
Candidate's answer

1.

- You can achieve this objective as follows.
 - The fishing method disclosed in EPKM refers to EP1 as part of the direct disclosure of the invention.
 - The fishing method appears to be novel and inventive based on the Search Opinion issued in September 2009.
 - However, there is a problem with sufficiency of disclosure under A83 EPC, because the structure of the electromagnetic signal is essential for carrying out the invention.
 - EPKM discloses the signal structure only by reference to EP1.
 - This reference would need to be replaced by expressly incorporating the essential details of the signal structure into the description (Guidelines A-II 4.19; T689/90).
 - However, the necessary reference can only be included if the reference document, i.e. EP1, is either publicly available on the filing date of EPKM (clearly here it was not) or it is both (a) available to the EPO on or before the filing date of EPKM and (b) published on or before the date of publication of EPKM (T737/90, Guidelines C-II 4.19).
 - Presently, EP1 has not been published as publication occurs approximately 18 months from the date of filing (A93(1) EPC), i.e. around 12/1/09 + 18m = 12/7/10.
 - The sufficiency of EPKM will therefore depend on whether EP1 publishes before EPKM itself publishes (EP1 already being available to the EPO and thus criterion (a) above being satisfied).
 - If no action is taken to prevent EP1 publishing, it will do so before EPKM because EP1 was filed a month earlier than EPKM. In that case, EPKM would be sufficiently disclosed and, probably, allowable.
 - KA should therefore withdraw EP1 as soon as possible to avoid it being published. The withdrawal should be effected well in advance of the completion of technical preparations for publication (5 weeks before publication – so early June 2010).
 - Once EP1 is withdrawn, KA should monitor for publication of EPKM and then consider (a) filing 3rd party observations to draw attention to the insufficiency disclosure during pendency of the EPKM application and/or (b) filing an opposition to EPKM when it grants based on lack of sufficiency, within the 9 month post-grant opposition period.
 - In this case, 3rd party submissions may initially seem to be the better option as they are cheap, can be made anonymously and seem to have a high chance of success. However, it is recommended instead to wait until EPKM grants and then to file an opposition. The opposition should successfully prevent the claim to the fishing method; moreover, EPKM would likely not be able to amend the claims to instead cover the (apparently novel and inventive) combination of net and transmitter, because this would extend the scope of protection of the granted patent (A123(3) EPC).

- The lack of sufficiency attack outlined above will be preferable to any attack of lack of novelty and/or inventive step, e.g. made without withdrawing EP1 because:
 - (a) the public disclosure by KA at the 20/1/09 conference is not significant because it did not contain enabling disclosure of the signal;
 - (b) in any case, EPKM's disclosure of a combination of a fishing net and transmitters is apparently novel and inventive itself.
- It is noted that it will most likely not be possible to file new applications (either KM or another party) to the fishing method or net/transmitter combination, because KM have already publicly disclosed this subject-matter on their website on 11/2/09.
- For the avoidance of doubt that a combination of the general method of EP-KM and KA's specific signal might still be found inventive if combined in a later application, KA could themselves now simply publicly disclose their combination (e.g. on their website, in their public library, etc.) (It is noted that KA are not interested in protection for the fishing method).
- Finally, it should be noted that it would not be advisable to withdraw EP1, but then to add a priority claim to EP1 in one of KA's later filings (e.g. in EP3). This is because the publication of the later application would then still occur before publication of EPKM (it being determined by the earliest priority date). Upon publication of the later application, e.g. EP3, the text of EP1 would immediately become publicly available via the online file for the later application - hence EPKM would be sufficiently disclosed.

2.

- As indicated above, EP1 should be withdrawn as soon as possible.
- EP2 contains apparently allowable claims to (1) the signal and (2) the filter, F1. (In fact, if EP1 was not withdrawn, it would on publication become a European prior right against EP1 and so take away the novelty of claim (1) of EP2 – this will not be a problem given that EP1 is being withdrawn).
- Claim 3 of EP2, to the circuit C1, is apparently insufficiently disclosed.
- EP3, as corrected by filing the missing description pages, has a filing date of 2/2/10 and contains a sufficiently disclosed claim to C1.
- However, this filing date is after the public disclosure of EP3 at the end of January 2010 in KA's public library. It is not relevant that "no one has consulted" EP3 so far: this is still a disclosure under 54(2) because it has nonetheless been made available to the public (see, e.g. Guidelines C-IV 6.1).
- All of the claims of EP3 would therefore lack novelty over the library disclosure (in addition, EP2 will on publication become a European prior right against EP3, destroying the novelty of claims to the signal and F1).
- KA should therefore reply to the EPO notification to withdraw the missing parts of the description, i.e. pages 6 to 9.
- The deadline for doing this is:
 - Notification of 17/2/10 is deemed to be 27/2/10 (R126(2) EPC);
 - Time limit is therefore 27/2/10 + 1 month = 27/3/10 (R56(6) EPC).
- It will still be necessary to include pages 6 to 9 as these seem to be essential for disclosing F1 and thus the claimed combination F1+C containing the required electrical connection.
- Therefore, at the same time or later than withdrawing the pages 6 to 9 under R56(6), the following action should be taken:

- (1) A priority claim to EP2 should be added (deadline for taking this action is 1/3/09 + 16 months = Sat 1/7/10, R52(2), extended to Monday 3/7/10, R134(1); however, it must be done at the latest at the same time as taking step (2) below); and
 - (2) A new request to incorporate pages 6 to 9 into EP3 by reference to EP2 should be made (deadline is 12/1/10 + 2 months = 12/3/10, R56(3) EPC. This request will involve filing a copy of EP2 (probably not strictly needed as EPO has a copy of EP2 already, but advised in view of close deadline), and indicating where the missing pages are found in EP2 (in this case, they correspond directly to pages 6 to 9 of EP2).
- In view of the close deadline of 12/3/10, it is recommended to withdraw the current pages 6 to 9 and to carry out steps (1) and (2) in a single letter.
 - Once priority has been validly claimed from EP2 and the missing pages duly incorporated, EP3 will retain its original filing date, i.e. 12/1/10.
 - Accordingly, KA's subject-matter will be divided and in Europe as follows:

Electromagnetic Signal

- Covered in EP2. This claim appears novel and inventive over the 20/1/09 conference and the EPKM internet disclosure as these do not have an enabling disclosure of the actual signal structure. A similar point applies in relation to novelty over EPKM itself as a prior right.
- There is also no evident intervening disclosure of the signal before the filing date of EP3. EP3 also discloses the signal but priority cannot be claimed back to EP2 for this subject-matter because the first application was EP1 and this was still pending when EP2 was filed. Nonetheless, to save costs, KA could consider withdrawing EP2 before publication if the risk of an intervening disclosure of the signal between 1/3/09 and 12/1/10 is considered to be very small.
- If EP2 is not withdrawn before publication, it will destroy the novelty of any claim in EP3 to the signal as a European prior right.
- Note that addition of a priority claim in EP3 to EP1, to establish an effective date of 12/1/09, for the signal claim, is not recommended in view of the need to render EPKM insufficient – see Section 1 above for more details.

F1

- First disclosed, and claimed, in EP2. It appears possible to prosecute this subject-matter to grant in EP2 and also in EP3 since EP3 validly claims priority of EP2. In this situation, there may be double patenting issues at a national level post-grant. Alternatively, F1 could be deleted from EP2 or EP3 (and clearly the situation is moot if EP2 is withdrawn as proposed above).

C1

- First enabling disclosure is in EP3. There is no indication that this claim will not be allowable (EP2 even if maintained will not destroy novelty as a

European prior right because it does not disclose the electrical connection between F1 and C).

Other Possible Claims

- The following claims could also be added to EP3:
 - A claim to the electrical connection itself, which is said to be “inventive”.
 - A claim on underwater camera containing C1 (as disclosed already in the description).

3.

- Yes.
- EPF has been validated in NO because when EPF was filed in February 2008 NO was an EPC member state and it is evident that validation occurred in all states.

EP4

- EP4 was filed in May 2007, i.e. before NO joined the EPC on 1/1/08.
- EP4 has been published after, but has an earlier filing date (May 2007) than EPF's priority date (October 2007). EP4 is therefore a European prior right against EPF for novelty only.
- EPF was itself filed in February 2008, i.e. after entry into force of EPC 2000. Therefore, A54(4) EPC 1973 does not apply (Dec Ad Council SE1 OJ 2007 197; OJ 2007 504). EP4 is thus a European prior right for all states designated in EPF, including NO.
- However, an opposition against EPF (or a national revocation action) based on EP4 would fail, because EP4 discloses only nets made from the generic class G, not nets made from the specific (“species”) material M. The claims of EPF are therefore novel over the disclosure of EP4. EP4 cannot be used to invalidate EPF.
- (It follows that EPF was granted despite the citation of EP4 for the same reason).

PCT-JU

- PCT-JU was filed in May 2007 and so will designate NO (PCT member since 1/1/1980).
- PCT-JU also has an earlier filing date May 2007, than EPF's priority date (October 2007). PCT-JU therefore is capable of becoming a European prior right against EPF for novelty only. (PCT-JU is not only prior art for novelty and inventive step against EPF because it was published after EPF's priority date).
- However, for PCT-JU to become such a prior art, it must be published in an official EPO language (i.e. English, French or German) and the filing fee must be paid, R165 EPC. This can in practice only be achieved by validly entering the European regional phase. The initial 31-month deadline expired in December 2009.
- The European regional phase can still be entered by fulfilling the acts of R159 and paying the necessary further processing fees within 2 months of notification of the Communication of 4/1/10 deeming PCT-JU withdrawn, i.e. by

4/1/10 + 10 days → 14/1/10 (R126(2) EPC)
14/1/10 + 2 months → 14/3/10, Sunday (R112(2) EPC)
14/3/10 → Monday, 15/3/10 (R134(1) EPC)

- In principle, KA could get an assignment executed that transfers the rights in PCT-JU fully to KA before entering the European regional phase. However, in practice such an assignment only takes effect at the EPO only on production of appropriate evidence and after paying a fee (R22 EPC).
- Thus, in practice it will be much more convenient to deal with this after regional phase entry has been effected.
- As such, a professional representative (me) will be needed to complete the acts for late entry into the regional phase. This is because JU are currently named as an Applicant and, as a legal person not having a principal place of business in a Contracting State, they are required to be represented in proceedings before the EPO as designated office after the initial 31 month period for entry into the national phase (A133(2) EPC, A27(7) PCT, How to get a European Patent Euro PCT Part 2, S309).
- I can take the necessary steps myself without a separate authorisation. (R152 EPC; Dec Pres Spec Ed 3 of OJ 2007, L1).
- These steps are:
 - (a) supplying a translation of the international application
 - (b) specifying the documents on which the European grant procedure is to be based
 - (c) paying the filing fee
 - (d) paying the designation fee (assuming the ISR issued at least 6 months previously)
 - (e) paying the supplementary search fee
 - (f) filing a request for examination – including paying the examination fee (again assuming the ISR issued at least 6 months previously)
 - (g) paying the renewal fee for the 3rd year.

For items (a), (c), (d), (e) and (f), the further processing fees must also be paid (for (f) for both requesting examination and paying the examination fee). For (g) an additional fee (50%) is payable because the due date has been missed. As the 4th year renewal fee will be due soon (End of May 2010) it would also make sense to pay this now to avoid forgetting it later (we are within the 3-month allowable pre-payment period).

- Once entry into the EP regional phase has been completed, the EPO will publish the translation of the application and the European prior right effect will come into existence.
- Normally the publication takes about 6-12 weeks. Unlike for direct European applications there is no direct provision allowing for early publication, but I would recommend filing, when completing the acts for entry into the regional phase, an informal request for prompt publication on the basis that it is relevant to an opposition on another European patent (see below). Clearly, a careful watch should be in place to ensure publication occurs in good time.
- Once PCT-JU's translation has been published by the EPO, an opposition can be filed against EPF based on lack of novelty over PCT-JU as a European prior right. Unlike EP4, PCT-JU does specifically disclose in its description nets made of the specific material M and it is therefore novelty-destroying for EPF. Note that the whole content of PCT-JU is relevant, not just the claims.

- The opposition deadline is 9/9/09 (date of publication of mention of grant of EP4) + 9 months = 9/6/10 (A99(1) EPC).
- PCT-JU is prejudicial to novelty for EPF for all states because EPF was filed after entry into force of EPC 2000 (see transitional provisions already discussed above).
- Further, once EPF is revoked, its effect is void ab initio (A68 EPC), i.e. NF will not be required to pay any infringement costs.
- Of course, NF could also use this ability to have EPF revoked as a bargaining tool for reaching an agreement with SF instead of pursuing revocation. However, it would be prudent at least to ensure now that PCT-JU is validly regional-phased and available as a European prior right. NF could then, if desired, negotiate with SF in advance of expiry of the opposition period, e.g. for (free) rights to use the subject-matter of EPF in their territory of interest (probably only NO) and withdrawal of the infringement suit in exchange for not getting EPF revoked. This could have advantages for both sides:
 - SF would maintain their EPF patent and it would at least be more difficult for a third party to seek revocation throughout the national courts after expiry of the opposition period.
 - NF would be able to continue their activities, but EPF would block other parties from using this technology in the EP contracting states, including in NO (where EPF is validated, but which EP4 does not designate and where there could be problems national phasing PCT-JU – see below).
 - This puts NF in a strong negotiating position because SF clearly stand to lose most be not co-operating.
 - Should an agreement be reached, but relations deteriorate after the opposition period for EPF has expired, SF could still use the European regional-phased PCT-JU to attack EPF in national revocation actions (it appears action in just NO would suffice as both SF's and NF's activities are focussed there). A national action in NO is also an option instead of an opposition even in the absence of any negotiations.

4.

- Probably not.
- Although SF are Swedish, it appears that all of their activities are carried out in Norway (i.e. making and using the nets made of M).
- Therefore, patent protection in NO will be needed in order to use patent rights against SF.

EP4

- EP4 was filed in May 2007 and so cannot have designated NO (which joined the EPC only on 1/1/08). EP4 cannot therefore be used against SF in respect of their activities in NO.

Other Applications?

- There is no indication any national NO application was filed at the same time as filing EP4 and PCT-JU.
- The 12 month period for filing a new application (e.g. a NO national application or an EP application filed after NO joined the EPC) claiming priority from EP4 and/or PCT-JU expired in May 2008.

- Therefore no further applications look possible.

PCT-JU

- PCT-JU designates NO (all states designated and NO is a PCT-contracting state).
- However, it is not possible for the European regional phase application derived from PCT-JU to designate NO because NO was not an EPC-contracting state when PCT-JU was filed.
- The only way protection could be obtained for NO would therefore have been by entering the NO national phase directly.
- The time limit for entering the national phase in NO was 31 months from the priority date, May 2007 + 31m → December 2009.
- The period has thus expired.
- According to PCT Applicant's Guide – NP Vol II – NO (referring to R49.6 PCT), the national fee for entering the NO national phase must be paid by the 31 month deadline. If not paid, this can only be excused by re-establishment of rights requiring, *inter alia*, showing that the missed time limit was in spite of the Applicant taking “all due care” in the circumstances. As failure to enter the NO national phase was presumably deliberate (JU having lost interest in PCT-JU) it seems unlikely that the conditions for re-establishment will be met.
- It is therefore likely to be too late to obtain rights for NO from PCT-JU.
- A specialist on NO patent practice should nonetheless be consulted as soon as possible to check whether any options still exist for reviving PCT-JU in Norway.

EXAMINATION COMMITTEE III

Candidate No.

Paper D 2010 - Marking Sheet

		Maximum possible	Marks awarded	
			Marker	Marker
Part I	Question 1	4	3,5	3
	Question 2	5	5	5
	Question 3	5	5	5
	Question 4	4	3,5	4
	Question 5	4	4	4
	Question 6	5	4	3,5
	Question 7	4	3,5	3,5
	Question 8	5	5	4,5
	Question 9	4	4	4
Part II	Question 1	14	14	13
	Question 2	23	23	23
	Question 3	19	18,5	18
	Question 4	4	3,5	3
Total Part I + II		100	96,5	93,5

Examination Committee III agrees on 95 marks and recommends the following grade to the Examination Board:

☒ PASS
(50-100)

☐ COMPENSABLE FAIL
(45-49)

☐ FAIL
(0-44)

30 June 2010

Chairman of Examination Committee III