

I would advise my client on the basis of the following memorandum:

Case A1:

Reckitt (WR) has been telling people about invention on ABS (invention A).

Advise: file a European application as soon as possible. Potential claims are to the ABS itself and its use in racing cars and in domestic cars.

Relevant potential prior art:

- 1) Secret testing by Overtake and her team - secret, $\therefore$ not "made available to the public" as required by Art 54(2) EPC and $\therefore$ not relevant.
- 2) Disclosures by WR - firstly, his possession of the ABS box may not be such as to make a disclosure of the invention. The box alone may not "make available" information to the public, if for instance it is not possible to establish how it works. WR is described as "useless" and may thus not be able to provide further enlightenment. Secondly, even if the disclosure is "enabling", it may be possible to disregard it under Art 55(1)(a), as being as a result of an "evident abuse" in relation to the applicant (Overtake). We should have a good case for arguing this, as tests were secret and WR's contract probably bound him to secrecy.
 $\therefore$ Any disclosures by WR before filing should not be relevant.

Need to file within 6 mth of disclosure, to benefit from grace period in Art 55(1). $\therefore$ Need to file in EPO before end of April 1997 (find out exact date of accident from Overtake - earliest possible date of disclosure by WR).

USA: File in USA as soon as possible also.

Under 35 USC 102(a), non-written disclosures outside USA are not relevant to validity of a US patent.

$\therefore$ Disclosures by WR will not count against a US patent.

Can file provisional (35USCS111) application or regular. Both give a US filing date. Provisional is cheaper, but prosecution of regular begins sooner and will need to convert provisional to regular with 12 mth anyway.

Case A2:

(File in USA anyway, as above).

File our own application in EPO in the name of Overtake, as soon as possible - thus ensuring the invention and its advantages and preferred embodiments are described in optimum manner by us, as instructed by the inventor.

If WR or Pastawinna (PW) have already filed we can take action as below but we may also, by filing application in name of Overtake, be able to gain protection for things they have not described. Any application of theirs is highly unlikely to have been published (even if filed in November, not due until May 1998 under Art 93(1) EPC) and thus is relevant against our application as a novelty reference only, under Art 54(3) EPC, for commonly designated EPC states.

After filing in name of Overtake, find out if WR or PW have filed. Could approach PW - said to be "honorable" - if they find out true situation, may offer to assign.

Need really to wait for publication to establish whether application has been filed, if don't find out by other means.

Can then bring entitlement proceedings. Under Art 60(1) EPC the person entitled to a European patent is the inventor (Overtake) or her successor in title.

Country in which proceedings are to be brought is governed by Protocol on Recognition. Under Art 2 of the Protocol, the residence or place of business of the applicant determines where proceedings are brought. ∴ if PW is applicant, bring proceedings in Italy. If WR is applicant, bring proceedings in UK (check this is where he lives).

If this does not work (decision is not in Overtake's favour), keep watch on PW/WR application and file opposition once granted. Can also file Art 115 observations during prosecution.

After final decision (hopefully in Overtake's favour) she may take action under Art 61(1) EPC within 3 months of decision becoming final.

Options are: Art 61(1)(a): Continue with application in name of Overtake - good option if PW/WR application is in a good state currently.

Ar. 61(1)(b): file a new application - good option if PW/WR application originally contained useful information but we would like to, eg change the claims to unsearched or previously unclaimed matter.

Art 61(1)(c): ask for application to be refused - good option if it contains nothing more than Overtake's application and was not filed sufficiently earlier than it to cut out any significant prior art.

Case B:

Filing in USA: Case B was filed 1 Nov 94 and thus published on or just after 1 May 1996 (Art 93(1) EPC). Under 35USCS102(b) publications by the inventor are disregarded if made less than 1 yr before the US filing date.

Can file regular or provisional (both give US filing date for S102(b) purposes) paying necessary filing fees. Provisional is cheaper but regular gets under way for prosecution earlier.

Not too late, have until approx. 1 May 97 (1 yr from publication of Case B).

European application:

Parent must be kept alive 1) to safeguard Dipstick's (D's) rights and 2) to enable filing of divisional applications, for which parent application must be pending - see R25(1) and Guidelines A-IV, 1.1.3.

Rule 51(4) communication sent 1 Nov 96, deemed received under R78(3) on 11 Nov 96. Time limit expired 11 Mar 97 (calculated under R 83(4)). ∴ application will be refused under R51(5).

Time limit has been set by EPO, ∴ further processing is available under Art 121, and loss of rights will be retracted.

∴ We should request further processing under Art 121(1) and pay the fee under Art 121(2). We do not need to wait for the refusal itself (see Legal Advice 13/82). When that arrives, we have 2 months from date of notification.

Must complete omitted act, ie approve text subject to the amendments we want (claims only to Dipstick's invention - injection pump). We also need to amend the inventorship as a result, under R19(1). We need Overtake's written consent to present to EPO.

State we are filing a divisional application with our text approval. If by some chance the divisional arrives later, J 36/92 may help.

Renewal fees: renewal fee for 3rd yr was due on 30 Nov 96 under R37(1), the 2nd anniversary being 1 Nov 96. Grace period under Art 86(2) ends 31 May 97 (see J 4/91), extended to next working day, Mon 2 June 97 for payment. ∴ need to pay with surcharge by then. Surcharge is 10% of renewal fee - Art 2.5 Rfees.

Divisional

Should be able to file before text approval and request for further processing, because that should deem parent case always to have been in force. Perhaps best to file both on same day.

Need to pay: back renewal fees (for 3rd yr), due on filing of divisional but payable up to 4 mth from filing under R37(3).

Filing, search, designation fees: due 1 mth from filing - R25(2). Search fee may be refunded under Rfees Art 10(3).

Any excess claims fees due 1 mth from filing - R31(1).

Include whole description of parent to ensure maximum potential material for amendments - divisional may not extend beyond content of parent - Art 76(1) or beyond its own content as filed - Art 123(2).

It appears that Overtake's invention can be worked using known fuel injection pumps and does not require D's new pump. Advisable to make reference to parent, say fuel injection pump of parent can be used in fuel injection system of divisional.

Second divisional may need to be filed - see Case C below.

Other fees: Grant and printing fees under R51(6) may become due on parent, depending on when EPO issues communication.

Case C

US designation: Filing of demand for international preliminary examination has extended international phase. ∴ Need to enter USA 30 mth from priority under Art 39(1)(a) PCT. This is 20 Mar 97 (tomorrow).

No translation is needed - application is in English already.

Basic national fee must be paid by 30 mth date. ∴ fax to US agent and ask them to pay the fee immediately.

Inventor's declaration can be filed late with fee for late filing, as can any excess claims fees.

Later

Make preliminary amendment to claim the shoe itself and use of Damenill for shoe soles (reasons given below). File information disclosure statement (must disclose publication of Case B and commercial availability of Damenill, since we know these exist and are relevant).

EP Designation

Under R104b(1) entry into regional phase due 31 mth from priority, ie 20 Apr 97.

No translation needed under R104b(I)(a) ∴ application is in English.

Fees to be paid by 20 Apr 97 (extended under R. 85(1) to Monday 21 Apr 97): national basic fee (R104b(1)(b)(i)), designation fees (R104b(1)(b)(ii)), any excess claims fees (R104b(1)(b)(iii)), search fee (R104b(1)(c)) - probably not payable, because ISA was probably EPO (UK attorney would have filed in GB or at EPO as Receiving Office).

Renewal fees under R104b(1)(e) to be paid for 3rd yr (2nd anniversary was 20 Sep 96) by 31 mth date.

Reduced examination fee (assuming EPO was International Preliminary Examining Authority).

What to claim in which application

Disclosures of Damenill and its properties are:

- a) Commercial availability of product and use as shock absorbent. This leads to availability of composition if analysable without undue burden (G 1/92). This appears to be available before filing of Cases B and C.
- b) Properties, Compositions) in Case B (filed 1 Nov 94)
Use for improved fuel and heat resistance)
- c) Use for racing-shoe soles - Case C (filed 1 Nov 94) (it appears that this use was not disclosed in Case B).
Disclosures in Case B - Case C also.

In Case C, claim:

- (i) Damenill composition (if not available under a) above $\therefore$ not analysable).
- (ii) Use for improved fuel and heat resistant articles.
- (iii) Would appear inventive over prior art (a). Only known use was as shock absorbent, no need for fuel and heat resistance.

In Case C, also claim:

- (iii) racing shoe having Damenill sole.
- (iv) use of Damenill for soles of racing shoes.

(iii) and (iv) are certainly novel over prior art a). Case B was filed after Case C and is thus not relevant. (iii) and (iv) appear to be inventive over even (i) and (ii), since the applicability in a racing shoe is said to be "surprising".

May want to claim use of Damenill in the systems described in Case B (parent and divisional), for which there appears to be basis. Can also file a divisional application on this if it is important enough in its own right.

Include claims to (i)-(iv) in US ex-PCT application derived from case C.

Can include claims to use of Damenill in fuel injection system in US Case B if desired.

Cases B & C

Could possibly ask for interruption of proceedings under R90(1)(a), on ground that Overtake was legally incapacitated by accident, since EPC does not define this. Time limits such as R51(4) reply for case B would then not have expired. However, this looks unlikely to be agreed to by EPO, since there was another non-incapacitated applicant (D). Legal incapacity may only cover serious mental illness as discussed in eg J 49/92. Safer to take steps discussed above anyway.

* Case A2:

When proceedings have been brought, ask for suspension of proceedings on WR/PW application under R13(1). WR/PW cannot then withdraw application - R14. Cannot do this before publication. Check renewals are still being paid (although under G 3/92) application does not need to be pending for Art 61(1)(b) to keep all three Art 61(1) options open.