

Candidate's Answer Paper

Question 1

The opposition period ends on: 8 October 1997.

According to Art 99(1) EPC, opposition may be filed within 9 months of publication of the mention of the grant of the patent. The date of the publication of the patent itself does not affect this period (see decision T438/87). The relevant starting date is therefore 8 Jan 97.

Under Rule 83(4), periods expressed in months expire on the day in the relevant subsequent month having the same number as the starting day.

∴ Nine months from publication of mention is 8 Oct 97.

Question 2

- (a) According to R51(6) EPC the grant and printing fees must be paid. Under Article 2.8 RFees this is a single fee of 1400 DM, with no surcharge because the application contains only 35 pages.

No claims fees are due - only due for claims above 10 (Rule 51(7) EPC).

These fees are due within the time limit set in the R51(6) communication, ie between 2 and 3 mths. Normally it is 3 mths.

If 3 mths; R51(6) communication deemed received on 13 Mar 97, by R78(3) EPC. 3 mths from then is 13 Jun 97, by R83(4).

∴ Fees due by 13 Jun 97.

The time limit is non extendable (R51(6)).

The renewal fee for the 5th year is due at the end of the month containing the 4th anniversary (3 May 97), ie 31 May 97 (R37(1)). Can be paid until 2 Jun 97 (Monday) ∵ 31 May 97 is a Saturday. Under R51(9) the fee must be paid before grant can take place.

- (b) Claim translation is due within the same period, by R51(6). ∴ also due by 13 Jun 97.

- (c) LU: Does not require a translation of the specification under Art 65(1).

DE: Translation into German under Art 65(1) due 3 months from publication of mention of grant (Art II §3(1) LIPC German law), ie by 23 January 1998.

CH/LI: Translation into German, French or Italian under Art 65(1) due 3 mths from publication of mention of grant (CH/LI law), ie by 23 January 1998.

Only one translation required for joint designation of CH and LI.

Question 3.

- (a) Yes.

To file a PCT application, only one applicant needs to be national or resident of a PCT contracting state (R18.3 PCT). The Taiwanese inventor is not entitled (Taiwan is not a PCT member state), but the French company is (France is a PCT member state).

By Section 203 (a) PCT Administrative Instructions, different applicants may be named for different designated states.

However, it is not possible to designate FR as a national application but only as a Euro-PCT designation, under Art 45(2) PCT.

The EPC allows, under Art 59 EPC, different applicants to designate different contracting states. ∴ The FR company can be applicant for EP(FR) and the Taiwanese inventor for all other EP states.

- (b) PCT priority is determined under the Paris Convention, Art 8(1) and (2) PCT.

Under Paris Convention Art 4A(1) and (4), the first application in a Paris Convention country is the relevant one for priority. The Taiwanese application was not in a Paris Convention country (TW is not a member) so the GB application is the relevant first application and priority can validly be claimed.

However, some countries (eg DE, BE) do not recognise priority rights for applications filed by applicants not resident or national of a Paris Convention country, but the EPO does. There is a risk that the eventual national patents in some countries will be held to be not entitled to priority by the national courts.

We are still within the priority year under Art 4C(1), so can claim from 1 May 1996 application.

- (c) The PCT contains no provisions for registration of licences. This must be done with the national or regional offices on entry to the national or regional phase, if possible with those offices.

Question 4.

- (a) It will not be possible to add the examples to the application, because this would contravene Art 123(2) EPC, as confirmed by Guidelines C-VI, 5.7.

Dropping the priority P1 is anyway not advisable. This would mean paper reproducing contents of P1 would become prior art under Art 54(2) and would destroy novelty of the claims.

- (b) I can however submit the examples to the EPO during examination. I shall do this after receipt of the Search Report and before examination begins, asking that they be taken into account. This is usually permitted, see Guidelines C-VI, 5.7a, in particular since the examples support an advantage (effect already discussed in the application).

Question 5.

It will be possible to file a divisional application under Art 76 directed to the circuit.

To file, the parent must be pending, ie not finally refused. We must therefore file an appeal against the refusal of the parent, which has suspensive effect (Art 106(1) EPC). Due 2 mth from notification of refusal, grounds 4 mth from notification of refusal (Art 108). As confirmed by Guidelines A-IV, 1.1.3, divisional can be filed during appeal proceedings.

It appears that the requirements of Art 76(1) are met that the divisional application will not contain subject-matter not described in the parent (in figures and description of parent).

Fees to be paid: Renewal fees for 3rd and 4th yrs, due on filing divisional and payable within 4 mths of filing it (all under R37(3)). Filing, search and designation fees: all due one mth from filing divisional - R25(2).

Cannot simply appeal refusal of parent and introduce claims to circuit, because it has not been searched. R86(4) forbids introduction of claims which relate to unsearched subject matter and do not form part of the same invention as the claims which do relate to searched subject matter.

Question 6.

- (a) There is no obligation to reply to such a communication. The EPO must find any relevant published prior art or copending EP applications relevant under Art 54(3) EPC. Copending national rights are not relevant as prior art under the EPC.

The EPO may be interested for priority purposes, to check that any priority application was the first for the relevant subject matter (Art 87(1) and (4) EPC).

There should not be any adverse consequences unless the EPO has good reason to believe the priority application was not the first filing, in which case lack of proof that it is may lead to loss of priority right (C-V, 1.4a).

- (b) If for priority purposes, useful to include (iii) since utility models and certificates count as applications from which priority maybe claimed under Art 87(1). OA is an office acting for various Paris Convention states, ∴ a filing there is relevant under Art 87(1). Similarly, AU is a Paris Convention country, as is ES, so (i) and (ii) could usefully be included.

Question 7.

Time limit has been set by EPO, ∴ further processing under Art 121(1) available.

Request for further processing due 2 mth from notification of loss of rights. R69(1) communication noting loss of rights deemed received on 9 Sep 96, under R78(3). Therefore time limit expires on 9 Nov 96 (2 mth calculated according to R83(4) EPC). This is a Saturday, ∴ time limit extended to Monday 11 Nov 96 under R85(1).

- (a) Can request further processing $\therefore$ within time limit. Must pay fee within time limit (Art 121(2) EPC) and complete omitted act (Art 121(2) EPC), ie file response to examination report.
- (b) On 13 Nov 96, time limit has expired, so option (a) is not available. Could try for restitutio under Art 122 (possible in principle according to J12/92). This requires showing that the applicant took "all due care" to meet the time limit missed (in this case, the time limit for further processing). It is unlikely that we can show this, given that the applicant sent instructions so close to the due date (see for instance T30/90), and had deliberately chosen to abandon the case earlier.
If we try this, need to do so within 2 mths of removal of cause of non-compliance (in this case, probably my receipt of information that applicant has changed his mind, see for instance J 7/82) and 1 yr from missed time limit (due date for further processing - 11 Nov 96), both under Art 122(2).

Also, renewal fees may have fallen due - need to pay these if still within period for doing so.

Question 8.

According to Rule 50(1) EPC, the EPO informs the applicant of the date of mention of publication of the search report, but under R50(2) the applicant may not invoke the omission of this communication.

$\therefore$ The EPO will not refund the surcharge.

Question 9

For the countries specifically designated (KR and US), the fees can be paid with surcharge (R16bis. 2 PCT) within one month of the EPO communication, by R16bis. 1 PCT. The surcharge is 50% of the designation fees to be paid (but is not less than the transmittal fee [R16bis. 2(a)(ii)] or more than the basic fee, R16bis. 2(b)). This is all due by 1 Apr 97. Under R80.6(a) PCT time limits begin on date of mailing. Under R80.2 PCT time limit ends on 28 Mar 97. Under R80.5 PCT it is extended to next EPO working day, i.e. 1 Apr 97. $\therefore$ On 4 Apr 97 we are too late.

For those not specifically designated, ie CA, PL and RU, the precautionary designation system can be used. All were members of the PCT on the date of filing. The standard PCT Request form PCT/RO/101 contains a declaration under R4.9(b)(ii) that all states party to the PCT are designated subject to confirmation. Confirmation is due 15 mth from priority, ie by 8 May 97.

Under R4.9(b)(ii) precautionary designations do not apply to specifically designated countries, so we cannot apply this procedure to KR and US. Could perhaps try asking for some sort of restitution in those countries under Rule 82bis PCT.

Question 10.

- A: Approve text attached to R51(4) communication immediately. R51(6) communication will be sent out immediately (Guidelines C-VI, 4.9).
Pay grant and printing fees and file claims translations immediately. Under new Art 97(6) we can request that grant take place earlier than the normal five mth period specified in Art 97(5).
∴ Do this, make sure any renewal fees due already or due very soon are paid.
Patent could be granted within about 2 or 3 months if we carry out our acts quickly.
- B. Request extension for replying to R 51(4) communication. This is allowed once, up to a total of 6 mth (see R 51(4). Reasons are not needed - C-VI, 15.1.
Then use full 3 mth (normal period) under R 51(6) for filing claims translations and paying grant and printing fees. Period is non-extendable.
If any renewal fees are due and required to be paid under R 51(9), use full 6 mth grace period for payment.
If none are due, reply to 51(6) is likely to be in about 10 mths and grant cannot be earlier than 5 mths from R 51(6) communication, under Art 97(5). ∴ Likely to be granted in about 1 yr.