
Candidate's answer

1/. a/. A European patent application may be filed by any natural or legal person [Art. 58].

→ Mr McX is therefore entitled to file the EP application

A European application shall be filed in any of the three official languages (EN, FR, DE), or if filed in any other language, translated into one of the official languages [Art 14(2): Art 14(1)].

If filed in a non-official language such as Italian, the translation into EN, FR, DE should be filed within two months of the filing date [Rule 6(1)].

The application is therefore validly filed, but a translation into EN/FR/DE must be filed within two months of "last week".

Note: Mr McX is not entitled to a reduction in the filing fee, as he is not entitled to use Italian in accordance with Art 14(4) EPC.

b/. According to Rule 3(2), amendments to a European patent application must be filed in the language of the proceedings, i.e. French.

Under Article 14(4), a national or resident of a contracting state that has an official language other than EN, FR, DE may file a document that needs to be filed "within a time limit" in the official language of that state. However, Italian is not an official language of the UK, and so Mr McX is not entitled to use Italian. If he were, he must supply the translation into French within one month of "last week" [R. 6(1)]. However, since Mr McX is not entitled, R.3(2) requires that the amendments should have been filed in French.

Conclusion: The amendments are not validly filed [Art 14(4)].

c/. An opposition is a document to be filed in a time limit, and so potentially could be filed in Italian if Mr McX were entitled to use this language. However, as outlined in b/. above, Mr McX is not entitled to use Italian. Mr McX should have filed the opposition in EN/FR/DE within the 9 month period, i.e. by yesterday [R. 3(1), Art. 99(1)].

The opposition will be deemed not filed and the opposition fee will be refunded [Guidelines, D-IV, 1.2.1(v)].

The opposition will be forwarded to the proprietor and put on the file as 3rd party observations [Art 115].

2/. An opposition must be filed within 9 months [Art 99(1)]. It must therefore be filed today.

According to G3/99, an opposition can be filed with joint opponents [construed in the light of Art. 58]. Therefore, in principle it would be possible to file the opposition in the name of A & B.

According to G4/88, an opposition can be transferred or assigned to a third party as part of the opponent's business assets. However, this position was restricted in G2/04, which held that a conglomerate that filed an opposition could not transfer the opposition together with the subsidiary's assets, as it was deemed that the opposition could and should have been filed in the name of the subsidiary.

Following G2/04, it is not recommended to file the opposition with A as the opponent. Instead, should file it jointly in the name of A and B. A could withdraw as opponent after the transfer [G2/04, r2.1.2].

As an alternative, the opposition could be filed in the name of A as a main request, and B as an auxiliary request [G2/04, r3.2].

However, this latter strategy, and also filing in the name of B alone, raises the issue that I am not entitled to represent B, as I am not an employee of B [Art. 133(3)]. Thus, I could not file the opposition in the name of B and we would need to obtain the signature of a qualified representative or authorised employee of B. Absent either of these, the opposition in the name of B would be deemed not filed. Although the EPO would invite us to rectify the missing signature [Guidelines, D-IV, 1.2.1(ii)], it is better to file the opposition jointly (i.e. with A and B as opponents) with me as the common representative [G2/04, R. 151(1)].

3/. Pubⁿ SR = 13/8/08

Rule 39(1) - Designation fees are due 6 months after publication of the European search report. That date is:

13/8/08 + 6 months [R. 131(4)] => 13/2/09 [Friday]

It is too late to pay any more fees in the normal deadline.

They may still be paid under further processing, as the period under R.39(1) is not excluded in Rule 135(2).

The further processing deadline is:

20/2/09 + 10 days [Rule 126(2)]

=> 2/3/09 + 2 months [Rule 131(4)]

=> 2/5/09 [Saturday], extended under Rule 134(1)

=> 4/5/09 [Monday]

Therefore, the fees may still be paid until 4 May 2009, providing a 50% surcharge is also paid [RFees, Art 2(12)].

A divisional application may be filed from any pending European application [Rule 30(1)].

As the separate invention lacks unity, it will not be possible to pursue this invention in the present application [Art 82]. The invention is not claimed, and so was presumably not searched. The application cannot be amended to claim unsearched subject matter [Rule 137(4)].

Due to non-payment of the designation fee in Ireland, the application is deemed withdrawn in that state [Rule 39(2)]. This deemed withdrawal takes effect at the end of the R.39(1) period, i.e. 13 February 2009 [G4//98]. Therefore, the application is no longer pending in IE.

A must therefore pay the designation fee (€85) in Ireland together with the further processing fee (€42.50) before the deadline of 4 May 2009. A is advised to do this before 1 April 2009 when the designation fee changes to a flat fee of €500.

Once the designation fee has been paid, A may file a divisional application to the non-unified invention [Art 76(1); Rule 36(1)]. When filing the divisional, A should pay the filing, search and 3rd year renewal fee, together with any necessary claims fees.

On filing the divisional, DE, FR, GB and IE will be designated [Art 76(2)].

Provisional protection will be available on publication of the divisional [Art 67(1)]. To ensure earlier publication, A may wish to serve the competitor with a copy of the divisional, or any necessary translation as required under Irish Law.

I would advise filing the divisional using the description of the application as filed to allow maximum scope for amendment. The claims should be suitably drafted to the non-unified subject matter of interest. To ensure expedient grant, A may wish to waive his right under Rule 70(2) to confirm to proceed, and request PACE, that is accelerated search and examination [Notice from EPO dated 14 July 2007, Spec Ed. 3 OJ 2007, F1].

4/. The renewal fee for the 7th year is €1000 [RFees Art 2(4.5)].

The additional fee for belated payment is 50% of the relevant fee [RFees Art(2.5)].

A should have paid €1500.

Two weeks ago was: 17 February 2009.

Renewal fees are due at the end of the month, namely 28 February 2009 → 2 March 2009 [Rule 51(1); Rule 134(1)].

Therefore, payment was effected at least 10 days before the relevant due date. However, this is not relevant, as the 10 day fail safe arrangement of RFees Art 9(3) does not apply, the EPO received the fees, but not enough.

According to RFees Art 8(1) first sentence, the payment was not for the full amount and so the payment was not validly paid. According to RFees 8(1), last sentence, the EPO may overlook "small amounts". However, 847/1500 ~ 40% underpaid which is not a small amount [T161/96].

The fee is therefore not validly paid [RFees 8(1), first sentence].

However, as A made the payment through a deposit account, the EPO will take the correct amount, providing the intention is clear [T152/82], and there are sufficient funds in the account. Following this, the EPO will debit the correct fee of its own motion.

5/.a/. The PCT application has been filed in French. According to Rule 55.1 PCT, the Demand should be filed in the language of the application as filed, or as published (if different).

According to PCT Applicant's Guide, Chapter C-FR, the French Patent Office only accepts French. As French is a language of publication, and a language accepted by the EPO as a search language, the application will be published in French.

ROCOM must therefore file the demand in French, plus any amendments to the application in French [Rule 55.1 PCT, Rule 66.9(a) PCT].

Furthermore, Rule 66.9(b) PCT requires that any letter accompanying an amendment in the IPEA must be filed in the language of publication, i.e. French. If the communications to the IPEA are not in French, the IPEA will invite (subject to there being sufficient time) the applicant to file the amendments/letter translated into French [Rule 66.9(c)].

In summary, ROCOM should use French, but may be allowed to use another language at the discretion of the EPO acting as IPEA.

b/. According to Article 14(4) EPC, natural or legal persons having their residence or principle place of business in a contracting state that has an official language other than EN, FR, DE may use that language to file documents within a time limit. A translation into an official EPO language must however be supplied within 1 month [Rule 6(2) EPC]. This translation may be in EN, FR, or DE [Rule 3(1) EPC].

Romanian is an official language of Romania, which is a contracting state. ROCOM may therefore file documents that need to be filed within a time limit in Romanian.

More generally, any party may use English in written proceedings before the EPO [Rule 3(1)]. However, ROCOM must file amendments (or translations of any amendments) in the application in French, as this is the language of the proceedings [Rule 3(2)]. The question of whether ROCOM could change the language of the proceedings by filing a translation under Rule 159(1)(a) EPC has been referred to the Enlarged Board of Appeal [G4/08].

6/. a/. A European patent application may be licensed in whole or in part for the whole or part of a contracting state [Art 73].

According to Art. 74 EPC, the provisions of the EPC prevail over national law for the registration of the license.

The licensee may be recorded on the European Patent Register at the request of the licensee, upon production of the relevant documentation and payment of the necessary fee [Rule 23(1) referring to Rules 22(1) and 22(2)]. A should therefore send the license documentation to the EPO and request its recordal.

b/. According to Rule 24(a), a request to record an exclusive license can only be possible with the agreement of the exclusive licensee and the applicant. In this event, A will need to seek B's consent to record the license on the Register. The same steps as outlined in a/. above are required, only that B's consent is now required.

Absent B's consent, the license may only be recorded as a non-exclusive license, or possibly not recorded at all [no case law on this].

7/. Added-matter is a ground for opposition [Art 100(c)]. Therefore the opposition was based on valid grounds.

The withdrawal has been published and therefore is irrevocable. As the opposition period has passed, it is not possible to file a new opposition.

According to G9/91, the opposition is limited to the parts of the patent opposed. In this case, as there is only one claim, it is opposed in its entirety.

According to G10/91, the Opposition Division is not obliged to consider grounds that have not been raised in the notice of opposition. Novelty is a new ground, so the OD is not obliged to consider it.

However, the OD will continue with the opposition of its own motion in accordance with Art 114(1)/R84(2).

Under Art 114(1), the OD will, in principle, examine other grounds if they are *prima facie* prejudicial to the maintenance of the patent.

We could file the novelty destroying prior art document together with comments on how this document prejudices novelty under Art 115 (which refers to Art 54). These observations would be forwarded to the patentee and may be taken into account by the opposition division in its examination under Art 114(1)/R.84(2). However, we would not be party to the proceedings [Art 115, last sentence].

According to T1002/92, late filed documents that go beyond the statement of grounds would exceptionally be admitted if there are *prima facie* grounds to suspect that the material will prejudice maintenance of the patent. On this basis, they may be admitted and considered by the Opposition Division.

8/. A divisional application may be filed from any pending European application [Rule 36(1)].

The filing fee [€180, RFees 2(1)] and search fee [€1050, RFees 2(2)] must be paid within one month of filing the divisional application [Rule 36(3)], i.e.

3/3/09 + 1 month [Rule 131(4)] => 3 April 2009 [Friday]

Both the search and filing fee may be paid later using further processing. However as the invention has already been searched, the applicant should request a refund of the search fee [RFees 9(2)], and provide a copy of the earlier search report.

Additionally, the claims fees of €200 [RFees 2(15)] for the 16th-20th claims should be filed within one month of the filing of the first set of claims [Rule 45(2)], that is 3 March 2009 + 1 month [Rule 131(4)] => 3 April 2009.

Even though the claims fees have been paid on the parent application, they must still be paid on the divisional application [Guidelines, A-IV, 1.4.2]. If the applicant fails to pay the claims fee, he is invited to do so within 1 month [Rule 45(2)].

Renewal fees are calculated from the date of filing of the parent application. The third year renewal fee of the parent is therefore due 28 February 2010 [Rule 51(1); RFees 2(4)]. A renewal fee is therefore not due for the divisional application (Rule 51(3) indicates renewal fees already due). The renewal fee for the third year of the divisional is therefore also due 28 February 2010 [Rule 51(1) EPC; Art 76(1) last sentence (FD of divisional is FD of parent)].

The designation fees for the divisional application will be due 6 months from the date on which the European Patent Bulletin mentions the publication of the Search Report drawn up on the divisional application [Rule 36(4)]. This date is not yet known. The amounts designation fees are dictated by RFees Article 2(3) and 2(3a), presently 85 Euros. However, after 1 April 2009, the designation fee is changing to a single designation fee of €500 to designate all contracting states [RFees 2(3)].

The Examination fee becomes due 6 months after the publication of the European Search Report [Rule 70(1)]. The amount is €1405 [RFees 2(6)].

9/. The divisional application is filed in April 2008, which is after EPC2000 came into force (i.e. after 13 December 2007).

According to Article 1(1) of the Dec. Admin Council of 28 June 2001, Article 54(3) EPC2000 applies to applications pending on entry into force of EPC2000, however Article 54(4) EPC1973 applies only to applications filed under EPC1973 [see also Art 7 of the act revising the EPC, 29 December 2000].

As the divisional application is actually filed under Art 76(1) EPC2000, Art 54(4) EPC1973 does not apply to the divisional application. Although the divisional will be accorded the filing/priority of the present application [Art 76(1)], this is a legal fiction for prior art purposes, Art 54(3) EPC2000 shall apply.

Under EPC2000, D1 will constitute a prior right under Article 54(3) for all designated states in the divisional application, namely DE, GB and NL [Art 76(2)].

Thus, D1 will be citable for novelty against the divisional application, D1 will however not constitute prior art for the purpose of assessing inventive step [Art 56 referring to Art 54(3)].

D2 was published before the filing date of EP1, and therefore constitutes prior art under Art 54(2) EPC and is citable for both novelty and inventive step.

In contrast, D1 is not prior art against EP1, since it does not have any countries designated states [Art 54(3) & 54(4); Rule 23a EPC1973].

Thus, while D1 was not relevant to EP1, it is relevant to the divisional.

As D1 anticipates the subject matter of all of the claims of EP1, it is to be expected that the divisional application will lack novelty over D1 (at least the claims as filed do), and will therefore not lead to grant of a patent. This is of course assuming that EP1 had no subject matter in the description which could be novel over D1.

Note, as D1 is a 54(3) prior art document, it would be possible to establish novelty over D1 by using a disclaimer [G1/03].