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EUROPEAN QUALIFYING EXAMINATION 2022

Paper D2

This paper comprises:

Part II: Legal Opinion

Questions 1-4 (55 points)

Today is 8 March 2022.
You receive the following e-mail from the firm Optimisme.

Dear Representative,

[001] My name is Candide. I am the General Manager of Italian company Optimisme (OPT). OPT specialises in plastic recycling. We design our own recycling machines in-house and we have them made by Torre (TOR), an Italian company manufacturing plastic recycling machines. When we started working with TOR in 2018, we signed an agreement. Under this agreement, TOR is bound to secrecy, and all intellectual property generated since then belongs to OPT. In future, we will manufacture these machines ourselves.

[002] A known process of recycling includes cutting the plastic waste into small pieces in a mill, i.e. in a container with blades rotating at its bottom. An inorganic filler in the form of a powder is fed to the mill to be mixed with the plastic pieces to increase rigidity of the plastic. The problem with this known machine is that the maximum amount of filler that can be fed to the mill is 10% by weight. If higher amounts are fed to the mill, part of the filler is ejected outside the machine and a lot of dust is generated. Conventionally, to reach 50% by weight of filler, the plastic exiting the mill must be processed with another machine, where more filler is mixed with the plastic.

[003] In January 2019, we invented a new machine for recycling plastic. In our machine the filler is fed to the bottom of the mill so that it is mixed with the plastic pieces while the plastic waste is cut. This is a great improvement over the prior techniques: we can feed up to 50% of filler to the plastic in the mill and during the process less dust is generated, so that workers are safer than before.

[004] On 3 June 2019 we gave TOR our complete technical drawings and a fully enabling explanatory report to enable them to manufacture our machine, which we called FEED. On 1 July 2019 we received a prototype of the FEED machine with one feeding duct at the bottom of the mill. We modified the FEED machine received from TOR by adding a second feeding duct at the bottom of the mill. We discovered that by using two feeding ducts for the filler, a surprisingly greater uniformity of the recycled plastic can be obtained. We filed a European patent application, OPT-EP1, on 22 July 2019. OPT-EP1 discloses and claims a machine comprising at least one duct for feeding filler at the bottom of the mill. OPT-EP1 also discloses the machine with two feeding ducts at the bottom of the mill. This feature is claimed in dependent claim 2.

[005] After filing OPT-EP1, we realised that by mounting a special water spray device (SPRAY) on the FEED machine it is possible to reduce the dust generated by the machine, surprisingly without affecting the properties of the recycled plastic. On 4 October 2019, we filed European patent application OPT-EP2 without claiming any priority. OPT-EP2 includes the entire description and claims of OPT-EP1; it additionally discloses the SPRAY device and the FEED machine with the SPRAY device mounted on it.

[006] On 30 September 2020, we filed international application OPT-PCT. OPT-PCT contains the entire description and claims of OPT-EP2 and additionally claims the SPRAY device per se, and the FEED machine with the SPRAY device mounted on it. OPT-PCT claims priority from OPT-EP2.

[007] OPT-EP1 was granted as filed. The mention of grant was published on 27 January 2021. OPT-EP1 was opposed by a German lawyer. The grounds of opposition are lack of novelty and inventive step based on two documents.

[008] The first document is TOR-EP, a European patent application filed by TOR on 3 June 2019. The figures in TOR-EP are identical to the drawings we gave TOR, and the paragraphs of the description are identical to paragraphs of the report we gave to them. TOR-EP has a single claim directed to a machine having a duct for feeding filler at the bottom.

[009] TOR-EP discloses a subject-matter almost identical to the subject-matter of OPT-EP1. The only difference is that TOR-EP is silent on the two feeding ducts of OPT-EP1. TOR-EP is also silent on the water spray device of OPT-EP2. A communication of the intention to grant was sent to TOR five days ago.

[010] The second document is one of our own videos showing our prototype FEED machine and explaining how it works. We uploaded the video to our website, where it has been publicly available since 10 July 2019. The prototype machine disclosed in the video has only one feeding duct and no water spray device. According to the opponent, a claim directed to a machine having two feeding ducts is obvious in view of a machine having a single duct.

[011] We received a communication from the Opposition Division dated 3 December 2021 inviting us to file a response to the opposition within four months. Please help us to prepare our response. In our opinion, the opposition should be rejected because it was filed by a lawyer who has no interest in the case.

[012] There is another surprising advantage of having two ducts for feeding the filler to the bottom of the mill. We recently discovered that when filler in the form of a powder is fed from one duct and filler in the form of granules is fed from a second duct, the blades of the mill remain clean. The granules are made by compacting the filler powder. This feeding process, which we call CLEAN, provides an important advantage because it saves up to 30% of the costs of the recycling process by avoiding the machine having to be stopped in order to clean the blades. Feeding granules only does not provide this advantage.

[013] As it is such a valuable development, we want to protect the CLEAN process with a patent application. Before filing the application, we want to know the Opposition Division's opinion on it. Our idea is to explain this newly discovered advantage of having two ducts when arguing inventive step, in our written response to the opposition.

[014] We filed our OPT-PCT application in view of a joint venture we plan to enter with Avidus, an investment fund which will help us to manufacture our own machines and expand our activities in the US, China and India.

[015] There is another problem with TOR. Two weeks ago we received a "cease and desist" letter from TOR requesting us to cease any use of our FEED machine with the SPRAY device in view of their European patent TOR-EP-old. TOR-EP-old discloses and claims a water spray device that is identical to the one we make and use in our machine and which is disclosed in OPT-EP2. This water spray device was shown by TOR for a different purpose at a fair in Barcelona in 2014 which we attended. This water spray device was fully disclosed in a brochure with a date on it, which was handed out at the fair and is in our possession.

[016] TOR-EP-old was filed in 2015 without claiming priority and was granted in 2017. Avidus filed an opposition against TOR-EP-old on the ground of insufficiency of disclosure only. The opposition was rejected and Avidus appealed the decision of the Opposition Division. The appeal is pending.

[017] We attempted to contact TOR to resolve the above issues, but TOR refused to talk to us. Avidus informed us that they were contacted by TOR. TOR is using TOR-EP to convince Avidus to replace us with TOR in the joint venture. Avidus told us that if they reach an agreement with TOR, they will withdraw their appeal.

We have a meeting with Avidus scheduled for next week, and we need your help on the following points:

1. Outline the patent situation as it currently stands for:

    (a) the FEED machine with a feeding duct at the bottom of the mill
    (b) the FEED machine with two feeding ducts at the bottom of the mill
    (c) the CLEAN feeding process
    (d) the SPRAY water spray device
    (e) the FEED machine with the SPRAY water spray device

2. How would you advise us to respond to the opposition against OPT-EP1?

3. What could we do to improve our situation?

4. After the improvements, what products and methods could we stop TOR from making or using, and in which countries?