
Candidate's Answer on Paper D, Part I

1. Yes, for international applications filed after 1 July 1998. Rule 94.2 PCT & A. 38 PCT.
(EPO permits access to files of EP applications – A. 128 EPC – Re Rule 94.3 PCT)

2. It is unlikely that the patent will be revoked because, according to G 8/93, the withdrawal of an opposition by the opponent, who is sole appellant, terminates the appeal proceedings irrespective of whether the proprietor agrees to the termination or whether the patent meets the requirements of the EPC.

Despite the provisions of R. 66(1) EPC, R. 60(2) EPC which permits the EPO to continue opposition proceedings of its own motion after withdrawal of those proceedings, is not applicable to appeal proceedings. Also see G 7/91.

You should be aware, however, that the patent would be vulnerable to revocation under national law in the designated contracting states in which it has entered into force. A. 138 1(a) EPC provides that a patent may be revoked under national law for lack of novelty under A. 54(EPC).

3. At the European patent office at Munich or its branch at The Hague (A. 75(1)(a) EPC) or its sub office in Berlin (notice of President of EPO of 10/5/89).

The Spanish attorney may file in English, French or German at any of the above offices A. 14(1) EPC.

He may not file in any of the other languages permitted by A. 14(2) EPC because the applicant does not meet the requirements of that Article, assuming that the Argentinian company does not have its principal place of business in Spain. If the company does have its principal place of business in Spain the application could be filed in Spanish (A. 14(2) EPC).

Application could also be filed in Spain, pursuant to A. 14(2) EPC & Nat. law relating to EPC section II – in any language permitted under either A. 14(1) & (2) EPC ie English, French or German or official language of contracting state where company has principal place of business. If application is filed in Spain in a language other than Spanish it appears that a translation into Spanish is required (national law).

4. R. 104 b(d) EPC requires a request for examination to be made within a period 21 months from priority where A. 22(1) & (2) PCT apply – as in the case here – unless the time limit under A. 94(2) EPC expires later.

Period 21 months from priority expires 5/2/99.

A. 94(2) requires a request for exam to be filed up to the end of 6 months from when the European patent bulletin mentions the publication of the European search report. Under A. 157(1) EPC, publication of the international search report shall take the place of the European search report and the mention of its publication in the European Patent Bulletin.

Therefore period for filing request for examination under A. 94(2) EPC expires 6 months from 5 November 1999, ie 5 May 1999, extended to 6 May 1999 under Rule 85(1) EPC.

ie latest date for filing exam request w/out surcharge is 6 May 1999.

Date of publication of supplementary search report is irrelevant.

5. a) No. Guidelines C VI 15.1.2. No further R. 51(4) EPC communication is issued if the Examining Division consents to the proposed amendments without revision.

Also see notice of EPO OJ 1-2/1989, 43.

- b) Divisional applications must be filed "up to approval of text, in accordance with R. 51(4) EPC" – R. 25(1) EPC.

Submitting amendments to text, in response to R. 51(4) communication would be deemed approval of text were patent subsequently is granted for the amended text.

Divisional must therefore be filed, at latest, when responding to R. 51(4) EPC communication.

6. Requirements to obtain a filing date are set out in A. 80 EPC.

- a) Looking at requirements of A. 80 EPC:

Request form provides an indication that a patent is sought.

Request form contains an indication that all states are designated.

I assume that the applicant has been identified on the request form.

English is referred to in A. 14(1) EPC.

All requirements are met except need for one or more claims.

Application will not, therefore, receive filing date of 1/3/2000.

Claims were filed on 21/3/2000. This is within the 1 month term permitted in R. 39 EPC. Requirements for filing date were therefore met on 21/3/2000.

Application will be given filing date of 21/3/2000.

- b) Filing date of 1/3/2000 will be given.

Requirements of A. 80 EPC are met because description and claims are in same, allowable, language. The language of text matter in the drawings is not relevant to the accordance of a date of filing – such parts must be corrected if they do not comply with A. 14 EPC – J 7/80, T 382/94.

- c) Filing date of 17 March 2000 will be accorded.

Filing in Latvia does not meet the requirements of A. 80 EPC, because Latvia is not a contracting state to the EPC. Therefore Latvian is not a permitted filing language under A. 14(2) EPC.

Requirements of A. 80 are first met on filing the German translation – German being permitted under A14(1) EPC.

7. Probably.

An appeal must be filed in writing within two months after the date of notification of the decision appealed from A. 108 EPC. This period runs from the date of notification of the written decision – Guidelines E III 9.

Under normal circumstances the decision would be notified by registered letter (R. 78(1) EPC) and notification would be deemed to have taken place on the tenth day following posting (R. 78(2) EPC) ie by 13/12/99.

The two month period would therefore have ended 13/12/2000 (R. 83(4) EPC) but been extended to 14/2/2000 under R. 85(1) EPC – notice of president of 17/9/99.

It would therefore be too late to appeal on 3/2/2000.

However, because I am appointed as representative and was before despatch of the decision the decision should be notified to me under R. 81(1) EPC.

Under T 703/29, because the provisions relating to notification have not been observed (ie the provisions of R. 81(1) EPC), the question of whether notification has effectively taken place depends, in accordance with R. 82 EPC, on whether I have received the decision.

On this basis I only received the decision on 3/3/2000. Notification therefore only took place on that date, leaving until 3/5/2000 to appeal.

Nevertheless, for safety a notice of appeal including an explanation of the circumstances ought to be filed as soon as possible.

8. a) The applicant is required to file either a translation of the priority document or a declaration that the application is a complete translation of the priority document within a period set by the EPO or at the latest under the time limit under R. 51(6) EPC. (R. 38(4) EPC).

The EPO will not normally request the translation or declaration earlier than the deadline under R. 51(6) unless it is required to examine whether the priority claim is effective. Guideline C V 3.2 last paragraph.

I would propose filing a copy of the article at the EPO along with observations – under A. 115 EPC – drawing attention to the potential relevance of the article. The Examining division should then request filing of a translation or declaration (probably translation in view of application containing more text than JP application – G. C V 3.2 penultimate para) to enable the priority claim and hence relevance of article to be examined.

The cost of the translation would thus have to be borne by the applicant.

- b) It may still take some time to obtain the translation and it may not be requested by the EPO if the Examining division does not consider the article to be relevant.

Also, the suggested approach would mean showing the prior art to the applicant (A. 115(2) EPC). Client may prefer to keep it "up his sleeve" until relevance could be assessed.

However, if prior art is relevant, but examining division did not take notice of it (client would not be party to proceeding though filing observation) an opposition could subsequently be filed.

Since prior art is, in any event, in the public domain there does not seem to be any harm in submitting it to the EPO. Observations under A. 115 EPC can be made anonymously.

9. A. 100(c) EPC provides that an opposition may be filed on the grounds that the subject matter of the European patent extends beyond the content of the application as filed.

Also see Guidelines D V 5.1.

If the parameter range was not disclosed either explicitly or implicitly in the application as filed then it would appear to be added subject matter in the sense of A. 123(2) EPC and A. 100(c) EPC. As such, it would seem that the opposition will be likely to be successful, at least in relation to claim 1 as granted.

Client should be aware, however, that if the range is not necessary to distinguish over the prior art the competitor may be able to amend his patent to overcome the opposition.

However, removal of the range from claim 1 would probably be inadmissible in view of A. 123(3) EPC. Competitor could therefore be in a trap where he could not amend to remove the added matter, see G 1/93 and Guidelines D - V 6.1.

In this case prospects for successful opposition look good.

10. Obvious errors in application documents filed at the EPO can be corrected under R. 88 EPC.

However, according to Guideline C VI 5.9 requests for correction under R. 88 EPC can only be considered until the decision to grant has been handed over to the EPO's internal postal service, also see G 12/91.

Nor can the patent be amended under R. 86 EPC or A. 123(1) EPC at this stage.

G 7/93 permits minor amendments after issue of the R. 51(6) communication in exceptional circumstances. However, since amendment is minor and obvious patentee does not seem to be disadvantaged. Also, patent has been published EPO are unlikely to republish now. Further, since expiry of the opposition term the EPO no longer has responsibility for the case, patent(s) are now governed by national law.

Applicant should try to correct error before national offices where the patent has been entered into force.

11. Term for responding to written opinion expired 20/3/00 – R. 80.2 PCT, calculated from date of despatch of opinion.

-- deadline has been missed

However, this will not result in the application being rejected because the results of international preliminary examination are not binding on the elected (or designated offices). A. 33(1) PCT.

Failure to address objections may result in unfavourable international preliminary examination report but this is not in itself detrimental, it might mean, though, that objections are raised during the national/regional phase.

It may, however be possible for arguments filed now to be taken in account in the IPER which does not need to be established until at least 28 months from the priority date, ie 16/6/2000 – R. 69.2(i) PCT. Authorities do not need to consider any amendments or arguments submitted after the deadline for response to the opinion though, R. 66.4 PCT.

Advice is:

missing deadline is not fatal.

might still be able to have amendments/arguments taken into account. Suggest contacting IPEA to see if they would consider these at this stage. If not, might consider filing amendments and arguments (where possible) on entry into nat./regional phase to speed matters up. A. 41 R. 78 PCT & A. 28, R. 52.

Time limit for filing amendments in nat./regional phase is at least 28 months from priority under R. 52 PCT, ie 16/6/2000, R. 80.3 PCT.