

Examiners' Report – Paper D 2021

Purpose and extent of the examiners' report

The purpose of the present examiners' report is to enable candidates to prepare for future examinations (cf. Art. 6(6) of the Regulation on the European qualifying examination for professional representatives).

General comments

Candidates are reminded that they should pay attention to the way the questions are asked and should not simply repeat information from the paper in the answer. Repeating information per se is not awarded any marks. Alternative answers, one being correct and one being wrong, for the markers to choose from do not attract any marks.

In Part I, full marks were only awarded when the full legal basis was cited to support the analysis. Citing only the legal basis or repeating the text therefrom without any further explanation, reasoning or providing advice generally does not attract any marks.

However, alternative relevant legal bases also attracted marks.

An unnecessary amount of points was sometimes lost due to miscalculation of time limits.

Candidates are reminded that the PCT questions may make up a substantial part of paper D.

Examiners' Report – Paper D 2021, Part I

Question 1 (9 marks)

Most candidates realized that EP-A2 was not filed in the language prescribed, however fewer realized legal consequences and accordingly the necessity to revive EP1 so that a new divisional can be filed. Many candidates erroneously suggested to merely file a translation for EP-A2.

Question 2 (8 marks)

This question was reasonably well answered. Most of the candidates realized that the EPO is not bound by the decision of any receiving office under the “unintentional criterion”. Many candidates also correctly indicated the steps required to ensure that the restoration of the right of priority is effective in the European phase. The required payment of a fee for requesting restoration was sometimes forgotten.

Question 6 (8 marks)

The question regarding the procedural steps to be taken before the EPO to request amendment of the claim in respect of Germany was well answered, although some candidates did not realize the need to use the limitation procedure (not realizing that the examination phase was over). Very few candidates realized that the amendment proposed did not meet the requirements of Art. 123(3) EPC.

Question 3 (7 marks)

The question about EP-C1 was well answered. Regarding EP-C2, many candidates did not realize that the search report was issued with a first communication under Art. 94(3) EPC, not with a written opinion. Although some candidates realized that the examining division was responsible, they still suggested to check in the register if the examination already started.

Question 4 (8 marks)

Questions (a) and (b) were generally well answered.

Regarding question (c), many candidates failed to see the partial priority aspect. Nevertheless, some candidates correctly concluded that any amendment excluding

aluminium would violate the requirements of Art. 123(2) EPC.

Question 5 (10 marks)

This question was generally well answered, but marks were often lost for not providing legal basis. Some candidates overlooked that from the perspective of nationality or residence the EPO was a competent receiving office. Some candidates correctly calculated time limits but did not draw any conclusion regarding if it is still possible to take action or not.

Possible Solution – Paper D 2021, Part I

References to the legal basis are referring to the status on 31 October 2020.

Answer to Question 1 (9 marks)

The time limit for responding to the Art. 94(3) EPC communication expired on 15 February 2021 5.10.20+10d (Rule 126(2) EPC) +4m=15.02.21 (Rule 131(4) EPC). Thus, EP-A1 is deemed withdrawn, Art. 94(4) EPC .

EP-A2 was filed before the loss of right i.e. while EP-A1 was pending in the sense of Rule 36(1) EPC, but it was not filed in the language prescribed by Rule 36(2) EPC. Therefore EP-A2 cannot be treated as a valid divisional application, J13/14.

A further divisional application EP-A3 of EP-A1 should be filed in English. EP-A3 should claim invention Y.

A divisional application can only be filed if the loss of rights of EP-A1 is remedied, Art. 121(3) in conjunction with Rule 36(1) EPC. A should thus request further processing, Art. 121 EPC in respect of EP-A1, i.e. pay the further processing fee and file an answer to the communication thereby reviving EP-A1.

The filing fee and search fee for EP-A3 have to be paid, Rule 36(3) EPC.

Renewal fees already due in respect of EP-A1 have to be paid for EP-A3, Art. 86(1) and Rule 51 (3) EPC.

Answer to Question 2 (7 marks)

The deadline for filing an international application claiming priority of application US-B was 12 months from the filing date of US-B, 2 August 2019, Art. 8(2)(a) PCT and Art. 4C(1) Paris Convention.

Hence PCT-B was filed after expiry of the priority period but within two months from the date on which the priority period expired, Rule 49ter.2(a) PCT.

Yes, the applicant B needs to take action at the EPO as designated office as the restoration granted by the USPTO as receiving office will not automatically be effective before the EPO because the EPO is not bound by the decision of any receiving office under the “unintentional criterion”, OJ 2007 p. 694

To ensure that priority is restored during the European phase, the applicant should request restoration of priority within one month from the date on which the Art. 22 PCT time limit expires, Rule 49ter.2(b)(i) PCT.

Rule 159(1) EPC sets a 31-month deadline

02.08.2018+31m=02.03.2021 (Rule 80.2 PCT)

02.03.2021 +1m =02.04.2021 (Rule 80.2 PCT)-> 06.04.21 (Rule 80.5 PCT)

The fee for restoration of priority must be paid within the same time limit, Rule 49ter.2(b)(iii),(d) PCT.

The request for restoration of priority must be accompanied by a statement of reasons for the failure to file the international application within the priority period Rule 49ter.2(b)(ii) PCT.

Answer to Question 6 (8 marks)

(1) The procedural steps to be taken before the EPO to request amendment of the claim in respect of Germany are the following:

Request limitation and pay the limitation fee, Art. 105a(1) EPC.

The request must comply with the requirements of Rule 92 (2) EPC and thus file

- a) the particulars of the proprietor
- b) the number of the patent
- c) amended claims and description
- d) the particulars of the representative if required

A separate claim for Germany must be submitted and the EPO must be informed of DE-G, Rule 138 EPC.

Indicate that the claims for other contracting states remain unchanged.

(2) The proposed amendments are not allowable because the upper limit of 5% now applies to beef meat only. Therefore for example a food composition with 3% pork meat + 3% beef would fall within the scope of the amended claim but not in the claim as granted, Guidelines H-IV, 3.4.

The request will thus be rejected, Art.105b(2) EPC as it does not meet the requirements of Art. 123(3) EPC, Rule 95(2) EPC

Answer to Question 3 (7 marks)

EP-C1

The search will not start if no claim is filed, Art. 92 EPC. Thus, by not responding to the invitation under Rule 58 EPC or by actively withdrawing the application, the search fee will be refunded in full, Rfees Art. 9(1).

The examination fee will be reimbursed in full, Rfees Art. 11(a).

EP-C2

The search fee will not be refunded since the search report was already issued Rfees Art. 9(1).

The search report was issued with a first communication under Art. 94(3) EPC, OJ 2015 EPO A94, because:

- EPO Form 1001 contains a pre-filled request for examination
- the applicant waived his right under Rule 70(2) EPC and paid the examination fee and thus
- the examining division has already assumed responsibility, Rule 10(4) EPC
- the application is not in order for grant as a novelty destroying X document was cited in the search report.

The client can only get a 50% refund by actively withdrawing the application before expiry

of the time limit to reply to the communication, Rfees Art. 11(b).

Answer to Question 4 (8 marks)

a) EP-D0, which is a European patent application, was filed before the effective dates of EP-D1's claim but published after. EP-D0 forms therefore part of the prior art relevant for novelty for subject-matter of claim 1, Art. 54(3) EPC.

Yes, EP-D0 is novelty destroying because it discloses the subject-matter "aluminium" (ALU).

b) Yes, the claim of EP-D1 can be amended to make its subject-matter novel by disclaiming the species ALU, which is possible because EP-D0 is a novelty destroying prior right document under A 54(3) EPC, G1/16.

c) EP-D1 was filed within the priority year by the same applicant as US-D, Art. 87(1) EPC.

The subject-matter "metal" can be conceptually divided into the subject-matter "aluminium" (ALU) and the subject-matter "metal but not aluminium" (NOTALU), G1/15.

For the subject-matter ALU, US-D is not the "first application" in the sense of Art. 87(1) EPC because EP-D0 is also from applicant D and discloses the subject-matter ALU.

Therefore the claimed priority is not valid for the subject-matter ALU and the effective date of the subject-matter ALU is 8 June 2020.

For the subject-matter NOTALU, US-D is the "first application" and thus the effective date of the subject-matter NOTALU is 7 June 2019.

c-a) Then answer to a) would be Yes:

In that case EP-D0 was published before the effective date of the subject-matter ALU but after the effective date of the subject-matter NOTALU.

EP-D0 thus forms part of the prior art under Art. 54(2) EPC for the subject-matter ALU and under Art. 54(3) EPC for the subject-matter NOTALU.

c-b) Then answer to b) would be No:

Any amendment excluding ALU would violate Art. 123(2) EPC.

Answer to Question 5 (10 marks)

(1) The EPO as receiving Office (rO) does not accept Portuguese as a language in which the international application may be filed, Rule 157(2) EPC.

Hence the EPO will transfer the international application to the International Bureau (IB), Rule 19.4(a)(ii) PCT, which is thus the competent rO, Rule 19.4(b) PCT.

(2) Portuguese is not accepted by ISA/EPO to carry out the international search, Agreement EPO-WIPO, Annex A.

Hence the invitation sent by rO/IB is an invitation under Rule 12.3(c)(i) PCT to file a translation of the international application into EN, DE, FR for the purpose of the international search.

The time limit under Rule 12.3(a) PCT already expired (on 03.02.2021).

The translation can still be filed within whichever of the following time limits expires later, Rule 12.3(c)(ii) PCT:

(a) 29.01.2021 + 1m = 28.02.2021(Sunday) (Rule 80.2 PCT)->01.03.2021 (Rule 80.5 PCT)

(b) 03.01.2021 + 2m = 03.03.2021 (Rule 80.2 PCT)

so tomorrow at the latest.

A late furnishing fee must be paid to rO/IB with the same time limit, Rule 12.3(c)(ii) PCT.

(3) The applicant has both nationality and residence of an EPC Contracting State. Hence, from the perspective of nationality or residence the EPO is a competent rO according to Rule 19.1(a) PCT.

The EPO accepts English as a language in which the international application may be filed, Rule 157(2) EPC.

Hence the EPO is the competent rO, Rule 19.1(a)(i) PCT.

(4) The text of the drawings is in a different language than the language of the description and the claims. Hence the invitation is an invitation under Rule 26.3ter(a) PCT to furnish a translation of the text of the drawing into the language in which the international application is to be published (English).

This translation must be filed at the latest on 29.01.2021 + 2m = 29.03.2021 (Mo) (Rule 80.2 PCT), Rule 26.2 PCT.

Examiners' Report – Paper D 2021, Part II

This year's Part II of paper D required candidates to analyse a complex patent situation recognising an invalid claim to priority, prior art under Article 54(3) EPC, sufficiency of disclosure, the possibility of a PCT application entering the European phase late, the effect of Articles 123(2) and 123(3) EPC and the admissibility of submissions in the opposition procedure.

The order of the questions provided a structure for candidates to conduct a complete analysis of the patent situation before considering improvements and consequences. Candidates who followed this structure generally did well in the analysis and spotted most of the relevant issues. Providing the current status of the rights includes an assessment of the validity of those rights. Candidates who immediately proposed improvements without fully analysing the situation as outlined in the paper often missed several relevant issues.

Many candidates recognised that W-IT is not the first application in respect of a SPRINGY leash (S) and a SPRINGY leash with OH-NO fastener (S+O), though in some cases HP-PCT was incorrectly judged to be prior art under Article 54(3) EPC in respect of P-EP or W-EP in spite of not having entered the European phase. Some candidates concluded that the Japanese patent application W-JP constituted prior art for these patents under Article 54(3) EPC leading to incorrect conclusions.

Candidates exhibiting a proper understanding of the interplay between Articles 123(2) and 123(3) EPC in respect of the subject matter of P-EP answered question 2 well, recognising that the deficiencies in P-EP cannot be remedied in opposition proceedings and P-EP will be revoked. However, a worrying number of candidates suggested amending the claim of P-EP to remove the feature of a sound barrier (B), or replacing or supplementing B with the AHHH modification (A).

A number of candidates surprisingly proposed filing a divisional application on the basis of granted patent P-EP.

In the improvement of the situation, many candidates recognised the opportunity to enter the European phase in HP-PCT using further processing, though few noted the need to for the Chinese co-applicant, HOUND, to appoint a professional representative.

When HP-PCT is in the European phase, a number of practical steps are necessary to ensure it is taken into account as prior art under Article 54(3) EPC. Most candidates skipped at least one of these steps. In particular, in addition to requesting the admission of evidence into the procedure citing the regionalised HP-PCT application, it is necessary to evidence the new fact that the subject matters S+O and S+O+C in W-EP have, as effective date, the filing date of W-EP. Candidates often neglected to mention this important fact to show the invalidity of the claims as amended in W-EP. Furthermore, some candidates omitted to request the admission of HP-PCT to the opposition procedure as relevant prior art under Article 54(3) EPC for W-EP.

Additionally, some candidates incorrectly concluded that amended claim 1 of W-EP directed to S+O is novel over the disclosure of a SPRINGY leash with OH-NO fastener and a COMEBACK cable (S+O+C) in HP-PCT in the European phase.

Candidates were generally good at identifying the individual states in which patent protection can be obtained by each of the parties, noting the respective states of interest to the parties, and in summarising the effects of the protection obtained on competitors.

Possible Solution – Paper D 2021, Part II

1. What is the current patent situation in respect of:

SPRINGY leashes in general (S)?

W-JP is the first application containing S and was published in July 2018. It is withdrawn so will not provide protection. W-IT contains S and is withdrawn. HP-PCT discloses, but does not claim, S and will have published around December 2019. W-EP claims priority from W-IT. However, W-IT is not the first application in respect of subject matter S and so the claim to priority in W-EP is not valid in respect of subject matter S. The effective date for subject matter S in W-EP is the filing date of W-EP. W-JP published after the effective date of S in W-EP. The PUPPY-PRESS paper is prior art for all pending patent applications and granted patents. The claim to S in W-EP as granted is not novel over PUPPY-PRESS. P-EP discloses, but does not claim, S and is granted. As the situation currently stands no valid patent protection for S exists.

A SPRINGY leash with an OH-NO fastener (S+O)?

W-JP is the first application containing S+O and was published July 2018. It is withdrawn so will not provide protection. W-IT contains S+O and is withdrawn. HP-PCT discloses, but does not claim, S+O and will have published. S+O is present in W-EP as originally filed so the amended claim 1 of W-EP does not add subject matter. The claim to S+O in W-EP does not extend the scope of protection of W-EP as granted. W-EP claims priority from W-IT. However, W-IT is not the first application in respect of subject matter S+O and so the claim to priority in W-EP is not valid in respect of subject matter S+O. The effective date for subject matter S+O in W-EP is the filing date of W-EP. HP-PCT has not entered the European phase and so does not form part of the state of the art for W-EP. There is no prior art disclosing S+O for W-EP so the claim to S+O in W-EP is novel. S+O in W-EP is surprisingly clever, so it is inventive. According to the current situation W-EP is likely to be maintained in amended form with a claim to S+O.

A SPRINGY leash with an OH-NO fastener and a COMEBACK cable (S+O+C)?

HP-PCT is the first application directed to S+O+C. There is no prior art for HP-PCT disclosing S+O+C so the claim to S+O+C in HP-PCT is novel. HP-PCT is likely to lead to a granted patent in China giving protection for S+O+C to PUGZ and HOUND. W-EP claims priority from W-IT but W-IT does not disclose S+O+C. The effective date for the subject matter S+O+C in W-EP is the filing date of W-EP. There is no prior art for W-EP disclosing

S+O+C (HP-PCT did not enter the European phase) so the claim to S+O+C in W-EP is novel. S+O+C in HP-PCT and W-EP has a surprisingly positive effect, so it is inventive. According to the current situation, W-EP is likely to be maintained in amended form with a claim to S+O+C.

A SPRINGY leash with the YELP modification (S+Y)?

W-EP is the first applications directed to S+Y. W-EP claims priority from W-IT but W-IT does not disclose S+Y. The effective date for the claim to S+Y in W-EP is the filing date of W-EP. There is no prior art for W-EP disclosing S+Y so the claim to S+Y in W-EP is novel. S+Y in W-EP is surprisingly effective, so it is inventive. According to the current situation W-EP is likely to be maintained in amended form with a claim to S+Y.

A SPRINGY leash with the YELP modification and the AHHH modification (S+Y+A)?

P-EP is the only application to contain S+Y+A. P-EP discloses, but does not claim, S+Y+A which was published around January 2020. There are no granted patents or pending applications claiming S+Y+A.

A SPRINGY leash with the YELP modification and a sound barrier (S+Y+B)?

P-EP is the only application to contain S+Y+B. P-EP discloses and claims S+Y+B which was published around January 2020 and is granted. B is not sufficiently disclosed in P-EP and it is not known how to make B. WUFF's opposition of P-EP is likely to be successful.

2. Can we save our patent P-EP and why? Give a reasoned analysis.

The opposition period for P-EP expires 12th August 2021, so WUFF's opposition was filed in time. W-EP does not disclose feature B and the claim of P-EP is therefore novel over W-EP. Feature B in the claim of P-EP cannot be deleted or replaced without extending the scope of protection. It is also not possible to add sufficient disclosure for feature B to P-EP without adding subject matter. Thus, the deficiencies in P-EP cannot be remedied in opposition proceedings and P-EP will be revoked.

3. What improvements can we make to the current patent situation?

The deadline for entering the EP regional phase for HP-PCT was 18th January 2021. This date has passed although it is still possible for HP-PCT to enter the EP phase. To do this, pay the fees for further processing and fulfil the requirements for entry to the European phase, including paying the renewal fee in respect of the 3rd year with the surcharge. HP-

PCT will form part of the state of the art for novelty only for W-EP. The Chinese co-applicant HOUND must appoint a professional representative before the EPO.

HP-PCT discloses S+O+C and, since it forms part of the state of the art, it anticipates the claim directed to S+O and the claim directed to S+O+C in W-EP. After HP-PCT enters to the European phase, file written submissions in the opposition proceedings filing the new evidence W-JP and file HP-PCT – having entered the European phase – identifying the invalid claim to priority and the lack of novelty of the amended claims in view of HP-PCT.

The new evidence and argument are admissible because, since feature O was introduced into claim 1 from the description during opposition proceedings, there is a change to the subject of proceedings. Furthermore, HP-PCT was not prior art before it entered the European phase and so could not be cited earlier.

W-EP will not be maintained as currently amended. W-EP can give WUFF protection for S+Y.

Once HP-PCT has entered the European phase, file translations of claims of HP-PCT into French, German and Italian to obtain provisional protection in FR, DE, IT.

4. After our improvements:

Which products will we be able to stop WUFF from making and selling?

When granted in the European phase, HP-PCT will provide protection for S+O+C in Europe by validating in IT and maintaining in FR, UK, DE. PUGZ can stop WUFF making or selling products containing S+O+C in EP states in which HP-PCT in the European phase is validated or maintained, and China.

Which products will WUFF be able to stop us from making and selling?

An amended W-EP claiming S+Y will enable WUFF to prevent PUGZ from using any product comprising S+Y, including S+Y+A, in EP states in Europe in which W-EP is validated or maintained.

Examination Committee III: Paper D - Marking Details - Candidate No

Category		Max. possible	Marks Marker 1	Marker 2
Part D1-1	Part D1-1 - Question 1	9		
Part D1-1	Part D1-1 - Question 2	8		
Part D1-1	Part D1-1 - Question 6	8		
Part D1-2	Part D1-2 - Question 3	7		
Part D1-2	Part D1-2 - Question 4	8		
Part D1-2	Part D1-2 - Question 5	10		
Part D2	Part D2 - Question 1	28		
Part D2	Part D2 - Question 2	5		
Part D2	Part D2 - Question 3	14		
Part D2	Part D2 - Question 4	3		
Total				