

CANDIDATE'S ANSWER

D, EQE 2018

a) Part II

- The written decision was dated 2 October 2017. Thus deemed notified on 12 October 2017. Deadline for notice of appeal = 12/12/17, and grounds = 12/2/18.
- Both parties met these deadlines.
- However, BB's grounds of appeal merely refer to their previous submissions that were submitted at first instance. There is a good chance, therefore, that the opposition will be deemed not filed, because the grounds of appeal will not have been properly substantiated in accordance with Rule 99(2) EPC (see T213/85), because it does not indicate reasons why the decision should be set aside.
- Because the deadline for filing grounds of appeal has now passed, the appeal will be deemed not filed.
- However, the opponents appeal will have been deemed validly filed and so BB are still a party to the appeal proceedings - because they did not validly file an appeal, the opponent cannot be left in a worse position than if they had not appealed. Therefore, we cannot broaden the pending claim.
- Claim 1 at present (fruit A & B) lacks sufficiency in view of the further experiments conducted by the opponent.
- However, amending C1 to indicate the S-M (subject-matter) of claim 3 would appear to overcome the objections.
- We cannot, unfortunately, broaden the claim to remove fruit B because this would leave the opponent (who is the sole appellant) in a worse position than if they had not appealed.
- Therefore, amend claim1 (send submission now) to recite the FFP comprising fruit A, B and C. This claim does not lack sufficiency because acrylamide levels remain lower than 225ppb regardless of frying temperature used.
- Claim 1 amended in this way should be allowable.

- This amendment is based on cl, 2 and 3 as originally filed and so does not contravene A123(2) EPC.
- On the other hand, if the appeal was deemed validly filed (unlikely) amend claims based on original claims 1 + 3 (fruit A + C) in order to cover oliebollen sold in Dec 2017 and won competition because this product would not be covered by c1 amend to fruits A+B+C.
- Must amend to include fruit C otherwise claim will lack sufficiency since no disclosure of the required temp of 220°C or lower.

2.1) EP-BB2:

- EP-BB2 has a single claim to a method of preparing a FFP, by frying at a temp of 150-220°C.
- No fees were paid and a loss of rights comm. was issued in June 2017 (for non-payment of filing and search fees). Further processing deadline will have expired in August 2017 (2 months from loss of rights comm).
- Reestablishment not possible as wouldn't meet "all due care" criterion".
- EP-BB1 has therefore lapsed irretrievably.
- No patent protection is possible for BB from EP-BB1.
- In any event, it lack novelty over the pub. of EURO-PCT-FKI (approx 18m from 31/3/15 – 31/9/16) - since FFP with fruit D + 135°C, falls within scope of the claim.

2.2) PCT-BB2

- PCT-BB2 has the same claim as EP-BB2 (method of making FFP inc. frying at temp 150-220°C).
- Priority is validly claimed by PCT-BB2 from EP-BB2 in respect of the s-matter of the claim of PCT-BB2) (same app., within 12m, same s-matter, EP-BB2 was first app. by the applicant to this s-matter).
- Therefore effective of claim (150-220°C) is 3/2/17.
- This claim lacks novelty over EURO-PCT-FK1 as explained above (fruit D still falls within the scope of the claim, 155°C falls within claimed range + EURO-PCT-FK1 published approx September 2016).
- Therefore, as it currently stands, no patent protection will be possible through the claim of PCT-BB2.

2.3)

EP-BB3: claim to app: dough mixer inc. trumpet-shaped nozzle.

- Filing date = 26/1/818. No priority claim.
- EP-BB2 is not prior art under A54(2) EPC because it was deemed withdrawn in June 2017, which is before it will have been published (approx. 3/8/17) → therefore not A54(3) EPC prior art.
- EP-BB3 claim will lack novelty over the drawing of the trumpet shaped nozzle in PCT-BB2 under Article 54(3) EPC should PCT-BB2 validly enter EP regional phase (ie. pay filing fee – R165 EPC).
- If PCT-BB2 does not enter the EP regional phase, then EP-BB3 claim will be valid since there is not PA disclosure of a trumpet shaped nozzle, and it is inventive because it further lowers acrylamide levels by allowing higher liq. content.

EP-BB3 is currently pending but no fees have been paid. Search fee and filing fee due on 26/2/18 (1 M from FD). Missed this date and so will be deemed withdrawn (can be remedied by FP). But, as explained above, at present no valid protection will be obtained through this app.

Assume PCT-BB2 will be entered into regional phase to get protection for the method claim, therefore, no protection possible at present from EP-BB3.

- Is novel over EURO-PCT-PK though as this doc does not disclose the use of trumpet shaped nozzle. Is inventive over EURO-PCT-FK1 because trumpet nozzle has the tech effect of further lowering acrylamide levels through higher liquid content.

PCT – New (intended to file)

- Priority claim from EP-BB3 will be invalid because it is not the first app. by BB directed to nozzles (trumpet shaped).

EP-BB2 served as a priority basis for PCT-BB2 and so A87(4) EPC criteria has not been met for restarting the priority from a second app.

- Effective date of claim of PCT-BB2 will thus be the filing date.

(PCT-New cont...)

- this will lack novelty under A54(3) EPC (or A54(2) if filed after PCT-BB2 is pub. approx. 3.8.18)

Wherever PCT-BB2 is entered (in any designated states that have such prior art conditions), because of the drawing contained in PCT-BB2.

2.4) EURO-PCT-FKI

Ind. claim 1 – nozzle (arranged to deposit....)

- First app. for nozzle that is “arranged to deposit...” (filed 31/3/15).
- However, this claim lacks sufficiency and/or clarity (A83 or 84 EPC) because it is missing an essential feature that the dough mixer has a screw conveyer in order to expel dough from the mixer.
- No patent protection will thus be achieved by FK by this claim.
- In any event it would lack novelty over the general known use since the end of the 20th century to use conically shaped nozzles + screw conveyors.
- Ind. claim 2 (method prep. FFP + fruit D at 155°C → 250°C).
- First app for this S-M (FD = 31/3/15)
- Novel over EP-BB1 disclosure as no temp disclosed in this app (temp. investigations made after opposition of EP-BB1).
- Involves an inventive step because it has the tech effect of making products crispy on the outside and fluffy on the inside for longer.
- Therefore, FK will obtain patent protection for this S-M in EURO-PCT-FK1 (and in Europe as has entered EP regional phase and wherever else in the world the PCT app has been pursued).

3. EP-BB1

- As explained above nothing is likely to be able to be done apart from amend to A+B+C (unless the appeal is deemed validly filed and then amend to A+C).
- As after grant no divisional can be filed for this app.

EP – BB2

- Irretrievably lapsed and so novelty can be done for this app.
- We are also outside the 12m priority period and so cannot file a new app. claiming priority from EP-BB2 (expired 3/2/18).

PCT-BB2

- Amend the claim of PCT-BB2 based on the disclosure of the preferred range in the description (175 - 200°C).
- A claim amended in this way will be novel over EURO-PCT-FK1 because it will be a valid selection invention (narrow range, end points sufficiently far removed from 155°C and 250°C and not an arbitrary selection – lowers acrylamide levels to below 225 ppb).
- Also, would involve an inventive step over EURO-PCT-FK1 because it has the effect of keeping the acrylamide levels lower than 225 ppb.

To obtain protection for nozzle (trumpet shaped):

- File a late declaration of priority for EP-BB3 from EP-BB2 (possible by 16m from PD since EP-BB3 was filed within 12m of EP-BB2 – file request BY 3/6/18).
- EP-BB3 effective date will therefore be 3/2/17 and so PCT-BB2 will not be A54(3) EPC PA.
- Cannot file a new PCT app as this will lack novelty over PCT-BB2 A54(3) EPC when enters EP reg. phase – assume client wants to enter EP regional phase to gain protection of method (175-200°C).
- Need to add priority date to EP-BB3 so that PCT-BB2 not A54(3) EPC prior art when enters EP regional phase.

- EP-BB3 – pay filing and search fees + (50% FP fee) and req. further processing in response to loss of rights communication when it issues.
- PCT-BB2 – enter EP regional phase by 3/9/19.

Possibility:

- In other PCT contracting states could try to obtain protection for nozzles (trumpet shaped) basing a claim on the drawing – though may constitute added matter. Worth an attempt to try to gain worldwide protection.
- Validate all granted patents in whatever contracting states relevant for client (inc. NL as “Oliebollen” in a Dutch speciality).

4)

If you do not buy it and a competitor does instead:

- The competitor (or FK) will be able to stop BB (BB won't be allowed to) use a method of preparing FFP containing fruit D frying at 155-250°C.

Thus will not be able to work within the scope of any claims granted from PCT-BB2, when fruit D is present.

This means that the oliebollen in Dec 2017 that won a competition would not be able to be made since it contains fruit D and was made at a tempo falling within the scope of ind claim 2 of EURO-PCT-FK1.

- All of the rights of BB in PCT-BB2 will be dependent on EURO-PCT-FK1 when fruit D is present.
- Method claims also afford protection of the direct product of the process and so would give BB protection of the direct product of the method of second ind. claim of EURO-PCT-FK1.
- First ind claim of EURO-PCT-FK1 is not valid and so do not buy for this claim. Only buy for the reason of the second independent claim (which all the previous discussion is based on).
- The second independent claim of EURO-PCT-FK1 is valid over the prior art and so will proceed to a granted patent.
- Possible reason : depending on wording of some method claims, the claim is interpreted as merely being "suitable for" preparing the desired product and in this scenario all off the claims of EP-BB1 (direct product of process) and PCT-BB2 would be dependent on this right owned by a competitor.
- If you don't buy it, they will offer/sell it to a competitor.
- Negotiate a lower price as can show them that the first independent claim lacks sufficiency. Perhaps offer to buy rights to second independent claim only.

Conclusion:

- The claims in EP-BB3 would be dependent on ind claim 1 of EURO-PCT-FK, as nozzle (trumpet) would fall within scope of ind c1 of EURO-PCT-FK, but

claim lacks sufficiency. If it did not, we would infringe this patent performing EP-BB3's invention.

- To perform methods claims of PCT-BB2 (in current state or as amended as proposed above) patent will be dependent on ind c2 of EURO-PCT-FK (to the extent that fruit D is used, if the claim is interpreted as limited to having to contain D – which is the most probable interpretation). This will mean BB won't be able to make and sell their Dec 2017 winning variety of "Oliebollen").
- Therefore important to buy.

Part I

1. The PCT application will be considered to have met the requirements for a filing date because at least one claim is present (albeit the actual second half is missing, a claim is still present). (A11(1)(iii)(c) PCT). ("just requires something that appears on the face of it to be a claim – PCT. APP Guide, IP, 6.025)
- File the second page of the claim as a missing part (R20.5 PCT).
- Within 2m of the filing date (R20.7(a)
 - (ii) (i.e. 2m from 20/2/18 = 20/4/18), file the missing page of the claims. The app. will be re-dated to the date in which this part is provided (R20.5, (b) and (c) PCT).
- However, if the missing part is filed by incorporation by reference, the missing part will not redate the application (R20.5(d) PCT) (missing part can also be withdrawn within 1m of redating notification (R20.6(e) PCT).
- This is important because if the app. is redated, the app. filing date will fall outside the 12m priority period and priority will be lost (unless restored) – (A8 PCT and Art 4 PC).
- Must submit a written notice confirming that the missing part is incorporated by reference under R4.18 PCT (this is possible because priority was derived from FR-A, the whole claims were contained within FR-A and the PCT form PCT/RO/101 (PCT App Guide, IP, 6.028) automatically contains an incorporated by reference statement. Must provide sheet showing entire missing part (all of second pg of claim) R20.6,a(i), provide a copy of the earlier priority app. (FR-A) (R20.6,a(ii)), no translation required as FR is an int. pub. lang. (R48.3(a) PCT) and both FR-A and PCT-A are in same lang. (R20.6,a(iii)), indication where the missing part is in FR-A (R20.6(a)(iv).
(R20.6(a)) ← File req. with the EPO as RO.
- EPO will under R20.6(b) PCT, not redate the app. and deem that it was contained in the app. as filed.
→ Provisional protection:

- Request early pub. under Rule 48.4 PCT. and A21(2)(b). ISR not yet available and so need to pay special pub. fee (R48.4(a) PCT). Will be pub. promptly after fee paid (R48.4(b) PCT).
- In accordance with A67(3) EPC - contracting states may require translation of the claims into their official language in order to gain provisional protection.

b)

Company D may become a party to the opposition proceedings by intervention (intervention of the assumed infringer) (A105(1)(a) EPC), even after opp period has expired. The intervention shall be treated as an opposition (A105(2) EPC).

- Must file the notice of intervention by 3m from date on which infringement proceedings commenced (ie. 22/2/18 + 3m = 22/5/18). (R89(1) EPC).
- Must file a written reasoned statement + pay opposition fee within the 3m period R89(2) EPC). Must also comply with R76 + 77 EPC.
- The opp. may be based on any ground (G1/94) (Guidelines D, VII 6)
- Therefore, can raise against claim 1 the new ground of lack of novelty against claim 1 based on doc D1. Since it discloses the S-M of claim 1 claim 1 will be revoked for lack of novelty/deleted (A101(b) EPC).
- Lack of clarity is NOT a ground of opposition under A100 EPC. (G3/194 – even if new art cited) therefore amended claim 2 cannot be revoked on this basis since the amended feature came from the claims – (Guidelines, D-V 5 (i)). Therefore, claim 2 will not be revoked on this basis.
- Therefore, must file valid opposition by 22/5/18 →
- Written reasoned statement (R76(1) EPC)
R76(2) EPC:
 - Identify opponent
 - No. of EP + name of proprietor and title of invention,
 - Statement of extent to which EP is opposed and grounds ie. claim 1, as A100(a) EPC (new opponent entitled to raise new ground).
- Notice of intervention in written reasoned statement → Intervention possible because opp. proceedings are pending (D-VII 6).

Pay opp fee! (A99(1) EPC).

3)a) FD = 15/11/17 because for a filing date to be accorded, a desc. or reference to a prev. filed app is required (R40(1)(c) EPC) along with an indication that patent is sought + info identifying applicant (R40(1)(a) and (b) EPC).

- The desc. can be filed in any language. (A14(2) EPC)

Therefore, 15/11/17 = FD because this was the date when requirements for a FD were met.

→ An applicant can file an app w/out representation – can file all things required for a date of filing (A-VIII 1.1). Therefore, desc. filed on 15/11/17 is deemed filed.

b) Representation is required (A133(2) EPC) app. not have his residence (or principal place of business) in an EPC contracting state. Based in Argentina.

- The translations filed on 27/11/17 will not be deemed filed as the applicant requires representation and can only perform acts required for a FD by himself (A133(2) EPC). (Guidelines (A VIII 1.1)).
- The invitation will be under R58 EPC and so will set a deadline of 2m (5/2/18 + 10 days – R126(2) EPC - + 2m 5/4/18) to appoint a representative. If I am a European patent attorney no authorisation is required (SE No. 3, OJ EPO 2007, L.1), if I identify myself as such.
- actions →
- must file the translations again by 15/11/17 + 2m = 15/1/18 (R6(1) EPC). Missed this date therefore must file translations in response to inv. pursuant to R58 (A90(4) EPC) (10d +2m).

+ appoint self as agent before filing the translations + don't need to pay filing fee + search fee as these can be paid by any party. (A-XI, Legal Advice No. 6/91 rev.)

4)a) File a request for reestablishment of rights (in respect of the time limit for filing an appeal) under A122 EPC. This is available for proprietors of a patent in relation to the time period for filing an appeal. → [Under A122(1) EPC]

- According to R132(1) EPC, file request in writing within 2m of removal of cause of non-compliance but at latest within 12m of missed deadline (2m from removal of cause of non-compliance = 2m from 27/2/18 – this communication made the representative realise the non-compliance, therefore 27/4/18 and within 12m from (15/9/17 + 10 days (R126(2) EPC) = 25/9/18.

(T 428/981 → renewal of cause of non-compliance = date receives comm. notifying of missed time limit).

- Must pay reest. fee within this period of time, and file the notice of appeal + pay appeal fee (R136(1) EPC & A108 EPC, R99 EPC).
- Likely to be accepted as it is an isolated mistake and so would appear to be meet the “all due care requirement”.
- Must state grounds + facts supporting request (R136(2) EPC) e.g. isolated mistake, failure of monitoring system to record receipt of doc.
- If request for reestablishment of rights is accepted, then appeal will be deemed to have been filed, and appeal proceedings can commence.
- File grounds of appeal also with the request for reestablishment as the grounds were due on (25/1/18 – A108 EPC).
- Likely to be accepted as “all due care” → T439/66 r4: “isolated mistake within a normally satisfactory system” → satisfies all due care criterion.
All due care applies to both applicant + representative (J 3/93).

b) Cannot do anything as representative for opponent because FP not available to opponent or proprietor (A121(4) EPC) and because reestablishment of rights is only available for applicants/proprietors & not opponents.

Further Info:

(Both parties are, however, entitled to appeal A107 EPC – because adversely effected (IGNORING the missed time limit issue!)).

Reestablishment not available to opponent for 2m time limit for filing an appeal (T 210/89).

5)

- Once the applicant has approved the text, further requests for amendment will only be given in exceptional circumstances at discretion of the Examining Division under R137(3) EPC.
- Minor amendments which do not require re-opening of the substantive examination may be allowed (G 7/93).
- Amendments must comply with R137(4) EPC.

ED will send invitation (provide basis)

- Conditions defined in G 7/93 must be met.
- Must provide translations of the amended claims + explain the reason for the amendment and why it is of a minor nature.
- Can request up until decision to grant handed over to EPO's internal post service (G 12/91) → time when EPO bound by decision (usually 5 days before stamped date of transmittal) therefore request amendment ASAP.
- Will be allowed because substantive exam. will not need to be reopened because claim 2 is within the scope of claim 1 (so narrowing claim, therefore, no issues with patentability and because the claims will already have been examined for clarity etc.).
- Should be allowed as EPO will take into account the applicant's interest in having a patent that is legally valid in all of the states (G 7/93).

b) File a request for central limitation post-grant (after the patent has been granted) under A105(a) EPC.

- Must pay limitation fee, request not deemed filed until fee is paid (A105a(1) EPC).
- Court request while a pending opposition (A102a(2) EPC).
- No reason needed.
- Will be examined by EPO (A105b EPC). Thus amendment will be allowed because it is a minor amendment, limiting the scope of the claim and only introducing S-M from the claims.

- Takes effect from when pub. in EPB (A105b(3)).
- Request must satisfy R92(2) and (1) EPC (filed in writing, in official EPO language (or trans. made under R6(2) EPC), contain info on proprietor, contracting states, patent no., file a complete version of the amended claims + amended desc. pages if necessary.
- Must pay publishing fee + new amended claim translations (R95(3) EPC), within 3m of communication from ED.
- New amended spec will then be published in EPB (A105c EPC).

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

Category		Max. possible	Marks Marker 1	Marker 2
Part I - Question 1	Part I - Question 1	10	9.0	9.5
Part I - Question 2	Part I - Question 2	8	7.0	6.5
Part I - Question 3	Part I - Question 3	8	6.5	6.5
Part I - Question 4	Part I - Question 4	6	4.0	4.0
Part I - Question 5	Part I - Question 5	8	5.0	5.0
Part II - Question 1	Part II - Question 1	10	7.5	7.5
Part II - Question 2.1	Part II - Question 2.1	3	3.0	3.0
Part II - Question 2.2	Part II - Question 2.2	6	6.0	5.5
Part II - Question 2.3	Part II - Question 2.3	12	9.5	9.5
Part II - Question 2.4	Part II - Question 2.4	8	6.0	6.0
Part II - Question 3	Part II - Question 3	16	10.0	10.0
Part II - Question 4	Part II - Question 4	5	4.0	4.0
Total			77.5	77.0

Examination Committee III agrees on 78 points and recommends the grade PASS