

Examiners' Report on Paper D/1991

The Committee again pleads for legible writing.

Part II

None of the different aspects of this question was particularly complex, but it was necessary to apply the provisions of EPC to the situations revealed. Although a client may not need to be told what provisions apply, it may help candidates to note them and derive the consequences correctly. Again, the question should be read carefully. Each section ended with a client's request which should have been answered. Many candidates did not gain marks because they failed to give the advice asked for.

PART II

Part A

1. Decision of 14.11.90 is deemed to have been received on the 10th day after delivery to the postal service, Rule 78 (3) EPC.
2. Term for lodging the appeal and payment of the appeal fee is 2 months from service of the decision, Article 108 EPC
3. Provided that cheque is honoured, payment of the appeal fee occurred in good time, Article 8 (1c) Schedule of Fees
4. Appeal was lodged in good time, Article 108, sentences 1 and 2 EPC
5. Term for grounds of appeal = 4 months, Article 108 EPC + R. 85(1) (24.3 = Sunday) = 25.3.91
6. No extension of term for grounds of appeal possible, Art. 108, sentence 3, R. 84 EPC
7. Written request for reinstatement according to Article 122 EPC necessary
8. Reinstatement in term for grounds of appeal also possible for opponent
9. see Decision G 1/86 (Official Journal 1987, 447)
10. within 2 months after removal of the cause of non-compliance, Article 122 (2) EPC
11. The cause of non-compliance is removed here when the mistake of the firm of Tell about a term extension being possible is removed
12. Reasoning for the fact that the opponent, despite observing all due care

- required by the given circumstances, was prevented from complying with the term for giving grounds of appeal, establishing credibility of the facts, Article 122 (3) EPC
13. These conditions can be affirmed here as it is the right of a party to exhaust legal terms and the illness of the patents expert was neither foreseeable nor the fault of the opponent
 14. Payment of the reinstatement fee, Article 122 (3) EPC, Article 2, No. 13 Schedule of Fees
 15. within the reinstatement term completion of the omitted act, Article 122 (2) EPC (i.e. grounds of appeal)

Part B 1

16. Priority of the German application cannot be effectively claimed by X for his European patent application, as the narrow field was not disclosed in the prior German application
17. Thus the subsequent application does not disclose the same invention as the prior application within the meaning of Article 87 (1) EPC, 88 (3) EPC
18. As the Swiss priority can be claimed for invention A, (prior in time)
19. the European application of X is not prior art according to Article 54 (3) EPC in respect of Application A
20. the examination procedure in the German application should be monitored in order to file an opposition, if applicable, against the German patent
- 20a. X can get the patent in NL

Part B 2

21. The firm of Y is deemed to be entitled to exercise the right to the European patent in respect of its application, Article 60 (3) EPC
22. although the Convention contains a substantive allotment of this right to the inventor or his legal successor, Article 60 (1) EPC
23. Suit against Y, Article 1 of the Recognition Protocol
24. this suit is to be brought in Sweden, Article 2 of the Recognition Protocol
25. then as promptly as possible request postponement of the examination procedure of the application Y, Rule 13 (1) EPC
26. it is to be proved that proceedings against Y have been initiated, Rule 13 (1) EPC
27. If legally valid decision of the Swedish Court exists, this must be proved to the EPO, Article 61 (1) EPC, Rule 13 (2) EPC
28. If the conditions according to Article 61 (1) EPC are met, the European patent application of Y can be prosecuted as own application, Article 61 (1) a) EPC
29. this should be done with regard to the country SE
30. For the additional embodiment of the invention C only own application can be prosecuted
31. For all countries apart from BE and NL own application must be correspondingly restricted and
32. a separate set of claims filed (pursuant to Art. 54(4) EPC. R. 87)

Part C

33. there is nothing to be done
34. the term for payment of the designation fee expired on the 28.1.1991, Article 79 (2) EPC, R. 83(4), R. 85(1)
35. Extension of a term expiring on the Saturday to the next working day, Rule 85 (1) EPC
36. Additional period of time of 2 months for the payment of the designation fees, Rule 85a (2) EPC
37. Supplementary fee of DEM 1 110.-, Rule 85a (2) EPC and Article 2 No. 3b Schedule of Fees
38. Additional period of time expired on the 28th March 1991 (Legal Information No. 5/80, (Official Journal 1980 149))
39. Remittance on the 18th March in good time, Article 8 No. 3a Schedule of Fees
40. Payer is requested to select the states which he wants, Article 7 (2) Schedule of Fees and Decision J 23/82 (Official Journal 1983, 127)
41. According to Article 9(2) Schedule of Fees the designation fees are deemed not to have been paid for AT, LU, ES and GR, if there is no response to the request
42. Applicant has claim to re-payment of DEM 10.- which lapses according to Article 126 (2) EPC (Decision of the President of the 10.12.1990, A2 : the Office does not automatically pay back petty amounts, under DM 20.-).

PART II

PARTS	Maximum possible	Individual marks awarded	Where grades awarded are not identical	
			Revision of marks/grade (if any)	Remarks*
A	17			
B1	7			
B2	13			
C	13			
TOTAL PART II		50		
TOTAL PART I		50		
TOTAL PARTS I + II		100		
CORRESPONDING GRADE				

Translation of marks into grades

%	Grade
0 - 35	7
35,5 - 45	6
45,5 - 55	5
55,5 - 65	4
65,5 - 75	3
75,5 - 85	2
85,5 - 100	1

* to be filled in if both the following requirements are fulfilled:
 (a) the grades awarded by the two individual examiners before their discussion differ by two grades or more;
 (b) the marks awarded by at least one of the two individual examiners have been changed during their discussion.
 If remarks are to be filled in, they should briefly explain why the examiner has changed his marks.