

## **Examiners' Report – Paper D 2022**

### **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, one being correct and one being wrong, for the markers to choose from do not attract any marks.

In part I, full marks are only rewarded when the full legal basis was cited to support the analysis; candidates lost many marks due to 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. However, alternative relevant legal basis not mentioned in the model 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, also the explanation is provided in view of the situation in the question.

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

## **Examiners' Report – Paper D 2022, Part I**

### **Question 1 (8 marks):**

Most of the candidates realized that the time limit to reply to the communication under Article 94(3) EPC and the time limit for applying for further processing already expired and a request for re-establishment of rights in respect of the time limit for further processing has to be made to further prosecute the application.

Few candidates recognized the need to pay the renewal fees for the 5<sup>th</sup> and 6<sup>th</sup> year that became due on the date of notification of the decision re-establishing the rights and that the provisions of Rule 51(4)a) EPC applied.

### **Question 2 (10 marks):**

Most of the candidates proposed requesting a correction of the spelling mistake. Fewer realized that a request for correction under Rule 139 EPC triggers the procedure under Rule 71(6) EPC.

Some of the candidates still requested to waive the right to receive a further communication under Rule 71(3) EPC (waiver option) without expressing the applicant's agreement to the text to be granted. However, the EPO does not process these waivers any more.

Some candidates suggested to approve the text as proposed for grant with the first communication under Rule 71(3) EPC and thereafter to request the correction of the spelling mistake while EP-B is still pending. This approach would lead to a further delay of the conclusion of the grant procedure of EP-B contrary to the wish of the applicant.

Full points were also attributed to candidates who suggested expressing the applicant's agreement to the text to be granted immediately after receiving the second communication under Rule 71(3) EPC, if the translations of the corrected claims and the fee for grant and publishing had already been filed and paid respectively in reply to the first communication under Rule 71(3) EPC.

Many candidates overlooked paying the renewal fee for the fourth year.

The necessary steps to be taken to have the European patent application take effect in the Netherlands were less well answered.

### **Question 3 (8 marks):**

This question was generally well answered. Most of the candidates realized that no supplementary international search report can be established for C2, as its basis is the set of claims as filed, and that C2 can be the subject of a supplementary European search and can be examined under the provision of Rule 164(2) EPC.

### **Question 4 (6 marks):**

Several candidates came to the right conclusion that EP-D3 was not entitled to the priority date of EP-D2. However, many of them did not realize and/or provide the correct legal basis why the disclosure of EP-D2 does not enable the skilled person to carry out the method for producing product D2 starting from raw material D1. Even fewer candidates explicitly stated that D2 is sufficiently disclosed in EP-D4.

### **Question 5 (5 marks):**

Due to different publication dates for the article given in the English, German and French versions of the paper, the Examination Board decided to award full marks to all candidates for question 5.

### **Question 6 (8 marks):**

Many candidates realized the asymmetry between opposition and appeal proceedings in relation to the continuation of the opposition proceedings ex officio. However, few candidates realized that the opposition and appeal proceedings are not pending any more in situation 2, and that limitation is possible under Article 105a(2) EPC to address the lack of novelty in view of D1.

Likewise, few candidates realized that the withdrawal of the opposition by the sole opponent-appellant is interpreted as withdrawal of the appeal, and that the correct legal basis for this conclusion is G8/93.

## Possible Solution – Paper D 2022, Part I

References to the legal basis refer to the situation on 31 October 2021

### Answer to Question 1 (8 marks):

The time limit to apply for further processing under Article 121(1) and Rule 135(1) EPC already expired on 4 March +10 days (Rule 126(2) EPC) + 2 months (Rule 135(1) EPC) = 14 May 2021 (Fri). Thus, EP-F is deemed to be withdrawn, Article 94(4) EPC.

It is possible to request re-establishment of rights in respect of the time limit for further processing, Article 122(1) EPC and Rule 136(3) EPC. The request has to be filed within two months of the removal of the cause of non-compliance, Rule 136(1) EPC, i.e. two months after 3 February 2022, i.e. at the latest on 3 April 2022 (Sun), extended to 4 April 2022 (Mon), Rule 134(1) EPC. This is still within the one year period from 14 May 2021. Thus the request has to be filed at the latest on 4 April 2022.

In addition to filing the request for re-establishment of rights, applicant F has to pay the prescribed fee, Rule 136(1) EPC, state the grounds and facts on which the request is based or state that all due care was observed, Rule 136(2) EPC, and has to complete the omitted acts by requesting further processing under Article 121(1) and Rule 135(1) EPC by paying the prescribed fee and replying to the communication under Article 94(3) EPC.

The time limit for replying to the communication under Article 94(3) EPC expired on 11 January 2021 (Mon).

Two renewal fees (in respect of the 5<sup>th</sup> and the 6<sup>th</sup> year) were due on 31 January 2021 and 31 January 2022, respectively, Article 86(1) and Rule 51(1) EPC. This is after a loss of right.

Therefore the renewal fees are due on the date of the notification of the decision re-establishing the rights. The renewal fees can still be paid within 4 months of the notification of the decision, Rule 51(4)(a) EPC, without an additional fee, or within 6 months of the decision with an additional fee, Rule 51(4)(a) and 51(2) EPC.

### Answer to Question 2 (10 marks):

The communication issued by the EPO on 12 November 2021 was a communication under Rule 71(3) EPC. The following acts need to be carried out by 22 March 2022 (Tue) (12 November 2021 + 10 days (Rule 126(2) EPC) + 4 months (Rule 71(3) EPC) = 22 March 2022):

File a request to correct the spelling mistake in one of the claims and additionally file a reasoned statement, why the correction satisfies the requirement of Rule 139 EPC, Guidelines C-V, 4.3; request PACE and reply as soon as possible to the second communication under Rule 71(3) EPC, *OJ 2015, A93, C.15*; immediately after receiving the second communication under Rule 71(3) EPC according to Rule 71(6) EPC, pay the fee for grant and publishing and file a translation of claims 1-16 in German and French, Rule 71(3) EPC; pay one claim fee for claim 16, Rule 71(4) EPC, before or immediately after receiving the second communication under Rule 71(3) EPC; pay the renewal fee for the fourth year with an additional fee of 50% of the renewal fee for the fourth year, Rule 51(2) EPC, within 6 months of the due date, i.e. until 31 August 2022: 28 February 2022 (last day of Feb) + 6 months (Rule 51(2) EPC, J4/91) = 31 August 2022 (Wed). Only after all of the fees are paid, the decision to grant the European patent is issued, Rule 71a(1) EPC, and the mention of the grant of the European patent is published.

To have the European patent based on EP-B take effect in the Netherlands, file a translation only of the claims in Dutch, Article 1(2) and Article 1(3) of the London Agreement, and pay the special fee, National Law relating to the EPC, IV., column 5 for NL, under Article 65(2) EPC. Both actions need to be performed within 3 months from the date on which the mention of the grant is published in the European Patent Bulletin, Article 65(1) and National Law relating to the EPC, IV., columns 4 and 5 for NL.

### Answer to Question 3 (8 marks):

1.(a): The supplementary international search report, SISR, may be requested within 22 months from the filing date, Rule 45bis.1(a) PCT, i.e. until 28 March 2022 (26 May 2020 (Thu) + 22 months (Rule

45bis.1(a) PCT) = 26 March 2022 (Sat) extended to 28 March 2022 (Mon) (Rule 80.5 PCT)). The request shall be filed at the International Bureau, Rule 45bis.1(b) PCT.

Both the supplementary search handling fee, Rule 45bis.2(a) PCT, and the supplementary search fee, Rule 45bis.3(a) PCT, are to be paid to the International Bureau, Rule 45bis.2(c) PCT and Rule 45bis.3(b) PCT, within one month of the date of the receipt of the supplementary search request, Rule 45bis.2(c) PCT and Rule 45bis.3(c) PCT.

- 1.(b): No SISR can be established for C2, as the basis for the SISR is the set of claims as filed, Rule 45bis.5(b) PCT.
2. Since the EPO drew up the SISR, no supplementary European search report will be established, Article 153(7) EPC and Guidelines B-II, 4.3.1. However C may and must amend the claims so as to claim C2, upon entry into European phase or in response to a communication under to Rule 161(1) EPC. The EPO will issue an invitation to pay an additional fee pursuant to Rule 164(2)(a) EPC. Provided C pays the additional fee, C2 can be searched and examined pursuant to Rule 164(2) EPC.

**Answer to Question 4 (6 marks):**

- (a) EP-D1 was not made available to the public before or on the publication date of EP-D2, because EP-D1 was withdrawn in due time before its publication, Rule 67(2) EPC. Therefore, the relevant content of EP-D1, i.e. the method for obtaining raw material D1, is not to be considered as forming part of the content of EP-D2 for the disclosure of the invention, Guidelines F-III, 8 in combination with H-IV, 2.2.1. The disclosure of EP-D2 does not enable the skilled person to carry out the method for producing product D2 starting from raw material D1. Therefore, EP-D2 does not sufficiently disclose product D2, Article 83 EPC.
- (b) EP-D3 is not entitled to the priority date of EP-D2, because EP-D2 does not sufficiently disclose product D2, Case Law II.D.3.1.6, because an essential element (i.e. the method for obtaining D2 starting from D1) is neither expressly disclosed nor directly and unambiguously implied in EP-D2, as it is not part of the content of EP-D2. EP-D4 and EP-D3 are sufficiently disclosed, because EP-D4 and EP-D3 describe a method for producing D2 from D3 and D3 was part of the state of the art for EP-D4 and EP-D3. EP-D4 is filed before EP-D3 but published after and is prior art pursuant to Article 54(3) EPC. Therefore the subject-matter of the claim of EP-D3 is not novel in view of EP-D4.

**Answer to Question 5 (5 marks)**

*(The following possible answer applies only for the German and French versions of the question, whereas the English version should be read as if the article was published in December 2019):*

EP-E was filed within the priority period, which was extended from 30 May 2020 (Sat) through 1 June 2020 (Whit Monday) to 2 June 2020 (Tue) and the EPO's filing offices in Germany were closed from 30 May to 1 June 2020,

Rule 134(1) EPC. Hence, the effective date for the composition comprising E1 in the range [10-20%] is the filing date of the priority document JP-E and the effective date for E1 being within [5-10%[ or ]20-40%] is the filing date of EP-E, G1/15. The skilled person can see at once that the disclosure of the article contains errors, i.e. a composition comprising 40% of E1, and can identify what the only possible correction should be, i.e. a composition comprising 15% of E1. Hence, the article can be considered to contain the correction when assessing its relevance to patentability, i.e. it discloses a composition comprising 15% of E1, Guidelines G-IV, 9.

The article forms prior art under Article 54(2) EPC only for the subject-matter not entitled to priority, G3/93, i.e. the composition comprising E1 in the range [5-10%[ or ]20-40%].

Therefore the article is not novelty destroying, because it discloses an embodiment of a composition comprising 15% of E1, which falls within the range [10-20%] of E1, being entitled to the right of priority.

**Answer to Question 6 (8 marks):**

Situation 1:

- (a) The opposition division will continue the proceedings of its own motion, Article 114(1) EPC and Rule 84(2) EPC, when the opposition is withdrawn, because the stage reached in the opposition

proceedings is as in Guidelines D-VII, 5.3 and 5.2. Namely, the proceedings are likely to result in a limitation or revocation of EP-A without further assistance of the opponent and without the opposition division itself having to undertake extensive investigations in view of document D1 being prior art according to Article 54(3) EPC and being novelty destroying for claim 1. The opposition division will inform the patent proprietor that the opposition proceedings are continued, Guidelines-D-VII, 5.2.

- (b) Because the opposition is still pending, the proprietor should file an amendment limiting the claims to claim 2 only, which is occasioned by the ground of opposition under Article 100a EPC, Rule 80 EPC. Hence, EP-A will be maintained as amended, Article 101(3)(a) EPC.

Situation 2:

- (c) The opponent is the sole appellant. If an opposition is withdrawn by the sole opponent-appellant during appeal proceedings, the withdrawal of the opposition is interpreted as withdrawal of the appeal, G8/93. The withdrawal of the appeal terminates the appeal proceedings, and the first instance decision becomes final.
- (d) The opposition / appeal proceedings are not pending anymore and therefore limitation is possible, Article 105a(2) EPC and Rule 93(1) EPC. In order to address the lack of novelty in view of D1, the patent proprietor should request limitation by performing the acts according to Article 105a(1) EPC and Rule 92 EPC, in particular submit amended claims limited to claim 2, Rule 92(2)(d) EPC, and pay the fee for limitation, Article 105a(1) EPC.

## **Examiners' Report – Paper D 2022, Part II**

Question 1 was in general well answered and the priority issues well analyzed.

Much to the Examiner's delight, most of the candidates did follow in their response the scheme for the questions as it had been asked. Only some candidates instead of discussing the patent situation by subject matter followed an approach by patent application thus losing some marks because of incomplete analysis. It was often not detected that OPT-EP1 is a prior art document (for novelty only) to subsequent filings OPT-EP2 and OPT-PCT. The same occurred with reference to OPT-EP2 being an Art. 54(3) document for OPT-PCT.

Concerning the appeal many candidates recognized the impossibility of introducing a fresh ground by Avidus without Torre's consent. Some candidates wrongly suggested filing third party observations. The question about the German lawyer acting as strawman was correctly answered by almost all the candidates. Similarly, almost all the candidates correctly advised against discussing CLEAN process with the Opposition Division, but very few recognized that OPT-EP1 does not disclose the cleaning effect and that it cannot therefore be used to argue inventive step.

Few candidates realized the urgency of acting asap with entitlement proceedings before TOR-EP could be granted and that renewal fees must be paid while proceedings are stayed. Too many candidates wrongly advised to intervene in pending appeal proceedings solely on the basis of Torre's cease and desist letter, without mentioning that it was necessary to institute proceedings before an Italian Court. The three-months time limit for intervention was seldom mentioned.

Most of the candidates noticed that OPT-2 does not claim the FEED + SPRAY combination, but only a minority realized that the combination could not be claimed as it was a not searched subject matter. Very few candidates suggested abandoning OPT-2 and prosecuting with OPT-PCT for the combination FEED + SPRAY.

Question 4 was generally well answered even though some candidates' answer was a generic FTO rather than the required response.

## Possible Solution – Paper D 2022, Part II

### Question 1

#### (a) the FEED machine with a feeding duct at the bottom of the mill.

TOR-EP is first filing for a FEED machine comprising at least one duct for feeding filler at the bottom of the mill (FEED-1). TOR-EP is novel and inventive because no pertinent prior art is cited and a greater amount of filler can be fed to the mill. TOR-EP is likely to be granted because a 71(3) communication was sent.

TOR-EP is (presently) an Art. 54(3) document for OPT EP-2 and OPT-PCT applications that have a claim to at least one feeding duct, if OPT-PCT enters the EP phase. Such a claim is not novel over TOR-EP.

Filing of TOR-EP is a violation of the secrecy agreement and thus the publication of TOR-EP is an evident abuse. The date of filing of TOR-EP is no earlier than six months preceding filing of OPT-EP1, therefore TOR-EP is a non prejudicial disclosure for OPT-EP1.

OPT are the rightful owners of the invention disclosed and claimed in TOR-EP.

OPT-PCT does not enjoy priority from OPT-EP2 for the subject matter of FEED-1, because OPT-EP2 is not the first application from the same applicant for those features. OPT-EP1 and OPT-EP2 would both be Art. 54(3) prior art for OPT-PCT should the latter enter EP phase. OPT-PCT would not be novel in Europe.

The video is a prior art under Art. 54(2) for all of OPT-EP1, OPT EP-2 and OPT-PCT; in OPT applications the claims directed to a Feed machine comprising one duct are not novel.

#### (b) the FEED machine with two feeding ducts at the bottom of the mill.

OPT-EP1 is first filing for a FEED machine comprising two ducts for feeding filler at the bottom of the mill (FEED-2). The video and TOR-EP disclose one single duct, therefore claim 2 in OPT-EP1 is novel. Claim 2 is inventive because of the surprising effect in greater uniformity of the recycled plastic.

OPT-EP1 is prior art under Art 54(3) and novelty destroying for the same subject matter in OPT-EP2.

OPT-PCT does not enjoy priority from OPT-EP2 for subject matter of FEED-2 because EP2 is not the first application from same applicant for those features. OPT-EP1 and OPT-EP2 would be Art. 54(3) prior art for OPT-PCT, if the latter enters EP phase; OPT-PCT would not be novel in Europe. OPT-PCT can lead to protection in non-European countries once OPT-PCT enters a national phase.

#### (c) the CLEAN feeding process.

There is no prior art and there is a technical effect: clean process is novel and inventive. There is presently no patent application claiming CLEAN process.

#### (d) the SPRAY water spray device.

TOR-EP-old is first filing for SPRAY. The disclosure at the fair in Barcelona is 54(2) prior art. The claim to a water spray device in TOR-EP-old is not novel. The opposition by Avidus was based on insufficient disclosure only. Novelty attack based on prior use in Barcelona would be a fresh ground of opposition.

Avidus cannot introduce a fresh ground in Appeal proceedings without the consent of the Patentee. The appeal is still pending, if the patent is maintained, OPT will be restricted from making or using SPRAY.

The claim in OPT-PCT to SPRAY is not novel over any of TOR-EP-old and the Barcelona fair.

OPT-EP2 discloses but does not claim SPRAY.

#### (e) the FEED machine with the SPRAY water spray device.

OPT-EP2 is first filing for FEED + SPRAY.

OPT-PCT validly claims priority of OPT-EP2 for FEED + SPRAY. Only OPT-PCT claims the combination of FEED+SPRAY.

Currently, there is no patent protection available.

There is no prior art for the combination, FEED + SPRAY is novel and also inventive because the dust is reduced without affecting the properties of the recycled plastic.



## Question 2

Any person, including a German lawyer having no interest in the case, can file an opposition.

The four-months period for responding expires on 13 April 2022.

Claim 1 of OPT-EP1, directed to FEED-1, is not novel in view of the publicly available video of OPT. A claim directed to FEED-2 is novel. In the response argue that FEED-2 is inventive using the surprising effect on uniformity of recycled plastic and file a request with main claim limited to a mill with two feeding ducts. If you discuss your new invention CLEAN in your response, the reply letter would be available to the public through file inspection. Any later filed application for CLEAN would therefore not be novel over the disclosure in the reply letter. Also, the cleaning of the blades is a new technical effect not disclosed in or derivable from the opposed patent, as such it cannot be used to support inventive step in the opposed patent.

## Question 3

### (a) FEED-1

The rights to TOR-EP are of OPT in view of the 2018 agreement with TOR. Institute entitlement proceedings in Italy to have TOR-EP assigned to OPT. Then notify the EPO of the pending entitlement proceedings and provide evidence of the same before patent is granted. The EPO will stay the proceedings of the application. Make sure that renewal fees are paid during stay of proceedings. Once TOR-EP is assigned to OPT, prosecute the application.

### (b) FEED-2

Delete claims to two ducts in OPT-PCT, not novel over OPT-EP1. When entering EP phase maintain claims to two ducts in OPT-PCT outside EP.

### (c) CLEAN

File the CLEAN application before discussing it with Avidus.

### (d) SPRAY

Intervention is necessary for introducing the fresh ground of lack of novelty into appeal proceedings. For intervention national proceedings are required: institute national proceedings before a Court in Italy for a ruling of non infringement. Within three months from start of proceedings, pay opposition fee, file notice of intervention based on lack of novelty over disclosure at Barcelona Fair. TOR-EP-old will be revoked. Make sure Avidus does not withdraw its appeal otherwise the appeal proceedings are terminated. Delete claims to SPRAY in OPT-PCT when entering national phases.

### (e) FEED + SPRAY

Claims directed to a combination of machine and water spray device in OPT-EP2 are unsearched subject matter, not unitary with the original claims. Prosecution of the combination of Feed machine and spray device based on OPT-EP2 would only be possible if a divisional is filed.

The combination is already covered by OPT-PCT; therefore abandon OPT-EP2 and enter EP phase of OPT-PCT by 04.05.22, with amended claims directed to combination of spray device and Feed machine.

OPT-PCT outside Europe should have claims to FEED-2 and to the combination of Feed machine and spray device. Enter timely OPT-PCT in USA, China and India. The 30-months time limit expires on 04.04.22.

## Question 4

After TOR-EP is assigned to OPT and granted, OPT could stop Torre in EPO Countries from making or using a Feed machine with at least one feeding duct, thus also a Feed machine with two feeding ducts.

After maintaining OPT-EP1 in amended form, OPT could stop Torre in EPO countries with OPT-EP1, from making or using FEED-2.

OPT could stop Torre in view of OPT-PCT in non-EPO countries where OPT-PCT enters the national phase from making or using FEED-2.

With OPT-EP1 or OPT-PCT OPT could stop Torre from carrying out the CLEAN process because to carry out CLEAN a Feed mill with two ducts is required.

After filing the application for CLEAN process OPT could stop Torre from using the process in the Countries covered by the CLEAN application.

OPT can stop Torre from making and using a Feed machine with Spray device in those countries where OPT-PCT enters the national phase.

| D1-1       | Max | Awarded (Marker 1) | Awarded (Marker 2) |
|------------|-----|--------------------|--------------------|
| Question 1 | 8   |                    |                    |
| Question 2 | 10  |                    |                    |
| Question 3 | 8   |                    |                    |
| Total      | 26  |                    |                    |

| D1-2       | Max | Awarded (Marker 1) | Awarded (Marker 2) |
|------------|-----|--------------------|--------------------|
| Question 4 | 6   |                    |                    |
| Question 5 | 5   |                    |                    |
| Question 6 | 8   |                    |                    |
| Total      | 19  |                    |                    |

| D2         | Max | Awarded (Marker 1) | Awarded (Marker 2) |
|------------|-----|--------------------|--------------------|
| Question 1 | 22  |                    |                    |
| Question 2 | 9   |                    |                    |
| Question 3 | 19  |                    |                    |
| Question 4 | 5   |                    |                    |
| Total      | 55  |                    |                    |