

Candidate's Answer Paper
(Examination Paper D)

Part I

1. The application will not be published.

Rule 48(2) EPC provides that the application will not be published if withdrawn before technical preparations for publication are complete.

President's Notice of 14.12.92 and Guidelines A-VI, 1.1 provide technical preparations will be completed 7 weeks before 18 month date.

Therefore, application is deemed withdrawn before technical preparations are completed, and so will not be published.

2. (i) Yes, file a new application. As the EPO was not open for the filing of documents on 14-17 April 1995 (President's Notice 10.11.94), an application may be filed on 18 April validly claiming priority from 14 April 1994 as the period under Article 87(1) EPC is extended by virtue of Rule 85(1) EPC to the next day on which all filing offices of the EPO are open.

Therefore, file a new application today, 18 April 1995 claiming the valid priority date of 14 April 1994. The application filed on 14 April 1995 may be abandoned.

- (ii) Yes, it is too late to file a new application claiming priority.

However, correction can be made to a missing or wrong priority claim under Rule 88 EPC. This was held to be allowed in J2/92, J3/91, J6/91 and J9/91 and other cases. The burden of proof of error is very low.

(In theory, there is no reason why a Rule 88 EPC correction could not be used for (i), but it is better to have an application claiming valid priority without requiring correction!).

3. Request is inadmissible.

Under Article 122(2) EPC, a request for re-establishment must be made within 12 months following the expiry of the time limit. For renewal fees, this period will expire 12 months after the original due date, i.e. 12 months from 30 September 1993. This period expires on 30 September 1994 applying Rule 83(4) EPC.

It is also necessary for the application to be made, the omitted act completed, and the fee paid within 2 months of removal of the reason for non-compliance. This removal probably took place on notification from the EPO - J27/90. This notification was dated on 5 August 1994, and so by Rule 78(1) and (3) EPC will be deemed to be notified 10 days later, namely 15 August 1994. The 2 month period from this date will end 15 October 1994

applying Rule 83(4) EPC. This is a Saturday, and so is an excluded day (Presidents Notice 07.10.93). Under Rule 85(1) EPC, the period is extended to the next day on which all filing offices of EPO are open, namely 17 October 1994.

By J6/90, where there is a clear indication that re-establishment is sought before the end of the 1 year period, which in this case there was as most acts had been completed, then the required acts for restitutio may be validly completed at any time until the end of the 2 months from removal of the cause of non-compliance. This was done so restitutio should be allowed.

4. (i) Austria.

The relevant court is decided by the Protocol on Recognition.

Article 4 of the Protocol provides that for an invention by an employee, the Court of the contracting state whose law determines the right to the patent under Article 60(1) EPC shall have the exclusive jurisdiction.

Article 60(1) EPC provides that the contracting state which determines the ownership is the state in which the employee is mainly employed. This is Austria.

(ii) Belgium.

As the inventor is not an employee, Article 4, Protocol on Recognition does not apply.

Article 2 Protocol on Recognition determines the court by reference to the applicant's residence or place of business, but this does not apply if this place of business is not a contracting state of the EPC. In this case, the applicant's place of business is Canada and so Article 2 does not apply.

Therefore, Article 3, Protocol on Recognition applies. This provides that if the party claiming the right has residence or a place of business in a contracting state, the Court of that state will have jurisdiction.

The inventor claiming the right is resident in Belgium, and so the Belgian court shall decide.

(iii) Germany.

There is no employment contract, and so Article 4 (P on R) does not apply.

The applicant has neither a residence or place of business in a contracting state as Iceland is not a contracting state. Therefore, Article 2 (P on R) does not apply.

The person claiming the right has neither a residence or place of business in a contracting state, as he is resident in Iceland. Therefore, Article 3 Protocol on Recognition does not apply.

Article 6 Protocol on Recognition provides that if none of Articles 2 to 4 apply, as in the case here, then the German court has jurisdiction.

In all above cases, if there is an agreement between the parties as to a different court which should have jurisdiction, Article 5(1) Protocol on Recognition provides that this Court will have jurisdiction.

5. (i) Yes.

Article 8(2)(a) PCT provides that the conditions for making a priority claim for an international application are as provided in Article 4 Paris Convention.

Article 4A(1) Paris Convention provides that priority may be claimed from an earlier patent application filed in one of the countries of the Union. Article 4A(2) Paris Convention provides that any filing equivalent to a regular national filing shall be sufficient for a priority claim. As a European application is deemed to be equivalent to a national application in any designated state - Article 66 EPC, a European filing meets the requirements for claiming priority made by Article 4 Paris Convention, and hence Article 8 PCT.

(ii) It may be.

If the scope of the eventually granted European patent is different to the scope of the patent resulting from the International application, then 2 patents should be granted. The EPO will not however allow the grant of 2 identical patents.

6. Yes.

Article 54(1) EPC provides that the state of the art comprises everything made available to the public before the date of filing the application. Article 89 EPC provides that the date of filing is deemed to be the priority date.

In G1/92, it was held that the composition or internal structure of a compound is deemed to have been made available if the composition could have been identified by a person skilled in the art. It was held to be irrelevant whether the person would have identified the composition, or actually did identify the composition.

Therefore, product Y was sold without restriction before the priority date of the patent to product X. It appears that the composition could have been determined, for example by C, and in this case, following G1/92, the composition of Y does form part of the state of the art.

If such determination was not possible, then only Y, and not its composition form part of the state of the art.

7. (i) File a new application, claiming priority from the original application. Withdraw the incorrect European application.

Because the new application can still claim the original priority date, there will be no loss of rights in withdrawing the existing application and filing a new one. (In view of G3/93, it should be ensured that there is no possible intervening disclosure between the filing of the existing EP application and new European application. If there has been, further consideration may be required).

Alternatively, Figure 2 may immediately be filed, in which case the application will be re-dated to the date of filing the drawings - Rule 43(1) EPC, Article 91(6) EPC. These options both involve no additional cost, and so may be equally acceptable, but I would prefer filing a new case to ensure everything is filed together, in case any other pages were originally missing in the original European application.

- (ii) Either file the drawing and lose priority, or do not file the drawing, keep the priority date, but lose references to the drawing. Under Article 80 EPC, all requirements have been met to give the application a date of filing.

The EPO will therefore examine the application to check, inter alia, whether the drawings were filed on the date of filing - Article 91(1)(g) EPC.

In this case, Figure 2 was not filed, and so Article 91(6) EPC applies.

Under Rule 43(2) EPC, the EPO will set a one month term to file the drawings. If the drawings are filed within this term, the application will be re-dated to the date on which the drawings are received. Accordingly, the priority claim will be lost as the filing date will be more than 12 months from the date of filing the priority application - Article 87 EPC.

If the drawings are not filed, then Rule 43(2) EPC and Article 91(6) EPC provides that the references to the drawings will be deleted. Nevertheless, in this case the priority date remains.

The advice must therefore be to file the drawings as soon as possible, but lose the priority date if this is of no value.

Alternatively, do not file the drawings, and let all reference to them be deleted, but keep the priority date. In this case, no protection will be available covering specifically Figure 2, but this may be filed as a separate application if this is merited, but the priority date will remain. This may be important.

8. (i) Due 16 months from the date of filing, or where priority is claimed, the priority date - Article 91(5) EPC.

If not done on time, the application is deemed withdrawn - Art. 91(5) EPC.

Restitutio under Art. 122 EPC will be available, as it is a time limit to be met by the applicant, and is not excluded by Art. 122(5) EPC.

Further processing under Art. 121 EPC is not available to the 16 month period as it is not a period set by the EPO. However, the Guidelines A-III, 5.4 interpret Rule 42(1) EPC as requiring the EPO, when notifying the applicant of the failure, to set a minimum 2 month period for remedy of the deficiency. It is indicated that further processing is available for this period.

- (ii) Due date - 3 months from the filing date, but no more than 13 months after the priority date - Rule 6(1) EPC.

If not filed on time, the application is deemed withdrawn - Article 90(3) EPC.

As the period is not one set by the EPO, further processing under Article 121 EPC is not available.

Restitutio under Article 122 EPC is available, as it is not precluded by Article 122(5) EPC, and is a time limit for the applicant to meet.

9. No.

Croatia is not a contracting state of the EPC, and has not made an agreement to be an extension state. Therefore, protection in Croatia by a European application is not possible.

Ireland, Liechtenstein, Monaco and Switzerland are all contracting states of the EPC, and so a single European application can cover these. Switzerland and Liechtenstein have agreed under Article 149(1) EPC that they may only be designated together. Accordingly, only one designation fee is due in respect of the combined Liechtenstein/Switzerland designation.

Slovenia does have an extension agreement with the EPO. Accordingly, when filing a European application, a request can be made to extend this to Slovenia.

Therefore, an application should be filed at the EPO. The filing and search fee must be paid within 1 month of filing - Article 78(2) EPC, although these may be paid within a grace period of 1 month from notification from the EPO under Rule 85a(1) EPC.

Ireland, Monaco and Switzerland/Liechtenstein should be designated in the request. Under Article 79(2) EPC, the 3 designation fees due must be paid within 12 months of filing if no priority is claimed, or the later of 12 months of priority and one month of filing if priority is claimed. Under Rule 85a(1) EPC, a 1 month period of grace from notification is available for payment of the designation fees, or, if this notification is dispensed with, a 2 month period from the due date - Rule 85a(2) EPC. In either case, a 50% surcharge is due.

Also on filing, Slovenia must be designated as an extension state. The extension fee, which is the same as the designation fee, must be paid by the normal due date under Article 79(2) EPC for paying designation fees. The 2 month grace period under Rule 85a(2) EPC is available for payment with a 50% surcharge.

Regarding Croatia, a separate national application must be filed. (Croatia is not a PCT state and so a PCT application would not be possible).

10. Pay 3rd year renewal fee + 10% surcharge by 31 July 1995. File a notice of appeal and pay fee by 18 April 1995, and file grounds including amendments by 19 June 1995.

Renewal fees

Article 86(1) EPC provides that renewal fees are due in respect of 3rd and subsequent years from filing. Therefore, the third year renewal fee is due in respect of the year from 09.01.95 to 08.01.96. By Rule 37(1) EPC, this fee should have been paid by the last day of the month containing the anniversary of the filing, i.e. by 31.01.95. This date has been missed.

Article 86(2) EPC gives a 6 month period from the due date on which the renewal fee may validly be paid, together with a surcharge (10% - Article 2(5) EPC Fee Rules). By the decision of J4/91, this period expires on the last day of the relevant subsequent month, namely on 31 July 1995. (This is not an excluded day).

The renewal fee plus 10% surcharge must be paid by 31 July 1995.

Overcome refusal

The decision from the EPO must be appealed. An appeal notice, and fee, must be filed within 2 months of the date of notification of the decision - Article 108 EPC.

By Rule 78(1) and (3) EPC, the notification is deemed made 10 days after the communication is sent (this being the deemed date of receipt unless it is actually received later). Accordingly, notification is deemed to be made on 17 February 1995. By Rule 83(4) EPC, the 2 month period will therefore expire on 17 April 1995. This is an excluded day (President's notice 10.11.94) and therefore, under Rule 85(1) EPC, the due date will be the next day on which all filing offices of the EPO are open, namely 18 April.

A notice of appeal must be filed by 18 April 1995.

Also within 4 months of notification, Article 108 EPC requires a written statement with the grounds of appeal to be filed. Applying Rule 83(4) EPC, this period ends on 17 June 1995. This is a Saturday and so is an excluded day (President's Notice 10.11.94).

Applying Rule 85(1) EPC, the period is extended, and expires 19 June 1995.

Accordingly, the grounds of appeal must be filed by 19 June 1995.

The grounds of appeal should include the amendments suggested by the Examiner. In this case, there must be an interlocutory revision under Article 109(1) EPC. This means that the decision to refuse must be set aside. (It is unlikely that the appeal fee will be reimbursed under Rule 67 EPC as there was no substantial procedural violation.)