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Candidate's examination paper (Examination paper D/1990)

1. If applicant chooses EPO as receiving office in accordance with Art. 152(1) EPC he shall file it directly with the EPO and Art. 75(2) EPC applies. Thus in accordance with Art. 75(1) EPC application may be filed at EPO in Munich, The Hague or in accordance with the decision of the President 10.05.89 in Berlin.

   In addition where a Contracting State has made an agreement with the EPO in accordance with Rule 19.1(b) PCT, international applications may be filed through the intermediary of the competent central industrial property office and transmitted to the EPO in accordance with Art. 152(2) EPC.

2. Under Rule 54.2 PCT the right to make a demand under Art. 31(2) PCT exists if at least one of joint applicants is a resident or national of a State bound by Chapter II. Switzerland is not bound by Chapter II but Germany is. Thus, since one of the applicants is entitled to file demand under Art. 31 EPO can act as IPEA in accordance with Art. 155(1) EPC.

   The demand for Chapter II will also be effective for CH if it elects EPO as a designated regional state for Chapter II.

3(a) If applicant only wishes to continue with invention 2, for which a further search fee was paid under Rule 46(1), then he need only delete the subject matter of inventions 1 and 3 from the application in his response under Art. 96(2), Rule 51(2) EPC and simply maintain claims and description relating to invention 2. This will satisfy requirements for unity under Art. 82.

3(b) If applicant wishes to maintain protection for all three inventions it will be necessary to have three separate applications to satisfy unity provisions of Art. 82. He can choose either invention 1 or 2 to maintain in present application, since search fees have been paid for both, but other two inventions will need to be subject of divisional applications under Art. 76 EPC. Under Rule 25 EPC these can be filed any time up to approval of text but if not divided out in response to official action, application would be rejected due to lack of unity Art. 82. Rule 25(3) states filing fees, search fees and designation fees must be paid in respect of divisional applications. However, search fee already paid for inventions 1 and 2, thus search fee need only be paid for divisional application covering invention 3. In accordance with Art. 10(3) of the Rules relating to Fees the search fee shall be fully refunded if Search Report relates to a divisional application and is based entirely on an earlier Search Report on the earlier application. Thus must pay search fee on divisional filed to cover invention 1 or 2 but it will be refunded in full.

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4(a) In accordance with Rule 78(3) EPC notifications are d
be delivered on the tenth date following its posting.
communication deemed to have been made on 3 February 199

Time limits expressed in months are calculated to expire in
relevant month on same number day - Rule 83(4) EPC, from
relevant notification.
Thus

3 February 1990 + 4 months =
3 June 1990.

This is a Sunday and thus offices are closed and in accordance with Rule 85(1) EPC time limit is extended to next day on which offices are open. 4 June 1990 is a Bank Holiday and thus time limit is extended to Tuesday 5 June 1990.

4(b) Under Rule 51(4) the period set may be extended by a maximum of two months providing representative applies for extension before expiry of time limit. No grounds for extension are required. The two month extension would expire on 5 August 1990 which again is a Sunday so under Rule 85(1) would expire on Monday 6 August 1990.

Only one extension is allowable and if applicant fails to respond within extended period application is refused in accordance with Rule 51(5) EPC and he would be notified of this Rule 69(1) - Art. 119. The applicant could then apply for further processing under provisions of Art. 121 within two months of notification.

5. Art. 78(1) states that application must contain a request, description, claim(s), and abstract but in accordance with Art. 80 a date of filing can be granted if there is an indication that EPA is sought, designation of at least one state, information identifying applicant (all of which have been provided by the request for grant) and a description and one or more claims <u>even though these may not comply with other requirements of EPC</u>. Thus, assuming British application was filed with at least one claim, it could be argued that priority document fulfils this requirement. Thus file extra copies of application etc. to comply with EPC in order to maintain priority and European application having same scope as initial application as rectification of deficiencies in the application documents provided for by Rule 41(1).

In the alternative, an attempt could be made to claim a correction of error in document in accordance with Rule 88 EPC. However, in this case no document really corresponding to description and claims other than priority document was filed - thus arguably no document to correct. Also corrections to description and claims must be obvious (last sentence Rule 88) and although case law has held priority document may be used to support such requests it is unlikely that complete replacement of text would be allowable. Better to request that priority document be considered to represent the description/claims and filing of extra copies etc. merely represents a correction of deficiencies as allowed for under Rule 41(1) EPC.

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6. Under Art. 114(1) the EPO is entitled to examine the fa a case of its own motion i.e. does not need to be directe an opponent. However conflicting case law exists on this p and the most recent decision by the Technical Board of Appea held that it was not for the opposition division to effectively reopen examination proceedings of its own motion during opposition but was to rely on facts raised during the proceedings. Nevertheless, where there is very clearly a valid ground of opposition to a granted patent it is reasonable for the EPO to safeguard the public against invalid patents being maintained. Thus opposition division will advise proprietor that ground for opposition under Art. 100(c) exists in respect of claim and unless proprietor amends patent to delete claim as provided for in Art. 102(3) the Opposition Division will revoke the patent in accordance with Art. 102(1).

7(a) Time limit set under Rule 51(6) is non-extendable (line 6) but is set by the EPO to be "not less than two months or more than three months". In accordance with Rule 51(8) if fees are not paid in due time the application is deemed to be withdrawn and applicant would be notified of withdrawal in accordance with Art. 119 EPC and Rule 69(1).

7(b) Art. 121(1) provides remedy to this failure since application is deemed to be withdrawn following failure to reply within time limit set be office. Thus applicant must request further processing and pay the grant and printing fees, thus completing omitted act Art. 121(2).

7(c) Within two months of notification of the communication that application is deemed to be withdrawn.

Alternatively, if failure to pay was due to some particular reason and was "in spite of all due care" - then "Restitutio in integrum" under Art. 122 may be applied for. This application must be filed in writing within two months of removal of cause of non-compliance and within a year of expiry of the time limit Art. 122(2). Full grounds and facts must be set out and grant and printing fees paid within two month period.

8. Interruption of proceedings under Rule 90 EPC applies only to the applicant for or proprietor of a European patent or his representative, and does not appear to apply to an opponent, who is nevertheless a party to the proceedings.

However, in the circumstances it seems likely that an immediate request filed with the EPO to defer the oral proceedings would be granted and a situation analogous to Rule 90 interruption would exist and the EPO would re-set the date for oral proceedings to take place. However, costs incurred in the cancellation e.g. of interpreters etc. may be incurred in accordance with Rule 63 EPC.

In the alternative proceedings would continue even in the absence of any further contribution from the "opponent" and a decision would be reached by Opposition Division on basis of facts and arguments already submitted.

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9. Under Art. 79(3) the designation of a Contracting Sta[illegible]e withdrawn at any time up to grant of the patent.

The patent application has been published and thus the pub[illegible] advised that GB has been designated in the application.

Under Rule 88 "mistakes in any document filed with the EPO may be corrected on request". Designations do not concern the description, claims or drawings so mistake need not be obvious.

In this case evidence would need to be provided that a "mistake" had actually occurred i.e. the applicant had not simply changed his mind, but assuming this could be produced correction of the mistake under Rule 88 should be allowable providing the public interest is not harmed. In this respect public had presumably not yet been advised of withdrawal e.g. by notice printed in the OJ, so correction should be allowable. However, if public had been advised correction not allowable.

10. Search Report published on 4 July 1990 in accordance with Art. 93(2) EPC. Under Art. 94(2) request for examination must be filed within 6 months of publication of search report, i.e. by 4 January 1991 (Friday) and the request is not deemed to be filed until after the examination fee has been paid.

In accordance with Art. 8(1)(a) of the Rules relating to Fees a payment made to the EPO but credit transfer (as permitted by Art. 5(1)(a) Rules relating to Fees) is considered to have been made on the date on which the payment is entered in EPO account i.e. 7 January 1991. This is after expiry of 6 month time limit.

However Art. 8(3) Rules relating to Fees provides that where payment is effected through a bank not later than 10 days before expiry of period then payment is deemed to have been completed. However, 26 December 1990 was less than 10 days before expiry therefore payment not made within six month period.

However Rule 85b EPC provides a period of grace for filing the request for examination and allows it to be validly paid within one month of notification of a communication pointing out the failure to observe the time limit, provided a surcharge is paid. Surcharge is 50% of examination fee (Art. 2.6a Rules relating to Fees) so this surcharge must be paid within one month of notification, otherwise application will be deemed to be withdrawn Art. 94(3) EPC.

11. SE - 5 January 1990
EPA - 12 June 1990

Art. 14(1) EPC states that European patent applications must be filed in French, English or German. However Art. 14(2) provides a derogation of this provision where an applicant is resident in a Contracting State having an official language

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other than this and thus a person resident in Sweden is entitled to file a European application in Swedish.

However, Art. 14(2) second sentence states that a translation must be filed in ENG, FR or DE within the time limits laid down in the Implementing Regulations.

In Rule 6(1) this time limit is set to be within three months of filing but no later than 13 months after priority date. Thus translation was due to be filed by 12 September 1990 (Wednesday).

In accordance with Art. 14(5) the document i.e. the application is deemed not to have been received and for this reason all fees are refunded.

It should be recommended that a fresh application claiming priority is filed within 12 month convention period i.e. by 5 January 1991 (Saturday): Rule 85(1) extension to Monday 7 January 1991.

12. The Opposition Division should issue an interlocutory decision in accordance with the recent notice of the President (based on case law) to allow the patent to stand in amended form. This decision allows separate appeal Art. 106(3) for both patentee and opponent.

However, if opponent has <u>unequivocally</u> withdrawn his opposition i.e. he is no longer a party to the proceedings, then decision is not required since communication under Rule 58(4) has already been made so will issue proprietor with request to pay printing fee for new spec. in accordance with Rule 58(5).

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