

Examiners' Report on Paper D

General

It is necessary to repeat, what is said almost every year, that candidates should use up-to-date text books and revision material. It was clear from candidates' papers that many were using old copies of the EPC and did not have access to, or read, the EPO Official Journals covering the most recent years and, in particular, the year preceding that in which the examination was held. Thus, a surprising number were, for example, unaware of the changes to the period for payment of designation fees.

In other cases only a small number of the questions were answered very accurately, giving the impression that the answers had been prepared wholly by reference to the books during the exam. Whilst answers to Part I can be obtained in this way, a candidate is unlikely to have sufficient time to look everything up and should be familiar enough with the EPC and PCT to need only some confirmatory checks in the books. Even then, it is necessary to be familiar enough with the texts so as to know quickly where to look since candidates must give reasons for or the basis for their answers.

Again there were candidates who missed out parts of questions, apparently carelessly or inadvertently. Candidates should read the questions carefully and deal with all the specific points they are asked to address. Also, they should accept what they are told are the facts of a situation and not spend time and effort surmising that these facts may be incorrect. Despite being told that US-MAG had no details of room temperature superconductors some candidates spent a great deal of effort discussing what could be done if somewhere in the specification there was such information.

It has been reported that some candidates were surprised at the number of PCT questions. They should really be prepared for this, especially now that more than 50% of European applications are filed by the PCT route.

As a final general remark, candidates should remember the need to give the basis for any answer. A simple yes or no is hardly ever likely to be an adequate treatment of the subject.

Part I

- Q. 1 Most candidates were able to deal with this question adequately. However, the test to find out if candidates knew that the ten days for receipt is added at the beginning, to set the start of the term, was failed by a significant number.
- Q. 2 The lack of knowledge of the designation fee change and of the transitional provisions was mentioned above. Candidates, as always, were expected to give the basis for their answers and, for this, it was necessary to mention the transitional provisions under which the new rule applied to those applications for which even some designation fees had not been paid but for which, on 1 July 1997, there was still time for payment under the old rules. Many did not mention this provision or, if they did, were unable to apply it correctly.
- Q. 3 (a) & (b) were generally answered correctly. The main fault was the assumption that the EPC provisions applied also to the PCT, without change.

Most candidates missed some of the possibilities in (c) & (d) with many ruling out any refunds at all or missing the difference between the cases of Art. 10b (a) and Art. 10b (b) RRF.

- Q. 4 Many candidates assume incorrectly that the EPC provisions apply with the same effect in the international phase and the regional phase, if the EPO is the Receiving office. Also, many assumed that filing an English translation on entry to the regional phase would change the language of the proceedings.
- Q. 5 Generally, reasonably well handled although a lot missed out the possible protest fee requirement of R. 40.2e for the part (b) answer.
- Q. 6 Parts (a) & (b) were in the majority of cases correctly handled but quite a number overlooked that the re-establishment proceedings are solely a matter between the proprietor and the EPO. "Yes" and "No" answers without adequate basis were rarely awarded marks.

On the other hand for part (c), very many concentrated on the due care requirements of Art 122 without considering that for this to be available the direct consequence of the failure to comply with the time limit has to be refusal, deemed withdrawal, revocation or the loss of other right or means of redress, Art. 122(1) EPC (GL E-VIII, 2.2.6).

Similarly, for part (d) many overlooked that Art. 121 only applies to European Patent applications.

- Q. 7 Too many candidates assumed that all the EPC provisions are available in the PCT international phase. Further processing and restitutio are not available and the international application cannot be revived. Those who recognised this also, mostly, knew the detailed requirements for entry into the regional phase using Art. 25(1)(b) and that the time limits ran from the date of the declaration by the Receiving Office. A number assumed that the EPO ten day rule applied. Others forgot that further

processing should be requested and that the same time limit applies as for the Art. 25 PCT request.

- Q. 8 Most knew Articles 22 and 112 and produced correct answers. A large number, however, overlooked answering the question as regards which utterance was binding.
- Q. 9 Generally well answered, although quite a number had the usual difficulty with simple arithmetic. In some cases, candidates set out the basis for the answer but applied it wrongly.

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

PART II

A	12.5						
B	17						
C	10						
D	9.5						
E	6						
Total Part II		55					

Translation of marks into grades

% Grade

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, 10 September 1998

*J. L. Muir***J. Muir - Chairman of Examination Committee III**

Model Solution for Paper D

Part I

Answer to Question 1

- (a) The communication was sent by registered letter. Consequently, Rule 78(3) EPC applies and the communication is deemed received on 3 March 1997. In accordance with Rule 83(4) EPC, the time limit expires 3 May 1997. Since this is a Saturday and since Monday, 5 May 1997 is a day on which the filing office of the EPO in The Hague is closed, the time limit is extended until Tuesday, 6 May 1997, in accordance with Rule 85(1) EPC.

Hence, in accordance with Rule 84 EPC, the last day for requesting an extension is Tuesday, 6 May 1997.

- (b) The extended time limit of four months is to be calculated from the start of the original period (Guidelines E-VIII 1.6).

The last day for replying to the communication is therefore Thursday, 3 July 1997.

Answer to Question 2

All states were covered by the precautionary designation in Form 1001. Hence, options are kept open for validly designating contracting states other than DE, FR, GB and IT until the time limit for payment of the corresponding designation fees expires.

New Art. 79(2) EPC applies to applications for which the basic period under old Art. 79(2) EPC had not expired on 1 July 1997, i.e. the date of entry into force of new Art. 79(2) EPC (see Art. 2 of the Decision of the Administrative Council of 5 December 1996, OJ 1997, 13 and Notice of the EPO, OJ 1997, 215, point 10).

Under the old Article 79(2) EPC, the due date for paying designation fees would have been 27 July 1997, extended to 28 July 1997. Hence, in this case, the amended version applies and the designation fees are payable up to six months from publication of the search report.

Publication of the application (with or without search report) would have been on or shortly after 28 December 1997, in accordance with Art. 93(1) EPC. Therefore, unless an early publication had been requested, the due date is not earlier than 28 June 1998.

Hence, it is possible to validly pay the fees for ES, NL and SE.

Answer to Question 3

- (a) The application is not published if it has been withdrawn before the termination of the technical preparations for publication (Rule 48(2) EPC). Preparations for publication are deemed completed at end of the day that falls 7 weeks before the expiry of the 18 month period (Rule 48(1) EPC, Decision of the President of the EPO of 14.12.92, OJ EPO 1993, 55, Guidelines A-VI 1.2). Hence, a withdrawal of the application by that day will ensure that the application will not be published.

The EPO will accept a conditional withdrawal if the applicant makes the withdrawal subject to the proviso that the content of the application is not made known to the public (Guidelines A-VI 1.2).

- (b) The international publication can be prevented provided notice of withdrawal reaches the International Bureau before technical preparations for publication are completed (Art. 21(5) and Rule 90bis.1(c) PCT).

Technical preparations are generally completed by the 15th day prior to the date of publication (PCT Applicant's Guide Vol. I, § 240), i.e. prior to the expiry of 18 month period (Art. 21(2)(a) PCT). Hence, a withdrawal of the application before that day will ensure that the application will not be published.

- (c) An "A2" publication indicates that the search report has probably not yet been drawn up (Guidelines B-IV, 1.4).

In accordance with Art. 10(4) RRF, the search fee shall be fully refunded if the application is withdrawn before the Office has begun to draw up the search report. If already paid, the examination fee will be fully refunded, since the Examining Division has not yet assumed responsibility (Art. 10b(a) RRF, Art. 18(1) and 16 EPC).

- (d) The Examining Division has assumed responsibility for the application as soon as valid request for examination has been made (Art. 16 and 18(1) EPC). Hence, Art. 10b(b) RRF applies in this case and a refund of 75% of the examination fee will be made provided substantive examination has not yet begun.

Answer to Question 4

In the international phase:

Since the international application was filed in German, in the international phase, amendments must be in German (Rule 12.2 PCT, wherein Rules 46.3, 55.3 and 66.9 PCT do not apply, since the application was published in German (Rule 48.3 PCT)). Letters sent to the IPEA may, however, be in English, as follows from Rule 92.2(b) PCT. There are no provisions under the PCT which would permit a change of the language of the application.

In the regional phase before the EPO:

In written proceedings, English may be used (Rule 1(1), Art.14(1) EPC). However, amendments must be filed in the language of proceedings (Rule 1(2) EPC), which, as follows from Art. 150(3) and 14(3) EPC, is German.

There are no provisions under the EPC which would permit a change of the language of the proceedings.

Answer to Question 5

- (a) Four additional search fees should be paid to the ISA by the expiry of the time limit set in the communication sent with the partial search report (Art. 17(3)(a) PCT,

Rule 40.2(a) and 40.3 PCT).

- (b) The finding of lack of unity can be challenged by paying the additional search fees under protest and filing a reasoned statement. The protest will be reviewed by a three member Board (Rule 40.2(c) PCT).

A protest fee may be called for after the review, as follows from Rule 40.2e PCT. The protest fee should then be paid within one month from the date of the notification, in order to have the protest referred to a Board of Appeal for a final decision (Rule 104a(3) EPC).

- (c) The Search Division will proceed according to Rule 104b(4) EPC.
- (d) There are no provisions under the PCT which permit the filing of a divisional application in the international phase (see also Art. 34(3) PCT and the PCT Applicant's Guide, Vol. I, § 324). Hence a divisional application can be filed in the regional phase at the earliest.

Under the EPC, only a pending European patent application may be divided (Guidelines A-IV 1.1.3). An international application is deemed to be a pending European patent application when the EPO acts as designated or elected Office (Art. 150(3) EPC) and the fees required for entering the regional phase were paid (Rule 104c(1) EPC). Hence, before the EPO, a divisional application can be filed at the earliest after having entered the regional phase.

Answer to Question 6

- (a) Yes, see Guidelines, E-VIII, 2.2.6, since the request for re-establishment is concerned with a time limit connected with the opposition procedure.
- (b) No, since the opponent is not involved in the procedure for the re-establishment of rights of the proprietor, see Guidelines, E-VIII, 2.2.6.
- (c) The request for re-establishment will be rejected, because the non-observance of the time limit to file the observations does not have the direct consequence, by virtue of the EPC, of causing the refusal of a request or the revocation of the European patent or a loss of any other right or means of redress, as is required by Art. 122(1) EPC; see also Guidelines, E-VIII, 2.2.4.
- (d) No, Art. 121 EPC only applies to European patent applications.

Answer to Question 7

It is not possible to revive the international application; there are no provisions for revival under the PCT.

However, the designation EP can be saved by filing the request as mentioned in Art. 25(1)(a) PCT and by taking the necessary steps for entry into the regional phase (Art. 25(2)(a) PCT). These steps must be performed within a time limit of two months from

the date of the RO declaration, i.e. at the latest on 17.04.98, as follows from Art. 25(1)(c), Rule 51.1 and 51.3 PCT.

Since the refusal was not the result of an error on the part of the RO, as referred to in Art. 25(2)(a) PCT, in order to be sure that the application will be in good order before the EPO as a European application, a request for the delay to be excused should be filed at the EPO at the same time (Art. 24(2) and 48(2) PCT; PCT Applicant's Guide, Vol.II, par. 63, 65, 68, 69 and EP.23,24,25).

For that purpose, a request for further processing under Art. 121 EPC should be filed, since the time limit was set by the RO. The request for further processing must be filed along with the payment of a fee and the completion of omitted act (i.e. filing of B's signature on a copy of the request form). Since the RO declaration is deemed notified on the date of despatch, the time limit of Art. 121(2) EPC also ends on 17.04.1998.

Answer to Question 8

- (a) The Enlarged Board of Appeal issues a decision in case of points of law referred by Boards of Appeal (Art. 22(1)(a), Art. 112(1)(a) EPC);
- (b) It will issue an opinion in case of points of law referred by the President of the EPO under the conditions laid down in Art. 112 EPC (Art. 22(1)(b) EPC).
- (c) Yes, only decisions of the Enlarged Board of Appeal bind the Board of Appeal referring the question in respect of the appeal in question (Art. 112(3) EPC).

Answer to Question 9

- (a) Rule 37(1) EPC: filing date is 27.05.94, hence 31.05.1997 was the due date. Since 31.05.97 was a Saturday, the last day for validly paying the renewal fee for the fourth year without an additional fee was Monday, 02.06.97 (Rule 85(1) EPC). With an additional fee, following J4/91 (no aggregated time limits), the relevant date for the start of the 6 month time limit according to Art. 86(2) EPC is 31.05.1997. Hence, in accordance with Rule 83(4) EPC, the 6 month time limit expired on 30.11.1997 (Sunday). In accordance with Rule 85(1) EPC, payment with surcharge could have been done on 01.12.1997 at the latest.
- (b) No, see Art. 141(1): a Contracting State may only impose a renewal fee for the years which follow the year in which the mention of grant was published.
- (c) Since the mention of the grant will be published on 13.05.98, i.e. within the fourth year of the application, the renewal fee for the fifth year is not to be paid to the EPO but to the national offices (Art. 86(4) and 141(1) EPC).