
Candidate's answer

Abbreviations used:

A. or Art.	Article
R.	Rule
RRF	Rules Relating to Fees
EPC	European Patent Convention 2000
PCT	Patent Cooperation Treaty

Question 1

- a.) Requirement for the accordance of a filing date: A.80, R.40 EPC.

The requirements of R.40(1) are met.

R.40(1) a.) indication that a European Patent is sought OK

b.) information identifying the applicant or allowing him to be contacted: his name and e-mail address satisfies this requirement.

c.) a description – the article is sufficient to include a description (Guidelines A-II, 4.1.3)

=> Thus requirements of A.80+R.40(1) met.

It is possible to file a European patent application with the EPO by fax. A.75(1)(a) EPC, R.2(1) EPC, Dec. of the President of 12/07/2007, Spec. Ed. 3 of OJ 2007, A. 3. Art. 2(1).

Written confirmation may be requested by the EPO, to be filed on request (Dec. Pres. Spec. Ed. 3 of OJ 2007, A. 3. Art. 7.)

It is possible to file in Japanese Art.14(2) EPC.

→ Thus a filing date will be accorded the fax will be treated as a European patent application.

- b.) Formal requirements to be met: Examined under A.90(3) EPC, R.57 EPC.

File a translation to one of the EPO's official languages (official languages: English, French, German A.14(1) EPC), within 2 months of filing A.14(2) EPC, R.6(1) EPC, (R.57(a) EPC).

R.57(b): file request for grant from (Form 1001) in accordance with R.41: shall contain in addition

R.41(2)(b) title of the invention

(c) name, address and nationality of applicant and state in which his residence, place of business is

- (d) representative's name, address
- (h) signature of the applicant or representative
- (i) list of documents
- (j) designation of inventor acc. to A.81 EPC

within 2 months from invitation under R.58 EPC if not filed earlier.

R.57(c): claims shall be included in the application → shall be filed A.78(1)(c).

Claims filed later upon invitation under R.58 must comply with A.123(2)!

If more than 10 claims: pay claims fee for the claims from 11 and further

(R.45, RRF2(15)) within 1 month of the filing of the first set of claims (R.45(2) EPC)

R.57(d): abstract shall be filed A.78(1)(e).

Both to be filed within 2 months from invitation under R.58 EPC if not filed earlier.

Pay the filing and search fee (RRF 2(1) filing fee, RRF 2(2) search fee) within 1 m. of the filing of the application R.38 EPC.

R.57(i): file the description in a form which satisfies R.49 and R.46 if there are any drawings.

Appoint a representative A.133(2) EPC. If a professional representative is appointed according to A.134(1) EPC authorisation is not required to be filed only upon invitation (R.152(1) EPC, Decision of President Spec. Ed. 3. of OJ 2007).

Question 2

today 04/03/2008

DE-U 26/02/2007

It is possible to claim priority from a German utility model: A.87(1), Germany is a member of Paris Convention A.87(1)(a).

End of priority year: 26/02/2007 $\xrightarrow[\text{R.131(4)}]{\substack{\text{A.87(1)} \\ \text{12m}}} \underline{26/02/2008}$
(Tuesday)

On 04/03/2008 the priority year is over.

Possibility to remedy: Further processing is excluded under A.121(4) EPC.

But it is possible to request re-establishment of rights in the priority period A.122, R.136 within 2 months of the expiry of the priority period (R.136(1) EPC):

26/02/2008 $\xrightarrow[\text{R.131(4)}]{\substack{\text{R.136(1)} \\ \text{2m}}} 26/04/2008$ $\xrightarrow[\text{(Monday)}]{\substack{\text{R.134(1)}}} 28/04/2008$
(Saturday)

This a written request for re-establishment of rights shall be filed at the latest on 28/04/2008.

R.122(2), R.136(1) pay the fee for re-establishment RRF2(12) complete the omitted act → thus file the application (R.136(2)).

The request must comply with R.50, and state the ground on which it is based and set out the facts on which it relies (R.136(2), A.122(2)).

It seems that the accident can serve as a basis on which base all due care can be proven, it was unattended (T525/91 in which a sudden illness was a sufficient ground).

The facts may be submitted later by providing means by which facts are supported: here e.g. medical certificates, documents from the police (T324/90).

Question 3

EP grant 03/2006

product claim + dependent product claims

process claim

Opposition on the ground A.100(a) EPC – A.54(3) novelty destroying for product claim.

EP filed under EPC 1973: The document is novelty destroying only for the designated contracting states in common as patent filed before 13/12/2007 (Guidelines: C-III, 8.1. (i)) i.e. for DE, FR, GB, IT.

→ The claims may be maintained as granted in the other connecting states.

The product claims in for DE, FR, GB and IT should be amended on the basis of R.80 EPC and R.138 EPC : restrict on the basis of the dependent claims if possible in the light of the cited document or amend it to a use claim as it is possible, does not contravene A.123(3) EPC (G2/88).

R.138 EPC allows different claims for different contracting states for applications filed before 13/12/2007 (R.87 EPC 1973).

Question 4

Opponent O
 Patentee P

a) Yes it is possible to intervene: Art.105(1)(a) EPC.

Possible to intervene during pending opposition appeal proceedings G1/94.

→ The intervenor will be party as of right → he/she does not have to pay the appeal fee (G3/04).

Notice of intervention shall be filed within 3 months of the date of institution of proceedings for infringement (A.105(1)(a) + R.89(1)) :

$$10/01/2008 \xrightarrow[\substack{\text{R.89(1)} \\ \text{3m} \\ \text{R.131(4)}}]{\text{}} 10/04/2008 \text{ (Thursday)}$$

Notice of intervention shall be filed at the latest on 10/04/2008 provided appeal of opposition is still pending in written reasoned statement R.89(2), R.76, R.77 EPC together with the payment of opposition fee within the same period (R.89(2), RRF2(10)).

b) No

If the sole appeal (by opponent) is withdrawn the intervenor may not continue the proceedings and the appeal proceedings are terminated for all parties as regards the substantive issues, including new ground raised by the intervenor (G3/04) as a party as of right has no independent right to continue proceeding following the withdrawal of the sole appellant (G2/91).

Thus the intervenor cannot continue the appeal proceedings.

Question 5

A + B – EP – P pending
| |
NL BE

Filing of a divisional application: Art. 76, R.36 EPC.

The divisional cannot extend the content of the patent application as filed A.70.

The parent application is still pending, R.36(1) OK

To be filed directly with EPO A.76(1).

Designated contracting state: NL was designated in the parent application when divisional filed, Art.76(2) fulfilled.

But the parent application is filed by multiple applicants (A.59) designating different contracting states. → A.118 they are regarded as joint applicants so can act only commonly.

Where the parent application is filed by multiple applicants the divisional should also be filed by the same multiple applicants.

So the application will not be accepted as a divisional. It is suggested to file the divisional by both A and B and B should subsequently notify the EPO under R.22 and withdraw as applicant (J2/01.).

Question 6

The international application is published immediately after the expiration of 18 months from the priority date (Art.21(2)(a) PCT):

The application is filed without claiming priority its "priority date" is the filing date
Art.2(2)(xi)(c) PCT = 30/09/2006

Date of publication 30/09/2006 $\xrightarrow{18 \text{ m}}$ 30/03/2008
R.80.6 PCT Sunday
R.80.2 PCT

→ The publication is in general the first Thursday after said expiry: 03/04/2008

There will be no international publication if the international application is withdrawn before the technical preparations for publication have been completed:

Art.21(5), R.90bis 1(c) PCT.

The technical preparations for publication are generally completed by the 15th day prior the date of publication (Applicants Guide-I, 305.)

→ here: 03/04/2008 – 15 days: 19/03/2008. Thus today on 04/03/2008 it is not too late.

The application can be withdrawn before the expiration of 30 months from the priority date (Art.3; R.90bis 1(a)).

→ The withdrawal must be submitted to the receiving office or the International Bureau (IB) (R.90bis 1(b)) but as the date is close (19/03/2008) it is recommended to contact the IB for the exact date of publication.

A notice of withdrawal must be signed by all (both) applicants (R.90bis 5(a)) if no common agent or common representative has been appointed R.90.2(a) as the considered common representative (R.90.2(b)) may not sign the notice of withdrawal.

An appointed agent or appointed common representative (R.90.2(a) PCT) may sign the notice of withdrawal on behalf of the applicants but in this case a separate power of attorney has to be furnished before or simultaneously with the notice of withdrawal (R.90.4(e)) if not submitted yet (R.90.4(d)).

As the US was also designated the applicant/inventors X and Y for US must also sign. (R.4.1(a)(iv)).

It is free of charge Applicants Guide – I, 452.

Question 7

A filing 21/09/2005

Mr B

Ms G

filing date = "priority date" : A.2(2)(xi)(i) PCT. : 21/09/2005.

The change in the name of the inventors can be requested within 30 m. from the "priority date" (here filing date) : R.92bis 1(a)(ii)

21/09/2005 $\xrightarrow[30\text{ m}]{\text{R.80.2 PCT}}$ 21/03/2088 it is not over yet,

so the change can be requested in the international phase. It can be sent to the receiving office or to the International Bureau (IB) R.92bis 1(a)(ii) → but the IB records it. As the time limit is close better to send directly to IB.

It is free of charge (Applicants Guide – I, 427)

The PCT has no similar provision as R.21(1) EPC that the inventor must give his consent to be removed from the international application. The request need only be signed by the applicants or agent as a normal letter under R.92.1; R.4.6 PCT.

Assignments and other documents relating to the right to file the international application may be required by designated offices once national processing has started.

(Applicants Guide – I, 427)

Thus file a letter signed by applicant or agent to the IB.

If it is requested after the 30m. → has to be done in the regional phase before the EPO Art.153 EPC, +Art.150(2) EPC under Art.81 EPC.

The request for correction must contain a declaration according to R.19(1) mentioning the added designation of inventor and signed by applicant or representative and the consent of the wrongly designated inventor has to be filed as well! R.21(1)!

Thus it is more simple to correct the designation of inventor in the international phase.

Question 8

PCT-X	15/05/2006
prior.	14/12/2005
ISR	30/04/2007

Time limit for filing the demand: R.54bis 1(a) PCT

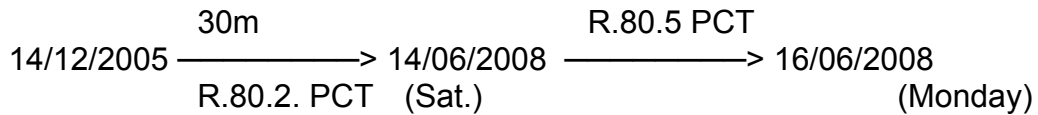
22 m. fr. priority: 14/12/2005 $\xrightarrow{22m}$ 14/10/2007 $\xrightarrow{R.80.5 PCT}$ 15/10/2007
R.80.2 PCT (Sunday)

or 3m. fr. transmittal of ISR:

30/04/2007 $\xrightarrow{3m}$ 30/07/2007
R.80.2 PCT (Monday)

Both are over.

- a) Withdrawal of priority claim R.90bis 3(a) possible within 30 months from priority date:



Yes, withdrawal of the priority claim is still possible as 30 months from priority date not expired yet (16/06/2008 and today 04/03/2008 OK).

- b) No, as because as detailed above the time limit for filing the demand (R.54bis 1(b) is 15/10/2007 22 months from priority date as it is later than 3 months from receipt of the search report (30/04/2007) ← already expired and by the withdrawal of the priority claim only those time limits are recomputed which are not expired yet R.90bis 3(d).

- Thus the withdrawal of the priority has no sense in order to file a demand.
- As the demand is necessary in order to carry out an international preliminary examination A.31(1) PCT.