
Examiners' Report on Paper D

PART I – General

Some questions, in particular questions 7 to 11, at least in part, caused difficulty for many candidates. The other questions were substantially or sufficiently (well) answered by the majority of the candidates. It is worth repeating that in part I the candidates are expected to quickly and correctly apply their legal knowledge to the facts as given. Reasons and legal basis justifying and explaining how the said application of legal knowledge fits to the said facts should be given to get full points. The questions should be read carefully, because the answers should be to the point. Comments are given below on the aspects/questions which were found difficult.

Question 1

This question was open as to date of filing of the international application and place of inspection, and this openness gave sufficient freedom of answer to the candidates, ie yes or no, but with appropriate arguments. A number of candidates answered the question in an exhaustive manner however.

Actually, the candidates were expected to be familiar with new Rule 94 PCT, as in force from 01.07.1998 for applications filed on or after that date. As a matter of fact, new Rule 94.3 PCT does mention the term "third parties" of the question. Many (also or only) cited Rule 94.1 PCT. This Rule does not fit to the question as given, because a preliminary examination report is being carried out before the EPO.

Question 2

Most candidates, albeit they correctly acknowledged that the patent will not be revoked by the Board of appeal of the EPO pursuant to G 8/93, however failed to explain that proceedings must be pending for the purpose of examination under Art. 114(1) EPC, which is not the case here once opposition has been withdrawn.

Very few mentioned that, in view of the new novelty destroying document, the patent actually might be attacked on nullity before the national instances.

Question 3

Some candidates actually held that the representative could nevertheless file the application in Spanish before the Spanish Patent Office, ignoring the fact that the applicant (an Argentinean company) does not fulfill the requirements of Art. 14(2) EPC, and that these legal provisions apply to the applicants and not to the representatives (see T 149/85). Many overlooked the necessity for filing a translation in Spanish, if the representative filed the application in any EPO official language (DE, EN, FR) before the Spanish Patent Office. Most realized the possibility of filing the application at the EPO, but many overlooked the possibility of filing at national offices other than the Spanish Patent Office.

Question 4

This question was well answered apart the fact that some candidates did not mention that the International search report takes the place of the European search report.

Question 5

Some candidates correctly mentioned the relevant legal provisions, they actually failed to apply them to the case in question, ie by explicitly stating that in the case in question the divisional application should be filed at the latest with the filing of the amendments.

Question 6

A number of candidates were not aware of T 382/94 and have either erroneously referred to the legal provisions of Rule 43 EPC and to the Guidelines A-II, 4.7 and A-III, 10, ie redating of the application. These legal provisions actually apply to late-filed or missing drawings, whereas in the present case the drawings were present ab initio, albeit with text in another language, ie with non-complying physical requirements. Some candidates even generically affirmed that Art. 80(d) EPC does not require the filing of drawings for according the filing date, thus ignoring the fact that in the case in question the drawings were part (ie accompanied and were cited in the description) of the application as filed.

Question 7

Surprisingly this basic question was badly answered by many, who actually missed the only means of redress, with the consequence of a serious loss of right of appeal for the opponent. This denotes lack of knowledge of the provisions on notification (Rules 81 and 82 EPC) as well as of the relevant case law (eg T 703/92).

Many simply asserted that appeal was not possible any longer, because the time limit under Art. 108 EPC had lapsed on 03.02.2000 (without any account of the ten days Rule), or on 14.02.2000 (account of the ten days rule as well as of Rule 85(1) EPC), without any doubt as to the ineffectiveness of the notification.

A number mentioned restitutio (actually this means of redress is not applicable to the notice of appeal, as decided in T 210/89 and G 1/86), because the cause of non-compliance was in the non valid notification according to Rule 81(1) EPC, which non-compliance actually was removed only on 03.03.2000.

Some candidates confused closure of oral proceedings with closure of written proceedings, ie the actual despatch of the written decision. They argued that in oral proceedings the pronouncement of the decision closes the proceedings, thus the appointment of the representative after the 11.11.1999 was not valid or late filed. Thus, the time limit under Art. 108 EPC had lapsed and no errors in the notification of the decision by the EPO could be seen either.

Several, in view of the ineffective notification, wrongly suggested writing to the EPO to request a new notification of the decision, upon which the time limit for appeal should run anew.

Question 8

Most candidates did mention the possibility of filing the observations under Art. 115(1) EPC for introducing the article into the proceedings. Not all of them clearly stated that the examining division actually will check whether the priority claimed is valid, because the article has been published in the priority interval, and the application contains more text than the priority application (Guidelines C-V, 2.1), and thus will set a time limit for filing the translation of the priority application. – Very few suggested searching for corresponding national applications, or instructing a JP patent attorney to compare application and article.

Question 9

Almost all of the candidates acknowledged that the requirements of Art. 123(2) EPC had been contravened and that the ground of opposition under Art. 100(c) EPC was justified. Many mentioned the impossibility of deleting the restriction without extending the scope of protection under Art. 123(3) EPC. Very few have correctly discussed G 1/93, as to whether and when the criteria for maintaining or replacing the added restriction are fulfilled. The majority however concluded that the patent will be revoked. Actually this conclusion is not strictly correct. The fact that the proprietor cannot maintain the patent as granted, in particular claim 1, does not amount to the patent being revoked (in its entirety). Actually, the proprietor might be able to fall back to an allowable claim without the non-admissible restriction. Very few answered the question fully and correctly.

Question 10

Before commenting on the answers, it is worth stressing that the question was whether the error (missing claim in the French translation) could be corrected before the EPO (not before any national instance) in the situation as delineated. Actually, not many acknowledged that and explained why the error cannot be corrected before the EPO.

First of all, the error did not result from the publication of the specification of the patent by the EPO (ie no printing error). The error was already present when the French translation of the claims was filed by the applicant.

A high number of candidates were not aware that the translation of the claims in the two other languages actually is not part of the decision to grant.

Although the question did mention that no opposition had been filed (and the day of the examination was well after the nine month period of Art. 99 EPC), hence neither opposition, nor opposition-appeal proceedings were running, many nevertheless suggested correction under Rule 88 EPC, first or second sentence. They were actually not aware that for Rule 88 EPC to be applicable (implementation of Art. 123(2) EPC) proceedings before the EPO must be running (Guidelines, C-VI, 5.9).

Several wrongly relied on legal certainty for the public (missing claim) to justify the correction of the error by a new publication of the specification by the EPO.

Some candidates correctly acknowledged that the text in the language of the proceedings is the authentic text (see Art. 70(1) EPC), and this text was complete and correct. Many of these did not use the information correctly.

Question 11

Not many candidates have correctly assessed that the report must be established by 16 June 2000. Thus, it is likely that the examiner has not yet drawn up the report. They failed to address the most simple suggestion, ie to contact the examiner, eg for an interview under Rule 66.6 PCT, to then file amendments as requested by the applicant. It is worth mentioning in this respect, that a positive IPER can speed up the subsequent procedure, at least before the EPO.

Few candidates have clearly answered that failure to respond to a written opinion in PCT II procedures does not lead to any loss of the application.

Model Solution for Paper D, Part I

Answer to Question 1

According to new Rule 94.3 PCT, an elected office may allow inspection of the files of a published international application according to its national/regional law.

The EPO will allow inspection of the files of international applications filed on or after 01. July 1998, in accordance with the provisions of Article 128 (4) EPC, as established in the notice published in EPO OJ 1999/329, see also the EPO Guidelines E-IX, 6.5.

Answer to Question 2

The patent will not be revoked by the EPO.

Pursuant to G8/93 (OJ 1994, 887), as soon as an opponent who is sole appellant withdraws his opposition, the appeal proceedings are automatically terminated.

The board of appeal no longer has the power to examine the substantive merits of the case under the terms of Article 114 EPC, as for that purpose the proceedings must be pending.

There is however a risk that the patent will be declared null and void in national proceedings.

Answer to Question 3

The Spanish attorney can file the application according to Art. 75 (1) EPC with the Spanish patent office, or any other competent authority of any contracting state which so permits and with the EPO.

In all cases the application must be filed in an EPO official language as Art. 14(2) EPC does not apply, because the applicant is not resident of one of the contracting states.

If the application is filed with the Spanish patent office, a Spanish translation must be annexed. If he filed with any other competent authority a translation may be required. (See "National Law relating to the EPC", Ch. II).

Answer to Question 4

5 May 1999: Holiday in The Hague – Rule 85(1) EPC = 6 May 1999

The six months time limit in Article 94(2) EPC runs from the date of the mention of the publication of the European search report.

Where a PCT application is concerned, the International search report shall take the place of the European search report in accordance with Article 157(1) EPC.

The six month time limit therefore runs from the publication of the international search report, irrespective of whether a supplementary search report is drawn up or not (Guidelines C-VI, 1.1.3).

Answer to Question 5

- a) No further communication in accordance with Rule 51(4) EPC is issued; a Rule 51(6) EPC communication is sent (Guidelines C-VI, 15.1.2).
- b) By the time the applicant indicates his approval of the notified text of the parent application. (Rule 25(1) EPC).

As no further Rule 51(4) EPC communication is sent, at the latest with the filing of the amendments.

Answer to Question 6

- a) Filing date 21 March 2000. Article 80(d) EPC requires one or more claims in order to be accorded a date of filing.
- b) Filing date 1 March 2000. Pursuant to T 382/94 (OJEPO 1998/24), it does not matter whether text in the drawings is in the same language as the description and claims in accordance with Art 14(1) and (2) EPC.
- c) Filing date 17 March 2000. Latvia is an extension state and not a contracting state to the EPC. Latvian is not an acceptable language pursuant to Art 14(1) EPC for filing a European patent application. The date of filing will be the date of filing the German language documents.

Answer to Question 7

According to Rule 81(1) EPC, if a representative has been appointed, notification shall be addressed to him. A representative has been appointed on 23.11.1999 which is before the date of the written decision of 03.12.1999.

If, despite the appointment of a representative, notification is made directly to the opponent himself, the notification is ineffective (T 703/92).

According to Rule 82 EPC, a document shall be deemed to have been notified on the date established by the EPO as date of receipt.

In this case, the representative has received the decision on 03.03.2000. Therefore due date for filing appeal is 03.05.2000 in accordance with Art. 108 EPC. Appeal is still possible.

Answer to Question 8

- a) The article might be introduced into the examining procedure by filing observations in accordance with Article 115 (1) EPC.

Since the article was published between the priority date and the filing date, the examining division will check whether the priority claim is valid (C-V, 2.1), and will set a time limit in accordance with Rule 38 (4) EPC within which the translation of the previous application must be filed.

A declaration stating identity of the texts of the EP and the JP application cannot be accepted since the EP application contains more text than the JP application.

Under these circumstances, the translation will be available by inspection of the files, Art. 128 (4) EPC, at a date which is earlier than the normal time limit under Rule 51 (6) EPC.

- b) This is not the best solution from a tactical point of view since the applicant is warned to file the translation of the priority document and then to amend the claims in such a way that the priority claim becomes valid. Hence, it is more recommendable to wait, or to instruct a JP patent attorney to compare the JP application to the article, or other acceptable alternatives like no action at all, national procedure, opposition procedure, family search.

Answer to Question 9

The patent will not be maintained as granted.

Claim 1 as granted extends beyond the content of the application as filed in the sense of Article 123 (2) EPC, and therefore, the ground for opposition under Article 100 c) EPC prejudices maintenance of the patent.

Removal of the added feature is not possible since extending the protection conferred, thus offending against Article 123 (3) EPC.

Hence the patentee is caught in a trap between Article 123 (2) and Article 123 (3) EPC. The conditions outlined in G1/93 under which he could maintain or replace the added feature do not apply in the present case.

Answer to Question 10

The error cannot be corrected before the EPO.

Art. 70 (1) EPC states that the text of a European patent in the language of the proceedings, i.e. English in the present case, shall be the authentic text.

The translations are not part of the decision to grant (Art. 97 (2) EPC), nor are they examined (Guidelines C-VI, 15.2.1). Hence Rule 89 EPC being applicable to decisions of the EPO cannot be applied to the translations of the claims.

Rule 88 EPC does not apply after publication of the grant in the Patent Bulletin.

Answer to Question 11

The three month deadline had expired on 20 March 2000.

The international preliminary examination report must be established by 16 June 2000, 28 months from priority according to Rule 69.2 PCT.

According to Rule 66.4bis PCT the IPEA need not take into account any arguments or amendments submitted after it has begun to draw up the report.

If the examiner has begun to draw up the report, the arguments and amendments can only be submitted on or after entering the regional phase.

Contact the examiner to request a personal interview pursuant to Rule 66.6 PCT and he must grant this provided he has not begun to draw up the report.

Failure to respond does not lead to loss of the application, only that the IPER will include unfavourable comments.