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## Candidate's Answer - DI

### Question 1

Deadline for entering European Regional Phase = 31 m from filing date or priority date if priority is claimed (Art 39(1)(b) PCT, R107 EPC).

No priority claim in this case (published 18 m after filing date).

- deadline for regional phase = 31 month from 31/7/98 = 28 February 2001.

Under Art 38(1) PCT neither the IB or the IPEA may allow third parties access to the International Preliminary Examination (IPE) file unless requested or authorised by the applicant.

However under R94.2 PCT an elected office has access to the IPE file after the preliminary exam report has been established, and under R94.3 PCT an elected office may allow 3<sup>rd</sup> party access to any documents in its file, including those related to IPE, to the same extent as provided for by national law for access to files of national applications.

The EPO as elected office will therefore allow inspection of files including relating to IPE, however this applies only to applications filed on or after 1/7/98 (which applies in this case) provided international publication has taken place (which it has in this case) and either

- a) at least one act under R107(1) has taken place (which haven't) or
- b) International Preliminary Exam Report was drawn up on or after 1/2/03 (OJ 2003, 382 and OJ1999, 529; Guidelines EIX 6.5)

As neither a) nor b) applies: no, EPO will not allow access to the file.

### Question 2

a) No because:

Although amendments in response to a first communication from the examiner under Art 96(2) EPC are permitted under R51(2) EPC, according to

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Rule 86(4)EPC and G2/93, amended claims may not relate to unsearched subject matter not combining with the originally claimed invention to form a single general inventive concept.

b) Yes because:

The patentee may file amended claims in opposition proceedings under R57(1) EPC or R57a EPC. However such amendments must not extend the protection conferred (Art 123(3) EPC). According to G2/88, a change of claim category may not be a broadening amendment which would contravene Art 123(3) EPC. Amendment of a product claim to a use claim is a limiting amendment (because a product/substance claim includes all uses of that product). So this amendment would be permitted according to Art 123(3) and G2/88. As the purpose of this use was originally disclosed, it seems that the amendment would also comply with Art 123(2) EPC.

c) No because:

Although under R36(5) EPC the President of the EPO may permit documents filed subsequent to filing the patent application to be transmitted by other means than by post, electronic filing of such documents via EPO-line (which is possible from 3/12/03 onwards) is only for use during grant proceedings (OJ 2003, 609; Decn Pres OJ 2002, 543) and is not available for opposition and appeal proceedings (OJ 2003, 609).

d) Yes because:

According to G1/03 and G2/03, an amendment by adding a disclaimer may not be refused under Art 123(2) EPC just because there is no basis in the application as filed. A disclaimer to give novelty over an Art 54(3) EPC document is permitted, provided it doesn't also restore novelty or give inventive step over an Art 54(2) EPC document, or remove more subject matter than is required to give novelty.

So will be allowed with this proviso.

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e) Yes because:

Although are broadening protection, seemingly in contravention of Art 123(3) EPC, according to G1/93, if the added feature was merely excluding protection for part of the subject matter and didn't provide any technical teaching (as is the case here), then removal of the limitation in Opposition doesn't contravene Art 123(3).

### Question 3

a) Art 99(1) allows any person to file an opposition.

According to G3/99 this can be any natural or legal person, and an opposition can be filed in common by several persons, with only one opposition fee being required.

As the opponents all live in an EPC contracting state, they do not need to be represented (Art 133(2) EPC) to act before the EPO.

So yes, the opposition was validly filed.

b) Joint opponents must act through a common representative (G3/99). If one or more joint opponents wishes to withdraw, the opposition will continue with the remaining opponents, but the EPO must be informed (G3/99).

If the opponent who is common representative withdraws, the EPO must be informed and a new common representative must be appointed either by the remaining opponents or by the EPO (R100(1)-R100(2) EPC).

### Question 4

Applicant A fulfilled the requirements to file the priority document by requesting the USPTO to forward it to the IB under R4.1(c)(ii) PCT, however this didn't actually happen. According to R17.1(c) PCT, if the priority document is not supplied, any designated office can ignore the priority claim but must first give the applicant an opportunity to supply the priority document. The EPO will request a copy at regional phase entry under R111(2) EPC and if the applicant fails to provide a

copy on request, the claim to priority will be lost (A91(3) EPC via A150(3)EPC). As this provision is intended to be used where non-supply of the priority document in the International Phase is due to the applicant, rather than the situation here, it would seem to apply here too because the International Phase has now terminated so the IB will have no further involvement.

Therefore, to maintain a priority claim, the applicant should provide the EPO with a certified copy obtained from the USPTO. If the priority claim is actually not particularly important because there is no relevant prior art between the filing and priority dates, then the lack of a priority document may have no significance in substantive examination.

When the EPO communicates with the applicant under R111(2) requesting the priority document, a time limit for reply will be given. If the applicant doesn't manage to achieve this, may be able to extend the time limit under R84 EPC and restitutio would be possible (Art 122 EPC) (if for example, lack of response is due to difficulty obtaining a copy from the USPTO).

### Question 5

In order to have the written opinion re-examined in the International Phase, a demand for International Preliminary Examination (Art 31(1) PCT) must be filed.

The time limit to file the demand = any time prior to the latest of

1) 3m from date of transmittal of search report and written opinion  
= 9/1/05 (Sunday) extended to 10/1/05 (R80.5 PCT)

and

2) 22m from priority date = 8/3/05 (Tuesday)  
(Rule 54bis.1(a) PCT)

- Therefore demand must be filed by 8/3/05
- Should be filed with the EPO as competent IPEA (Art 31.6(a), R59.1(a), (b) PCT)
- Fees need to be paid:
  - handling fee (R57.1 PCT) which is due within 1 month of date of submitting demand or 22m from priority date, whichever is later (R57.3a PCT); and
  - preliminary examination fee (R58.1a PCT) which is due in the same time limit as the handling fee (R58.1b PCT).

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Both fees should be paid to the EPO as IPEA.

According to Art 34(2)(c) PCT the applicant will get at least 1 written opinion from the IPEA unless the application complies with all requirements, however the written opinion of the search authority will be considered to be the written opinion of the exam authority (R66.1bis(a) PCT), so if no amendments are filed in response to this written opinion, the International exam report will be the same as the written opinion.

Therefore the applicant should file reasoned arguments and amendments under Art 34 PCT if appropriate, in response to the objections raised in the written opinion, directly to the EPO, at the same time as filing the demand, indicating that the response is for the purpose of the Chapter II examination procedure.

### Question 6

No. Under Art 59 EPC it is possible to have different proprietors for different states.

Under R52 EPC, patent is granted to each applicant accordingly. According to Art 118 EPC, where the proprietors are not the same for all designated states, they shall be regarded as joint proprietors for all proceedings before the EPO, and the text of the patent shall be uniform for all states, unless otherwise provided for in the EPC.

This also applies in opposition proceedings (T272/95).

The only exceptions to this unity requirement are where there are different European or national prior rights for different states, where a 3<sup>rd</sup> party is judged to be partially entitled to the application under Art 61 EPC, or where states have reservations (no longer applicable). None of these exceptions apply in this case so far as we know:

Different European prior rights for different states under Art 54(3), (4) and R23a may be raised in opposition under Art 100(a) EPC but this could only give different claims for Austria only if the prior European rights applied only to

Austria, or to all states except Austria. Prior national rights are not a ground under Art 100 EPC.

A and B agreed to share the application, so the entitlement exception also does not apply.

Therefore cannot pursue different sets of claims (unless European prior rights makes Austria an exception as discussed).

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### Question 7

Fees to be paid in response to the R51(4) Communication =

- fee for grant, including fee for printing up to and including 35 pages (=€715)
- fee for printing 36<sup>th</sup> and each additional page = €10 each page
- pay claims fees for each claim from claim 11 onwards (R51(7) EPC)

No claims fees are due because only 10 claims.

- 1 extra page to pay for

Therefore total payable = €715 and 10 = €725

Actually paid €730 therefore overpaid by €5.

According to Rfees 10c, a small excess payment is not repaid unless payer requests and the EPO has determined <10 Euros to be a small amount (Decn President, OJ EPO2001, 521).

Therefore excess will not be repaid automatically.

### Question 8

The decision under appeal = rejection of the opposition, therefore only the opponent O was adversely affected by the decision, so only O can appeal (Art 107 EPC).

Therefore client is a party as of right in the appeal proceedings (Art 107EPC).

Filing of the Document D1 and the restricted claim set appear to have been carried out in due time so should both be admissible per se.

However according to G8/93, if opponent as sole appellant withdraws his opposition during appeal proceedings, this immediately and automatically terminates appeal, irrespective of whether the patentee agrees or whether the patent meets the requirements of the EPC.

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There can be no examination by the EPO of its own motion under Art 114 EPC as proceedings are now pending.

Therefore the client cannot restrict the patent before the EPO.

However if D1 really is highly relevant, the client could, and should, seek to amend the patent in post-grant proceedings before each national office of the designated contracting states which he has validly entered, in order to ensure that his patent is valid. The ability to do this and the procedure required will depend on national law. If he doesn't amend, there is danger of revocation (grounds for revocation under Art 138 EPC include the grounds of Art 100(a) EPC – Art 138(1)(a) EPC).

### Question 9

According to Art 25 EPC, at the request of the competent national court trying a revocation action, the EPO is obliged to give a technical opinion concerning the European patent which is the subject of the patent, on payment of a fee (Rfees 2(20)). The opinion, drawn up by the responsible examining division is similar to those given during the examination process but does not expressly give an opinion as to whether the patent is valid (Guidelines EXII, 2). The opinion will be concerned with technical aspects, according to the specific request of the national court.

So EPO will give a technical opinion but not make a specific statement about validity.

### Question 10

a) According to Art 14(3) EPC, French is the official language of proceedings for this application, as the language of translation under Art 14(2) EPC.

There is no provision in the EPC to change the language of proceedings.

Any amendment to the patent application filed during substantive examination must be filed in French (R1(2) EPC).

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However, apart from amendments, in written proceedings before the EPO any party may use any official language (R1(1) EPC), such as English (Art 14(1) EPC).

So attorney (for client) may use English for any other written document than amendments and so may the EPO (however if the EPO is to use English, the applicant must agree J18/90).

b) Under R2(1) EPC any party to oral proceedings can use any official language provided gives EPO notice at least 1 month before oral proceedings or makes provision for interpretation into language of proceedings. Therefore attorney/client can use English with warning or translation into French.

The EPO can also use English (R2(2) EPC) as a different official language, but must arrange and pay for interpretation if required (R2(5) EPC; agreement of other parties is not required. Guidelines EV, 5.

The minutes will be in French however (Rule 2(6) EPC).

c) Divisional application must be filed in the language of proceedings of the parent application = French (R4 EPC), if USCO are applicant. If ITSA are the applicants, they can file either in French, or in Italian, under Art 14(2) EPC, followed by a translation into French within 1m of filing the divisional application (because = >3 months from filing parent) (GL AIV 1.3.3), R4, R6 EPC)

d) Art 115 EPC doesn't prescribe any language requirements for 3<sup>rd</sup> party observations. Art 14(4) EPC allows documents to be filed within a time limit to be filed in a language party is entitled to under Art 14(2) EPC, however this does not apply to 3<sup>rd</sup> party observations because they do not have to be filed in a time limit.

3<sup>rd</sup> party is not party to proceedings so R1(1) EPC does not apply.

Therefore 3<sup>rd</sup> party can file in any of the 3 official languages of Art 14(1) EPC, ie English, French or German.



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### Question 11

Can't file declaration that texts correspond because don't (R38(5)).

R51(4) communication deemed received (notified) 10d after date of communication  
(R78(2) EPC) = 25/11/04

Therefore 4 months to respond expires 25/3/05 (R83(4) EPC) = Friday but = Easter holiday

Therefore time limit extended to Tuesday 29/3/05.

Translation only available some time this week - or on 28/3/05?

### Option 1

As R51(4) communication was issued before 1/4/05, it will be possible to extend the time limit for response by 2 months under R84 EPC, so deadline for filing translation will be 25/5/05 (Wednesday), so request extension before 29/3/05 and file translation when available.

### Option 2

Clarify with translation service that "ready only in week after 28/3/05" means available from 28/3/05 – in which case, can fax-file it to the EPO on 29/3/05 and will be within the time limit (as shown above).