
Candidates' answer

Question 1

Yes.

Under EPCa.59, a European application may be filed by joint applicants, here HYPERTOOLS + CYBERFIT. However, joint applicants are forced to act in common – there must be a single address for service (EPCr.100).

Therefore, applications filed in the joint name of HYPERTOOLS + CYBERFIT should contain the appointment of one applicant as common representative (EPCr.26(3)). Therefore, here applications should be filed with the Request for Grant Form 1001 indicating HYPERTOOLS as the common representative. If not, the EPO will appoint a common representative in accordance with EPCr.100(1) (so as an alternative, I could name HYPERTOOLS first on the Request for Grant).

Once Hypertools is appointed as common representative in this way, as an Irish company (and therefore a legal person having its principal place of business within a Contracting State in the sense of EPCa.133(3)), it may be represented by an employee of that entity (i.e me), even though I am not a professional representative (EPCa.133 (3)).

However, in order to act as representative, I must be authorised (EPCa.133(3)), in accordance with EPCr.101. Where there are two or more applicants, only the common representative (which is HYPERTOOLS), as noted above, must file the authorisation.

=> File a signed authorisation (signed in name of Hypertools) with each application filed, or else wait for the EPO to invite me to file an authorisation for each application under EPCr.101(1) (A-IX, 1.7).

As Hypertools and Cyberfit will apparently be filing lots of applications, it would make sense to file a general authorisation under EPCr.101(2) enabling me to act as representative for all applications where Hypertools is common representative.

Question 2

i) Yes

An appeal has suspensive effect (EPCa.106(1), second sentence). Thus, the appeal prevents the decision (here, refusal of the application) having legal consequences until the Appeal is decided (or withdrawn) (J 28/94 & E-XI, 1). Since during that time a pending application exists, the filing of a divisional application is possible (EPCr.25(1); J 8/98; A-IV, 1.1.1)

ii) My answer would be no.

The suspensive effect of EPCa.106(1), second sentence occurs only if an admissible appeal has been filed (EPCa.108). It is irrelevant whether the appeal is inadmissible from the start or rejected later (J 28/03).

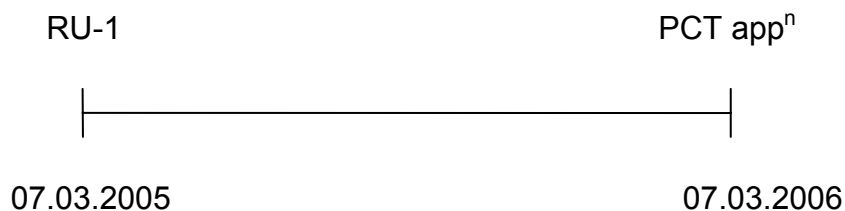
As failure to pay the appeal fee in time (2 months from notification of the decision to refuse – EPCa.108) results in the appeal being deemed not to have been filed (J 17/82; T324/90), no admissible appeal was filed and no suspensive effect arises.

=> Not possible to file the divisional.

iii) No.

In opposition proceedings, the application has been granted (EPCa.99(1) – an opposition may only be filed within 9 months after publication of the mention of grant of the application). Therefore, there is no longer a pending application (an application is pending up to (not excluding) the date that the EPB mention grant under EPCa.97C4) (A-IV, 1.1.1, OJ 2002, 112). Thus, a divisional application cannot be filed (EPCr.25(1)).

Question 3



Resident of CH, US national

Under PCTa.10, PCT appⁿ must be filed with the prescribed receiving office. Under PCTr.19.1(a) the application may be filed, at the applicant's choice at a national/regional office acting for the Contracting state of which the applicant is resident (part i) or national (part ii), or else with the International Bureau (part iii).

As a US national, the inventor may file the application with the USPTO or the International Bureau (AGI, Annex B1 – US).

As a Swiss resident, the application may be filed with the Swiss Patent Office, the EPO or the International Bureau (AGI, Annex B2 – EP).

=> Choices are USPTO
Swiss PO
EPO
IB.

Languages:

PCTa.3(4)(i) – must be in prescribed language. PCTr.12.1(a) – file in any language accepted by the Receiving Office (rO).

The USPTO will accept applications in English only (AGI, Annex C-US) => must file in English if using USPTO as rO.

The EPO will accept PCT applications in English, French or German only (PCT AGI, Annex C – EP) → must file in English if using EPO.

The IB will accept PCT applications in any language (AGI, Annex C – IB) => File in English or Russian.

Swiss PO accepts English, French or German as rO (PCT AGI, Annex C – CH) => must file in English if using this office.

Component International Searching Authority (ISA)

Where EPO is receiving Office: ISA must be the EPO (AGI, Annex C – EP).

Where USPTO is the receiving Office : ISA may be:

- i) EPO (OJ, 192, 323 & OJ 1990, 443).
- ii) Korean Intellectual Property Office (AGI, Annex C – US)
- iii) USPTO

Where Swiss Patent Office is the receiving Office: ISA may be EPO (All rOs of EPC contracting states have specified the EPO as competent ISA (EPCa. 154(1)).

If using the International Bureau, the competent ISA is any ISA which would have been competent if the international application had been filed with any receiving Office of, or acting for, the PCT contracting state of which the applicant is a national or resident (PCTr. 35.3(a)), the choice being upto the applicant (PCTr. 35.3(b))

=> Any of USPTO, EPO, Korean Patent Office listed above.

Question 4

1) Yes.

Under PCTr.92 bis.1(a), the International Bureau shall, on request of the applicant or the receiving Office, record changes in the person of the application (PCTr.92 bis.1(a) (i). The request must be filed before the end of 30 months from the priority date (PCTr.92 bis.1(b).

The request may be sent either to the receiving Office or the International Bureau (AGI, para 429), although it must reach IB by the 30 month deadline.

=> Best to file directly at the IB.

2) The demand has to be filed with the competent International Preliminary Examining Authority (IPEA) (PCTa.31(b)(a)). For an application where the receiving Office was the EPO (as here), the competent IPEA is the EPO (specified under PCTa.32(2) as the EPO according to AGI, Annex C-EP).

=> File the demand with the EPO.

The demand must be filed in the language of the international application or, if filed in a language that is not a language of publication, in the language of publication (PCTr.55.1). As German is a language of publication (AGI, paragraph 54), this exception does not apply. The language of the application is German.

=> File the demand in German.

Question 5

Yes.

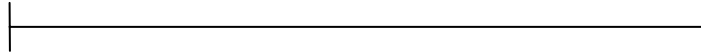
For the purposes of EPCa.54(3) and (4), the effective filing date of EP2 is the filing date of the Portuguese priority application (EPCa. 89), i.e. March 2002.

Although the applicant did not file a copy of the priority document within the 4 month period set under EPCa. 91(2) and EPCr.41(1), the priority right would have been lost under EPCa. 91(3) at the expiry of this period (i.e. November 2003). As this was after the publication date of EP2 (Sept 2003), the loss of priority right does not effect the application of EPCa. 54(3) and (4) (see C-IV, 6.1a).

Accordingly, EP2 is part of the state of the art under EPCa. 54(3) and (4) because it has an earlier effective filing date under EPCa.89 (March 2002 vs. January 2003 for EP1) and was published after this date (in September 2003). We are told that it designated the same states and described the same invention => it is novelty destroying for all designated states (EPCa 54(3) & (4), EPCr.23d).

Question 6

69(1)



21.02.2006

+10 78(2)

= 03.03.2006

+ 2 months 121

03.05.2006 (Wed)

Procedure for this set out at E-VIII, 1.6.

1) First, the application needs to be reinstated using further processing under EPCa.121.

Notification of loss of rights under EPCr.69(1) took place ten days from 21.02.2006, i.e. 03.03.2006 (EPCr.78(2)). The two month period for requesting further processing and paying the fee (EPCa.121(2)) therefore expires on Wednesday 3rd May 2006 (EPO is open).

=> By that date must:

- i) file request in writing for further processing of the application (EPCa.121(1) and (2)).
- ii) pay fee (EPCa.121(2)), which is €200 (Rfees 2(12)).
- iii) complete the omitted act (i.e. file response to the communication under EPCa.96(2) (EPCa. 96(3)).

At the same time, I must request reimbursement of the fee for further processing. A decision rejecting the request for reimbursement (which is likely here) is open to appeal, either together with the final decision or separately (depending on how the ED issues the decision to reject request for reimbursement: i.e. with final decision or as interlocutory decision with separate right to appeal EPCa.106(1) (J37/89).

The appeal would be filed by filing a notice of appeal and paying the appeal fee (€1020, Rfees 2(11)) within 2 months from notification of the decision to reject the reimbursement; and file statement of grounds within 4 months of that notification (EPCa.108).

2). No.

I would not advise client to have case reviewed by Board of Appeal, because the reason for requesting the second extension under EPCr. 84 was weak. Suitable reasons, for which I might have advised the appeal are set out at E-VIII, 1-6 (e.g. representative or client is so ill that response was not possible; or extensive experiments required), but none of these apply. Indeed "foreseeable....leave", which would apply in this situation is mentioned as an unsuitable reason. Similarly, current situation does not fit into situation set out in Notice of VP DG2 28.02.1989 (OJ 1989, 180) where a further extension might be allowed.

Question 7 10:54 → 11.03

Yes.

Although a proprietor cannot terminate opposition proceedings by surrender of the patent (T73/84), he can get the patent revoke by stating that he no longer approves the granted text (i.e. the text as unamended) and not providing an amended text. Such a statement is regarded as an amendment to be taken into account under EPCa.102(3) (see Legal Advice L11/82, paragraph 2), which means that if no alternative text is provided by the applicant, the patent cannot be maintained, even in its form as granted (EPCa.113(2)). This was confirmed in T73/84 and T186/84.

=> Even though the Opposition Division believes the patent to be valid, a request for revocation by the proprietor (which is regarded as disapproval of the text as granted – T186/84) will result in the patent being revoked, although not under EPCa 100(1), (4) or (5) (see L11/82, third paragraph).

Question 8 11.05 → 11.23

EP-B

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27.04.2005

No.

Mention of grant was published on 27.04.2005 => the 9 month period for filing a notice of opposition under EPCa.99(1) expired on 27.01.2006 (Friday => EPO open).

The notice of opposition was filed by fax on 24th January 2006 => within the 9 month period. Filing by fax is permitted under EPCr. 36(5) (Dec. of the Pres OJ 2005, 41). The EPO received the confirmation on 31st January 2006.

This is irrelevant as confirmation copies are now only required on request (OJ 2005, 41).

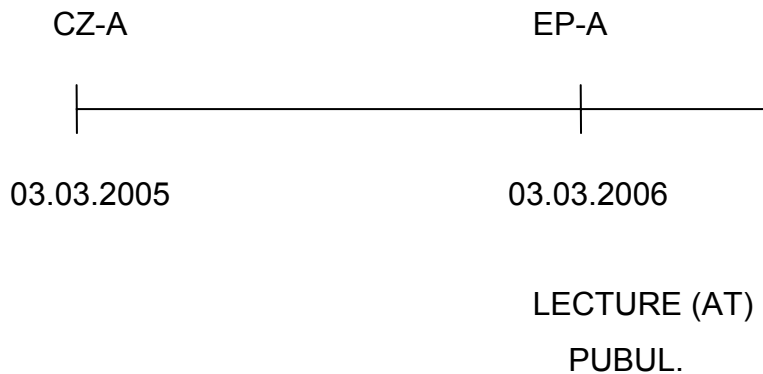
The opposition was filed by an Italian company, who as a company having its principal place of business in a contracting state with an official language other than French, German or English (here, Italian (Nat Law Table II, column 4) is entitled to file the Notice of Opposition in Italian (EPCa.14(4)).

The fee was paid by debit order filed on 24th January 2006, which is the date the fee is deemed paid (Rfees 8(1) and A.D.A 5(2)), so the fee was paid in time (EPCa.99(1)).

The translation of the notice of opposition required under EPCa.14(4) was required within the longer of 1 month from filing the notice of opposition or the end of the opposition period (EPCr.6(2), second sentence). Here, the relevant date was therefore 1 month from 24th January 2006, because the time limit runs from receipt by facsimile (A-IX, 2.5). The translation was therefore needed by 24th February 2006 (Friday – EPO open).

=> Translation filed here, opposition deemed not to be received (EPCa.14(5) & EPCa. 99(1)). Note receipt of the confirmation copy was outside the 9 month period (27.01.2006) => this would not help.

Question 9 11.23→11.40



European applications may not be filed at the sub-office in Vienna, as it is not an EPO filing office under EPCa.75(1)(a) (A-II, 1.1, OJ 1992, 183 & OJ 2005, 44).

The Vienna sub-office forwarded the application to the EPO as a courtesy service. However, the date of filing is the actual date of receipt of the application documents by a permitted office (J18/86 & OJ 2005, 44, para 7). Therefore, Prof. Piro's application will have a filing date of 6th March 2006. This is outside the 12 month period for claiming priority from CZ-A, which expired on 3rd March 2006 (EPCa.87(1); no extension under EPCr.85(1) as EPO open on 03.03.2006). Therefore, EP-A is not entitled to its priority date and has an effective filing date of 6th March 2006 (EPCa.89).

The public disclosure on 3rd March 2006 is therefore comprised in the state of the art under EPCa 54(2) (which includes oral disclosures) because it took place before the effective filing date, and EP-A will lack novelty (assuming the lecture was enabling (C-IV, 7.3a)) in light of the lecture.

EP-A should therefore be abandoned (which will mean a refund of the search fee, if paid (Rfees 10(1))). However, the Czech application is unaffected by this disclosure and could be pursued if he wants protection there.