

Examiners' Report - Paper D 2009 - Part I

On the positive side, many candidates were generally showing a satisfactory knowledge of the individual relevant provisions and their sources. Nevertheless in some cases, out of date references were used. These candidates unnecessarily lost marks.

On the other hand, still too many candidates were losing marks for not showing that they can apply the law to the particular facts of the case. In particular, candidates are reminded that the purpose of paper D1 is to check their knowledge of the legal texts and how to apply the provisions to a particular set of facts. Hence, the given answer inevitably has to be supported with a citation of the relevant legal basis. Furthermore, it is important that candidates do not merely reproduce the wording of a legal provision but that they actually relate it to the facts presented in the question. Similarly, a simple reproduction of portions of the question also does not lead to marks.

Candidates are also reminded to cite the most relevant legal basis. For example, if an Article or Rule of the EPC is the most relevant provision to support an answer, then citing passages from the brochure "How to get a European Patent" is not sufficient.

Specific Remarks:

Question 1:

The question was generally well answered. In part b, some candidates wrongly considered that filing amendments is to be considered as filing of documents which have to be filed within a time limit and thus tried to apply Article 14(4) EPC.

Question 2

Relatively few candidates actually discussed the consequences of filing the opposition in each of the presented options in view of the planned transfer of company B to company C.

Question 3

The question was generally well answered. Most of the candidates recognized that a divisional application had to be filed and that the designation of Ireland in EP-1 had to be recovered.

Question 4

Some candidates did not use the latest version of the applicable schedule of fees resulting in a wrong reasoning. Moreover, many candidates were not aware that the EPO will debit the correct amount because the purpose of the payment was clearly indicated.

Question 5

Many candidates failed to clearly distinguish the language requirements for filing amendments, for filing requests, such as the demand for international preliminary examination or the request for examination, and for submitting other correspondence or further documents with the relevant authority. Moreover, many candidates failed to concretely respond to whether Romanian or English may be used for the different types of submissions. Some candidates wholly ignored the provisions of the PCT for the international phase by citing from the EPC instead.

Question 6

This question was generally very well answered. For part b, some candidates did not recognize that the registration of the exclusive licence is not possible because there is no consent from company B. Moreover, some marks were lost when candidates failed to mention that only an interested party is entitled to file a request for registration of a licence.

Question 7

This question was generally well answered. Many candidates did not cite Rule 81(1) EPC, which states that new grounds of opposition may still be examined by the opposition division of its own motion if they would prejudice the maintenance of the European patent.

Question 8

Quite a number of candidates seemed unaware that the date on which a fee is due is generally the first day on which it is payable, not the last, see Guidelines A-XI. Moreover, candidates overlooked that the designation fee and the examination fee are in fact due on the date of filing the divisional application due to the use of Form 1001 where examination is automatically requested.

Question 9

This question was answered very well by those who applied and cited the relevant transitional provision.

Possible Solution - Paper D 2009 - Part I

Answer to question 1:

- a) Yes, according to Article 14(2) EPC, European patent applications may be filed in any language, thus in Italian by a GB national living in UK. Translation of EP-1 in an official EPO language is required.
- b) No, amendments for EP-2 must be filed in the language of the proceedings, Rule 3(2) EPC. The language of the proceedings is the one in which the application was filed, Article 14(3) EPC. Here, this is French.
- c) No, a GB national living in the UK does not enjoy the language privilege under Article 14(4) EPC and should have filed the opposition in DE, EN or FR, Rule 3(1) EPC. Thus, the opposition to EP-3 is deemed not to have been filed, Article 14(4) EPC.

Answer to question 2:

Filing the opposition in the name of A alone: Even though it is possible to file the opposition in the name of company A alone, this is not advisable because it is not possible to transfer an opposition filed in the name of company A to another company, G2/04.

Filing the opposition in the name of B alone: Not being an employee of company B, you cannot validly file an opposition in the name of company B alone, Article 133(3) EPC.

Filing a joint opposition: Joint opposition is possible according to G3/99. It is the advisable approach in this situation. By this procedure, company B is joint opponent and will remain so even after being sold to company C. In the case of a joint opposition of A and B, no professional representative is needed since both companies have their place of business in one of the contracting states, Article 133 EPC, and company B remains joint opponent after sale to company C. In the case of joint opposition you, i.e. as an employee of A, can be the representative provided that A is common representative either by explicit statement in the notice of opposition or the first named opponent, Rule 151(1) EPC, G 3/99. Signatures of A and B are required but can be submitted later.

Answer to question 3:

Since the separate invention is not unitary with the claims of EP1, the applicant A has to file a divisional application claiming the separate invention, Article 76(1) EPC, Guidelines C-VI 9.1.2 or C-III 7.10, last paragraph. For the divisional application to designate Ireland, IE has to be designated in EP1 according to Article 76(2) EPC.

According to Rule 39(1) EPC, the time limit for the payment of designation fees is six months from the publication of the search report of EP1, which expires on 13 February 2009 (Friday). On 3 March 2009, it is too late to pay the designation fees for IE for EP1 according to Article 79(2) EPC. Therefore, the designation for IE is deemed to be withdrawn according to Rule 39(2) EPC.

However, the time limit for filing a request for further processing is still running; Article 121(1) and Rule 135(1) EPC, 20 February 2009 -> Rule 126(2) EPC: 2 March 2009 -> Rule 131(4) EPC: 2 May 2009, Saturday. -> Rule 134(1) EPC: 4 May 2009. It is necessary to pay the fee for further processing, Rule 135(1) EPC, i.e. 50% of the designation fee RFees (Article 2.12, 42,5 €) and to pay the designation fee for IE according to RFees (Article 2.3, 85 €).

The divisional application has to be filed while EP1 is pending, Rule 36(1) EPC.

Answer to question 4:

The renewal fee for the seventh year is 1000 €. A 50% surcharge has to be paid as well, i.e. a total of 1500 €, RFees Article 2, items 4 and 5. The indicated amount of 847€ is too low. However, the intention to debit the seventh year renewal fee was clearly indicated, therefore EPO has to debit the correct amount, GL A-XI, 7.1.2 or T 152/82 (OJ 7/1984, page 301) or Arrangements for deposit accounts (ADA) 5.2, Addition to OJ 10/1007, page 16. Hence, the fee was validly paid.

Answer to question 5:

a) The application has been filed in French, and French is a language of publication. Hence, the demand has to be filed in French, Rule 55.1 PCT. According to Rule 12.2(a) PCT amendments have to be filed in the language in which the application is filed. Further correspondence to the EPO as IPEA can be filed in English, Rule 92.2(b) PCT and OJ 2007, 617.

b) Amendments have to be filed in French in the European phase, Rule 3(2) EPC and Article 153(2) EPC. Documents which have to be filed within a time limit may be filed in English or Romanian, Article 14(1) and (4) EPC. Other correspondence with the EPO may be filed in English Rule 3(1) EPC.

Answer to question 6:

a) Yes, the registration of the grant of a licence is possible, Rule 23(1) EPC. According to Rule 23(1) EPC, Rule 22 EPC, paragraphs 1 and 2, applies mutatis mutandis. A is an interested party in the sense of Rule 22(1) EPC and therefore is entitled to request the registration alone. A must file a request for registration. Sufficient evidence of the licensing contract must be provided. The administrative fee mentioned in Rule 22(2) EPC must be paid.

b) According to Rule 24 a) EPC, the recording of the licence as an exclusive licence is only possible if the applicant and the licensee so request. Since applicant B does not consent to the recording of A's licence as an exclusive licence, the recording thereof is not possible.

Answer to question 7:

Yes, although after his withdrawal your client is no longer a party to the opposition proceedings, it is possible to file this document as third party observations under Article 115, Rule 114 EPC. However, observations can only be taken into account until proceedings have been terminated, (Guidelines E-VI, 3.).

The EPO can continue the proceedings of its own motion if the opposition is withdrawn, Rule 84(2) EPC. Although novelty is a ground for opposition which was not raised during the opposition period, new grounds may still be considered by the opposition division under Article 114(1) EPC if the document supporting these grounds is prima facie relevant, Rule 81(1) EPC (see also G9/91 and/or G10/91).

Answer to question 8:

Filing and search fee according to Article 78(2) EPC are due. They may be paid up to one month from filing, Rule 36(3) EPC, i.e. 3 April 2009. The search fee is reimbursed, Article 9(2) RFees.

Claims fees for 5 claims are due, Rule 45(1) EPC. They may be paid up to one month from filing of the claims or within one month of a communication concerning the failure to observe the time limit of Rule 45(2) EPC.

Examination fee, Article 94(1) EPC, is due on the date of filing because of the request for examination in form 1001, see Article 4(1) RFees or Guidelines A-XI, 5.2.2. It may be paid up to six months from the date, on which the European Patent Bulletin mentions the publication of the search report, Rule 70(1) EPC.

Designation fees, Article 79(2) EPC, are due on filing, Guidelines, A-XI, 5.2.1. They may be paid up to six months from the date, on which the European Patent Bulletin mentions the publication of the search report, Rule 36(4) EPC.

The amounts of the fees are defined in Art. 2 RFees.

Answer to question 9:

Although according to Article 76(1) EPC the divisional is deemed to have been filed on the date of filing of the earlier application, the date of receipt of the divisional application determines the applicability of the EPC2000, Notice from the EPO, 20 September 2007, OJ 10/2007 page 504 or Article 7(1) Revision Act or Article 1(1) Transitional Provisions. Therefore, Article 54(3) EPC2000 applies. The divisional application was made pending only after entry into force of EPC2000.

Consequently, D1 is novelty destroying under Article 54(1) and (3) EPC2000 for the subject-matter of all claims of the divisional application for all contracting states. D2 is still novelty destroying according to Article 54(2) EPC2000 for the subject-matter of claim 1.

EXAMINATION COMMITTEE III

Candidate No.

Paper D 2009 Schedule of marks

Question	Maximum possible	Marks awarded	
		Marker	Marker

PART I

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

PART II

1	8		
2	11		
3	13		
4	19,5		
5	8,5		
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)

30 June 2009

Chairman Examination Committee III