
Examiners' Report - Paper D - Part II

Most candidates correctly assessed the relationship between the patent documents. However, many failed to outline in appropriate depth the relevance of the non-patent disclosures. It is noted that a small number of candidates believes that a granted patent gives a positive right to make use of the claimed subject-matter.

The first three questions in the paper asked for an analysis of the patent situation and asked how the client could improve upon his position; it was therefore necessary to analyse the rights and the effect those rights would have on the client's business activities. Many candidates focussed on the analysis of the patent situation and neglected to clearly advise the client. In some cases many pages were filled with detailed advice on formalities and fee payments to be taken care of at some time in the future and little attention was paid to acts that needed to be carried out urgently. The conclusion seems to be that many candidates either do not have experience of giving practical advice to clients or simply failed to read the questions to determine what the client (examiner) was looking for.

With regard to the first question (foamed core technology and the use of recycled material), most candidates realised that the client, MÖWE, cannot use the economically important recycled plastic material without a license from the competitor, DQWE. Most recognised that DQWE needed a license under EP1 but not all came to the conclusion that their client should be strongly advised to take up the offer of acquiring EP1 from Mr Vinge. Those candidates who advised their client to acquire EP1 then correctly determined that a cross license with DQWE under which DQWE obtained a license under EP1 in exchange for the client's license under PCT1 was the logical conclusion.

In order to answer the second question (flap technology) it was necessary to realise that, because the disclosure of EP1, as originally filed, included the text of the description of EP2 albeit without the "superfluous" drawings, EP1 was prior art under Article 54(3) against the re-dated and therefore later filed EP2. Filing a divisional application was not necessary to obtain this prior art effect. Those that realised that EP2 lacked novelty over EP1 generally also realised that opposition against the European patent was possible but that the opposition period would soon expire. Those candidates that recommended

acquiring EP2 clearly failed to correctly determine its validity. The conclusion that the client should purchase EP1 with minimum delay, effect the assignment so that a divisional application based on the full original text of EP1 could be filed as soon as possible was not mentioned by many candidates. Very few candidates discussed the patent rights situation for the flap technology in the USA, even though it was explicitly mentioned in the paper that the client had strong interests there.

The analysis of the situation for the third question (dimples and equivalent knobs) was correctly made by many candidates but, again, the consequences for the client were not seen by all such candidates. Many candidates appeared to know that a disclosure of an invention on the same day as filing a patent application thereon was not prior art but did not clearly explain this. Similarly, most knew that patent applications filed on the same day were not prior art against each other but did not explain this and the consequences for each applicant. The issue of whether Mr Cervantes was really the inventor of EP4 was missed by many. The better candidates dealt with the aspect of equivalence of dimples and knobs and saw that cross licensing between the client and DQWE was the logical solution to the conflict.

No specific comments can be made with respect to the fourth question.

It is pointed out that the submission of pre-prepared materials as part of the answer paper is contrary to the Regulations (see "Instructions to candidates concerning the conduct of the examination", paragraphs 4. and 5.7, published in Supplement to Official Journal 12/2004). Such materials will be disregarded for marking.

Possible Solution DII 2005

Dear Mr. Möller,

In reply to your recent letter, please be advised as follows:

As to your first question:

Mr. Vinge's application EP1 is the first filing for the foamed core technology and is validly filed on 29.4.2002. Since no relevant prior art is available, patent protection can be obtained in Europe for a process of manufacturing wings and the resulting wings having foamed plastic cores and an outer hard shell.

Mr. Cervantes' application PCT1 was validly filed and claims a process of manufacturing wings and the resulting wings with foamed cores of recycled scrap plastic. No pertinent prior art concerning PCT1 appears to be available:

- since EP1 was only published later, Art 54(2) EPC,
- since EP1, though filed earlier, cannot successfully be used as Art 54(3) EPC document because it does not mention recycled scrap material,
- since the foam core of recycled material of the wing displayed at the wedding was invisible and thus unavailable to the public, see e.g. GL D-V, 3.1.3.1 or G1/92,
- since Mr. Vinge cannot be identified as a source of disclosure of the foam core technology to Mr. Cervantes at the wedding,
- since the disclosure of foam core technology to you by Mr. Vinge in May 2002 was under secrecy agreement.

Therefore, Mr. Cervantes would appear to have rights resulting from PCT1 in EP and US.

However, Mr. Cervantes may be faced with problems of true inventorship before the USPTO/EPO, perhaps having partly based PCT1 on technology invented by Mr. Vinge.

The broken wing incident in Germany represents a possible infringement of provisional protection resulting from the published PCT1 and Mr. Cervantes may take action against you in accordance with Arts 67 and 150(3) EPC. Any action against you is however only possible from the date when PCT1 was properly regionalized and translated. The broken wing incident in Germany may also represent an infringement of provisional protection resulting from the published EP1 under Art 67 EPC. Your company, MÖWE, could try to argue right of continued use, however, such a right would in any circumstances be limited and also would depend on national law.

Any exploitation by you in the USA of wings with foamed cores of recycled scrap plastic will clearly infringe the US patent from DQWE's PCT1 and may incur heavy damages. Counterattacks could be based on the inventorship issue. DQWE is infringing the general foamed core technology claims of EP1 by manufacturing and selling wings in Europe. In the USA DQWE is free to act, since no rights apart from their patent resulting from PCT1 exist there. At this

time it is too late to file a US application based on EP1, since the grace period has expired.

Despite Mr. Cervantes' rights resulting from PCT1 on wings having foamed cores of recycled scrap plastic, his company (DQWE) cannot freely exploit this technology in Europe, since it would fall under the broader claims of EP1. It is therefore strongly advisable for you to purchase EP1 to establish a situation where DQWE infringes rights held by your company. This would also positively exclude any infringement problems with EP1 resulting from the broken wing incident in Germany. EP1 should be validated in Spain as soon as possible to be able to attack DQWE there.

Cross licensing of the rights of PCT1 and EP1 in Europe would then appear to be a reasonable strategy for the meeting with Mr. Cervantes, since both companies infringe the rights of the other. At the same time, you (MÖWE) should try to obtain a license of the US patent of PCT1, in particular in view of the Californian tender.

Concerning your second question:

The adjustable flaps were initially filed in EP2 on the 29.04.2002, however, the date of filing was re-dated on request by Mr. Vinge to 25.05.2002 when filing the originally missing drawings, Art 91(1)(g), 91(6), R 43 EPC or GL. A-III-10.

Therefore, the effective filing date for EP2 is 25.05.2002. The disclosure of the adjustable flap technology to you on 15.05.2002 was prior to the effective date of filing for EP2, but was under secrecy agreement and consequently will not be relevant as prior art. The wing with flaps shown at the wedding is also not relevant, since the disclosure was after the date of filing.

However, the disclosure of adjustable flaps from the description of EP2 as included in EP1 when filed on 29.04.2002 is prior art under Art 54(3) EPC, since EP1 was filed before and published after the re-dated filing date of EP2. This applies even though the subject-matter in question was not included in the translation and consequently also not published, Art 70(2) EPC, GL A-VIII, 5.2 or C-IV, 6.1. EP2 was granted on 02.08.2004 and can be successfully opposed in its entirety for lack of novelty based on EP1 until 02.05.2005.

Therefore, do not buy EP2 !!

EP1 as originally filed contains a full and enabling seven pages disclosure of the flap technology. Hence, it would be possible to obtain separate protection for this technology by filing a divisional application as soon as possible, since EP1 will only be pending until early April, R 25(1) EPC. Even though the flap technology was neither part of the translation nor published in EP1, filing a divisional would still be possible, since the content of a European application is ultimately determined by the original text of the application (in this case Danish), Arts 70(2), 76(1), 123(2) EPC and GL C-VI, 9.4 or A-VIII, 5.2

Therefore, EP1 should be purchased now !!

An assignment signed by both Mr. Vinge and you must be effected and recorded at the EPO immediately in accordance with Arts 72 and R 20 EPC and GL E-XIII, 1. Thereafter, a divisional application with your company (MÖWE) as applicant

can be filed. It could be tried to bring the seven pages relating to the flap technology into EP1 before grant, Arts 14(2) last sentence, 70(2) or R 88 EPC. With the above-mentioned steps effected, your company (MÖWE) cannot be barred by DQWE from exploiting the flap technology in Europe. DQWE would be barred from exploiting the flap technology in Europe, in particular to produce in Spain, by the divisional application to be filed by your company (MÖWE). Since no rights exist for the flap technology in USA both MÖWE and DQWE are free to use such flaps there.

As to your third question:

The applications EP3 and EP4 were both filed by fax in accordance with R 36(5) EPC, OJ 1992, 299, Art. 2 and GL A-II, 1.1.1 establishing 04.07.02 as the valid date of filing.

The displayed wing with dimples is not prior art under Art 54(2) EPC against EP3 and EP4, since this disclosure was only made on the very same day as the filing took place.

The EPO only counts in full days with respect to establishing the date of filing and different filing times on the same day will get the same filing date, Art 120 and R 83 EPC. Applications EP3 and EP4 are not prior art against each other under Art 54(3) EPC, since they have the same date of filing.

Therefore, valid patent protection can be obtained for the dimples by both EP3 and EP4. It strongly appears from the facts and circumstances that Mr. Cervantes is neither the true inventor nor successor in title for the dimples part of EP4 and thus he is not entitled to the grant of a European patent, Art 60 EPC. You (MÖWE) should consider the possibility of initiating national proceedings and proceed in accordance with Art 61 EPC, GL A-IV 2 and GL C-VI 9.2.3 and subsequently file a request for suspension under R 13 EPC.

Concerning the protrusions part of EP4, it should be noted that it depends on national law in Spain who would be recognized as the true inventor, since protrusions were not shown on the wing. Therefore, patent protection for the protrusions according to EP4 may go to DQWE.

In any case, you are potentially in a position to forbid exploitation of dimples in Europe.

On the other hand, even if losing the dimples part of EP4, DQWE may be in a position to forbid exploitation of protrusions in Europe.

Depending on national law, it is possible that applications EP3 and EP4 each will result in rights protecting both protrusions and dimples since these could be seen as equivalents.

In these not fully predictable circumstances, cross licensing of the rights of EP3 and EP4 in Europe could be a solution, since both parties might be held to infringe the rights of the other.

As to the fourth question:

After purchase and assignment to DQWE of EP2, an opposition can be filed.

Nevertheless, an opposition cannot be filed anonymously. The only option would therefore be to convince a third party to file an opposition, and to supply this party with your argument. In case of actions against DQWE concerning EP4, it appears unavoidable that Mr Cervantes will be informed about your identity during the national proceedings.

Sincerely yours,

NB.

Citations of any legal provisions given here are just for information.

84 Marking Schedule

EXAMINATION COMMITTEE III

Candidate No.

Paper D Schedule of marks

Question	Maximum possible	Marks awarded	
		Marker	Marker

PART I

1	2		
2	7		
3	4		
4	4		
5	5		
6	3		
7	3		
8	5		
9	2		
10	6		
11	4		
TOTAL PART I	45		

PART II

A	19		
B	20		
C	13		
D	3		
TOTAL PART II	55		

Total Parts I + II	100		
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Examination Committee III agrees on marks and recommends the following grade to the Examination Board:

☐

PASS
(50-100)

☐

FAIL
(0-49)

COMPENSABLE FAIL

(45-49, in the case the candidate sits the examination for the first time)

9 September 2005

... - Chairman Examination Committee III