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## Candidate's Answer on Paper D, Part II

1. FORM-EU2 contains a description of both SAD FORM and SAD FORM 2.

SAD FORM is also disclosed in FORM UK-1 from which priority is claimed. On the assumption that FORM-EU2 validly claims priority from FORM UK-1 the subject matter common to both applications will be entitled to the benefit of the priority date of FORM UK-1, ie 24 July 1998 (A. 87/88 EPC).

It appears that priority has validly been claimed under A. 87 EPC because the twelve month period for doing so, running from the filing date of FORM UK-1, would be extended until 26 July 1999 under R. 85(i) EPC because 24 & 25 July 1999 were days on which at least one of the filing offices of the EPO was closed.

Therefore, it appears that a valid patent can be obtained for the subject matter common to both FORM-UK1 and FORM-EU2, ie SAD-FORM, because the article in the Journal of Soap Chemistry was not published until 1 April 1999, after the filing of FORM UK-1.

Whether valid protection can be obtained for SAD FORM 2 is uncertain.

The Soap Chemistry journal will be prior art under A. 54(2) EPC in relation to any claims of FORM EU-2 directed to SAD FORM 2, because these claims will not be entitled to the benefit of the priority date of FORM-UK1, even though they may contain matter from FORM-UK1. This follows from 63/93.

Whether valid protection for SAD FORM 2 per se can be obtained will depend upon whether claims to SAD FORM 2 distinguish inventively over the disclosure in the Soap Journal article. (A. 56 EPC).

We are told SAD FORM 2 is commercially very important, this could be an indication that it improves over SAD FORM and is therefore arguably not obvious over SAD-FORM.

Whether or not protection can be obtained for SAD FORM 2 per se, claims to SAD-FORM may well (and probably do) cover SAD FORM 2 as SAD FORM 2 is described as an "embodiment of SAD FORM". Would need to check this.

2. So far as SAD-FORM is concerned it is no longer possible to file priority claiming applications directed to this invention, because more than 12 months has elapsed from the filing of FORM UK-1, the first application for that subject matter. A. 87(1)(4) EPC, A. 4 C(2) Paris Convention.

It is also too late to file a non priority application in the US as over a year has elapsed from publication of the Soap Journal article on 1 April 1999. Cannot therefore take advantage of the 1 year grace period.

Protection for SAD-FORM cannot be obtained via non-priority applications elsewhere because of disclosure of SAD-FORM in Soap Journal article.

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In order to obtain protection for SAD-FORM in Europe, FORM-EU2 should be continued, bearing in mind that this may also cover SAD FORM 2.

Assuming that FORM EU-2 is still pending\*, next action required will probably be to pay designation fees and request examination (including paying examination fee), if not already done so, within 6 months of publication of the European search report, (A. 94(2), A. 79(2) EPC). Extension fees for any extension states should also be paid then. Renewal fees will also be payable from end of July 2001 (A. 86, R. 37 EPC).

To seek protection for SAD-FORM 2 (on basis this does distinguish over SAD-FORM and/or on basis that it is worth attempting to seek protection, in any event, because of commercial importance) and the new invention using oil I would recommend the filing of a new PCT application directed to SAD-FORM 2 and the new method of mixing the pharmaceutical with oil.

The application should designate all available states, which is quite economic as the maximum number of 8 designation fees would be payable under R. 4.9a PCT, PCT Schedule of fees.

Sadly Resources should be applicant for all states except US where inventor(s) should be named as applicants, to meet requirements of US law. It may be necessary to take an assignment from Gobbleup and/or name other inventors depending upon who invented the oil's development.

Application should claim priority from FORM EU-2, but would only be entitled to the benefit of the filing date of EU2 in respect of the matter mentioned in EU2 but not in FORM UK-1, ie: SAD FORM 2. That is, the subject matter for which FORM-EU2 is the first filing.

Claiming priority from EU2 will be essential if EU2 has been published, if valid protection in other countries were to be sought. EU2 would be published under A. 93 EPC as soon as possible after 18 months from its priority date, ie soon after 26/1/2000 and has therefore most likely been published.

To defer costly entry in the national/regional phase of the PCT application a demand for the International Preliminary Examination should be filed within 19 months of priority, A. 39 PCT. That is 19 months from 26 July 1999, this is 26/2/2001. This will delay the deadline for entry into the national/regional phase until at least 30 months from the priority date, 26/7/99.

This will give the company the 18 months it requires to assess the commercial value of the inventions as well as a preliminary view on patentability at less cost than filing individual national applications.

Preliminary examination fee and handling fee to be paid within 1 month of submission of demand, R. 57.3, 58.1(6) PCT.

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\* (can infer that FORM EU-2 is pending because search report has issued)

Further thoughts on question 1

Could publication of Soap Journal article be non-prejudicial to FORM-EU under A. 55(1)(a) EPC because it was an evident abuse in relation to Sadly Resources and FORM-EU was filed within 6 months of 1<sup>st</sup> April 1999?

Unlikely because Blowit appears to be within the terms of his agreement with Sadly Research because he did not disclose anything until filing of FORM UK-1 and then no more than the contents of FORM UK-1.

3. Because the 12 month priority term has expired it is no longer possible to file new applications claiming priority from PROT-EU1.

It will not be possible to obtain valid protection for the contents of PROT-EU1 by filing any new applications because PROT-EU1 will have been published under A. 93 EPC, as soon as possible after 18 months of its filing date ie, soon after 14/7/98. It will also not be possible to obtain valid protection for the use of the protein SAD PROT as a medicament because of the disclosure of its use as such in the American Air Force article published last week.

Basis for any valid protection must be PROT EU-1.

Notification of communication from the Examining division will be deemed to have taken place ten days from its date of despatch, ie 14 September 1999 (R. 78(2) EPC).

Extended 6 months term would expire 14/3/2000, R. 83(4) EPC. Deadline for reply would be 15/3/2000 under R. 85(1) EPC.

It is therefore too late to respond. Application will therefore be deemed withdrawn under A. 96(3) EPC. [We do not know if the two month extension request was granted – it probably was in accordance with Guideline E VIII 1.6]

A communication noting this will be (or may already have been) despatched under R. 69(1) EPC.

It will still be possible to proceed with the application by filing a request for further processing in writing, paying the fee for further processing and responding to the communication from the Examining division within 2 months of notification of the communication under R. 69(1) EPC. See A. 121 EPC.

Even if the communication under R 69(1) EPC was dispatched 16/3/2000 there is still time to request further processing.

Need to check if R. 69(1) communication has been received and note deadline, if not, it is possible to request further processing before receipt of R. 69(1) communication.

When responding to the examination report appropriate arguments/amendments should be submitted with a view to seeking protection for the method of isolating the protein.

Protection is also to be sought for SAD PROT, which is disclosed in PROT EU-1.

It will probably not be possible to introduce a claim to SAD PROT because it would relate to unsearched subject matter and would thus not be admissible under R. 86(4) EPC. May be worth trying, though, to obtain view of Examining Division by filing amended claims in response to communication.

If introduction of a claim to SAD PROT is not allowed, or in any event, a divisional application could be filed under A. 76 EPC, claiming SAD PROT.

Deadline for filing a divisional would be deadline for approval of text of PROT EU-1 to be granted. This may not be for some time, nevertheless a divisional can be filed at any time before then.

Would need to file at EPO in Munich, The Hague or Berlin. Search, filing, designation fees would need to be paid within one month of filing R. 25(1) EPC. Renewal fees in respect of 3<sup>rd</sup> and 4<sup>th</sup> years would be due within four months of filing, R. 37(3) EPC. Examination fee would also need to be paid, within 6 months of publication of search report on divisional – A. 94(2) EPC.

Only states designated in PROT EU-1 may be designated in divisional. A. 76(2) EPC.

Need to check if 4<sup>th</sup> year renewal fee, due 31/1/2000 under A. 86(1), R. 37(1) EPC, in respect of PROT EU-1 was paid. If not, it can be paid up until 31/7/2000 under A. 86(2) EPC.

It should be possible to seek valid protection for the isolation process and SAD PROT (subject to prior art) in UK, France and Germany – the countries designated in PROT EU-1 and which can be designated in any divisional.

Further states cannot now be designated. PROT EU-1 filed 14/1/97 – designation fees due one year from filing under old Article 79(2) EPC, even taking into account old precautionary designation system, and transitional provisions for new A. 79(2) EPC it is too late to add other designations now.

Designations could not, in any case, usually be added after publication of the application J 3/81.

4. Details of SAD PROT will have been disclosed on a publication of PROT EU-1, probably in July 1998.

Any application for a European patent for SAD PROT per se with a priority date after July 1998 would therefore not result in valid protection. The American Air Force's work was carried out in 1999 so they cannot have filed an application directed to SAD PROT before publication of PROT EU-1. Therefore they cannot get valid protection for SAD PROT per se.

They may, however, be able to get protection for the use of SAD PROT in Europe as a medicament, particularly for treating jet lag, if they filed an appropriate European patent application or foreign patent application from which priority could be claimed prior to publication of the results of their research work.

If they obtained a European patent they could prevent Sadly Resources selling SAD PROT for use as a medicament. However if Sadly Resources obtain a patent for SAD PROT per se they could prevent the US Air force selling SAD PROT for any purpose in the countries where protection is secured (probably GB, DE, FR). Thus, there would be a potential to negotiate a cross licence with the American Air force whereby Sadly Resources give permission to sell SAD PROT in return for permission to sell it as a medicament.

As any patent application filed by the American Air force would post date PROT EU-1 it could not affect progress of PROT EU-1 or any divisional which would benefit from the filing date of PROT EU-1.

## 5. General

To be cited in the search report the PCT application must have been published. As it was not entered into the nat. US or reg. EP phase it cannot hinder the exploitation of SAD ENZ in those countries.

Publication of PCT rules out protection being sought for SAD ENZ per se.

Protectable inventions appear to be Fat Cat's high yield process and the activity of SAD ENZ, ie use as a medicament both generally and for treatment of obesity/as a slimming aid.

To obtain protection for Fat Cat's high yield process it is necessary to retain 7/4/99 priority date of FAT EU – due to subsequent disclosure of process by Dr Puss in interview in newspaper report. FAT EU will be considered withdrawn through failure to pay filing and search fees in time.

Refund to fees paid on ENZ EU cannot be obtained. Filing fee cannot be refunded and search has been carried out therefore search fee cannot be refunded – A. 10 RRF.

### Situation a

Take assignment of FAT EU.

File new application (preferably PCT to keep options open and costs down for next two years) directed to:

Fat-Cat's method of producing SAD ENZ and activity of SAD ENZ (ie combination of FAT-EU + ENZ-EU). Claim priority from both FAT EU and ENZ EU.

Application will need to be filed by 9 April 2000, (A. 8 PCT + A. 4 Paris Convention).

Priority can be claimed from European Applications as they are equivalent to a regular national filing (A. 66 EPC) as required by A. 4 A(2) Paris Convention.

Designate all states, therefore keep options open whilst paying max. 8 × designation fee. (R 4.9(a) PCT + PCT Fee Schedule)

Deadline is close, can file application by fax on last day if necessary at UK or European office (at least. but UK/EP probably most convenient).

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Request should be made under R 4.11 PCT asking the ISA (which will be EPO) to base search on earlier search of ENZ-EU.

Partial refund of search fee may be requested from EPO, in view of search already carried out.

Will need to pay transmittal fee (R. 14 PCT), Basic Fee (R. 15.1(i) PCT) and designation fees (R. 15.1(ii) PCT) within one month of filing.

The search fee should also be paid 1 month from filing.

A demand for international preliminary examination should be filed within 19 months from priority\*\* (A. 39 PCT) and the fee for international preliminary examination + handling fee paid within 1 month of submission of the demand (R 57.3, 58.1(b) PCT).

The application will be subjected to a preliminary examination and the deadline for entry to the national/regional phase and its associated expense delayed from at least 20 to at least 30 months from priority.

It is noted that a new application of some sort is required, in any event, to maintain the priority date of FAT EU as it will be deemed withdrawn under A. 90(3) EPC for failure to pay the filing and search fees in due time (1 month from filing, A. 78(2) EPC).

Mr Puss and Dr Plump will need to be named as applicants for the US in the above-proposed PCT application.

If there is not enough time to take an assignment of FAT EU from Fat Cat to file PCT by 9/4/00, the new application could validly be filed in joint names of Sadly Resources and Fat Cat (with Fat Cat's consent) and a partial assignment effecting transfer of the application to Sadly Resources solely executed later and registered at the International Bureau.

Again, if short of time a PCT application can be filed without an authorization which can be filed subsequently under Rule 26.1a PCT.

It is noted that if FAT and ENZ EU are in different languages some translation may be necessary in preparing the new PCT application.

### Situation b

Client will only be able to seek valid protection for the activity of SAD ENZ.

Client has option of continuing with ENZ EU. This would mean paying the examination fee and designation fees within 6 months of the date of mention of publication of the European search report, A. 79(2), A. 94(2) EPC if not already paid and dealing with any objections raised by the examining division. Renewal fees will be payable annually from end April 2001. A. 86(1) R. 37(1) EPC.

Client may also file priority claiming application in other countries if action taken from 12/4/2000.

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\*\* (ie 7/11/00)

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Alternative would be to abandon ENZ EU and file a new PCT application claiming priority of ENZ EU. The application should be filed in the name of Sadly Research, Dr Plump being named as applicant for the US – if designated.

Otherwise I would recommend proceeding with the PCT application in the manner outlined in relation to that proposed for situation as above.

Were Fat Cat to file a new application claiming priority from FAT EU they could prevent Sadly using the high yield process described in FAT EU, but could not stop sadly using the low yield process described in the Genie Genie PCT application.

Without cooperation from Fat Cat, Sadly Research cannot obtain protection for the high yield process as a claim to priority from FAT EU is essential for this, because of the newspaper article disclosing the process subsequently.

Protection cannot be sought for SAD ENZ per se due to its disclosure in GG's PCT.