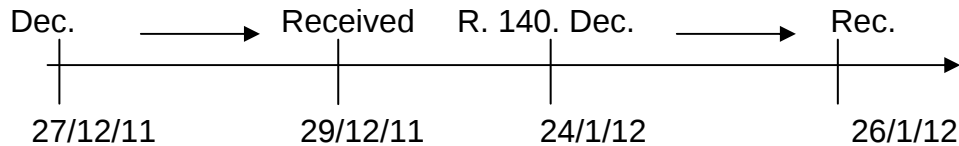


Candidate's answer

Q1.



- The original decision was in error because a lack of novelty falls under A. 54 EPC, not A. 56 EPC (which is inventive step).
- R. 140 allows for decisions to be corrected for obvious mistakes, which is clearly the case here.
- The timetable for filing appeal therefore depends upon which decision is appealed: 27/11/11 or 24/1/12.
- According to T 212/88, correction under R. 140 has retrospective effect, meaning that the 27/11/11 decision is “correct”.
- Hence the time table for appeal is as follows:

File Notice of Appeal: 2m from “decision” (A. 108 EPC)
i.e. 27/12/11 + 10d (notification; R. 126(2) EPC)
= 6/1/12
+ 2m = 6/3/12 (R. 131(4) EPC) (Tuesday)

- Since today is the final day for filing notice of appeal, I will inform client of this.
- If client wants to appeal, I can do the following:
- Time can be saved by filing notice of appeal by fax (R. 2(1); OJ 2007, SE3, A.3)
- Client must at least file notice of appeal to keep options open.
- Appeal fee also needs to be paid by 6/3/12 (A. 108 EPC).
- Whilst the appeal fee is expensive, it must be paid.
- Client then has 4m from decision to file grounds of appeal (A. 108 EPC), thus client can make his final decision by:

27/12/11 + 10d (R. 126(2) EPC) = 6/1/12
+ 4m (A. 108) = 6/5/12 (Sunday)
→ Extends to Monday 7/5/12 (R. 134(1) EPC)

Q2.

EP1 (EN), 1st E.D = 13/11/07
DIV-1 (EN) = 14/12/09 (Munich)
6/10/11 = S.R. A. 83, no s. fee
DIV-2 (EN) = 30/09/10 (Berlin!)

- EP1 was filed before 13/12/07, and was therefore filed under EPC 1973.
- However DIV-1 and DIV-2 were filed after entry into force of EPC 2000, so EPC 2000 applies.

a)

DIV-1

- EP1 must still have been pending when DIV-1 was filed (R. 36(1) EPC).
- Decision CA/D 2/09 of Admin. Council had not taken effect, so no other time limit applied except pendency of the parent EP1.
- DIV-1 filed in same language as EP1, so the requirement of GL, A-IV-1.3 and GL, A-VIII-1.3 was met as required until 1/4/10.
- Filing at Munich is acceptable (R. 36(2)).

DIV-2

- Filed after 1/4/10, so Decision CA/9 2/09 takes effect.
- Although disunity was raised in EESR, this is not a Communication from Exam. Div, so R. 36(1)(b) does not take effect (GL, A-IV-1.1.1.2).
- Thus, DIV-2 is a “voluntary” divisional (R. 36(1)(a) EPC).
- As such, the 24m time limit runs from the first communication from Exam. Division for the original application EP1 (R. 36(1)(a); OJ 2009, 481; GL, A-IV-1.1.1.2).
- So, time limit = 13/12/07 + 10d (R. 126(2); GL A-IV-1.1.1.3) = 23/12/07
+ 24 m = 23/12/09 (R.

131(4))

- i.e. DIV-2 filed too late, but ...
- However, Decision CA/D 2/09 provided an amnesty until 1/10/10 where the divisional deadline had passed by 1/4/10, so DIV-2 filed in due time.
- Filing divisional DIV-2 at Berlin is also acceptable (R. 36(2) EPC).

b)

- Yes, divisionals cannot be filed from EP1/DIV-2 since they are withdrawn i.e. not pending (R.36(1) EPC).
- ‘Mandatory’ divisionals can be filed from DIV-1 provided it is still pending and that Exam. Div raises a disunity objection (R. 36(1)(b) EPC).
- This would trigger a new 24m term (R. 36(1)(b) EPC).
- If no disunity objection is raised by Exam. Div., then no more divisionals.

Q3.

- Yes, this can be done by using EPO as SISA (A. 17(1); R. 45bis PCT).
- Request for SIS must be filed at IB within 19m of filing date along with payment of handling fee and supplementary search fee (to IB) (R. 45bis1(a); R. 45bis2(a); and R. 45bis3(a) PCT).
- Request must indicate EPO as SISA (R. 45bis1(b)(ii) PCT).
- Deadline = 5/10/12 + 19m = 5/5/12 (Saturday)



7/5/12 (Monday) (R.80.5 PCT).

- In request, applicant must indicate that the EPO search is intended to cover the second invention (R. 45bis1(d)).
- EPO as SISA will only search in EN, FR, DE (AG-IP; Annex SISA).
- However, SPTO as rO only accept Spanish (AG-IP; Annex C)
- Hence, applicant must submit a translation into EN, FR or DE along with the request (OJ 2010, 316).
- Applicant not required to provide an official representative (A. 49; R.90.1(a) PCT).

Q4.

EP-X (paper) → A (A.80 = 20/12/09)
R.45 = 15/2/10 = A1
PCT1 @ USPTO = EP-X, priority

a)

- Draft paper is the description of EP-X (R.40(1)(c) EPC).
- PCT1 filed 17/11/10, which is less than 12m after EP-X filing date of 20/12/09 (A. 8(2)(a) PCT; A. 4C(1)(2) PC).
- Claim not required for EP filing date (A. 80; R. 40(1) EPC).
- The description of PCT1 is the same as EP-X (A. 4C(2) PC), so priority is probably valid in the international phase.
- The claim to A1 in PCT1 would have been present at filing (A. 3(2) PCT), so no added-matter issue.
- IPRP probably favourable since the document disclosing A1 was published after the priority date.
- On entry into the EP phase (31m from priority – R. 159(1) EPC: 20/6/12 since priority will be assumed valid).
- EPO will conduct supplementary search (GL, B-11-4.3) which might find the document disclosing A1.
- Otherwise, the ISR will be part of the EP file, so Examiner will see it.
- Examiner will investigate priority validity since A1 was disclosed between priority and filing date (GL, C-V-2.1).
- Priority will be deemed invalid because A1 is not unambiguously derivable from the application as filed (G 2/98; GL C-V-2.2; A. 87(1) EPC).
- In this regard, the claim to A1 in EP-X is not part of the first application because it was not present on the filing date (A. 70(2) EPC).
- Effective date of PCT-1 claim to A1 is therefore 17/11/10 (A. 89 EPC).
- Claim will lack novelty over the disclosure of A1 in March 2010 (A. 54(2) EPC).

b)

- Draft paper includes unambiguous disclosure of A1, so priority claim is valid in EP (A. 87(1) EPC; G 2/98).
- Effective date of claim to A1 in PCT-1 is 20/12/09 (A. 89 EPC)
- Hence, A1 is not state of the art and the claim to A1 will be novel (A. 54(2) EPC) and likely inventive (A. 56 EPC).
- There should be no double patenting objection to identical claims of A1 in EP-X and PCT-1 because Applicant has 'legitimate' interest in obtaining prolonged protection from PCT-1 (T 1423/07).
- For completeness, the claim to A1 in EP-X was filed in due time (GL, A-III-15; R. 57(c) EPC).

Q5. PCT – CN @ SIPO

|
?/9/10

ISR

|
?/9/11

a)

- Chinese is a language of publication, so the specification will be published in Chinese (R. 48.3(a) PCT)
- The abstract will be additionally published in English (R. 48.3(c) PCT)
- The title, declaration according to A. 17(2)(a) PCT, International Search Report, and text pertaining to figure(s) in abstract will also be published in English (R. 48.3(c) PCT).
- The A. 19 PCT amendments will be published (R. 48.2(f) PCT) in Chinese.

b)

- Yes, WIPO makes abstract available in all languages of publication (R. 48.3(a) PCT), including French.

Q6.

IT1 – INV1 IT2 – INV2 = 28/10/10

- EP1 filed in due time to claim priority from IT1 and IT is a PC state, so priority is valid (A. 87(1) EPC).
- Effective date for Inv1 is EP1 is 28/10/10 (A. 89), so D is not state of the art (A. 54(2)) and Inv1 is novel.
- At present, Inv2 has an effective date of 28/10/11 (A. 89) and lacks novelty over D (A. 54(2)).
- Applicant should claim priority from IT2 to make effective date of Inv2 also 28/10/10 (A. 89 EPC).
- Multiple priorities are allowable (A. 88(2) EPC; G 2/98).

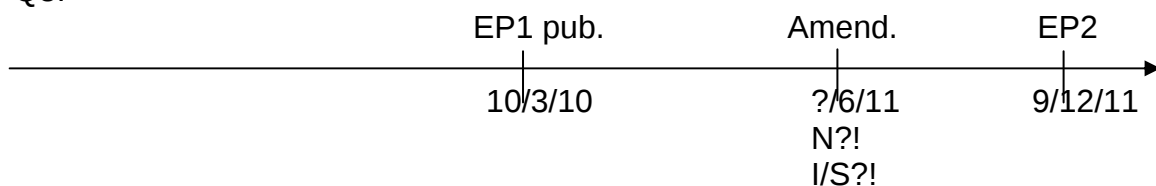
- Priority claim can be added up to 16m from the earliest priority date (i.e. 28/10/10) (R. 52(2) EPC).
- So, deadline is 28/10/10 + 16m = 28/02/2012 (R. 131(4)).
- Hence, the deadline has been missed (R 52(2)).
- FP is not available (A. 121; R. 135(2) EPC).
- Applicant can apply for re-establishment (A. 122) if he can prove missed deadline was despite 'all due care'.
- Without successful RE, applicant can use EP1 to get prosecution for whole of EP for Inv1 with EP1 and Inv2 in IT with IT2.

Q7.

- Methods of Diagnosis are not patentable according to A. 53(a) EPC
- However, not all methods of diagnosis are excluded (GL, C-IV-4.8.1), only those methods including:
 1. Examination phase
 2. Comparison with known values
 3. Finding deviation
 4. Decision phase (G 1/04; GL, C-IV-4.8.1).
- If all these phases are present, then it is prohibited.
- However, if it not clear whether 'on the basis of the tissue sample in the analysing liquid' constitutes steps 2 + 3 above, this requires further investigation.
- Moreover, even the implicit presence of steps 1 to 4 results in prohibition under A. 53(c) (G 1/09)
- So, method is probably not patentable.
- Although step a) represents surgery which is prohibited, (A. 53(c)), this is not essential so does not bar patentability.
- Instead, applicant should claim materials used in method.
- E.g.
 - chemical components per se.
 - chemicals for use in any method (A. 54(4) EPC)
 - chemicals for use in this method (A. 54(5) EPC; G 2/08)

All of which are not excluded by A. 53 EPC

Q8.



EP1

- The publication of EP1 on 10/3/10 becomes part of the state of the art (A. 54(2) EPC).
- After publication, the file of EP1 is open to public inspection (A. 128(4)).
- The matter filed in June 2011 is 'new' and 'inventive' over the application as filed (A. 70(2) EPC).
- In view of the unitary concept of disclosure in the EPC (G 2/98; G 2/04; G 2/10), matter which is new and inventive cannot be unambiguously derivable therefrom.
- Accordingly, the new matter will not be granted via EP1 because it adds subject-matter (A. 123(2) EPC), so no protection via EP1.

EP2

- As explained above, the file of EP1 is open to public inspection as from publication (A. 128(4)).
- Hence, applicant's reply in June 11 will also be publicly available (A. 54(2) EPC).
- There may be a delay before the Applicant's reply is published, but it will be available before 9/12/11 (i.e. effective date of EP2 – A. 89 EPC).
- Thus, applicant's reply will anticipate EP2 (A. 54(2) EPC).
- For completeness, it is noted that since the new matter is sufficient (A. 83), then it must also be enabling (GL, C-IV-6.3).
- Hence, EP2 is anticipated by Applicant's reply to Exam. Division in EP1 (A. 54(2) EPC).
- So, neither EP1 nor EP2 will provide protection for the improved matter.

EXAMINATION COMMITTEE III

Candidate No.

Paper D 2012 - Marking Sheet

Category		Maximum possible	Marks awarded	
			Marker	Marker
Part I	Question 1	5	4	4
	Question 2	6	5	5
	Question 3	5	3,5	3,5
	Question 4	4	4	4
	Question 5	5	3	2
	Question 6	6	4,5	4,5
	Question 7	4	0,5	1
	Question 8	5	4,5	4,5
Part II	Question 1	20	15,5	17,5
	Question 2	9	8,5	7,5
	Question 3	12	6,5	7,5
	Question 4	19	17	16,5
Total		100	76,5	77,5

Examination Committee III agrees on 77 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