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# Paper DI – Part 2

This paper (Part 2) comprises:

- Question 4: 7 marks
- Question 5: 7 marks
- Question 6: 11 marks

**QUESTION 4****(7 MARKS)**

Today is 2 March 2021.

Mr Scrooge is a US resident and national and is the applicant for an international application PCT-S which was filed on 17 April 2017 without claiming priority. The USPTO acted as International Searching Authority (ISA) in the international phase and issued the international search report and written opinion in April 2018.

Mr Scrooge has completed the formalities for entry into the regional phase (EP-PCT-S) before the EPO, waived the right to receive a communication under Rules 161(2) and 162 EPC, and appointed a professional representative, before the expiry of the period of 31 months from the filing date of PCT-S.

In September 2020, the EPO as designated Office issued a supplementary European search report for EP-PCT-S and indicated that the claims as filed appear to meet the requirements of the EPC. On 3 November 2020, a communication giving Mr Scrooge an opportunity to amend the application and setting the time limit of six months was issued by the EPO and sent to the professional representative.

What actions need be taken in 2021 and by when?

**QUESTION 5****(7 MARKS)**

A European patent application was refused by the Examining Division. The applicant successfully appealed the decision: the Board of Appeal found the claims patentable and remitted the case to the Examining Division for further examination. Subsequently, European patent EP-P was granted.

EP-P was then opposed and in the opposition proceedings, the opponent presented a document D, not cited in the proceedings up to grant. The patentee's main request to maintain EP-P as granted was refused during oral proceedings after much discussion. Claim 1 of the main request was considered to lack novelty over the document D. A written interlocutory decision to maintain the patent as amended on the basis of the patentee's first auxiliary request is dated 4 January 2021.

The patentee maintains that the claim 1 of his main request is novel over document D. Furthermore, the patentee is of the opinion that the fact that the Opposition Division did not follow the decision of the Board of Appeal on appeal from the decision of the Examining Division represents a substantial procedural violation. The patentee thus wishes to file an appeal against the decision of the Opposition Division.

- a) Is the patentee entitled to file the appeal?
- b) What steps need be taken and until when?
- c) What would be your advice regarding the alleged substantial procedural violation?

## QUESTION 6

(11 MARKS)

A large company C has a European patent application EP-A, a European patent EP-B, and an international application PCT-C.

EP-A was filed on 18 September 2017 in English and is pending. The communication about intention to grant, dated 15 October 2020, was received by C on 27 October 2020. The response to the communication, including the translations of claims into German and French, was filed on 25 February 2021.

EP-B was revoked by a decision of the opposition division dated 23 December 2020 and received by C on 28 December 2020. C filed a notice of appeal on 1 March 2021 via EPO Online Filing, together with Form 1038E indicating that the fees should be debited from C's deposit account.

PCT-C was filed on 28 January 2021, both the request and the specification (description, claims and abstract) being in character-coded format (XML), with EPO as the Receiving Office. No fees were paid upon filing.

C has a deposit account with the EPO, and C has an automatic debit order in place for EP-A and PCT-C.

- a) Which fees need to be paid for which application / patent between 15 October 2020 and 31 March 2021, how much are they, and what is the last date for payment of each respective fee, without using any remedy?
- b) Please discuss the dates and the order in which the fees are considered to be paid.