

Examiners' Report - Paper D 2010 - Part II

In this year's paper there were not so many applications or inventions. Hence, the analysis phase was relatively straightforward, but the candidates had to define important strategies and actions in order to accommodate the client's needs.

The analysis of the existing situation and the application of legal provisions (for example the steps to request further processing) was generally answered well. However, to achieve good marks it was also necessary to recognise and propose actions that correspond best to the client's requirements.

The main points in this year's paper were the following:

1. In the first part it had to be recognised that EPKM does not disclose the structure of the signal necessary for carrying out the fishing method because it only refers to EP1. Therefore, KA could render EPKM unpatentable due to a lack of sufficient disclosure by withdrawing EP1 before publication. It had also to be realised that priority from EP1 should not be claimed because then EP1 would be made publicly available with the publication of EP3 (as the priority document in the file of EP3) with the consequence that the fishing method in EPKM would then be sufficiently disclosed. Additionally, it was important to spot that the disclosure of the fishing method at the website of KM would, in combination with the structure of the signal as disclosed in EP3, stop any future patenting of the method.
2. In improving KA's patent situation in Europe, patent rights from EP3 were necessary. The report of KA became prior art when the filing date of EP3 was changed, so it was vital to restore the original filing date of EP3 and claim priority from EP2. Most of the candidates recognised this and proposed the correct procedure to achieve it, i.e. adding a claim to priority from EP2 in EP3 and using the priority document to file the missing parts (under Rule 56(3) EPC) so that the filing date would not be changed. However, the first step to take was to withdraw the already submitted missing parts as an answer to the communication of the EPO.
3. In helping Norwayfish against Swedishfish, most of the candidates recognised that the disclosure of EP4 was too general to be novelty destroying against EPF and that PCTJU could be used for a novelty objection in an opposition against EPF. Most of the candidates also recognised that it was still possible to enter the European regional phase of PCTJU through further processing and the majority proposed the correct series of steps to take. In order to answer the question correctly it was necessary to realise that due to the fact that the EPC entered into force in Norway only on 01.01.2008, Norway was designated in EPF but not in EP4, nor was it included in the EP designation of PCTJU (EP-PCT JU). However, under EPC2000, EP- PCTJU would be prior art for all contracting states (EPF filed after 12/2007, EPC 2000 applies for examination and opposition procedures concerning EPF). It is noted that candidates who proposed on the basis of Art 153 (4) EPC and Rule 165 EPC that it was only necessary to request further processing for payment of the EP filing fee and for filing a translation for PCT-JU in order to make it prior art under Art. 54(3) EPC did not lose marks.

4. In order to use patent rights against Swedishfish, which has all its activities in Norway, the client must have patent rights in Norway .
Attention had to be paid to the fundamental issue of checking the countries in which EP4, PCTJU or EPF may be enforced, thereby realising that, for the reasons mentioned above, Norway could not be designated in EP4 nor in EP-PCTJU.
As a consequence, KA had no patent rights in Norway that could be used to attack Swedishfish. It should, however, be investigated whether an entry into Norwegian national directly from PCTJU might be possible. Finally, with EPF revoked and no other patent rights existing in Norway, the use of material M would be free there.

Possible Solution - Paper D 2010 - Part II

1. Stopping KM and everyone else from having a patent for the fishing method (14 marks)

EP1 is the first filing for the signal attracting only adult fish. EPKM is the first filing for the fishing method using this signal.

The public conference and the video presented there are state of the art against EPKM, but since the characteristics of the signal were not disclosed in the video they do not constitute an enabling disclosure and cannot be considered as relevant prior art.

EPKM discloses the use of the signal for a fishing method, but it does not disclose the characteristics of the signal necessary to carry out the fishing method since it makes only a reference to EP1. For the fishing method claimed in EPKM to be sufficiently disclosed, EP1 must be available at the EPO on the filing date of EPKM (which is the case) and EP1 must be available to the public on or before the date of publication of EPKM.

EP1 has not been published yet. If publication of EP1 is avoided, then the fishing method of EPKM would be insufficiently disclosed and therefore not patentable. It is possible to withdraw EP1 before publication. Publication of EP1 will be in July 2010, so there are still about 2 months left before the termination of the technical preparations (5 weeks before publication). EP1 should be withdrawn within this time frame so that it will be certain that it will not be published. In addition, no priority should be claimed from EP1 for any further European patent application (eg. EP2, EP3) because after publication of that further application, which would take place in July 2010 (18 months from priority), the priority document, i.e. EP1, would be also available to the public as part of the file.

As referenced document EP1 will not be available to the public, EPKM will suffer from insufficiency of disclosure regarding the fishing method which will not be patentable. There are alternative courses of action at this point: KA could inform KM that their application would not be patentable as far as the fishing method is concerned in the hope that they will withdraw or abandon it or, in the case that EPKM is granted by the EPO, opposition can be filed against EPKM on the ground of lack of sufficiency of disclosure.

Moreover, the publication of the content of EPKM at the KM website on the day after EPKM's filing or the publication of EPKM itself in combination with the publication of the structure and the characteristics of the signal in the report of KA at the end of January 2010 will be enabling prior art against any future application related to the fishing method.

2. Improving KA's patent situation in Europe (23 marks)

EP2 is the first application disclosing the filter F1 and the circuit C1, but the disclosure of the circuit C1 is not enabling. EP3 is the first enabling disclosure of C1 and the inventive connection between C and F1.

The public conference and the video on January 20, 2009 cannot be used as prior art against EP2 or EP3 because the characteristics of the signal or the circuits to produce it were not disclosed and no enabling disclosure of the signal took place.

When/if EPKM is published it would be a prior art document relevant only for novelty (Art. 54(3) document) against EP2 and EP3, but not relevant because it does not disclose the nature of the signal or the circuit to produce it.

EP2 when/if published will be prior art document under 54(3) EPC relevant only for novelty against claims 1 and 2 of EP3.

EP2 can give KA protection for the filter F1 and the signal but not for the circuit C1 since it is not sufficiently disclosed. Hence, the only way KA can get protection for C1 is via EP3.

However, EP3 has had its filing date moved to 02.02.2010 after the submission of the missing parts. The report of KA with EP3 was made available to the public in the library, even if nobody consulted it, as of end of January 2010. The report will thus be novelty destroying for EP3 with the new date of filing. In order for KA to be able to get protection via EP3, it is necessary for EP3 to have a filing/priority date before the end of January 2010.

It is possible to recover the original filing date of EP3.

Your request for correction dated 02.02.2010 should be withdrawn to avoid the change of the filing date. This can be done within 1 month after notification of the communication under R56 EPC, i.e. until 27.03.2010, extended to 29.03.2010. Then EP3 will have a filing date before the publication of the report and the report will not be prior art anymore.

It is necessary to introduce the missing parts for sufficiency of disclosure of EP3. This is possible by claiming the priority of EP2 and requesting their introduction without changing the filing date.

EP3 was filed within 12 months from the filing date of EP2 which ended on 01.03.2010. A priority claim can be added until 16 months from the priority date, i.e. 01.07.2010 (according to Rule 52 EPC).

KA must request the addition of a claim to the priority of EP2 in EP3 and request correction (according to Rule 56(3) EPC) in order to introduce the missing pages 6 - 9. Request for correction is still possible until 12.03.2010 (i.e. 2 months from filing of EP3). Therefore, the withdrawal of the missing parts according to your request for correction dated 02.02.2010 has to be made before 12.03.2010, you can not wait until 29.03.2010. Neither can you wait for 01.07.2010 to add priority claim.

Claims to an underwater camera comprising the circuit C1 and the inventive connection between F1 and C could be added in EP3 or in a possible divisional patent application.

3. Helping Norwayfish (NF) in their conflict with Swedishfish (SF) (19 marks)

EPF validly claims priority from S1, therefore the effective date of EPF is in October 2007. EP4 is prior art document under Art. 54(3) EPC against EPF. Since EP4 does not disclose material M but only the general class G, EPF is new over EP4.

The only document which discloses material M is PCTJU. If PCTJU validly enters the European regional (EP) phase, it would be prior art document under Art. 54(3) EPC

against EPF. KA should accept the offer of JU and have the patent rights of PCTJU transferred to them.

The time limit for PCTJU to enter EP phase (31 months from filing) ended in December 2009. It is still possible to ask for further processing which should be done within 2 months from the notification of the communication of loss of rights. The two months end on 14.03.2010, extended to 15.03.2010. With the request for further processing, all the acts due for entry into the EP phase should be completed and the fee for further processing should be paid, for each omitted act.

[Pursuant to Art. 153 and Rule 165 EPC it appears sufficient to create prior art under Art. 54(3) EPC if the translation of PCTJU is submitted, the filing fee and the respective further processing fees are paid. However, it is advisable in the present case to complete all omitted acts to enter the EP phase to make sure that the application is published given the fact that without compliance with the requirements of Rule 159 EPC the application is deemed to be withdrawn as from expiry of the 31 months' time limit.]

In order to enter the EP phase after the expiry of the 31 months time limit, KA and JU can act as joint applicants but must act via a professional representative. Alternatively, if the transfer of rights takes place before the entry in EP phase, KA can act alone but they must request the registration of the transfer at the EPO upon entry.

Since EP-PCTJU has become prior art under Art. 54(3) EPC, an opposition should be filed against EPF based on lack of novelty. The time limit to file opposition against EPF ends on 09.06.2010.

EPF was filed after January 2008 and therefore is deemed to designate Norway, since Norway acceded to the EPC on 01.01.2008. PCTJU on the other hand, was filed before January 2008 and therefore EP-PCTJU cannot designate Norway. However, (EPC 2000 applies and) EP-PCTJU will be a prior art document under Art. 54(3) EPC against EPF for all contracting states, so EPF will be revoked and SF will lose the protection rights of EPF in all EPC states, including Norway. With EPF revoked, the infringement proceedings against NF should not be successful.

4. Using patent rights against Swedishfish (SF) (4 marks)

EP4 was also filed before January 2008 and cannot designate Norway. SF has all its activities based in Norway, therefore we can use rights against SF only if we have patent rights in Norway. Neither EP4 nor EP-PCTJU would give rights in Norway and NF cannot use them against SF.

PCTJU had designated Norway and could have entered the Norwegian national phase directly. However, the time limit to enter the Norwegian national phase has expired. It should be investigated whether it is still possible to enter the Norwegian national phase now. If it is possible to enter Norwegian phase of PCTJU then KA will have a Norwegian patent covering material M; SF will be infringing this patent and could be sued/stopped. If it is not possible anymore to enter the Norwegian national phase of PCTJU then the use of material M in Norway will be free for everybody after the revocation of EPF since there will be no patent right protecting it.

EP4 and EP-PCTJU could be used as prior right against S1, depending on Swedish law.

EXAMINATION COMMITTEE IIICandidate No.

Paper D 2010 - Marking Sheet

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

Examination Committee III agrees on 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