

Candidate's Answer – DI

1. EP1 is filed in Italian, which is acceptable for an Italian applicant (A. 14(2) EPC).

Translation was filed within 2 weeks, well within the deadline under R. 6(1).

The authentic text of the application is the English translation (A. 70(1)). However this can be corrected under R. 88 with no danger of adding matter (A. 123(2)) because under A. 70(2) the original (Italian) text constitutes the basis for determining whether matter is added. So it is possible to correct for EP1.

EP2 was filed in English. The application as filed is therefore this English text. It might be possible to correct the translation under R. 88 but only if the correction is obvious in the sense that it is immediately evident from the English text that nothing else would have been intended than what is offered as the correction. The Italian priority document cannot be used to show what was intended (G 3/89).

2. Ask for an apportionment of costs (A. 104(1)) during oral proceedings. The apportionment will form part of the decision on the opposition (GLX D-IX, 1.2, R. 63(1)). After the decision a request for the awarding of costs must be filed within a month in writing to the EPO (R. 63(3)) to get the amount – the month runs from the date of notification which will be deemed received 10 days after receipt (R. 78(2)).

Costs incurred when the other party withdraws just before oral proceedings will generally be apportioned (D-IX, 1.4).

3. I would point out that although both the document & abstract theoretically form part of the state of the art under A. 54(2), following T 77/87 an original and its abstract cannot disclose different subject matter as a matter of technical reality and when there is an inconsistency the original document must permit, so it must be presumed the skilled person would disregard the abstract which therefore does not form part of the state of the art under A. 54. The prior published document must stand prima facie on its own & complete (T 77/87). However I would also attempt to provide evidence as to the incorrectness of the abstract (T 160/92).

4. We can make an objection to the inclusion of the member of the opposition division. Unfortunately the EPC has no provisions for exclusion from a member of a department of 1st instance because of suspected partiality, but does have such provisions for members of Boards of Appeal (A. 24(1)). However, the basic requirement of impartiality does apply to departments of 1st instance as well (G 5/91). So we can raise the objection. If it is refused, the decision to ignore the rejection cannot be appealed separately but may be challenged in a final appeal (A. 106(1)). It is also possible that the Opposition Division will decide on the objection by means of an appealable interlocutory decision (G 5/91).

Any appeal fee may be refunded (R. 67) if the appeal is successful because partiality of a member of the opposition division constitutes a substantial procedural violation (T 433/93).

5. (a) It is possible to inspect the file at the EPO under A. 128(4) following publication under A. 93. Since the patent has been granted it must have been published.

According to R. 95a(4)(c) the files will be kept for at least five years from the end of the year in which the patent lapses in the last of the designated states.

When renewal fees become due depends on the states in which it was validated, but in almost all countries this is the last day of the month containing the anniversary of the date of filing (NatLaw, Table VI). So unless GB was last to lapse, the next ones will all have been due 31.3.96 but not paid, so the patents all lapsed 31.3.96.

Five years from then is 31.3.01 (Saturday) so this time limit is extended under R. 85(1) to 2.4.01, which is the last day the file can be inspected.

- (b) If a patent granted on a divisional is still in force, the file of the patent will be kept at least as long as that of the divisional (R. 95a(5)) – so for another 5 years after the divisional is abandoned or lapses.
6. (a) Application was filed after the cut-off date of 1. 7.99 so only 7 designation fees are payable (RFees 2(3)). Since 2 unnecessary designation fees have been paid, 2 will be refunded (GLX A-10).
- (b) One designation fee will be refunded as CH and LI are a single designation (A. 142(1)).
- (c) The designation fees were validly paid so there is no reason for them to be refunded.
- (d) There is no legal basis for payment of designation fees as there is no pending application for the fees to be paid on. So they will all be refunded (GLX A-XI, 10.1.1(i)).
7. (a) The designation of inventor must include the inventor's address (R. 17(1)). The communication informing us of this deficiency will have been issued under R. 42(1) warning us that the application will be deemed to be withdrawn (A. 91(5)) if a complete designation is not filed.

The notification will have been deemed received on 25.2.01 (R. 78(2)). 2 months from then is 25.4.01. So can still be validly filed.

However, L 19/99 & GLX A-III, 5.5 state that the complete designation can be filed the late of two months from this notification or 16 months from priority – so it is possible 16 months expires later (we don't know priority date).

Two month limit under R. 42(1) is an office time limit leading to deemed withdrawal if not met. So further processing (A. 121) is possible – within two months of notification of deemed withdrawal, file des. of inventorship with address & pay further processing fee.

Restitutio under A. 122 is also possible – within 1 year of missed time limit (& within 2 months of notification of deemed withdrawal – J 27/94), pay restitutio fee, file notice & grounds & provide evidence that all due care was taken in the circumstances.

- (b) The designation must be signed by applicant or representative (R. 17(1)).
Priority date = 28.11.99
→ 16 months from then = 28.3.01
So 16 month deadline (A. 91(5)) was 28.3.01.
R. 42(1) notification deemed received 1.2.01.
Specified time limit expires (probably) 1.4.01 (L 19/99).
So time limit probably can be met by 1.4.01 (Sunday) extended to 2.4.01 (R. 85(1)),
but best to file signed designation of inventorship today by fax.
Restitutio (A. 122) possible for either time limit.
Further processing (A. 121) only available for A. 42(1) two-month time limit.
- (c) Communication issued under R. 111(1). Office time limit of two months from notification.
Deemed received 25.1.01
Deadline 25.3.01 (Saturday) extended to 27.3.01
So deadline missed.
Application will be deemed withdrawn (A. 91(5)).
But further processing (A. 121) is possible.
Restitutio is possible (A. 122).
See (a) above for details of further processing & restitutio.
- (d) Designation of inventor was due on filing (R. 17(1), J 1/80). Notification this time is under R. 42(2) referring to R. 42(1) giving two months.
Deemed received 25.1.01.
2 month expiry 25.3.01 (Saturday) extended to 26.3.01.
Deadline missed. Application deemed withdrawn (A. 91(5)).
Since R. 42(2) specifies limit as 2 months, further processing (A. 121) is not possible.
Only remedy is restitutio (A. 122) within 12 months + within 2 months of notification of withdrawal. Pay fee, show all due care.

8. Priority date is 2.00

So publication expected (in French) in 8.01 (A. 93(1)). We need to get application published as soon as possible – this can be done immediately providing filing and search fees were paid (A-VI, 1.1) & since they were due in March 2000 (A. 78(2)) & we are told all fees were paid, this is the case.

Once application is published then under A. 67(1) it confers same protection as granted patent (A. 64) in each designated state.

This may well extend only to damages recoverable after grant & not the ability to bring action before grant (A. 67(2)). It is also necessary in all states to file a translation of the claims in a language of that state to obtain provisional protection (A. 67(3)) – all states require this. Some states also require that the claims translations are forwarded to the potential infringer.

We also need to request accelerated processing to get the patent granted as quickly as possible (PACE – Notice of President dated 1.7.97).

So need to

- request accelerated search (although search report should have already issued within 6 months of filing)
- request accelerated examination
- submit exam request & pay exam fee (A. 94(2)) now.
- pay designation fees (A. 79(2)) now for states in which competitor is infringing.

If patent is accepted for grant, can request accelerated grant under A. 97(6) – reply to R. 51(4) communication immediately & request early publication of grant. Must also pay grant & printing fees (A. 97(4)) and claims translations into English & German (A. 97(5)) as early as possible.

Also note that all outstanding renewal fees must be paid before publication of grant – first renewal fee (for 3rd year) is not due until 28.2.02 (R. 37(1)) however.

9. R. 69(1) EPC communication deemed received 27.10.00 (R. 78(2)).

Further processing must be requested within 2 months (A. 121(2)), i.e. by 27.12.00 (Wednesday).

Registered letter containing request for further processing & response was despatched 5 days before deadline and received within 3 months of deadline. This will therefore have been deemed received in time to meet the deadline (R. 84a(1) EPC, Dec. of Pres. dated 11.12.98) since it was sent by registered post. So request & response deemed received in time.

However, the cheque (EUR 76 correct. RFees 2.12) was sent separately and R. 84a does not apply to payment of fees (OJ 1999, 301 § 22-32).

But under RFees 8(3), if a fee is paid late it shall be considered paid in time if a cheque and letter were despatched at a post office, bearing the address of the EPO, before the deadline (RFees 8(3)(a)(iii)). Evidence may be needed (RFees 8(4)) that the cheque was indeed sent then (eg registered post receipt).

But, since it was not sent at least 10 days before the deadline, a surcharge of EUR 153 must be paid (RFees 8(3)(b)) for the original cheque to be deemed received in time.

So request for further processing would be validly filed as long as the EUR 153 surcharge is filed within a time limit to be set by the office (RFees 8(4)).

10. (a) Examination fee for divisional is not due until 6 months after publication of search report for divisional (A. 94(2)).

But if no examination fee (A. 94(2)) paid for patent, application is deemed withdrawn (A. 94(3)) at the end of the standard six-month time limit under A. 94(3) (J 4/86). The divisional could have been filed during the grace period (R. 85b) but would only be validly filed if examination fee was paid during that period. So divisional not validly filed.

No remedies – A. 94(2) period and R. 85b period are convention time limits, so further processing (A. 121) is not possible. The A. 94(2) period is specifically excluded from restitutio (A. 122(5), G 5/92). The R. 85b period is also excluded from restitutio (J 8/94).

- (b) Divisional can be validly filed.

Refusal for lack of unity (A. 82) will not have come about from a convention time limit, and the application is lost.

So further processing (A. 121) is possible.

Refusal decision (A. 121(2)) was deemed received 28.1.01 (R. 78(2)).

Two months from then is 28.3.01 – today.

So – today – fax letter to EPO meeting unity objection, + pay further processing fee, preferably by deposit account debit. Then pending application exists & divisional can be filed. (Note divisional cannot be filed if further processing is not requested).

Other alternative is to file appeal (A. 106(1)) & pay fee – also today – meeting unity objection so interlocutory revision (A. 109) is issued. Again, this means divisional can be filed.

- (c) Technically the divisional application should be filed at the latest with the approval under R. 51(4) (R. 25(1)).

However, J 21/94 said that the approval of the text in such circumstances was “conditional” on the filing of the divisional – since the approval letter explicitly stated that a divisional was being filed – so on the principle of good faith the filing of the divisional must be valid.

11. First priority date was 10.6.99

Deadline for demand (A. 39(1)(a) PCT) was thus 19 months later i.e. 10.1.01 in order to put the application into Chapter II. Priorities can be withdrawn (R. 90bis 3(a)(b)), and this means that all time limits are calculated from the next earlier date of priority (R. 90bis 3(c)) but only time limits not already expired. Since the demand deadline was already past by the time the 1st priority was withdrawn the application did not enter Chapter II then & the international phase expired after 20 months (A. 22 PCT) – i.e. 10.2.01.

But this was after the withdrawal of the 1st priority, so the 20 months of A. 22 PCT is now computed from the other priority which is 15.9.99. This 20 month deadline is thus 15.5.01.

To enter national phase before EPO, 21 month deadline applies (A. 22(3) PCT, R. 107(1) EPC). So it is still possible.

So by 15.6.01 must

- file request for entry into regional phase (R. 107 EPC)
- indicate documents to be used for grant procedure (R. 107(1)(b) EPC)
- pay national, search & claims fees (R. 107(1)(c),(e), R. 110(1) EPC)
- pay exam + designation fees (R. 107(1)(d),(f) EPC)

3rd year renewal fee will be due (R. 37) on 30.6.02.

Note exam + designation fees would have already fallen due since publication would have been ~ 10.12.00 so deadline would have been ~ 10.6.01.

NF-EU2 probably can claim priority for

- Use of blottanes as moisture absorbers
- Moisture absorbent materials including blottanes

B-PCT, published after the filing date, but claiming valid priority from B-GB1, can act as Art. 54(3) novelty only prior art against those claims not entitled to priority, as all designation fees were paid and although it was published after filing date, B-GB1 is earlier (priority) date. This would knock out claims to blottanes in general – disclosed by B-PCT. But claims to any of the rest of the subject matter would remain untouched.

NF-EU2 was also not published before priority or filing date of NF-EU1, but itself has an earlier priority date even than the priority of NF-EU1. By the same arguments as the claims not entitled to priority, it would anticipate (Art. 54(3)) all claimable subject matter except the moisture absorbent properties of blottanes.

- 2) Neither NF-EU1 nor NF-EU2 were published at the priority date (15.10.98) of B-EU1. B-PCT was identical to B-GB1 so priority may be validly claimed.

NF-EU1 shares the same priority (for some of its matter) with B-EU1 and can therefore not be cited against it, even after publication. B-EU2 has the same priority as B-EU1 (Art. 76(1)) so NF-EU1 cannot be cited against B-EU2 either. NF-EU1 is not relevant to the patentability of B-EU1 or B-EU2. NF-EU2 might be citable under Art. 54(3) for novelty only, but only if the designation fees are paid (R. 23a), and then only for those states for which they were paid. Worst case scenario (from Boggy's point of view) is that N does pay all designation fees and surcharges using R. 85a(1) or R. 85a(2), so NF-EU2 becomes citable.

It is relevant for novelty only (Art. 54 (3), Art. 56) though. The payment of designation fees for NF-EU2 could knock out claims (in B-EU1) to blottanes in general. It would not knock out the claim to product X which is therefore patentable. In B-EU2, the subject matter of composts containing blottanes is not disclosed by NF-EU2 so claims to this subject matter are patentable.

B-EU1 is about to proceed to grant, following which it will be too late to amend to e.g. textiles & papers of blottane, and the use of blottanes as a moisture absorbent material (which could be claimed – G 2/88). There does not seem to be an obvious way of holding up grant by non-payment of fees – no renewal fees have fallen due. So write to EPO immediately requesting amendment to overcome this prior art.

The EPO does not have to accept the amendment (R. 86(3)), but equally it is possible in exceptional cases (G 7/93) up until the decision to grant is actually put in the EPO's internal post (G 12/91). The EPO has to balance the applicant's interest in obtaining a legally valid patent with the EPO's interest in bringing the procedure to a speedy conclusion. Hard to call, because they might need to re-open examination to allow the amendment (Art. 114(1)) & check if it is not anticipated by NF-EU2, which could dissuade them. But worth a try because once it is being re-examined there will be a chance to find out for good whether any/which designation fees are paid for NF-EU2.

- 3) If no exam/designation fees are paid for NF-EU2 it will be deemed withdrawn and cannot lead to problems. If they are paid, then NF-EU2 could issue with a general claim to “blottanes” which would indeed cause problems (although note there is problem with support, they might not get such a broad claim allowed).

NF-EU1 shares a priority date with B-EU1 & B-EU2 of 15.10.98 – at least to some of its matter: In particular, claims to the use of blottanes as moisture-absorbent materials are entitled to priority and therefore not anticipated under Art. 54(3) by B-EU1. Such claims could therefore be allowed and would be likely to cause you problems. They would also cause Pure Agrochemical problems in exploiting their compost as they would cover what they are doing.

Note (and this applies to the patentability of B-EU1 & EU2) – there is no bar on patents being granted to different applicants when the two have the same priority date (GLX C-IV, 6.4). So material in NF-EU1 that is entitled to priority cannot be cited against B-EU1 or B-EU2, and B-PCT cannot be cited against the material in NF-EU1 that is entitled to priority. So it is possible (if you can persuade the examiner to let you amend B-EU1) for both you and Niffy to get valid patents claiming the use of blottanes as a moisture absorbent material.

- 4) If Niffy do not pay designation fees for NF-EU2, then B-EU2 could be granted in its present form and would form a valid patent. In order to enforce it, you need to file translations in the designated states into their national languages (Art. 65(1)) within 3 months. Once that is done then you can enforce the patents under national law where necessary, including the filing of injunctions etc.

If Niffy do pay designation fees on NF-EU2, then you will need to amend the patent to ensure it has a valid claim. If this cannot be done before grant (eg because the EPO refuse amendments under R. 86(3), or even R. 86(4)), then you would end up with a granted but only partially valid patent. You can probably amend after grant in most countries, but this is an expensive procedure. If you try to sue Niffy within the next 9 months they would almost certainly oppose the patent (Art. 99) centrally on the grounds that claim 1 is not new (Art. 54(3)) over NF-EU2. You would then get a chance during opposition proceedings to amend the patent to ensure it is valid.

If you are allowed to amend by the EPO, and they re-open examination, then you have provisional protection after publication under Art. 67 EPC – the PCT publication counts as a European publication (Art. 158(1) EPC). This does not allow you to open proceedings before grant, but you have the power after grant to sue for damages incurred between publication and grant. However you will need to file claims translations (Art. 67(3) in each country you are interested in to start the provisional protection running.

5. Disposable nappies containing X

A divisional cannot be filed having claims to disposable nappies containing X based on B-EU2. A divisional application cannot extend beyond the subject matter of its parent application (Art. 76(1) EPC). B-EU2 does not contain any disclosure of product X or the use of blottanes in disposable nappies. So a divisional based on B-EU2 cannot include

claims to disposable nappies containing product X. This is based on the fact that B-EU1 cannot have matter added to it extending beyond the content of B-EU2 as filed (Art. 123(2)). So claims to product X can also not be introduced into B-EU2. Art. 123(2) (matter compared to application as filed) and Art. 76(1) (matter compared to patent) are quite separate restrictions (T 441/92).

A divisional can also theoretically not be filed based on B-EU1 as approval of the text under R. 51(4) has already been given (R. 25(1)). The only chance of filing a divisional based on B-EU1 is if examination proceedings are re-opened before the decision to grant is issued, as discussed under Point 2, p. 8* above. Following G 7/93 approval of the text becomes binding only on the issue of the decision to grant.

However, it is not possible to withdraw approval of the text simply to file a divisional (J 29/96). If you file an amendment and the EPO simply accepts it and issues the decision to grant, then it will still not be possible to file a divisional, as this is still deemed approval of the text (J 29/95). Only hope is for EPO to re-open examination proceedings, in which case R. 51(4) will require a new approval of the text, in which case a divisional can be filed up until the new approval of the text (G 10/92).

The best bet would seem to be to attempt to file amended claims on B-EU1 including a claim to a disposable nappy containing X and a claim to the use of blottanes as a moisture absorbent, drawing the examiner's attention to NF-EU2 and arguing that exceptional circumstances apply (T 92/85) so examination should be re-opened. Then he might re-open examination, in which case divisional can be validly filed. Or he might (R. 86(3)) simply accept the amendment, in which case no divisional can be filed but at least B-EU1 would contain a claim to a disposable nappy containing X. Or he might just refuse the amendment and issue the decision to grant, in which case we have not lost anything by trying! It is important only to request amendment, not withdraw approval of text under R. 51(4), as otherwise you run the risk of the application being refused for lack of an agreed text (R. 51(5)).

6. As ever, this depends on whether the designation fees for NF-EU2 are paid.

If the designation fees for NF-EU2 are paid with surcharge in the period of grace under R. 85a(1) or R. 85a(2), then claims in NF-EU1 to the process of producing continuous fibres, and to blottanes in the form of a woven textile, would not be valid as they would be anticipated under Art. 54(3) by NF-EU2. So they could not use NF-EU1 to stop you.

However, if they also paid the examination fees on NF-EU2 with surcharge within the R. 85b grace period, then NF-EU2 would remain alive and might proceed to grant. It contains a claim to a process for making continuous fibres of blottanes, and such a claim would prevent you from making continuous fibres of X (which is a blottane). It would also (Art. 64(2)) protect the continuous fibres of X per se, as the direct product of the claimed process. They could thus stop you from producing X as a woven textile to supply F (depending, obviously, in which states they validate the patent).

If the designation fees are not paid for NF-EU2 then it will not act as Art. 54(3) prior art against NF-EU1. Claims in NF-EU1 to the process for producing continuous fibres, although they cannot claim priority, were still novel and inventive at the filing date of

* Ed. Note: page 8 in the original, ie page 2 last paragraph of No 2) in this printed copy

NF-EU1 and therefore should still be patentable. This would cover part of the process of manufacturing X as a woven textile as described above and would therefore allow Niffy to prevent you supplying X as a woven textile to F in whichever states NF-EU1 is granted in.

Since you are, at the very least, going to be able to get some form of valid patent to blottane or to its use as a moisture-absorbent, even if it involves post-grant amendments, it would seem that some form of cross-licensing would be in order with Niffy. None of your other contacts make shoes, and it sounds as though product X would be better for shoes than other blottanes because of its odour-absorbing properties. Niffy may therefore wish to use X in their shoes – and anyway will require a license to use any blottane as a moisture absorbent. You are going to need a license from them (probably) to make long fibres of X, and also (possibly, depending on what happens to NF-EU2) to use blottanes in general or to use blottanes as a moisture absorbent. So you will need to come to an agreement with them.