PART II

CASINO

I. a) EPC I was filed Friday Dec 01 1995 in Italian (allowable under Art 14(2) EPC). No fees were paid.
A translation into English French or German was due by 1996 March 01 Friday under A 14(2) and Rule 6(1) EPC.
This was not filed. Therefore the Application is deemed withdrawn Art 90(3) EPC.
Although A 122 EPC is available for failure to file a translation, this is not applicable in this case, since the Applicants intended to abandon the Application. (T 413/91 - No restitution for change of mind).

Therefore, regardless of whether there is time to pay the fees late under R 85a(1) and (2) EPC, this application is deemed withdrawn.

However, a filing date was allocated - Art 80 EPC.

EPC 2 was filed in Italian on 96 Jan 05 Wednesday. There were no claims - therefore no filing date will be allocated (Art 80(d) EPC).

According to Article 90(2), the Receiving Section will give an opportunity to correct the deficiency within 1 month of a notification (Rule 39) (inextensible).

We do not know whether this notification has been received but in any case, if we filed the claims now, the Application would receive the filing date of their date of receipt (Rule 39 EPC last sentence). This is later than the filing date of EPC 4 so no use (see below for fees).
If there is no reply to the communication, the Application is not dealt with as a European Patent Application (R 39 EPC & A 90(2) EPC)

If an application is not accorded a filing date, the fees are refunded because fees are not due until a date is accorded (Guidelines A-II, 4.9 and A-XI, 10.1). Therefore, there is no reason to try to save this Application. Instead EPC 4 should be relied upon.

EPC 4

All papers were present so a filing date of Feb 05 1996 should have been accorded. Check the file. (Art 80 EPC).
The filing and search fees were due by 1996 March 05 Tuesday. (A 78(2)) If they were not paid they are due with a surcharge - see discussion of fees in c) below.
However, see discussion concerning most cost effective way of obtaining protection.

The status of this Application is that it is deemed withdrawn (A 78(3)) if the filing and Search fees have not been paid but that it is probably reinstatable under Rule 85a(1) depending on when a communication under Rule 85a(1) was sent out. A reduction of 20% in the filing fee would be available (Rule 6(3) EPC A 12(1) RRF). If the Application is to be continued with, a translation into GB, FR or DE will be due within 3 months of filing (Rule 6(1) EPC).

EPC 3

The communication was dated Friday 10 November 1995, and sent to a Swiss compa
It was therefore deemed received on 20 Nov 1995 (Rule 83(2) + (3) - meaning o
4 months
Rule 78(3) - ten day rule).
A response was due on 20 March 1996 Wednesday.
Any extension of time had to be requested before that date (Rule 84 EPC).
Therefore the Application will be deemed withdrawn (Article 94(3)).

However, further processing Art 121 EPC is available if requested within 2 months of a communication under Rule 69 EPC deeming the Application withdrawn (Art 121(2) EPC). The omitted act - filing a response to the communication must also be completed and a (relatively small) fee paid.

We could wait for the communication, or instead request further processing immediately (Legal Advice 13/82).

If the further processing deadline is missed despite all due care, we can request restitution under Art 122 EPC (J 12/92).

Protection is likely to be available in the EPC states for the lamp incorporating J, provided priority is claimed from EPCI (see below) and for the gold elements.

Protection for the iron elements is complicated by LEEK (see below).

b) To protect the inventions in the most cost effective way.

C1 was disclosed at a local Exhibition of 6 Dec 1995. This is not an international exhibition (Art 55 EPC) and because the invention of C1 is geometrical, a view together with an explanation is likely to have been a complete disclosure, even though no written material was distributed. We are told it was non-confidential.

Therefore, to protect C1 and the gold elements (if they are still worth protecting), the priority of EPC 1 must be claimed. EPC 1 has a filing date (A 80 EPC) although the Application was withdrawn.

To protect the iron elements, any new application should also claim priority from EPC 4 filed on Feb 05 96. If the iron elements are not inventive over the disclosure of the gold elements, this disclosure could still cause problems because the priority date of the iron elements is after the date of the disclosure of the gold elements (which intervening disclosure is citable) (G 3/93).

Because the possibility of obtaining separate patent protection for the iron elements is doubtful, and because EPC 4 does not claim priority from EPC 1, there is little point in continuing with EPC 4, even if we are in time to pay the fees with surcharge. This is not a cost effective way of protecting the iron elements ; and the surcharge is large (50% - Rule 85(a)(1) and (2) and RRFees A2-3b).

We should therefore file a new European Application and a new US Application, PCT Application designating Europe and U.S. claiming priority from EPC 1 and EPC 4. This must be filed by 1996 Dec 01 (Sunday) → Rule 85(1) EPC 96 Dec 92 at the latest (A 87 EPC, A 4 Paris Convention, Article 8 PCT).

US Fees are heavy upfront, so to minimise expenditure in the near future and keep options open a PCT is advisable.

We want to keep the rights in the name of the holding companies therefoere the PCT Applicant will be CASINO (Swiss). This is no longer a problem for Chapter II. A competent receiving office (Swiss Patent Office, EPO, International Bureau must be used (A 10 PCT Rule 19 PCT).

Which language to file in must be considered.

The EPO will probably be the competent ISA (protocol on centralisation) and therefore dictates the language of filing (A 3(4)(i) PCT and A 16(2); Rules 12.1(a) and 35 PCT). The EPO will dictate GB, FR or DE and there is plenty of time to translate into one of these languages.

c) Fees on EPC 3

The fee for further processing RRF 2.
A renewal fee was due on 1996 February 28 (Tuesday) (Art 86(1) R 37(1) EPC) and presumably was not paid.
This is now due with 10% surcharge (RRF A 2-5) by 1996 August 31 Thursday (by J 4/91).

For the PCT Application, to cover the subject matter of EPC 1 and EPC 4, the following fees will be necessary (B amounts - R 96 Schedule PCT)

Basic Fee (Rule 15.2(a) PCT)

Designation Fees (Rule 15.2(a) PCT) (1 for EP-all states (R 15.i(ii) PCT) max = 11 (R 96 PCT Schedule).

Search Fee (Rule 16.1 PCT)

ZORBAS

a) As far as we know, the Greek Patent applications were allocated filing dates and are regular national filings (Paris Convention A 4(2)) and could form the basis for priority claiming European and US or PCT Applications.

b) We do not know whether the inventions have been disclosed, so it would be advisable to claim priority for each application.
ie file for GRZ1 on March 28, 96 Thursday.

This is probably too soon to obtain a translation into English for filing in US.

Therefore, file a PCT Application in Greek if possible in the name of ZORBAS Greek Receiving Office specifying a suitable ISA (Rule 12.1(a) PCT).

The Application(s) for GRZ2 need not be filed with 1996 June 30 (Sunday) - under Rule 85(1) EPC - 1996 July 01

Therefore translations can be obtained and either a PCT Appn or a separate European and US Applications could be filed.

c) For a PCT Application, the fees would be as discussed for the CASINO PCT Application.

If there has been a disclosure but the language requirements of the competent Searching Authority and R.O. make it impossible to file in Greek (check this in PCT Applicant's Guide, volume 2), a European Application can be filed in Greek (Art 14 EPC) by fax on the last day claiming priority (Notice OJ 6/92, 306-311) provided written confirmation is sent simultaneously or 1m from a communication.

For the US, there is a 1 year grace period so any disclosure since the filing of the priority appn. would probably be allowable.

FLEUR

a) It is too late to claim priority from FRF1 which was filed over 12 months ago (A 4 Paris Convention, A 8 PCT, A 87 EPC).

The invention has not been disclosed by FLEUR. However F1 is the same as Z1, which may have been disclosed, and for which we should be able to maintain a priority date of 1995 March 28; at least in Europe (see above).

Therefore, it is probably most sensible to pursue the ZORBAS application instead of the FLEUR one.

If language requirements make it impossible to claim priority in the ZORBAS application, either an application for the ZORBAS GRZ1 subject matter or this FLEUR application could be refiled as a PCT or EP & US Applications, (or an EP Appn only could claim priority as discussed previously).

II Concerns with DIABLO

Lamp L1 is the same as C2 (the lamp with iron elements).

EPL 1 covers arrangement J with iron elements
EPL 1 was filed between the filing dates of EPC 1 (arrangement J with gold elements subclaim) and EPC 4 (arrangement J with iron elements subclaim)

Therefore for the arrangement (J) and for (J) with gold elements CASINO have the prior European filing date.

For Europe :

Under A 54(3) EPC EPC 1 would be citable against EPL 1 for arrangement J for novelty, provided it is published. We are abandoning EPC 1 and filing another European Application or a PCT claiming priority from EPC 1. This will also be citable against EPL 1 provided it is published (A 158 EPC) but only for novelty. Therefore since J with iron elements is novel over J with gold elements, LEEK (DIABLO) max obtain a patent for J with iron elements. The priority date of our claim for the lamp with iron elements is 1996 Feb 05, while the priority date of EPL 1 is 1996 January 22. Article 54(3) will therefore prevent CASINO obtaining a patent for J with iron elements for GB, DE & FR, as for GB, FR & DE only (A 54(4)) EPL 1 is prior art for novelty purposes over CASINO's European patent (whether via a PCT or not).

In Europe therefore, it appears that CASINO will have the right to arrangement J for all states, and to the iron elements for all contracting states except DE, FR, GB. For these states DIABLO will have the right to the iron elements.

DIABLO will need a licence from CASINO to manufacture their iron element arrangement because (assuming a patent is granted to CASINO for all states for this concept) CASINO will own the master patent for arrangement J.

In return, CASINO could take a licence from DIABLO to manufacture the iron element arrangement in FR DE GB.

The U.S. has a first to invent system but we are not aware of any US interest by DIABLO at the moment.

Any conflict in the US would probably have to be resolved in interference proceedings. If we filed a PCT in the name of CASINO, it might be advisable to enter the National Phase in the U.S. early, because of A 64(4)(a) PCT. On the other hand, if we find out that DIABLO have U.S. interests, this could be a good reason to file direct in the US to obtain a filing date.