
Time Line

15 August 1998	-	B PCT Priority Date
July 1998	-	AFR Filed
Aug 1998	-	B PCT Filing Date
Jan 1999	-	Intl. Conf. disclosure
Feb 99	-	Publn. of B PCT
March 99	-	AI-EP
15 March 1999	-	Demand on B-PCT due

1) Can AI-EP be continued with?

Yes! Although, I would advise against doing so. AI-EP was filed last week in Spanish and no fees were paid. Art. 80 EPC indicates the requirements to obtain a filing date.

- (i) indication that patent is sought
- (ii) at least one designated state
- (iii) applicant's identity
- (iv) description + claims in an allowable language.

By Art. 14(2) EPC, a legal person who is a Spanish national i.e. Company Y may file in an Official language of that state i.e. Spanish.

Thus assuming all the other requirements of Art. 80 EPC are met, AI-EP will be awarded a filing date.

In order to maintain AI-EP in force, a translation from ES into an EPO Official language must be filed within 3 mths after filing (Rule 6(1) EPC).

Also, by Art. 78(2) filing and search fees will be due within 1 mth from filing along with any excess claims fees by Rule 31(1).

However, AI-EP cannot validly claim priority from A-RR since A-FR was filed in the name of X. By Art. 87(1) EPC, a person who has filed an application for a patent in a Paris Convention State (FR is a PC state) shall enjoy for the purposes of filing an EP application in respect of the same invention, a right of priority during a period of 12 mths from the first filing. i.e. The right of priority from A-FR belongs to X and not Y, hence the priority claim is invalid.

It is noted that Mr Goya of Y was working with X when A-FR's spray nozzle system was devised. Hence there may be a question mark over the entitlement of X to file A-FR in its name alone. If Mr Goya was employed by Y when temporarily working for X then it may be that Y should be a co-applicant on A-FR. It is assumed however that Mr Goya's rights were safely owned by X.

It is also not possible to transfer a part of a patent to X other than through a Art. 61 application or Divisional application. The designation of inventor may not need correcting since the spray nozzle system seems to be derived by Goya alone.

Also, it is not possible to add the cylinder coating process described in A-Fr to AI-EP since this would contravene Art. 123 (2) EPC.

However, assuming AI-EP was granted a filing date then AI-EPI may serve to establish a priority date. By Art. 4A (3) PC in conjunction with Art. 4C (2) PC, any filing equivalent to a national filing gives rise to a priority right and a regular filing is one which is awarded a priority date whatever its fate.

Hence I would recommend allowing AI-EP to lapse, but using it as a priority application.

It should be noted that an EP application awarded a filing date is, in the designated states, equivalent to a regular national filing (Art. 66 EPC); it is considered regularly filed for that state and can give rise to a priority right.

In order to protect the coating and spraying inventions to their fullest degree, I would recommend filing a PCT application (or perhaps two applications - see later), claiming priority from both A-FR and AI-EP, assuming this was granted a filing date.

The PCT application must be filed within 12 mths from the earliest priority date = July 98 i.e. file by July 99, although if AI-EPI did not get a filing date the new PCT must be filed as soon as possible.

The applicants for the PCT should be X and Y and inventors Goya + Mr Renoir must be named as applicants for the US.

The applicants should have claims to all the features of the apparatus and processes described in both A-FR and AI-EP since the prior art significance of B-PCT is not yet known.

The 15/3/99 deadline on the B-PCT is the Art. 39 PCT deadline by which a Demand for Examination under Art. 31 PCT must be filed in order to delay entry into the national phase until 30 mths.

This deadline has been missed hence National phases are due by Art. 22 (1) PCT at 20 months. The EPO has used the provisions of Art. 22 (2) PCT to extend this deadline to 21 mths from priority. This deadline is therefore 15 May 1999 ⇒ R85 17 May 1999.

Hence if B-PCT is to be continued in Europe, the Nat. phase must be entered by 17 May 1999, the requisite fees paid and a translation from RU into EN/FR/DE is required (see Rule 104b (1a)).

If Moscow Cardboard Institute (MCI) fail to take these steps, the B-PCT will not constitute prior art in Europe for the material in A-FR.

The B-PCT was filed before but published after the priority date of A-FR. Hence, B-PCT is prior art for Art. 54 (3) EPC only. PCT's only become Art. 54 (3) prior art when the national fee is paid, the translation is filed at the EPO (Art. 158 EPC) and only then are citable in the designated states for which designation fees are paid.

Hence, if B-PCT fails to enter the EPO regional phase, the cylinder coating process may still be claimed, along with everything else in A-FR.

Even if B-PCT does validly enter the regional phase, it may be citable in certain states only and then only for novelty (Art. 54 (4) + Art. 56 EPC). Art. 56 EPC confirms that Art. 54 (3) documents do not constitute prior art for inventive step purposes.

Thus, even in states where B-PCT is prior art it is only the cylinder coating process which is novelty destroyed not the apparatus. The apparatus in A-FR is almost the same but not identical i.e. The apparatus is novel!

Hence, the coating inventions must all be claimed in the new PCT filing since B-PCT is still an unknown quantity.

As to whether a licence will be necessary, clearly it is too early to say with any certainty but if PCT-B does not enter the European Regional Phase then no licence will be required.

If B-PCT does enter the reg. phase then a licence will be required in the states they designate and pay for to allow X to use the cylinder coating process.

Having said that, I would check that the B-PCT was entitled to its priority date. If it is not, the filing date of B-PCT becomes its priority = Aug 98 which is after the priority date of A-FR. In this case, B-PCT is not a worry in any way to the material in A-FR.

If MCI have too few funds available to maintain B-PCT they may well be prepared to sell it to you. This would be an expensive route since if you wished to proceed with B-PCT a translation from RU in EN would be required for the EPO and the US. There are also many fees to pay. However, if this case is of large commercial importance you may wish to consider this option.

If B-PCT is continued by MCI there arises the possibility of cross-licensing. Is X's coating apparatus better than the one in B-PCT? If so, could this be the basis for a cross-license.

The new material in AI-EP needs to be novel and inventive over the disclosure in both B-PCT and the disclosure at the fair in Monaco. Art. 54 confirms the state of the art includes oral/written disclosure irrespective of language. B-PCT concerns only cylinder coating process and hence is not relevant to the spray techniques of A-FR and AI-EPI.

A-FR comprised an enabling description of an apparatus and a process using spray nozzles. This discussion pre-dates the January conference.

At the conference, the spraying apparatus of AI-EP was shown but not the vacuum box. The oral disclosure did not give information about the improved apparatus. The fact that a written disclosure has yet to be submitted by Goya is irrelevant, the disclosure at the fair constitutes prior art in Europe.

I would also like to know specifically the differences between the spraying machine at the conference and the general disclosure in A-FR. Would the differences have been visible to the viewer and could the skilled artisan from viewing the machine at the conference have devised a machine himself? i.e. was the disclosure enabling.

I assume the multiple spray nozzles was disclosed at the conference but not in A-FR. However, the addition of the vacuum box results in surprising improvements in the penetration of the impregnating agent and this is patentable over the Conference disclosure.

Hence the new PCT should include a general claim to spraying + apparatus derived from A-FR and claim to the multiple bars in combination with the vacuum box. This is dependent on the actual disclosure of the conference.

The PCT may well be deemed to lack unity but such problems may be dealt with later by filing divisionals or alternatively 2 applications may be filed

- A) to cylinder coating process and apparatus
- B) to spraying and apparatus.

In this case

- A) claims priority from A-FR and is in name of X
- B) claims priority from both A-FR and AI-EP and is in names of X and Y.

Rule 12 PCT governs languages of filing. Although a PCT may be filed in any language, in this case I would recommend filing in FR since A-FR is in FR and FR is a language of the EPO. The PCT may conveniently be filed at the EPO.

I have suggested the filing of PCT applications since they minimise cost up front whilst covering many potential territories. If you are interested in EP only, then Europeans can of course be filed.

- B) EP-ZI was revoked after Oral Proceedings on 20/1/99. By Rule 68(1) EPC, this decision is notified to the parties in writing.

Art. 106 indicates that a decision of the Opposition Division is appealable.

Art. 107 indicates that any party adversely affected by a decision may appeal. Z is clearly adversely affected. Art. 108 indicates that an appeal must be filed in writing at the EPO within 2 mths after the date of notification of the decision appealed from (i.e. 2 mths from the Rule 68(1) notification) + the fee paid. The decision contested and the extent to which amendment or cancellation of the decision is requested must be identified.

The notification would have been sent to Z in Belgium and therefore it would have been deemed received 10 days later by Rule 78(3). Thus, even if the Rule 68(1) Communication was sent on

	Rule 78(3)	2 months	
20/1/99	⇒ 30/1/99	⇒	30/3/99

∴ An appeal can still be requested.

The grounds for appeal need not be filed until 4 mths from the decision notification (Art. 108), hence Z can file the Notice of Appeal now and pay the fee and follow this later with the reasoned grounds.

Z wants to obtain a claim set in line with those granted not the narrower amended form submitted during opposition proceedings. Art. 123(3) EPC prevents the broadening of a claim set after to grant but here the granted claims covered composition ZI so Art. 123(3) is not prejudiced.

T840/93 and G9/91 comment that amended claims submitted during appeal should be based on those considered during Opposition. G9/92 and G4/93 discussed the reinstatement of claims following an appeal by an opponent after the patent had been maintained in amended form. Although in this case the proprietor is not allowed to reinstate claim Z can since the patent has not been maintained and it is Z i.e. the proprietor that is appealing. T123/85 quotes that by offering to limit the patentee does NOT irrevocably surrender that part of the patent. T217/90 confirmed this.

Hence, Z may appeal to reinstate claims to the ZI composition if the new arguments and evidence are deemed persuasive. By T258/84 the new evidence may force the appeal board to remit the case to the department of 1st instance.

Damages from M would need to be obtained through infringement proceedings in national courts.

- C) In order to minimise costs, I would recommend filing a PCT application.

BE-Z2 was filed in 4/98 ∴ By Art. 8 PCT, the PCT is bound by the provisions of the Paris Convention and the PCT filing is therefore due by 12 mths Art. 4C (1) PC.

The PCT allows for different applicants for different states (Rule 4.5 (d)) and the PCT must have an applicant who is a national or resident of a PCT Contracting state. Since both FR + BE are PCT members, this is satisfied.

The Contracting States of the PCT include US, EP of interest to X and many Eastern Europe countries e.g. HCl, CZ, BG, Croatia. Some Eastern Europe countries can also be covered by extension of a European Patent e.g. RO, AL, MK. All these states should be designated a filing.

Hence, a PCT could be filed covering the important Eastern Europe countries identifying Z as applicant, EP identifying Z and X as applicants, US identifying Mr van Dongen as applicant/inventor.

By Rule 4.15 multiple applicants must sign the PCT request form since a common representative cannot file the application on behalf of his fellow applicants. If Mr Dongen's signature is not available then by Rule 4.15 (b) a statement explaining his lack of signature may be furnished.

The claim of the PCT should cover the composition Z2 and its uses in the various technical fields e.g. cardboard.

When entering the national phase in Eastern Europe, Z can restrict the claims of the PCT to cover only those parts of interest to him, if so desired.

The US Nat. phase can also be entered and the claims restricted as desired by X, if so desired.

I would suggest that the claims be kept as broad as possible to ensure maximum protection.

After entering the European regional phase, a divisional application may be filed. The Divisional will need to be in the names X and Z since by Rule 25 (1)c the applicant on the division must be that of the parent. Then an assignment of X's right in the parent and Z's right in the divisional may be prepared and recorded such that there are 2 EP Applicants - one in the name of Z, one in the name of X.

Z may restrict his claims to his preferred uses + Z2 and X may restrict to one in cardboard. Z's European application should also be extended to the Eastern European states AL, RO, MK if desired.

The initial costs of a PCT are low, since translation costs are delayed, only 1 priority document is required and only 1 set of fees are due.

Within 1 mth from filing the transmittal fee, basic fee, designation fee will be due. Also the search fee is due.

The PCT can be filed in any language, conveniently in the language in which BE-Z2 was filed. The PCT should be filed with the competent receiving office which by Rule 19 may conveniently be the EPO if BE-Z2 is in French.

A Certified Copy of BE-Z2 should be transmitted to the Receiving Office or International Bureau by 16 mths from priority.

Despite the agreement, I would recommend that X + Z co-operate fully to ensure protection is as broad as possible. Restrictions to claims such that Z and X own the correct parts of the application should not lose coverage for important material.

Z may wish to consider partially assigning the right to claim priority from BE-Z2 to X to ensure priority is definitely validly claimed. This is not however absolutely necessary.

By filing a PCT, the expensive translation costs can be delayed until 31 mths from priority i.e. Nov 2000.