
Candidate's answer

1.

- The last request may be accepted.
- The extent of the opposition is defined by the notice of opposition filed under A99 EPC/R76(2) EPC – specifically R76(2) EPC.
- The notice of opposition must be filed within 9 months of publication of the mention of grant A99(1) EPC.
- Subject-matter not covered by the extent of opposition is not subject to any opposition in the sense of A101 and nor are there any proceedings in the sense of A114 and A115, G9/91.
- Thus, the attempt to extend the opposition to claim 2 will be rejected.
- However, there may still be a chance of succeeding in getting the patent revoked.
- In particular, it is only necessary for a single claim in the set of claims on file to be found unallowable in order for that set of claims to be rejected in its entirety (T926/93).
- Thus, if claim 1 is found to lack novelty and/or inventive step then the patent will be revoked (unless the patentee files auxiliary requests directed to a more limited set of claims not sharing this deficiency).
- In principle, the objection of lack of novelty against claim 1 should have been made in the notice of opposition, G10/91.
- However, the Opposition Division must nonetheless consider every ground raised, including those raised only during the opposition proceedings, G10/91. such new grounds are only to be admitted if they appear *prima facie* relevant, G10/91.
- Thus, the Opposition Division is required at least to consider the relevance of the new ground of lack of novelty in relation to claim 1. if it is *prima facie* relevant and on further examination correct, then the claims as granted will be rejected as a whole (T926/93) on the basis of lack of novelty of claim 1.
- Alternatively, should the Opposition division either not admit the lack of novelty attack as not *being prima facie* relevant or not being found correct, then the claims as granted could still be rejected as a whole on the basis of the lack of inventive step attack put forward in the original notice of opposition.

2.

- Protection can be obtained only for the football made of 33 patches of PX.
- A divisional application can only be filed in respect of subject-matter that does not extend beyond the content of the earlier applications as filed (A76(1)EPC) and while the earlier application is pending (R36(1)).
- DIV-1 was thus validly filed as its subject-matter was completely contained in EP-1 and it was filed before EP-1 was withdrawn, i.e. while EP-1 was pending.
- DIV-2 however currently does not fulfil the requirements of A76(1) EPC, because it discloses the stitching method whereas the earlier application, DIV-1, does not. Note that the requirements of A76(1) must be assessed in relation to the disclosure of DIV-1 not EP-1 as DIV-2 is a divisional of DIV-1 (G1/05). It would in fact not have been possible to file DIV-2 as a divisional of EP-1 since EP-1 was already withdrawn (i.e. fails the R36(1) requirement).

- It is allowable to remove the unallowable subject-matter (the stitching method) from DIV-2 and still to retain divisional status, G1/05. It is not relevant that the subject-matter is no longer pending, G1/05.
- The disclosure relating to the stitching method will thus need to be deleted from DIV-2 by amendment under A123/R137(2) after receipt of the European Search Report.
- It does not appear possible to claim a football having a number of patches other than 33.
- The claim includes the number 33 as a technical feature and in order to delete this feature direct and unambiguous basis for the amendment is needed (A123(2), G1/93, GL C-V1 5.3.1).
- In the case of deletion of a feature from a claim, it would be necessary to show that:
 - (a) the feature was not explained as essential in the disclosure;
 - (b) it is not, as such, indispensable for the functions of the invention in the light of the technical problem it serves to solve, and
 - (c) the removal requires no real modification of other features to compensate for the change.

(GL C-VI 5.3.10; T331/87).

- In this case, removal of the “33 patches” feature appears to contravene at least the above requirements (a) and (b) and as such it would be unallowable under A123(2).
- It may be possible to file a new application directed to footballs having other than 33 patches. This would of course depend on factors such as whether priority could still be claimed from any of EP-1, DIV-1, DIV-2, whether any of these applications have been published, whether an inventive step exists in relation to other numbers of patches, and so on.

3.

- a) No.
 - The conditions for an effect of a priority claim under the PCT are subject to A4 of the Paris Convention (A8(2)(a) PCT).
 - The priority period is fixed at 12 months for patents (and utility models), A4C(1) PC.
 - The priority period therefore ran to 27/2/09 +12 m = Saturday 27/2/10, which is extended to Monday, 1/3/10 under R80.5 PCT.
 - The filing date of 2/3/10 is therefore outside the priority period, and the priority claim is invalid.
 - Under A48(1) PCT and R82(1)(a) PCT it may be possible to excuse missed time limits due to mail irregularities, provided the relevant document or letter was mailed at least 5 days prior to the expiration of the period, R82(1)(a) PCT.
 - In this case, the mailing date of 25/2/10 is only 4 days prior to the expiry of the period (1/3/10): hence A48(1)/R82 PCT does not apply.
- b)
 - The applicant could seek to make use of the PCT provisions on restoration of priority for PCT-X, R26bis3 PCT, R49ter PCT.

- The request for restoration could be filed at the EPO as Receiving Office R26bis3 PCT.
- Such a request would need to be filed within 2 months from the expiry of the priority period (R26bis3(e)PCT), i.e. by 1/3/10 + 2 m = Saturday 1/5/10, extended to Monday 3/5/10 under R80.5 PCT.
- It would also need to state the reasons for failure to file in the priority period, satisfying the requirements of “all due care”, and include the fee for applying for restoration (R26bis.3(b),(d) PCT; PCT App. Guide Annex C – EPO – fee is €550).
- Alternatively, the Applicant could pursue separate restoration requests at the designated offices for entering the respective national phases, R49ter PCT.
- It may well be best to pursue the restoration at the EPO as Receiving Office because subject to narrow exceptions designated offices allowing restoration would be required to accept a positive finding by the EPO under the “due care” criterion, thus saving money compared to multiple separate requests in the national phase.
- Not all states will accept the restoration of priority under any circumstances, eg JP (see reservations to R26bis3 PCT, R49ter1g PCT and R49ter2h PCT).

4.

a)

- EP-A must have met the requirements of R40 EPC, i.e.
 - o An indication that a European patent is sought, R40(1)(a),
 - o Information identifying the applicant or allowing the applicant to be contacted, R40(1)(b) (the fax number would be sufficient – GL A-II 4.1.2),
 - o A description or reference to a preceding filed application, R40(1)(c) (here, the reference),
 - o The filing date and number of the referenced application, the office (CN) with which it was filed, and an indication that it replaces (at least) the description and any drawings, R40(2),
 - o A certified copy of the previous application, R40(3) (NB this can be filed within 2 months of filing the application according to R40(3) or within 2 months of a communication under R55 EPC, in which case the date of filing is retained, GL A-II 4.1.5).

b)

- The PCT application must contain a request, a description, one or more claims and an abstract (A3(2)PCT).
- There is no provision in the PCT for filing an application by reference. However, since it will have been necessary for applicant A to have filed an certified copy of CN-A to obtain a filing date for EP-A, this implies he will be able to use this document as the basis for at least the description.
- Claims may or may not have been filed on EP-A (not a requirement to obtain a file date – see above). If not, claims should be added.
- The abstract can be added later, if necessary (A11.1 PCT does not require an abstract to acquire a filing date; it can be added later in accordance with A14 PCT).
- However, the priority claim to EP-A will not be valid.
- The PCT applies A4 of the Paris Convention to determine the conditions for claiming priority, A8(2)(a) PCT.

- According to A4C(2) PC, the priority period, of 12 months (A4C(1) PC), from the date of filing of the first application.
- EP-A is not the first application, as CN-A was filed earlier by the same applicant on 1/7/08.
- The priority period for this first application, CN-A, has thus long expired (on 1/7/08 + 12m = 1/7/09).
- Moreover, the narrow exception of A4C(4)PC does not apply – EP-A cannot be considered the “first” application because CN-A has been published and has also served as a basis for claiming priority.
- As such, CN-A as published on 10/1/10 will be prior art for novelty and inventive step against PCT-A (R33.1a PCT) and will destroy its novelty.
- (NB there may be an exception as regards the US designation, since under US law disclosures by the inventor up to 1 year before the filing date are not novelty-destroying – US grace period, PCT AG NP Summary USA.)

5.

- For application PCT-E, the EPO will not carry out a Supplementary European Search under A153(7) as it was the ISA (Dec. Adm. Council OJ 2007 642, A1).
- The EPO will therefore invite the Applicant to restrict PCT-E to the subject-matter searched in the ISR, R164(2) EPC, i.e. PCT-E1.
- In order to obtain protection for PCT-E2, a divisional application will need to be filed (while PCT-E is still pending, R36(1)), GL C-III 7.11.4.
- The divisional application should be filed either with only the claims relating to PCT-E2 or at least with those claims listed first.
- For application PCT-U, the situation depends on whether the 1 month period for responding to an invitation to amend the claims after entry into the European regional phase has expired, R161 EPC.
- If this period has not expired, the Applicant should respond to the invitation by amending the claims so that PCT-U2 is the invention first mentioned in the claims.
- In this case, the EPO will draw up the Supplementary Search Report of A153(7) EPC based on this invention at least, R164(1) EPC.
- The Applicant should then be able to prosecute PCT-U2 directly in PCT-U.
- If the period has expired, the EPO will carry out the search of A153(7) based on the claims now on file. If the EPO agrees that there is a lack of unity as set out by the US PTO in the international phase, the search will be limited to the first invention, i.e. PCT-U1, R164(1) and the Examining Division will invite the applicant to limit to these claims, R164(2).
- Unless the Applicant can convince the Examining Division that the non-unity finding was wrong, it will then be necessary to file a divisional application to pursue PCT-U2, while PCT-U remains pending, R36(1).

6.

- A70(1) EPC holds that the authentic text of the European patent is that in the language of the proceedings before the EPO.
- A70(3) EPC however allows contracting states requiring a translation into one of their official languages to consider this translation to be regarded as authentic, except in revocation proceedings, if the translation is of narrower scope.

- Italy has made use of this provision, Nat Law Table V1-Italy.
- The authentic text in Italy thus contains the range 3-4% (this being narrower than the text in the language of proceedings 3-40%).
- However, Italy is required to allow X to file a corrected translation under A70(4) EPC, which has legal effect only after the normal post-grant requirements under A65(2) EPC have been complied with (for Italy, translation of the patent specification and providing of a declaration by X or his representative on the last page of the translation that it is in complete agreement with the original, Nat Law Table IV – Italy).
- Italy has also made use of A70(4)(b) EPC (Nat Law Table V.2 – Italy) and so company Y is entitled to continue their use, which was not an infringement according to the original translation, even after the legal effect of the new translation takes effect, provided that the earlier use was in good faith.
- Thus, it appears that assuming Y did not act in bad faith X is not able to stop Y from selling the new product.
- It would be sensible to contact a local patent attorney or legal practitioner to confirm this position (and, e.g., whether Y still has the right to carry out other acts such as licensing).

7.

- a) - The first renewal fee was due on 28/2/10 (R51(1) – last day of month containing the anniversary of filing date of European patent; A86(1) – first fee due in respect of 3rd year).
 - However, the last day for valid payment is Monday, 1/3/10 since EPO cannot require mail on the due date, Sunday 28/2/10 (J4/91; GL A-XI 5.2.4).

- b) - The first renewal fees are due as follows (Nat Law Table VI)
 - DK Last day of February 2011, 28/2/11.
Must be paid by this date to avoid surcharge.
 - FR Last day of February 2011, 28/2/11
Must be paid by this date to avoid surcharge, but if the amount paid is insufficient, the deficit can be made good without incurring a surcharge up to 6 months from the due date, i.e. up to last day of August 2011, 31 August 2011.
 - IT Last day of February 2011, 28/2/11.
Must be paid by this date to avoid surcharge.

- c) - DK requires translation of claims into Danish
(no other requirements because patent is in English)
 - FR no translation necessary.
 - IT translation of the whole specification into Italian, with

proprietor or his representative giving a declaration on the last page of the translation that the translation is in complete agreement with the original.

(Nat Law Table IV)

(NB DK and FRs' requirements are a consequence of their membership of the London Agreement – OJ 2001 550; OJ 2008 123.)

8.

- a) - Claims fees are required in respect of the 16th and each subsequent claim, R45(1) EPC.
 - Thus, 10 claims fees are payable as there are 25 claims.
 - The total fee is $10 \times \text{€}200 = \text{€}2000$ (Supplement to OJ EPO 2/2009, 12).
 - The fees are payable within 1 month of the filing date, R45(2) EPC and GL A-III 9.
 - However, if not paid the EPO will send an invitation to pay the fee in a period of 1 further month, R45(2) EPC.
 - In practice, the EPO will not be able to send this invitation until they have received the certified copy of the previous application under R40(3) (GL A-III 9).
 - No unnecessary payments are incurred by paying in response to the R45(2) invitation.

- b) - No action needs to be taken.
 - If no fees are paid in response to the R45(2) invitation, the EPO will deem claims 16-25 to be abandoned, R45(3) EPC.
 - It is not, anyway, possible to amend the claims at this stage, R137(1) EPC.

- c) - Re-introduction of the claims should be possible provided they have basis in the description, i.e. provided their addition would not contravene A123(2) EPC (J15/88).
 - Thus, the deemed abandonment will only have a substantive effect and prevent reintroduction of the claims if the relevant subject-matter was only present in the original, deemed abandoned claims (J15/88, GL A-III 9).
 - If the claims can validly be introduced later on, then claims fees for each claim above the 15th would become payable under R71(6) when responding to a notification under R71(3) proposing a text for grant.
 - Thus, if no fees were paid on filing or in response to a R45(2) invitation, and then claims 16-25 were later reintroduced such that the allowable claim set has 25 claims, then ten claims fees will become payable (=€2000).

9.

- The Communication from the Opposition Division will be deemed notified on the tenth day following its posting, R126(2) EPC, i.e. on 5/1/09 + 10 days = Friday 15/1/09.

- The 4 month period for response thus expires on
 $15/1/09 + 4m = 15/5/09$ (Saturday),
extended to 17/5/09 (Monday) under R134(1) EPC.
- The period had not therefore expired when T provided evidence of having initiated entitlement proceedings, or when the proceedings were stayed as from 8/5/09.
- The staying is in accordance with R78(1) EPC, which provides that R14(2)-(4) EPC apply *mutatis mutandis*.
- Under R14(4) EPC the time not elapsed on a stayed period runs from the date on which proceedings are resumed, but the time to run must be not less than 2 months.
- In accordance with the calculation procedure set out in GL D-VII 5.3, there were clearly less than 2 months left to run when the proceedings were stayed (in fact, significantly less than 1 month was left).
- Therefore, the period will be two months after the date of resumption on 4/1/10, i.e.

$4/1/10 + 2m = \underline{4/3/10}$ (R131(4) EPC).

EXAMINATION COMMITTEE III

Candidate No.

Paper D 2010 - Marking Sheet

		Maximum possible	Marks awarded	
			Marker	Marker
Part I	Question 1	4	3,5	3
	Question 2	5	5	5
	Question 3	5	5	5
	Question 4	4	3,5	4
	Question 5	4	4	4
	Question 6	5	4	3,5
	Question 7	4	3,5	3,5
	Question 8	5	5	4,5
	Question 9	4	4	4
Part II	Question 1	14	14	13
	Question 2	23	23	23
	Question 3	19	18,5	18
	Question 4	4	3,5	3
Total Part I + II		100	96,5	93,5

Examination Committee III agrees on 95 marks and recommends the following grade to the Examination Board:

 PASS
(50-100)

 COMPENSABLE FAIL
(45-49)

 FAIL
(0-44)

30 June 2010

 Chairman of Examination Committee III