

## 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.