

Part II

II A

1. C's PCT application

1.1 The "priority application" was not the 1st US applⁿ for the tool concerned; it was a continuation of US-XXX,XXX. Therefore (Paris Convention, Art. 4A(1) & 4C(1) &(2)) the application cannot give rise to a valid right of priority

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for the PCT application (PCT Art. 8(2) - conditions for priority governed by Paris Convention), unless the 1st US application was abandoned before the 2nd one was filed (Paris Convenⁿ, Art. 4C(4)). To give rise to a continuation application, XXX,XXX cannot have been abandoned at the time the continuation application was filed. Thus, the continuation application cannot give rise to a priority claim for the PCT applⁿ, which was filed more than 12 months from the 1st application (XXX,XXX) for the tool. The PCT applⁿ is only entitled to its date of filing, 30.1.92, and not to any earlier priority date.

- 1.2 The US patent published on 30-6-92 is not prior art citable against the PCT application or, in particular, against any EP applⁿ derived from the PCT - it was published too late (EPC Art. 54(2)).
- 1.3 You say the PCT application designated all EPC Contracting states. I assume they were designated with a request for an EP patent, so that the PCT applⁿ may later give rise to an EP applⁿ. The advice below may differ slightly if the states are designated nationally only - effects of the resultant national applⁿs depend then on national law.
2. A's company's EP application
- 2.1 The priority claim from the Swedish applⁿ seems to be valid - the EP applⁿ was filed within 12 months of the Swedish filing date (EPC Art. 87(1)). You also say there were no formal deficiencies in the application. Thus, the EP applⁿ validly claims a priority date of 31-1-91, for all EPC contracting states.
- 2.2 There is adequate support in the EP applⁿ for later claims to the BRIGHT IDEA (B.I.) because it is mentioned in the description. B.I. is entitled to the 31-1-81 priority date because it is mentioned in the Swedish description (EPC Art. 88(3) and especially (4)).
- 2.3 You say you want to abandon your EP application. Do not do so until you have decided how to protect the B.I., eg. by filing a valid divisional applⁿ (see later). A divisional can only be filed while the parent EP applⁿ is still pending (EPC Rule 25(1)).
3. Effect of the EP applⁿ on C's PCT applⁿ
- 3.1 Assuming C proceeds with his PCT applⁿ into the European regional phase, A's EP applⁿ will be prior art citable against C's EP applⁿ under EPC Art. 54(3). It has an earlier priority date (31-1-91) than that of C's applⁿ.

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(30-1-92) but was published after C's applⁿ's "priority (ie. filing) date. Thus, to the extent that C's claims lack novelty over what is disclosed in A's EP applⁿ, C's claims are invalid. This applies with effect for all EPC contracting states designated in A's applⁿ. C's claims to the tool itself, identical to the egg beater disclosed in A's applⁿ, are invalid for lack of novelty, as are C's claims to the use of the tool to pick up elongated elements (A's disclosure of spaghetti) by vertical-type rotation.

3.2 C could still obtain claims, in such an EP applⁿ, to the use of the tool by rotating it with its axis held horizontal - there is support for this in C's US patent & hence, I assume, in the PCT applⁿ that tried to claim priority from it. Such use claims would be novel over the vertical-type use disclosed in A's applⁿ. However, they would be limited to a use of the tool which A maintains does not work anyway. Thus, not only are such claims of little commercial use, they are also arguably invalid for insufficiency (EPC Art. 83) because the skilled man could not make the claimed invention work. Moreover, they would be difficult to enforce - C would have to sue his own customers for using the tool in a particular way & prove that they were doing so, or sue others for selling the tool and prove that the sales were such as to induce the user to use the tool horizontally (exact remedies depend on national law).

Note: the horizontal use is arguably disclosed in A's applⁿ, tho' for a different purpose - unlikely to destroy novelty of C's claims.

3.3 For the invention disclosed in A's EP applⁿ, A is entitled to the grant of a European patent in preference to C, since A's application has the earlier filing (priority) date & has been published under EPC Art. 93 (EPC Art. 60(2) & Art. 89). This applies for all states designated in A's EP applⁿ as published (EPC Art. 60(2)).

3.4 Note C could also still obtain claims to the use of the tool to pick up yarn, since this appears to be novel over A's disclosures. Again, such use claims would be hard to enforce.

4. What action should A take?

4.1 The invalidity of C's priority claim, & of certain of his claims, should be seen by the EPO if & when he proceeds to the EPO regional phase. However, it does no harm to file observations on these issues with the EPO under

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Art. 115(1) EPC. A can file such observations anonymously, & does not thereby become a party to proceedings before the EPO. The observations can only be taken into account by the EPO once regional processing of C's application starts, but they can be filed now (the PCT publication on 6-8-92 takes the place of European publication (EPC Art. 158(1)), allowing observations to be filed afterwards). When the EPO starts to examine C's applⁿ, it should cite A's applⁿ against it (EPC Art. 97(1) & Art. 54(3)) & require restriction of C's claims.

4.2 No need for A to stop marketing the B.I. in Europe, since C does not appear to be entitled to protection for the tool in Europe and A, on the contrary, does. Care to market with instructions for use in vertical orientation - no risk of conflict with any claims C may get. I assume from what you say of C's marketing plans that he has not yet made the tool public in Europe - had he done so prior to A's priority date (31-1-91) he might be entitled to continue such use in certain countries, despite any claims which A might be granted (rights depend on national law).

4.3 If C goes ahead & markets the tool in Europe, he risks infringing claims which A may eventually be granted for the B.I. A has provisional protection against such use, dating back to the EP publication date of 13-8-92 - this gives him the right to claim reasonable compensation for C's activities falling within the scope of A's claims. However, A needs to file translations of his claims in some countries to be sure of his rights (EPC Art. 67(3)) - this depends on the national laws of the countries concerned & applies in those states which do not have English (the publication language - EPC Art. 14(3) & 14(6)) as an official language. The claims translations can be sent to C directly or filed with, & published by, the national Patent Offices of the relevant states - C should put this in hand for those European states in which he has a commercial interest.

5. Miscellaneous

5.1 Patentability of the B.I. - should be patentable under EPC law (EPC Art. 52). It is industrially applicable &, so far as we know from prior art of which we are aware, novel & inventive. Has advantages (see top of p. 2 of A's letter) to lend possible inventive step over prior art.

5.2 Request for a copy of the US priority application from WIPO - since the PCT applⁿ has been published, WIPO should send a copy of the priority applⁿ to anyone on request & on payment of a fee. They will not do this if,

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prior to international publication, the PCT applⁿ. has been withdrawn or the priority claim withdrawn, considered not made or cancelled. (PCT Rule 17(2)(c)). It could be that WIPO's failure to send a copy to A means that C has already withdrawn the priority claim, but we cannot check this until the PCT applⁿ. is nationalized.

5.3 National law - if C's PCT applⁿ. only designates individual EPC states, then the effect of A's EP applⁿ. as prior art against C's national applications, & A's entitlement to grant of a patent instead of C, depends on national law in each state. National laws in Europe are broadly similar to European law in this respect; A's C^o. is entitled to the earlier priority date & is safe to go on using the tool.

5.4 In some countries (depends on national law), A's C^o. may be able to take action against C for unjustified "threats" of "legal action" under C's patent applⁿ. Consult local patent agent/lawyer in states of interest.

II B

1. Problems with the divisional application

1.1 The divisional cannot be filed at the Swedish Patent Office, only directly at the EPO (EPC Art. 75(3) & Art. 76(1)). A will have to ask the Swedish P.O. to forward his papers to the EPO, or send a fresh copy to the EPO - date of receipt at the EPO will be the divisional's filing date.

1.2 Ireland cannot be added to the designations. The divisional can only designate states designated in the earlier EP applⁿ. (EPC Art. 76(2)). The EPO will treat the IE designation as invalid.

1.3 The designation of inventor will need to be corrected, since it appears that B invited the B.I., not A. A request for correction will need to be filed at the EPO if the original papers are forwarded to them. The request must be filed by, or be accompanied by the consent of, the applicant C^o. It appears A was correctly designated, since he invented the tool itself; his consent is therefore not needed for the addition of B as co-inventor (EPC Rule 18(1) as interpreted by LBA case law).

1.4 The request for grant, as well as indicating that the application is a divisional (which indication should be typed, not hand-written EPC Rule 35(10)), should indicate the filing n^o. of the earlier EP applⁿ. (EPC Rule 26(2)(e)). Both these defects can be corrected later, on invitation by the EPO under Art. 91(1)(d) &

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91(2) (2 months allowed usually) - if not corrected, the applⁿ will be refused (EPC Art. 91(3)).

1.5 Fees need to be paid on the divisional:

filing fee	}	
search fee	}	within 1 month of filing
designation fees	}	divisional (EPC Rule 25(2)).

No renewals yet.

Grace period for above fees - 1 month from notification by EPO of failure to pay; surcharge payable (EPC Rule 85a).

1.6 The description, claim, drawings & abstract filed are OK, so long as the subject matter of the claim does not extend beyond the content of the earlier application as filed (EPC Art. 76(1)). More copies of these documents may be needed if they weren't filed in triplicate, but can be supplied later in reply to an EPO invitation (EPC Art. 91(1)(b) & (2)).

1.7 A copy of the original request for grant is insufficient in that an original signature is needed, of the applicant or an authorized representative (EPC Rule 26(2)(i)). Again, a fresh copy with an original signature can be filed in reply to an EPO invitation. (EPC Art. 91(1)(d) & (2)).

1.8 A designation of inventor with original signature is also needed - this can be provided in reply to an EPO invitation under Art. 91(5) & Rule 42(2) - at least 2 months from notification of the invitation is allowed for this (Rule 42(2)).

1.9 An original signature is also needed for the authorisation. This can be filed within 1 month of an EPO Rule 101(1) invitation to file a correct authorization (authorization needed because A acts as an employee of the applicant C^o - EPO President's decision).

1.10 A certified copy of the priority application, and a translation into one of the EPO official languages, will also need to be supplied in reply to an EPO invitation under Art. 91(1)(d) & (2) - 2 months from the invitation, however long this is after the priority date (LBA case law).

1.11 Note that because the divisional applⁿ has as yet no official EPO filing date, time periods for the above acts have not yet started to run. The important thing is to establish an EPO filing date a.s.a.p.

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2. Status of the earlier EP application

2.1 It is vital that the earlier application be in force at the date the divisional is filed. No renewals are due on the earlier applⁿ until 31-1-94 (EPC Rule 37(1)) but a request for substantive examination should be filed within 6 months of publication of its search report (EPC Art. 97(2)) so as to keep the earlier application pending.

Thus, check when the search report is to be/has been published; it is as well to file a divisional before this six month period expires, since then the earlier application can be allowed, subsequently, to expire by not paying the examination fee. The earlier applⁿ remains pending until the end of this period whether the exam fee is paid or not.

3. Other ways of protecting the B.I.

3.1 You could keep the earlier applⁿ pending, & simply file a new claim to the B.I. by way of an amendment under EPC Rule 86(2), allowable because the search report has already been received. The amendment appears to be supported by parts of the original description, & hence does not contravene EPC Art. 123(2) (addition of subject matter by amendment).

3.2 On examination by the EPO Examining Division (E.D.), the new claim would be found to lack unity (EPC Art. 82 & Rule 30) with those already searched, since it concerns a different invention in a different technical field and with a different use. The E.D. would then invite you to file a divisional covering the new claim, so that it could be searched and examined in its own right. This would delay the cost of filing a divisional, but force you to pay 2 exam. fees - one on the divisional & one on the earlier application. (NB, it is a moot point whether the E.D. will examine a claim, not previously searched but supported by the original application, without the filing of a divisional - question recently referred to the EBA.)

II C Final advice

In view of the points above, the safest option has to be to file an EP divisional application covering the B.I. specifically.

Filing a divisional now rather than later probably allows you to avoid paying an exam fee on the earlier application. It also means the divisional will be examined sooner, which is of use

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if C intend to enter the European market soon with a potentially infringing device.

For the same reason, you may want to request accelerated prosecution of the divisional applⁿ, with a reasoned request to the EPO. Paying the exam fee at this stage & requesting unconditional examination (ie. regardless of search results) would also help speed things up).

As for the already-filed divisional, find out what the Swedish P.O. has done with the papers & ask them to return them or forward them to the EPO. In the former case, file a fresh divisional at the EPO asap, avoiding the problems referred to in (B).

So long as the 1st EP applⁿ is kept pending until the divisional has been filed (EPC Rule 25(1)) and for all subject matter contained in the 1st applⁿ, a divisional can still be filed for the B.I., entitled to the same priority date as the earlier applⁿ (EPC Art. 76(1)).

NB New divisional claim must be filed in English (EPC Rule 4).