

Examiners' Report - Paper D Part I 2006

It has been repeatedly reported that candidates are supposed to keep in mind that in D1 their versatility and their ability to apply the legal basis to specific situations is verified. It has to be repeated again how important it is to cite the correct legal basis and to also apply it to the specific question. The mere citation of articles and rules leaves the examiner in doubt whether the candidate has understood the underlying problem and cannot, therefore, be considered as useful. Likewise, providing the correct answer without citing the legal basis is rarely convincing.

In general, but especially when answering an open question (e.g. question 9) candidates should keep in mind that they are expected to demonstrate their ability to identify the most relevant issues of the specific situation given, and to provide solutions and advice to a potential client, for all these issues in a complete, understandable and clear manner.

Candidates are expected to use the most recent updates of legal texts in order not to lose marks.

Question 1 - It was overlooked by some candidates that the common representative was HYPERTOOLS represented by its employee, Rule 26(3) EPC was cited by few candidates. Nearly all candidates missed the point that representation before the EPO is also an issue in the international phase.

Question 2 did not cause any problems to most candidates. It seems that EPO's practice with regard to divisional applications is well known.

Question 3 - Rule 19.1(b) PCT was not always mentioned and not all the possibilities regarding languages and/or competent ISAs were identified.

For **question 4** it was expected to mention that Rule 92bis.1(a)(i) PCT only applies until the expiration of 30 months from the priority date and that German is a language of publication and can be used before the EPO. Many candidates failed to mention that the request must be received by the IB within the 30 month term.

Regarding **question 5**, most candidates did not realise that any loss of priority occurring after publication does not affect the application of Art. 54(3) EPC.

Question 6 - Many candidates proposed the procedure of Rule 69(2) EPC. They overlooked that applying this procedure would not avoid the loss of the application.

Question 7 and **question 8** were reasonably well answered.

Question 9 did not pose a serious problem to most candidates. It was required to explain what happens if an applicant transmits an application to the EPO in Vienna although this is not a filing office.

Possible Solution - Paper D- Part I

Answer to question 1

Yes. Both applicants have a place of business or residence in one of the contracting states. Therefore, no professional representative is needed (Art. 133(1),(2) EPC). Thus, I can act before the EPO because I am an employee of the applicant (A133(3) EPC).

Conditions to be fulfilled are that:

- I am authorised by HYPERTOOLS to act before the EPO
- and the authorisation or general authorisation has been filed with the EPO.

See Rule 101(1)(2) EPC, or Decision of President 19 July 91, OJ 91 p.489, or GL A-IX 1.5.

Another condition to be fulfilled is that HYPERTOOLS is appointed as common representative. HYPERTOOLS can be made the common representative either by explicit statement in request for grant (R26(3) EPC), or as first named applicant (R100(1) EPC).

I can also act before the EPO for International Applications filed with the EPO as Receiving Office by virtue of Article 49 PCT or Rule 90.1(a) PCT and Article 133 (3) EPC. HYPERTOOLS is a common representative either by explicit statement, Rule 90.2 (a) PCT, or as first named applicant, Rule 90.2 (b) PCT.

Answer to question 2:

i) Yes. A divisional application can only be filed in respect of a pending earlier European Patent Application R25(1) EPC. As the decision to refuse the application is suspended on filing of the appeal, (Art. 106(1) EPC), the application is considered to be pending. See Guidelines A-IV, 1.1.1 or J28/03, OJ 12/2005, or Notice of the EPO OJ 2002, pg.112.

ii) In this case the answer is no, because an appeal is deemed not to have been filed if the fee is not paid. See A108 EPC (second sentence).

iii) No: if an opposition against a patent has been filed, there is no pending application (as required by R25(1) EPC).

Answer to question 3:

1. Competent receiving offices:

- a. as US national he can file with the USPTO, Rule 19.1(a)(ii) PCT;
- b. as resident of Switzerland he can file with the Swiss patent office, Rule 19.1(a)(i) PCT;
- c. as resident of Switzerland he can file with the EPO, Rule 19.1(b) PCT, Art.151(1) EPC;
- d. he can file with the IB, Rule 19.1(a)(iii) PCT.

Text to be used:

when filing with the USPTO, the EPO or the Swiss office he can use the English translation;

when filing with the IB, he can use the English translation or the Russian original text, Rule 12.1(a) PCT and Applicant's Guide, Annex C.

2. Competent International Searching Authorities (Rule 35 PCT):

a. USPTO is ISA:

- when USPTO was RO (and USPTO was chosen by applicant to be ISA);
- when IB was RO (and USPTO was chosen by applicant to be ISA).

b. EPO is ISA:

- when USPTO was RO (and EPO was chosen by applicant to be ISA);
- when Switzerland was RO;
- when EPO was RO;
- when IB was RO (and EPO was chosen by applicant to be ISA).

Answer to question 4:

1. Changes of person or name of applicant can be recorded by the IB according to Rule 92bis.1 (a) (i) PCT, as long as the request for recording is received at the IB before the expiration of 30 months from the priority date, Rule 92bis.1(b) PCT.

The request can be filed with the IB or with the RO.

If the request is made shortly before the expiration of the time limit indicated above, it is recommended that it be sent directly to the IB (Applicant's Guide, Vol. I, Phase Int. 429).

2. According to Article 31 (6) (a) PCT, the demand has to be filed with the IPEA, in this case the EPO.

According to Rule 55.1 PCT, the demand has to be filed in the language of the International Application, unless this language is not a publication language or unless a translation is required before the IPEA. German is a publication language and can be used before the EPO. Therefore, the demand has to be filed in German.

Answer to question 5:

EP2 is novelty destroying against EP1 under Art. 54(3) EPC for the contracting states designated in EP2 (which are identical to the contracting states designated in EP1) for which the designation fees have been paid, R 23a EPC.

EP2 claimed a priority of March 2002 as indicated on the publication of the application.

EP2 was published earlier than the date of filing of EP1.

Any loss of EP2's priority right occurring after publication by not filing the copy of the priority document does not affect the application of Article 54(3) EPC: see Guidelines C-IV, 6.1a or C-V, 3.4.

Therefore, under Article 99 EPC an opposition against EP1 based on Art. 100(a) EPC filed until 02 November 2006 (01 November extended according to Rule 85(1) EPC) will be successful.

Answer to question 6:

1. If the client insists on having the rejection of the requested extension of time limit reviewed by a board of appeal, further processing must be requested and a refund of the fee for further processing must be requested.

The Rule 69 (1) communication is deemed to be delivered on 03.03.2006 (Rule 78(2) EPC). The request for further processing must therefore be filed by 03.05.2006.

Within said time limit, the fee for further processing must be paid and the reply to the communication must be filed.

The decision to refuse the requested refund could then be challenged with the decision terminating the proceedings, Art.106(3) EPC, i.e. grant or refusal, or separately, Guidelines E-VIII, 1.6 and J37/89 (OJ 4/1993, 201).

2. No, a sailing trip is not a sufficiently exceptional circumstance for extension, Guidelines E-VIII, 1.6.

Simply requesting further processing alone (Article 121 EPC) is cheaper and is guaranteed to succeed.

Answer to question 7:

Yes, see legal advice No. 11/82, OJ 82, 57 (or Guidelines D-VI 2.2 or Guidelines D-VIII 1.2.5. or Case Law Book VI.I.2. or T 73/84, T 186/84, T 237/86, T 347/90, T 459/88).

According to paragraph 3 of the legal advice, the request for revocation implies that the proprietor no longer approves the text as granted, Art.113(2) EPC.

Answer to question 8:

The opponent is allowed to file in Italian. According to Rule 6(2) EPC, the translation of the notice of opposition required under Art. 14(4)EPC has to be filed within the longer of one month after filing the notice (Rule 6(2), first sentence), i.e. 24.02.2006, or the nine-month opposition period (Article 99(1) EPC), expiring on 27.01.2006. Thus, the period for filing the translation expires on 24.02.2006.

The one month time limit runs from the day the fax is received (Rule 36 (5) EPC, Notice of the President dated 06 December 04, OJ 1/2005,41, Guidelines A-IX, 2.5).

The translation was received at the EPO on 28.02.2006. This is too late.

Therefore, the opposition is deemed not to have been filed.

Answer to question 9:

The Vienna sub-office of the EPO is not a filing office in the sense of Art. 75(1)a EPC.

Therefore European patent applications cannot be filed there. See notice of the EPO of 06 December 2004 concerning the Vienna sub-office, OJ 1/2005, 44, Guidelines A-II, 1.1.

Applications received at the Vienna sub-office will be transmitted to Munich or The Hague, and their filing date is their date of receipt in Munich or The Hague.

Hence the filing date of EP-A is 06.03.2006, which is later than the 12-month period of Article 87(1) EPC, which ended on 03.03.2006.

The priority claim is therefore not valid, and the lecture is novelty destroying for EP-A under Article 54(1) and (2) EPC. The lecture is not prior art against CZ-A.

EXAMINATION COMMITTEE III

Candidate No.

Paper D 2006 Schedule of marks

Question	Maximum possible	Marks awarded	
		Marker	Marker

PART I

1	5		
2	4		
3	7		
4	4		
5	5		
6	5		
7	2		
8	4		
9	4		
TOTAL PART I	40		

PART II

Claim 1	9		
Claim 2	6		
Claim 3	6		
Claim 4	17		
Claim 5	1		
Can we extend to cover UK and BE?	2		
Is there any possibility to postpone the national phase?	5		
Can we stop Mr Bad marketing his panel?	11		
Can Mr Bad stop us from marketing our panel?	3		
TOTAL PART II	60		

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)

29 August 2006

Chairman Examination Committee III