

Examiners' Report on Paper D/1994

This report is no short-term substitute for consistent preparation, study and training for the examination during the years of experience required for enrolment.

The attached solution to Paper D is much longer than the Committee expects from candidates as it contains very full explanations. Certainly less is expected from an average successful candidate. An actual answer paper by a good candidate is attached for comparison.

Candidates are urged to time themselves, both for the short and long questions, leaving a good margin for review. Then time can be used to read the question carefully and to answer what has been asked. Many errors in candidates' answers would have resulted in the loss (often irreparable) of a client's rights.

1. Several candidates assumed that Taiwan was a Paris Convention country. Although appreciating that a utility model application is, for priority purposes, equated with a patent application, some did not realise that its filing more than 12 months before the PCT application was fatal to the priority claim. A few thought that a utility model application was a design application and dismissed it from consideration.
2. A surprising number failed to realise that the priority claim in A's European patent application would not stand up, so that B's would be prior art under Article 54(3) in common designated countries.
3. Some candidates wrote unnecessarily of the need for the contents of the opposition to be substantively correct, rather than dealing with the formalities of lodging, paying and signing.
4. Many failed to see that the amendments must be appropriate and necessary, arise out of the opposition, and not extend the scope of protection. Some answers indicated a lack of familiarity with recent case law and the difference between sufficiency of the disclosure of the patent, required by Art. 83, and the clarity of the claims, required by Art. 84.
5. Some offered only Rule 88 action, not realising that Form 1001.1 contains precautionary designations of which advantage could be taken. The period and date calculations in (b) and (c) were often inexplicably incorrect.
6. Those familiar with Decision T 1/92 were able to answer well.
7. Many failed to appreciate that, in the regional phase, the EPO performs a supplementary search, considers the question of non-unity and invites payment of further search fees, if necessary.
8. Some candidates have either never required an extension, or never prosecuted an application. Many forgot the 10-day rule for notification, and the need for a response when applying for further processing.
9. Few seemed to be familiar with J 9/90 and its consequences fatal to the renewal, despite J 7/83 and J xx/87 (OJ EPO 8/1988, p. 323).
10. Many gave good and clear answers, but others neglected one or other of the fees due. Some date calculations were awry.

In Part II, few took the important point that Grisk had no right to claim DK1 priority, as he was not the applicant in that application. Similarly, many proposed to include Grisk's inventions in EP2 with Smart as sole applicant, claiming EP3 priority without assignment of Grisk's right to priority.

To keep EP3 in force, some failed to realise that a translation into English, French or German is needed. Most appreciated that fees were due, although the time periods involved were often calculated inaccurately.

Few knew that, with Grisk co-operative, there was no need to keep EP3 in force, provided that it was sufficient to establish a valid priority date, e.g. for a PCT application.

Many who recommended claiming priority from DK1 and EP3 did not realise that EP3 contained some Grisk inventions not belonging to Smart and that Grisk was the applicant in EP 3, so both should be applicants in the PCT application.

Candidates seemed unfamiliar with second medical indication claims and many showed an inability to use the "optimal" claims from DK1 as the basis for the claims to be filed with PCT2, whether as such or in combination with EP3.

The greater difficulties arising when Grisk was unco-operative were realised by many, but few proposed effective action. Most recommended entitlement proceedings in Denmark, followed by a request for suspension in the EPO. Few noted that suspension was only effective after publication and that fees and a translation were needed to ensure such publication.

Whilst fees are payable by anyone, filing a translation is a procedural step not available to Smart. Many did not realise that the entitlement would not be for the whole of EP3, but only for the parts owned by Smart.

In assessing whether or not to keep EP3 alive, credit was given for intelligent argument in support of the choice made, whether or not Grisk was co-operative. Thus, it could be argued that EP3 should be allowed to go by default, checking after the final dates for translation and fees, and including Smart's inventions (not Grisk's) in an early PCT (or EP or Danish) application without Grisk's help, relying upon Article 55 (or its equivalent) to deal with disclosure to Albatross. One problem with this would be the possibility of Grisk (or Albatross) filing another application claiming priority from EP3, which could render its contents prior art under Article 54(3) EPC.

The recent Enlarged Board of Appeal's Decision G 3/92 was not available before the examination, so that some argued that maintenance of EP3 was important to have a pending application to be the subject of Article 61(1) proceedings, and discussed the various options open.

The difficulty of including inventions not made by Smart alone in any proposed PCT application was overlooked by many candidates who recommended the inclusion of the contents of EP3 in such PCT cases. Whilst it is conceivable, the likelihood of the Danish Court acting quickly enough to give a decision, even interim, in time to allow a PCT application to be filed before 3 June 1994 (the date to claim DK1 priority) seems to be too small to justify claiming EP3 priority and including its contents without some explanation of what to do if no early decision were to be obtained.

Comparison of the PCT and EP routes was generally poor, although some noted the accelerated prosecution advantage of any EP application. Against this, several noted the ready and quick access to Japan and the USA via PCT. The acceptability of English language applications in Japan was not then available.

PART I

Answers to Question 1

a) Yes.

Taiwan is not a member of the Paris Convention and therefore the first application filed in Taiwan on 01.03.93 cannot be used to claim priority for the International application under Art. 4A(1) of the Paris Convention. Japan is a member of the Paris Convention and consequently the Japanese application filed on 03.04.93 can be used to claim priority, being the first filing in a Convention country within the meaning of Art. 4C(2) of the Paris Convention. As the international application was filed within the twelve months period following the first filing, the claim to priority right is valid.

b) No.

As the first application filed on 01.03.93 was a Japanese utility model application, a right of priority based on its filing is available under Art. 4E(2) of the Paris Convention for a subsequent patent application filed within twelve months (Art. 4C(1)). Accordingly, as Japan is a member of the Paris Convention, the Japanese application filed on 03.04.93 was not the first filing under Art. 4C(2) of the Paris Convention. Thus, because the international application was filed on 31.03.94, more than twelve months after the first filing, it was not possible validly to claim priority for the application, unless under Art. 4C(4) of the Paris Convention the Japanese utility model application had been withdrawn, abandoned or refused before the filing of the Japanese patent application, without being published, leaving any rights outstanding, or serving as a basis for claiming priority right.

Answer to Question 2

Inventor A: FR, DE, SE.

Inventor B: DK, IT, NL.

Inventor A filed the A-EP application after the expiry of the twelve months period of priority under Art. 4C(1) of the Paris Convention, so that the claim to priority was not available and the date of filing, 05.01.94, was the effective date. Inventor B filed the B-EP application on 05.02.93 as a first application and therefore has the prior right for all designated countries in that application, i.e. FR, DK, IT and NL under Art. 60(2) EPC, so that Art. 54(3) will apply against A-EP. However, the inventor A filed in FR on 04.01.93, so that in FR, Art. 139(2) EPC applies and the prior right belongs to A. As the A-DE application was filed in Germany on 04.01.94, claiming priority from A-FR filed 04.01.93, and as the B-DE application was filed on 03.01.94 claiming priority from B-EP filed 05.02.93, both A-DE and B-DE satisfy the twelve months rule under Art. 4C(1) of the Paris Convention, and A has the right in DE having an earlier priority date. As SE was not designated in B-EP, A has the right for SE under Art. 60(2) EPC.

Answer to Question 3

a) Yes.

Oppositions can be faxed according to Rule 36(5) EPC and to the President's Decision dated 26 May 1992 in OJ EPO 6/1992, pp. 299, 300. Written confirmation should follow to satisfy the requirements of Art. 4(2) of that Decision. However, the faxed opposition is valid even if not signed, because the EPO has to invite the party concerned to do so within a time limit (Rule 6(3) EPC) set at one month (unextendable) by the Decision. In the present case, the opponent sent a copy of the opposition which was signed before requested to do so by the EPO. The Managing Director may be assumed to be able to sign on behalf of Company A and satisfy the provisions of Art. 33(3) EPC provided that the Company has its residence or principal place of business in a Contracting State. Otherwise, the EPO will request the appointment of a professional representative. In Decision T 665/89 (EPO Board of Appeal Case Law 1991), it was confirmed that an opposition was admissible in similar circumstances.

b) If the signed copy had not been sent, the EPO would have invited the opponent to provide the missing copy properly signed within the time limit of one month specified in Art. 4(2) of the President's Decision. If the opponent failed to provide the missing signed copy within that month, the opposition would be deemed not to have been received.

Answer to Question 4

- a) According to Rules 57(1) and 58(2) EPC, the amendments must be appropriate and necessary in order to be allowable. Further, they are admissible if they can fairly be said to arise out of the grounds of opposition (Decision T 95/87). The amendments need to satisfy the provisions of Art. 123(2) and 123(3) EPC. As the claims have been limited, Art. 123(3) should not apply, but it should be checked whether the limitation can be found in the content of the application as filed.
- b) The lack of clarity objection made by the opponent is not a ground for opposition under Art. 100 EPC, but as clarity of the claims is required by Art. 84 EPC, the Opposition Division should take it into consideration under Art. 102(3), provided the claims have been amended and if the lack of clarity arises from the amendments made (Decisions T 23/86 and T 127/85).

The lack of unity objection made by the opponent is not a ground for opposition under Art. 100 EPC although unity is required by Art. 82 EPC. The objection is not to be considered in opposition proceedings and is considered to be irrelevant to the opposition according to a Decision of the Enlarged Board of Appeal (Decision G 1/91). The function of Art. 82 EPC is primarily administrative and is not relevant to the validity of the claims, which is the issue in opposition proceedings. [Rule 61a EPC refers to Regulations applying to opposition proceedings, namely Rules 26 to 36, but only applies to documents and Rule 30 EPC does not relate to documents].

Answer to Question 5

- a) EPO Form 1001.1 includes a precautionary designation of all Contracting States (including DK). A designation only becomes effective upon payment of the designation fee. This fee is due within one month of filing the European patent application under Art. 78(2) and 79(2) EPC. This period of time expired on 03.02.94, but the fee can still be paid two months later under Rule 85a(2) EPC with a surcharge of 50% of the fee payable (Art. 2 No. 3b Rules relating to Fees). This time limit expired on 03.04.94, which is a Sunday. Accordingly, the time limit is extended under Rule 85(1) EPC to 04.04.94, but this is Easter Monday and the EPO is closed until Tuesday 05.04.94, so that the time limit is extended until today. Accordingly, the advice is to pay today one designation fee and 50% surcharge, specifying DK as the country to be designated.
- b) If the European patent application had been filed on 30 December 1993, the one month period for paying the designation fee expired on 30.01.94, which is a Sunday, so that it is extended under Rule 85(1) EPC to 31.01.94. Consequently, the two months grace period expired on 31.03.94. Thus it is too late to designate DK today.
- c) The European application claims no priority and therefore Art. 79(2) EPC is applicable, but not Art. 78(2) EPC. Thus only twelve months is given for payment of the designation fees, that is until 04.01.94, without surcharge. Taking advantage of the two months grace period under Rule 85a(2), the designation fee could have been paid with 50% surcharge until 04.03.94. Today, 05.04.94, it is too late to designate DK.

In both b) and c) circumstances, DK national applications could be filed without claim to priority if there has been no publication of the invention, because the European patent applications would not have been published under Art. 93 EPC.

Answer to Question 6

- a) According to the Guidelines C-VI, 4.10, the applicant is bound by his approval and can no longer amend the text of the patent to be granted of his own volition, but only with the consent of the Examining Division under Rule 86(3) EPC. At this stage, only the Examining Division can resume proceedings and that only if the Division becomes aware of circumstances rendering claimed subject matter unpatentable. In the present instance, such circumstances may be brought to the Division's attention by the applicant, indicating withdrawal of approval and proposed amendments under Rule 51(5) EPC. (Decision T 1/92 is relevant). This should be done by submitting a request for resumption and, if necessary, a request for a two months extension of the time limit under Rule 51(4)EPC.
- b) According to the Guidelines C-VI, 4.10, the despatch of the decision of the Examining Division to grant a patent is binding for the Division, and the only possible amendments are those allowed by Rule 89 EPC. (This question has been addressed in the reference to the Enlarged Board of Appeal pending under G 7/93 from Decision T 830/91, not yet published in OJ EPO). The applicant, once the patent has been granted and he has become patentee, can oppose his own patent under Art. 100(a) EPC (Decision G 1/84). (The question of this entitlement has been referred to the Enlarged Board of Appeal under G 9/93 by the unpublished Decision T 788/90).

Answer to Question 7

- a) The USPTO as ISA will only establish a search report for the parts of the patent application which relate to the invention first mentioned in the claims (Art. 17(3)(a) PCT).
- b) On entry into the regional phase and payment of the reduced search fee, the EPO will draw up a Supplementary Search Report (Art. 157(2)(a) EPC). The Search Division will consider whether the application complies with the requirements of unity of invention (Rule 104b(4) EPC). If this is found not to be the case, the applicant is informed that a European Search Report can be obtained for the unsearched parts, if a search fee is paid for each invention involved within a period set by the Division (between 2 and 6 weeks). Search reports are then drawn up for all inventions with fees paid in time.

Answer to Question 8

As I am a professional representative, the communication of the EPO examiner is deemed to have been delivered to me ten days after posting exactly four months ago, under Rule 78(3) EPC. The four months time limit for response started on the deemed delivery date and ends in ten days time. As I have instructions not to respond, I will apply for an extension of that time limit under Rule 84 EPC and Guidelines E-VIII, 1.6, within the next ten days. No fee is involved. An extension to a total of six months from the deemed delivery date is thus obtainable, i.e. an extension of two months. If, within that time, no response is possible and you send me details of exceptional circumstances explaining why, I can apply with a reasoned request for a further extension (last sentence Rule 84 EPC), but this will only be for a short period and only exceptionally (Guidelines E-VIII, 1.6, and Notice of the Vice-President of DG2, OJ EPO 5/1989, 180). Again no fee. If the reasoned request is unsuccessful or not made, the application will be deemed to be withdrawn under Art. 96(3) EPC. Thereafter, the EPO will notify me of a loss of rights under Rule 69(1) EPC. Then I have two months to (i) file a request for further processing under Art. 121 EPC, (ii) to respond to the EPO examiner's communication, and (iii) to pay the corresponding fee for further processing. (Art. 2 No. 12 Rules relating to Fees).

Answer to Question 9

No.

In order to save the application, the proceedings would have to be interrupted under Art. 90(1)(a) EPC. However, this is not possible because the dead person is not identical with the applicant entered in the Register of European Patents. For the purposes of proceedings before the EPO, according to Art. 60(3) EPC, the applicant registered in the Register of European Patents is deemed to be entitled to exercise the right to the European Patent. As no request for recording the transfer from A to B has been filed under Rule 20(1) EPC, no fee pursuant to Rule 20(2) has been paid and no transfer document has been submitted under Rule 20(3) EPC, there is no transfer carried out vis-à-vis the EPO. Consequently, at the date of death of B, the applicant before the EPO was still A. A request for registration of the transfer filed today has no retroactive effect (Decision J 9/90, EPO Board of Appeal Case Law 1992).

Answer to Question 10

There are two fees to be paid, the examination fee and the renewal fee for the third year. No action, apart from payments, is needed.

The examination fee is due six months after publication of the international search report which takes the place of the publication of the European Search Report (Art. 157(1) and 94(2) EPC). In the present case, the time limit expires on 28.04.94. Non-payment will be notified by the EPO and a grace period of one month will be allowed for payment with a 50% surcharge (Rule 85b EPC and Art. 2 No. 7 Rules relating to Fees). If payment is not made, even with surcharge in the grace period, the application will be deemed to be withdrawn (Art. 94(3) EPC).

The third year's renewal fee is due on 30.04.94 according to Art. 86(1) EPC. Nevertheless, it can be paid without additional fee until 02.05.94 because 30.04.94 and 01.05.94 are weekend days when the EPO is closed and Rule 85(1) applies. The renewal fee can be paid with an additional fee of 10% six months after the due date (Art. 2 No. 5 Rules relating to Fees). This later date is actually 31.10.94 being calculated as the end of the month in accordance with Legal Advice 5/93 in OJ EPO 4/1993.

As payment of fees is not a procedural step before the EPO, you can effect such payment yourself (Legal Advice 6/91).

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	8			
6	5			
7	4			
8	5			
9	5			
10	5			
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.