

Examiners' Report - Paper D 2008 - Part I

This was the first EQE after entry into force of EPC 2000. Most Candidates demonstrated to be well familiar with the new provisions and thus they were able to collect most of the marks available for EPC 2000 issues, both in D1 and in D2.

The questions relating to EPC 2000 were generally well answered. As usual, it is essential that candidates give a complete and detailed legal basis including the appropriate articles and rules. This applies in particular to questions relating to the PCT. In general, mere citation of the guidelines, decisions or the applicant's guide may not be sufficient to gain full marks for a question.

In detail:

Question 1

The requirements for obtaining a filing date under EPC 2000 were well understood by the candidates. Also the formal requirements to start with the search were correctly listed.

Question 2

Most candidates recognised that the right to priority can be saved by filing a request for re-establishment of rights even though some candidates missed that the time limit for requesting re-establishment is calculated from the end of the missed priority period. Moreover, some candidates also failed to point out that it is necessary to actually file EP-X. The omitted act is not just claiming the priority but also filing said application.

Question 3

Most candidates recognized that the transitional provisions were to be applied. However, some answers were based on the provisions of Article 54(4) EPC 1973 together with Rule 138 EPC 2000 rather than Rule 87 EPC 1973. However, Rule 138 EPC 2000 is only applicable for existing national prior rights under Article 139(2) EPC 2000.

Question 4

Few candidates realised that the third party has to file proof that proceedings for infringement had been instituted against him. This is required according to Article 105(1)(a) EPC.

Question 5

The answer given to this question shows that some candidates cite case law without referring to the related provisions of the EPC. In this case, many cited J2/01 without mentioning Article 59 EPC and Article 118 EPC. Surprisingly few candidates mentioned that a new divisional application should be filed and that the rights should be transferred after filing thereof.

Question 6

The application was filed for all contracting states, i.e. including the US. Many candidates overlooked that the inventors X and Y were applicants for the US, though, and their signatures were required, too.

Question 7

Many candidates correctly mentioned that, in the European phase, the erroneously designated inventor must give his consent to the rectification.

Question 8

Some candidates cited Rule 90*bis*.3(d) PCT without realising that only time limits which had not yet lapsed before the withdrawal of the priority would be recalculated. These candidates wrongly concluded that a demand could still be filed.

Possible Solution - Paper D 2008 - Part I

Answer to question 1 (7 marks):

- a) It is possible to file a European patent application in Japanese, Article 14(2) EPC. The fax contains an indication that a European patent is sought, therefore, Rule 40(1)(a) EPC is fulfilled. Name and e-mail address, or fax response number, are sufficient for identification if they allow the applicant to be contacted, Rule 40(1)(b) EPC. The article is considered a description. Only a description is required (no claims necessary), Rule 40(1)(c) EPC. Filing by means of fax is possible, Rule 2(1) EPC, and decision of the President 12 July 2007, special edition Nr 3 of OJ 2007, page 7 or Guidelines A-II 1.2. All requirements of Rule 40 are fulfilled; according to Article 80 EPC, a date of filing is accorded.
- b) Appoint a representative, Article 133(2) EPC, Rule 57(h) EPC within two months from invitation according to Rule 58 EPC. File a translation into an official language of the EPO within two months from filing the application, Article 14(2) EPC, Rule 6(1) EPC, i.e. by 4 May 2008 (which is a Sunday), extended to 5 May 2008 (which is a holiday in The Hague), thus extended to 6 May 2008, or according to Rule 57(a) EPC, within two months from invitation according to Rule 58 EPC. Pay filing fee and search fee within one month of filing, Rule 38 EPC (i.e. until 4 April 2008). Use "request for grant" form (Form 1001) in order to fulfill Rule 41 EPC within two months from invitation according to Rule 58 EPC; Rule 57(b) EPC. File claims and abstract according to Article 78(1)(c) and (e) EPC, Rule 57(c) and (d) EPC, respectively, within two months from invitation according to Rule 58 EPC.

Answer to question 2 (5 marks):

The 12 month time limit of Article 87 (1) EPC expired on 26 February 08. A German utility model can be the basis for claiming priority for a European patent application, Article 87(1) EPC. Since DE-U is available to the public, it will be novelty-destroying for EP-X under Article 54 (2) EPC if the right of priority is not saved. A request for re-establishment according to Article 122 EPC should be filed and the fee be paid. The time limit for filing the request and paying the fee is two months from expiry of the priority period, Rule 136(1) EPC. This time limit ends on 26 April 08, which is a Saturday, extended to 28 April 08 according to Rule 134(1) EPC. The request should state the grounds and set out the facts on which it relies, Rule 136(2) EPC. Application EP-X must be filed within the two month period, Rule 136(2) EPC and the priority of DE-U must be claimed. The car accident and the subsequent stay in the hospital appear to be sufficient grounds for re-establishment (Guidelines E-VIII 2.2.1).

Answer to question 3 (4 marks):

Article 54(4) EPC1973 continues to apply to patents already granted at the time EPC2000 entered into force, see the transitional provisions, decision of the Administrative Council of 28 June 2001, Article 1, item 1 or OJ special edition 2007 Nr 1, page 197, or OJ special edition 2007 Nr 4, page 219. Therefore, Rule 87 EPC1973 continues to apply in this case (see the decision of the Administrative Council 7 December 2006, Article 2 amending the Implementing Regulations to the EPC2000). File a different set of claims for DE, FR, GB, and IT according to Rule 87 EPC1973, which makes reference to Article 54(4) EPC1973. Limited product claim(s) should be included.

Answer to question 4 (5 marks):

- a) Yes, according to Article 105 EPC, intervention of the assumed infringer is admissible during pending appeal proceedings, see G1/94 or G3/04. Within three months of the date of institution of the proceedings for infringement, Rule 89(1) EPC, i.e. until 10 April 2008, file notice of intervention in a written reasoned statement, Rule 89(2) EPC, and file proof that proceedings for infringement of the same patent have been instituted against company C, Article 105(1)(a) EPC. Moreover, the opposition fee has to be paid, Rule 89(2) EPC.
- b) Appeal proceedings after withdrawal of the sole appeal may not be continued with the intervener during appeal, see G3/04.

Answer to question 5 (4 marks):

According to Article 59 EPC, two applicants may file a European patent application designating different contracting states. According to Article 118 EPC applicants who each designated different states for an application shall be regarded as joint applicants, so that the unity of the application is not affected. The divisional application can only be filed in common, see J2/01 (OJ 2005, 88). Therefore EP-D is not treated as a divisional application.

According to Rule 36(1) EPC, the applicant may file a divisional application relating to any pending earlier application. A new divisional application can still be filed in the name of both applicants, Article 76 EPC, Rule 36(1) EPC. After filing, transfer of rights from applicant B to A may be performed.

Answer to question 6 (5 marks):

Publication can only be avoided by withdrawing the application. Notice of withdrawal has to be received at the International Bureau (IB) before completion of the technical preparations for publication; Article 21(5) PCT or Rule 90*bis*.1(c) PCT. Withdraw the application by filing a notice of withdrawal with the IB or the Receiving Office (RO) according to Rule 90*bis*.1(b) PCT.

The technical preparations are completed by the 15th day prior to the date of publication, which is around mid-March 2008 (Nr. 305 PCT Applicant's Guide). Better file the withdrawal at the IB to make sure it is received in time. The notice of withdrawal has to be signed by all applicants, Rule 90*bis*.5(a) PCT, which are companies B and D, and inventors X and Y, who are applicants for the US.

Answer to question 7 (5 marks):

Rectification in the international phase is possible: File a request with the IB to record a change in the person of the inventor by deleting Ms Grey and adding Ms White, Rule 92*bis*.1(a)(ii) PCT. The request must be received by the IB within 30 months from the priority date, Rule 92*bis*.1(b) PCT. This time limit expires on 21 March 2008 (possibly extended because of Good Friday and Easter Monday). The request may also be filed with the EPO as RO (see Applicant's Guide I 429) (which will then forward it to the IB).

Rectification is also possible in the European phase: Obtain the consent of the wrongly designated person, and then file a request with the EPO for rectification of the designation of inventor by deleting Ms Grey and adding Ms White Rule, 21(1) EPC. Rectification in the international phase is preferable because the signature of the erroneously designated person for her consent is not required.

Answer to question 8 (5 marks):

- a) Yes, the priority claim can be withdrawn until the expiration of 30 months from the priority date, Rule 90*bis*.3 (a) PCT, i.e. up to 14 June 2008, extended under Rule 80.5 PCT to 16 June 2008.
- b) The time limit for filing a demand expires 22 months after the priority date, Rule 54*bis*.1(a)(ii) PCT, or three months after transmittal of the International Search Report, Rule 54*bis*.1(a)(i) PCT. The 22 month time limit, computed from the original priority date, has already expired, i.e. on 14 October 2007 (extended under Rule 80.5 PCT to 15 October 2007). The three months time limit expired on 30 July 2007 (which is a Monday). Both time limits already expired. Therefore, withdrawal of the priority causes no change in the computation of this time limit, Rule 90*bis*.3 (d) PCT. Hence, it is too late to file demand for international preliminary examination.

EXAMINATION COMMITTEE III

Candidate No.

Paper D 2008 Schedule of marks

Question	Maximum possible	Marks awarded	
		Marker	Marker

PART I

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

PART II

1	22		
2	26,5		
3	11,5		
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)

1 July 2008

Chairman Examination Committee III