
Examiners' Report - Paper D - Part I

General Comments:

Candidates are reminded that a full preparation including a good knowledge of the Guidelines and official communications published in the Official Journal of the EPO is necessary to pass the exam.

There are still candidates using outdated legal texts or making reference to superseded legal provisions. This causes an unnecessary loss of marks.

The D1 paper tests legal knowledge and reasoning. Some candidates try to obtain marks by presenting more than one answer to a question leaving it to the marker to pick a good one. It is not possible to obtain the full number of marks with such a strategy and often, no marks can be given at all.

As always, it is only possible to obtain full marks if all pertinent legal provisions are cited correctly.

It is pointed out that the submission of pre-prepared materials as part of the answer paper is contrary to the Regulations (see "Instructions to candidates concerning the conduct of the examination", paragraphs 4. and 5.7, published in Supplement to Official Journal 12/2004). Such materials will be disregarded for marking.

Question 1:

A considerable number of candidates were not aware of the latest notice of the EPO with respect to the handling of file inspections relating to the international applications not having entered the European phase. Even some of those candidates who were aware of this notice did not correctly interpret its content, thus wrongly suggesting that file inspection is not possible.

The Guidelines E-IX, 6.5, effective at the date of the exam and referring to the above notice, lead some candidates to a different solution. These candidates were not penalized.

(N.B.: The Guidelines were amended in the meantime in this respect.)

Question 2:

This question was generally well answered. In part (b), however, many candidates missed that, according to Rule 57a, an amendment of the claims in opposition proceedings, including a change in the category of claims, is only allowable if it is occasioned by grounds of opposition. In part (e), some candidates, even though citing G1/93, were not able to apply its content to the specific situation outlined in the question.

Question 3:

Even though most candidates correctly referred to G3/99 for answering to this question, still a considerable number failed to apply in detail Rule 100 (1) EPC referred to in this decision.

Question 4:

Nearly all candidates had difficulties with this question. At least some candidates realized that the requirements of Rule 17.1 (b) PCT had been fulfilled and that the EPO shall not request the applicant to furnish the priority copy according to Rule 17.2 (a) PCT. Still, very few candidates knew how the EPO would act in such a situation.

Question 5:

Most candidates correctly responded that it is necessary to file a demand for International Preliminary Examination within the time limit specified in new Rule 54bis.1(a)(ii) PCT. However, a very low number of candidates correctly answered that, in order to have the WO-ISA reviewed, it is necessary to actually file a response according to Rule 66.3 PCT. Otherwise, the content of the WO-ISA will be automatically converted to the International Preliminary Report on Patentability not having obtained the intended review of opinion.

Question 6:

This question was generally well answered. Many candidates, though, missed the main legal basis of Article 118 EPC when responding.

Question 7:

This question was generally very well answered. Some candidates, though, were referring to an earlier decision of the President of the EPO on the same matter. They eventually came up with the same solution but were missing marks.

Question 8:

Although most candidates correctly referred to G8/93, only a few candidates specifically outlined that a withdrawal of the opposition in appeal proceedings has the legal effect of withdrawal of the appeal itself. Many candidates did not recognize the possibility of limitation in national proceedings. Of those that did, few recognized that this depends on national law.

Question 9:

This question was also generally well answered. However, the mere reference to Article 25 EPC was not sufficient to obtain the full marks.

Question 10:

This question was also generally well answered. However, many candidates did not answer the question of whether the employees of the EPO can use another language in the proceedings before the EPO. In part (c), a considerable number of candidates did not distinguish between ITSA and USCO with respect to the language requirements when filing a divisional application.

Question 11:

It was considered not to be a viable solution to file an amendment of the claims which the Examining Division would not accept, as this does not guarantee that the Examining Division reopens the examination proceedings. Moreover, further processing in accordance with Article 121 EPC does not apply in this situation because there is no complete loss of rights. Some marks were awarded for proposing to timely file the translation if the translation happens to be ready by 29 March 2005. Another more costly alternative is to file a divisional application.

(N.B.: The change to Rule 51(4) EPC effective 01 April 2005 closes the solution of requesting the extension of time in the future.)

Possible Solution - Paper D - Part I

Answer to question 1:

Rule 94.3 PCT entitles any elected office, after international publication, to allow access by third parties to any documents regarding an international application, including international preliminary examination, contained in its files. As from 01.02.2003, see the notice published in OJ EPO 7/2003, p.382, EPO as elected office affords access to the file of international preliminary examination for applications filed as from 1 July 1998 after publication of the international application and completion of the International Preliminary Examination Report. Since all these requirements are met by PCT1, access to the file of IPE will be afforded by the EPO.

Answer to question 2:

- a) The amendment does not meet the requirements of Rule 86(4) EPC and is therefore not admissible.
- b) According to G2/88 (OJ EPO 1990, 93), a change of the claim category in opposition proceedings cannot be objected to under Article 123(3) EPC, when the scope of the claims as a whole is not extended, provided that the amendment is caused by a ground for opposition, as required by Rule 57a EPC. Since the protection for substance A and the mixture B containing substance A is absolute, a claim directed to an originally disclosed special use of substance A in mixture B contains a limiting additional feature.
- c) According to the Notice from the European Patent Office dated 3 December 2003 (OJ EPO 12/2003, p.609), the electronic filing of documents (in accordance with Rule 36(5) EPC) is not possible in appeal proceedings.
- d) According to G1/03 or G2/03 (OJ EPO 04, p. 413), introduction of an undisclosed disclaimer only for establishing novelty against state of the art under Article 54(3) EPC is considered as not contravening Article 123(2) EPC.

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- e) According to G1/93 (OJ EPO 94, p. 541), an added, not originally disclosed feature without any technical meaning can be removed from a claim without infringing Article 123(3) EPC.

Answer to question 3:

- a) Yes, the opposition is validly filed. One opposition fee suffices according to G3/99 (OJ EPO 2002, p. 347).
- b) The common representative has to notify the EPO. The member of the family first mentioned in the notice of opposition is the common representative, Rule 100 (1) EPC, unless a common representative has been designated. If the common representative withdraws from the opposition proceedings, the first remaining family member will be the new common representative by application of Rule 100 (1) EPC (G 3/99, paragraph 20 of the reasons for the decision), unless a new common representative has been designated.

Answer to question 4:

Substantive examination will start despite the missing priority document, see Guidelines A-VII, 3.5 (or C-V,2.1). If the result of substantive examination is that the patentability requirements are not met the application can be refused without priority document. If the application is allowable, the applicant is informed that the decision to grant will not be taken as long as the priority document is missing.

The EPO shall not request the applicant to furnish the priority document, Rule 17.2 (a) PCT (exception to Rule 111(2) EPC), since the requirements of Rule 17.1 (b) PCT (request timely, i.e. not later than 16 months and payment of the fee) are fulfilled.

Answer to question 5:

In order to have the WO-ISA reviewed, it is necessary to file a demand for International Preliminary Examination at the EPO. The demand has to be filed 22 months from the date of priority, Rule 54bis.1(a)(ii) PCT or three months from the transmission of the ISR and WO to the applicant, Rule 54bis.1(a)(i) PCT, whichever is later.

The 22 months time limit ends 08.03.2005, which is today; the 3 months time limit ended on 09.01.2005 (Rule 80.6 PCT), extended to 10.01.2005 because of holiday (Rule 80.5 PCT), hence the demand has to be filed today.

The demand will only be treated if the Handling Fee, Rule 57.3(a) PCT, (for the benefit of the International Bureau) and the Preliminary Examination Fee (for the benefit of the IPEA), Rule 58.1(b) PCT, (both being collected by the IPEA), have been paid within one month from filing the demand, i.e. until 08.04.2005 (Friday). Because the WO-ISA is considered to be the first Written Opinion of the International Preliminary Examining Authority (WO-IPEA) according to Rule 66.1bis(a) PCT, a response has to be filed in order to have the written opinion reviewed, according to Rule 66.3 PCT.

Answer to question 6:

Companies A and B are different proprietors in respect of different designated contracting states.

According to Art. 118 EPC nevertheless they shall be regarded as joint proprietors for the purposes of opposition proceedings before the European Patent Office. The unity of the patent shall not be affected, in particular the text of the patent shall be the same for all designated contracting states. Hence the proprietors are forced to act in common.

Therefore A and B cannot pursue separately different sets of claims, Guidelines DI, 6 (or D VII, 3). Art 118 EPC allows for a deviation from the unity of the patent only for the case where the EPC provides for exception (e.g. the cited prior art is an Article 54(3) EPC document designating AT).

Answer to question 7:

The due sum for the fees for grant and printing was EUR 715.- plus EUR 10.- for the 36th page, i.e. EUR 725.-, Art. 2, 8.2 RFees.

Hence the sum of EUR 730.- paid was too large by EUR 5.-

This sum is an insignificant amount in the sense of Art. 10 c RFees, see Decision of the President of the European Patent Office (06.09.01), OJ EPO 2001, 521

(or Guidelines A-XI, 10.1.3), where the limit of the insignificant amount is determined to be EUR 10 or less.

Hence the EUR 5.- will not be automatically refunded, unless it is expressly requested that the sum be refunded.

Answer to question 8:

Withdrawal of the opposition by the opponent has to be regarded as a withdrawal of the appeal, see G8/93 (OJ EPO 1994, 887).

Withdrawal of the appeal by the sole appellant immediately terminates the appeal proceedings, as follows from G7/91, G8/91 (OJ EPO 1993, 346,356).

Consequently, the Board of Appeal has no power to consider the patent, and the decision of the opposition division becomes final. Under these circumstances, a restriction of the patent before the EPO is no longer possible.

The client may restrict the patent only in national proceedings. In the countries where this is possible according to national law, the client may initiate an ex parte limitation.

Answer to question 9:

It follows from Article 25 EPC that the EPO shall be obliged at the request of the competent national court to give a technical opinion.

However, no opinion will be given on the validity and infringement of the European patent, see Guidelines E-XII, 1 and 2.

Answer to question 10:

- a) In the written procedure, the attorney may use any official language of the EPO, Rule 1(1) EPC or Guidelines A-VIII, 2.1, and may therefore use the English language which is one of the official languages of the EPO, Article 14(1) EPC. The EPO will use the language of the proceedings in the written procedure, see Guidelines A-VIII, 1.2 or 2.1, which is the language of the translation, Article 14(2) and (3) EPC, i.e. the French language. Amendments have to be filed in the language of the proceedings, i.e. they cannot be filed in English, Rule 1(2) EPC.

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- b) In oral proceedings, the attorney may use the English language in lieu of the language of the proceedings, following Rule 2(1) EPC.

The employees of the EPO may also use the English language, Rule 2(2) EPC.

- c) If the applicant is USCO, the divisional application must be filed in the language of the proceedings, i.e. in French, Rule 4 EPC. If the applicant is ITSA, they can also, according to Article 14(2) EPC, file the divisional in Italian and then translate it into French, see Rule 4 EPC or GL A-VIII, 1.3 or A-IV, 1.3.3.
- d) The statement of grounds must be filed in English, German or French, see Guidelines E-VI, 3 or A-VIII, 3.2. Rule 1(1) EPC is not applicable since third parties are not a party to the proceedings.

Answer to question 11:

The priority claim can be saved by requesting before expiry of the time limit on 25 March 2005, extended to 29 March 2005 (Easter Holidays), Rules 78(2) and 85(1)EPC, an extension of the period given in the 51(4) - communication C1, even if the corresponding actions have already been taken, Rule 51(4) EPC, second sentence. This extension then automatically extends the period set under Rule 38(5) EPC, first sentence. The extension can be requested once for a maximum of two months. This would be sufficient to get the translation of the priority document filed.

Alternatively, it would be possible to simply wait for a communication under Rule 41(1) EPC and to submit the translation of the priority document in reply to this communication, legal advice 19/99 (OJ EPO 99, 296), see also Guidelines A-III, 6.8 or C-V, 3.4.

84 Marking Schedule

EXAMINATION COMMITTEE III

Candidate No.

Paper D Schedule of marks

Question	Maximum possible	Marks awarded	
		Marker	Marker

PART I

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

PART II

A	19		
B	20		
C	13		
D	3		
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)

9 September 2005

... - Chairman Examination Committee III