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## Part II

The purpose of this part of the examination is to ascertain whether the candidate can give clear reasoned advice on the basis of the facts presented and whether the candidate has sufficient knowledge that the clear advice is not dangerous. Candidates who are able to organise the information presented and to give firm proposals for action tend to get good marks. Those who give an unorganised recitation of facts they know (whether relevant or not), and whose answers consist mostly of questions, are not so successful. Production of a time line appears to be of assistance, but on its own is no substitute for a reasoned answer.

### **Question 1: Will it be possible to get a valid patent in Europe for the subject matter of FORM-EU2?**

This question was generally well answered by those candidates who realised that SAD-FORM and SAD-FORM/2 had different priority dates. Those candidates who took time to clearly analyse what embodiments of SAD-FORM were entitled to what priority date generally gained full or near-full marks.

### **Question 2: What actions would you take to secure patent protection?**

In their enthusiasm to protect SAD-FORM/2 and the new oil invention, surprisingly many candidates did not appreciate that to obtain protection for SAD-FORM it was essential to maintain FORM-EU2.

Most candidates did not appreciate that although a journal article may bear a date, this is not necessarily the date of publication, which may be earlier or later. Some candidates realised that if the actual publication date of the Blowit article was later than 1<sup>st</sup> April 1999 there may still have been time to file a US application within the grace period and so gain protection for SAD-FORM.

### **Question 3: Will it be possible to get protection for the isolation process and SAD-PROT?**

This question was often well answered but a significant number of candidates did not analyse what claims were sustainable, and/or did not analyse what amended claims could be filed under Rule 86. Some candidates did not appear to know the date they were sitting the examination and so missed points for realising that a due date had passed.

### **Question 4: What would be the consequences of American Air Force filing patent applications?**

Many candidates realised that an American Air Force application could not have been filed before AAF did their work in 1999.

Some candidates did not clearly address who required a licence and for what. Some suggested cross-licensing without explaining what was licensed.

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**Question 5: What actions must be taken in the next two years concerning SAD-ENZ?**

Again, those candidates who analysed what inventions were entitled to what priority dates, and what documents were available as prior art against each invention, were able to get good marks.

Most candidates did not comment on the apparent insufficient disclosure of ENZ-EU.

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**Model Answer on Paper D, Part II**

Memorandum for the meeting with the General Director of Gobbleup:

**Q1: Regarding the first question, whether it will be possible to obtain patent protection in Europe for the subject-matter of FORM-EU2:**

The application FORM-UK1, describing SAD-FORM, was filed on 24/7/98.

The application FORM-EU2, claiming the priority of SAD-FORM, was filed on 26/7/99. As 24/7/99 was a Saturday, according to Rule 85 EPC, FORM-EU2 could still be filed until the following Monday (26/07/99), thus it was filed within the time limit for validly claiming priority.

However, the priority claim covers only those parts which have already been disclosed in FORM-UK1. SAD-FORM/2, which has not been disclosed in FORM-UK1, thus has the priority date of 26/7/99.

Under the terms of his agreement with Sadly-Resources Professor Blowit was entitled to publish the article on 1/4/99, as this article only contains the subject-matter of FORM-UK1, which had been filed prior to the disclosure. There is surely no breach of confidentiality. This article is not considered as prior art for the subject-matter of FORM-UK1 (SAD-FORM), as it is published after its (valid) priority date, 24/7/98. However, Professor Blowit's article is prior art for SAD-FORM/2, which can only claim a priority date of 26/7/99. In order to get a valid patent in Europe for the subject-matter of FORM-EU2, we have to show that SAD-FORM/2 is new and inventive over the article of Prof. Blowit. This should be possible, as SAD-FORM/2 is commercially important and therefore it is likely that it has advantageous effects.

**Conclusion:** The article of Prof. Blowit should not prevent us from getting a valid patent in Europe for the subject-matter of FORM-EU2 (ie SAD-FORM and SAD-FORM/2).

**Q2: Regarding the measures which have to be taken in order to obtain the best possible patent protection in Europe, US, Japan and as many countries as possible for these inventions:**

The priority year for SAD-FORM has lapsed (priority date: 24/7/98), so we cannot file any follow-up application for SAD-FORM validly claiming the priority from FORM-UK1.

For Europe, we have to ensure that the application FORM-EU2 stays alive. Hence, the examination fee and the designation fees for FORM-EU2 should be paid. The Search Report for FORM-EU2 has already been published (around 26/01/2000), therefore the designation fees will become due (earliest 26/7/2000). As we want broad protection, we should pay for all states, which can be done for the cost of seven.

As Gobbleup wishes to obtain patent protection in as many countries as possible, a PCT application should be filed,

- designating all states and
- claiming priority of FORM-EU2.

As the subject-matter concerning SAD-FORM/2 has been disclosed for the first time in FORM-EU2, this added matter can still be claimed for all states.

If Gobbleup applies for Preliminary International Examination, no translations or national fees need to be paid within the next 30 months, so Gobbleup can pay later, when the commercial value of SAD-FORM/2 can be better assessed.

The content of the PCT application should contain not only everything from FORM-EU2, but, additionally, the mixture with oil, as this form seems to be the most interesting commercially. Alternatively, this mixture with oil could also be claimed in a separate application.

The only document of the Search Report is the article by Prof. Blowit. Neither, SAD-FORM/2 nor the mixture with oil has been disclosed in this article, and both of these are therefore novel. We will have to show that they are also inventive, which should not be difficult.

SAD-FORM/2 because of the reasons given above (see question 1) and the mixture with oil should be patentable because of the unexpected effects of enhanced stability and effectiveness.

In order to validly claim priority, Sadly Resources and Gobbleup should be the applicants, except for the US, where the inventors Dr Fairy and Prof. Blowit will be the applicants.

Though the priority year for SAD-FORM is over, there might still be a possibility to get a valid patent for SAD-FORM in the US because of the grace period of one year. The article of Prof. Blowit is dated 1/4/99. Check with the publishers the actual date of publication of the article. If it has been published later than 1/4/99, the grace period of one year may not have lapsed yet. For that reason and also to get the earliest priority date for the new invention, the PCT application, claiming also the subject-matter of SAD-FORM, should be filed immediately!

For non-PCT countries national applications should be filed.

There could also be filed a second PCT application later on, claiming priority of the first PCT-application, so as to prolong the patent term for the oil mixture feature.

**Q3: Regarding the possible patent protection for the isolation process in general and for SAD-PROT in all EP-countries:**

First of all, we have to check whether we can keep the application PROT-EU1 alive:

The communication of the examining division dated 4/9/99 is deemed to have been received the 14/9/99. The four months time limit and the two months prolongation are aggregate time limits, therefore the time limit for the response expired 14/3/2000. No response was sent by this date, and, as a result, the application is deemed to be withdrawn under Article 96(3) EPC. As the time limit for answering the communication is set by the Examining Division, further processing under Article 121 EPC is possible.

Gobbleup should therefore request further processing, pay the fee, file a response to the official communication and also include a claim to SAD-PROT and to the process of purifying proteins from brewer's yeast. Gobbleup can do this immediately, we do not have to wait for the official letter that the application is deemed to be withdrawn.

As a further point, in order to keep the application alive, we should check whether the fourth year renewal fee has been paid (due end January 2000) and if not, pay it with surcharge.

Thus, the formal requirements to keep the application alive, should be fulfilled. As to the subject-matter Gobbleup would like to get patented, the following points should be discussed at the meeting:

Though the isolation process **per se** does not seem patentable in the light of the documents cited in the Search Report, the process for purifying proteins from brewer's yeast might be patentable. If such claims were included they would also give protection for the products directly obtained by the claimed process (Art. 64(2) EPC), hence also for SAD-PROT.

However, a claim directed directly to SAD-PROT would be commercially more interesting. SAD-PROT can be used as a fermentation promoter and should, therefore, be patentable as a product **per se**.

SAD-PROT was disclosed in PROT-EU1, therefore a claim to SAD-PROT can be included under Art. 123(2) EPC. As the original claims were only directed to the isolation process in general, most probably, SAD-PROT has not been searched. Hence, the introduction of a claim directed to SAD-PROT may not be allowable under Rule 86(4) EPC (as it concerns unsearched subject-matter which does not form a single inventive concept with the originally claimed invention). In this case a divisional application should be filed while the parent application PROT-EU1 is still pending. The divisional application could be continued, even if the parent application is abandoned.

So Gobbleup should be able to get patent protection for the process for purifying prot from brewer's yeast and for SAD-Prot **per se**, but, most likely, not for the isolation process in general.

Concerning the designated states:

The Article 79(2) time limit (six months after publication of the application, the new regulation applies) and the 2 months extension period have both expired, hence it is too late to add designations to PROT-EU1.

Normally, in a divisional application no other countries can be designated beyond those already designated in the parent application. But, as G4/98 is still pending, it could be tried and we will file a divisional application with all countries designated, referring to G4/98.

The applicant of the divisional application must be the same as for the parent application, thus Sadly-Resources.

Conclusion: We will try, but, most probably, Gobbleup will only get patent-protection in the United Kingdom, France and Germany.

**Q4: Regarding the implications of possible patent applications of the US Air Force:**

The research work of the American Air Force was carried out in 1999, so we can assume that, if any filing was done, then it was done at the earliest in 1999. This would be later than the priority date of PROT-EU1 (14/1/97). So a possible patent application from the USAF would not constitute prior art with respect to PROT-EU1.

However, PROT-EU1 would be prior art against any application from the US Air Force and therefore the US Air Force cannot get protection for SAD-PROT itself. The US Air Force could, however, get protection for SAD-PROT as a medicament for reducing the effects of jetlag or for making medicaments reducing the effects of jetlag, as this activity of SAD-PROT has not been disclosed in PROT-EU1. A claim directed to a method of treatment of the symptoms of jetlag would not be allowable in Europe.

If the US Air Force published the article before filing a patent application, USAF may get protection in the US only, but not protection in Europe. This should be checked.

In conclusion, USAF would require a license under PROT-EU1 (or its divisional) to manufacture, sell or use SAD-PROT for any purpose in UK, France or Germany, as Gobbleup has the earlier patent rights in these countries.

On the other hand, if the US Air Force applies for a patent in Europe, Gobbleup would require a license from USAF to produce, sell or use (or license) SAD-PROT as a medicament or for producing medicaments reducing the effects of jetlag.

Cross-licensing is a possible way out of this impasse.

**Q5: Regarding the measures to be taken with respect to SAD-ENZ:**

First we should check the status of the two applications concerning SAD-ENZ, namely ENZ-EU and FAT-EU.

ENZ-EU was filed by Sadly-Resources on 12/4/99, so the convention deadline expires 12/4/00. ENZ-EU describes the structure of the enzyme SAD-ENZ and its activity, but does not contain any information on how to prepare SAD-ENZ. It is therefore doubtful, whether the disclosure is sufficient.

The Gene-Genie application, which has been filed in 1996, has been published before the filing date of ENZ-EU (18 months after filing) and, therefore, constitutes prior art against ENZ-EU. This application describes not only the structure of SAD-ENZ, but also a way of preparing the enzyme. The disclosure of the Gene-Genie application and the newspaper report being public knowledge at the filing date of ENZ-EU, this disclosure of how to prepare SAD-ENZ may be used to show that the disclosure of ENZ-EU was sufficient on the day of filing.

As the Gene-Genie application discloses the structure also of SAD-ENZ, the structure of SAD-ENZ is no longer patentable. However, the activity of SAD-ENZ has not been disclosed in the Gene-Genie application, so that this activity is not prejudiced by this document.

Also the newspaper report, which was published on 9/4/99, is prior art against ENZ-EU. The newspaper report describes the structure and a method of preparing SAD-ENZ, but does not mention its activity. Therefore, also the newspaper report prejudices novelty and inventive step of the structure of SAD-ENZ, but does not prejudice the patentability of the activity of SAD-ENZ.

The activity of SAD-ENZ could therefore be validly claimed in ENZ-EU.

FAT-EU was filed by Fat-Cat on 7/4/99, so that the priority year will end on 7/4/00 (in two days!). FAT-EU describes the structure of SAD-ENZ and a new, high yield process for its preparation. It does not mention the activity of SAD-ENZ.

The Gene-Genie application is also prior art against FAT-EU and, therefore, prejudices novelty and inventive step of the structure of SAD-ENZ. It does not anticipate the high-yield process for the preparation of the enzyme, as this process was not disclosed in the Gene-Genie application.

The newspaper report of 9/4/99 is published after the filing date of FAT-EU and thus does not constitute prior art.

FAT-EU, if maintained, should give valid patent protection for the new, high yield process of preparing SAD-ENZ.

So, Gobbleup will not get patent protection in Europe for the enzyme SAD-ENZ **per se**. But, by keeping ENZ-EU alive, it should get valid patent protection for the activity of SAD-ENZ.

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**(a) If Gobbleup wants to get patent rights for the new, high yield process and assuming that Gobbleup is willing to pay Fat-Cat one million euros:**

Gobbleup should inform Fat-Cat that they are willing to pay, provided Fat-Cat files a European application in its name, claiming priority of FAT-EU (this can only be done until 7/4/00, thus in two days). This time all the fees should be paid. Later this new European application can be assigned to Gobbleup.

Gobbleup should refile ENZ-EU on or before 12/4/2000 claiming priority of the application filed 12/4/1999, with an amplified description to ensure sufficient disclosure (referring to Genie-Genie patent and the newspaper article). File in the name of Sadly-Resources to claim priority validly.

It would, however, be better to combine the subject matter of FAT-EU and ENZ-EU and claim both priorities in a single application with joint applicants filed on or before 7/4/2000 – however, this might not be possible due to the limited time available to get the agreement of Fat-Cat.

If this 'joint' application is possible, a divisional application might be necessary, as the high yield process and the use of the product as slimming aid may lack unity, the only common technical feature, the product SAD-ENZ, being known.

**(b) If Gobbleup is not willing to pay Fat-Cat any money:**

No fees have been paid for FAT-EU. This means, if no further application claiming the priority of FAT-EU is filed, the application FAT-EU will have no outstanding rights after the lapse of the convention deadline. Hence, if Gobbleup is not interested in patent rights for the new, high yield process, it can let the priority period of FAT-EU pass without any action.

The newspaper article describing the new process being public knowledge, and if not patented by third parties, Gobbleup may use it anyway (but cannot prevent others from using it too).

**EXAMINATION COMMITTEE III**

Candidate No. ....

Paper D Schedule of marks

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

**PART I**

1	2				
2	4				
3	3				
4	4				
5	3				
6	4				
7	5				
8	7				
9	4				
10	5				
11	4				
<b>Total Part I</b>	<b>45</b>				

**PART II**

SAD F1	9				
SAD F2	13				
SAD P3	14				
SAD P4	5.5				
SAD E5	13.5				
<b>Total Part II</b>	<b>55</b>				

<b>Total Parts I + II</b>	<b>100</b>				
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Examination Committee III agrees on ..... marks and recommends the following grade to the Examination Board:

- PASS** (50 - 100)     
  **FAIL** (0 - 49.5)     
  **COMPENSABLE FAIL** (45 - 49.5) in case the candidate sits the examination for the first time

Munich, 04 September 2000

*I. R. Muir*

I. Muir - Chairman of Examination Committee III