
Examiners' Report – Part D II 2006

This year the candidates were asked:

- to assess the validity of a patent application having claims with different priority dates
- to comment on some procedural issues
- and to advise whether the client could stop or be stopped by his competitor.

In assessing validity the first problem the candidates were expected to discuss was the effect of a document which was a written report of an oral disclosure at a Symposium.

Most candidates correctly stated that the oral disclosure was prior art as it took place before the earliest claimed priority date.

Many candidates also noted that the written report was deemed to represent the contents of the oral disclosure unless proven otherwise.

Too few candidates suggested investigation of the oral disclosure (e.g. by contacting attendees) to determine whether the written document was a correct representation of the oral disclosure. The effect of any disparity could be large [the client might possibly maintain their extremely broad claim 1 if the document discloses more than the oral disclosure].

While candidates are generally expected to accept the facts presented to them, when those facts indicate the need for specific enquiries, they should say what those enquiries would be, and what they would hope to demonstrate from those enquiries.

In assessing the effect of the different priority dates, most candidates were able to correctly attribute the different dates to the different claims. However too many candidates appeared unaware of G3/93 and attributed the priority of D1 to Claim 3. Some candidates even seemed to be of the erroneous view that a dependent claim always has the priority date of the independent claim it depends from.

The majority of candidates appreciated that EPB was Art.54(3) prior art against Claims 3 and 4. However, relatively few discussed the possibility of disclaiming the specific examples of EPB. Given the relatively recent publication of Decisions G1/03 and G2/03 which set out the requirements for disclaimers, this was surprising.

The most complex part of this question was the relationship between D1 and IT1, and the effect this had on Claims 2-4.

Many candidates realised that the disclosure of IT1 cast doubt on the technical effect claimed in D1, and hence on the inventive step of Claim 2 over the oral disclosure.

Relatively few candidates discussed the partial validity of Claim 4, in view of its overlap with the disclosure of D1, and what options there might be for amendment to make the claim fully valid.

The procedural questions in this paper were generally well answered.

A relatively small part of this paper was concerned with questions of infringement or the commercial effect of the legal situation.

Those candidates who had thoroughly analysed the legal status sometimes failed to draw the appropriate conclusions, but most were able to reach a reasonable opinion. It was reassuring that those candidates who suggested using disclaimers to overcome the prior art effect of EPB generally appreciated that they could not enforce these claims in the area of the disclaimer.

Those candidates who had a cursory analysis of the situation found it difficult to obtain marks in assessing infringement issues. It must be stressed that before an opinion on the effect of a patent or application can be given it is necessary to come to a conclusion as to validity. Also, it should be remembered that candidates are writing a legal opinion for a client. Clients are not only interested in what they cannot do; they tend to welcome suggestions for what they can do and all aspects as to how the legal situation may affect their business. Many candidates considered only the legal situation and did not make any suggestions as to how it could be improved or consider the business effect.

Candidates who gave structured answers with clear reasons for the conclusions they reached tended to do well: those candidates who adopted a stream of consciousness style, or who stated conclusions without giving reasons found it difficult to gain marks. This is the same every year and candidates are encouraged to adopt an organised approach to answering DII. In particular, the order in which questions are posed in DII may indicate a sensible order to deal with DII. Candidates who deviate from the order of questions may find the paper more difficult to deal with than those who follow this order.

Possible Solution - Paper D II

Are each of claims 1 to 5 valid in Euro-PCT1, and if not, can we improve them?

Each claim is dealt with in turn below:

Claim 1

Claim 1 validly claims priority from F1 and has a priority date of 1/10/2003.

The subject matter in PCT1 entitled to a priority date of 1/10/2003:

- a panel having undulating walls,
- use of undulations to increase the thermal efficiency
- and the extrusion process.

The extrusion process is discussed under Claim 5.

The Oral Disclosure at the Symposium in 2002 is before filing of F1. It may disclose the undulations in general and, in particular, 20 undulations per metre for a 1 metre panel.

During the European regional phase, the EPO will assume the written disclosure matches the oral disclosure. The article will be considered as indirect evidence of what was disclosed. If the applicant wishes to overturn this assumption, he will have to demonstrate that the written disclosure does not correspond to the oral disclosure. It should therefore be investigated whether the article matches the oral disclosure. If the article discloses more than what was actually presented at the Symposium in 2002 Claim 1 may be novel. The Proceedings were published only in 2004, which is after the priority date of claim 1.

It is further noted that the function of undulations as assumed to be disclosed at the Symposium is different from the function in PCT1. Thus, the use of undulations to improve thermal efficiency may be patentable. Therefore, amendment to use claims or preferably addition of use claims is advisable.

It is noted that the oral disclosure is not considered part of the prior art for the purposes of novelty and inventive step in the International phase. It will only be considered as a disclosure during the national/ regional phases.

Claim 2

It is possible to claim priority from a German utility model, i.e. D1, within one year.

Claim 2 validly claims priority from D1 and has a priority date of 15/03/2004. The subject matter entitled to the priority date of 15/03/2004 is panels having 5-16 undulations per metre.

The subject-matter of claim 2 is novel over the Tokyo disclosure.

At first sight it appears inventive because of technical effect over the claimed range. But IT1 states that the technical effect is not achieved for some combinations of length and undulations. Therefore, the subject-matter of claim 2 appears not to be inventive for these combinations of length and undulations. Therefore the subject-matter of claim 2 may not be patentable.

Limiting Claim 2 to a solar panel having a length of one metre, or adding such a limited claim, may improve patentability. Such a claim would retain the priority of D1.

Please note, however, that claim 2 cannot be improved by using a disclaimer to disclaim the non-inventive combinations of length and undulations because this is relevant to inventive step and has a technical effect (G1/03 & G2/03).

Claim 3

Claim 3 validly claims priority from IT1 and has a priority date of 22/09/2004. The subject matter entitled to a priority date of 22/09/2004 is solar panels having 5-16 undulations per metre and having a length of less than 3 metres. Claim 3 as it stands cannot benefit from the priority of D1 or F1 because it includes an additional technical feature (G3/93).

Claim 3 is novel over Tokyo disclosure.

EPB will be comprised in the state of the art in the European regional phase under Article 54(3) EPC against claim 3. The embodiment in EPB of a panel having 10 undulations per metre and a length of 2 metres is novelty destroying against the subject-matter of claim 3. However, this particular embodiment could be disclaimed (G1/03 & G2/03).

D1 forms part of the state of the art since D1 was published before filing of IT1. The subject-matter of claim 3 is not patentable over D1 because of the disclosure of 1m test panels in D1.

Validity of Claim 3 may be improved by limiting to 1m panels if there is scope for such a generalisation from the examples, since for such a claim, the priority claim from D1 may be valid [this would be effectively the same as the amended Claim 2 mentioned above].

Claim 4

Claim 4 validly claims priority from IT1 and has a priority date of 22/09/2004. The subject matter entitled to a priority date of 22/09/04 includes solar panels having 15-30 undulations per metre and having a length of more than 3 metres.

The subject-matter of claim 4 is novel over the Tokyo disclosure because of the claimed length.

D1 claims 5-16 undulations over all length ranges and overlaps claim 4 in the region 15-16 undulations per metre for panels having a length greater than 3m.

There is an argument that selection of the length gives novelty in this range. However, this argument is likely to fail. In assessing prior art the entire technical content must be considered not just the examples (for example, T666/89).

D1 states that a technical effect is achieved over a specified range of undulations per metre. In the region of overlap, claim 4 simply confirms this. There is no new technical information and therefore, no novelty over D1.

D1 specifically teaches that in order to obtain better results, the number of undulations per metre has to be between 5 and 16. For panels having >16 – 30 undulations per metre and a length greater than 3 metres Claim 4 is therefore novel.

D1 teaches that the improved efficiency is not achieved above 16 undulations per metre. Therefore, in the range >16-30 undulations per metre, it would appear inventive to go against this teaching of D1.

However, whether there is basis for claiming the range >16-30 undulations per metre (or a sub-range) in the description of PCT1 needs to be established. Whether the valid priority claim from IT1 would be retained for such an amended range or sub-range is to be considered.

With respect to claim 4, EPB in the European regional phase will form part of the state of the art under Article 54(3) EPC. EPB will be considered for novelty purposes only for the commonly designated states. The 20 undulations per metre panel embodiment having a length of 4 metres disclosed in EPB will destroy the novelty of claim 4 for that combination.

To overcome this problem, a disclaimer of the specific combination of 20 undulations per metre and a length of 4 metres is possible (G1/03 or G2/03).

As a further improvement, a claim to the use of undulations to improve thermal efficiency would provide further protection.

With respect to Mr. Bad's proposal to withdraw conflicting embodiments in application EPB for the three countries (DE, FR, IT) designated in Euro-PCT1, it is noted that such a withdrawal is not possible.

Further, if Good NV can show that the invention was stolen, Article 55(1) EPC would then apply because EPB was published after the filing of PCT1. Also, entitlement proceedings may be instigated under Article 61 EPC.

If sufficient evidence can be collected and such entitlement proceedings are successful, Good NV should file a separate application directed to the stolen subject-matter.

Claim 5

Claim 5 validly claims priority from F1 and has a priority date of 1/10/2003. There is no reason to doubt the patentability of its subject-matter.

Can we extend our Euro-PCT1 to cover the United Kingdom and Belgium?

It is possible to pay the designation fees within the 31 months period, i.e. up until 02/05/06.

Is there an easy way to postpone national phase entry for PCT1 outside Europe without paying surcharges?

To postpone national phase entry withdrawing the priority claim from F1 may be considered. If the priority claim of F1 is withdrawn, the 30 months period for entering national phases will end on 15/09/06. It is thus possible to delay entry into the national/regional phases for those states where the national/regional phases have not started yet.

A disadvantage of such a course of action is that you lose the priority claims for claims 1, 5 and the possible use claim.

It should be noted that some countries have a longer than 30 month period for entering the national/regional phase without a late filing fee.

Can we stop Mr Bad from marketing his panels?

If claim 1 is valid (over Tokyo Symposium) it covers all ranges of undulations and as a result we can stop Mr. Bad from marketing his panels, since they fall within the scope of claim 1.

If claim 1 is not valid and claims 2 and 3 are unamended then we cannot stop Mr. Bad from making small panels (panels under three metres long). Amended claims covering one metre panels (as suggested above under heading Claim 2 or Claim 3) may make it possible to stop Mr Bad from making small panels.

For large panels (panels over three metres long) a claim with a disclaimer could not stop Mr Bad making a panel with 20 undulations per metre having a length of 4 metres.

If a disclaimer is not necessary following a successful showing of abuse, then Mr. Bad can be prevented from making such panels.

To improve your position, you should consider the designation of ES to prevent new sales as Mr Bad has exhibited in Spain. By paying 7 designation fees, you will cover all designations.

A use claim may make it possible to stop Mr Bad selling panels with undulations for improved thermal efficiency. The enforcement of such a claim, however, depends on national law.

To stop Mr. Bad, it may also be possible to begin a National action based on F1, IT1 or D1.

The process claim 5 may be infringed by Mr Bad.

It is suggested to request accelerated examination at the EPO to get a quick grant.
Further, consideration may be given to entering national phases from PCT 1 directly where possible to get a quick grant.

Can Mr Bad stop us from marketing our panels?

No, if Good NV does not market panels using the specific structure claimed in EPB.

At present in EPB, the undulations are only described, but are not claimed.

There may be scope, however, for amended claims or a divisional application that could cause problems for Good NV.

EXAMINATION COMMITTEE III

Candidate No.

Paper D 2006 Schedule of marks

Question	Maximum possible	Marks awarded	
		Marker	Marker

PART I

1	5		
2	4		
3	7		
4	4		
5	5		
6	5		
7	2		
8	4		
9	4		
TOTAL PART I	40		

PART II

Claim 1	9		
Claim 2	6		
Claim 3	6		
Claim 4	17		
Claim 5	1		
Can we extend to cover UK and BE?	2		
Is there any possibility to postpone the national phase?	5		
Can we stop Mr Bad marketing his panel?	11		
Can Mr Bad stop us from marketing our panel?	3		
TOTAL PART II	60		

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)

29 August 2006

Chairman Examination Committee III