

Candidate's Answer Paper

PART I

Question 1

- a) A 88(1) EPC - must file a translation in accordance with the Implementing Regulations:
Rule 38 EPC
Rule 38(4) EPC - a translation must be filed within a time limit set by the EPO, at least before the expiry of the communication under R 51(6) EPC (Since June 01 1995)
- or
- b) a declaration must be submitted that the European Patent Application is a complete translation of the previous application.
- c) Deadline for a) and b) = within a time limit set by the EPO. Rule 84 EPC will apply. But before expiry of R 51(6) deadline.

Question 2

Mention of grant 4 May 1995

Opposition deadline - 4 Feb 1996 (Sunday)

↓ R 85(1) extended to:

5 Feb 1996 (Tuesday)

therefore Opposition validly filed from time point of view.

Proceeding instituted 28 Feb 1996.

- a) A 105(1) EPC a 3rd party who proves proceedings for infringement have been instituted against him can intervene in the opposition proceedings provided he gives notice of intervention within 3 months of the date on which opposition proceedings were instituted.

So, intervene by - 3 months from 28 Feb 96

According to R 83 - 28 May 1996 Tuesday

A 105(2) notice of intervention must be filed in a written reasoned statement and the opposition fee (RRF 2-10) must be paid.

The intervention is then treated as an opposition (A 105(2) EPC last sentence).

Intervention can be filed up until the Decision on the opposition is handed over to the internal postal service (G 4/91) and (G 12/91) + T 631/94. We should be in plenty of time.

- b) According to G 1/94 and G 6/93, interventions can be filed during pending appeals on oppositions ∴ the answer would be the same.

Question 3

- a) A 9 PCT - the applicant for a PCT application must be a resident or national of a contracting state.

Rule 18 PCT defines residence and nationality.

South Africa is not a contracting state of the PCT
therefore the application cannot proceed in the South African's name only.

- b) Australia is a contracting state therefore according to Art 9 PCT the Australian is entitled to be a PCT Applicant.

The Application would have to be filed at the prescribed receiving office (Art 10 PCT)
According to Rule 19 PCT, this would be the Australian Patent Office (R 19.1(1)(a) PCT, R 19.1(a)(II) PCT or the International Bureau (R 19.1(a)(III)

Therefore you could file at the international Bureau
But may not be entitled to represent (R 83-1^{bis} PCT) unless entitled to represent in Australia.

Question 4

The 6 month A 86(2) period has been missed and therefore the only remedy is restitution (A 122 EPC)

This is available to the Applicant if he can show that the time limit was not met despite his showing all due care (Art 122(1) EPC)

The Application must be filed within 2 months of the removal of the cause of non-compliance, and within 1 year of the expiry of the unobserved time limit (A 122(2))
1 year deadline expires 28 Feb 1996 (Wednesday)

The removal of the cause of non-compliance is usually taken to be receipt of the Rule 69(1) notification (J 27/90 - although this applied when the notification was sent to an unauthorised representative). Therefore, in the absence of evidence to the contrary, the deadline would expire 2 months from deemed receipt of the Rule 69 letter (on 29 Sept 1995 according to Rule 78(2))
→ 29 Nov 96 Friday. Therefore we are out of time.

Absences on business trips are no reason not to comply with a time limit (J 41/92) - the Applicant showing all due care would ensure that a representative was instructed to pay the fees. Additionally, relying on letters from the EPO such as the notification that the renewal fee is overdue is not showing due care (J 12/84) so being away from the office when the letter was received would be immaterial.

From the facts on the face of it restitution does not seem possible.

If we could show that the representative withdrew his authorisation without the Applicant's consent, so that the Applicant did not think he had to respond to letters, and (probably) that the letter of 95 March 23 was not received so that the Applicant thought he was still represented, we might succeed in restitution. In this case, the removal of the cause of non-compliance could be

said to be when we received the letters from the Applicant, because the Applicant did not realise what was going on. Although case law shows that the EPO can be quite generous to unrepresented applicants, the case is weak.

Question 5

Rule 57.3 PCT

Handling fee is due when the demand is submitted. (Within 19m to delay nat. processing).

Rule 58.1(a) PCT - amount of preliminary examination fee and due date are fixed by the IPEA, but mustn't be later than the due date for the handling fee.

Failure to pay handling fee

- Rule 57.4(a) PCT - IPEA invites applicant to pay the fee within 1 month from the date of the invitation.
- Rule 57.4(b) PCT - demand is deemed not submitted

Failure to pay IP Examination Fee

Rule 58.2(a) to (c) PCT - an invitation must be sent by the IPEA, in the same way as described above for the handling fee.

Question 6

A45(2) PCT - the law of any state may provide that a designation is assumed to be for a regional patent.

Since Jan 01 1995 the Netherlands has provided that a designation will have the effect of the designation of a European Patent.

Therefore this designation will be taken as designation of a European Patent.

The US designation is only valid if the applicant is the inventor Art 27(3) PCT

The other designations should be valid.

Question 7

According to Article 55(2) EPC, display at any exhibition should be stated on filing, and a certificate filed within 4 months (Rule 23 EPC).

Neither of these have been done, and we want additional states, so file either a new EP Application and a US Application, or a PCT designating EP (all states) and the U.S.

It is not clear from Art. 55 EPC whether the six month period runs before the filing or priority date.

To be safe, assume filing date and file the new applications before 01 April 1996 (Monday). Priority should be claimed from the original EP application, particularly if any disclosures have occurred after filing.

The Exhibition must be mentioned on filing the EP or PCT Application (A 55(2) EPC and the certificated filed (A 55(2) EPC or Rule 104b(1)(f) EPC and Rule 51^{bis} PCT).

In the US there is a 1 year grace period so the disclosure is not a problem.

Question 8

a) Rule 2(I) EPC first sentence

A party to oral proceedings may use another official EPO language if he gives one month's notice.

It is then the responsibility of the EPO to arrange for translation (Guidelines EV1)

- So by 18 May 1996 (Saturday)
extended under R 85(I) EPC to May 20 1996 Monday, give notification to EPO that English will be used.

b) Rule 2(I) EPC second sentence

- any party may likewise use any language of a contracting state, but then must make provision himself for translation into the language of the proceedings.

Question 9

DE 1 - Feature A - 28 Oct 93

DE 2 - Feature A plus Feature B - 28 Sept 94

Published 95 May 08

EP - feature A plus feature B - 27 Sept 95

a) Art 4 Paris Convention

+ Art 87(I) EPC - to claim priority validly, the EP Appn must be filed within 12 months of the date of the first application disclosing a particular feature.

For feature A, the first Application was filed on 28 Oct 1993 the European application was filed too late and cannot claim priority for feature A.

However, feature B was first disclosed in an application filed on 28 Sept 1994 therefore EP claims priority validly for feature B.

b) No for feature A.

It is too late to file a priority claiming application for feature A.

Since feature A has been published, no valid patent can be obtained.

For feature B a European Patent could be obtained since priority is validly claimed, since before the disclosure.

- c) No. A 87(4) EPC - In order for DE 2 to be treated as the first application, DE 1 would have had to have been abandoned without claiming priority. However DE 2 claimed priority from DE 1.

Question 10

Filing date = 31 Aug 88 no priority
Granted - 5 July 1995

Filed Aug 31 88
Grant published July 05 1995

Renewal fee due Aug 31 1995

If the document was published in 1986 and clearly anticipated the subject matter of the patent (all claims) the patent is invalid for all states (Art 52(1) EPC and Article 54(1)&(2) or Art. 56 EPC)

To get the royalties back, the patent must be invalidated or not brought into force. It is not made clear whether the patent was brought into force in all the designated states by complying with the National Requirements according to Art 65(1)&(2) EPC. Deadline expired 1995 October 05 (Tuesday).

This should be checked by inspecting national registers.

If the patent was brought into force in at least some of the countries, it should not simply be allowed to lapse by non payment of renewals, as then it will not have been "invalidated" and back royalties will not be repaid.

Therefore, if it is financially worthwhile an opposition could be filed so as to obtain invalidation of all the national patents in one procedure. An opposition may be filed even if the patent has lapsed for all the designated states (Art 99(3) EPC).

The deadline for filing opposition expires on 5th April 1996 Friday, extended under A 85(1) to 9th April 1996 (5th April is Good Friday, Saturday, Sunday, 8th April = Easter Monday)

Therefore contact company A saying that unless they repay the royalties, company B will oppose the patent.

Depending on their reply, the patent could be opposed, revoked, and the royalties recovered (or A sued for breach of contract).

Question 11

Art 86(I) EPC Renewal Fees are due for the third year calculated from the filing date. Rule 37(1) EPC - the fees are due on the last day of the month.

3rd years renewal fee is due 31 March 1995 Friday

4th years renewal fee is due 31 March 1996 (Saturday)

This is extended under R 85(I) to 1st April 1996 (Monday)

(ii) Last day for payment without fine = 1st April 1996 (Monday)

(iii) Art. 86(2) - six month grace period with additional fee (10 % RRF 2-5)

According to J 4/91 the 6 month grace period also extends to the end of the month, and it is not an aggregate time limit.

therefore final date = 30 Sept 1996 Monday.

b) A 86(4) obligation to pay renewal fees terminates in respect of grant year. This was not yet granted when the 4th Years fee was payable $\therefore$ the fees should be paid to the EPO.