

Part I

Quⁿ.1

No.

When the PCT application was filed, MC was a member of the PCT but not of the EPC. Therefore, MC could not be designated via a request for a European patent (PCT Art. 45(1) - can designate via a regional patent only a state "party to both the regional patent treaty" & the PCT). This has been confirmed by EPO Legal Board of Appeal case law relating to designations of Denmark in PCT applications.

Since there was no valid EP (MC) designation in the PCT applⁿ as filed, the EPO cannot act as a designated office (Art. 153(1) EPC refers to EPC contracting states being designated; case law (see above) makes clear that the states designated must be in the EPC at the PCT filing date). Thus, on nationalization, the EPO cannot act as a designated office for MC - applicant must nationalize directly in MC.

Quⁿ.2

Yes.

The EP application can be filed in Italian (EPC Art. 14(2)) because the applicant is Italian. This allows him (EPC Rule 6(3)) a 20% (Art. 12(1) Rules re Fees) reduction in the filing fee payable.

He must then file a translation of the application into English, French or German within 1 month of the filing date, but no later than 13 months from priority (i.e. 4 June 1993) (Art. 14(2) and Rule 6(1) EPC). If the EP applⁿ is the same as the Italian one, then the English translation already supplied could be used. English then becomes the language of subsequent proceedings before the EPO (EPC Art. 14(3)). The translation into English, French or German must be filed no earlier than the Italian version to obtain the fee reduction (Enlarged Board of Appeal case law).

Applicant could use his certified copy of the Italian application as the European application, if the texts are to be the same for the priority and the EP application. The EPO will then accept this as a certified copy of the priority application for EPC Rule 38(3) and Art. 88(1), and will accept a declaration from the applicant that the English translation supplied for the EP applⁿ is a direct translation of the priority applⁿ (Guidelines).

The EP applⁿ must be filed within 12 months of the Italian filing date (EPC Art. 87(1)) i.e. by 4 May 1993, if priority is to be validly paid.

The exam fee will also be reduced by 20% (EPC Rule 6(3) and Art. 12(1) Rules re Fees) if the exam request is included in the EP applⁿ in Italian as well as in an official EPO language. Again (EBA case law) the Italian exam request must be filed no later than simultaneously with the EPO language exam request.

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There is no fee for filing the certified copy of, or translation of, the Italian priority applⁿ.

Quⁿ. 3

Written communications with the EPO can be in any official EPO language (EPC Rule 1(1)) but amendments to an application must be filed in the language of the proceedings (Rule 1(2)). Failure to file in the correct language means a document is deemed not received (Art. 14(5)).

But, the applicant here is Greek and so can make use of EPC Art. 14(4) - he can file documents, in order to meet time limits, in Greek. He must then file a translation into any EPO official language (Art. 14(4) and Rule 1(1)) within 1 month of filing the document (Rule 6(2)). Amendments must still be in the language of the proceedings when translated (Rule 1(1)).

The nationality of the representative doesn't affect the Greek applicant's rights under Art. 14(4) (EPO Guidelines & Legal Bd of Appeal case law).

Thus, to meet the time limit:

- (a) only arguments - file immediately in Greek; file German translation within 1 month of filing the Greek.
- (b) arguments & amendments - also file immediately in Greek; file German translation of arguments within 1 month of filing the Greek; file translation of amendments into language of proceedings within same time period.

Because this is the last day of the reply period, file by fax (or telex, or telegram) at the EPO (EPO President's decision). Confirmation of the fax will be required of any amendments to the applⁿ - EPO will invite the filing of such confirmation (still in Greek) within 1 month of its invitation. Any translations necessary are separate from the fax confirmation.

Quⁿ. 4

- a) 3 claims fees are payable, for the set having the greatest number of claims (EPO Legal Advice 3/85).

The deadline is 1 month from filing the application (EPC Rule 31(1)). Fees can still be paid within 1 month of an EPO notification about failure to pay (Rule 31(1)).

- b) Claims fees have only been paid for the GR, PT, ES set. However, the other set now has the greatest n° of claims & so a full set of excess claims fees must be paid for it (Legal Advice 3/85). The set now has 20 claims, and so 10 excess claims fees must be paid (EPC Rule 51(7)).

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The deadline is 3 months from an EPO invitation to pay grant, printing & claims fees (EPC Rule 51(6) & EPO practice to set the 3 months). This period is non-extendable (Rule 51(6)).

- c) Missing deadline in a) means the claims for which fees have not been paid are deemed abandoned (EPC Rule 31(2)). e.g. if no claims fees are paid, Claims 11 & 12 in the 1st set and Claims 11-13 in the 2nd set are deemed abandoned.

In b), the consequence of not paying any one of the claims fees on time is that the applⁿ is deemed withdrawn (EPC Rule 51(8)).

Ouⁿ. 5

- a) Legal basis - PCT Art. 17(2)(a) with PCT Rule 39-1(iv). No provision in the PCT for appeal against an ISA decision on this point.
- b) Yes. The ISA simply issues a declaration that it will not search the relevant claims, but there is no provision in the PCT for deemed abandonment of such claims - they remain in the application through to entry into the national phase.

It is up to each designated/elected office, under its own national laws, to decide on substantive patentability of any claim (PCT Art. 27(5)) & whether or not an additional search is required or indeed whether claims can be deemed abandoned because they have not been searched. This all occurs after entry into the national phase, & does not affect the PCT applⁿ prior to, or on, entry into the national phase.

Ouⁿ. 6

- a) The EPO should be informed of the new appointment, in a letter/statement signed by the applicant or by the new representative. In the latter case, the EPO will invite the rep. to file an authorization, signed by the applicant, within 1 month from notification of the invitation (EPO President's decision). ('cos he's in a different firm to the 1st rep.) No authorization is needed if the EPO has already been informed of the termination of the previous appointment of the 1st rep. (President's decision). EPC Rule 101(1) is also relevant, referring to the need for authorizations when the EPO President decides so, & Rule 101(6), saying a previous rep. is still regarded as the rep. until termination of his authorization has been notified to the EPO.

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- b) Yes, he can be made an additional representative. The same procedures apply as under (a), i.e. an authorization would be needed, or a statement of his appointment signed by the applicant. He would not necessarily receive all EPO communications - under Rule 81(2) EPC the EPO will only notify 1 of several reps, & EPO practice is to notify the 1st appointed. Applicant would have to notify the EPO (via an authorized rep.) that a particular rep. is to be used as the address for service.

Note that the US applⁿ cannot take any procedural steps himself, only through an authorized rep. (EPC Art. 133(2)). But he can appoint a representative himself, since the EPO does not regard such a step as a "proceeding established by the Convention" for which a rep. is needed under Art. 133(2). (Guidelines) The applicant can also file the authorization if needed. All other steps must be taken by an authorized rep.; it is safer if the rep. takes all steps, in case there are irregularities to sort out & correspondence necessary with the EPO.

Quⁿ 7

To claim both priorities, the EP application should strictly be filed within 12 months from the earliest priority filing (EPC Art. 87(1)) i.e. here, by 30-4-92. However, 30-4-92 and 1-5-92 are national holidays for at least one of the EPO filing offices; 2-5-92 & 3-5-92 are weekends when the EPO filing offices are also closed. Thus (EPC Rule 85(1)) the priority 12-month period is extended to the 1st normal day after the "excluded" days, i.e. until 4-5-92. The EP applⁿ can still be filed on 4 May, validly claiming priority from both US applⁿs.

To meet the deadline, the application can be filed by fax; confirmation is needed within 1 month of notification of the EPO's invitation (EPO President's decision under Rule 24(1) EPC).

If the deadline is met, and priority validly claimed, the contents of the published article cannot invalidate the EP applⁿ either for lack of novelty or for obviousness (Paris Convention Art. 4B) under the EPC, to the extent that the subject matter of the article is specifically disclosed in the documents making up the priority applications, so that the matter is entitled to priority even in the EP application (EPC Art. 88(4)).

Be sure to make a declaration of priority (stating at least the filing dates & country of the 2 priority applications) in the EP applⁿ as filed (EPC Rule 38(1) & (2)).

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Quⁿ. 8

- a) To extend the international phase, the demand must be filed, and the relevant states selected, by the end of 19 months from the (earliest) priority date (PCT Art. 39(1) & Art. 2 (xi)).

The demand has to be filed with the competent international preliminary examining authority (IPEA), i.e. in this case, since applⁿ filed at EPO, with the EPO itself (PCT Art. 31(6)(a)).

- b) Such "later elections" can be made at any time after the demand is filed. (PCT Art. 31(4)(a)). Only states designated in the original PCT applⁿ can be elected (PCT Art. 31(4)(a)) & only those party to PCT Chapter II (Art. 31(4)(b)). The later election should be filed with the International Bureau (PCT Art. 31(6)(b), though it can also be filed with the IPEA (PCT Rule 56-1(f)). It does not extend the international phase for the elected state concerned unless filed within 19 months from the priority date (PCT Art. 39(1)).
- c) See (b) above - International Bureau preferably, but if submitted to the competent IPEA, IPEA marks date of receipt on the notice effecting the later election & forwards it to the I.B. The deemed date of receipt by the I.B. is the actual date of receipt at the IPEA.

(PCT Rule 56.1(f)).

Quⁿ. 9

- A. Because the EPO has not yet despatched the decision to grant, proceedings are still open before it which the Examining Division is competent to handle if necessary. (Recent TBA case law on divisional applications). The decision to grant in any case does not take effect until it is mentioned in the European Patent Bulletin (EPC Art. 97(4)).

Thus, 3rd party observations can still be taken into account by the EPO. They will be treated as late-filed submissions under EPC Art. 114(2), so the EPO has discretion to disregard them and may do so if they are of little relevance & if to introduce them would unduly delay proceedings to grant. EPC Art. 114(1), however, requires the EPO to examine facts of its own motion & (TBA) case law) overrides Art. 114(2) so that, if the observations are of crucial relevance to the proceedings (e.g. might show that a valid patent cannot after all be granted), the EPO should take them into account an re-open proceedings before the Examining Division to

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consider the effect of the observations on the application. The applicant must have a chance to comment on them (Art. 115(2)).

If the observations are not sufficiently relevant to consider, they will be placed on the official file. If the patent is later opposed, the observations can be considered by the EPO during the opposition (EPC Art. 114(1)).

- B. (i) No. The 3rd party does not become a party to the original proceedings before the EPO (EPC Art. 115(1)) of which the interview forms a part. The interview is not formal and is not held in public.
- (ii) No. Again, the 3rd party is not a party to the proceedings. Since oral proceedings before the Examining Division are not public (EPC Art. 116(3)), he cannot attend as a member of the public either.
- C. Yes, 3rd party observations under Art. 115(1) EPC can be presented any number of times by the same party (EPO Guidelines; no restriction in Art. 115); this does not affect the way in which they are considered. In this case, new observations would be treated in the same way as the original ones, if filed before a new decision to grant is despatched. This will occur only when the applicant has filed translations of the new claims into the 2 EPO official languages other than the language of the proceedings, & has paid any excess claims fees due on the amended claims (EPC Art. 97(2)(c) & (5); Rule 51(6)). Thus, if 3rd party observations are filed before despatch of the decision to grant, the EPO may still take them into consideration. Again, it has discretion to disregard them if they seem unlikely to affect the decision to grant. It is more likely to do so at this stage because the proceedings have already been lengthened & the EPO's discretion should be exercised bearing in mind the need for procedural expediency (EPO Guidelines, & many TBA decisions on Art. 114(2)).