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Paper D

eEQE

2021

What We Will Try and Cover

- Material to prepare
- The format of the new exam
- How to try and best prepare
- Exam Technique



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Part VII Common provisions

Article 120

where the corresponding Rules refer to 'period', The German and French versions consistently use only 'Frist' and 'délai', respectively.

The EPC 1973 used the term 'time limit' as an equivalent of 'period' (see e.g. J18/04-1, 26), whereas the EPC 2000 uses 'time limit' in the more common English meaning of 'a fixed point in time beyond which something ceases to be possible or allowable' (Oxford English Dictionary). In the terminology of the EPC 2000 'a time limit is the expiry of a period'.

3 Periods

The first class contains the periods of the EPC which are divided into two classes. The first class contains the periods of a legally indicated length fixed for carrying out a particular procedural act (J24/03 hn.1). In the EPC 1973 such periods were called 'time limits'. Examples are the one-month period of payment of the filing fee and search fee (R.38), the two-month period of R.58 for correcting formal deficiencies in the application, the period to be specified for correcting substantive errors under R.71(1), the 12-month period for claiming priority (Art.87(1)), the period for responding to a communication from an examiner (Art.94(3)) and the opposition period (Art.99(1)). The period is not necessarily equal to the period during which the procedural act may be validly performed. In many cases the EPC allows applicants to perform acts even before the period starts to run (J18/04-1, 30).

The second class contains periods within which a party need not perform an act before the EPO and internal periods of the EPO. Examples are the term of a patent (Art.63(1)), the patent years for the payment of renewal fees in Art.86(O) 1984, 272, the eighteen-month period of Art.93(1)(a) (see e.g. J32/89-1, 3), internal periods as in Art.109(2), the ten-day period of R.126(2) and the 'negative' periods of six months in Art.55(1) and two and five weeks in R.67 (see e.g. J32/89-1, 3).

Art.120 deals with time limits, i.e. the expiry of periods of the first class. Their triggering and computation are governed by R.131. Some periods may be extended upon request under R.132 and periods will be extended automatically under R.134(1)-(3). R.133 and R.134(5) provide a legal fiction that a late received document may be deemed received in due time. In special cases a period may be interrupted (R.14(4), R.142(4)).

Periods calculated from the priority date must be calculated anew from the filing date if the priority claim has been withdrawn before the expiry of the period as calculated from the priority date (A-III,6.11). Failure to observe a period of the first class can be remedied using either further processing or re-establishment. Time limits or periods of the second class are not open for the legal remedies of further processing and re-establishment.

A condition that must be complied with for carrying out an act cannot be equated with a period; for the former the duration is determined by the occurrence of the condition, whereas for the latter the duration is predetermined from the outset. E.g. the filing of a divisional requires compliance with the condition of pendency of the parent application (R.36(1)); the last day on which the divisional can be filed, i.e. the last day of pendency of the parent application, is not predetermined from the outset but determined by occurrence of the condition of pendency. Therefore, R.36(1) does not impose any time limit on filing a divisional application but rather sets a condition. (J24/03 hn. II, 111)

The computation of periods of the second class is not explicitly provided for in the EPC. However, it is generally accepted to apply mutatis mutandis the computation of the periods of the first class as set out in R.131; however the extensions under R.132 and 134 are not applicable.

*Time limit = expiry of period
Period = length of time*

E-VIII

1. Time limits and loss of rights resulting from failure to respond within a time limit.

1.1 Determination of time limits

The EPC imposes time limits upon parties to proceedings. Art. 120
Some of these are fixed by the articles of the EPC, e.g. Art. 87(1) (priority period), and Art. 99(1) (opposition). Others are fixed in the Implementing Regulations, e.g. in Rule 30(2) (payment of late-filing fee), Rule 38 (payment of filing and search fee), Rule 39(1) (payment of designation fees), Rule 58 (correction of deficiencies in application documents), Rule 70(1) (request for examination), Rule 71(3) (filing translations of the claims and payment of fees for grant and printing) and Rule 112(2) (applying for a decision after notification of loss of rights).

Others take the form of a stipulated range, the precise period within this range being at the EPO's discretion.

In other cases, e.g. those dealt with in Rule 31(3) (filing translation of documentary evidence), or Rule 70(2) (invitation to the applicant to indicate whether he desires to proceed further with the European patent application), a period, but not its duration, is provided for in the EPC. The duration must be determined by the EPO in accordance with Rule 132 (see VIII, 1, 2).

1.2 Duration of the time limits to be determined by the EPO on the basis of EPC provisions

Duration of such periods should be based, in principle, on the amount of work which is likely to be required to perform the operation in question. However, in order to facilitate the work of parties and the EPO it has been decided, as a general rule, to adopt a uniform practice with respect to time limits. This practice is at present as follows:

- (i) if deficiencies to be corrected are merely formal or merely of a minor character; if simple acts only are requested, e.g. under Rule 83 the subsequent filing of documents referred to by a party; or if observations are required on amendments which are merely of a merely descriptive nature:
 - (i) communications from an Examining or Opposition Division raising matters of substance - four months.

A longer time limit of up to six months should be set only in the exceptional cases where it is clear that in the circumstances a four-month time limit cannot be adhered to. Each case must be judged on its individual merits and it is difficult to give general guidance, but a six-month time limit might be justified if for example the subject-matter of the application or patent or the objections raised are exceptionally complex. Where the applicant is invited to submit the indication provided for in Rule 70(2), a six-month time limit (unless the applicant has requested a shorter period) is appropriate.

1.3 Time limits which may be freely determined

Time limits for operations in respect of which the setting of a time limit is not explicitly provided for in the EPC are not subject to the restrictions as to the duration of time limits laid down in Rule 132. They may be fixed by the EPO at its own discretion.

E-VIII, 2

2. Further processing and re-establishment of rights

2.1 Request for further processing of the European patent application

If the European patent application is to be refused or is refused or is to be withdrawn following failure to reply within a time limit vis-à-vis the European Patent Office, the applicant is allowed to proceed if the applicant makes a request for further processing of the application. Further processing must be requested by payment of the prescribed fee within two months of the communication concerning either the failure to observe a time limit or a loss of rights. The request is not deemed to have been filed until this fee has been paid. The department competent to decide on the time limit also decides on the request for further processing.

As a general rule, further processing is the legal remedy for failure to observe a time limit during proceedings before grant, even where the consequence is a partial loss of rights (e.g. loss of priority right). However, the possibility of requesting further processing is ruled out for the periods referred to in Art. 121(1) (see notes 611, 161(2), 21(2), 361(3a) and (3), 40(3), 51(2) to (5), 50(2) and (3), 55, 56, 58, 60, 62a, 62b, 64 and 112(2)).

2.2. Further processing under Art. 121 EPC

An extension can no longer be requested once a period has expired (J 781, OJ 1983, 89). However, Art. 121(1) EPC provides that applicants may request further processing of a European patent application if their application is to be refused, has been refused or is deemed to be withdrawn following failure to reply within a time limit set by the EPO.

In J 3789 (OJ 1993, 201) the Legal Board of Appeal pointed out that the applicants could overcome a loss of rights under Art. 96(3) EPC resulting from the refusal of a request for a time-limit extension by requesting further processing in accordance with Art. 121 EPC. At the same time, they could request reimbursement of the fee for further processing. This secondary request had to be decided on in connection with the final decision. Under Art. 196(3) EPC, the decision on the secondary request could be contested together with the final decision. The appeal could also be confined to contesting the decision on the secondary request.

In J 4792 (OJ 1995, 180) the Legal Board of Appeal stated that further processing under Art. 121 EPC was available only in respect of those time limits the duration of which was determined or set by the EPO. As regards the period of grace pursuant to and not by the EPO, though it was true that the actual date of expiry of the period of time was set by the EPO, since the EPO did not thereby determine the duration of the time limit. The period of grace was therefore not open to further processing.

In a 1892 the examining division had issued a communication pursuant to R. 69(1) EPC after the first communication inviting observations had failed to elicit a response. The representative had thereupon applied for further processing of the application, requesting an extension of the time limit for filing observations concerning the first communication. The omitted act had, however, not been completed within the two-month time limit provided for in Art. 121(2) EPC. The Legal Board of Appeal concluded that where the omitted act consisted in filing a reply in substance to a first communication, it was not a time limit was not equivalent to the act the party in question had proposed performing within the time limit requested.

European Patent Convention

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4 Convention period and office period
The EPC distinguishes two types of periods: convention periods and office periods.

A convention period is a period of which the duration is fixed in the Articles or Rules of the EPC, such as the periods for the payment of filing and search fee (R.38), for the filing of the request for examination (R.70(1)) and for filing the notice of appeal (Art.108). A convention period cannot be extended on request under R.132.

An office period is a period the duration of which is not fixed by the EPC but by the EPO in each specific case as set out in R.132. Examples are the period for responding to a communication of an examiner under Art.94(3) and the period of R.70(2) inviting the applicant to indicate whether he desires to proceed further. An office period may be extended on request under R.132.

5 Non-observance of period
Possible consequences of not observing a time limit or period:

- The application will not be dealt with as a European patent application (Art.90(2)).
 - The application is refused or the right of priority is lost (Art.90(5)).
 - The application is deemed withdrawn (Art.94(2), 94(4)).
 - The patent is revoked (R.82(3)).
- If non-observance leads to a direct loss of rights, the affected party is notified according to R.112(1).

Art. 121 Further processing of the European patent application

1 Remedy

Further processing is the main remedy for non-observance of a time limit vis-à-vis the EPO in the grant procedure and related ex parte appeal proceedings. It allows further processing of the application merely by paying a fee; no written request is necessary. If further processing is possible, re-establishment according to Art.122 is not possible (R.136(3)). Further processing is a reliable remedy. In contrast, re-establishment is not reliable (see notes to Art.122; Spec. Ed. 4 of OJ 2007, Art.121), because it requires the applicant to prove exercise of all due care. A summary of the requirements for further processing are given in the notes to Art.121(2).

Art. 121(1) If an applicant fails to observe a time limit vis-à-vis the European Patent Office, he may request further processing of the European patent application.

1 Applicability

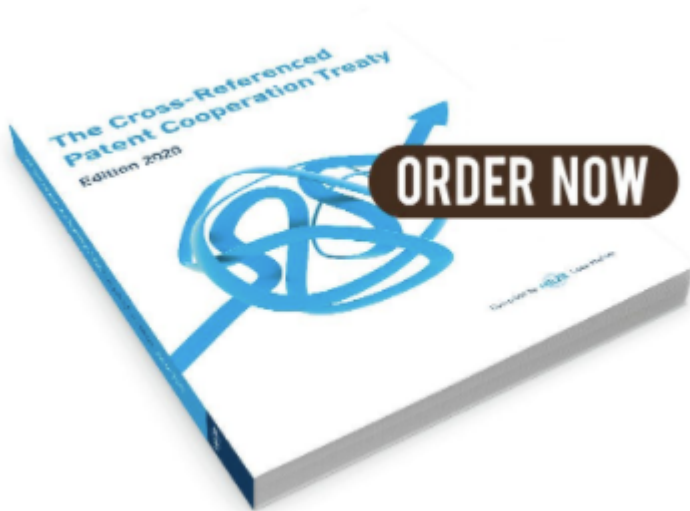
The reference in Art.121(1) to 'applicant' restricts the application of further processing to patent applications; patents are excluded. Hence, further processing can be used in grant proceedings and subsequent ex-parte appeal proceedings but not in opposition proceedings.

Since Art.121(1) allows only the applicant to request further processing, an applicant to whom the application has been transferred may only request further processing after the transfer has been registered at the EPO (R.21(3)).

Further processing is available both for Convention periods, i.e. periods fixed by the EPC, such as the one month period of R.38 for paying the filing and search fee, and for office periods, i.e. periods fixed by the EPO, such as

J21+16
PF+2
J24+16
R.132
R.134
R.136
R.137
R.138
R.139
R.140
R.141
R.142
R.143
R.144
R.145
R.146
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R.191
R.192
R.193
R.194
R.195
R.196
R.197
R.198
R.199
R.200

Your Material - PCT



Article 4 The Request

<i>[IA must contain request]</i>	Art.3(2)
<i>[applicant]</i>	Art.9
<i>[national requirements]</i>	Art.27
<i>[seeking certain kinds of protection]</i>	Art.43
<i>[seeking two kinds of protection]</i>	Art.44
<i>[regional patent treaties]</i>	Art.45
<i>[right to practice before international authorities]</i>	Art.49
<i>[form of request]</i>	R.3
<i>[contents of request]</i>	R.4
<i>[designation of states; kinds of protection; national and regional patents]</i>	R.4.9
<i>[request IA: signature]</i>	R.4.15
<i>[applicant]</i>	R.18
<i>[competent rO]</i>	R.19
<i>[IFD]</i>	R.20
<i>[fees prescribed under Art.4(2):</i>	R.27.1(b)
<i>- international filing fee (R.15.1)</i>	
<i>- and, where required, late payment fee (R.16bis.2)]</i>	
<i>[what are main effects of IA?]</i>	AG-IP 5.003
<i>[what is contents of request?]</i>	AG-IP 5.016-017
<i>[when and how must inventor be identified?]</i>	AG-IP 5.035-036
<i>[how is agent to be appointed?]</i>	AG-IP 5.043
<i>[what is designation of States?]</i>	AG-IP 5.052
<i>[is it possible to choose kind of protection other than patent and if so how is it done?]</i>	AG-IP 5.055-056
<i>[when is office dO?]</i>	AG-NP 2.002-003
<i>[EPO as dO or eO]</i>	Art.153 EPC
	R.3
	R.4
	AG-IP 5.016
	Art.3(2)
	R.4.2
	R.4.9
	AG-IP 5.003
	AG-IP 5.052
	AG-IP 5.055-056
	Art.2(iv)
	Art.45(1)
	R.4.9
	Preamble EPC
	Art.153 EPC
	R.4.9
	[CPC]
	[CH & LI]
	Art.45(2)
	R.4.9
	Art.9
	R.4.1(a)(iii)
	R.4.5, R.4.4
	R.20.1(b)
	R.26.2bis(a)
	R.18.3
	R.19.2

(1) The **request** shall contain:

(i) a **petition** to the effect that the international application be processed according to this Treaty;

(ii) the **designation** of the Contracting State or States in which protection for the invention is desired on the basis of the international application ("designated States");

if for any designated State a **regional patent** is available and the applicant wishes to obtain a regional patent rather than a national patent, the request shall so indicate;

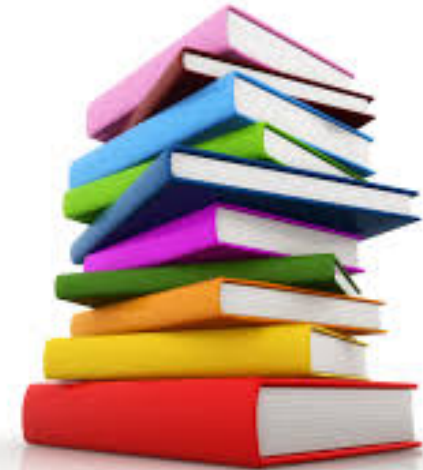
if, under a treaty concerning a regional patent, the **applicant cannot limit his application to certain of the States** party to that treaty, designation of one of those States and the indication of the wish to obtain the regional patent shall be treated as designation of all the States party to that treaty;

if, under the national law of the designated State, the **designation of that State has the effect of an application for a regional patent**, the designation of the said State shall be treated as an indication of the wish to obtain the regional patent;

(iii) the name of and other **prescribed data concerning the applicant**

Your Material – Other Useful Items

- Case Law
- Guidelines
- Protocols (Art 69, Recognition, Privileges, Centralisation, Staff Complement) Some in Visser, otherwise included in the standard EPC
- Schedule of Fees
- ADA and AAD
- Paris Convention - Relevant bits in Visser
- RProc BoA and EBoA
- London Agreement and Contracting States
- National Law relating to EPC
- PCT Applicant's Guide International/National Phase
- Lists of contracting states to WTO, PC, PCT and EPC
- List of International Exhibitions
- Answers to past paper or other practice questions (e.g. Delta Patents)
- EPO official journals
- Ancillary Regulations to the EPC



Exam Procedure

- Lockdown Browser
 - Company IT Administrator likely required
- Log on 1 hour before start
- Duration of papers extended – 6 hours for Paper D
- Once time allowed for a part has elapsed, you can't go back
 - Forget earlier mistakes and move on but note you still need to be logged in 20 minutes before the next part starts
- Can only print calendar
- Seems that no annotation is possible
 - practice note taking in a form that works for you
- D2 now 50 rather than 60 marks

Helpful Links

- [Pete Pollard's blog](#)
- Yellow Sheet – [notes on EPO webinar](#)
- [Delta Patents notes on the session](#)
- [Delta Patents Guidance on D2](#)

Exam Structure

Part	Content	Time	CET time
D1 - 1	Part D1 - three questions (25 points)	90 min	9.30-11.00 hrs
	Break	30 min	11.00-11.30 hrs
D1 - 2	Part D1 - three questions (25 points)	90 min	11.30-13.00 hrs
	Break	45 min	13.00-13.45 hrs
D2	Part D2 (50 points)	3 hours	13.45-16.45 hrs

During part D2, candidates may take unscheduled breaks. Further instructions relating to taking unscheduled breaks will be communicated at a later stage. It should be noted, however, that the exam clock will continue to run during unscheduled breaks, i.e. the examination will not be stopped.

- Print off / write down password for each part of exam before exam starts

- EPO have posted a link for [FAQ](#)
 - This will be continually updated – keep an eye on it!
- EPO have also posted [information](#) on the Wiseflow system for the e-EQE
- 2 mock examinations – second during week of 1 to 5 February under exam conditions
- Only one screen allowed
- The text editor is a simple tool for text entry with basic formatting functions (underlining, bold, italic, bullets and numbering).
- Copy/paste will be possible from any text part of the examination paper – note that this is pdf.

For the 2021 main examination only, candidates' answers will be marked either on the basis of the legal texts and document versions in force on 31 October 2019, or on the basis of those in force on 31 October 2020, depending on which of the two dates would give the candidate the higher mark. In view of this provision and in order to facilitate marking, the Examination Board advises candidates to indicate at the start of their answers to each of the papers A, B, C or D, which of the two dates they will be using. In spite of this indication, if subsequent marking of the answer shows that more marks would have been obtained using the alternative date, the candidate will be awarded the higher mark.

Devise a Plan

- How many days do you have?
- [Delta Patents Paper D Questions](#)
- [Past Paper Compendium](#)
- [EQE Online](#)
 - Daily Paper D Questions



D1 Answer Format

- **yes / no / action**
- **legal basis (precise) – For EPC: Art / Rule / Dec Pres / Case Law (G>J>T) / GL; for PCT: Art / Reg / Applicant's Guide**
- **why this is the legal basis and how it is applied**

- How many minutes per mark – divide your time on each question

- **Read the question carefully – more than once**
 - D1 easier to deal with than D2 on screen – but practice note taking
 - Double check you have copied it correctly

- Use all info in question

D1 Answer Format

- **GENERAL APPROACH**
- * **BECAUSE** *
give **REASONS** – especially when it seems too obvious to mention
- Consider **IMPLICATIONS** of conclusions – take it a step further
- Practical legal advice – appropriate for client

- **STATE THE OBVIOUS**
- **DRAW CONCLUSIONS** – don't just sit on the fence
- ***APPLY*** the law

- e.g. Priority date of X is date because that's filing date of priority app, which is first application within meaning of Art 87(1) EPC

D1 – Low Hanging Fruit

- USE THE DATES – give period + actual deadline (date).
- How calculated, when expires, what needs doing by end of period.
 - If something needs to be filed: what, when, where.
 - If something needs to be paid: how much, when, where.
- CROSS CHECK DATES
- Day of week – always include in answer. Is it excluded e.g. extended?

- Don't calculate fees if not asked for but do calculate time limits

- If q refers to practicing before the EPO then that's EPC and PCT
- If there is no reference to an EP or PCT application, quote PC for priority
- Cite PC for any PCT priority

- If it asks about next few months think renewal fees!

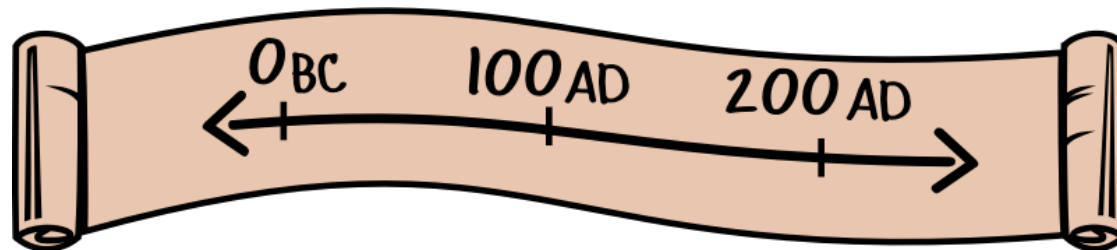
D1 - Low Hanging Fruit

- **Suspect infringement?**
- Cannot enforce patent until granted
- Request early publication
 - provisional protection after publication
- If PCT, request early NPE
- Request accelerated search + prosecution
- Set up watch
- Cross licence? (Be specific)
- No prior art effect until published (i.e. if doesn't publish, won't become prior art)
- Check app pending (renewal fee paid?)
- PCT – entered regional phase in EP?
- Fee
- Was meeting in confidence?
- Check agreements + facts of case
- Prior art search (+reason)
- Register self as agent
- Is licence/assignment registered? If no, register licence/assignment
- Is application/patent entitled to priority? (if yes, if no ...)
- Check contents of priority doc (what subject matter entitled to what priority and why?)
- What happened to priority doc?

- More difficult to take notes – typically 3 pages of info
 - Practice how to make it work for you
 - Work out how to split your time in a way that works for you
- Are there questions in text
- Identify client's wishes
- Post-script?
- Note the date of the client's letter = IMPORTANT (usually date of exam)
- Highlight dates and establish time line
- Legal basis not required for full marks in D2 but can use it for efficiency

D2 - Timeline

- Dates and facts of questions – check for closed days
- Include today
- EPC 2000/1973
- Include future projections of:
 - Priority date/filing date
 - Publication date/grant date/end of opposition period
 - Time limits e.g. to pay fees (designation/examination/renewal), regional phase entry, opposition, divisionals, 6 months Art 55
- Link important facts and dates
- Unmentioned dates may be due imminently or may have expired but FP/RE available



D2 – Table

Method 1:

	App	Inv	Filing Date	Priority Date	Pub	Grant	Entitlement	Invention Claimed and Not Claimed but Disclosed	Eff Date	Prior Art	Patentability (Incl Sufficiency)	Status	Who has what and where	Actions

Method 2:

DATE	EP-1	EP-2
01/01/2018	Pr	
03/04/2018		Pr
01/01/2019	F	
02/04/2019		F
...		

- Can add extra column per invention
- Can annotate applications / inventions based on entitlement

D2 – Likely Issues

- Priority
 - Same applicant? Within 12 months? First application for subject matter?
- Prior art
 - Art. 54(2) EC / Art. 54(3) EPC
 - Public disclosures
 - Non-prejudicial disclosures
- Generic / specific disclosures
- Rescue advice
 - Extensions of time limits
 - Further processing
 - Re-establishment
- Unclaimed subject matter
 - Add claim?
 - Divisional?
- Licensing
 - What? To whom? In which territories? Cross-licence?

1) Think “US and THEM”

US	THEM
What does client do / want	What do they do
Where does client operate	Where do they operate
Etc	Etc

2) Then say, in summary:

Client has the following rights <...> which cover the activities of the competitor in <...> states.

Competitor has the following rights <...> in the following states: <...>. This will prevent the client from doing x,y,z in these states.

...this is the CORE of a DII answer

3) Provide advice:

US:

What does the client have in what territories
What could the client have in what territories
What does the client need to do to strengthen position?
 Accelerate prosecution under PACE
 Amend application to ensure validly granted patent
 Accelerate grant procedure

THEM:

What does the competitor have in what territories
How does this prevent client from carrying out his business
Can these rights be opposed or knocked out?
Can you intervene in an opposition process (if accused of infringement)
Can you get rights revoked in granted territories
3rd party observations?
Do you need to set up a watch on the competitors application(s) to check what has been validated and where – IT MAY BE BETTER TO KEEP QUIET !
Check for corresponding applications in other territories (check register in USJP/etc)
What could the competitor have in what territories

CONCLUDE:

EPC does not provide for infringement so will need to say:
"Both parties should discuss cross-licensing to allow them to continue to operate in their respective business areas."

EASY MARKS FOR STATING THE OBVIOUS + REASON

- No prior art effect until published (i.e. if doesn't publish, won't become prior art)
- PCT – US inventor = applicant if pre-AIA – priority issues?
- PCT – entered regional phase in EP?
- Fee
- Was meeting in confidence?
- Check agreements + facts of case
- Prior art search (+reason)
- Register self as agent
- Is licence/assignment registered? If no, register licence/assignment
- Describe processes carefully e.g. for FP – pay fee (give amount), what action, last date