
Examiners' Report on Paper DI

The examiners' hope for better structured responses was often disappointed. Particularly, candidates failed to respond with detailed reasoning in which provisions of law are applied to the case presented. In detail, the following observations are made:

Question 1:

Most candidates found the solution for part a) according to which the renewal fees had to be paid for the 3rd and 4th year. This is also true for the time limit asked for in part b). Most candidates, however, failed to correctly respond to part c) in that they did not distinguish the differing time limits for paying the renewal fees for the 3rd and 4th years with surcharge.

Question 2:

Surprisingly many candidates failed to identify that the priority of PCTLATE is not valid. A good portion of those candidates who correctly identified the priority problem referred to the EPC provisions instead of the provisions of the Paris Convention and the PCT. Very few candidates considered that valuable protection in Germany is anyway given by the utility model.

Question 3:

The majority of candidates correctly responded to this question. Most candidates, however, missed to mention the exceptions to the general rule of no reformatio in peius outlined in G1/99.

Question 4:

Even though a majority of candidates answered that the International Bureau will act as Receiving Office in this case, most candidates failed to explain to whom and until when the various fees had to be paid.

Questions 5:

This question was generally well answered, even if only few candidates proposed the simple option to refile the application.

Question 6:

Most candidates failed to mention that, for EP3, there would have been a possibility to designate. Other than that, the question was generally well answered.

Question 7:

With regard to part b) and c), some candidates wrongly proposed to file an appeal against the communication according to Rule 69 (1) EPC, without requesting an appealable decision under Rule 69(2).

Question 8:

In general, the legal situation was correctly understood, but many candidates ignored the instructions from the client not to pay the extra fees.

Question 9:

Most candidates responded following the principal idea to which this question was directed. However, the provisions in the PCT in part a) were often not correctly and sufficiently cited.

Question 10:

Again, most candidates responded following the principal idea to which this question was directed. However, the responses were often not elaborated in sufficient detail. In particular, the requirement of filing the statement together with the application was often missed.

Question 11:

Many candidates failed to mention that it is the applicant who has to file the request for further processing. Most candidates, however, correctly identified that the request eventually was not validly filed.

Possible Solution DI/2004

Question 1

- a) The renewal fee for the third year (Rule 37(3) EPC, first sentence) and the renewal fee for the fourth year (Rule 37(3) EPC, second sentence) both have to be paid in 2004.
- b) According to Rule 37(3) EPC, second sentence, the two renewal fees can be paid without an additional fee within four months of the filing date of the divisional application, i.e. until 29 May 2004, extended to 01 June 2004 (Rule 85(1) EPC).
- c) The renewal fee for the third year can be paid with surcharge until 29 July 2004 in accordance with Rule 37(3) EPC, third sentence.
- The renewal fee for the fourth year can be paid with surcharge within the six-month grace period of Article 86(2) EPC, which applies ("de ultimo ad ultimo") from the end of one month to the end of the other, (Rule 37(1) EPC and J4/91). Therefore the renewal fee for the fourth year can be paid until 31 August 2004.

Question 2:

The priority claim of PCTLATE is not valid.

The German utility model is the first application for the invention. A did not claim priority from the first application (Article 4 C (4) Paris Convention and Article 8(2)(a) PCT). Consequently, PCTLATE has the filing date as the relevant date.

The German utility model was made available to the public before the filing date of PCTLATE and is therefore prior art for PCTLATE.

Only the German utility model provides protection for the invention.

Question 3:

In principle, the patent proprietor cannot reinstate the granted claim 1 during the appeal proceedings.

According to G9/92 or G4/93 (no reformatio in peius), the patent proprietor who did not himself file an admissible appeal may, in principle, only defend the patent in the form in which it was maintained by the opposition division in its decision.

However, exceptions to this are outlined in G1/99.

Question 4:

The EPO transmits the international application to the IB on the basis of Rule 19.4 PCT. When the EPO acts as a receiving office, the PCT-application must be filed in one of the official languages of the EPO, i.e. English, French or German (Rule 104(1) EPC).

The international application so transmitted shall be considered to have been received by the IB and the International Bureau acts as receiving office according to Rule 19.4 PCT.

The date of receipt is the date on which the EPO received the PCT-application.

The date of receipt of the transmitted application at the IB is used for the calculation of the due dates of the transmittal fee, the international fee and the search fee (Rule 19.4 (c) PCT).

Fees have to be paid to the IB either directly without surcharge or after notification by the IB with surcharge.

All fees already paid to the EPO will be reimbursed (OJ 1993, p 764).

Question 5:

a) According to Art. 14(2) EPC, a European patent application may be filed in Greek language for the Greek national.

According to Rule 6 (1) EPC, a translation should have been filed within 3 months after the filing, but not later than 13 months after the priority date, i.e. at the latest on 13 March (Saturday), extended to 15 March 2004 (R.85(1) EPC).

Since no translation has been filed, the application is deemed to be withdrawn in accordance with Article 90(3) EPC.

b) Since the original application has not yet been published, the application could be refiled. However, priority can no longer be claimed.

If there are arguments that the "all due care" requirement was met, a request for restitutio in integrum (Article 122 EPC) is to be filed.

Question 6:

The designation fees for EP1 had to be paid within 6 months of the mention of the publication of the search report (Article 79(2) EPC), i.e. by 02 October 2003.

EP1 validly designates AT, BE, ES and DE. The designation fees were duly paid by the deadline of 02 October 2003.

EP2 was filed within the time limit of Art. 79(2) EPC. Therefore EP2 may validly designate all contracting states, including NL (see G4/98), even though EP1 did not validly designate NL.

EP3 was filed after the time limit of Art. 79(2) EPC. Thus EP3 may only validly designate those states which are validly designated in EP1 (see G4/98).

The two-month grace period of Rule 85a(2) expired on 2 December 2003.

At the time of filing EP3, the Rule 85a(2) time limit had not yet expired. Thus although we are told that designation fees were only paid for AT, BE, ES and DE for EP1, at the time of filing EP3, it was still possible to pay further designation fees including the designation fee for NL for EP1. Thus provided that this/these designation fee(s) was/were paid before 02 December 2003, also NL could have been validly designated in EP3. Otherwise only AT, BE and DE may be validly designated in EP3.

A further consideration concerns the grace period of Rule 85a(1) EPC. Since the designation fee for NL was not paid by 2 October 2003, a communication under Rule 85a(1) must be issued. As long as the grace period triggered by receipt of this communication has not yet expired, it may still be possible today (24 March 2004) to pay the designation fee for NL in EP1. If this is still possible, then EP3 can still validly designate NL. Otherwise, only AT, BE and DE may be validly designated in EP3.

Question 7:

a) The application is deemed to be withdrawn (Article 96(3) EPC).

To save the application, I would request further processing under Article 121 EPC.

The loss of rights was notified under Rule 69(1) EPC on 01 February 2004 (Rule 78(2) EPC). Further processing should be requested, the corresponding fee should be paid and the reply to the communication should be filed within two months from notification of the loss of rights, i.e. until 01 April 2004.

b) The rejection of the further request in communication C2 as such cannot be appealed, as it does not terminate the proceedings (Article 106(3) and Rule 65 EPC). An appeal would therefore not be admissible.

c) C3 is a communication under Rule 69(1) EPC.

Within two months after notification of C3, I can apply for a decision under Rule 69(2) EPC on the finding that the application is deemed to be withdrawn.

This decision is appealable (Article 106(1) EPC). Thus the finding of loss of rights can be reviewed by a Board of Appeal.

Question 8:

a) Under the given circumstances, since no additional fee is paid, an official protest procedure is not possible (Rule 40.2(c) PCT).

b) There will be an International Search Report indicating that the search was performed only for the main invention, i.e. the invention first mentioned in the claims (Article 17(3)(a) PCT and Rule 47(3) PCT).

The International preliminary examination need not be carried out for the inventions for which no search was carried out (Rule 66.1(e) PCT) and the EPO as IPEA will not do so.

Question 9:

a) Rule 64(1)(a) PCT states that, for the purposes of Article 33(2) and (3) PCT, everything made available to the public by means of written disclosure prior to the relevant date shall be considered prior art. The relevant date is the international filing date (Rule 64(1)(b)(i) PCT). Although Prof. A's oral disclosure was before the relevant date, the written version was only made available to the public later than the relevant date.

According to Rule 64(2) PCT, such a non-written disclosure is not considered part of the prior art. However, the IPER shall mention such disclosure according to Rule 70.9 PCT.

b) In the regional phase before the EPO, Prof. A's disclosure will be considered part of the prior art since Article 54(2) EPC refers to written or oral description.

Question 10:

The IGA 2003 is an international exhibition as referred to in Article 55(1)(b) EPC (see e.g. official list published in OJ 2003)

If the client proceeds as planned, the disclosure of the gardening tool at IGA 2003, would have to be taken into consideration for the application of Article 54 EPC since it occurred earlier than six months before the planned filing date of EP-1.

In accordance with G3/98 or G2/99, the relevant date for the calculation of the six-month period of Article 55(1) EPC is the filing date, not the priority date.

Hence EP-1 would be lost for lack of novelty over the disclosure at IGA 2003.

The six-month period of Article 55(1) EPC started on the date of the first disclosure, i.e. on 24.09.2003 and thus expires today.

Instead of the national first filing CH-1, the client should therefore file EP-1 today and include on filing the statement under Article 55(2) EPC.

Within four months from the filing date of EP-1, i.e. until 24.07.2004 extended to 26.07.2004 (Rule 85(1) EPC), the certificate referred to in Article 55(2) EPC and the accompanying documents, which are available to client, must be filed in accordance with Rule 23 EPC.

Question 11:

No, the request for further processing was not validly filed.

The period for filing the request for further processing expired on 14.11.2003 (Article 121(2) EPC, Rule 78(2) EPC). The request was therefore filed on time.

However, the request for further processing must be filed by the applicant (Article 121(1) EPC).

A transfer shall have effect only when the documents satisfying the EPO that a transfer has taken place have been produced (Rule 20(3) EPC). The declaration of transfer signed by both companies is satisfactory (GL E-XIII, 1.2) and so the transfer is registered on 27.11.2003.

The newly registered applicant B became applicant only after expiry of the period for filing the request for further processing and therefore could not have filed the request for further processing.

EXAMINATION COMMITTEE III

Candidate No.

Paper D Schedule of marks

Question	Maximum possible	Marks awarded	
		Exr	Exr

PART I

1	5		
2	4		
3	2		
4	5		
5	4		
6	5		
7	5		
8	3		
9	3		
10	5		
11	4		
TOTAL PART I	45		

PART II

A	17		
B	5,5		
C	8		
D	24,5		
TOTAL PART II	55		

Total Parts I + II	100		
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Examination Committee III agrees on _____ marks
and recommends the following grade to the Examination Board:

☐

PASS
(50-100)

☐

FAIL
(0-49)

COMPENSABLE FAIL

(45-49, in the case the candidate sits the examination for the first time)

Munich, 9 September 2004

Chairman Examination Committee III