

Examiners' Report Paper D 2014

General Comments

This year was the second year where the candidates had the flexibility to manage the distribution of their time between part I and part II. It was once again observed that some candidates had difficulties with time management.

Many candidates this year used in their answers an outdated version of the legal provisions. Candidates are reminded that, according to the Implementing Provisions to the Regulation on the European Qualifying Examination, the examination syllabus covers the legal texts which are in force on 31 December of the year prior to the examination.

Candidates are also reminded that they should not write their name or initials on any of the sheets of EQE lined paper nor should they use their name or initials in their answers.

Simply reciting the question does not gain any marks.

A complete answer requires an analysis and a conclusion.

Examiners' Report Paper D - Part I

Question 1 (6 marks)

Many candidates recognised that Ms Mele should bring proceedings against Mr Baum before a German court. However, candidates did not state that because the new application to be filed under Article 61(1)(b) EPC is deemed to have the date of filing of EP1, the scientific publication is not prior art. Most candidates did not provide a sufficient legal basis for why protection can be obtained in all contracting states.

Question 2 (7 marks)

Many candidates correctly analysed the validity of the priority for subject-matter A and A+B. However, far fewer candidates reached the conclusion that the priority of IT1 is to be added in order to establish an effective date for subject-matter A before the symposium. Some of those who did suggest adding the priority of IT1 wrongly cited Rule 52(3) EPC instead of Rule 52(2) EPC.

Surprisingly, some candidates considered national application IT1 to be prior art under Article 54(3) EPC.

Question 3 (8 marks)

Most candidates correctly applied Rule 70(1) EPC to calculate the time limit for paying the examination fee. Only some candidates pointed out that this time limit is suspended. Few candidates correctly calculated the part of the period still to elapse.

Question 4 (7 marks)

Not all candidates are familiar with the Rules of the PCT governing representation before the EPO as receiving Office.

Question 5 (6 marks)

This question was very well answered. A few candidates lost marks because they either did not calculate the time limits for filing the notice of appeal and the grounds for appeal, or did not realise that the decision is deemed notified on the 10th day after posting.

Question 6 (6 marks)

Although many candidates cited OJ 2009, 338, few candidates correctly determined the number of pages on the basis of which the additional fee will be calculated.

Although 5 May 2014 was a closing day for the EPO branch in The Hague, this was not indicated in the calendar given to the candidates. Candidates extending to 6 May were not penalized.

Surprisingly some candidates wrongly considered that the filing fee could be paid 1 month after expiry of the time limit according to Rule 159(1) EPC.

Examiners' Report Paper D 2014 - Part II

The second part of the D paper requires candidates to analyse a situation concerning various existing patent rights and suggest specific actions that are usually to be carried out within a time limit. Care should be taken to correctly calculate the time limits.

This year the main aspects of the paper were:

- Claim 1 of EPCZ1 is patentable; it has two effective dates, one for compositions comprising A and another one for compositions comprising B, C or D.
- EPFR3 confers protection to the direct product of the process, i.e. to Z, but not to A which is substantially different from Z.
- A patent may be obtained on the basis of PCTCZ2 because GD has not been notified about the loss of rights and therefore further processing is still available.
- Although CLC has a stronger position because of EPFR1, the position of GD may be improved by offering CLC a licensing or a transfer of the rights of PCTCZ2.

Regarding the specific questions:

Question 1 (33 marks)

The vast majority of candidates realised that in claim 1 of EPCZ1 compositions comprising B, C or D do not enjoy the priority of CZ1. Nevertheless, many either did not realise or did not explicitly state that claim 1 has two effective dates. Many candidates did not recognise that claim 1 of EPCZ1 is novel over EPFR2 and that no amendment is required, provided that the priority right is maintained.

A surprisingly large number of candidates referred to the version of Rule 53 EPC valid prior to 1 April 2013, which does not apply in the present case, and consequently provided the wrong time limit for filing the translation of the previous application.

Some candidates mentioned that a claim is novel and/or inventive without referring to the relevant piece of prior art and/or without providing any explanation to this effect.

Question 2 (9 marks)

Most candidates correctly stated that the protection conferred by EPFR3 extends to the direct product of the process. However, fewer specified that this direct product is Z.

Only a minority stated that A is substantially different from Z due to the fact that A is produced from Z by a multistep process and/or A exhibits different properties than Z. This means that A cannot be considered as the direct product of the process of EPFR3 and importation of A into Europe would not constitute infringement of this patent.

Some candidates mentioned that A is different from Z without providing any explanation. This led to candidates not earning all the available marks.

Question 3 (9 marks)

The majority of candidates realised that the entry of PCTCZ2 into the European phase is still possible because GD has not yet been notified about the loss of rights. However, some candidates erroneously thought that in the present case the time limit for the entry into the European phase could be changed by withdrawing the priority claim.

Some candidates either did not spot the possibility of further processing or wrongly calculated the respective time limit. Re-establishment of rights was not an option.

Question 4 (9 marks)

Most candidates recognised that GD could not commercialise any of its products without a license from CLC, due to EPFR1.

Most candidates also correctly mentioned that the product of EPFR2 could not be commercialised by CLC without a license from GD, due to EPCZ1.

Only a few candidates stated that EPFR2 would not present a problem to GD, since the products that it intends to commercialise do not contain W.

Many candidates indicated the possibility of a cross-licensing agreement; however, not all explained the motivation and the respective rights involved.

A number of candidates correctly stated that the negotiating position of GD might be improved by offering CLC a license or a transfer of rights arising from PCTCZ2 with respect to Europe.

Possible solution - Paper D 2014 - Part I

Answer to question 1

a) Mr Baum has his residence in Germany. Therefore, according to Article 2 of the Protocol on Recognition, proceedings must be brought against him in a German court.

Since EP1 has not been granted, in accordance with Rule 16(1)(b) EPC, Ms Mele may avail herself of the remedies under Article 61(1) EPC. Because EP1 is no longer pending, Ms Mele should file a new application under Article 61(1)(b) EPC. According to G3/92, EP1 does not have to be pending for a new application to be filed.

The new application should be filed no later than three months after the decision recognising that Ms Mele is entitled has become final, Rule 16(1)(a) EPC.

Article 76(1) EPC applies mutatis mutandis to the new application, Article 61(2) EPC. Therefore, the new application shall be deemed to have been filed on the date of filing of EP1 in January 2013. This precedes the publication of the scientific article in July 2013. Hence, this publication will not be prior art under Article 54(2) EPC for subject-matter A.

For the new application, the filing fee and search fee are to be paid within 1 month of filing, Rule 17(2) EPC.

Thus, Ms Mele can obtain patent protection for subject-matter A.

b) According to Article 9 of the Protocol on Recognition, final decisions given in any Contracting State on the right to the grant of a European patent, shall be recognised in the other Contracting States. Therefore, the final decision of the German court shall be recognised in the other Contracting States.

In accordance with Article 79(1) EPC, all the Contracting States were deemed to be designated in EP1. Therefore, the new application can be filed for all Contracting States, Rule 16(2) EPC.

Answer to question 2

EP1 was filed within 12 months of the date of filing of IT2, Article 87(1) EPC.

IT1 is the first application which discloses subject-matter A and it had not been withdrawn at the date of filing of IT2. Therefore, in accordance with Article 87(4) EPC, IT2 is not considered as the first application for the purpose of determining priority for subject-matter A. However, IT2 is the first application within the meaning of Article 87(1) EPC for subject-matter A+B. Therefore the priority claimed in EP1 is not valid for subject-matter A (i.e. claim 1), but valid for subject-matter A+B (i.e. claim 2).

Thus, the disclosure at the symposium will be prior art under Article 54(2) EPC for subject-matter A. Subject-matter A lacks novelty with respect to said disclosure.

The applicant should file a request to add the priority claim to IT1, Rule 52(2) EPC.

EP-1 was filed on 3 December 2013, i.e. within 12 months of the date of filing of IT1. Thus, priority of IT1 can be claimed, even though IT1 has been withdrawn, Article 87(3) EPC.

Once the claim to priority to IT1 has been added, the symposium will no longer be prior art under Article 54(2) EPC.

Thus, EP1 can be granted provided that applicant X files a request to add a priority claim to IT1 at the latest on 3 April 2014, i.e. 16 months from the earliest priority date, Rule 52(2) EPC.

Answer to question 3

Form 1001 contains the written statement for requesting examination. However, the request for examination shall not be deemed to be filed until the examination fee has been paid, Article 94(1) EPC. The applicant may request examination up to 6 months after the date on which the European Patent Bulletin mentions the publication of the European search report, i.e. until 21 February 2014, Rule 70(1) EPC.

According to J7/83 or Guidelines E-VII,1.4, when proceedings are interrupted the time limit for paying the fee for examination is suspended. On the day on which the proceedings are resumed, the period resumes for the part still to elapse, or for at least the two months prescribed by Rule 142(4), second sentence.

The last day of the part of the period which has already elapsed is 19 November 2013. Thus the part of the period still to elapse ran from 20 November 2013 until 21 February 2014, i.e. for 3 months and 1 day. This is more than two months, therefore the period resumes for 3 months and 1 day.

The time which has not yet elapsed begins to run as from the date on which proceedings are resumed, J7/83. Thus, the applicant has 3 months and 1 day, starting on 20 January 2014, i.e. until Sunday 20 April 2014, to pay the examination fee. Since the EPO is closed on Easter Monday, 21 April 2014, this period is extended until Tuesday 22 April 2014, Rule 134(1) EPC.

Answer to question 4

a) According to Rule 4.15 PCT the request is to be signed by the applicant. The signature of the agent on the request has the effect of the signature by the applicant himself, Rule 90.3(a) PCT.

The EPO as receiving Office has waived the requirement under R. 90.4(b) PCT that a separate power of attorney is to be submitted, see Rule 90.4(d) PCT and Notice from the EPO OJ 2010, 335. Since a separate power of attorney is not required, the missing signature on the power of attorney does not constitute a defect.

b) The notice of withdrawal is to be addressed to the International Bureau or the EPO as receiving Office, see Rule 90bis.1(b) PCT.

Either the applicant signs the notice of withdrawal, Rule 90bis.5(a) PCT, or it is signed by the agent. In the latter case, a separate power of attorney signed by the applicant must be filed because the waiver under Rule 90.4(d) PCT does not apply to withdrawals, see Rule 90.4(e) PCT.

Answer to question 5

a) According to Article 108 EPC, the notice of appeal must be filed within 2 months of notification of the decision. The decision is deemed to be notified 10 days after posting, i.e. 16 August 2013, Rule 126(2) EPC. Thus, the notice of appeal must be filed by 16 October 2013. The notice is not deemed to have been filed until the fee has been paid, Article 108 EPC. It was paid on 4 October 2013. Therefore, the appeal was filed on time.

The statement of grounds must be filed within 4 months of notification of the decision, i.e. by 16 December 2013, Article 108 EPC. Thus, the statement of grounds was filed on time.

Thus the appeal is admissible.

b) As previously indicated by the examining division, the new single claim meets the requirements of the EPC. Therefore, the amendment overcomes the objections given in the decision and renders the appeal well founded, see Guidelines E-X- 7.1 iii or T 139/87. As the appeal is admissible and well founded, the examining division will rectify its decision in accordance to Article 109(1) EPC.

As there was no substantial procedural violation, the fee will not be reimbursed, Rule 103(1)(a) EPC.

Answer to question 6

a) Because the documents for entry into the European phase are not filed online, the filing fee is 200 EUR, see Article 2(1)1 EPC Rules relating to Fees. The additional fee specified by Rule 38(2) EPC and Article 2(1)1a Rules relating to Fees is 14 EUR for the 36th and each subsequent page.

According to the Notice supplementing the notice from the EPO dated 26 January 2009 concerning the 2009 fee structure, OJ 2009, 338, if an amended set of claims is filed, the additional fee will be calculated on the basis of the number of pages of the description belonging to the international application as published by WIPO and the replacement pages containing the amended set of claims in English as the language of proceedings. Thus, the fee is calculated on the basis of 40 pages of description of the publication of PCT-CN, 3 pages of amended claims in English and 1 page for the abstract, see Notice and also Notice from the EPO dated 26 January 2009, OJ 2009, 122. Therefore an additional fee for 9 pages, i.e. 126 EUR, has to be paid. The total fee to be paid is 326 EUR.

b) According to Rule 159 (1)(c) EPC the filing fee has to be paid within 31 months from the date of filing. The 31-month period ends on Sunday, 4 May 2014. Since periods for payments are also extended, Guidelines A-X, 6.1 or J 1/81, the period for paying the fee is extended to 5 May 2014, Rule 134(1) EPC.

Possible solution - Paper D 2014 - Part II

Question 1

EPFR1/FR1

FR1 is the first application for cream compositions of a compound of family K and X. EPFR1 was filed within the priority year and belongs to the same applicant as FR1. EPFR1 is directed to the same invention (filed by reference) as FR1. Therefore, the priority claim is valid.

There is no relevant prior art for EPFR1. Therefore, there is no reason to doubt the validity of EPFR1.

EPCZ1/CZ1

CZ1 is the first application for cream compositions containing A, X and Y. EPCZ1 was filed well within the priority year and it belongs to the same applicant as CZ1. CZ1 can be used as a priority application even if it has been withdrawn.

Since CZ1 does not disclose compositions containing any one of B,C or D, claim 1 of EPCZ1 does not enjoy the priority of CZ1 for cream compositions containing B, C or D. On the other hand, claim 1 enjoys the priority of CZ1 for cream compositions containing A. Thus, claim 1 has two effective dates, 16 April 2012 and 10 August 2012 (which is possible because claim 1 is directed to a limited number of clearly defined alternative subject-matters (G2/98)).

Claim 2 enjoys the priority of CZ1 and its effective date is 16 April 2012.

EPFR1 is prior art for both claims of EPCZ1. Both claims of EPCZ1 are novel over EPFR1 because the compositions of EPCZ1 contain the additional ingredient Y. The addition of Y provides an unexpected effect. Therefore, both claims are also inventive over EPFR1.

EPFR2 is prior art under Art. 54(3) EPC for the part of claim 1 of EPCZ1 which has as effective date 10 August 2012 (compositions comprising B, C or D) and may be taken into account only with regard to novelty. Claim 1 of EPCZ1 is novel over EPFR2 because the latter does not disclose compositions comprising B, C or D.

On the other hand, if EPCZ1 loses its priority right, EPFR2 will become novelty destroying for both claims of EPCZ1.

If the translation of the priority document is filed, the EPO will accept that EPFR2 is not novelty destroying for claims 1 and 2 of EPCZ1.

Since there is no other relevant prior art, both claims of EPCZ1 are patentable. The patent resulting from EPCZ1 will be dependent on EPFR1.

EPFR2

Taking into account its priority date, EPCZ1 is prior art for EPFR2 under Art. 54(3) EPC with respect to compositions containing A. Claim 1 of EPFR2 is novel over EPCZ1 since it contains the additional feature W.

EPFR1 is also prior art for EPFR2, however claim 1 of EPFR2 is novel over EPFR1 since the latter does not disclose compositions containing A and/or because the composition of EPFR2 contains in addition Y and W. It also appears that claim 1 of EPFR2 involves an inventive step over EPFR1, since the stability of the composition has been unexpectedly increased. Thus it appears that EPFR2 will proceed to grant. The patent resulting from EPFR2 will be dependent on EPFR1 and EPCZ1.

Actions that we should take in the next four months:

Within the next four months we have to file the translation of the previous application CZ1.

We also have to pay the examination and designation fees for EPCZ1.

Furthermore, we have to review the search opinion of EPCZ1 because a negative opinion requires a response.

The translation of the previous application has to be filed by 18 June 2014.

The remaining actions also have to be performed by 18 June 2014.

Question 2

EPFR3 confers protection to the direct product of the claimed process, i.e. Z.

However, A is different from Z. Compound A is produced by a further transformation of Z. This transformation is substantial since Z does not exhibit the anti-ageing properties of A and/or in order to arrive at A, a multistep process has to be employed.

Furthermore, the product imported from India does not contain any Z.

Therefore, there is no infringement by the importation of A into the Czech Republic and thus GD can continue to obtain A from its supplier in India.

Question 3

The time limit for entering the European phase for PCTCZ2 expired on 7 October 2013. Since the required acts have not been carried out, the application is deemed to be withdrawn. Nevertheless, the EPO has to communicate the loss of rights to the applicant. Even if said communication was sent by the EPO, GD has not received it and therefore it has not been notified. Therefore, further processing for entering the European phase is still available.

GD has to pay the fee for further processing and perform the omitted acts for the entry into the European phase.

However, further processing does not apply to the payment of the renewal fees. The 3rd year renewal fee was due on 7 October 2013 and it may be paid with surcharge until 7 April 2014.

Therefore, a patent may still be obtained in Europe on the basis of PCTCZ2.

Question 4

The commercial exploitation of cream compositions containing any one of the compounds of family K in combination with X and Y would infringe EPFR1. Therefore, GD has to obtain a licence from CLC.

GD's product would not infringe EPFR2 because it does not contain W.

CLC will not be able to commercialise products containing a member of the K family, X and Y, (with or without W), without a license from GD, due to the protection conferred by EPCZ1.

Since the compositions containing X and Y represent an improvement over the compositions of EPFR1, CLC may be interested in a cross licence agreement. However, CLC may commercialise products containing only a member of the K family and X without infringing EPCZ1.

In order to strengthen its negotiating position, GD may offer a license or a transfer of the European part of PCTCZ2. Since CLC is active in the preparation of compounds of the K family, it may be interested in such licence/transfer, especially since PCTCZ2 represents a great improvement over the process that it is currently using.

GD does not have to make any payments with respect to PCTCZ2 before the meeting with CLC.

EXAMINATION COMMITTEE III

Candidate No. _____

Paper D 2014 - Marking Sheet

Category		Maximum possible	Marks awarded	
Part I	Question 1	6		
	Question 2	7		
	Question 3	8		
	Question 4	7		
	Question 5	6		
	Question 6	6		
Part II	Question 1	33		
	Question 2	9		
	Question 3	9		
	Question 4	9		
Total		100		

Examination Committee III agrees on marks and recommends the following grade to the Examination Board:

☐

PASS
(50-100)

☐

COMPENSABLE FAIL
(45-49)

☐

FAIL
(0-44)

24 June 2014

Chairman of Examination Committee III