

## Candidate's answer

### Question 1

The period for filing an opposition has expired 9 months after the mention of the grant was published: [A99(1)]

28.04.2010 + 9 months = 28.01.2011 Friday [R 131(4)]

Hence, it is no longer possible to file a notice of opposition. Re-establishment of rights is not available for an opponent [A122(1)].

At this point, the proprietor has not instituted infringement proceedings against Company A. A105(1)(a) does not apply.

Company A could institute proceedings to obtain a declaration of non-infringement against company B, according to national law, in a national court. If this is done, Company can intervene in the pending opposition proceedings [A105(1)(b)], within 3 months of instituting the action [R89(1)]. An opposition fee must be paid within the same time limit [R89(2)].

A cheaper option is to file third-party observations to bring the novelty destroying prior art to the attention of the EPO, but in that case Company A will not be a party to the proceedings [A115].

### Question 2

a)

Invitation to indicate independent claim to be searched states a period of 2 months [R62a(1), R43(2)]. The trigger is the notification of the invitation: 09.04.2010 + 10 days = 19.04.2010 [R126(2)] 19.04.2010 + 2 months = 19.06.2010 Sat. [R131(4)] extension to next working day = 21.06.2010 Mon. [R134(1)]

Further processing is not available [R135(2)]. Re-establishment of rights is possible if all due care can be proven until 2 months after the removal of the source of non-compliance, and max 1 year after missed time limit [A122, R136]. 21.06.2010 + 1 year = 21.06.2011 [R131(3)].

The invitation to correct deficiencies in the application states a period of 6 months after the mention of the publication of the European search report [R70a(1) + R70(1)].

25.08.2010 + 6 months = 25.02.2011 Fri [R131(4)]. Since the applicant didn't reply in time, the application is deemed withdrawn [R70a(3)].

Further processing is available [A121, R135], until 25.02.2011 + 2 months = 25.04.2011 (Easter Mon.) [R131(4)] extension to next working day = 26.04.2011 Tue [R134(1)].

b)

Due to the lack of reply to the 1<sup>st</sup> invitation, only claim 1 has been searched [R62a(1), last sentence]. Although the applicant has the right to amend the application once of his own volition [A123(1) last sentence], such an amendment of the claims may not relate to unsearched subject matter [R137(5)].

Solution:

- request further processing to make sure that EP1 is properly pending
- file a divisional application claiming original claim 3 (A76, R36).

### Question 3

The latest version of form PCT/R0/101 contains a standard phrase to the effect that the content of the priority application(s) is incorporated by reference.

Hence, the international application could be completed by incorporating the claims from the Belgian application within two months from the communication from the rO.

15.12.2010 + 2 months = 15.02.2011 Tue (R.20.7 PCT + R.80.2 PCT)

This time limit was missed. However, as long as the rO has not made a declaration to this effect (“no further communication was sent by the EPO”), the incorporation can still be performed and will be deemed to have been performed in time. Thus, the filing date can be saved by immediately sending a confirmation of incorporation by reference of the claims:

- |           |   |   |
|-----------|---|---|
| R20.6 PCT | { | <ul style="list-style-type: none"> <li>- a sheet embodying the claims</li> <li>- a copy of the earlier application</li> <li>- no translation necessary</li> <li>- indication where the claims are found in earlier application</li> </ul> |
|-----------|---|---|

### Question 4

a)

Request for limitation is not deemed to have been filed until the limitation fee has been filed [A105a(1)]. The fee is set at €1050 [R Fees 2(1)10a].

The proprietor is Spanish, Spain has the non-EPO language Spanish as an official language. Thus, the proprietor benefits of A14(4) (national of a contracting state with non-EPO language as official language, residing abroad).

Although the request for time limitation is not bound to a time limit, a fee reduction under R6(3) is nevertheless available for A14(4) compliant proprietors [R6(3) is a lex specialis].

Hence, the request is filed in Spanish, the fee is reduced by 20% [R Fees14(1)]:  
€1050 - €210 = €840. A translation into an EPO language must be filed within one month [A14(4) by analogy + R6(2)].

Elements to be filed in Spanish: particulars of proprietor, list of effective contracting states, particulars of proprietor(s) for other contracting states (if any), particulars of representative (if any) [R92(2) a, b, c, e].

b)

Although A115 does not exclude limitation proceedings, it is not beneficial to file third-party observations in proceedings in which substantive patentability issues cannot be examined [A105b(1), R95(2)].

However, it is not too late to file a notice of opposition:

trigger = publication of mention of the grant:

02.06.2010 + 9 months = 02.03.2011 Wed [A99(1), R131(4)]

The notice of opposition must be filed today or tomorrow. The pending limitation proceedings will be terminated and the limitation fee will be reimbursed [R93(2)].

#### Question 5

To benefit from priority from IS1, the European patent application would have had to be filed within 12 months, i.e. in October 2010 [A87(1)].

Even if all due care could be proven, re-establishment of rights would have been available only for 2 months from the expiry of the priority period, i.e. until December 2010 [A122, R136(1)]. Thus, the priority right is irrevocably lost.

IS1 was never published, so it does not constitute prior art [A54(2)].

The disclosure at the symposium today is part of the state of the art for any European patent application filed after today's date [A54(2)].

Hence, it is still possible to obtain protection for subject matter Y by filing a European patent application today. Without further instructions from the client, the application must be filed by reference to IS1 [R40(1)(c)].

It shall mention the application number of IS1 [R40(2)].

The application must also mention the filing date of IS1; the question does not indicate if that information is available. If the filing date is not available, the EPO will send a communication under R55 to supply the missing information, but redating of the application will then become unavoidable.

## Question 6

The period for entering European phase expires 31 months from the priority date [R159(1)]:

03.07.2008 + 31 months = 03.02.2011 Thu [R131(4)]

This deadline was missed, so the application is deemed withdrawn [R160(1)]. Further processing is available [A121, R135] for two months after the notification of the deemed withdrawal (not yet received).

Thus, the applicant should now appoint a (professional) representative (A133(2); the US is not a EPO contracting state) and perform for the following acts:

R159(1)a -> no translation necessary, EN is ok.

R159(1)b -> specify application docs = identical to international application

R159(1)c -> pay filing fee [R Fees2(1)1]

Online: €105 + €52,50 further processing

Not online: €190 + €95 further processing [R Fees2(1)12]

R159(1)d -> pay designation fee [R39 period expired in July 2010]  
€ 525 + €262,50 further processing [R Fees2(1)3 +12]

R159(1)e -> pay search fee

€ 1105 (R Fees2(1)2) - €190 (Council dec. 27.10.2005 OJ '05/548)

The search fee amounts to €1105 - €190 = €915 because an international search was carried out by the USTPO.

+ Further processing: €457,50 [R Fees2(1)12].

R159(1)f -> file request for examination [R39 period expired]

€1645 + €822,50 further processing [R Fees2(1)6+12]

R159(1)g -> pay renewal fee for 3<sup>rd</sup> year if due [R51(1)]

Filing date = 02.07.2009 [A 153(2)]

3<sup>rd</sup> year fee due: 31.07.2011 [R51(1)]

⇒ Must not yet be paid

R159(1)h -> not applicable

Number of claims > 15 => claims fee 2 x €210 = €420. [R162(1) + R Fees2(1)15]

These fees may be paid after an invitation under R162(2). (1 month period)

## Question 7

The opponent-respondent raises an objection under art. 100(c) and 123(2) for the first time in appeal. This constitutes a new ground.

A new ground may not be raised in opposition-appeal proceedings, unless the proprietor agrees to it (G10/91). Hence, if the proprietor refuses to allow this new ground, only the issue of novelty will be addressed, to the extent that the original claims are examined.

However, as soon as the proprietor amends the claims under R.80, the amended claims will be fully examined w.r.t. compliance with the EPC, including A123(2). (T263/05)  
Thus, the request of the proprietor including amended claims B for AT and BE will not be allowed for failure to comply with A123(2).

### Question 8

The EPO will normally publish the application 18 months after the earliest priority date as claimed: [A93] approximately: 22.10.2009 + 18 months = 22.04.2011 Wed  
The period for correcting the declaration of priority expires 16 months after the earliest priority (claimed or correct):

22.10.2009 + 16 months = 22.02.2011 Tue [R52(3), R131(4)].

Alternatively, filing date + 4 months [R52(3), last sentence] yields the same time limit in this case.

Further processing is excluded [R135(2)].

Re-establishment of rights is available if all due care can be proven [A122, R136]. If not, the priority from FR1 will be lost.

The invitation to supply missing drawings shall specify a period of two months [R56(1)].

Trigger = notification:       04.01.2011 + 10 days = 14.01.2011 [R126(2)]  
                                      14.01.2011 + 2 months = 14.03.2011 Mon [R131(4)]  
                                      => Submit missing drawing by 14.03.2011

The application will normally be redated to the date of receipt of the missing drawing [R56(2)].

Redating can be avoided by:

- Not filing the missing drawing [R56(4)a]
- Withdrawing the filed missing drawing [R56(4)b + 56(6)]
- Identify the missing drawing in the priority document [R56(3)], provided that the priority claims was corrected.

Consider using R139 for correcting the priority claim. Such a correction is not bound to the time limits of R52(3) and can still be requested in time for an inclusion of the correct application number in the published application. -> J3/91.

The true intent of the application must be shown, but no proof of "all due care" is required.

This way, the effective date of the European patent application is kept before the date of the prejudicial disclosure in the article of 12 March 2010.

**EXAMINATION COMMITTEE III**

Candidate No.

Paper D 2011 - Marking Sheet

		Maximum possible	Marks awarded	
			Marker 021	Marker 054
<b>Part I</b>	Question 1	4	3,5	4
	Question 2	6	5	5,5
	Question 3	5	4,5	4
	Question 4	5	5	5
	Question 5	3	2,5	2,5
	Question 6	6	5,5	6
	Question 7	4	2,5	3
	Question 8	7	3,5	4
<b>Part II</b>	Question 1	35	28	27,5
	Question 2	11	8,5	7,5
	Question 3	10	9	10
	Question 4	4	2,5	2,5
<b>Total Part I + II</b>		<b>100</b>	<b>80</b>	<b>81,5</b>

Examination Committee III agrees on 81 marks and recommends the following grade to the Examination Board:

**PASS**  
(50-100)

**COMPENSABLE FAIL**  
(45-49)

**FAIL**  
(0-44)

29 June 2011

*M Winter*

M Winter - Chairman of Examination Committee III