

Examiners' Report Paper D 2013

This year candidates had the flexibility to manage the distribution of their time between part I and part II. It was observed that some candidates had difficulties with time management.

Examiners' Report Paper D 2013 - Part I

Candidates are reminded to accept the facts given in the paper and to limit themselves to these facts (see in particular questions 2, 3 and 4).

Candidates are also reminded to use the legal bases applicable on the date stipulated in the Implementing Regulations. In particular, this year many candidates appeared to refer to outdated Rules relating to Fees and outdated Guidelines for Examination.

Question 1

Most candidates recognised the fact that the passage in US1 is part of the content of EP1 because US1 was available to the EPO on the date of filing EP1 and available to the public on the date of publication of EP1.

Some candidates thought that a document cross referenced in the description of an application is to be treated as filing by reference under Rule 40 EPC.

Several candidates suggested introducing the passage of US1 into the description of EP1 although this is not necessary for sufficient disclosure of the compound.

Question 2

This question was generally well answered.

Most candidates correctly applied the provisions of Rules 36(1)(a) and 36(1)(b) EPC and recognised that the notification of the minutes of the telephone conversation triggered the time limit under Rule 36(1)(b) EPC.

Some candidates erroneously applied Rule 133 EPC and argued that since the divisional to EP1 was filed more than five days before expiry of the time limit it shall be deemed to have been received in due time. However, the question does not contain any indication that the divisional was received no later than three months after expiry of the time limit.

Question 3

The majority of candidates recognised that translations of the patent as amended have to be supplied and the costs of the publication of such translations have to be paid to the national offices.

A large number of candidates did not realise that renewal fees have to be paid to the national offices. Of those that did mention the renewal fees, many wrongly referred to the fees for the fifth year.

Although the question mentions an interlocutory decision in opposition proceedings, some candidates referred to the provision of Rule 71 EPC rather than Rule 82 EPC.

Question 4

Although it is apparent from the question that the opposition was based on an unspecified document which was identified only after expiry of the opposition period, many candidates

nonetheless assumed that the identification of the document within the opposition period was implied by its use as a basis for the ground of opposition. These candidates answered as if the opposition was admissible. As a result, candidates inappropriately applied the provisions of Article 114 EPC and concluded that the late filed document would be taken into account.

Some candidates did not realise that the opposition division can not exercise its discretion under Article 114(1) EPC if the opposition is rejected as inadmissible.

Question 5

Many candidates correctly answered those parts of the question relating to representation in the international phase. Where mistakes were made these related to not recognising that Mr Surat will be the common representative irrespective of whether he is mentioned first, and not recognising that an Indian agent is entitled to represent the applicant before the EPO acting as IPEA.

Moreover, few candidates recognised that because Mr Surat has to appoint a professional representative, Mr Wilson cannot represent both applicants in the European phase.

Question 6

This question was generally not well answered.

Candidates picked up some marks by calculating the time limit for paying the additional search fee and the time limit for replenishing the debit account. Very few candidates realised that a debit order for the administrative fee also has to be sent.

Examiners' Report Paper D 2013 - Part II

The second part of the D 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:

Question 1

- the independent claim to a pan with 3D protrusions of EP-HEMI could not validly claim priority from DE-HEMI, since DE-HEMI was not the first application by Schnell-Koch for that subject-matter;
- EP-3D was pending until the expiry of the appeal period against its refusal, DIVI-3D therefore was filed in time;
- the disclosure of pans with cubic protrusions in DIVI-3D extended beyond the content of EP-3D, therefore no patent protection could be obtained for said subject-matter via DIVI-3D; DIVI-3D could be "repaired" by deleting the passage relating to pans with cubic protrusions, and by filing an amended claim which overcame the clarity objection.

Comments to question 1

Surprisingly few candidates realised that the independent claim of EP-HEMI could not enjoy priority from DE-HEMI. Apart from that, the patent situation was discussed well by most candidates. However, many candidates did not properly indicate in which application a specific type of protrusion was disclosed for the first time.

Most candidates realised that DIVI-3D was filed in time, i.e. within 24 months after the first communication and before the expiry of the appeal period. They also realised that the disclosure of a pan with cubic protrusions in DIVI-3D extended beyond the content of EP-3D. However, a significant number of candidates wrongly concluded that DIVI-3D could lead to a patent for a pan with cubic protrusions on the incorrect basis that the subject-matter of cubic protrusions could be allocated its own date of filing.

Question 2

- a translation of the notice of opposition into an official language had to be filed with the EPO before the meeting with Mr Gusto in order to make sure that the notice of opposition was deemed to have been filed;
- EP-3D belonged to the state of the art under Article 54(3) EPC for the dependent claim of EP-HEMI, and therefore could not be used for attacking inventive step thereof.

Comments to question 2

Most candidates were familiar with Article 14(4) EPC and therefore correctly identified the need to file a translation of the notice of opposition into an official language of the EPO. However, quite a few candidates wrongly calculated the time limit for filing the translation from the end of the opposition period.

Many candidates realised that EP-3D cannot be considered for assessing the inventive step of the dependent claim of EP-HEMI. However, a number of candidates did not come

to the conclusion that Schnell-Koch could therefore be expected to file amendments / an auxiliary request directed to hemispherical protrusions.

Questions 3a+b

- any type of 3D protrusion fell under the scope of DIVI-3D in Italy and Germany; Buona Cucina therefore would infringe DIVI-3D by producing such pans.

Comments to questions 3a+b

Most candidates recognised that Buona Cucina could use IT-PYR for preventing competitors from manufacturing pans with pyramidal protrusions in Italy. An alarming number of candidates incorrectly concluded that a granted IT-PYR will give Buona Cucina freedom to produce and sell pans with pyramidal protrusions. Such advice is incorrect and leads to substantial risk for the client. In the present case, any pan with pyramidal protrusions will fall under the scope of any claim directed to pans with 3D protrusions. Candidates should remember that a patent is not a positive right to operate.

Question 3c

- Dr Serrano was the true inventor of a pan with 3D protrusions and of a pan with cubic protrusions;
- entitlement proceedings (Art. 61 EPC) for DIVI-3D should be instituted against Schnell-Koch. After the final court decision, DIVI-3D should be taken over, or a new European patent application should be filed; thereby, Buona Cucina would obtain the generic patent to a pan with 3D protrusions; EP-HEMI would then become a dependent patent;
- the disclosure of a pan with cubic protrusions in DIVI-3D is considered an evident abuse (Art. 55(a) EPC); a European patent application EP-CUB therefore should be filed.

Comments to question 3c

Most candidates realised that Schnell-Koch was not entitled to a patent for a pan with 3D protrusions or to a patent for a pan with cubic protrusions.

Many candidates suggested entitlement proceedings but often did not indicate for which application the proceedings should be brought against Schnell-Koch. Some candidates inappropriately indicated EP-HEMI, EP-3D or the cubic subject-matter mentioned in DIVI-3D.

Some candidates stated that the proceedings before the EPO would be stayed but not all indicated the need to provide the required evidence.

Very few candidates realised that Schnell-Koch's disclosure of a pan with cubic protrusions in DIVI-3D was an evident abuse under Article 55 EPC and that a new European patent application could be filed for a pan with cubic protrusions within 6 months of the publication of DIVI-3D.

Possible solution - Paper D 2013 - Part I

Answer to question 1

For a compound to be enabled, the process for making the compound has to be disclosed. EP1 comprises a reference to the relevant specific passage of US1 in which the process is disclosed.

Since the applicant submitted US1 together with EP1, a copy of US1 was available to the EPO on the date of filing of EP1, and US1 is part of the file of EP1. According to Article 128(4) EPC, after publication of EP1 the file relating to EP1 may be inspected by the public on request. Therefore, US1 was made available to the public on the date of publication of EP1.

Thus, in accordance with the Guidelines H-IV, 2.3.1 or H-IV 2.5 or F-III 8 or decision T 737/90 the disclosure of the process in US1 forms part of the content of EP1. Hence, the European patent discloses the invention in a manner sufficiently clear and complete for it to be carried out by a person skilled in the art and the Opposition Division will not revoke the patent.

Answer to question 2

According to Rule 36(1) EPC, the applicant may file a divisional application relating to any pending European patent application subject to the time limits set out in (a) and (b). Both EP1 and EP2 are pending.

- a) Pursuant to Rule 36(1)(a) EPC, any divisional to EP1 must be filed before the expiry of twenty-four months from the Examining Division's first communication in respect of the earliest application (here EP1). The Examining Division has not issued a communication raising an objection that EP1 does not meet the requirements of Article 82 EPC (Rule 36(1)(b) EPC). The first communication was deemed notified on 11 February 2011 (1 February 2011 + 10 days, Rule 126(2) EPC). Thus, a divisional to EP1 could have been filed up to 11 February 2013. Today the time limit has expired but it was still running when the applicant attempted to file DIV1. According to Rule 135(2) EPC, further processing is ruled out in respect of the period under Rule 36(1)(a) EPC. It follows from Rule 136(3) EPC, that re-establishment of rights under Article 122 EPC is available. The request for re-establishment of rights and DIV1 have to be filed within two months of 20 February 2013 (Rule 136(1) EPC), i.e. the request and DIV1 can be filed up to 20 April 2013. This period is extended under Rule 134(1) EPC to Monday 22 April 2013.
- b) Pursuant to Rule 36(1)(b) EPC a divisional application can be filed before the expiry of a time limit of twenty-four months from the communication in which the Examining Division raised a specific objection under Article 82 EPC for the first time. According to the Guidelines A-IV, 1.1.1.3(iv), the time limit is to be calculated from the notification of the minutes of the telephone call. The minutes are deemed notified on 28 November 2011 (18 November 2011 + 10 days, Rule 126(2) EPC). Thus, the time limit expires on 28 November 2013, and a divisional DIV2 to EP2 can still be validly filed.

Answer to question 3

- a) The Opposition Division will invite the patent proprietor to file a translation of the amended claims into English and German and pay the prescribed fee, Rule 82(2) EPC. According to Article 2(1) No. 8 Rules relating to Fees, the fee for publishing a new specification is 70 €.
- b) Renewal fees for the 6th year have to be paid to the national offices, Article 141(1) EPC. These fees are 100 € for Austria, 100 CHF for Switzerland and 160 € for the Netherlands, "National law relating to the EPC", Table VI, column 1.

According to Articles 65(1), 65(2) EPC and the London Agreement:

For Austria, a translation into German of the description and claims as amended has to be supplied. The cost of publication of the translation is to be paid. The cost is 180 € plus 130 € for every 15 pages following the 16th page of the translation.

For the Netherlands, a translation of the claims into Dutch must be supplied. Because the patent has been granted in French, a translation into English must be supplied. The translation may also be supplied in Dutch. The cost of publication of the translation is to be paid. The cost is 25 €.

For Switzerland no translation is required and no fee is to be paid.

Answer to question 4

Within nine months of the publication of the mention of the grant of EP1 in the European Patent Bulletin, a notice of opposition can be filed, Article 99(1) EPC. The time limit expired on 21 December 2012. According to Rule 76(2)(c) EPC the notice of opposition shall contain an indication of the facts and evidence presented in support of the grounds of opposition. The notice of opposition referred to an unspecified document, and therefore, does not meet the requirements of Rule 76(2)(c) EPC. Since the document was only identified after expiry of the opposition period, the indication of the evidence was presented too late, and the opposition will be rejected as inadmissible, Rule 77(1) EPC. EP1 cannot be revoked based on the document.

It is to be noted that documents which are prima facie highly relevant but submitted after the expiry of the opposition period can only be taken into account in accordance with Article 114(1) EPC and decision T1002/92 or Guidelines E-V, 2 if an admissible opposition is pending.

Answer to question 5

- a) Mr Surat may be appointed as common representative in the international phase in accordance with Rule 90.2(a) PCT either by indicating in the request that Mr Surat should be the common representative with each applicant signing the request, or by each applicant signing a separate power of attorney, Rule 90.4(a)-(c) PCT.

If the applicants do not appoint a common representative, the applicant first named in the request who is entitled to file an International application with the receiving Office shall be considered to be the common representative of all the applicants, Rule 90.2(b) PCT. Since Mr Surat is the only applicant entitled to file an International application at the Patent Office of India, he will be the common representative.

- b1) In accordance with Article 49 PCT or Rule 90.1(a) PCT, a person having the right to practice before the national Office with which the International application is filed may be appointed by the applicant to represent him before the International Preliminary Examining Authority. Thus an Indian agent may be appointed.
- b2) According to Rule 90.1(c) PCT, a person having the right to practice before the EPO acting as the International Preliminary Examining Authority may be appointed by the applicant to represent him before that Authority. Thus a European professional representative may be appointed.
- c) Since Mr Surat does not have his residence in a Contracting State of the EPC, he has to be represented by a professional representative, Article 133(2) EPC. Thus, Mr Surat is obliged to appoint a professional representative and this representative shall be deemed to be the common representative, Rule 151(1) EPC. Thus, Mr Wilson, an employee of company A, cannot be appointed as common representative.

Answer to question 6

If, within a period of one month of receipt of the fax, i.e. before 25 February 2013, the account is sufficiently replenished to enable payment of the second search fee, and within the same period an administrative fee is paid, then the date on which the debit order was received shall be considered to be the date on which payment was made, see Arrangement for deposit accounts (ADA) 6.5. According to Article 2(1) No. 2 Rules relating to Fees or the Agreement between the EPO and WIPO under the PCT published in OJ 3/12, the search fee in respect of an international search is 1875 €. The administrative fee is 30% of the shortfall, but not less than 50 € or more than 305 €, ADA 6.6. Although replenishing the account with 3000 € is sufficient to pay both fees, the client should have sent a debit order for the administrative fee –or paid the fee by any other means- within the 1 month time limit. Since the debit order was not sent in time, the payment of the additional search fee is considered to have been made on the date on which the deposit account was duly replenished, i.e. on 22 February 2013, ADA 6.7.

The time limit set by Rule 40.1(ii) PCT to pay the additional fee is one month from the date of the invitation and expired on 11 February 2013, Rule 80.2 PCT. As this date is earlier than the date on which the payment of the additional search fee is considered to have been made, the additional search fee is not paid in time and the international search report will be established on those parts of the International application which relate to the invention first mentioned in the claims, i.e. claim 1, Article 17(3)(a) PCT.

Possible solution - Paper D 2013 - Part II

Question 1

Analyse the patent situation for frying pans with

- a) 3D protrusions, and in particular with
- b) pyramidal,
- c) hemispherical and
- d) cubic protrusions:

a) EP-3D is the first application directed to a frying pan with 3D protrusions.

The independent claim directed to 3D protrusions of EP-HEMI cannot validly claim priority from DE-HEMI, since DE-HEMI was not the first application by Schnell-Koch directed to a frying pan with 3D protrusions.

EP-3D was published before the filing date of EP-HEMI. EP-3D belongs to the state of the art (under Article 54(2) EPC) for the independent claim of EP-HEMI.

The independent claim of EP-HEMI lacks novelty over EP-3D.

The appeal period against the refusal of EP-3D expired on 5 June 2012 and EP-3D was pending until that day.

The 24-month time limit for filing a divisional application expired at the earliest in July 2012.

Thus, DIVI-3D related to a pending European patent application and was filed in time. By amending DIVI-3D, i.e. by removing the added subject-matter relating to cubic protrusions, and by filing an amended claim overcoming the clarity objection, a patent for a frying pan with 3D protrusions can be obtained, since there is no prior art disclosing a frying pan with 3D protrusions, i.e. a claim to a frying pan with 3D protrusions is novel, and 3D protrusions heat up the food much faster than a flat surface, i.e. they involve an inventive step.

b) IT-PYR is the only application directed to a frying pan with pyramidal protrusions. Buona Cucina can obtain a patent for a frying pan with pyramidal protrusions in IT because there is no prior art disclosing a frying pan with pyramidal protrusions, and since pyramidal protrusions reduce vitamin loss in fried food, i.e. they involve an inventive step.

The priority period for IT-PYR has expired, so that no further patent application can validly claim priority from IT-PYR.

c) DE-HEMI was the first patent application directed to a frying pan with hemispherical protrusions. EP-HEMI validly claims priority for hemispherical protrusions from DE-HEMI, since it was filed by the same applicant within the priority year. The deemed withdrawal of DE-HEMI does not affect the right to priority.

EP-3D is prior art under Article 54(3) EPC for the dependent claim of EP-HEMI.

The dependent claim of EP-HEMI is novel over EP-3D. The dependent claim of EP-HEMI involves an inventive step, since hemispherical protrusions can be cleaned easily and do not become encrusted with food residues.

d) DIVI-3D is the first patent application which discloses a frying pan with cubic protrusions. However, the disclosure of a frying pan with cubic protrusions in DIVI-3D extends beyond the content of EP-3D. Therefore, no patent protection for a frying pan with cubic protrusions can be obtained via DIVI-3D.

Pans with cubic protrusions were disclosed by the publication of DIVI-3D. Pans with cubic protrusions were also disclosed at the trade fair "Hot Pans 2013".

Question 2

Analyse the status of our opposition against EP-HEMI. Discuss what can be achieved by our opposition, and advise on any necessary actions.

The opposition period for EP-HEMI expired on 2 February 2013, carried on to 4 February 2013. The opposition was received by the EPO on time.

Buena Cucina may file the notice of opposition in Italian. However, a translation into an EPO official language shall be filed within one month of filing the notice of opposition. The one month period expires on 1.3.2013 i.e. before the meeting with Mr Gusto.

You are entitled to file the translation because Buena Cucina's letter instructs you to act on their behalf. You could also ask Buena Cucina to ensure that the translation is filed.

Due to the lack of novelty of the independent claim of EP-HEMI over EP-3D, the independent claim of EP-HEMI cannot be maintained.

EP-3D belongs to the state of the art under Article 54(3) EPC and thus, EP-3D cannot be used for attacking inventive step of the dependent claim of EP-HEMI, as incorrectly stated in Buena Cucina's notice of opposition.

As EP-3D only belongs to the state of the art under Article 54(3) EPC, it is very likely that Schnell-Koch will file amendments/an auxiliary request limited to the dependent claim. Schnell-Koch would then retain a patent EP-HEMI directed to a frying pan with hemispherical protrusions.

Question 3

- a) Are we free to act in our two markets?
- b) Can we prevent our competitors from selling such pans in our two markets?

Buona Cucina cannot in particular manufacture, sell or offer frying pans with hemispherical protrusions in Italy or in Germany, if Schnell-Koch pays the renewal fee for Germany for EP-HEMI, since they would infringe EP-HEMI.

A frying pan with cubic protrusions falls under the scope of the independent claim of DIVI-3D. In Italy and Germany. Buona Cucina will infringe DIVI-3D by producing frying pans with any type of 3D protrusions in their Italian factory / by selling or offering them.

Due to IT-PYR, Buona Cucina can prevent competitors from selling, offering or manufacturing frying pans with pyramidal protrusions in Italy.

- c) Can either of these positions be improved? If so, how?

True inventor:

Dr Serrano is the true inventor of the concept of 3D protrusions. He is also the true inventor of a frying pan with cubic protrusions. Since Dr Serrano also sold Buona Cucina

the right to file patent applications, Buona Cucina should bring entitlement proceedings for DIVI-3D against Schnell-Koch.

Alternative A:

Take over DIVI-3D, then correct the Article 76 EPC problem by deleting the passage about cubic protrusions, and file amended claims directed to a frying pan with 3D protrusions.

Alternative B:

File a new European patent application (DIVI-3D-NEW) in respect of only the subject-matter disclosed in EP-3D, in the name of Buona Cucina, with claims directed to a frying pan with 3D protrusions.

Provide evidence to the EPO that entitlement proceedings were brought against Schnell-Koch, in order to stay the proceedings of DIVI-3D.

DIVI-3D-NEW / DIVI-3D will be granted, and Buona Cucina will obtain the generic patent for 3D protrusions in Germany and Italy. Any competitor of Buona Cucina will infringe DIVI-3D-NEW / DIVI-3D by manufacturing, selling or offering frying pans with any type of 3D protrusions, in Germany or Italy.

Once Schnell-Koch starts selling their frying pans with hemispherical or cubic protrusions, Buona Cucina can stop Schnell-Koch in Germany or Italy by bringing infringement proceedings against Schnell-Koch.

EP-HEMI is a dependent patent, since a frying pan with hemispherical protrusions falls under the scope of the independent claim of DIVI-3D.

For hemispherical protrusions, Buona Cucina could negotiate a cross-license from Schnell-Koch. Buona Cucina's position is much stronger than Schnell-Koch's, since Buona Cucina will have the generic patent.

Evident abuse:

The disclosure of a frying pan with cubic protrusions in DIVI-3D is considered an evident abuse in relation to Dr Serrano who is the legal predecessor of Buona Cucina (Article 55(1)(a) EPC).

Thus, the disclosure in Schnell-Koch's application DIVI-3D will not prejudice Buona Cucina's rights, provided that Buona Cucina files a European patent application within six months of such publication. Therefore, file a European patent application EP-CUB in the name of Buona Cucina, directed to a frying pan with cubic protrusions, before 27 March 2013. With this application, Buona Cucina can obtain a patent for a frying pans with cubic protrusions in Germany and Italy. Buona Cucina can then stop Schnell-Koch from manufacturing, selling or offering frying pans with cubic protrusions in their German factory by bringing infringement proceedings against Schnell-Koch.

EXAMINATION COMMITTEE III

Candidate No. _____

Paper D 2013 - Marking Sheet

Category		Maximum possible	Marks awarded	
Part I	Question 1	5		
	Question 2	8		
	Question 3	6		
	Question 4	6		
	Question 5	8		
	Question 6	7		
Part II	Question 1	24		
	Question 2	12		
	Question 3	24		
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)

27 June 2013

Chairman of Examination Committee III