
GENERAL

The results this year show a marked improvement over those of previous years.

The provision of extra time seems clearly to have helped and this year there was less impression that the last parts of the papers had been rushed. Also, it seemed clear to some examiners that candidates they marked were better prepared for the examination.

The incomplete answers of some of the candidates to Part I showed that it is necessary to be familiar with the law before taking the examination and that it is not possible to rely on speed reading of texts during the examination itself. Some very bad Part I answers demonstrated that there were candidates who thought otherwise.

Yet again, it was clear that many candidates were using out of date revision material. If, on a subject, a legal advice or President's Notice is republished, this would normally indicate some change in the substantive content of the notice. Obviously, candidates need to keep their reference material current and up to date.

Candidates should also realise that inappropriate recommendations to the client, to use Art. 121 and/or Art. 122 EPC and/or to file an appeal, may cause them to lose marks.

PART II

Candidates should use the facts as given and seek to use all the facts. The question is unlikely to contain redundant or irrelevant information. Significant facts or scenarios are included for a purpose.

Also, in this part the examiners are expecting candidates to demonstrate an ability to use the law and practice to solve the problems set. They are not expected to simply list formal details of fees etc. at every opportunity and are unlikely to gain any extra marks for the excessive detail provided.

Candidates really should remember that it is for us to ask the questions and not them! Many wrote to Mr. Renoir setting out questions that came to mind and giving various possible answers or subsidiary questions without giving any conclusions or positive advice. A client expects to be advised and not to produce the answers himself.

Those candidates that used a time line clearly benefited from its use. However, solely producing the time line does not constitute an acceptable answer on its own, even if some of the necessary information can be obtained from it by the examiner.

It is clear that A1-EP has an invalid claim for priority and many candidates recognised this. However, too many assumed a late transfer would suffice. The use of the priority claim in this application was invalid from the beginning and later correction based on the facts supplied was not acceptable. Telling the examiner that you propose to lie or have your client lie or falsify documents in his submissions is not what the examiners expected to see in the answer.

Many candidates concentrated on the details of priority and for filing formalities etc., without considering the content of the question and the need of a client to have good practical advice. Candidates were thus expected to consider and advise on the subject matter to be covered in a proposed application.

Candidates should discuss all the different aspects that are mentioned and, in particular, should answer the specific questions asked in the paper. Many candidates failed to say whether A1-EP or B-PCT could be continued with or not.

Very few candidates thought to suggest checking whether or not B-PCT was entitled to its priority, which should have been one of the first things to check. Also, a lot of the advice was directed at the Russian applicant and not, necessarily, in the best interests of the client. Some candidates confused patentability with the right to use.

Very many candidates were unaware of the possibility of reintroducing substance claims on appeal. Others wrongly assumed that the client could actually lodge the appeal on Z1-EP as of right because he would be adversely affected by its limitation.

The naming of joint applicants and different applicants for different PCT states was often poorly understood.

MODEL SOLUTION FOR PART II

Dear Mr. Renoir,

Following your visit I have considered the questions you raised and, on the basis of the information you gave me, I set out below my answers to those questions and my further advice, including suggestions with regard to the actions I feel you should take.

1. Can A1-EP be continued with and how can we best protect the coating and spraying inventions?

a) Status of A1-EP:

Application A1-EP can be continued with. It was filed in March 1999 and there is, therefore, still time to pay the necessary fees and to file the translation of the text into an EPO official language. If this is to be done, your right to be named as an inventor of the application as filed should be checked.

However, I do not think continuation of A1-EP is the best course to be followed since the claim to priority from A-FR is not valid because the applicant for A1-EP was neither the same as that for, nor the legal successor to, the applicant for the priority application, A-FR.

A subsequent partial transfer of rights would not render the priority claim valid.

The exhibition in Monaco was not one recognised under Article 55 EPC and, even if it had been recognised, the formalities required by Article 55(2) EPC were not fulfilled. Therefore, the presentation and oral disclosure at the exhibition may be a bar to patentability for A1-EP and the written report would provide evidence of the disclosure even if published after the A1-EP filing date. The spraying apparatus of A-FR has probably, therefore, been disclosed at the exhibition and thus is not validly claimed in A1-EP even if contained therein. Nevertheless, the improved spray system with the vacuum box, of A1-EP, is probably still patentable following the exhibition.

b) Proposal for action on A-FR and A1-EP:

Instead of continuing with A1-EP, a new EP application should now be filed describing and claiming the coating system, the basic spraying system and also the improved spraying system not disclosed at the exhibition. Both the priority of A-FR and the priority of A1-EP should be claimed, the former being valid for the coating and basic spraying systems and the latter for the improved spraying system. X and Y should be co-applicants and Goya and yourself designated as co-inventors.

If the filing is made in Spanish reduced fees can be obtained.

Should protection be required outside the EPC states, the new application could be filed as a PCT application with the appropriate designations.

Division of the application into separate applications for coating and spraying may be required later during the prosecution of the new application.

A1-EP should be abandoned or withdrawn.

If B-PCT is deemed to be withdrawn or is abandoned, then its content will not in respect of the new application constitute prior art for novelty purposes, as a prior application under Article 54(3) EPC, with respect to the cylinder coating system having priority from A-FR. However, if B-PCT has entered the EP regional phase with a valid priority, it will become relevant prior art under Article 54(3) EPC against the cylinder coating system with respect to those states designated in common with the new application under the EPC. The basic spraying apparatus covered by the new application will be novel, however, as may the specific coating apparatus.

With regard to the improved spraying system, B-PCT is only pertinent with respect to consideration of the obviousness of the new system.

The disclosure at the exhibition post-dates A-FR and is thus not prior art with respect to the coating system and basic spraying system. This disclosure does pre-date A1-EP but is only pertinent for obviousness with regard to the improved spraying system.

2. Could Moscow Cardboard Institute (MCI) continue with B-PCT and would we require a licence to use their cylinder coating invention?

a) Status of B-PCT:

Yes, B-PCT could be continued with by MCI if they desire.

The 15th March 1999 date referred to by their patent agent is certain to be the date for filing the demand for international preliminary examination under the PCT. This date is the only due date at 19 months from priority and has been missed. However, this does not prevent MCI from proceeding with normal entry into the PCT national and regional phases without international preliminary examination.

MCI have a time limit of 20 months from priority for entering the US national phase and thus they have until 15th April 1999 to complete the procedures for this entry.

The corresponding time limit for entering the EPO regional phase expires on 15th May 1999. By this date they have to file a translation of the application into English, French or German and pay the necessary fees for entry to the EPO procedure.

b) Proposal for action with respect to B-PCT:

The validity of MCI's claim to priority needs to be checked. If the priority claim is not valid, X has prior rights to MCI with respect to the coating system. Therefore, to check the claim for priority, a copy of the priority document should be obtained from WIPO.

If the priority is valid and B-PCT enters the regional phase before the EPO, exploitation of the system by X and Y may be impeded. However, if the priority is valid B-PCT will have the earliest date there could thus be an advantage in keeping the patent alive provided you obtain ownership of a licence under it, on a reasonable basis. Thus to get the best protection Mr. Soutine of MCI should be persuaded to keep B-PCT alive so that it would be possible for you to take over and prosecute the application or alternatively take a licence under any granted patents.

If B-PCT is allowed to die, however, you will not need a licence for Europe or the USA. Similarly if the priority claim is invalid you will not need a licence.

Therefore, if you do not want to take a licence or pay for assignment of the application, you should not encourage Mr Soutine to continue with MCI's application. If the application is not continued with then, provided there has been no publication of MCI's coating system or any other equivalent system prior to the date of application of A-FR, you will obtain protection for that system with the new application proposed above.

3. Is there anything that can be done to save something from Z1-EP and to obtain damages from M?

Revocation of a patent has retroactive effect such that the revoked patent is deemed never to have existed and, therefore no infringement damages would be liable for the time such a patent or its application were alive prior to revocation. However, an appeal against revocation under the EPC has a suspensive effect on the revocation and, theoretically, M could be sued for infringement whilst the appeal is pending.

In accordance with Board of Appeal decision T 123/85, Z did not irrevocably surrender the claims directed to the composition Z1 when requesting the patent to be maintained in limited form during the opposition proceedings. On appeal, Z is entitled to reintroduce into the claims the subject-matter he previously offered to delete. Should such claims be reintroduced and the appeal be successful, the products of M infringe and damages may be obtained, even for the period when the proposed limitation existed.

Only Z is entitled to appeal. Z should, therefore, both file a notice of appeal against the decision and pay the appeal fee within two months from receipt of the written notification and file the grounds of appeal within four months of that receipt. The product claims should, of course, be reintroduced when filing the grounds.

It is also possible for Z to ask for an accelerated appeal procedure in view of the alleged infringement by M.

Please note, the date of the decision at the oral proceedings is different from the date of written notification of the decision. I am not aware of the date of receipt of the notification but, even if it were issued on 20th January 1999, we are still within the 2 months period for filing an appeal since 10 days are also allowed for its receipt.

Z should be sure to pay any renewal fees that fall due during the appeal procedure.

[Although not related to this specific question, I should mention that it would also be possible to include description and claims covering the use of Z1 in the apparatus of A-FR and A1-EP in the new application proposed under 1. above.]

4. We want the best protection possible (for Z2) both in Europe and the USA against competitors and would like to minimise costs during the next few years; what would you suggest that we do in the near future?

Under the PCT it is possible to have different applicants for different states in one PCT application. Therefore it would be best if a PCT application were filed for Z2, claiming priority of BE-Z2 and naming X and Z as co-applicants for EP. For the USA it is essential that the applicant is the inventor and, therefore, Van Dongen will have to be named not only as inventor for the invention Z2 but also, only for the USA, as a further PCT applicant. Additionally, Z should be specified as the sole applicant for Eastern Europe. Not all of the Eastern European states need to be prosecuted separately since some of the Eastern European states can be covered, as a result of their having extension agreements with the EPO, on the basis of the EPO examination procedure.

The application should include claims covering all inventions. In particular the composition of Z2 should be covered, as well as its uses as an additive for paper and as a waterproofing agent for cardboard.

In the European regional phase X and Z will remain as co-applicants but they should have a signed agreement covering ownership of the rights with regard to the different uses of Z2 in their respective fields.

Normally the inventor should sign the application as applicant for the USA. It seems likely that you will not be able to obtain Van Dongen's signature but the application can, nevertheless, be filed without his signature and an explanation can be provided to the PCT receiving Office thus enabling the obtaining of protection in the USA. The transfer of the US application from Van Dongen to X may be done at the US national phase.

Clearly it will be necessary to pay all the necessary fees and to file the application at an appropriate receiving Office, for example the EPO or WIPO.

It will be possible for X to act as the common representative and he can be specifically named as such or can simply be the first named applicant.

Paper D Schedule of marks

Question	Maximum Possible	Marks awarded		Marking by further examiners	
		Exr	Exr	Exr	Exr

PART I

1	2				
2	6				
3	4				
4	4				
5	6				
6	4				
7	4				
8	4				
9	7				
10	4				
Total Part I	45				

PART II

A1	10				
A - FR	10				
B - PCT I	4				
B - PCT II	8				
Z1	11				
Z2	12				
Total Part II	55				

Total Part I + II 100					
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	PASS
	COMPENSABLE FAIL
	FAIL

Munich, 10 September 1999

I. Muir - Chairman of Examination Committee III