

Examiners' Report Paper D 2012 - Part II

The DII paper requires candidates to analyse a situation concerning various existing patent rights and suggest specific actions that are usually to be carried out within a time limit. Care should be taken to correctly calculate the time limits.

This year the main aspects of the paper were:

- the priority claim for claim 1 of EP-2 was invalid since it was directed to a generalisation not directly and unambiguously derivable from EP-1;
- claim 2 of EP-2, claiming validly the priority from EP-1, was novelty destroying for claim 1 of EP-WG;
- the interview with the examiner set for the following day indicated that the international preliminary examination report (IPER) of PCT-1 had not been issued yet despite the expiration of the 31 month time limit; consequently the submissions of Membrain were not yet publicly available so that a new application based on them could still be filed;
- the time limit for PCT-1 to enter the European regional phase had been missed but it was still possible to enter through the further processing procedure;
- it was possible to attack EP-CART for lack of inventive step by having Dialab appeal the decision of the opposition division and by Membrain intervening in the pending opposition-appeal proceedings;
- the encyclopaedia could be used as proof of common general knowledge despite the fact that it was published on the filing date of EP-CART and was not itself part of the state of the art.

Regarding the specific questions:

Question 1

Most candidates realised that PCT-1 and EP-2 fulfilled the formal requirements for claiming priority from EP-1: identity of applicant and filing within the priority period. They also realised that claim 1 of EP-2 could not benefit from the priority of EP-1 since it was not directed to the same invention as EP-1. The consequence that this claim was lacking novelty over the website posting by Watergate was also recognised by many candidates.

A lot of candidates correctly stated that claim 2 of EP-2 enjoyed the priority of EP-1 and was novelty destroying for claim 1 of EP-WG.

Most of the candidates stated that the normal time limit for PCT-1 to enter the European regional phase had expired. Not all of them, however, commented on the missed time limit to enter the US national phase.

Few candidates recognised that the objection for missing essential features in the claim of PCT-1 would be very likely dropped.

Question 2

A lot of candidates suggested that Membrain should file a new application related to the subject matter described in the reply submitted for PCT-1.

Not all of those were familiar with the fact that the international preliminary examination (IPE) is confidential until the issue of the IPER and the submissions made by Membrain were not immediately made available to the public. Fewer candidates reached the conclusion that, since Membrain had an interview with the examiner set for the following day, the IPE had not finished yet and the file had not been made accessible to the public by the EPO. Those candidates suggested that the new application should ideally be filed at the latest on the day of the interview since the IPER could be issued any moment thereafter.

Few candidates elaborated on the eventual geographic coverage and the possible claims of the new application.

Question 3

Most of the candidates recognised that it was still possible to enter the European regional phase of PCT-1 by requesting further processing. Very few candidates, however, stated that this can be done even before the notification of loss rights is issued by the EPO.

Very few candidates suggested that Membrain should file third party observations /opposition based on Euro-PCT 1 and/or EP-2 against EP WG in order to invalidate its first claim.

Many candidates provided an analysis of what scope of protection Membrain and Watergate would obtain after the suggested actions were carried out. Not all of them, however, drew conclusions about how the resulting rights could be used by Membrain and Watergate to prevent each other from exploiting their inventions. Some candidates suggested reasonable licensing agreements.

Question 4

Most of the candidates recognised that the correct way to respond to the infringement proceedings instituted against Membrain was to have Dialab appeal the decision of the opposition division so as to give to Membrain the opportunity to intervene as assumed infringer. With respect to filing the appeal, most of the candidates stated the required actions. Regarding the intervention procedure, however, insufficient details were given by most of the candidates.

Many candidates realised that the encyclopaedia was not part of the state of the art, but could be used as proof of common general knowledge. They recognised that the only reasonable attack against EP-CART was based on lack of inventive step. Not all of those candidates, however, provided an argumentation against EP-CART based on the combination of D1 with this common general knowledge.

Few candidates recognised that lack of inventive step was a fresh ground of opposition and that if Dialab raised it, it would only be admitted with the consent of Watergate. Raised by Membrain as intervener, it would be admitted without this restriction.

Possible solution - Paper D 2012 - Part II

Answer to question 1

EP-1 was validly filed as no claims are needed for accordance of a filing date. EP-1 is the first filing for a membrane module comprising the special nozzle N and the combination of ceramic membranes C and the nozzle made of stainless steel.

EP-2 was filed within the priority period, 31.7.2010 extended to 2.08.2010. Priority can be claimed from EP-1 as the subsequent fate of the application is irrelevant. The priority is not valid for claim 1 in EP-2 as it is directed to a generalisation not derivable from EP-1, i.e. not to the same invention. The handbook is prior art under Art. 54(2) EPC for claim 1 of EP-2. The website posting is prior art under Art. 54(2) EPC for claim 1 of EP-2. The disclosure on the website destroys novelty of the subject-matter of claim 1 of EP-2.

The priority is valid for claim 2 of EP-2 as it is directed to the specific combination of ceramic membranes and the nozzle made of stainless steel disclosed in EP-1. Claim 2 of EP-2 is novel and inventive.

PCT-1 validly claims priority from EP-1 as it was filed within the priority period and the claim of PCT-1 is unambiguously and directly derivable from the general part of EP-1. The subject-matter of the sole claim of PCT-1 is novel and inventive.

US-WG is the first filing for a module with nozzle N and a bundle of fibres made of polymer P and there is no relevant prior art. EP-WG validly claims priority as it was filed within the priority period, i.e. 30.4.2011 extended to 2.5.2011, and directed to the same subject-matter as US-WG due to filing by reference. As EP-WG was published and its priority is valid, EP-WG is 54(3) EPC prior art for claim 1 of EP-2. The subject-matter of claim 2 of EP-2 is 54(3) EPC prior art against the subject-matter of claim 1 of EP-WG because claim 2 of EP-2 validly claims priority from EP-1. The subject-matter of claim 1 of EP-WG is not novel in view of claim 2 of EP-2.

The demand for PCT-1 was validly filed as the time limit is the transmittal of ISR plus 3 months.

There is sufficient evidence before the examiner that a module also works with other materials than ceramic fibres; the objection as to the missing essential feature is likely to be dropped resulting in a positive IPER.

The time limit of 30 months for entering the US national phase with PCT-1 has lapsed.

Answer to question 2

The evidence submitted to the EPO and concerning the revolutionary membranes comprising the coating is NOT yet made available to the public due to the confidential nature of the IPE. The EPO allows access to the IPE files once IPER has been established. IPER has not been established as the interview with the examiner has not been held yet.

File a new application directed to the revolutionary membranes at the latest tomorrow, i.e. the date of the interview. The new application should be (a) a PCT application, (b) a priority filing for a subsequent PCT application in order to cover the relevant markets including the emerging countries or (c) national filings for those countries. This time, ensure you seek protection in the US in order to obtain patent rights that would prevent Watergate from manufacturing in the US. The claims in the new application(s) should be directed to a membrane fibre made of polymer P and comprising the coating K. Include also dependent claims e.g. directed to a bundle of those membranes, bundle plus means for injecting air into the bundle.

Answer to question 3

Time limit for entering the EP-phase with PCT-1 lapsed on 29.02.2012. However, further processing is still possible. Further processing can be requested even before receiving notification of the loss of rights.

Request further processing by paying the fees and complete the omitted acts, i.e. all steps necessary to enter the regional phase.

Once the filing fee has been paid for PCT-1 (Euro-)PCT-1 will be Art. 54(3) EPC prior art against claim 1 of EP-WG.

File third party observations or an opposition against EP-WG pointing to Euro-PCT-1 and/or EP-2.

Watergate will be able to obtain a European patent based on claim 2 of EP-WG.

Provided that the national requirements are met, Watergate may claim compensation from Membrain based on provisional protection conferred by EP-WG as Membrain are manufacturing the modules in Austria.

In turn, Membrain might be able to claim compensation based on provisional protection conferred by PCT-1.

Watergate will have patent rights to the modules using polymer P membranes enabling them to prevent Membrain from exploiting modules comprising the membranes made of P, with or without the coating with K. Membrain will be able to prevent Watergate from exploiting Watergate's modules using membranes made of P and comprising the nozzle N in Europe and in the

emerging countries using the rights conferred by national patents based on PCT-1.

Negotiate a cross-license agreement that may include: Membrain can produce modules made of P in Europe and Watergate can produce modules comprising the nozzle N in Europe.

Neither Watergate nor Membrain will have protection for the modules using cheaper nozzles available on the market together with membranes without the coating K, thus, Membrain can produce/sell those modules, but cannot prevent Watergate from doing the same.

Answer to question 4

The decision of the opposition division is still open to appeal, as the two-months time limit runs from notification of the written decision. The time limit for filing the appeal is 8.05.2012. The time limit for filing the statement of grounds is 9.07.2012.

The Encyclopaedia was published on the filing date of EP-CART, and thus is not prior art itself. However, a teaching doesn't become common general knowledge because it is published in a textbook but rather is included therein because it was common general knowledge before the date of publication of the book. The Encyclopaedia reflects common general knowledge; thus the Encyclopaedia may be used as evidence to show that it was common general knowledge before the filing date to use compound R for pore size control.

The subject-matter of claim 1 thus lacks an inventive step over the combination of D1 and common general knowledge since there is no unexpected technical effect.

Lack of inventive step is a fresh ground of opposition.

If Dialab appeals, Membrain may intervene as an assumed infringer even at the appeal stage. The time limit for intervention is 3 months from institution of the infringement proceedings against Membrain, i.e. 7.05.2012. In order to keep the proceedings running Dialab must file a notice of appeal: pay the appeal fee and file reasons in due course.

In appeal proceedings a fresh ground of opposition by the opponent-appellant will be examined only if the patentee agrees. Thus, if Dialab themselves raise the fresh ground of inventive step, Watergate must agree to the examination of this ground of opposition. In contrast, if Membrain intervene in the appeal proceedings, they may raise this fresh ground without the consent of Watergate.

Membrain must file a notice of intervention; include proof of institution of the infringement proceedings, pay the opposition fee, submit reasons; raise the ground of lack of inventive step based on D1 and common general knowledge. Common general knowledge does not need to be substantiated unless contested, but as it is likely that Watergate will challenge this, it is prudent to file a copy of the Encyclopaedia as soon as possible, i.e. together with the notice of intervention.

Make sure that Dialab do not withdraw their appeal since otherwise the proceedings would be terminated.

EXAMINATION COMMITTEE III

Candidate No. _____

Paper D 2012 - Marking Sheet

Category		Maximum possible	Marks awarded	
Part I	Question 1	5		
	Question 2	6		
	Question 3	5		
	Question 4	4		
	Question 5	5		
	Question 6	6		
	Question 7	4		
	Question 8	5		
Part II	Question 1	20		
	Question 2	9		
	Question 3	12		
	Question 4	19		
Total		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)

28 June 2012

Chairman of Examination Committee III