

## Examiners' Report Paper D 2012 - Part I

As a positive trend it was noticed that more candidates cited the relevant legal basis with the necessary accuracy, which in the past has been a problem, especially for PCT-questions.

Candidates are reminded to accept the facts given in the paper and to limit themselves to these facts. See, for example, comments to question 6, last paragraph.

### Question 1

The majority of candidates recognized that the relevant date for calculating the period of appeal was 27 December 2011. However, not all of these candidates cited a T-decision relevant for the fact that a correction of the decision according to Rule 140 EPC has a retrospective effect.

Some candidates did not realize that the concept of extension of periods according to Rule 134(1) EPC is not applicable to the date on which the decision was deemed delivered in accordance with Rule 126(2) EPC.

Other candidates thought that the reference to Article 56 EPC rather than Article 54 EPC implied a procedural violation and did not comment at all on the correction under Rule 140 EPC.

Few candidates recognized that reimbursement of the appeal fee is possible if the appeal is withdrawn in due time.

### Question 2

Some candidates did not realize when amended Rule 36 EPC entered into force and therefore did not differentiate between the requirements for DIV1 and DIV2. Few candidates were aware of the relevant transitional provisions, which apply to DIV2.

Although only the filing requirements were asked for under item a), some candidates lost time by listing other requirements, like payment of various fees.

A large number of candidates did not understand that the notification of the partial search report does not start the time limit for mandatory division according to Rule 36(1)(b) EPC.

### Question 3

Most candidates correctly referred to the supplementary **international** search and the corresponding provisions of the PCT.

However, some candidates suggested entering into the regional phase before the EPO to have the second invention searched in the supplementary **European** search. Since the question states that your client wants a search to be carried out by the EPO **before** deciding on entry into the national/regional phase, such answers were not awarded any marks.

Not all candidates stated to which office the request should be submitted and by which fees have to be paid.

Very few candidates identified the Agreement under Article 16(3) PCT between the EPO and the WIPO as legal basis.

#### **Question 4**

The question was generally answered well.

With reference to Art. 150(2) EPC it must be taken into account that the priority claim is made under the PCT. However, the notion of "same invention" is to be interpreted in accordance with the case law for Article 87(1) EPC (see Art. 27(5) PCT). Nevertheless, candidates who answered the question by referring only to either Article 87 EPC or Art. 8 PCT in conjunction with Art. 4 Paris Convention were still awarded the marks.

Some candidates wrongly assumed that the later filing of the claims would result in a re-dating of EP-X according to Rule 56(2) EPC. This rule is only applicable if parts of the description or drawings are missing.

#### **Question 5**

Most candidates referred to English and Chinese as languages of publication. For full marks all relevant elements of the contents of the publication had to be identified in detail.

#### **Question 6**

Although the majority of candidates drew the correct conclusion, that it is too late to add a priority claim, a considerable number of candidates overlooked the possibility of requesting a correction under Rule 139 EPC.

Some candidates allocated a single priority date to the whole application instead of distinguishing between the priorities for Inv1 and for Inv2.

Even though the question did not give any facts supporting a request for re-establishment of rights in accordance with Article 122 EPC, some candidates lost time by speculating about this issue.

Some candidates speculated that the priority of Inv2 is valid because it could be derived from Inv1, although there was no basis in the question for such speculation.

#### **Question 7**

Most candidates referred to G1/07 and G1/04. However, not many correctly applied them to the facts of the question.

A number of candidates missed the fact that the application had not yet been filed and suggested to insert a disclaimer into a claim.

### Question 8

The majority of candidates recognized the crucial point that the improved subject-matter was made publicly available through file inspection. Some candidates wrongly concluded from the fact that the improved subject-matter in itself is sufficiently disclosed according to Article 83 EPC, that the amended claims meet the requirements of Article 123(2) EPC.

## Possible solution - Paper D 2012 - Part I

### Answer to question 1

A correction of a mistake in a decision according to Rule 140 EPC has a retrospective effect, T116/90 or T212/88. The correction dated 24 January 2012 does not change the date of the decision dated 27 December 2011.

The decision refusing the application was deemed delivered on 6 January 2012 (27 December 2011 + 10 days, Rule 126(2) EPC). This is the starting date for calculating the time limit to appeal. In accordance with Article 108 EPC, notice of appeal shall be filed within 2 months of notification of the decision. Therefore, the period for filing the notice of appeal and paying the appeal fee expires today, 6 March 2012. It is advisable to file the notice of appeal and to pay the appeal fee today.

Should your client decide not to proceed with the appeal, the appeal fee will be reimbursed in accordance with Rule 103(1)(b) EPC, provided that the appeal is withdrawn before filing the statement of grounds of appeal and before the period for filing that statement has expired.

If your client decides to continue with the appeal, the statement of grounds of appeal has to be filed within 4 months from notification of the decision, Article 108 EPC. Since this period expires on Sunday, 6 May 2012, it is extended to Monday 7 May 2012, Rule 134 (1) EPC.

### Answer to question 2

a) Amended Rule 36(1) EPC entered into force on 1 April 2010.

DIV1 was filed on 14 December 2009, i.e. before amended Rule 36 EPC entered into force. Hence, previous Rule 36(1) EPC applies, requiring only that the earlier application is pending. Moreover, according to Article 76(1) and Rule 36(2) EPC (as in force until 31 March 2010), the divisional has to be filed in the language of the proceedings for EP1 with the EPO in Munich, The Hague or Berlin. Since DIV1 was filed in English with the EPO in Munich, and EP1 was still pending on 14 December 2009, all requirements were met.

DIV2 was filed on 30 September 2010, i.e. after amended Rule 36 EPC entered into force. In accordance with amended Rule 36(1)(a) EPC, the applicant may file a divisional application before the expiry of 24 months from the examining division's first communication in respect of the earliest application (i.e. EP1). This time limit expired before 1 April 2010. According to the transitional provision applicable to amended Rule 36(1) EPC (Article 3 of the Decision of the Administrative Council of 25 March 2009, OJ 2009, 298 or 485) a divisional application of EP1 could still be filed until 1 October 2010. Moreover, according to Article 76(1) and amended Rule 36(2) EPC, the divisional has to be filed in the language of the proceedings for EP1 at the EPO in Munich, The Hague or Berlin. Since DIV2 was filed before 1 October 2010 in English with the EPO in Berlin, and EP1 was still pending on 30 September 2010, all requirements were met.

b) Since both EP1 and DIV2 are withdrawn and hence are no longer pending as required by Rule 36(1) EPC, it is not possible to validly file further divisional applications of EP1 and DIV2.

For DIV1, the 24 month time limit set by amended Rule 36(1)(a) EPC has expired. Therefore, a divisional application cannot be filed unless the examining division issues a communication confirming the, or raising another, lack of unity objection, amended Rule 36(1)(b) EPC.

### Answer to question 3

a) Yes, it is possible. Because the EPO was not ISA, the EPO is competent to carry out a supplementary international search, Article 3(4) of the Agreement between the EPO and WIPO (OJ 2010, 307) and Rule 45*bis*.9(a) and (b) PCT.

b) A supplementary international search may be requested at any time prior to the expiration of 19 months from the priority date, Rule 45*bis*.1(a). This period expires on 5 May 2012, extended under Rule 80.5 PCT to 7 May 2012.

The request for a supplementary international search must be filed directly with the IB, Rule 45*bis*.1(b) PCT and should indicate that the EPO should act as SISA, Rule 45*bis*.1(b)(ii) PCT.

The international application was filed in Spanish. Since Spanish is not a language accepted by the EPO according to the Agreement between the EPO and WIPO, a translation of the international application in DE, FR or EN has to be filed together with the request, Rule 45*bis*.1(c)(i) PCT.

It should be indicated in the request that the second invention should be searched, Rule 45*bis*.1(d) PCT.

The handling fee and the search fee have to be paid to the IB within 1 month from receipt of the request for the supplementary international search Rule 45*bis*.2 and Rule 45*bis*.3 PCT.

### Answer to question 4

a) No, it is not possible.

Product A1 is not disclosed in EP-X as filed. Thus, the claim directed to product A1 in PCT1 is not in respect of the "same invention" as EP-X, Article 87(1) EPC. Therefore a claim directed to A1 is not entitled to the priority date of EP-X, but has as effective date the filing date of PCT1. The document published in March 2010 is comprised in the state of the art within the meaning of Article 54(2) EPC. The claim directed to A1 is not new in view of the disclosure of this document.

b) PCT1 was filed within the priority period, which expired on 20.12.2010, Article 8 PCT and Article 4 Paris Convention. If the draft paper had disclosed A1, then EP-X would have disclosed A1 and the priority claim would be valid. Therefore, the publication of March 2010 would not be comprised in the state of the art within the meaning of Article 54(2) EPC and would not be novelty destroying. Thus patent protection could be obtained for the claim directed to product A1.

**Answer to question 5**

a) The international publication comprises a description, claims and drawings, if any (Rule 48.2(a) ii-iv) PCT), a standardized front page (Rule 48.2 (a) i PCT) including the abstract (Rule 48.2(b) iii) PCT) and title, and the search report.

Since the amendments and statement under Article 19 PCT were filed with the IB within the time limit of Rule 46.1 PCT, these will also be published, Rule 48.2(f), Rule 48.2(a)(vi) PCT.

The description and claims (Rule 48.3(a) PCT), the amendments under Article 19 PCT (Rule 46.3 PCT) and the statement under Article 19 PCT (Rule 46.4 PCT) will be published in Chinese. The abstract, title and search report will be published in English and Chinese (Rule 48.3(c) PCT).

b) According to Rule 86.1 (i) and 86.2(a) PCT a French translation of the abstract is published in the Gazette. This translation is available on the WIPO web site.

**Answer to question 6**

For Inv1, EP1 validly claims priority from IT1, because EP1 was filed within the priority period and in respect of the same invention, Article 87(1) EPC. Therefore, document D is not part of the state of the art and protection can be obtained for Inv1.

EP1 does not claim the priority of IT2 for Inv2. Thus, the effective date for Inv2 in EP1 is 28 October 2011. This is after D was published. Therefore, at present D is comprised in the state of the art in accordance with Article 54(2) EPC, and destroys the novelty of Inv2 in EP1. Hence, only with a valid claim to priority of IT2 protection for Inv2 in EP1 can be obtained.

The insertion of a priority declaration under Rule 52(2) EPC is no longer possible because the 16-month time limit expired on 28 February 2012. Further processing is ruled out, Rule 135(2) EPC.

Filing a request for correction of the priority declaration under Rule 139 EPC, first sentence, is possible. Since EP1 has not been published yet and the preparations for publication have not been terminated yet, such a request has the potential to be granted (J3/91, J6/91 or J9/91).

**Answer to question 7**

According to G1/07 a method including a surgical step is excluded from patentability under Article 53(c) EPC. Thus, any method comprising (a) is excluded from patentability.

Diagnostic methods carried out outside the human body, such as (b), are not excluded under Article 53(c) EPC, G1/04. Since the known method of biopsy (a) is not an essential feature of the method of diagnosing the illness, it can be omitted from a possible claim (Article 84 EPC). Thus (b) taken alone is patentable.

**Answer to question 8**

Since the subject-matter of the amended claims is new and inventive over the originally disclosed subject-matter, it extends beyond the content of the application as filed, contrary to Article 123(2) EPC. Therefore, the amended claims are not allowable. Thus, no protection for the improved subject-matter can be obtained via EP1.

EP1 has been published. Therefore, the files relating to EP1 may be inspected according to Article 128(4) EPC. Since the amendments filed by the applicant in June 2011 are not excluded from file inspection by Rule 144 EPC, these were made available to the public as of June 2011, i.e. before the date of filing of EP2. These amendments are therefore comprised in the state of the art according to Art. 54(2) EPC and are novelty destroying for the improved subject-matter claimed in EP2. Thus, no protection for the improved subject-matter can be obtained via EP2.

**EXAMINATION COMMITTEE III**

Candidate No. \_\_\_\_\_

Paper D 2012 - Marking Sheet

Category		Maximum possible	Marks awarded	
Part I	Question 1	5		
	Question 2	6		
	Question 3	5		
	Question 4	4		
	Question 5	5		
	Question 6	6		
	Question 7	4		
	Question 8	5		
Part II	Question 1	20		
	Question 2	9		
	Question 3	12		
	Question 4	19		
<b>Total</b>		100		

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

PASS  
(50-100)

COMPENSABLE FAIL  
(45-49)

FAIL  
(0-44)

28 June 2012

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Chairman of Examination Committee III