

# Training for the European Qualifying Examination

## Exam-Related Questions and Answers

**Pete Pollard, Roel van Woudenberg  
and Jelle Hoekstra**

### 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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## EPC: SUBSTANTIVE PATENT LAW

### B – INTRODUCTION EPC

#### B2 – Interpretation of the EPC

##### B2-02

(EQE – 2 points)

After expiry of the period for filing the request for examination, the applicant received a communication noting the loss of rights. Thereupon the applicant duly paid the examination fee and the fee for further processing. At the same time he requested a refund of the fee for further processing alleging that the EPO had not communicated the date on which the European Patent Bulletin mentioned the publication of the European search report to him and had not drawn his attention to the provisions of R.70(1) and Art.94(2) EPC in this communication.

Will the EPO refund the fee for further processing?

##### Answer

##### EPC

No:

- FP - A.121 - may be requested for period of R.70(1)
- There is no EPC provision for such refund
- R.69(1) obliges EPO to inform applicant of SR publication date, R.70(1), A.94(2) provisions. If this was not correctly notified, EPO may reconsider loss of rights
- If still within 2m time limit, he should preferably request R112(2) decision on matter, providing any facts and evidence
- If outside 2m limit, he may be able to invoke good faith - G5/83 - because he was misled by conduct of EPO - J902/87

##### Comment

- *Based on Question 8 of Paper DI of EQE 1997 [2 points (adapted)].*
- *It is assumed that before the expiry of the R.70(1) period, the applicant responded to the search report if not wholly positive - R.70a(1) and paid the designation fee - R.39(1)*
- *If the decision is to maintain the loss of rights, the applicant can appeal - A.106*

### B3 – Institutional Provisions

##### B3-01

(3 points)

During Opposition Proceedings, a patent is transferred to a new owner. The opponent objects against the new owner being party to the opposition proceedings, and appeals against the decision to mention the new owner in the register.

Who is competent to decide this appeal?

##### Answer

##### EPC

- This is transfer - A.71, R.22 jo. R.85
- In principle, Legal Division is responsible for decisions on such transfers - A.20(1)
- o Formalities officers of Opposition Divisions are responsible for initially registering transfer - R.11(3); OJ2007-SE3-F.2
- o Normally no decision is taken - the transfer is just carried out by the Opposition Division formalities if requirements are complied with
- o In this case, there is a dispute and an adverse decision is likely, so the Legal Division becomes responsible OJ2007-SE3-G.1
- ~~Formalities officers of Opposition Divisions are responsible for initially registering transfer - R.11(3); OJ2007-SE3-F.2, which is normally routine task. No conflict would be detected based upon transfer request from proprietor~~
- ~~Opponent disputed transfer, so EPO must take decision. As decision will be adverse for one of parties, Legal Division is responsible - R.11(3); OJ2007-SE3-G.1~~
- If decision appealed, Legal BoA will consider appeal - A.21(2)

**Comment**

- o *Appealing may not be very useful in view of T553/90 stating that for a transfer in opposition proceeding, entitlement may not be questioned.*

**B4 – Languages; Translations of applications****B4-06****(7 points)**

A Greek applicant living in the Netherlands, files a European patent application in Greek and at the same time files a translation in German. His European patent attorney feels more at ease with English.

- (a) Is the patent attorney allowed to communicate in English with the EPO?
- (b) Is the patent attorney allowed to file amended claims in English in response to a communication pursuant Art.94(3) EPC?

Oral proceedings are arranged by the Examining Division.

- (c) Is the patent attorney allowed to use English at the oral proceedings?  
If so, under which conditions?
- (d) Is the patent attorney allowed to use Dutch at the oral proceedings?  
If so, under which conditions?
- (e) Is the Examining Division allowed to use English at the oral proceedings?  
If so, under which conditions?
- (f) Is the Examining Division allowed to use Dutch at the oral proceedings?  
If so, under which conditions?
- (g) Is the Examining Division allowed to use English in the written proceedings?

**Answer****EPC**

German is language of proceedings – A.14(3)

- (a) Yes
  - o Patent attorney may use English because it is En, Fr or Ge - A.14(1), R.3(1)
  - o No translation into German is required
- (b) No
  - o Amendments must be filed in German as language of proceedings - R.3(2)
  - o But amendments - A.94(3), R.71(1) are documents to be filed in time limit
  - o So amendments may be initially filed in Greek (nationality) or Dutch (residency) by this applicant – A.14(4), followed by German translation – R.6(2)
  - o so it is not allowed to file in English
- (c) Yes
  - o Conditions: either give notice to EPO at least 1m before date, or arrange for interpretation into Germ- R.4(1)
- (d) Yes
  - o Applicant (or patent attorney) must provide for interpretation into Germ- R.4(1), 2nd sentence
  - o Alternatively, if applicant and Examining Division agree, any language (including Dutch) may be used without interpreting or prior notice - R.4(4); GL E-V, 2
- (e) Yes
  - o EPO employees may use En, Fr or Ge other than language of proceedings - R.4(2)
  - o EPO will provide (at its own expense) interpretation into German, or, where appropriate, into English or French - R.4(5)
- (f) Yes
  - o Examining Division is allowed to use Dutch if applicant agrees - R.4(2), (4); GL E-V, 5
- (g) No
  - o There is case law to support this if all parties agree - J18/90; GL E-V, 6
  - o More recently, case law has indicated that Exam. Div. will not do it - J8/07, G4/08
  - o So they will so only use German

**Comment**

~~(e) GL A-IV, 1.3.3: A divisional application must be filed in the language of the proceedings of the parent application. Even if the parent application was filed in a language other than an official language of EPO - A.14(2) EPC, the applicant may not avail himself of this possibility when filing a divisional application based on that parent application. The application is not accorded the date of filing of the parent application if these requirements are not met.~~

~~(he) GL E-V, 5: The employees of EPO should not depart from the language of the proceedings without good reason, and unless the parties involved are competent in the language used and express no objection, EPO should provide for interpretation into the language of the proceedings at its own expense.~~

**B4-09****(EQE – 3 points)**

A Korean applicant files two European patent applications, EP1, which claims the priority of Korean application KR1, and EP2, which claims the priority of Korean application KR2. EP1 is filed in Korean and is identical to KR1. Six weeks later an English translation is supplied to the EPO by a European patent attorney. EP2 is filed in English. It is a translation of KR2. During the examination procedure before the Examining Division, the English texts of EP1 and EP2 are found to contain translation errors.

Would it be possible to correct these errors?

**Answer**

EPC

EP1 (filed in Korean, translation into English):

- ~~○ Applications may be filed in any language, including Korean - A.14(2), 1st sentence – followed by translation - R.6(1)~~
- English translation may be brought into conformity with Korean application as filed at any time during EPO proceedings – A.14(2), last sentence; A.70(2)

EP2 (filed directly in English):

- application as filed is in English – so there is no basis to allow correction of translation errors
- R.139 (correction of obvious errors) may be used, but
  - skilled person must be able to derive correction directly and unambiguously from documents filed – G3/89
  - content of English text application as filed may not be extended – A.123(2), G11/91
- ~~○ KR2 may not be used as basis for correction – T260/85~~

**Comment**

- *Based on Question 1 of Paper DI of EQE 2001 [3 points].*
- EP1 => Applications may be filed in any language, including Korean - A.14(2), 1st sentence – followed by a translation into En, Fr or Ge - R.6(1)
- EP2 => KR2 may not be used as basis for correction - T260/85
- *GL A-VIII, 5.2: An erroneous translation from the original language of filing may be brought into conformity with the original language at any time during proceedings before EPO, i.e. during pre-grant proceedings and also during opposition proceedings.*
- *GL C-VI, 5.4: Linguistic errors, errors of transcription and other mistakes in any document filed with the Office may be corrected at any time. However, where the mistake is in the description, claims or drawings, the correction must be obvious in the sense that it is immediately evident (at least once attention is directed to the matter): (i) that an error has occurred; and (ii) what the correction should be.*

**B5 – Representation before the EPO****B5-03****(5 points)**

A European patent attorney is summoned to oral proceedings before a Board of Appeal. On the day of the oral proceedings, he surprises the Board with his large team. He explains that the case is so complex that different aspects of the case must be presented by different members of the team.

For each person in the team, explain whether they are entitled to speak:

- (a) The European patent attorney himself
- (b) A younger colleague who intends to sit the European qualifying examination the following year
- (c) The owner of Dutch company D, who is the applicant
- (d) A Dutch national patent attorney, who wrote the Dutch priority application
- (e) The inventor Mr X, who is employed by company D

**Answer**

## EPC

- (a) Assuming patent attorney is duly appointed, he may speak on behalf of applicant – A.134
  - o EPO usually checks whether patent attorney is authorised – R.152; GL E-III, 5
  - o He is responsible for presentation to EPO of all submissions made by the party. This is essential core of function of a professional representative under Art. 133. During oral proceedings, he is expected to present entire case – G4/95
- (b) Probably not, A.134
  - o right of younger colleague to present case is at discretion of EPO
  - o requirements for allowance of submissions of non-qualified persons are rather strict and listed in G4/95 - GL E-III, 8.5; G2/94
  - o Permission should have been requested in sufficient time before oral proceedings – BoA was surprised so this was not done, so unlikely to be allowed
- (c) Applicant is party, so always has the right to speak – GL E-III, 8.5 or T621/98
- (d) No
  - o NL is an EPC state, so a national legal practitioner may represent - A.134(8)
  - o but a national patent attorney cannot be regarded as “legal practitioner” - J19/89
- (e) Yes, if inventor/employee is authorised to act for applicant - A.133(3), R.152(1)
  - o No, if inventor/employee is not authorised: applicant / patent attorney must keep control - G2/94 and G4/95 mutatis mutandis; GL E-III, 8.5

**Comment**

- (b) *GL E-III, 8.5: Submissions by a person who is not qualified under A.133 and A.134 to represent parties to proceedings before EPO may be admitted at oral proceedings when this person accompanies a professional representative representing that party. Such submissions, however, cannot be made as a matter of right, but only with the permission and at the discretion of the Examining or Opposition Division. In opposition proceedings the Division should consider in exercising its discretion whether - see G4/95:*
  - o *the party on behalf of which the person is to speak has filed a request to this effect;*
  - o *the party making the request has indicated the name of the person, the subject-matter of the submission and the person’s qualification to speak on this matter;*
  - o *the request has been filed sufficiently in advance of the oral proceedings;*
  - o *in the case of a late filed request, either there are exceptional circumstances justifying the admission of the submission or all the other parties agree to the making of the submission; and*
  - o *the submissions are made under the continuing responsibility and control of the professional representative.*
- (e) *GL E-III, 8.5: If a party is represented by an authorised employee rather than a professional representative, the same considerations apply in respect of a person accompanying the authorised employee.*

**C – PATENTABILITY****C1 – Patentable and non-patentable inventions; Industrial application****C1-03****(EQE – 3 points)**

Mr. Fujimoto has devised a spinnaker (a particular sail for sailboats), whose structure and shape have new aesthetic features in addition to new and advantageous technical features. His spinnaker is covered by a Japanese utility model application filed 3 months ago. The Japanese application describes and shows both the technical and the aesthetic features. Mr. Fujimoto wishes to protect both the technical and the aesthetic features of his new spinnaker in EPC Contracting States, claiming the priority of his domestic utility model application under the Paris Convention.

State briefly the options open to him and the periods involved.

**Answer**

## EPC

Technical features:

- o File EP or PCT application within 12m from JP filing date - A.87(1)
- o Priority may be claimed from utility model - A.87(1)

- Or may file national applications or utility model applications (where utility models exist) - A.4A(1) PC, within 12m from JP filing date - A.4C(1) and 4E(2) PC

#### Aesthetic features:

- Patent for aesthetic creations without technical effect will be rejected as lacking inventive step - A.52(2)(b), A.56, T641/00; G3/08
- But may register designs or file design applications in countries which have these IP forms, and claim priority - A.4E PC, within 6m from JP filing date - A.4C(12), A.4E(1) PC

#### **Comment**

*Based on Question 8 of Paper DI of EQE 1991 - 4 points (adapted).*

#### **C1-05**

**(2 points)**

In the course of lengthy experiments it is found that a particular known chemical compound (thenoyl peroxide), which had not previously been used in the pharmaceutical field, is suitable for treating acne and also generally for the care and cleansing of the skin.

What claims should be used in the application?

#### **Answer**

EPC

A.53(c):

- Thenoyl peroxide for use as medicament - A.54(4)
- Thenoyl peroxide for treatment of acne - A.54(5)
- ~~Swiss-style claim of G5/83 may be permitted here because this is first therapeutic use of compound - G2/08: Use of thenoyl peroxide for manufacture of medicament for treatment of acne~~
- Cosmetic treatment: Use of thenoyl peroxide for cosmetic cleansing of skin - T36/83

#### **Comment**

- *Under EPC2000, the further medical indication - A.54(5) - is in principle patentable even if thenoyl peroxide had already been used in the pharmaceutical field.*
- *If the composition is new with respect to the amount of thenoyl peroxide, the composition itself can also be claimed.*
- *Swiss-style claims – G5/83 – are no longer accepted at EPO for second and further medical indications – G2/08 hn 3*

## **C4 – Exceptions to patentability; Medical uses**

#### **C4-02**

**(2 points)**

In the vicinity of the Alps many people suffer ill effects from the föhn (type of dry down slope wind occurring in the lee of a mountain range). Inventor X, after lengthy experiments, comes to the conclusion that the inhalation of an aqueous solution of salt and sugar causes the consequences of the föhn suddenly to disappear, if inhalation for ten minutes is repeated at least five times ~~after at five minutes' intervals~~ interruption.

Can patent protection be obtained in a European patent? And if so, for what?

#### **Answer**

EPC

Patent protection cannot be obtained for method; term "therapy" is given broad interpretation - A.53(c); T81/84 or; GL C-IV, 4.8

First and second medical indications of aqueous solution are patentable ~~~GL C-IV, 4.8:~~

- "aqueous solution of sugar and salt for use as medicament" - A.54(4); ~~T128/82~~
- "aqueous solution of sugar and salt for treatment of föhn disease" - A.54(5)
- ~~"Swiss-style claim" of G5/83 may be permitted here because it is first medical use of solution - G2/08~~  
~~—"Use of aqueous solution of sugar and salt for manufacture of medicament for treatment of föhn disease"~~

A dependent claim including the dosage regime is recommended as a fall-back position:

- "aqueous solution of sugar and salt for treatment of föhn disease by inhalation for ten minutes, repeated at least five times at five minutes intervals" – G3/08

#### **Comment**

- ~~In practice it is well-known that~~, an aqueous solution of sugar and salt is *often* used to mitigate the effects of diarrhoea for children and for travellers. ~~So it is reasonable to state that in that case, the first medical use would be patentable because it is already known as a medicament anymore.~~
- In T81/84 the question arose whether or not the character of menstrual discomfort manifesting itself for instance in intense headaches and other painful symptoms was such that its treatment should fall under the category of therapeutic treatment. The Board found that the concept of therapy should not be confined narrowly.
- See also T128/82
- Since G2/08, Swiss-style claim is no longer accepted by EPO

**C4-06****(1.5 points)**

It is discovered that a chemical compound X, well known as a dye, relieves the pain of asthma.

What claims are in principle acceptable in a European patent application?

**Answer**

EPC

following claims are possible:

- "Compound X for use as medicament" - A.54(4)
- "Compound X for relieve of pain of asthma" - A.54(5)
- ~~"Use of X for manufacture of medicament for relieve of pain of asthma" - Swiss claim - G5/83 - may also be used because it is a first medical use of X - G2/08~~

**Comment**

- *T128/82: Where a known compound is for the first time proposed and claimed for use in therapy, the fact that a specific use is disclosed in the specification does not in itself call for a restriction of the purpose-limited product claim to that use.*
- *If it is later discovered that X is known for a therapeutic use, then if the application has a priority date after the publication of G2/08 in the OJ EPO - not known yet in June 2010, the Swiss claim will no longer be accepted by EPO as a fall-back position - G2/08*
- *Also see GL C-IV, 4.8.*

**C7 – Priority under Paris Convention, EPC and US/JP national law****C7-01****(3 points)**

A French patent application FR-A for invention X was hastily filed as a first application on 7 January 2011. The invention X having evolved, the applicant wished to replace application FR-A by a more satisfactorily compiled French patent application FR-B without further embodiments, filed on 4 September 2011. After receiving the French search report on 17 October 2011, application FR-A was withdrawn.

From which patent application(s) would you advise to claim priority for a subsequent patent application? Until what date?

**Answer**

- ~~FR-A~~ was earliest application for X
- ~~FR-B~~ cannot be considered as first application for X - A.4C(4) PC, because at time of filing ~~application~~ FR-B, ~~application~~ FR-A had not been withdrawn for subject-matter also contained in ~~application~~ FR-A
- So ~~FR-A~~ remains first application for X, and should be basis for priority claim - A.4A(1) PC
- subsequent application can invoke priority at latest on:  
7/1/11 + 12m [A.4C(1); A.4C(2) PC] → 7/1/12 (Sat)  
[A.4C(3) PC] → 7/1/12 (Mon)
- But it is advised to claim priority from both ~~French applications~~ FR-A and FR-B, because ~~application~~ FR-B is "more satisfactorily compiled". This keeps all options open
- Claiming multiple priorities is allowed - A.4F PC

**Comment**

- *The question is general – there is no reference to European or international patent applications. Therefore, the Paris Convention should be used.*

- Referring in your answer to the priority provisions of the instead of the Paris Convention would lead to a significant loss of points at the EQE (no points for legal basis).

**D-03****(EQE – 5 points)**

By a final decision of a national court dated 15 May 2008~~2011~~, it was adjudged that your client is entitled to the grant of a European patent on the basis of a European patent application EP-A filed by a third party. Your client intends to file a new European patent application in respect of the invention of application EP-A.

- (a) If application EP-A is pending:
  - (i) Would your client be allowed to include some further embodiments of his invention in this new European patent application?
  - (ii) Would your client have to pay renewal fees in respect of the year in which the new European patent application is filed and any preceding year?
- (b) Would your client still be entitled to file a new European patent application if application EP-A is no longer pending?

**Answer****EPC**

(a-i) No

- ~~When filing new application - A.61(1)(b), R.17, provisions of A.76(1) apply - A.61(2)~~
- ~~So subject-matter of new application - A.61(1)(b) - must not extend beyond content of original (parent) application as filed - A.76(1); A.61(2)~~
- ~~test for extension - A.76(1) corresponds to standard test - A.123(2) - G1/05 r.5.1~~
- ~~So, client cannot include further embodiments. - A.123(2); GL C VI, 9.2.1~~

(a-ii) No

- ~~No Renewal fees need not be paid for year in which new application is filed and any preceding year - R.51(6); GL A-IV, 2.7~~
- So, applicant would not have to pay

(b) Yes

- ~~G3/92: if original application no longer pending, A.61(1)(b) is nevertheless applicable - GL A-IV, 2.1 or C-VI, 9.2.2~~
- So, client is entitled to file new application, no later than - R.16(1)(a):  
15/5/08-11 + 3m [R.131(4)] → 15/8/08-11 (Assumption day)  
[R.134(1)] → 16/8/08-11 (MonTue)

**Comment**

- Based on Question 8 of Paper DI of EQE 2003 - 5 points.
- (a) If embodiments were included, it should be possible to delete them during examination – G1/05
- (a) See G1/05 r.5.1 for standard test
- (a) See also GL C VI, 9.2.1 and GL A-IV, 2.7
- (b) See also GL A-IV, 2.1 or C VI, 9.2.2

**E – Rights conferred by a Patent and by an Application****E-05****(EQE – 6 points)**

One of your clients phones you today, 5 March 2012. She tells you that she filed an EP application and that a competitor has been using her invention in some of the EPC Contracting States since February 2012. The application was filed in French in February 2011, without claiming any priority rights; all fees have been duly paid.

She asks you to defend her rights. How would you proceed?

**Answer****EPC**

- First, check patent situation of client and competitors, search report, prior art. Look at strength of patents and look for conflicting applications
- Check also whether competitors product infringes or not
- Provisional protection for application may be create on publication - A.67(1) Its extent is determined by claims as published - A.69(2), 1<sup>st</sup> sentence

- Contracting states, under their national law - A.67(2) - may allow infringer to be sued based upon provisional protection of published application
- As extent of provisional protection may be retroactively amended on or after grant - A.69(2), last sentence, national judges will normally not pursue case solely on provisional protection, preferring to at least wait for grant
- ~~But in most contracting states, v~~Validly establishing provisional protection establishes liability for reasonable compensation or even damages - A.67(2), last sentence and Nat. Law, Tab. III.A, col. 1, 2 and 4.
- So, it may be wise to:
  - File amended claims which capture infringer prior to publication - A.69(2), 1st sentence
  - Request early publication, as application is only due to be published in August 2008 - A.93(1)(b)
  - Validly establish provisional protection by complying with national requirements, such as filing translation of claims - A.67(3) and Nat. Law, Tab. III.A col. 3 and 4 and Nat. Law, Tab. III.B
  - Consider official notification of infringer: National laws may enable infringer to argue good-faith (or right of continued use) if infringement started before publication of application
  - For states with French as official language, such translation is not required - A.67(2)
- faster grant, quicker protection - A.64 is obtained:
  - Request for accelerated procedure should be filed under PACE - OJ2010, 352
  - Requesting examination - A.94(1), R.70(1), and waiving notification - R.70(2) will also speed up examination. In fact, WO will be omitted in favour of first office action, or even R.71(3) communication - R.62(1), GL C-VI, 1.1.2
  - Consider amending claims after receiving ESR - R.137(2)
  - faster grant can be realised by narrowing claims as much as possible to exclude prior art, but ensuring that infringing product still falls under claims - A.69
  - If required, divisional may be filed - A.76, R.36 - to pursue any broader claims - GL C-VI, 9.1.6 But application must still be pending and at least one of 24m time limits of R.36 must not have expired
- Consider negotiating with infringer for license
- After publication of application, pay designation and extension fees for all States relevant to exploitation of invention
- After grant, validate patent in desired States - A.65

### Comment

- *Based on Question 8 of Paper DI of EQE 2001 - 4 points (adapted).*
- *However, these considerations are frequently in the DII paper.*
- *Examiners' report: No major mistakes were made in answering this question. Maybe the greatest mistake was the failure to realise that national law determines whether the infringer could be sued at once or only after the grant of the patent.*
- *Note that the conditions for provisional protection are unaffected by the London Agreement.*

## EPC: PROCEDURAL LAW

### H – PROCEDURE

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

H3-08

(7 points)

A Dutch applicant files a European patent application at the EPO and wishes to proceed with the application in English. What should be done in the following cases:

- The application includes a description in English and claims in Dutch.
- The application includes a description in English; no claims are included. The applicant supplies claims in Dutch one month later.
- The application is filed with reference to an earlier Dutch national application filed in Dutch. The applicant includes at filing claims in English.
- The application includes a description and claims in English; however the drawings include some Dutch text.

#### Answer

##### EPC

- does not prescribe how EPO should respond to such filing
  - filing date will be awarded as requirements of A.80, R.40 is satisfied by presence of description
  - GL A-VIII, 4.1 indicate that documents making up application may be filed in any language. But GL do not discuss what will happen if these documents are in different languages: they only indicate that requirements are satisfied if all are in “same language”
  - As applications may be filed in any language - A.14(2) - and language is not defined, EPO may not even be able to detect whether documents making up application contain more than one actual language. It is so unlikely that EPO will consider use of more than one language deficiency
  - But EPO cannot proceed with application until language of proceedings is determined - A.14(3)
  - It is so likely that EPO will simply require translation from applicant because application is not filed in one of official languages (En, Fr or Ge) - A.14(1) and (2)
  - translation of application must be filed at EPO within 2m of date of filing - R.6(1) If applicant has not filed translation, EPO will invite him to rectify this deficiency - R.58 within period of 2m
  - language of this translation will determine language of proceedings - A.14(3)
  - It would be simplest to just translate claims into English and send them to EPO
- Later-filed claims:
  - presence of at least one claim is requirement for application - A.78(1)(c), but set of claims can be provided after date of filing
  - Where application documents as originally filed did not include at least one claim, applicant may also file claims of his own motion after date of filing, but before EPO invites him to do so - R.58. In this case, no communication - R.58 will then be issued - GL A-III, 15
  - claims should still be translated into English in period described above
- Filing by reference:
  - description should be translated into English within 2m of date of filing - R.40(3)
  - If applicant has not filed translation, EPO will invite him to rectify this deficiency - R.58 within period of 2m. If translation is not available to EPO - R.40(3) juncto R.53(2), certified copy of previous application must also be supplied within 2m of filing date - R.40(3)
- text in drawings should be translated into English within period described above

#### Comment

- GL A-VIII, 4.1: *All the documents making up a European application can be filed in any language - i.e. those listed in A-II, 4.1, plus the claims if present on the date of filing and any text of the drawings present on the date of filing. Consequently, it is not possible to file these documents in the wrong language, provided that they are all in the same language and are furnished on the date of filing.*
- A.14(3): *The language (chosen from En, Fr or Ge) in which the application is filed, or into which it is subsequently translated, constitutes “the language of the proceedings”.*
- Where claims were not filed together with the European patent application but are provided after ad date of filing has been accorded (so-called “late-filed claims”), they are regarded as amendments en have to be filed in the language of the proceedings - R.3(2), i.e. where the applications was not filed in of the official EPO languages, in the official language into which the European patent application has been translated. It*

*follows from the preceding consideration that if claims are provided before the translation of the description has been filed - R.6(1), they have to be in the official EPO language into which the applicant intends to translate the application.*

- *There are two situations in which a translation of the European application will be required:*
  - (i) the European application was (at least partly) filed according to A.14(2) in a language which is not an official language of EPO;*
  - (ii) the European application was filed by reference to a previously filed application, which is (at least partly) not in an official language of EPO - R.40(3).*
- *In either case, a translation of the application must be filed at EPO within 2 months of the date of filing according to R.6(1) - for type (i) - or R.40(3) - for type (ii).*
- *If the applicant has not filed the translation, EPO will invite him to rectify this deficiency under R.58 within a period of 2 months.*

**H3-16****(3 points)**

An applicant receives a R.71(3) communication as the first communication from the Examining Division. The mention of the grant of a European patent is published in the European Patent Bulletin on 15 May. Almost two months later on 11 July the applicant files a divisional application together with a request for re-establishment of rights of the right to file a divisional application by restoring the pending status of the parent.

Discuss the legal situation.

**Answer****EPC**

- RE request is admissible only if applicant was unable to observe time limit vis-à-vis EPO - A.122(1), R.136(1)
- divisional may only be filed - A.76, R.36 - if parent is still pending, and at least one of 24m periods of R.36(1) has not yet expired. As first communication from Examining Division was R.71(3) – no more than few months prior to grant - then divisional filing in July is within 24m of R.36(1)(a)
- application is pending up to (but not including) date that Bulletin mentions grant of patent - A.67(4) and G1/09
- R.36(1) does not impose any time limit for filing divisional but rather sets condition namely that earlier application is pending - J24/03
- So, no time limit - A.122 is imposed by R.36
- For this reason, RE request is not admissible

**Comment**

- *GL A-IV, 1.1.1: re-establishment of rights - A.122 and R.136 is excluded as regards the filing of a divisional application - J10/01.*
- *In addition to being pending, at least one of the 24 month time limits of R.36(1)EPC must not have expired.*
- *By analogy with other proceedings (opposition & appeal), the RE fee will not be refunded.*

**H3-19****(6 points)**

In October 2007 an applicant has filed a European patent application EP1 as a first filing claiming subject-matter A and independently subject-matter B. Following an objection of non-unity between subject-matters A and B, the applicant paid a further search fee for the claims relating to subject-matter B.

In the European Search Report, two documents are cited in the Search Report as prior art. D1 is a European patent application filed in November 2006, published in May 2008 and validly designates DE and GB. D2 is a European patent application filed in February 2007, published in August 2008 and designates GB and FR. D1 discloses subject-matter A; D2 discloses subject-matter B.

After publication of EP1 the designation fees for all Contracting States are validly paid.

During substantive examination, the applicant receives a communication maintaining the non-unity objection. In response, he decides to immediately file a divisional application EP2 for subject-matter B.

- (a) For what subject-matter can the applicant obtain a European patent? And, if so, in what countries?
- (b) Would your answer have been different if applicant A would have filed a divisional for subject-matter A instead of for subject-matter B?

**Answer****EPC**

<b>D1</b>	<b>D2</b>	<b>EP1</b>	<b>EP2</b>
A	B	A B	(divisional of EP1) B
DE, GB	GB, FR	all States	all States

Nov-06

Feb-07

Oct-07

- divisional may only be filed - A.76, R.36 - if parent is still pending, and at least one of 24m periods of R.36(1) has not yet expired. As communication from Examining Division maintaining non-unity objection has just been sent, divisional filing will easily be possible within 24m of R.36(1)(b)
- For applications filed before 1 April 2009, there was a system of charging designation fees for individual designated states - OJ2009, 118; GL A-III, 11.32

~~○ In GL A-11.3, reference is made to old version of relevant provisions, which remain applicable to applications filed and Euro-PCT applications entering European phase before 1 April 2009 - A. 7(1) Revision Act, Transitional Provisions - Decision AC 28/06/01, A.1 & and OJ2008, 513, A.2~~

(a) Parent application – Subject-matter A:

- Application D1 was filed before and published after filing date of EP1
- So D1 is prior right - A.54(3) - with respect to EP1
- Because EP1 has been filed before entry into force of EPC2000, prior right effect of D1 with respect to EP1 is - EPC1973 - GL C-III, 8.1
- So D1 destroys novelty of subject-matter in EP1 in commonly designated States, i.e. in DE and GB
- So patent can be granted for subject-matter in EP1 in all Contracting States except in DE and GB

Divisional – Subject-matter B:

- divisional EP2 is deemed filed on filing date of earlier application - A.76(1)
- D2 is prior right - A.54(3) - with respect to EP2
- Because divisional EP2 has been filed “during substantive examination”, it must actually have been “received by EPO” after entry into force of EPC2000
- So prior right effect of D2 with respect to divisional EP2 is - EPC2000 - A. 7(1) Revision Act, A.1(1) Transitional Provisions and OJ2007, 504
- So D2 destroys novelty of subject-matter B in EP2 in all States
- So no patent can be granted for subject-matter B in EP2

(b) Yes

- patent can be granted for subject-matter B in parent application EP1 in all Contracting States except in GB and FR
- No patent can be granted for subject-matter in divisional EP2

**Comment**

~~○ In GL A-III, 11.3, reference is made to old version of relevant provisions, which remain applicable to applications filed and Euro-PCT applications entering European phase before 1 April 2009 - A. 7(1) Revision Act, Transitional Provisions - Decision AC 28/06/01, A.1 & and OJ2008, 513, A.2~~

- (a) *GL C-III, 8.1: If EPO notes that in respect of one or more of the designated Contracting States the content of an earlier European patent application forms part of the state of the art pursuant to A.54(3), two situations could arise:*
- *the filing date of the application or patent under examination is before the date of entry into force of EPC2000. A.54(4)1973 is still transitionally applicable. Here, if conflicting prior art gives rise to different texts of the claims, different sets of claims for the Contracting States concerned may be filed. Different descriptions and drawings will only be required if it is not possible to set out clearly in a common description which subject-matter is to be protected in the different Contracting States, having regard to the appropriate prior art.*
  - *the filing date of the application or patent under examination is on or after the date of entry into force of EPC2000. As A.54(4)1973 has been deleted, the conflicting prior art belongs to the state of the art for all Contracting States, irrespective of the effected designations.*
- (b) *OJ2007, 504:*
- *Note that for a divisional application received at EPO on or after the date of entry into force of EPC2000, the provisions of EPC2000 apply, regardless of whether the parent application was filed under the 1973 or EPC2000.*
  - *Note in this context, that for European divisional applications the relevant date for A.54(4) and R.23a1973 to apply or not, is the date of receipt of the divisional application at EPO and not the attributed filing date of the parent application. This means that under EPC2000, parent and divisional applications may be treated differently as regards the application of A.54(3).*

**H3-22**

**(7 points)**

Today is 1 January 2011. Applicant X filed a European patent application EP1 in 2008. The search report with the written opinion was dispatched on 20 September 2008. No further communication from the EPO has been received for EP-1. EP-1 is still pending.

On 27 October 2008, the applicant validly filed divisional applications DIV-1 and DIV-2, requesting accelerated proceedings for DIV-1. DIV-1 and DIV-2 are were filed initially with the same description and claims as EP1. The first Article 94(3) communication for DIV-1 is dated 10 February 2009. The first Article 94(3) communication for DIV-2 is dated 23 February 2009.

No non-unity objections have been raised for EP-1, DIV-1 & DIV-2.

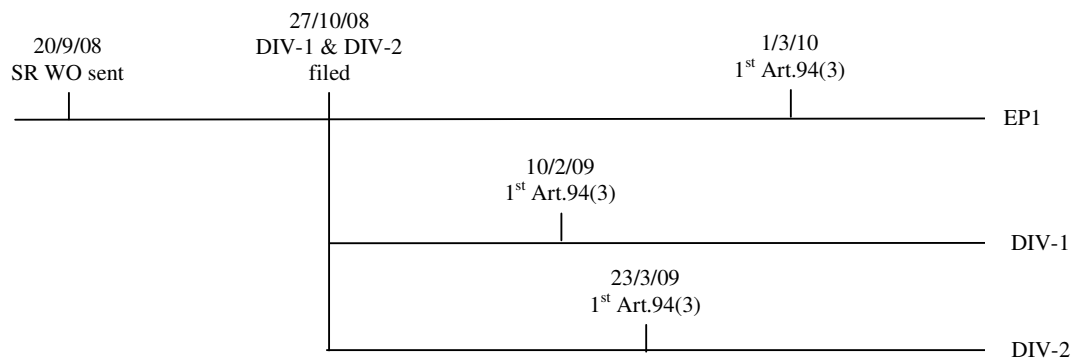
- (a) What is the last date to be able to file a divisional of DIV-1? What is the last date to file a divisional of DIV-2?
- (b) Would your answer to a) be different if an Article 94(3) communication was had eventually been issued for EP-1 on 1 March 2010
- (c) Would your answer to a) be different if the Examining Division had indicated non-unity during oral proceedings for DIV-2 on 3 May 2010. This objection was confirmed in the minutes of the oral proceedings, dated 3 June 2010. This is the only non-unity objection raised for EP-1, DIV-1 & DIV-2.

### Answer

#### EPC

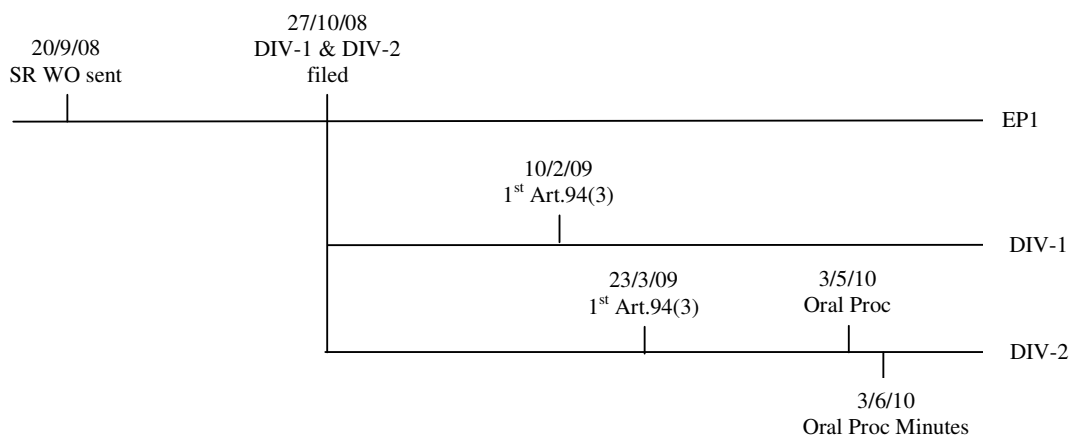
- (a)
  - o For valid divisional: EP1 immediate parent must be pending - Art.76, R.36(1), and period of R.36(1) must still be unexpired
  - o EP-1 and DIV-1 form first divisional family, and EP-1 and DIV-2 form second family.
  - o For first family, DIV-1 is earliest application that has received communication from Examining Division
  - o So period to file voluntary divisional expires:
    - 10/2/09 + 10d [R.126(2)] => 20/2/09
    - +24m [R.36(1)(a); R.131(4)] => 20/2/11 (Sun)
    - [R.134(1)] => 21/2/11 (Mon)
  - o As there are no non-unity objections, period of R.36(1)(b) is not available
  - o So last date to file divisional of DIV-1 is 21/2/11
  - o For second family, DIV-2 is earliest application that has received communication from Examining Division
  - o So period to file voluntary divisional expires:
    - 23/2/09 + 10d [R.126(2)] => 5/3/09
    - +24m [R.36(1)(a); R.131(4)] => 5/3/11 (Sat)
    - [R.134(1)] => 7/3/11 (Mon)
  - o As there are no non-unity objections, period of R.36(1)(b) is not available
  - o So last date to file divisional of DIV-2 is 7/3/11.
  - o There has not yet been communication from Examining Division for EP-1. As it is still pending, divisional of EP-1 may still be filed – GL A-IV, 1.1.1.4

(b)



- o Yes, difference is that for both families, EP-1 becomes earliest application for which communication form Examining Division is issued. Therefore last date to file divisional of EP-1, DIV-1 or DIV-2 is:  
 $1/3/10 + 10d$  [R.126(2) - => 11/3/10  
 $+24m$  [R.36(1)(a); R.131(4)] => 11/3/12 (Sun)  
[R.134(1)] => 12/3/12 (Mon)

(c)



- o only difference is that R.36(1)(b) period becomes available for DIV-2. It expires on:  
 $3/5/10 + 24m$  [R.36(1)(b); R.131(4)] => 3/5/12 (Thu)
- o So last date to file divisional of DIV-2 becomes 3/5/12

**Comment**

- o Based on Q.3 DI 2003 - 4 points - adapted
- o The Search report with written opinion does not trigger the R.36(1) periods – OJ 2010, 406
- o The new divisional is to be filed  $\geq 1$  April 2010, so the 24m R.36(1) time limits are applicable - OJ 2009, 296 & 481

(c) The time limit runs from the actual notification, which was during oral proceedings. The minutes and the 10 days of R.126(2) are irrelevant – GL A-IV, 1.1.1.3 (iii)

**H4 – Search, search opinion and search report****H4-03****(7 points)**

An application is filed disclosing and claiming an improved water pump P, and an improved pipe connector C. P may be used with all types of connectors, and C may be used with all types of pumps, so the applicant files only two independent claims, one for P and one for C.

The Search Division informed the applicant in accordance with R.64(1) EPC that the European patent application contained two inventions, P and C, and invited him to pay an additional search fee. This he did not

pay, and subsequently he received the search report confirming the non-unity, and the fact that only the claim to P was searched.

The claim was considered novel, but there were some strong objections with regard to inventive step. He prepares a single page, titled amended claims, with the independent claim to P and a new independent claim based on a feature found in one of the drawings.

He asks you as his European patent attorney to file it because he has already approached pump manufacturers in Europe, and request examination. A grant of the claim to P is the most important right now, but the scope of the claim to P should not be limited. Anticipating a period of about three years to grant, he proposes that claim to C be re-introduced immediately before the grant to then ensure protection of invention C.

What objections are to be expected if you file the amended claim sheet only? What do you have to do to ensure that the client gets what he wants?

### Answer

#### EPC

#### Legal situation:

- objection of Search Division is based on A. 82, R.44 which restricts application in general to one invention
- Here two claims are included, directed to different products having no technical relationship because they can be used independently of each other
- So, Search Division seems correct in its assessment of unity. protest asking Examining Division to reconsider issue is unlikely to succeed - R.64(2)
- As WO is not positive, reply is required to WO - R.70a(1), otherwise application will be deemed withdrawn - R.70a(3)
- This reply must be filed within same period as requesting examination - R.70a(1), last sentence, R.70(1), and within same period for paying designation fee - R.39(1)
- Forgetting these fees leads to application being deemed withdrawn - A.94(2), R.39(2) respectively
- Deleting claim to C would address non-unity objection, but not inventive step - A.56 - objection to claim to P
- If I was to file amended claims only, then application may be deemed withdrawn - R.70a(3), even though I requested examination and paid fee - A.94(1), R.70
- Another possibility is that Examining Division would object - R.137(4) that basis for dependent claim has not been indicated. This can ultimately lead to application being refused - R.137(3) - GL C-VI, 4.7 - if we do not indicate it all
- mere presence in schematic drawing is enough to satisfy R.137(4) - GL C-VI, 5.7, but subsequent objection of extension of subject matter - A.123(2) - is also possible
- It will not be possible to reintroduce claim to C during examination because it has not been searched - R.137(5) divisional must then be filed - A.76, R.36; G2/92

#### Advice to improve:

- I will prepare arguments defending inventive step - A.56 - of claim to P, and include this with amended claim sheet as R.70a(1) response
- I will request examination and pay fee - A.94(1), R.70
- I will also pay designation fee - A.79, R.39 - as deadline to pay expires 6m after publication of Search Report - R.39(1)
- To avoid objection - R.137(4), I will indicate basis for dependent claim in drawings. To avoid subsequent objection of extension of subject matter - A.123(2) - I will check that subject matter of dependent claim is directly and unambiguously derivable for skilled person from application as filed - G1/93
- To file divisional for C, parent application must still be pending (i.e. not granted), and at least one of 24m periods of R.36(1) must not have expired

- When we start examination, we will receive A. 94, R.71(1) communication (Office Action). As we have amended and replied to search opinion, this may take several months to be sent.
- R.137(5) communication does not trigger 24m of R.36(1)(b) for non-unity objection - GL C-VI, 5.2(ii)
- We then have possibly no more than 24m after notification of first Office Action to file divisional, assuming parent is not granted within that time. This period should be monitored and prior to its expiry, divisional should be filed

### Comment

*This question contains DII considerations, where a client needs to be advised about the actions which are in his best interests. These are not always the same as the actions he has asked you to take.*

## H5 – Publication of the patent application

### H5-03

(2.5 points)

A European patent application has been filed on ~~15-13~~ January ~~2008-2012~~ as a first filing. On 16 February ~~2008-2012~~ the applicant files a request for early publication of his application. One month later the applicant files a request to add a priority claim from ~~10-17~~ May ~~2007-2011~~. Subsequently, the EPO informs him that the application will be published on Wednesday ~~16-18~~ April ~~2008-2012~~.

Legal situation?

### Answer

#### EPC

- applicant can request early publication of his application – A.93(1)(b)
- In principle, declaration of priority (including addition of priority claim to existing declaration of priority) can be made - R.52(2) - at latest on:
  - 17/5/11 + 16m [R.131(4)] → 17/9/12 (Mon)
  - 10/5/07 + 16m [R.131(4)] → 10/9/08 (Wed)
- so request in early March 2012 was in time
- But declaration of priority may not be made or corrected after 16/2/12 when request for early publication of application – A.93(1)(b) - ~~has been~~ was filed - R.52(4)
- ~~Because early publication has been requested, it is too late to add missing priority claim~~
- ~~So application will be published without priority claim~~
- applicant can file new application claiming priority of earlier application, ~~which can be done~~ at latest on:
  - 17/5/11 + 12m [A.87(1); R.131(4)] → 17/5/12 (Ascension Day)
  - [R.134(1)] → 18/5/12 (Tue)
  - 10/5/07 + 12m [A.87(1); R.131(4)] → 10/5/08 (Sat)
  - [R.134(1)] → 13/5/08 (Tue)
- As priority claim is validly made, effective date of new application becomes 10/5/07 – A.89, and so thus publication of previously filed EP application is too late to be ~~considered as~~ prior art against new application

### Comment

- *GL A-III, 6.5.1: The declaration of priority should preferably be made on filing, but can be made up to 16 months from the earliest priority date claimed. That is to say, the date, State or WTO member and the file number can be supplied up to 16 months after the earliest claimed priority. Where the priority claim is inserted after the filing date and causes a change in the earliest priority date, this 16-month period is calculated from that new earliest priority date in accordance with A.88(2).*
- *OJ2007 – SE 5 – Synoptic presentation: R.52(2) and (3) apply the time limits laid down in R.26bis.1(a) for the addition or correction of priority claims to Euro-direct applications. For clarity's sake, the addition of further priority claims and the correction of existing ones are dealt with separately.*
- *The applicant may also try to withdraw the request for early publication – no provision in the forbids this. If accepted by EPO, the applicant can still add the priority claim as long as the 16-month period of R.52(2) has not yet expired.*

### H5-04

(EQE – 7 points)

- (a) What is the latest date by which a European patent application can be withdrawn if the applicant wants to be sure that publication will be prevented?

Will the EPO accept a conditional withdrawal when the condition is that the application should not be withdrawn in the event that publication can no longer be stopped?

- (b) Is the EPO obliged to publish a European patent application if it is withdrawn between the date under (a) and the scheduled date of publication?
- (c) What is the latest date by which a PCT application can be withdrawn if the applicant wants to be sure that publication will be prevented?
- (d) An applicant irrevocably withdraws a European patent application one day after having received notification that the European patent application will be published as an A2 document. What fees, if any, will be refunded by the EPO?
- (e) An applicant irrevocably withdraws a European patent application seven months after publication of the search report, having requested examination and having paid the examination fee. What fees, if any, will be refunded by the EPO?

### Answer

#### EPC

- (a)
- application is not published if it has been withdrawn before termination of technical preparations for publication - A.93(1), R.67(2)
  - Preparations for publication are deemed completed at end of day that falls 5 weeks before expiry of 18m period - R.67(1); OJ2007-SE3-D.1
  - So withdrawal of application by that day will ensure that application will not be published
  - EPO will accept conditional withdrawal if applicant makes withdrawal subject to proviso that content of application is not made known to public - GL A-VI, 1.2
- (b) No
- R.67 does not mean that EPO is prevented by law from stopping publication of application once technical preparations for its publication are deemed completed - J5/81, hn.1
- (c) Non-publication PCT application
- international publication can be prevented provided notice of withdrawal reaches International Bureau before technical preparations for publication are completed - A.21.5, R.90bis.1(c)
  - Technical preparations are generally completed by 15<sup>th</sup> day prior to date of publication - AG-IP 9.013305, i.e. prior to “promptly after expiry of 18m period” - A.21(2)(a)
  - So withdrawal of application before that day will ensure that application will not be published
- (d) Refund of fees:
- “A2” publication indicates that search report has probably not yet been drawn up - GL B-IV, 1.4
  - -RFees 9(1), if application is withdrawn before Office has begun to draw up search report, search fee will be fully refunded
  - If already paid, examination fee will be fully refunded, since Examining Division has not yet assumed responsibility - RFees 11(a)
- (e) Refund of fees:
- request for examination may not be withdrawn - R.70(1), last sentence
  - Examining Division has assumed responsibility for application as soon as valid request for examination has been made - R.10(2)
  - So RFees 11(b) applies in this case and refund of 75% of examination fee will be made provided substantive examination has not yet begun - OJ 2009, 542
  - designation fee may have been paid together with examination fee. But designation fee is not refunded - R.39(3)

### Comment

Based on Question 3 of Paper DI of EQE 1998 - 6 points.

- (a) Because of the formulation “wants to be sure” in the question, a reference in the answer to the provision “two weeks before the scheduled date of publication” in OJ2006, 406 is not required.
- (e) GL A-I, 2: Once the application is transferred to the Examining Division, the latter accepts responsibility for the formalities of the application.

## H7 – Amendments and correction of errors

**H7-06****(EQE – 3 points)**

Upon receiving the European Search Report and the negative search opinion from the Search Division, and prior to receiving the first communication from the Examining Division, the applicant wishes to add to the description of your European patent application:

- (a) a reference to a patent cited in the search report quoting part of the abstract;
- (b) statements concerning further advantages of the invention over the cited art which you had not mentioned in the originally filed description;
- (c) statements concerning recently discovered disadvantages of the cited state of the art.

Are these additions permissible?

**Answer****EPC**

- As search opinion was not positive, applicant is required to respond - R.70- GL B-XII, 9 and A-V, 2.1
  - With this response, he may amend description, claims and drawings of his own volition- R.137(2)
- (a) Yes, adding such reference is admissible - A.123(2)
    - mere addition to description of reference to prior art could not reasonably be interpreted as addition of "subject-matter" contrary to A.123(2) - T11/82; GL C-II, 4.3
  - (b) No, such statements is not admissible
    - It is possible that addition of discussion of advantages of invention with reference to prior art does not contravene A.123(2), it depends on actual wording used and circumstances - T11/82; GL C-II, 4.3 and C-VI, 5.3.1
    - In this case, amendment seems not permissible since advantages are not derivable directly from description
  - (c) Same answer as (b), because prior art disadvantages imply advantages for invention

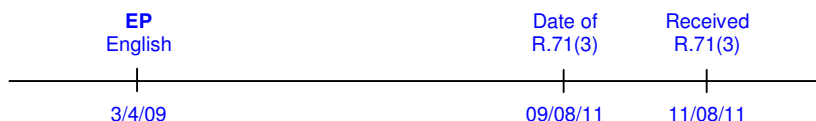
**Comment**

- Based on Question 3 of Paper DI of EQE 1992 - 3 points (adapted).
- T 13/84 "Problem reformulation allowed when deducible from application in light of the closest prior art"

**H8 – Decision to grant the patent or refuse the application****H8-02****(EQE – 7 points)**

You filed a European patent application for your client in the English language on 3 April 2009. On 11 August 2011 you receive a communication according to R.71(3) EPC. The communication is dated 9 August 2011. You are informed that the EPO intends to grant a European Patent for the designated states [Luxembourg \(LU\)](#), [Germany \(DE\)](#), and [Switzerland/Liechtenstein \(CH/LI\)](#). The patent specification contains thirteen claims.

- (a) What fees have to be paid and what will the periods be for paying the fees?
- (b) What will the period be for submitting the translation of the claims to the EPO?
- (c) The mention of the grant of the patent will be published on 22 December 2011. What are the periods for submitting the translation of the patent to the national patent offices and in what languages?

**Answer****EPC**

- (a) Fees to be paid:
  - fee for grant and publishing - R.71(3), RFees 2(1).7
  - There are 13 claims, so no claims fees are due - R.71(6)

Period for payment of fees:

- communication pursuant R.71(3) is deemed received on:  
9/8/11 + 10d [R.126(2)] → 19/8/11
- period for R.71(3) communication is 4m - R.71(3), 1st sentence

- So last day for paying fee for grant and publishing is:  
19/8/11 + 4m [R.131(4)] → 19/12/11 (Mon)
  - If 4m period is not observed, application will be deemed withdrawn - R.71(7)
  - FP - A.121 - is available up to 2m from communication concerning loss of rights - R.112(1), R.135(1)
  - There is single flat fee for late performance of R.71(3) acts - RFees 2(1).12
- (b) Translations of claims into French and German have to be filed within same period as mentioned under (a) - R.71(3), i.e. at latest on: 19/12/11
- (c) Validation:
- EPO will indicate where A.65(1) translation requirements for designated states may be found on website - R.71(10)
  - States may require translation of patent specification to be filed within no less than 3m from mention of grant of patent - here 22 March 2012 - A.65(1); Nat. Law, Tab. IV
  - As patent is granted after 1 May 2008 and LU, DE and CH/LI have all ratified it, London Agreement applies
  - In this case, as LU, DE and CH/LI have EPO language, namely Germ- A.14(1) - as official language, no translation at all will be required for validation in these states - A.1, London Agreement
  - But proprietor may subsequently be required to supply full translation in German in event of dispute in these states - A.2, London Agreement

### Comment

- *Based on Question 2 of Paper DI of EQE 1997 - 5 points (adapted).*
  - *Examiners' report: Many missed answering parts of this question, e.g. failed to specify the languages of the translation.*
  - *You could also mention designation R.71(8) and renewal fees R.71(9) for (a).*
  - *For (c), prior to 1 Apr. 2009, EPO indicated in the R.71(3) communication which of the designated states would require a translation under A.65(1) - old R.71(10) – see decisions of Administrative Council of 21 Oct. 2008.*
  - *Note that the actual time limit for filing the translations is determined under national law – A.65(1) simply guarantees a minimum of 3 months*
  - *Additionally, the proprietor may be required to provide an address for service, typically required where offices send reminders concerning national renewal fees – National Law Table VI, Col. 6. However, there is no sanction or time limit specified in the.*
- (a) *Periods:*
- *The period in R.71(3) is not a “period to be specified”, and thus not extendable before expiry under R.132.*
  - *The grant is before 3/4/12, so the last renewal fee to EPO – A.86(2) will be in the fifth patent year. The last renewal fee was due on 30/4/11 - R.51(1). If it was not paid on or prior to this due date, it may still be paid, with a surcharge of 50% at the latest on 31/10/11(Monday) - R.51(2), J4/91 de ultimo ad ultimo.*

## H12 – Periods and time limits

### H12-04

(EQE – 5 points)

On 20 October 2011 you received a communication dated 17 October 2011 from the EPO, noting a loss of rights [R.112(1) EPC] and stating that your client's European patent application is deemed to be withdrawn under Art.94(4) EPC because the invitation to file observations on a communication from the Examining Division dated 7 March 2011 was not complied with. On the morning of 22 December 2011 your secretary posted a registered letter containing a request for further processing of the European patent application and a response to the Examining Division's communication. On the afternoon of 22 December 2011 she realised that she had forgotten to enclose a debit order for the payment of the fee for further processing in the envelope. Therefore, she immediately despatched at a post office a second registered letter bearing the address of the EPO, enclosing the forgotten debit order and indicating the purpose of the payment. Both registered letters were received at the EPO on 29 December 2011.

Was the request for further processing validly filed?

**Answer**  
EPC



- o R.112(1) communication deemed notified on:  
17/10/11 + 10d [R.126(2)] → 27/10/11
- o So period for FP expired on - A.121(1), R.135(1) :  
+ 2m [R.131(4)] → 27/12/11 (Tue)

#### Letter with Request FP + response to office action:

- o letter deemed received in due time since it was posted on 22/12/11, which is 5 days before expiry of period and was sent as registered mail - R.133(1); GL E-VIII, 1.7; OJ2007-SE3-I.1
- o As it was sent as registered letter, evidence is available of date it was posted
- ~~o All requirements of R.133 and Decision of President are met~~

#### Letter with fee payment:

- o R.133 is not applicable for fee payments for which provisions of RFees are applicable – different fail-save arrangement
- o In case of debit order, payment is considered to have been made to EPO on date of receipt of debit order, i.e. on 29/12/11 - RFees 7(2) and ADA item 6.3 - which is after expiry of 2m period
- o amount on debit order was not sufficient to pay FP fee because of surcharge of 10% on this fee - RFees 7(3)(b) and ADA 6.8 - should have been paid
- o RFees 7(4); EPO may issue communication requesting applicant to provide evidence of date on which second letter was posted and to pay surcharge of 10%
- o If surcharge is paid, all requirements of A.121(1), R.135(1) have been met

#### **Comment**

- o *Based on Question 9 of Paper DI of EQE 2001 - 5 points.*
- o *Examiners' report: The most common error made by the candidates was the lack of acknowledgement that, contrary to the request for further processing, the payment by debit order could not be considered as having been made in due time and therefore resulted in a surcharge of 10%.*
- o *OJ1999, 301, item 25: R.133 does not apply to fee payments, for which RFees 7(3) is lex specialis.*
- o *ADA item 6.3 (part): Upon receipt by EPO, the debit order is stamped with the date of receipt. Provided there are sufficient funds in the deposit account to cover the total fee payments indicated for the application referred to in the order, or in the case of an order containing a list of applications for each application referred to, this date is considered to be the date on which payment is made.*
- o *ADA item 6.8: If EPO receives a debit order by post after expiry of a period for payment, then under RFees 7(3) and (4) that period is considered to have been observed if evidence is provided to EPO that the person who made the payment:*
  - a) despatched at a post office in a Contracting State, within the period for making the payment, a letter bearing the address of EPO containing the order, provided the account contained sufficient funds on the date on which the time limit expired, and*
  - b) paid a surcharge of 10% on the relevant fee or fees, but not exceeding € 150; no surcharge is payable if the letter was despatched not later than ten days before expiry of the period for payment. Such letters should be sent by registered mail for the purpose of securing evidence.*

## H13 – Further processing and re-establishments of rights

### H13-10

(2 points)

An opponent having filed a notice of appeal does not submit the grounds of appeal within the due period.

- What is the relevant period?
- Is there a means of redressing the situation? If so, what can he do?

#### **Answer**

EPC

- period for filing grounds of appeal is 4m from notification of decision - A.108, last sentence
- Yes

- FP in this period is ruled out - A.121(4) - and thus - R.136(3) - proprietor - A.122(1) - may RE request - GL E-VIII, 2.2.2
- opponent is not proprietor, so no remedy is provided in EPC
- But RE is allowed by exception for opponent for period for submitting grounds - A.122(1), R.136(1); G1/86

### Comment

(b) *Re-establishment of rights:*

- A.122 applies for the applicant or the proprietor only.
- G1/86: In principle, re-establishment for filing the notice of appeal - 2 months; A.108 is only available for the applicant or proprietor to provide certainty for the applicant/proprietor. However, there is no reason to exclude the 4-month period of A.108 for these other persons.

### H13-14

(EQE – 3 points)

The applicant files many patent applications, including two having identical titles and similar applicant's references and which receive similar EPO application numbers. A communication from the Examining Division is received and sets a period for response. As the applicant's reference given is that of the one application which is no longer needed, no response was filed and the applicant receives notice of deemed withdrawal of the application because of failure to respond within the period. He does not react to this communication either, considering that he does not need to undertake anything more. Two months later the applicant pays the renewal fee for the fourth year. One month later, the renewal fee is refunded and the applicant now realises that because of the error of the EPO, he has allowed an application to lapse other than the one which he in fact no longer needed. In each instance the correct EPO application number had been given on the official communication, but the applicant's reference was wrong.

Comment briefly upon the possibility and requirements for recovery of the application.

### Answer

#### EPC

- application was deemed withdrawn - A.94(4)
- FP - A.121(1), R.135(1) - was in principle possible but is no longer applicable as more than 2m have already elapsed
- applicant can also not apply for decision - R.112(2), because 2m period for this has also expired

#### RE:

- applicant should argue that conditions for requesting RE - A.122(1), R.136(1) - are satisfied and why
- applicant should file application for RE within 2m after refund took place (= removal of cause of non-compliance) but before expiry of 1 year following expiry of unobserved period
- At same time, applicant should pay RE fee, complete omitted act - request FP by paying FP fee, file response to communication, all - A.121(1), R.135(1) - and prove all due care - R.136(1)
- It is not possible to RE-request RE when replying to communication, since FP would have been possible - R.136(3)

### Comment

- Based on Question 5 of Paper DI of EQE 1992 - 3 points (adapted).
- The applicant may also try to argue that he relied in good faith on information from EPO - A.125; G5/88. If the argumentation is successful, the acts of EPO and of the applicant will be totally null and void - see e.g. J2/87, J3/87, J15/92. However in the case of the question, the correct application number is given by EPO, only the applicant's reference was wrong.

## H14 – Fees and payment

### H14-06

(5 points)

As the result of a typographical error, an applicant pays € 1,445 for the examination fee for a Euro-PCT application upon entry in the regional phase before the EPO as designated office. The application was filed in 2010. The EPO acted as International Searching Authority in the international phase. After expiry of the period for paying the fee, the EPO notifies the applicant that the application is deemed to withdrawn.

What can the applicant do?

### Answer

#### EPC

- Upon entry into EP phase, examination fee must be paid - R.159(1)(f), A.94

- EPO = ISA, so no supplementary ESR will be performed after entry - A.153(7), OJ2009, 594
- EPO is designated, not elected, so no IPE has been carried out, and no fee reduction can be expected - OJ2010, 133
- So fee for examination should be € 1,645 - OJ2010, 133; RFees 2(1).6
- Payment is € 200 too little
- If examination fee is not paid, application deemed withdrawn - R.160(1)
- EPO communicates loss of rights to applicant - R.160(2)

**Main request:**

- Ask for decision - R.112(2) within 2m from notification of loss of rights communication - R.160(2)
- Argue that € 200 is small amount lacking (less than 15%) - RFees 8(1)
  - J11/85: about 10% may as rule be considered small amount;
  - T130/82: it is justified to overlook underpayment of just over 10%;
  - J27/92: 20% may also be considered small amount, if withheld by misinformed party
- By virtue of relatively small amount of underpayment, request permission to pay missing amount under RFees 8(1) + payment € 200

**Auxiliary request:**

- Pay ~~rest of~~ examination fee, and pay FP fee - A.121(1), R.135(1) - within 2m from notification of R.160(2) communication
- Payment € ~~200 + € 100~~ 1645 ~~+-~~ 50% of missed amount; RFees 2(1).12

**Comment**

- *T290/90: the question (of a small amount lacking) must be decided on an objective basis, having regard to all the relevant circumstances of the case.*
- *Because further processing is possible, re-establishment of rights is ruled out for late paying the examination fee - A.122(4) and R.136(3).*

**H14-09****(4 points)**

The renewal fee in respect of the third year of a European patent application was due on 31 March. By the end of October the applicant received a communication from the EPO according to which his European patent application is deemed to be withdrawn due to the failure to pay the renewal fee. The applicant pays the fee immediately, together with the additional fee, and also files a request for re-establishment of rights, paying the corresponding fee. The applicant bases his request on the fact that his excellent secretary had not presented him with the communication from the EPO in April, because of a nervous breakdown. The communication stated that the renewal fee could still be paid provided that the additional fee is paid. He provides a relevant medical certificate. He explains that so far as his other European patent applications are concerned he has always paid the renewal fees with the additional fee after having received the corresponding communication from the EPO.

Legal situation?

**Answer****EPC**

- EPO communication in April was issued to notify applicant that he had failed to pay renewal fee within normal period - A.86(1), R.51(1) – and to inform applicant that renewal fee could still be paid with additional fee – R.51(2) = 50%; RFees 2(1).5
- period for paying with additional fee is 6m from due date - R.51(2); J4/91, which period expires on 30 September
- EPO communication in October was R.112(1) issued to inform applicant that he had failed to observe 6m period of R.51(2)
- FP – A.121 – not available for period of R.51(2) - R.135(2)
- Applicant may apply for RE - A.122 - for 6m period, all due care must be proven
- Communication from EPO in April is courtesy service of EPO - GL A-XI, 5.2.4
- Applicant who relies on such a courtesy communication cannot be exercising “all due care” – J23/87.
- So application for RE will be inadmissible - J12/84, J1/89
- No other ground for arguing “all due care” is apparent from question

**Comment**

See Case Law book (20062010), Ch.VI.A.3: "Courtesy services performed by EPO" and Ch.VI.E.67 "Merit of applications for re-establishment of rights", e.g. J23/87 referred to in 7.3.1.

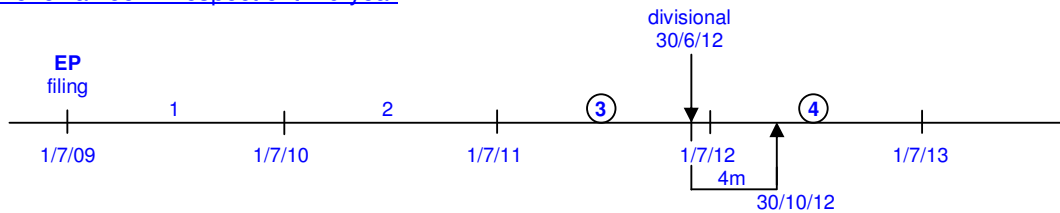
**H14-13****(4 points)**

A European patent application was filed (parent application) on 1 July 2009. On 30 June 2012 the applicant files a divisional application within the period of R.36(1)(b) EPC.

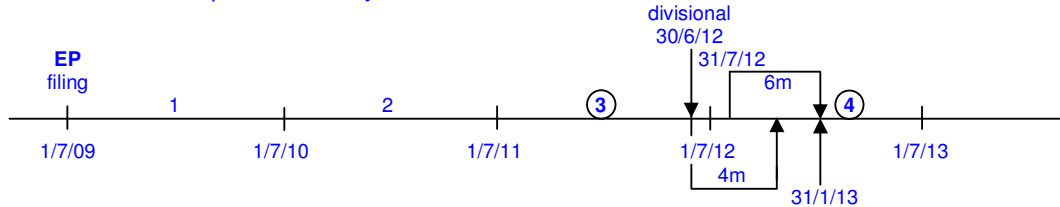
When is the last day for validly paying the renewal fee for the third and fourth year for the divisional application without and with additional fee?

**Answer**

EPC

Renewal fee in respect of third year:

- renewal fee in respect of third year fee for divisional - A.76 - falls due on "filing date of divisional" = 30/6/12 - R.51(3), first and 2nd sentence
- renewal fee in respect of third year fee for divisional can be paid without additional fee at latest on: 30/6/12 + 4m [R.51(3), 2nd sentence; R.131(4)] → 30/10/12 (Tue)
- renewal fee in respect of third year for divisional can be paid and with additional fee (= 50%; RFees 2(1).5) at latest on within 6m from "due date" = filing date of divisional: 30/6/12 + 6m [R.51(2), R.51(3), last sentence; R.131(4)] → 30/12/12 (Sun) [R.134(1)] → 02/01/13 (Tue)

Renewal fee in respect of fourth year:

- renewal fee in respect of 4<sup>th</sup> year fee for divisional falls due on last day of them containing anniversary of parent application = 31 July 2012 - R.51(1)
- renewal fee in respect of fourth year fee for divisional can be paid at latest without surcharge on: 30/6/12 + 4m [R.51(3), 2nd sentence; R.131(4)] → 30/10/12 (Tue)
- renewal fee in respect of fourth year for divisional can be paid and with surcharge (= 50%; RFees 2(1).5) at latest on: within 6m from "due date" = last day of them containing anniversary of parent application: 31/7/12 + 6m [R.51(3), last sentence; J4/91: "de ultimo ad ultimo"] → 31/1/13 (Thu)

**I/J – Revocation and National Rights****I/J-05****(3 points)**

What is the procedure to be followed by the EPO with regard to national prior rights:

- (a) during search?
- (b) during substantive examination?
- (c) during limitation?

**Answer**

EPC

(a)

- National prior rights - A.139(2) - are brought to notice of applicant, if stumbled upon by EPO, but EPO does not specially search for national prior rights - GL B-VI, 4.2

- (b)
  - separate set of claims is allowed if applicant request so, but is not suggested by examiner to applicant - GL C-III, 8.4; R.138
  - applicant must produce evidence of existence of national right, e.g. by providing copy - R.138
- (c)
  - Different sets of claims - R.92(2)(d) - are allowed upon request - GL D-X, 10
  - If claims become different in different States:
    - to avoid national prior rights in some States: requestor must inform EPO of these prior rights - R.138;
    - to avoid EP prior rights – only for patents filed under EPC1973 - R.87 EPC1973;
  - If claims are already different for different States:
    - if patent already granted or limited with several sets of claims - due to prior rights or partial transfer of rights - A.61, R.18(2)
    - if different versions of patent are in force in different States, and requestor wants to bring them in line with each other

**Comment**

- *GL C-IV, 8:*
  - *Where a national right of an earlier date exists in a Contracting State designated in the application, there are several possibilities of amendment open to the applicant. First, he may simply withdraw that designation from his application for the Contracting State of the national right of earlier date. Second, for such State, he may file claims which are different from the claims for the other designated States. Third, the applicant can limit his existing set of claims in such a manner that the national right of earlier date is no longer relevant.*
  - *Amendment of the application to take account of prior national rights should be neither required nor suggested. However, if the claims have been amended, then amendment of the description and drawings should be required if necessary to avoid confusion.*
- *GL C-VI, 8.1: The examiner performs a “topping-up” search for conflicting applications because the search files in the Search Division may not be complete in respect of such material at the time the main search is made.*

## PCT: SUBSTANTIVE AND PROCEDURAL LAW

### L1 – Introduction PCT

#### L1-01

(4 points)

- (a) In an international application to be filed at the EPO as receiving Office, the applicant, in completing and signing the form, has indicated the agent appointed by him in Box No.IV of the Request form by giving the name and address of the agent.  
Does an explicit appointment need to be filed?
- (b) In an international application to be filed at the EPO as receiving Office, a European patent attorney identifies himself as the agent.  
Does an explicit authorisation need to be filed?
- (c) In a European patent application does an explicit authorisation need to be filed where the applicant has made a corresponding indication as to the representative in Boxes 15-19 of the Request-for-Grant form?

#### Answer

##### PCT

- (a) No
- o appointment of agent can be effected:
    - o by applicant signing Request or separate power of attorney - A.4(1)(iii); R.90.4(a);
    - o by referring in Request to existing general power of attorney - R.90.5(a)
- (b) No
- o agent may also sign Request - R.90.4(a); R.2.1
  - o power of attorney must be submitted - R.90.4(b) - but may be waived by competent authority - R.90.4(d) or R.90.5(c)
  - o EPO has, - R.90.4(d), R.90.5(c), waived requirement under R.90.4(b), R.90.5(a)(ii) to submit (general) power of attorney - OJ2010, 335
  - o So separate power of attorney signed by applicant is not required before EPO as rO
- (c) No
- o In general no signed authorisation is required if professional representative's name appears on list maintained by EPO and he identifies himself as such - A.134(1)
  - o Only in special circumstances original authorisation is required - R.152(1); OJ2007-SE3-L.1; GL A-IX, 1.5

#### Comment

- (a) EPO is a receiving Office - A.10 and R.19; A.151.
- (b) See also HTG-II (07/11), 10973  
Note, that where an agent or common representative submits a notice of withdrawal, the requirement for a separate power of attorney may not be waived - R.90.4(e).
- (c) GL A-IX, 1.5: Representatives acting before EPO must on request file a signed authorisation within a period to be specified by EPO. If the requirements of A.133(2) are not fulfilled, the same period will be specified for the communication of the appointment and, where applicable, for the filing of the authorisation. Professional representatives who identify themselves as such will be required to file a signed authorisation only in certain cases - see OJ2007-SE3-L.1.

#### L1-02

(3.5 points)

In compliance with the French rules relating to representation, a French patent attorney files an international application for a French company with the French national office. The person is not an employee of the company, and he is not a European patent attorney.

- (a) Can this person request international preliminary examination and follow this procedure through?
- (b) Can this person act before the EPO as designated Office?
- (c) Can this person carry out the formalities for passing from the international phase to the European regional phase?

#### Answer

##### PCT

- (a) Yes
- o He can request IPE and follow this procedure through - A.49, R.90.1(a)

- French patent Office is competent rO - R.19.1(i), (ii)
- (b) No, he cannot act before EPO as dO – J19/89
  - EPO applies A.27(7), R.51 bis.1(b)(i) PCT, implemented by A.133(1), A.134(1) EPC
  - French applicant can either act under his own name or can be represented by patent attorney (or by employee of company or legal practitioner if qualified)
- (c) No
  - Under no circumstances may applicant act, before EPO as dO/eO, through his existing representative in international phase, if his representative is not agent entitled to practice before EPO - A.49; AG-NP: National Chapter - EP.11; GL A-VII, 3.1
  - But applicant himself may initiate regional phase before EPO

### Comment

- (a) See AG-IP 10.020
- AG-NP, National-Chapter - EP.11: *Natural and legal persons having either their residence or their principal place of business within the territory of one of the Contracting States may act on their own behalf in proceedings before EPO - A.133(1). Natural and legal persons not having either a residence or their principal place of business within the territory of one of the Contracting States must be represented by an agent who is entitled to practice before EPO. In case of failure to appoint the required agent, the applicant will be invited by EPO to do so within two months. If the deficiency is not corrected in due time, the application is refused. Nevertheless, the applicant may act on his own behalf within the 31-month time limit applicable under A.22(3) and A.39(1)(b) and R.159(1).*
- See also HTG-II (04/08), 307
- EPO makes the legal position very clear. However, in practice, this could cause applicants to miss deadlines, so EPO will inform the applicant that he needs to be represented by an agent who can act in front of EPO - R.163(5). If a representative satisfying A.133 & A.134 is appointed, the new representative may send a letter confirming the actions of the international representative, thereby retaining the date of filing of the original documents.

### L1-03

(3 points)

A French national living in the USA has filed an international application with the USPTO.

- (a) Can the applicant act before the EPO as designated Office?
- (b) Can the applicant carry out the formalities for passing from the international phase to the European regional phase?
- (c) Would your answer to question (b) have been different if the applicant wants to perform the formalities by requesting further processing after receiving the communication from the EPO that the European patent application is deemed to be withdrawn pursuant R.160(1) EPC?

### Answer

#### PCT

- (a) No, applicant cannot act before EPO as dO - A.153
  - EPO applies A.27(7), R.51 bis.1(b)(i) PCT, implemented by A.133(2) EPC
  - Because applicant has his residence outside Contracting States, EPO requires applicant to be represented by patent attorney in EP regional phase
- (b) Yes, applicant may himself initiate regional phase
  - This is allowed only if applicant performs acts for entry before end of 31m period of R.159(1)
  - See HTG-II (04/08), 306-310
- (c) Yes, this is not allowed
  - See ~~HTG-II, 307~~ HTG-II (04/08), 307 and 309
  - Also AG-National Chapter - EP.11

### Comment

- HTG-II (04/08), 306-310:
  - *Applicants having neither their residence nor principal place of business within the territory of one of the Contracting States to the must be represented by a professional representative and act through him in all proceedings established by the.*
  - *However, up to expiry of the 31-month time limit under R.159, non-resident applicants may either take the procedural steps initiating the procedure before EPO as designated/elected Office themselves, or act through a professional representative entitled to practise before EPO.*

- *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. The only exception is that payments to EPO can be validly made by anybody.*
- *Non-resident applicants who did not themselves take the required steps for entry into the European phase within the 31-month time limit may subsequently perform these and the other procedural steps only through a professional representative entitled to practise before EPO.*
- *If such representative has been appointed agent for the international phase, he is not automatically also appointed for the European phase. A separate appointment is necessary.*
- *AG- National Chapter - EP.11: Natural and legal persons having either their residence or their principal place of business within the territory of one of the Contracting States may act on their own behalf in proceedings before EPO - A.133(1). Natural and legal persons not having either a residence or their principal place of business within the territory of one of the Contracting States must be represented by an agent who is entitled to practice before EPO. In case of failure to appoint the required agent, the applicant will be invited by EPO to do so within two months. If the deficiency is not corrected in due time, the application is refused. Nevertheless, the applicant may act on his own behalf within the 31-month time limit applicable under A.22(3) and A.39(1)(b) and R.159(1).*

**L1-05****(1 point)**

For which Contracting States of the EPC is it impossible to obtain a direct national patent by the PCT procedure?

**Answer**

PCT

Belgium, Cyprus, France, Greece, Ireland, Italy, Latvia, Malta, Monaco, Netherlands and Slovenia have closed route for obtaining national patent - A.4(1)(ii), final clause, and A.45(2); see HTG-II [\(07/11\)](#), [11679](#) and [12183](#)

**Comment**

*HTG-II, 83HTG-II (07/11), 121:*

- *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.*
- *The countries which close off the route to a national patent in this way were, at 1 April 2008 July 2011, Belgium, Cyprus, France, Greece, Ireland, Italy, Latvia, Monaco, Malta, the Netherlands and Slovenia.*

**L2 – The international application; Filing; Filing date; Formalities****L2-20****(8 points)**

An international application from a Dutch applicant is filed, in Dutch, with the Netherlands Patent Office without claiming priority on 16 April 2008.

- (a) Legal situation? Is a translation of the international application required and, if so, what period applies?
- (b) If the applicant files a translation into English may he choose another official EPO language as the language of the proceedings upon entry in the EP regional phase?
- (c) Would your answer to question (a) have been different if the Dutch applicant had filed his international application directly with the EPO?

**Answer**

PCT

(a) rQ:

- Dutch applicant is allowed to file IA in Dutch at Netherlands patent Office - R.12.1(a), R.19.1(a)(i), (ii); AG-IP: Annex C – NL
- EPO is competent ISA for Dutch applicant - A.16, A.154(1); AG-IP: Annex C – NL
- translation of IA is not required for purpose of international search because in this case EPO as ISA will search in Dutch - R.12.3; OJ2010, 304, A.3(1) and Annex

Translation of IA:

- For purpose of international publication of IA, applicant will have to furnish translation into one of languages of publication accepted by NL office as rO, i.e. in Eng, Fre or Ger - R.12.4(a), R.48.3(a); AG-IP: Annex C - NL
- period for filing translation is 14m from priority date - R.12.4(a)
- Because no priority is claimed, "priority date" is filing date - A.2(xi)(c)
- translation must be filed at latest on:  
16/4/08 + 14m [R.12.4(a); R.80.2] → 16/6/09 (Tue)

- (b) No, because translation is supplied by applicant under R.12.4, it is not possible to file new translation upon entry in EP regional phase - G4/08; see also HTG-II (04/08), 285 and 330
- (c) Yes  
EPO as rO:
- EPO is competent rO for Dutch applicants - R.19.1(a)(i) or (ii), A.151
  - IA must be filed in language which is accepted by rO - R.12.1(a)
  - EPO as rO does not accept Dutch - only German, English and French are accepted, R.157(2)
  - safeguard of R.19.4(a)(ii) applies: Where language of IA is not accepted by rO, IA shall be considered to have been received by that Office on behalf of IB
  - application is promptly transmitted by EPO to IB and shall be considered to have been received by IB as rO on date of receipt of IA by EPO - R.19.4(b)

Translation:

- EPO as ISA only searches in Dutch if IA is filed with patent Offices of Belgium or Netherlands - OJ2010, 304, A.3(1) and Annex
- For purpose of international search EPO as ISA requires translation of IA in En, Fr or Ge - R.12.3(a); R.157(2)
- period for filing translation is 1m from receipt of IA by rO - R.12.3(a), i.e. at latest on 16/4/08 + 1m [R.80.2] → 16/5/08 (Fri)
- IA will be published in language of translation - R.48.3(b)

**Comment**

*HTG-II (07/11), 438208:*

- *An exception to the translation requirements for the purpose of international search by EPO as ISA applies only if the application was filed with the Belgian or Netherlands patent Office as receiving Office, since – although not an official language – EPO as ISA also accepts applications in Dutch.*
- *Therefore, a translation of an international application filed in Dutch with the Belgian or Netherlands patent Office is not required for the purpose of the international search by EPO as ISA.*
- *However, within 14 months of the priority date a translation must be filed with the receiving Office in a language of publication accepted by the receiving Office for the purpose of international publication.*
- *The ISR and WO-ISA will be established in the language of the international publication.*

**L2-25**

**(EQE – 5 points)**

Today is 24 October 2011. A Spanish company filed with the EPO an international application in Spanish on 14 October 2011. The international application validly claims priority from a Spanish application filed on 22 October 2010. All necessary fees were paid to the EPO. The Spanish company received a notification from the EPO that the application had been transmitted to the International Bureau.

Why did the EPO transmit the application, what effect does this have, and what has to be done next?

**Answer**

**PCT**

- EPO as rO accepts IA's in Eng, Fr or Ger - ~~A.3(4)(i)~~, R.12.1(a) PCT; ~~A.151~~, R.157(2) EPC
- Consequently, Spanish is not accepted
- That is why EPO transmitted IA to IB under R.19.4(a)(ii) ~~- this is a legal safety not in case of error.~~
- IB as rO accepts IA's in any language - ~~R.12.1(a)~~; AG-IP: Annex C – IB

Effect of transmittal:

- Application considered received by EPO on behalf of IB as rO - ~~R.19.1(a)(iii)~~, R.19.4(a) – on 14/10/11
- Therefore, filing date remains 14/10/11 - R.19.4(b)

What next?

- Fees paid to EPO will be refunded – AG-IP 6.034; OJ 1993, 764
- Applicable fees [transmittal fee, international filing fee; search fee] must be paid to IB as rO within 1 month of the date of receipt by IB – R.14.1(c), R.15.3 and R.16.1(f)
- ~~Because of transmittal under R.19.4, 1m for payment starts on the date of actual receipt by IB as rO – R.19.4(e)~~

**Comment**

- *Based on Question 4 of Paper DI of EQE 2004 - 5 points.*

- *Examiners' report: Even though a majority of the candidates answered that the International Bureau will act as receiving Office in this case, most candidates failed to explain to whom and until when the various fees had to be paid.*
- [R.19.4\(a\)\(ii\) is a legal safety net in case of error.](#)
- *The Request form (PCT/RO/101) under Box No.VII gives the applicant the choice of ISA (ISA) if two or more ISAs are competent to carry out the international search - R.4.14bis.*
- *For nationals and residents of Spain the competent ISAs are EPO and the Spanish patent office - AG-IP Annex C – ES.*
- ~~See AG-IP Annex C – EP~~
- [Because of transmittal under R.19.4, 1m for payment starts on the date of actual receipt by IB as rO - R.19.4\(c\)](#)
- *If the applicant supplies a translation of the application - R.12.3 - into one of the official languages of EPO - R.157(2), EPO may act as ISA.*

**L2-26****(EQE – 6 points)**

On 22 December 2011 you filed an international application at the EPO claiming priority from a European patent application filed on 19 August 2011. Today, 20 March 2012, you received a telephone call from your client who instructs you also to claim priority from a German utility model filed on 24 December 2010.

- (a) Is this possible? If so, what is the last date on which the applicant can add the priority claim?

Your client further informs you that the certified copy of the priority document of the German utility model will not be issued by the German Patent and Trademark Office before 20 May 2012.

- (b) What can you undertake?

**Answer****PCT**

- (a) For adding priority claim, either 16m or 4m period applies - R.26bis.1(a):
- 24/12/10 + 16m [R.80.2] → 24/4/12 (Tue)
  - 22/12/11 + 4m → 22/4/12 (MonSun) [R.80.5] → 23/4/12 (Mon)
  - 24/4/12 is later, so 16m period determines that this is last day to add it
  - So, on 20 March 2012, this is still possible
- German utility model may be used for claiming priority - A.8(1); A.4A(1) PC
- (b) last day to file certified copy is 24/4/12 (16m) - R.17.1(a)
- So copy on 20/5/12 will be too late
  - Publication is due immediately after: 24/12/10 + 18m [A.21(2)(a)] → 24/6/12
  - So we can file certified copy directly with IB before publication
  - It will then be deemed received on 24/4/12
- It can even be filed with national or regional Offices upon invitation - R.17.1(c)

**Comment**

- *Based on Question 3 of Paper DI of EQE 2002 - 6 points (adapted).*
- *It is allowed to file a patent application based on a utility model - A.4E(2) PC.*
- *The priority year of a utility model is 12 months - A.4C(1) PC*
- *On EP entry, if necessary EPO will invite the applicant to supply it – R.163(2)*
- *Examiners' report:*
  - *For part (a), most candidates found that R.26bis.1(a) PCT is relevant for this case. However, some did not correctly calculate and compare the two periods of 4 and 16 months, and particularly failed to appreciate that the period having the later date applies.*
  - *For part (b), only few candidates mentioned the possibility of R.17.1(c) PCT according to which the priority document can be filed with the national or regional Offices.*

**L3 – International search and publication; preliminary examination****L3-02****(EQE – 4 points)**

The applicant filed an international patent application in March 2008. The applicant receives notice from the USPTO as International Searching Authority (ISA) that it considers the application to lack unity and invites the applicant to pay an additional search fee for a second invention. The applicant considers the unity objection is unjust and does not protest or pay the additional fee as requested.

What is the consequence of non-payment of the additional fee before:

- (a) the USPTO as ISA?
- (b) the EPO as designated Office?

**Answer****PCT**

- (a) USPTO as ISA will only establish ISR for parts of application which relate to invention first mentioned in claims - A.17(3)(a)
- (b) EPO will draw up supplementary search report - A.153(7), ~~OJ2010, 642~~OJ 2009, 594 - because USPTO was ISA
  - o fee for supplementary SR is reduced by € 190 - R.159(1)(e), OJ2010, 141

Non-unity:

- o If EPO considers agrees that there is non-unity, supplementary SR will only be drawn up for invention first mentioned in claims - R.164(1)
- o Examining Division will then require application to be limited to one invention either covered by ISR, or supplementary SR - R.164(2)
- o For non-unitary subject-matter, applicant has to file divisional - A.76(1), R.36; G2/92
- o This is only permitted after regional entry - J18/09 -, if application is still pending - G1/09, and at least one of 24m time limits of R.36(1)EPC has not expired

**Comment**

- o *Based on Question 7 of Paper DI of EQE 1994 - 4 points.*
- o *Also see GL B-VII, 2.4, C-III, 7.11.1 (ii), C-III, 7.11.2 and E-IX, 5.7.*
- (b) EPO as dO:
  - o AG-IP 7.021: The lack of an international search report in respect of those parts of the international application does not, of itself, have any influence on the validity of the international application, the processing of which, including its communication to the designated Offices, continues in respect of all claims. Nevertheless, the national law of any designated State may provide that such unsearched parts of the international application will be considered withdrawn as far as that State is concerned unless a special fee is paid by the applicant to its national Office. There are only a few Offices which apply such provisions.
    - The EPO does not provide for such special fee.
  - o J18/09 was issued 1/9/2010, and published recently (OJ 2011, 480) – in view of this recent publication in the OJEPO, a reference to J18/09 is likely required at the EQE.

**L3-06****(EQE – 3 points)**

The applicant of an international application, filed as a first filing with the EPO as receiving Office, would like to amend the claims directly after having received the international search report. Afterwards, the applicant files a demand for international preliminary examination.

- (a) With which authorities must he file the amendments? What if the amendments are filed after the demand has been filed?
- (b) Is a period laid down for doing so?

**Answer****PCT**

- (a)
  - o Amendments to claims (after receiving ISR) must be filed with IB - A.19(1), R.46.2
  - o If amendments to claims are made after demand is filed, then copy of amended claims should, preferably, also be sent to IPEA - R.62.2
- (b) Yes:
  - o period under A.19 is 2m from date of transmittal of ISR to applicant or 16m from priority date of application whichever expires later - R.46.1
  - o As no priority is claimed in IA, 16m period runs from international filing date - A.2(xi)(c)
  - o Period will be considered to have been met if amended claims reach IB before completion of preparations for publication - R.46.1-, which is 15d before scheduled publication date - AG-IP 9.013
  - o Amendments or arguments need not be taken into account by IPEA if they are received after IPEA has begun to draw up IPER - R.66.4bis, R.66.1(b)

**Comment**

*Based on Question 5 of Paper DI of EQE 1991 - 3 points (adapted).*

- (a) *When filing the demand, he needs to indicate how the IPEA should deal with the A.19 amendments - R.53.9(a)(i).*
- (b) *HTG-II (07/11), 247364: Amendments and arguments filed under A.34(2) PCT should preferably be filed together with the demand. However, they also have to be taken into account by EPO as IPEA if they are filed before expiry of the time limit for filing the demand - R.54bis.1.*

**L3-07****(3 points)**

Three applicants have jointly filed an international application. They have not appointed a common representative. In the request you are appointed as agent. The request was signed by the deemed common representative. After receiving the International Search Report the applicants decided to amend the claims.

- (a) Where must the letter be submitted containing the replacement sheets with the amended claims? What period applies?
- (b) Are you entitled to sign this letter?
- (c) Would your answer to (b) be different if you had signed the request?

**Answer****PCT**

- (a)
- After receiving ISR, applicant is entitled to amend claims with IB - A.19(1), R.46.2
  - period referred to in A.19 PCT is 2m from date of transmittal of ISR to IB and to applicant by ISA or 16m from priority date, whichever period expires later - R.46.1.
  - period will be considered to have been met if amended claims reach IB before completion of preparations for publication - R.46.1 -, which is 15d before scheduled publication date - AG-IP 9.013.
- (b) Yes, agent is entitled to sign - R.90.3(c), R.90.4(a) and (d)
- IB has waived requirement to submit separate power of attorney. waiver applies only in respect of agent or common representative who has been indicated in Request form - see list on PCT website: "Offices (or Authorities) which have notified WIPO of Waiver(s) of Power of Attorney requirement under R.90.4(b) and/or R.90.5(a)(ii)"
  - request was signed by deemed common representative and letter is signed by agent indicated in Box No.IV of Request form
  - signature of deemed common representative on Request form completes appointment of agent, at least as agent of deemed common representative
- (c) No, answer is same - see PCT NL 12/2004 "Practical Advice"

**Comment**

- (a) *At same time applicant may also file "brief statement" explaining amendments - A.19(1)*
- (b-c) *PCT NL 12/2004 "Practical Advice":*
- *The IB has waived the requirement to submit a separate power of attorney. The waiver applies only in respect of an agent or common representative who has been indicated in Box No.IV of the Request form.*
  - *The agent is permitted to file various papers with the IB throughout the international phase without the need to submit a power of attorney signed by the applicant(s).*
  - *For example, the agent can now submit the following papers to the IB without the need to submit a power of attorney: A.19 amendments; corrections of priority claims; informal comments on the written opinion; requests for recording of changes in certain indications in the request or the demand - R.92bis - for all changes except for a change of agent where the request for change is signed by the new agent.*
  - *AG-IP 5.089: The international application may be signed by an agent, but in that case the agent must be appointed as such by the applicant in a separate power of attorney signed by the applicant himself. The power of attorney has to be submitted to the receiving Office unless the receiving Office has waived the requirement to furnish a separate power of attorney (see paragraphs 5.041 to 5.051, and 11.001 to 11.014). If there are two or more applicants, the request may be signed by an agent on behalf of all or only some of them; in that case the agent must be appointed as such in one or more powers of attorney signed by the applicants on whose behalf the agent signs the application.*

**L3-08****(7 points)**

A German applicant and a Swedish applicant jointly filed an international application in Swedish at the European Patent Office indicating the EPO as International Searching Authority (ISA).

- (a) Under what conditions will the EPO act as ISA?

After receiving the international search report and an unfavourable written opinion of the EPO as ISA the applicants decided to file a demand. The names of both applicants are indicated in the demand. However, the address, nationality and residence of only the German applicant are indicated in the demand. In addition, the demand is signed by the German applicant only.

(b) What is the legal situation before the EPO as IPEA?

### Answer

PCT

(a) Non-competent rO:

- EPO will forward Ito IB because EPO does not accept Swedish as language in which IA may be filed - R.19.4(a)(ii); R.157(2)
- IB becomes rO under R.19.1(a)(iii) - see R.19.4(a), last sentence

Language of international search:

- EPO acts as ISA (ISA) and as IPEA - PCT, -agreement between patent Organisation and International Bureau of WIPO, for applicants who are residents or nationals of State party to - A.152
- EPO as ISA accepts Eng, Fre or Ger - OJ2010, 304, A.3(1)
- For EPO to act as ISA, IA must be translated into Eng, Fre or Ger within 1m from date of receipt of IA by rO - R.12.3(a)

(b) EPO as IPEA: name, address, nationality and residence:

- As to indications in demand concerning applicant R.4.5 - name; address; nationality and residence - applies mutatis mutandis - R.53.4
- If there are several applicants prescribed requirements must be given for each of them - R.53.4, R.4.5
- For purposes of R.53.4, if there are two or more applicants, it shall be sufficient that indications referred to in R.4.5(a)(ii) - address - and R.4.5(a)(iii) - nationality and residence - are provided in respect of one of them who has right - R.54.2 to make demand - R.60.1(a-bis)
- Both German and Swedish applicant are entitled to make demand - R.54.2
- If required indications are available in respect of one of applicants, this is considered sufficient and no invitation will be issued - HTG-II [\(07/11\)](#), [361244](#)

Signature demand:

- demand must be signed - R.53.2(b)
- demand must be signed by applicant or, if there is more than one applicant, by all applicants making demand - R.53.8(a)
- For purposes of R.53.8, if there are two or more applicants, it is sufficient that demand be signed by one of them - R.60.1(a-ter)
- If signature of one or more applicants is missing, EPO as IPEA will not invite applicant(s) to furnish missing signature(s) provided that at least one of applicants has signed demand - HTG-II [\(07/11\)](#), [348231](#)

### Comment

(b) See OJ2005, 493 for the policy of EPO when acting as IPEA.

### L3-14

(2 points)

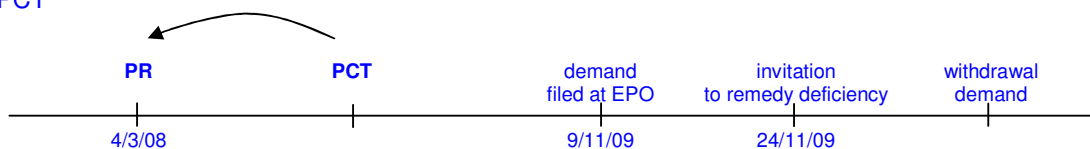
An international patent application is filed claiming a priority of 4 March 2008. The International Search Report is included in the international publication.

On 9 November 2009 the applicant files a demand with the EPO; the fee for the preliminary examination is paid on the same day. On 24 November 2009, the applicant is invited to remedy a deficiency in the demand within a period of 1 month, that the demand as filed is not signed. The applicant responds to the invitation in time. The deficiency is remedied after expiry of the relevant period for filing the demand. Subsequently, the applicant withdraws his demand for international preliminary examination.

Will the fee for preliminary examination refunded?

### Answer

PCT



- Withdrawal of demand is possible at any time prior to expiration of 30m from priority date - R.90bis.4(a)
- Effect of withdrawal: processing of IA by IPEA will be discontinued - R.90bis.6(c)
- If demand is withdrawn before start of preliminary examination: 75% of fee for preliminary examination will be refunded - R.58.3; OJ2010, 304, A.5(3) and Part II(5); also see HTG-II (07/11), 359242
- R.69.1(a) specifies when IPE starts. IPE starts will not start before expiry of applicable period under R.54bis.1(a), in this case, after:  
4/3/08 + 22m [R.54bis.1(a); R.80.2] → 4/1/10 (Mon)

**Comment**

HTG-II (07/11), 210327: EPO as IPEA will not start examination before expiry of the time limit laid down in R.54bis, unless the applicant requires an earlier start. Arguments and/or amendments under A.34(2) filed after filing of the demand, but before expiry of this time limit, must always be taken into account for international preliminary examination.

**L4 – National phase and Euro-PCT application****L4-01****(2 points)**

An international patent application has been filed but without indicating the name and other prescribed data of the inventor. Upon entry into the regional phase, at the end of 31 months after the priority date, the applicant has omitted to designate the inventor before the EPO.

What is the sanction for this omission? Remedies?

**Answer****PCT**

- A.4(1)(v): details should be provided on filing IA. But details may be provided later if national law allows - A.22(1)
- R.163(1) EPC: EPO sets period of 2m in which applicant may remedy defect of not having filed designation of inventor at expiry of 31m period - R.159(1) EPC
- EPO: Euro-PCT will be refused if designation not provided - A.24(2) PCT; R.163(6) EPC
- Applicant will be notified of this decision - R.112(1) EPC
- FP - A.121 – is available because R.163 is not excluded - R.135(2); RFees 2(1).12 EPC

**Comment**

- See also HTG-II (04/08), 305 and GL A VII, 3.4
- If applicant fails to file designation, A.24(1)(iii), national Office may declare effect of A.11(3) (effect of regular national application) ceases

**L4-04****(EQE – 3 points)**

Applicant A timely requested the Russian Patent Office acting as receiving Office to prepare and transmit the priority document to the International Bureau by crossing the relevant box in the PCT Request form and paying the prescribed fee. Upon entry into the European phase, the priority document has been furnished neither to the International Bureau nor to the EPO.

What are the consequences for substantive examination?

**Answer****PCT**

- Substantive examination will start despite missing priority document - GL A-VII, 3.5 or C-V, 2.1
- If result of substantive examination is that patentability requirements are not met application can be refused without priority document - GL C-V, 2.1
- If application is allowable, applicant is informed that decision to grant will not be taken as long as priority document is missing - GL A-VII, 3.5 or C-V, 2.1
- EPO shall not request applicant to furnish priority document - R.17.2(a), 2nd sentence (exception to R.163(2)), since requirements of R.17.1(b) (request timely, i.e. not later than 16m and payment of fee) are fulfilled - GL A-VII, 3.5

**Comment**

- Based on Question 4 of Paper DI of EQE 2005 - 4 points.
- Examiners' report: Nearly all candidates had difficulties with this question. At least some candidates realized that the requirements of R.17.1(b) had been fulfilled and that EPO shall not request the applicant

to furnish the priority copy according to R.17.2(a). Still, very few candidates knew how EPO would act in such a situation.

- Also see HTG-II (04/08), 421.
- GL A-III, 3.5:
  - Where the file number or the copy of the previous application has not yet been submitted at the expiry of the period of 31 months, EPO invites the applicant to furnish the number or the copy within a specified period.
  - However, R.53(2) and the Decision of the President - OJ2009, 236, providing an exception to the requirement that a copy of the previous application be furnished, also apply to international applications entering the European phase.
  - Furthermore, where the applicant has complied with R.17.1(a) or (b) EPO as a designated Office may not ask the applicant himself to furnish it with a copy of the priority document - R.17.2(a), 2nd sentence.
  - If the priority document is not on file, substantive examination may nevertheless be started. However, no European patent may be granted until such time as the priority document is on file. In such a case, the applicant is informed that the decision to grant will not be taken as long as the priority document is missing.

**L4-06****(2.5 points)**

An international application was published in English and comprises 100 pages:

- abstract – 1 page;
- description – 50 pages;
- 140 claims – 20 pages;
- drawings – 20 pages;
- 60 amended claims filed under PCT Art.19 PCT – 9 pages.

On entry into the European phase, and by the date of payment of the additional fee within the 31-month period, 10 pages with 70 amended claims are filed to replace previous pages of claims, as indicated by the applicant in EPO Form 1200.

- (a) For how many pages must the additional fee be paid?

In response to the communication pursuant R.161 EPC, the applicant files a set of 15 amended claims on 3 pages.

- (b) Will there be a refund of the additional fee already paid?

**Answer****EPC**

- (a) number of pages for which additional fee – R.159(1)(c), A.78(2), R.38(2), Rfees 2(1).1a - must be paid is 46:
- number of pages on which calculation of additional fee (as part of filing fee – R.159(1)(c)) is based - GL A-III, 13.2; OJ2009, 118 :  
100 – 20 (original claims) – 9 (A.19) + 10 (EP entry) – 35 (fee-exempt) = 46 pages
- (b) No - OJ2009, 118 or OJ2009, 338 (last par.)
- Pages of amendments filed after date of payment of additional fee, in particular during 1m period - R.161, are not taken into account in calculation
  - So, if amendments are filed at this stage which reduce number of pages already paid for, no refund of additional fee will be made

**Comment**

- For the additional fee: also see OJ2008, 10.
- Payment of claims fees upon entry into the regional phase before EPO can be avoided if the applicant, in response to the (combined) communication pursuant to R.161 and R.162 - EPO Form 1226, reduces the number of claims to less than or equal to 15 - R.162(3).

**L4-11****(EQE – 3 points)**

An international application was filed without claiming priority. The last day to enter the European regional phase expires on 7 November 2012.

Is it possible to obtain a European patent for Serbia, San Marino, Albania and the Former Yugoslav Republic of Macedonia when entering into the European regional phase?

**Answer****EPC**

- EPO can only act as dO for those States designated which are Contracting States to PCT at time of filing IA - A.153(1)(a); J30/90
- IA must have been filed on:  
7/11/12 - 31m [R.159(1), R.131(4) mutatis mutandis] → 7/4/10

At time of filing IA:

- RS: was not EPC state (only since 1/10/10), but extension state since 2004
- SM: was EPC state (since 1/7/09)
- AL: was not EPC state (only since 1/5/10), but extension state since 1996
- MK: was EPC state (since 1/1/09)
- So EP patent can be obtained in MK and SM. RS and AL also possible if extension fees – OJ1994, 82: A.3 - areis paid no later than 31m – R.159(1)(d); GL A-III, 11.12
- ~~○ AL not possible via EP.~~
- ~~○ But AL is PCT since 1995, so IA may enter AL. Deadline is also 31m – AG-NP: National chapter-AL~~

### Comment

Based on Question 1 of Paper DI of EQE 1993 - 3 points (adapted).

GL E-IX, 5.1

### L4-13

(EQE – 6 points)

You are asked to perform the necessary acts for entering the regional phase before the EPO in respect of:

- (a) an international application, PCT1, filed 18 months ago in the USA claiming the priority of an earlier application filed 30 months ago. The USPTO was International Searching Authority (ISA). The international application was published as A1 publication. International Preliminary Examination has not been requested. The application contains twelve claims.
- (b) an international application, PCT2, filed 30 months ago in the USA without any priority claim. Two months after international publication, the A3 publication was published. International Preliminary Examination has been carried out. The EPO was International Searching Authority (ISA) and International Preliminary Examining Authority (IPEA). The application contains eighteen claims.

What fees are to be paid for entering the regional phase:

- in case (a)?
- in case (b)?

### Answer

PCT

following fees have to be paid within period of 31m from date of filing of application or, if priority is claimed, from priority date - R.159(1) :

- (a) Acts for entry into EP regional phase:
  - Pay filing fee - R.159(1)(c), A.78(2)
  - Pay designation fee since period of R.39(1) has already expired - R.159(1)(d); IA was published with ISR (A1)
  - Pay fee for supplementary ESR because USPTO acted as IS- R.159(1)(e), A.153(7); search fee is reduced by € 190 - A.153(7); OJ2010, 316, item 9
  - File request for examination including payment of examination fee, since period of R.70(1) has already expired - R.159(1)(f), A.94(2)
  - Payment of renewal fees is not yet due - R.159(1)(g)
  - No claims fees have to be paid - R.162(1)
- (b) Acts for entry into EP regional phase:
  - Pay filing fee - R.159(1)(c), A.78(2)
  - Pay designation fee since period of R.39(1) has already expired - R.159(1)(d); IA was published as A2; A3 publication is ISR; A3 publication was around 20m after filing I
  - No fee for supplementary ESR is required because EPO acted as IS- R.159(1)(e), A.153(7); GL B-II, 4.3 (i); also see HTG-II (04/08), 372
  - File request for examination including payment of examination fee since period of R.70(1) has already expired - R.159(1)(f); examination fee is reduced by 50% as EPO acted as IPE- RFees 14(2)
  - Pay renewal fee in respect of third year - R.159(1)(g), R.51(1) - because this renewal fee has already fallen due

- Pay 3 claims fees - R.162(1)

**Comment**

- Based on Question 6 of Paper DI of EQE 1999 - 4 points.
- OJ2009, 206, Annex A 2 (ii): EPO will not act as an IPEA for international applications where the international search has been performed by an ISA other than EPO or the industrial property Office of a State party to the.
- GL B-II, 4.3 (i): The Administrative Council decided that a supplementary European search report is not drawn up for international applications for which EPO was the ISA.
- OJ2009, 118: The new fee structure (two-tier structure of claims fees, additional fee on filing, flat designation fee, flat fee for grant and publication) apply to European patent applications, including European divisional applications and new applications under A.61(1)(b), filed on or after 1 April 2009 and to international applications entering the regional phase on or after that date.

**L4-14****(1 point)**

A French applicant filed an international application. After receipt of the international search report from the EPO, the applicant filed amended claims and filed a demand for international preliminary examination.

Will the examination fee be reduced:

- in the international phase?
- in the regional phase?

**Answer**

PCT

- No
  - No reductions are available as France is not on World Bank list of lower-income countries – OJ2008, 521
  - So applicant has to pay full examination fee - R.58.1, RFees 2(1).19
- Yes
  - Because IPER was drawn up by EPO, examination fee upon entry EP regional phase is reduced by 50% - R.159(1)(f) and, A.14(2); also see RFees 2(1).6

**L4-18****(EQE – 7 points)**

Today, 22 March 2010, you receive a letter from a US client asking you to perform the necessary acts for entering the regional phase before the EPO for an international application, if still possible. He filed the international application on 17 July 2008 with the US Patent Office (USPTO). The priorities of US applications dated 17 July 2007 and 23 October 2007 were claimed.

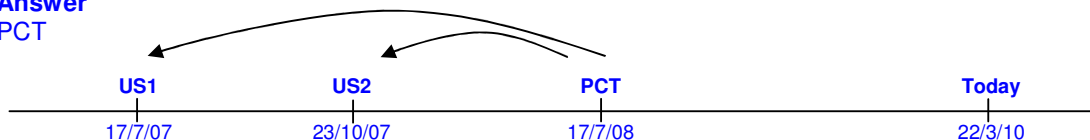
International search and preliminary examination was carried out by the USPTO. The subject-matter of each of the original fifteen claims met the requirements of PCT Art.33(1) to (4).

Since the period for performing the necessary acts for entering the regional phase before the EPO has already lapsed, your client proposes to withdraw the first of the priority claims in order to extend this period.

- Will withdrawal of the first priority claim have the desired effect?
- If this priority claim were maintained, would it still be possible to enter the regional phase before the EPO and, if so, what measures should be taken?

**Answer**

PCT



- No
  - applicant may withdraw priority claim - R.90bis.3(a); A.2(xi)(b) – at latest on:
    - 17/7/07 + 30m [R.80.2] → 17/1/10 (Sun)
    - [R.80.5] → 18/1/10 (Mon)
  - In view of current date (22/3/10), it is thus no longer possible to withdraw first priority claim
- Yes
  - Last day to enter EP regional phase was:
    - 17/7/07 + 31m [R.159(1); R.131(4) EPC] → 17/2/10 (Wed)
  - So today (22/3/10), application is deemed withdrawn - R.160(1)

- o EPO will communicate deemed withdrawal to applicant - R.160(2)

applicant can pay missing fees together with Request FP within period of 2m from communication - R.160(2) provided at same time FP fee is paid for each of omitted acts - A.121(1), R.135(1); RFees 2(1).12 :

- o filing fee - R.159(1)(c), A.78(2);
- o designation fee - R.159(1)(d); OJ2009, 118;
- o search fee for supplementary search - R.159(1)(e); there is reduction of € 190 in search fee because USPTO acted as IS- A.153(7); OJ2010, 316, item 9;
- o examination fee - R.159(1)(f)

No FP fee has to be paid for late filing of translation of application because IA must have been filed (or translated) in English by US client - R.159(1)(a)

- o due date for renewal fee in respect of third year is 31/07/10 (Sat) - R.159(1)(g), R.51(1); renewal fees are calculated with respect to international filing date
- o renewal fee can be validly paid without additional fee at latest on Mon 2 August 2010
- o Payment of claims fees (15 claims) is not required - R.162(1)

Representation:

- o After expiry of 31m period, only patent attorney can perform above acts for US client - A.27(7); A.133(2); HTG-II (04/08), 306-310
- o If US client does not appoint patent attorney, EPO will invite him to appoint professional representative within 2m - R.163(5)

### Comment

- o Based on Question 2 of Paper DI of EQE 1999 - 5 points (adapted).
- o Examiners' report:
  - (a) Many overlooked that this question related to the international phase and wrongly relied on the instead of R.90bis.3(a)PCT.
  - (b) Some missed out specific required measures and others gave the requirements but not the legal basis. Far too many others thought the 30-month period had expired and that it was too late to do anything despite further processing and no need for translation. Most did not mention that the US client cannot perform the acts for entry after expiry of the 31 month time limit. However, many answered the question well.
- o OJ2009, 118: The new fee structure (two-tier structure of claims fees, additional fee on filing, flat designation fee, flat fee for grant and publication) apply to European patent applications, including European divisional applications and new applications under A.61(1)(b), filed on or after 1 April 2009 and to international applications entering the regional phase on or after that date.

### L4-20

(6 points)

A US applicant filed an international application on 6 May 2009 as a first filing at the USPTO as receiving Office. The application comprises two independent claims 1 and 2, complying with the unity requirements.

The USPTO acted as International Searching Authority. The international search report was transmitted to the applicant in December 2009, together with the written opinion (WO-ISA) indicating that both claims were not patentable.

Today is 3 December 2010.

- a) What steps should the applicant take to enter the European phase without paying a surcharge?
- b) What further steps are required to get a European search for claim 2 only granted during the European phase? Will a fee be due for this search?
- c) What steps should the applicant take to obtain a search by the EPO for both claims during the international phase. How does this change the procedure and steps given in the answers to a) and b) ?

### Answer

a) last day to enter EP phase is:  
6/5/09 + 31m [R.159(1), R.131(4) EPC] → 6/12/11 (Tue)

- applicant should perform acts of R.159(1) no later than 6/12/10 to avoid paying any surcharge for further processing – Art. 121 EPC
- US-resident may initiate EP-entry himself - HTG-II, 307HTG-II (04/08), 307. After that, he must be represented - Art.27(7), R.51bis.1(b) PCT; Art.133(1),(2) EPC

b):

- EPO was not ISA nor SISA, so supplementary ESR will be drawn up - Art.153(7), OJ2009, 594. So search fee must also be paid on entry - R.159(1)(e)
- After entry, EPO will send R.161(2) communication. Either on entry or in response to this R.161(2), applicant should either delete claim 1 or switch order of claims – R.164(1)
- This new claim set will form basis for supplementary EP search – R.161(2), which forms the basis for examination and grant – R.164(2)

c):

- SIS request must be filed at latest on:  
6/5/09 + 19m [R.45bis.1(a); R.80.2] → 6/12/10 (Mon)
- and it must be filed with IB - R.45bis.1(b)
- following should be paid to IB - R.45bis.3(b):  
1) SIS handling fee for benefit of IB - R.45bis.2(a); Schedule of Fees, Item 2  
2) SIS fee for benefit of EPO as SIS– RFees 2(1).2; R.45bis.3(a); OJ 2009, 593

Differences:

- a) Because EPO was SISA, NO supplementary ESR will be drawn up - Art.153(7); OJ 2009, 594 so no search fee is due on entry
- b) EPO will send R.161(1) communication. Either on entry or in response to this, applicant should delete claim 1 or switch order of claims
- Additionally, because EPO was SISA, applicant must comment on SISR WO if it is not completely positive – R.161(1); OJ 2010, 316
- If there are objections in WO, it may also be wise to amend claim 2 as this is also last chance to amend of own volition – R.137(2). After this, amendments may only be made with consent of Examining Division – R.137(3)

### Comment

- *EPO acts as SISA from 1/7/10*
- a)
  - *A US-resident applicant may initiate EP entry himself if it is done prior to 6/2/11. After that, a representative must be appointed.*
- b)
  - *On entry, the application may also be amended to delete claim 1 – Art.28 PCT*
  - *The search fee will be reduced by € 190 because the USA was the ISA - OJ2010, 133*
  - *Both SIS fees must be paid no later than 1m from the date of receipt of the SIS request - R.45bis.2(c); R.45bis.3(c) & R.45bis.2(a)*
- c)
  - *EPO has offered SIS's since 1 July 2010 - OJ 2010, 316; AG-IP: Annex SIS – EP*
  - *the SIS request should not be filed at EPO - AG-IP 8.008.*
  - *it should be in either English or French - R.92.2(d); AG-IP 8.009.*
  - *EPO expands on optional explanations - R.45bis.7(e) - to give full EPO WO - OJ 2007, 316 item 6*
  - *As both claims were searched by the USPTO as ISA, EPO cannot excluded claims from the search under R.45bis.5(d)*
  - *Time limit to pay the fees is also in AG-IP 8.030*
  - *The last day to enter the EP phase remains 6/12/11 and the applicant must still be represented after initiating the entry. All the acts of R.159(1) must also be performed, except that no search fee needs to be paid - GL A-III, 3.1*