



# DELTA PATENTS

Training for Patent Professionals

# BASIC LEGAL QUESTIONS FOR PRE-EXAM AND PAPER D

Update 20 Nov 2018

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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 2018, and to the 'Basic legal Questions for Pre-Exam and Paper D -book ("L-book", edition May 2018, EQE 2019):

- Publications in OJ EPO after the Book was printed (OJ May 2018 – 31 Oct 2018);
- Publications in PCT Newsletter after the Book was printed (PCT NL May 2018 – 31 Oct 2018);
- New Euro-PCT Guide (11<sup>th</sup> edition, issued 18 May 2018, up to date until 1 Jan 2018);
- Corrections to the questions and answers;
- Correction to the calendars.

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,  
20 November 2018

## EQE 2019 preparation courses

DeltaPatents organizes further training sessions for candidates preparing for Pre-Exam 2019 and for the Main Exam 2019 in the period from April 2018 until February 2019. 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](mailto:training@deltapatents.com) .

## 1. Update of Study Guide

### Training Material and Sources - Law +Regulations

#### Guide for Applicants: How to get a European patent

A new, 18th edition of "How to get a European patent, Guide for applicants (June 2018)", based on the information available on 1 April 2018, was published on 22/6/2018.

The paragraph numbering was largely unchanged.

Major updates were made to paragraphs 122, 122, 125, 160, 161, 162, 215, 220 and 228.

A new paragraph 198a was inserted (reduction of appeal fee)

A new chapter XI with new paragraphs 229-239 was added (How to register transfers of rights, licences and other rights).

#### Euro-PCT Guide

A new, 11<sup>th</sup>, edition of the Euro-PCT Guide (up to date until 1/1/2018; published 18 May 2018) was published shortly after the finalization of the April/May 2018 edition of the L-book for EQE 2019, which refers to the 10<sup>th</sup> edition (up to date until 1/1/2017).

In the new version Euro-PCT Guide, some paragraphs were deleted and quite some new paragraphs added. Moreover, the part about par. 40 to about par. 90 was restructured. As a consequence, the paragraph numbering has changed.

A concordance table is given in chapter 2 of this document, and can be used to navigate from the old paragraph numbers as provided in the Study Guide, modules L1-L4, and in the Answers to the Questions to the new edition of the Euro-PCT Guide.

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

#### C2, Law + Regulations:

Add:

- OJ 2018, A44 (April issue), par. II.1.2 "International exhibitions as referred to in Art.55 EPC"
  - (Beijing CN 29.04-07.10.2019, Dubai AE 20.10.2020-10.04.2021, Almere 28.04-23.10.2022)

F:

Add:

#### How to get...

- HTG (2018) "D.XI How to register transfers of rights, licences and other rights"
  - HTG (2018) "D.XI 229-234 – Transfer of rights"
  - HTG (2018) "D.XI 235-239 – Licences and other rights"

#### G1 and G2, Law + Regulations:

Correct:

- OJ 2016 – Special Edition No.4:
  - p.278 OJ2007-SE3-J.2 "Online and paper file inspection"  
→ *partially superseded by OJ 2018, A14; Art. 1(2), (3) and (5) and 2 of OJ2007-SE3-J.2 continue to apply*



Add:

- OJ 2018, A14 “Decision of the President dd 14 February 2018 concerning online file inspection of documents contained in the file held by the EPO as rO, ISA or SISA”

### **H3, H11 and L1, Law + Regulations, and Annex:**

OJ 2018, A45 superseded OJ 2015, A91 (OLF), OJ 2015, A27 (CMS) and OJ 2014, A98 (web-form filing) per 1/6/2018

Add:

- OJ 2018, A45 “Decision of the President dated 9 May 2018 concerning the electronic filing of documents” (supersedes and consolidates OJ 2015, A91, OJ 2015, A27 & OJ 2014, A98 per 1/6/2018)
- OJ 2018, A46 “Notice from the EPO dated 9 May 2018 concerning the electronic filing of documents”

### **H10, Case Law:**

Add:

- Referral G1/18 (by President): “If notice of appeal is filed and/or the appeal fee is paid after expiry of the two-month time limit under Article 108 EPC, is the appeal inadmissible or is it deemed not to have been filed, and must the appeal fee be reimbursed?”

### **H12, Law and Regulations**

Add:

- OJ 2018, A82 “Notice situation in the USA, the Philippines, Hong Kong SAR, China, Indonesia and Japan after the hurricanes and the earthquake between 15 Sep and 1 Oct 2018” (R.134(5) EPC and R.82*quater* PCT)

### **H14, Law + Regulations & Annex, M, item at p.488:**

OJ 2018, A37 superseded OJ 2007 – SE3 – M.3: insignificant amount changed from € 10 to € 15 per 1/7/2018

### **L4, PCT Newsletter:**

Add:

- PCT NL Sep 2018: With effect from 1 April 2005, Uganda withdraws its notification of incompatibility of PCT Art.22(1) as modified with effect from 1 April 2002.
  - So the 30m time limit under Art.22(1) PCT for entry into national phase of Uganda as dO applies as from 1/4/2015 in respect of IAs for which the earlier 21m time limit expired on or after that date and in respect of which the acts referred to in Art.22(1) PCT have not yet been performed by the applicant.

## 2. Euro-PCT Guide

This chapter lists the major differences of the Euro-PCT Guide 11th edition (up to date until 1 January 2018; released 18 May 2018) w.r.t. the previous, 10th edition (up to date until 1 January 2017; released 10 April 2017)

**Concordance table paragraph numbering (left column: EPG (2017); right column: EPG (2018):**

### A. General overview

OLD	NEW
- 1-9:	unchanged
- 10:	deleted
- 11-12:	-1 (10-11)
- New:	13 new (former second part of 12)
- 14-15:	14-15 - contents redistributed over the two pars.
- 16-22:	unchanged
- 23:	renumbered to 26
- 24-25:	renumbered to 23-24 (-1)
- 26:	old 26 deleted, replaced by former 23
- 27-41:	unchanged
- New:	42-44 (external complaints)

### B. EPO as rO

- 42-45:	+3 (renumbered to 45-48)
- 46-51:	49-78 methods of filing, loss in the mail, ...: info from former paragraphs
- 46-51 and 64-89	redistributed
	E.g., pre-conversion archive was 89, now in 57
- 54-57:	+27 (renumbered to 79-84)
- New:	85 (new, negative finding missing parts as IA already complete)
- 58-63	+28 (renumbered to 86-91)
- 64-89:	moved to 49-78 block
- 90-159	+2 (92-161)
	E.g. closure of national route was 120, now 122
- New:	162
- 160	deleted
- 161-189	+2 (163 -191)

### C. EPO as ISA

- 190-227	+2 (192-229)
- New	230
- 228-233	+3 (231-236)
- New	237
- 234-270)	+4 (238-274)

### C. EPO as SISA

- 271-290	+4 (275-294)
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#### D. EPO as IPEA

- 291-404 +4 (295-408)

#### E. EPO as dO/eO

- 405-453 +4 (409-457)
- New: 458 payment by credit card
- 454-516 +5 (459-521)
- New 522
- 517-548 +6 (523-554)
- New 555
- 549-555 +7 (556-562)
- New 563
- 556-571 +8 (564-579)
- New 580
- 572-576 +9( 581-585)
- New 586
- 577-586 +10 (578-596)
- New 597-598
- 587-598 +12 (599-610)
- New 611-612
- 599- +14 (613-)

#### Major changes (new paragraphs)

- 6: email for contact added ([international\\_pct\\_affairs@epo.org](mailto:international_pct_affairs@epo.org))
- 42-44: new: external complaints
- 85: new, negative finding missing parts as IA already complete
- 237: new: Taking earlier search and classification results into account (R4.12; R.23bis.2a/(c))
- 265: provisional opinion on patentability of fist invention mentioned in non-unity invitation
- 357: refund of fee for IPE updated
- 432: early entry check-box in entry form
- 436: automatic debiting on early entry possible since 1/11/2017
- 457: online-only debit orders per 1/12/17
- 458: credit-card per 1/12/17
- 522: RE in respect of missed FP period for translation added
- 555: RE in respect of missed FP period for filing fee added
- 563: RE in respect of missed FP period for designation fee added
- 577: added "Information on search strategy" annexed to all suppl ESRs per 1/1/2018
- 580: EPO uses third party observations from intern phase for suppl. ESR if ...
- 586: EPO uses third party observations from intern phase for first IA if ...
- 597-598: RE in respect of missed FP period for search fee added
- 611-612: RE in respect of missed FP period for request for examination added
- 664: provisional opinion on patentability of fist invention mentioned in non-unity invitation

## Cut-off date

Note that EPG (2018) is only up to date until 1/1/2018, such that the following are not yet included:

- OJ 2018, A17: not anymore possible to file with BE=rO since 1/4/2018
- OJ 2018, A24 "EPO-WIPO Agreement: Amended Annex A(ii) – search-in-Dutch not anymore for BE"
- OJ 2018, A35 "EPO-WIPO Agreement - Amended Annex D, Part I – fees per 1/4/2018"



## 4. Update of Basic Legal Questions

### “QUESTIONS DEALING WITH LEGAL CHANGES OF 2018”

Add:

- Electronic filing of documents per 1/6/2018      H3-01, H3-04, H9-02, H10-05, H12-02, H12-17, L2a-19  
OJ 2018, A45-A46  
(consolidates and supersedes  
OJ 2015, A91 [electronic filing],  
OJ 2015, A27 [CMS],  
OJ 2014, A98 [web-form filing])
- Insignificant amount per 1/7/2018      H14-09  
OJ 2018, A37

#### H3-01

Update the dates in the question for EQE2019 to:

A European patent application is delivered by an applicant at an EPO building in Munich on Saturday 16 February 2019.

- What date of filing will be accorded to the application?
- Would your answer to question (a) have been different if the application was delivered directly to the EPO in The Hague?
- Would your answer to question (a) have been different if the application was sent by regular mail to the EPO on Friday 15 February 2019?

#### H12-14

Delete “using web-form filing”: from the first sentence, such that the question starts with:

You want to file a notice of opposition against a European patent on the last possible date ~~using EPO web-form filing~~. The mention of the grant of the patent was published in the European Patent Bulletin on 23 May 2018.

## 5. Update of Answers to Basic Legal Questions

### C2-02

Add to comment:

- *OJ 2018, A44, par. II.1.2 mentions Beijing CN 29.04-07.10.2019, Dubai AE 20.10.2020-10.04.2021, and Almere 28.04-23.10.2022.*

### C4-04

Correct first bullet in answers to (a) and (b) to:

- [Art.53\(b\), R.28\(2\) excludes plants obtained from essentially biological processes](#)

### H3-01, H3-03, H3-04, H9-02, H10-05, H12-02(g), H12-17, L2a-19

Update the references for electronical filing to OJ 2018, A45, which superseded OJ 2015, A91 (OLF), OJ 2015, A27 (CMS) and OJ 2014, A98 (web-form filing) per 1/6/2018 – also see OJ 2018, A46.

### H4-04(b), H4-12(c) and H7-25(b)

Correct legal basis in 5<sup>th</sup> bullet of H4-04(b), answers to H4-12(c) and H7-5(b) to:

- [Subsequent amendment to unsearched subject matter is not permitted – R.64 & G 2/92](#)

(c) F (no further search fees paid for invention three; [R.64 & G 2/92](#))

(b) F (GL (2017) H-II, 7.1/7.2; [R.64 & G 2/92](#))

Add to comments:

- (c) *If an amendment is done to unsearched subject-matter:*
  - *If the newly introduced independent claim was originally claimed but not been searched, legal basis is R.64(1) & G 2/92; see GL (2017) H-II, 6.2.*
  - *Legal basis is different if the invention would not have been claimed originally, and the newly introduced claim was based on the description: then R.137(5): GL (2017) H-II, 7.2.*

### H10-15

Add to comments:

- *Referral G 1/18 (by President): “If notice of appeal is filed and/or the appeal fee is paid after expiry of the two-month time limit under Article 108 EPC, is the appeal inadmissible or is it deemed not to have been filed, and must the appeal fee be reimbursed?”*



## H12-14

Amend the answer to:

### Answer

- The 9m period for filing the notice of opposition seems to expire on:  
23/5/18 + 9m [Art.99(1) EPC, R.131(4)] → 23/2/19 (Sat) [R.134(1)] → 25/2/19
- But the extension of periods under R.134(1) applies to all types of means of electronic communication (installed software or web-based applications) provided by the EPO under R.2(1), and to all documents which can be filed electronically, regardless of any restrictions applicable to the means of electronic communication in question – OJ 2018, A25
- On Monday, web-form filing was unavailable due to maintenance work, so attributable to the EPO.
- As web-form filing is unavailable on 25/2/19, and all means of communication are available again on 26/2/19,
- the period extends from 25/2/19 → 26/2/19
- which is the last day to file the notice of opposition.
  
- Although Webform filing cannot be used to file an opposition – R.2(1); OJ 2018, A45, Art.3(1); GL (2017) D-III, 3.2-,
- any period extends if any other means allowed under R.2(1) can be used, e.g. EPO Online filing, CMS filing, fax filing, handover to the porter or in the automatic mailbox in Pschorhofs or Berlin,
- so also the opposition period.
- The opposition can thus still be filed on Tuesday 26 Feb 2019...
- ...and by any means, except for web-form filing.

## H14-09

Note: OJ 2018, A37 supersedes OJ2017-SE3-M.3 per 1/7/18 and changed the insignificant amount to €15

## L1-05, L1-08, L2a-10, L2b-02, L3-05, L3-06, L3-08, L3-27, L3-28, L3-29,

Correct “OJ 2018, A27 (updated Annex A(ii), Belgium)” to “OJ 2018, A24 (updated Annex A(ii), Belgium)” in answers and comments.

## L2-04

Add to the answer:

- The EPO as rO provides access to the file held by the EPO as rO to third parties after international publication – Art.30, R.94.1bis & ter, OJ 2018, A14, Art.2 –, except for:
  - any information that, as notified by IB, has been omitted from publication under R.48.2(I) or from public access under R.94.1(d) or (e) PCT;
  - any documents excluded from file inspection under the EPC -Art.150(2), R.144 EPC & OJ2007-SE3-J.3.

Add to the comments:

- *OJ 2018, A14 “File inspection of documents contained in the file held by the EPO as O, ISA or SISA” supersedes OJ2007-SE3-J.3 in part since 1/3/2018. Art.1(2), (3), (5) and 2 of OJ2007-SE3-J.2 continue to apply:*
  - *Article 1 - Online file inspection*
    - *(2) After the introduction of free online file inspection, as a rule it will no longer be possible to inspect paper files on the premises of the European Patent Office.*

- (3) *If inspection is requested of a file not yet stored in electronic form, as a rule the file will be made available online within ten working days of entry of the application or publication number, unless it has already been destroyed (Rule 147 EPC). Entering a valid application or publication number is equivalent to requesting a file inspection. There is no need for a separate written request.*
- (5) *Files or parts thereof that are not scannable shall be made available for inspection in their original form or as filed. They shall be made thus available on the premises of the European Patent Office.*

#### Article 2 - File inspection on paper copies

- (1) *File inspection on paper copies shall be available on request. If it is requested, an administrative fee shall be payable in advance. The request shall not be deemed to have been made until the administrative fee has been paid.*
- (2) *If more than 100 pages have to be produced, the EPO will normally provide only an electronic storage medium holding a copy of the file. If paper copies are expressly requested instead, an additional fee for each page in excess of 100 shall be charged. The invoice for the additional administrative fee shall be sent together with the file inspection documents.*
- (3) *On request, the European Patent Office shall certify the paper copies made available under paragraph 1. The certification request shall not be deemed to have been made until the administrative fee for it has been paid.*
- (4) *It will normally take at least four weeks for the requested electronic storage media or paper copies to be made available.*

#### L3-10(e)

Add to the answer:

- Art.30, R.94.1bis & ter, OJ 2018, A14–, except for:
  - any information that, as notified by IB, has been omitted from publication under R.48.2(l) or from public access under R.94.1(d) or (e) PCT;
  - any documents excluded from file inspection under the EPC - Art.150(2), R.144 EPC & OJ2007-SE3-J.3.

#### L4-26(a)

Correct legal basis in 11<sup>th</sup> bullet point to:

- Not possible to amend later on, as the applicant may not subsequently amend to subject matter not searched in the supplementary ESR [\[R164\(1\) & G 2/92\]](#); GL (2017) C-III, 3.1.1 & 3.1.2

Add to comments:

- *If an amendment is done to unsearched subject-matter:*
  - *If the newly introduced independent claim was originally claimed but not been searched, legal basis is R.64(1) & G 2/92; see GL (2017) H-II, 6.2.*
  - *Legal basis is different if the invention would not have been claimed originally, and the newly introduced claim was based on the description: then R.137(5): GL (2017) H-II, 7.2.*

#### L4-33 and L4-34

Correct typo in date calculation:

1/6/2012 + 6m [R.131(4)] → 1/12/12 (Sat) R.134(1) → 3/12/12 (Mon)



#### L4-43(a)

Add to answer:

- For observations filed during the international phase to be taken into account in the procedure before the EPO as dO, it is required that – OJ 2017, A86, item 5.2.2:
  - the entire observation was filed in an EPO official language,
  - the third party has clearly expressed its wish that the next office action in the EP phase be expedited,
  - the observation was not filed anonymously and
  - the third party has substantiated it.
- A third party wanting the next office action in the European phase to be expedited should, therefore, express this wish in the observation submitted in the international phase OJ 2017, A86, item 5.2.2.
- Alternatively, once the application has entered the European phase, the third party may refile the observation with the EPO as designated/elected Office or refer the EPO as designated/elected Office to its observation filed earlier with the IB. - OJ 2017, A86, item 5.2.2

## 6. Update of calendars

### 2020

In the table of closure dates of 2020, replace 31.05.2020 with 01.06.2020 for Whit Monday.