

CANDIDATE'S ANSWER

D, EQE 2019

Part 1

Question 1

EPC

B should provide evidence today that he/she has instituted proceedings against A seeking a decision that B is entitled to the grant of EP-A. The EPO shall stay the proceedings of EP-A (Art. 61(1), R 14(1) EPC).

After the competent court has issued a final decision that B is entitled to the grant of EP-A, B should provide evidence of such decision. The EPO shall notify the parties that the proceedings for EP-A shall be resumed at a date not less than 3 months after the decision becomes final (Art 61(1), R 14(2))

While the proceedings are stayed, the period for responding to the 71(3) communication shall be interrupted (R 14(3)). Since the stay takes effect before the communication is deemed delivered under R 126(2) EPC, the R 71(3) Communication shall be void. (GL A-IV, 2.2.3, second paragraph).

Before resumption or proceedings, B should inform the EPO that he intends to prosecute EP-A in the place of A (Art 61(1)(1), GL A-IV, 2.4). B will become the applicant for EP-A.

Upon resumption of proceedings, B should request amendment of EP-A to delete claim 3 and combine claim 1 and 2. The EPO should issue another communication under R 71(3) with this single claim.

While EP-A is pending i.e. at the latest of the day before the mention of grant of EP-A in the European Patent Bulletin (G1/09), B should file a divisional application with a single claim corresponding to claim 3 (Art 76(1), R36(1))

During the stay, B should ensure that the maintenance fees continue to be paid under Art 86, R 51(1) (R 14(4)).

The decision of the competent court is recognised by all Contracting States (Art 9, Protocol of Recognition) so that B may continue with EP-A and file a divisional application therefrom in respect of all Contracting States designated in EP-A now.

Question 2

a)

- File observations on the application using the third party observation system.
- The observations should include the document making product A available and comments explaining why it anticipates claim 1
- The observations should be limited to novelty of claim 1
(AG-IP 11.109; Section 801(a) and (b) of ePCT TPO Guide)

Deadline is 28 m from filing date:

13.2.2017 + 28m (AG-IP 11.110, S802(a)(ii), 804(b) of ePCT TPO Guide)

→ 13.6.2019 (Thur)

Observations must be uploaded using the ePCT system and must be in a language of publication. The prior art document may be filed in any language.

The observations will be published and transmitted to the designated offices.
(AG-IP, 11.110, 11.113, 11.115-11.117)

b)

- We may file third party observations while the application is pending (Art 115 EPC)
- File the prior art document and argumentation of lack of novelty of claim 1 under Art 54(1), (2) EPC
- Include arguments on lack of clarity under Art 84 EPC. These are taken into account (GL E-Vi, 3; T 598/97)

If a patent is granted nonetheless, we may file an opposition on the ground of lack of novelty over the found document (Art 99(1), 100(a), 54(2) EPC) in respect of claim 1.

Clarity if not a ground of opposition (Art 100) so claim 2 may not be objected to under Art 84 EPC. (G3/14, T409/91).

Question 3

a)

PCT: The application does not include claims; a filing date cannot be accorded in its present form (Art 11(1)(iii)(e))

The EPO as receiving office shall invite the applicant to correct the application or confirm that the claims of DE-1 are incorporated by reference (R 20.3 (a)(i),(ii))

Within 2m of the date of this invitation (R20.7(a)(i)), the applicant must:

- confirm that the claims of DE1 are incorporated by reference under R4.18
- file the claims of DE-1 (R20.6(a)(i);
- supply a copy of DE-1, if not already done (R20.6(a)(ii))
- an indication of where the claims are contained in DE-1 (R20.6(a)(iv)).
- if PCT-X was not in the same language as DE1, also file a translation of DE1 into the language of PCT (R20.6(a)(iii).

The claims shall be deemed to be completely contained in the PCT-X as filed (R20.6(b) PCT)

The statement of incorporation by reference under R4.18 is included on PCT/RO/101.

The claims of PCT-X are entitled to priority because they are included in DE1 (Art 8(2)(a) PCT) and PCT was filed during the priority period by the same application (A4A(I) PC).

The effective date of the claims is the filing date of DE1 (Art 4A(1), 4B Paris Convention), so the article disclosing the capsules made from metal and aluminium is not prior art.

C can still get protection for capsules made from metal and from aluminium.

b) EPC

Claims are not required for a filing date (Art 80, R40(1)). The applicant may not make use of missing parts under R56 because this is limited to missing description and/or drawings.

Since no claims are filed, the applicant may file claims of his own volition or in response to an invitation from the EPO under R58 with R57(c), setting a period of two months.

Claims filed after the filing date must not introduce new subject matter (Art 123(2), GL A-III, 15). There is only basis in the description for capsules made from aluminium. The applicant should file a claim to capsules made from aluminium and indicate the basis in the application as filed (R137(4) EPC).

Claims to such capsules are entitled to the priority date of DE-1 because EP was filed within the priority period by the same application, and capsules made from aluminium are disclosed in DE-1 (Art 87(1)). The effective date is the filing date of DE-1 (Art 89).

The article is not prior art. (Art 54(2)).

C can get protection for capsules made from aluminium.

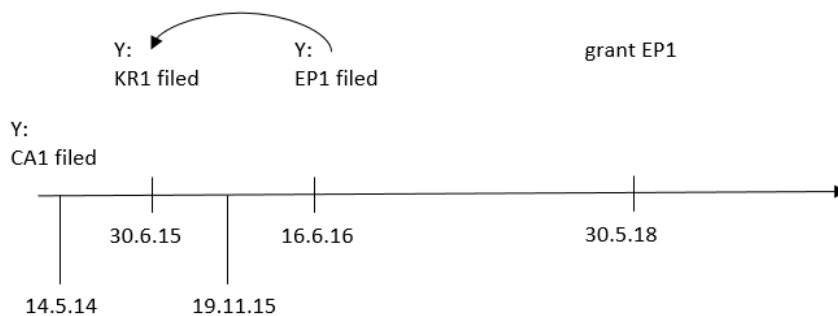
Made from metal

Claim to capsules made from metal would introduce new subject matter. This is not allowed (Article 123(2) EPC)

Applicant may not get protection for capsules made from metal in EP-X.

It is too late to file a new application claiming priority from DE-1 because the priority period has expired (Art 87(1)). The article is prior art for any new application, and the claim to capsules made from metal would not be novel.

Question 4



a) Yes

The sole claim of EP1 to device A does not validly claim priority from KR1 because KR1 was not the first filing by competitor Y for device A (Art 87(1) EPC). CA1 was the first filing for device A by competitor A and it was not withdrawn, refused, or abandoned at the date of filing KR1 without leaving any rights outstanding. CA1 has subsequently been made available to the public (Art 87(4) EPC).

The effective date of claim of EP1 is 16.6.16 (filing date). The publication of CA1 on 19.11.15 is prior art under Art 54(2) EPC and anticipates claim 1. Claim 1 is not novel (Art 54(1) EPC).

The opposition period expires on: 1.4.2019

30.5.2018 + 9m (Art 99(1), R131(4) EPC) → 30.2.2019 (Saturday, R134(1) EPC) → 1.4.2019 (Monday)

I should file an opposition by the date on the ground that claim 1 lacks novelty under Art 54 EPC over CA1 (Art 100(a) EPC) and pay the opposition fee (Art 99(1) EPC)

b) Yes. The previous application KR1 is in Korean, which is not an official language of the EPO (Art. 14(1) EPC) and the validity of the priority claim is relevant to the determination of patentability of the invention of EP1 because CA1 was published in the priority year. The EPO will invite the proprietor to file a translation, or declaration

that EP1 is a complete translation, of KR1, within a period to be specified (R53(3) EPC), which is four months (GL A-III, 6.8.2; R132(1) EPC).

Question 5

The period for paying the additional search fee is one month from the date of the invitation. This expired on 25.2.19 (R40.1(ii) PCT).

Automatic debiting using a deposit account is allowed (OJ EPO 2017, Supplementary Publication 5. Annex 1, hereinafter “ADA”, Art. 3.3(i)).

The decisive payment date was 25.2.19 (ADA, Art. 6.1(a)).

a) Upon replenishing the deposit account today, the EPO automatically debits the additional search fee. The outstanding payment is considered to have been made today, 26.2.19 (ADA, Art 8.)

This is too late. The period was missed. The search report and written opinion are drawn up on the basis of the invention first mentioned in the claims (Art 17(3)(a) PCT). The fee will be refunded.

b) The period for paying the additional search fee is considered to be observed if evidence is provided to the EPO that I gave the order to the banking establishment on 14.2.2019 to transmit 10 000 EUR (Rfees 7(3)(a)(ii)).

No surcharge is required under Rfees 7(3)(b) because 14.2.2019 is not later than 10 days before the expiry on 25.2.2019.

Thus, if such evidence is provided, the deposit account is deemed replenished before the expiry of the period (Rfees 7(3)(a)(ii)) and the date of duly replenishment under ADA Art 8 is considered to have been in time.

The report and opinion are established on the basis of both inventions (Art 17(3)(a) PCT).

10 000 EUR is sufficient to cover the additional search fee of 1775 EUR (Rfees 2(1)2).

Part II

1 a)

EP-F2 claims priority from EP-F1 and was filed within 12m of EP-F1 by the same applicant A. Therefore, to the extent that EP-F2 and EP-F1 relate to the same invention, EP-F2 is entitled to the priority date of 19 January 2018.

Claim 1 of EP-F2 claims a shoe sole (S) comprising metal nanoparticles (NP), whereas EP-F1 only discloses S comprising copper (Cu) NP up to 40 nm.

Since EP-F1 only discloses part of the subject matter of claim 1 of EP-F2, claim 1 of EP-F2 is only partially entitled to the priority date of 19 January 2018. Claim 1 therefore has two priority dates:

C1(i): when S comprises Cu NP up to 40 nm, C1 enjoys the priority date of 19 January 2018 because this is the same invention disclosed in EP-F1;

C1(ii): when S comprises metal NP that are not Cu NP up to 40 nm C1 is not entitled to priority because EP-F1 does not disclose this subject matter. The effective date is 25 February 2018 (the priority date).

For C1(i), the prior art comprises AT-H, published in April 2017, and the content of EP-H as filed because this is an earlier filed European patent application that has been published.

AT-H is citeable for novelty and inventive step. EP-H is citeable for novelty only.

C1(i) differs over both of these documents by having Cu NP up to 40 nm. The priority entitled portion of claim 1 is novel. The features of claim 1(i) surprisingly increase energy storage so that it is inventive.

For C1(ii), the prior art comprises:

AT-H published April 2017;

Announcement B; published on 21 February 2018 and EP-H as published in English on 21 February 2018.

EP-H as filed in Chinese, and made available on publication of EP-H.

EP-H as published in English discloses S comprising Cu particles of from 70 nm to 80 nm. Particles having a size of less than 100 nm are nanoparticles and Cu is a metal, so that this publication in English anticipates C1(ii).

Claim 1 is therefore not novel as a whole over the English publication of EP-H and will not be granted in its current form.

Note also that Claim 1 (ii), and therefore Claim 1, lacks novelty over announcement B of the same date disclosing the same subject matter, and the website bears a date of disclosure of 21 February 2018 so that this is citeable as prior art.

The situation is analogous for claims 2 and 3. In so far as claims 2 and 3 of EP-F2 relate to S comprising Cu NP up to 40 nm, the claim is priority entitled and therefore novel and inventive. However, the other portion lacks priority entitled and therefore novelty over EP-H as published in English and announcement B. The claims as a whole lack novelty and cannot be granted.

1b)

EP-F1 is the first filing for the subject matter S comprises a shoe sole comprising copper nanoparticles up to 40 nm.

This subject matter is novel and inventive for the same reasons given above in respect of claim 1 part (i).

However, EP-F1 was considered withdrawn due to non-payment of the filing fee and search fee on 19 March 2018. The notification of loss of rights triggered a two month period for requesting further processing, which expired in August/September 2018.

Further processing is no longer possible. Reestablishment does not appear to be available because the failure to request further processing seems to have been intentional.

EP-F1 is dead. No rights can be obtained through this application.

1c) EP-F3

The claim in EP-F3 is the first time that F has claimed S comprising metal NP in the range of from 35 nm – 80 nm. However, it is not the first filing in the sense of Art 87(1) EPC because EP-F1 was filed in respect of S comprising Cu NP up to 40 nm, which overlaps with the disclosure/claim of EP-F3.

EP-F3 may therefore only be considered the first filing for S comprising metal NP of from 35 nm to 80 nm that are not S comprising Cu NP up to 40 nm.

Claim of EP-F3 has an effective date of 2 Feb 2018. The prior art is the same as that for C1(i) of EP-F2 and claim of EP-F1.

EP-H constitutes prior art under Art 54(3) EPC. The relevant subject matter is that disclosed in the authentic text of EP-H: the application as filed in Chinese.

The content of EP-H as filed discloses S comprising Cu NP of from 70 µm to 80 µm. This does not anticipate claim of EP-F3. EP-H is not citeable for inventive step.

EP-F1 is not prior art because it is unpublished. EP-H as published in English is not prior art because it was published after the filing date. So too announcement B.

Claim of EP-F3 is novel inventive over AT-H because the specific size of NP is not disclosed and has the effect of increasing energy storage.

However, EP-F3 is dead for the same reasons as EP-F1, the further processing period for EP-F3 having expired in September/October 2018 unobserved.

No patent rights can be obtained through EP-F3.

2.

a) Sole A

F is not free to produce or sell shoes with sole A in Austria because AT-H claims all S comprising nanoparticles and Sole A, which comprises silica NP of from 35 to 45 nm, falls within the scope.

F is free to produce or sell shoes with sole A in Germany because AT-H is in force in Austria and EP-H is limited to S comprising Cu NP having 70 to 80 nm, and silica NP are not Cu NP.

H is free to produce or sell shoes with sole A in Germany or Austria because F has no patent rights. The only patent rights in force belong to H, and H is not prevented by the own patents.

b) Sole B

F is not free to sell shoes comprising Sole B in Austria because AT-H, which covers all S comprising NP. Sole B comprises NP so falls under AT-H.

F is also not free to sell shoes comprising Sole B in Austria or Germany because EP-H covers S comprising Cu NP of from 70 – 80 nm and Sole B falls within the scope. In Germany, the patent entered into force immediately on grant because no translation was required. In Austria, a translation of the patent specification needs to be filed by 16 April 2019, with the payment of a fee and appointment of a representative to validate the patent. It is assumed that these requirements will be met because H is an Austrian company and manufactures in Austria, but this should be monitored.

Again, H is free to sell shoes comprising Sole B in Austria and Germany because F has no patent rights.

3.

Add a priority claim to EP-F2 from EP-F3 by 20 May 2019 (16m from earliest priority date of 19 Jan 2018, extended to Monday).

Claim 1 would then be conceptually divided into 3 parts:

- a) Eff. date 19 Jan 2018: S comprising Cu NP up to 40 nm
- b) Eff. date: 2 Feb 2018: S comprising metal NP from 35 nm to 80 nm that are not Cu NP up to 40nm
- c) Eff. date: 25 feb 2018: S comprising metal NP that are not Cu NP up to 40 nm and are not metal NP from 35 to 80 nm.

For parts a) and b), the prior art is AT-H and the content of EP-H as filed under Art. 54(3). Neither doc. discloses an embodiment within the parts and the claimed particles have the effect of increased energy storage, so that the parts are novel and inventive.

For part c), the prior art includes announcement B and EP-H as published in English. Although novel, it is likely that this part lacks inventive step because S comprising 80 nm to 100 nm are obvious.

Claim 3 would also lack novelty because the part of the claim that is S comprises Cu NP up to 80 nm but not up to 40 nm is only entitled to the filing date of 25.2.2018 and lacks novelty over announcement B and EP-H in English.

So limit to claim 2 to give a claim conceptually divided into:

- a2) S comprising metal NP up to 80 nm that is Cu NP up to 40 nm; Eff. date 19 Jan 2018
- b2) S comprising metal NP up to 80 nm that is metal NP from 35 to 80 nm that is not Cu NP up to 40nm; Eff. date 2 Feb 2018
- c2) S comprising metal NP up to 80 nm that is not metal NP from 35 to 80 nm that is not Cu NP up to 40 nm.

a2) and b2) have the same prior art as for claim 1a) and b) noted on the previous page and are novel and inventive for the same reasons.

c2) has announcement B and english publication of EP-H as prior art.

Both only disclose Cu NP from 70 nm to 80 nm. This does not anticipate c2) because S having metal particles of 35 to 80 nm does not fall within part c2). C2) differs from Cu NP from 70 nm to 80 nm at least in that the NP must be smaller than 35 nm. This could be argued to have the same effect of improved energy storage, so is inventive.

Claim is therefore valid and could be granted.

Actions: add priority claim to EP-F2 from EP-F3
delete claims 1 and 3
request examination and pay the examination fee
waive the R70(2) communication
request accelerated examination
request early publication

To obtain provisional protection and then a patent from EP-F2 as soon as possible.

EP-H

File an opposition against EP-H, paying the opposition fee, by 16 October 2019, on the ground that the patent, and claim, as granted includes added subject matter not disclosed in the application as filed because the application as filed does not disclose nm, only μm .

Even though the patent may be brought into line with the application as filed, in theory, in this case we might succeed in revoking the patent on the basis that correction is not allowable under Article 123(3) EPC because of the claim is to change so much.

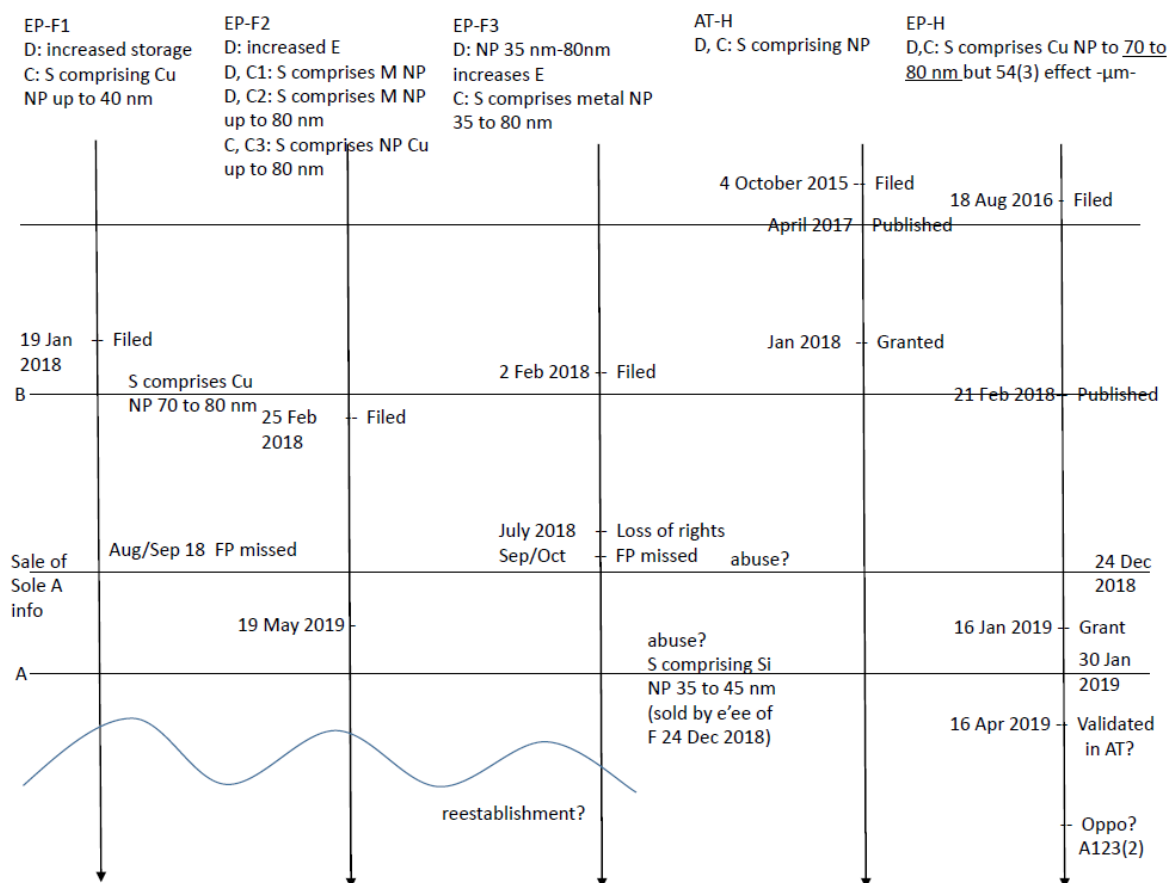
In any case, the amended patent would be amended to 70 µm to 80 µm and would not cover Sola A or B.

F would be free to produce and sell Soles A and B in Germany.

File an application with a claim to soles comprising silica nanoparticles in the range of 35 nm to 45 nm. No basis for a priority claim. File as soon as possible. The employee's letter of 24 December 2018 and the announcement A are not prior art because these are in consequence of evident abuse of F by the employee, provided the application is filed by 24 June 2019.

Novel and inventive because no disclosure of sole A and has increased energy storage. Request accelerated search, examination, early publication, waive R70(2), request exam. And pay exam fee to get patent a.s.a.p. Can use to stop H from producing and selling Sole A in Austria and Germany.

Consider cross-licencing rights to Sole A from EP-NEW and Sole B under EP-F2 to H in exchange for rights to sell both soles under AT-H in Austria.



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

Category		Max. possible	Marks Marker 1	Marker 2
Part I	Part I - Question 1	9	6.5	7.0
Part I	Part I - Question 2	7	6.5	6.5
Part I	Part I - Question 3	9	9.0	9.0
Part I	Part I - Question 4	7	5.5	5.5
Part I	Part I - Question 5	8	5.5	6.0
Part II	Part II - Question 1a	17	15.5	16.0
Part II	Part II - Question 1b	2	2.0	2.0
Part II	Part II - Question 1c	2	2.0	2.0
Part II	Part II - Question 2a	4	4.0	4.0
Part II	Part II - Question 2b	8	8.0	8.0
Part II	Part II - Question 3	27	21.5	21.0
Total			86.0	87.0

Examination Committee III agrees on 87 points and recommends the grade PASS