

Examiners' Report on Paper D

General

It is necessary to repeat, what is said almost every year, that candidates should use up-to-date text books and revision material. It was clear from candidates' papers that many were using old copies of the EPC and did not have access to, or read, the EPO Official Journals covering the most recent years and, in particular, the year preceding that in which the examination was held. Thus, a surprising number were, for example, unaware of the changes to the period for payment of designation fees.

In other cases only a small number of the questions were answered very accurately, giving the impression that the answers had been prepared wholly by reference to the books during the exam. Whilst answers to Part I can be obtained in this way, a candidate is unlikely to have sufficient time to look everything up and should be familiar enough with the EPC and PCT to need only some confirmatory checks in the books. Even then, it is necessary to be familiar enough with the texts so as to know quickly where to look since candidates must give reasons for or the basis for their answers.

Again there were candidates who missed out parts of questions, apparently carelessly or inadvertently. Candidates should read the questions carefully and deal with all the specific points they are asked to address. Also, they should accept what they are told are the facts of a situation and not spend time and effort surmising that these facts may be incorrect. Despite being told that US-MAG had no details of room temperature superconductors some candidates spent a great deal of effort discussing what could be done if somewhere in the specification there was such information.

It has been reported that some candidates were surprised at the number of PCT questions. They should really be prepared for this, especially now that more than 50% of European applications are filed by the PCT route.

As a final general remark, candidates should remember the need to give the basis for any answer. A simple yes or no is hardly ever likely to be an adequate treatment of the subject.

Part II

It should be noted that the French translation of this part was inadvertently different from both the German and English texts; this difference was taken into account in the marking of the papers.

As a general point, candidates should keep in mind that they are advising their client and not spend time advising how the competitor can improve their position unless this has relevance to their client's necessary actions. They are expected to put forward practical suggestions as to what their client should, or should not, do to improve their position and not simply list a multiplicity of suggestions and leave it to the Examiner (i.e. their client) to decide.

- A. The candidates were asked to advise on what actions needed to be taken to file or maintain the applications in good order and there were easy marks to be picked up for answering this fully. However, only very few achieved good marks with full answers. Most ignored priority documents and fees and failed to check exactly what had been done already.

It was hoped that candidates would pick up that the disclosure in US-MAG was arguably insufficient since it did not contain the necessary information to make room temperature superconductors. An unexpectedly large number of candidates failed to notice this point. Of those who did note the problem, some did not consider the effect on the priority claim and others then simply thought this meant there was no possible way of obtaining protection for the invention of US-MAG and decided to abandon anything related to this application.

- B. Inability to handle priority questions also caused problems in this section. Many overlooked that US-SUPER had the same crystal structure as that of US3 - even if not explicitly disclosed - and that, therefore, US3 was not the earliest application for this invention. Of those who did notice this point, some decided US3 could not be used as a priority at all, overlooking the content that first appeared in that application.

The matter of the Internet disclosure was handled in a very varied way. Many candidates simply ignored it altogether. Others wrote extensively on Art.55(1), before concluding it was irrelevant because of the early priority dates of US-SUPER and US-MAG, and many again overlooked its public disclosure of the crystal structure and that it was prior art as regards US3.

Only a small number considered the prior art effect of the Internet disclosure and of any European application based on PCT-SUPER with regard to a European patent application claiming priority only from US3.

Only some suggested the filing of a new application (EP3/PCT3), at the latest by 04.05.1998, claiming the priorities of US-SUPER, (PCT-SUPER) and US3. A larger number suggested the Art.55(1)(a) EPC route of filing within six months of the Internet disclosure - again by 04.05.1998 - and having the more difficult task of arguing that the disclosure was an evident abuse.

- C. Very few actually discussed completely, as was asked, the effect the invention of FR1 could have on the patenting of PCT-SUPER, PCT-MAG and US3. With regard to exploitation of those inventions, the majority ignored the fact that FR1 could found a priority claim and that corresponding applications may be faced elsewhere. As a result, only France was considered as a problem with lots of discussion of the national application not being prior art citable in European prosecution.

Those who did notice often realised that Filarus SA would need a licence so that a cross-licence situation was possible. Others, however, simply suggested manufacture and sale would have to be avoided in the countries in which patents corresponding to FR1 had been filed.

- D. Again the possibility of US4 being used as a priority for damaging corresponding applications was overlooked by the majority. Many discussed interference being set up in the US but the majority seemed to consider wrongly that US4 could be an invalidating citation against PCT-MAG.

Few discussed the exploitation problems if Dr. Ghosh had filed widely based on US4 since it had the earliest priority date..

- E. Even fewer came up with any suggestions of improving the position. Simple suggestions such as rapid prosecution and designating as many states as possible were rarely made. A number did suggest registering the licences which would improve the position for infringement actions and one or two suggested filing an application combining some or all available priorities without indicating why or for what benefit.

EXAMINATION COMMITTEE III

Candidate No.

Paper D Schedule of marks

Question	Maximum Possible	Marks awarded		Revision of mark/grade (if any)		Marking by further examiners	
		Exr	Exr	Exr	Exr	Exr	Exr

PART I

1	3						
2	5						
3	6						
4	4						
5	5						
6	6						
7	8						
8	3						
9	5						
Total Part I		45					

PART II

A	12.5						
B	17						
C	10						
D	9.5						
E	6						
Total Part II		55					

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

Total Parts I + II	100						
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Corresponding Grade							
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Remarks (if any)

Grade recommended to Board _____

Munich, 10 September 1998

J. L. Muir

J. Muir - Chairman of Examination Committee III