

Examiners' Report on Paper D/1997

An amazing number of candidates failed to read questions properly or completely and, as a result, many marks were lost unnecessarily. The message has once again to be, ***READ CAREFULLY BEFORE WRITING***. If there is any doubt on the part of candidates, we should make it clear that we do not give any marks at all for an essay, however brilliant, on an unasked topic. Therefore, if you do not know the answer to a question, deliberately writing something on a topic you know is no better than saying nothing; in fact, it is worse because you lose time as well as marks.

Many candidates were also again using out-of-date reference books – including old versions of the EPC.

Candidates should understand Rule 69 and the differences between requesting a decision, filing an appeal, further processing and restitutio in integrum. Many made no choice and gave them as alternatives and others always chose inappropriately or suggested only one course, such as appeal, as a solution for every problem.

As a further general point, far too many candidates overlooked the date on which they were taking the exam or the dates given in the question. If the question does not specifically take the candidate to an earlier date, the candidate should relate the dates in the question to the date of the exam, i.e. when the question refers to today, it means the exam date.

Candidates should know that the ten days rule applies at the beginning and not at the end of a term.

It was pleasing that this year candidates generally performed better on Part II and for the first time for many years, or ever, there were a large number of candidates who performed better at answering Part II than they did Part I.

Part I

Particularly in this part, candidates are expected to give the legal basis for their answers. For this reason, a simple yes or no answer without reasons is unlikely to attract any points. Candidates who cite the relevant law without explaining how it fits the facts of the question, to give an answer to the problem, also fail to gain full points.

- Q.1. This caused few problems for candidates.
- Q.2. Many missed answering parts of this question, e.g. failed to specify the languages of the translations. Also, a significant number were obviously using an old version of the EPO's publication National Law Relating to the EPC (which they cited) and gave the wrong old date for filing in CH/LI.
- Q.3. This was answered well by many but a significant number displayed confusion over the use of multiple applicants in the PCT and thought that they were required as applicants for all designated states, so that, they decided, the US could not be designated. Very few realised or mentioned that an assignment of rights would be necessary for the French company to file in France.
- Q.4. Well answered by many although a lot overlooked using the examples to support the wide scope by submitting them as evidence of allowability of the claims. What was disturbing was the large number that overlooked the Art. 123 danger in their suggested procedure of abdicating their responsibility and simply submitting the amendments to see whether or not they would be accepted by the examiner.
- Q.5. Many candidates confused requesting a decision under Rule 69 with filing an appeal, overlooking the statement that the application was refused, i.e. an appealable decision had already been given. Even worse was the larger number who simply answered that, as a result of publication of the application, there was no possibility of obtaining any protection for the circuit.
- Q.6. Candidates either knew Art. 124 or they did not. If they did not, many assumed incorrectly that the question related to the filing of copies of priority documents. Many who correctly answered part (a) did not know of Art 140 for part (b) and those who gave simple yes or no answers could rarely be given any marks.
- Q.7. Again this year there was major confusion between filing an appeal and a request for further processing. If an Art. 96(2) term is missed, a request for further processing is the required procedure and there is no appealable decision. Requesting a decision under Rule 69(2) is totally inapplicable. Many candidates were also completely confused between further processing and restitutio in integrum. With regard to part (b) the latter was proposed by some because they

looked only at the maximum one year term and ignored the initial two month term of Art. 122. Also they were not at all clear as to what term was to be reinstated, i.e. the term for requesting further processing.

- Q.8. It was astonishing how many candidates knew of Rule 50(1) but not of Rule 50(2) and as a result gave the wrong answer. Even more candidates knew neither clause (1) nor (2) of Rule 50.
- Q.9. Many candidates used the ten day rule for receipt, which does not apply under the PCT. Most were aware of precautionary designations but not that specific designations do not fall under precautionary designations (Rule 4.9(b)PCT).
- Q.10. Part (a) was well answered but part (b) surprisingly badly. For part (b), many overlooked the simple application for a two months extension under Rule 51(4). They also ignored missing the deadlines and applying for further processing at each stage although some suggested it for one stage only.

EXAMINATION COMMITTEE III

Candidate No.

Paper D Schedule of marks

Question	Maximum Possible	Marks awarded		Revision of mark/grade (if any)		Marking by further examiners	
		Exr	Exr	Exr	Exr	Exr	Exr

PART I

1	2.5						
2	6						
3	6						
4	5						
5	4						
6	2.5						
7	5						
8	3						
9	5						
10	6						
Total Part I		45					

PART II

A1	6						
A2	16						
B	14						
C	10						
C'	9						
Total Part II		55					

Translation of marks into grades

%	Grade
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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

Total Parts I + II	100						
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Corresponding Grade							
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Remarks (if any)

Grade recommended to Board

Munich, 4 September 1997

I. Muir - Chairman of Committee III

Model Solution

Part I

Answer to Question 1

Notice of opposition must be filed within nine months from the publication of the mention of the grant of the European Patent (Article 99(1) EPC). Therefore the opposition period ends on 8 October 1997. It is confirmed in T438/87 that the actual date of publication of the specification is not relevant. The public has access to the text of the patent by requesting inspection of files (Art. 128(4) EPC) anyway.

Answer to Question 2

- (a) Fees to be paid: granting and printing fee for up to 35 pages [DM 1.400,--]
Renewal fee for 5th year [DM 850] (Rule 51(6) and (9) EPC, Article 2, items 4 and 8.1 RFees).

Time limit for the fees: the communication is deemed received on 13 March 1997 (Rule 78(3) EPC). The time limit for a Rule 51(6) EPC communication is set by the examining division between two and three months; normally it is three months (see GL, C-VI 15.2). Thus the due date for paying the grant and printing fee is 13 June 1997. Regarding the due date for the 5th annual fee, 31 May 1997 is calculated using Rule 37(1) EPC. Since this day is a Saturday, the actual due date is extended to 2 June 1997 (Rule 85(1) EPC).

- (b) Translations of the claim into French and German have to be filed within the same time limit as mentioned under (a) for the granting and printing fees: 13 June 1997 (Rule 51(6) EPC).
- (c) Within three months from the mention of the grant of the patent (here 23 January 1998), translations of the patent have to be filed in the official languages of the designated states. No translation of the specification is necessary for LU (Art. 65(1) EPC).
DE translation into German.
CH/LI translation into German, French or Italian.

Answer to Question 3

- (a) Yes. Any resident or national of a PCT contracting state may file (Art. 9 PCT). Since Taiwan is not a member of the PCT, the client could not file a PCT application alone. PCT, however, allows for multiple applicants, with different applicants being specified for different states. In this case, the right to apply exists whenever at least one applicant is entitled (Rule 18.3 PCT). France cannot be designated alone in a PCT application but only via EP. Hence file PCT designating US and EP (all members of EU are members of EPC) naming client as applicant for

all states except France and naming French company as applicant for French EP designation.

- (b) GB filing is the first filing in a Paris Convention state. TW is not a member of the Paris Convention. Thus, the TW application does not count as an earlier application in the meaning of Article 8(1) PCT and Article 4A(1) Paris Convention. The client can thus claim priority of the GB application under Art. 8(1) PCT. An assignment of the priority right for FR is however necessary.
- (c) There are no provisions under the PCT for recording licences.

Answer to Question 4

- (a) You cannot add these examples to the European application as requested by the client. This would be an amendment of the application, which would only be taken into account after receipt of the search report (Rule 86(1) EPC). Any amendment is subject to the requirements of Art. 123(2) EPC (see also GL, C-VI, 5.7 on the way to deal with the introduction of further examples). You cannot drop the priority of P1 because this was the first application for the broad scope of the claims and such a broad scope would then only be entitled to the date of filing the European application. Since the European application was filed after the date of publication of the paper, lack of novelty would result for at least the broad claims.
- (b) The new examples can be used to support the wide scope by submitting them as evidence to the examiner of the allowability of the claims (GL, C-VI, 5.7a). One could also consider filing an application for the new examples claiming them in their own right as a selection invention.

Answer to Question 5

The priority term has already expired. Moreover, the application has already been published (Article 93(1) EPC) and, therefore, its content has become part of the state of the art (Article 54(2) EPC). Consequently, the filing of a new application will not result in a valid patent.

Filing an appeal, however, is still possible, since the time limit for filing an appeal has not yet expired (Article 108 EPC). Nevertheless, in the appeal procedure, the filing of a new set of claims directed to the circuit would not be accepted in view of Rule 86(4) EPC (see also GL, C-VI, 5.2(ii)). The suspensive effect of an appeal, however, allows the filing of a divisional application directed to the circuit (Art. 106(1) EPC, see also GL, A-IV, 1.1.3).

Thus, the answer is yes: file an appeal on the earlier application to allow for filing a divisional application.

Answer to Question 6

- (a) Yes, if applicant fails to reply within the time limit set in the invitation, the application shall be deemed to be withdrawn (Article 124 EPC).
- (b)
 - (i) Yes (Article 140 EPC)
 - (ii) Yes (Article 124 EPC)
 - (iii) No (Article 140 EPC).

Answer to Question 7

The Rule 69(1) communication of 30 August 1996 was deemed notified on 9 September 1996 (Rule 78(3) EPC).

Further processing is available under Article 121(1) EPC within two months after the communication under Rule 69(1) was deemed notified (Article 121(2) EPC). In this case the term ends on 9 November 1996 (a Saturday), which is extended to 11 November 1996 (Rule 85(1) EPC).

- (a) In time for further processing. Thus apply for further processing, pay the fee, and file the reply.
- (b) Too late for further processing.
It is in principle possible to apply for restitutio in integrum (Article 122 EPC) for the term for further processing, since Article 122(5) EPC does not exclude term of Art. 121(2) EPC (see J 12/92 (unpublished), J ..87 (OJ/1988, 323, points 2.3 and 2.4)). In order for Article 122 EPC to apply, the applicant has to show that the time limits were not met "in spite of all due care" of the applicant, i.e. the delay was caused by unforeseeable factors (Article 122(1) EPC).

Answer to Question 8

No. The legal basis is Rule 50(2), 1st sentence, EPC [see also J 12/84 (OJ EPO 1985, 108, point 4 of the grounds and J ..87 (OJ EPO 1988, 177, point 4 of the grounds)]: The applicant may not invoke the omission of the communication provided for in Rule 50(1) EPC. The time limit for the filing of the request for examination began to run in accordance with Art. 94(2) EPC. Since the applicant failed to pay the examination fee within the time limit the surcharge fell due (Rule 85b EPC).

Answer to Question 9

The PCT Request Form contains a pre-crossed box for precautionary designations.

The time limit for confirmation of precautionary designations is 15 months from the priority date (Rule 4.9(b) PCT). In the present case it is on 8 May 1997 (holiday) which is extended to 9 May 1997. Thus, in the case of CA, PL, and RU, the confirmation of precautionary designations at receiving Office, paying designation fees and confirmation fees (50% of designation fees, see Schedule of Fees) can be carried out until the above time limit.

US and KR cannot be designated any longer because they were designated as specific designations. Specific designations do not fall under precautionary designations (Rule 4.9(b) PCT). The due date for paying for US and KR with surcharge was 28 March 1997 (holiday) extended to 1 April 1997. This date is past. If the PCT application has not yet been published (publication date will normally be around 8 June 1997) and if no other damaging publications have occurred, applications for US and KR may still be possible.

Answer to Question 10

Application A - Approve text and file translation of claims and pay grant and printing fees and any renewal fees as soon as possible requesting accelerated grant under Art. 97(6) EPC. Under the PACE programme, prompt grant (within three months) is possible.

Application B

Action	Time
Rule 51(4) notice sets due date for approval of text	4 months
Request extension of time before expiry of 4 month term	2 months obtainable but no further (last sentence of Rule 51(4)).
Do not approve text - application refused (Rule 51(5))	communication of refusal normally takes some time to issue.
Within two months of communication of refusal request further processing (Art. 121) paying the fee and approving the text	2 months
Rule 51(6) communication is issued setting anon-extendable term to file translations of claims and pay grant and printing fees	3 months
Do not pay fees or file translations - application deemed withdrawn	communication of deemed withdrawal may take some time to issue.
Within two months of communication of deemed withdrawal request further processing (Art. 121) paying the fee for further processing, the grant and printing fees, and filing the claims translations.	2 months
Depending on dates it may be possible to defer grant by delaying payment of renewal fees.	
Grant	Grant may take some time after filing of translation with over a year from Rule 51(4) notice being possible.