

Examiners' Report - Paper D 2007 - Part I

GENERAL

The candidates are reminded to read the questions carefully and to use the information given therein. Failure to do so can result in overlooking issues, which are expected to be discussed, or in applying inappropriate provisions (e.g. EPC instead of PCT) or simply in answering questions not posed.

Candidates are also reminded to provide legal basis in their reasoning.

The candidates are expected to give a consistent answer to a question. When contradictory alternatives are given, no marks are awarded.

Legible handwriting is appreciated.

Question 1

This question was generally well answered. Some candidates missed marks because they either did not calculate the time limit for paying the fees at all or because they calculated it incorrectly. A few candidates overlooked that the question was related to an international application and not to a European application, because they referred to Art. 78(2) EPC for the filing fee and the search fee. These candidates got no marks.

Question 2

Many candidates only referred to Art. 23(2) or 40(2) PCT and Rule 107 EPC and were not aware that it is also necessary to request PACE for examination to start as soon as possible. According to the Notice of the President, "PACE" is explicitly available also for international applications entering the European phase. Only very few candidates correctly noted that the start of examination can further be accelerated by waiving the right to receive an invitation from the EPO to confirm that the applicant desires to proceed with the application.

Question 3

The majority of candidates correctly noted that in principle protection in Germany can be obtained via a European patent. But many candidates did not provide a satisfactory chain of reasoning how this principle has to be applied starting from the given situation. In particular only very few candidates calculated the time limit for entering the European phase. This calculation was expected, because only if the time limit had not lapsed yet, could a European patent be granted through which protection in Germany could be obtained. In addition often no legal basis was cited at all.

Question 4

Most candidates correctly analysed the involved priority problem and concluded that the priority of EP1 is invalid. However, many candidates completely ignored the information given in the question concerning the internal processing error of the German Patent and Trademark Office, which was an indication that the issue of non-prejudicial disclosure under Art. 55 EPC was expected to be discussed.

Question 5

This question did not pose a serious problem to most candidates. However, a considerable number of candidates did not discuss which filing date is accorded to an application filed on a day when the EPO is not open. Only few candidates knew that this issue is treated in a Notice of the EPO.

Question 6

A considerable number of candidates did not calculate the priority period and therefore did not check whether EP1 had been filed within this period.

Furthermore many candidates erroneously applied Rule 20(3) EPC to the transfer of the right of priority based on EP1 thereby coming to the conclusion, that at the date of filing of EP2 company M was not the successor in title of EP1 and thus priority was not validly claimed. Some of these candidates were aware of J19/87 but argued that this decision is concerned with the transfer of a national first application where national law applies whereas the present case is concerned with the transfer of a European first application where the provisions of the EPC should apply. From this, these candidates deduced that Rule 20(3) EPC is applicable to the transfer of the right of priority based on the European application EP1. This argumentation is not correct because Rule 20(3) applies to the transfer of a European application and not to the transfer of a priority right as such, which is never registered.

Question 7

This question was generally well answered. Full marks could often not be awarded because candidates did not realize that Rule 85(1) EPC is not applicable since the period for filing a divisional application is not a time limit. In part b) some candidates wrongly referred to Art. 122(5) EPC not realizing that in connection with divisional applications this Article does not concern the period for filing such an application but the time limit for paying fees therefor.

Question 8

Many candidates failed to distinguish clearly between the taking of evidence by hearing a party and the taking of evidence by hearing a witness. The relevant Article 117(1)(a) and (d) EPC was rarely mentioned.

Question 9

The majority of candidates correctly referred to Rule 87 EPC and suggested filing different sets of claims for different states. The most common reason for losing marks was that the time limit for paying the designation fees for D1 had not been estimated thus missing the fact that the validly designated states were already determined. Some candidates overlooked that D1 is a European application and not a national application. Some candidates did not discuss the situation for not commonly designated states.

Question 10

This question was reasonably well answered. However, some candidates seem not to have brought along the National law relating to the EPC to the exam and therefore could not obtain many marks for this question. Surprisingly, some candidates thought it necessary to file a translation for GB.

Possible Solution - Paper D 2007 - Part I

Answer to question 1:

Fees to be paid are:

- the transmittal fee according to Rule 14.1 (a) PCT or Article 152(3) EPC
- the international filing fee according to Rule 15.1 PCT
- the search fee according to Rule 16.1 (a) (b) PCT

All fees have to be paid to the receiving Office, i.e. the EPO.

All fees have to be paid within one month from the date of receipt of the international application (Rule 14.1 (c), Rule 15.4, Rule 16.1 (f), respectively). According to Rule 80.2 PCT, this period expires on 6 April 2007. This is Good Friday when the EPO is not open to the public. According to Rule 80.5 (i) PCT, the one month period ends on the next subsequent day when the EPO is open, which is Tuesday, 10 April 2007.

The fees can also be paid with late payment fee within one month from the date of an invitation from the EPO (Rule 16bis.1 and Rule 16bis.2 PCT, or OJ 1992, 383).

The international filing fee and the search fee can be refunded, Rule 15.6 PCT and 16.2 PCT, respectively.

Answer to question 2:

Normally, a designated office is forbidden to start the processing of an international application before the expiry of the time limit of the international phase (Art. 23(1), Art. 39 and 40(1) PCT). This can, however, be overruled by a request of the applicant, Art. 23 (2) PCT or 40 (2) PCT, see also Guidelines, part E-IX, 5.5 and Notice of the President dated 01.10.03 (OJ 03, 509) and OJ 01, 586.

Hence, the applicant should request early processing.

The applicant should also perform all necessary steps in accordance with Rule 107 EPC, i.e. request examination, pay the fee etc.

Upon entry into the European phase, he should request accelerated processing under PACE in accordance with Notice of the President 01 October 2001 in OJ 2001, 459.

Furthermore, he should waive the right to receive a communication pursuant to Article 96(1) EPC.

Answer to question 3:

On the PCT request form PCT/RO/101, all states and regions are automatically designated in the sense of Rule 4.9(a)(i) PCT. Hence, according to Rule 4.9 (a)(iii) PCT, EP is also designated.

Patent protection in Germany can therefore still be obtained through the existing designation of a European patent, in which the contracting state DE will have to be designated.

The European phase for PCT-X has to be entered on or before 09 March 2007 (Rule 107(1) EPC).

Answer to question 4:

DE-1 is not a first application in the sense of Art. 87(1) EPC. Art. 87(4) EPC does not apply here because DE-0 was withdrawn only after DE-1 was filed, see also Guidelines, part C-V, 1.4.

Since the priority of EP-1 is invalid, the effective date of EP-1 is its European filing date (01 Feb 2005). Thus, DE-0 was published before the effective date and is prior art against EP-1 according to Art. 54(2) EPC.

It is worth considering if the publication of DE-0 could be a non-prejudicial disclosure under Art. 55 EPC. However, the publication of an application by a national office as a result of an error is, according to T585/92 or Guidelines part C-IV 8.3 not an abuse in relation to the applicant within the meaning of Art. 55(1)(a) EPC.

Answer to question 5:

- a) Concerning the automated mailbox of the EPO, the provisions are laid down in OJ 2005, 44 or notice of the EPO dated 06 Dec 2004 or Guidelines, part A-II.1. According to these provisions the automated mailbox of the EPO in Munich can be used at any time, even on days when the EPO is not open. The date of posting the application in the automated mailbox (Sunday) 05 March 2006 is the date of filing.

Hence, the time limit of Art. 87(1) EPC expired on 05 March 2007, so filing on 06 March 2007 is too late to validly claim priority.

- b) The date of filing of the first application was 03 March 2006. The priority period according to Art. 87(1) EPC ends on 03 March 2007. As 03 March 2007 was a Saturday, the period is extended until 05 March 2007 according to R. 85(1) EPC.

Therefore the period expired on 05 March 2007 and the priority has been validly claimed.

Answer to question 6:

According to Art. 87(1) EPC, the right of priority belongs to the applicant of the previous application or his successor in title.

According to Guidelines part A-III, 6.1 or J19/87, a valid transfer of the priority right under national provisions on or before the filing date of the subsequent application is sufficient. Proof of such transfer can be filed later.

The transfer of EP1 - hence the transfer of the priority right - took place in Nov 06 and was valid under the national Polish provisions. Therefore, company M is the successor in title for the purposes of Art. 87 (1) EPC on the filing date of EP2.

The right of priority can be enjoyed for 12 months from the date of filing of EP1, i.e. until 22 Dec 06.

Therefore, the priority of EP1 is validly claimed.

Answer to question 7:

- a) Rule 25(1) EPC states that the parent application must still be pending. An application is pending in the sense of Rule 25 (1) EPC up to but not including the date of publication of the mention of the grant in the Bulletin, see Guidelines part A-IV, 1.1.1 or OJ 2/2002, p.112, or notice of the EPO dated 09 Jan 2002. Hence, the divisional application may be filed until 01 May 2007.

Although 01 May 2007 is a holiday, there is no extension to 02 May 2007 according to Rule 85(1) EPC, since the period for filing a divisional is not a time limit.

- b) The remedy of restitutio in integrum (Art. 122 EPC) applies to time limits vis-à-vis the EPO. Since R. 25(1) EPC sets the condition that the earlier EP-application is pending, it does not impose such a time limit. Hence, Art. 122 EPC is not applicable. This was subject of the decisions J24/03 or J18/04 and is further referred to in the Guidelines, part A-IV, 1.1.1.

Answer to question 8:

Generally, according to Art. 104(1)EPC or Guidelines, part E-IV 1.9, each party to opposition proceedings shall meet the costs he has incurred.

Since Mr. A is a party to the opposition proceedings in the sense of Art. 99(4) EPC, the taking of evidence was hearing of a party, Art. 117(1)(a) EPC. Hence, Mr. A is not entitled to reimbursement.

Since Mr. X is a client of Mr. A, he is not a party to the proceedings. In his case, the taking of evidence was the hearing of a witness or an expert in the sense of Art. 117(1)(d) or (e) EPC.

According to Rule 74(2) EPC or Guidelines, part E-IV 1.10 or notice of the EPO in OJ 1983, p. 100, witnesses and experts shall be entitled to appropriate reimbursement of expenses for travel and subsistence. Thus, Mr. X is entitled to reimbursement.

Answer to question 9:

Rule 87 EPC allows different sets of claims for different contracting states in cases of conflicting prior art,

- either being prior art under Art. 54(3) EPC
- or earlier national prior rights according to Art. 139(2) EPC.

Document D1 is prior right under Art. 54(3) EPC because it has an earlier filing date than EP and because it was published only after the filing date of EP. D1 has prior art effect only for those states which were designated in both EP and D1, Art. 54(4) EPC and for which designation fees have been paid, Rule 23a EPC. These states can be determined because the time limit for paying the designation fees for D1 has ended (in January 2004, Article 79(2) EPC, + possible grace period).

Document D2 is a national prior right according to Article 139(2) EPC.

The following sets of claims should be filed in order to obtain the broadest scope of protection possible:

- A first set of claims for the overlapping states between EP and D1. The independent claim thereof has the combination of features A and B.
- A second set of claims for DE in order to overcome the conflict with D2. The independent claim thereof has the combination of features A, B, and C.
- A third set of claims may remain without amendments for all other states.

Answer to question 10:

According to Art. 65 (1) EPC, the contracting states may prescribe that a translation has to be furnished in the national phase. According to the brochure "National Law relating to the EPC", table IV, the following steps are required in the respective contracting states:

- for validation in TR, the patent has to be translated into Turkish. The translation into Turkish should be filed within 3 months from the mention of the grant, hence until 28 February 2007, but can still be filed within further 3 months by payment of a surcharge. In addition, an authorised professional representative in Turkey has to be appointed.
- for validation in FR, it is too late to file the translation into French. However, restitutio according to national law in France can be tried.
- for validation in GB, no action has to be taken.

EXAMINATION COMMITTEE III

Candidate No.

Paper D 2007 Schedule of marks

Question	Maximum possible	Marks awarded	
		Marker	Marker

PART I

1	4		
2	4		
3	3		
4	6		
5	3		
6	5		
7	3		
8	4		
9	5		
10	3		
TOTAL PART I	40		

PART II

1	18		
2	14		
3	11		
4	5		
5	12		
TOTAL PART II	60		

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)

3 July 2007

Chairman Examination Committee III