
Q1 Yes

By Rule 57a EPC, the description claims and drawings may be amended, provided that the amendments are accompanied by grounds for opposition (Listed in Art. 100(a)-(c) EPC) even if the respective ground has not been invoked by the opponent.

However, this right does not extend to simply tidying up the claims (T 127/85), nor to amendments accompanied by factors e.g. clarity which are not grounds for opposition.

Q2 Where a Demand for International Examination has been filed prior to 19 mths from the earliest priority date in line with Art. 31 PCT, Art. 22 PCT does not apply and in line with Art. 39(1)(a) PCT, the national phase must then be entered by 30 mths from the Earliest priority.

However, the EPO has made use of the provisions of Art. 39(1)b by extending this time limit to 31 mths from priority.

The Earliest priority date is 18/7/96

Rule 80 PCT

∴ 31 mths ⇒ 18/2/99 (Thursday).

- (a) By Rule 90bis.3.(a), the applicant may withdraw a priority claim at any time prior to the expiration of 30 mths from the priority date when Art. 39 applies.
Hence, the applicant cannot withdraw the priority claim since this date (18/1/99 = 30 mths) has elapsed.

Moreover, by Rule 90bis.3(d) even if the priority claim could be withdrawn, only time limits which have not already expired are recalculated hence the applicant could not meet the deadline anyway.

- (b) The 31mth deadline is 18/2/99. Since the client is a US citizen who I assume lives in the USA, he must be represented. By Legal Advice 18/92, a non-EP state resident may only take procedural steps before the EPO to enter the EPO regional phase before the 31 mth deadline, hence all steps to enter the regional phase now need to be taken by a representative (A133 EPC) (Me!)

To enter the EP regional phase, a translation of the International application is required by 31 mths (Rule 104b)(1a)). However, the International application is in English so this is not required.

The requisite fees may be paid late:-

National Fee = Basic fee, desig fee, claims fee.

Basic = Due within 1 mth from Rule 85a(1) Communication which will be sent directly to the US applicant and therefore Rule 78(2) applies in that there is no 10-day rule (this was changed on 1/1/99). There is a 50% late payment surcharge.

Designation fees - Rule 85a(1) Comm. ⇒ 1 mth + 50% surcharge

Search fee - Rule 85a(1) extrn. + 50% surcharge

Exam Fee - Rule 85b Comm. ⇒ 1 mth period of grace + 50% RFees 12(2)

It is very likely that the Rule 85a + b extn. periods are still running - Check!

If OK, I would pay all the necessary fees above with their surcharges. The EPO reg. phase will then be properly entered.

- Q3 (a)** By Art. 78(2) EPC, the filing and search fees are due on filing and may be paid within 1 mth after the filing of the application.

Also, if the application contains more than 10 claims by Rule 31(1) EPC each claim over and above 10 has a fee associated with it which must be paid by 1 mth from filing.

= 2/3/99 FD

R83(4)

1 mth

⇒ 2/4/99 - Good Friday

⇒ R85(1) - 6/4/99

- (b) If the filing or search fee is not paid, the EPO issues an invitation under Rule 85a EPC giving a period of grace of 1 mth within which to pay these fees with a 50% surcharge (RFees 2(3b)). Failure to meet this limit leads to the application being withdrawn by Art. 90(3) EPC.

There is no Art. 121 Further processing and Restitutio is excluded by Art. 122(5) confirmed by G3/91.

The excess claims fees may be paid with no surcharge within 1 mth from the Rule 31(1) EPC communication.

- (c) By Art. 4A(3)PC in conjunction with Art. 4A(2) Paris Convention, any filing equivalent to a regular national filing gives rise to a priority right, and a regular filing is one which is awarded a filing date whatever its subsequent fate.

By Art. 80 EPC, the payment of fees is not required to obtain a filing date and as is clear from the question the application was granted a filing date.

A European application awarded a filing date is, in the designated states, equivalent to a regular national filing (Art. 66 EPC) and it is considered regularly filed for that state and may give rise to a priority right.

- Q4** Art. 81 EPC indicates an EP patent shall designate the inventor and origin of rights to the invention of the applicant.

The Communication under Rule 42(1) requests that the designation of inventor be filed within the time limit prescribed in Art. 91(5) = 16 mths from filing or 2 mths from the notification.

The filing date is 11/10/97

Hence by Rule 83(4) EPC 16 mths ⇒ 11/2/99 (Thursday)

However, the Guidelines A-III 5.4 indicate that the deadline for filing the designation of inventor is the Art. 91(5) deadline or 2 mths from the Rule 42(1) EPC notification.

This notification is dated 10/12/98

by Rule 78(3) ⇒ 20/12/98 deemed received

2 mths

Rule 83(4) ⇒ 20/2/99. Saturday ⇒ Rule 85(1)22/2/99

The desig. of inventor was received by the EPO on 15/2/99 i.e. within the time limit.

∴ Request a decision under Rule 69(2) within 2 mths of the Rule 69(1) comm. i.e. 27/5/99. (Thurs)

Rule 69(1) dated 17/3/99 + 10 days

Rule 78(3) 27/3/99 + 2 mths

Rule 83(4) 27/5/99 (Thursday).

As a safety net may also simultaneously apply from Restitutio of the 16 mth deadline. If Rule 69(2) granted, restitutio fee will be reimbursed.

Q5 (a) No - Since no Opposition was filed, the patent is now a series of national patents. The EPO no longer has competence over the patent hence any assignments must be recorded at the national offices. Rule 61 only extends transfer of Patents during the Opposition period or proceedings, not thereafter.

(b) Yes - By Art. 71 EPC, an EP application may be transferred. By Art. 72 EPC, an assignment must be in writing and requires the signatures of all parties.

By Rule 20 EPC, in order to satisfy the EPO that a transfer has taken place you simply need written documents. Hence, I would write to the EPO requesting the recordal enclosing a copy of the assignment, and paying the admin. fee.

(c) Yes - Art. 71 EPC indicates that a European application may be transferred for one or more designated contracting states. Hence this transfer may be recorded in line with the provisions of Rule 20 EPC as above.

Note however that by Art. 118 EPC where applicants are not the same in respect of different contracting states, they shall be regarded as joint applicants. i.e. the unity of the application will not be affected.

(d) No - Licences cannot be recorded after the decision to grant since Rule 61 does not refer to Rule 21 - See J 17/91.

(e) Yes - Art. 73 EPC indicates that a European application may be licensed in whole or in part for the whole or part of the territories of the designated contracting states. Rule 21 EPC governs their recordal.

By Rule 21, licences may be recorded as for transfers (Rule 20)

- i.e.
- i) Require request in writing
 - ii) Evidenciary documents
 - iii) Pay fee

By Rule 22(1) and (2) exclusive or sub-licences may be recorded. Rule 92(1)w EPC confirms that these transfers are entered in the EPO register.

(f) Yes - Rule 21 EPC also allows recordal of a right in rem. Hence a security may also be recorded over a European patent application.

Q6 - If no demand filed - Nat Phase due at 21 mths (Art. 22(1) + (2) PCT).

(a) Fees

- 1) National Fee (Art. 158(2), Rule 104b(1)b)
which is
 - i) Basic fee Rule 104b(i)

- ii) Designation Fees i.e. Art. 79 does not apply
→ Rule 104b(ii)

- iii) Since only 8 claims - no excess claims fees.

- 2) Search Fee - Art. 157(2)(b), Rule 104b(1)c

Since USPTO drew up ISR get 20% reduction
∠ Art. 157(3b)

Exam fee not due yet.

- (b) Since Art. 31 PCT demand filed - Nat Phase due 31 mths (Art. 39(1) + (2) PCT)

- Fees 1) National Fee (Art. 158(2)) consisting of:

- i) Basic fee - Rule 104(1)b(i)
- ii) Designation fee - Rule 104(1)b(ii)
- iii) Claims fee (3 excess claims) Rule 104(1)b(iii)

- 2) Search fee not required since ISR must have been drawn up by EPO. US applicants can choose their IPEA and ISA since by Art. 16 PCT the US has included the EPO as ISA IPEA. However, the EPO can only be IPEA if it does the search.

Hence, there is no search fee to be paid.

- 3) Exam Fee: Rule 104(1d) Due at 31 mths. But by Rule 104(b)6, since EPO was IPEA get 50% reduction in exam fee (RFees 12(21)).
- 4) Renewal Fee for 3rd year due at 31 mths. Rule 104b(1e).

Q7 According to Art. 87(1) EPC, a person or his successor in title who has filed an application for a patent in or for a state party to the Paris Convention shall enjoy, for the purposes of filing an EP application in respect of the same invention, a right of priority during a period of 12 mths from the date of filing of the first application.

The 12 mth period elapsed on 14/7/98 which although is Bastille day in France is not a holiday in any of the EPO filing Offices. A holiday in a contracting state does not extend the priority date in line with Rule 85(1). Hence the 14/7/98 deadline is not extendable in any way. Thus, although filing by fax at the EPO is allowed (Dec. of Pres EPO J 1992, 299) and non-EP residents may take the steps necessary to establish a filing date without being represented, the fax sent to the secretary is too late.

However, by Art. 75 EPC, European applications may be filed at Nat. Offices in a contracting state and the FR patent office allows this. But, such an application is deemed received by the EPO on the date filed at the Nat. Office. So, cannot maintain priority by filing at FR Office a day late even though it was closed the previous day.

However, the priority could be maintained if the applicant filed a PCT in FR, adding the FR agent as a co-applicant to make the FR receiving Office competent (Art. 9 + Rule 19 PCT).

Q8 (a) Yes - Governed by provisions of PACE = OJ EPO 340, 1997.

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- (b) Once the EP patent has entered the regional phase it is treated like any other EP application. Art. 150(3) EPC and Art. 45 PCT. Hence, accelerated prosecution may be requested.
 - (c) Yes - Notice of EPO 5/98 - The EPO will speed up proceedings if party files reasoned statement informing the EPO of pending infringement proceedings. The National court may also tell the EPO of such proceedings.
 - (d) Yes - An appeal may be accelerated if there are for example pending or envisaged infringement proceedings, the patent's validity effects pending licence negotiations or the appeal comes from an accelerated Oppo proceedings. (Not. of Pres EPO, OJ EPO 1998, 362).

Q9 A and B must cooperate. B must file an appeal and A must intervene.

The Opposition was rejected on 5/3/99.

By Art. 106(1) this decision is appealable.

By Art. 107 any party to proceedings who is adversely affected may appeal. B can therefore appeal.

The Due date is Art. 108 - 2 mths to file notice of appeal and pay fee. 4 mths to file grounds.

∴ B should file appeal straight away introducing B.

A new ground for Opposition can only be introduced at appeal stage with the consent of patentee.

∴ Check whether original opposition included grounds of novelty + inventive step. Likely that these grounds were in original opposition. Since D is relevant, the case may well be remitted back to the department of 1st instance. (T258/84).

A should intervene in appeal proceedings in line with Art. 105 EPC. Must intervene within 3 mths of date of infringement proceedings i.e. 12/6/99. Rule 85(1) ⇒ 14/6/99. By Art. 105(2) A must file a reasoned statement within the 3 mths + pay fee. Safest to pay both Appeal and Opposition fees. G1/94 confirms that a notice of Intervention may be filed during an appeal. However, this decision also allows the Intervener to raise new grounds of Opposition i.e. Even if novelty + inventive step weren't revised. A can revise them.

Q10 02/12/96 = Earliest Priority Date
 1/8/97 = FD

Macedonia joined as an Extension state on 1/11/97. See EPO J 97, 538.

You can only extend to MK if EPO + Extension state were designated or filing AND extension agreement was in force as Filing date of PCT. This latter requirement was not fulfilled

∴ Cannot extend to Macedonia.

ii) Romania - 15/10/96

The above requirements were fulfilled.

31 mths deadline (Art. 39(1)+(2) PCT) = 02/7/99. Friday. By Rule 104 bii - Designation fees due at 31 mths. As are extension fees. ∴ Need to request Extn. to RO and pay extension fee.