

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 II

A. Client should carry on marketing of the BRIGHT IDEA.

Explanation:

As the US-application filed on 30.01.1991 is a continuation application, the disclosure was the same as that in the US-application No. XXX,XXX. Although this application has been abandoned, this was after filing the 30.01.1991 US-application and it still leaves rights outstanding. Thus the 30.01.1991 US-application was not the first application for protection of the inventions. Therefore, for the PCT-application, no valid priority claim based on the 30.01.1991 US-application can be made, see Art. 8(2)(a) PCT, Art. 4C(4) Paris Convention and Art. 87(4) EPC. Hence, pursuant to Art. 89 EPC, the effective date of the PCT-application is its filing date, 30.01.1992.

In order to establish whether the PCT-application is still pending, it should be checked whether the regional phase has been entered correctly, that is on 30.10.1992 at the latest under Art. 22 PCT and Rule 104b EPC, or a demand for an international preliminary examination under Art. 31(1) and (4)(a) PCT has duly been filed in order for Art. 39(1)(a) PCT to be applicable, that is on 31.08.1992 at the latest, because 30.08.1992 was a Sunday and the EPO as IPEA was closed and Art. 31(6)(a) and Rule 80.5 PCT applied.

If still pending, observations pursuant to Art. 115 EPC should be filed in order to draw the examiner's attention to the fact that in view of the invalid priority claim, client's European application could constitute a prior application provided that its priority claim of 31.01.1991 is valid.

The examiner will then make an investigation as to the validity of the priority claims, see Guidelines C-V 2.1. In view of the fact that the descriptions, claims and drawings of the Swedish and the EP-application are identical and the EP-application has been duly filed by 31.01.1992 to claim the priority date, the latter priority claim appears valid, although correct filing of the certified copy and translation under Rule 38(3) and (4) EPC is to be checked.

Consequently, client's EP-application constitutes a prior application against the PCT-application for all the EPC Contracting States, see Art. 54(3) and (4) EPC. So the contents are prior art for novelty purposes and as these include the device and the BRIGHT IDEA, C should not get a European patent for the device or the BRIGHT IDEA.

As the PCT-application has been published, WIPO must furnish a copy of the priority document on request according to Rule 17.2(c) PCT. Alternatively, file inspection is possible at USPTO or EPO.

B. According to Art. 76(1) EPC, a divisional application must be filed at the EPO in The Hague, Munich or Berlin. It may be that the Swedish Patent Office has forwarded the divisional application in view of Art. 75(3) and Art. 77(2) EPC. This should therefore be checked. The date of receipt by the EPO would be the date of filing of the divisional application.

Moreover, according to Rule 25(1) EPC, the filing of a divisional application is only valid if the parent application is still pending. This should also be checked. The requirement according to Rule 26(2)(e) EPC has been fulfilled, as the first page of the request is marked "Divisional".

Correction of the request form in order to correctly mention the parent is, however, necessary under Art. 91(1)(d) and Rule 41(1) EPC.

According to Art. 76(2) EPC, a valid designation for Ireland cannot validly be made.

According to Art 76(3) and Rule 25(2) EPC, the filing fee, excess claims fees and the search fee are due within one month after the filing of the divisional or, with 50% surcharge, within one month after notification, see Rule 85a(1) EPC, Art. 2(3b) RrtF. For the designation fees in respect of Contracting States which have only been precautionary designated by the crossed box on the request form, either the above-mentioned period or a period of grace of 2 months after the normal time limit of one month after filing of the divisional applies, whichever is the latest.

The subject matter must not extend the content of the parent application in order that the divisional be deemed to be filed on the date of filing of the parent. It was not necessary to file the divisional merely because of the fact that the BRIGHT IDEA was not claimed in the earlier EP-application; it may still be claimed by filing amended claims in relation to the parent application. The fact that the BRIGHT IDEA was not claimed in the parent application does not prevent it being claimed in the divisional.

As the chief designer is the inventor, the designation of an inventor should be corrected in accordance with Art. 81 and Rule 19(1) EPC, A's consent to removal being needed.

- C. If there has been no specific withdrawal in writing, the parent will still be pending as the date for requesting examination has not been passed. This must be checked and if the parent is still pending, add claims under Rule 86(2) directed to the BRIGHT IDEA. In that case no further action in respect of the divisional should be undertaken. The designation of inventor in the parent should be corrected by adding B.

If the parent has been abandoned, the proceedings in respect of the divisional should be continued. As already mentioned under A, observations under Art. 115 EPC should be filed in respect of the PCT-application regarding the invalid priority claim. In addition, an argument may be based on Art. 83 EPC, as the client states that the tool does not work as a spaghetti pick up tool when used horizontally, as described in C's application.

If the PCT-application nevertheless results in a European patent, a notice of opposition should or could be filed under Art. 99 EPC, depending on the subject matter for which patent has been granted. C would only be able to stop client selling the tool for use horizontally to pick up yarn and the like in countries in which EPC and PCT had entered into force on 30.01.1992, provided all necessary steps had been taken to designate those countries.

In any case, on the basis of his European patent, the client would be able to stop C selling the egg beater as a spaghetti pick up tool to be used vertically.

[Some candidates suggested accelerated prosecution for the BRIGHT IDEA and others the possibility of provisional protection by filing translations where necessary].

PART II

Parts	Maximum possible	Individual marks awarded	Where grades awarded are not identical	
			Revision of marks/grade (if any)	Remarks*
A	20			
B	19			
C	11			
TOTAL PART II	50			
TOTAL PART I	50			
TOTAL PARTS I + II	100			
CORRESPONDING GRADE				

Translation of marks into grades

%	Grade
0 - 35	7
35,5 - 45	6
45,5 - 55	5
55,5 - 65	4
65,5 - 75	3
75,5 - 85	2
85,5 - 100	1

* 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.