



DELTA PATENTS

Training for Patent Professionals

**MAIN-EXAM
QUESTIONS
FOR PAPER D**

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D

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Introduction and acknowledgement

This document comprises an update to the Study Guide and Questions and Answers as used in our LEGAL Main Exam Courses in 2016, and “D –book” (edition May 2016, EQE 2017):

- Publications in OJ EPO after the Book was printed (OJ May 2016 – August 2016);
- Publications in PCT Newsletter after the Book was printed (PCT NL June – September 2016);
- Corrections to the questions and answers.

We thank all who provided any comments and all candidates who participated in our legal training courses, as well as those that gave feedback on our material via email, for useful feedback. Any further comments are highly appreciated.

The latest version of this document is available on our website.

Roel van Woudenberg,
19 September 2016

EQE 2017 preparation courses

DeltaPatents organizes further training sessions for candidates preparing for Pre-Exam 2017 and for the Main Exam 2017 in the period from April 2016 until February 2017. Also, our Correction Papers programme for the EQE Main Exam papers will start after the summer and be active until late January.

Please check our website for course details, further announcements and enrolment:

<http://www.deltapatents.com/eqe.html>

<http://www.deltapatents.com/eqe-pre-exam.html>

<http://www.deltapatents.com/eqe-main-exam-paper-d.html>

<http://www.deltapatents.com/registration--cancellation.html>

or contact us via email at:

training@deltapatents.com .

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1. Update of Study Guide

Training Material and Sources - Law + Regulations

1. EPC – Ancillary Regulations

A new edition of the “Ancillary Regulations to the European Patent Convention” has been published as Supplementary Publication - Official Journal 4/2016, which supersedes OJ 2010-SE1. The Study Guide already referred to the original publications included in the “Ancillary regulations”.

Training Material and Sources - Guidelines (EPC & EPO-PCT)

New editions of the Guidelines will enter into force per 1 November 2016, both “Guidelines for Examination at the EPO” (GL2016[^]) as well as “Guidelines for Search and Examination at the European Patent Office as PCT Authority” (EPO-PCT-GL2016).

Training Material and Sources - Applicant’s Guide (PCT)

“Introduction to the International Phase” was amended per 1/7/2016:

- AG-IP 5.066-067 - R.26bis.3(f)&(h-bis): documents in relation to request for restoration of prio
- AG-IP 5.175 – R.9: correcting defects under R.9
- AG-IP 8.010 – R.92.2(d): correspondence with IB may also be in language of international publ
- AG-IP 9.016A – R.26.4 & R.48.2(f): omitting certain information from international publication
- AG-IP 9.023A – R.90bis.1(c): preventing international publication
- AG-IP 9.025 – R.94: information excluded from file inspection
- AG-IP 10.003 – R.94: idem
- AG-IP 11.049 – R.90bis.1(c): effect of withdrawal of IA
- AG-IP 11.065A: general unavailability of electronic communication
- AG-IP 11.066: communication to IB may also be in language of international publ if via ePCT
- AG-IP 11.073/073A/074 – R.94: information excluded from file inspection, request thereto

Case Law (EPC):

- “Case Law of the Boards of Appeal of the European Patent Office”, 8th edition, Jul 2016, supersedes the 7th edition, Oct 2013

H2 & H6, Law + Regulations:

Add:

- OJ 2016, A67 “Validation in Moldova (MD)”

H3 & H4 & H6, Law + Regulations:

Add:

- OJ 2016, A66 “Notice concerning the handling of enquiries as to the processing of files”

H9, Law + Regulations:

Update and add:

- OJ 2016, A42 supersedes OJ 2001, 148 per 1/7/2016: "Opposition procedure as from 1 July 2016"
- OJ 2016, A43 "Information in streamlined opposition procedure"

H14, Law + Regulations:

Add:

- OJ 2016, A48 "Decision dd. 29.06.2016 concerning amending RFees 11"
- OJ 2016, A49 "Notice dd. 30.06.2016 concerning refunds of the examination fee RFees 11"
- FAQ: information letter "Expected start of examination" (F2919):
<http://www.epo.org/service-support/faq/procedure-law/information-letter-F2919.html>

L1, Law + Regulations:

- The "Learn the PCT" videos are also available at the WIPO website:
<http://www.wipo.int/pct/en/training/index.html>

Add to PCT Contracting states:

- OJ 2016, A65 / PCT NL June 2016: "Accession by Kuwait (KR) - in force per 9/9/2016"
- OJ 2016, A72 / PCT NL Jul/Aug 2016: "Accession by Djibouti (DJ) - in force per 23/9/2016"
- OJ 2016, A?? / PCT NL Sep 2016: "Accession by Cambodia (KH) - in force per 8/12/2016"

L2, Law + Regulations:

Add:

- OJ 2016 – Special Edition No.4:
 - p.413 OJ 2014, A33 "Filing a PCT application with the EPO as rO"
 - p.420 OJ 2015, A51 "PCT Direct – EPO as ISA"

L3, PCT Newsletter:

Add:

- PCT NL Sep 2016, Practical Advice "Differences between international search and supplementary international search"
- OJ 2016 – Special Edition No.4:
 - p.413 OJ 2014, A33 "Filing a PCT application with the EPO as rO"
 - p.420 OJ 2015, A51 "PCT Direct – EPO as ISA"

L3, Law + Regulations:

Add:

- OJ 2016, A66 "Notice concerning the handling of enquiries as to the processing of files"



4. Update of Main-Exam Questions

“QUESTIONS DEALING WITH LEGAL CHANGES OF 2016”

Add:

- Kuwait accedes to the PCT (9 Sep 2016) – PCT NL Jun 2016 L2-31
- Djibouti accedes to the PCT (23 Sep 2016) – PCT NL Ju/Aug 2016 L2-31
- Cambodia accedes to the PCT (8 Dec 2016) – PCT NL Sep 2016 L2-31
- Amended RFees 11 – OJ 2016, A48 & A49 H4-15, H5-04, L4-02

B2-02

Please correct “EPO” into “applicant”:

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~~ applicant had not received the communication under Rule 69(1) EPC.

L2-22

Change the designations to:

An international application is filed in English with the EPO in Munich. Applicant A is a Lebanese living in Lebanon. Applicant B is Belgian living in Pakistan. Applicant A is the only applicant for the US. Applicant B is the only applicant for JP, KR and CN. Applicants A and B are joint applicants for the other designated states.

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5. Update of Answers to Main-Exam Questions

B2-01

Add to the comments:

- *T 1325/15 commented on these two referrals G1/14 and G2/14, and answered the questions:*
- *T 1325/15, r.35. Both referral decisions concentrated on the meaning of Art.108, second sentence, which reads "Notice of appeal shall not be deemed to have been filed until the fee for appeal has been paid". In numerous decisions the BoAs had interpreted this provision as meaning that an appeal did not come into existence, i.e. the notice of appeal was deemed not to have been filed, if the appeal fee was not paid within the two-month time limit of Art. 108, first sentence. In a smaller number of deviating decisions, the BoA dismissed the appeal as inadmissible where the notice of appeal was filed and the appeal fee paid after expiry of the time limit.*
r.41. Art.108, first sentence, requires that notice of appeal be filed within two months of notification of the decision. If no notice of appeal is filed, then no appeal comes into existence. Although the position that R.101(1) means that a late-filed notice of appeal brings into existence an inadmissible appeal may be not unreasonable, in view of the general rule that no distinction is to be made between the late filing and the non-filing of a document, the Board considers that no appeal exists where a notice of appeal was not (deemed to be) filed in due time.
r.42. The Board notes that its approach, although it has not always consistently been applied in the jurisprudence of the BoAs, is also in line with the reasoning in earlier decisions which have argued that an appeal is deemed not to have been filed where the appeal fee was paid in time but the notice of appeal was filed only after expiry of the two-month period of Art.108(1) (see in particular decisions J 19/90, r.1.2.2 and 4; T 445/98, r.1.2, 5, 6 and 7; and T 778/00, section V of the facts and submissions and point 6 of the reasons).

B4-13

Add to the Answer:

IS

- Further, if the patent proprietor is not domiciled in Iceland, he must have an agent residing in the EEA.
- Also, a fee of ISK 27.000 must be paid within the same 4m period

SK

- Also, a fee of EUR 116 had to be paid within the 4m period

H5-04

Because of the amendment to RFees11 1/7/2016 – OJ 2016, A48 & A49, the answer to b) changes to:

- Exam. Div. has assumed responsibility as soon as valid request for examination made - R.10(2)
- So, refund of full examination fee will be made provided substantive examination not yet begun - RFees 11(a) per 1 July 2016 - OJ 2016, A48 & A49,
- or at a rate of 50% if the European patent application is withdrawn after substantive examination has begun and before expiry of the time limit for replying to the first invitation under Art.94(3) issued by the Examining Division proper or, if no such invitation has been issued by the Examining Division, before the date of the R.71(3) communication – Rfees 11(b) per 1 July 2016 (1 Nov 2016)
- EPO will inform the applicant, at least 2m beforehand, of the date on which it intends to start substantive examination / OJ 2016, A48

Note: due to the amendments to RFees11, GL (2015) A-VI, 2.5 is out-of-date.

H6-07

RFees11 1/7/2016 was amended per 1/7/2016 OJ 2016, A48 & A49

Update the first bullet of the Comments to:

- *In general, examination fee is 100% refunded if Examining Division has not yet taken responsibility and not yet started substantive examination – RFees 11(a) per 1 July 2016 – OJ 2016, A48 & A49*
- *Applicant will be informed at least 2m ahead about intended start of substantive examination – OJ 2016, A49*

Note: due to the amendments to RFees11, GL (2015) A-VI, 2.5 is out-of-date.

H8-09

Update the second bullet of the answer, as the Guidelines specifies the period to be specified from R.53(3):

- Where validity is relevant for patentability, Exam. Div. will invite applicant to file translation into En, Fr or Ge within a period to be specified – R.53(3), R.132 – which will be 4m during examination – GL (2015) A-III, 6.8.1

H14-15

RFees11 1/7/2016 was amended per 1/7/2016 OJ 2016, A48 & A49

Updated answers:

- (b)
 - If applicant has waived, full refund - RFees 11(a) per 1 July 2016 – if substantive examination has not yet started
- (c)
 - if withdrawn after substantive examination has begun and before expiry of the time limit for replying to the first invitation under Art.94(3) from the examining division proper:
 - at a rate of 50% - RFees 11(b) per 1/7/2016
 - if a communication under another legal provision:
 - full refund / OJ 2016, A49
- (f):
 - If not yet started: refund of examination fee in full - RFees 11(a) since 1/7/2016; GL (2015) A-VI, 2.5 (ii)


L2-26

Correct legal basis for 12 month for priority from Art.4A(1) PC tp Art. 4C(1) PC.

L2-31

Kuwait became a PC as well as a PCT state rather recently. Update the answer accordingly:

- Azerbaijan is PCT state and Kuwait is PCT state since 9 September 2016
- Applicant may file IA as resident of Azerbaijan and as national of Kuwait - A.9(1), R.18.1(a) –

- 
- Kuwait is WTO member since 1995, and a PC state since 2 December 2014
[...]
 - And priority for an EP appln may be claimed from a filing in a PC state– A.87(1) EPC

L4-02

RFees11 1/7/2016 was amended per 1/7/2016 OJ 2016, A48 & A49

Updated last bullets of answer a):

- Full examination fee will be refunded - RFees 11(a) per 1/7/2016 – if withdraw before starting date
- 50% refund if withdrawal after starting date and R.71(1) period not yet ended or no R.71(3) issued yet – RFees 11(b) per 1/7/2016 – OJ 2016, A48 & A49
- No refund if withdrawal later

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