

Candidate's Answer Paper

1. (a) The Communication was dated 21/2/97, and sent by registered letter, so by Rules 78 (I) & (3) EPC it will be deemed notified 10 days later i.e. 3/3/97.

The 2 month period is calculated from 3/3/97 by Rule 83(4) EPC so expires 3/5/97 - this is a Saturday (an excluded day) so the period is extended under Rule 85(1) EPC to the next day on which all filing offices of the EPO are open, which is Tuesday 6/5/97. (Monday 5/5/97 is a holiday in The Hague). According to Rule 84 EPC, last sentence a request for extension must be made before the expiry of the period, so the last day for requesting an extension was 6/5/97 (i.e the day the period expires).

- (b) If a 2 month extension was granted, the total period is now 4 months which is a unitary time limit, and is calculated from the date of notification by Rule 83(4) i.e. 3/7/97 + 4 months = 3/3/97 (which is a Thursday).

2. Form 1001 was used - so ES, NL and SE were precautionarily designated.

Under the old Art. 79(2) these designation fees would be due later at 12 m from priority or 1 m from filing i.e. 27/6/97 + 1 m → 27/7/97.

Art 79(2) was amended with effect from 1/7/97. Under the transitional provisions, (OJ EPO 1997, page 219) designation fees can be paid under the new system time limits (and at lower amount) provided: they had not already been paid, and could have still been validly paid after 1/7/97 under the old Art 79(2).

These conditions are met, so fees for ES, NL and SE can still be designated and the fees will be due within 6 months of mention of publication of the Search Report (which may not have happened yet and the earliest the search report would be published is 18 m from priority date plus the 6 m.
∴ applicant has at least 2 years from priority to designate states.

3. (a) Under Rule 48(2) EPC a European application shall not be published if it has been withdrawn before termination of the technical preparations for publication.
Rule 48(1) states that the President of the EPO shall determine when the technical preparations for publication have been completed. According to the notice in the EPOJ 1993 page 55, preparations are completed at the end of the day seven weeks before expiry of the 18th month from day of filing or priority if claimed.

Withdrawal on condition of non-publication will be accepted - Guidelines A-VI, 1-2,

- (b) Publication of a PCT application can be prevented if the withdrawal request reaches the International Bureau before completion of technical preps for publication which is the 15th day prior to the date of publication, and can be conditional. Rule 90 bis.1 (c) PCT.

- (c) The EPO will refund any fees that have been paid that are no longer due. As publication is an A2 - without search report,

- certainly examination fee 100% refund under Rules relating to fees 10b. (examining division will not have assumed responsibility yet - still being searched or about to be searched).
- search fee will be refunded under Rules Relating to fees 10(4) in full IF the office has not yet begun to draw up search report.

Filing, designation, extension fees are not refunded (if already paid) because they are only refunded if there is a particular reason for refund
Guidelines A-XI, 10 2.

- (d) If the Examining division have assumed responsibility (i.e. have received the application from the receiving section) which they will have as soon as examination is requested after issue of search report a 75 % refund of exam fee will be given under Rules Rel. Fees 10b(b) IF substantive examination has not begun.

- 4. Company Y files PCT app in German at EPO as receiving office. Demand for IPEA filed by Y. EPO is ISA & IPEA.

GB company X acquires Y.

- X want to use English, both in international & EP regional phase .

International application will be published in German - Rule 48.3 (a) PCT.

Demand for IPEA must have been filed in language of publication - Rule 55.1 PCT (i.e. German). Any amendments of letter before IPEA must be in language of the Demand (i.e. German) by Rule 66.9 PCT. ∴, in international phase X must use German.

- REGIONAL PHASE

Language of the proceedings will be German - Article 14(3) EPC. This cannot be changed (Rule 3 of EPC has been deleted).

However, in written proceedings any official EPO language can be used Rule 1 (1) EPC, but amendments must be filed in the language of the proceedings Rule 1 (2) EPC. Therefore X can write letters and so forth in English, but must file amendments to the specification in German.

- 5. (a) The ISA will invite the applicant to pay additional search fees Art 17(3), Rule 40.1 PCT. Time limit will be set by EPO as ISA usually 1 month from notification. (Rule 40.3 PCT).
 - (b) Extra search fees can be paid under protest with a protest fee and reasoned statement. PCT Rule 40.2 (c). Time limit is set Rule 40.3 PCT. In the present case one extra fee could be paid and 3 under protest.
 - If the ISA agree with the protest the extra disputed fees are refunded.
 - (c) Rule 104 b (4) EPC determines that in the EP Regional phase, the Search Division will search any unsearched claims of the international application if extra search fees are paid - on invitation in a term set by EPO of 2-6 weeks.
 - (d) A divisional application can be filed anytime after entry to the EP regional phase under the conditions of Article 76 EPC. There are no provisions in the PCT for divisionals.
- 6. (a) Usually each party is informed of submissions of the others during opposition under Art 101(2) EPC, and Rule 57(3) EPC.

The file is open for public inspection in any case.

- (b) Re-establishment proceedings should be ex parte proceedings, so I would not expect the opponent to be a party to them.
- (c) According to G 1/90 decision of the Enlarged Board of Appeal, reason 8, failure to observe a time limit for filing observations under Art 101(2) EPC does not lead to a loss of rights, so re-establishment under Art 122 EPC will not succeed.
 - The opposition division may reject the opposition even without the patentee's observations,

or they may appoint oral proceedings.

- so no loss of rights yet.

(d) Further processing under Art 121 EPC is NOT possible because it only applies to applications, not patents granted.

7. International application considered withdrawn 17/2/98. There is no appeal procedure under the PCT, however the application may be revived in the national phase, so this must now be commenced for EP & US under the provision of Art 25(1) PCT.

- A request must be submitted to the International Bureau within 2 months of the end of the Int. phase (Rule 51.1 PCT) i.e. 17/4/98 (a Friday) (no 10 day notification period) requesting that the IB transmit the files to each of the designated states (EP & US).

The requirements of Rule 104 b (1) EPC must be met before the EPO.

A review procedure will commence before each designated office

- because the refusal by the receiving office was correct, the applicant must request excusal for not meeting the time limit.

Under Art 48 (2) PCT and Rule 82^{bis} PCT contracting states of PCT can excuse missed time limits for reason admitted under national law [so the fate in the USA will depend on the law there]. In the EPO by Rule 82^{bis} PCT, further processing & restitutio in integrum are permitted.

According to the EPC, the signature of the inventor is not actually required, so there is nothing to put right - the PCT application must be treated as a normal European application.

Steps need to be taken under Rule 20 EPC to transfer the application from A to C.

Priority date 18/10/96 so we are now under 18 months from priority. Examination fee is not yet due to EPO.

1 National fee (basic + designation fees due N.B. new Art 79(2) does not apply RI04b states designation fees due on national phasing.

2 Application, if not in English, French or German, a translation must be filed.

3 Search fee due.

1, 2 & 3 must be done.

8 Enlarged Board of Appeal (EBA)

(a) A decision is issued by the EBA under Art. 112(1) (a) EPC if a question is referred to it by a Board of Appeal during proceedings on a case (either of its own motion or on request by a party).

(b) An opinion is given on a point of law referred to the EPA by the president of the EPO under Art 112(1) (b).

LEGAL EFFECT:

A decision [(a) above] is binding on the Board of Appeal that referred the question - Art 112 (3) EPC. An opinion [(b) above] is not binding on the boards of appeal, but is a persuasive authority which will

generally be followed.

- 9 (a) 4th year renewal fee is due according to Art 86 (1) and Rule 37 (1) EPC on the last day of the month containing the anniversary of the day of filing, and is due for the following year i.e. 4th year fee is due at end of 3rd year.
- Filing date = 27/5/94
+ 3 years = 27/5/97
end of month = 31/5/97 (Saturday)
by Rule 85(1) is extended to next working day
fee due = 2/6/97 (Monday).

Can be paid late under Art 86 (2) by 6 months, with addition fee 10% Art 2 of Rules relating to fees. 6 m period is not an aggregate time limit - it still expires at the end of a month (J4/91) i.e. 31/5/97 + 6m → 30/11/97 However this is a Sunday so period is extended by Rule 85(1) to

Monday 1/12/97.

- (b) NO. Art 141(1) EPC: Renewal fees may not be charged by Contracting state for year in which mention of grant is published, only for subsequent years (+ see Art 86(4) EPC for last year fee due to EPO).
- (c) Art 86 (4) EPC last renewal fee due to EPO is for year containing the publication of mention of grant. 4th year runs from 28/5/97 to 27/5/98 - Grant is published 13/5/98 which is in 4th year (it is irrelevant that fee is not due until end of month)

∴ 4th year is last year fee due to EPO.

5th year fees are due to Contracting states.