

Part I

1. Examination fee, under Art. 94(2) is due 6 months from the publication of the Search Report.

The A1 publication is the publication of the application which includes the Search Report, and thus the examination request must be filed within 6 months of this A1 publication.

The request for examination under Art. 94(2) comprises a written request and the payment of the fee and the request is not duly filed until both the written request is received and the fee paid. Interruption of procedures is determined by R. 90.

Under R. 90(1)(a) proceedings may be interrupted because of death of the applicant.

Under R. 90(4), time limits are also interrupted. R. 90(4) states that the time limit for the request for examination is interrupted, and will resume once proceedings are started. EPO decision J 7/83 confirms that, for examination requests, the time limit resumes once proceedings are resumed and does not "begin again" as stated in R. 90(4). However, there is a caveat which states that if there are less than two months left of a time limit upon interruption, a 2 month time limit is given upon resumption.

In this case, applicant had one month of the term left and thus qualifies for the 2 month term above mentioned.

The new applicant can therefore pay the fee within 2 months of resumption of proceedings.

2. a) EP-1 has the first disclosure of the first further embodiment and can therefore serve as a priority document for this first further embodiment under Art. 87(1) for EP-2.

DE was the first disclosure of the invention and therefore can be a priority document. DE satisfies the requirements of Art. 87(2)

EP-2 may claim multiple priorities under Art. 88(2).

EP-2 is filed within 12 months of DE and is therefore within the Convention period {Art. 87(1)}.

- b) No - EP-1 is not the first application containing the whole disclosure. Priority would be valid for the first further embodiment, but would not be for the remainder of the disclosure of EP-1.

Because EP-1 is the second disclosure of this information, it cannot serve as a priority document alone.

- c) If EP-1 was filed claiming priority from DE and then DE was abandoned, the fact that DE was the first disclosure of the information and not EP-1 does not change and the situation as under (b) above would still exist.

For EP-1 to be the first disclosure of the whole invention if, and only if, DE had been abandoned at the time of filing of EP-1 and had not served as a basis of priority {Art. 87(4)}.

If DE had been abandoned before EP-1 was filed, EP-2 could validly claim priority from EP-1.

The second further embodiment in EP-2 would not be entitled to any claim of priority as it was disclosed for the first time in EP-2.

- 3.1 Amendment of the application may be made after receipt of the Search Report under R. 86(1).

Amendments may be made of applicants own volition after receipt of the Search Report and before receipt of the first Examination Report under R. 86(2).

- a) Amendments may be made to introduce a reference to prior art. There is a Board of Appeal decision which confirms this. However, this should relate to background art and not to an essential element of the invention.

A direct quote should be allowable if it is not used in a defamatory manner.

- b) Statements regarding advantages of the invention can only be introduced if the skilled man could have derived the information already from the application as filed. These should not add advantages not already embraced by the application as a whole.
- c) Although these may be considered as forming part of the discussion of prior art, and therefore allowable amendments, it may be that the newly discovered disadvantages put the invention in a new and advantageous light, which was not clear at the time of filing the application.

Although such amendments might not be considered added subject matter under Art. 123(2), wherein the test for added subject matter may be taken to be whether novelty is introduced by the addition, it seems likely that such amendments might affect the manner in which the specification is read. Care should be taken and, on balance, I would say that the addition is not allowable.

- 3.2 No - the communication under R.51(4) should include the text on which the Examiner intends to grant the patent. The applicant must approve the text and may suggest minor amendments. Normally amendments of substance are not allowed. [Guidelines support this].

However, if the prior art is of extreme relevance, it should be notified to the EPO, and they should consider re-opening examination. If this newly found patent application is of such relevance, then, during re-examination a reference to it could be introduced. If it is not of such relevance to re-open proceedings a mention of it in the application can not be essential.

[Guidelines indicate the procedure re. such situations].

4. a) No - programs for computers are specifically excluded under Art. 52(2)(c). To qualify for patentability as, for example, a computer operated by the program, there must be some technical progress. Translation of one language to another - i.e. the result of the program, or the effect of the program, can not be considered a technical effect, and would itself be excluded as a "method for performing mental acts" under Art. 52(2)(c). There is much Board of Appeal case law on computer and mental acts.
- b) Methods of treatment of human are excluded from patentability under Art. 52(4).

However, a method of treatment is a method of surgery or therapy, including curative or prophylactic therapy.

A sun-tanning pill might be considered a cosmetic treatment and may well have patentability because of its sole cosmetic indication. European case law has indicated that cosmetic treatments are patentable.

I would recommend claiming the tablet per se if new, or the use of the tablet in cosmetic treatment, rather than a method of treatment claim format.

- c) It should be considered whether such a compound would be excluded under Art. 53(0), i.e. as being contrary to ordre public and morality. Clearly, use of the compound would not be legal in that the police breath test would be ineffective. However, if some alternative use for the compound could be found it may then be patentable. [The Guidelines give some examples here e.g. the letter bomb which is clearly not patentable - but a safe-breaking mechanism which may have alternative, i.e. non-burglary related uses may be patentable].

If the only use of the compound is an illegal use, then the compound should not be patentable under Art. 53(a). If there is some alternate use, as well as the illegal use, patentability cannot be denied - if all other patentability requirements are fulfilled.

5. The error: applicant considers that this is an error of the EPO. However, care should be taken on this front. There was clearly an error in that the applicant's reference was incorrectly stated - and this error was made at the EPO. However, the EPO assigned application number was correct - and presumably also the title of the invention, if given. Although there is no case law on this point, reference could be made to case law on opposition proceedings - for example an opposition is deemed allowable if sufficient information is given to identify the application in question, even if the requirements of the EPC are not fully met. In the present situation one could say that sufficient information was given by the EPO to identify the application - in the application number.

There is therefore little possibility of blaming the error on the EPO so that recovery of the application could be made that way. There is also no provision e.g. under R. 89 or R. 82, in the EPC for correction of errors in EPO communications.

The applicant cannot apply Art. 121 further processing, because the 2 month time limit set by Art. 121(2) has passed. He also cannot apply for a decision under R. 69(2), because the 2 month time limit for this runs concurrently with that for further processing and has thus expired. The only option available is Art. 122 restitutio.

Requirements are:

- (i) missing of the time limit resulted in loss of rights;
- (ii) omitted act and request for restitutio must be filed within 2 months of removal of the cause of non-compliance with the time limit (Art. 122(2));
- (iii) payment of fee;
- (iv) proof that all due care required by the circumstances was taken.

Applicant should therefore file his request immediately and within 2 months of the refund of the renewal fee.

Chances of success? Because he files many applications it might be that the mix-up was an isolated mistake of procedure in a normally satisfactory system. European case law confirms that in such situations restitutio may be allowed.

6. French is the language of the proceedings of the patent application - this is the language in which the application was filed - Art. 14(3).

Opposition may be filed in any EPO official language, under R. 1(1). English is therefore alright as the language of the opposition.

Documents to be used as evidence may be filed in any language under R. 1(3). The US firm may therefore file such documents in English.

Under R. 2(4) - any language may be used at oral proceedings if the parties and the EPO agree. However, R. 2(1) states that

if a party at oral proceedings wants to use an EPO language different to that of the proceedings, he must notify the EPO one month in advance of the hearing or provide translation.

It is therefore possible for the French representative to speak in French and the British representative to speak in English.

7. Publication under Art. 93(1) takes place at 18 months from priority at the earliest. The earliest date of publication here would therefore be 8 July 1992.

- a) To avoid publication the application should be unconditionally withdrawn by sending of a letter to the EPO at The Hague (i.e. directly to the formalities/receiving section) with clear indication on the envelope that action is required urgently.
- b) This withdrawal letter should be sent immediately to be sure that publication will not occur, and in any event before 10 weeks before the due publication date (i.e. before preparations for publication have started). The Guidelines suggest the ten week period.

The letter should therefore be sent before 29 April 1992.

8. Demand for international preliminary examination should be filed within 19 months of the priority date under Art. 39(1)(a) PCT.

P. date = 31.08.90
demand due date = 31.03.92

[Computation time limits - R. 80.2 PCT]

Demand arrived at EPO on 01.04.92 - i.e. after expiry of the 19 month period.

Applicant cannot make use of R. 82 PCT excusing delays in the main service - because the demand was not sent by mail.

The EPO is not entitled to excuse the delay in meeting the time limit under R. 82bis PCT because there is no equivalent time limit under the EPC.

The demand is therefore deemed not to have been received on time.

To save the application the applicant will have to enter the regional phase under Art. 22 PCT, within the 20 month time limit (21 months at EPC, R. 104b(1)).

9. Correction of the request would be made under the EPC and not PCT because the application is in the regional phase.

R. 88 EPC allows correction of any document filed at the EPO and case law has shown that this includes the request for

grant. Case law has also shown that mistakes in the priority claim may be corrected.

However, further case law has indicated that corrections under R. 88 should be made before publication of the application so that the public can be warned of the mistake and the correction - or at least not misled.

Here international publication has already taken place.

There is an EPO decision which states that correction of designations under R. 88 of a PCT in the regional phase after international publication is not permitted.

However, in the present situation, the mistake only came to light after such publication and would not have affected such publication date if corrected earlier. Also the public would not be damaged should such a correction be allowed as the priority date claimed was correct.

On balance it is likely that the EPO would allow the correction to be made.

10. The opponent can request oral proceedings under Art. 116(1).

The EPO should agree to this request and if they do agree, the patent cannot be revoked prior to the oral proceedings.

If, however, the opposition division have considered all observations submitted and do not consider that oral proceedings will help the situation at all, they may decide against oral proceedings. They are then entitled to revoke the patent under Art. 102(1).

11. a) Yes - Guidelines specify that priority may be withdrawn at any time - and also the effects of such withdrawal on time limits existing and expired.
- b) The priority of a PCT application may be withdrawn at any time up to international publication, under R. 32bis 1(a) PCT.
- The priority may then only be withdrawn once the regional or national phase has started and before the regional or national offices.
- c) No - Guidelines and EPO decisions both indicate that once a time limit has expired, it cannot be restored by withdrawal of a priority claim.
- d) In the case of an EPA, the technical preparations for publication will have been completed 20 days before the 18 month period. The Guidelines indicate that withdrawal must be made at least 10 weeks before termination of preparations for publication.

Although the EPO will do their best to comply with the applicant's wishes and terminate publication if at all

possible, it is unlikely that this can be prevented in this situation.

In case of a PCT, preparations for publication are terminated 15 days before publication. Any withdrawal made before said 15 days should be complied with.
R. 32bis 1(c) PCT.