

Examiners' Report Paper D 2018

Purpose and extent of the examiners' report

The purpose of the present examiners' report is to enable candidates to prepare for future examinations (cf. Article 6(6) of the Regulation on the European qualifying examination for professional representatives).

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. Answering more than prompted by the question merely causes loss of time but is not awarded any marks.

Full marks were only awarded when the full legal basis was cited to support the analysis. However, alternative relevant legal bases also attracted marks.

An unexpected amount of points was lost due to miscalculation of time limits.

It has become a trend that candidates skip entire questions from D1. However, these candidates typically do not pass.

Examiners' Report Paper D 2018 – Part I

Question 1 (10 marks)

Early entry into European phase has per se no effect on provisional protection and was not awarded points.

Some candidates did not realise that they could file the missing part on their own volition, without the need for an invitation under R. 20.5(a) PCT.

Question 2 (8 marks)

Only some candidates realised that it has to be proven that proceedings for infringement are instituted against D. Similarly, few candidates noted that the opposition proceedings have to be pending to intervene.

Question 3 (8 marks)

Question b) was poorly answered. Many candidates did not realise the correct legal consequences of the filing of the translation by the applicant.

Question 4 (6 marks)

Full marks were awarded also for candidates indicating the legal basis in the 2017 Guidelines.

G1/86 is not applicable for b), because it relates to the 4 month time limit for filing the grounds of appeal.

It was often overlooked that one fee of re-establishment needed to be paid for the missed two month time limit, and a second one for the missed four month time limit (T2017/12, point 2 and J26/95).

Question 5 (8 marks)

Question 5 was well answered, although few candidates suggested to file a divisional application, which was clearly excluded by the wording of the question that required to “*restrict ... in EP-G*”.

Possible Solution Paper D 2018 – Part I

Answer to Question 1 (10 marks)

The applicant can file the missing part of the claim on his own volition within two months from filing the application, Rule 20.7(a)(ii) PCT, i.e. until 20 February + 2 months = 20 April 2018 (Fri).

The statement for the incorporation by reference under Rule 4.18 PCT has to be present from the date of filing.

This is the case as form PCT/RO/101 (Box VI) has been used.

The applicant is advised to: submit a written notice to the receiving office confirming that a part of the claim is incorporated by reference, Rule 20.6(a) PCT; file the missing part of the claim, Rule 20.6(a)(i) PCT and a copy of FR-A, Rule 20.6(a)(ii)

PCT, if not available yet; and indicate where the missing part is contained in the earlier application, Rule 20.6(a)(iv) PCT.

Then, the complete claim will be considered to have been contained in the international application on 20 February 2018, Rule 20.6(b) PCT, without consequences on the filing date and the priority claim. The complete claim will be published.

The extent of the protection conferred is determined by the published version of the claim, Article 29(1) PCT and Articles 67 and 69(2) EPC first sentence.

The applicant should therefore also ask the IB to publish PCT-A earlier, Article 21(2)(b) PCT. Since the International search report is not yet available, the special publication fee specified in Rule 48.4(a) and (b) PCT should be paid.

The application confers provisional protection from the date of publication, Article 67(1) EPC.

Some EPC contracting states require the translation of the claims in one of their official languages, Art 67(3) EPC and National law relating to the EPC, table IIIB.

Candidates referring to Article 29(1) PCT for the provisional protection conferred by the published application where also awarded points.

Answer to Question 2 (8 marks)

The opposition period already expired on 14 December 2016 + 9 months, (Article 99(1) EPC) = 14

September 2017 (Thu). It is too late to file a notice of opposition under Art 99(1) EPC. Since proceedings are still pending D can intervene under Article 105(1) EPC, G4/91.

To intervene, company D has to prove that proceedings for infringement of EP-B are instituted against them under Article 105(1)(a) EPC. The notice of intervention is to be filed within 3 months from the date on which proceedings are instituted, Rule 89(1) EPC, i.e. the notice has to be filed by 22 February 2018 + 3 months = 22 May 2018 (Tue). The notice of intervention shall contain a reasoned statement and the intervening party has to pay the opposition fee, Rule 89(2)EPC.

Pursuant to G1/94, new grounds of opposition may be raised. Therefore, company D should file the intervention on the grounds of Article 100(a) EPC, pointing out that claim 1 of EP-B lacks novelty over document D1.

Since the non-compliance with Article 84 EPC was already present in granted claim 3, amended claim 2 cannot be objected to in the opposition proceedings for lack of clarity, G3/14.

Answer to Question 3 (8 marks)

a) Applicant E can file the application without representation, Art 133(2) EPC. Therefore, applicant E can file the description himself.

The application can be filed in Spanish, Article 14(2) EPC.

Since Form 1001 has been used, the formal requirements of Rule 40(1)(a) EPC are met. The requirements of Rule 40(1)(b) EPC are met, as the applicant was contacted.

Thus, 15 November 2017 will be accorded as the date of filing, Article 80, Rule 40 EPC.

b) A representative has to be appointed under Article 133(2) EPC. The invitation under Rule 58 EPC to correct the deficiency of missing appointment of the representative under Rule 57(h) EPC sets a time limit of 2 months. This time limit expires on 16 April 2018 (Mon) (5 February + 10 days (Rule 126(2) EPC) + 2 Months (Rule 58EPC), extended (Rule 134(1) EPC) to Monday).

The translation should have been signed by the representative, Guidelines A VIII, 3.1. Documents signed by a person who is not entitled are treated as if they had not been signed. The representative has to provide the missing signature in response to the invitation under Rule 50(3) EPC.

The abstract has to be filed, Rule 57(d) EPC.

Answer to Question 4 (6 marks)

a) The decision is deemed notified on 25 September 2017, Rule 126(2) EPC. According to Article 108 EPC, the notice of appeal is to be filed within two months of

notification of the decision, i.e. until 25 November 2017 (Sat), extended under Rule 134(1) EPC to 27 November 2017 (Mo).

According to Article 108 EPC, a statement setting out the grounds of appeal is to be filed within four months of notification of the decision, i.e. until 25 January 2018 (Thu). The proprietor may request re-establishment of rights according to Art 122 EPC.

An isolated mistake in an otherwise well-functioning system is a ground for re-establishment, J2/86.

Within 2 months of the receipt of the communication under Rule 82(2) EPC (removal of the cause of non-compliance), i.e. 2 months from today but within one year of the expiry of the unobserved time limit R. 136(1) EPC, the proprietor needs to request re-establishment proving all due care, complete the omitted acts (filing the notice and grounds of appeal as well as paying the appeal fee), and

pay two fees for re-establishment, Article 122, Rule 136 EPC.

b) The re-establishment in respect of the 2 month time limit of filing the notice of appeal is ruled out for an opponent appellant, Guidelines E VII 3.1.2(GL2016)

Answer to Question 5 (8 marks)

a) Under Rule 71a(2) EPC, the examining division may resume examination until the decision to grant. According to G12/91, the examining division may resume the examination procedure

up to the moment the decision to grant is handed over to the EPO's internal postal service.

Since applicant G paid the fees and filed the translations, he is deemed to have approved the text, Rule 71(5) EPC.

However, said approval is not binding, G7/93. Applicant G should file the amendment and the reasoning why the amendment is necessary. The examining division will resume examination of the application because the document is novelty destroying, Guidelines C-V, 6.1. The fee for grant and publishing does not need to be paid again, Rule 71a(5) EPC.

b) Limitation under Art 105a EPC is available after grant. The request for limitation has to meet the requirements of Rule 92(2) EPC, in particular the amended claims and adapted description have to be filed, Rule 92(2)(d) EPC.

The applicant has to pay the limitation fee Art 105a(1) EPC.

The applicant does not have to provide reasons why he wants to limit the claims, Guidelines D-X, 4.2.

Examiners' Report Paper D 2018 – Part II

This year's D2 paper required candidates to demonstrate their knowledge relating to numerical ranges, admissibility of appeals and priority claims. Following their analysis of the current situation of the client's various patent rights, the candidates were required to come up with solutions maximising the scope of protection obtained by their client.

Candidates generally fared quite well in their analyses. Demonstrating that they could also oversee the consequences for the client's rights and its preferred product appears to have presented the candidates with more difficulties.

Many candidates noticed that the date of receipt of the decision of the opposition division was decisive for calculating the period for filing the grounds of appeal. Only a minority of candidates realised that BB's appeal was not sufficiently substantiated and therefore inadmissible. Even fewer realised that, as a consequence of BB only being party as of right, the principle of (no) reformatio in peius applied.

This year, candidates were required to analyse the various applications, rather than inventions. However, as always, this still required them to identify the first applications for the various inventions.

In the analysis of PCT-BB2, the identification of the end point of the temperature range disclosed in PCT-FK1 as falling within the range claimed in PCT-BB2 was necessary. Discussions on the criteria for novelty of selection inventions in cases of sub-ranges (Gl. G-VI, 8) were not called for.

Candidates should have realised that EP-BB3 was already deemed withdrawn at the date of the examination (27 February 2018).

The concept of the first application was crucial for the analysis of EP-BB3 and the potential PCT application claiming priority from EP-BB3.

The availability of EP-BB2 upon publication of PCT-BB2 does not mean that EP-BB2 thereby becomes prior art under Art. 54(3) EPC for EP-BB3, if restored. PCT-BB2 was the potential earlier right. Candidates with an eye to the client's rights did not merely propose to abandon PCT-BB2 to eliminate its prior right effect.

Although candidates were asked to consider a potential PCT application claiming priority from EP-BB3, many overlooked this.

When it came to improving the situation of PCT-BB2, the very good candidates were able to recommend formulating a new range of 175-220°C. The less optimal solution of 175-200°C also attracted marks. Candidates should also have considered inventive step.

When it came to buying PCT-FK1, the consequence of BB not being free to operate was generally recognised. However, the additional advantage of owning a potential European patent based on PCT-FK1 with regard to the method of producing the award-winning product and the product directly obtained by the method was often not dwelled on.

Possible Solution Paper D 2018 – Part II

1. Current position in the appeal proceedings and how to proceed

The written decision was deemed notified on 12 October 2017, but received on 16 October 2017. Time periods for BB are calculated from the later date. BB's notice of appeal included a specific request defining the subject of the appeal. BB's grounds of appeal were to be filed by 16 February 2018 (a Friday), and were thus on time. However, the mere reference to submissions made at first instance cannot be considered sufficient reasoning for the purposes of Art. 108, 3rd sentence.

It is too late to remedy the lack of grounds. The appeal filed by BB will be deemed inadmissible. Re-establishment of rights would have no reasonable prospect of success. BB can withdraw its appeal to obtain a partial refund of its appeal fee.

The opponent's grounds and notice were on time and substantiated, so that his appeal is valid and BB will be party as of right. As such, BB is limited to defending the result of the first instance proceedings.

BB's main request is broader than the result of the first instance proceedings. It thus violates the principle of (no) reformatio in peius. BB therefore has no allowable request on file.

The time period for response to the Opponent's grounds of appeal has not yet expired. BB should file a response within the time period of four months to be set by the Board.

BB's preferred fallback position has a different scope than the result of the first instance proceedings, because it covers embodiments without fruit B. It would thus also violate the principle of (no) *reformatio in peius*.

A request to uphold the patent as maintained by the decision of the Opposition Division would not be allowable, because the subject-matter of granted claim 2 is not enabled (Art. 100(b) EPC). If such a claim would be the only request, the Board might disregard any other request (A. 13(1) RPBA), if filed only at a later stage in the proceedings, because the objections to the patent as maintained in opposition proceedings were known to BB.

Therefore, BB should now file a response containing a complete case (A. 12(2) RPBA), including a request containing an independent claim combining claims 1, 2 and 3 as granted. The scope of such a claim would be more limited than the patent as maintained at first instance. The request would also comply with Art. 123(3) EPC, because the scope is more limited than the patent as granted. The tests demonstrate that its subject-matter would be enabled.

2.1. EP-BB2

EP-BB2 was filed on 3 February 2017. The filing fee and search fee can no longer be paid, so that EP-BB2 is deemed withdrawn with no legal remedy remaining. EP-BB2 is the first application for the method of preparing a fried food product by frying a ball of dough at a temperature between 150 and 220°C. EP-BB2 is also the first application to disclose an apparatus including a dough mixer and a trumpet-shaped nozzle. The period for filing an application claiming priority from EP-BB2 has expired.

2.2 PCT-BB2

PCT-BB2 was filed on 4 December 2017, i.e. before expiry of the period for claiming priority from EP-BB2. PCT-BB2 was filed by the same applicant and for the same method as disclosed in EP-BB2. The independent claim of PCT-BB2 thus has an effective date of 3 February 2017. PCT-FK1, having a filing date of 31 March 2015,

has been published, presumably shortly after 18 months, so that its publication is state of the art under Art. 54(2) EPC. PCT-FK1 discloses the temperature value 155°C. Disclosure of a value included in a range anticipates the claimed range. The subject-matter of claim 1 of PCT-BB2 is therefore not new.

2.3. EP-BB3 and the intended international patent application

EP-BB3 was filed on 26 January 2018. The filing fee and search fee for EP-BB3 were due by 26 February 2018. The application is deemed withdrawn. EP-BB3 does not include a priority claim, so that its current effective date is 26 January 2018. EP-BB3 claims and describes an apparatus including a dough mixer and a trumpet-shaped nozzle, but is not the first application for this apparatus. Rather, EP-BB2 is BB's first application for this subject-matter. EP-BB2 has served as a basis for claiming priority and was not withdrawn before EP-BB3 was filed. Therefore, EP-BB3 has not given rise to a right of priority.

PCT-BB2 will presumably be published shortly after 3 August 2018, so that it cannot form state of the art under Art. 54(2) EPC. PCT-BB2 discloses an apparatus including a dough mixer and a trumpet-shaped nozzle. PCT-BB2 validly claims priority from EP-BB2 insofar as the apparatus including the dough mixer and the trumpet-shaped nozzle is concerned, so that the effective date of this subject-matter is 3 February 2017.

If PCT-BB2 enters the regional phase before the EPO, then it will be state of the art under Art. 54(3) EPC for a revived EP-BB3 and any EURO-PCT-BB3.

PCT-BB2 will then be novelty-destroying for the claimed subject-matter of EP-BB3, if the fees are paid on EP-BB3 (with further processing, see below) and for such a claim in any future European patent application based on an international patent application claiming priority from EP-BB3.

2.4 PCT-FK1

PCT-FK1 is the first application for an apparatus comprising a dough mixer having a nozzle arranged to deposit shaped quantities of dough into a bath of frying oil. PCT-FK1 is also the first application for a method of preparing a food product by frying

dough with fruit D at between 155°C and 250°C. PCT-FK1 has an effective date of 31 March 2015.

EP-BB1 will have been published in April 2015. EP-BB1 was thus filed before and published after the filing date of EURO-PCT-FK1 and is therefore state of the art under Art. 54(3) EPC, relevant for novelty only. EP-BB1 does not disclose the apparatus or a method in which fruit D is used, so that the subject-matter of claims 1 and 2 is new compared with EP-BB1.

The subject-matter of claim 1 is not new, because combinations of nozzles with a conical shape and a dough mixer have been in use since the end of the 20th century.

The method as defined in claim 2 appears to be new. The use of fruit D within the claimed temperature range provides a technical effect and therefore appears to involve an inventive step. The subject-matter of claim 2 thus appears to be patentable.

3. Improving BB's position

3.1. PCT-BB2

To restore novelty over the disclosure in PCT-FK1, the claim should be limited to the temperature range 175-220°C. Where a narrower range within a broader range is disclosed, a claim to the narrow range and a sub-range on one side thereof is permissible (cf. T 2/81 and subsequent case law). The new range is narrow compared to the range of 155°C to 250°C disclosed by PCT-FK1 and sufficiently far removed from the end points of the known range. It is also a purposive selection, because the acrylamide level remains below 225 ppb if the claimed temperature range is used. The method according to the new claim is therefore new.

EP-BB1 represents the closest prior art, because it concerns the problem of keeping acrylamide levels at an acceptable level. Starting from EP-BB1, the objective technical problem is to keep the acrylamide level in FFPs within acceptable bounds regardless of the types of fruit present. The claimed temperature range solves this problem.

Neither EP-BB1 nor PCT-FK1 discloses the relevance of temperature to the acrylamide problem, much less a relevant temperature range or value. The subject-matter of the amended claims will thus in all likelihood be considered inventive.

3.2. *EP-BB3*

PCT-BB2 discloses an apparatus in which the nozzle is combined with a screw conveyor. There is no basis for an apparatus claim that does not include the screw conveyor in either a European patent application based on PCT-BB2 or a divisional application based on such a European patent application.

To obtain protection for an apparatus including a dough mixer having mounted thereon a trumpet-shaped nozzle (with or without a screw conveyor to expel the dough), EP-BB3 should be prosecuted to grant. To this end, BB should file a request for further processing within 2 months of notification of a communication of loss of rights. This entails payment of the filing fee and search fee and the further processing fee, which is 50 % of these fees.

A claim to priority from EP-BB2 should be added before 4 June 2018 (16 months from the filing date of EP-BB2). This is possible, because EP-BB3 was filed on 26 January 2018, i.e. within twelve months of the date of filing of EP-BB2 on 3 February 2017, by the same applicant and because EP-BB2 discloses the apparatus with the dough mixer and the trumpet-shaped nozzle mounted thereto.

The effective date of EP-BB3 will be 3 February 2017. No prior art discloses the apparatus with the dough mixer having mounted thereto a trumpet-shaped nozzle. The effect of providing a higher liquid content and thus a lower level of acrylamide supports a finding of the presence of an inventive step.

The contemplated international patent application could still be filed, but will have its filing date as effective date. It will only be of use in states in which PCT-BB2 does not enter the national phase.

4. Reasons for buying EURO-PCT-FK1

The process used by BB to produce the award-winning products falls within the scope of claim 2 of EURO-PCT-FK1. There is thus an infringement risk. PCT-FK1 already offers provisional protection for the method.

If BB can obtain EURO-PCT-FK1, then it will be able to prosecute the application to grant to obtain a patent for the method of claim 2. It could then stop others from applying the method to produce the award-winning oliebollen. They will be protected by virtue of being the products directly obtained by the method.

BB's existing portfolio is weak, because EP-BB1 will in all likelihood be maintained with a scope of protection that can be readily worked around by leaving out fruit B and a European patent granted on PCT-BB2 will not cover the entire temperature range that can be used to produce the award-winning oliebollen.

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

Category		Max. possible	Marks Marker 1	Marker 2
Part I - Question 1	Part I - Question 1	10		
Part I - Question 2	Part I - Question 2	8		
Part I - Question 3	Part I - Question 3	8		
Part I - Question 4	Part I - Question 4	6		
Part I - Question 5	Part I - Question 5	8		
Part II - Question 1	Part II - Question 1	10		
Part II - Question 2.1	Part II - Question 2.1	3		
Part II - Question 2.2	Part II - Question 2.2	6		
Part II - Question 2.3	Part II - Question 2.3	12		
Part II - Question 2.4	Part II - Question 2.4	8		
Part II - Question 3	Part II - Question 3	16		
Part II - Question 4	Part II - Question 4	5		
Total				