

Candidate's Answer Paper
(Examination Paper D)

1. A 87(1) EPC gives a right of priority for filing in or for any State party to the Paris Convention.

A 8(1) PCT provides the right to claim priority in an international application, again from an application filed in or for any country party to the Paris Convention.

Taiwan is not party to the Paris Convention.

- (a) The priority claim is valid. The PCT application was filed within one year of the first filing in a State party to the Paris Convention.
A 8(2)(a) PCT ensures A 4 of the Paris Convention applies.

The applicant was the same in all cases, fulfilling the requirement of A 87(1) EPC. Switzerland is a Contracting State of PCT giving the individual the right to file a PCT application by virtue of his nationality (Article 9(1) PCT).

- (b) National law, EPC, is ultimately determinative. A utility model can give a valid right to priority - A 87(1) EPC. Here A 87(4) EPC would apply. Assuming the utility model application were not withdrawn, abandoned or refused by the patent application was filed, and without being open to public inspection without leaving any rights outstanding nor serving as a basis for claiming a right of priority, there is no valid claim, as far as EPC States are concerned.

2. A 60(2) EPC gives the right to the European patent to the person whose European application has the earliest date of filing. A 89 EPC indicates that the date of priority shall count as the date of filing for this purpose.

A 60(2) applies only in respect of States designated.

A therefore has the right for FR, DK, IT, SE.

B has the prior right for NL.

For Germany, national law counts and A 4 Paris Convention gives the right of priority to A, who has the earlier priority date - 4/1/93 - and so the right to the German patent.

3. (a) The Decision of the EPO President dated 26/5/92 allows documents to be filed by facsimile under R 36(5) EPC.

R 36(3) requires a notice of opposition to be signed, since it applies to opposition proceedings by virtue of R 61a. If a document is not signed, the original date of receipt is kept if it is signed within a time-limit set by the EPO (R 36(3) second and third sentences).

The notice will therefore get the date of fax filing (by analogy with Legal Advice 13/82 one should be able to file the signed document before the invitation to do so is received).

For an opposition to be validly filed, the fee must be paid by the end of the opposition period, A 99(1), last sentence.

The receipt of the payment from a deposit account at the EPO is a permissible way of paying fees - (see Decision of President).

Is the Managing Director an authorised employee (or a professional representative)? If Company A has residence or a principal place of business in an EPC Contracting State then an authorised employee can act on behalf of the company A 133(3). If this is the case here, all is OK.

If A is not a company with residence or a principal place of business within an EPC Contracting State, a professional representative must be appointed (A 133(2)). The wrong signature will count as no signature (T 665/89) - the applicant will be invited to appoint a representative, who will have to sign the notice (R 36(3)).

(b) No signed copy:

R 36(3) invitation for a signature, likely coupled with a R 59 invitation for 2 copies of the notice and documents therewith.

Also, there will be an invitation for an authorisation if a professional representative is not appointed, - R 101(1) and Decision of President.

4. G 1/91 - don't need A 82 unity of invention for claims resulting from opposition.

(a) The amendments must be appropriate (R 57(1)) and necessary (R 58(2)) to overcome the objections - there is no guarantee of amendment (T 406/86).

The amendments must meet the requirements of the Convention (A 102(3)) i.e. A 84 and A 123. (Not- A 82 - see above). T 472/88 allowed A 84 objections to be raised against any lack of clarity which amendments "bring into notice". T 127/85 indicated that A 84 clarity should only be an issue when it arises from an amendment. The OD must therefore examine for compliance with A 84 (with regard to the amendments).

G 9 and 10/91 confirmed that A 123(2) and (3) must be considered. The amendments will only be allowed where no subject matter is added going beyond the content of the application as filed and the scope of protection is not extended.

Under A 114(2) a late amendment might be disregarded.

(b) Yes - either in the proceedings (i.e. in writing or at Oral Proceedings before an interlocutory decision) - A 113(1) right to be heard - all parties - opponents are party to opposition proceedings by virtue of A 99(4), or in response to an A 58(4) communication.

5. (a) The standard request form contains a precautionary designation of all states and a waiver of R 85a(1) communication.

R 85a(2) enables such precautionary designations to be effected by payment of a fee with surcharge (A 2 No. 3b of RRF - 50% of fee).

By A 79(2), applying the A 78(2) period, the fee for DK was subject to payment of the fee by one month after filing - 3 Feb. 94 (no R 85(1)(a) extension - all EPO Offices open).

R 85a(2) enables the fee to be paid (as discussed) by 2 months from 3 Feb. 94, i.e. 3 April 1994.

However, this was a Sunday and at least one EPO Office within the meaning of A 78(1)(a) was closed on 4 April and so R 85(1) extends the time-limit to 5 April 1994 (today).

- Pay the fee and surcharge today.

- (b) 30/12/93 plus 1 month -> 30/1/94, which is a Sunday therefore R 85(1) extends the normal period to 1 February 1994.

R 85a(2) grace period is calculated from the expiry of the normal period therefore grace period expires 1 April 1994, except this was Good Friday - the EPO was closed 1, 2, 3 and 4 April and R 85a(1) extends the grace period to 5 April 1994.

Therefore same answer as (a).

- (c) Different - designation fee would then be due 12 months after filing - 4 Jan 1994 (A 79(2)).

The 2-month grace period would then have expired on 4 March 1994.

Therefore would be too late for DK.

- A 79(2) - no fee, no designation of DK.

NB

The fees may be paid by any person (Legal Advice 6/91 with regard to A 7(1) Rules relating to Fees). Simplest would be for the Munich representative to pay the fees in (a) and (b).

6. (a) Withdraw approval of text - R 51(6) communication cannot be issued (T 1/92 - it must be established beyond any doubt that applicant agrees text): A 113(2) requires that the EPO can only decide on text agreed by the applicant. Simultaneously request an amendment to overcome the prior art and give approval to the text subject to the amendment being made.

If the amendment is not allowed, examination should be resumed. (The Guidelines confirm that, exceptionally, this will happen where there are new reasons to doubt validity of the R 51(4) claims.)

G 7/93 is currently pending on the question of whether approval given by the applicant under R 51(4) is binding. However, the public interest should be protected - the EPO should not grant patents it knows to be invalid, where it still has the chance to resume examination proceedings.

- (b) Too late for action as in (a).

Instead - self opposition. A 99(1) - any person may oppose, confirmed by G 1/84 to include the patent proprietor. Oppose own patent after publication of mention of grant and within the A 99(1) period, on the

ground of lack of novelty of Claim 1 - A 100(a) subject-matter not patentable within the terms of A's 52-57.

7. (a) A 17(3)(a) PCT
- the USPTO as ISA shall establish the international search report on those parts of the application relating to the invention first mentioned in the claims.
- (b) A 17(3)(b) PCT implicitly requires a designated Office to review the invitation (not until expiration of the A 22 PCT time-limit - see A 23(1) - unless requested by applicant - A 23(2)).

The EPO may require a fee if it finds the invitation justified, the consequence of non-payment of which fee being the unsearched invention being considered withdrawn - A 17(3)(b) PCT.

R 104b(4) EPC requires the EPO Search Division to consider whether the application complies with the requirement of unity. If it decides no, then the applicant will be invited to pay a further search fee.

If he does - he'll get a supplementary EPO search for both inventions.

The Examining Division will decide on the question of unity (applying A 3(4)(iii) and Rule 13 PCT, because of A 27(1) PCT). If it maintains the objection, one invention will have to be dropped from the application - protection might be pursued in a divisional application.

If the ED drops the objection to lack of unity (i.e. thinks the objection unjustified) - the extra fee shall be refunded if the applicant requests a refund - R 46(2) EPC.

If, in response to the Search Division's invitation the applicant does not pay an additional fee according to Rule 104b(4), he cannot have invention 2 without filing a divisional application, according to G 2/92.

8. Consequences of non-timely reply

A 96(3) - application deemed withdrawn.

EPO sends R 69(1) communication noting loss of rights.

The application will then proceed further only if, within 2 months of the notification of the R 69(1) communication further processing is requested, the fee is paid and a response is filed (completing the omitted act). See A 121(1) and (2) EPC.

Proposal

Request an extension of time for reply, before expiry of the period - in accordance with Rule 84, final sentence. It is the EPO's practice to allow an extension of a time-limit up to a total period of 6 months, without reasons being given - see G's E VIII 1.6 and Notice of Vice-President of DG 2.

By R 78(1) notifications are by registered mail - to a professional representative under R 81.

R 83(2) provides that computation of a time-limit, where the relevant event is a notification, is from receipt of the notification. By R 78(3), a registered letter within an EPO Contracting State (e.g. to a professional representative), is deemed to be delivered on 10th day following posting.

Thus, the 4-month period has not yet expired (there may be as much as 10 days left) and a R 84 request for an extension will be granted - no fee payable.

If even more time is needed, the further processing route outlined above could be used to gain more time on payment of the fee required by A 121(2) which is DM 150 or equivalent (A 2 No. 12 RRF).

A request under R 84 for a further extension beyond the 2 months taking the period up to 6 months, would probably be refused - see Notice of Vice-President DG 2 and Guidelines, as above.

9. R 90(1)(a) provides for interruption of proceedings in the event of death of the applicant.

J .../87 has indicated that such interruption does apply to the grace period for paying renewal fees, notwithstanding R 90(4) (in line with J 7/83).

However, here the applicant has not died. The transfer from A to B has no effect vis-à-vis the EPO, by virtue of R 20(3), since no request from the transfer to be recorded under R 20(1) has been received by the EPO, neither has the fee required by R 20(2) been paid.

A is the applicant vis-à-vis the EPO, therefore no interruption. Therefore the application is deemed withdrawn - A 86(3), A 121 (further processing) does not apply because the time-limit was not set by the Office.

10. Legal advice 18/92 applicant may initiate processing.

R 104b(1) - 21 months deadline - here 10 Jan 94.

R 104b(1)(b) - national fee (basic, designations and search) paid in time

R 31(1) - no excess claims fees due.

Exam fee:

A 94(2) - due 6m from publication of European Search Report, which the International Search Report is considered to be.

The Exam fee must be paid, and examination requested by 28 April 1994. If this is not done, there will be a grace period of 1 month set under R 85b: a surcharge will have to be paid - 50% of exam. fee - A 2 No. 7 RRF. The Office will send a Rule 85b communication if the exam. request is not made (including fee paid) by 28/4/94.

If the request is still not made, the application shall be deemed to be withdrawn - A 94(3).

.../...

Also,

3rd year renewal fee - due on 30 April 1994 (R 37(1) - applying A 86(1)).

Last day for payment - Mon. 2 May 1994, because R 85(1) extends the period to the next day EPO open (30/4/94 is a Saturday).

If not paid, may be paid within 6 months - up to 31 October 1994 (J 4/91 - not an aggregate time-limit) with additional fee of 10% of renewal fee - A 2 No. 5 RRF.

This assumes the application has been accorded a date of filing having met with the requirement of A 80.

Deficiencies noted by the Receiving Section performing an A 91 examination must be rectified within the time-limit set under R 41(1), or the application shall be refused - A 91(3).