

Candidate's Answer – DII

- 1) NF-EU2 has the same description as NF-IE2 and priority (Art. 87 EPC) would therefore seem to be validly claimed. We do not know of any disclosure of any of this subject matter before the priority date (1.10.97) so it would appear that everything in NF-EU2 is new.

Blottanes in themselves seem to be inventive, so a claim to blottanes in general in NF-EU2 should be patentable. Furthermore, since blottanes in general are described in NF-EU2 (& NF-IE2), introducing such a claim is not prevented by Art. 123(2). The only argument against this is that blottanes in general are described as being of no practical use so such a broad claim might be seen as not being supported by the description. The process for making continuous fibres of blottanes is claimed, and is described as “ingenious” so is presumably inventive.

Product A in the form of a woven textile is also already claimed, is new and is presumably inventive, if nothing else for its antistatic properties. The use of A for antistatic properties gives the possibility of a claim to A. No other uses of blottanes are described, or any other blottanes mentioned.

To summarise, it seems possible that patentable claims in NF-EU2 could include:

- Blottanes generally (possibly)
- Product A
- A in the form of a woven textile, and
- Process for making continuous fibres of blottanes

The fact that designation fees have not been paid may be significant. The designation fees were due in February 2001 (6 months after search report (A 3 publication) was published – Art. 79(2)). If they were not paid then, under R. 85a(1) or R. 85a(2) there is still a possibility they could be paid with a surcharge.

If they are not, the application will be deemed withdrawn (Art. 91(4), Art. 79(3)). Similarly the examination fee was due in 2.01 and does not seem to have been paid. If it is not (under R. 85b, within 1 month of notification with surcharge) then, again, the application will be deemed withdrawn (Art. 94(3)).

NF-EU1 claims priority from NF-IE1. The two applications are identical so priority would appear to be validly claimed. However, Art. 87(1) states that priority can only be claimed for a first application, and for at least some of the subject matter of NF-EU1, NF-IE2 is the first application rather than NF-IE1, so priority cannot be claimed from NF-IE1.

So NF-EU2 probably cannot claim priority for

- Blottanes in general
- Product A
- How to make blottanes as continuous fibres
- Blottanes as woven textiles in shoe liners (NF-IE2 disclosed A – which is a blottane – as a woven textile in shoe liners). Such claims will only have the filing date of NF-EU1 (1.6.99).

NF-EU2 probably can claim priority for

- Use of blottanes as moisture absorbers
- Moisture absorbent materials including blottanes

B-PCT, published after the filing date, but claiming valid priority from B-GB1, can act as Art. 54(3) novelty only prior art against those claims not entitled to priority, as all designation fees were paid and although it was published after filing date, B-GB1 is earlier (priority) date. This would knock out claims to blottanes in general – disclosed by B-PCT. But claims to any of the rest of the subject matter would remain untouched.

NF-EU2 was also not published before priority or filing date of NF-EU1, but itself has an earlier priority date even than the priority of NF-EU1. By the same arguments as the claims not entitled to priority, it would anticipate (Art. 54(3)) all claimable subject matter except the moisture absorbent properties of blottanes.

- 2) Neither NF-EU1 nor NF-EU2 were published at the priority date (15.10.98) of B-EU1. B-PCT was identical to B-GB1 so priority may be validly claimed.

NF-EU1 shares the same priority (for some of its matter) with B-EU1 and can therefore not be cited against it, even after publication. B-EU2 has the same priority as B-EU1 (Art. 76(1)) so NF-EU1 cannot be cited against B-EU2 either. NF-EU1 is not relevant to the patentability of B-EU1 or B-EU2. NF-EU2 might be citable under Art. 54(3) for novelty only, but only if the designation fees are paid (R. 23a), and then only for those states for which they were paid. Worst case scenario (from Boggy's point of view) is that N does pay all designation fees and surcharges using R. 85a(1) or R. 85a(2), so NF-EU2 becomes citable.

It is relevant for novelty only (Art. 54 (3), Art. 56) though. The payment of designation fees for NF-EU2 could knock out claims (in B-EU1) to blottanes in general. It would not knock out the claim to product X which is therefore patentable. In B-EU2, the subject matter of composts containing blottanes is not disclosed by NF-EU2 so claims to this subject matter are patentable.

B-EU1 is about to proceed to grant, following which it will be too late to amend to e.g. textiles & papers of blottane, and the use of blottanes as a moisture absorbent material (which could be claimed – G 2/88). There does not seem to be an obvious way of holding up grant by non-payment of fees – no renewal fees have fallen due. So write to EPO immediately requesting amendment to overcome this prior art.

The EPO does not have to accept the amendment (R. 86(3)), but equally it is possible in exceptional cases (G 7/93) up until the decision to grant is actually put in the EPO's internal post (G 12/91). The EPO has to balance the applicant's interest in obtaining a legally valid patent with the EPO's interest in bringing the procedure to a speedy conclusion. Hard to call, because they might need to re-open examination to allow the amendment (Art. 114(1)) & check if it is not anticipated by NF-EU2, which could dissuade them. But worth a try because once it is being re-examined there will be a chance to find out for good whether any/which designation fees are paid for NF-EU2.

- 3) If no exam/designation fees are paid for NF-EU2 it will be deemed withdrawn and cannot lead to problems. If they are paid, then NF-EU2 could issue with a general claim to "blottanes" which would indeed cause problems (although note there is problem with support, they might not get such a broad claim allowed).

NF-EU1 shares a priority date with B-EU1 & B-EU2 of 15.10.98 – at least to some of its matter: In particular, claims to the use of blottanes as moisture-absorbent materials are entitled to priority and therefore not anticipated under Art. 54(3) by B-EU1. Such claims could therefore be allowed and would be likely to cause you problems. They would also cause Pure Agrochemical problems in exploiting their compost as they would cover what they are doing.

Note (and this applies to the patentability of B-EU1 & EU2) – there is no bar on patents being granted to different applicants when the two have the same priority date (GLX C-IV, 6.4). So material in NF-EU1 that is entitled to priority cannot be cited against B-EU1 or B-EU2, and B-PCT cannot be cited against the material in NF-EU1 that is entitled to priority. So it is possible (if you can persuade the examiner to let you amend B-EU1) for both you and Niffy to get valid patents claiming the use of blottanes as a moisture absorbent material.

- 4) If Niffy do not pay designation fees for NF-EU2, then B-EU2 could be granted in its present form and would form a valid patent. In order to enforce it, you need to file translations in the designated states into their national languages (Art. 65(1)) within 3 months. Once that is done then you can enforce the patents under national law where necessary, including the filing of injunctions etc.

If Niffy do pay designation fees on NF-EU2, then you will need to amend the patent to ensure it has a valid claim. If this cannot be done before grant (eg because the EPO refuse amendments under R. 86(3), or even R. 86(4)), then you would end up with a granted but only partially valid patent. You can probably amend after grant in most countries, but this is an expensive procedure. If you try to sue Niffy within the next 9 months they would almost certainly oppose the patent (Art. 99) centrally on the grounds that claim 1 is not new (Art. 54(3)) over NF-EU2. You would then get a chance during opposition proceedings to amend the patent to ensure it is valid.

If you are allowed to amend by the EPO, and they re-open examination, then you have provisional protection after publication under Art. 67 EPC – the PCT publication counts as a European publication (Art. 158(1) EPC). This does not allow you to open proceedings before grant, but you have the power after grant to sue for damages incurred between publication and grant. However you will need to file claims translations (Art. 67(3) in each country you are interested in to start the provisional protection running.

5. Disposable nappies containing X

A divisional cannot be filed having claims to disposable nappies containing X based on B-EU2. A divisional application cannot extend beyond the subject matter of its parent application (Art. 76(1) EPC). B-EU2 does not contain any disclosure of product X or the use of blottanes in disposable nappies. So a divisional based on B-EU2 cannot include

claims to disposable nappies containing product X. This is based on the fact that B-EU2 cannot have matter added to it extending beyond the content of B-EU2 as filed (Art. 123(2)). So claims to product X can also not be introduced into B-EU2. Art. 123(2) (matter compared to application as filed) and Art. 76(1) (matter compared to patent) are quite separate restrictions (T 441/92).

A divisional can also theoretically not be filed based on B-EU1 as approval of the text under R. 51(4) has already been given (R. 25(1)). The only chance of filing a divisional based on B-EU1 is if examination proceedings are re-opened before the decision to grant is issued, as discussed under Point 2, p. 8* above. Following G 7/93 approval of the text becomes binding only on the issue of the decision to grant.

However, it is not possible to withdraw approval of the text simply to file a divisional (J 29/96). If you file an amendment and the EPO simply accepts it and issues the decision to grant, then it will still not be possible to file a divisional, as this is still deemed approval of the text (J 29/95). Only hope is for EPO to re-open examination proceedings, in which case R. 51(4) will require a new approval of the text, in which case a divisional can be filed up until the new approval of the text (G 10/92).

The best bet would seem to be to attempt to file amended claims on B-EU1 including a claim to a disposable nappy containing X and a claim to the use of blottanes as a moisture absorbent, drawing the examiner's attention to NF-EU2 and arguing that exceptional circumstances apply (T 92/85) so examination should be re-opened. Then he might re-open examination, in which case divisional can be validly filed. Or he might (R. 86(3)) simply accept the amendment, in which case no divisional can be filed but at least B-EU1 would contain a claim to a disposable nappy containing X. Or he might just refuse the amendment and issue the decision to grant, in which case we have not lost anything by trying! It is important only to request amendment, not withdraw approval of text under R. 51(4), as otherwise you run the risk of the application being refused for lack of an agreed text (R. 51(5)).

6. As ever, this depends on whether the designation fees for NF-EU2 are paid.

If the designation fees for NF-EU2 are paid with surcharge in the period of grace under R. 85a(1) or R. 85a(2), then claims in NF-EU1 to the process of producing continuous fibres, and to blottanes in the form of a woven textile, would not be valid as they would be anticipated under Art. 54(3) by NF-EU2. So they could not use NF-EU1 to stop you.

However, if they also paid the examination fees on NF-EU2 with surcharge within the R. 85b grace period, then NF-EU2 would remain alive and might proceed to grant. It contains a claim to a process for making continuous fibres of blottanes, and such a claim would prevent you from making continuous fibres of X (which is a blottane). It would also (Art. 64(2)) protect the continuous fibres of X per se, as the direct product of the claimed process. They could thus stop you from producing X as a woven textile to supply F (depending, obviously, in which states they validate the patent).

If the designation fees are not paid for NF-EU2 then it will not act as Art. 54(3) prior art against NF-EU1. Claims in NF-EU1 to the process for producing continuous fibres, although they cannot claim priority, were still novel and inventive at the filing date of

* Ed. Note: page 8 in the original, ie page 2 last paragraph of No 2) in this printed copy

NF-EU1 and therefore should still be patentable. This would cover part of the process of manufacturing X as a woven textile as described above and would therefore allow Niffy to prevent you supplying X as a woven textile to F in whichever states NF-EU1 is granted in.

Since you are, at the very least, going to be able to get some form of valid patent to blottane or to its use as a moisture-absorbent, even if it involves post-grant amendments, it would seem that some form of cross-licensing would be in order with Niffy. None of your other contacts make shoes, and it sounds as though product X would be better for shoes than other blottanes because of its odour-absorbing properties. Niffy may therefore wish to use X in their shoes – and anyway will require a license to use any blottane as a moisture absorbent. You are going to need a license from them (probably) to make long fibres of X, and also (possibly, depending on what happens to NF-EU2) to use blottanes in general or to use blottanes as a moisture absorbent. So you will need to come to an agreement with them.