

Candidate's Answer – DII

1. HVHF plugs

$\Delta + \square \quad \Delta$

PP has: US2 - granted in US (related to US 1)
 EP1 - pending before EPO $\Delta + \square + \triangle$ for all states

LBP has: FR1 - Δ France - still pending?
 EP2 - granted for DE, ES, FR, GB $\Delta + \square$

PP has granted US patent US2 which provides PP with patent protection for HVHF plugs with triangular and square cross-sections in the US.

EP1 was sent by registered letter on 29.10.02. In order to claim priority validly from US2, EP1 had to be filed during a period of twelve months from the date of filing the first application, ie by 1.11.02 (Friday), 1.11.02 was holiday in Munich branch of EPO so under R 85(1) EPC, due date for claiming priority was extended to Monday 4.11.02. EP 1 was not received at EPO until 8.11.02, ie after the due date. But R 48a EPC provides that where a document is received late at the EPO it is deemed to have been received in time if it was posted in due time before the expiry of the time limit. Dec. of Pres. OJ 1999, 45 and E - VIII, 1.7 sets out that document must be posted at least 5 days before due date and it can be sent by registered letter or recognised delivery service and if from outside Europe by air mail. Here, EP1 was posted 6 days prior to due date by registered letter and from inside Europe. Therefore, EP 1 is deemed received in due time to claim priority from US2. However EP 1 may only claim priority in respect of the same invention as in US2, which is the first application and in the preceding 12 months.

“Same invention” (G 2/98) means that the specific combination of features in the claims of EP1 must be disclosed in the first application as a whole either explicitly or implicitly. For the claims to the plug with square contacts, EP1 can validly claim priority from US2, since the first application by the same applicant in which this subject matter was disclosed was US2. However, for claims of EP1 relating to Δ contacts, US2 was not the first application in the sense of A 87(1) EPC. The subject matter of the triangular contacts was disclosed in a still earlier application (US1) originating from PP, so the priority right for the plugs with triangular contacts is invalid in so far as this was already described in US1 since the A 87(4) EPC exception doesn't apply in this case (cascading priority problem here), ie although the previous (US1) and subsequent (US2) applications were filed in the same state (USA), at the filing date of US2, US1 had not been withdrawn, abandoned or refused (as it was withdrawn after US2 filing date) and it had left rights outstanding (in that US2 is a C-I-P of US1). Therefore, the 3 areas of subject matter of EP1 do not have the same effective date (A 89 EPC).

- Square contacts - entitled to priority date (ie filing date of US2) of 1.11.01.
- Triangular contacts and new pentagon contacts entitled to filing date only.

The date on which all the requirements for a filing date were met (A 80 EPC) was 8.11.02.

R 84a EPC does not apply to filing date itself as was no "due date" missed. So, effective date for Δ and \triangle contacts subject matter is 08.11.02.

EP2 claims priority from FR1. FR1 discloses plugs with triangular contacts only. EP2 validly claims priority from FR1 since they have same applicants (LBP) and EP2 was filed within 12 months of FR1's filing date, but only in respect to the same subject matter. Therefore subject matter in EP2 relating to plugs with triangle contacts has valid claim to priority of 6.6.01. But subject matter in EP2 relating to plugs with square contacts is entitled only to the filing date of EP2, ie 14.11.01.

This means for:

(i) square contact subject matter in EP1, which has effective date of 1.11.02, EP2 is not prior art since the square contact subject matter in EP2 has an effective date of 14.11.01. In fact, EP1 is prior art for novelty only (under A 54(3) and (4) EPC) - not inventive step - against the square contact subject matter in EP2 as EP1 has an earlier effective date than EP2 but will be published after the filing date of EP2, in respect of the states that are designated in both applications and only if EP1 publishes as a regularly published application under A 93 EPC and the designation fees for EP1 are paid (R 23a EPC).

EP1 is not due to be published until after 18 months from priority date, so 18 months from 1.11.01, ie due to be published soon after 1.5.03. Designation fees are due (and examination fee and request for examination) within 6 months of publication of search report (and R 85a grace periods apply), which will either be published at same time as application or later. So PP need to make sure this is done in order that EP1 is A 54(3) EPC prior art against EP2 for square subject matter.

(ii) for triangular subject matter in EP1, effective date is 8.11.02 (actual filing date) so EP2, which has then published, is full prior art for novelty and inventive step (A 54(2) EPC) against this application. \rightarrow Δ subject matter of EP1 looks like it lacks novelty over EP2.

(iii) for pentagon subject matter in EP1, effective date is 8.11.02, ie actual filing date. EP2 is full prior art as explained above. EP2 does not disclose plugs with pentagon contacts so EP2 does not give rise to lack of novelty of \triangle subject matter of EP1. Issue is inventive step: Is a pentagon-shaped contact obvious in view of a triangular or square shaped contact, as disclosed in EP2. From client letter seems that pentagon shape is equivalent solution to triangle and square shape - so may be difficult to argue that this subject matter has an inventive step over EP2.

Also be to checked, is there a US patent application publication? there should be as US1 and US2 were filed after the 29.11.00 date at which publication of US applications took effect. US1 was withdrawn so wouldn't have published. US2 would have published - but not sure if date is 18 M from filing date of US2 or 18 M

from filing date of US1 which was basis for the IP - does not appear to affect situation with respect to EP1 or EP2 though.

Also relevant to patent situation for EP1, EPC does not consider aesthetic creations as such to be patentable (A 52(2)(b) and (3) EPC). Shape of contact - aesthetic creation? Appears not as has technical effect, therefore at least the square contact subject matter of EP1 appears patentable.

For pentagon-shaped contact, if changing shape from square (as disclosed in EP2) to pentagon only provides equivalent effect, then the issue of is this merely an aesthetic creation may also be relevant as the change in shape does not provide a technical effect, therefore pentagon subject matter may be unpatentable.

On unity point, in absence of EP2 from consideration, the three embodiments have corresponding special technical features which are alternatives having the same technical effect and so are unified, C-III, 7.2, R 30(1) EPC. Further problem perhaps is presence of multiple independent claims to the plug with each type of contact shape in view of new R 29(2) EPC which sets out specific exclusions to general requirement that there may be only one claim type (ie product or process) in each European patent application. R 29(2)(c) EPC exclusion is that the claims are alternative solutions to a particular problem, where it is not appropriate to cover these alternatives by a single claim. That is the case here - the 3 shapes are alternative solutions to the problem of prolonging life of the HVHF plugs. So, feel could argue in theory for the presence of such independent claims in EP1 (if not then could file divisional applications at any time while patent still pending). However, due to EP2 making triangular contact shape subject matter lacking in novelty, at least that independent claim may have to be removed from EP1.

Note that EP2 had mention of grant published on 6.11.02, so still in opposition period. Could file an opposition against EP2 up to 9 months from 6.11.02, ie up to 6.8.03 (and pay fee). Presence of EP1 as A 54(3) novelty only citation could be used as ground of opposition, A 100(a) EPC against square-contact subject matter.

May be worth requesting accelerated prosecution of EP1.

2. Shielding systems

PP has ES1
PCT1
and EP4

LBP has EP3

EP3 has no priority claim. Publication of search report mentioned 24.9.02. Therefore, designation fees, due 6 M from 24.9.02, ie 24.3.03 (Monday). This fee is still payable with surcharge in the grace period of R 85a EPC. But check whether these have been paid, if not paid by end of grace period application will be deemed withdrawn (A 91(4) EPC).

At least exam fee and request have been dealt with through (due also 6 M from publication of search report) as first examination report has already issued. PCI 1 - although no action since search report published, this application is still pending. Seems that no Demand for international preliminary examination was filed in accordance with A 31 PCT) but since filing of Demand is no longer necessary to extend entry into national phase from 20/21 M to 30/31 M in all states, this application is still pending for all states except those that have notified the IB of the non-applicability of the new time limit under A 22(1) PCT, presently including Brazil, Singapore and others. However US and EPO have applied new A 22(1) PCT time limit. So, for all those countries that have applied the new time limit 30 M period from priority date for entering national/regional phase for PCT 1 expires 1.4.03 - this is the case for the USA. 31 M period expires 1.5.03 - eg for EPO. So, if want protection in USA and Europe, enter national phase in US by 1.4.03 - need to file translation of Spanish application into English and pay national fee, file declaration of inventor, declaration of applicant's entitlement to priority and preferably information disclosure statement by the expiry of 30 M deadline (ie 1.4.03) Must at least pay national basic fee by this date but other requirements can be met later, if necessary on payment of various surcharges.

Have a little more time for EPO entry (1.5.03). Need to pay national basic fee, pay designation fees, pay search fee, file request for examination and pay examination fee, and pay 3rd year renewal fee on this application by 31 M due date (R 107(1) EPC), grace periods available for these acts on payment of surcharges (R 108 EPC). Also required (R 107(1)(a) EPC) to file translation of the application, which is presently in Spanish, into one of the official EPO languages (FR, DE, EN).

Since all states were designated and paid for in PCT 1, may wish to consider whether want to obtain protection for SI in other states (apart from those that have notified non-applicability of A 22(1) PCT).

Once requirements for entry into European phase have been fulfilled (A 158 EPC, R 106 and R 107 EPC), PCI 1, which has an effective date of 1.10.00 since it appears to have validly claimed priority from ES1 (same applicant within 12 M from ES1 filing date, same subject matter - ie S1 shield) will be A 54(3) EPC prior art with respect to EP3 (ie novelty only prior art). This is because PCT 1 has an effective date prior to the effective date of EP3 (which does not have a claim to priority) but PCT 1 published (on 10.4.02) after the effective date of EP3. Therefore, to the extent that PCT 1 and EP3 designate the same states (A 54(4) EPC) and the designation fees for PCT 1 are paid, the subject matter of the claims of EP3 (SI type shielding system) lack novelty over the disclosure of PCT 1 (which also discloses the SI type shielding system).

EP4

This is already European patent application, nothing appears to have happened since publication of search report (10.4.02). Check designation fees and exam request and exam fee was paid/filed by 10.10.02, or within R 85a or b EPC grace periods (for exam fee within 1 M from notification of the failure to observe the time limit and surcharge payable, R 85b EPC; for designation fees 1 M after

notification under R 85a(1) if didn't dispense with notification and within 2 months of the missed date if did dispense with designation, R 85a(2) EPC). All these dates are likely to have passed now (certainly R 85a(2) EPC deadline would have) and no further processing or restitutio possible on these time limits. So check paid - if not can't do anything with EP4 now so claims to S2 would have been deemed withdrawn. If these fees etc. were paid then EP4 still pending and make sure pay 3rd year renewal fee due 31.10.03 (can be paid up to 30.4.04 with additional fee, A 86(1) + (2) EPC).

If EP4 still pending, can't amend EP4 to put in claims to S1 (which would have saved having to enter PCT 1 in European regional phase) even though have description of S1 in EP4's abstract as abstract may not be used for providing support for amendments (T 246/86). Consequently, such an amendment would not be allowable since it would add matter over the application as originally filed (contrary to A 123(2) EPC). Also, a priority document (ie here ESI) can not be used as basis for an amendment (also G 3/89 relevant). Therefore, if want to protect S1 in Europe, will have to continue with PCT 1 (likewise, can't amend PCT 1 by including claims to S2 since disclosure of S2 in PCT 1 is only in abstract). If EP4 is still pending (and designation fees paid) then it is also relevant as novelty-only prior art against EP3 to the extent that designate same states and that designation fees have been paid and because EP4 has an effective date earlier than but was published later than effective date of EP3.

However, although EP4 discloses S1 in the abstract, even such a disclosure was enabling, since EP4 is relevant to EP3 for novelty only, content of abstract cannot be taken into consideration (since A 54(3) EPC refers to content of application as filed and neither prior document nor abstract, in view of A 85 EPC, form part of content of application). Abstract only forms part of prior art once published. Therefore, EP4 would not affect novelty of subject matter claimed in EP3.

ES1 - Spanish right now granted. So, PP can stop anyone making, using etc. both S1 and S2 type shields in Spain.

ES1 is relevant to EP3 as a prior national right - could lead to revocation of EP3 if granted, with respect to Spain. (Check when published though - assuming not published by 15.3.01 filing date of EP3 - if did then ES1 would be full prior art). But as prior national right, ES1 can't affect EP3 until after grant as is not considered comprised in the state of the art for EP3. Also, can't oppose EP3, if granted, before EPO in view of ES1 itself as prior national right is not a ground of opposition.

3. Negotiation position

PP's position

- PP has granted US2 in US, so can prevent LBP from using, selling, making etc. (and any other acts constituting infringement under US law) plugs with triangular or square-shaped contacts in the US, which is a relevant market for LBP. → ie bargaining point for PP. (Patents are negative rights).

- PP has EP1 pending; plug with square contact looks patentable and granted could prevent LBP using, selling, making etc. in any EPC state which designation fees are paid for, such plugs. Position with regard to pentagon-shaped plugs is questionable - would need to show are inventive; but presently still pending. Once published EP1 will provide provisional protection (A 67 EPC), which can only be enforced after grant. Maybe good idea to request early publication by EPO so that provisional protection begins as soon as possible - need to file translations of claims in those states requiring it.
- PP is currently prevented from using etc. plugs with triangle or square cross-section in Germany, ES, FR and GB by EP2 (patents are negative rights). Even though consider square x-section subject matter invalid is presently still in force → threat of filing opposition against this patent to get this patent revoked centrally, at least with respect to the square contact subject matter.
- PP has ES1 which can stop LBP operating in Spain with respect to S1 and S2 type shields.
- PP has PCT 1 pending, which could, if granted, prevent LBP operating with SI shield in any state in respect of which this is granted - possibly will be EPC states and USA.
- PP has EP4 pending (I think) which would prevent LBP exploiting S2 if granted.

So, PP is in strong position as can, or may be able in the future, to prevent LBP doing a number of things, especially in relation to the shielding systems. LBP may not be so bothered about PP being able to stop some of their activities with the plugs as they can freely use the Δ contacts everywhere except US.

Looks possible to suggest cross-licensing so that LBP can use shields S1 + S2 and the Δ and \square shaped contracts in US and \square shaped contact plugs in EPC states where hopefully EP1 will eventually grant. In return, PP will want to be able to use Δ shaped plugs.

4. If negotiation not successful,

- oppose EP2, pay fee by 6. 8.03 using attacks described above in view of EP1 as A 54(3) EPC prior art for \square contact subject matter.
- File A 115 EPC 3rd party observations against EP3, which is pending, in view of PCT 1.

Make sure enter PCT 1 in national phase and check fee payments on EP4.

Amend EP1 by removing Δ subject matter, (divisional to pentagonal maybe) and file request for accelerated prosecution. Certainly request early publication of EP1.