

Examiners' Report on Paper D/1993

The committee reminds candidates of the Instructions concerning the conduct of the Examination, 4.5, to write legibly. Scripts that cannot be read cannot be marked.

Candidates should read each question carefully and thoroughly, and give a clear answer to any question asked. Such an answer, if for example it is "Yes" or "No", then needs support in the form of a brief statement of the legal basis, preferably referring to Articles, Rules and possibly Guidelines and specific case law.

One example of an answer without reasoning occurred in response to Question 7, where several candidates, suspecting that there might be an escape route, suggested filing with claims to both priority dates and hoping that the EPO would allow the priorities, without giving any basis for such hope.

A simple answer, supported by reasons, such as that arising from the excluded days in Question 7, is to be preferred.

Knowledge on the subject of priority is essential. A continuation application is not a continuation-in-part and is identical with the parent, which is abandoned after the filing. The consequences for a claimed priority should be known.

In Question 8, the International Preliminary Examination was stated to be "to extend the international phase". Answers stating that demand could be made at any time up to 31 months did not meet this requirement.

Some answers showed a failure to divide time sensibly between the Parts, and consequent loss of marks.

The attached solution to paper D is longer than the Committee expects from candidates as it contains very full explanations. Certainly less is expected from an average successful candidate. As a guide, an actual answer paper by a very good candidate is attached with the permission of the author.

PART I

Answer to Question 1

No.

At the time of filing the request as referred to in Art. 4 PCT, a regional patent, in this case a European patent, was not available for Monaco, as the EPC only entered into force for Monaco on 1 December 1991, as reported in OJ 11/91. Therefore, the special circumstances referred to in Art. 4(1)(ii) PCT did not apply to Monaco on 26 September 1991 and a European patent cannot be obtained with the international application. Moreover, in accordance with J30/90, the European Patent Office can only act as a designated Office under Art. 153(1) EPC, for those States designated which are Contracting States to the EPC at the time of filing the international application.

Answer to Question 2

Yes.

According to Art. 78(2) EPC, a filing fee is to be paid within one month of filing. In accordance with Art. 14(2) EPC, the application should initially be filed in Italian, by which a reduction of 20% in the filing fee is obtained under Rule 6(3) EPC and Art. 12(1) RrtF. For the examination fee reduction, the request for examination should be in Italian. Decision G6/91 applies and the English translation could be filed simultaneously, or should be filed within 3 months after the filing of the application, but not later than thirteen months after the date of priority under Rule 6(1) EPC.

Answer to Question 3

- a) Greece is a Contracting State of the EPC. Hence, in accordance with Art. 14(4) EPC, the instructions may be filed in Greek. A translation of the instructions is to be filed within one month of the filing of the Greek instructions under Rule 6(2) EPC and may be in any of the official languages of the EPO, i.e. English, French and German, as required by Rule 1(1) and Art. 14(1) EPC.
- b) Amended claims and/or amended description pages which are filed in response to an invitation of the Examining Division in order to meet the requirements of the Convention are part of the observations referred to in Art. 96(2) EPC for which a period is fixed under Rule 51(2) EPC. Hence, these documents are "documents which have to be filed within a time limit" as referred to in Art. 14(4) and may therefore be filed in Greek. A translation of these documents must be filed within one month of the filing of the Greek documents and must be in the language of the proceedings, as follows from Art 14(4), Rule 6(2) and Rule 1(2) EPC.

Answer to Question 4

- a) In accordance with the Guidelines A-III 9, Rule 31 EPC is only applicable to the set having the highest number of claims, in this case the second set having 13 claims. Hence, claims fees are payable in respect of 3 claims within one month after the filing of the application under Rule 31(1) EPC.
- b) In accordance with Legal Advice 3/85, the first set has the highest number of claims, having 10 claims in excess of the first 10 claims. Because 3 claims fees have already been paid, claims fees are payable in respect of 7 claims under Rule 51(7) EPC within the non-extendable period set for response under Rule 51(6).

- c) In a), pursuant to Rule 31(1) EPC, the failure to observe the time limit is pointed out in a communication, the fees may still be validly paid within a period of grace of one month of notification of the communication. If claim fees are still not paid within that period, excess claims are deemed abandoned under Rule 31(2) and the provisions of Art. 121 are not available.
- In b), pursuant to Rule 51(8) EPC, the application is deemed to be withdrawn. However, since the relevant time limit is set by the Office under Rule 51(6) and (7) EPC further processing pursuant to Art. 121 EPC could be requested.

Answer to Question 5

- a) The legal basis in the PCT for the refusal by the ISA is Art. 17(2)(a)(i) and Rule 39.1(iv).
There is not provision for an appeal under PCT.
- b) Yes.
From Art. 22(1) and (2) PCT, it follows that the presence of non-searched claims does not affect the entering of the national phase. This is also in accordance with Art. 15(2) PCT stating that the objective of the international search is to discover relevant prior art. Moreover, Art. 27(5) PCT, makes clear that any Contracting State is free to apply its own criteria of patentability. Finally, whether or not subject-matter is excluded from patent protection may be discussed during the national examination before the designated offices.

Answer to Question 6

- a) Art. 133 EPC covers the general principles of representation. In accordance with Rule 101(6) EPC, the termination of the authorisation of the first representative should be communicated to the EPO in order to be effective. If this is done at the time of notification of the appointment of the new representative, no signed authorisation for the new representative is required. If not, a signed authorisation should be filed along with the notification of appointment, or, if omitted, will be requested by the EPO in accordance with Rule 101(1) EPC and the Decision of the President of the EPO on the filing of authorisations reported in OJ 9/91.
- b) From Rule 81(2) EPC, it follows that it is possible to have several representatives appointed. However, the EPO is not obliged to address notifications to the added representative, because under Rule 81(2) EPC notification to any one of them is sufficient. Nevertheless, the EPO will normally communicate with the added representative.

Answer to Question 7

I would file the European patent application on 04.05.1992 at the latest and claim the priorities of 30.04.1991 and 05.05.1991. By doing so, the scientific article constitutes a P-document (Guidelines B-X 9.2).

Explanation:

According to Art. 87(1) EPC, priority may be claimed validly during 12 months from the date of filing of the first application. In this case, the earliest priority date is 30.04.1991 under Art. 88(2) EPC. Art. 120(a) and Rule 85 EPC relate to the calculation of time limits. Since Rule 85(1)

applies to 30.04.1992 because The Hague office was closed, to 01.05.1992 being a holiday and to 02.05.1992 and 03.05.1992 being a weekend, when all EPO offices were closed, the time limit is extended until the first day on which all EPO offices were open, that is, Monday 04.05.1992. This is in accordance with Art. 4C(3) Paris Convention. In order to be sure that the application is filed in due time, I would either file the application, that is the documents referred to in Art. 78(1) EPC directly at the EPO, by hand under Art. 75(1)(a) and (b) EPC, or file by fax at either the EPO or, where allowed, at a national authority in a Contracting State, see Guidelines A-II 1.1. In case of filing by fax, I would simultaneously send off 3 copies of the application and the signed request for grant by post in accordance with Rule 24(1) EPC and the Decision of the President reported in OJ 6/89. Otherwise, the Receiving Section will ask for written confirmation to be supplied within a non-extendable period of one month, although Art. 121 EPC would be applicable.

[The occurrence of a German postal strike during the relevant period was spotted by a few candidates but not expected by the Examiners].

Answer to Question 8

- a) To avoid the deadline of Art. 22, the demand should be made prior to 19 months from the filing date of the PCT application or the first claimed priority, see Art. 31(1), Art. 39(1)(a) and Art. 40(1) PCT, and be filed with the EPO as IPEA (because it was receiving office) under Art. 31(6)(a) and Art. 32 PCT.
- b) One or more further countries may be elected before or after the 19 months, provided these countries are Contracting States already designated in the request, as provided in Art. 31(4)(a) PCT. In accordance with Art. 31(4)(b) PCT, these additional Contracting States must also be bound by Chapter II.
- c) Any later elections are to be effected by notice submitted to the International Bureau under Art. 31(6)(b) and Rule 56.1 PCT, although the EPO as IPEA must forward the election under Rule 56.1(f) PCT.

Answer to Question 9

- A As the examination proceedings have not been concluded yet by despatch of the decision to grant, the Examining Division has to consider the observations on the basis of Articles 114(1) and 115(1) EPC, see Guidelines C-VI 4.10 and E-VI 1.1 and 3.
- B (i) No. The third party is not a party to the proceedings before the EPO, see last sentence, Art. 115(1). Moreover, an interview is an instrument covered by Art. 96(2), hence meant for the applicant, see Guidelines C-VI 6.1a.
(ii) No. The third party is not a party to the proceedings before the EPO, see last sentence Art. 115(1), and the oral proceedings before the Examining Division are not public, see Art. 116(3) EPC.
- C Yes, as long as the decision to grant has not been despatched, the examination proceedings have not been concluded and, therefore, the Examining Division has to consider the observations, for which see also answer to 9A. Anyway, as in the present case the grant is based on amended claims, other requirements, e.g. translation of the claims, have to be met and, consequently, a decision to grant cannot be delivered under Art. 97(2) EPC.

EXAMINATION COMMITTEE III

Candidate's answer-paper No.

Report by examiner No.

PART I

Questions	Maximum possible	Individual marks awarded	Where grades awarded are not identical	
			Revision of marks/grade (if any)	Remarks*
1	4			
2	4			
3	4			
4	6			
5	5			
6	5			
7	7			
8	7			
9	8			
Total Part I	50			

* to be filled in if both the following requirements are fulfilled:

- (a) the grades awarded by the two individual examiners before their discussion differ by two grades or more;
(b) the marks awarded by at least one of the two individual examiners have been changed during their discussion.

If remarks are to be filled in, they should briefly explain **why** the examiner has changed his marks.