
Candidate's answer

Paper D1

Question 1

Yes, you can act before the EPO representing both companies. Under A133(1) and subject to A133(2), no person is obliged to be represented. Both companies being from EPC states, none is obliged to be represented. Under A133(3), natural or legal persons having their residence in an EPC contracting state may be represented by an employee, who need not be a professional representative.

So an employee can definitely act on behalf of Hypertools. He will require to be authorised (A133(3), OJ 1991, 489).

Under A133(4), parties acting in common required common representation. If common representative not appointed in request for grant (R26(3)), the election of who is the deemed common representative will be ruled by R100(1).

So, in order for an employee of Hypertool to be the common representative of both applicants, it would be necessary to name him as common representative in Request for Grant to be signed by both applicants (A-IX-1.3).

Question 2

- i) Yes. A divisional can be filed relating to any pending earlier European patent application (R25(1)). Since under A106(1) an appeal has suspensive effects, the decision to refuse the application is “frozen” and one can file a divisional as long as the appeal is pending (see also A-IV-1.1.1)

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- ii) If appeal fee is not paid in due time, the notice of appeal is deemed not filed (A108). In such a case, any divisional filed after decision to refuse will be invalid since it will not relate to a pending application as required under R25(1).
 - iii) No, since according to R25(1) divisionals can be filed relating to earlier pending EP applications. Opposition proceedings (A99) relate to granted European patents, and so the subsequent appeal related to said opposition proceedings. Since patent is already granted, no possibility to file divisionals anymore.

Question 3

The international application (IA) shall be filed with the prescribed receiving office (RO) (A10 PCT). According to R19 PCT, the competent RO is at the option of the applicant:

- i) the national office of or acting for the State of which he is resident (R19.1i) → here CH patent office or EPO (see also Applicant's Guide, vol I, Annex C). EPO acts under A151(1) EPC
- ii) the office of the State of which he is a national (R19.1ii) → USPTO here
- iii) the International Bureau (IB) (R19.1iii PCT)

So, he can file at the patent offices of CH, US, EPO or IB. Since he is claiming priority, no problem with national security provisions.

Under A 3.4 (i) PCT, the IA must be in a prescribed language. Under R12.1 (a) PCT, the IA must be filed in a language which the RO accepts for that purpose.

According to Applicant's Guide, vol I, Annex C:

- the CH patent office accepts English, French or German →so IA can be filed here in English
- USPTO accepts English only →so IA can be filed here in English
- EPO accepts English, French or German (see also R104(1)EPC)→file here in English
- the IB accepts any language→so here you can file in English or Russian

The competent ISA for each RO under A16, R35 PCT are as follows:

- RO=CH → ISA is EPO (Applic. Guide vol I, Annex C)
- RO=USA→ ISA is USPTO, EPO (A154(2)EPC) or Korean Patent Office
- RO=EPO→ ISA is EPO (A154(1) EPC)
- IB is RO → then under R35.3a PCT, the competent ISA is the one that would have been competent if the IA would have been filed with a RO competent under R19.1. So here, all the ones mentioned above (EPO, USPTO, KR patent office could be ISA). If more than one, the choice is to the applicant (R35.3b).

Question 4

- 1) Yes, it is possible to record changes in relation to the applicant during the international phase under R92bis PCT (R92bis.1(a)(i)).

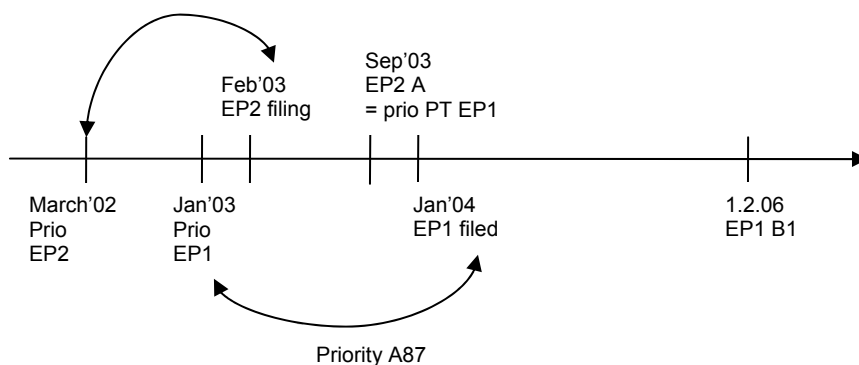
Request must be filed with the IB or the receiving office (R92bis.1(a)) and shall be requested before expiration of 30 months from priority. Recommended therefore to file it directly with the IB. If submitted before technical preparations for publication are completed, this will be already reflected in the international publication under R48 PCT

- 2) Company B is a US company.

They are entitled to file a demand for IPE under A31.2a and R54.2 PCT. The IA has been filed at the EPO. So the EPO is the competent IPEA under R59.1(a). Under A155(2) EPC the EPO may act as IPEA for a US

applicant. Demand must be submitted to EPO. Under R55.1 PCT, the demand must be in the language of the IA or if IA filed in a language other than language in which it is published, the language of publication. Application has been filed in German, which is language accepted by EPO as RO (R104 EPC) and is also a language of publication in the PCT (R48.3)→demand is to be filed in German.

Question 5



No. EP2 was filed on Feb'03 claiming priority from an earlier Portuguese national application dated March'02. From the publications of EP2 and the Portuguese application in Sept'03 we know they disclose the same invention. So under A87(1), EP2 seems to correctly claim the priority of March'02. If this was the case, then EP2 could be prior art against EP1 under A54(3), since it has been published thereafter under A93, all states are designated, so designated states are in common with EP1 as required under A54(4) – assuming that the designation fees under A79(2) have been validly paid as required by R23a.

However, in order to be prior art under A54(3) EP2 must be entitled to the priority date of March'02, so the requirements of A88(1) EPC must be fulfilled. If this were so, then under A89 the priority date shall be considered as the date of filing of EP2 for the purposes of A54(2) and (3). The requirements for validly claiming priority in EP2 have been not fulfilled and therefore the priority claim has been lost.

Under A88(1) and R38(3), a copy of the previous application must be filed. Here not done. Moreover, the applicant did not respond to communication under R41(1) setting a period for responding to this deficiency → consequence: right of priority is lost under A91(3) → effective date of EP2 is then Feb'03, which is after the priority date for EP1 (Jan'03), which has been validly claimed → EP2 is not prior art under A54(2) nor A54(3) against EP1 and thus EP1 cannot be revoked based on EP2.

Question 6

- 1) The refusal on the request for extension (R84) of the time limit is not a decision terminating the proceedings and cannot therefore be separately appealed (A106(3) EPC). The ensuing loss of rights can only be overcome by requesting further processing under A121. This should be done by 21.2.06 + 10d [R78(2), R83(2)] → 3.3.06 + 2 months [A121(2), R83(4)] → 3.5.06 Wednesday. It would be necessary to pay the fee for further processing and complete the omitted act (file a response to the communication under A96(2)) at the same time (A121(2)). At the same time, it is possible to request reimbursement of the fee for further processing. A decision rejecting the reimbursement of the fee is open to appeal (J37/89, see also E-VIII-1.6).

2) No, I would not advise him to do so. Requests for extension under R84 beyond six months, as was desired here, are only granted in certain special cases. According to E-VIII-1.6, such special circumstances might be e.g. a serious illness or the need to conduct further extensive experiments. Being on holiday on a long trip does not seem to be an unforeseeable circumstance deserving the grant of exceptional extensions under R84.

Question 7

Yes. If the proprietor of the patent states that he no longer approves the text in which the patent was granted and does not submit an amended text, the patent must be revoked. This is due to the fact that the EPO shall consider and decide upon the EP patent only in the text submitted or agreed to by the applicant or proprietor (A113(2)). See also D-VIII-1.2.5 and LA 11/82.

Question 8

Patent was granted on 27.4.05. 9m opposition period (A99(1)EPC) ends on 27.4.05 + 9m [R83(4),A99(1)]→27.1.06 Friday

Under A14(4), persons under A14(2) (i.e. persons having residence or business in EPC state not having EPO official language) may file documents to be filed within a time limit - here Notice of opposition - in an official language of state concerned. Here Italian filed opposition in Italian→ A14(4) fulfilled. A translation must be filed within 1 m of the filing of the document or up to the end of the opposition period (R6(2) EPC).

Opposition was filed by fax. This is acceptable (R36(5), R61a, OJ2005 41,45 - entered into force 1.2.05) (see also OJ 2001, 148, item 4). Date of receipt is date of receipt of the fax→24.1.06→translation into EPO official language must be filed by 24.1.06 + 1m [R6(2),R83(4)]→24.2.06 Friday→the translation is received too late.

Under A14(5), if translation not received in due time, the document is deemed not received→this brings to the Notice of Opposition being deemed not filed (see D-IV-1.2.1,(v)).

The fact that he had paid a reduced opposition fee was correct since he was entitled under the language provisions of Art 14 to a reduction in opposition fee (R6(3)) as long as R55(c) part of Notice of opposition was filed in Italian (T290/90).

Question 9

The EP patent has been filed at Vienna suboffice. The Vienna suboffice is not a filing office for the purposes of A75(1)(a) EPC. Patent applications filed with the Vienna suboffice will be forwarded to one of the filing offices (here Munich) and will be accorded a date of filing on receipt by the latter (OJ 2005,44, item 7.3)→therefore filing date of EP application is date of receipt at Munich→6.3.06→consequence is that right of priority is lost since more than 12 months (priority year ended 3.3.06 Friday) (A87(1)→12 month period)→the disclosure on 3.3.06 at a public congress in Vienna is prior art under A54(2)→EP patent application not novel under A54(1), patent cannot be granted.

CZ national application has earlier date as date of disclosure→if no additional prior art, CZ application can be granted.

Note to examiner: unless otherwise state, references to A (article), R (Rule) refer to Articles and Rules EPC. If reference is made to PCT articles or rules, this has been indicated.