

GENERAL

The results this year show a marked improvement over those of previous years.

The provision of extra time seems clearly to have helped and this year there was less impression that the last parts of the papers had been rushed. Also, it seemed clear to some examiners that candidates they marked were better prepared for the examination.

The incomplete answers of some of the candidates to Part I showed that it is necessary to be familiar with the law before taking the examination and that it is not possible to rely on speed reading of texts during the examination itself. Some very bad Part I answers demonstrated that there were candidates who thought otherwise.

Yet again, it was clear that many candidates were using out of date revision material. If, on a subject, a legal advice or President's Notice is republished, this would normally indicate some change in the substantive content of the notice. Obviously, candidates need to keep their reference material current and up to date.

Candidates should also realise that inappropriate recommendations to the client, to use Art. 121 and/or Art. 122 EPC and/or to file an appeal, may cause them to lose marks.

PART I

Many candidates often failed to give fully the articles and rules or other source providing the basis for their answers. This is essential in Part I if full marks are to be obtained for a question.

- Q. 1. This was well answered by almost all candidates although some were sparse in their justification.
- Q. 2. (a) Many overlooked that this question related to the international phase and wrongly relied on the EPC instead of R. 90bis.3(a)PCT.
- (b) Some missed out specific required measures and others gave the requirements but not the legal basis. Far too many others thought the 30 month period had expired and that it was too late to do anything despite grace periods and no need for translation. However, many answered the question well.
- Q. 3. A basic knowledge question that was surprisingly incompletely answered by many. Candidates were not expected to guess the result of G4/98 and could obtain full marks without reference to this case, provided they knew the way the law has been interpreted to date.
- Q. 4. An amazingly large number of candidates were unaware of the extension of the period for filing the designation of inventor by late notification of the deficiency. As a result they were unaware that the designation had been submitted in time and launched into extensive unnecessary discussion of Arts. 121 & 122 EPC. What was worse, some of these candidates believed that Art. 121 EPC would be applicable.
- Q. 5. Generally well answered, although many overlooked that the provisions do not apply to granted patents beyond the opposition period for a) or at all for d). Also, the majority of candidates overlooked that in (b) the application could not have been published and would not appear in the register. They also overlooked that entry on the register could only be made after publication.

- Q. 6. This basic knowledge question caused few problems except for the surprising number of candidates who did not know that the deferred time limit of Art. 79(2) EPC for the designation fees does not apply to Euro-PCT cases.
- Q. 7. This was a very basic but important priority question which we had expected virtually all candidates to be able to answer. However, far too many were unaware of R. 85(3) EPC and thus of the possibility of obtaining extra time for claiming priority by filing in a Contracting State on the first working day after a holiday period, in that state, even if the priority term had already ended for the EPO. Some wrongly assumed that the holiday in France also extended the period for filing in the EPO to the same date and others wrongly applied Art. 122 EPC.

In real life, a great number of candidates would have lost priority for this client and would now be looking carefully at their professional indemnity insurance.

- Q. 8. Many answered this question well, with the main omission being the possibility of shortening the international phase under Art. 23(2) or Art. 40(2) PCT.
- Q. 9. The greatest problem for candidates was a lack of knowledge of the difference between the end of the opposition, by pronouncement of the decision in oral proceedings, and the start of the term for filing appeal, based on the written notification of the decision. Thus, many assumed the term for appeal had started with the decision in the oral proceedings and had, therefore, ended. For these candidates, once again, Art. 122 EPC was inappropriately applied.
- Q. 10. The most common mistake was the overlooking of the need for the extension agreement to be in force at the time of filing of the PCT application and for specific designation to have been made at that time. If some candidates knew this it was not clear from their answer and the basis for an answer is required for most, or any, marks to be given.

MODEL SOLUTION FOR PART I

Answer to Question 1

Yes, the European patent may be amended if the amendments are occasioned by a ground for opposition as specified in Article 100 EPC.

It is not necessary however, that the ground for opposition in question was actually invoked by the opponent, see Rule 57(a) or the Guidelines D.IV.5.3.

Answer to Question 2

- a) No, since the applicant may withdraw a priority claim only prior to the expiration of 30 months from the priority date, see Rules 90bis.3(a) PCT and Article 39 (1) PCT. The time limit to withdraw the first priority claim expired on 18.01.99, and hence prior to the current date of 24.03.99, it is thus not possible to withdraw the first priority.
- b) Yes. Although 31 months have expired, the national basic fee, the designation fee and the search fee for supplementary search may be paid with surcharge within the grace period of one month from the communication under Rule 85(a) EPC.
The examination fee may be paid with surcharge within one month of notification under Rule 85b EPC.
Furthermore, the translation of the application is not required since the PCT application must have been filed in English, see Rule 104b(1)(a) PCT.
The renewal fee for the third year should be paid before 30.07.99.

Answer to Question 3

- a) The filing fee and the search fee must be paid within one month after the filing of the application (see Article 78(2) and Rule 83(4) EPC), hence on or before 02.04.99 extended to 06.04.99 pursuant Rule 85(1) EPC.
The claims fee, according to Rule 31(1) EPC, must be paid for any European application comprising more than 10 claims and shall be payable within one month after the filing of the application.

- b) If the filing and search fees are not paid in time, a communication is sent to the applicant about the failure to observe the time limit, and these fees may still be validly paid within a period of one month, see Rule 85a(1) EPC with a surcharge of 50% (Article 2(3)(b) RRF). According to Article 90(3) EPC, if the fees are still not paid, the application is deemed to be withdrawn. In this case, the restitutio in integrum according to Article 122(5) EPC or further processing of the European patent application (Article 121 EPC) is not possible. If the claims fee is not paid in due time, it may still be validly paid within a period of grace of one month of notification of a communication pointing out the failure, see Rule 31(1) EPC. If the claims fee remains unpaid, the claims concerned are deemed to be abandoned, see Rule 31(2) EPC.
- c) Yes, priority from the EP application can be claimed. A European application is equivalent to a regular national filing (Article 66 EPC) by which is meant any filing that is sufficient to establish a filing date whatever may be the outcome of the application (Article 87(3) EPC). Every filing equivalent to a regular national filing is recognized as giving rise to a right of priority (Articles 87(2) EPC and 4A(2) Paris Convention).

Answer to Question 4

The applicant has 16 months after the filing date of the application to overcome the omission of designation of the inventor (Article 91(5) EPC), hence until 11.02.99, or within a minimum period of 2 months as from notification, therefore until 22.02.99, whichever period is longer, see Guidelines A.III.5.4 version of 1995 [A-III, 5.5 in version of July 1999].

The applicant should file a request for a decision pursuant to Rule 69(2) EPC within 2 months of notification, which is 27.05.99 (17.03.99 + 10 days + 2 months) and file a stamped receipt for documents as evidence that the designation was submitted in due time.

Answer to Question 5

- a) The record of the transfer, according to Rule 61 EPC is not possible since this rule only applies to patents against which opposition was filed, or where the time limit for filing an opposition is still running.
- b) Yes, but only after the publication of the application, see Rule 20 and Article 127 EPC.
- c) Yes, the European patent application may be transferred in respect of only one of the designated contracting states, see Rule 20 and Article 71 EPC.
- d) No, since Rule 21 EPC only refers to patent applications.
- e) Yes, see Rule 21 and Article 73 EPC.
- f) Yes, since the security right is a right in rem as indicated in Rule 21(1) EPC.

Answer to Question 6

The following fees are to be paid:

- a) Rule 104b(1)(b)(i) EPC: the national basic fee;
Rule 104b(1)(b)(ii) EPC: the designation fees, since the time limit of Article 79(2) EPC does not apply;

Rule 104b(1)(c) and Article 157(2)(b) EPC: the search fee as USPTO was ISA, but reduced pursuant Article 157(3)(b) EPC.

- b) Rule 104b(1)(b)(i) EPC: the national basic fee;
 Rule 104b(1)(b)(ii) EPC: the designation fees, since the time limit of Article 79(2) EPC does not apply;
 No search fee is required as the EPO was IPEA and must therefore have been ISA, hence no supplementary search is needed;
 Rule 104b(1)(d) EPC: examination fee, reduced by 50% as EPO was IPEA, see Rule 104b(6) EPC and Article 12(2) RRF;
 Rule 104b(1)(e) EPC: renewal fee in respect to the third year; and
 Rule 104b(1)(b)(iii) EPC: 3 claims fees.

Answer to Question 7

As the 14.07.98 was holiday in France, Rule 85(1) and (3) EPC applies, and therefore the priority period is extended until 15.07.98 if the filing proceeds at the INPI in Paris.

Thus, the patent attorney should ask the director in Montreal to fax him a copy of the application at once so that he can file it at the INPI today.

The application filed directly by the Canadian company should be withdrawn or abandoned.

Answer to Question 8

- a) Yes, in accordance with PACE: OJ 97 p. 340.
- b) Yes, any elected/designated office may on the request of the applicant proceed to the examination and other processing of the international application at any time, see Article 23(2) or 40(2) PCT.
 In the regional phase (before the EPO) a request for an accelerated prosecution may be filed under PACE.
- c) Yes, in case of infringement proceedings and on request of a party to the proceedings, see OJ 98 p. 361.
- d) Yes, parties with legitimate interest may request accelerated appeal, see OJ 98 p. 362.

Answer to Question 9

An intervention under Article 105 EPC should be filed by the company A. However, in accordance with G4/91, company A can only intervene in pending proceedings. Although the opposition proceedings are no longer pending since the opposition division has given a decision, an intervention by an alleged infringer is still possible during appeal proceedings, see G1/91.

Therefore, company A should inform B of the document D to persuade B to file an appeal. In accordance with Article 108 EPC, B should file the appeal within 2 months of notification of the decision.

Meanwhile, company A must intervene at latest by 14.06.99 (12.03.99 + 3 months = 12.06.99 Saturday), pay the opposition fee in accordance with Article 105(2) EPC and provide a reasoned statement referring to document D.

As a precaution, A should also pay an appeal fee to be an independent appellant in case B later withdraw the appeal. A will have to file the intervention before the appeal by B falls due.

However, in accordance with the decision G4/91, if B does not file an admissible appeal, the intervention has no legal effect and then only national proceedings are available for attacking the patent.

Furthermore, A's opposition and appeal fees will be refunded if B does not appeal.

Answer to Question 10

Romania and Macedonia are both PCT contracting states like EP and therefore are designated in the application.

A valid request for extension for Romania can still be filed since an extension agreement was concluded on 15.10.96, see OJ 94 p.75 and OJ 96 p. 601, National law relating to EPC, XI.
The time limit for payment of extension fee for Romania is 31 months from the priority date, hence expires on 02.07.99.

An extension cannot be validly made for Macedonia since the extension agreement was only concluded as from 01.11.97, which is after the PCT filing date.

Paper D Schedule of marks

Question	Maximum Possible	Marks awarded		Marking by further examiners	
		Exr	Exr	Exr	Exr

PART I

1	2				
2	6				
3	4				
4	4				
5	6				
6	4				
7	4				
8	4				
9	7				
10	4				
Total Part I	45				

PART II

A1	10				
A - FR	10				
B - PCT I	4				
B - PCT II	8				
Z1	11				
Z2	12				
Total Part II	55				

Total Part I + II 100					
------------------------------	--	--	--	--	--

	PASS
	COMPENSABLE FAIL
	FAIL

Munich, 10 September 1999

I. Muir - Chairman of Examination Committee III