

Examiners' Report Paper D 2015

1. General comments

Some candidates do not follow the Implementing Provisions to the Regulation on the European Qualifying Examination by putting their names or initial in their paper or by using outdated version of the legal provisions.

It is reminded that not following the rules of the IPR can only have negative consequences.

A complete answer requires a detailed analysis and a clear conclusion without contradictory statements. Simple repetition of the facts does not bring any marks.

Candidates are reminded that it is essential that their answers can be read and are encouraged to write legibly.

Examiners' Report Paper D – Part I

Question 1 (9 marks)

Most candidates recognized that it is important to avoid the re-dating of EP1 and EP2. However, not all candidates pointed out that for EP1 the applicant has to request that the date of filing remains 17 February 2015 and that for EP2 the drawings have to be withdrawn.

Question 2 (8 marks)

Many candidates correctly established that the right to priority for EP1 is lost. Some candidates wrongly referred to Article 90(5) EPC as a legal basis. Fewer candidates noticed that the loss of priority occurred after the publication of EP1 and therefore EP1 is prior art under Article 54(3) EPC for EP2.

Question 3 (9 marks)

Parts a) and b) of the question were very well answered. Many candidates referred to both the Paris Convention and the WTO. Full marks were given to candidates referring to either of them. However, not all candidates are familiar with the Rules of the PCT and EPC governing which Office can act as a receiving Office. Very few candidates considered the requirements of the GPTO regarding the language in which international applications may be filed.

Question 4 (7 marks)

Almost all candidates correctly answered that for EP-D1 the English translation may be brought into conformity with the original Japanese text and that EP-D2 cannot be corrected on the basis of Rule 139 EPC. Only some candidates suggested filing a new application within the priority year.

Question 5 (7 marks)

Candidates gained points by referring to Rule 30(3) EPC but few candidates went into the details of the Decision of the President and the Notice of the EPO. For instance, few candidates recognised the requirement to file the sequence listing in electronic form and the requisite statement. Some candidates failed to point out that two fees for further processing are to be paid.

Possible solution – Paper D2015 – Part I

Answer to question 1

According to Rule 56 (2) EPC, the applicant can file the missing drawings within two months of the date of filing, i.e. until 17 April 2015. Submitting the drawings results in EP1 and EP2 being re-dated to the date on which said drawings were filed, Rule 56 (2) EPC. Thus, the new date of filing for EP1 and EP2 is 23 February 2015, which is later than the expiry of the priority period. As a consequence, the claimed priorities are not valid and the publication of UK1 and UK2 on 20 February 2015 is prior art according to Article 54(2) EPC. The subject-matter of the claims of EP1 and EP2 lacks novelty with respect to the disclosure of UK1 or UK2.

Hence, it is important to avoid the re-dating of EP1 and EP2 to ensure that the claimed priorities are valid.

Because the drawings filed for EP1 are completely contained in UK1, the applicant should, within 2 months of the date of filing, request that the date of filing remains 17 February 2015 and file an indication as to where the missing drawings are completely contained in UK1, Rule 56 (3) EPC.

For EP2, the applicant should withdraw the drawings within one month from a notification that can be expected from the EPO informing the applicant under Rule 56(2) EPC of the re-dating of EP2. The re-dating shall then be deemed not to have been made, Rule 56 (6) EPC.

Answer to question 2

Since the requested translation was not filed in due time, the right of priority for EP1 is lost, Rule 53(3) EPC. The time limit for requesting further processing in accordance with Article 121 EPC has already expired.

Thus, the article is prior art according to Article 54(2) EPC and EP2 is prior art under Article 54(3) EPC. EP1 lacks novelty in view of each of the scientific article and EP2 and will be refused.

EP1 would have been published in July 2011 after expiry of a period of eighteen months from the date of filing, in accordance with Article 93(1) EPC. This is before the EPO sent out the invitation under Rule 53(3) EPC. Therefore, the loss of the right of priority for EP1 took effect after its date of publication and does not affect the application of Article 54(3) EPC, Guidelines G-IV, 5.1.1 or Guidelines F-VI, 3.4.

The priority date of EP1 is before the date of filing of EP2, but EP1 was published after the date of filing of EP2. Therefore EP1 is prior art according to Article 54(3) EPC for EP2.

The opposition period specified in Article 99 (1) EPC is still running. The period for filing an opposition expires nine months from 12 November 2014, i.e. on 12 August 2015.

Applicant B can file an opposition against EP2 on the grounds of Article 100(a) EPC, pointing out that EP2 lacks novelty over EP1.

Answer to question 3

Yes. The international application may contain a declaration claiming the priority of application A because application A was filed in Argentina, which is a party to the Paris Convention, Article 8(1) PCT, and a member of the WTO, Rule 4.10(a) PCT.

Hans is entitled to file a PCT application since he is a national of a PCT Contracting State (Germany), Article 9(1) PCT.

Pursuant to Rule 18.3 PCT, if there are two applicants, the right to file an international application exists if at least one applicant is entitled to file an international application. Therefore, Hans and EE are entitled to file PCT-A together.

It is sufficient that the Office with which the application is filed is acting for a Contracting State of which at least one applicant is a national, Rule 19.2(i) PCT and Rule 19.1(a)(ii) PCT. Since Hans is a national of Germany, which is a Contracting State to both the EPC and the PCT, the EPO is competent to act as a receiving Office, Rule 157(1) EPC.

The GPTO does not accept international applications filed in English, see PCT Applicant's Guide (part C - DE). The GPTO will not act as receiving Office. The international application will be considered to have been received by the GPTO on behalf of the International Bureau as receiving Office.

Answer to question 4

For EP-D1, “©” can be replaced by “µm” because the English translation may be brought into conformity with the original Japanese text, Article 14(2) EPC.

Any amendment of EP-D2 replacing “©” by “µm” would contravene Article 123(2) EPC. A correction of EP-D2 on the basis of Rule 139 EPC is not possible because the replacement of “©” by “µm” is not immediately evident. The priority document cannot be used as a basis for the correction, G3/89 or G11/91.

The period for claiming priority of JP-D has not yet expired. Applicant D should file a new application mentioning “µm” instead of “©”, claiming priority of JP-D and directed to the subject-matter of claim 2.

Answer to question 5

Within a period of two months from the invitation under Rule 30(3) EPC, applicant E has to:

- i) furnish the sequence listing referred to in Rule 30 (1) EPC in electronic form complying with WIPO standard ST.25, Article 1(1) of the Decision of the President of the EPO dated 28 April 2011;
- ii) pay the late furnishing fee according to Rule 30 (3) EPC and Article 2.1(14a) Rfee; and
- iii) furnish a statement that the sequence listing does not include matter which goes beyond the content of the application as filed, Article 2(2) of the Decision of the President of the EPO dated 28 April 2011 or the Notice from the EPO dated 18 October 2013 concerning the filing of sequence listings.

The invitation is deemed to be delivered on 28 February 2015. Thus, the period mentioned above expires on 28 April 2015.

If the applicant fails to remedy the defect within the period specified above, the application will be refused, Rule 30 (3) EPC.

According to the Notice from the EPO dated 18 October 2013 concerning the filing of sequence listings, the applicant can request further processing under Article 121 and Rule 135 EPC. Within two months from the notification of the refusal, the omitted acts mentioned under i), ii) and iii) must be completed, and a further processing fee must be paid for each omitted act, i.e. one further processing fee for having omitted the filing of the sequence listing and one further processing fee for having omitted the payment of the late furnishing fee.

Examiners' Report Paper D – 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:

- A patent for the subject-matter M+A would provide the broadest protection but there is currently no pending patent application validly claiming it. A new application based on EP-Z can be filed by TIPOGRAF-X claiming M+A.
- EP-X3 is not an enabling disclosure for M+A+B+C+D but the problem can be solved by filing a new application, preferably a PCT application in order to extend protection worldwide.
- TIPOGRAF-X will not be free to use M+A+B+C+D because IPCR-G has rights to M+A+B (via EP-G) and PRINT-L has rights to M+A+C (via PCT-L).

Regarding the specific questions

Question 1 (30 marks)

This part was generally well answered by candidates.

Any analysis of the current situation must be conducted without considering potential actions which may come later. Candidates pointing directly to actions may be unable to earn all points for analysing the current situation

This year, question 1 specifically requested an analysis structured around the subject-matters. In spite of this, many candidates structured their analysis around the patent applications which can lead to points being missed.

Candidates cannot earn full marks by merely identifying documents belonging to the state of the art without identifying whether they are novelty destroying. For example, identifying an Art. 54(3) document does not necessarily imply that it is novelty destroying.

Comments on inventive step were occasioned by the information given in the paper and therefore expected. Some candidates discussed only novelty and did not address inventive step.

Question 2 (4 marks)

This question required an appreciation that patent ownership does not relate to freedom of action. This fundamental concept is still not always understood.

Many candidates did not realise that machine M+A+B+C+D falls within the scope of protection of broader claims M+A+B and M+A+C.

Question 3 (26 marks)

A large number of candidates saw the possibility of using Art. 61(1) to file a new application based on EP-Z, although very few discussed the consequences that it will have on the negotiation with ICPR-G.

Few candidates saw that old EP-Z can be used to block the grant of M+A in EP-G.

Some candidates saw the possibility to redate EP-X3 by adding the missing parts but very few saw the optimal solution consisting in filing a new PCT application claiming priority of EP-X2 and EP-X3. Most of those candidates realised that by filing a PCT application rights may be obtained in the competitor's market, which would be beneficial for a cross-licensing agreement with PRINT-L.

Possible solution Paper D 2015 – Part II

Question 1

M+A

EP-Z is the first filing for M+A. There is apparently no relevant prior art available for EP-Z. However, EP-Z was withdrawn in November 2013 (after its publication which must have been in Sept. 2013 at the latest) and cannot be revived. The s-m of the claim to M+A in application EP-G is not novel, Art. 54 (3) EPC, over EP-Z even if the EPO is apparently not aware of EP-Z as prior art for EP-G. The subject-matter of the claim of application EP-X1 (directed to M+A) is not novel, Art. 54 (3) EPC, over EP-G (M+A) although this is not mentioned in the search report. EP-G was published around Nov. 2013, i.e. after establishment of the search report of EP-X1.

It is impossible to get protection for M+A via EP-X1. The subject-matter M+A is made public by publication of EP-Z in Sept. 2013 or at most a few months before and there is currently no patent application pending which validly claims M+A

M+A+B

EP-G is the first filing for the s.-m. M+A+B. There is apparently no relevant prior art available for EP-G.

Feature B enables the use of different types of paper over the known machine M and is, therefore, regarded to be inventive.

Therefore, with EP-G, ICPR-G will obtain a European Patent for M+A+B.

EP-G will have published around November 2013 (18m from filing) and is novelty destroying for the claim to M+A+B in EP-X2.

Therefore, no protection for M+A+B can be achieved via EP-X2

Currently it appears that the patent rights for M+A+B will belong only to ICPR-G

M+A+C

PCT-L is the first filing for M+A+C. There is apparently no relevant prior art. M+A was published only after the filing of PCT-L, so both features C and A contribute to inventive step of subject-matter M+A+C.

M+A+C is clearly inventive because A allows a higher speed and/or C allows the reduction of the number of misprints.

Therefore, PRINT-L will get patent protection for M+A+C in any national/regional phase they choose.

In the event that PCT-L enters the European phase, or at least if the requirements of Rule 165 EPC are fulfilled, the publication of PCT-L on 13 March 2014 will constitute prior art under Art. 54(3) EPC for EP-X2 (filed on 10 March 2014) and the subject-matter of the respective claim in EP-X2 directed to M+A+C will not be novel. The last date to enter the EP regional phase is 08.04.15.

In that case, TIPOGRAF-X cannot get protection for M+A+C via EP-X2 and the patent rights for M+A+C in Europe will belong only to PRINT-L.

If PCT-L is not regionalised the patent rights in Europe will belong to TipograF-X.

M+A+B+C

EP-X2 is the first and only filing for M+A+B+C.

For the claim to M+A+B+C in EP-X2, EP-G (M+A+B) is prior art under Art. 54 (2) EPC and

PCT-L (M+A+C) may become prior art under Art. 54 (3) EPC.

The subject-matter of the claim to M+A+B+C in EP-X2 is novel over the prior art.

For inventive step analysis only EP-G disclosing the combination M+A+B can serve as closest prior art.

Since feature C as such, as well as in combination with feature B, has the advantages of the reduction of number of misprints and of noise respectively, the subject-matter of M+A+B+C is inventive.

Therefore, TIPOGRAF-X will get patent protection in Europe for M+A+B+C via EP-X2.

However, the machine M+A+B+C falls also under the scope of EP-G (M+A+B) and any European or national patent that claims M+A+C from PCT-L or EP-X2.

M+A+B+C+D:

Due to the missing parts in the description of EP-X3, feature D as well as the combination M+A+B+C+D is not sufficiently disclosed in EP-X3 (Art. 83 EPC) which is the only patent application related to that combination.

Hence, at present there are no valid patent applications for M+A+B+C+D.

M+A+B+C+D or the feature D were not made available to the public at the trade fair because feature D was not visible and no information about it was given.

Question 2

The exhibited machine (M+A+B+C+D) is within the scope of the claims of possible patents to be granted based on EP-G (M+A+B), and PCT-L (M+A+C), because they protect versions of the machine with fewer features, i.e. they have broader scope. Therefore the machine M+A+B+C+D will infringe EP-G once it is granted and validated.

Similarly, the machine M+A+B+C+D will infringe patents originating from PCT-L once granted and validated.

Our client is not free to produce, sell or use M+A+B+C+D in any country where EP-G is validated and where patents originating from PCT-L will be in force.

Provisional protection for EP-G may also be provided in some countries, depending on national law.

Question 3

Make sure that EPO becomes aware of the publication of M+A in EP-Z either by filing 3rd party observations in respect of EP-G or alternatively wait to file an opposition against EP-G (EP-Z forms part of the state of the art for EP-G under Art. 54(3) EPC). You can also inform ICPR-G about EP-Z during negotiations.

In any case ICPR-G will have valid protection in Europe only for M+A+B.

Outside Europe, no patent protection for M+A+B will be possible due to the publication of EP-G in November 2013.

Regarding the combination M+A, TIPOGRAF-X can file a new application EP-Z-NEW with the same content as EP-Z and get the filing date of EP-Z under Art. 61(1)(b) EPC and with the decision of the court. The limit date to do this is three months from the date the decision of the national court became final, 15.1.2015 + 3 months = 15.4.2015. This can be done even if the original application EP-Z has been withdrawn.

This new application EP-Z-NEW will have the earliest filing date for M+A and will give TIPOGRAF-X the broadest protection possible in Europe.

EP-G with a claim to M+A+B would be dependent on EP-Z-NEW (M+A).

This will put TIPOGRAF-X in an advantageous position for the meeting with ICPR-G and can form the basis for a cross licence.

It is likely that TIPOGRAF-X will be made liable for its activities.

But in turn, TIPOGRAF-X may make ICPR-G liable for any action in any EP state designated in EP-Z-NEW.

Since ICPR-G is operating only in Iceland, which was a contracting state at the date of filing of EP-Z, TIPOGRAF-X may make ICPR-G liable on the basis of EP-Z-NEW (M+A) and should, therefore, validate EP-Z-NEW also in Iceland.

PCT-L, if regionalised in EP, would also be dependent on the more general EP-Z-NEW.

Additionally, it is highly recommended to file a new PCT application PCT-X describing and claiming M+A+B+C+D in order to get worldwide protection for this subject-matter.

Moreover, in order to allow for protection of M+A+B+C not only in Europe (EP-X2) but worldwide which is in the interest of TIPOGRAF-X, PCT-X should contain a claim directed to M+A+B+C.

PCT-X should claim priority of EP-X2 and therefore should be filed at the latest by 10 March 2015, i.e. 12 months after filing of EP-X2. Otherwise the exhibition of the machine M+A+B+C+D (with D invisible) at the trade fair would be novelty destroying prior art for the claim to M+A+B+C in PCT-X.

A less preferred alternative is to save EP-X3 by filing the missing parts.

The missing pages of the description should be filed before 20.3.2015, within two months from the filing date, and this would change the filing date of EP-X3 which is however not important because there was no public disclosure of D at the trade fair.

The subject-matter of the claims to M+A+B+C+D and M+A+B+C in PCT-X or redated EP-X3 is novel and inventive.

However, PCT-X or redated EP-X3 will be a dependent patent of EP-G and PCT-L if granted in EP.

By using the rights to M+A from EP-Z-NEW in Europe, as well as the right to M+A+B+C and M+A+B+C+D from PCT-X worldwide, TIPOGRAF-X will be in a position to negotiate with PRINT-L a cross license with the potential rights of M+A+C from PCT-L worldwide.