Examiners' Report Paper D 2016

General Comments

Many candidates did not manage to correctly apply Rule 126(2) EPC. Those candidates adding 10 days to e.g. the date on which the applicant received the notification of the decision clearly were not awarded full marks.

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.

Examiners' Report Paper D 2016 – Part I

Question 1 (6 marks)

Not all candidates realized that announcing the decision during oral proceedings does not trigger the time limit for filing an appeal. Most candidates correctly answered that the appeal fee is fully reimbursed if the appeal is withdrawn before expiry of the time limit for filing the grounds of appeal. Some candidates argued for question b2) that the fee will not be reimbursed because there is no evidence of a substantial procedural violation. These candidates seem to have based their answer on a previous version of Rule 103 EPC.

Question 2 (10 marks)

Few candidates discerned the fact that because PCT-C is filed in Italian, the EPO will forward PCT-C to the International Bureau acting as receiving Office. Candidates were not generally aware of the different language requirements for filing PCT or European patent applications with the EPO.

Question 3 (7 marks)

Neither candidates who answered that the national route was closed for Lithuania nor candidates who answered that it is still possible to enter into the national phase in Lithuania lost marks, because some official communications were not clear on this topic.

Many candidates were aware of the possibility of requesting accelerated processing. However, few candidates pointed out that in addition the applicant has to waive the right to be asked whether he wishes to proceed further, and waive the right to receive the communication under Rule 161(2) EPC.

Question 4 (9 marks)

Few candidates fully grasped the consequences of the fact that the subject-matter of claims 16 and 17 is deemed to be abandoned. Answers only referring to Article 84 EPC for lack of support for claim 16 or Article 82 EPC for claim 17 were not awarded any points.

Question 5 (8 marks)

Question 5 was well answered, although some candidates, rather than referring to Rule 165 EPC, seemed to imply that all requirements of Rule 159(1) EPC have to be met before Euro-PCT-F can be considered prior art under Article 54(3) EPC.

Possible solution – Paper D 2016 – Part I

Answer to question 1

a) According to Article 108 EPC, the notice of appeal shall be filed within 2 months of notification of the decision. The decision is dated 14 July 2015 and thus deemed to be delivered on 24 July 2015, Rule 126(2) EPC. Therefore, a notice of appeal should have been filed by 24 September 2015.

b1) Within four months of notification of the decision, a statement setting out the grounds of appeal shall be filed. The grounds should have been submitted by 24 November 2015.

Since the applicant withdrew the appeal before expiry of the four month period, the appeal fee will be 100% reimbursed, Rule 103(1)(b) EPC.

b2) Since the minimum time period that can be specified for responding to the communication under Rule 100(2) EPC is two months, Rule 132(2) EPC, the applicant withdrew the appeal before any possible expiry of the time limit. Therefore, 50% of the appeal will be reimbursed, Rule 103(2)(b) EPC.

Answer to question 2

a) In accordance with Rule 19.1 PCT, MAXIMA is entitled to file PCT-B with the Italian patent office as receiving Office.

An international application may claim priority of an earlier application filed in or for any country to the Paris Convention, Article 8(1) PCT. An international application that has obtained a filing date is equivalent to a regular national filing, under the Paris Convention and its priority can be claimed Article 11(4) PCT. The fact that no fees were paid is irrelevant for obtaining a filing date for PCT-B. Thus, priority can be claimed from PCT-B.

PCT-B and PCT-C have been filed by the same applicant and the contents of PCT-B and PCT-C are identical.

The priority period expired on Sunday, 7 February 2016, Article 8(2)(a) PCT and Article 4C(1) Paris Convention. Pursuant to Rule 2.4 PCT in conjunction with Rule 80.5 PCT, the priority period is extended until Monday, 8 February 2016.

Where the EPO acts as receiving Office, an international application cannot be filed in Italian, it must be filed in English, French or German, Rule 157(2) EPC. Therefore, the EPO must forward PCT-C to the International Bureau, Rule 19.4(b) PCT. The EPO is deemed to have received PCT-C on behalf of the International Bureau as receiving Office, Rule 19.4(a) PCT. Thus, PCT-C is deemed received on 8 February 2016 at the International Bureau. Therefore, PCT-C was filed within the priority year and the priority is considered valid.

b) Since PCT-C has been filed with the International Bureau as receiving Office, the competent searching authority is the EPO, Article 16(3)(b) PCT, Rules 35.1 and 35.3(a) PCT, in conjunction with Article 3 of the Agreement between EPO and the International Bureau of WIPO as published in Official Journal 2010, page 304 and Article 152 EPC.

The applicant has to file a translation of PCT-C for the purpose of international search into one of the languages accepted by the EPO, i.e. English, French or German, Rule 12.3 PCT and Official Journal 2014, A117. The translation has to be furnished to the International Bureau, Rule 12.3(a) PCT.

Answer to question 3

For the Netherlands and Italy it was not possible to enter the national phase, because these countries had closed the national route in accordance with Article 45(2) PCT before the filing date of PCT-D. For Lithuania the national route was available, because PCT-D was filed before the date on which the national route was closed, see PCT Applicant’s Guide, Annex B1, "General Information" for each of these states, and PCT Gazette.

PCT-D was filed in Russian, searched by the Russian Patent Office as International Searching Authority and in accordance with Rule 48.3(a) PCT published in Russian. Since the Euro-PCT application is published in "another language", Article 153(4) EPC requires that a translation in DE/EN/FR is filed with the EPO. In accordance

with Rule 159(1)(a) EPC, the translation has to be filed upon entry into the European phase, i.e. today. The applicant also has to specify the application documents on which the European grant procedure is to be based, Rule 159(1)(b) EPC.

The applicant must file a valid request for examination including payment of the examination fee, see point 15 of the Notice from the EPO concerning the request for early processing, Official Journal 2013, page 156, and request accelerated prosecution, Guidelines E-VII,3.2. The applicant should waive the right to be asked under Rule 70(2) EPC whether he wishes to proceed further, see point 16 of the Notice from the EPO, and waive the right to receive the communication under Rule 161(2) EPC, Official Journal 2011, page 354.

Answer to question 4

The application documents on which the European grant procedure is to be based, comprise more than 15 claims. Therefore, claims fees should have been paid for claims 16 and 17, Rule 162(1) EPC.

a1) Since no claims fees have been paid, claims 16 and 17 are deemed to be abandoned under Rule 162(4) EPC. Thus, the supplementary search is based on claims 1 to 15.

a2) As the subject-matter of claim 16 is deemed to be abandoned and not otherwise to be found in the description or drawings of PCT-E, it cannot be reintroduced into the claims, Guidelines E-VIII, 2.1.3. Thus, EP-E cannot be granted with the subject-matter of claim 16.

a3) As claim 17 is not unitary with the searched subject-matter, it cannot be granted in EP-E, Rule 137(3) EPC or Rule 137(5) EPC. The subject-matter of claim 17 can only be granted through a divisional application.

b) Because no excess claims fees had previously been paid under Rule 162 EPC, the applicant will be invited to pay excess claims fees in respect of claims 16 to 19, Rule 71(4) EPC.

Answer to question 5

PCT-F has a priority date which is earlier than the date of filing of EP-G, but has been published after said date of filing. In accordance with Article 153(5) EPC and Rule 165 EPC, Euro-PCT-F shall be considered as prior art under Article 54(3) EPC, if the filing fee under Rule 159(1)(c) EPC has been paid and a translation has been filed. As all necessary documents, including the translation, have been filed, the requirements of Rule 159(1)(a)EPC have been met.

Since no filing fee has been paid, the EPO communicates to the applicant that the application is deemed to be withdrawn, Rules 160(1) and (2) EPC. The communication of the loss of rights is deemed delivered on 25 January 2016, Rule 126(2) EPC. Further processing can be requested by payment of the prescribed fee within two months of the communication, i.e. until 25 March 2016, Rule 135(1) EPC. Since the period expires on Easter Friday, it is extended to 29 March 2016, Rule 134(1) EPC. The filing fee has to be paid within the same period.

The time limit for filing a notice of opposition expires on 25 August 2016, Article 99 EPC. Company F should file an opposition based on the ground that the claim of EP-G lacks novelty with respect to the disclosure of Euro-PCT-F, Article 100(a) EPC.

Examiners' Report Paper D 2016 – Part II

Some candidates did not follow the scheme that was given in question 1. Instead of discussing the patent situation by subject matter, as was requested, they discussed it by patent application. This approach often resulted in an incomplete analysis for a particular subject matter and earned fewer marks. If the conclusions were not present, e.g. "*elliptical rib takes away novelty of rib in general"*, the relevant points were missed.

Generally, parts a), b) and e) of question 1, and parts b) and e) of question 2 were well answered.

The insufficiency problem for capsules with ribs in general was often not recognized. Very few candidates saw that claim 1 of PCT-SA lacked the essential feature of material X.

Although many candidates recognized that a French company is not entitled to file an appeal in Dutch, few came to the conclusion that the appeal was deemed not filed. Therefore, a new appeal had to be filed and the appeal fee had to be paid again.

Most candidates recognized that FR2-SA is the first filing for additive G. However, fewer candidates realized that priority of FR2-SA could be added to PCT-SA.

Question 3 was generally well answered.

Possible solution – Paper D 2016 – Part II

Question 1

a) plastic coffee capsules having an elliptical rib

CH-BC is the first filing for capsules having an elliptical rib. There is no relevant prior art and the technical effect is that piercing is improved: a claim to a capsule having an elliptical rib seems to be novel and inventive.

PCT-BC validly claims priority from CH-BC because applicants and subject matter are the same, and the priority period is extended from 1 August 2015 to 3 August 2015 (Saturday ->Monday). CH-BC is not enabling for capsules with ribs in general so that priority is valid only for capsules with elliptical ribs.

If PCT-BC and PCT-SA both enter the European regional phase, PCT-BC would constitute a prior right under Article 54(3) EPC, and would destroy novelty of any possible claim to a capsule having an elliptical rib in PCT-SA.

BC will be able to obtain protection for a capsule having an elliptical rib made from any material from PCT-BC.

b) plastic coffee capsules having a triangular rib

FR-SA is the first filing for capsules having a triangular rib.

PCT-SA validly claims priority from FR-SA: the applicants are identical, the subject-matter is the same, and PCT-SA was filed within the priority period which is extended from 12 December 2015 to 14 December 2015 (Saturday->Monday).
If PCT-BC became prior right under Article 54(3) EPC, it would not take away novelty and would not be relevant for inventive step of capsules with triangular ribs.

There is no relevant prior art and the triangular rib has the technical effect of improving the piercing of the capsule. A claim to a capsule having a triangular rib would seem to be novel and inventive.

A triangular rib is disclosed but not claimed in FR-SA or in PCT-SA or in any other patent application.

c) plastic coffee capsules having a rib

CH-BC is the first filing for capsules having a rib.

Material X is essential to make a generic rib and CH-BC and PCT-BC do not contain any reference to material X in claims or description. Therefore claims to a capsule having a generic rib in both CH-BC and PCT-BC are not sufficiently disclosed over their entire scope.

The disclosure of a capsule with elliptical ribs in PCT-BC is novelty destroying under Art 54(3) EPC for the claim to a capsule having a rib in PCT-SA.

Material X is disclosed in FR-SA and PCT-SA. The claim of PCT-SA is missing the essential feature of material X for a capsule having a rib of a shape other than triangular or elliptical.

The claim in FR-SA and in PCT-SA is not sufficiently disclosed over its entire scope. A claim to a capsule having a rib made of material X would be novel and inventive. As it stands, BC will be able to obtain protection for a capsule having a rib made from any material from PCT-BC.

d) plastic coffee capsules made of material X

Capsules made of material X are disclosed in document D. Document D is prior art under Article 54(2) EPC for EP1-BC, thus EP1-BC lacks novelty over document D. EP1-BC is currently in force and can be used to prevent SA from selling capsules made of material X.

SA is a French company, thus SA is not entitled to file an appeal in Dutch. The appeal is deemed not filed and the appeal fee will be reimbursed.

e) coffee powder containing additive G

FR2-SA is the first filing for coffee powder containing additive G because FR1-SA was withdrawn in August 2013 without leaving any rights outstanding and without having served as a basis for claiming a right of priority.

There is no relevant prior art. Additive G is only known as stabilizer for cosmetics. G has the technical effect of increasing extraction. Thus, a claim to coffee powder containing additive G seems to be novel and inventive.

PCT-SA discloses coffee powder containing additive G, but does not have any claim to coffee powder containing additive G. PCT-SA does not claim priority from FR2-SA. PCT-BC was filed after FR2-SA but before PCT-SA. Once regionalized, PCT-BC would be prior art under Article 54(3) EPC for PCT-SA.

Question 2

a) plastic coffee capsules having an elliptical rib

Add a claim to a capsule having an elliptical rib in PCT-SA or in any application resulting therefrom to get protection in countries where PCT-BC does not enter the national/regional phase.

b) plastic coffee capsules having a triangular rib

Add a claim to a capsule having a triangular rib in PCT-SA or in any application resulting therefrom. Such a claim may be added in the international phase of PCT-SA or on entry of EP or national phases.

c) plastic coffee capsules having a rib

File third party observations (possible in the PCT phase), citing FR-SA and/or PCT-SA and mentioning insufficient disclosure of plastic coffee capsules having a rib and being made of a material other than material X.

It is also possible to file an opposition on the ground of insufficiency of disclosure once PCT-BC has entered the EP phase and has been granted.

In case of third party observations and/or opposition, a European patent based on PCT-BC will not be granted or will be revoked for a claim directed to a capsule with a rib.
With respect to FR-SA and in PCT-SA, file an amended claim directed to a capsule having a rib and being made of material X. The claim would be considered unitary by the EPO since such a rib is a corresponding special technical feature when compared to a triangular rib or to an elliptical rib.

d) plastic coffee capsules made of material X

The time limit for filing an appeal expires on 9 March 2016 (30 December 2015 plus 10 days plus 2 months).
File a new notice of appeal in an official language. Pay the appeal fee. The appeal fee paid by the Dutch representative will be refunded. File the grounds of appeal - until 9 May 2016 and discuss the prima facie relevance of document D.
Lack of novelty was already raised as the ground for opposition.

e) coffee powder containing additive G.

PCT-SA was filed within the priority year of FR2-SA. The period for adding a priority claim in PCT-SA has not lapsed. A priority claim to FR2-SA should be added in PCT-SA, by 14 April 2016.

Upon addition of the priority claim to FR2-SA, PCT-SA will have the earliest effective date for coffee powder containing additive G, and will become a prior right for PCT-BC.

The claim to coffee powder containing additive G in PCT-BC then will lack novelty over PCT-SA.

File third party observations, (either in the international phase or in the European phase), and/or file an opposition against a European patent resulting from PCT-BC. Add a claim in PCT-SA directed to coffee with additive G. This can be done in the international phase or on entry to the EP/national phases.

Coffee powder containing additive G is not unitary with a plastic capsule having a rib. Therefore file a divisional application for coffee powder containing G.

Question 3

a) plastic coffee capsules having an elliptical rib

BC can stop SA from selling plastic coffee capsules having an elliptical rib, based on the patent originating from CH-BC in Switzerland, and/or the patent(s) originating from PCT-BC.

b) plastic coffee capsules having a triangular rib

SA can stop BC from selling plastic coffee capsules having a triangular rib, based on the patent originating from FR-SA in France, and/or the patent(s) originating from PCT-SA.

c) plastic coffee capsules having a rib

SA can stop BC from selling plastic coffee capsules having a rib made from material X, based on the patent originating from FR-SA in France, and/or the patent(s) originating from PCT-SA.

d) plastic coffee capsules made of material X

When EP1-BC is revoked, neither SA nor BC can stop the other party from producing plastic coffee capsules from material X, as long as the capsules do not contain a rib.

e) coffee powder containing additive G

SA can stop BC from selling coffee powder containing additive G, based on FR2-SA in France, and/or the patent(s) originating from PCT-SA.

EXAMINATION COMMITTEE III

Paper D - 2016 - Marking Sheet

Category		Maximum possible
Part I	Part I-Question 1	6
	Part I-Question 2	10
	Part I-Question 3	7
	Part I-Question 4	9
	Part I-Question 5	8
Part II	Part II-Question 1a	7
	Part II-Question 1b	6
	Part II-Question 1c	9
	Part II-Question 1d	6
	Part II-Question 1e	7
	Part II-Question 2	18
	Part II-Question 3	7
Total		100