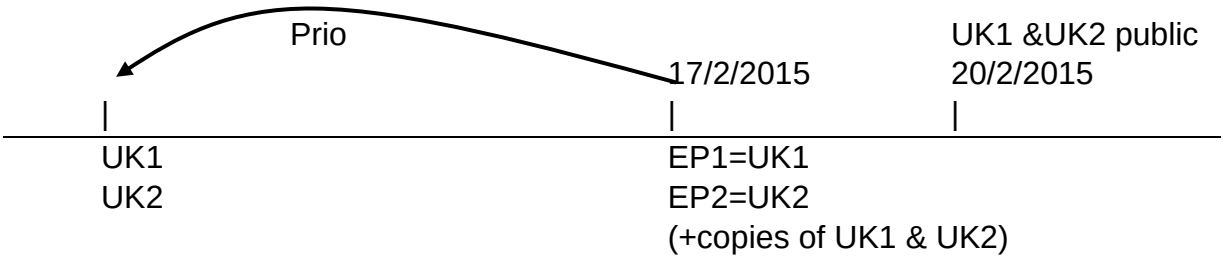
CANDIDATE'S ANSWER

D-I. QUESTION 1



EP1 – EP2

- Missing drawings can be filed within 2m of the date of filing (or upon invitation from the EPO) – R56(2) EPC
- This will cause a redating of the application to the date on which the missing parts were filed;
- Thus, the filing date of EP1 and EP2 will change to 23/2/2015
- This means that the priority is no longer validly claimed (A87(1) EPC), because EP1 and EP2 are outside the 12m period to claim priority (17/2/2015 was last day of priority period)
- This means that UK1 and UK2, publicly available since 20/2/2015 are A54(2) prior art documents for EP1 and EP2.
- Since UK1 = EP1 and UK2=EP2, EP1 and EP2 are not novel over UK1 and UK2, respectively and EP1 and EP2 will not be granted

Correction of the situation

A/ EP1

- The EPO will send us a notification under R56(2) informing us of the redating of the application.
- Within 1m of this notification we should withdraw the missing drawings filed, thus nullifying the redating (R56(6) EPC)
- After withdrawal, we can reintroduce the missing drawings under R56(3) EPC, without redating by filing a request to this effect
  → also within 2m of filing, thus by 17/2/2015 + 2m ---------> 17/4/2015 (Friday)
  [R131(4)]
  we should also withdraw the missing drawings filed in this period
  → we already claim priority of UK1
  → the missing drawings are completely contained in UK1

→ we do not need to file a copy of UK1 as already available to EPO [R56(3)(a)]
→ translation is presumably not necessary [R56(3)(b)], as UK1 is presumably in English which is an official language of the EPO
→ we have to indicate where the missing drawings are completely contained in UK1

- Thus drawings can be introduced in EP1 without redating. Priority will remain validly claimed. Effective date of EP1 is filing date of UK1 and UK1 (published on 20/2/2015) is no longer prior art document

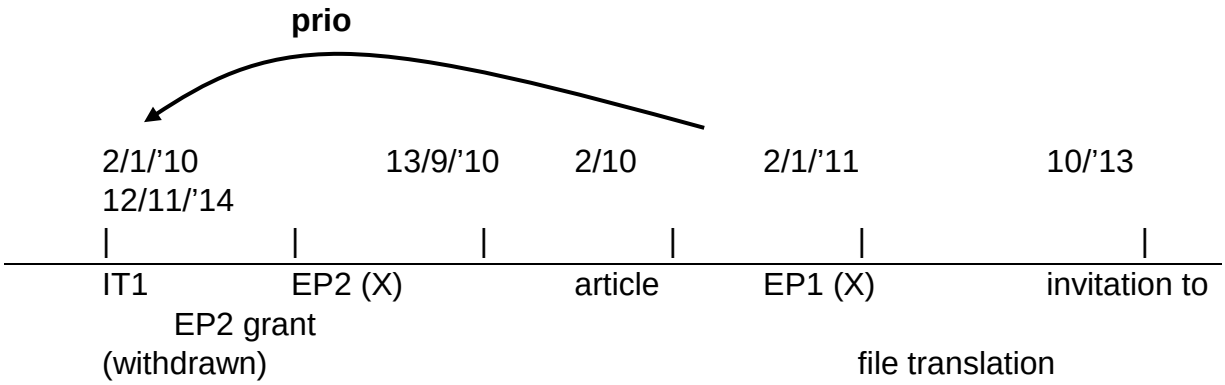
B/ EP2

The above setup for EP1 does not work for EP2 (because UK2 does not contain drawings)

To avoid redating and the novelty destroying UK2 publication:

- We should, like for EP1, withdraw the missing drawings filed within one month of the EPO notification under R56(2), thus avoiding the redating
- This way, we keep the filing date of 17/2 also for EP2 and priority will still be validly claimed.
- Presumably, since the applicant only noted that drawings were missing for EP1, there will be no reference to the drawings in UK2 and EP2. The absence of drawings will thus not affect the further prosecution of EP2

D-1. QUESTION 2



- EP1 claims priority from IT1, which has been withdrawn, but this does not affect the right to claim priority [A87(3) EPC]

- priority claim from utility model application is allowed [A87 (1) EPC]

- article is published in priority period

- Thus, if priority claim is valid, then article is not an A54(2) document (because effective date of EP1 would be filing date of IT1)

- however, if priority claim is invalid

  → effective date of EP1 is filing date of EP1 and article would be A54(2) document and destroys novelty of EP1

- thus, the validity of the priority claim is relevant for the patentability of EP1 (inv X) → R53(3): EPO invites B to file translation (this occurred in 10/2013)

- B has not filed translation → loss of rights is loss of right to priority of EP1 (under R53(3)

(A)

With the priority right lost according to R53(3)

- the effective date of EP1 is filing date of EP1 (2/01/2011)

- article is published before filing date of EP1 and is hence a novelty destroying A54(2) document

- EP1 claiming X will not be novel over article (X) and will not be validly granted

(B) with a valid priority claim EP1, having as effective date the filing date of IT1, which is before the filing date of EP2, and published after filing date of EP2, EP1 is a A54(3) EPC prior art document relevant for the novelty of EP2

Since EP1 discloses X, EP1 would be novelty destroying for EP2 (claiming X)

In the present context, EP1 is published in early July 2011 (18 after priority date: 01/2010 + 18m → 07/2011). EP1 was thus published with the priority claim.

According to GL F-VI, 3.4, for reasons of legal certainty, the right of priority remains effective for determining the state of the art for the purposes of A54(3) in respect of any other EP application, thus also including EP2

In this respect, it is immaterial whether the translation has been filed: changes taking effect after the date of publication, as is the case here, do not affect the application of A54(3)

Thus, EP1 is still an A54(3) doc for EP2

With mention of the grant published on 12/11/2014, the 9m opposition period [A99(1) EPC] ends at 12/11/2014 + 9m – R131(4) --> 12/8/2015 (wed)

Thus, B can duly file an opposition against EP2 (before 12/8/2015, file notice of opposition + pay opposition fee), based on the ground of lack of novelty [A100 (a) EPC] using EP1 as an A54(3) document.

With EP1 disclosing X and EP2 claiming X → EP2 will be revoked by the opposition division.

D-1. QUESTION 3

(A) PCT-A vs claiming priority of A

-Argentina is a state party to the Paris Convention and a member of the WTO.

-A is regular national application

-A PCT application may claim priority from an application filed in or for any country party to the Paris Convention ([Art 8(1) PCT]

-yes, PCT-A may contain a declaration claiming priority of application A

- in addition, for claiming priority, applicants of PCT-A and A are the same

(B) Hans and EE: joint applicants

-any resident or national of a PCT CS may file an international application

-Hans, as German national, with Germany as PCT CS may file an international application

-EE is an Argentinian resident, and Argentina is not a PCT CS, so EE may in itself not file a PCT application

-However, a PCT application may have several applicants [Art 9(3) PCT]

-according to R18.3, if there are 2 or more applicants the right to file a PCT application shall exist if at least one of them is entitled to file an international application

-Here: Hans is entitled to file

-So, EE + Hans may file jointly PCT A

(C) 1. EPO as RO

-competent RO: also R19 PCT

-EPO is competent RO if applicant is a resident or national of a PCT and EPC contracting State [Art 151 EPC; R157(1) EPC]

-Hans is German national – Germany is PCT and EPC CS

-English is a language accepted by EPO as RO [R157(2)]

So, if PCT A is filed directly at EPO in English, EP will be the competent RO for PCT-A

(C) 2. GPTO [see PCT applicant's guide Annex C (DE)]

- GPTO is competent RO for nationals of Germany. Hans fulfils this criteria

-However, GPTO only accepts PCT applications filed in German

-with PCTA in English, GPTO will not act as RO for PCT-A. In this case, GPTO will transmit PCT-A to the IB [R19.4(ii) PCT]

→ GPTO will be considered to have received PCT-A on behalf of IB as RO

R19.2 PCT shows that in case of multiple applicants at least one applicant should be entitled to file at the RO.

D-1. QUESTION 4

EP-D1

→ filed in Japanese + English translation

- According to Art 14(2) EPC, an European patent application may be filed in any language (including Japanese), provided a translation is filed within 2m of filing [R 6(1) EPC] in an official EPO language
- English is an official EPO language – translation was duly filed → comply with EPC
- English text is authentic text [A70 (1)]
- The Japanese text remains the application as filed according to A70(2) & A14(2),
- throughout the proceedings before the EPO, the (English) translation may be brought into conformity with the (Japanese) application as filed.

- Since JP-D (claim to apparatus 1) presumably corresponds to the Japanese text of EP-D1 as filed, we can correct the translation of « µm » in the English translation

- Thus, prosecution of EP-D1 (cl 1) with the correction of © to µm (based on the Japanese text as filed) can continue without further additional measures.

EP-D2

→ in this case, the English text is the text as filed as well as the authentic text of EP-D2

- Under R139 EPC, correction of errors is possible in any document filed with the EPO. However, in case such an error concerns the description or claims, it must be an obvious error : it must be immediately evident that nothing else could have been intended than what is offered as the correction.
- This is not the case here : the replacement of © by µm is not evident.
- Thus, correction under R139 is not possible

- Correction of the translation is also not possible, as for EP-D2 there is no translation : text as filed & authentic text are in English (it is irrelevant that priority application is in Japanese)

- Option is to withdraw EP-D2 and refile with the correct « µm »
    - Priority can still be validly claimed [A87(1)]
        - 24/3/2014 + 12m → R131(4) → 24/3/2015 (Tuesday)
    - Thus, refiling of EP-D2 before 24/3/2015
- With priority validly claimed (within 12 m, same applicant D, same invention (apparatus 2), JP-D is first application for apparatus 2): effective date of EP-D2(bis) remains filing date of JP-D, so state of the art will not change and thus no influence on further prosecution of EP-D2(bis)
- EP-D2(bis) should be directed to apparatus 2. Preferably, EP-D2bis can also be filed in Japanese & English translation, so as to be able to correct other translation mistakes in the future (outside priority period).

D-1. QUESTION 5

- R30(1) EPC requires that for an European patent application disclosing amino acid sequences, the description must contain a sequence listing.
- This sequence listing should follow the rules for the standard representation of sequence listings, as laid down in decision of the President of 30.05.2011 (OJ 2011, 372) and must comply with the WIPO Standard ST.25
- E has not filed a sequence listing.
- Thus, R30(3) EPC : the EPO shall invite E to furnish the sequence listing + pay the late furnishing fee
- → communication received by E is thus R30(3) communication

a) E has to provide the sequence listing and pay the late furnishing fee [Rfees 2(1)14a = 230 EUR]
This should be done within 2m from communication R30(3)

18/2/2015 + 10d [R126(2) EPC] → 28/2/2015 + 2m → 28/4/2015 (Tuesday)

b) Legal consequence of not remedying the defect is refusal under R30(3)
Further processing under Art 121 & R135(1) may be used if this time limit is not met, and may be requested until 2m after notification of the loss of rights.
Further processing should be requested for any of the omitted acts:
   - ➔ Pay the fee: FP fee equals to 50% of late furnishing fee (50% of 230 = 115 EUR)
   - ➔ Furnish sequence listing: FP fee is fixed fee of 250 EUR [Rfees 2(1)12]

and the omitted acts should be completed as well for a successful FP

D-2

I. ANALYSIS

1/ analysis EP-X1

Applicant TIPOGRAF-X (further TIPO-X)

Filing date : 07/2012

Priority claimed : none

Disclosed : M+A

Claim 1 : M+A Effect of A : increased speed

Status : 10/2013 : ESR → prior art EP-Z

2/ analysis EP-Z

Applicant DRUCK-Z

Filing date 03/2012

Priority claimed : none

Disclosed & claimed : M+A

EP-Z is earliest application for M+A

Status : withdrawn in 11/2013; entitlement proceedings by TIPO-X → successful for TIPO-X

3/ analysis of EP-X2

Applicant TIPO-X

Filed 10/03/2014

No priority claimed: priority period expires +12m → 10/3/2015 (TUE)

Disclosed: M+A+B (effect: use of various type of papers)

M+A+C (effect: fewer misprints)

M+A+B+C (effect: less noise)

Claimed: 1) M+A+B

2) M+A+C

3) M+A+B+C

Status: pending

EP-X2 is earliest application for M+A+B+C

4/ analysis EP-X3

Applicant TIPO-X

Filed 20/01/2015

Priority claimed: none

Description is identical to EP-X2

Not disclosed: D

Claim M+A+B+C+D

EP-X3 is earliest application for M+A+B+C+D

5/ analysis PCT-L

Applicant PRINT-L

Filed 08/09/2012

No priority claimed (because entry was not yet performed by 02/2015 at the trade fair)

Disclosed + claim 1: M+A+C

Status: positive IPER

National entry due at 30m → 08/03/2015 (SUN) → 09/03/2015

At 31m → 08/04/2015 (WED)

Published 13/9/2014

PCT-L is earliest application for M+A+C

6/ analysis of EP-G

Applicant ICPR-G

Filed 05/2012

No priority claimed

Disclosed + claims 1) M+A & 2) M+A+B (+ effects)

Status: ESR does not mention any relevant documents

EP-G is earliest application for M+A+B

II. Question 1 - SITUATION FOR M+A

3 applications claim M+A: EP-Z; EP-G and EP-X

(i) EP-Z (cl 1 = M+A)
- no priority claimed: effective date is filing date EP-Z: 03/2012
- earliest application for M+A; no A54(2) or A54(3) docs known, so cl1 is novel
- effect of A (increased speed) forms basis of inventive step, thus cl 1 is deemed novel and inventive and would be validly granted
- however, EP-Z is withdrawn
- so, cl 1 (M+A) will not be granted and DRUCK-Z will get no protection for M+A in Europe and can hence not stop others from producing/using M+A

(ii) EP-G (cl 1 = M+A)
- no priority claimed: effective date is filing date EP-G: 05/2012
- EP-Z is A54(3) prior art for EP-G: filed before EP-G + published thereafter (assumption based on fact that EP-Z was cited in search report of EP-X1)
- EP-Z is relevant for novelty only of EP-G
EP-Z discloses M+A, so cl1 (EP-G) is not novel over EP-Z and will thus not be validly granted.
- ICPR-G will thus not get protection for M+A. With no rights in Europe ICPR-G cannot stop others from exploiting M+A

(iii) EP-X1 (cl1 = M+A)
- no priority claimed: effective date = 07/2012
- both EP-Z and EP-G are A54(3) docs (filed before EP-X1 and published thereafter – EP-G is close to grant)
- so cl1 (M+A) of EP-X1 is not novel, since both EP-Z and EP-G disclose M+A
- TIPO-X will not get patent protection for M+A in Europe and with no rights in Europe cannot stop others from commercialising M+A

* Disclosure of M+A to DRUCK-Z is no public disclosure because of confidentiality and is thus not an A54(2) disclosure

III. Question 1 - SITUATION FOR M+A+B

2 applications claim M+A+B: EP-G and EP-X2

(i) EP-G (cl2 = M+A+B)
-no priority claimed: effective date is filing date of EP-G
-EP-G is earliest application for M+A+B
-search report shows no relevant docs → no A54(2) or A54(3) prior art
-cl 2 is novel over Prior art
-effect of B (use of multiple papers) forms basis of inventive step
-cl2 (M+A+B) is novel and inventive

-cl2 will be validly granted and give protection for M+A+B in all EPC states where validated. To cover IT, they will have to file a translation of EP-G in Italian
-assuming validation and payment of renewal fees: after grant ICPR-G can stop others from producing, selling, using M+A+B in validated EPC contracting states

(ii) EP-X2 (cl1 (M+A+B)
-no priority claimed → effective date is filing date of EP-X2
-EP-Z is presumably A54(2) document for EP-X2 (presumably published in 03/2012 + 18m = 09/2013). EP-Z discloses only M+A, while cl1 is directed to M+A+B
-cl 1 is novel over EP-Z
-EP-G is presumably also A54(2) (publication in 05/2012+18m = 11/2013)
-EP-G discloses M+A+B, so cl1 (EP-X2) is not novel over EP-G
EP-X2 (cl1) will not be validly granted
TIPO-X will not get protection for M+A+B and can thus not stop others from exploiting M+A+B

IV. Question 1 - SITUATION FOR M+A+C

2 applications claim M+A+C: PCT-L and PE-X2

(i) PCT-L (cl1 M+A+C)
-no priority claimed: effective date = filing date
-assuming PRINT-L will take the necessary steps for national entry in Europe by performing the acts under R159(1) (I'll check this) by 8/4/2015:
-EP-Z and EP-G will then be considered A54(3) docs (relevant for novelty only)
-EP-Z and EP-G only disclose M+A and M+A+B
-PCT-L is earliest application for M+A+C
-positive IPER + effect C forms basis for inventive step
- → Cl 1 (PCT-L) will be novel and inventive and will be validly granted in Europe
- Thus, PRINT-L will have protection in all EPC contracting states were validated and can stop others from commercialising M+A+C in the states were validated

(ii) EP-X2 (cl2 = M+A+C)
-assuming duly national entry in EP for PRINT-L:
-PCT-L (EP) will be A54(3) prior art for EP-X2
-PCT-L discloses M+A+C
-so cl2=M+A+C is not novel over PCT-L
-And M+A+C (cl2) will not be validly granted

-TIPO-X will not get any patent rights for M+A+C and can thus not stop others from exploiting M+A+C

If however, PRINT-L does not enter EP:
-PRINT-L will not get any rights on M+A+C in Europe
-PCT-L is not an A54(3) doc (if filed in Chinese – I'll check that)
-in this case TIPO-X may obtain patent protection for M+A+C (because EP-Z and EP-G as A54(2) documents do not disclose M+A+C)

V. Question 1 - SITUATION FOR M+A+B+C

1 application: EP-X2

-no priority claimed: effective date is filing date of EP-X2
-EP-X2 is earliest application for M+A+B+C
-PCT-L (assuming A54(3) doc) and EP-Z and EP-G only disclose M+A and/or M+A+B or M+A+C
-so EP-X2 (cl 3) for M+A+B+C is novel over prior art
-inventive step seems ok as well, because of synergistic effect of B+C (noise reduction)
-thus cl3 is novel and inventive
-cl 3 will be validly granted and give protection for M+A+B+C in all EPC CS were validated
-thus after grant of cl3, TIPO-X can stop others from exploiting M+A+B+C, including M+A+B+C+D (since it comprises M+A+B+C) in CS were validated and renewal fees are paid to keep EP-X2 (cl3) in force.

VI. Question 1 - SITUATION FOR M+A+B+C+D

1 application EP-X3 (cl1)

-no priority claimed: effective date is filing date EP-X3
-earliest application for M+A+B+C+D
-A54(2) documents known (EP-X1, EP-Z, EP-G, PCT-L) do not disclose M+A+B+C+D
-EP-X2 is A54(3) document, but also does not disclose this combination
-EP-X3, cl1 is novel over prior art
-effect of D (ink consumption reduction) forms basis of inventive step
-EP-X3 is novel and inventive
-however, D is insufficiently disclosed: an A83 objection can be made during examination or opposition
-thus, EP-X3 cl1 will not be validly granted
And TIPO-X will not get patent protection for M+A+B+C+D in EP and cannot stop others from exploiting M+A+B+C+D based on EP-X3

VII. Question 2

No: TIPO-X is not free to exploit M+A+B+C+D

- Currently, nobody will get a valid claim for M+A: nobody can using (M+A) patent rights stop TIPO-X from exploiting M+A+B+C+D (M+A would be dominating for M+A+B+C+D, because the latter includes M+A)
- With ICPR-G obtaining valid protection for M+A+B, they can stop TIPO-X from producing/selling/using M+A+B+C+D, because the latter includes M+A+B. TIPO-X would thus infringe EP-G (M+A+B)
- Assuming entry in EP: PRINT-L will obtain valid protection for M+A+C and can stop TIPO-X from exploiting M+A+B+C+D, because PCT-L (EP) dominates EP-X3 and the latter invention includes M+A+C. TIPO-X would thus infringe PCT-L (M+A+C)

  So: TIPO-X with M+A+B+C+D will infringe EP-G (cl2) and PCT-L (if entered in EP)

- Based on EP-X2 (cl3) TIPO-X can stop others from producing in Europe M+A+B+C, including M+A+B+C+D.
- Currently, TIPO-X has no valid patent rights on M+A+B+C+D itself
- Nobody can thus produce M+A+B+C+D without infringing patent rights

VIII. Question 3 - Improvements

<u>I – Take the necessary steps to fully claim EP-Z (M+A) from DRUCK-Z (Art61)</u>

-TIPO-X has obtained a final decision that it is entitled to EP-Z (M+A)

-TIPO-X should file a new patent application for M+A (cl 1 = M+A)

-EP-Z was not granted → so condition of R16 OK

-TIPO-X should take this step within 3m of decision: 15/1/15 + 3m → 15/4/15

-protocol on recognition recognizes entitlement decision in all EPC CS → new application will get protection in all EPC CS.

-the fact that EP-Z is withdrawn does not matter for filing a new application (G3/92)

Thus, TIPO-X will have a new application on M+A with effective date = EP-Z

As discussed before [see DII – II (i)]:

-M+A is novel and inventive and will be validly granted

-TIPO-X will get protection for M+A in Europe were validated:

IT: file IT translation

IS (party to London Agreement): file claim translation

DE (party to London Agreement): automatic validation

(+ renewal fees should be paid to keep in force)

-TIPO-X can thus stop others from producing/selling/exploiting M+A; including M+A+C (PRINT-L) & M+A+B (ICPR-G), because these inventions include M+A, in all EPC CS were validated and renewal fees paid.

-TIPO-X would thus obtain the dominating patent

II – file 3rd party observations indicating EP-Z to examiner of EP-G

This way, the A54(3) document will be used to destroy the novelty of EP-G cl1 (M+A)

III – improve EP-X3

-introduction of missing paragraph will cause redating of EP-X3 (missing paragraph was not disclosed in EP-X2, so claiming priority from EP-X2 + trying to incorporate the missing paragraph is not possible)

-redating of EP-X3 (to the date when the missing paragraph is filed) would mean that the trade fair of 10/02/2015 would be an A54(2) disclosure of M+A+B+C+D

-however, a novelty destroying disclosure requires a sufficiently enabled disclosure →M+A+B+C+D was on display, so only its visible features were disclosed (T1085/92) and made available to the public

-thus, even with a redated EP-X3:

* the trade fair is not a novelty destroying A54(2) disclosure

* the effect of D forms the basis for the inventive step

→ Thus cl (M+A+B+C+D) will be novel and inventive

→ M+A+B+C+D would be validly granted in EP and give protection for M+A+B+C+D in all CS were validated.

-TIPO-X would then be able to stop others form exploiting M+A+B+C+D in CS were validated

Filing the missing paragraph under R56(2) should be done within 2m of filing (it is uncertain the EPO will issue a communication about the missing paragraph), i.e. by:

20/01/2015 + 2m → 20/03/2015 (but the sooner the better)

Alternatively, for EP-X3 – we can withdraw EP-X3 (to avoid publication) and refile a PCT application (PCT-X3) – see next section

IV – in view of PRINT-L – extend geographic protection

The priority year of EP-X2 and EP-X3 (as redated) is not yet over:

➔ File a PCT application
- PCT-X2, directed to cl M+A+B+C
- PCT-X3, directed to cl M+A+B+C+D

+ claiming priority from EP-X2 and EP-X3 (respectively)

-as discussed above, these claims will be novel and inventive, and depending on the national phases entered (to be decided in light of production/markets of PRINT-L), TIPO-X will obtain valid protection for M+A+B+C and M+A+B+C+D in these countries, and can thus stop others from exploiting M+A+B+C and M+A+B+C+D

- Priority can still be validly claimed from EP-X2 and EP-X3 (if EP-X3 is corrected to include paragraph D):
  -within 12m
  -1st application of TIPO-X for M+A+B+C and M+A+B+C+D, respectively
  -same invention (in paragraph D is included in EP-X3)

IX. Final note on business aspects after improvements

-with TIPO-X having the dominating patent M+A (dominating for M+A+B of ICPR-G), in particular when validated in IS, ICPR-G would infringe TIPO-X patent on M+A if they exploit M+A+B in IS

-however TIPO-X would still infringe EP-G when exploiting M+A+B+C+D in IS

-this crosslicense situation can be exploited to get more reasonable terms from ICPR-G relating to their EP-G, because they need the rights on M+A to produce M+A+B

-with TIPO-X having the dominating patent M+A with regard to M+A+C from PRINT-L

→ PRINT-L would need a license from TIPO-X to exploit M+A+C in Europe (CS where validated)

→ perhaps they can be persuaded not to enter EP? (which would mean as discussed before that TIPO-X would also be able to obtain protection for M+A+C in EP

however, if PRINT-L enters EP, TIPO-X would still need a license from PRINT-L to exploit M+A+B+C+D

with PCT(X2) and PCT(X3) we will be able to protect M+A+B+C and M+A+B+C+D on PRINT-L's home market (but TIPO-X will need a license from PRINT-L on PCT-L to exploit M+A+B+C+D

- Since PRINT-L was open to collaboration, a big crosslicense deal involving rights to
    - EP-Z (refiled/taken over by TIPO-X) in EP (from TIPO-X to PRINT-L)
    - PCT-L(EP) in EP (from PRINT-L to TIPO-X)
    - Rights in Asia (PCT-L) (from PRINT-L to TIPO-X)

    + if TIPO-X is not interested in Asia: give (license) rights of PCT(X2) and/or PCT(X3) to PRINT-L in Asia

Examination Committee III: Paper D 2015 - Marking Details			Candidate No	
Category		Maximum possible	Marks awarded	
			Marker 508	Marker 524
Part I	Question 1	9	8	7
Part I	Question 2	8	7	8
Part I	Question 3	9	9	9
Part I	Question 4	7	5	5
Part I	Question 5	7	6	6
Part II	Question 1	30	26	26
Part II	Question 2	4	2	3
Part II	Question 3	26	17	18
Total			**80**	**82**

Examination Committee III agrees on 81 points and recommends the grade PASS