

Candidate's Answer – DI

Q1

Decision was deemed received on 16.12.2002, Rule 78(2) EPC and Article 119 EPC.

Article 108 EPC sets period of 2M from date of notification of decision to file appeal in writing and payment of fee (R fees. 2, Item 11). So deadline for filing notice of appeal expired 16.02.03 (Sunday), therefore extended to 17.02.03 (R 85(1) EPC). No further processing (A 121 EPC possible).

A refusal of application by Examining Division is an appealable decision (Article 106(1) EPC).

Applicant can make restitutio application (A 122 EPC) of 2M time limit but needs to file request in writing within 2M of removal of non-compliance and within 1Y of missed time limit; pay fee; show all due care (may be difficult here, representative should have known about appeal period?).

Omission of reason for decision is substantial procedural error (R 67), but not sure about communication of possibility of appeal being anything more than a courtesy service which in view of J 1/89 cannot be relied on J 2/87 - refusal of patent is void if due to an erroneous EPO communication (good faith). Not clear from the question if this is erroneous communication - possibly in which case J 2/87 may apply.

Q2

EPI	27.12.02	fees and translation	Rule 51(4)
	02.01.03		

(a) R 25(1) EPC, applicant may file divisional application for any pending European patent application. Application is pending up to but not including date of mention of grant being published under A 97(4) EPC (OJ 2002, 112), C-VI 15.5.

Combination of R 51(4) + R 51(6) communications (OJ 2001, 488) intended to shorter period between despatch of R 51(4) communication and grant to about 8 months.

02.01.03 such a short time after R 51(4) acts completed that application will not yet have granted so can file divisional application.

Q2(b)

EP2 23.04.03 - to be published.

R 25(1) EPC - any pending application can be file up to but not including date of mention of grant being published under A 97(4) EPC (OJ 2002, 112), C-VI 15.5, ie 22.04.03 is last possible date. File divisional directly at EPO in Munich or The Hague (A 76(1) EPC).

Q2(c)

No - there is no pending application as required by R 25(1) EPC on which divisional may be based.

Opposition proceedings only relate to granted patents (A 99(1) EPC).

Q3

R 60(2) EPC/A 114 EPC is not applicable to appeal proceedings in opposition because of the different legal nature of the proceedings (G 7/91). So withdrawal of appeal by opponent as sole appellant terminates appeal proceedings (G 7/91). Termination of appeal occurs irrespective of whether patent satisfies requirements of EPC (G 8/93).

Intervention under A 105 EPC is admissible if filed during pending appeal proceedings (G 1/94). But if filing of intervention and filing of sole appellant's notice of withdrawal of appeal take place on same day then their chronological order must be taken into account (T 517/97). Withdrawal of an appeal has immediate effect and is not postponed to midnight on date of filing (T 517/97) - T 517/97 also related to filing by fax and in view of this, in Q3 A 105 EPC intervention wouldn't be admissible (fees for opposition and appeal would be refunded). [Doesn't matter when confirmation of fax was received].

Q4

Notice of opposition needed to be filed within 9M of publication of grant of patent (A 99(1) EPC) ie by 19.03.03 (Wednesday). Fee for opposition (RFee 2, item 10 = 610 Euro) was also due that day.

Notice of opposition was sent in time (14.03.03). Fax filing allowed (OJ 1992, 299) and R 36(5) EPC. EPO may request written confirmation of fax and probably good idea to send this anyway. Fee arrived late (20.03.03) by 1 day and was insufficient amount (122 Euros too little) but this is OK because of RFees 12(1) - 20% reduction in opposition fee ie 20% of required amount, R 6(3) EPC for A 14(2) EPC situation.

RFees 8(3) provides that will be considered filed in time if an order was given to a banking establishment within the period set (ie before 19.03.03, which it was) and a 10% surcharge was paid (or is within 10 days of expiry of period for payment). Didn't pay surcharge - so under Rule 8 fees 8(4) EPO will ask for surcharge and evidence of transfer to bank establishment in time → pay this:

Language

Spanish opponent (by nationality) so A 14(4) EPC applies (as opposition must be filed by time limit) - opposition can be filed in Spanish so is OK. But must file translation within 1M of filing document (R 6(2) EPC, A - VIII, 2.1) or else is deemed not received (A 14(5) EPC). So have until 14.04.03 to file translation into English, French or German under R 6(2) EPC. As opposition was filed by fax, subsequent copy must be sent in same language as fax and then copy is deemed received on date of filing fax (A - IX, 2.5).

Representative

Spanish client was allowed to file notice of opposition due to A 133(1) EPC as is resident of a Contracting State. For me to be his representative will likely need to file authorisation under R 101 EPC (OJ 1991, 489) as has been change of representative (before first act done on behalf of client).

Q5

priority date 28.08.00.

31 M period (R 107(1) EPC) expires 28.03.03 (Friday).

Enter EP regional phase by 28.03.03 using Form 1200, pay national basic fee (R 107(1)(c) EPC), pay designation fees R 107(1)(d) EPC, (as A 79(2) EPC) period will already have expired and international search report takes place of EP search report (A 157(1) EPC), pay search fee (R 107(1)(e) EPC, A 157(2)(b) EPC) as search fee will need to be drawn up - get 20% reduction in supplementary search report if JPO did ISR (OJ 1979, 368); file request for examination (A 94 EPC, R 107(1)(f) EPC) and pay 3rd year renewal fee (R 107(1)(g) EPC).

R 107(1)(a) EPC requires translation of PCT application to be furnished to EPO as required by A 158(1) EPC. But not ready to file this yet (don't want to incur urgency charges etc. by getting spec translated here into Japan by Friday) so enter European regional phase (by doing all things noted above by 28.03.03) without filing translation of application. R 108(3) EPC provides grace period of 2 M after notification to furnish translation, on payment of surcharge (RFees 2.3(c)) - although will end up paying surcharge this is likely to be much less than urgency charges for translation costs. Therefore have at least 2 months for client's translation department to do this.

Not necessary to file Japanese priority document (OJ 1999, 80, Dec. of Pres and A - III, 6.7) as EPO will put this in file automatically, R 38(4) EPC. Will need eventually to file translation of this (or declaration that priority doc \equiv application as filed) by end of Rule 51(4) EPC period.

Q6

Mr A. died, Rule 60(2) EPC indicates Mr H. can become party to opposition proceedings but that Opposition Division may continue proceedings of its own motion without the participation of heirs. However Guidelines D-VII, 6.2 says that this provision will also apply where only one opposition has been filed (as is the case here). Effectively Mr H. has been transferred Mr A's business and assets of interest in which opposition was filed, so pending opposition has also been transferred (G4/88).

Opposition is limited by extent indicated in notice of opposition, that have been properly submitted and substantiated in the notice of opposition (G 10/91, G 9/91): So can't extend opposition to cover method of producing P at this stage.

Q7

A 135(1)(b) EPC allows the national office of a Contracting State to apply procedure for grant of a national patent at the request of the applicant/proprietor in certain circumstances, where provided by national law.

For Portugal, (see Nat Law Table VII, cols. 1 and 5 (pg 103)) European patent applicant can't be converted into a Portuguese patent application for the reason of refusal by EPO (only for deemed withdrawal, A 77(5) EPC; deemed withdrawal due to A 90(3) EPC because translation in language of proceedings under A 14(2) not filed in time). But can convert EP application that has been refused into a Portuguese application for a utility model (see col. 5) - could well be worthwhile doing that here.

Conversion to national utility model also has lower inventive step requirements, so might be allowable - needs checking.

Take steps of requesting conversion within 3 M of refusal of application (A 135(2) EPC) and then take steps referred to in cols. 2 + 3 on pg 103 Nat Law Table VII - will not need to appoint authorised representative if applicant has place of business/residence in Portugal.

Q8

must apply for new appln within 3 months of decision becoming final (A 61(1) EPC) ie by 11.05.03.

- (a) (i) Can file new EP patent application (A 61(1)(b) EPC). Rule 15 EPC sets out rules for filing new application, and A 61(2) EPC provides that provisions of A 76(1) EPC also apply to the new application. A 76(1) EPC does not allow subject matter of new application to extend beyond the content of the earlier application as filed (and A - IV, 1.3.3 and A - VIII, 1.3 are relevant). So client would not be allowed to include further embodiments as this would extend beyond application as filed contrary to A 61(2) EPC in conjunction with A 76(1) EPC.
- (ii) No in view of R 37(4) EPC (which expressly refers to Article 61(1)(b) EPC and says no fees due in respect of year in which new application is filed and any preceding year.
- (b) Yes still entitled to file new European patent application even if original application A is not pending at time new application is filed (G 3/92). → in fact the only thing client can do in these circumstances is to file a new application (G 3/92) ie can't do either A 61(1)(a) or (c) alternatives.

Q9

R 17(2)(a)(i) declaration means that EPO as ISA has told applicant and IB that no international search report will be established as the ISA considers the application to relate to subject matter which the ISA is not required or decides not to search.

- (a) No refund of search fee will be made by EPO, EPC or PCT. PCT only provides for refund of search fee where due to reasons of national security, the PCT application isn't treated as such (R 16.2 PCT) or if PCT application is withdrawn before the transmittal of the search copy to the ISA. EPO also refund 100% of search fee where PCT appln is withdrawn or considered withdrawn under Art 14(1), (3) or (4) PCT before the start of the international search or if the ISA is based wholly or partly on an earlier search (100% and 50% respectively), OJ 2002, 56, in line with R 16.3 and R 41.1 PCT. But no provisions for reimbursement of search fee in this case.
- (b) Entry into the national phase is not affected by R 17(2)(a)(i) PCT declaration (A 22(2) PCT). However, a designated state may consider unsearched parts (ie the only claim in this case) to be withdrawn unless the applicant pays a special fee to the national office of that state (A 17(3)(b) PCT).

On entry into European regional phase, a European (supplementary) search report will not be established as claim relates to a method of treatment (A 52(4) EPC) as the subject matter is excluded from patentability, R 45 EPC.

Suggest filing amended claims on entry into European regional phase, which may have likelihood of being searched under A 92(1) EPC (will be given opportunity to do this under R 109 EPC + R 110 EPC).

As implant itself is new and revolutionary, file claim (product claim) to implant. Appears to have support in description and claim amendment won't add matter over application as filed, in accordance with A 123(2) EPC and G 2/98.

G 2/88 - change of claim category allowed if no extension of protection.

Q10

Thailand is not a Paris Convention country (see OJ 2002, 216).

Thailand is a WTO country (see OJ 2002, 226).

Article 8(2)(a) PCT and R 4.10(a) PCT provide that an application in or for any country party to the Paris Convention of the WTO can be basis of priority claim for a PCT application. So, a PCT application can validly claim the Thailand priority. BUT R 4.10(d) PCT provides that where a designated office has laws incompatible with R 4.10(a) and (b) PCT, those paragraphs do not apply to those states for as long as the incompatibility exists provided the office informs the IB as required under R 4.10(d) PCT. The EPO and the JPO have informed the EPO of this incompatibility. So at present, for EPO and Japan, may not be able to sustain priority claim to the Thai application.

However, for EPO this question has now been referred to the Enlarged Board of Appeal, G 2/02 and G 3/02.