

Examiners' Report Paper D – 2001

Part I

- Q1: This question was generally well answered. Some candidates omitted to provide sufficient legal basis for supporting their justification (eg by citing G3/89 and/or G11/91).
- Q2: The mention of filing the request for apportionment of costs during oral proceedings, before a decision, was very often overlooked by candidates. Moreover, the fact that the opponent informed at the last moment that he would not attend the oral proceedings was rarely regarded as a possible abuse of procedure. Many candidates failed to distinguish between request for fixing of costs and request for apportionment of costs.
- Q3: This question was generally well answered but most candidates neglected to mention that sending copy of the article to the Examining Division would be appropriate for proving that the abstract is erroneous.
- Q4: The majority of candidates missed out that sufficient evidence of personal interest in proceedings should be required. Many candidates failed to realise that the objection should be raised asap, before taking any further procedural steps.
- Q5: The candidates encountered no major difficulties with this question. Some of them surprisingly wrongly fixed the time limit of 31 December 2000 instead of 31 December 2001. Their opinion was founded on the false belief that the last payment made in 1995 caused lapse of the patent at the end of 1995. Some others correctly cited the provisions of Rule 95a(4)(c) EPC but failed in applying them to the specific case, ending with a wrong date (typically March 2001).
- Q6: This question raised no major problems to the candidates.
- Q7: Inappropriate recommendations to the client to use Article 121 and/or Article 122 EPC caused the candidates to lose marks. In part (a) some candidates failed to point out that a missing inventor's address is regarded as a minor deficiency according to the Guidelines A-III, 5.5. This mistake resulted in wrong conclusions about both legal consequences and legal remedies. Regarding part (c) numerous candidates failed to acknowledge that in the case of an international application the time period was set by the EPO and is therefore extendable under Rule 84 EPC.

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- Q8: No major mistakes were made in answering this question. Maybe the greatest mistake was to fail to realise that national law determines whether the infringer could be sued at once or only after the grant of the patent.
- Q9: The most common error made by the candidates was the lack of acknowledgement that, contrary to the request for further processing, the payment by cheque could not be considered as having been made in due time and therefore resulted in a surcharge of 10%.
- Q10: Parts (b) and (c) caused some problems to the candidates.
Part (b): The candidates often seemed not to have realised that a divisional application could still be filed if an appeal is pending (the last day for filing the appeal being 28.03.2001).
Part (c): Too many candidates were not aware of decisions J36/92 and J27/94.
- Q11: Few candidates provided a satisfactory chain of reasoning showing why and how the time limit for entering the regional phase should validly be calculated on the basis of the new priority date of 15 September 1999. Some candidates wrongly assumed that the time limit for entering the regional phase had lapsed and suggested to rely on Rule 85a EPC, resulting in unnecessary payment of fees. Very few candidates correctly noted that withdrawal of the priority is valid because within the 20-month-period (Rule 90bis,3(a)PCT).

Model solution for Paper D – 2001

Part I

Answer to Question 1

For EP1, yes, in accordance with Article 14(2) EPC and Article 70(2) EPC (Guidelines A-VIII, 5.2).

For EP2, correction in accordance with Article 14(2) EPC would not be possible since the application has been filed in English. However Rule 88 EPC, subject to G3/89 and G11/91, could apply, see Guidelines C-VI, 5.9.

Answer to Question 2

During oral proceedings, file a request for apportionment of costs pursuant to Rule 63 EPC, Article 104(1) EPC. There could well be an abuse of procedure on the part of the opponent (Guidelines, D IX 1,4). Request should be for all costs incurred for the oral proceedings to be borne by the opponent.

Answer to Question 3

The objection is unfounded. Argue in accordance with T 77/87 that the abstract does not correctly reflect the article and that there is a substantial inconsistency between them. Consequently, the disclosure of the article should prevail. Provide evidence that the disclosure of the abstract is itself erroneous by sending a copy of the article.

Answer to Question 4

Members of opposition division are also subject to requirement of impartiality, G 5/91, Article 24 EPC.

Request should be filed as soon as possible but sufficient evidence of personal interest in proceedings would be required, T143/91.

Answer to Question 5

- a) The files relating to a European patent may be inspected on request, subject to the restrictions laid down in the Implementing Regulations (Article 128(4) EPC).

Under Rule 95a(4)(c) EPC (as in force from 01.01.1999; see OJ EPO 1999, 305 ff), files relating to European patent applications and patents must be preserved for at

least five years from the end of the year in which the patent lapses in the last of the designated States.

Since renewal fees are payable in respect of the coming year, the last payment made in 1995 caused lapse of the patent in 1996. Hence the file could be inspected at the EPO at least until 31 December 2001.

- b) In accordance with Rule 95a(5) EPC it would be possible as long as the files on the patent granted on the divisional are preserved.

Answer to Question 6

- a) Two fees will be refunded: a maximum of seven designation fees are due, Article 2(3) Rules relating to Fees.
- b) One fee will be refunded: in accordance with Article 2 (3a) RFees, only one common fee is to be paid for the Swiss Confederation and the Principality of Liechtenstein.
- c) Article 79(3) EPC, last sentence: designation fees shall not be refunded where application is withdrawn.
- d) All seven designation fees are to be refunded, due to the fact that they were paid without legal basis. Guidelines A-XI, 10.1.1.

Answer to Question 7

- a) Designation of inventor (Article 81 EPC) is validly filed, but contains a minor deficiency (incomplete address = formal deficiency; Rule 17(1) EPC). The period for correcting the deficiency is therefore set by the EPO (Article 91(2) EPC; minimum period of two months; Rule 84, first sentence, EPC). Rule 84 EPC period set by the EPO, not yet expired. Extension of period on request.

Legal consequence = refusal of application Article 91(3), first sentence, EPC.

Legal remedies: Further processing: Article 121 EPC (time limit set by the EPO and total loss of rights). Re-establishment of rights: Article 122 EPC.

(Guidelines A-III, 5.5).

- b) Designation of inventor (Article 81 EPC) is not validly filed. The following are required: name and address of inventor, statement of origin of the right to the patent and signature of applicant (Rule 17(1) EPC, Guidelines A-III, 5.5). Lack of signature of applicant is a major deficiency – designation of inventor is deemed not to have been filed. Notification in accordance with Article 91(1)(f) and (5) in conjunction with Rule 42(1) EPC. Corrected designation to be filed within 16 months of priority date (= 27 November 1999), ie by 27 March 2001 or within a period of 2 months whichever is the longest (Guidelines A-III, 5.5).

Time limit of two months should thus be granted by the EPO. Time limit expired on 1 April 2001, extended to 2 April 2001.

Regular time limit not set by the EPO in this case. Article 91(5) EPC contains statutory time limits. No extension of time limit possible under Rule 84 EPC.

Legal consequence = application deemed to be withdrawn in accordance with Article 91(5), first sentence, EPC.

Legal remedies: only re-establishment under Article 122 EPC. No further processing under Article 121 EPC, as it does not apply to a statutory time limit.

- c) Legal consequence = application deemed to be withdrawn in accordance with Article 91(5), first sentence, EPC. However, in this case the period is set by the EPO under Rule 107(1) EPC and Rule 111(1) EPC. The time limit expired on 26 March 2001, extension (Rule 84) no longer possible.

Legal remedies: Further processing under Article 121 EPC and re-establishment under Article 122 EPC.

- d) In this situation the time limit expired on 26 March 2001. However, the application is deemed to be withdrawn in accordance with Article 91(5), first sentence and Rule 42(2) EPC.

Legal remedies: The period is set by the EPC and thus not extendable. (Guidelines A-IV, 1.5, and A-III 5.5.) No further processing possible under Article 121 EPC. Only restitutio in integrum, Article 122 EPC.

Divisional application may be refiled.

Answer to Question 8

Check the patent situation of the client and competitors, search report, prior art.

To enjoy provisional protection the application must be published, Article 67(1) EPC.

Publication will take place at the latest in August 2001, but earlier publication can be requested under Article 93(1)EPC.

From the publication date the client has provisional protection in countries with French as an official language. To obtain provisional protection in the other designated contracting states a translation of the claims may be required. Article 67(3) EPC and National law relating to EPC 1999, page 37.

Whether she can sue the infringer at once or only after the grant of the patent depends on national law. A request should be filed for accelerated procedure under PACE.

Notify infringer.

National laws may enable infringer to argue good-faith if infringement before publication of the application.

Answer to Question 9

The Rule 69(1) EPC communication is deemed to have been delivered on 27.10.2000, Rule 78(2) EPC; hence the time limit for further processing expired on 27.12.2000.

The letter containing the request for further processing and the response to communication of the examining division is deemed to have been received in due time since it was posted 5 days before expiry of the time limit and was sent as registered mail. Rule 84a EPC and Decision of the President of the EPO dated 11 December 1998, OJ EPO 1999, 45/Guidelines E-VIII, 1.7).

In the case of the cheque, payment is considered to have been made to the Office on the date of receipt of the cheque, ie 29.12.2000, Article 8(1)(b) RFees, which is after expiry of the time limit.

Hence the 10% surcharge is due. In accordance with Article 8(4) RFees.

The sum of EUR 76 was not sufficient to pay the fee for further processing; a surcharge of 10% on this fee (Article 8(3)(b) RFees) should have been paid.

In accordance with Article 8(4) RFees the EPO may issue a communication requesting the applicant to provide evidence of the date on which the second letter was posted and to pay the surcharge of 10%.

Answer to Question 10

- a) The divisional application is invalid because the loss of rights in respect of the parent application is deemed to have occurred on expiry of the normal time limit for filing a request for examination, J 4/86. Thus the parent application is no longer pending when the divisional application is filed.
Rule 25(1) and Article 94(3) EPC.

Re-establishment of rights in respect of the time limit under Article 94(2) EPC is not possible (Article 122(5) EPC); nor is it possible in respect of the period of grace in Rule 85b EPC (J 12/82: period of grace cannot change the nature of the basic period).

Further processing in accordance with Article 121 EPC is also excluded because of a statutory time limit.

- b) To file the divisional application the first application has to be still pending (Rule 25(1) EPC). However, according to Article 106(1) EPC, (Guidelines A-IV 1.1.4) a divisional can still be filed during the appeal procedure.

The time limit for filing the appeal expired today, 28.03.2001. File the notice of appeal per fax and pay the appeal fee today.

The appeal on the first application can be abandoned after having filed the divisional application.

- c) The divisional application has been validly filed. Where an applicant approves the text of a European patent application pursuant to Rule 51(4) EPC and in the same letter states that he had that day filed a divisional application, the filing of the divisional should be allowed, whether or not it is actually received by the EPO on the same day as the letter. (See J 36/92 and J 27/94).

Answer to Question 11

Yes. The time limit for entering the regional phase expires 21 or 31 months as from the first priority date (Rule 107(1) EPC), depending on whether or not a demand has been filed prior to the expiration of the 19th month from the priority date (Article 39 PCT).

In the present case, the 19-month period expired on 10.01.2001. Withdrawal of the 1st priority on 19.01.2001 did not affect this time limit, as it had already expired (Rule 90bis.3(d) PCT).

For the priority however, the withdrawal is valid, since it was done prior to the expiration of 20 months from the priority date (Rule 90bis.3(a) PCT).

The entry into the regional phase by 21-month period as calculated from the 1st priority date only expired on 10.03.2001, i.e. after the withdrawal.

Hence, in accordance with Rule 90bis.3(d) PCT, the 21-month limit under Article 22 PCT now runs from the new priority date, namely 15.09.99 (Article 2(xi) PCT) and expires on 15.06.2001.

The regional phase can thus still validly be entered by taking the steps according to Rule 107(1) PCT.

EXAMINATION COMMITTEE III

Candidate No.

Paper D Schedule of marks

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

PART I

1	2				
2	2				
3	3				
4	3				
5	3				
6	4				
7	7				
8	5				
9	5				
10	6				
11	5				
Total Part I	45				

PART II

NF-EU1	12,5				
B-EU1, EU2	14				
EXPLOITATION	4				
STOP NIFFY	4				
DIV	15,5				
FEUCHT	5				
Total Part II	55				

Total Parts I + II	100				
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Examination Committee III agrees on marks and recommends the following grade to the Examination Board:

PASS (50-100)

FAIL (0-49)

COMPENSABLE FAIL

(45 - 49, in case the candidate sits the examination for the first time)

Munich, 6 September 2001

G. Checcacci, Chairman Examination Committee III