
Examiners' Report – Paper D

General

Candidates this year seemed to be better prepared than in previous years. This trend is very much welcomed by the examination committee.

Again, some candidates missed valuable marks by surprisingly using old legal texts. This is a good way of failing the examination.

This paper tests legal knowledge and reasoning. Some candidates seem to believe that supplying two different and inconsistent views on a question may give them twice the chance of gaining marks. Poor or inconsistent reasoning leads to low (or even no) marks.

Part I

- Q1 This question was generally well answered, but a number of candidates mentioned Rule 68(2) without realizing the significance of the last sentence.
- Q2 This question was well answered by most. Despite the clear language of Rule 25, a surprising number of candidates did not realize that the divisional had to be filed at the latest by the day before grant of the parent application.
- Q4 Most candidates were able to address correctly all the relevant issues, but some concentrated their attention on one issue only, either the language or the fee issue, and disregarded the rest.
- Q6 A significant number of candidates misunderstood G9/91 and came to the wrong conclusion.
- Q9 Many candidates seemed unwilling to offer any suggestions as to how their client could gain a patent, but most realized that claiming the product rather than the method offered a possible solution. Few candidates were completely unaware of the problems posed by a declaration under Art. 17(2)(a)(i) PCT.
- Q10 Almost all candidates showed to be aware of the possibility of claiming priority from WTO countries, and most of them also correctly addressed the limits posed by derogations.

Possible Solution of Paper D, Part I

1. According to Rule 68(2) EPC, last sentence, a party may not invoke the omission of the communication. The decision dated 06.12.2002 is deemed received on 16.12.2002, Rule 78(2) EPC. Hence, the 2 month time limit for filing the notice of appeal according to Article 108 EPC which ended on 16.02.03, extended to 17.02.03, Rule 85(1) EPC, has lapsed. Therefore, such an appeal would be deemed not filed because the appeal fee cannot be paid in time.
2.
 - (a) Yes, according to Rule 25(1) EPC, OJ EPO 2001, 489, a divisional application can be filed on a pending application. Until one day before the publication of the mention of grant, EP1 is still pending.
 - (b) According to Article 97(4) EPC (OJ EPO 2002, 112), EP2 is pending until 22.04.2003, which is one day before the mention of the grant. Therefore, a divisional application can still be validly filed until that day, Rule 25(1) EPC.
 - (c) No, since Rule 25 EPC refers to a pending European patent application, not to a European patent.
3. According to G1/94 (refer to Guidelines D-VII, 7), Article 105 EPC also applies to appeal proceedings. Intervention is only possible during pending proceedings. From the moment the first fax is received at 16.09 hours, the appeal is no longer pending, see T517/97 (OJ EPO 12/2000). An intervention was no longer possible on the same day at 20.12 hours.
4. The 9 month opposition period according to Article 99(1) EPC expired on 19.03.2003. Opposition can validly be filed by telefax according to Rule 36(5) EPC in combination with the decision of the president of the EPO dated 26.05.1992 (OJ EPO 1992, 299) (refer also to the Guidelines D-III, 3.2). The opponent is entitled to use Spanish, Article 14(4) EPC.

The time limit for filing the translation of the notice of opposition is 1 month from receipt of the telefax at the EPO according to Rule 6(2) EPC. Hence, the translation of the notice of opposition must be filed by 14.04.2003. The amount of 488 Euros corresponds to the opposition fee reduced by 20%, according to Rule 6(3) EPC and Article 12(1) RFees.

The fee is considered to be validly paid if evidence is provided to the EPO that the order for the transfer was given to a bank before the expiry of the opposition period on 19.03.2003, as set out in Article 8(3)(a)(ii) RFees. A surcharge corresponding to 10% of the fee is to be paid within a time limit set by the EPO under Article 8(3)(b) RFees in combination with Article 8(4) RFees because the order was given only five days before expiry of the opposition period.

5. The 31 month time limit for entering the regional phase according to Rule 107(1) EPC expires on 28.03.2003. Hence, the translation will not be available in due time. However, the regional phase must be entered on 28.03.2003 at the latest by duly fulfilling the requirements of Rule 107 EPC, in particular, by paying the national basic fee (Rule 107(1)(c) EPC), the designation fees (Rule 107(1)(d) EPC), the search fee (Rule 107(1)(e) EPC) and the examination fee (Article 94(2) EPC).

These acts should be carried out by the due date without submitting the translation required under Article 158(2) EPC, thereby failing to meet the requirements of Rule 107(1)(a) EPC. The missing translation should be filed when available within the time limit of two months of notification of the communication according to Rule 108(3) EPC. The surcharge for late filing of the translation, which is 500 Euros according to Articles 2 and 3c RFees should be paid. By filing the translation late, costs are kept to a minimum, since other actions if performed late will increase costs (refer to Article 2, 3b and 3c RFees).

6. Rule 60(2) EPC (in the light of G4/88) implies that Mr A's opposition may be inherited by his heir (see also Guidelines D-I, 4 or VII, 6.2). Thus, Mr H becomes a party to the opposition proceedings.
The extent of the opposition cannot be broadened because it is limited to the extent defined in Mr A's notice of opposition according to Article 99 and Rule 55 EPC. Moreover, the opposition division is not allowed to broaden the extent of the opposition ex officio according to G9/91 (refer also to the Guidelines D-V, 2.1).
7. According to Article 135(1)(b) EPC, a European patent application refused by the EPO may be converted to a national patent application if provided for by national law. Article 135 EPC also applies to utility models in view of Article 140 EPC. Thus, under the EPC, the conversion to a utility model is permissible. The national law of Portugal provides the possibility of converting into a utility model, according to "National law relating to EPC", page 103, Table VII. A request for conversion should be filed within three months after the decision of refusal has been notified according to Article 135(2) EPC. Further, according to Article 136(1) EPC, the request shall be filed with the EPO, specifying the Contracting State Portugal and paying the conversion fee (which is 50 Euros under Article 2, 14 RFees).
8. a)i) When filing a new European patent application according to Article 61(1)(b) EPC, the provisions of Article 76(1) EPC apply in accordance with Article 61(2) EPC. Hence, the subject-matter of the new application must not extend beyond the content of the original application as filed (refer also to the Guidelines C-VI, 9.9). Therefore, the client cannot include further embodiments.
a)ii) According to Rule 37(4) EPC, renewal fees shall not be payable in respect of the year in which the new European patent application is filed and any preceding year (refer to the Guidelines C-IV, 2.7.2). Therefore, he would not have to pay.
b) G3/92 (OJEPO 9/1994) states that in cases where the original application is no longer pending, Article 61(1)(b) EPC is applicable (refer also to the Guidelines C-VI, 9.9a). Therefore, the client is entitled to file a new application.

The application has to be filed within a period of three months after the decision has become final, that is on or before 11.05.2003, extended to 12.05.2003 under Rule 85(1) EPC.

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9. a) In the present circumstances, there is no legal basis for a reimbursement of the international search fee. The conditions set out in Article 5 of the Agreement between the EPO and WIPO of 31.10. 2001, OJ EPO 12/2001, 601 Rule 16.2 PCT are not fulfilled.
- b) The present claim is directed to a surgical method, and would not be patentable because of lack of industrial applicability under Article 52(4) EPC. The applicant should file amended claims directed to the heart implant and enter the regional phase within 31 months according to Rule 107(1) EPC. It is noted that the time limits for entering the regional phase before the EPO do not change in case of a declaration under Article 17(2) PCT, refer to Article 22(2) PCT. Having entered the European regional phase, substantive examination will take place. The declaration according to Article 17(2)(a)(i) PCT takes the place of the European search report under Article 157(1) EPC. If the prior art found in the additional search (according to the procedure outlined in Guidelines C-VI, 8.5 or B-III, 4.2 ii, or B-VIII, 6) is not pertinent, a patent can be granted for a claim directed to the heart implant.
10. Yes, it is possible under Rule 4.10(a)(i)-(iii) PCT. Thailand is a member of the World Trade Organisation (It is noted that Thailand is not a signatory to the Paris Convention). However, if priority is to be claimed from such a Thai application, it should be checked which of the designated states of the PCT application have filed a derogation to Rule 4.10 (refer to the Editor's note to Rule 4.10 PCT). It is noted that the EPO has informed the IB of WIPO of such a derogation, and thus would not recognize such a priority claim.

EXAMINATION COMMITTEE III

Candidate No.

Paper D Schedule of marks

Question	Maximum possible	Marks awarded	
		Exr	Exr

PART I

1	4		
2	4		
3	4		
4	6		
5	5		
6	4		
7	4		
8	5		
9	6		
10	3		
TOTAL PART I	45		

PART II

1	24		
2	9		
3	11		
4	11		
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 the case the candidate sits the examination for the first time)

Munich, 12 September 2003

Chairman Examination Committee III