

Examiners' Report – Paper D 2025

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 for the markers to choose from, one being correct and one being wrong, 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. Candidates are reminded to bring their own calendars for date calculations.

Examiners' Report – Paper D 2025, Part I

Question 1 (8 marks)

This question was rather well answered. Many candidates realized that the claim to priority should be withdrawn to delay the entry into the regional phase before the EPO for as long as possible and provided the necessary steps. Some candidates wasted time speculating on prior art becoming potentially relevant after withdrawal. Very few candidates however realized that EP-B will become novelty destroying prior right if it is not withdrawn.

Candidates only suggesting not to fulfil the acts for entry, combined with further processing, did not receive any marks as the entry is only temporarily delayed until further processing is granted. Once further processing is granted, the legal consequence of the failure to observe the time limit for entry shall be deemed not to have ensued. The question required the delay to be for as long as possible. Because the expiry of the time limit and the date of the exam are more than a year apart, full marks were exceptionally awarded already for the indication of the month, rather than the exact date.

Question 2 (7 marks)

This question was generally well answered. Most candidates identified that the procedure under Rule 56a EPC can be used. Some candidates however forgot to mention that the correct application documents need to be filed. Very few candidates realized that Rule 56a(4) EPC requires an explicit request to keep the filing date. Good candidates further recognized that the erroneously filed application documents or parts remain in EP-1, which therefore will become a novelty destroying prior right for EP-2. Most of these candidates correctly advised to add a priority claim to EP-2 from EP-1. Some however lost marks by calculating the time limit for adding the priority claim from the filing date of IT-1, instead of the filing date of EP-1. Because the expiry of the time limit and the date of the exam are more than a year apart, full marks were exceptionally awarded already for the indication of the month, rather than the exact date.

Question 3 (9 marks)

For many candidates, this question appears to have been the most challenging in Part I. Some candidates were not aware of the res judicata principle and speculated on the cause of the loss of rights communication. Many candidates did realize that the additional claim cannot be added to EP-D. Fewer candidates concluded that this may be achieved via filing a divisional. Some of these candidates however wrongly suggested to revive EP-D by requesting a decision under Rule 112(2) EPC and filing an appeal, which is not sufficient as the suspensive effect is only temporary. Very few noted that there is an issue with double patenting.

Question 4 (10 marks)

Although relating to rather standard matter, i.e. the payment of fees, this question was not well answered. Many points were lost by not providing the correct legal basis. While parts (b) and (d) were rather well solved, in (a) many candidates did not realize that the additional search fees are automatically debited if nothing is done, and in (c) very few candidates discussed the decisive payment date and many candidates overlooked the fact that renewal fees fell due on the same day as the appeal fee.

Question 5 (11 marks)

This question was generally well answered. Many candidates realized that no examination will be performed for unsearched subject-matter. Very few candidates however indicated the SIS alternative to perform the search. Candidates are reminded that, if the given task is to provide the legal options, full marks are only awarded if all relevant options are given.

Possible Solution – Paper D 2025, Part I

References to legal bases refer to the situation on 31 October 2024.

Answer to Question 1 (8 marks)

To delay the entry of PCT-AB into the regional phase before the EPO for as long as possible, A and B should withdraw the priority claim, Rule 90bis.3(a) PCT, before the IB, Rule 90bis.3(c) PCT.

This is possible because today, 11 March 2025, is before 11 May 2026 (Mon), 10 November 2023 + 30 months → 10 May 2026 (Sun) → 11 May 2026 (Mon), Rule 90bis.3(a) PCT, Rule 80.2 and 80.5 PCT.

If no common representative is appointed, the first named applicant is deemed to be the common representative for A and B, Rule 90.2(b) PCT, Rule 151(1) EPC.

In this case, the withdrawal must be signed by both, A and B, Rule 90bis.5 PCT, PCT-AG 11.056.

The time limit for entering the regional phase before the EPO has not yet expired, Rule 159(1) EPC, 10 November 2023 + 31 months → 10 June 2026, and will thus be re-computed from the filing date, Rule 90bis.3(d) PCT, 11 November 2024 + 31 months → 11 June 2027 (Fri).

B should withdraw EP-B before publication, which is in May 2025, as otherwise it would become novelty destroying prior art under Article 54(3) EPC, GL G-IV, 5.1.1.

Answer to Question 2 (7 marks)

(a)

It is important to retain the filing date of the priority IT-1 as effective date of EP-1, as otherwise the journal publication will become novelty destroying prior art.

Applicant C should therefore file the correct application documents, namely claims and description of IT-1 within 2 months of the date of filing, GL A-II, 6.4, 16 January 2025 + 2 months → 16 March 2025 (Sun) → 17 March 2025 (Mon), Rule 56a(3) EPC, Rule 131(4) and Rule 134(1) EPC, and, pursuant to Rule 56a(4) EPC (first sentence),

i) request that filing date is kept;

ii) file a copy of IT-1, either directly or via DAS system, GL A-III, 6.7;

iii) file a translation in an official language of the EPO, GL A-II, 6.4.3 and A-II, 5.4.4; and

iv) indicate under Rule 56a(4)(c) EPC as to where the parts are completely contained in the translation of the priority document.

Then, the correct application documents will be included in the file and the filing date remains the same.

(b)

As it stands, EP-1 will become novelty destroying prior art under Article 54(3) EPC for EP-2,

since the erroneously filed application documents or parts remain in the application, Rule 56a(4) EPC, last sentence.

However, applicant C can still add a priority claim to EP-2 from EP-1, as the conditions for claiming priority by the same applicant, within 12 months, and EP-1 being the first application for same subject-matter B are fulfilled. C should therefore add the priority claim within 16 months from the earliest priority date for subject-matter B, Rule 52(2) EPC, i.e. until 16 January 2025 + 16 months → 16 May 2026 (Sat) → 18 May 2026 (Mon), Rule 52(2) EPC, Rule 131(4) EPC and Rule 134(1) EPC.

Answer to Question 3 (9 marks)

(a)

A communication under Rule 71(3) EPC was sent to inform the applicant of the text in which it intends to grant it and to invite the applicant to pay the fee for grant and publishing and to file a translation of the claims in the two official languages of the European Patent Office other than the language of the proceedings within a time limit of four months.

Since the applicant requested further amendments under Rule 71(6) EPC instead of complying with the Rule 71(3) EPC requirements within the prescribed time limit, the application is deemed withdrawn under Rule 71(7) EPC as the procedure under Rule 71(6) EPC cannot be applied in view of the binding effect (*res judicata*) resulting from Article 111(2) EPC under Article 164(2) EPC, GL E-XII, 9. For this reason, the applicant received the communication under Rule 112 EPC.

(b)

A patent with the complete text as decided by the board and the additional dependent claim can only be obtained by filing a divisional. This is only possible if EP-D is pending, Rule 36(1) EPC. EP-D is however presently not pending because it is deemed withdrawn, GL A-IV, 1.1.1.

Therefore, D needs to request further processing by paying the further processing fee, the fee for grant and publishing, and filing a translation of the claims as decided on by the board in the two official languages of the European Patent Office other than the language of the proceedings to revive EP-D, Article 121 EPC and Rule 135(1) EPC.

There is still time to do so, as the communication under Rule 112 EPC has only been received today, i.e. until 11 March 2025 + 2 months → 11 May 2025 (Sat) → 13 May 2025 (Mon), Rule 131(4) EPC and Rule 134(1) EPC.

Once EP-D is revived, D needs to file a divisional, Article 76(1) EPC, comprising the complete text as decided on by the board and the additional dependent claim.

After filing the divisional, yet before grant, D should withdraw EP-D to avoid double patenting, G 4/19.

Answer to Question 4 (10 marks)

(a)

Yes, E must notify the EPO that they do not wish the further inventions to be searched before the period for payment expires to prevent the automatic debit of the additional search fees being carried out, Annex A.2 to ADA 2024, II.4.

(b)

No, an automatic debit order filed in the international phase has no effect in proceedings before the EPO as designated or elected Office. A separate automatic debit order must be filed for international applications entering the European phase, Annex A.1 to ADA 2024 (AAD), 2.2.

(c)

Yes, but only the appeal fee. The automatic debit order is still valid after the refusal, Annex A.1 to ADA 2024 (AAD), point 11.1(b) in combination with ADA 2024, point 9.2. The debit is effected on the “decisive payment date”, Annex A.1 to ADA 2024 (AAD), par. 4.3.

The decisive date for the appeal fee of 2.925€, (SMEs 2.015€) is the date of receipt of the notice of appeal, Annex A.1 to ADA 2024 (AAD), 5.1(c), i.e. 28 February 2025.

The decisive date for the renewal fee is the due date of the renewal fee, Annex A.1 to ADA 2024 (AAD), 5.1(e). The renewal fee for the sixth year of 1.155€ is due on the last day of the month containing the anniversary of the date of filing of EP-F, i.e. also on 28 February 2025, Rule 51(1) EPC. There are not enough funds to pay both fees on the same day.

Therefore, according to ADA 2024, 7.3, the fees are booked in the order of priority whereby the appeal fee is booked first.

(d)

Yes, the renewal fee for the fifth year of EP-3 was automatically debited from the account of company G. With the transfer of the application from company G to company H, G must explicitly revoke the automatic debit order, otherwise the EPO will continue to automatically debit fees from the deposit account of company G, Annex A.1 to ADA 2024 (AAD), 10.3.

Answer to Question 5 (11 marks)

The EPO will act as IPEA if Sweden has performed a search as ISA, PCT GL C-II, 2. Examination by the EPO in Chapter II is however only possible for subject-matter, for which an (S)ISR has been drawn up, Rule 66.1(e) PCT.

There are two options to have D searched in PCT Chapter I.

The first option is to pay to the ISA, Rule 40.2(b) PCT, the additional search fee within 1 month from invitation under Rule 40.1(ii) PCT.

The second option is to request SIS within 22 months from priority, Rule 45bis.1(a) PCT, at the IB, specifying the EPO as SISA, Rule 45bis.1(b) PCT, and paying to the IB the supplementary search handling fee and supplementary search fee, Rule 45bis.2 and Rule 45bis.3 PCT within 1 month from the date of the SIS request.

Since the ISA has already raised a non-unity objection, the applicant must, upon filing the SIS request, specify that the SISR is to be drawn up for invention D, Rule 45bis.5(b) PCT.

To have invention D examined by the EPO during PCT Chapter II, the applicant must file a demand with the EPO, Article 31(6) PCT, before the expiration of the later of three months from the date of transmittal of the ISR to the applicant, Rule 54bis.1(a)(i) PCT, and 22 months from the priority date, i.e. June 2026, Rule 54bis.1(a)(ii) PCT, Rule 80.2 PCT. The handling fee and preliminary examination fee need to be paid within one month from the date of receipt of the demand or 22 months from the earliest priority date, whichever expires later, Rules 57 and 58 PCT.

For the second option, the demand should be filed with the EPO as the IPEA in addition to the request for SIS by the EPO, GL/PCT-EPO B-XII, 11. The EPO will first establish the SISR and then continue with Chapter II.

The invention must be limited to D with the demand or upon Rule 68.2 PCT invitation, Article 34 PCT.

Examiners' Report – Paper D 2025, Part II

Question 1 (27 marks)

As usual, the question regarding the patent situation is answered well by the candidates. However, a decent analysis should involve the identification of the first filing for the respective subject-matter, the validity of the priority and the resulting effective dates per subject-matter. Just stating the dates that are already known from the paper without proper conclusion as to the priority period will not be awarded marks.

Many candidates again failed to recognize the partial priorities in claim 1 of EP-ABC, leading to incorrect evaluation of the prior art.

An analysis of novelty and inventive step is required per subject-matter. For novelty discussion, only a reference to a search report or existing prior art is not sufficient; the candidates should at least identify a distinguishing feature with respect to the prior art. A simple statement that “subject-matter is not disclosed in the prior art” does not attract any marks.

Furthermore, concerning prior art under Art. 54(3) EPC, many candidates did not realize that just identifying a document as Art. 54(3)-prior art does not imply that it is indeed relevant to novelty in the specific case.

When discussing the validity of a divisional application, such as EP-DIV, it is required to trace back its content to the earlier application.

Question 2 (6 marks)

It is stressed that questions relating to the freedom to operate should be analyzed with due regard to the possible differences in territorial protection, i.e. also worldwide. It is expected that candidates point out where there is freedom to operate and where there is not.

Most candidates restricted their analysis to EP-ABC; this analysis applies to EP only. Only few candidates made an analysis of freedom to operate outside Europe,

specifically in the countries of interest for the client or their competitors. Furthermore, the application EP-B, conferring provisional protection, was often not mentioned. Also, regarding Selle S.A.'s freedom to operate, the protection conferred by P-MY was rarely mentioned.

Question 3 (17 marks)

Regarding subject-matter O, the model answer cites the solution of amending EP-DIV by adding an independent claim to subject-matter O. However, most candidates proposed to file a new divisional from EP-DIV claiming that the damping means are in the form of spheres made from rubber (O). This is possible as the subject-matter is disclosed in both the original PCT-MY and EP-DIV, and EP-DIV is still pending. This alternative solution has been awarded the same number of marks as the one mentioned in the model answer.

Not all candidates mentioned that prosecution of EP-DIV should be continued.

In general it is worthwhile to check whether renewal fees are due in the near future and then state it. However, a simple remark to pay all due renewal fees usually does not award marks.

Those candidates that saw that the priority period for DE-GPS is still running, usually answered well that a subsequent PCT-application as well as a national application in TW should be filed. However almost nobody mentioned the necessity of claiming priority in view of the display at the Bike & Gravel trade fair.

Quite a few candidates realized that a new novelty objection based on EP-B could be raised in the opposition proceedings and will likely be taken into account by the opposition division.

Regarding EP-B, it was essential to explore contractual possibilities with Alessio, just repeating that he was interested in cooperation is not sufficient. Many did not see the implications of a missing agreement on freedom to operate for Bikey with respect to the second prototype.

Question 4 (5 marks)

The first paragraph of the Examiners' report for question 2 also applies to question 4. Some candidates missed the implication of EP-B; Bikey has to come to a proper agreement with Alessio Alessi as EP-B covers the second prototype and thus Bikey would not be free to produce and sell in Europe.

Most candidates saw the implications of the amended EP-DIV for Selle S.A.'s freedom to operate in Europe but again overlooked P-MY.

Regrettably, the Examiners still find candidates who write that having a granted patent confers freedom to operate.

Possible Solution – Paper D 2025, Part II

Question 1 (27 marks)

a) i) What is the current patent situation as regards a bicycle saddle connector with damping means in the form of spheres made from rubber (O)

P-MY is the first filing for a bicycle saddle connector comprising damping means in the form of spheres made from rubber (O). P-MY has been granted with a claim to O. P-MY confers protection for O in Malaysia to Bikey.

PCT-MY and Euro-PCT-MY validly claim priority of P-MY as P-MY can serve as priority application because Malaysia (MY) is party to the Paris Convention (PC), the priority right of P-MY was validly transferred before the filing date of PCT-MY to Bikey that is the applicant of PCT-MY, PCT-MY was filed within the priority period, and the subject-matter of a bicycle saddle connector comprising damping means in the form of spheres made from rubber (O) is disclosed in P-MY.

Therefore, the effective date for O in PCT-MY and Euro-PCT-MY is the priority date, 28 May 2021.

The brochure by Selle S.A. is not relevant to novelty or inventive step as it is published after the effective date for O. The prior art only discloses rigid bicycle saddle connectors without damping means. Therefore, the subject-matter of the claim to O is novel.

The subject-matter of the claim to O is also inventive, as the connector with damping means in the form of spheres provides a surprisingly good riding experience.

Euro-PCT-MY is deemed to be withdrawn, as a notification of loss of rights has been received six months ago.

Euro-PCT-MY cannot give rise to any patent protection any more as the time limit for further processing has long passed since Bikey received the loss of rights 6 months ago.

Also, a request for re-establishment of rights would fail as ignoring an invitation by the Office does not meet the "all due care" condition.

The 30/31 month deadline for entry into national/regional phases has passed and therefore protection in countries outside the EPC cannot be derived from PCT-MY any more.

Currently, there is no application pending with claims to O that originates from PCT-MY.

a) ii) What is the current patent situation as regards a bicycle saddle connector with damping means in the form of pyramids made from rubber (P)

P-MY is the first filing for a bicycle saddle connector comprising damping means in the form of pyramids made from rubber (P). P-MY has been granted with a claim to P. P-MY confers protection for P in Malaysia to Bikey.

The subject-matter of the claim in EP-DIV does not extend beyond the content of the earlier application PCT-MY as originally filed, even though not claimed in PCT-MY or Euro-PCT-MY.

The claim to P is entitled to the priority of P-MY for the same reasons as regarding the claim to O.

The effective date for P in EP-DIV is the priority date, 28 May 2021.

The brochure by Selle S.A. is not relevant to novelty or inventive step as it is published after the effective date for P. The prior art only discloses rigid bicycle saddle connectors without damping means. Therefore, the subject-matter of the claim to P is novel.

The subject-matter of the claim to P is also inventive, as the connector with damping means in the form of pyramids provides a surprisingly good riding experience.

a) iii) What is the current patent situation as regards a bicycle saddle connector with damping means in the form of cubes made from rubber (R)

There currently is no patent application directed to R.

b) i) What is the current patent situation as regards a bicycle gear shift system comprising an electric motor for shifting the gears and a switch to be mounted on the handlebar of a bicycle for selecting the gears via an electrical wire (A)?

IT-A is the first filing for a bicycle gear shift system comprising an electric motor for shifting the gears and a switch to be mounted on the handlebar of a bicycle for selecting the gears, wherein the switch is connected via an electrical wire to the motor (A). IT-A has been withdrawn before publication.

The subsequent application EP-ABC has a claim 2 directed to this subject-matter and has been granted with this claim.

EP-ABC was filed by same applicant within 12 months, for the same subject-matter. The priority is therefore validly claimed and the effective date for subject-matter A is the priority date, 6 June 2018.

Traditional gear shift systems according to the prior art have no electric motor and therefore the subject-matter of claim 2 is novel.

The subject-matter of claim 2 is also inventive, as the switch can be handled with the same force irrespective of the gear which is advantageous wrt to the traditional gear shift systems.

Although currently an opposition is pending, EP-ABC confers protection to subject-matter A.

b) ii) What is the current patent situation as regards a bicycle gear shift system comprising an electric motor for shifting the gears and a switch to be mounted on the handlebar of a bicycle for selecting the gears via a wireless radio connection (B)?

EP-B is the first filing for a bicycle gear shift system comprising an electric motor for shifting the gears and a switch to be mounted on the handlebar of a bicycle for selecting the gears, wherein the switch is connected via a wireless radio connection to the motor (B). EP-B is currently pending.

The effective date for subject-matter B in EP-B is the filing date, 20 September 2018. Traditional gear shift systems according to the prior art have no electric motor and therefore the subject-matter B which is claimed in EP-B is novel.

It is also inventive, as the switch can be handled with the same force irrespective of the gear which is advantageous with respect to the traditional gear shift systems.

Therefore, the grant of a patent for EP-B can be expected.

The rightful owner of EP-B is Alessio, as all rights and title to the application were transferred to him by notary agreement.

EP-ABC filed by Campagnelli and claiming priority of EP-B also claims subject-matter B in claim 3. However, since the right to claim priority from EP-B was transferred before filing of EP-ABC, the applicant of EP-ABC did not enjoy the right to priority of EP-B at the time of filing the same and therefore the priority claim for subject-matter B is not valid in EP-ABC.

Claim 3 of EP-ABC thus has the filing date, 14 May 2019, as effective date.

EP-B is filed before and published after the filing date of EP-ABC and therefore is prior art under Art. 54(3) EPC and takes away the novelty of claim 3 of EP-ABC. Since the issue regarding the priority claim to EP-B has not yet come to the attention of the EPO, the patent EP-ABC currently confers protection for subject-matter B.

b) iii) What is the current patent situation as regards a bicycle gear shift system comprising an electric motor for shifting the gears and a switch to be mounted on the handlebar of a bicycle for selecting the gears as such (C)?

EP-ABC is the first filing for a bicycle gear shift system comprising an electric motor for shifting the gears and a switch to be mounted on the handlebar of a bicycle for selecting the gears (C), i.e. for switches as such.

Independent claim 1 directed to C covers subject-matter A, subject-matter B and subject-matter with switches other than according to A and B. For the part relating to subject-matter A, claim 1 is entitled to the priority of IT-A. For the part relating to subject-matter B, the priority claim to EP-B is not valid. The remaining subject-matter of claim 1 has not been disclosed in IT-A or EP-B.

Claim 1 therefore has two effective dates, namely the filing date of IT-A for the subject-matter A, and the filing date of EP-ABC for the remaining subject-matter.

As EP-B is filed before and published after the filing date of EP-ABC, it is prior art under Art. 54(3) EPC for the subject-matter not enjoying priority of IT-A. EP-B takes away the novelty of claim 1 of EP-ABC.

Since the issue regarding the priority claim to EP-B has not yet come to the attention of the EPO, the patent EP-ABC currently confers protection for subject-matter C.

c) What is the current patent situation as regards a bicycle gear shift system comprising an electric motor for shifting the gears and means for selecting the gears, the means including a GPS sensor (D)?

DE-GPS is the first filing for a bicycle gear shift system comprising an electric motor for shifting the gears and means for selecting the gears which include a GPS sensor (D). The effective date for this subject-matter is the filing date, 22 March 2024.

EP-B and EP-ABC are prior art as they have been published before the filing date of DE-GPS. The subject-matter of claim 1 of DE-GPS is novel because the prior art does not disclose selecting means that include a GPS sensor, and also inventive, as

an automatic selection of gear using a GPS sensor reduces the overall effort by the cyclist enormously.

Therefore, a patent for pending DE-GPS is likely to be granted in Germany.

Question 2 (6 marks)

a) As the situation currently stands, are we free to produce and sell bicycle gear shift systems according to our two prototypes?

For the first prototype, a bicycle gear shift system comprising an electric motor for shifting the gears and means for selecting the gears which include a GPS sensor, Bikey is free to produce and sell anywhere in the world. EP-B and EP-ABC only claim systems with a handlebar switch, while the first prototype does not have a handlebar switch. Furthermore, there is no pending application/patent by a third party covering this subject-matter in any other country.

However, the second prototype with the handlebar switch connected via a wireless radio connection falls under the protection conferred by present claims 1 and 3 of EP-ABC. Therefore, Bikey is not free to produce and sell the second prototype in the countries in which EP-ABC is in force.

Also, the production and selling Bikey's second prototype might fall under provisional protection conferred by pending application EP-B in some of the EPC contracting states.

Outside Europe, there are no relevant patent rights and Bikey is free to produce and sell the second prototype.

b) As the situation currently stands, is Selle S.A. free to produce and sell their existing and planned lines of bicycle saddle connectors?

Selle can produce and sell the line with damping means in the form of cubes made from rubber as there are no relevant patent rights for this subject-matter.

In MY, Selle is not free to sell and produce the new line with damping means in the form of spheres made from rubber in view of Bikey's P-MY. In all other countries, Selle can sell and produce the new line as there currently is no relevant pending application/patent with claims covering Selle's planned line.

Question 3 (17 marks)

What can we do to improve our position?

Prosecute EP-DIV for protecting P (pyramids)

Bikey can improve their position regarding bicycle saddle connectors with damping means in the form of pyramids made from rubber (P) by continuing prosecution of EP-DIV in order to get a granted patent.

For this, examination and designation fees for EP-DIV have to be paid by 18 June 2025 at the latest. Also, the renewal fee has to be paid by the end of May 2025, extended to June 2025.

If all actions are taken in due time, EP-DIV can proceed to grant as a positive search report was received.

Make sure spheres (O) are protected

In order to get protection for bicycle saddle connectors in the form of spheres made from rubber (O), file in response to the search report an additional independent claim directed to spheres in pending EP-DIV.

Spheres and pyramids are alternatives that solve the same technical problem and are unitary.

As discussed above, the priority claim for subject-matter O is valid, and thus the effective date of the new independent claim is the priority date. Furthermore, the subject-matter of the claim to damping means in the form of spheres is novel and inventive.

This amended EP-DIV with claims to subject-matter P and O can proceed to grant.

Opposition against EP-ABC

If nothing is done, Campagnelli will likely retain a patent EP-ABC as granted, as a positive opinion by the opposition division has been received.

Therefore, Bikey should raise a novelty objection based on EP-B against claim 1 and 3 in the opposition proceedings as soon as possible. They should also file the notary agreement between Campagnelli and Alessio as evidence and provide arguments that the priority claim in EP-ABC to EP-B is not valid, and that EP-B is prior art under Art. 54(3) EPC taking away novelty of claims 1 and 3.

Novelty will be a fresh ground of opposition (G7/95), raised after expiry of the opposition period.

Grounds, facts and evidence filed after the expiry of the opposition period are considered late and only admitted at discretion of Opposition Division. In the present case, they are likely to be taken into account as they are prima facie relevant. EP-ABC will be revoked or at most maintained in an amended form, which does not cover the embodiments B and C.

Further applications for a bicycle gear shift system comprising an electric motor for shifting the gears and means for selecting the gears which include a GPS sensor (D and E)

As the priority period of DE-GPS only expires on 22 March 2025 (Sat), extended to 24 March 2025 (Mon), Bikey should file a PCT application with the claims as in DE-GPS claiming priority from DE-GPS.

It is necessary to claim priority, otherwise the display at the "Bike & Gravel" trade fair will be novelty destroying prior art.

Once this PCT-application enters the corresponding national/regional phases, it is likely that patents will be granted providing protection for these subject-matters.

To obtain protection in TW, where Bikey and Campagnelli have clients, Bikey should also file a national application in TW for the same subject-matter, also claiming priority from DE-GPS. TW is a member of the WTO, therefore the priority from DE-GPS, which is an application filed in a WTO member state, can be validly claimed.

Proceeding in respect of EP-B for B

Bikey should explore cooperation possibilities with Alessio, e.g. take a license or ask for a transfer of rights in order to improve their position with respect to Campagnelli and enlarge their freedom to operate for products based on their two prototypes.

Question 4 (5 marks)

a) After the improvements, will we be free to produce and sell bicycle gear shift systems according to our two prototypes?

For the first prototype, i.e. without a handlebar switch, the situation will not change and Bikey will still be free to produce and sell worldwide.

For the second prototype, Bikey will be free to produce and sell outside Europe, as no third party has an application/patent directed to this subject-matter.

In Europe, with respect to Campagnelli, it can be expected that Bikey will be free to produce and sell because of the likely outcome of the opposition against EP-ABC.

However, systems according to the second prototype are covered by EP-B because they contain a handlebar switch connected via a wireless radio connection and, unless Bikey obtains a license or the rights to EP-B transferred from Alessio Alessi, Bikey will not be free to produce or sell in Europe.

b) After the improvements, will Selle S.A. be free to produce and sell their existing and planned lines of bicycle saddle connectors?

Selle S.A. will not be free to produce and sell their planned line of bicycle saddle connectors with damping means in the form of spheres made from rubber in Europe and specifically in FR, where they produce, in view of the amended EP-DIV directed to this subject-matter.

Outside Europe and MY, Selle S.A. will be free to produce and sell saddle connectors with damping means in the form of spheres made from rubber.

Regarding their existing line with damping means in the form of cubes made from rubber, the situation will not change. Therefore, Selle S.A. will still be free to continue their existing line.