

Candidate's Answer – DI

1. Yes. Rule 18 EPC states that the inventor's name will be published unless he waives his right to be mentioned. A-III, 5.1 of the Guidelines: the waiver must be received in time to be effective, ie before publication and before technical preparations have been completed under Rule 48 EPC.

I therefore recommend filing a waiver of Mr Man's rights under Rule 18 EPC in good time before seven weeks prior to 18 months from priority as this is when technical preparations for publication are completed (Rule 48(1) EPC and OJ EPO 1993, 55.

2a) Rule 90 EPC applies. The applicant was not able to act due to legal reasons (Rule 90(1)(b) EPC) so the proceedings are automatically interrupted from the date of incapacity, 5 December 2001. Bankruptcy is included within Rule 90(1)(b) EPC – J 7/83, J 26/95.

I would therefore write to the EPO immediately to inform them of the bankruptcy and request interruption from 5 December 2000 to 19 March 2002.

Response to communication: communication (96(2)) was issued after the interruption. The 4 month period begins again on 19 March 2002 (Rule 90(4) EPC). A response must be filed by 19 July 2002 (Friday).

Renewal fees: the renewal fee was due on 31 May 2001 (Art. 86(1) EPC and Rule 37(1) EPC). The time limit for paying renewal fees does not begin again (Rule 90(4)) after interruption, nor is it interrupted since it is not a "time limit", J?/87 OJ EPO 1988, 323, but the due date is deferred to the date proceedings are resumed (J?/87), 19 March 2002. This has passed, but the renewal fee can still validly be paid with a 10% surcharge (Art. 86(2) EPC) up to 19 September 2002.

The date of resumption of proceedings is set by the EPO (Rule 90(2) EPC). However, for the purposes of these time limits, I have assumed that proceedings are resumed on 19 March 2002, the earliest date on which resumption could take place. If a later date were set by the EPO, further time may be allowed and it may be possible to pay the renewal fee without the surcharge of Article 86(2) EPC.

2b. If bankruptcy did not bar action, Rule 90(1)(b) EPC does not apply (Rule 90(1)(b) EPC requires "prevented from continuing proceedings").

96(2) communication:

96(3) communication was notified on 28 December 2001 (Rule 78(2) EPC). Two months from this date has already expired so further processing cannot be requested (deadline 28 Feb 2002, Art. 121). Restitutio is also not possible as this must be requested by two months from receipt of the 96(3) communication (Art. 122(2); Rule 78(2) does not apply – J 7/82), assuming the Rule 96(3) communication was the cause of non-compliance. The application cannot be saved, in this case.

Renewal fees: due 31 May 2001 or 31 November 2001 under Art. 86(2) EPC with surcharge. Assuming cause of non-compliance removed on receipt of 14 October communication, two month deadline for requesting restitutio has passed.

The only possibility for saving the application would be if the applicant only became aware of missing the deadlines for paying renewal fees and for responding to the communication on 19 March 2002 when bankruptcy proceedings terminated. This would be the case if, for example, the communications under Article 86(2) EPC and Article 96(3) EPC were not received by the applicant.

In this case, we should request restitutio in the terms for responding to the 96(2) communication and paying the renewal fee, pay the fees for restitutio and the renewal fee and file the response to the 96(2) communication within two months of 19 March, thus 19 May 2002, extended to 21 May 2002 (Rule 85(1) EPC) and prove all due care was taken (Art. 122(1) and (2) EPC).

nb – the 1 year periods from the initial deadlines of 21 November 2002 and 31 May 2002 have not yet expired (Art. 122(2) EPC).

3.1) Yes. A priority claim can be added under Rule 26bis PCT. The convention year (12 months) had not expired. Filing date of 19 December 2001 is within 12 months of 27 December 2002 (Art. 8(2)(a) PCT and Art. 4A and 4C Paris Convention).

Priority can be claimed from a utility model – Article 4F(2) Paris Convention.

The priority claim must be added by 27 April 2002, extended to 29 April 2002 (Rule 80.5 PCT) (Rule 26bis.1(a) PCT) as this is 16 months from the earliest (here the new priority date).

3.2) The certified copy is due by 27 April 2002, extended to 29 April (Rule 80.5 PCT) – Rule 17.1(a) PCT. If the certified copy is received by the int. Bureau before the application is published at 18 months (not before 27 June 2002) it will be deemed received in time Rule 17.1(a). If the certified copy is available by then we should submit it directly to the international Bureau.

Even if the certified copy is not available by then, each designated or elected office must give the applicant an opportunity to furnish the certified copy in the national phase (Rule 17.1(c) PCT).

4. Demand:

The applicant lives in England which is a State bound by PCT Chapter II, so he is entitled to file a demand (Article 31(2)(a) PCT). The application was also filed with a valid receiving office under Article 31(2)(a) PCT.

Article 31(6)(a) – the demand should be submitted to the competent IPEA which is the EPO (Protocol on Centralisation, Section II).

The demand has been submitted to the receiving office not the IPEA but will be forwarded to the EPO as IPEA under Rule 59.3(c) PCT or to the international Bureau under Rule 59.3(a) PCT. In either case, the receiving Office will date stamp the demand on the date of receipt (Rule 59.3(a) PCT) and this date is deemed the date of receipt by the IPEA (Rule 59.3(e) PCT). The demand was therefore validly filed within 19 months from the priority date.

Last date for entry into US national phase is 30 months from priority (Article 39(1)(a) PCT) ie 18 March 2002, which has passed. The US national phase cannot validly be entered.

Last date for entry into the EP Regional phase is 31 months from priority (Article 39(1)(a) PCT and Rule 107(1) EPC), 18 April 2002.

5.

a) Yes, Art. 45(2) EPC

Not excluded under Art. 55(1)(a) EPC as evident abuse as A's application was not filed within 6 months of the disclosure (G 3/98 – priority date is not relevant to 6 month period). There is evident abuse under Art. 55 as there is intent to harm (Guidelines C-IV, 8.3).

b) Not state of the art under Art. 54(2) EPC. Published prior to A's filing date, but publication was through evident abuse and so Article 55(1)(a) applies. A's application was filed within 6 months of the disclosure (G 3/98).

Not state of the art under Art. 54(3) EPC, as publication is as a result of evident abuse. Article 54(3) requires a valid publication under Article 93 EPC which has not taken place here. See also Guidelines C-IV, 8.3 (Article 55(1)(a) EPC applies to a published application). The earlier application will not be taken into consideration.

5c) Not Art. 54(2) EPC prior art as published after A's filing date.

Not state of the art under Art. 54(3) EPC, as for (b).

6a) M1: on publication of EP1, 6 June 1998 (Article 67(4) EPC). The rights conferred on publication depend upon national law.

M2: on publication of EP2, 11 November 1998 (Article 67(4) EPC). No protection on publication of EP1 as protection is only conferred in respect of claimed subject matter (Art. 2(2) EPC + national law).

M3: at mention of grant of EP2, 10 May 2001. No Article 67(4) protection as the claim was not published in EP2 in 1998. Art. 64 EPC therefore applies.

Note: national law determines the protection provided on publication. Translation of the claims may be required in some states, Article 67(3) EPC.

6b) Assuming all renewal fees are paid, both EP1 and EP2 expire 20 years from filing (Art. 63(1) EPC), on 12 December 2017. Article 76(1) EPC provides that the date of filing of EP2 is the date of filing of EP1 since no subject matter was added to EP2 on filing (it contains the same description as Ep1).

7a) Priority date is valid.

Art. 87(1) EPC – can claim priority within 12 months of earlier filing. 12 m expires on 16 Feb 2002, but is extended to 18 Feb 2002 (Rule 85(1) EPC). The claim is filed in time.

The claim was correctly in the request for grant (Rule 26(2)(g) EPC).

That the Dutch application was subsequently deemed withdrawn does not matter – Art. 87(3) EPC.

b) The priority claim is not valid, and probably cannot be corrected. The declaration was not filed in time as the 19 March 2002 letter will not have been received within the 12 month period of Art. 87(1) EPC.

A correction under Rule 88 EPC to add the priority claim is unlikely to succeed, but may be allowable following J 9/91 (Omission of a priority claim is almost always an error). J 6/91 – the burden of proving the facts is heavy. A correction should be requested before publication and in time for the priority claim to be included in the publication – J 14/82.

7c) The priority claim is not valid but can be corrected.

The declaration was made in time under Art. 87(1) EPC (see(a)) and was correctly in the request for grant under Rule 26(2)(g) EPC, but the declaration does not correctly indicate the date or state of the earlier application.

The date and state can be corrected under Rule 88 EPC but this must be done in time to publish the corrected priority claim, J 14/82, J 6/91. 18 Feb 2001 is a Sunday which may help to show that the original declaration was erroneous.

8. Yes, if the request was sent by airmail and using one of the recognised delivery services (Guidelines E-VIII, 1.7), and OJ EPO 1999, 45 – Decision of the President.

Rule 84a applies. The request will be deemed received in time as it was delivered to delivery service 6 days before the deadline (deadline for claiming priority is 10 October 2001 – Article 87(1) EPC). It was received within 3 months of the deadline. The priority declaration was therefore deemed to be made within 12 months (Article 87(1) EPC) from the priority date.

A certified copy of the priority application need not be filed since it is available to the EPO under Rule 38(4) EPC (OJ EPO 1999, 80 – Japanese patents are included in the file free of charge).

Ms Sumo must either provide a translation of the priority document (Article 88(1) EPC) or, more simply, a declaration under Rule 38(5) EPC that the European application is a direct translation of the Japanese application. The translation or the declaration must be

filed within the period for replying to the Rule 51(6) communication or earlier if required by the EPO (Rule 38(5) EPC). This will complete the requirements of Article 88(1) EPC.

9. Yes, furthermore the appeal fee should be refunded.

Unity of invention is not a ground of opposition under Article 100 EPC, further G 1/91 states that unity of invention is irrelevant in opposition proceedings even if the patent as amended does not meet the requirements for unity.

The Opposition Division's decision to revoke the patent on this ground is therefore a substantial procedural violation.

I therefore recommend that we file a notice of appeal and pay the appeal fee by 18 May 2002 (Article 108 EPC) (extended to 21 May 2002 under Rule 85(1) EPC). We should also request a refund of the appeal fee under Rule 67 EPC setting out our reasons.

The Opposition Division may well rectify its decision under Article 109 EPC (interlocutory revision) and, since the dependent claims 2 and 3 appear to be patentable, will maintain the patent as amended.

The refund of the appeal fee should be allowed since it is equitable according to Rule 67 EPC.

10a) Yes, a Greek lawyer may act as the professional representative as long as he is entitled to act as a professional representative in patent matters under Greek national law (Article 134(7) EPC). Mr Ouzo must also file a signed authorisation under Rule 101(1) EPC.

b) The IPER was prepared by the EPO, so a 50% reduction in the examination fee is obtained (Rule 107(2) EPC).

Mr Ouzo is entitled to use Greek for the examination request as he is of Greek nationality (Article 14(4) and (2) EPC) and a 20% reduction in the examination fee is given under Rule 6(3) and RFees 12(1) EPC.

The total fee payable is reduced by 50% and the thus reduced amount is reduced by 20% (Notes III, 6.2 to Form 1200). If the regional phase were entered today, 20 March 2002, the total fee would be EUR 1430, with 40% of this total payable.