Examiners' Report Paper D – 2002

General Remarks

When a specific question is asked, a specific answer is expected. Some candidates appear to waste valuable time to address issues that are not relevant to the questions given. Some others try to give comprehensive answers covering different specific questions (especially in part DII), very often confusing different issues and thus losing points.

Marks are given for providing answers, not for simply repeating the facts given in the questions.

Citing articles, rules, decisions etc. is not per se an answer. Citations should support the answers, not take their place.

Candidates should not apply EPC provisions to PCT situations, and viceversa.

Candidates should pay more attention to time calculations.

Finally, candidates are free to chose the order they prefer to give their anwers; however, in DII, the order of the questions is chosen to make it easier to address all the necessary aspects in a logical progression.

Part I

Q1: This question was generally answered well. Many candidates, however, missed marks by not mentioning that the inventor's request has to be filed with the EPO before the technical preparations for publication are completed.

Q2: Many candidates had difficulties with this question. It was generally missed for part (a) that prudently the provisions of Rule 90 and Art. 122 EPC needed to be applied. The effect of Rule 90 was generally not well understood. Furthermore, hardly any candidate addressed the payment of the fourth renewal fee. Few candidates saw that each of the two requests under Article 122 requires the payment of a respective fee. For part (b), many candidates failed to realise that restitutio can be successful in a situation where an applicant can show that severe financial problems stopped him from taking actions.

Q3: For part (1), most candidates found that Rule 26bis1.a PCT is relevant for this case. However, some did not correctly calculate and compare the two time limits of four and 16 months, and particularly failed to appreciate that the time limit having the later date applies. For part (2), only few candidates mentioned the possibility of Rule 17.1c PCT according to which the priority document can be filed with the national or regional offices.

Q4: The question was generally well answered. Those few candidates who were completely unaware of Rule 59.3 PCT normally still received marks for applying the provisions of Article 39 (1) PCT.

Q5: Most candidates saw that this is a situation falling under the provisions of Article 55 (1) EPC. Most candidates also correctly applied the calculation of the six-month period according to G3/98 and G2/99. Consequently, part (a) was

generally well answered. Most candidates, however, did not realise that Article 54 (1) EPC could also be applied to the cases of parts (b) and (c) with an earlier European pending application according to Article 54 (3) EPC. Many candidates referred to opposition proceedings under Article 60 EPC for parts (b) and (c) which was not however within the scope of the question.

Q6: This question was answered quite well.

Q7: Many candidates failed to check whether the 12 months time limit for claiming priority is actually observed. Such checking involved the application of Rule 85 (1) EPC. Candidates often did not pay attention to the time for filing a useful request for correction under Rule 88 EPC.

Q8: Most candidates were aware of Rule 84a EPC and of the President's Decision, and consequently provided good answers.

Q9: Most candidates were aware of G1/91. However, it was rarely clear whether candidates recognized that G1/91 was about whether unity of invention came under the requirements that a European patent has to meet under Art. 102(3) EPC when the patent is to be maintained in amended form. Full marks required also mentioning the applicability of Article 109 EPC and Rule 67 EPC (thus to request refund of the appeal fee).

Q10: Some candidates confused the provisions of Article 133 EPC with those of Article 134 EPC. Some candidates were unable to correctly accumulate the fee reductions.

Preferred solution for Paper D – 2002

PART I

Answer to Question 1

Rule 18(1) EPC states that the person designated as the inventor shall be mentioned as such in the published European patent application and the European patent specification, unless the said person informs the EPO in writing that he waives his right to be mentioned.

The request must be received in time to be effective before publication, ie before technical preparations for publication have been completed.

Answer to Question 2

a) Inform the EPO of the situation. The EPO will declare the proceedings interrupted according to Rule 90(1)(b) EPC from 5 December 2000. Proceedings will be then resumed according to Rule 90(2) EPC. If the proceedings are interrupted, reply to the outstanding Office action within four months from the date of resumption, pay the renewal fee for the third year on a date fixed by the EPO without surcharge or within six months from that date with surcharge (see Jxx/87) and pay the renewal fee for the fourth year on 31 May 2002 without surcharge. Even if the proceedings are not resumed by that date it is allowed to pay up to one year before the due date.

As according to T 315/87 the grounds for restitutio are less severe, just to be sure to have the application saved, you have in any case to ask for restitution.

Request for restitutio in integrum according to Article 122 EPC ultimately on 19 May 2002 extended under Rule 85(1) EPC to 21 May 2002 by arguing that in spite of all due care it was not possible to act on this application because of financial problems.

Complete the omitted acts when applying for restitutio by
- replying to the outstanding Office action
- paying the renewal fee for the third year

Pay two fees for re-establishments of rights according to J 26/95

b) File request for restitutio in integrum. Restitutio can be successful where the applicant can show that severe financial problems stopped him from taking actions.

Answer to Question 3

1) According to Article 4 A(1) PC, a German utility model can be used for claiming priority. According to Rule 26 bis 1.a PCT a priority claim may be added within a time limit of 16 months starting from the earliest priority date. i.e. 27 December 2000 + 16 months = 27 April 2002.
The addition may be made until the expiration of 4 months from the international filing date, i.e. 19 December 2001; this time limit expires on 19 April 2002.
The later date applies. Therefore, the last date for adding the forgotten German utility model is the 27 April 2002 extended to 29 April 2002 (Rule 80.5 PCT). This is still possible.

2) According to Rule 17.1.a PCT, if one claims priority a certified priority document should be filed at the latest 16 months after the priority date.

a) However if the certified priority document issued on 20 May 2002 is filed directly with WIPO before publication of the international application, which is according to Article 21.2a PCT about 18 months from the priority, i.e. at the earliest on the 27 June 2002. The priority document will then be deemed to have been received on 29 April 2002.

b) Alternatively, file the priority document according to Rule 17.1.c PCT with the national or regional offices.

Answer to Question 4

The demand for preliminary examination was not filed with the competent authority (EPO), Article 31 (6)(a) PCT.

However, under Rule 59.3 PCT, the UK Patent Office must mark the date of receipt on the demand. The UK Patent Office will transmit it to either the EPO or the International Bureau. The demand is then considered to have been received by the competent authority on the date it was received by the UK Patent Office. So the demand is considered to have been filed within the 19-month time limit.

The time limit for entry into the regional or national phase is 30 months, in accordance with Article 39(1)(a) PCT.

However, applying the provisions of Article 39(1)(b) PCT and Rule 107(1) EPC, the applicant has 31 months to enter the regional phase before the EPO.

The time limit for entering the US national phase expired on 18 March 2002 (too late).
The time limit for entering the EP regional phase expires on 18 April 2002.

Check US law on possibilities to reinstate US application

Answer to Question 5

There is an evident abuse within the meaning of Article 55(1) (a) EPC.

For the calculation of the six-month period referred to in Article 55(1) (a) EPC, the relevant date is the actual filing date of the European patent application; the date of priority is not to be taken into account in calculating this period; G 3/98 and G 2/99. Therefore:

a) Yes, since public disclosure (25/10/2000) was earlier than six months preceding the filing of the application as required by Article 55(1) (a) EPC

b) No, since public disclosure (10/10/2001) was not earlier than six months preceding the filing of the application as required by in Article 55(1) (a) EPC:

Although B's application is a co-pending application under Article 54(3) EPC it has to be disregarded because Article 55(1)(a) EPC refers to Article 54 EPC as a whole.

c) Same as b) irrespective of the fact that B's application was published (15/11/2001) after the filing date of A's application.

Answer to Question 6

a) **M1**: M1 was claimed in publication EP1 and thus, in accordance with Article 67(1) EPC, enjoys protection as of 06/06/1998.
M2 : M2 was not claimed in publication EP1, which therefore confers no provisional protection on it (Article 69(2) EPC). The protection is determined by the claims contained in the publication under Article 93 EPC. M2 will only enjoy the provisional protection conferred by EP2 on 11/11/98.
M3 : M3 was not claimed in applications EP1 and EP2, and therefore cannot enjoy any provisional protection at all. At the earliest, M3 will enjoy the protection conferred by patent granted on EP2 when the latter is published on 10/05/2001 (Article 64(1) EPC).

b) M1 will enjoy the protection conferred by patent granted on EP1, for up to 20 years as from the date of filing of EP1, i.e until 12/12/2017 (Article 63(1) EPC). M2 will enjoy the protection conferred by EP2 up to 20 years as from the date of filing of EP2 (Article 63(1) EPC). However, EP2 is a divisional application based on EP1, so the date of filing of EP2 is that of EP1 (Article 76 EPC). At most, M2 will enjoy protection up to 12/12/2017. Like M2, M3 will enjoy the protection of patent granted on EP2, i.e at most up to 12/12/2017 (Articles 63(1) and 76 EPC).

Answer to Question 7

The 12 month term of Art. 87 EPC ends on 18/02/2002, since 16/02/2002 is a Saturday, Rule 85(1) EPC.

a) Priority claim is valid in accordance with Article 87(3) EPC, because it is only necessary to have a valid filing date and the outcome of the earlier application has no consequence.

b) Priority claim is not valid. According to Rule 38(2) EPC the date and the state of the previous filing must be stated on filing the European patent application. However, correction according to Rule 88 EPC seems allowable according to J9/91. Therefore, file request immediately.

c) Priority claim may be corrected under Rule 88 EPC. File the request for correction sufficiently early for the correction or a warning to be included in the application to be published (Guidelines A-III 6.5).

Answer to Question 8

4 October 2001 is more than 5 days before the expiry of the time limit for priority (Art. 87(1) EPC), which is 10 October 2001. 31 October 2001 is less than three months after the same time limit.

The EPO may ask Ms Sumo to file a confirmation of receipt by the delivery service (Article 1 of the Decision of the President of the EPO dated 11 December 1998 (OJ EPO 1999, 45)).

The time limit under Article 87(1) EPC is thus deemed to be met according to Rule 84a EPC provided that:

i) the delivery service used by Ms Sumo belongs to those recognised by the EPO (Article 2 of the before-mentioned decision)
ii) the method of despatch of the request for grant documents complies with Article 3 of the before-mentioned decision.

The further requirements which have to be fulfilled so far are complied with (Article 87(1), 88(1) and Rule 38(1) EPC).

The EPO includes free of charge a copy of the earlier application in the file of the European patent application see Decision of the President of the EPO dated 22 December 1998 (OJ EPO 1999, 80).

A translation of the priority application is to be filed within the time limit of Rule 51(6) EPC (Rule 38(5) EPC). A declaration under Rule 38(5) EPC would be sufficient.

Answer to Question 9

Yes. It will be successful if an appeal is validly filed. The opposition division has made a procedural error, see G1/91, OJ EPO 1992, 253 or GL D-V, 2.2, since unity of invention is not one of the requirements of the Convention which a patent amended under Art. 102(3) EPC has to fulfil.
Either the opposition division will rectify (Article 109 EPC) or the Board of appeal will set the decision aside, and maintain the patent as amended.
The appeal fee will be refunded under Rule 67 EPC.

Answer to Question 10

a) Yes, provided the Greek representative is allowed to act before the EPO either because of Article 134(1) EPC or Article 134(7) EPC.

b) There is a reduction by 50% under Rule 107(2) EPC, Article 12(2) RFees, since EPO acted as IPEA. From the remaining 50%, there is a further reduction by 20% under Rule 6(3) EPC, Article 12(1) RFees, because the request for examination was made in an admissible language different from the official languages of the EPO. Therefore, 40% of the examination fee had to be paid. (see also Notes on EPO Form 1200, Number III.6.2)