

Examiners' Report Paper D 2010 - Part I

General Remarks

As always, reading the questions carefully is crucial for formulating a correct and complete response. It is essential to work with up to date material. The citation of most appropriate legal bases is required in this paper, although the mere citation of a legal basis cannot constitute an answer to a question and will not earn enough marks to pass the paper. Similarly, simply reproducing the facts of a question does not gain any marks. In preparing for the examination, candidates are reminded to consult the Examination Syllabus as defined in Article 13 REE and the corresponding provisions in the IPREE.

Question 1

Some candidates had difficulties in determining the degree to which the opposition division can examine of its own motion: (i) the extent to which a patent is opposed; and (ii) the grounds of opposition.

Question 2

Here it was important that candidates realise the requirements for filing divisional applications, especially concerning a chain of divisional applications and the subject-matter disclosed in each member of the chain. In addition candidates were expected to apply Article 76(1) EPC and Article 123(2) EPC. While the former defines requirements relating to the filing of a divisional application, the latter has to be observed for all European patent applications when examining amendments.

Question 3

This question was directed to PCT proceedings. Replies based on the EPC are not correct and could not be awarded any marks. The PCT has its own provisions for both claiming priority, including a reference to the Paris Convention, and restoration of priority rights. Rule 26*bis*.3 PCT includes detailed provisions split across ten paragraphs (a) to (j), some of which are relevant to this question. It is necessary to cite the relevant paragraphs in order to gain full marks.

Question 4

Even though most candidates saw that EP-A cannot serve as a basis for claiming priority, some candidates did not conclude that the effective date of PCT-A is therefore its filing date. Consequently, the pre-published CN-A constitutes prior art for the PCT application.

Question 5

This question was generally answered either very well or rather badly. The question had one key point: where the EPO carries out a supplementary search report, applicants can take advantage of the opportunity to amend the claims.

Question 6

Candidates were expected to answer basic questions on the effects of a European patent in the national law of Contracting States. The framework for these effects derives from the EPC and candidates should be acquainted with them.

Question 7

The comments for question 6 apply. It was acknowledged that candidates did not have a calendar for 2012 and would not know that this is a leap year. Consequently, the exact date was not required to get full marks.

Question 8

One independent claim having 24 dependent claims add up to a total of 25 claims. Consequently, claims 16 to 25 represent ten claims and not nine. This is important because subject-matter which is only disclosed in a claim is irrevocably abandoned if the claim fee is not paid.

Question 9

Many candidates did not cite the specific provision for the stay of proceedings in opposition. Some candidates had difficulty establishing when the time limit set by the communication expired.

Possible Solution - Paper D 2010 - Part I

Answer to question 1:

The extent of the opposition is determined by the notice of opposition, Rule 76(2)(c) EPC. The process claim 2 was not attacked in the notice of opposition. As a consequence, the opposition is limited to the subject-matter of the product claim 1, G9/91 or G10/91. The request will be rejected with respect to claim 2.

With respect to the product claim 1, novelty is a fresh ground of opposition, G7/95. Document Dn is late filed and therefore may be disregarded, Article 114(2) EPC or Rule 116(1) EPC. However, the opposition division will assess *prima facie* the relevance of the new document Dn and the fresh ground of opposition, and based on the relevance continue of its own motion, Rule 81(1) EPC, second sentence or G10/91.

Answer to question 2:

A divisional application can serve as an earlier application in the sense of Article 76(1) EPC, i.e. parent application, G1/05 or G1/06. Hence, DIV-2 is a valid divisional application of DIV-1. However, DIV-2 does not fulfil Article 76(1) EPC since the method is not disclosed in DIV-1. DIV2 can however be amended with respect to Article 76(1) EPC even when the earlier application is no longer pending (G1/05 or G1/06). Thus, amend DIV-2 by deleting all contents referring to the method.

A claim directed to a football with a variable number of patches is not possible as it would extend beyond the content of the application as originally filed because the 33 patches are disclosed as being essential for achieving the technical effect, Article 123(2) EPC.

Since the football with 33 patches made of PX is disclosed in both EP-1 and DIV-1 you can keep it in DIV-2 (G1/05 or G1/06).

Answer to question 3:

- a) No, the priority has not been validly claimed. The time limit for claiming priority according to Article 4.C(1) of the Paris Convention, to which Article 8(2)(a) PCT makes reference, expired on 27 February 2010. This is a Saturday and is thus carried on to Monday, 1 March 2010 according to Rule 2.4 PCT and Rule 80.5 PCT. As a consequence the letter with PCT-X is received late, after the end of the priority year.
- b) Restoration of the right of priority by the Receiving Office is possible according to Rule 26bis.3(a) PCT since the failure to file the international application within the priority period occurred in spite of due care. According to Rule 26bis.3(b)(i) and (e) PCT the request for re-establishment must be filed within two months of the expiry of the priority period, i.e. at the latest on 3 May 2010 (Monday). The request for re-establishment should contain all the relevant facts and circumstances, Rule 26bis.3(b)(ii)PCT. The prescribed fee, according to Rule 26bis.3(d) PCT, must be paid within two months, Rule 26bis.3(e) PCT. The fee is 550 Euros according to RFees Article 2.13.

Answer to question 4:

- a) The filing date according to Article 80 EPC is the date on which the filed documents contain, according to Rule 40(1) EPC: an indication that a European patent is sought; information identifying the applicant or allowing the applicant to be contacted (letterhead); and a reference to a previously filed application. According to Rule 40(2) EPC the reference has to include the filing date and number. Further, the applicant must have provided a certified copy to the EPO, Rule 40(3) EPC, Rule 55 EPC.
- b) The exceptional situation according to Article 4.C Paris Convention does not apply for any of the following reasons: CN-A was not filed in or for the same state; CN-A was not withdrawn before filing EP-A; or CN-A was published. The international application cannot validly claim priority from EP-A because it is not the first application in the sense of Article 4 Paris Convention, Article 8(2)(a) PCT. The effective date of PCT-A would therefore be its filing date. CN-A would be pre-published prior art and would be novelty destroying for PCT-A.

Answer to question 5:

For PCT-U, the EPO will draw up a supplementary European search report since the USPTO was the International Searching Authority (ISA), Article 153(7) EPC, on the invention first mentioned in the claims, i.e. presently PCT-U1, Rule 164(1) EPC. To continue with the second invention PCT-U2, upon receipt of the communication according to Rule 161 EPC, the application should be amended to make PCT-U2 the invention first mentioned in the claims. Alternatively, claims relating to PCT-U1 should be deleted. Thus, the EPO will draw up the supplementary European search report based on PCT-U2.

For PCT-E, there will be no supplementary European search report since the EPO was the ISA, Decision of the Administrative Council dated 25 October 2007 or OJ 2007 page 642. Hence, USCO can only proceed with the searched invention, i.e. PCT-E1, Rule 164(2) EPC, even if PCT-E is amended to make PCT-E2 the invention first mentioned in the claims. A divisional application will have to be filed directed to PCT-E2.

Answer to question 6:

Italy requires translation of the patent specification within three months from mention of the grant in the Bulletin according to Article 65(1) EPC and National law relating to the EPC, Table IV or OJ 2008 page 123. The three months period ended 9 February 2010, hence the translation was duly filed.

Italy has adopted the provision pursuant to Article 70(3) EPC, see National law relating to the EPC, Table V. Because the translated claim is narrower than the claim in the language of the proceedings, the translation is regarded as authentic in Italy.

According to Article 70(4)(a) EPC, X may file a corrected translation. Nevertheless, Y is allowed to continue to produce and sell even after the corrected translation was made available because Italy has made provision pursuant to Article 70(4)(b) EPC, see National law relating to the EPC, Table V. Thus, X cannot stop Y. However, if Y did not act in good faith according to Article 70(4)(b) EPC, X can stop Y.

Answer to question 7:

- a) According to Article 86(1) and Rule 51 (1) EPC the first renewal fee is due on 28 February 2010 (Sunday). However, payment may be made until 1 March 2010.
- b) The first renewal fee for FR and DK is due on 28 February 2011, National law relating to the EPC, table VI, column 2a, Article 141(1) EPC. The first renewal fee for IT is due on 29 February 2012, National law relating to the EPC, table VI, column 2.a, Article 141(1) EPC. All renewal fees can be paid without surcharge until the respective date, National law relating to the EPC, table VI, column 2.b.
- c) According to Article 1(1) of the London Agreement (LA) on the application of Article 65 EPC, no translation has to be supplied for FR, National law relating to the EPC, Table IV, column 2. DK requires the translation of the claims into Danish, Article 1(2) and (3) LA, National law relating to the EPC, Table IV, column 2. IT did not sign the London Agreement, thus a complete translation into Italian is required, National law relating to the EPC, Table IV, column 2.

Answer to question 8:

- a) According to Rule 45 (1) EPC, the 16th and each subsequent claim incurs payment of a claims fee. The fees for claims 16 to 25, i.e. ten claims, is $10 \times 200 \text{ EUR} = 2000 \text{ EUR}$; RFees 2.15. Since EP1 was filed by reference the applicant has two months from the communication under Rule 55 EPC informing the applicant of the requirement to file a certified copy of US1 according to Rule 40(3) EPC. Only then can the EPO see how many claims are comprised within US1 and send out a communication according to Rule 45(2) EPC inviting the applicant to pay ten claims fees within one month of this communication.
- b) Do not pay claims fees for claims 16 to 25. According to Rule 45(3) EPC the claims for which the fees have not been paid in due time shall be deemed to be abandoned.
- c) According to J15/88 additional claims 16 to 25 can only be reintroduced during the examination proceedings if the corresponding features were part of the original description or drawings. In that case an additional ten claims fees have to be paid before grant of EP1 according to Rule 71(6) EPC. This amounts to $10 \times 200 \text{ EUR} = 2000 \text{ EUR}$, RFees 2.15.

Answer to question 9:

Rule 78(1) is relevant for the stay of opposition proceedings. According to Rule 78(1), Rule 14(2) to (4) shall apply mutatis mutandis. Without the stay of the opposition proceedings the four month period would have expired: 5 January 2009 plus 10 days (Rule 126(2)) which is 15 January 2009, plus four months (Rule 131(4)) which is 15 May 2009. The four month period was running at the date of the stay of opposition proceedings and was therefore interrupted, Rule 78(1) in combination with Rule 14(4). The time which has not yet elapsed shall begin to run from the date on which opposition proceedings are resumed, Rule 78(1) EPC in combination with Rule 14(4) EPC. The time which has not yet elapsed is one week (i.e. 8 May 2009 to 15 May 2009). According to Rule 14(4) EPC, the time still

to run after a resumption shall not be less than two months. Hence, the four month period expires on 3 March 2010.

EXAMINATION COMMITTEE IIICandidate No.

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Paper D 2010 - Marking Sheet

		Maximum possible	Marks awarded	
			Marker	Marker
Part I	Question 1	4		
	Question 2	5		
	Question 3	5		
	Question 4	4		
	Question 5	4		
	Question 6	5		
	Question 7	4		
	Question 8	5		
	Question 9	4		
Part II	Question 1	14		
	Question 2	23		
	Question 3	19		
	Question 4	4		
Total Part I + II		100		

Examination Committee III agrees on marks and recommends the following grade to the Examination Board:

☐ PASS
(50-100)☐ COMPENSABLE FAIL
(45-49)☐ FAIL
(0-44)

30 June 2010

Chairman of Examination Committee III