

Examiners' Report on Paper D/1994

This report is no short-term substitute for consistent preparation, study and training for the examination during the years of experience required for enrolment.

The attached solution to Paper D is much longer than the Committee expects from candidates as it contains very full explanations. Certainly less is expected from an average successful candidate. An actual answer paper by a good candidate is attached for comparison.

Candidates are urged to time themselves, both for the short and long questions, leaving a good margin for review. Then time can be used to read the question carefully and to answer what has been asked. Many errors in candidates' answers would have resulted in the loss (often irreparable) of a client's rights.

In Part II, few took the important point that Grisk had no right to claim DK1 priority, as he was not the applicant in that application. Similarly, many proposed to include Grisk's inventions in EP2 with Smart as sole applicant, claiming EP3 priority without assignment of Grisk's right to priority.

To keep EP3 in force, some failed to realise that a translation into English, French or German is needed. Most appreciated that fees were due, although the time periods involved were often calculated inaccurately.

Few knew that, with Grisk co-operative, there was no need to keep EP3 in force, provided that it was sufficient to establish a valid priority date, e.g. for a PCT application.

Many who recommended claiming priority from DK1 and EP3 did not realise that EP3 contained some Grisk inventions not belonging to Smart and that Grisk was the applicant in EP 3, so both should be applicants in the PCT application.

Candidates seemed unfamiliar with second medical indication claims and many showed an inability to use the "optimal" claims from DK1 as the basis for the claims to be filed with PCT2, whether as such or in combination with EP3.

The greater difficulties arising when Grisk was unco-operative were realised by many, but few proposed effective action. Most recommended entitlement proceedings in Denmark, followed by a request for suspension in the EPO. Few noted that suspension was only effective after publication and that fees and a translation were needed to ensure such publication.

Whilst fees are payable by anyone, filing a translation is a procedural step not available to Smart. Many did not realise that the entitlement would not be for the whole of EP3, but only for the parts owned by Smart.

In assessing whether or not to keep EP3 alive, credit was given for intelligent argument in support of the choice made, whether or not Grisk was co-operative. Thus, it could be argued that EP3 should be allowed to go by default, checking after the final dates for translation and fees, and including Smart's inventions (not Grisk's) in an early PCT (or EP or Danish) application without Grisk's help, relying upon Article 55 (or its equivalent) to deal with disclosure to Albatross. One problem with this would be the possibility of Grisk (or Albatross) filing another application claiming priority from EP3, which could render its contents prior art under Article 54(3) EPC.

The recent Enlarged Board of Appeal's Decision G 3/92 was not available before the examination, so that some argued that maintenance of EP3 was important to have a pending application to be the subject of Article 61(1) proceedings, and discussed the various options open.

The difficulty of including inventions not made by Smart alone in any proposed PCT application was overlooked by many candidates who recommended the inclusion of the contents of EP3 in such PCT cases. Whilst it is conceivable, the likelihood of the Danish Court acting quickly enough to give a decision, even interim, in time to allow a PCT application to be filed before 3 June 1994 (the date to claim DK1 priority) seems to be too small to justify claiming EP3 priority and including its contents without some explanation of what to do if no early decision were to be obtained.

Comparison of the PCT and EP routes was generally poor, although some noted the accelerated prosecution advantage of any EP application. Against this, several noted the ready and quick access to Japan and the USA via PCT. The acceptability of English language applications in Japan was not then available.

PART II

For both situations, it is to be noted that Grisk cannot claim the priority of DK1 for EP3, because Smart is named as applicant in DK1 and he alone has the right under Art. 87(1) EPC.

A i) If it is desired to keep EP3 in force, the following steps should be taken:

- 1) The filing and search fees should be paid. These fees were due, pursuant to Art. 78(2) EPC, within one month of filing, i.e. 01.03.94. They can still be paid, pursuant to Rule 85a(1) EPC within one month of notification by the EPO. Mullet or Grisk should be asked if and when such notification has been received, as it is likely that the one month has not expired. Because EP3 was filed in Danish, EP3 is entitled to a 20% reduction of the filing fee (Rule 6(3) EPC, Art. 12 Rules relating to Fees). The fees must be paid with a surcharge of 50% (Art. 2 No.3b Rules relating to Fees).
- 2) The designation fees should be paid. These fees are not due until twelve months after the date of priority (Art. 79(2) EPC), that is 03.06.94, the anniversary of the filing of DK1.
- 3) A translation of the Danish language documents into an official language of the EPO (EN, FR, or DE) pursuant to Art. 14(2) EPC must be filed at the EPO within three months of the filing date (Rule 6(1) EPC). As the filing date was 01.02.94, the three months end on 01.05.94, which is no later than thirteen months after the date of priority (03.06.93). Because 01.05.94 is a Sunday, the deadline date for filing the translation is 02.05.94 under Rule 85(1) EPC.

The translation must be filed and the fees paid before the expiry of the stated deadlines. If the grace period for paying the filing and search fees has expired and the application is deemed to have been withdrawn under Art. 90(3) EPC, but further processing is possible under Art. 121 EPC, provided that the fees and surcharge are paid within the time limit. The provisions of Art. 122 EPC are not available in view of Art. 122(5) EPC.

As Grisk was not entitled to claim priority from DK1, it would be advisable to abandon the priority claim at once. This would eliminate the need to provide a certified copy of DK1 and a translation thereof. As you were inventor of DK1 and the joint inventor of process B, the designation of inventor should be corrected. With the consent of Grisk, Smart should be added as co-applicant.

A ii) Probably not.

Arguments in favour of maintaining EP3 would be that it has been disclosed to Albatross (although this may have been in confidence); that there is the possibility that a third party may be working in the field and seeking to obtain patents for the same invention; and that it is the first patent application with disclosure of Grisk's inventions and Grisk and Smart's joint inventions. Thus, it is important to establish the filing date as the priority date for further applications in Europe and elsewhere. Provided EP3 has a valid filing date, this priority can be claimed under Art. 4(A)(3) of the Paris Convention and Art. 87(2) and 87(3) EPC, whatever happens to EP3. The minimum requirements for establishing a filing date for EP3 under Art. 80 EPC are: (a) an indication that a patent is sought, (b) the designation of at least one Contracting State, (c) the

identity of the applicant, and (d) a description and at least one claim in one of the languages permitted under Art. 14(1) and 14(2) EPC. If Grisk and Mullet used a standard form of request when filing EP3, which must be checked, all these requirements were satisfied and EP3 has a valid filing date of 01.02.94. EP3 need not be kept alive so long as it is used as the basis for priority claims in later patent applications.

Aiii) Yes; upon the assumption that Smart and Grisk are happy to have patent applications in which they are joint applicants and that each will own his own inventions, leaving a sorting out until prosecution results in the possible need and opportunity to file divisional applications. This is because there are inventions not disclosed or covered in DK1 and EP3 and because protection is wanted outside EP countries.

a) Although a PCT application should be filed, it would not be exactly as planned for PCT2, but would include all the related inventions of Smart, Grisk and the joint inventions of Smart and Grisk. This will be referred to as PCT4. Because it will include inventions not previously disclosed in patent applications, it must be filed as soon as possible and claim priority from both patent applications including relevant inventions, i.e. DK1 and EP3. As Smart has planned to designate all PCT Contracting States, i.e. including USA and Europe, this would be done.

b) PCT4 should name Smart and Grisk as joint applicants and joint inventors, because PCT4 will include claims (see d) whose owners are indicated, because priority from DK1 and EP3 is to be claimed, and because inventorship is important in USA.

c) As noted under a) above, PCT4 should be filed as soon as possible and before 03.06.94 with a claim to priority from DK1 (03.06.93) and EP3 (01.02.94). As both were filed in Danish, it may be quickest to use the Danish language when filing.

d) PCT4 should have the following claims:

Product X (S)

Product Y, mixture of X and Z (G)

Product Z in the form suitable for administration to humans and animals (G), because Product Z, per se, cannot be claimed being not novel in view of the Danish Journal 1992

Product X for use as a medicament (S)

Product Y for use as a medicament (G)

Product Z for use as a medicament (G)

Pharmaceutical composition comprising X (S)

Pharmaceutical composition comprising Y (G)

Pharmaceutical composition comprising Z (G)

Use of product X for the production of a hypotensive agent (S)

Use of product Y for the production of a hypotensive agent (G)

Use of product Z for the production of a hypotensive agent (G)

Use of product X for the production of an anti-herpes virus agent (S)

Use of product X for the production of an anti-measles and anti-chicken pox virus agent (S)

Use of product X for the production of an anti-viral agent (S)

Use of product Y for the production of an anti-viral agent (S & G)

Use of product Y for the production of an anti-herpes virus agent (S & G)

Use of product Y for the production of an anti-measles and anti-chicken pox virus agent (S & G)

Process A (S)

Process B (S)

Process C (G)

Process for the separation of X and Z from mixture Y (G)

If Smart and Grisk agree that they are likely to cover working inventions, the following claims would be added:

Use of product Z for the production of an anti-viral agent (S & G)

Use of product Z for the production of an anti-herpes virus agent (S & G)

Use of product Z for the production of an anti-measles and anti-chicken pox virus agent (S & G)

(Although optimal for protection, as stated in the Note to candidates on page 2, method of treatment claims could be added, as being allowable in U.S.A.).

- B i) Because Grisk has refused to co-operate, it has to be assumed that he may continue with EP3 or an application based thereon. As Smart owns and invented some parts of this, the first legal step to be taken is to take advantage of Art. 5 of the Protocol on Recognition and apply to the Maritime and Commercial Court in Copenhagen for a declaration of ownership of those parts of EP3 which comprise the contents of DK1 and which disclose and claim process B. If possible, an injunction should be sought requiring Grisk to take all necessary steps to maintain EP3 in force until a final decision is obtained. This is because, although Smart can pay the fees (Legal Advice 6/1991), only Grisk or Mullet can carry out procedural steps, such as filing a translation, withdrawing the application or priority claim. Immediately following the instigation of entitlement proceedings in Copenhagen, suspension of the patent application proceedings should be requested in accordance with Rule 13 EPC so that Grisk cannot wilfully withdrawn the application EP3 (Rule 14 EPC). Such proceedings cannot, however, be stayed until publication which is to be expected in December 1994 (last sentence of Rule 13(1) EPC).

- B ii) Yes.

If ownership of those portions of EP3 which disclose and claim process B and which disclose the contents of DK1 is adjudged to be that of Smart quickly, then under Art. 61(1) EPC, Smart may choose between prosecuting the application EP3 as his own application, filing a new application, and asking for the application to be refused. As ownership will only be of part of EP3, the second course of action is probably to be expected with consequential amendment of EP3, although the first course could be followed allowing Grisk to file a divisional application. Then PCT2 could be filed as planned but claiming also priority from EP3, that is before 03.06.94

If a final decision is not obtained until after this date, then Smart must continue with DK1 and its derivatives, and EP3 separately and hope to obtain a decision in good time to be able to file corresponding applications before 01.02.95.

If it is not possible to keep EP3 in force because an injunction is not issued in time and, for example, the translation is not filed, then the subject matter of EP3 belonging to Smart can be claimed in PCT2 as planned. The disclosure to Albatross, if it was not confidential, is a non-prejudicial disclosure under Art. 55 EPC, because Grisk was bound by agreement not to disclose.

- Biii) It is recommended to file PCT2 as planned as soon as possible, claiming priority from DK1, and before 03.06.94.

EP3 filed by Grisk has the earliest priority date for the invention of process B and could be cited against a later EP application by Smart under Art. 54(3), if Smart is unable to claim priority of EP3. However, Art. 55 provides some protection for Smart if he is unable to get a favourable decision from the Copenhagen Court in time. If a favourable decision is obtained in time, then priority from EP3 should be claimed.

Smart would be the sole applicant, because Grisk refuses to co-operate, but Grisk should sign the application form because he is a joint inventor with Smart and thus needs to be a joint applicant for USA. If he refuses to do this, evidence will be needed of his non-co-operation to overcome the lack of signature (Rule 4.15(b) PCT). Grisk could be required to sign by a Court injunction, if this can be obtained in time.

- B iv) The advantage of filing a European patent application (EP5) in place of PCT2 is that Grisk's signature is not required to request a European patent, nor for any other documents filed at the EPO. Accordingly, Grisk's non-co-operation is unimportant as far as the EP application is concerned. Grisk must be named as inventor for any invention of which he is the true inventor or joint inventor. Another advantage of the EP route is that Smart may request accelerated prosecution of his application to obtain early grant of an EP patent.

The main disadvantages of using the European route directly are that the EP fees must be paid up at once, and that further applications must be filed if protection is to be obtained in USA and elsewhere.

The PCT route gives Smart more time to evaluate the inventions before the major cost time of the EP regional phase. If Smart requires rapid grant, Chapter II may be used in combination with a request for accelerated prosecution.

- a) EP5 should name Smart as sole applicant. PCT2 should name Smart as sole applicant for all designated states except USA. For USA, Smart and Grisk must be named as joint applicants because they are joint inventors.
- b) Priority from DK1 should be claimed with filing of PCT2 or EP5 before 03.06.94. Priority from EP3 should also be claimed, if the Danish Court has decided in time to assign the part of EP3 disclosing process B to Smart.
- c) PCT2 or EP5 should include all those claims listed under Aiii(d) above which are owned by Smart alone. The description should include all the matter owned solely by Smart, taking great care that none of Grisk's information is included.

EXAMINATION COMMITTEE III

Candidate's answer-paper No.

Report by examiner No.

PART II

Parts	Maximum possible	Individual marks awarded	Where grades awarded are not identical	
			Revision of marks/grade (if any)	Remarks*
A i	9			
A ii	7			
A iii	10			
B i	7			
B ii	5			
B iii	6,5 (5,5)			
B iv	5,5 (6,5)			
TOTAL PART II	50			
TOTAL PART I	50			
TOTAL PARTS I + II	100			
CORRESPONDING GRADE				

Translation of marks into grades

%	Grade
0 - 35	7
35,5 - 45	6
45,5 - 55	5
55,5 - 65	4
65,5 - 75	3
75,5 - 85	2
85,5 - 100	1

* to be filled in if both the following requirements are fulfilled:

- (a) the grades awarded by the two individual examiners before their discussion differ by two grades or more;
(b) the marks awarded by at least one of the two individual examiners have been changed during their discussion.
If remarks are to be filled in, they should briefly explain **why** the examiner has changed his marks.