offered by the EPO only.

Question 5

10 November 2015.

26bis.1 (a) 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. The correction of a priority claim may include the addition of any indication referred to in Rule 4.10.

16 months from 10 July 2014 (earlier of 2 priority dates) = 10 November 2015

4 months from 3 June 2015 = 3 October 2015 = Saturday → 5 October 2015.

10 November 2015 as it is later than 5 October 2015.

Question 6

8 August 2016.

Rule 54bis.1(a): 22 months from priority date or 3 months from the date of transmittal to the applicant of the international search report and of the written opinion established under R. 43bis.1, whichever period expires later. 7 October 2014 + 22 m = 7 August 2016 = Sunday so 8 August 2016. 3m after receipt of the International Search report = 1 September + 3 m is 1 December 2015, which is earlier.

Question 7

The EPO only (PCT Applicants' Guide, Annex C, EP).

Question 8

No, entry into the national/regional phase is possible at any time after filing the PCT application.

The applicable time limit for performing the acts for entry into the national/regional phase is 30-31 months from the filing date or, if priority has been claimed, the priority date. Therefore the national/regional offices will not commence processing an international application before the 30-31 month time limit has expired. An exception applies if the applicant lifts the processing ban earlier. This requires that a request for early processing under Articles 23(2) or 40(2) PCT is filed with the designated/elected Office and that the requirements for the request to be effective are complied with.

Question 9

Make a specific request to start early (Art. 23(2)/40(2)).

Comply with all national requirements (perform all acts for national/regional entry).

Arrange documents to be sent to national offices (only if very early, not likely here that IB had not yet done so, and publication already done).

Question 10

30 June 2017.

R. 51(1) EPC: the renewal fee for the 3rd year is due on the latest date of either the 31m deadline for regional entry or the end of the month of 2 years from the filing date.

31m deadline: 7 October 2014 + 31 m = 7 May 2017 (is Sunday: 8 May 2017)

2y from filing: 3 June 2015 → 30 June 2017 (= Friday).

Case 4

Question 1

5 January 2015.

Priority can be claimed at the time of filing, or for a short period thereafter. Priority can be claimed 6 months from the priority date of 1 July 2014, i.e. Thursday 1 January 2015. However since this is non-working day, the term will be extended automatically to the next working day, Monday 5 January 2015. (Article 2.6 BVIE)

Question 2

18 June 2015.

BOIP will send you an invitation to file the Priority Document within one month of the date of the invitation. This term can on request be extended to a maximum of 6 months. (Article 2.6 BVIE, Rule 1.4 UR)

Question 3

See application form.

Question 4

No, it is not possible to add an additional class after filing an application.

You should withdraw the application filed on 8 December 2014 and file a new application before 5 January 2015 including all classes.

Question 5

22 July 2015.

As of 1 October 2013 the time limit to file an opposition against a Benelux trademark application is two months counted from the publication date. (Art. 2.14 BVIE). 21 July 2015 is National Day of Belgium on which the Office is deemed to be closed in connection with determining compliance with terms and deadlines so the correct answer is 22 July 2015.

Attention: The costs for a trademark application on paper are 15% higher than an online application

Space reserved for the Benelux Office for Intellectual Property

<i>Number</i>	<i>Depotdatum</i>	<i>Vervaldatum</i>
•	•	•

P.O. Box 90404	T + 31 70 349 11 11
NL-2509 LK The Hague	F + 31 70 347 57 08
The Netherlands	www.boip.int

1 Your references

Reference

- **12345 BX**

Contact

•

Telephone

•

E-mail

•

2 Bank details (see the explanatory notes)

Bank account number

•

In the name of

•

IBAN code

•

IBAN code

•

3 Applicant

Surname and first name, or name of organisation and legal form

- **Innovations GmbH**

Address

- **Bahnhofstrasse**

House number

- **4**

Postal code

- **41460**

City

- **Neuss**

Country

- **Germany**

P.O. Box (optional, see the explanatory notes)

•

Postal code

•

City

•

Country

•

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4 Representative

Name

- **Octroibureau IP4 YOU**

Address

- **Vincent van Goghlaan**

House number

- **4**

Postal code

- **2508 ZH**

City

- **The Hague**

Country

- **The Netherlands**

P.O. Box (*optional, see the explanatory notes*)

•

Postal code

•

City

•

Country

•

5 Correspondence address (*Only for applicants outside the EU without representative*)

Name

•

Address

•

House number

•

Postal code

•

City

•

Country

•

6 Accelerated registration

Yes

No

7 Individual or collective mark

Individual

Collective

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P.O. Box 90404

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8 Type of trademark

- Word mark
- Combination of word mark and figurative mark
- Figurative mark

9 Other trademarks (optional, see the explanatory notes)

- Shape mark
- Colour mark
- Sound mark
- Other:

10 Colour(s) (optional, see the explanatory notes)

.

11 Description of distinctive features (optional, see the explanatory notes)

.

12 Right of priority based on earlier application (see the explanatory notes)

Country

- **Germany**

Under number

- **30 2014 007725.0**

In the name of

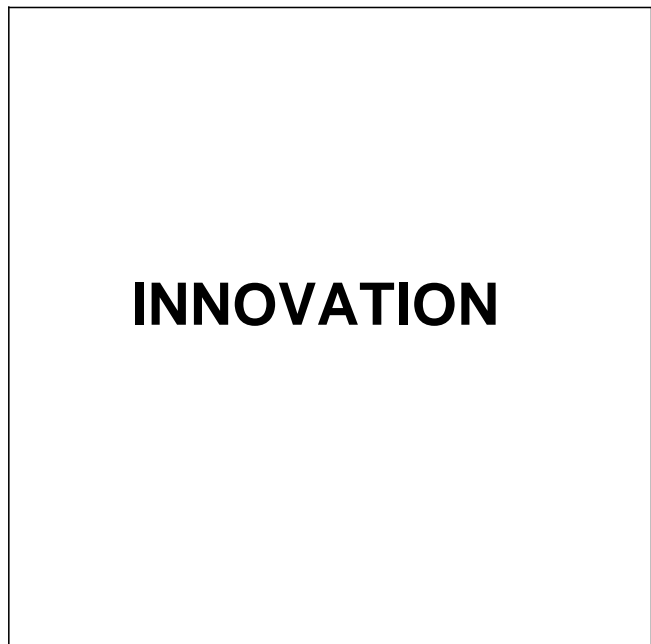
- **Innovations GmbH**

Date

- **1 July 2014**

13 Representation of the trademark

In case of a word mark, please indicate it in the appropriate box. In case of a figurative mark, please add the logo to the appropriate box.



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The Netherlands

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14 List of goods and/or services (see the explanatory notes)

Class number(s)

Description

29**Vlees, vis, gevogelte en wild****30****Koffie, thee, cacao en suiker****32****Bieren****33****Alcoholische dranken
(uitgezonderd bieren)**

I have an earlier application or registration and would like to use the same class numbers and wording:

Application number:

Registration number:

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The Netherlands

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www.boip.int**15 Fees****Application****Amount**

Basic fee for individual trademark

276

Basic fee for collective trademark

Supplementary fee for each class after the third

42

Supplementary fee for description of distinctive features

Accelerated registration

Supplementary fee for each class after the third

Total

318

16 Payment (see the explanatory notes)

I will pay in accordance to the statement of the fees due stating the payment reference.

(Please note: even if you did not receive a statement of the fees due, you have to ensure that the payment is transferred to our bank account within one month after sending the form).

I will transfer the amount immediately (recommended for an accelerated registration).

Debit from account number:

20737

(Please note that this option only applies for customers with a current account with BOIP; a direct debit from a bank account is not possible).

17 Attachments (see the explanatory notes)

•

18 Signature

Name

Date

•

•

Position

Signature

•

•