

Training for EQE 2015

Main Exam Legal

**KNOWN ERRORS & CORRECTIONS FOR
MAY 2014 EDITION**

Questions – Answers – Comments

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DELTA PATENTS

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Main-Exam Questions

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General updates and comments

- The GL references in the April 2014 book were all to the 2013 version. However in most cases, the GL references have remained the same for the 2014 version. Where it is different chapter or paragraph, we have included them in this update
- In many of our answers, the legal basis in the answer indicated which sentence of a particular article or rule. This is misleading for the exam – the sentence number should only be given in very exceptional cases where the sentences deal with completely different legal provisions. Such as R.40(3) EPC and R.139(1) EPC. Even for these exceptional provisions, the sentence number is not required for full points on the exam. H14-13 has been updated already, and has been included in this errata.
- A number of questions simply ask “Legal situation?”. This formulation is no longer used on the D paper as the Examination Committee prefers to direct the answer to the issues they want to see in the answer. So we be updating these questions in future editions. E-07 and L2-18 has been updated already, and are included in this errata.
- We do not include DI questions from the last five years to avoid spoiling any exam training. So make sure you do at least the D papers of 2014-2010 before the exam.

EPC: SUBSTANTIVE PATENT LAW

B4 – Languages; Translations of applications

An additional comment has been added to explain answer (e):

B4-01

(EQE – 12 points)

Today is 24 February 2015. In which of the following cases is the applicant filing a European patent application entitled to a reduction in the filing fee?

- (a) A British national, resident in Sweden, files a European patent application in Swedish.
- (b) An Argentinean national, resident in France, files a European patent application in Spanish.
- (c) A Swiss national, resident in the USA, files a European patent application in Italian.
- (d) A Spanish European patent attorney files a European patent application in Spanish for a natural person who is resident in and a national of Andorra.
- (e) A firm whose principal place of business is in Germany and a Belgian national who is resident in Germany together file a European patent application in Dutch. The firm employs only ten people with an annual turnover of 1 million Euros.
- (f) A Dutch national files a European patent application with a description in Dutch, and at the same time he files a set of claims in English.
- (g) A Spanish national files a European patent application with reference to a previously filed Spanish application in Spanish, and at the same time he files a set of claims in French.

Answer

EPC

A.14(4) person is entitled to 30% reduction if filed in corresponding A.14(4) language - R.6(3); RFees 14(1)

- (a) Yes
 - Sole applicant is an A.14(4) natural person – R.6(4)(b) – and resident in Sweden
 - So filing in Swedish benefits from the 30% reduction
- (b) No
 - Argentina is not EPC Contracting State
 - Spanish is not official language of France
- (c) Yes
 - Italian is official language of Switzerland - Nat Law, Tab II, col 4
 - Sole applicant is an A.14(4) natural person, so filing in Italian benefits from the reduction
- (d) No
 - Andorra is not an EPC Contracting State
 - A.14(4) relates to applicant, not to his representative, so it is irrelevant where representative has his business - T149/85
- (e) No
 - Belgian applicant is an A.14(4) person
 - German company is considered an SME – R.6(4)(a), R.6(5)
 - but all applicants must be A.14(4) persons – R.6(7)
 - the German company is not – OJ 2014, A23
- (f) Yes
 - Sole applicant is an A.14(4) natural person
 - For filing, description is essential element, and that is satisfied here – G6/91, J4/88, GL (2014) A-X, 9.2.2
- (g) Yes
 - Sole applicant is an A.14(4) natural person
 - Legally, no difference between direct filing in Spanish and filing by reference to earlier Spanish application – R.40(1)(c)
 - So reference provides essential element of filing - GL (2014) A-II, 4.1.3.1

Comment

- Based on Question 3 of Paper DI of EQE 1985 [5 points (adapted)]

- *For application filed on or after 1 April 2014, and for PCT applications entering the EP phase, the broad 20% fee reduction system has been replaced by a narrow 30% fee reduction. It is applicable only for the filing and examination fees, and for natural persons, small or medium enterprises, non-profit organisations, universities, and public research organisations. OJ 2014, A4 and A23*
- *A declaration must also be made – R.6(6) – that all of the applicants comply with R.6(4) and may benefit from the reduction. This is possible using Form 1001[RFQ] Box 14.1] or a separate declaration [Form 1011]*
- *The limitation that all applicants must also comply with A.14(4) for the fee reduction is not found in the law, but in OJ 2014, A23, section 2:
.... whose residence or principal place of business is in an EPC contracting state with an official language other than English, French or German, and nationals of such states who are resident abroad.*
- *R.6(7) itself only explicitly requires compliance for all applicants with R.6(4) – applying only the law strictly to part (e) would mean that the answer was yes – the reduction is possible.*
- *The Rule 6 FAQ (<http://www.epo.org/service-support/faq/procedure-law/language-related-fee-reductions.html#faq-723>) on the EPO web-site supports our interpretation:*
 - *In case of multiple applicants, is it sufficient if only one of them is eligible within the meaning of Rule 6(4) EPC?*
 - *No, Rule 6(7) EPC stipulates that in such a case each applicant must be an entity or a natural person within the meaning of Rule 6(4) EPC for the fee reduction to apply (cf. also point 6 of the notice from the EPO dated 10.01.2014, in OJ EPO 2014, A23). If for instance an SME with place of business in Italy files a European patent application together with its business partner, an SME with place of business in France, and in doing so files a request for examination in Italian, no reduction of the examination fee will apply, because the language criterion is not fulfilled by the French co-applicant.*
- *The translation into an EPO language must be filed within 2m of filing – R.6(1) or R.40(3)*

E – Rights conferred by a Patent and by an Application

GL references corrected, and question made more direct:

E-07

(6 points)

European patent application EP1 includes a first independent claim “Process X including ...” and a second independent claim “Product Y obtained by process X of claim 1”. During substantive examination, the Examiner indicates the intention to refuse the second independent claim referring to A.64(2) EPC. It is acknowledged that process X is new and inventive.

- (a) May the applicant pursue both claims?
 (b) How would patentability change if the Examiner provided evidence of the public availability of product Y before the relevant date of EP1?

Answer

EPC

(a) :

- Claim 2 = “product by process” claim, which is allowed if no other definition is possible - GL (2014) F-IV, 4.12
- Examiner could consider second claim as superfluous, since A.64(2) already gives protection for the directly obtained product
- But scope of protection for the product based on claims 1 and 2 are different
 - Claim 2 is the broadest and protects the product Y however it is produced
 - Claim 1 only protects the product directly-obtained from process X
- So the applicant is entitled to pursue second claim assuming other criteria are met

(b) :

- So product Y is not new - A.54(2)
- Process X being new does not make the obtained product Y new
- So the Examiner is right in refusing the second claim
- Even though product Y is not new, the directly obtained products of Process X still fall under the claim – A.64(2)

Comment

- *For product-by-process claims, see GL (2014) F-IV, 4.12*
- *It is a common mistake on the EQE to confuse “product-by-process” claims with Article 64(2).*
- *Case a) is not considered “double patenting” - GL (2014) G-V, 5.4*
- *A.64(2) is a tool to assist in infringement cases for methods because of the difficulty in determining what method/process an alleged infringer is actually using.*

EPC: PROCEDURAL LAW

H – PROCEDURE

H5 – Publication of the patent application

Dates updated and answer re-written:

H5-05

(6 points)

A European patent application is filed on 7 January 2015 claiming priority of a French patent application filed on 9 January 2014.

- (a) When will the patent application be published?
- (b) In what form is the application published?
- (c) What is the last day for withdrawing the patent application to be sure that publication is prevented? What if we miss this deadline by two or three days?

Answer

EPC

- (a)
 - Appln published as soon as possible after - A.93(1)(a):
9/1/14 + 18m [R.131(4)] => 9/7/15 (Thu)
 - First possible day of publication is on 15/7/15 (Wed)
- (b) Will be published in electronic form on publication server - R.68(2); OJ2007-SE3-D.3; GL (2014) A-VI, 1.4
- (c) R.67(1), R.67(2) + OJ2007-SE3-D.1:
 - Technical preparations for publication are deemed completed at the end of the day:
9/7/15 – 5w [R.131(5)] => 4/6/15 (Thu)
 - So last day for withdrawing appln is 4/6/15 if non-publication is to be guaranteed

OJ2006, 406:

 - If withdrawal is received later than 4/6/15, EPO cannot guarantee non-publication
 - But they will make an effort on a case-to-case basis - J5/81; GL (2014) A-VI, 1.2
 - In practice, publication can often be prevented if withdrawal received at latest:
15/7/15 – 2w => 1/7/15 (Wed)
 - So last day for withdrawing may in practice be 30/6/15

Comment

- (b) See the “European publication server” on EPO website: “From 2007 on the publication day for European patent applications and patent specifications will always be the Wednesday, irrespective of whether this day is a public holiday or not.”
- (c) The EPC does not indicate how to count back, so this is the best legal basis you could give. On the EQE, they would not expect a legal basis. So if you did not cite “R.131(5)”, you would not lose any points.

H7 – Amendments and correction of errors

Question did not match answer, so question has been replaced:

H7-17

(EQE – 5 points)

Company A filed a European patent application EP on 9 March 2012. EP contains the following claims:

Independent claim 1: Feature A

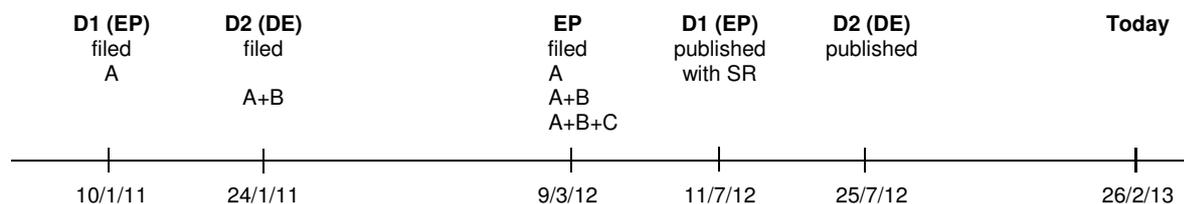
Dependent claim 2: Combination of features A and B

Dependent claim 3: Combination of features A, B and C.

The European search report of EP mentions European patent application D1. In addition, a German national patent application D2 has been brought to the attention of the EPO by third party observations under Article 115 EPC. D1 was filed on 10 January 2011 and published on 11 July 2012 together with the search report. D2 was filed on 24 January 2011 and published on 25 July 2012. D1 discloses feature A. D2 discloses the combination of features A and B.

Today is 26 February 2013. How can the applicant obtain a European patent giving the broadest possible protection which cannot be invalidated by the cited documents in any of the Contracting States?

Answer



EPC

- D1 is A.54(3) prior right because it is filed earlier than EP and published later, relevant only for novelty
- D1 discloses A, so claim 1 in EP1 is not novel

- D2 is A.139(2) DE national prior right because it is earlier than EP and published later
- D2 discloses A + B, so claim 2 in EP1 will be not novel in the DE national phase.
- Applicant may already file different sets of claims to resolve this national conflict - R.138

- So, two sets of claims should be filed to get the broadest scope of protection:
- For all States, except DE ----- claim 1: A+B and claim 2: A+B+C
- For DE only ---- claim 1: A+B+C

Comment

- Based on Question 9 of paper D1 of EQE 2007 - 5 points (amended)
- Examiners Report:
 - The majority of candidates correctly referred to R.138 EPC and suggested filing different sets of claims for different States.
 - Some candidates overlooked that D1 is a European application and not a national application.

- Most candidates lose points for lack of reasoning and explanation
- This is usually considered a minor amendments which does not require re-opening of the substantive examination, and which do not appreciably delay the grant - G7/93; GL (2014) H-II, 2.6
- See also GL (2014) G-IV, 6 and GL (2014) H-III, 4.5
- It is not required on the EQE to know and to explain the exact legal effect of national prior rights in each contracting state. However, it can be presumed that there will be at least a novelty issue to be avoided

H8 – Decision to grant the patent or refuse the application

Dates updated and answer re-written:

H8-03

(7 points)

The applicant has filed a European patent application on 12 August 2013 for a pharmaceutical product and its method of manufacture. At filing, the application includes a set of 18 claims.

- (a) Must claims fees be paid? If so, how many and when?
- (b) Would your answer be different if at filing no claims were enclosed, but the claims were filed on 19 September 2013?

The claims fees due on filing were duly paid. During examination, the applicant adds 5 claims. On 7 April 2015, the EPO issues a communication from the EPO that Examining Division intends to grant a patent including these further claims.

- (c) Must claims fees be paid? If so, how many and when?
- (d) What are the consequences of missing the deadlines in (a) and (c)?

Answer

EPC

- (a) First set of claims were on filing
 - o So (18 – 15 =>) 3 claims fees are payable - R.45(1), at latest on - R.45(2):
12/8/13 + 1m [R.131(4)] => 12/9/13 (Thu)
- (b) First set of claims were filed later
 - o So 3 claims fees must now be paid at latest on:
19/9/13 + 1m => 19/10/13 (Sat)
[R.134(1)] => 21/10/13 (Mon)
- (c) Extra claims fees payable for 5 claims - R.71(4) - which have to be paid at latest on - R.71(3):
7/4/15 + 10d [R.126(2)] => 17/4/15
+ 4m => 17/8/15 (Mon)
- (d-a) :
 - o EPO will communicate failure to observe 1m period
 - o but 3 fees may still be validly paid within a further 1m from notification of comm. - R.45(2)
 - o If fees still not paid within that period, excess claims are deemed abandoned - R.45(3)
 - o FP - A.121, R.135 - is available
- (d-c) :
 - o application is deemed withdrawn - R.71(7)
 - o FP is also available

Comment

- o (d-a): see GL (2014) A-III, 16.2
- o (d-c): see GL (2014) C V, 8
- o FP - A.121, R.135 - is available by:
 - requesting FP within 2m from notification of loss of rights – R.112(1)
 - paying each omitted claims fee
 - paying FP fee for each omitted claims fee = 50% of each omitted claims fee – Rfees 2(1).12

H9 – Opposition; Request for limitation or revocation

Answer was based on old version of Guidelines. However, the section E-VII, 2.2.6 was updated in 2013 to be consistent with the case law:

H9-26

(EQE – 4.5 points)

In opposition proceedings, the proprietor of the patent was invited by the Opposition Division, in accordance with Art.101(1) EPC, to file his observations on the comments filed by the opponent. The invitation set a period of 4 months. Due to a sudden, severe illness, the proprietor was unable to observe this period in spite of all due care required by the circumstances having been taken. Thereupon he applied in due time for re-establishment of rights, stating the grounds on which the request was based, paying the fee for re-establishment of rights and completing the omitted act.

- (a) Will the opponent be informed of the application for re-establishment of rights?
- (b) Will the opponent be party to the proceedings for re-establishment of rights?
- (c) How do you think the Opposition Division will decide on the request for re-establishment of rights?
- (d) Would a request for further processing under Art.121 EPC have been successful?

Answer

EPC

- (a) Yes, since RE request is concerned with period connected with opposition procedure - GL (2014) E-VIII, 2.2.6
- (b) Yes - T1561/05 (or T552/002)
- (c) RE request will be rejected:
 - o non-observance of period to file observations does not have direct consequence, by virtue of the, of causing refusal of request or revocation of patent or loss of any other right or means of redress, as is required by A.122(1) - G1/90; GL (2014) E-VII, 2.2.4
- (d) No, FP - A.121, R.135 - only applies to applications

Comment

- o *Based on Question 6 of Paper DI of EQE 1998 - 5 points (adapted).*
- o *Examiners' report:*
 - o *Parts (a) & (b) were in the majority of cases correctly handled but quite a number overlooked that the re-establishment proceedings are solely a matter between the proprietor and EPO. "Yes" and "No" answers without adequate basis were rarely awarded marks.*
 - o *On the other hand for part (c), very many concentrated on the due care requirements of A.122 without considering that for this to be available the direct consequence of the failure to comply with the period has to be refusal, deemed withdrawal, revocation or the loss of other right or means of redress, A.122(1) - GL (2014) E-VII, 2.2.6. Similarly, for part (d) many overlooked that A.121 only applies to European patent applications.*
- (b) *Party to the proceedings for re-establishment of rights?*
 - o *In T1561/05, the request for re-establishment of rights was filed in the context of inter partes proceedings, so both the patent proprietor and the opponent will be parties to the re-establishment proceeding. The opponent, who is contesting the request, has an unlimited right to be heard under A.113.*
 - o *In T552/02, the BoA decided upon the re-establishment concerning the notice of appeal following a decision of the Opposition Division.*
 - o *According to the Board, the response to be given to the application for re-establishment was of the utmost importance for the respondents, as it affected the actual admissibility of the appeal and hence the reviewability of the Opposition Division's decision to revoke the patent in suit. From this the Board deduced that it would be a breach of A.113(1) to take a decision concerning the interests not only of the appellants but also of the respondents without giving the latter an opportunity to present comments.*
 - o *They indicated in reason 1.3 that this deviated from the passage in the GL E-VII, 2.2.6 at that time. This passage was amended in September 2013.*

H11 – Common provisions governing procedure

Question was still partly based on the old Art. 124, answer was too extensive, and b) OA answer was not clear:

H11-11

(EQE – 4.5 points)

- (a) If you receive an invitation from the Examining Division of the European Patent Office to provide information on prior art taken into consideration in national or regional patent proceedings and concerning an invention to which the European patent application relates, do you have to reply? What are the consequences of not replying?
- (b) If you reply, do you have to include prior art cited in proceedings for:
- a corresponding ES utility model application?
 - a corresponding AU patent application?
 - a corresponding OA utility certificate application?

Answer

EPC

- (a) Yes
- EPO may invite me to provide this information within 2m - A.124(1), R.141(3)
 - If I do not respond in due time, appln is deemed withdrawn - A.124(2)
 - but FP is available - A.121, R.135
- (b) ES:
- ES is EPC State
 - So, yes - um appln must be included - A.140

AU:

- A.124(1) is not limited to EPC states
- so, yes - AU appln must be included

OA:

- It is not a patent
- OA is not EPC State
- So, no - OA utility certificate need not be included

Comment

- Based on Question 6 of paper DI of EQE 1997 - 3 points (adapted).
- A.140: A.66, A.124, A.135, A.137 and A.139 apply to utility models and utility certificates and to applications for utility models and utility certificates registered or deposited in the Contracting States whose laws make provision for such models or certificates.

H13 – Further processing and re-establishments of rights

Question was unclear, and answer was too extensive

H13-07

(7 points)

Three weeks ago, you received a registered letter containing an invitation from the EPO to pay five further search fees for a client's European patent application.

Your client is a small inventor who is currently negotiating with a large multinational company for the purchase of his inventions; the multinational has agreed to pay all necessary costs to protect the inventions, but will only make the money available in three months time.

The inventor lacks the funds to pay the search fees. Although he requested earlier payment, the multinational company refused. Several applications for bank loans have also been refused due to his severe financial difficulties.

What can be done to prosecute the inventions, and what would you advise?

Answer

EPC

- period for paying fees expires 10d + 2m, so we cannot wait for money
- So, ESR will only be drawn up for first invention - A.82, R.64(1)

- Later, during substantive examination, Exam. Div. will review non-unity finding. If examiner agrees, examination will only continue for searched subject-matter and inventor may have to remove all unsearched subject-matter - R.137(5), G2/92

- Requesting FP for period of R.64 is excluded - A.121, R.135(2)
- In principle, RE - A.122(1) - is available if all due care can be proven

- Financial difficulties may justify RE
- Fact that inventor tried to get loans from banks indicates that he tried with "all due care" - J22/88
- and obtaining the money from the company would remove the cause of non-compliance – R.136(1) – so there we can wait for the money

Advice

- but RE is not reliable remedy and can take several months to get a decision.
- In this case, advice is to wait for money, then file divisionals - A.76, R.36 - for unsearched inventions.
- Divisionals must be filed while parent is still pending – R.36(1); G1/09

Comment

- *For divisionals filed between 1.10.10 and 31.3.14, the patent application needed to be pending AND at least one of the 24m periods of the old R.36(1) must not have expired.*

H14 – Fees and payment

Legal basis in answer was too extensive

H14-13

(6 points)

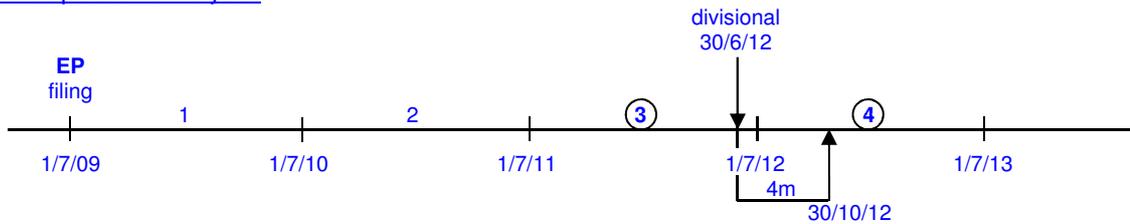
A European patent application was filed (parent application) on 1 July 2009. On 30 June 2012 the applicant validly files a divisional application.

When is the last day for validly paying the renewal fee for the third and fourth year for the divisional application without and with additional fee?

Answer

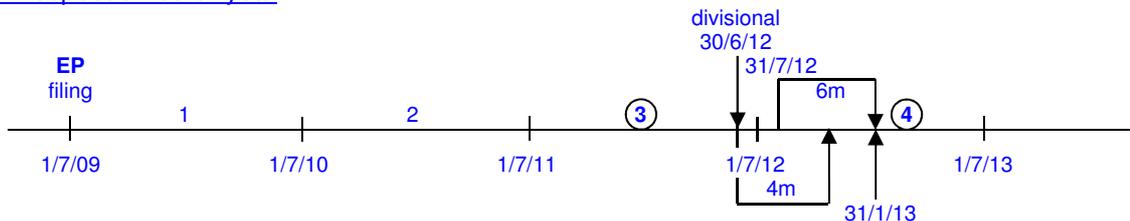
EPC

In respect of third year:



- 3rd year fee for divisional - A.76 - falls due on “filing date of divisional” = 30/6/12 - R.51(3)
- 3rd year fee can be paid without additional fee at latest on:
30/6/12 + 4m [R.131(4)] => 30/10/12 (Tue)
- and with additional fee (= 50%; RFees 2(1).5) – at latest on:
30/6/12 + 6m [R.51(2),] => 30/12/12 (Sun)
[R.134(1)] => 02/01/13 (Tue)

In respect of fourth year:



- 4th year fee falls due on 31 July 2012 - R.51(1)
- 4th year fee can be paid at latest without surcharge on:
30/6/12 + 4m => 30/10/12 (Tue)
- and with surcharge (additional fee = 50%; RFees 2(1).5) at latest on:
31/7/12 + 6m [J4/91: “de ultimo ad ultimo”] => 31/1/13 (Thu)

Comment

- For divisionals filed between 1.10.10 and 31.3.14, the patent application needed to be pending AND at least one of the 24m periods of the old R.36(1) must not have expired.

Extra comments in answer due to changes in deposit account shortfall rules:**H14-16****(4.5 points)**

The fee for appeal must be paid by Tuesday 14 July 2015 at the latest. The appellant wishes to pay the fee on that day at the BNP in Paris, which keeps an EPO account. The bank is closed owing to a French national holiday.

Legal position? How should you proceed?

Answer

EPC

Legal position:

- Payment after 14 July 2015 in Paris will be too late
- Consequence: notice of appeal is deemed not to have been filed - A.108 and FP is ruled out for time limits of A.108 - A.121(4)

How to proceed:

- Pay by debiting deposit account by sending fax to EPO or by using Online Fee Payment
 - after first ensuring that there are sufficient funds in deposit account – ADA 6.4

Alternative:

- drive to neighbouring Contracting State, and pay at bank there – Rfees 7(3)(a)(i) or ask colleague in neighbouring Contracting State to pay fee at a bank;
- payment will probably arrive too late, but within 10-days of Rfees 7(3)
- so subsequently pay 10% surcharge on request – Rfees 7(4)

Comment

- *J7/81 hn.I: Cash payments via a bank are considered to be “effecting payment through a banking establishment” pursuant Rfees 7(3)(a)(i).*
- *J7/81 hn.II: the 10-day fail-safe R. therefore applies.*
- *Since 1 April 2014, the EPO will no longer allow shortfalls in the deposit account to be remedied by payment of an administrative fee – OJ 2014, A.24*
- *The regulations regarding payment using a deposit account is found in OJ 2014, Suppl. 4 (ADA)*

I/J – Revocation and National Rights

Question rewritten to a more likely exam question, answer updated accordingly and comments amended to give general overview of conversion:

I/J-06

(4.5 points)

A European patent application has been correctly deemed withdrawn by the EPO due to non-payment of the filing and search fees.

Can the applicant still obtain patent protection from this application, using the EPC, in any of the EPC states, and how?

Answer

EPC

- Conversion into national patent applications is possible in some states – A.135(1)(b)
- EE, IT and LV allow conversion if EP application was deemed withdrawn - A.78(2) – for non payment
- PL and SK allow conversion when an EP application is deemed withdrawn for any reason - Nat. Law, Tab. VII, col. 1
- Applicant must:
 - Request conversion for each state at EPO – A.135(3)
 - Pay conversion fee for each state – Rfees 2(1).14
 - no later than 3m – R.155(1) - from notification R.112(1) communication indicating deemed withdrawal

Comment

- See also GL (2014) A-IV, 6
- Conversion – A.135 - to national patent applications (and where permitted to national utility models – A.140) was included in the EPC to mitigate any disadvantages the EPC route may have compared to a direct national filing.
- Note that Nat. Law (2013) Tab. VII still refers to A.90(3) of EPC1973:
 - (3) If the filing fee and the search fee have not been paid in due time or, in the case provided for in Article 14, paragraph 2, the translation of the application in the language of the proceedings has not been filed in due time, the application shall be deemed to be withdrawn.
- All EPC states permit conversion if the EP application is deemed withdrawn under A.77(3) due to non-forwarding by the national office – NL Tab. VII, Col. 1.
- Many states allow conversion if the EP application was deemed withdrawn under A.14(2) because no translation was filed – NL Tab. VII, Col. 1: BG, CH (if filed in Italian) CY, EE, ES, FI, GR, HR, HU, IT (if filed in Italian), LV, LT, MK, MT, PL, PT, RO, RS, SK and SI.
- A few states allow conversion if the application was deemed withdrawn under A.78(2) because the filing fee and/or the search fee was not paid – NL Tab. VII, Col. 1: EE, IT, LV, PL, and SK
- A couple states allow conversion if the application was withdrawn, deemed withdrawn, or refused for any reason – NL Tab. VII, Col. 1: EE (utility model only), ES (utility model only), FI (utility model only), IT, PL, and SK
- The request is filed at EPO, who forwards the request to each relevant national office – Art. 135(3)
- The following possibilities are based on the relevant national law, and fall, as such, outside the syllabus for the EQE.
 - Some states even allow conversion/derivation of a pending EP application into a national utility model/certificate – NL Tab. VII, Col. 5: DE, ES, FI, FR, PT, and SK.
 - A couple of states even allow a revoked patent (following Opposition or Revocation) to be converted - NL Tab. VII, Col. 1: IT and SK

This would never be asked in the D paper:

I/J-07 - deleted

PCT: SUBSTANTIVE AND PROCEDURAL LAW

L2 – The international application; Filing; Filing date; Formalities

Question rewritten to exam question style, and answer updated accordingly:

L2-15

(4.5 points)

An applicant filed an international application on 6 July 2015 with the intention of claiming the priority of two national applications, N1 filed on 22 July 2014 and N2 filed on 10 August 2014. The priority claim to N2 was validly filed. However, the priority claim to N1 was inadvertently omitted from the Request form (PCT/RO/101).

- (a) Today is 20 November 2015. Is it possible to add the priority claim to N1? If so, how?
 (b) What will then be the publication date of the international application?

Answer

PCT

- (a) Period to request addition - R.26bis.1(a):
- earliest 16m period to expire is:
 - 22/7/14 + 16m [R.80.2] => 22/11/15 (Sun)
 - [R.80.5] => 23/11/15 (Mon)
 - 4m period expires:
 - 6/7/15 + 4m => 6/11/15 (Mon)
 - 16m period expires latest, so last day to add priority claim is 23/11/15
 - So it is possible. Request should be submitted to IB or to rO
- (b)
- Publication, based on N2 as earliest priority, is due to occur promptly after - A.21(2)(a):
 - 10/8/14 + 18m => 10/2/16
 - It has not yet expired
 - So after addition of N1 priority claim, 18m period will be recomputed - R.26bis.1(c)
 - 22/7/14 + 18m [R.80.2] => 22/1/16 (Fri)
 - Typically, IB publishes on Thu, so 28/1/16 may be first possible publication date.
 - But to be sure, we can contact IB for exact publication date

Comment

- (a) *Preferably, the request should be sent to the IB, because of the technical preparations of the publication of the international publication by the IB.*
- *The request may be filed on paper or online using the ePCT document upload to the IB*
- (b) *Publication by the IB is normally on Thursday - see e.g. PCT NL (November issue). However, publications are often changed to other days due to holidays.*

Question style changed from “Legal situation?”, 2m period mentioned in HTG-II, GL reference was wrong, and US now accepts restoration of priority as dO/eO so answer updated accordingly:

L2-18

(15 points)

A Polish applicant filed a Polish application on 18 August 2011. Due to a fire in August 2012 which destroyed his office, he was unable to access his records and did not realise that the priority period was about to expire. On 28 September 2012 the office systems were restored, and the applicant filed an international application with the EPO as receiving Office on 29 September 2012, claiming the priority of the Polish application. On 29 September 2012, the applicant also filed a request at the EPO for the priority to be restored, stating that the late filing was unintentional. The applicant subsequently received a communication, dated 17 October 2012, from the EPO stating that the request was to be refused.

(a) Can the priority be restored in the international phase?

The applicant continues with his international application without the restored priority because it is vital for his business interests to obtain patent protection in Europe, Egypt, Ukraine and USA from this international application. The applicant contacts you on the 20 November 2012 for advice.

(b) What is the deadline for entering these regional/national phases?

Will the designated Offices accept the priority claim?

Answer

PCT

(a)

- Restoration of priority may be requested at rO - R.26bis.3(a)
- EPO as rO requires proof of “due care” - R.26bis.3(i); AG-IP: Annex C - EP
- So, EPO is justified in refusing RE request
- Such a fire in the office has been accepted by EPO as ground for all due care - GL (2014) E-VII, 2.2.1
- So new request can be based upon criteria of due care which should be accepted by EPO
- EPO must allow applicant to make observations on intended refusal - R.26bis.3(g),
- so it may be possible to submit further arguments and evidence to prove all due care no later than - HTG-II (2014): 134:

17/10/12 + 2m [R.80.2] => 17/12/12 (Mon)
- Or, a second RE request could be submitted no later than:
18/8/11 + 12m [R.2.4] => 18/8/12 (Sat)
[R.80.5] => 20/8/12 (Mon)

+ 2m [R.26bis.3(b)(i) and (e)] => 20/10/12 (Sat)
[R.80.5] => 22/10/12 (Mon)
- If EPO accepts arguments and evidence, all dO/eO's that recognise restoration of priority system will accept restored priority claim - R.49ter.1(a)

(b)

- Deadlines are calculated from priority date of 18/8/11, even though request was refused - R.26bis.2(c)(iii)
- For dO's with 30m (EG, US), deadline is:
18/8/11 + 30m [A.22(1)] => 18/2/14
- For dO's with 31m (EP, UA), deadline is:
18/8/11 + 31m [A.22(3)] => 18/3/14

Restoration of right of priority:

- On 20/11/12 it is too late to file a second request before rO - R.26bis.3(b)(i) and (e)
- But may file individual requests at selected dO/eO's
- Deadline for this 1m after expiry of A.22 periods for national entry - R.49ter.2(b)(i)
- Criteria determined by each dO/eO - see AG-IP: National Chapter:
 - EP, EG: “due care”;
 - UA: “unintentional”;
 - US: “unintentional”

Conclusion:

- “due care” will require additional arguments and evidence to demonstrate.

- EP should accept as dO, EG probably also (assume that legal test is same as EP).
- UA and US: “unintentional” is relatively easy to demonstrate

Comment

- (a) *A receiving Office may extend the time limit for paying the fee for restoration until 2 months after the time limit for filing the request for restoration - R.26bis.3(d).*
- *EPO is competent rO for Polish applicant - A.151*
 - *Due care under PCT should be considered the same as all due care under EPC*
 - *It is not clear whether the applicant may respond to the letter requesting that the ground be changed to due care. If they will not accept such a change, then a new request must be filed.*

 - *See AG-IP 5.062-5.069.*
 - *See “Practical Advice” in PCT NL 04/2007.*
 - *R.2.4(b): PCT 80.5 applies mutatis mutandis to the priority period.*
 - *For an updated list of PCT Reservations, Declarations, Notifications and Incompatibilities, see:
http://www.wipo.int/pct/en/texts/reservations/res_incomp.html.*
 - *For an overview of “Restoration of the right of priority by receiving Offices (rO) and designated Offices (dO) under PCT Rules 26bis.3 and 49ter.2, see:
<http://www.wipo.int/pct/en/texts/restoration.html>*
 - *Applying R.82quater to excuse the delay due to force majeure is not permitted for the priority period and the deadline for national entry – these periods are not “fixed in the regulations” – R.82quater.1(a)*
 - *Legally, the “12 months” is fixed by A.4C(1) PC, and not by R.2.4 PCT*
 - *The “30 months” is fixed in A.22/A.39 PCT*

L3 – International search and publication; preliminary examination

The answer had too much background in it. It has been reformulated to focus on the questions asked:

L3-03

(8 points)

An international application is filed in Spanish by a Spanish applicant at the Spanish Patent and Trademark Office as a first filing. The applicant has indicated in form PCT/RO/101 the Spanish Patent and Trademark Office to act as International Searching Authority (ISA). The applicant does not file a demand for international preliminary examination.

- (a) What is the period for establishing the written opinion of the ISA?
- (b) In what language will the written opinion of the ISA be prepared?
- (c) Can the applicant file comments on the written opinion of the ISA?

The applicant enters the regional phase before the EPO fulfilling all requirements including filing a translation of the international application in French.

- (d) Is the “written opinion of the ISA” made available to the EPO? If so, in what form by when and in what language?
- (e) Who is responsible for preparing the report and the translation under (d)?
Can the applicant comment on the translation?

Answer

PCT

- (a)
 - ISA also establishes WO with ISR - R.43bis.1(a)
 - ISR should be established no later than 3m from receipt of search copy by ISA, or 9m from priority date, whichever period expires later - R.42.1
 - So in principle, WO will (normally) be established within 9m from filing this IA - A.2(xi)(c)
- (b)
 - WO-ISA is established by ISA - R.43bis.1(a)
 - Spanish is language of publication of IA - R.48.3(a)
 - So WO-ISA will be published in Spanish – R.43bis.1(b), R.43.4
- (c) Yes, AG-IP 7.030:
 - applicants may submit informal comments to IB
 - allowing applicant to rebut WO-ISA
- (d) Yes
 - IB communicates IPRP (Ch.I) to each dO, but not before 30m from priority date - R.44bis.2(a)
 - this IPRP contains the WO-ISA - R.44bis.1(a)
- (e)
 - IB will translate the IPRP CH I - R.44bis.3(b) - into English - R.44bis.3(a)
 - Applicant may make written observations as to correctness of translation and send them to each of interested dO's, and to IB - R.44bis.4

Comment

- (c) *Informal comments are usually only used if applicant does not intend to file a demand*
- (d) *See also AG-IP 9.001(vi) and 7.031*
 - *The IB always translates the WO into English as there is always at least one dO/eO that requires it.*

The answer had too much legal basis so it was rewritten:

L3-27

(4.5 points)

What is the competent International Preliminary Examining Authority (IPEA) for international applications filed in the following countries:

- (a) France?
- (b) Denmark?
- (c) United States of America?

Answer

PCT

Competent IPEA - A.32(1), R.59

- (a) AG-IP – Annex C – FR:
 - EPO - A.152EPC
- (b) AG-IP – Annex C – DK:
 - EPO
 - XN
 - SE patent office
- (c) AG-IP – Annex C – US:
 - AU patent office (only for certain IAs),
 - EPO
 - Korean patent office, or
 - US patent office

Comment

- (c) EPO as ISA or IPEA:
 - *The availability of EPO as ISA and/or IPEA is restricted - OJ2003, 633; Agreement WIPO-EPO OJ 2010, 304 and OJ 2014, A40*
 - *HTG-II (10/12), 197: EPO will not carry out international preliminary examination in respect of any international application filed by a national or resident of the USA with the USPTO or the IB as the receiving Office, where such application contains one or more claims relating to the field of business methods.*