
Candidate's answer

1.) Legal situation of the inventions

a.) Sports racket R

The sports racket R was first disclosed in IN-DS filed on 10/12/2005. The application PCT-DS validly claims the priority of IN-DS which was filed in a Paris Convention country not more than 12 months earlier filed by the same applicant and discloses the same subject-matter → same invention. As PCT-DS entered the European phase validly and no relevant prior art was cited in the EPO's search report a valid patent can be obtained for R in Europe (as well is in other countries if the national phase/regional phase will be started; 30 m. not expired yet! (expires on 10/06/2008))

The inventive step of the racket seems to be supported by the advantage of the racket being light and stiff.

(Only EP-BEP claiming priority of FR-BEP dated 03/09/2005 has an earlier effective date but as it relates to a dumper D2 it is not relevant for the inventive step as its subject-matter is different and was not published but even when published would be Art.54(3) prior art not relevant for the inventive step assessment.)

b.) The tennis racket R1

It was first disclosed also in IN-DS whose priority is validly claimed in PCT-DS as mentioned above. PCT-DS does not claim R1 but the claim on R covers also R1! As PCT-DS is still pending in Europe DS might add new claims relating to R1 as it would not extend the scope of the application as filed because D1 is disclosed in the description as an example, or DS can even file a divisional application for R1.

(it would be more costly)

EP1 and EP2 also claim R1 but none of them is entitled to the priority of DK-1 and DK-2 respectively as neither DK-1 nor DK-2 is the first disclosure of R1 as it was already disclosed by the same applicant (Copen Tennis) in DK-U. As DK-U was made publicly available (published in April 2006) before filing DK-1 and DK-2 Art.87(4) does not apply (nor because DK-U has left rights outstanding as DK-1 and DK-2 claim its priority!)

Thus as the claims in EP1 and EP2 relating to R1 have an effective date of 15/12/2007 and 14/11/2007 respectively, so later than the effective date of PCT-DS Copen cannot obtain patent protection for R1 in Europe as PCT-DS designating EP, published in English and entered the European phase in all designated contracting states will be Art.54(3) prior art for both EP1 and EP2.

From EP2 however as it was filed before 13/12/2007 Art.54(4) EPC'73 still applies and PCT-DS will be prior art only in the commonly designated states. As PCT-DS designates all contracting states it can be only Malta which could be designated in EP2 but not in PCT-DS. If EP2 can be saved protection for Malta for R1 is possible.

Regarding DK-U a valid protection might be possible in DK depending on the national requirements for utility models, but as PCT-DS has an earlier effective date it is questionable. Additionally DK-U published before the effective date of R1 in EP1 and EP2 is Art.54(2) prior art thus novelty destroying.

c.) Racket dumper D1

The racket dumper D1 is disclosed among the patent applications only in DK1 and EP1. EP1 validly claims the priority of DK1 with regard to D1 as the combination R1+D1 was first disclosed in it thus the claim relating to D1 has an effective date of 27/12/2006. (DK-U discloses only R1 but not D1!)

PCT-DS has an earlier effective date but does not disclose or mention a dumper, it is not relevant.

Further EP-BEP claiming priority of FR-BEP validly as the priority year of FR-BEP expires on 03/09/2005 (Sunday) → 04/09/2006. But EP-BEP was not published, so no Art.54(3) effect. Even if would be published were not relevant as discloses a different dumper D2 and would be Art.54(3) prior art not relevant for inventive step. DK-U's publication is state of the art but as discloses R1 it is not relevant.

Thus from EP1 a valid patent could be obtained for D1. But important pages missing (page 3-4) from the description. If not present problem can arise as the disclosure is not sufficient (Art.83!) as so the invention is not patentable as cannot be carried out by person skilled in the art. EP1 filed after 13/12/2007 thus EPC 2000 applies. Accordingly new Rule 56 could be applied to insertion of the missing 2 pages is possible without affecting the filing date. As the EPO sent no notification the time limit for this is 2 months from filing i.e.: 15/02/2008 already expired. It can be remedied only with re-establishment of rights if all due care can be proven. It seems so as the cause was the fire occurred on 21/12/2007 before the expiry of the 2 months.

Thus request for re-establishment has to be filed within 2 m. fr. the removal of the cause of the non-compliance: i.e. fr. 28/02/2008 2m → 28/04/2008 at the latest on 28/04/2008 paying the fee for re-establishment, completing the omitted act of R.56(2) and (3) thus file missing pages, copy of the earlier application, the translation of the earlier (DK1) application an indication where the missing parts of the description are in the earlier application (DK1) and a request that the missing parts are based on the earlier application.

As EP1 is a complete translation of DK1 if request for re-establishment accepted the request regarding the missing parts should be accepted without the change of filing date. The request for re-establishment has to state the grounds and facts (fire and that patent department was destroyed). As backup files were kept it supports all due care so also request for re-establishment should be granted and thus EP1 can be saved without changing the filing date, maintaining the priority!

D1 is novel as not disclosed in any prior art document. Its inventive step seems to be supported by the significant advantages through reducing the vibrations due to its specific shape.

In Denmark DK1 can confer protection for D1 if EP1 cannot be saved. If EP1 is saved better to have protection in DK via EP1 as it provides longer protection with ~ 1 year.

d.) Racket dumper D2.

D2 is first disclosed in FR-BEP. A valid patent can be obtained for it in FR.
EP-BEP validly claims the priority of FR-BEP (priority year of FR-BEP:

A.87(1)

03/09/2005 —————> 03/09/2006 —————> 04/09/2006 OK.
12m Sunday

+EP-BEP claims the same invention as FR-BEP. Thus has an effective date: 03/09/2005.

EP-BEP validly filed, filing date accorded but the filing and search fees not paid. They should have been paid within 1 month from filing i.e. 04/09/2006 1m→ 04/10/2006. But before the expiry of this time limit BEP was declared bankrupt from 06/09/2006 → was not able to pay.

It is possible to inform EPO about bankrupt.

The EPO will probably declare the proceedings interrupted (J7/83, J26/95) retroactively from 06/09/2006 and also inform EPO about the authorization of yesterday to allow BEP to sell assets to meet debts. → Thus EPO will probably define a date from which proceedings will be resumed. The filing and search fees can be paid within 1 month from the date of resumption.

If above successful EP-BEP can be saved. As D2 is novel and seems to be inventive as achieves the same advantageous effect as D1 but in an other way a patent can be obtained from EP-BEP for D2 in Europe.

e.) Grip G.

The grip is first disclosed in EP2.

The claim for G and R1+G in EP2 is entitled to the priority of DK-2 as G and R1+G were first disclosed in EP2. Thus have an effective date of 29/12/2006. DK-U discloses R1 thus not relevant. As the grip is not disclosed in the prior art documents it is novel. Its inventive step is supported by its advantageous new properties: i.e. moisture absorbent. But EP2 is deemed to be withdrawn as no filing + search fee was paid.

EP2 filed before 13/12/2007 thus EPC 1973 applies. EPO notification deemed notified on 27/12/2007. But 1 m. for paying fees expired on 14/11/2007 1m→ 14/12/2007 after 13/12/2007 thus further processing is available for the payment of fees : this expires on: 27/12/2007 2m→ 27/02/2008 already expired.

But re-establishment in the period of further processing is possible as it seems that all due care can be proven. → Thus request re-establishment by filing written request and pay fee for re-establishment and pay fee for further processing + filing + search fees.

The request for re-establishment should be granted for the same reasons, on the same basis as for EP1 detailed above. Time limit for filing request for re-establishment of rights: 2m fr. 28/02/2008 → 28/04/2008.

Thus if re-establishment granted EP2 can be saved and patent obtained for G. Similarly to D1, for G protection can be obtained from DK2 if not possible via EP2, but if possible via EP2 the protection will be longer!

f.) Combinations:

R1 + D1 first disclosed in DK1. → Thus as EP1 validly claims its priority as this combination was not disclosed in DK-U only R1 which is not the same invention.

R1 + D1 is novel. PCT-DS is prior art 54(3) against it thus not relevant for the assessment of inventive step. Thus as it seems to be inventive and if EP1 can be saved as disclosed above R1 + D1 can be patented by Copen Tennis.

Similarly R1+G can be patented as it is first disclosed in EP2 as DK-U does not mention the combination, not the same invention, and validly claim priority of DK-2. If EP2 can be saved as disclosed above patent can be obtained for R1+G from EP2. Patent for the triple combination R1+D1+G not possible but the patent protection for R1+G and R1+D or for D or G would provide sufficient protection as would also stop 3rd parties from making R1+D1+G. But similarly PCT-DS if granted in EP can stop Copen from exploiting R1+D1+G. The combination R1+D2 cannot be protected as not disclosed in any patent application and was published on 05/02/2008 in the press release. But a patent protection on G can stop others from making, selling, using R1+G. But also a patent protection on R or R1 from PCT-DS can stop Copen from using R1+G. The combinations R1+D1 and R1+G can be protected in DK through DK1, DK2 if not possible via the EP applications, but if possible the EP applications confer longer protection.

The publication of DK-U is state of the art 54(2) for EP1 and EP2 regarding the combinations. It is not novelty destroying as discloses only R1 not R1+D1 or R1+G.

It can be relevant for the inventive step, however if D1 or G patentable its combination with known R1 should be also patentable. (based on an inventive step)

2.) Save applications EP1 and EP2 as disclosed above by requesting re-establishment of rights. Contact BEP explaining them that they should immediately contact the EPO and inform about the situation in order to obtain interruption of proceedings and once resumed complete the necessary acts immediately as disclosed above. Once situation cleared acquire patent rights of EP-BEP and inform EPO about the transfer by registering it with EPO.

To have provisional protection for D1 and G in Europe applicant might request early publication once applications saved as disclosed above.

If all above steps are successful later on the national applications can be abandoned to save money.

3.) A European patent arising from PCT-DS if granted can be problematic as the general claim on R could stop Copen Tennis from the exploitation of R1 alone or in any other combination with D1, D2, G.

Additionally as tennis racket R1 is already sold and PCT-DS already published the sales can infringe the provisional protection conferred by PCT-DS, Euro-PCT-DS!

But as the racket seems to be not really useable without the solution of D1 or D2:
i.e. without the damper as show annoyingly high vibrations when hitting the ball DS
needs to use the solution of D1 or D2. Thus it is very important to acquire rights for D2 to
stop DS from using it which they intend according to the press release and also to save
EP1.

Further as DS intends to use the grip G according to the press release our position is
further improved as if EP2 saved we can have a patent for it in Europe.

Thus neither the competitor DS nor Copen Tennis can produce the rackets without
infringing the other's patent rights in Europe which is of interest for Copen Tennis with
the exception of Malta where DS cannot have patent protection as Malta was neither
PCT nor EPC member state in 2006 when PCT-DS filed.

Thus it is suggested to negotiate with DS to obtain cross-licensing for Europe.

As Copen produces only tennis rackets a licence from DS is needed only for the tennis
rackets. However it seems that the claims on D1 and G are not restricted for tennis
rackets thus DS needs the licence for other rackets as well.

If by some reason EP1 and EP2 cannot be saved Copen Tennis will be in a very bad
situation as DS will be able to use D1 and/or G in all European countries except DK.

Also if D2 not patented via EP-BEP and rights for this not acquired the use of D1 would
be circumvented by DS by the use of D2.