Examiners' Report Paper D – 2001

Part II

A high number of candidates failed to correctly analyse the priority situation for NF-EU1.

For most of the subject-matter of NF-EU1, priority is not validly claimed from the application NF-IE1, since this application is in fact not the first filing. In other words, for all subject-matter disclosed in NF-IE2, NF-IE1 can not be used for a valid priority claim in NF-EU1.

Mistakes of this kind led to immediate loss of many points. Furthermore, later questions and answers also depend on a correct priority analysis.

A surprising number of candidates failed to see that applications with same date of filing are not prior art against each other.

Another central point where far too many candidates made fundamental mistakes was the analysis of what the various applications claim and what they merely disclose.

Candidates having made this kind of mistake also were unable to indicate the mutual

possibilities for Niffy and Boggy in terms of preventing each other from exploiting various aspects of blottanes, since such candidates did not have a clear picture of the potential patent rights of the two companies. In this connection, it appears that a detailed time line having information about applications, claims, disclosures and dates would be of great help to gain a correct overview of the situation.

A number of candidates in reply to question 4 explained how to stop Niffy obtaining a patent instead of explaining how to stop Niffy using blottanes.

A surprising number of candidates considered that a patent gives the right to exercise an invention and not the right to stop others from doing so. In particular, it was often not realised that a patent for a specific item such as product X does not give a right to exploitation when another (broader) patent covers the subject-matter in question.

Many also did not set out that when two companies hold patents of the same date for the same invention, as for B-EU1 and NF-EU1 with respect to moisture absorption, neither company can exploit without licence from the other.

In this connection it is also to be noted that many candidates at various points suggested cross licences as a solution to problems without indicating with reasoning precisely what the contents of such licences should be.

Most candidates correctly analysed the pure formal status of the various applications in the paper. In particular, most noted that the designation fees for NF-EU2 are still payable with a surcharge and the possible consequences of invalidity for the general claims to blottanes in B-EU1 in view of NF-EU2 being potential prior art under Article 54(3) EPC.

Most candidates saw that the desired divisional application can not be filed with B-EU2 as a parent, since this divisional application itself does not include the desired matter.

Most candidates also saw the complications when trying to use the B-EU1 as a parent, since B-EU1 stands immediately before grant having completed the procedures under Rule 51(4 and 6) EPC. A large number of candidates unfortunately gave up at this point, without seeing the possibility of quickly introducing NF-EU2 to the examiner to justify reopening of the procedure of B-EU1, both to enable the valid filing of the desired divisional application and to improve the claims in the parent application.

Model Solution – Part II

1. Could you advise us in detail as to the patentability in the EPC contracting States of the subject matter of NF-EU1 and NF-EU2?

The designation fees of NF-EU2 are still payable with a fine.

If the designation fees for NF-EU2 are paid then, for those countries for which the fees have been paid, NF-EU2 appears to have patentable claims to:

- a process for producing continuous fibres from blottanes,
- product A in the form of a woven textile and
- the use of product A for its anti-static properties.

Furthermore, NF-EU2 has a description of blottanes in general which appears to be patentable subject matter. However the statement in NF-EU2 that blottanes

other than product A are of no practical use may cause problems if Niffy seek broaden the claims of NF-EU2.

In any event, NF-EU1 is not entitled to its priority claim for any subject matter that was in NF-EU2 (and NF-IE2), since NF-IE1 was not the first application for such matter. Claims to the use of blottanes for their moisture absorbent properties are entitled to the priority of NF-IE1.

Since NF-EU2 was published before the filing date of NF-EU1, NF-EU2 is available as prior art both for novelty and inventive step for that subject matter in NF-EU1 which is not entitled to the priority claim.

Since NF-EU2 was published after the filing date of NF-IE1, NF-EU2 is not novelty destroying prior art for those claims in NF-EU1 directed to the use of blottanes for their moisture absorbent properties. Both B-EU1 (from B-GB1) and NF-EU1 (from NF-IE1) have the same date and earliest priority date for the use of blottanes for their moisture-absorbent properties. Thus, NF-EU1 and B-EU1/B-EU2 are not prior art against each other for the use of blottanes as moisture-absorbent materials.

NF-EU1 therefore has patentable subject matter in claims relating to the use of blottanes for their moisture absorbing properties and appears to have patentable subject matter for the use of blottanes for moisture-absorbent shoe linings.

2. <u>Could you advise us whether the subject matter of B-EU1 and B-EU2 is patentable in the EPC contracting States in view of the Niffy applications?</u>

<u>If not, is there any action we can take to improve our position?</u>

NF-EU2 was published after the priority date of B-EU1 (from B-GB1) and so is only available as prior art for novelty and not for inventive step for those countries in which designation fees are paid. If the designation fees of NF-EU2 are not paid then B-EU1 can have claims to blottanes in general; if designation fees of NF-EU2 are paid then B-EU1 cannot have claims to blottanes in general for those countries in which the designation fees have been paid.

In IE there may be a conflict because of NF-IE2. Therefore a separate set of claims should be considered for IE.

If a patent is granted and not opposed, the claims cannot be amended centrally to use claims which would be valid and amendments would have to be carried out nationally for those countries that permit this. If an opposition is filed, then amendments will be possible during the opposition procedure.

To improve our position, it would be helpful if we could delay the grant to see whether the fees are paid on NF-EU2. Grant cannot normally take place less than 5 months after the R. 51(6) notice but in this case rapid grant has been asked for and this may mean a waiver of the five month term.

Therefore, the examiner must be contacted as soon as possible, the request for

accelerated grant must be retracted and the examiner must be advised of the existence of NF-EU2 and NF-IE2. Oral proceedings should be requested and/or a separate set of claims should be filed. Amended claims on B-EU1 can be filed. For IE and those countries for which the designation fees have been paid, such amended claims should be directed to the use of blottanes as moisture absorbent materials and to product X; for the other countries, the claims should additionally include product claims to blottanes in general. As the European Patent Office will not knowingly grant an invalid patent, the examiner will resume examination if material prior art is brought to his attention.

In any event, NF-EU1 does not constitute prior art for B-EU1. NF-EU2 does not appear to prejudice claims to product X in B-EU1 and claims to composts containing blottanes in B-EU2 since these claims are new over NF-EU2.

For the reasons given above for NF-EU1, B-EU1 could – if amended – have valid claims to the use of blottanes for their moisture-absorbent properties.

Even if the same invention is covered by NF-EU1 and B-EU1/B-EU2, each applicant will get their patent.

Boggy should file a new application for woven X as a shoe liner.

Filing translations to obtain provisional protection under national law should be considered.

3. <u>Could the Niffy patents cause us any problems in exploiting blottanes in the EPC contracting States?</u>

There is a potential risk that the claims of NF-EU2 will be amended to blottanes in general. Whether or not the designation fees are paid for NF-EU2, Niffy (through NF-IE1 and NF-EU1) may get a patent granted directed to the use of blottanes as moisture absorbent materials which covers the uses of blottanes intended by Boggy and the licensees . A patent does not give a right to exercise the claimed invention, only the right to stop others. Therefore, such a patent granted on NF-IE1/NF-EU1 could be used to stop Boggy even though Boggy would have a patent of the same priority date as NF-EU1. However, possible prior knowledge defences should be taken into account according to national law.

4. <u>What action can we take to stop Niffy using blottanes in the EPC contracting States?</u>

B-EU1 could be used to stop Niffy exercising their invention since B-EU1 claims blottanes. If the designation fees on NF-EU2 are paid and/or in view of NF-IE2, there could be problems in exerting B-EU1 as it would be partially invalid. However, if B-EU1 were restricted to use claims (use for moisture absorbent properties) then it could still be used to stop Niffy using blottanes for their moisture absorbent properties for the same reasons as given above. However, Niffy could not be stopped from using blottanes for other purposes.

5. Can we validly file such a European divisional application based on B-[illegible] or B-EU2?

B-EU2 has no disclosure in the application as filed of the use of blottanes in nappies nor of the product X. Therefore, a divisional based on this subject matter cannot be filed.

If a divisional has to be filed it will have to be from B-EU1. However, the approval of the text of B-EU1 has been filed and so filing a divisional is normally no longer possible. However we cannot retract our approval in reply to the R. 51(4) communication simply because it is too late to file a divisional. Therefore the procedure mentioned above should be adopted to draw NF-EU2 and/or NF-IE2 to the examiner's attention. It should be checked, close to the due date, whether NF-IE2 has been published or whether the designation fees have been paid for NF-EU2. If neither of these actions has occurred, then we can pay, on or close to the last day, at least one designation fee for NF-EU2 – with the surcharge – for a country covered by B-EU1. This will force the examiner to consider NF-EU2.
It is noted that the EPO will accept payment from anyone. Earlier payment might encourage Niffy to pay the remaining fees, so we should pay late to reduce this risk.

If possible, an unimportant country should be selected. Examination will be resumed and should result in a fresh R. 51(4) communication. Once examination has been resumed, a divisional from B-EU1 claiming disposable nappies containing product X can be filed.

6. Can Niffy stop us from supplying Feuchtfurcht in the EPC contracting States?

Niffy may obtain rights, through NF-EU1/NF-IE1, in the use of blottanes as moisture-absorbent material and may obtain rights, through NF-EU2/NF-IE2 for blottanes in general or at least for woven blottanes, because continuous fibres are necessary for making woven materials. In that case a licence from Niffy would be needed. Cross licensing would seem to be a practical solution. Notably, Niffy may be interested in product X for its odour-absorbing properties and so a potential for agreement exists. Otherwise acquisition of Niffy or acquisition of patents from Niffy would also be a solution.

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	2				
3	3				
4	3				
5	3				
6	4				
7	7				
8	5				
9	5				
10	6				
11	5				
Total Part I	**45**				
PART II					
NF-EU1	12,5				
B-EU1, EU2	14				
EXPLOITATION	4				
STOP NIFFY	4				
DIV	15,5				
FEUCHT	5				
Total Part II	**55**				
Total Parts I + II	**100**				

Examination Committee III agrees on ..... marks
and recommends the following grade to the Examination Board:

☐ PASS
(50-100)

☐ FAIL
(0-49)
COMPENSABLE FAIL
(45 - 49, in case the candidate sits the examination for the first time)

Munich, 6 September 2001

G. Checcacci, Chairman Examination Committee III