

## Examiners' Report

As every year, there were some questions which were well answered by virtually all candidates, whilst other questions caused difficulty for many. Comments are given below only on the questions that were found difficult. However, as a general point, it was clear from the answers on many of the questions that a significant number of candidates were working from out of date revision books and texts. This error can easily lose a candidate the critical marks needed. Once again, a surprisingly high number of candidates failed to read the questions carefully. Many also clearly did not use "time-lines" when answering appropriate questions.

### Part I

#### Question 1

Many candidates concentrated on Rule 38(4) and overlooked Art.88 which makes the filing of the priority translation a requirement.

#### Question 2

In part (b) very few suggested the safeguard of paying the appeal fee to ensure the appeal remained in force.

#### Question 3

(b) A large number were unaware that if the application was filed at the EPO nothing was lost and that the EPO acted for the International Bureau under Rule 19.4 PCT.

#### Question 4

This was poorly answered with many candidates indiscriminately suggesting an appeal, further processing and reinstatement as equal possibilities. Very many took the date of the client's letter to the representative as the date of removal of the cause of non-compliance rather than the date of actual receipt of the Rule 69(1) communication by the applicant.

#### Question 7

Very few candidates obtained full marks on this question. The use of the first application for the purpose of claiming priority was commonly overlooked - although one candidate suggested that, as a valid filing, it was possible to use it as the priority for a convention application in the USA but that, unfortunately, no rights could be obtained in the EPO. A further very common misconception was that the exhibition itself could be used as a priority right. Only a small proportion knew that it was necessary to give on the application form notification of the exhibition. Rule 88 was erroneously proposed by some candidates.

Question 8

- (b) The second sentence of Rule 2(1) was commonly overlooked and Rule 2(4) mentioned instead for this part.

Question 9

Candidates confused novelty with inventive level and most candidates overlooked that DE1 and DE2 had been published before EP was filed. Articles 54(3) and 54(2) were also wrongly mixed up by candidates. A large percentage overlooked that DE1 was still claimed as a priority in DE2 so that in (c) abandonment of DE1 did not help. virtually all those who used a time line got this question correct.

Question 10

Candidates should really learn to read the question. An unbelievable number spent their time explaining how the competitor A could try to reinstate his lapsed patents. Very few mentioned that under Rule 60(1) the EPO will notify the opponent of the lapsing of the patents in the designated states but may continue the opposition on the request of the opponent filed within two months.

**EXAMINATION COMMITTEE III**

Candidate No. ....

**Paper D Schedule of marks**

Question	Maximum Possible	Marks awarded		Revision of mark/grade (if any)		Marking by further examiners	
		Exr .....	Exr .....	Exr .....	Exr .....	Exr .....	Exr .....

**PART I**

1	4						
2	6						
3	3						
4	5						
5	2.5						
6	3						
7	6						
8	2.5						
9	5						
10	5						
11	3	3	3				
<b>Total Part I</b>	<b>45</b>						

**PART II**

I a	12.5						
I b	21						
I c	5						
II	16.5						
<b>Total Part II</b>	<b>55</b>						

<b>Total Parts I + II</b>	<b>100</b>						
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<b>Corresponding Grade</b>							
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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 .....

Munich, 5 September 1996

I. Muir - Chairman of Committee III

**Model Solution****Part I****Question 1**

- (a) Yes, since the language of the priority application is not one of the official languages of the EPO, in accordance with Art. 88(1) EPC, 1st sentence, a translation of the priority documents into one of the official languages has to be filed.
- (b) Alternatively, in accordance with Rule 38(4), a declaration that the European patent application is a complete translation of the previous application may be submitted.
- (c) Under Rule 38(4) EPC, the translation (or declaration) must be filed within the time limit set by the EPO (extendable under Rule 84 EPC), but at the latest must be filed within the non-extendable time limit laid down in Rule 51(6) EPC, see GL, A-III, 6.8.

**Question 2**

- (a) Under Art. 99(1), 1st sentence opposition must be filed within 9 months of the publication of the mention of the grant of the European patent to company A. In accordance with Art. 99(1) and Rule 85(1), since 04.02.1996 was a Sunday, the opposition period expired on 05.02.1996, therefore opposition can no longer be filed.

It is therefore advised to intervene as assumed infringer. Under Art. 105(1), 1st sentence, intervention as assumed infringer is possible since:

- (i) from the information given an opposition procedure is pending before the EPO (B's opposition);
- (ii) the patent proprietor A has instituted proceedings for infringement of the European patent against C;
- (iii) the time limit for intervention as assumed infringer which is three months from the date of institution of proceedings against C by A, has not yet expired (expires 28.05.1996).

In accordance with Art. 105(2) EPC, notice of intervention has to be filed in a written reasoned statement (Art. 105(2), 1st sentence) and the opposition fee has to be paid (Art. 105(2), 2nd sentence).

C is not limited to the grounds of opposition originally filed, in accordance with Art. 105(2), 3rd sentence, after notice of intervention has been filed, it shall, subject to any exceptions laid down in the implementing regulations, be treated as an opposition, GL, D-VII,7.

A less preferred alternative is for C to file observations under Art. 115 EPC but in this case he will not be a party to the proceedings.

- (b) No, in the decision of the Enlarged Board of Appeal G1/94 (OJ EPO 1994, 787), it was decided that the term "opposition proceedings" used in Art. 105 EPC was not restricted to the department of first instance, but could also refer to such proceedings at second instance. Intervention during appeal proceedings was therefore admissible. The intervener should pay the appeal fee to ensure that the appeal remains in force.

### Question 3

- (a) No, in accordance with Art. 9(1) PCT, any resident or national of a contracting state of the PCT may file an international application. Since South Africa is not a PCT contracting state, the application cannot proceed in the name of the South African.
- (b) In the case of an Australian citizen resident in Australia, since Australia is a contracting state of the PCT, an international PCT application could proceed in the name of the Australian, in accordance with Art. 9(1) PCT. However, such an application could not proceed at the EPO since in accordance with Art. 10 in conjunction with Rule 19.1 PCT, the international application shall be filed with the national office of or acting for the contracting state of which the applicant is a resident or with the national office of or acting for the contracting state of which the applicant is a national or with the International Bureau.

In the present case the EPO may, however, act on behalf of the International Bureau under Rule 19.4 PCT. Under that rule, the EPO will receive the application, date stamp it and forward it to the International Bureau.

### Question 4

The only course of action which could save the application is requesting re-establishment of rights under Art. 122 EPC. Such a request would be inadmissible if the two month time limit referred to in Art. 122(2) EPC had already expired or if a year had passed from the missed renewal fee.

At the time of the notification pursuant to Art. 86(3) and Rule 69(1) EPC, (application deemed to be withdrawn), the applicant had no representative and would therefore be notified by ordinary letter post in accordance with Rule 78(2). In accordance with Rule 78(2) the date of receipt of the communication pursuant to Rule 69(1)EPC is considered to be when despatch has taken place, i.e. 29.09.1995. This date would count as the date of removal of the cause of noncompliance for the purposes of Art. 122(2) EPC, unless the applicant is able to prove that he received the communication on a later date, in such a case the significant date is the actual date of receipt by the applicant according to the case law (J7/82). This must be checked with the client.

In any event it is unlikely that the applicant could be said to have exercised "all due care" in accordance with Art. 122(1) in observing the time limit in question.

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Question 5

In accordance with Rule 57.3(a) the handling fee shall be due at the time the demand for international preliminary examination is submitted.

In accordance with Rule 58.1(b) the due date of the preliminary examination fee shall be fixed by the IPEA but shall not be earlier than the due date of the handling fee. If the EPO is the IPEA the fee is also due at the time the demand for international preliminary examination is submitted (Art. 4 RRF).

If the fees are not paid in due time, the International Preliminary Examining Authority shall invite the applicant to pay the fee within one month of the (mailing) date of the invitation in accordance with Rule 57(4) PCT (handling fee) and 58.2 PCT (preliminary examination fee). If they have still not been paid by then, the demand is deemed not to have been filed.

Question 6

The designations of US, JP, DE and GB for a national patent are all valid (Art. 4(1) PCT). The Netherlands has, pursuant to Art. 45(2) PCT, closed the national route for international applications filed on or after 01.04.1995, consequently a national patent can not be obtained for the present application filed on 20.04.1995. The international application will be deemed to include a request for grant of a European patent designating the Netherlands. (See also OJ EPO 1995, 457).

Question 7

When the EP application was filed, it was not stated that the invention had been displayed at an exhibition in accordance with Art. 55(1)(b) EPC. Art. 55(2) requires that in order for such a disclosure not to be taken into account in assessing novelty (Art. 54), in accordance with Art. 55(1), the applicant is required to state when filing the European patent application that the invention has been so displayed, and to provide a supporting certificate. In accordance with Rule 23 EPC, such a certificate must be filed within 4 months of filing; this deadline has been missed.

The applicant is still within the 6 month deadline specified in Art. 55(1), therefore it is recommended to the client either to file a PCT application designating Europe and the USA or a European and a US (national) application.

Vis à vis the EPO it should be ensured that it is clearly indicated on the PCT or EP application form that the invention was displayed at the international exhibition (Art. 55(2) EPC), and the relevant certificate should be filed in accordance with Rule 23 EPC.

If the PCT route is chosen the relevant certificate can be filed upon entry into the regional phase, in accordance with Rule 104b(1)(f) EPC. In the USA the client has one year grace period as from the first disclosure.

Priority of the EP application should be claimed as there might be intervening publications. If the application itself may be allowed to lapse.

### Question 8

- (a) Yes, in accordance with Rule 2(1), 1st sentence and Rule 2(5) EPC. Provided that the EPO is notified at least one month prior to the date set for oral proceedings (18.06.1996 in this case), the EPO has to make provisions for interpretation; otherwise the opponent himself must make the provisions for interpretation and pay the costs.
- (b) In accordance with Rule 2(1), 2nd sentence and Rule 2(5) EPC, since Spanish is not an official language of the EPO but is an official language of one of the contracting states, it is possible to use Spanish during the oral proceedings, however in this case the opponent must make provisions for interpretation himself and pay the costs.

### Question 9

- (a) No, in accordance with Art. 87(1) the right of priority extends for a period of 12 months from the date of filing of a first application for the same invention in a state which is party to the Paris convention.

For the feature A, this period expires on 28.10.1994, 12 months after filing of DE1. In accordance with Art. 87(4), DE2 could only be considered as a first filing for the feature A, provided that DE1 had been withdrawn, abandoned or refused without being made open to public inspection, and had not served as a basis for claiming a right of priority. Since this is not the case, EP cannot claim the priority of DE2, for the feature A. Hence the effective filing date for assessing novelty and inventive step of A is 27.09.1995, i.e. the date of filing of EP.

Since feature B is not disclosed in DE1, and since EP is filed within the 12 month period after filing of DE2, (which represents the first filing for B) the priority claimed for feature B is valid in accordance with Art. 87(1) EPC.

- (b) Feature A is not new within the definition of Art. 54(2) EPC and therefore, a claim to feature A is not allowable under Art. 52(1) EPC.

Feature B of EP is novel.

Since EP validly claims the priority of DE2 the priority date counts as the filing date for the purposes of Art. 54(2) EPC (Art. 89 EPC). DE1 is not prior art in the sense of Art. 54(2) nor is it prior art in the sense of Art. 54(3) since it is not an EP application. DE1 does, however, constitute a national prior right within the meaning of Art. 139(2) EPC and could be used in Germany but only in revocation proceedings.

- (c) Because DE2 claims priority from DE1, even if DE1 were withdrawn/abandoned without having been published, DE2 cannot be considered to be a first application as defined in

Art. 87(4) EPC for the feature A. The answers to parts (a) and (b) therefore remain unchanged.

#### Question 10

Under Art. 99(1) EPC, opposition can be filed against A's patent until 9 months from the publication of the mention of the grant of the patent on 05.07.1995, i.e. until 05.04.1996, extendable under Rule 85(1) until 09.04.1996.

Therefore, it is recommended that the applicant lodge an opposition to A's patent based on the document found. It is allowable to file opposition even though the patent has expired in all designated states under Art. 99(3) EPC.

The EPO will notify the opponent under Rule 60(1) EPC and, if continuation is requested within two months of notification, the opposition continues with the probable consequence that revocation will occur. Revocation of A's patent would give company B the retroactive (ex tunc) effect of Art. 68 EPC, rather than the ex nunc effect of national expiry, see T 329/88, supplement to OJ EPO 6/1994, 117.

#### Question 11

- (a) (i) In accordance with Art. 86(1), renewal fees shall be due in respect of the third year and each subsequent year. From Rule 37(1) EPC, renewal fees are due on the last day of the month containing the anniversary of the date of filing of the application. Consequently the renewal fee in respect of the fourth year is due on Sunday 31.03.1996.
- (ii) In accordance with Rule 85(1) EPC, because the due date given above in part (a) (i) is a Sunday, the due date for payment without additional fee is extended to Monday 01.04.1996.
- (iii) Under Art. 86(2), LA 5/93, a renewal fee may be validly paid within six months of the due date provided that additional fee is paid at the same time, consequently the last day for payment with additional fee is Monday 30.09.1996.
- (b) In accordance with Art. 97(2)c, Rule 51(9) and as explained in GL C-IV, 15.2.2, the examining division shall decide to grant the European patent provided that the renewal fees already due and any additional fees have been paid and furthermore, mention of the grant of the European patent will only be published once the renewal fee has been paid. The renewal fees should be paid to the EPO.