

Training for the European Qualifying Examination

Basic Questions and Answers

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Updates for the EQE 2012 edition

Our thanks to the many candidates who have informed us of issues in our materials. Your feedback helps us keep the materials clear and up to date.

This document only includes major updates where points awarded on the EQE could be affected or where the answers are unclear

Change bars are shown in the margin.
Additions are underlined, deletions are ~~struck-through~~

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Basic Questions

EPC: SUBSTANTIVE PATENT LAW	4
B4 – Languages; Translations of applications	4
B5 – Representation before the EPO	4
C2 – State of the art	5
EPC: PROCEDURAL LAW	7
H2 – The European patent application	7
H3 – Filing the application; Filing date; Formalities examination; Divisionals	7
H4 – Search, search opinion and search report	11
H5 – Publication of the patent application	12
H6 – Request for examination and substantive examination	13
H8 – Decision to grant the patent or refuse the application	16
H9 – Opposition; Request for limitation or revocation	16
H10 – Appeal; Petition for review	17
PCT: SUBSTANTIVE AND PROCEDURAL LAW	19
L1 – Introduction PCT	19
L2a – Filing an International Application; Filing date	23
L2b – Priority; Formalities on Filing	24
L3 – International search and publication; preliminary examination	25
L4 – National phase and Euro-PCT application	29

EPC: SUBSTANTIVE PATENT LAW

B – Introduction EPC

B4 – Languages; Translations of applications

B4-17

The language of proceedings of a European patent application is English. The patent is granted in 2011, and duly validated in Iceland. One year after grant of the patent the patent proprietor notifies a company in Iceland that their best-selling product infringes the patent. In court proceedings in Iceland, it is established that the Icelandic translation of the claims is narrower than the English text of the granted claims. In addition, it is established that the product of the alleged infringer does not infringe the protection conferred by the claims in Icelandic.

- (a) What will be the outcome of the court proceedings?
- (b) Is it possible to bring the Icelandic translation into conformity with the English text of the granted patent? If so, what effects does this have on the infringement case?
- (c) If the alleged infringer starts revocation proceedings in Iceland, which text of the patent would be decisive in the revocation proceedings?

Answer

EPC

- (a)
 - In principle, the English text is authentic in any proceedings before EPO and in any Contracting State - A.70(1)
 - But in Iceland - A.70(3) - the Icelandic translation will be regarded as authentic, because it provides a narrower scope of protection than the English text - National Law, Tab V, col 1
 - So the protection conferred by the Icelandic text is decisive for establishing infringement
 - Conclusion: alleged infringer does not infringe patent in Iceland
- (b)
 - Iceland must allow the proprietor to file a corrected translation - A.70(4)(a) - Nat Law, Tab IV, col 9
 - This corrected translation does not have retroactive effect
 - So the best-selling product will infringe after the translation has been made available to the public as prescribed by Iceland – Nat Law, Tab IV, col 7
 - But Iceland has chosen ~~made use of the options of to use~~ A.70(4)(b) - Nat Law, Tab V, col 2
 - So if the infringer has used the invention in good faith, they may continue such exploitation without any payment
 - However, if the proprietor can show a lack of good faith, then the infringer can be stopped after correction of the translation
 - ~~Conclusion: The alleged infringer does not infringe the patent in France after the French~~
- (c)
 - The Icelandic text is, in principle the authentic text for national proceedings - A.70(3)
 - But in the case of revocation – A.138 - proceedings, an exception is made and English is the authentic text – A.70(3)

B5 – Representation before the EPO

B5-09

Who is deemed the common representative for a European patent application with three applicants, where no common representative has been appointed?

- (a) All applicants are from a Contracting State and none has appointed a professional representative.
- (b) All applicants are from a Contracting State and applicant 3 has appointed a professional representative.
- (c) Applicant 1 and 3 are from a Contracting State; applicant 2 is a US company; no professional representative has been appointed.
- (d) Applicant 1 and 3 are from a Contracting State; applicant 2 is a US company; applicant 1 has appointed a professional representative.

- (e) Applicant 1 and 3 are from a Contracting State; applicant 2 is a US company; applicant 3 has appointed a professional representative.

Answer

EPC

R.151(1):

- (a) No applicants need representation – A.133(1), (2) => applicant 1 as first-named
- (b) same as a) => applicant 1 as first named. Representative of applicant 3 is irrelevant when all applicants do not need representation
- (c) applicant 2 must appoint a representative – A.133(2) => professional representative of applicant 2
- (d) applicant 1 represented => professional representative of applicant 1
- (e) applicant 1 not represented => professional representative of applicant 2

Comment

○ See GL A-IX, 1.3

○ (e) applicant 2 must be represented – A.133(1), (2). Therefore, the representative of applicant 2 will be used.

○ See also the notes to the Request-For-Grant form:

“If no common representative is named in Section 15, the applicant first named in the request (Sections 7 and 8) is deemed to be the common representative. However, if one of the applicants is obliged to appoint a professional representative, that representative is deemed to be the common representative unless the

first-named applicant has appointed a representative (Rule 151(1))”

“If all the applicants have their residence or principal place of business in an EPC contracting state, they may jointly name an applicant other than the first-named as their common representative. This should be done on a signed additional sheet.”

C – PATENTABILITY

C2 – State of the art

C2-08

In October 2012 applicant P filed a European patent application EP1 as a first filing claiming subject-matter A. EP1 is subsequently published. In March 2014, applicant Q has filed a European application EP2 as a first filing claiming subject-matter A and independently subject-matter B.

Who has the right to a patent and for what subject-matter?

Answer

EPC



A:

- EP1 was filed before and published after EP2 filing date
- So, EP1 is a prior right - A.54(3) - for EP2 – relevant for novelty only
- EP1 destroys novelty of A in EP2
- The claim to A in EP2 will not be validly granted
- No prior art is known before EP1 filing date, so that claim to A will be validly granted
- P will then have protection for A in all EPC states where EP1 is validated – Art.65 - after grant

B:

- EP1 does not disclose B
- So, the claim to B will be validly granted

- Q will then have protection for B in all EPC states where EP2 is validated – Art.65 - after grant

Comment

- *A.54(2) & A.54(3) implement A.60(2)*

EPC: PROCEDURAL LAW

H – EPC PROCEDURE

H2 – The European patent application

H2-10

How must nucleotide or amino acid sequences be disclosed in a patent application?

Answer

EPC

- If disclosed in an application, an electronic sequence listing must be provided - R.30(1)
- EPO uses this electronic listing to search - GL A-IV, 5; OJ2011, 3722007-SE3-C-4
- If not supplied on filing, EPO will invite applicant to supply listing and pay a late furnishing fee - R.30(3)
- If furnished late, sequence is not considered part of the application-as-filed - R.30(2)

Comment

Also see GL A-IV, 4.1.

H3 – Filing the application; Filing date; Formalities examination; Divisionals

H3-08

A request for a European patent is filed on 10 March 2012 with a reference to the description and drawings of an earlier Korean patent application. The reference does not include claims. The applicants name & address are included.

- (a) What requirements must be fulfilled for a filing date to be accorded?
- (b) Are any other requirements that the applicant has to address in the near future?
- (c) Are there remedies if the applicant does not comply with the invitations from the EPO?

Answer

EPC

- (a)
 - For a filing date - A.80 and R.40(1):
 - (a) indication that Patent is sought = satisfied by the request
 - (b) contact information for applicant = satisfied by the name & address
 - (c) a reference to an earlier application = provided for KR application
 - The reference given must comprise - R.40(2):
 - filing date; file number; Office where it was filed; and an indication that this reference replaces description and drawings
 - KR applications are not available to EPO - R.53(2); OJ2009, 236; GL A-II, 4.1.3.1 corrected by OJ2009, 486
 - So the applicant must supply a certified copy of the earlier KR application no later than - R.40(3), 1st sentence:

~~120/3/12 + 2m [R.131(4)] => 120/5/12 (ThuSun)~~
~~[R.134(1)] => 21/5/12 (Mon)~~
 - Receipt of the certified copy within the 2m is checked - A.90(1), R.55
 - If not received on or before 21/5/12, EPO will invite applicant to file it within 2m - A.90(4) and R.55
 - If the applicant does not provide the certified copy in due time, the application will not be treated as an application - A.90(2) and R.55 EPC; also see GL A-II, 4.1.4 and 4.1.5
 - So if the reference complied with R.40(2) and if the certified copy R.40(3) is duly filed at the latest in response to the R55 invitation, the filing date of 20/3/12 will be accorded
 -

- All the above acts can be performed by the Korean applicant upon filing the application – A.133(1), (2)
 - But after filing the application, the applicant must be represented by a professional representative and act through him in all proceedings
 - Earlier application is in Korean, so a translation into En, Fr or Ge must be filed within 2m of the filing date - R.40(3), 2nd sentence. The translation should be filed via the professional representative, and no later than: 21/5/12
 - Receipt of the translation on or before 21/5/12 is checked - A.90(3) and R.57(a)
 - If not received, EPO will invite applicant to file it within 2m - A.90(4) and R.58
 - Claims are not required for a filing date, but at least one claim is needed for the search and examination - A.78(1)(c)
 - Applicant may file a set of claims, either with the reference or of own volition (shortly) after filing the application - GL A-III, 9 (iii)
 - EPO checks for the claims - A.90(3), R.57(c)
 - If missing, applicant will be invited to file them within a period of 2m - A.90(4) and R.58
- (b) Remedy if R.55 invitation missed:
- If certified copy not provided in due time, application will not be treated as an application - R.55, last sentence; GL A-II, 4.1.4 and 4.1.5
 - FP – A.121 - is not available - R.135(2)
 - but RE can be requested if all due care can be proven - A.122, R.136

Remedy if R.58 invitation missed for translation:

- If translation of earlier KR application not filed in time, application deemed withdrawn - A.90(5), A.14(2)
- FP – A.121 - is not available - R.135(2)
- But RE can be requested if all due care can be proven

Remedy if R.58 invitation missed for claims:

- If no claims are filed in time, the application will be refused - A.90(5)
- FP – A.121 - is not available - R.135(2)
- But RE can be requested if all due care can be proven

Comment

- (a) *GL A-II, 4.1.3.1: Instead of filing application documents, the applicant can file a reference to a previously filed application according to R.40(1)(c). The previously filed application relied on for the reference does not need to be claimed as priority.*
- (b) *Translation of previously filed application is not a requirement for a filing date – see R.55*
- (c) *Note the difference in legal consequence - see GL A-II, 4.1.4 and 4.1.5:*
- *Copy of the previously filed application not filed:*
 - *Application not be treated as a EP application - R.55*
 - *Translation of the previously filed application not filed:*
 - *Application deemed to be withdrawn - A.90(5), A.14(2)*
 - *The filing date is unaffected by a missing translation*

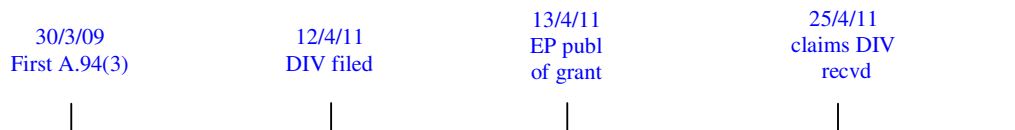
H3-19

A divisional application is filed on 12 April 2011 at the EPO. The grant of the parent European patent application is published on Wednesday 13 April 2011 after receiving three Article 94(3) communications. The first Article 94(3) communication is dated 30 Mar 2009, and no objection to non-unity was made by the Examining Division at any stage.

The claims for the divisional application are received by the EPO on 25 April 2011.

- (a) Is the divisional validly filed?
- (b) Would your answer be different if the second Article 94(3) communication, dated 15 February 2010, contained a non-unity objection?

Answer
EPC



- (a)
- o Parent was pending - R.36(1); G1/09 - up to but not including 13/4/11
 - o No non-unity objections were received, so R.36(1)(b) does not apply
 - o Last day to file a (voluntary) divisional – R.36.1(a) - is:
30/3/09 + 10d [R.126(2)] => 9/4/09
+24m [R.36(1)(a); R.131(4)] => 9/4/11 (Sat)
[R.134(1)] => 11/4/11 (Monday)
 - o On 12/4/11, parent was pending but R.36(1)(a) had expired, so divisional was not validly filed
- (b) Yes
- o Last day to file a (mandatory) divisional – R.36.1(b) - is:
15/2/10 + 10d [R.126(2)] => 25/2/10
+24m [R.36(1)(a); R.131(4)] => 25/2/12 (Sat)
=> [R.134(1)] => 27/2/12 (Mon)
 - o So on 12/4/11, parent was pending and R.36(1)(b) had not expired, so divisional was validly filed
 - o Divisional satisfying A.80, R.40(1) inherits filing/priority date from parent - A.76(1)
 - o Since R.40(1) does not require claims, the same applies to a divisional
 - o So claims may be filed later – divisional is validly filed – GL A-IV, 1.2.1
 - o Claims may not extend subject-matter beyond divisional as filed - A.123(2)
 - o Also basis for claims in description should be indicated. If not, Examining Division will request details to be submitted – R.137(4)

Comment

- o *The divisional was filed ≥ 1 April 2010, so the 24m R.36(1) time limits are applicable [OJ2009, 296 & 481]*
- o *Filing of the claims may be done after the parent is no longer pending, provided that R.40(1) with was satisfied while the parent was still pending - GL A-IV, 1.2.1*
- o *R.137(4) also applies for late-filed claims, although the Search Division may not send a R.137(4) communication – GL C-VI, 3.1 & C-VI, 5.7*

H3-24

A European patent application is filed on 15 December 2011 claiming priority of a Japanese application filed on 15 January 2011 and a Taiwanese patent application filed on 17 December 2010.

- (a) When must the declaration of priority be filed?
 (b) What must be indicated in the declaration of priority?
 (c) Does the applicant need to provide any more information from the prosecution file of the priority application?

Answer

EPC

EPC application may claim priority from a TW application - A.87(1); TW is a WTO member

- (a) Preferably, ~~the~~ declaration of priority should be ~~is~~ made on filing - R.52(2), ~~1st sentence; R.41(2)(g)~~
 o Declaration of priority may still be made - ~~R.52(2), 2nd sentence~~ - at the latest on:
 17/12/10 (~~earliest priority date~~) + 16m [R.131(4)] → 17/4/12 (Tue)
- (b) For JP & TW applications, D ~~declaration must indicate the following for the JP & TW applications -~~
 A.88(1), R.52(1):
 (i) filing date
 (ii) State - here JP or TW

(iii) file number

(c)

- ~~Application filed after 1/11/11 – OJ2010, 410~~
- For both the JP and TW priority claim, a copy of any official search results must be filed - A.124, R.141(1) - together with the application
- ~~The applicant is exempted from filing such copy for the JP application – R.141(2), OJ 2011, 62; OJ 2011,64~~
- The applicant must however file such copy for the TW application
- If not available on filing the EP application, ~~they it~~ should be filed without delay if ~~they it~~ becomes available later
- Final compliance is checked by ~~the~~ Examining Division – R.70b

Comment

- *GL A-III, 6.10: The right to priority for a European patent application is lost where:*
 - *the declaration of priority is not filed in due time;*
 - *the declaration of priority is not corrected in due time, and*
 - *the copy of the previous application or of any translation of the previous application is not filed in due time.*
- *GL A-III, 6.5.3: Three potential deficiencies exist with regard to the priority claim, namely:*
 - *failure to indicate a date of the previous application or to indicate the correct date;*
 - *failure to indicate a State or WTO member in or for which it was filed or to indicate the correct state or WTO member*
 - *failure to supply a file number or to indicate the correct file number.*

Further processing - A.121 EPC does not apply to the period of R.52(3) EPC, since it is excluded by R.135(2) EPC.
- Application filed after 1/1/11 – OJ2010, 410
- OJ 2010, 410, OJ 2011, 62 and OJ 2011, 64: applicants will be exempted from filing a copy of the search results under Rule 141(1) EPC if they are claiming the priority of either:
 - an application on which the EPO drew up a certain type of search report, or
 - a first filing made in Japan, the United Kingdom or the United States of America.
- See also R.41(2)(g)

H3-26

A European patent application disclosing nucleotide and amino acid sequences is filed by an applicant claiming priority of an earlier national application.

What happens in the following cases? Will the EPO send an invitation to correct? If so, what is the relevant period? What remedy is available if the applicant does not respond?

What is the legal consequence if the applicant does not furnish the missing item?

- (a) At the date of filing the applicant has not filed a sequence listing in computer-readable form.
- (b) The application does not contain an abstract.
- (c) The file number of the priority document is missing.

Answer

EPC

- (a)
 - If nucleotide or amino acid sequences are disclosed in the application, the description must contain a sequence listing in a standard format - R.30(1); ~~OJ2011, 372~~~~OJ2007-SE3-C.1~~
 - EPO checks whether the sequence listing has been filed - A.90(3), R.57(j)
 - If not, they will invite the applicant to file it in the prescribed form - R.30(3) - and to pay the late furnishing fee within 2m
 - If the listing is not furnished or the fee was not paid in due time, the application will be refused - A.90(5) and R.30(3), 2nd sentence
 - FP - A.121 – is available for the R.30 period
- (b)
 - An application must contain an abstract - A.78(1)(e)

- EPO checks whether the abstract has been provided - A.90(3), R.57(d)
- If not, they will invite the applicant to file the missing abstract within a period of 2m - R.58
- If not furnished in due time, the application is refused - A.90(5)
- FP is excluded for the period of R.58 EPC - A.121, R.135(2)
- RE - A.122 - is so possible, if all due care can be proven – R.136
-
- Preferably, the declaration of priority is made on filing – A.88(1), R.52(1), 1st sentence
- But it may still be made within 16m from the earliest priority date claimed - R.52(1), 2nd sentence
- EPO checks whether the declaration has been filed - A.90(3), R.57(g)
- If not, EPO will invite the applicant to file the missing file number within a period to be specified - R.59
- This period cannot be less than 2m nor more than 4m - R.132(2)
- If declaration not filed in due time, the right to priority is lost - A.90(5), last sentence
- FP is excluded for the period of R.59 - A.121 and R.135(2)
- RE - A.122, R.136(3) - is possible, if all due care can be proven

Comment

- (a) Also see GL A-IV, 5.2.
 - The late-filed sequence is not considered part of the application-as-filed - R.30(2)
- (b) Also see GL A-III, 16.2 (iv).
- (c) Also see GL A-III, 16.2 (viii).

H4 – Search, search opinion and search report

H4-03

- (a) What is the procedure when no meaningful search can be carried out?
- (b) Will the search fee be refunded?
- (c) How does such a declaration affect examination?

Answer

EPC

- (a) R.63, GL B-VIII, 3:
 - No meaningful search = If EPO considers that the application does not comply with EPC to such an extent that it is impossible to carry out a meaningful search into the state of the art on the basis of all or some of the subject-matter claimed,
 - EPO will
 - initially invite applicant to indicate subject matter to be searched - R.63(1)
 - if no response or an insufficient response, EPO either issues a declaration of no meaningful search or provides a partial search report and will determine the subject-matter to be searched
- (b) No, because the declaration is considered as the ESR - R.63(2), last sentence
- (c) Normally, the applicant bases the decision to continue with examination on the contents of the ESR. When the applicant enters examination with no ESR, the patentability issues are dealt with by the Examiner using objections in R.71(1) communications
 - If a partial search report has been drawn up, the Examining Division invites the applicant to restrict the claims to the subject-matter searched, unless the meaningful search objection was not justified – R.63(3)

Comment

- *GL B-III, 3.11: The examiner may exclude certain subject-matter from his search. These exclusions may result from certain subject-matter not complying with the provisions of the EPC relating to exclusions from patentability or to susceptibility to industrial application. They may also arise where the application does not comply with the provisions of the EPC to such an extent that a meaningful search is impossible for some or all of the claims, or for a part of a claim, for other reasons (GL B-VIII, 3) or where the application does not comply with R. 43(2) - GL B-VIII, 4*
- Also see GL B-X, 8 (iii) and (iv).

H4-08

- (a) When is the European search report sent to the applicant?
- (b) What events are triggered by the transmittal of the search report?

- (c) What is sent to the applicant when the European search report is forwarded to the applicant?
- (d) Must the applicant respond to the search report?

Answer

EPC

- (a) Immediately after it has been drawn up - R.65
- (b)
 - The applicant may amend the description, drawings and claims after receipt of the ESR - A.123(1), R.137(2)
 - ~~In the ESR written opinion~~ Subsequently, applicant is invited to comment on the ESR and to amend if desired within the period for requesting examination – R.70a, R.70(1). This is combined with R.69(1) communication.
- (c) The ESR and copies any cited documents are sent - A.92, R.65

EPO also forwards to the applicant:

- The search opinion - R.62(1); GL B-XII, 1
- An annex listing the families of the patent documents cited - GL B-IV, 3.1; B-X, 9.1.2; OJ1999, 90
- Information relating to restriction of search because of unpaid claims fees, non-unity or impossibility to make a meaningful or complete search - GL B-VIII; B-X, 8
- An invitation to comment on the ESR – R.70a(1)

GL B-X, 7: EPO also informs the applicant about:

- (i) approval or amendment of the abstract or figure depicted - R.66, R.47(4)
- (ii) approval or amendment of the invention title - R.41(2)(b)
- (iii) translation of the title into the two other official languages - A.14(7)(a), A.129(a)

- (d) A response is only required if the written opinion is not positive – R.70a(1), GL B-XII, 3.9
But any required response must be filed within the period for requesting examination – R.70a, R.70(1) EPC; GL B-XII, 9.

Comment

- (b) *Transmittal European search report:*
 - *R.68(4): The publication of the patent application also contains any new or amended claims filed by the applicant under R.137(2) if available before termination of the technical preparations for publication - GL A-VI, 1.3*
 - *R.10(4): If a request for examination is filed before the European search report has been transmitted to the applicant, and if the applicant has waived the right under R.70(2), the Examining Division is responsible from the time when the search report is transmitted to the applicant.*
- (c) *R.62(1): European search report is accompanied by an opinion on whether the application and the invention to which it relates seem to meet the requirements of the EPC, unless a communication under R.71(1) or R.71(3) can be issued.*

H5 – Publication of the patent application

H5-03

A European patent application is filed on 7 January 2012 claiming priority of a French patent application filed on 9 January 2011.

- (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 prevent publication? How to proceed?

Answer

EPC

- (a)
 - The application is published as soon as possible after - A.93(1)(a):
9/1/11 + 18m [R.131(4)] → 9/7/12 (Mon)
 - The first possible day of publication of the application is on 11 July 2012 (Wed)

- ⊖
- Applications are published in electronic form by means of a publication server - R.68(2); OJ2007-SE3-D.3; GL A-VI, 1.4
- (b) R.67(1), R.67(2) + OJ2007-SE3-D.1:
 - The technical preparations for publication of the application are deemed completed at the end of the day:
 - 9/11/7/12 – 5 weeks [R.131(5)] → 4/6/6/09 (~~Mon~~Wed)
 - So the last day for withdrawing the application is ~~Wed 6/4~~ June 2012
- OJ2006, 406:
 - If withdrawal is received after the 5-week period, EPO cannot guarantee non-publication anymore
 - But they will make an effort on a case-to-case basis - J5/81; GL A-VI, 1.2
 - In practice, publication can often be prevented if withdrawal is received at the latest:
 - 11/7/12 (~~scheduled publication date~~) – 2 weeks [R.131(5)] → 27/6/12 (Wed)
 - So the last day for withdrawing the application may in practice be 26/6/12

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.”

H6 – Request for examination and substantive examination

H6-01

A European patent application is filed on 11 January 2012 claiming priority of an earlier identical national application on 11 January 2011. The A2 publication is on Wednesday 18 July 2012, the A3 publication is on Wednesday 24 October 2012.

- (a) When must the request for examination of a European patent application be filed?
- (b) Of what parts does the request for examination consist?
- (c) What is the consequence if an applicant of a European patent application does not pay the examination fee?
- (d) Can a failure to pay the examination fee be repaired?
- (e) Are there any other important actions due at the same time?

Answer

EPC

- (a) Last day it ~~can~~may be validly paid - A.94(1), R.70(1) – is:
 - 24/10/12 + 6m [R.131(4)] → 24/4/13 (Wed)
- (b) Request consists of two acts:
 - (written) request for examination and payment of the examination fee - R.Fees 2(1).6
 - ⊖
 - Consequence is that the request for examination is deemed not filed - A.94(1), last sentence
 - If no request for examination has been made in due time, application deemed withdrawn - A.94(2)
 - EPO then sends a R.112(1) communication noting loss of rights
- (c) Yes
 - FP - A.121 - is available for the period of R.70
 - FP must be requested within 2m of notification of the R.112(1) communication
 - Two acts means that FP must be requested twice – once for the request and once for the fee
 - Request FP for the request by paying the FP fee = other cases fee - R.fees 2(1).12
 - At the same time complete the omitted act – R.135(1) = request examination
 - Request FP for the fee by paying the FP fee = 50% of examination fee – R.fees 2(1).12, R.Fees.2(1).6
 - At the same time complete the omitted act – R.135(1) = pay the examination fee – R.fees 2(1).6
- (d) Yes
 - The designation fee must be paid within the same 6m period - A.79(2), R.39(1)

- Otherwise, the application is deemed withdrawn - R.39(2) If missed,
- FP is available

- Within the same period, the applicant must also respond to the written opinion if the opinion was not positive - R.70a(1),(2) EPC, GL B-XII, 3.9
- Otherwise, the application is deemed withdrawn - R.70a(3)
- FP is available

Comment

- (a) *Non-payment of the examination fee in due time leads to the patent application being deemed to be withdrawn - A.94(2) which can be remedied by requesting further processing - A.121 and R.135. Within the same 6m period, a response must be filed to the written opinion when required – R.70a – and the designation fee must be paid – R.39*
- (b) *The written request for examination is pre-printed on the Request-for-Grant form [Form 1001] with the appertaining box already ticked. Since the Request-for-Grant form is compulsory upon filing the application - R.41(1), the written request for examination is always filed together with the application. However, not paying the fee results in the request being deemed not filed (A.94(1), last sentence). So further processing is required for both the request and the fee.-*

This requirement for two further processing fees has been seen in practice. Internal EPO form 1907 indicates cause of loss of rights, and describes how to correct it: "It should be noted that if a loss of rights occurs because the request for examination or the reply to the opinion accompanying the European search report has not been filed within the time limit, the flat-rate amount of the further processing fee ("other case") is due and, where neither has been timely filed, this fee has to be paid twice. Apart from that, for any non-payment of fees in due time, 50% of the relevant fees become payable as further processing fees"

Note that this is also the case if a Euro-PCT application misses the 31m date- R.159(1)(f); R.160(1)

H6-02

- (a) Does the applicant of a European patent application get an invitation from the EPO to pay the examination fee?
- (b) Can the applicant of a European patent application obtain a reduction of the examination fee? If so, what are the requirements and how much is the fee reduction?
- (c) Is the applicant obliged to indicate the request for reduction on filing of the European patent application?

Answer

EPC

- (a)
- Yes. It is not strictly an invitation, but a R.69(1) communication is sent informing when the mention of the ESR will be published. It draws his attention to R.70(1), A.94(2) i.e. to pay examination fee and what the consequences are when request is not filed in due time. The applicant's attention is also drawn to the any required response to the written opinion – R.70a(1), and to requirement to pay designation fee – R.39(1)
- (b)
- If the applicant is a person of Art.14(4) - national or resident of an EPC state having an official language other than En, Fr or Ge
 - 20% fee reduction is given for the examination fee - R.6(3) EPC and RFees 14(1) if the request for examination is filed in that official language – G6/91
- (c) No, it is not necessary - J21/98; GL A-XI, 9.2.3:
- The request for examination constitutes an autonomous step quite separate from the (previous) step of filing the application
 - Since EPO gave the applicant the right to file the request for examination after the publication of the search report, it followed that the same right must be owed to the applicant who wanted to avail himself of the option provided for in A.14(4)

Comment

- (a) *Where the applicant files a request for examination [= written request + payment of the examination fee] before the search report is transmitted to him, he may also dispense with the need to comply with the*

invitation - R.70(2) [also see R.10(4)], and file a categorical request for examination whatever the result of the search may be. In this case, confirmation that he desires to proceed further with his application is deemed given when the search report is transmitted to him. See also GL A-VI, 2.2

- o *For a Euro-PCT application, the examination fee is reduced by 50% if EPO was IPEA - RFees 14(2)*

H6-05

A European patent application was filed claiming priority of an earlier national application. The applicant supplied missing parts of the description shortly after accordance of the filing date and the Receiving Section determined that the missing parts were “completely contained” in the priority application. As a consequence, the filing date of the European patent application remained the date on which the application was filed. Upon reviewing the findings of the Receiving Section, the Examining Division comes to the conclusion that the missing elements are not “completely contained” in the priority document.

Legal situation?

Answer

EPC

GL C-VI, 3.1:

- o Examining Division may review the findings of Receiving Section on R.56(3)
- o Examining Division will communicate this objection to the applicant. The applicant has a chance to respond – A.113(1)
- o If the applicant is not successful, EPO will inform about the redate – R.56(5)
- o New filing date will be date that missing parts were originally received
- o Communication will also inform that the missing parts of the description can still be withdrawn within a period of 1m from the date of notification of the new filing date - R.56(6)
- o If applicant withdraws the missing parts, the re-dating is deemed not made - R.56(6)
- o EPO informs the applicant accordingly - R.56(4), R.56(6) – that the original filing date is retained

Comment

- o *Note that the re-dating in most cases in practice will result in loss of the right to priority.*

H6-06

(EQE – 3 points)

You are on the list of professional representatives before the EPO and are the German representative in Munich for a Greek applicant for a European patent. On the very last day of the period for reply to a communication pursuant to A.94(3) and R.71(1) EPC you receive instructions for filing a reply. The instructions are in the Greek language, of which you have a good command, and are rather lengthy, in the form of a draft response, but are apparently proper and deal with all objections raised in the communication. The applicant expressly tells you that you must file the reply by the end of the period.

What are the minimum necessary steps for you to take to comply with your client's requirement?

- if the instructions only include arguments.
- if the instructions also include amended claims and/or amended description pages (in Greek).

Answer

EPC

- o Response to a R.71(1) communication is a document to be filed within a time limit
 - o Applicant is an A.14(4) person – national of Greece with official language Greek. So, the instructions may be filed in Greek
 - o A translation must be filed within 1m of filing the Greek instructions - R.6(2) - in En, Fr or Ge - R.3(1), last sentence; A.14(1)
- o The answer to a) remains the same for the arguments
 - o Under A.94(3), EPO invites the applicant to file observations and amend the application. So amendments are also “documents to be filed within a time limit”. So they may be filed in Greek
 - o A translation of the amendments must be filed within 1m - R.6(2) – of filing the arguments in the language of proceedings - A.14(3), R.3(2)

Comment

- Based on Question 3 of Paper DI of EQE 1993 [3 points (adapted)].
- Examiners' report: Many candidates rely for the answer to question (b) on the text of R.3(2) only and miss that the provisions of A.14(4) should be applied first.
- A.164(2) does not allow R.3(2) to be interpreted in conflict with A.14(4)
- In practice, you could get more time by extending the period to reply under R.132(2). However, this goes against the direct wishes of the client.
- FP – A.121 – is available for the period of R.6(2)
- Filing amended claims in your own EP language is almost never done – it is not worth the extra translation effort.

H6-07

The applicant has paid the examination fee together with the filing and search fee within one month after filing the a European patent application as a first filing. After receiving the search report, the applicant concludes that there is no real basis to continue with the application.

Under what conditions will the examination fee be refunded?

What actions, if any, must the applicant undertake to ensure the refund?

Answer

EPC

Quick refund:

- The applicant immediately withdraws the application - GL A-VI, 1.2
- ~~He can then also prevent the publication of the application – R.67(2)~~
- The examination fee will be quickly refunded by EPO - RFees 11(a)

Applicant takes no action:

- The request for examination was filed before the ESR had been transmitted
- So EPO will invite applicant to indicate, within a period to be specified – R.132(2), whether he wishes to proceed - R.70(2)
- If applicant does not respond, application will be deemed withdrawn - R.70(3)
- Examination fee will eventually be refunded - RFees 11(a) and R.10(3)]

Comment

- *GL A-XI, 10.1.1: If the payment is made before or on the due date and if, no later than that date, the legal basis ceases to exist (e.g. because the patent application is deemed to be withdrawn or is withdrawn), the amount paid is to be refunded.*
- *J8/83 hn.II: Refund of the examination fee after withdrawal of the application in response to R.70(2) communication.*
- *GL C-VI, 1.1.2: Where the applicant files a request for examination before the search report is transmitted to him, he may also dispense with the need to comply with the invitation pursuant to R.70(2) [also see R.10(4), and file a categorical request for examination whatever the result of the search may be. In this case, confirmation that he desires to proceed further with his application is deemed to be given when the search report is transmitted to him.*
- If the European patent application is subsequently withdrawn before the substantive examination has begun, 75% of the examination fee will be refunded [RFees 11(b) and OJ2009, 542].
- In most cases, he can then also prevent the publication of the application - R.67(2). First filing means that no priority is claimed – EPO then provides the search report within 4-6 months of filing – OJ2010, 352

H8 – Decision to grant the patent or refuse the application**H9 – Opposition; Request for limitation or revocation****H9-09**

A European patent is granted on 11 January 2012. An Italian person files a notice of opposition in Italian on 24 September 2012.

- (a) Until when can the Italian person file a translation of the notice of opposition?
- (b) Would your answer have been different if the notice of opposition was filed on 15 October 2012?

Answer

EPC

- (a)
- A notice of opposition can be filed at the latest on - A.99(1):
11/1/12 + 9m [R.131(4)] → 11/10/12 (Thu)
 - An Italian national – A.14(4) person – may file the opposition in Italian
 - The translation En, Fr or Ge - R.3(1), last sentence - must be filed within the later of - R.6(2):
24/9/12 + 1m [R.131(4)] → 24/10/12 (Wed), and
the expiry of the opposition period = 11/10/12
 - So last day for filing translation = 24/10/12
- (b) Yes
- The translation must be filed within the later of:
15/10/12 + 1m [R.131(4)] → 15/11/12 (Thu), and
the expiry of the opposition period = 11/24/10/12 - from (a)
 - So the last day of filing a translation of the notice of opposition = 15/11/12

H10 – Appeal; Petition for review**H10-29**

Would a petition for review be possible in the following cases:

- (a) The Board of Appeal did not follow the Guidelines;
- (b) The Board of Appeal clearly misinterpreted a document;
- (c) The Board of Appeal refused the patent application on a ground not discussed during examination and subsequent appeal proceedings;
- (d) The appellant has requested oral proceedings in the grounds of appeal and the Board of Appeal delivered the decision without arranging oral proceedings;

Answer

EPC

- Petition for review may only be filed by an adversely affected party - A.112a(1)
 - solely to appeal proceedings on grounds given in A.112a(2), R.104
 - Objection must also have been duly raised - R.106
- (a) No - A.112a(2), R.104
- GL do not have binding authority of legal text - T42/84
 - so cannot be a procedural defect defined in the Rules - A.112a(2)(d)
- (b) No - A.112a(2), R.104
- No - error is substantive, not procedural
- (c) Yes - A.112a(2)(c), A.113(1)
- A party adversely by a BoA decision, may file a petition for review by Enlarged BoA based on a fundamental violation of A.113
fundamental violation of right to be heard - A.112a(2)(c), A.113(1)
- (d) Yes - A.112a(2)(d), R.104(a), A.116
- violating A.116 is fundamental procedural defect - A.112a(2)(d), R.104(a)
 - Failure to arrange for holding of oral proceedings - A.116 - is a fundamental procedural defect - R.104(a)

Comment

Petition for review is only permitted in case of a fundamental procedural defect. These grounds are defined in A.112a(2)(a)-(e) and R.104, and are a selection from substantial procedural violations identified during past appeal proceedings where the appeal fee was reimbursable under R.103.

The following comments are based on case law before the BoA's:

- (a) *Not following the GL:*
- *T42/84: The GL not having the binding authority of a legal text, a failure to follow them is not to be regarded as a procedural violation within the meaning of R.103 unless it also constitutes a violation of a R. or principle of procedure governed by an article of the or one of the Implementing Regulations - A.23(3); see e.g. T42/84*
- (b) *Misinterpretation of a document.*

- *A decision based only on a wrong assessment of the prior art and/or of the claimed invention must be regarded as a substantive, but not as a procedural “violation” [see e.g. T367/91*
- (c) *Ground not discussed:*
 - *T647/93: The provision of A.113(1), that EPO must consider and decide upon the European patent application or the European patent only in the text submitted to it, or agreed, by the applicant for or proprietor of the patent, is a fundamental procedural principle, being part of the right to be heard, and is of such prime importance that any infringement of it, even as the result of a mistaken interpretation of a request, must, in principle, be considered to be a substantial procedural violation.*
 - *T647/93, hn.I: The provision of Article 113(2), that the European Patent Office shall consider and decide upon the European patent application or the European patent only in the text submitted to it, or agreed, by the applicant for or proprietor of the patent, is a fundamental procedural principle, being part of the right to be heard, and is of such prime importance that any infringement of it, even as the result of a mistaken interpretation of a request, must, in principle, be considered to be a substantial procedural violation. In any case, such violation occurs when, as in the present case, the Examining Division does not make use of the possibility of granting interlocutory revision under Article 109, after the mistake has been pointed out in the grounds of appeal.*
 - *Example: T1123/04, r.2.4: Therefore, the issue of a decision refusing the set of claims filed with the letter of 17 March 2004 without having provided the grounds and evidence to the applicant is in breach of the provisions of Article 113(1), which amounts to a substantial procedural violation (R. 67). For this reason alone, the decision must be quashed.*
 - *R7/09:*
 - r.2: Since the Office was not able to establish delivery of the critical communication within the meaning of R. 126(2) and in the absence of any evidence to the contrary, the opponent's (appellant's) statement setting out the grounds of appeal must be considered not to have been communicated to the petitioner as prescribed by R. 100(1) in conjunction with R. 79(1).*
 - r.6. It follows that in the appeal proceedings under consideration the petitioner had, within the meaning of Article 113(1), no opportunity at all to comment on the grounds for the decision under review which objectively came as a total surprise to him, both as to its timing and its content. This qualifies as a fundamental violation of Article 113 pursuant to Article 112a(2)(c), so that the petition and the request for re-imbursement of the fee for the petition for review (R. 110) have to be allowed.*
- (d) *Oral proceedings:*
 - *T283/88, r.6: If the failure to provide for oral proceedings is due to negligence this is deemed to be a substantial procedural violation under R.103.*
 - *T93/88, r. 3: Failure by Opposition Division to hold oral proceedings in response to a clear request by the Appellant, because of an oversight, is necessarily a substantial procedural violation.*

PCT: SUBSTANTIVE AND PROCEDURAL LAW

L1 – Introduction PCT

L1-10

- (a) Can France be designated in an international application?
- (b) Can Taiwan be designated in an international application?
- (c) Can a State be designated twice in an international application?
By when can such an indication be made?

Answer

PCT

- (a) Yes/No
 - o France is a PCT Contracting State
 - o Filing of Request – either PCT/RO/101 or acts to obtain a filing date - constitutes the designation of all Contracting States bound by PCT on the filing date - R.4.9(a)(i); AG-IP 5.052
 - o So FR is always automatically designated

 - o But FR has closed its national route - ~~HTG-II, 83~~HTG-II (07/11), 121
 - o French national office cannot be a dO/eO
 - o So grant in FR can only be pursued indirectly via EP designation
- (b) No
 - o Taiwan is not a PCT state - R.4.9(a)(i) not fulfilled
- (c) Yes
 - o filing a request constitutes an indication that:
 - R.4.9(a)(iii): IA is considered an application for both a regional and a national patent in respect of each PCT state which is party to the regional treaty - A.45(1)
 - R.4.9(a)(ii); AG-IP 5.052: IA is considered an application for every kind of protection available for each PCT state where A.43 (seeking certain kinds of protection) or A.44 (seeking two kinds of protection) apply

 - When to indicate:
 - o AG-IP 5.055 : although some indications may be made on filing, the final decision on what they wish to pursue, may be made on national/regional entry
 - o Indicate another kind of protection – A. 43 - when performing acts of A.22/A.39(1)(b) - R.49bis.1(a)/R.76.5
 - o Indicate more than one kind of protection - A.44 - when performing acts of A.22/A.39(1)(b) - R.49bis.1(b)/R.76.5. Also indicate, if applicable, which kind of protection is sought primarily and which kind is sought subsidiarily

Comment

- o ~~HTG-II, 83~~HTG-II (07/11), 121:
 - o *The national law of a number of Contracting States stipulates that on the basis of an international application only a European patent may be obtained for these States.*
 - o *The countries which close off the route to a national patent in this way were, at 1 March 2010, Belgium, Cyprus, France, Greece, Ireland, Italy, Latvia, Monaco, Malta, the Netherlands and Slovenia.*
- o *R.4.9(a): The filing of a Request constitutes - AG-IP 5.016:*
 - o *the designation of all Contracting States bound by the PCT on the international filing date,*
 - o *for the grant of every kind of protection available, and*
 - o *for the grant of both regional and national patents.*
- o *Example: In Germany a national patent, a utility model and a regional patent (via EPO) can be obtained simultaneously via the PCT-route.*
- o *Automatic designation was introduced for IA's filed on or after 1 Jan 2004*

L1-12

- (a) Give a definition of “designated Office”.

Give the relevant PCT provision(s) and finding place in the PCT Applicant's Guide.

How does processing start before such an office?

(b) Give a definition of "elected Office".

Give the relevant PCT provision(s) and finding place in the PCT Applicant's Guide.

How does processing start before such an office?

(c) Can the EPO act as designated or elected Office?

Answer

PCT

(a)

- = national Office of or acting for State designated by applicant under Chapter I of PCT - A.2(xiii)
- Processing is started by sending copy, translation and fee to dO's - A.22
- AG-IP 5.003 and AG-NP 2.002

⇨

(b)

- = national Office of or acting for State elected by applicant under Chapter II of PCT - A.2(xiv)
- Processing is started by sending copy, translation and fee to eO's - A.39
- AG-IP 5.004 and AG-NP 2.004

~~(b)~~(c) Yes

- EPO may be dO/eO for any EPC state designated in IA for which applicant wishes to obtain patent - A.153(1)(a) EPC
- EPO may be eO if a demand is filed – A.153(1)(b) EPC & (b)

Comment

(a) *AG-NP 2.002: The filing of a Request constitutes the designation of all Contracting States that are bound by the PCT on the international filing date - R.4.9(a)*

(b) *Elected Office:*

- *"Elected States" are defined in A.31(4)(a) PCT.*
- *AG-NP 2.004: Where a demand for international preliminary examination is filed, the term "elected Office" is used – instead of the term "designated Office" – to denote the Office of or acting for a State in which the applicant intends to use the results of the international preliminary examination. Since only designated States can be elected, all elected Offices are necessarily also designated Offices.*

(c) *All EPC states are PCT states*

L1-13

(a) What is the meaning of the word "agent" under the PCT. Who can act as agent?

Give the relevant PCT provision(s) and finding place in the PCT Applicant's Guide.

(b) What is the meaning of the word "common representative" under the PCT.

Give the relevant PCT provision(s) and finding place in the PCT Applicant's Guide.

Answer

PCT

(a)

- agent = person appointed under R.90.1, unless contrary clearly follows from wording or context - R.2.2
- = person having right to practice before rO. If IA filed at IB, person having right to practice in respect of IA before IB as rO. Agent may then represent applicant before rO, IB, ISA and IPEA – R.90.1(a)
- This may be an attorney, patent agent, or any other person (such as a lawyer) entitled under national law - A.49
- rO or dO (only after national entry) may apply their national law about who must be represented - A.27(7)
- AG-IP 5.041 – 5.051 and 11.001 – 11.014

(b)

⇨ Com. repr of R.90.2

- = one of applicants appointed as such – R.90.2(a), or considered to be (deemed – R.90.2(b)) common representative under R.90.2 - R.2.2bis
- Applicant must be entitled to file an IA at rO – R.19.1 - R.90.2(a), (b)

- AG-IP 5.048 and 11.005-11.007 and 11.101-11.014

Comment

- *AG-IP 5.048: If neither a common agent nor a common representative is appointed, the first-named applicant who has a right to file an international application with the receiving Office concerned is automatically considered to be the “deemed” common representative of all the applicants.*

L1-14

Two applicants wish to appoint a new agent for filing their next international application.

- How must the agent be appointed?
- The applicants want the agent to sign the request. Will the receiving Office require the filing of a separate power of attorney?
- Does the EPO require the filing a separate power of attorney?

The applicants subsequently decide to always use the agent, for which a general power of attorney has been prepared.

- Is it necessary to attach a copy of the general power of attorney to the Request [PCT/RO/101]?
- Does the EPO require filing a copy of the general power of attorney?

Answer

PCT

- R.90.4(a):
 - For the two applicants, appointment of a common agent is effected by each applicant signing, at his choice, the request or a separate power of attorney. R.90.4(a), AG-IP: 11.007
- It depends on the rO – usually no:
 - Applicants are not signing the request, so applicants must effect the appointment before rO by - R.90.4(b) – submitting a separate power of attorney either rO or IB
 - unless the rO waives this requirement - R.90.4(d) – which many have done
 - But if agent submits a notice of withdrawal, the separate power of attorney must be provided - R.90.4(e); AG-IP 5.044
- No
 - R.90.4(d), OJ2010, 335: EPO as rO has waived requirement to submit a separate power of attorney
 - HTG-II [\(07/11\)](#), [73-74109-112](#)
- It depends on the rO – usually no:
 - Appointment may be effected by referring in request to a general power of attorney
 - A copy of the power must usually be supplied with the request - R.90.5(a)(ii) - unless rO has waived requirement - R.90.5(c); AG-IP 5.003
 - But copy must be provided if agent submits a notice of withdrawal - R.90.5(d); AG-IP 5.044
- No
 - R.90.5(c); OJ2010, 335 EPO has waived requirement to submit copy
 - HTG-II [\(07/11\)](#), [73-74109-112](#)

Comment

- See AG-IP 11.007-11.008.
- HTG-II [\(07/11\)](#), [74111](#):
 - *As a matter of strategy and caution agents are recommended to obtain explicit authorisation from all applicants by way of direct signature of the PCT Request or by duly signed powers of attorney.*
 - *An explicit authorisation of each applicant is required in any case in which a withdrawal of any kind is submitted.*
 - *Further, EPO may require the filing of a separate power of attorney or a copy of a general power of attorney in any case of doubt as to the agent’s entitlement to act.*

L1-16

- Must the applicant be represented by an agent in the national phase?

- (b) Can an applicant resident in the USA perform the required steps for entry in the regional phase before the EPO as designated Office? If so, what conditions apply?

Answer

PCT

- (a) It depends on dO/eO:
- Once processing of IA has started in dO/eO (after national entry), dO/eO may require, as under national law, that applicant be represented - A.27(7), R.51bis.1(b) / R.76.5
- (b)
- EPO as dO requires representation for a US resident - A.133(1) & (2) EPC
 - If no representative appointed at expiry of 31m period - R.159(1) EPC, EPO will invite applicant to appoint one within 2m - R.163(5) EPC
- HTG-II (04/08), 306-310:
- Up to expiry of 31m -R.159 EPC, non-resident applicants may either take procedural steps initiating procedure before EPO as dO themselves, or act through a professional representative entitled to practise before EPO
 - Any acts after 31m (such as FP – A.121 EPC)- may only be taken through an entitled representative

Comment

- AG-NP 5.006: *Most designated Offices require non-resident applicants to be represented by an agent; others require non-resident applicants to have an address for service in the country for which the Office acts.*
- Also see GL A-VII, 3.1.
- HTG-II (04/08), 306-310: *Even if an entitled representative was appointed for international phase, he is not automatically also appointed for EP regional phase. A separate appointment is necessary.*

L1-19

The IB as receiving Office invites the applicant to remedy pursuant PCT R.26.2 certain defects in the international application within a period of 2 months. The applicant had supplied an e-mail address when the request was filed, and checked the “advance copies” box. An e-mail is sent, indicating the date of mailing as 1 April 2010, and a paper copy is dispatched on 6 April 2010. The applicant receives the letter on 9 April 2010.

- (a) At what time does the time limit expire?
 (b) Would your answer have been different if the applicant received the letter on 15 April 2010?
 (c) Would your answer to (a) have been different if he had checked the other box in the request?

Answer

PCT

- (a)
- R.4.4(c), last sentence; AG-IP 5.029
- By checking “advanced copies” box, applicant authorized notifications to be initially sent to e-mail address. Thus e-mail will always be followed by official notification on paper
 - Dispatch date of e-mail is irrelevant – this is additional service to applicant
 - Paper notification remains legal copy, and its dispatch date starts deadline - AG-IP 5.029
 - So time limit expires:
 - 6/4/10 + 2m [~~R.26.2~~; R.80.2] → 6/6/10 (Sun)
 - [R.80.5] → 7/6/10 (Mon)
- (b) Yes
- It was received more than seven days after date it bears, so period may expire later - R.80.6
 - 15/4/09 – 6/4/10 = 9 days, which is 2 days over limit
 - So 2m period will expire:
 - 6/6/10 + 2d [R.80.3] → 8/6/10 (Tuesday)
- (c) Yes
- By checking “exclusively in electronic form” box, applicant authorized notifications to only be sent to e-mail address

- No paper copies would be sent
- E-mail notification is legal copy, and date of mailing indicated, 1 April 2010, is starting point for legal calculation of deadline - Notes to PCT/RO/101
- So time limit expires:
1/4/10 + 2m [R.26.2; R.80.2] → 1/6/10 (Tue)

Comment

- -See also PCT AG-IP Annex B: IB allows communications to be sent by e-mail
 - The communication is sent pursuant to A.14(1)(b), R.26
- (b) *If there are extra days under R.80.6 available, they should be added first, and then followed by any extension under R.80.5 – see “Background Reading on the patent Cooperation Treaty” –Procedural Safeguards, paragraph 31. This useful little book is available at www.wipo.int/pct/en/seminar/basic_1/index.html:
31. An applicant who wants to claim an extension of a period because of late receipt of mail must offer evidence to the satisfaction of the Office concerned that the document or letter was received more than seven days after the date it bears. The period will then be treated as starting on the proven later date, which means that the date on which the period starts is the date of actual receipt minus seven days.*
- (c) It is not recommended to use this option because e-mails can get lost, and PCT has no simple remedies such as further processing

L2a – Filing an International Application; Filing date

L2a-07

What is the competent receiving Office for nationals and residents of the following countries:

- (a) France?
- (b) The Netherlands?
- (c) Mali?

Answer

PCT

rO determines for which applicants they are competent -

R.19.1(a)

- (a) AG-IP – Annex B1 – FR:
 - Either FR patent office, EPO or IB
 - But FR resident may only file directly with EPO or IB if it is a subsequent application claiming priority of an earlier FR application
- (b) AG-IP – Annex B1 – NL:
 - Either NL patent office, EPO or IB
- (c) AG-IP – Annex B1 – ML:
 - Either IB or OAPI

Comment

- (b) *Note: European patent applications may not be filed at NL national office - A.75(1)(b) and National Law, Table II, column 1*
- (c) *Mali will not be tested on the EQE. However, this question is intended to test whether candidates can find countries in their materials. The Examination Board makes a large (1600 pages) printable version of the PCT AG in January before the EQE.*
- If more than 1 competent rO, applicant(s) may choose

L2a-17

An applicant files a European patent application as a first application on 3 March 2011 comprising a description and drawings. Upon invitation from the EPO, a set of claims is immediately filed on 14 May 2011.

- (a) What date will be accorded by the EPO as the date of filing?
- (b) Would your answer have been different if the applicant had filed an international application at the EPO as receiving Office?

Answer

- (a) EPC: Filing date = 3 March 2011
 - Criteria of A.80, R.40(1)(c) met on 3 March 2011
 - I assume that R.40(1)(a) & (b) are also met
 - Claims need to be filed for search - A.78(1)(c), but claims are not required for filing date
 - EPO will check whether at least one claim is filed - A.90(3), R.57(c). If not, EPO will invite - R.58 - applicant to file one or more claims within 2m
 - ~~14 May 2011~~ Filing immediately will always fall within this period, so claims have been filed in time
- (b) Yes, PCT: filing date would become 14 May 2011
 - EPO as rO accords as filing date, provided that IA comprises a part which on face of it appears to be a claim - A.11(1)(iii)(e)
 - SO 3/3/11 will not be accorded as filing date
 - EPO as rO checks for presence of a claim - A.11(1). If not present, EPO will invite applicant to furnish at least one claim - A.11(2)(a), R.20.3(a)(ii) - within 2m from date of invitation - R.20.7(a)(i)
 - So 14/5/11 will be filing date - R.20.5(b)

Comment

- See AG-IP 6.025.
- applicant is informed of filing date so accorded – R.20.2(c) PCT

L2b – Priority; Formalities on Filing

L2b-03

Upon filing an international application all States are automatically designated.

- (a) Why can it be useful to be able not to designate a Contracting State?
Which States have made use of this provision?
- (b) How can a specific designation be excluded?
- (c) If a designation of a State is excluded, can this State later on be designated again?

The applicant has indicated in the Request [PCT/RO/101] the exclusion of the designation of Germany.

- (d) Can the applicant obtain a patent in DE in the EP regional phase?

Answer

PCT

- (a)
 - On filing, all PCT states and recognised regional treaties are automatically designated - R.4.9(a)(i)
 - But some national laws prescribe that filing an IA claiming priority of a national application results in that national application being considered withdrawn - R.4.9(b)
 - DE, JP & KR are the only PCT states where this is prescribed - AG-IP 5.053
- (b) Request PCT/RO/101 contains check-boxes in Box No. V to exclude designation of DE, JP, and/or KR “for any kind of national protection”
- (c) No – exclusion is irrevocable - box V PCT/RO/101
- (d) Yes - HTG-II (07/11), 12082
 - Problem of self-designation is exclusively for DE designation under PCT
 - EP designation under PCT and therefore the DE designation under EPC are unaffected

Comment

- Since 2004 it is no longer possible to designate States separately when filing an international application.
- See also AG-IP, Annex B - DE
- R.4.9(a) and AG-IP 5.016: The filing of a Request constitutes:
 - the designation of all Contracting States bound by the PCT on the international filing date,
 - for the grant of every kind of protection available and

- o for the grant of both regional and national patents.

L3 – International search and publication; preliminary examination

L3-08

A Dutch applicant interested in patent protection for his invention in the USA and in Europe files an international application relating to a method of doing business with a technical character.

The EPO as International Searching Authority declares pursuant PCT Art.17(2)(a)(i) and R.39.1 that the international application relates to subject-matter which the International Searching Authority is not required to search.

- How would you advise your client?
- Should the EPO have not first **informed** the applicant before declaring that no search would be performed? Can the applicant file a protest and obtain a reimbursement of the search fee?
- Would your answer have been different if the applicant was an US national indicating EPO as International Searching Authority?

Answer

PCT

- Advice:
 - o Do nothing and normally enter US and EP national phases
 - o A demand is probably no use because - R.66.1(e) – unsearched claims need not be examined - AG-IP 10.062

National phase US: No problem – business methods are patentable

EP regional phase:

- o During substantive examination, EPO will probably object under A.52(2)(c) or A.56 EPC
 - o we can then argue that invention has technical character and is to be regarded as invention - GL C-IV, 2.3.5
- No, there is no provision for such a protest in PCT
 - o But as a courtesy service, EPO will sometimes contact the applicant before declaring that no search can be performed – A.17(2)(a) PCT - to request clarification of the application – OJ2011, 327
 - Yes, OJ2002, 175:
 - o EPO will perform a competence check immediately after receipt of search copy
 - o Where EPO finds that it was indicated as ISA although application relates to a business method, it will delete indication and indicate USPTO as ISA *ex officio*
 - o EPO will inform applicant, IB and USPTO accordingly and transfer search fee received to USPTO

Comment

General remarks about the consequences if an applicant receives a declaration of no search - A.17(2)(a). See also "Practical Advice" in PCT NL 10/2007, p.7:

- o *Results of international search are not binding on dO/eO's - A.27(5)*
- o *Applicant may informally contact ISA and ask them to review the declaration of no search. ISA is not forbidden from revising its decision*
- o *On national entry, applicant may always amend application - A.28, 41 and R.52, 78*

L3-09

The EPO as ISA considers that the sequence listing filed by the applicant upon filing the international application is not available in a form and manner acceptable to it. For the purposes of the international search, the EPO invites the applicant to furnish a sequence listing complying with the required standard.

- Is a fee required for the late furnishing of the sequence listing?
- If so, what is the amount?
- What is the sanction if the sequence listing is not filed?

Answer

PCT

- (a)
- Sequence is late-filed because EPO had to formally ask for it - R.13ter.1(a)
 - Filing it incurs a late furnishing fee - R.13ter.1(c) – for benefit of ISA
 - maximum = 25% of international filing fee - R.13ter.1(c)
 - EPO levies this late furnishing fee - OJ2007-SE3, C.1 and C.2 OJ2011, 372 & 376; GL A-VII, 4.2
 - = €210 - “Schedule of fees and expenses of EPO”
- (b) If not filed, ISA is only required to search IA to extent that a meaningful search can be carried out without sequence listing - R.13ter.1(d)

Comment

- (a) Also see AG-IP 7.005-7.012, in particular 7.010.
- (b) GL A-VII, 4.2: For Euro-PCT applications entering the regional phase before EPO, the applicant will be invited to furnish a sequence listing in accordance with WIPO Standard ST.25 and pay a late furnishing fee within a period of 2 months, if such a sequence listing is not available to EPO at the expiry of the period for entry into the regional phase [see R.163(3) and R.30(3)].
- (c) Also see AG-IP 7.013.

L3-23

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.152, 1st sentence EPC
- (b) AG-IP – Annex C – DK:
 ○ EPO - A.152, 1st sentence EPC
 ○ XN
 ○ SE patent office
- (c) AG-IP – Annex C – US:
 ○ AU patent office (only for certain IAs),
 ○ EPO - A.152, last sentence EPC
 ○ 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; OJ2010, 304
 ○ HTG-II (07/11), 197+96: 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.

L3-25

- (a) What are the amounts of the fees payable in respect of a demand for international preliminary examination if the EPO acts International Preliminary Examining Authority?
 (b) Which languages are accepted by the EPO for the international preliminary examination?

Answer

PCT

- (a) A.31(5):

- Handling fee - Schedule of Fees, Item 3: handling fee; R.57.2(a) = 200 Swiss Francs
- Payment of €164 to be paid to EPO = equivalent amount in AG-IP – Annex E – EP
- IPE fee - R.58 PCT; R.158(2) & RFees 2(1).19 EPC = €1760

- (b) EPO as IPEA - A.152 EPC
- Accepts En, Fr or Ge - OJ2010, 304, A.3(2)
 - Also AG-IP – Annex E – EP

Comment

(b) *Languages accepted by EPO as IPEA:*

- *HTG-II (07/11), 339222: If EPO is IPEA for an international application originally filed in Dutch with the Dutch or Belgian patent office as receiving Office, the applicant need not file a translation of the international application since EPO as IPEA will use the published version of the international application which it receives from the IB. It should be noted that the demand and amendments must be submitted in the language of the international publication.*

L3-27

After receiving the international search report and an unfavourable written opinion from the EPO acting as ISA, the applicant decides to file a demand for international preliminary examination.

- (a) Will the EPO regard the written opinion of the ISA as a written opinion of the IPEA?
- (b) Will the applicant receive a further written opinion before the international preliminary examination report (IPER) is established?
- (c) Is the applicant entitled to a personal interview with the EPO examiner responsible for preparing the IPER? If so, when should a request for an interview be filed?
- (d) How can the applicant optimally benefit from the procedure before the EPO as IPEA?

Answer

PCT

- (a) Yes
 - Generally, WO- ISA - R.43bis.1 - is regarded as a (first) written opinion of IPEA - R.66.1bis(a)
 - But EPO will not consider WO by any ISA other than EPO itself as a WO-IPEA - R.66.2(a), R.66.1bis(b)
- (b) ~~No, normally not~~ It depends
 EPO acting as IPEA - OJ2011, 532005, 493 and HTG-II (07/11), 254372-379:
 - ~~○ A further written opinion before drawing up IPER is entirely at discretion of EPO~~
 - EPO will normally issue IPER while taking into account any arguments and/or amendments duly filed, but usually without issuing a second written opinion, even if not all objections have been overcome

~~HTG-II, 255:~~

 - EPO will issue a second WO if:
 - it considers issuing a negative IPER, and
 - the applicants filed amendments/arguments to be taken into account during examination – R.66.1(a)-(d); R.66.4bis
 - Applicant will then have opportunity to submit further amendments and/or arguments, making the chance of a negative IPER smaller
 - ~~○ If WO-ISA established by EPO contained comments or objections (“negative WO-ISA”), EPO as IPEA will consider WO-ISA as first written opinion~~
 - ~~○ WO-ISA will usually be reissued as a first written opinion of IPEA. EPO may thus issue IPER immediately after expiry of time limit for filing demand~~
 - ~~○ This procedure applies irrespective of whether applicant has filed arguments and/or amendments for EPO to take into account as IPEA, since as a rule no second written opinion is established~~
- (c) Yes, HTG-II (07/11), 262385-388; OJ2011, 5322005, 493: A.34(2)(a), R.66.6
 - Request for personal communication by telephone is permitted. It should be requested immediately, preferably with demand. If request is later, IPRP (Chapter II) may already have been established and request cannot be granted
 - This telephone consultation replaces any second WO
- (d) Best way to proceed:

- File amendments – either under A.19 after receiving ISR, or under A.34 specifically for IPE – R.66.1(c and (b)
- **Fileing** arguments how the amendments overcome objections in WO-ISA;
- Include a conditional request for a telephone interview in case a negative IPER is foreseen/envisaged by IPEA

Comment

- (a) *PCT NL 01/2004, p.4: EPO, in its capacity as IPEA, has notified the IB under R.66.1bis(b) that R.66.1bis(a) will apply as follows - also see HTG-II (07/11), 442371:*
 - *R.66.1bis(a): WO-ISA is considered to be a (first) written opinion of the IPEA for the purposes of international preliminary examination.*
 - *However, EPO has notified the IB under R.66.1bis(b) that this provision is only applied by EPO as IPEA to the extent that the WO-ISA has been established by EPO acting as ISA.*
 - *This means that EPO as IPEA does not consider any WO-ISA established by any ISA other than EPO itself as a written opinion for the purposes of international preliminary examination – see HTG-II (07/11, 373).*
- (b) ~~*It is so in applicant's interest to deal as comprehensively as possible with all matters raised in first written opinion immediately on filing his reply – OJ 2005, 493 This has changed from December 2011. HTG-II (07/11): 370-379 is unclear. The notice of OJ2011, 532 is clearer about the new practice.*~~
- (c) *OJ2005, 493: While one such interview will, if requested on time, normally be granted, any further such interviews are entirely at the discretion of the examiner concerned.*
- (d) *Also see HTG-II (07/11), 245-249362-368.*

L3-29

- (a) Is the international preliminary examination report accessible to persons other than the applicant and the elected Offices?
- (b) To what extent is the international preliminary examination confidential?
- (c) When is access to the file of the international preliminary examination afforded by the EPO?

Answer

PCT

- (a) No:
 - Neither IB nor IPEA, unless requested or authorised – R.94.2 - by applicant, allows access - A.30(4) - to file of IPE, except by eO's once IPER has been established - A.38(1)
- (b)
 - In general, neither IB nor IPEA gives information on issuance or non-issuance of IPER and on withdrawal or non-withdrawal of demand or of any election - A.38(2). Exceptions are if applicant requests/authorises it, once IPER is established - A.38(1) – and communications between PCT authorities - A.36(1), (3) and 37(3)(b),
 - If national law applicable by any eO allows access by third parties to file of a national application, that Office may allow access to IA file in the same way, but not before publication of IA - R.94.3
- (c) GL E-IX, 6.4 - OJ2007–SE3, J.2; HTG-II (07/11), 404274:
 - After publication of IA and completion of IPER
 - Access to file is allowed even if applicant did not signal his intention to enter EP-phase

Comment

- (a) *AG-IP 10.080: The report is not published by the IB. According to A.36(3)(a), the IB communicates the report to elected Offices. As of 1 January 2004, however, if so requested by an elected Office, the IB will furnish copies of the IPRP (Chapter II) to any person, although, not before the expiration of 30 months from the priority date. The IPEA may not, unless requested or authorized by the applicant, give copies to anyone other than the applicant and the International Bureau. Once the IPRP (Chapter II) becomes part of the file in the elected Office, however, the national law applicable by that Office applies as to access to that report and the international preliminary examination file by persons other than the applicant.*
- (b) *AG-IP 10.081: Neither the IB nor the IPEA may, unless requested or authorized to do so by the applicant, give information on the issuance or non-issuance of an IPRP (Chapter II) or on the withdrawal or non-withdrawal of the demand or of any election. Information from the international preliminary examination file may, however, be available through some elected Offices.*
- (c) *GL E-IX, 6.4: In its capacity as elected Office EPO allows access to its files (including the entire PCT Chapter II file) relating to the international phase of applications filed on or after 1 July 1998, provided*

international publication has taken place and, as far as the PCT Chapter II file is concerned, the IPER has been completed. The above applies mutatis mutandis to the communication of information from the files.

L4 – National phase and Euro-PCT application

L4-03

A US applicant, resident in the US, files his international application at the USPTO. After receiving a positive search report from the USPTO, he wishes to pursue his application before the EPO as designated office.

- (a) Can the US applicant initiate the national entry procedure himself?
- (b) What happens if a representative is not appointed once the processing has started by the EPO?
- (c) What are the minimum acts to enter the regional phase before the EPO if surcharges are to be avoided?

Answer

PCT

- (a) Once processing of IA has started, EPO as dO may apply EPC - A.27(7) PCT – concerning who needs to be represented
 - o Applicant is not resident in EPC state, so in principle must be represented - A.133(1),(2) EPC
 - o But this only applies once “processing has started”
 - o Applicant may initiate national phase himself – i.e. may perform R.159(1) EPC acts for entry before expiry of 31m from priority - HTG-II (04/08), 307
- (b) If no representative appointed on entry, EPO will invite applicant to do so within 2m – R.163(5) EPC
 - o Failure will lead to a refusal of application - R.163(6) EPC
 - o FP is available - A.121(1), R.135(1) EPC
- (c) :
 - o A.22(1)/A.39(1)(a) PCT requires:
 - o where applicable, a translation - R.49.2/R.76.5
 - o payment of national fee – AG-NP – National Chapter - EP

Before expiry of 31m from priority - R.159(1) EPC:

- (a) supply any prescribed translation – A.153(4) EPC
- (c) pay filing fee and any page fee – Rfees 2(1).1 & 1a; A.78(2) EPC
- (d) pay designation fee if R.39 EPC has already expired – Rfees 2(1).3 EPC
- (e) pay search fee, because a supplementary ESR has to be drawn up – Art.153(7) EPC, OJ2009, 594; RFees 2(1).2 EPC
- (f) file request for examination if R.70(1) EPC period has already expired, and pay examination fee – Rfees 2(1).6 EPC
- (g) pay renewal fee in respect of third year - A.86(1) EPC - if fee has fallen due earlier - R.51(1); RFees 2(1).4 EPC

Optional requirements – do before expiry of 31m to avoid surcharges:

- o R.163(3) EPC: Where applicable, file a sequence listing if listing not available to EPO - R.30 EPC
- o R.159(1)(h) EPC: Also file, where applicable, certificate of exhibition - A.55(2); R.25 EPC

Comment

- (b) *HTG-II (04/08), 307: Under no circumstances can an applicant act through his agent appointed for the international phase if the latter is not a professional representative entitled to practise before EPO. See also GL A-VII, 3.1*

L4-04

What happens if an applicant does not perform the acts required for national entry in due time?
What is the effect on other designated or elected Offices?

Answer

PCT

- o IA loses effect of a national application – A.11(3) - in respect of that dO/eO - A.24(1)(iii) / A.39(2)
- o For example, any provisional protection or national prior right effect will be lost

- Applicant may request dO/eO to maintain effect of IA and to excuse delay - R.49.6; A.48(2) R.82bis
- Termination will not affect procedure before other dO/eO's where national phase was duly entered

Comment

- Also A.11(3): regular national effect of international application.
- Also AG-NP 4.003.
- AG-NP 6.022: Contracting States are required under R.49.6 to provide the possibility to reinstate the rights of the applicant with respect to an international application where the applicant failed to comply with the requirements of A.22 or A.39(1). Details of this possibility are given in R.49.6. Some Contracting States have notified the IB, under R.49.6(f), of the incompatibility of this rule with their national laws. A table of such notifications is available online on WIPO's website.
- See AG-NP 4.004 and 6.021-6.027

L4-07

(EQE – 4 points)

British company X has just acquired from German company Y full rights to an international application designating EP. The application was filed in German at the EPO. A valid demand for international preliminary examination was filed by company Y. The EPO is ISA and IPEA.

Company X would like English rather than German to be used in all forthcoming proceedings, both in the international and in the EPO regional phase.

Is this possible? If so, to what extent?

Answer

In international phase - PCT:

- IA was filed in German,
 - so amendments must be in German – R.12.2(a)
 - so default language for correspondence also Germ - R.92.2(b); OJ2010, 304 Annex D
- But X may use any official EPO language in correspondence, including English – OJ1993, 540
- There are no PCT provisions to permit a change of language of application

In EPO regional phase - EPC:

- In written proceedings, English may be used - R.3(1); A.14(1)
- But amendments must be filed in language of proceedings - R.3(2), which is Germ- A.153(2) and A.14(3)
- There are no provisions to permit a change of language of proceedings - G4/08

Comment

- Based on Question 4 of paper DI of EQE 1998 [4 points]
- R.46.3, 55.3 and 66.9 do not apply, since the application was published in German (R.48.3)
- See HTG-II (04/08), 285 and 330-332.
- Any unnecessary translation of the IA that is nevertheless filed will be ignored by EPO - HTG-II (04/08), 330

L4-10

An international application is filed in 201107.

- (a) Under what conditions will a supplementary European search report be drawn up when it enters the EP regional phase?
What fee must be paid? What is the amount of the fee?
- (b) Under what conditions is the fee reduced? How much is the reduction?
- (c) What is the consequence if the fee in respect is not paid? When does the loss of rights ensue?
Remedy?
- (d) Is the supplementary search report published by the EPO? If so, how?

Answer

EPC

- (a)
 - A supplementary ESR is always drawn up - A.153(7), unless - OJ2009, 594:
EPO was ISA, or EPO was SISA

- If supplementary ESR to be drawn up, search fee must be paid before expiry of 31m from priority - R.159(1)(e)
 - Search fee = € 1105 - RFees 2(1).2
- (b) OJ2010, 133:
- If ISR (or a SISR) was drawn up by AT, FI, ES, SE or XN offices, fee reduced by € 940
 - If AU, CN, JP, KR, RU or US were ISA, fee reduced by € 190
 - If CA or BR were ISA, no reduction is given
- (c)
- If not paid in due time, application deemed withdrawn - R.160(1)
 - EPO will notify applicant of this loss of rights - R.160(2)
 - Loss of rights ensues on expiry of 31m period - G4/98, mutatis mutandis
- Remedy: Request FP – A.121 - within 2m of R.160(2) notification:
- Pay FP fee – Rfees 2(1).12 = 50% of missing search fee
 - Complete omitted act – R.135(1) – by paying missing search fee
- (d)
- Supplementary ESR is established on a new main page marked A4 - GL B-X, 4
 - It is not published, but it is forwarded to applicant
 - It is also available via file inspection - A.128(4)

Comment

- (a) Also see HTG-II (04/08), 368.
- (b) Supplementary European search report:
- See GL B-II, 4.3.
 - For an overview of the reductions, see OJ2010, 133.
- (d) Supplementary European search report:
- GL B-X, 4: Where the search report is a supplementary search report in respect of an international application, this search report is established on a new main page marked A4.
 - The completion of the report is published in the EP patent Bulletin - GL B-X, 7
 - Also see HTG-II (04/08), 376.

L4-11

An international application is filed in 2007 at the EPO. The EPO was also the ISA.

- (a) When must the request for examination be filed for an international application entering the European phase before the EPO as elected office?
- (b) What fee must be paid? What is the amount of the fee? Under what conditions is the fee reduced?
- (c) What is the consequence if the examination fee is not paid in due time? When does the loss of rights ensue? Remedies?

Answer

EPC

- (a) Whichever expires later – either 6m after publication of ISR - A.153(6), R.70(1) - or 31m from earliest priority - R.159(1)(f)
- (b) EPO was ISA, so no supplementary ESR will be performed and no search fee is to be paid - A.153(7), OJ2009, 594
- EPO as elected office means that a demand was filed – R.53.7 PCT
 - EPO was rO, so only the EPO could be the IPEA – A.31(6)(a), R.59 PCT
 - Examination fee - A.94(2) - RFees 2(1).6 – is therefore reduced by 50% => €822.50 - RFees 14(2)
 - 20% reduction is due if applicant is A.14(4) person and requests examination in corresponding national language – A.153(2), R.6(3); RFees 14(1)
- (c)
- application deemed withdrawn - R.160(1)
 - EPO will notify applicant of this loss of rights - R.160(2)

Remedy = within 2m of R.160(2) notification :

- Request FP – A.121(1) – by:
 - paying FP fee – Rfees 2(1).12 = 50% of examination fee
 - completing omitted act – R.135(1) – by paying missing examination fee
- Loss of rights ensues on expiry of period indicated in (a) - G4/98, mutatis mutandis

Comment

- *If the applicant did not use EPO Form 1200 for the act of entry into the regional phase before EPO [using this form is not obligatory – GL A-VII, 1.1 or E-IX, 5.1 -, and does not supply the written “request for examination” in another form, the Euro-PCT will be deemed to be withdrawn. This omission can be corrected by requesting further processing and paying the fee for further processing.*
- *If both reductions apply, the full fee will be reduced with 50% and the resulting amount with 20%, i.e. a total reduction of 60% [also see HTG-II (04/08), 396*

L4-17

(EQE – 7 points)

An international application was filed on 18 October 2011 with the intention to enter the EP regional phase. A priority of 18 October 2010 was claimed. The abstract is missing in the international application.

The receiving Office has invited company A to correct the defect, setting a time limit which ended on 9 February 2012. In the meantime, due to the sudden bankruptcy of its main debtor, company A faced severe financial difficulties, neglected the application and did not react to the invitation.

As a consequence, the receiving Office considered the application withdrawn and dispatched the corresponding declaration, dated 21 February 2012. After having being fully informed of the status of the application, company C took over all assets of company A on 5 March 2012.

C asks you whether it is possible to revive the international application or at least to save the designation EP, and if so, what the time limits involved are.

Answer

PCT

Review and excuse procedure by EPO as dO:

- It is not possible to revive IA: there are no provisions for revival under PCT
- Time limit was set by rO - R.82bis.1(ii)
- So designation EP may be saved by filing an A.25(1)(a) review request at EPO and taking necessary steps for entry into EP regional phase - A.25(2)(a)
- These steps must be performed at latest on - A.25(1)(c), R.51.1 and 51.3:
 - 21/2/12 + 2m [R.80.2] → 21/4/12 (Sat)
 - [R.80.5] → 23/4/09 (Mon)
- Since refusal was not result of a rO error - A.25(2)(a), a request for delay to be excused should be filed at EPO at same time - A.24(2), A.48(2)
- EPO will excuse delay if it would do so for a direct EP filing under the EPC
 - EPO would send a R.58 EPC invitation to file missing abstract. If not rectified in time, application would be refused - A.90(5) EPC. FP – A.121 EPC - is ruled out - R.135(2) EPC, so RE – A.122 EPC is available - R.136(3) EPC
- So a RE request should also be filed, and RE fee paid - RFees 2(1).13 EPC
- Complete omitted act by filing missing abstract
- Argue that in spite of all due care it was not possible to act on this application because of financial problems - see e.g. J22/88
- Financial problems were resolved when company C took over, so RE request must be filed at latest on:
 - 5/3/12 + 2m [R.136(1), R.131(4)] → 5/5/12 (Sat)
 - [R.134(1)] → 7/5/11 (Mon)
 and no later than:
 - 9/2/12 + 1year [R.136(1), R.131(3)] → 9/2/13 (Sat)
 - [R.134(1)] → 11/2/13 (Mon)
- So RE request must be filed no later than 7/5/11

Comment

- Based on question 7 of paper DI of EQE 1998 [8 points (adapted)]
- Examiners report (adapted): Too many candidates assumed that all the provisions are available in the PCT international phase. Further processing and re-establishment of rights are not available and the international application cannot be revived. Those who recognised this also, mostly, knew the detailed requirements for entry into the regional phase using A.25(1)(b) and that the time limits ran from the date of the declaration by the receiving Office. A number assumed that EPO ten-day R. applied. Others forgot that re-establishment of rights should be requested.
- See AG-NP 6.018, 6.020, 6.023, 6.025 and EP.23, 24, 26
- For an example, see OJ1984, 565, item 4 (a decision of the Examining Division): What general procedural conditions must be fulfilled under A.24(2) emerges indirectly from the reference to A.25 in this provision [by the words "... even where such effect is not required to be maintained by virtue of A.25(2)"] A.24(2) contains no detailed provisions on how the national (regional) phase is to be entered before EPO as designated Office. Therefore this provision must be seen as a subcategory of A.25(2) wherein the finding that the contested decision to withdraw the international application was the result of an error or omission is not germane to the case.
- Also see HTG-II (04/08), 431-433.
- R.159(2): The Examining Division is competent to take decisions of EPO under A.25(2)(a).
- The invitation to supply the abstract is under R.26(1) PCT
- Note that EPO will also need to be informed of the change of applicant. This can no longer be performed in the international phase because there is no pending application.

L4-18**(EQE – 3 points)**

- (a) Is it possible to formally request the acceleration of the prosecution of a European patent application?
- (b) Can a similar effect be obtained in the regional phase for an international application designating/electing EP? If this application has not yet entered the regional phase before the EPO, how would you proceed?
- (c) Is it possible to accelerate the processing of an opposition before the EPO?
- (d) Is it possible to accelerate the processing of an appeal before the EPO?

Answer**PCT**

- (a) Yes - PACE - OJ2010, 352
- (b) Yes:
 - a PACE request may be filed on entry or at some time regional phase - OJ2010, 352 – item 8
 - If entry is done before 31m - R.159(1) EPC – then explicit request for early entry must be given - A.23(2) / A.40(2)
- (c) Yes, if infringement proceedings and on request of party to proceedings - OJ2008, 221
- (d) Yes, parties with legitimate interest may request it - OJ2008, 220

Comment

- Based on Question 8 of paper DI of EQE 1999 [3 points (adapted)]
- Examiners' Report: Many candidates often failed to give fully the articles and R.s or other source providing the basis for their answers. This is essential in Part I if full marks are to be obtained for a question. Many answered this question well, with the main omission being the possibility of shortening the international phase under A.23(2) or A.40(2) PCT.
- HTG-II (04/08), 296: In addition to the possibility of early entry into the European phase, the applicant may wish accelerated prosecution on or after entry into the European phase. For this purpose, a request under the PACE programme is to be submitted on entry into the European phase or later. The acceleration affects the formalities examination, the establishment of the supplementary European search report, where such a report is to be drawn up, and substantive examination.
- Also see GL E-VIII, 3, 4, and 5 and GL D-VII, 1.2 (iii)

L4-19

You are a Dutch patent attorney and you have filed an international application in English for your Dutch client with the Netherlands Patent Office as receiving Office. 29 months after the priority date your client asks you to take the necessary steps for entry into the regional phase before the EPO.

How would you advise your client?

Answer

EPC

- A Dutch patent attorney is not entitled to represent before EPO as dO/eO - A.27(7) PCT; A.133(1)
- Applicant should so either appoint a professional representative or perform acts for entry himself
- In either case, acts for entry into EP regional phase must be performed before end of 31m - R.159(1)

Comment

- *Alternatively, the Dutch client can also be represented by an employee - A.133(3).*
- *HTG-II (04/08), 307: Under no circumstances can an applicant act through his agent appointed for the international phase if the latter is not a professional representative entitled to practise before EPO.*

L4-21

An international application is filed in Italian at the Italian Patent and Trademark Office as receiving Office. During the international phase the application is translated into English for the ISA.

- (a) Briefly summarise the procedure to be followed on entry into the European regional phase
- (b) After entry, may the applicant file a divisional application?
- (c) In which language(s) can the divisional be filed?

Answer

EPC

- (a)
 - EPO is competent ISA for filings at IT patent office as rO - A.10, R.19 PCT; AG-IP: Annex C, IT
 - So on entry, no supplementary ESR will be performed - Art.153(7); OJ2009, 594
 - After entry, R.161(1) communication will be sent. If WO-ISA is not wholly positive, a response is required to objections of WO-ISA. At this time, application may be amended to resolve these objections
 - Examination will then follow on application as amended in response to R.161(1) communication
- (b) Either a R.71(1) or R.71(3) communication from Examining Division will be sent – its notification being trigger for 24m to file a voluntary divisional – R.36(1)
After entry, IA considered an EP application - A.153(2)
As long as Euro-PCT remains pending - G1/09, and one of periods of R.36(1) has not expired, divisional - A.76 – may be filed
- (c) Italian is not a language of publication - R.48.3(a) PCT
 - EPO is competent ISA, which does not accept Italian - OJ2010, 304, A.3(1) and Annex A
 - So a translation under R.12.3(a) PCT would have been required
 - This is English translation – a language of publication R.48.3 PCT , so it would have been published in English
 - So, on entry, no translation was required - A.153(3)
 - Language of proceedings is English - A.153(2), Art.14(3) and it cannot be changed – G4/08
 - So divisional should be filed in English - R.36(2)
 - But as parent was filed in Italian, it may also initially be filed in Italian, and a translation into English provided within 2m of filing divisional - A.153(2), R.36(2)

Comment

- (a) *See HTG-II (04/08), 445
GL A-VII, 4.1: There is no provision in the PCT for filing divisional applications. One or more European divisional applications may be filed in respect of subject-matter contained in an earlier Euro-PCT application, but not before the latter application is pending before EPO acting as designated or elected Office, i.e. has entered the European phase. The divisional application must be filed in the language of proceedings of the earlier application.*
- (b) *Also see HTG-II (04/08), 330-332.*

L4-23

An international application was filed in Japanese at the Japanese Patent Office without claiming priority on 24 September 2009. The international application was published on 31 March 2011, the international search

- So we should complete all other acts of R.159(1) at latest on 12/3/12:
 - filing fee - R.159(1)(c); Rfees2(1).1 - and any page fee - Rfees 2(1).1a; R.38(2) - for pages above 35
 - pay designation fee - R.159(1)(d); Rfees2.1(3)
 - file written request for examination - R.159(1)(f)
 - pay examination fee - R.159(1)(f); Rfees2.1(6)
 - pay search fee - R.159(1)(e); Rfees2(1).2 - because JPO was ISA, and not EPO, so supplementary ESR will be drawn up - A.153(7); OJ2009, 594
- Once we have translation on 24/4/12, we will still be within 2m of R.135(1). We should then pay fee, and file translation as omitted act - R.135(1)

Comment

- *Based on Question 5 of paper DI of EQE 2003 [5 points*
- *EPO does not accept JP, so a translation into En, Fr or Ge has to be filed - A.153(4) and R.159(1)(a).*
- *The applicant is resident outside states, so I must be appointed to perform the further processing - A.133; HTG-II (04/08), 314*
- *Withdrawing the priority claim pursuant R.90bis.3 is not possible, because the time limit for filing such withdrawal is 30 months from the priority date.*
- *Search fee is reduced with EUR 190 as ISA=JP - OJ2010,133*
- *No reduction on examination fee for JP=ISA - OJ2010,133*
- *Not necessary to specify application documents under R.159(1)(b) if it is intended to continue with the Ch.II documents before EPO as eO - A.31(4)(a) PCT; GL E-IX, 6.1*
Remark: if EPO would have been dO, default would be the published documents with any amendments under A.19 PCT - GL E-IX, 5.7
- *The renewal fee in respect of third year falls due at 31/8/2012 (Friday) - R.159(1)(g); R.51(1). So no need to pay and cannot yet be paid, as more than 3m before due date - R.51(1),last sentence*
- *Not necessary to pay claims fees (if any) yet, as invitation under R.162 will follow.*
- *Not necessary to submit copy of search results of P-JP upon entry - R.141(1) - as an exemption applies - R.141(2); OJ2011, 62*