

Examiners' Report Paper D 2017

General Comments

Candidates are reminded that they should pay attention to the way the questions are asked and should not simply repeat information from the paper in the answer.

Repeating information per se is not awarded any points.

Candidates are encouraged to ensure their handwriting is always legible in order that examiners can readily identify all opportunities to award marks. Also, while abbreviations for referring to the subject matter and patents/applications are acceptable and typically included in the questions themselves, examiners cannot be expected to be familiar with unconventional informal shorthand summarising a candidate's analysis or conclusions in which the meaning to a reader is lost.

Full marks can only be awarded when the full legal basis is cited to support the analysis. Legal basis for the interrelationship between the PCT and EPC and EPO practice is rarely adequately cited.

Candidates are urged to ensure they answer the question posed. If a question asks for positive statements (e.g. what can be made, used and sold), discussing only negative statements (what a party can prevent) may risk not earning all available marks.

Examiner's Report Paper D 2017 – Part I

Question 1 (6 marks)

In part a), few candidates spotted the advantage of entering with a unitary claim set, i.e. claim 1 only. A minority of candidates recognized that both PACE and the waiver should be used to accelerate the proceedings.

In part b), very few candidates realized the need to submit comments as the IPRP contains a lack of unity objection and the claims were not amended. Candidates suggesting entering the regional phase with claim 2 only were also awarded marks.

Question 2 (6 marks)

In part a), few candidates realized that the transfer must have taken effect vis-a-vis the EPO according to Rule 22(3) EPC for the amended claims to be validly filed.

In part b), few candidates answered that a request to recognise the transfer of the opponent status has to be filed in addition to the submission of the evidence of the corresponding transfer.

Question 3 (4 marks)

Very few candidates pointed out that the claims should also be filed by reference to avoid possible issues under Art. 123(2) EPC because claims filed later are treated as amendments (GL A II,4.1.3.1).

Although the question stated “to file the application today”, some candidates engaged in an analysis of the priority period.

Question 4 (6 marks)

This question was well answered.

Most candidates recognized that the technical info on the website about TEL1 was accessible to the public. Fewer correctly referred to the pertinent legal basis for evaluating internet disclosures as prior art.

Many candidates discussed only the website disclosure, despite the question pointing to “each of the (above) disclosures”.

Question 5 (10 marks)

In part a), too many candidates did not appreciate the difference between the addition of a priority claim under Rule 26bis.1 PCT and the restoration of the right of priority under Rule 26bis.3 PCT. As a result, many candidates discussed the restoration of the right of priority, but did not discuss the addition of the corresponding priority claim.

Part b) of the question was well answered.

In part c), few candidates mentioned that, in this case, the time limit for the restoration also applies to the addition of the priority claim in view of Rule 26bis.3(c) PCT.

Few candidates pointed out that a right restored by the EPO as receiving office under the PCT is valid before the EPO as designated office under Rule 49ter.1(a) PCT.

On the other hand, many candidates suggested to restore the right of priority before the EPO as designated office, e.g. citing Rule 49ter.2(a) PCT or even Art. 122 EPC. This aspect was not asked in the question and therefore was not awarded any points.

Question 6 (8 marks)

While parts a) and b) of this question were well answered, the majority of candidates scored less well in part c). Many candidates referred to the ADA 6.4 instead to the AAD 8 as legal basis for the day on which the payment is deemed to have been made.

Possible Solution - Paper D 2017 – Part I

Answer to Question 1

a) The applicant received an IPRP with a positive opinion for the first invention. Therefore, the first invention can be granted.

The applicant has to:

- Enter the European regional phase within 31 months, i.e. today, and perform the acts of Rule 159(1) EPC;
- Avoid any objections under Article 82 EPC, by entering the regional phase with claims directed towards the first invention only, i.e. with claim 1, Rule 159(1)(b) EPC;
- Waive the right to the communication under Rules 161 and 162 EPC, OJ 2015 A94; and
- Request PACE for this application, OJ 2015 A93.

After entry into the European regional phase, the applicant has to file a divisional application directed to the second invention, i.e. claim 2, while the application relating to the first invention is still pending, Art 76(1) EPC and Rule 36(1) EPC.

b) The EPO as ISA has not searched the second invention.

The applicant has to enter the European regional phase with claims towards both inventions. Either upon entry or in response to a communication issued pursuant to Rule 161(1) EPC the applicant has to submit comments without deleting the second invention.

The Examining division will invite the applicant to pay a search fee within a period of two months, Rule 164(2)(a) EPC. The applicant has to pay the search fee and decide on the basis of the results of the search which invention to continue with, Rule 164(2)(b)(c) EPC.

Answer to Question 2

a) Company D has to appoint a professional representative, Article 133(2) EPC.

The newly appointed professional representative has to request the registration of the transfer of the patent and submit documents providing evidence of the transfer, Rules 22(1) and 85 EPC. The transfer only takes effect vis-à-vis the EPO when these documents have been filed and the administrative fee has been paid, Rules 22(2) and 22(3) EPC.

All the above, plus the submission of the amended set of claims, has to be done at the latest today because of the time limit set under Rule 116(1) EPC.

b) An opposition may be transferred together with the assets in the interests of which the opposition was filed, G4/88. Mr X has to file supporting evidence of the transfer and request that the EPO recognise the transfer of opponent status to company E, T1421/05.

Answer to Question 3

Under Article 80 EPC and Rule 40(1) EPC, I file the European patent application at the EPO

- by indicating that a European patent is sought,
- by providing information identifying the applicant, or allowing the applicant to be contacted, and
- by filing a reference to JP 12345.

The e-mail does not provide any details about the applicant. Therefore, I provide my address to allow the applicant to be contacted, GL A-II, 4.1.2.

The reference, which indicates that JP 12345 replaces the description and drawings, shall state the filing date, the filing number, and the office at which JP 12345 was filed, Rule 40(2) EPC.

I indicate that the claims are also filed by reference to satisfy the requirement of Rule 57(c) EPC.

Answer to Question 4

Priority is not valid because of the different type of antenna, Article 87(1) EPC.

The announcement of launch in June 2016 does not disclose any technical details of TEL2, and it is therefore not relevant for patentability.

Phone TEL2 was sold after the filing date, and therefore its sale does not constitute prior art.

Even though password protected, the technical information of TEL1 on the website is accessible to the public as of August 2016, Guidelines G-IV, 7.5.1. This is therefore prior art under Article 54(2) EPC.

TEL2 does not involve an inventive step over TEL1 and ANT2, Article 56 EPC. Hence, TEL2 is not patentable.

Answer to Question 5

a) Yes, priority claims may be added after the filing date under Rule 26bis.1 PCT.

A request must be filed with the receiving Office or the International Bureau within the time limit under Rule 26bis.1(a) PCT, i.e. within 16 months from the changed priority date: 12 February 2016 plus 16 months is 12 June 2017, provided that the request is submitted within 4 months from the international filing date, i.e. by 14 June 2017.

Therefore, a request can be filed with the EPO until 14 June 2017.

b) The 31-month time limit under Art. 153(2) EPC and Rule 159(1) EPC is computed from the earliest priority date, i.e. 12 February 2016, Rule 26bis.1(c) PCT.

Therefore, the last day on which the requirements for entry into the European regional phase must be fulfilled is 12 February 2016 plus 31 months, i.e. 12 September 2018.

c) The priority period expired on Sunday 12 February 2017, extended to 13 February 2017, Rule 80.5 PCT and Rule 2.4 PCT.

The filing date is later than the date on which the priority period from FR-NAT2 expired but within two months of that date. Therefore, restoration under Rule 26bis.3 PCT may be requested.

The applicant should submit a request to the receiving Office, i.e. to the EPO, within 2 months of expiry of the priority period, Rule 26bis.3(b)(i) PCT, i.e. until 13 April 2017.

Thus, requests for adding priority and restoration have to be filed by 13 April 2017, Rule 26bis.3(c) PCT. Pay the fee for restoration Rule 26bis.3(d) PCT before the same time limit.

The criterion of "due care" is applied by the EPO as receiving Office, OJ 2007 694.

The request shall state the reasons for the failure to file PCT-G within the priority period, Rule 26bis.3(b)(ii).

If the EPO, as receiving office, has restored a right under Rule 26bis.3 PCT, this decision is valid before the EPO as designated office, Rule 49ter.1(a) PCT.

Answer to Question 6

a) Pay the filing fee and the search fee by 7 April 2017, Art.78(2) EPC and Rule 38(1) EPC.

b) When the Portuguese text is used:

- The filing fee includes the additional fee for two pages: 36 pages plus 1 page of abstract minus 35 pages = 2 pages, Rule 38(2)(3) EPC, Rfees 2(1)1a and Guidelines A-III 13.2;
- The filing fee is reduced by 30% under Rules 6(3) and (4) EPC, Art 14(1) Rfees because your client is a university of a member state not having an EPO language as an official language.

When the English text is used, no additional fee is due.

The 30% reduction is greater than the saving by filing in English.

File EP-A electronically to reduce filing fee, Rfees 2(1)1.

c) The payment is deemed to have been made on the date on which the account was duly replenished, AAD 8.

Since this is after the due date for paying the fees, the application is deemed to be withdrawn Art 78(2) EPC.

The applicant has to request further processing under Article 121 EPC. The fee for further processing is 50% of the search fee and filing fee.

Examiner's Report Paper D 2017 – Part II

Question 1

In general, higher scoring candidates tend to follow the wording of the question by discussing the patent situation by subject matter as opposed to by patent application/patent.

Some candidates stated that a disclosure was prior art without specifying for which claim(s) in which patents/applications the disclosure is prior art. Too many candidates did not identify the difference w.r.t. the priority document. Similarly, some candidates made statements about the novelty/inventive step of subject matter without referring to specific claim(s) in specific applications/patents. E.g. the claim directed to beams with SHAPE-B1 projections is novel and inventive in CB-PCT but is not novel in ST-EP3.

Some candidates identified a disclosure as belonging to the prior art under Article 54(2) or 54(3) EPC. However, it does not follow that such disclosures are novelty destroying. To achieve full points, candidates are expected to consider both the status of a disclosure and its effect.

Very few candidates recognised that the novelty of the claim to a beam with projections in ST-EP1 results from the distinct differences (the absence of stress effects) vis-à-vis the beams of OLD1.

Some candidates did not analyse CB-EP or consider its relevance to the manufacture of beams with any shape.

Candidates would benefit from fully analysing the current situation and recording their conclusions to ensure they are able to earn available marks for the analysis.

Question 2

The invalid claim to priority in CB-PCT was recognised by most candidates although, in some cases, candidates did not explain what actions could be taken to affect the outcome of CB-PCT in respect of the claim directed to beams with SHAPE-B projections.

The opportunity for STEELCO to seek protection for beams with SHAPE-B projections outside Europe was recognised by many candidates. The different filing date of ST-EP2 in the French version of the paper was inconsequential to the answer and did not result in a different allocation of marks.

Few candidates considered steps for quickly securing provisional protection in Spain via ST-EP1 in view of the client's circumstances and a surprising number of candidates made no reference to Spanish validation.

Some candidates who correctly identified the possibility of filing an opposition against CB-EP omitted to outline on what basis such an opposition might be filed, such as the novelty destroying publication of ST-EP1.

Question 3

Question 3 was generally answered poorly with a number of candidates mistaking patent ownership with freedom to operate. A great number of other candidates elected to discuss how STEELCO can prevent CHINABEAM and vice versa without addressing the specific question: which types of metal beam are the companies free to produce, sell and use. This led to some candidates not earning available marks. Additionally, this omission to fully consider the freedom to operate led to candidates not thoroughly considering the situation in all the relevant jurisdictions.

Possible Solution - Paper D 2017 – Part II

Question 1a where the projections are of any shape

ST-GB1 is the first application for beams with projections. ST-GB1 cannot lead to patent protection because it has lapsed and is irretrievable. ST-EP1 was filed within the priority year of ST-GB1 and claim 1 of ST-EP1 is disclosed in ST-GB1 and therefore enjoys priority, having an effective date of 23 September 2013.

OLD1 was published before the priority date of ST-EP1 and forms part of the state of the art under Art 54(2) EPC but does not disclose a rolling process. The metal beams resulting from the rolling process have distinct differences vis-à-vis the beams of OLD1. The difference is the absence of stress effects. Claim 1 of ST-EP1 is therefore novel. The strengthening effect of projections on beams is surprising so claim 1 of ST-EP1 is also inventive.

A response to the communication under Rule 71(3) EPC was due on 28 February 2017 which has passed. ST-EP1 is deemed withdrawn.

Currently there is no patent protection for beams with projections of unspecified shape.

Beams with projections formed by a rolling process will infringe the claim of the granted patent CB-EP as products directly obtained by the process claimed in CB-EP (Article 64(2) EPC). The manufacture of beams with projections will infringe the claim of the granted patent CB-EP.

Question 1b where the projections are of SHAPE-A

ST-EP1 is the first application for beams with SHAPE-A projections. SHAPE-A projections are not disclosed in the priority application ST-GB1. Therefore, claim 2 of ST-EP1 has an effective date of the date of filing of ST-EP1 of 15 September 2014.

There was an enabling disclosure at the trade fair of how to make beams with SHAPE-A projections. The trade fair took place before the effective date of claim 2 of ST-EP1. The disclosure at the trade fair destroys novelty of claim 2 of ST-EP1.

Therefore, the intended opposition against the claim of ST-EP1 directed to beams with SHAPE-A projections would be successful.

Question 1c where the beams are of SHABE-B

ST-EP2 is the first application for beams with SHAPE-B projections. ST-EP2 was deemed withdrawn in July 2016. Further processing is no longer available – the period lapsed 2 months after notification of a loss of rights, i.e. September 2016.

CB-PCT, which is also directed to beams with SHAPE-B projections, was filed within the priority year of ST-EP2. The assignment of ST-EP2 by Mr G to STEELCO on 4 April 2016 includes the assignment of the right to claim priority. CB-PCT was not filed by the successor in title and does not have a valid claim to priority.

The claim of CB-PCT to beams with SHAPE-B projections has an effective date of the date of filing of CB-PCT, i.e. 10 June 2016.

ST-EP3, in respect of SHAPE-B, validly claims priority from ST-EP2. However, ST-EP3 does not include a claim to beams with SHAPE-B projections so ST-EP3, in its current state, will not lead to protection for beams with SHAPE-B projections.

CB-EP and ST-EP1 will have been published. Both are prior art for CB-PCT and ST-EP3 but neither disclose beams with SHAPE-B projections.

The article is prior art for CB-PCT and is novelty destroying.

Also, if ST-EP3 is published, it will become prior art under Article 54(3) EPC and be novelty destroying for CB-PCT in respect of claims directed to beams with SHAPE-B projections, if CB-PCT enters the European phase.

As it currently stands, no patent application is likely to grant with a valid claim to beams with SHAPE-B projections.

Question 1d where the projections are of SHAPE-B1

CB-PCT is the first application for beams with SHAPE-B1 projections. Claim 2 of CB-PCT has, as effective date, the date of filing of CB-PCT, i.e. 10 June 2016.

ST-EP3 was filed within the priority year of ST-EP2, however SHAPE-B1 projections are not disclosed in ST-EP2 so the claim to beams with SHAPE-B1 projections in ST-EP3 has, as effective date, the filing date of ST-EP3, i.e. 13 June 2016.

If CB-PCT enters the European phase it constitutes prior art under Article 54(3) EPC and is novelty destroying for the claim of ST-EP3.

CHINABEAM can be expected to enter the European phase for CB-PCT at the latest 31m from their claimed priority date. CB-EP and ST-EP1 will have been published. Both are prior art for CB-PCT and ST-EP3 but neither discloses beams with SHAPE-B1 projections.

If published, any subject matter in ST-EP3 that enjoys priority from ST-EP2 is prior art Article 54(3) EPC for CB-PCT. However, SHAPE-B1 is not disclosed in ST-EP2. The claim directed to beams with SHAPE-B1 projections in CB-PCT is therefore novel over ST-EP3.

SHAPE-B1 projections unexpectedly exhibit improved beam strength. The claim directed to beams with SHAPE-B1 projections in CB-PCT is therefore inventive and it is likely that this claim will be granted in any of the PCT contracting states selected by CHINABEAM.

If CB-PCT does not enter the European phase, STEELCO could obtain protection for beams with SHAPE-B1 projections in Europe via ST-EP3.

Question 2 to improve the patent situation vis-à-vis CHINABEAM

ST-EP1 discloses a rolling process for forming metal beams using rollers. This subject matter has a priority date before, and was published after, the filing date of CB-EP and is novelty destroying under Article 54(3) for the claim of CB-EP. CB-EP is currently within the opposition period that ends tomorrow, 8 March 2017. File an opposition against CB-EP raising the lack of novelty in view of ST-EP1.

Request further processing, pay the fee for grant and the fee for further processing, respond to the communication and file translated claims for ST-EP1. Request amendment to delete claim 2 giving a reason. STEELCO will be able to obtain a granted EP patent to beams with projections via ST-EP1 which can be used to prevent CHINABEAM importing beams with projections into Europe.

Commission a translation of the claims of ST-EP1 into Spanish, file the translated claims at the Spanish Intellectual Property Office and pay the national fee to obtain provisional protection for beams with projections in Spain. When ST-EP1 grants, validate in Spain.

The priority period of ST-EP2 has not yet expired. File a new PCT application, PCT-NEW, claiming priority from ST-EP2 and including a claim directed to beams with SHAPE-B projections. This claim is novel. Beams with SHAPE-B projections are surprisingly much stronger and so the claim is also inventive. Protection for beams with SHAPE-B projections can be obtained via patents resulting from PCT-NEW.

File third party observations with WIPO pointing out the invalid claim to priority in CB-PCT and citing the trade journal article dated 11 April 2016. The observations will be communicated to the EPO as ISA.

Beams with SHAPE-B1 projections will infringe patents resulting from PCT-NEW protecting SHAPE-B projections.

Question 3 types of metal beam we or CHINABEAM free to produce, sell and use in the future

If patents from CB-PCT are granted, CHINABEAM will be able to stop STEELCO importing beams with SHAPE-B1 projections in all PCT states where they enter the national/regional phase.

When PCT-NEW grants, STEELCO can stop CHINABEAM making, selling and importing beams with SHAPE-B (and SHAPE-B1) projections potentially worldwide such as in UAE and Spain.

Outside Europe, CHINABEAM will be free to use beams with projections of any shape except SHAPE-B (and SHAPE-B1) which is covered by PCT-NEW.

STEELCO will be free to use beams with projections of any shape except that STEELCO cannot use beams with SHAPE-B1 projections in any state in which CHINABEAM obtains a patent from CB-PCT. To make, sell or import beams having SHAPE-B1 projections in these states, STEELCO will need a license from CHINABEAM.

STEELCO will be able to continue to supply CASITAS in Spain and the UAE customers with all beams, except those having SHAPE-B1 projections.

A cross license could be negotiated with CHINABEAM in which STEELCO grants rights to use beams with SHAPE-B projections.

Examination Committee III: Paper D - Marking Details - Candidate No

Category		Max. possible	Marks Marker 1	Marker 2
Part I	Part I - Question 1	6		
Part I	Part I - Question 2	6		
Part I	Part I - Question 3	4		
Part I	Part I - Question 4	6		
Part I	Part I - Question 5	10		
Part I	Part I - Question 6	8		
Part II	Part II - Question 1 a	10		
Part II	Part II - Question 1 b	5		
Part II	Part II - Question 1 c	11		
Part II	Part II - Question 1 d	9		
Part II	Part II - Question 2	18		
Part II	Part II - Question 3	7		
Total				