



# **DELTA**PATENTS

Training for Patent Professionals

# **BASIC LEGAL QUESTIONS FOR PRE-EXAM AND PAPER 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 Integrated Pre-Exam Courses in 2016, and to the 'Basic legal Questions for Pre-Exam and Paper D -book ("L-book", edition May 2016, EQE 2017):

- Publications in OJ EPO after the Book was printed (OJ May 2016 – September 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,  
31 October 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>

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

or contact us via email at:

[training@deltapatents.com](mailto: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) – OJ 2016, A76 – as well as “Guidelines for Search and Examination at the European Patent Office as PCT Authority” (EPO-PCT-GL2016) – OJ 2016, A77 – .

The Guidelines were updated to refer to updated OJ references, some paragraphs have been renumbered and some changes were made as to its content. An overview of revisions is available on the EPO website for GL2016 on the Guidelines pages, linking to the changed pages and showing strikethrough and highlighting.

### 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"
- OJ 2016, A78 "Notice concerning the online filing of subsequently filed documents under the PCT, including the demand under PCT Chapter II"

## 4. Update of Basic Legal Questions

### “QUESTIONS DEALING WITH LEGAL CHANGES OF 2016”

Add:

- RFees 11 per 1/7/2016  
OJ 2016, A48 & A49 B4-11, H6-05
- KW accedes to PCT – in force per 9 Sep 2016  
PCT NL June 2016; OJ 2016, A65 L1-21
- DJ accedes to PCT – in force per 23 Sep 2016  
PCT NL Jul/Aug 2016; OJ 2016, A72 L1-21
- KH accedes to PCT – in force per 9 Dec 2016  
PCT NL Sep 2016; OJ 2016, A82 L1-21

#### H8-10

Add “pay two claims fees” to statement (c), to update (c) from

- (c) The applicant can, on or before 16 August 2017, file the amended claims, file translations of the amended claims into the other two EPO languages, pay the fee for grant and publishing and expressly waive a further R.71(3) communication.

Into

- (c) The applicant can, on or before 16 August 2017, file the amended claims, file translations of the amended claims into the other two EPO languages, pay the fee for grant and publishing, pay two claims fees, and expressly waive a further R.71(3) communication.

#### H11-04

Please delete statement (d), which belongs to H11-05. The question then reads:

For each of the statements below, indicate whether the statement is true or false.

- (a) Any third party may file observations concerning the patentability of an invention but, by that act, do not become a party to the proceedings.
- (b) Any party to the proceedings may file third party observations concerning the patentability of an invention.
- (c) If prima facie relevant third party observations are filed after the applicant has given his approval under R.71(3), the examining division may not resume examination proceedings.
- (d) Third party observations can be filed during opposition proceedings.
- (e) Third party observations can be filed during limitation proceedings.
- (f) Third party observations can be filed during central revocation proceedings.

#### H11-05

Please insert statement (b), which erroneously showed up in H11-04 (d). The question then reads:

For each of the statements below, indicate whether the statement is true or false.

- (a) Oral proceedings may only be held at the request of any party to the proceedings.
- (b) A first request for oral proceedings by a party to the proceedings may not be refused before a decision to refuse the application is taken.
- (c) Oral proceedings before the Examining Division are, in principle, public.
- (d) Oral proceedings before the Opposition Division are, in principle, public.



## 5. Update of Answers to Basic Legal Questions

### B4-08

Add R.3(1) to legal basis of all statements

Change Art.14(3) to Art.14(1) in statements a.2-a.5, b.2-b.5, c.2-c.5

### B4-09

Add R.3(1) and Art.14(4) to statement (c)

### B4-11-c

Under option C2, change

as the Examining Division has not yet assumed responsibility –RFees11(a).

into

as the Examining Division has not yet assumed responsibility, so examination did not yet start –RFees11(a).

*Note RFees11 has been amended per 1/7/2016 – OJ 2016, A48 & A49*

### H2-03 & H2-04

Correct OJ references in

- € 200 for Moldova (MD) for applications filed  $\geq$  1/11/2015 – OJ 2015, A85 & OJ 2015, A8
- into
- € 200 for Moldova (MD) for applications filed  $\geq$  1/11/2015 – OJ 2015, A84 & OJ 2015, A85 & OJ 2016, A67

### H2-11

Correct and update OJ references in

- Moldova – OJ 2015, A85 & OJ 2015, A8
- into
- Moldova – OJ 2015, A84 & OJ 2015, A85 & OJ 2016, A67

### H5-03

Correct OJ references in

- EUR 200 [OJ 2015, A8) for Moldova (MD) for applications filed  $\geq$  1/11/2015
- into
- EUR 200 [OJ 2015, A84) for Moldova (MD) for applications filed  $\geq$  1/11/2015

### H6-05

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

Update answer to b):

- (b) T (response to R.70(2) causes ED to assume resp; R70a(3); OJ 2016, A48 & A49: RFees11(a): substantive examination has not yet begun: full refund)

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

## H6-12

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

Under “Quick refund”, insert as a second bullet:

- Examining division not yet responsible, so substantive examination did not yet start

Under “Applicant takes no action”, add the underlined part to the third bullet:

- Examination division thus does not become responsible and substantive examination will not begin

Update the answer under “Applicant responded positively to R.70(2)” into:

- The request for examination was filed before the ESR had been transmitted
- So EPO will invite applicant to indicate, within a period to be specified – R.132(2), whether he wishes to proceed - R.70(2), R.70a(2)
- As applicant responded that he wishes to continue, Examination division ~~does not~~ becomes responsible – R.10(3)
- However, if applicant did not comment to the deficiencies noted the search opinion, nor filed amendments within the R.70(2) period, the application is deemed to be withdrawn - R.70a(3)
- So, substantive examination does not begin - OJ 2013, 153
- Examination fee will then be refunded ~~at 75% – RFees 11(b)~~ in full - RFees 11(a)
- Alternatively, the applicant can actively withdraw the application before substantive examination begins
- Also the, examination fee will then be refunded in full - RFees 11(a)

In the comments, amend the 4<sup>th</sup> bullet to:

- *If Examining Division did assume responsibility (after a positive confirmation under R.70(2)), but the European patent application is subsequently withdrawn before the substantive examination has begun, ~~75% of the examination fee will be refunded [RFees 11(b)]~~ the examination fee will be refunded in full [RFees 11(a) as in force per 1/7/2016 – OJ 2016, A48&A49 – and OJ 2013, 153].*

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

## H7-19

Correct the answer to (b) to:

- (b) E (also too late for R.52(3), – GL (2015) A-III, 6.5.2)

## H8-03

Comment, (a), second bullet:

Correct the RFees reference for the Free for grant and publishing into RFees(1),7

## H8-13

Add to (f):

The translation must be filed online or by post with the UIBM, or through the appropriate Chamber of Commerce; No fee if filed with the UIBM;

and:

update the fee in (f) from EUR 40 to EUR 43.

## H10-14

Add to the comments:



A recent T –decision, R 1325/15, commented extensively on these 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 boards of appeal 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 2 m 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 boards of appeal, 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).

#### H14-03

The answer to a.4 was accidentally missing:

- (a.4) F (you calculated end of third year and wrongly shifted due date due to weekend day)

Correct the answer to D.2 to:

- (d.2) F (you missed EPO is closed and last day for valid payment is when EPO open again; R.134(1), J 4/91)

#### L1-21

Three states acceded to the PCT since the book was printed. So add to the answer:

- Cambodia (KH) – in force per 9/12/16 – OJ 2016, A?? / PCT NL 09/2016
- Djibouti (DJ) – in force per 23/9/2016 – OJ 2016, A72 / PCT NL 07-08/2016
- Kuwait (KW) – in force per 9/9/2016 – OJ 2016, A65 / PCT NL 06/2016

#### L3-03, L3-16, L3-26

The two-letter code for the Visegrad Patent Institute is XV

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