



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 2019, and to the 'Basic legal Questions for Pre-Exam and Paper D -book ("L-book", edition July 2019, EQE 2020):

- Publications in OJ EPO after the Book was printed (OJ July 2019 – 31 Oct 2019);
 - Incl. new ADA/AAD per 1 October 2019
- Publications in PCT Newsletter after the Book was printed (PCT NL July 2019 – 31 Oct 2019);
- New How to Get Guide (19th edition, issued 7 October 2019, updated to 1 April 2019);
- Corrections to the questions and answers;
- Correction to the calendars;
- Answers to referrals G 1/18 and G 2/19 (not yet in OJ).

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.

Also refer to our compilations of key parts of the EQE syllabus as in force on 31 October 2019 for EQE 2020, on <https://www.deltapatents.com/course-links.html>:

- [EQE 2020 references - EQE](#)
- [EQE 2020 references - EPC](#)
- [EQE 2020 references - EPO and PCT](#)
- [EQE 2020 references - PCT](#)

Roel van Woudenberg,
15 November 2019

EQE 2020 preparation courses

DeltaPatents organizes further training sessions for candidates preparing for Pre-Exam 2020 and for the Main Exam 2020 in the period from April 2019 until February 2020. 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

1. Update of Study Guide

Notes on the references & Training Material and Sources – Law + Regulations

How to get.../ Guide for applicants / Euro-PCT Guide (HTG)

A new, 19th edition of "European Patent Guide - How to get a European patent (April 2019)", based on the information available on 1 April 2019, was published on 7 October 2019.

The paragraph numbering was changed from a consecutive numbering scheme to a chapter.paragraph.item (e.g., 4.1.001) numbering scheme, as in the most recent edition of the Euro-PCT Guide.

- Please replace all references to "Guide for Applicants: How to get a European patent", 18th edition to "European Patent Guide: How to get a European patent", 19th edition.

Training Material and Sources – Law + Regulations

3. London Agreement from www.epo.org

Add:

- OJ 2019, A71: "Belgium (BE) acceded London Agreement – in force for BE per 1/9/2019"

4. Fee payments to the EPO from www.epo.org

"Arrangements for deposit accounts" [OJ Suppl 5/2017; per 1 December 2017] and its updates of OJ 2019, A20 and OJ 2019, A46 are superseded by ADA2019 in OJ Suppl 4/2019; per 1 October 2019:

- Notice from the EPO dd 20 Aug 2019 concerning revision of the ADA and their annexes
- Arrangements for deposit accounts (ADA)
- Arrangements for the automatic debiting procedure (AAD)
- Information from the EPO concerning the automatic debiting procedure

EQE

1. EQE Regulation

Add:

- Decision Supervisory Board of 26 June 2019 w.r.t. Rule 25(3) IPREE (paper C) [OJ 2019, A66]



B3, Case Law – Headnotes / reasons

- Referral G 2/19 answered as follows
(see <https://www.epo.org/law-practice/case-law-appeals/communications/2019/20190717.html>):
“The first referred question was rejected as inadmissible. The second and third referred questions were reformulated and answered as follows:
 1. in Dritter im Sinne von Artikel 115 EPÜ, der gegen die Entscheidung über die Erteilung eines europäischen Patents Beschwerde eingelegt hat, hat keinen Anspruch darauf, dass vor einer Beschwerdekammer des Europäischen Patentamtes mündlich über sein Begehren verhandelt wird, zur Beseitigung vermeintlich undeutlicher Patentansprüche (Artikel 84 EPÜ) des europäischen Patents den erneuten Eintritt in das Prüfungsverfahren anzuordnen. Eine solchermaßen eingelegte Beschwerde entfaltet keine aufschiebende Wirkung.
 2. Mündliche Verhandlungen der Beschwerdekammern an deren Standort in Haar verstoßen nicht gegen die Artikel 113 (1) und 116 (1) EPÜ.”

B4, How to get...

Updates references into:

- HTG (2019) “4.1.006 ff – Languages for EP applications”
- HTG (2019) “4.1.088 ff – Language arrangements to assist applicants from certain states”
- HTG (2019) “Annex IV – The requirements of the contracting states regarding translations of European patent specifications”

B4, Law + Regulations:

Add:

- OJ 2019, A71: “Belgium (BE) acceded London Agreement – in force for BE per 1/9/2019”

B5, How to get...

Updates references to “How to get... “ into:

- HTG (2019) “4.1.023 ff – Representation

C1, Law + Regulations:

Updates references to “How to get... “ into:

- TG (2019): “3.2 – Invention”

C2, Law + Regulations:

Updates references to “How to get... “ into:

- HTG (2019) “3.3.011 ff – Novelty – Basic principles”
- HTG (2019) “3.3.003 ff – Prior rights”

C3, Law + Regulations:

Updates references to “How to get... “ into:

- HTG (2019) “3.011 ff – Novelty”

C4, Law + Regulations:

Updates references to “How to get... “ into:

- HTG (2019) “3.2.001 ff – Invention”
- HTG (2019) “3.2.005 – Prohibited matter”

C5, Law + Regulations:

Updates references to “How to get... ” into:

- HTG (2019) “3.4 – Inventive step”

C6, Law + Regulations:

Updates references to “How to get... ” into:

- TG (2019) “4.2f – Presenting your invention”

C7, Law + Regulations:

Updates references to “How to get... ” into:

- TG (2019) “2.4.010 – Filing EP application creates right of priority”
- HTG(2019) “4.1.017 ff – Claiming priority”

D1, Law + Regulations:

Updates references to “How to get... ” into:

- HTG (2019) “4.1.001 – Entitlement to European patent applications”

E1, Law + Regulations:

Updates references to “How to get... ” into:

- HTG (2019) “2.2 – Nature and purpose of the EPC”

F, Law + Regulations:

Updates references to “How to get... ” into:

- HTG (2019) “5.11 How to register transfers, changes of name, licences and other rights”
 - HTG (2019) “5.11.001 ff – Transfer of rights”
 - HTG (2019) “5.11.007 ff – Changes of name”
 - HTG (2019) “5.11.008 – Licences and other rights”

H1, Law + Regulations:

Updates references to “How to get... ” into:

- HTG (2019) “2 – General”
- HTG (2019) “5.1 – General survey: overview of procedure”
- HTG (2019) “Annex I – Overview of the procedure for the grant of a European patent”

H2, Law + Regulations:

Updates references to “How to get... ” into:

- HTG (2019) “4.2.001 ff – Presenting your invention”
- HTG (2019) “Annex II – Examples of European patent applications”
- HTG (2019) “4.1.002 ff – States for which European patent applications may be filed”
- HTG (2019) “2.5.001 ff – Extending/validating European patent to/in non-EPC states”



H3, Law + Regulations:

Updates references to “How to get... ” into:

- HTG (2019) “4.3 – Filing European patent applications”
- HTG (2019) “Annex III – Authorities with which EP applications may be filed”
- HTG (2019) “4.4 – Filing other documents”
- HTG (2019) “4.1 – Formal requirements”
- HTG (2019) “5.2.001 ff – Examination on filing”
- HTG (2019) “5.8 – Divisional applications”

H4, Law + Regulations:

Updates references to “How to get... ” into:

- HTG (2019) “5.2.009 ff – European search report”

H5, Law + Regulations:

Updates references to “How to get... ” into:

- HTG (2019) “5.3 – Publication of the European patent application”

H6, Law + Regulations:

Updates references to “How to get... ” into:

- HTG (2019) “5.4 – Examination procedure”

H7, Law + Regulations:

Updates references to “How to get... ” into:

- HTG (2019) “5.4.017 ff – Amending applications before and during examination”

H8, Law + Regulations:

Updates references to “How to get... ” into:

- HTG (2019) “5.4.008 ff – Stages of the procedure: grant or refusal”

H9, Law + Regulations:

Updates references to “How to get... ” into:

- HTG (2019) “5.5 – Opposition procedure”
- HTG (2019) “5.6 – Limitation and revocation procedure”
- HTG (2019) “Annex I – Charts for limitation, revocation and opposition procedure”

H10, Law + Regulations:

Updates references to “How to get... ” into:

- HTG (2019) “5.7 – Appeals procedure”

Add:

- Per 1/1/2020, a revised RPBA2020 will apply [OJ 2019, A63]. For EQE2020, the RPBA2007 [OJ 2007, 536] applies.

H10, Case Law :

The EBA has answered G 2/19: see B3.

The EBA has answered G 1/18:

- 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 Art.108 EPC, is the appeal inadmissible or is it deemed not to have been filed, and must the appeal fee be reimbursed?”
 - The Enlarged Board answered the referred point of law as follows (provisional translation for the purposes of press release <https://www.epo.org/law-practice/case-law-appeals/communications/2019/20190718.html>):
 1. An appeal is deemed not to have been filed in the following cases:
 - (a) where notice of appeal was filed within the 2m time limit prescribed in Art.108, first sentence, AND the appeal fee was paid after expiry of that 2m time limit;
 - (b) where notice of appeal was filed after expiry of the 2m time limit prescribed in Art.108, first sentence, AND the appeal fee was paid after expiry of that 2m time limit;
 - (c) where the appeal fee was paid within the 2m time limit prescribed in Art.108, first sentence, for filing notice of appeal AND notice of appeal was filed after expiry of that 2m time limit.
 2. In the cases referred to in 1(a) to (c), reimbursement of the appeal fee is to be ordered ex officio.
 3. Where the appeal fee was paid within or after the 2m time limit prescribed in Art.108, first sentence, for filing notice of appeal AND no notice of appeal was filed at all, the appeal fee is to be reimbursed.

H11, Law + Regulations:

Updates references to “How to get... ” into:

- HTG (2019) “5.4.008 – Requesting oral proceedings”
- HTG (2019) “5.5.006 – Requesting oral proceedings”

H12, Law + Regulations:

Updates references to “How to get... ” into:

- HTG (2019) “Annex V – Time limits”

Add after OJ 2015, A61:

- OJ 2019, A88 “Notice dd 2 Oct 2019 termination of restrictions on cross-border payments originating in GR”

H13, Law + Regulations:

Updates references to “How to get... ” into:

- HTG (2019) “5.10 – General provisions governing periods”

H14, Law + Regulations:

Updates references to “How to get... ” into:

- HTG (2019) “5.9 – Renewal fees”
- HTG (2019) “Annex VI – Fees”

Update:

- ADA2017 (OJ Suppl 5/2017 + OJ 2019, A20 + OJ 2019, A46) superseded by:
ADA2019 (OJ Suppl 4/2019; per 1 October 2019)
 - Notice from the EPO dd 20 Aug 2019 concerning revision of the ADA and their annexes
 - Arrangements for deposit accounts (ADA)
 - Arrangements for the automatic debiting procedure (AAD)
 - Information from the EPO concerning the automatic debiting procedure
- OJ 2019, A26 superseded by OJ 2019, A82 “Notice from the EPO dd 20 Aug 2019 concerning the revised fee refund procedures per 1/10/19”



K2, Law + Regulations:

Updates references to “How to get... ” into:

- HTG (2019) “2.2.001 – Right conferred by patent”
- HTG (2019) “2.3.001 – WTO / TRIPS”

L1, Law + Regulations:

- OJ 2019, A26 superseded by OJ 2019, A82 “Notice from the EPO dd 20 Aug 2019 concerning the revised fee refund procedures per 1/10/19”

L2, PCT Newsletter:

Add:

- PCT NL July/Aug 2019, “Same day corrections before the International Bureau as receiving Office”

Advanced – Add:

- PCT NL Jul-Aug 2019 With effect from 1/7/19, NO withdraws notifications of incompatibility with its national law for R.26bis.3(j) (restoration of right of priority by rO), R.49ter.1(g) (effect if restoration of priority by rO) and R.49ter.2(h) (restoration of priority by dO), and NO office applies “unintentional” criterion
 - so that R.26bis.3 (a)-(i), R.49.ter.1(a)-(d) & R.49ter.2(a)-(g) apply to IAs filed with NO as rO ≥ 1/7/19
 - or entering the NO national phase ≥ 1/7/19

L2, Law + Regulations:

Add:

- PCT NL March 2019 “National Intellectual Property Center of Georgia (SAKPATENTI) starts operation as both depositing and accessing Office of DAS per 1/4/19.”

L3, PCT Newsletter:

Add:

- PCT NL Sep 2019, Practical Advice “Competent International Searching and Preliminary Examining Authorities”

L3, Law + Regulations:

Update:

- ADA2017 (OJ Suppl 5/2017 + OJ 2019, A20 + OJ 2019, A46) superseded by:
ADA2019 (OJ Suppl 4/2019; per 1 October 2019)
 - Notice from the EPO dd 20 Aug 2019 concerning revision of the ADA and their annexes
 - Arrangements for deposit accounts (ADA)
 - Arrangements for the automatic debiting procedure (AAD)
 - Information from the EPO concerning the automatic debiting procedure
- OJ 2019, A26 superseded by OJ 2019, A82 “Notice from the EPO dd 20 Aug 2019 concerning the revised fee refund procedures per 1/10/19”

Annex – Table of Contents OJ2016-SE4:

Update references:

- L.11: OJ 2014, A30 superseded by OJ 2017, A95 per 1/4/18, superseded by OJ 2019, A4 per 1/4/19
- M : OJ Suppl 3/2017 superseded by OJ Suppl 5 2017, superseded by OJ Suppl 4/2019 per 1/10/19

2. Update of Basic Legal Questions

QUESTIONS DEALING WITH LEGAL CHANGES OF 2017

- OJ 2016, A99 superseded by OJ 2019, A71 per 1/9/2019 (Belgium joined London Agreement)

QUESTIONS DEALING WITH LEGAL CHANGES OF 2019

- OJ 2019, A26 superseded by OJ 2019, A82 (fee refund procedure)

Add:

- BE acceded to London Agreement per 1/7/2019 H8-13, H8-15
OJ 2019, A71 (supersedes OJ 2016, A99)

H9-02

Update question (c) to:

- (c) Can a notice of opposition to a European patent be filed by fax? Is confirmation on paper necessary? What is the date of receipt?



3. Update of Answers to Basic Legal Questions

Updates in view of new ADA2019 (OJ Suppl 4/2019)

Please update all references to ADA2017 (as amended by OJ 2019, A20 and OJ 2019, A46) by references to ADA2019 as follows:

ADA

- Paragraphs 1 – 7 numbering unchanged
- Paragraph 8 newly inserted (refunds)
- Paragraph 8 renumbered to paragraph 9

AAD concordance table

AAD2017	AAD2019
1.1	1.1
1.2	1.2
1.3	Incorporated in 1.2
1.4	1.3
1.5	Incorporated in 1.3
2.1	2.1 (rephrased)
2.2	2.2 (rephrased)
-	2.3
-	2.4
3	3.1
4	3.2
5	4
6	5 (but different sub-paragraphs)
7	6
8	7
9	8
10.1(a)-(b)	5.1(b)
10.1(c)	5.2(b)&5.2(c)
10.1(d)	5.2(a)
10.2(a)-(b)	5.1(f)
10.2(c)	5.1(c)&(f)
10.2(d)-(f)	5.1(b)
10.2((g)	5.1(f)
11	9
12	10
13.1(a),(b),(e)-(g)	11(a)-(e)
13.2(a)	11(b)
13.3	11(f)
13.4	11.2

B3-16, B4-11, H3-05, H6-05 (comment), H6-12, H8-12, H10-11, H14-01

- OJ 2019, A26 superseded by OJ 2019, A82 (fee refund procedure) per 1 October 2019

B4-11

Add to comment:

- a) *As to what happens with the unjustifiably reduced amount paid for the filing fee in option A1, the FAQ also provides:*
*“If however the applicant does belong to one of the categories in Rule 6(4) EPC but has not filed the declaration under Rule 6(6) EPC in time, he can still file it within two months of notification of the loss of rights communication. He must then pay the flat-rate further processing fee (for late performance of a procedural act). Lastly, if the applicant considers that the finding of the EPO was not correct, e.g. that there was no actual underpayment or the declaration was indeed filed, it is important that he react by informing the EPO accordingly within two months of the loss of rights communication (Rule 112(2) EPC). **Otherwise the loss of rights will become final and any invalidly paid fee will be refunded (Article 8, second sentence, RFees).**”*
- *RFees 8, 1st and 2nd sentence: “A time limit for payment shall in principle be deemed to have been observed only if the full amount of the fee has been paid in due time. If the fee is not paid in full, the amount which has been paid shall be refunded after the period for payment has expired.”*

B5-02

Correct typo in first line to:

- No – J 19/89, Art. 134(8) EPC:

H5-02

Correct legal reference for fee for Tunisia to:

- EUR 180 [OJ ~~2015~~ 2017, A84] for Tunisia (TN) for applications filed ≥ 1/12/2017

H8-13

In view of Belgium joining the London Agreement per 1 September 2019, change the answer to (d) to:

- (d) BE: dispensed with translation reqs, so no translations needed as grant after 1/1/2017 – OJ 2016, A99 - and London Art.1(1): acceded to the London Agreement per 1/9/2019 – OJ 2019, A71

and the second bullet of the comment to:

- *Belgium became a party to the London Agreement per 1/9/2019 – OJ 2019, A71 –, but dispensed with the translation requirements of Art.65 EPC already for grants on and after 1/1/2017. For EP granted in English before that date, and maintained in amended form or limited on or after 1/1/2017, a translation of the full specification into Dutch, French or German is still needed – OJ 2016, A99.*

H8-15

In view of Belgium joining the London Agreement per 1 September 2019, change the answer to:

Status on 1 September 2019: latest three:

- Belgium (BE) per 1/9/2019 – OJ 2019, A71
- Norway (NO) per 1/1/2015 – OJ 2014, A105
- Ireland (IE) per 1/3/14 (20th state) – OJ 2014, A18

and the third bullet of the comment to:

- *Belgium became a party to the London Agreement per 1/9/2019 – OJ 2019, A71 –, but dispensed with the translation requirements of Art.65 EPC already for grants on and after 1/1/2017. For EP granted in English before that date, and maintained in amended form or limited on or after 1/1/2017, a translation of the full specification into Dutch, French or German is still needed – OJ 2016, A99.*

H9-02

Add to the answer to (c):

- Paper confirmation only needed after invitation of the EPO, within a period of 2m from the invitation R.2(1) EPC; OJ 2019, A18, Art. 7(2)];
- if not complied with the invitation, fax shall be deemed not to have been received.
- Date of receipt = when received in full [OJ 2019, A18, Art.5(3); T 858/18]
- If transmission of the notice of opposition extends over midnight, not possible to waive part received after midnight [T 858/18]
 - The latter is only possible only for patent applications [OJ 2019, A18, Art.5(1)-(2); T 858/18]
- Deemed not to have been received if documents illegible or incomplete [OJ 2019, A18, Art. 6]

Add to comment to (c):

(c) Filing by fax: T 858/18, catchwords:

- *If a facsimile transmission of a document within the meaning of Rule 50(3) EPC begins on an earlier date and extends beyond midnight to a later date, the entire document is accorded the later date as single date of receipt. There is no legal basis for accorded the earlier date as date of receipt to the part of the document arriving at the EPO before midnight (see in particular point 6 and for the term "document" point 4 and for the "date of receipt" point 5 of the reasons). Deviating from decisions T 2061/12 and T 2317/13 (see points 7.3 and 7.4 of the reasons).*

H10-15

In view of the decision taken in G 1/18, amend the first bullet to:

- Appeal fee (or a sufficient amount) not paid within appeal period - Art.108, 2nd sentence (G 1/18)

Add to comments:

- → *The Enlarged Board answered the referred point of law as follows (provisional translation for the purposes of press release <https://www.epo.org/law-practice/case-law-appeals/communications/2019/20190718.html>):*
 - An appeal is deemed not to have been filed in the following cases:*
 - where notice of appeal was filed within the 2m time limit prescribed in Art.108, first sentence, AND the appeal fee was paid after expiry of that 2m time limit;*
 - where notice of appeal was filed after expiry of the 2m time limit prescribed in Art.108, first sentence, AND the appeal fee was paid after expiry of that 2m time limit;*
 - where the appeal fee was paid within the 2m time limit prescribed in Art.108, first sentence, for filing notice of appeal AND notice of appeal was filed after expiry of that 2m time limit.*
 - In the cases referred to in 1(a) to (c), reimbursement of the appeal fee is to be ordered ex officio.*
 - Where the appeal fee was paid within or after the 2m time limit prescribed in Art.108, first sentence, for filing notice of appeal AND no notice of appeal was filed at all, the appeal fee is to be reimbursed.*

L3-03, L3-26

Add PH: Philippines

Intellectual Property Office of the Philippines began operating as an ISA and IPEA with effect from 20 May 2019 (PCT NL May 2019); not as SISA.