

Examiners' Report – Paper D 2019

Purpose and extent of the examiners' report

The purpose of the present examiners' report is to enable candidates to prepare for future examinations (cf. Art. 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 marks. Alternative answers, one being correct and one being wrong, to the choice of the markers do not attract any marks.

In Part I, full marks were only awarded when the full legal basis was cited to support the analysis. Citing only the legal basis without any further explanation or reasoning does generally not attract any marks. However, alternative relevant legal bases also attracted marks.

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

It is still noticed that candidates skip entire questions from D1. However, these candidates typically do not pass. All-round knowledge of the syllabus, as tested in Part I, is required to successfully do the legal assessment in Part II.

Candidates are reminded that the PCT questions may make up a substantial part of paper D.

Examiners' Report – Paper D 2019, Part I

Question 1 (9 marks)

Most candidates correctly mentioned Art. 61 EPC, however very few noted that, according to Rule 16(1)(b) EPC, this article is applicable only as long as EP-A has not yet been granted.

Few candidates realized that the period for payment of the renewal fees is not interrupted.

It was often not realized that the divisional application for claim 3 could only be filed after resumption. Candidates mostly spotted that the parent application has to be pending, but many failed to attract the full marks because they did not cite the legal basis. Filing a new application pursuant to Art. 61(1)(b) EPC, was not an option, as this would cause the parent to be deemed to be withdrawn.

Question 2 (7 marks)

While third party observations may address an alleged lack of clarity under EPC, third party observations concerning a lack of clarity are rejected when filed under PCT. More candidates than expected missed this issue.

It is important to carefully read the question. The specification “while the competitor’s application is pending”, render arguments relating to opposition moot.

Question 3 (9 marks)

This question was reasonably well answered. Most of the candidates realised that the PCT form PCT/RO/101 automatically includes a statement of incorporation by reference, which can be confirmed later, so that the claims of the earlier application DE1 can still be incorporated into the PCT application. Candidates also appreciated the different requirements between EPC and PCT for obtaining a filing date.

Some candidates suggested to file missing parts pursuant to Rule 56 EPC for the EP application, but they did not realise that that is limited to the description and drawings.

Question 4 (7 marks)

This question concerned losing a right to priority because competitor Y had claimed priority from an application that was not the first application.

Several candidates missed this and even mistook CA1 as Art. 54(3) EPC prior art for EP1, which is not possible for a national application. In fact, CA1 is full prior art under Art. 54(2) EPC.

Many candidates failed to see that, irrespective of the contents of KR1, the priority claim is invalid, and therefore the translation of KR1 is not needed for determining the validity of the priority claim.

Question 5 (8 marks)

This question was generally not well answered. Essential in this question were the Arrangements for Deposit Accounts (ADA) and its Annex A.1, the Arrangements for the automatic debiting procedure (AAD). Very few candidates mentioned that the payment is considered to have been made on the date on which the deposit account is duly replenished with sufficient funds. The majority of the candidates realized the 10-day fail-safe arrangement from Art. 7(3) Rfees.

Possible Solution – Paper D 2019, Part I

References to the legal basis are referring to the status on 31 October 2018.

Answer to Question 1 (9 marks)

(a) EP-A is not yet granted. The Rule 71(3) EPC communication was issued only today, therefore, according Rule 16(1)(b) EPC, Art. 61 EPC is applicable.

Company B has to provide evidence to the EPO that it has instituted proceedings against Applicant A. The effect is that proceedings are stayed according to Rule 14(1) EPC and the period for replying to the Rule 71(3) EPC communication is interrupted, Rule 14(4) EPC.

According to Rule 14(4) EPC, the period for payment of renewal fees is not interrupted. Company B should make sure the renewal fees are paid (if not by A, then by B) during the stay.

Once a final decision in favour of Company B has been taken, Company B has to provide evidence to that effect to resume the proceedings to grant, Rule 14(2) EPC, within 3 months after the decision recognising entitlement has become final, Rule 16(1)(a) EPC.

Company B has to inform the EPO that it wants to prosecute EP-A as its own application, Art. 61(1)(a) EPC. Company B also has to file a new independent claim based on original claims 1 and 2 upon resumption within the time which has not yet elapsed under Rule 71(6) EPC, (or within 2 months, Rule 14(4) EPC, Rule 71(6) EPC) and delete claim 3.

Company B can either wait for a new Rule 71(3) EPC communication, or expressly waive a further Rule 71(3) EPC communication, OJ 2015, A52, and at the same time file a translation of the new claims into the other two official languages and pay the fee for grant and publishing.

(b) After the proceedings are resumed, J 9/12, Company B has to file a divisional application for claim 3, Art.76(1) EPC. EP-A has to be pending Rule 36 (1) EPC, hence the divisional application must be filed at least one day before the mention of the grant in the bulletin of EP-A.

Answer to Question 2 (7 marks)

(a) In the international phase, third party observations may only be filed electronically at the IB, GL/PCT-EPO E-II, within 28 months from the international filing date.

The 28 months expire on 13 August 2019. The 3rd party observations may only relate to novelty and inventive step.

Therefore, claim 2 cannot be objected to under clarity in a third party observation, because observations relating to clarity, Art. 6 PCT, will not be communicated to any international authority, and will not be open to public inspection.

The client should file a third party observation relating to lack of novelty (Art. 33.2 PCT) of claim 1 in view of the document.

(b) Third party observations can be filed according to Art. 115 EPC once the application has entered the European regional phase and may also relate to Art. 84 EPC according to GL E-VI, 3.

The client should file a third party observation under (Art. 115 EPC) raising lack novelty in view of the disclosure against claim 1 and raise a lack of clarity objection for claim 2.

Answer to Question 3 (9 marks)

(a) In the absence of claims, a date of filing cannot be obtained for the PCT application Art. 11.1(iii)(e) PCT. An applicant can file the claims on his own volition Rule 20.7(a)(ii) PCT within 2 months from the date of filing, or the rO will invite the Applicant to correct a deficiency under Art. 11(1) PCT, Rule 20.3 PCT, in response to which he can file the claims, Rule 20.7(a)(i) PCT within 2 months.

The PCT form (PCT/RO/101) automatically includes a statement of incorporation by reference according to Rule 4.18 PCT.

The Applicant should send a written notice under Rule 20.6(a) PCT, confirming that the missing claims are incorporated by reference, accompanied by sheet(s) containing the claims as contained in the priority application DE1, a copy of the earlier application DE1 and indication of where they are contained.

The filing date is then the date when the application was received by the Office, Rule 20.3(b)(ii) PCT. Hence, the priority is validly claimed for both capsules made of aluminium and capsules made of metal.

Therefore, yes, the applicant can get protection for capsules made of aluminium and capsules made of metal, because the article does not become prior art under Art. 33(2) PCT.

(b) A filing date will be accorded to EP1, even without claims, Art 80 EPC, Rule 40 EPC.

The applicant can remedy the deficiency under Rule 57(c) EPC, requiring at least one claim, by voluntarily filing the claim, GL A-III, 15, or he can do so in response to an invitation pursuant to Rule 58 EPC, within 2 months.

Applicant C should file a claim directed to capsules made from aluminium on the basis of the description that does not contravene Art. 123(2) EPC. A claim to capsules made from metal cannot be included as that would contravene Art. 123(2) EPC.

The priority claim is valid, and the article is not prior art under Art. 54(2) EPC

Answer to Question 4 (7 marks)

(a) The patent was granted on 30 May 2018, so the 9 month opposition period, Art. 99(1) EPC, expires on 28 February 2019, on last day of the month, Rule 131(4) EPC.

Pursuant to Art. 87(1) EPC, to give rise to a right to priority, the application must, inter alia, be the first application for this invention.

CA1 was filed before KR1 by the same applicant and pertains to the same device A. Art. 87(4) EPC is not applicable, since CA1 not filed in the same country. Thus, KR1 is not the first application for that subject-matter, whether KR1 discloses device A or not.

The priority is thus invalid. The relevant date for subject matter A in EP1 is its filing date, GL F-VI 1.4. Consequently, CA1 belongs to the state of the art under Art. 54(2) EPC and anticipates EP1.

An opposition filed on the ground of Art. 100(a), lack of novelty over CA1, will be successful.

(b) No, a translation is not needed for determining the validity of the priority claim, GL F-VI, 3.4.

Answer to Question 5 (8 marks)

(a) The time limit for paying the additional search fee expired within 1 month from the date from the invitation, Rule 40.1(ii) PCT, i.e. on 25 February 2019, Rule 80.2 PCT.

Since at the date of expiry of the time limit of Rule 40.1(ii) PCT, the account did not contain sufficient funds to cover the additional search fee, the debit order is not carried out, GL A-X, 4.3.

The payment is considered to have been made on the date on which the deposit account is duly replenished (GL A-X, 4.2.4, AAD 8), i.e. today. The additional search fee has not been paid, and the ISR and WOISA will cover the first claimed invention only, Art.17(3)(a) PCT.

(b) A 10-days fail-safe arrangement under Art. 7(3) RFees, applies to payments to replenish deposit accounts, ADA 4.1.

After the EPO is made aware that, the order was given to the banking establishment more than 10 days before expiry of the period under Rule 40.1(ii) PCT, the EPO will debit the additional search fee, because € 10 000 is more than sufficient.

The final ISR and WOISA will cover both inventions, Art.17(3)(a) PCT.

Examiners' Report – Paper D 2019, Part II

This year's Part II of paper D required candidates to demonstrate their knowledge relating to (partial) priority, numerical ranges, the contents of the application as filed, evident abuse 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 freedom to operate for and scope of protection obtained by their client in different contracting states.

Candidates generally did well on the analysis and spotted most of the relevant relationships between the various rights and how they affect the freedom to operate of the parties involved.

It is noted that candidates who immediately proposed improvements without fully analysing the situation as outlined in the paper, missed a lot of relevant issues.

The majority of candidates noticed that EP-F2 contained subject matter that was not covered by its priority application EP-F1. Only some candidates made the right assessment and distinguished between the different parts of the "OR-claim". Many candidates also did not recognise the consequence of partial lack of novelty for the claim as a whole.

Many candidates did not realise that announcement B also constitutes prior art under Art. 54(2) EPC.

Overall, the legal status of EP-F1 and EP-F3 was correctly assessed. Some candidates speculated on possible re-establishment of rights, without any indication in the paper, thereby losing time.

The assessment of the situation on selling and producing soles A and B in Austria and Germany was generally done well. The national effect of AT-H was usually correctly assessed. In the assessment of selling and producing Sole B, in particularly in view of EP-H, very few candidates noticed that the EP-H was only recently granted and would not

necessarily have been validated in contracting states that are not party to the London Agreement, such as Austria.

On the improvement of the situation, most candidates spotted the need to oppose EP-H on the ground of added subject matter.

The possibility of adding a priority claim to EP-F3 in EP-F2 was also generally well recognised. However, while the candidates understood that the earlier effective date added another part to the “OR-claim” they neither applied it to the partial (lack of) novelty of specific parts of the “OR-claim” in their original assessment, nor did they realise that just adding the priority claim without making claim amendments is not sufficient to get a granted patent out of EP-F2.

The evident abuse and the consequences of being able to file a new application was well recognised. The majority of candidates overlooked that despite the provision for a 6 month period to file the new application, the product launch was intended within 2 months from the date of the exam.

Possible Solution – Paper D 2019, Part II

1. Outline the patent situation as it currently stands for the claims of FASTER's applications.

(a) EP-F2

EP-F2 is still pending.

EP-F1 is the first filing for Copper (Cu) nanoparticles up to 40 nm, it was filed by the same applicant and EP-F2 was filed within priority year.

Claim 1 of EP-F2 enjoys partial priority (G1/15) from EP-F1 for the part directed to copper nanoparticles up to 40 nm. The remaining parts of claim 1, i.e. the part directed to metal nanoparticles from metals other than copper and the part directed to copper nanoparticles larger than 40 nm, have the filing date of EP-F2 (25 Feb 2018) as relevant date. AT-H belongs to the state of the art under Art. 54(2) EPC for claim 1 of EP-F2.

All claims of EP-F2 are novel over AT-H, since the specific metal nanoparticles are novel over the generic nanoparticles in AT-H. The claims of EP-F2 also involve an inventive step over AT-H. AT-H does not mention energy storage and does not disclose metal nanoparticles.

For the remaining part of claim 1 of EP-F2, the Announcement B (and English publication of EP-H) belong to the state of the art under Art. 54(2) EPC. The specific copper nanoparticles from 70 to 80 nm destroy novelty of that remaining part. Therefore, claim 1 of EP-F2 lacks novelty over announcement B (and EP-H).

Claim 2 of EP-F2 only enjoys partial priority from EP-F1 for the part directed to copper nanoparticles up to 40 nm. The remaining parts of claim 2, i.e. the part directed to metal nanoparticles from metals other than copper and the part directed to copper nanoparticles larger than 40 and up to 80 nm, have the filing date of EP-F2 as relevant date. For the remaining part of claim 2, announcement B (and the English publication of EP-H) belong to the state of the art under Art 54(2) EPC. Announcement B (and the English publication of

EP-H) disclose (specific) copper nanoparticles from 70 to 80 nm, which destroy novelty of that remaining part. Claim 2 of EP-F2 therefore lacks novelty over announcement B (and EP-H).

Claim 3 of EP-F2 enjoys partial priority from EP-F1 for the part directed to copper nanoparticles up to 40 nm. The remaining part of claim, i.e. the part directed to metal nanoparticles from metals other than copper and the part directed to copper nanoparticles larger than 40 and up to 80 nm, has the filing date of EP-F2 as relevant date. For that remaining part, announcement B (and the English publication of EP-H) belong to the state of the art under Art. 54(2) EPC. The announcement B (and English publication of EP-H) disclose copper nanoparticles from 70 to 80 nm, which destroy novelty of that remaining part. Claim 3 of EP-F2 therefore lacks novelty over announcement B (and EP-H).

(b) EP-F1

The notice of loss of rights was received in June 2018. Further processing is no longer available for EP-F1. EP-F1 is irretrievably lost.

(c) EP-F3

The notice of loss of rights was received in July 2018. Further processing is no longer available for EP-F3. EP-F3 is irretrievably lost.

2. As the situation currently stands, are FASTER or HIKE free to produce or sell the following products in Austria or Germany?

(a) shoes with sole A

AT-H is in force. Sole A falls within the scope of protection of AT-H, claiming a shoe sole with nanoparticles of unspecified material and unspecified size, in Austria. In Austria, HIKE can prevent FASTER from selling or producing shoes with sole A. In Germany there is no relevant patent, and FASTER is free to produce or sell shoes with sole A.

In Austria and Germany, HIKE is free to produce or sell shoes with sole A.

(b) shoes with sole B

Sole B falls within the scope of protection of granted EP-H in all validated states. Germany is a contracting state to the London agreement and has an official language in common with the EPO. No translation of EP-H needs to be supplied in Germany. EP-H is therefore currently in force in Germany. Austria is not a contracting state to the London agreement. For Austria, a translation of EP-H into German needs to be supplied within 3 months of grant, i.e. by 16 April 2019.

In Austria, sole B also falls within the scope of protection of AT-H.

In Austria and Germany, HIKE is free to produce and sell shoes with sole B. In Austria, HIKE can prevent FASTER from selling or producing shoes with sole B via AT-H and via EP-H, provided EP-H is validated in Austria. In Germany, HIKE can prevent FASTER from producing and selling shoes with sole B via EP-H.

3. How can you improve the situation for FASTER?

Sole B: "opposition against EP-H"

EP-H was filed in Chinese and translated into English. For EP-H, the Chinese text constitutes the application as filed. The English claim of EP-H is directed to "nanometers", and therefore extends beyond the content of the application EP-H as filed, disclosing "micrometers".

The mention of the grant of EP-H was published on 16 January 2019. The period for filing an opposition against EP-H runs until 16 October 2019 (Wednesday). File an opposition against EP-H within that period based on the ground for opposition of added subject-matter (under Art.100(c) EPC).

EP-H will not be maintained in opposition with a claim directed to nanoparticles. Thereafter, sole B will no longer be protected outside Austria.

Sole B: adding priority claim to EP-F2

EP-F3 is the first filing of a shoe sole with metal nanoparticles in the range of from 35 to 80 nm as far as it is not covered by EP-F1. EP-F3 and EP-F2 were filed by the same applicant, the filing dates of EP-F3 and EP-F2 lie within a period of 12 months.

A priority claim to EP-F3 can be added to EP-F2 within 16 months from the earliest priority date claimed, i.e. 19 January 2018 + 16M = 19 May 2019 (Sunday), carried on to 20 May 2019 (Monday).

Thereafter, the part of the claims of EP-F2 directed to “metal nanoparticles from 35 to 80 nm”, as far as it is not covered by EP-F1, has the filing date of EP-F3 as relevant date.

For that part, announcement B does not belong to the state of the art any longer since the filing date of EP-F3 lies before the publication date of announcement B and EP-H only belongs to the state of the art under Art. 54(3) EPC.

The Chinese text of EP-H is “the application as filed” for establishing the content of the prior right. It only discloses “micrometers”. Therefore, claims 1 and 2 of EP-F2 are novel. Claim 3 still lacks novelty over announcement B, since EP-F3 does not disclose copper nanoparticles.

For metal nanoparticles above 80 nm, the effective date of claim 1 of EP-F2 is the filing date. Claim 1 of EP-F2 still does not involve an inventive step over announcement B, and should be deleted.

Claim 2 of EP-F2 involves an inventive step over announcement B, because there is no indication in announcement B to use a metal other than copper, or a particle size of less than 35 nm.

Due to the lack of novelty over announcement B, claim 3 of EP-F2 should be amended and be restricted to copper nanoparticles up to 40 nm, which has priority from EP-F1.

After addition of the priority claim to EP-F3, consider quickly obtaining (provisional) protection, because a shoe with sole B falls within the scope of protection of claim 2 of EP-F2. FASTER will then be able to stop HIKE from manufacturing in Austria or selling in Germany and/or Austria shoes with sole B based on the patent originating from EP-F2.

Sole A: filing EP-NEW

Announcement A may be regarded an evident abuse in relation to Ms Fast. The evident abuse will be accepted by the EPO. The written statement of Mr Furious is a proof. File a new European patent application EP-NEW directed to a shoe sole comprising silica nanoparticles from 35 to 45 nm (Sole A). EP-NEW could be filed within six months from the abusive disclosure. There is still time, however, your intended sale of shoes with Sole A starting in April 2019 will generate prior art. EP-NEW must therefore be filed at the latest on the first day of sale. The claim of EP-NEW will be novel and inventive, as there is no relevant prior art.

FASTER will then be able to stop HIKE from manufacturing or selling shoes with sole A, based on the patent originating from EP-NEW (amongst others in Germany and Austria). Therefore, consider quickly obtaining (provisional) protection.

Licensing

A cross-license (at least for AT) should be negotiated taking into account AT-H, EP-F2 and EP-NEW.

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

Category		Max. possible	Marks	
			Marker 1	Marker 2
Part I	Part I - Question 1	9		
Part I	Part I - Question 2	7		
Part I	Part I - Question 3	9		
Part I	Part I - Question 4	7		
Part I	Part I - Question 5	8		
Part II	Part II - Question 1a	17		
Part II	Part II - Question 1b	2		
Part II	Part II - Question 1c	2		
Part II	Part II - Question 2a	4		
Part II	Part II - Question 2b	8		
Part II	Part II - Question 3	27		
Total				