

Based on legal text in force on 31.10.2019

1.

EP-A2 was not validly filed

- A European divisional application shall be filed directly at the EPO in accordance with the implementing regulations [A76(1) EPC].
- A divisional application shall be filed in the language of the proceedings of the earlier application (or the language which the earlier application was filed in if that was a language other than an official language of the EPO) [R36(2) EPC].
- The language of proceedings for EP-A1 is English [A14(3) EPC], because EP-A1 was filed in English and that is an official language of the EPO [A14(1) EPC].
- **Therefore, EP-A2 was not validly filed in accordance with A76(1) EPC and R36(2) EPC and will not be dealt with as a European patent application under A90(2) EPC.**

Validly file a divisional

- Applicant A needs to file a further divisional from EP-A1 directed to invention Y, referred to hereafter as EP-A3, in order to have invention Y searched.
- EP-A1 needs to be pending when EP-A3 is filed [R36(1) EPC]
- EP-A3 will meet this requirement:
 - until the mention of grant of EP-A1 (but not including) [G1/09]; and
 - until EP-A1 is deemed withdrawn, which is upon the expiry of the non-observed period [G4/98].
- Deadline to respond to A94(3) EPC communication is
 - 5 October 2020 + 10 days [R126(2) EPC] = 15 October 2020 + 4 months [R131(4) EPC] = **Monday 15 February 2021**
- This deadline has passed, so EP-A1 is deemed withdrawn [A94(4) EPC]
- Extension cannot be requested because the period has expired [GL E-VIII,1.6]
- Within two months from the notification under R112(1) EPC Applicant A therefore needs to request further processing [A121 EPC and R135 EPC] by paying the fee for further processing and filing a reply to the communication under A94(3) EPC [R135(1) EPC].
- Applicant A must do this before filing EP-A3 because a divisional filed after an application has been deemed withdrawn will only be filed if a remedy is applied successfully [J4/11 and GL A-IV,1.1.1]
- A divisional can only be filed in respect of subject-matter which does not extend beyond the content of EP-A1 [A76(1) EPC].
- EP-A3 will meet this requirement because EP-A1 described invention Y.
- EP-A3 needs to be filed in English because that is the language of proceedings of EP-A1 [R36(2) EPC]
- EP-A3 needs to be filed with the EPO in Munich, Hague, or Berlin [R36(2) EPC]
- Renewal fees already due for EP-A1 are due for EP-A3 on filing [R51(3) EPC].
- The first renewal fee for EP-A1 was due in 2020 because EP-A1 was filed in 2018 [A86(1) EPC]. Therefore, at least one renewal fee is due on filing for EP-A3.
- **Therefore, Applicant A needs to:**
 - **Pay the fee for further processing and filing a reply to the communication under A94(3) EPC to make EP-A1 pending.**
 - **Once EP-A1 is pending, file EP-A3 in English at the EPO and pay at least one renewal fee.**
- Only an indication that EP patent is sought (e.g. request for grant), applicant details, and description are required on filing [R40(1) EPC].

To have invention Y searched

- The EPO shall, in accordance with the implementing regulations, draw up and publish a European search report on the basis of the claims [A92 EPC]
- The search can only start after the claims have been filed because the search report is based on the claims [A92 EPC]
- **Therefore, Applicant A should file EP-A3 with claims directed to invention Y (although not needed for filing date) [R40(1) EPC]**
- The filing fee and search fee are due within one month of the date of filing [R36(3) EPC]
- However, the search will only start after paying the filing fee and search fee, since the EPO only renders a service after payment of the corresponding fee.
- **Therefore, Applicant A should pay the filing fee and the search fee on filing EP-A3.**
- The amount of the filing fee and search fee is fixed in Rfees2(1)1 and Rfees2(1)2, respectively.

2.

Restoration of priority is not effective in the European phase

- An office has a choice of applying two different criteria when deciding whether to restore the right of priority to an international application [R.26bis.3(a) PCT]
- One criteria is the the failure occurred in spite of due care [R.26bis.3(a)(i) PCT]

- The other criteria is that the failure was unintentional [R.26bis.3(a)(ii) PCT]
- Only a restoration of priority based on the due care criterion is generally binding on all designated offices [R49ter.1(a) PCT]
- Restoration of priority based on unintentional criteria is only effective in designated offices that apply that criterion [R.49ter.1(b) PCT]
- The EPO applies the all due care criterion [AG-NP National Chapter EP, A122 EPC, R136(1) EPC, EPG 5.13.019]
- **Therefore, because restoration was only based on unintentional criterion it is not effective and applicant B needs to take action before the EPO.**

Request restoration of priority before EPO

- A request may be filed during the national phase [R49ter.2(a) PCT]
- Therefore Applicant B needs to file a new request at the EPO as dO [EPG 5.13.022]
- The EPO will grant the request only if the following requirements are met:
 - The filing date of PCT-B is within two months of the date on which the priority period expired [R.26bis.2(c)(iii) PCT]
 - This criteria is met because the priority period expired on 2 August 2018 + 12 months [A4(C)(1) PC] = 2 August 2019 and therefore 9 August 2019 is well within the two months
 - The failure to file the claim occurred in spite of all due care [R49ter.2(a) PCT and A122 EPC]
 - This criteria is met.
 - The request is filed within one month of the date on which the 31-month time limit for entry into EP phase under R159(1) EPC expired [R49ter.2(b)(i) PCT]
 - The deadline under R159(1) EPC is from the priority date [R159(1) EPC].
 - The deadline for filing the request is therefore 2 August 2018 + 31 months [R131(4) EPC] = **2 March 2021** - i.e. today!
 - The fee for restoration of priority levied by the EPO is duly paid within the same time limit [R49ter.2(b)(iii), (d) PCT and R136(1) EPC]
 - The fee is fixed in Rfees2(1)13
 - The request for restoration is accompanied by a statement of reasons for the failure and any declaration or other evidence in support of the statement [R49ter.2(b)(ii) PCT and R136(2) EPC and T324/90]
- **Therefore, Applicant B needs to file a request to restore priority, with reasons, and pay the accompanying fee, today 2 March 2021.**

6.

1. Procedural steps for post-grant limitation

- At the request of proprietor F the European patent may be limited by amendment of the claims. [A105a(1) EPC]
- The request must be made in accordance with the implementing regulations [A105a(1) EPC, R90-92 EPC]
- The request is not deemed filed until the limitation fee has been paid [A105a(1) EPC]. The amount of the fee is fixed in Rfees2(1)10a]
- The request must be filed in writing [R92(1) EPC]
- The request must include details of the proprietor F [R92(2)(a) EPC] and the patent must be identified and a list of contracting states in which the patent has effect given [R92(2)(b) EPC]
- The amended claims must be given [R92(2)(d) EPC]
- Normally the decision on the request for limitation will have effect in all the Contracting States in respect of which EP-F has been granted [A105b(3) EPC]
- However, the decision may include a different set of claims for different contracting states if proprietor F requests this and informs the EPO of the existence of DE-G because DE-G is a national prior right [R138 EPC, GL D-X,10.1].
- **Therefore proprietor F needs to:**
 - **File a request for limitation in writing with the required information and pay the fee for limitation in accordance with A105a(1) EPC.**
 - **File the amended claims in respect of Germany under R138 EPC**
 - **Request that these are only for limitation of the claims in respect of Germany and inform the EPO of the existence of DE-G in accordance with R138 EPC**

2. Request will not be allowable

- The EPO examines whether the requirements laid down in the implementing regulations are met [A105b(1) EPC]
- The EPO examines whether the amended claims actually limit the patent and whether the requirements of A84 EPC, A123(2) EPC and A123(3) EPC are met [R95(2) EPC].
- The amended claim meets the requirements of A84 EPC because it is clear.
- The amended claim meets the requirements of A123(2) EPC because such a food composition is unambiguously disclosed in the description of EP-F.
- However, the amended claim is not a limitation and does not meet the requirements of A123(3) EPC [H-IV, 3.4 and T2017/07 hn]:
 - The proposed amended claim does not require that the food composition comprises 1 to 5% meat.
 - Therefore it encompasses a composition comprising 1 % beef meat, but also e.g. 5% pork meat.
 - Such a composition would comprise 6% meat, which is outside the scope of the claim of EP-F as granted, contrary to A123(3) EPC
- **Therefore, the request with the claim proposed by the proprietor is not allowable.**
- An exemplary amended claim which meets the requirements of A123(3) EPC would be: "A food composition comprising 1 to 5% meat and 1 to 5% beef

meat"

- This amended claim meets the requirements of A84 EPC because it is clear.
- We will have to check whether this amended claim meets the requirements of A123(2) EPC. It may do if it is considered that there is implicit basis for such a claim and the subject-matter does not extend beyond the teaching of EP-F, even if there is not explicit basis.
- Another exemplary amended claim which meets the requirements of A123(3) EPC is based on an undisclosed disclaimer: "A food composition comprising 1 to 5% meat, wherein the food composition does not comprise 3% of meat, wherein the meat is pork"
 - This amended claim meets the requirements of A84 EPC because it is clear.
 - Such an amendment meets the requirements of A123(2) EPC according to G1/16 because it exclude subject-matter for legal reasons and has no bearing on the technical information in the application.

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3.

Refund of search and/or examination fees for EP-C1

- The search fee is fully refunded if the application is withdrawn, refused, or deemed withdrawn at a time the EPO has not yet begun to draw up the search report [Rfees9(1), Not. EPO, OJ 2009 p.99]
 - The EPO draws up the search report on the basis of the claims [A92 EPC]. Therefore, the search can only start after the claims have been filed.
 - No claims have yet been filed for EP-C1 because the EPO has issued an invitation to file one or more claims.
 - Therefore, the search has not yet begun.
 - If client C does not respond to the invitation in due time then EP-C1 will be refused [A90(5) EPC]. The deadline for response is two months from the notification of the invitation [R58 EPC]
 - Alternatively, client C could actively withdraw EP-C1 before the deadline expires by writing to the EPO requesting unconditional withdrawal of EP-C1.
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- The examination is refunded if the application is withdrawn, refused, or deemed withdrawn before substantive examination has begun [Rfees11(a)]
 - Substantive examination has not started at least because the search has not been drawn up and the examining division has not assumed responsibility [R10 EPC]
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- Once EP-C1 is refused for failure to reply to the invitation (or actively withdrawn) the EPO will then make a refund to the deposit account that client C has indicated in the refund instructions [ADA.8 and OJ 2019 A82]
 - **Therefore, both the search fee and examination fee will be fully refunded and client C does not have to actively do anything.**

Refund of search and/or examination fees for EP-C2

- No refund of the search fee is possible because the European search report has been transmitted [Rfees9(1)]
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- The examination division can assume responsibility the day the search report is transmitted because the R70(2) EPC invitation was waived [R10(4) EPC]
 - The first step is a top-up search to identify additional prior art and the date of this is recorded in the file [GL C-IV,7.1]. The date can also be accessed or requested [Not. EPO OJ 2013 p.153 and GL A-VI,2.5]
 - If EP-C2 is actively withdrawn by client C **before** this first step has occurred then the examination fee will be refunded in full [Rfees 11(a)]
 - If EP-C2 is actively withdrawn by client C **after** this first step has occurred then the examination fee will be refunded at a rate of 50% [Rfees 11(b)] because the first A94(3) EPC communication has not issued and a R71(3) EPC communication cannot be the first communication because of the novelty-destroying document.
 - **Therefore, the examination fee will be refunded in full or at a rate 50% if client C actively withdraws EP-C2.**

4.

EP-D0 is novelty-destroying for the subject-matter of the claim of EP-D1

- EP-D0 **is not** state of the art under A54(2) EPC whether or not the claim is entitled to priority:
 - EP-D0 was published in Aug 2020, after the filing date of EP-D1 on 8 Jun 2020 and was therefore not publicly available prior to the effective date
- EP-D0 **is** state of the art under A54(3) EPC whether or not the claim is entitled to priority
 - EP-D0 has a filing date of Feb 2019, prior to the date of filing of US-D on 7 June 2019
 - EP-D0 was published in Aug 2020, after the filing date of EP-D1 on 8 Jun 2020
- Claim of EP-D1 therefore lacks novelty over EP-D0 as state of the art under A54(3) EPC [A54(1) EPC] because the disclosure of a bolt made of specific type of metal deprives the claim to a bolt made of a generic type of metal [GL G-IV,5]
- **Therefore, EP-D0 is novelty-destroying from the subject-matter of the claim of EP-D1**

Restoring novelty over EP-D0

- An undisclosed disclaimer may be added to make the claim novel over prior art under A54(3) EPC, such as EP-D0 [G1/16].
- Such a disclaimer excludes subject-matter for legal reasons and has no bearing on the technical information in the application and therefore meets the requirements of A123(2) EPC [G1/16]
- Therefore, the claim can be amended to "a bolt made of metal other than aluminium"
- Such a claim does not go beyond the purpose of making the claim novel over EP-D0 in accordance with G1/03
- **Therefore, claim EP-D1 can be amended to make its subject-matter novel**

If EP-D0 had been published in April 2020 it would be novelty-destroying for the subject-matter of the claim of EP-D1 and could not be overcome

- The priority claim is not valid because US-D is not the first application for the subject-matter of a bolt made of metal by applicant D [A87(1) EPC]
- EP-D0 is the first application by applicant D for a bolt made of metal, because aluminium is a type of metal.
- US-D cannot be the first application under A87(4) EPC because US-D and EP-D0 were filed in different states. Moreover, EP-D0 was not withdrawn leaving no rights outstanding on the date of filing US-D because it subsequently published around two months later. [A87(4) EPC]
- The effective date of the claim is therefore 8 June 2020.
- EP-D0 is state of the art under A54(2) EPC because it was publicly available April 2020, before the effective date.
- Claim of EP-D1 therefore lacks novelty over EP-D0 as state of the art under A54(2) EPC [A54(1) EPC].
- An undisclosed disclaimer cannot be used because EP-D0 is not an accidental anticipation since it is in the same technical field [G1/03] and such a claim would not meet the requirements of A123(2) EPC.
- **Therefore, if it was published in April 2020, EP-D0 is novelty-destroying from the subject-matter of the claim of EP-D1 and claim EP-D1 cannot be amended to make its subject-matter novel**

5.

Situation A: rO

- The applicant must file the international application with a competent rO (A10 PCT)
- The applicant must choose between the rO of or acting for the state which he is resident or a national and the IB [R.19.1(a)(i)-(iii) PCT]
- The EPO may act as rO if the applicant is resident of a contracting state, such as Portugal [A151 EPC, R157(1) EPC, OJ 2014 A33]
- Applicant E is a resident and national of Portugal so can file at National Institute of Industrial Property (Portugal), EPO or IB at the choice of the applicant [AG-IP, Annex B1]. Applicant E chose to file at the EPO.
- However, the EPO as rO accepts only French, German and English [R157(2) EPC]
- The EPO does not accept Portuguese because the PCT is applied in accordance with only A150-153 EPC and the corresponding rules, not A14(2) EPC.
- **Therefore, PCT-E will be transmitted to the IB under R.19.4(a)(ii) PCT which will then become the rO**

Situation A: translation

- Portuguese is a language of publication [R.48.3(a) PCT] so no translation is required for publication.
- Where the IB is the rO the competent ISA is the ISA which would have been competent if the application had been filed at the rO which is the national office of acting for a contracting state of which the applicant is national or resident [R.35.3(a) PCT].
- The EPO is competent ISA for Portugal and EPO [AG-IP Annex C] and is therefore the competent ISA.
- The EPO as ISA will only accept English, French and German for the international search of PCT-E [AG-IP Annex D, ISA/IPEA agreement between EPO and WIPO]
- Therefore, applicant E must furnish to the IB as rO a translation of PCT-E into English, French or German within one month of receipt of the international application by the rO [R.12.3(a) PCT].
- The date of receipt is considered the date of filing at the EPO, i.e. 3 Jan 2021 [R.19.4(b) PCT]. Therefore that deadline was:
 - 3 Jan 2021 + 1 month [R.80.2 PCT] = 3 Feb 2021
- If the translation is not provided by the time the rO notifies the applicant of the filing date the rO will invite the applicant to furnish the application within one month from the date of receipt of the invitation [R.12.3(c)(i) PCT]:
 - 29 Jan 2021 + 1 month [R.80.2 PCT] = Sunday 28 Feb 2021 = next working day [R.80.5 PCT] **Monday 1 March 2021**
- The translation can still be filed two months after the invitation subject to payment of a late furnishing fee [R.12.3(c)(ii) PCT and R.12.3(e) PCT]
- If the translation is not filed in due time the rO will declare PCT-E is considered withdrawn [R.12.3(d) PCT].
- A translation filed before this declaration is deemed filed in due time [R.12.3(d) PCT]
- **Therefore, a translation of PCT-E into English, French or German must be filed at the IB by Monday 1 March 2021**

Situation B: rO

- As described above, Applicant E is a resident and national of Portugal so can file at National Institute of Industrial Property (Portugal), EPO or IB at the choice of the applicant [AG-IP, Annex B1]
- As described above, the EPO as rO accepts English [R157(2) EPC]
- Drawings are not required to accord a filing date [A3(2) PCT and A11(1) PCT]
- **Therefore, the EPO is competent rO.**

Situation B: translation

- All elements of the IA must normally be in the same language [AG-IP 5.013]
- The IA, including the drawings, must be filed with the EPO as rO [EPG 2.23.001]
- However, if the text matter in the drawings are in a language which is different from the description and claims then the rO will invite the applicant to furnish a translation [AG-IP 6.018 and R26.3ter(a) PCT]
- The translation must be into the language in which the IA is to be published [R26.3ter(a) PCT] which will be English because the IA was filed in English [R48.3(a) PCT]
- The time limit is two months from the date of invitation [R26.3ter(a) PCT and R26.2 PCT]:

- 29 Jan 2021 + 2 months [R.80.2 PCT] = **Monday 29 March 2021**

- **Therefore, a translation of the text matter of the drawings into English must be filed at the EPO by Monday 29 March 2021**

1.

SPRINGY leashes in general (S)

W-JP

- W-JP is the first application for S
- However, W-JP was explicitly withdrawn soon after publication in July 2018 so cannot lead to patent protection for this subject-matter.
- W-JP also cannot act as a priority application for a new application because it was filed 2 Jan 2017, over 12 months ago

W-IT

- W-IT is the second application for S
- However, W-IT has been withdrawn so cannot lead to patent protection for this subject-matter.
- W-IT also cannot act as a priority application for a new application because it was filed 10 July 2017, over 12 months ago

W-EP

- W-EP is the third application for S
- S is claimed in claim 1 of W-EP as granted
- Priority is claimed from WT-IT
- Relevant prior art (whether or not priority claim is valid):
 - Puppy-press article published 4 Jan 2017 before effective date is state of the art under A54(2) EPC and discloses S
- Claim 1 of W-EP as granted lacks novelty over Puppy press article
- This objection was raised as a grounds in opposition by P
- W responded by limiting claim 1
- W-EP will not be maintained with claim to S and this has retroactive active [A68 EPC]
- Therefore W-EP will not provide patent protection for S

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

W-JP

- W-JP is the first application for S+O
- However, W-JP was explicitly withdrawn soon after publication in July 2018 so cannot lead to patent protection for this subject-matter
- W-JP also cannot act as a priority application for a new application because it was filed 2 Jan 2017, over 12 months ago

W-IT

- W-IT is the second application for S+O
- However, W-IT has been withdrawn so cannot lead to patent protection for this subject-matter.
- W-IT also cannot act as a priority application for a new application because it was filed 10 July 2017, over 12 months ago

W-EP

- W-EP is the third application for S+O
- S+O is claimed in claim 1 of W-EP as amended
- Priority is claimed from WT-IT
- Priority claim for S+O is invalid under A87(1) EPC because:
 - W-IT is not the first application for S+O by W
 - W-JP is the first application for S+O by W
 - A87(4) EPC cannot apply such that W-IT is deemed the first application for S because W-JP was filed in a different state to W-IT and because W-JP was not explicitly withdrawn until July 2018 which is after the filing date of W-IT on 10 July 2017
- Effective date for amended claim 1 is 29 June 2018, the filing date of W-EP
- Relevant prior art:
 - Puppy-press article published 4 Jan 2017 before effective date is state of the art under A54(2) EPC and discloses S
 - HP-PCT is **not** state of the art under A54(2) EPC because it was not published prior to the effective date
 - HP-PCT is **not** state of the art under A54(3) EPC because it was filed in Chinese, not an official language of the EPO and a translation has not been filed with the EPO [A153(5) EPC]
- Claim 1 of W-EP as amended is novel because Puppy press article does not disclose O
- Claim 1 of W-EP as amended is inventive because O is designed to detach the leash from the collar if the strain exceeds a particular limit to avoid excessive strain on the dogs's neck. This technical effect is disclosed in W-EP. No prior art suggests such a feature or effect.
- Claim 1 of W-EP as amended meets the requirements of A123(2) EPC because it was in the description of W-EP (although not claimed)

- Claim 1 of W-EP as amended meets the requirements of A123(3) EPC because it is narrower in scope than S as another feature has been added (O)
- Claim 1 of W-EP as amended meets the requirements of R80 EPC because amendment was made in response to ground of opposition (i.e. lack of novelty of claim 1)
- Claim 1 of W-EP as amended is currently valid.
- W-EP will currently be maintained with claim to S+O and this has retroactive active [A68 EPC]
- Therefore W-EP will provide patent protection for S+O in UK, France, Italy and Germany because it is currently in force in those states.

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

HP-PCT

- HP-PCT is first application for S+O+C
- S+O+C is claimed in claim 1 of HP-PCT
- Priority is not claimed
- Effective date for claim 1 is 18 June 2018, the filing date of HP-PCT
- Relevant prior art:
 - Puppy-press article published 4 Jan 2017 before effective date is state of the art under A54(2) EPC and discloses S
- Claim 1 of HP-PCT is novel because puppy press article does not disclose O or C
- Claim 1 of HP-PCT is inventive because:
 - O is designed to detach the leash from the collar if the strain exceeds a particular limit to avoid excessive strain on the dogs's neck. This technical effect is disclosed in HP-PCT. No prior art suggests such a feature or effect.
 - C has a surprisingly positive effect on the behaviour of the dog. This technical effect is disclosed in HP-PCT. No prior art suggests such a feature or effect.
- Claim 1 of HP-PCT is valid.
- HP-PCT has entered China national phase and will provide patent protection for S+O+C in China
- However, HP-PCT has not entered EP regional phase. Deadline was:
 - 18 June 2018 + 31 months = 18 Jan 2021
- The deadline for entering EP regional phase has passed, therefore EURO-HP-PCT is deemed withdrawn and no patent protection will be provided for S+O+C in Europe.

W-EP

- W-EP is the second application for S+O+C
- S+O+C is claimed in claim 2 of W-EP (as granted and amended)
- Priority is claimed from W-IT
- Priority is invalid for claim 2 because S+O+C is not disclosed in W-IT
- Effective date for claim 2 is 29 June 2018, the filing date of W-EP
- Claim 2 of W-EP is valid for the same reasons as claim 1 of HP-PCT
 - HP-PCT is **not** state of the art under A54(2) EPC because it was not published prior to the effective date
 - HP-PCT is **not** state of the art under A54(3) EPC because the filing fee has not been paid contrary to A153(5) EPC
- W-EP will currently be maintained with claim 2 to S+O+C
- Therefore W-EP will provide patent protection for S+O+C in UK, France, Italy and Germany because it is currently in force in those states.

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

W-EP

- W-EP is first application for S+Y
- S+Y is claimed in claim 3 of W-EP (as granted and amended)
- Priority is claimed from W-IT
- Priority is invalid for claim 3 because S+Y is not disclosed in W-IT
- Effective date for claim 3 is 29 June 2018, the filing date of W-EP
- Relevant prior art:
 - Puppy-press article published 4 Jan 2017 before effective date is state of the art under A54(2) EPC and discloses S
 - Although researchers at P developed S+Y in June 2018 there is no indication that this was made publicly available
- Claim 3 is novel because Puppy-press article does not disclose Y
- Claim 3 is inventive because Y is surprisingly effective at causing a dog to stop pulling on the leash to reduce the effect of strain on the dog. This technical effect is disclosed in W-EP. No prior art suggests such a feature or effect.
- Unity is not a ground of opposition and W-EP as amended does not need to comply with requirement of unity [G1/91]
- Claim 3 of W-EP is valid.
- W-EP will be maintained with claim 3 to S+Y
- Therefore W-EP will provide patent protection for S+Y in UK, France, Italy and Germany because it is currently in force in those states.

P-EP

- P-EP is second application for S+Y
 - The right to the European patent belongs to the first-to-file, not the first-to-invent [A60(2) EPC] - so it is not relevant that P developed invention in June 2018
- S+Y is not claimed in P-EP as granted
- It is too late to file a divisional application from P-EP because P-EP has granted and is therefore not pending
- It is too late to file an application claiming priority from P-EP because P-EP was filed on 2 July 2018, over 12 months ago
- Therefore, P-EP cannot provide protection for S+Y in Europe
- Notwithstanding, a claim to S+Y would lack novelty over W-EP
 - W-EP is state of the art under A54(3) EPC because it was filed earlier and published later than filing date of P-EP
 - W-EP is not a non-prejudicial disclosure, even though invention was developed by P in June 2018 because W developed invention independently.
 - W-EP discloses S+Y therefore is novelty-destroying

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

P-EP

- P-EP is first application for S+Y+A
- S+Y+A is not claimed in P-EP as granted
- It is too late to file a divisional application from P-EP because P-EP has granted and is therefore not pending
- It is too late to file an application claiming priority from P-EP because P-EP was filed on 2 July 2018, over 12 months ago
- Therefore, P-EP cannot provide protection for S+Y+A in Europe

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

P-EP

- P-EP is first application for S+Y+B
- S+Y+B is claimed in claim 1 of P-EP as granted
- Priority is not claimed
- Effective date for claim 1 is 2 July 2018, the filing date of P-EP
- Relevant prior art:
 - Puppy-press article published 4 Jan 2017 before effective date is state of the art under A54(2) EPC and discloses S
 - W-EP was filed on 29 June 2018, before the effective date, and published after effective date, and least when granted 5 Aug 2019. Therefore, W-EP is state of the art under A54(3) EPC and discloses S+Y
- Claim 1 is novel
 - Puppy-press article does not disclose Y or B
 - W-EP does not disclose B
- Claim 1 is inventive
 - W-EP is not citable for inventive step
 - Starting from Puppy-press article Y is surprisingly effective at causing a dog to stop pulling on the leash to reduce the effect of strain on the dog. This technical effect is disclosed in P-EP. No prior art suggests such a feature or effect.
- Claim 1 lacks sufficiency
 - A detailed description of at least one way of carrying out the invention must be given [GL F-III, 1 and A83 EPC]
 - Burden lies with applicant when no single example or other technical information from which the invention can be plausibly carried out is provided [GL F-III,4 and T1329/11]#
 - Therefore claim 1 lacks sufficiency because the description of P-EP does not include any suitable sound barrier (B) and indeed no barrier has yet been obtained.
- Claim 1 of P-EP is invalid
- Lack of sufficiency has been raised by W as a ground in opposition.
- Therefore, claim 1 of P-EP will be revoked by the OD in opposition
- Revocation is retroactive
- Therefore, P-EP will not provide protection for S+Y+B in Europe

2.

P-EP cannot be saved

- Claim 1 of P-EP cannot be maintained because it lacks sufficiency.
 - The only way to demonstrate sufficiency would be by showing that the teachings of P-EP are sufficient for the skilled person to obtain S+Y+B without undue burden

- However, since P has not been able to obtain S+Y+B this is not plausible
- Claim 1 of P-EP cannot be amended to replace the sound barrier feature with the AHHH modification because that would be contrary to A123(3) EPC.
 - The scope of S+Y+A is different from the scope of S+Y+B and therefore would extend the protection conferred by P-EP
- Therefore, P-EP is caught in an inescapable trap [GL H-IV, 3.6]
- As described above, it is too late to file a further application
 - It is too late to file a divisional application from P-EP because P-EP has granted and is therefore not pending
 - It is too late to file an application claiming priority from P-EP because P-EP was filed on 2 July 2018, over 12 months ago
- Therefore, P-EP cannot be saved.

3.

Enter EP regional phase with W

- As described above, HP-PCT has not entered EP regional phase. Deadline was:
18 June 2018 + 31 months = 18 Jan 2021
- The deadline for entering EP regional phase has passed, therefore EURO-HP-PCT is deemed withdrawn.
- The EPO will communicate to H and P that EURO-HP-PCT is deemed withdrawn.
- H and P may use further processing to enter the EP regional phase
 - The deadline for using further processing is two months from notification of the loss of rights
 - If the notification has not been sent yet further processing can still be used before - there is no need to wait
 - Therefore, H and P have until 18 Jan 2021 + 2 months = 18 March 2021 to complete the omitted acts and pay the further processing fee
- H and P need to complete the following omitted acts under R159(1) EPC by the deadline:
 - Pay the filing fee (and any additional page fee) + 1 FP fee at 50% of filing fee
 - Pay the designation fee + 1 FP fee
 - Pay the search fee + 1 FP fee
 - File request for examination and pay exam fee + 1 FP (flat fee + 50% of exam fee)
- Subsequently, HP-PCT will validly enter EP regional phase as EURO-HP-PCT
- Once filing fee is paid, EURO-HP-PCT will provide provisional patent protection for S+O+C [as a consequence of A153(4) EPC, EPG 5.16.003]
 - Therefore entry to EP regional phase should be effected ASAP to obtain provisional protection
 - To obtain provisional protection in IT, FR and DE a translation of the claims must be filed in Italian, French and German, respectively - provisional protection will apply from when translation is made available to the public
 - To obtain provisional protection in GB no translation is necessary because HP-PCT is in English - provisional protection will apply from date of publication of HP-PCT (shortly after 18 Dec 2019) - W was already selling S+O+C in GB so damages can be obtained from this date
- As described above, Claim 1 of HP-PCT is valid.
- Therefore, EURO-HP-PCT is expected to proceed to grant and provide patent protection for S+O+C in whichever contracting states it is validated in
 - H and P should validate in at least IT by filing a translation of the patent specification
 - National right will arise in GB, DE and FR automatically following grant
- H will need to be represented by a professional representative
 - Therefore because 31 month deadline has passed H need to appoint a professional representative entitled to practise before the EPO to act on their behalf and perform the necessary acts for late entry to the EP regional phase [GL E-IX, 2.3.1] e.g. request for examination
 - Although the fees (including filing fee) can be paid by anyone [EPG 5.3.009]
 - Also to ensure P is deemed common representative and can act during prosecution they should also appoint a professional representative (can be the same) [R151(1) EPC]
 - If professional representative is not appointed in due time EPO will invite H to do so.

Cite EURO-HP-PCT in opposition against W-EP and file W-JP

- P should file W-JP and argue that claims 1-2 (as granted and amended) do not validly claim priority because W-IT is not the first application for this subject-matter.
 - Although evidence is late-filed it will be taken into account because it is prima facie relevant to novelty for the reasons below
- Claim 3 (as granted and amended) does not validly claim priority.
- All claims of W-EP therefore have an effective date of 29 June 2018
- P should file EURO-HP-PCT and argue that claims 1-2 (as granted and amended) lack novelty
 - Although evidence is late-filed it will be taken into account because it is prima facie relevant to novelty for the reasons below - moreover it was not relevant to novelty previously!
- Once filing fee is paid for HP-PCT and enters EP regional phase as EURO-HP-PCT, it becomes relevant for opposition against W-EP:
 - EURO-HP-PCT becomes state of the art under A54(3) EPC because it was filed on 18 June 2018, prior to effective date and published after the effective date
 - EURO-HP-PCT describes and claims S+O+C
- Effect on validity:
 - Claim 1 of W-EP as granted (S) lacks novelty over EURO-HP-PCT because EURO-HP-PCT discloses S+O+C and disclosure of a specific embodiment is novelty-destroying for the generic
 - Claim 1 of W-EP as amended (S+O) lacks novelty over EURO-HP-PCT because EURO-HP-PCT discloses S+O+C and disclosure of a specific embodiment is novelty-destroying for the generic
 - Claim 2 of W-EP as granted and amended (S+O+C) lacks novelty over EURO-HP-PCT because EURO-HP-PCT discloses S+O+C
 - Claim 3 of W-EP is still valid because EURO-HP-PCT does not disclose S+Y
- Therefore, W-EP claims 1 and 2 are invalid.

- W-EP is not expected to be maintained with claims 1 and 2. This effect is retroactive and therefore W-EP will not provide any patent protection for S, S+O or S+O+C.
- W-EP may still provide patent protection for S+Y.

4.

P can stop W from making and selling S+O+C

- As described above, once EURO-HP-PCT is granted and validated in IT it will provide patent protection for S+O+C in IT, GB, FR and DE
- P can stop W from making S+O+C in Italy (and GB, FR, DE)
 - P will have provisional protection once EURO-HP-PCT enters EP phase and translation of claims in Italian is filed
- P can stop W from selling S+O+C in IT, GB, FR, DE
 - P will have provisional protection once EURO-HP-PCT enters EP phase and translation of claims in Italian, French and German is filed

W can stop P from making and selling S+Y or S+Y+A or S+Y+B

- W-EP is granted and in force
- As described above, W-EP will be limited to S+Y (at best) and will provide patent protection in GB, FR, IT and DE
 - Protection will cover S+Y, S+Y+A and S+Y+B since these fall within scope of S+Y and claim 3 uses open ended "comprising" or "having" language
- W can stop P from making S+Y, S+Y+A and S+Y+B in GB (and IT, FR (and DE))
- W can stop P from selling S+Y, S+Y+A and S+Y+B in GB, IT, FR (and DE)
- Although P researchers developed S+Y in June 2018 they were not making or selling S+Y and therefore it is very unlikely that they can use any public prior use defence

Potential strategy

- P should not start making S+Y, S+Y+A or S+Y+B in GB or selling in GB, IT or FR unless they can agree a cross licence with W
 - Cross-licence could offer to at least allow W to continue selling S+O+C in DE since P does not intend to do that
 - P will need agreement of H to grant this licence
 - In return P could try to obtain some rights from W to make and sell S+Y or S+Y+A