

Candidate's Answer - DI

1)

a) A divisional application is deemed filed on the filing date of the patent application (A 76(1) EPC). Thus the deemed filing date of the divisional application is 12/2/01.

Under A 86(1) EPC renewal fees are payable in respect of the third year and each subsequent year calculated from the filing of the application. Under R. 37(1) EPC renewal fees in respect of the coming year are to be paid on the last day of the month containing the anniversary of the date of filing.

As the filing date of the divisional is 12/2/01 the patent years run as follows:

year 1	13/2/01	→	12/2/02
year 2	13/2/02	→	12/2/03
year 3	13/2/03	→	12/2/04
year 4	13/2/04	→	12/2/05
year 5	13/2/05	→	12/2/06

Under R. 37(3) EPC, renewal fees already due in respect of the earlier application up to the date of filing of the divisional application must also be paid on the divisional application.

Thus in 2004, the 3rd and 4th renewal fees must be paid.

b) Divisional application filed = 29/1/04
= due date for 3rd year

Due date for year four = 29/2/04

→ 1/3/04 R. 85(1)

Last day of 4 mo period for paying without an additional fee R. 37(3) for years 3 and 4 = 29/5/05

Under R. 37(3) EPC, renewal fees for a divisional application and any falling due within a period of 4 months from the filing of the divisional may be paid within the 4 months without an additional fee.

In this case the 3rd year fee is due on filing and the 4 y fee is due within 4 months of filing, therefore both the 3rd and 4th renewal fees can be paid up until 29/5/04 (R. 37(3)EPC), which is extended to Monday, 31/5/04 under R. 85(1) EPC.

- c) Under R. 37(3) EPC) if payment is not made in due time, the renewal fees will still be validly paid within 6 months of the due date, provided that the additional fee (A 86(2) EPC) is paid within the 6 months as well.

For the 3rd year renewal fee, this 6 months falls due on 29/7/04 (Thursday).

For the 4th year renewal fee, this 6 months falls due on 31/8/04 (Tuesday) (i.e. 6 months from the end of Feb 2004 applying de ultimo ad ultimo under J 4(91).

- 2) Under A 8 PCT, an international application may contain a declaration, claiming the priority of one or more earlier applications filed in for any country party to the Paris Convention (PC).

Under A 66 EPC, an EP application which is accorded a date of filing is equivalent to a national filing. Thus priority may be claimed from a European application.

In the case the requirement that the priority claim be made within 12 months of the date of filing of the first application has also been met (A 4C(1) PC).

The problem in this case is the requirement of A 4C(2) PC for the priority claim to be based on the first application; that is the application which first describes the subject matter.

When EP FIRST was filed, the German utility model was in existence and had rights outstanding therein. If it did not have outstanding rights then it would not have gone on to publish. Thus the conditions of A 4C(4) PC are not met for basing the priority claim on the later application.

In this regard it is important to note that under A 4 A (1) and (2) PC, a priority right is established on the basis of a utility model.

This means that the priority claim in the PCT application is invalid; hence the effective date for all the subject matter herein is the filing date, i.e. 23/9/03.

This means that the public availability of the German utility model in Dec 2002 will be available as full prior art against the PCT application A 33 PCT.

- 3) If only the opponent appealed the decision, then the patent proprietor is only a party as of right to the proceedings (A 107 EPC).

In 99/92 it was held that if the opponent is the sole appellant, the patent proprietor is restricted during Appeal to defending the patent in the form in which it was maintained by the Opposition division. This is "Reformatio in pesus". Thus generally the patent proprietor will not be allowed to reinstate granted claim 1.

The only way in which the patent proprietor would be allowed to make this amendment would be if the patent as maintained in amended form would otherwise have to be revoked as a direct consequence of an inadmissible amendment held allowable by the opposition division (91/99).

In this case this seems unlikely since the amendment simply involved combining claims; thus it is unlikely that the patent proprietor will be permitted to reinstate claim 1 as granted.

- 4) For the filing of an international application, the EPO is acting as a receiving office under A 151(1) EPC. Under R. 104(1) EPC, however, when the EPO acts as receiving office, the international application shall be filed in French, German or English.

Under R. 12.1 a) PCT, an international application shall be filed in any language which the receiving office accepts for this purpose. This requirement is not met since the application is filed in Spanish, and only French, German and English are accepted (as stated above).

In this situation, R. 19.4 ii) PCT provides that if the international application is in the wrong language, the application shall be considered to have been received by that office (i.e. by the EPO) on behalf of the IB as the receiving office.

Under R. 19.4 b) PCT, the EPO will promptly transmit the application to the IB and the international application so transmitted will be considered to have been received by the IB as receiving office on the date of receipt of the international application by the EPO. In this case this means that the filing date of 15/3/04, and the priority claim, remains. The EPO may charge a transmittal fee for having done this (R. 19.4 b) PCT).

As the application has been transmitted to the IB, the fees will now need to be paid directly to it. Under R. 19.4 c) PCT, the deadline by which the fees (transmittal fee, R. 14.1 PCT, international fee, R. 15.1 PCT and search fee, R. 16.1 b) PCT) must be paid is calculated from the date on which the international application is actually received by the IB, rather than the filing date. Thus these will be due 1 month from the date on which the IB received the application.

Meanwhile, the EPO will refund the fees which were paid to it as these were paid without legal basis. The only exception to this is that the EPO is entitled to keep an amount equal to the transmittal fee for forwarding the application to the IB (R. 19.4 b) PCT).

May also need to consider the issue of representation. Need a representative who can act before the Spanish patent office who would be competent RO.

5)

a) Under A 75(1) b) EPC a European application may be filed at the central industrial property office of a contracting state. Nat Law Book, table II confirms that applications may be filed at INPI and that the application may be filed in any language allowed under A 14(1) or (2) EPC.

Under A 14(2) EPC a national of state which has a language other than English, French or German may file the European application in an official language of that state, even when they are resident abroad. Thus the Greek applicant living in Paris is entitled to file the application in Greek, since Greek is the official language of Greece.

However, A 14(2) EPC who provides that when an application has been filed in such a language, a translation into one of the official languages must be provided. A 14(1) EPC states that French, English and German are the official languages. R. 6(1) EPC provides that the deadline for filing this translation is no later than 13 months after the date of priority. In this case this is by 13 March 2004, extended to 15 March 2004 under rule 85(1) EPC. This deadline has passed. Thus the application will be deemed withdrawn under A 90(3) EPC.

b)

(i) The application can be re-filed, although it will not be possible to validly claim priority from the earlier application of 13/2/03 as more than 12 months have now passed. This will, however, only matter if there has been any relevant art published in the intervening time.

(ii) He can use this application to claim priority from in a re-filed application if any new subject matter was added in over the original priority application.

(iii) Apply for restitutio (A 122) of the deadline for filing the translation within 2 months of removal of the cause for non-compliance (which in this case is likely to be a notification under R. 69(1)), by requesting restitutio, paying the fee, filing the translation, and setting out why despite all due care the deadline was missed.

- 6) EP 1 – As the applicant indicated on F 1001 that he intended to pay the designation fees for AT, BE, ES, DE and NL only, the applicant has waived his right to a R. 85(a)(1) EPC communication in respect of all other states.

The deadline for paying the designation fees is 6 months from the date on which the EPB mentions publication of the search report, i.e. 2/10/03 (A 79(2) EPC). On this date the designation fees were timely paid for AT, BE, ES, DE.

For NL, the applicant will receive a communication informing him that he has not paid the designation fee (R. 85(a)(1) EPC) and the deadline for paying it with a surcharge is 1 month from the date of that notification.

For other states, no such notification will issue (see paragraph 1 above), thus the deadline for paying the designation fees, along with a surcharge is set by R. 85(a)(2) EPC and is 2 months from the missed deadline, i.e. 2/12/03.

If both apply then any designation fee can be paid, with surcharge, up to the later of the two dates (J 5/91). But both of these have passed. Thus in EP 1, only AT, BE, ES and DE can be designated.

EP 2 was filed prior to the deadline for paying the designation fees on EP 1. Hence as F1001 contains a pre-checked box designating all contracting states, any contracting state can be designated. G4/98 confirmed that the subsequent non-payment of designations in the patent does not affect the designations on the already filed divisional application.

EP 3 -This was filed after the deadline for paying the designation fees on EP 1. G4/98 confirmed that when no designation fee is paid by the expiry of the grace periods of R. 85a that the designation is deemed withdrawn at the expiry of the normal limit of A 79(2) EPC. Thus when EP 3 was filed only the designations of AT, BE, ES and DE were pending in EP 1. Hence under A 76(2) EPC only these states (AT, BE, ES, DE) can be designated in EP 3.

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- 7) C1 24/6/03
R. 78(2) EPC → 4/7/03 deemed received
4 months → 4/11/03
but requested extension under R. 84 on 28/10/03
2 months → 4/1/03

C2 dated 8/1/04 informing rejection of extension

C3 dated 22/1/04 R. 69(1) EPC communication
R. 78(2) EPC → 1/2/04 deemed received

- a) The application on today's date (24/3/04) is deemed withdrawn under A 96(3) EPC because of the failure to reply to the A 96(2) EPC communication. The application can be saved by requesting further processing under A 121 EPC. This is done by requesting further processing, paying the further processing fee, and filing a response to the outstanding A 96(2) EPC communication. The deadline for doing these things is 1/4/04 (Thursday) i.e. 2 months from the date of decision communicating that the application is deemed withdrawn (A 121(2) EPC).
- b) No, an Appeal would not be admissible as the communication dated 8/1/04 does not terminate proceedings as required by A 106(3) EPC. This was confirmed by J 37/89.
- c) The finding as to the loss of rights can be appealed providing that the Applicant replies to the communication under R. 69(1) EPC dated 22/1/04 within 2-months stating that he considers the finding of loss inaccurate and the EPO maintains its position that the loss is correct. The deadline for applying for such a decision under R. 69(2) EPC is 1/4/04.

An adverse decision which results from this request for a decision will be appealable under A 106 since it is taken by an Examining division.

8)

- a) No, it is only possible to have the finding of the ISA as it the number of inventions reviewed if the applicant pays additional search fees.

Under A 17.3 a) PCT, the ISA issues an invite to the Applicant to pay additional search fees if it considers that more than one invention is claimed. R. 40 PCT sets out the procedure for doing this and includes a protest procedure (R. 40.2 c)- e) PCT). This procedure provides for the lack of unity opinion held by the ISA to be reviewed by a three membered Board.

However, R. 40.2 c) PCT specifically states that the additional fees may be paid under protest. Thus it does not allow for protest in the absence of payment of such additional fees.

- b) Under A 17.3 a) PCT, the non-payment of fees means that the international search report will be established on those parts of the application which relate to the invention first mentioned in the claims. The other subject-matter will remain unsearched.

This means that the international preliminary examination will be restricted to those parts of the application which have been searched. The international preliminary examination report will state that this is the case (R. 70(0) PCT).

It is important to note, however, that the non-payment of the additional search fees does not mean that the ISA or IPEA (or any of the designated offices) can assume that the non-searched subject matter has been abandoned.

9)

- a) Under A 33(2) and (3) PCT, an invention claimed is considered novel and inventive if it is not anticipated by the prior art as defined by the rules.

Rule 64 PCT defines for the purposes of A 33(2) and (3) PCT, what constitutes prior art.

Specifically, R. 64.1 b) PCT provides that where the making available to the public occurred by an oral disclosure before the filing date of the application and the date of the oral disclosure is indicated on a written document (in this case the compendium) on a date later than the filing date, the non-written disclosure shall not be considered as part of the state of the art for A 33(2) and (3). This applies in this case since the oral disclosure making the claimed invention publically available

occurred 1 week before filing, but the compendium in writing was not available after filing. Hence the professor's oral disclosure does not count as prior art according to R. 64.2 PCT. Nevertheless the IPER shall call attention to the lecture.

- b) Yes, under A 54(2) EPC, it is stated that the state of the art comprises everything made available to the public by means of written or oral description before the date of filing of the application.

As the date of filing is the international filing date and the public lecture took place before this date, it will be prior art for both novelty and inventive step under A 54(2) and A 56 EPC.

- 10) No, I would not advise my client to file a Swiss national application and then try to claim priority from it in a later EP application. I advise my client to file a European application today!

Under A 55(1) EPC, a disclosure of an invention shall not be taken into consideration if it occurred no earlier than 6 months preceding the filing of the European application if it has been displayed at an officially recognised international exhibition.

93/98 confirmed that the calculation of the 6-month period is to the actual date of filing of the European application, and the date of priority is not taken into account when calculating this period.

Hence as the invention was first disclosed at the exhibition on 24/9/03, the 6 month deadline for filing the EP is today, 24/3/04! The application can be filed by fax if necessary, R. 24 EPC.

In order for the disclosure to be discounted it must be stated at the time of filing the application that the invention has been so displayed so this should be done. There is no remedy for not filing this statement.

Moreover it will be necessary to file a supporting certificate within 4 months of the filing of the application i.e. by 23/7/04 (Friday). This must be the certificate which was issued at the exhibition by the authority responsible and state that the invention was displayed there. The certificate must also state the opening date of the exhibition, and as the opening date did not coincide with the first disclosure, the first date of disclosure (i.e. 23/9/03). The certificate should also be accompanied by an identification of the invention, duly authenticated.

N3 – this assumes that the exhibition is one which falls within the terms of the convention in international exhibitions as set out in A 55(1) EPC. If not, then the exhibition will count as part of the state of the art under A 54(2) EPC.

- 11) The R. 69(1) EPC communication dated 4/9/03 is deemed received on 14/9/03 (R. 78.2 EPC). Thus the deadline for requesting further processing, paying the fee and completing the omitted act is 14/11/03 (A 121(2) EPC).

A121(1) EPC, however, states that the legal consequence of deemed withdrawal following failure to reply to a time limit shall not ensure if the applicant requests further processing.

According to R. 20(3) EPC, a transfer has effect vis a vis the EPO “only when” the request for transfer is filed and a document satisfying the EPO that the transfer has taken place have been produced. The wording “only when” in R. 22(3) EPC means that the earlier date mentioned in the assignment is irrelevant for the EPO.

Hence on the date on which the request for further processing was filed, as far as the EPO is concerned, company A is the applicant, not company B. Hence the request of company B for further processing is not valid as they are not the applicant as required by A 121(1) EPC.