

Report on Paper D/1995

It is difficult to know what it is worth saying which would help future candidates in preparing for the exams. Despite the comments in previous reports, the same problems turn up year after year and it must be emphasised that it would be preferable if candidates did not enter the exam until they were really ready and had put in the necessary study.

Once again it was very regrettable to read answers which displayed such a complete lack of knowledge of priority rights - who owned them and what was necessary to claim them to maximum benefit. This is a major issue for the correct handling of a client's patent matters and any candidate who cannot deal with this is not fit to practice. Also a surprisingly common failing was for a candidate to know old case law but not to know the most recent decisions or EPC changes reversing the old law.

No well prepared candidate should have been short of time and the need this year to allocate time between the different parts was avoided by separating them and specifically allocating a maximum time for each part. Overall, the examiners felt the papers showed that there had been less time pressure and that Part II in particular was answered better this year, probably as a result of more time being allocated specifically for this part without the question having been made in any way more difficult. Nevertheless, many candidates would have lost valuable rights for their clients if they had been dealing with these problems in real life.

Attached is a model answer which is much fuller than would be expected from even very good candidates. Also attached are examples of some of the better actual examination answers which were submitted in different languages. These actual examples may suffer errors or omissions and may not accord with the model answer in all respects but they do show what actually can and has been achieved by good preparation and in the time permitted in the examination.

Many of the questions in Part I were well answered and obviously caused candidates very few problems but others were not found so universally easy and the following comments set out the main problems or deficiencies that arose in the answers.

Part I

1. Generally well answered but some candidates were using the old period of technical preparation for publication.
2. (i) Although the majority realised that it was still possible to claim priority the mechanism for doing so was not given. Only a very few mentioned the possibility of a request under Rule 88.

(ii) Most failed to give the possibility of correction under Rule 88 including some who mentioned it for part (i)
3. Although the majority realised they had to use Art.122 many failed to recognise there were two time limits involved and many calculated the limits incorrectly.
4. Many confused the applicable law with the competent court. Only very few recognised that Art. 5 of the Protocol may be applicable in all three instances.

5. Candidates were asked to justify their answer in part (i) but many thought a yes or no answer was sufficient - it wasn't. Many also failed to deal with PCT provisions even though an international patent application was concerned. In part (ii) full credit was given to candidates who pointed out that the EPC contains no provisions dealing with this question as well as to candidates who gave the view set out in the Guidelines.
6. Very few candidates referred to the need for there to be no undue burden for reproduction but otherwise most candidates answered this question well.
7. Many candidates simply referred back to case law which has been superseded to justify insertion of the drawing. Many relied incorrectly on Rule 88.
8. At the time of the exam the Guidelines were incorrect but candidates who relied on the Guidelines were given full credit.
9. Very few wrong answers.
10. Unbelievably many candidates considered they could rectify the situation by applying for further processing under Art. 121.

Model Solution to Paper D/1995

Part I

Question 1

According to Rule 48(2), a European patent application shall not be published if it is withdrawn before the termination of the technical preparations for publication. Rule 48(1) states that President of the EPO shall determine when technical preparations are deemed to have been completed. In the decision of the EPO President dated 14.12.1992, it is stated that these preparations are considered terminated at the end of the day that comes seven weeks before expiry of the eighteen month period from the date of filing or priority.

Hence in this case, since the applicant notified the EPO nine weeks before the expiry of the eighteen month period, he can be sure that the application will not be published.

Question 2

- (i) Since the EPO is closed for Easter between 14 and 17 April, according to Rule 85(1), the time limit is extended to the first day upon which all filing offices are open for the receipt of documents and on which ordinary mail is received i.e. 18 April. Therefore the representative can refile the application on the 18 April (which is still within the time limit) claiming the priority of 14 April 1994, and leave the original application to be deemed to have been withdrawn, as no fees have yet been paid.

The alternative would be to add the priority data to the request for grant form, as a correction under Rule 88 EPC, first sentence, and it would not be necessary to prove that any mistake had been made (see Legal Board of Appeal Decision J9/91).

- (ii) If the representative had only realised his mistake on 19 April, the first option above would not have been possible, since the time limit would have expired. The second option would be the only one remaining.

Question 3

The Rule 69(1) EPC notification regarding the ensuing loss of rights was sent out by the EPO on the 05.08.1994. According to Rule 78(1) EPC this notification would have been made by registered letter, and was deemed to have been received by the representative on the 15.08.1994 (Rule 78(3)). The receipt of this notification constitutes a removal of the cause of non-compliance within the meaning of Art. 122(2)EPC. Therefore the representative has 2 months from the date of receipt of the Rule 69(1) notification in which to file an application for restitutio in integrum (Art. 122). The two month period actually expires on the 17.10.1994 (Rule 85(1) EPC). The omitted act itself (the payment of the renewal fees) must also be completed within this period. According to Legal Board of Appeal decision J6/90, it is enough that the filing of an application for restitutio is completed within 1 year of expiry of the unobserved time-limit (i.e. 30.09.1994) (Art. 122(2)). The request for Restitutio in Integrum was received by the EPO on 21.09.1994 and the payment of the renewal fees on the 28.09.1994, i.e. both before 30.09.1994. The other Art. 122

requirements are to be filed within the two month time-limit, which in this case is later than the 1 year period. Since the grounds were filed before 17.10.1994, the request for re-establishment is admissible.

Question 4

The Protocol on Recognition governs the competence of national courts in relation to decisions over claims against the applicant to the entitlement to the grant of a European patent. The answers given below are all provisional on the absence of any agreement in accordance with Art. 5 of the Protocol on Recognition.

- (i) According to the above Protocol, Art. 4, if the claimant is an employee of the applicant, then Art. 60(1) EPC applies. According to this article 60(1), when determining who has the right to the European patent, if the inventor is an employee the law of the state in which an employee is mainly employed applies. Therefore the inventor should open proceedings in Austria.
- (ii) If the inventor is not an employee, the applicant has his residence or principal place of business outside the Contracting States, and the claimant has his residence of principal place of business within one of the Contracting States, then the courts of that State have jurisdiction (Protocol on Recognition Art. 3). The inventor should therefore open proceedings in Belgium.
- (iii) In this case neither the claimant nor the applicant have their residence or principal place of business within one of the Contracting States, therefore, according to Art. 6 of the above Protocol, the courts of the Federal Republic of Germany have jurisdiction. The inventor should therefore open proceedings in Germany.

Question 5

- (i) According to Art. 2(vi), 8(1) and 8(2)(b) PCT and Art. 66 EPC, an international application may claim a priority of one or more earlier national or regional applications filed in or for any country party to the Paris Convention. A European application accorded a date of filing is, in the designated States, equivalent to a regular national filing; it is considered as regularly filed for that State and can give rise to a priority right. Therefore an international application may validly claim the priority of a European application and designate the same States as the earlier application.
- (ii) There is no specific provision in the EPC against double patenting. However, if the provision of Art. 125 is applied, then in line with the patent systems of the Contracting States the general principle is that two patents should not be granted to the same applicant for the same invention (see Guidelines C IV 6.4). According to the Guidelines, the applicant should be requested to amend the applications so that there is some difference in the claimed inventions.

[Candidates who pointed out that there is no explicit legal basis for this request, and if such applications claiming the same subject-matter were to be granted, it would be a matter for

the national courts in the designated countries to decide, were credited with having answered correctly].

Question 6

According to Enlarged Board of Appeal decision G1/92, the chemical composition of a product belongs to the state of the art when the product as such is available to the public and can be analysed and reproduced without undue burden by the skilled person, irrespective of whether or not particular reasons can be identified for analysing the composition. Since the product Y in question was freely available ("sold without restriction"), it was available to the public, and could have been analysed by the skilled person. The issue of whether Company C actually made an analysis of the product Y or not has no relevance - it is only important that an analysis could have been made without undue burden. Therefore product Y does belong to the state of the art with respect to the opposed patent.

Question 7

- (i) In the case where the priority period has not yet expired, the applicant should file the omitted sheet containing figure 2 before the priority period expires. In accordance with Art. 91(6) the applicant should request that the application be re-dated to the date of receipt of figure 2 (provided this is within the priority period). If the applicant does not request a re-date himself, the Receiving Section will set a one month term for the applicant to request a re-date. The applicant should not wait until receiving notification from the Receiving Section under Rule 43(2) that a figure is missing, since by then the priority period will probably have expired and the application would have to be re-dated to the date (after the priority date) on which the omitted figure was filed. Alternatively the applicant could file a new application within the priority period including the previously omitted figure 2. Since no fees have been paid on the original application EP1 it can be left to be deemed to have been withdrawn.
- (ii) In the case where the priority period has already expired, the applicant must decide whether he considers the inclusion of the omitted figure 2 more important than the loss of the priority claim. If he does, the omitted sheet should be filed with the EPO with the least possible delay (e.g. fax), and according to Art. 91(6) a request made for the application to be re-dated to the date of receipt of figure 2. If the priority claim is regarded as more important, then figure 2 will have to be abandoned and any references to figure 2 will be deemed to be deleted (Art. 91(6)). A compromise solution could be to maintain the original application with the priority claim but without figure 2 and to file a new application straightaway without the priority but including figure 2.

N.B. The omitted drawing cannot be corrected under Rule 88 since there is no way of telling exactly what the applicant intended to be included in figure 2.

Question 8

- (i) The designation of inventor(s) should be filed with the application, according to Art. 81 and Rule 17 EPC. Art. 91(1f) stipulates that the Receiving Section examines whether the

designation of inventor has been made and Art. 91(5) and Rule 42(1) stipulate that an application will be deemed to have been withdrawn if no designation of inventor is made within 16 months of the date of filing or priority, if priority is claimed.

Further Processing under Art. 121 EPC is not available in this case since the time limit for the designation is set by the Convention, not by the EPO. On the other hand Restitutio in Integrum (Art. 122 EPC) is available.

- (ii) The translation into one of the official languages of the EPO of a European application filed in an admissible non-EPO language (i.e. a non-EPO official language of one of the Contracting States) must be filed within 3 months of the filing of the application in that non-EPO language, but not later than 13 months from the priority date, if priority is claimed (Art. 14(2) and Rule 6(1) EPC). Failure to file the translation within the time-limit of Rule 6(1) causes the application to be deemed to have been withdrawn in accordance with Art. 90(1c) and (3).

Further Processing under Art. 121 EPC is also not available in this case since the time limit for the translation is set by the Convention, not by the EPO. On the other hand Restitutio in Integrum (Art. 122 EPC) is available.

Question 9

Ireland, Liechtenstein, Monaco and Switzerland are Contracting States to the convention; an Extension Agreement is in effect for Slovenia. No provision exists for such an Extension Agreement with Croatia. It is therefore possible to obtain patent protection by an EP application in all the above States except Croatia.

The countries which are Contracting States should be designated with the filing of the application. According to Art. 79(2), the designation fees must be paid within twelve months of filing of the application or the priority date, if priority is claimed. In the latter case, the time-limit for payment is extended to one month after the date of filing of the application if this is later in accordance with Art. 78(2)EPC. If the Contracting States have been explicitly designated then a 1 month period of grace from the Rule 85a(1) notification is provided within which the fees can be paid with a 50% surcharge. If an explicit designation has not been made, the Rule 85a(1) is dispensed with and the provision of Rule 85a(2) provides for a grace period of two months within which the fees can be paid with a 50% surcharge.

As far as Slovenia is concerned it too can be designated at the time of filing, the extension fee to cover this extra designation being payable within the same time-limits that apply for the other designations. The Rule 85a(2) grace period of two months with a 50% surcharge is applicable.

The designation fee for each state is DM 350, except for Switzerland and Liechtenstein, for which a joint designation fee of DM 350 is payable.

Question 10

The applicant can appeal against the decision to refuse his application (Art. 106 EPC). He should file a notice of appeal and the appeal fee with the EPO within two months of the date of

notification of the decision, and within four months of the date of notification of the decision should file a written statement setting out the grounds of appeal. The two month time-limit for the notice of appeal begins on the 17.02.1995 (date of dispatch plus 10 days (Rule 78(3))) and ends on the 17.04.1995, Easter Monday, but is further extended to the 18.04.1995 (Rule 85(1)). The four-month time-limit for the grounds of appeal ends on the 17/06/95, a Saturday, and so is extended under Rule 85(1) to 19.06.1995.

Amended claims which conform with what the examiner has indicated as being allowable should be filed with the grounds of appeal. The examining division should then take advantage of the provision for Interlocutory Revision (Art. 109 EPC), and provided it regards the appeal to be admissible and well founded (i.e. overcoming the previous objections), the decision to refuse the application will be reversed (Art. 109 EPC).

Regarding the issue of fees, the first renewal fee was due on 31.01.1995 (last day of month in which second anniversary of filing date falls (Rule 37(1))) in accordance with Art. 86(1) EPC and is now overdue. The renewal fee may still be validly paid within six months of this date provided that a 10% surcharge is paid at the same time (Art. 86(2)). The renewal fee should therefore be paid before the 31.07.1995.

Paper D Schedule of marks

Questions	Maximum possible	Marks awarded		Revision of marks/grade (if any)		Marking of further examiners	
		Ex	Ex	Ex	Ex	Ex	Ex
PART I							
1	2						
2	3						
3	5						
4	6						
5	5						
6	5						
7	4						
8	5						
9	5						
10	5						
Total Part I	45						
PART II							
I i	5,5						
I ii	8						
I iii	7						
I iv	12						
II i	10						
II ii	12,5						
Total Part II	55						
Total Part 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

Remarks (if any):

Grade recommended to Board _____