

Examiner's Report Paper D 2011 - Part I

Generally, the candidates were able to deal with basic legal issues such as calculating time limits. As in the recent years questions pointing to the EPC were better answered than those dealing with the PCT. The candidates referred to the appropriate legal basis, however not always with the necessary accuracy. This applies in particular to PCT articles and rules.

Question 1

The majority of candidates realised that the period for filing an opposition has expired and that "Intervention of the assumed infringer" under Art. 105 EPC and "Observations by third parties" under Art. 115 EPC provide two possible options for company A. Some candidates realised that a warning letter does not mean that infringement proceedings have been instituted within the meaning of Art. 105(1)(a) EPC.

Question 2

For full marks, all aspects of the questions had to be dealt with, in particular the distinction between the invitations according to Rule 62a(1) EPC and Rule 70a(1) EPC, as well as the prosecution of the subject-matter of claim 3.

Question 3

Many candidates correctly stated that incorporation by reference is a remedy for the missing claims upon filing. However, some of these could have collected full marks if they had realised that the notification under Rule 20.4(i) PCT had not yet been issued and that consequently the incorporation by reference could still be confirmed.

Question 4

The question was generally answered well. However, full marks were only given to candidates who were aware that client C:

- had to attack claims 1 and 2 in order to ensure that claim 1 fell irrespective of the outcome of the limitation proceedings, and
- is of Spanish nationality and therefore qualifies for the fee reduction independently of his place of residence.

Question 5

The majority of candidates dealt well with this question and recognised the crucial point that filing a European patent application by reference today appeared to be the only solution to the situation. For all marks to be obtained, all the requirements for filing by reference had to be given, and in particular the requirement for a filing date had to be recognised.

Question 6

Again, full marks could only be given to candidates who indicated in detail what steps had to be taken in the present case for valid entry into the European phase, and that failure to perform some of these steps led to the application being deemed to be withdrawn.

Further, it had to be stated that the two-month time limit for requesting further processing according to Art. 121(1) and Rule 135(1) EPC is triggered by the notification of loss of rights under Rule 112(1) EPC, which had not yet been received.

Question 7

Many candidates drew the correct conclusion that the amendment requested by P contravened Art. 123(2) EPC, which was a new ground for opposition, admissible only with P's consent. A full analysis distinguished between the different sets of claims granted for the different contracting states.

Question 8

Most candidates were well aware of the possibility to correct the priority of a European patent application and of the time limits to be observed. It was important to recognise that the relevant 16-month time period runs from the earliest priority date (FR2). Few candidates realised that EP1 could claim priority from FR1 if the application was re-dated according to Rule 56(2) EPC as a result of filing the missing drawing today.

Possible solution - Paper D 2011 - Part I

Answer to question 1

Since the opposition period expired on 28 January 2011 a further opposition cannot be filed, Art 99(1) EPC.

a) One option for Company A is to intervene in the opposition proceedings. To do so, they need to institute proceedings for a court ruling that they are not infringing, Art. 105 (1)(b) EPC.

Within 3 months from institution of the proceedings, Company A needs to

- file a notice of intervention in a written reasoned statement based on the novelty-destroying prior art, and
- pay the opposition fee, Rule 89(1), (2) EPC.

b) Third party observations could be filed according to Art 115 EPC based on the novelty-destroying prior art. The observations must be filed in writing and the grounds on which they are based have to be stated, Rule 114(1) EPC.

For completeness, it is noted that, by intervening, the assumed infringer will be treated as an opponent, Art.105(2) EPC, whereas by filing third party observations, the assumed infringer will not become a party to the proceedings.

A less preferred option would be to make the opponent aware of the novelty-destroying prior art.

Answer to question 2

a) The time limit for replying to the first invitation is 2 months; Rule 62a(1) EPC.

Thus: 09 April 2010 + 10 days (Rule 126(2)EPC) gives 19 April 2010 + 2 months, resulting in 19 June 2010, which was a Saturday. Therefore the time limit was extended to Monday, 21 June 2010, according to Rule 134(1)EPC, and has expired.

As a means of legal redress, further processing is excluded by Rule 135(2)EPC and, moreover, makes no sense since the search report had already been published, thus already established before that.

Even though re-establishment of rights according to Art. 122 EPC would be possible, it is not likely to be granted (lack of any hint in the question).

The time limit for replying to the second invitation is 6 months after the mention of the publication of the European search report, Rule 70a(1) and Rule 70(1)EPC, i.e. 25 February 2011, and thus has also already expired (today is 1 March 2011).

However, further processing is possible for the second time limit, Rule 135(2) EPC.

Thus:

- the European search opinion should be replied to, and further processing should be requested by payment of the corresponding fee, Rule 135(1)EPC, Art. 2(1) No.12 RFees
- the examination fee and the respective further processing fee should be paid.

b) Since claim 3 was not searched, amended claims may not relate to this subject-matter, Rule 137(5) last sentence, EPC.

Since there is no communication from the Examining Division yet, the 24-month time limit has not yet been triggered, Rule 36(1)(a) EPC. Hence, a divisional application for the subject-matter of claim 3 can be filed. For this purpose, EP1 must be pending according to Rule 36(1) EPC (cf. GL-A-IV-1.1.1.1 and G1/09).

Answer to question 3

According to Art. 11(1)(iii)(e) PCT, no international filing date has been accorded since the claims were missing.

In order to avoid re-dating the application which would render the conference novelty destroying, the applicant should, according to Rule 20.3(a)(ii) PCT, confirm that the claims are incorporated by reference according to Rules 4.18 PCT and 20.6(a) PCT. By default, the current Form PCT/RO/101 contains a statement of incorporation by reference under Rule 4.18 PCT.

The time limit for requesting incorporation by reference is two months from the date of the letter from the EPO, Rule 20.7(a)(i) PCT, i.e. 15.02.2011, Rule 80.6 PCT. Today is 1 March 2011, thus the time limit has lapsed.

However, according to Rule 20.7(b) PCT, the confirmation of incorporation by reference is to be considered to have been received within the time limit if the notification under Rule 20.4(i) PCT had not been sent, which applies here. Therefore, it is possible to save the filing date by immediately confirming the incorporation by reference, Rule 20.6(b) and 20.3(b)(ii) PCT.

Answer to question 4

a) The limitation fee (Art. 105a(1) EPC) amounts to €1050, Art. 2(1) No. 10a RFees and a reduction of 20 % (Rule 6(3) EPC, Art. 14(1) RFees) applies if Spanish is used for the request for limitation ($€1050 - 20\% = €840$). Further, the publication fee has to be paid pursuant to Rule 95(3), Art. 2(1) No. 8 RFees.

b) Even though third party observations according to Art. 115 EPC are possible in limitation proceedings, patentability, e.g. novelty, is not examined, Rule 95(2) EPC. The EPO does not consider such observations. Therefore, third party observations are pointless.

The opposition period expires on 02 March 2011, Art. 99(1) EPC. Therefore, opposition should be filed against EP in its entirety based on document X by tomorrow. In addition, filing an opposition terminates the pending limitation proceedings, Rule 93(2) EPC. Therefore the limitation fee has to be reimbursed, Rule 93(2), 2nd sentence EPC.

Answer to question 5

The European patent application has to be filed no later than today. Otherwise the symposium will constitute prior art according to Art. 54(2) EPC since it anticipates subject-matter Y. Since the priority period of IS1 has expired, no priority can be claimed, Art. 87(1) EPC. The EP application has to be filed by reference because you are not in possession of a copy of IS1, Rule 40(1)(c) EPC. To this end, you need to

- indicate that a patent is sought, Rule 40(1)(a) EPC,
- indicate the name or contact information of the applicant, Rule 40(1)(b) EPC,
- state the office, filing date and number of IS1, Rule 40(2) EPC.

Since the exact filing date is unknown, you cannot fulfil the requirements of Rule 40 EPC immediately without further action. For instance, you might be able to obtain the filing date e.g. by contacting the Icelandic Patent Office, or you could indicate a probable filing date and subsequently request correction under Rule 139 EPC if necessary.

Answer to question 6

According to Rule 159(1) EPC the period for entering the European phase expires 31 months after the priority date, i.e. 3 July 2008 + 31m = 3 February 2011.

By then, the following requirements should have been fulfilled:

- specify the application documents, Rule 159(1)(b) EPC
- file the request for examination (already included in Form 1200), Rule 159(1)(f) EPC and pay the examination fee
- pay the filing fee, Rule 159(1)(c) EPC
- pay the designation fee, Rule 159(1)(d) EPC
- pay the search fee for the supplementary European search, Rule 159(1)(e) EPC (which will be reduced since an international search report from the USPTO is available, OJ 03/2010, p.138)

To fulfil the requirements of Rule 159(1)(b) EPC, the application documents have to be specified. Further, since none of the requirements of Rule 159(1)(c) - (f) EPC have been fulfilled, the application is deemed to be withdrawn according to Rule 160(1) EPC.

Therefore, further processing according to Art. 121(1) and Rule 135(1) EPC should be requested with respect to each of these requirements at the latest two months from a notification under Rule 112(1) EPC which has not yet been received. The applicant has to perform the omitted acts as required by Rule 135(1) EPC within the above time limit.

Within this time limit, the following fees for further processing have to be paid according to Art 2(1) No.12 RFees:

- 50% of each of the fees for examination, designation, filing and search, and
- the fee for the late submission of the request for examination (€225)

Additionally, within the 31-month time period, claims fees should have been paid for claims exceeding 15, in the present case 2 claims fees, Rule 162(1) EPC. However, these fees can still be paid within one month from a communication under Rule 162(2) EPC (as in force until 30 April 2011).

Answer to question 7

P requests the maintenance of the patent based on claim A as granted for DE and FR. As far as these states are concerned, the claim is not open to an objection under Art. 123(2) EPC, since Art. 100(c) EPC is not admissible as a ground for opposition unless the patent proprietor consents, G9/91, G10/91 or G1/95, G7/95.

The claim of the request with respect to AT and BE represents an amendment and is thus subject to a full examination as to its compatibility with the requirements of the EPC, including the provisions of Art. 123(2) EPC. A change to claim A for AT and BE would violate Art.123(2) EPC since X was not originally disclosed.

Therefore, the patent cannot be maintained based on claim A for all of DE, FR, AT, and BE.

Answer to question 8

The article was published after the filing date of FR1 but before the filing date of EP1. To prevent the article constituting novelty-destroying prior art according to Article 54(2) EPC, the priority of FR1 must be claimed.

The priority can be corrected within 16 months from the earliest priority date claimed, or, where the correction would cause a change in the earliest priority date claimed, within 16 months from the corrected earliest priority date, whichever 16-month period expires first, provided that such a notice may be submitted until the expiration of 4 months from the date of filing accorded to the European patent application, Rule 52(3), EPC. The 16-month periods respectively expire on

- 01 July 2011 for FR1 and
- 22 February 2011 for FR2

Thus, the relevant 16-month period expired on 22 February 2011. The 4-month time limit from filing of EP1 also expired on 22 February 2011.

To be able to correct the declaration of priority, it is necessary to file the missing drawing, so that the 4-month time limit starts running from the new date of filing and can be observed.

Missing drawings can be filed within two months of the invitation, Rule 56(1) EPC, i.e. 4 January 2011 +10 days (Rule 126(2) EPC) + 2 months = 14 March 2011.

When the missing drawing is filed, the application will be re-dated, Rule 56(2) EPC. Since the twelve-month priority period for FR1 expires today, Art. 87(1) EPC, the applicant has to file the missing drawing today (1 March 2011).

The 4 month time limit for correction of the declaration of priority will then expire on 1 July 2011. By that date, the applicant has to correct the declaration of priority.

Alternatively, the applicant may request correction of the priority declaration according to GL, A-V, 3 or the case law referred to therein.

EXAMINATION COMMITTEE III

Candidate No.

Paper D 2011 - Marking Sheet

		Maximum possible	Marks awarded	
			Marker	Marker
Part I	Question 1	4		
	Question 2	6		
	Question 3	5		
	Question 4	5		
	Question 5	3		
	Question 6	6		
	Question 7	4		
	Question 8	7		
Part II	Question 1	35		
	Question 2	11		
	Question 3	10		
	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)

29 June 2011

Chairman of Examination Committee III