Examiners' Report – Paper D 2024

Purpose and extent of the examiner's report

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

General comments

Candidates are reminded that they should pay attention to the way 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 are only awarded when the full legal basis is cited to support the analysis. Some candidates lost marks due to missing or incomplete legal basis. Citing only the legal basis or repeating the text therefrom without any further explanation, reasoning or providing advice generally does not attract any marks. Alternative relevant legal basis not mentioned in the possible solution also attracted marks. It is noted in this respect that the online examination with direct access to part of the syllabus in electronic form, appears to be seen as an invitation to copy articles, rules and paragraphs from the guidelines, for which full marks are only awarded if, apart from the copied text, the explanation is also provided in view of the situation in the question. With respect to the abolished 10-day rule, most candidates followed the Decision of the Supervisory Board of 26 June 2023 and calculated the time limits according to the newest version of the rules. Nevertheless, candidates, who correctly applied the old version, were also awarded full marks this year.

Examiners' Report – Paper D 2024, Part I

Question 1 (14 marks)

This question was generally well answered. Most candidates stated that PCT-3 was likely filed in Spanish, as it is an accepted language by the SPTO. Fewer candidates however realized that PCT-3 must have been filed in Spanish, as it is the only language accepted by the SPTO and would otherwise have been transmitted to the IB.

Quite a few candidates missed the fact that late filing of the translation is possible or did not calculate the corresponding time limits.

Most candidates correctly answered when and where to file amended claims and the rectified description. Some candidates however wrongly concluded that the claim amendments must be filed in the language of translation. Many candidates missed the fact that the rectified description needs to be filed both in the language of the application and in the language of translation.

Question 2 (12 marks)

Most candidates realized that the examination fee has not been paid and a reply to the written opinion was not filed in time. Some candidates forgot that the designation fee also has to be paid. Many candidates failed to recognize that the application is deemed withdrawn independently for each of the three omitted acts and did not cite all relevant legal bases. Most candidates correctly indicated that further processing was available, but the time limit for it has been missed, so that re-establishment into the period for further processing is the only option. Points were frequently missed due to wrongly calculated time limits. In particular, candidates often did not start the calculation of the 1-year time limit of Rule 136(1) EPC from the missed time limit for further processing. Moreover, the list of acts to be performed was often incomplete or insufficient legal basis was cited. Many candidates forgot to mention renewal fees or did not conclude that renewal fees for the third year will become due on the date of the notification of the decision re-establishing the rights.

Question 3 (9 marks)

Although relating to rather standard matter, this question was not well answered. Most candidates realized that A, not being a resident of a contracting state, needed to appoint a professional representative, and that the representative needed to sign the notice of opposition. Many candidates wrongly argued that the appointed representative will be deemed common representative only because A, who needs representation, is named first.

Some candidates realized that the translation of the notice of opposition was timely filed before the expiration of the opposition period, albeit not being validly signed. However, many failed to recognize that, to retain its original date, the accompanying letter needs to be signed by the appointed representative.

Question 4 (11 marks)

For many candidates, this question appears to have been the most challenging in Part I. Most candidates realized that EP-D2 and EP-D3 were late filed and will be admitted into the proceedings only if they are prima facie prejudicial to the maintenance of the patent. However, many candidates failed to recognize that EP-D3 is only relevant for claim 4, which is not covered by the extent of the opposition and will therefore not be admitted. Many candidates copied relevant provisions but failed to apply those to the situation at hand. Most candidates correctly suggested filing amended claims relating to subject-matters A+B and A+C.

Many candidates did not realize that subject-matter D cannot remain in a valid patent. Of those, who did, the majority missed that, to obtain a valid patent, subject-matter D should be deleted in a limitation procedure after the opposition.

Question 5 (9 marks)

This question was generally well answered. Most candidates provided the correct steps and bases needed to validate EP-7 in Poland and the UK, as well as those needed to obtain Unitary Patent protection. Points were mostly lost with respect to when and where renewal fees need to be paid. For example, most candidates overlooked the special provisions for payment of the

renewal fees in the UK. Considering that this was the first time a question was asked on Unitary Patent protection, most candidates were well prepared and cited the relevant legal basis.

Examiners' Report – Paper D 2024, Part II

Question 1 (20 marks)

Most candidates realized EP-P2 and EP-P3 were only entitled to partial priority, but a small minority correctly applied the case law of G1/15 in dividing the claimed subject matter. In the aftermath of decision G1/15, the Examination Committee has repeatedly tested partial priority in view of its importance in the practice before the EPO. To the regret of the Examination Committee, it appears that the majority of EQE candidates still cannot successfully apply the principles of G1/15.

In this respect, while the range of CO2 concentration was usually addressed, the generalization of spider species was often overlooked.

Candidates often missed the invalid priority claim in EP-P3 to EP-P2 for the subject matter which was already disclosed in EP-P1.

Even among the candidates who correctly divided the claimed subject matter, there were some who wrongly concluded that EP-P1 was novelty destroying for claim 1 of EP-P2.

Few candidates realized that the comparative example, AA [16], was also novelty destroying for claim 1 of EP-P3.

The part on EP-AA+ was usually well answered. However, a surprisingly high number of candidates wrongly considered that EP-P2 was a prior art document under Art. 54(3) EPC, despite there was no indication in the paper that EP-P2 was published after the filing date of EP-AA+.

The part on PCT-TM+ also quite well answered. However, discussion on the validity of product-by-process claims was often omitted.

Question 2 (12 marks)

Overall, this question was not well answered by most candidates.

Many candidates realized that there was a need to revive a Euro-PCT application after the missed regional phase entry for PCT-TM+. However, the applicable remedies that should be used to revive the application were not always properly identified and the corresponding

deadlines correctly computed (e.g. the starting point of the one-year period for re-establishment). In addition, many candidates wrongly concluded that the communication of loss of rights should have been notified to the representative.
Among the candidates who discussed the opportunity to extend the geographical scope of protection of PCT-TM+ to Bosnia-Herzegovina, only a small minority recognized how this should be achieved.

Question 3 (7 marks)

a)
Some candidates speculated about possible grounds to oppose EP-P2, presumably because the opposition period had not yet lapsed; however, there was no information in the paper that any ground could be successful.
A disappointing number of candidates noted that validation in Switzerland was automatic. In contrast, a good number of the candidates realized that the CO_2 concentration used in Spiez (16%) did not fall within the claimed range of EP-P2.

b)
Some candidates just considered that no rights were available in Turkey, and therefore, did not discuss the fact that the CO_2 concentration used in Turkey (8%) falls within the claimed range of EP-P2.

c)
The majority of candidates correctly acknowledged that there were no patent rights available in the US.

d)
A fair number of candidates correctly spotted the Art. 64(2) issue for importing in Switzerland.

Question 4 (6 marks)

a)

The candidates who suggested to file third party observations against EP-P3, and the ones who suggested to file an opposition later were awarded the same number of marks.

Very few candidates explained why it would not be possible for Prosilk to have protection covering the embodiment used by Xeracno, and concluded that they were free to operate.

b) and c)

The b) part of this question was poorly answered, whereas the c) part of the question was well answered.

d)

Very few candidates had the right answer because they simply replicated their answer to question 3 part d) without noticing that no patent right could be achieved on the 8% CO2 concentration and that therefore protection of a product directly obtained by a process was no longer applicable.

Possible Solution – Paper D 2024, Part I

Reference to legal bases refer to the situation on 31 October 2023

Answer to Question 1 (14 marks)

(a)

The SPTO accepts only Spanish as the language in which international applications may be filed, Rule 12.1(a) PCT and PCT Applicant's Guide Annex C. PCT-3 was filed in Spanish, because otherwise the SPTO would have transmitted it to the IB, Rule 19.4(a)(ii) and Rule 19.4(b) PCT.

The EPO, acting as ISA, Article 152 EPC, accepts English, French or German, PCT-EPO Guidelines A-VII, 2.1. Therefore, Spanish is not accepted. The invitation issued by the SPTO is thus an invitation under Rule 12.3(c) PCT to furnish a translation into one of English, French or German for the international search. The time limit for the late filing of the translation is the later of:

- one month from the date of the invitation, i.e. 17 January 2024 + 1 month → 17 February 2024 (Sat) → 19 February 2024 (Mon), Rule 80.5 PCT, and
- two months from the date of receipt of the international application by the receiving Office, i.e. 05.03.2024 (Tue, today). Therefore, today, D needs to file the translation and pay the late furnishing fee, Rule 12.3(e) PCT.

(b)

According to Article 19(1) PCT, amended claims can only be filed after the receipt of the international search report and, according to Rule 46.1 PCT, within 2 months from the date of its transmittal or within 16 months from the priority date, whichever expires later. The amendments must be filed at the IB, Rule 46.2 PCT.

Since the application is filed in Spanish, it will be published in Spanish, which is a language of publication, Rule 48.3(a) PCT. Hence, the amendments must be filed in Spanish, Rule 46.3 PCT.

An obvious mistake in the description can be corrected under Rule 91.1(b)(ii) PCT. Since the application is translated under Rule 12.3(a) PCT, the rectified description needs to be filed

both in Spanish and in the language of translation, Rule 12.2(b)(i) PCT. This must be done at the EPO/ISA within 26 months from the priority date, Rule 91.2 PCT.

Answer to Question 2 (12 marks)

The examination fee and the designation fee had to be paid at the latest on 17 May 2023 + 6 months → 17 November 2023 (Fri), Article 94(1), Rule 70(1), Article 79(2) and Rule 39(1) EPC. Since the search opinion was negative, a reply to the opinion also had to be filed by the same date, Rule 70a(1) EPC.

The communication noting the loss of rights is a communication under Rule 112(1) EPC indicating that the application is deemed to be withdrawn because three independent procedural acts were omitted:
- payment of the examination fee, Article 94(1) and (2) EPC;
- payment of the designation fee, Rule 39(2) EPC;
- non-compliance with the invitation to comment on the objections raised and/or to correct any deficiencies noted in the search opinion, Rule 70a(3) EPC.

Further processing, Article 121 and Rule 135(1) EPC, was available for each of the omitted acts until 12 December 2023 + 2 months → 12 February 2024 (Mon). Thus, today, it is too late.

Removal of the cause of non-compliance is today, i.e. when company C became aware of the notification. Re-establishment into the period for further processing under Article 122(1) EPC is thus still possible until 05 March 2024 + 2 months → 05 May 2024 (Sun) → 06 May 2024 (Mon), Rule 131(4) and Rule 134(1) EPC. This is within 1 year from the missed time limit for further processing, i.e. 12 February 2024 + 1 year → 12 February 2025, Rule 136(1) EPC.

The three omitted procedural acts have different legal bases and are therefore independent from each other. Consequently, three requests for re-establishment must be filed and three fees for re-establishment must be paid, Guidelines E-VIII, 3.1.3.

Company C must provide evidence that the failure to observe the time limit resulted from an isolated mistake within a normally satisfactory monitoring system, Guidelines E-VIII, 3.2, which shows that all due care was taken, Rule 136(2) EPC.

Company C must further complete the omitted acts for re-establishment, i.e. request further processing, Article 121(1) EPC and Rule 135(1) EPC, by:
- Paying the examination fee, and paying the fee for further processing, i.e. paying the examination fee with a 50% surcharge, Article 2(1) item 12 RFees;
- Paying the designation fee, and paying the fee for further processing, i.e. paying the designation fee with a 50% surcharge, Article 2(1) item 12 RFees;
- Filing a reply to the search opinion and paying the fee for further processing, Article 2(1) item 12 RFees.

The renewal fee for the third year was due on 30.11.2023, Rule 51(1) EPC. Hence, Rule 51(4) (a) EPC applies, i.e. the renewal fee falls due on the date of the notification of the decision re-establishing the rights and may still be paid within four months of that date without an additional fee.

Answer to Question 3 (9 marks)

The signature of A is invalid, because, in a joint opposition, each party or their duly authorized representative must sign the notice of opposition giving rise to their participation, Guidelines A-VIII, 1.4.

Since A is not resident in a contracting state, A must appoint a professional representative for filing the opposition, Article 133(2) EPC. The invitation of the opposition division is an invitation under Rule 77(2) EPC to appoint a representative and to arrange for the signature or approval of the notice of opposition by the representative to be appointed, Guidelines D-IV, 1.2.2.2 (iv). This must be done until 29 January 2024 + 2 months → 29 March 2024 (Good Friday), Rule 134(1) EPC → 02 April 2024 (Tue). The professional representative appointed by A shall be deemed to be the common representative upon appointment, Rule 151(1) EPC.

Both A and B are persons according to Article 14(4) EPC, because both are nationals of Spain and additionally B is resident of Spain, which has Spanish as an official language. Hence, the joint opponents could file the notice of opposition in Spanish, but a translation in an official language of the EPO had to be filed. The translation could be filed until the expiration of the opposition period, i.e. until yesterday, Rule 6(2) EPC. The translation was therefore filed on time.

However, since the letter accompanying the translation was not filed by the common representative, it will be considered not duly signed, Rule 50(3) EPC in combination with Rule 86 EPC. The common representative, once appointed by A, will have to sign a letter accompanying the translation on invitation of the EPO within a time limit to be specified. Once this is done, the translation will retain its original date, i.e. it will be considered to have been filed in due time.

Answer to Question 4 (11 marks)

EP-D2 and EP-D3 are late filed, Guidelines E-VI, 2.1, because they were filed after the expiry of the opposition period according to Article 99(1) EPC, Rule 76(2)(c) EPC. The EPO may disregard evidence, which has not been submitted by the parties in due time, Article 114(2) EPC.

In the present case:

- EP-D2 will be admitted into the proceedings, because it is prima facie relevant to the assessment of novelty, Article 114(1) EPC, Guidelines E-VI, 2.1;
- EP-D3 will not be admitted into the proceedings, because it is not related to the extent of the opposition, G9/91.

Claim 1 of EP-4 lacks novelty in view of EP-D2, Article 100(a) EPC in conjunction with Articles 52(1) and 54(3) EPC. Therefore, company E should as soon as possible file a new (main) request with claims directed to subject-matters 1: A+B, 2: A+C and 3: D.

The replacement of one independent claim as granted by two independent claims is admissible as the replacement is occasioned by a ground for opposition, Guidelines H-II, 3.1. The thus amended claims are novel over EP-D2. The patent will therefore be maintained in amended form, Article 101(3)(a) EPC.

The resulting patent will nevertheless not be valid. The claim directed to subject-matter D lacks novelty over EP-D3 but cannot be deleted in opposition proceedings, because it is not part of the extent of the opposition, G9/91.

To obtain a valid patent, company E should file a request for limitation, Article 105a(1) EPC, after the opposition proceedings are terminated, Article 105a(2) EPC. To this end, company E should file a new set of claims, wherein the claim directed to D is deleted, and pay the limitation fee, Article 105a(1) EPC, Article 2(1) item 10a RFees.

Answer to Question 5 (9 marks)

(a)
The renewal fee for the 5th year is due to the national offices, Article 86(2) EPC.
For Poland the renewal fee is due on 21 February 2024 + 2 months → 21 April 2024 (Sun) → 22 April 2024 (Mon), National Law Table VI and Article 141(2) EPC.
The UK allows for payment up to the last day of the 3rd month after the publication of the mention of the grant 21 February 2024 + 3 months → 21 May 2024 → 31 May 2024 (Fri), National Law Table VI.

For Poland, the patent specification needs to be translated into Polish, National Law Table IV and Article 65(1) EPC, within 3 months, 21 February 2024 + 3 months → 21 May 2024 (Tue). The special fee needs to be paid within 3 months from invitation by the Polish Patent Office, National Law Table IV. A Polish national representative must be appointed, National Law Tables IV and VI.A.

UK is a contracting state to the London Agreement. Therefore, no acts of validation are required.

(b)
A request should be filed in French, Rule 6(2) UPR (Rules relating to Unitary Patent Protection), with the EPO within 1 month, Rule 6(1) UPR, 21 February 2024 + 1 month → 21 March 2024 (Thu). It should contain the particulars of the proprietor, the number of the

European Patent, the particulars of a representative, as H is national and resident of Morocco, and a full translation of the specification into English.

The renewal fee for the 5th year is due within 3 months of the date of notification of the communication of registration of the unitary effect, Rule 13(4) or Rule 13(5) UPR, depending on the date of notification of the Rule 7(1) UPR communication, and is to be paid to the EPO, Rule 13(1) UPR.

Possible Solution – Paper D 2024, Part II

Question 1

- **EP-P2**

EP-P1 is the first application for raising spiders AA in an atmosphere containing from 3% to 9% CO_2 (AA [3-9]).

EP-P2 has the same applicant as EP-P1 and it has been filed within 12 months.

Claim 1 of EP-P2 has 2 effective dates due to partial priority:

- 16 January 2019 for subject matter AA [3-9] benefiting from the priority of EP-P1, and
- 14 January 2020 for remaining subject matter, i.e. for raising species other than AA with [3-9] CO_2 and for raising any species with a higher concentration than 9% CO_2, not benefiting from priority from EP-P1.

EP-P1 is a Art. 54(3) document for the part for which priority is invalid, because it was filed before and published after, but is not novelty destroying because it does not disclose it.

Claim 1 is novel over the prior art which uses acetylene. CO_2 is a different gas.

Claim 1 is also inventive because raising spiders in the claimed range of CO_2 concentration is not suggested in the prior art, and it avoids cannibalism while solving the safety issues.

As a result, claim 1 is patentable and has been correctly granted.

- **EP-P3**

EP-P3 has the same applicant as in EP-P2 and it has been filed within 12 months.

Claim 1 has 2 effective dates due to partial priority:

- 14 January 2020 for subject matter first disclosed in EP-P2, i.e. for raising species other than AA with [3-9] CO_2, and for raising any species with a higher concentration than 9% CO_2, for which the priority claim is valid.
- 15 May 2020 for subject matter AA [3-9] and the comparative example AA [16] which are first disclosed in EP-P1, and therefore the priority claim from EP-P2 is not valid.
- 15 May 2020 for remaining subject matter, i.e. for raising any species in the CO_2 range above 13%, excluding AA [16], for which priority claim is also not valid as it was not disclosed in EP-P2.

EP-P1 is Art. 54(3) document because it was filed before the priority date of EP-P3 and published after.

EP-P2 is also Art. 54(3) document for the claimed subject matter not enjoying priority, because it was filed before the filing date of EP-P3 and published after.
Claim 1 of EP-P3 lacks novelty over any of EP-P1 and EP-P2, which disclose the comparative example AA [16] and AA [3-9].
As a result, EP-P3 as it currently stands should not proceed to grant.

- **EP-AA+**

No priority is claimed and therefore the effective date for both claims is the filing date.
EP-P1 & EP-P2 are comprised in the state of the art under Art. 54(2) EPC, whereas EP-P3 is an Art. 54(3) document.
Claim 1 is novel over the prior art due to the presence of N_2O.
Claim 1 is also inventive because raising spiders in the presence of N_2O is not suggested in the prior art, and the presence of N_2O leads to an improved silk production.
Claim 2 being dependent on claim 1 is novel and inventive for the same reasons.

- **PCT-TM+**

No priority is claimed and therefore the effective date for both claims is the filing date.
Claim 1 is novel because no prior art document discloses a spider diet involving tiger mosquitos.
Claim 1 is also inventive because the feeding of spiders with tiger mosquitos is not suggested in the prior art, and such a diet surprisingly increases the spiders' lifespan.
As it currently stands, protection may therefore be expected in the US for claim 1.
Claim 2 is a product-by-process claim. The result of the process is still the same spider silk as the one produced according to the prior art.
Therefore, claim 2 would not be novel if the regional Euro-PCT phase was entered according to Xeracno's wish.

Question 2

The time limit for entering the European phase for PCT-TM+ expired on 14 November 2023.
The time limit for requesting further processing in response to the communication of loss of rights has expired on 14 February 2024.

It is possible to request re-establishment of rights in respect of the missed further processing time limit. In the request, it should be explained why the time limit for requesting further processing could not be observed despite all due care having been taken.
The omitted acts to enter the European phase have to be completed along with the payment of the further processing fees, as well as the corresponding re-establishment fees.
This should be done within 2 months of the removal of the cause of non-compliance, i.e. 4 March 2024, and therefore no later than 6 May 2024. This is within one year from the unobserved time limit for requesting further processing.
Additionally, the renewal fee for the third year needs to be paid, and this can be done within four months from the decision re-establishing the rights.
As far as Bosnia-Herzegovina is concerned, the time limit of 34 months for entering the national phase was missed. A possibility to get patent protection there is to request extension of the Euro-PCT patent application when completing the omitted acts.
The EPO did correctly send the notification of loss of rights to Xeracno instead of SMART SA because the appointment of a representative during the international phase does not imply that it applies also to the Euro-PCT phase.
Once Xeracno obtains a European patent, and all the requirements for validation are met in Bosnia-Herzegovina, they will be able to prevent Prosilk from harvesting spider silk with a method comprising feeding of spiders with tiger mosquitos in that country.

Claim 2 of PCT-TM+ cannot be granted by the EPO. However, in European countries, Xeracno will be able to prevent Prosilk from selling silk directly obtained by a method falling under the scope of claim 1, such as the one which is planned by Prosilk in Bosnia-Herzegovina.

There is nothing that can be done though against the current production of Prosilk in Germany because the method of harvesting spider silk by raising AF spiders in a concentration of 19% CO_2 cannot be covered by any of Xeracno’s patent applications.

Question 3

a)

Validation in Switzerland is not needed because the country has ratified the London Agreement. So EP-P2 is effective there because the renewal fees were paid.
Yet the 16% CO_2 concentration used at the farm in Spiez does not fall within the range covered by EP-P2 so that Xeracno is free to produce there.

b)

Raising AA-spiders under 8% CO_2 concentration falls within the scope of protection of the claim of EP-P2, irrespective of whether the spiders are fed with tiger mosquitos or not.
There is no evidence that validation of EP-P2 in Turkey has been carried out. Additionally, the renewal fees, which were due in January 2024 have not been paid.
Therefore, no patent protection is currently available there, and Xeracno is free to harvest spider silk there.

c)

The patent protection of EP-P2 does not extend to the USA, so Xeracno cannot be prevented from harvesting silk in Colorado in view of EP-P2.

d)

As far as importation to Switzerland is concerned, the silk harvested in Turkey or Colorado is a product directly obtained by the method of EP-P2. Therefore, Xeracno can be prevented from importing and selling this silk into Switzerland.

Question 4

At this stage of proceedings, it is advisable to file third party observations to draw the attention of the EPO to the priority and novelty issues.

a)

EP-P3 cannot validly cover the harvesting method of spider silk at the farm of Spiez because raising AA spiders at CO_2 concentration of 16% belongs to the prior art. It can therefore be expected that Prosilk cannot prevent Xeracno from harvesting spider silk in Spiez.

b)

EP-P3 cannot validly cover AA [3-9] because this belongs to the prior art. The harvesting method of spider silk planned at the farm in Turkey involves raising AA spiders at CO_2 concentration of 8%, which falls within the range of AA [3-9]. It can therefore be expected that Prosilk cannot prevent Xeracno from harvesting spider silk in Turkey.

c)

The protection conferred by EP-P3 cannot be extended to the USA, so Xeracno cannot be prevented from harvesting silk in Colorado in view of EP-P3.

d)

It is not possible to protect a harvesting method including an atmosphere containing 8% CO_2 via EP-P3 for the same reasons as in 4)b).

As a result, no patent protection can be achieved in Switzerland via EP-P3 for the product directly obtained by the harvesting method used in Colorado or Turkey.

Therefore, Prosilk cannot prevent Xeracno from importing and selling this silk in Switzerland.