
Examiners' Report - Paper D

General

Candidates this year seemed to be better prepared than in previous years. This trend is very much welcomed by the examination committee.

Again, some candidates missed valuable marks by surprisingly using old legal texts. This is a good way of failing the examination.

This paper tests legal knowledge and reasoning. Some candidates seem to believe that supplying two different and inconsistent views on a question may give them twice the chance of gaining marks. Poor or inconsistent reasoning leads to low (or even no) marks.

Possible Solution of Paper D, Part II

With regard to the patent situation of the HVHF plugs, I would first like to point out that in the US application US2 has the earliest dates for the subject-matter “triangular” and “square”. However, no applications are pending in the US for the subject-matter “pentagonal”.

In Europe, the patent situation is as follows:

EP1 does not validly claim priority under Art. 87(1),(4) EPC for the subject-matter “triangular” as US2 is not a first filing in a Paris Convention state because of US1. Despite having been abandoned US1 has left outstanding rights to US2 and the exception under A.87(4) EPC cannot be applied. Therefore, subject-matter “triangular” has only the actual filing date of EP1, i.e. 08.11.2002.

Subject-matter “square” in EP1 is equivalent to subject-matter “triangular”. When considering the latest case law of the enlarged Board of Appeal G2/98 the term “same invention” is to be interpreted in a narrow way and the so called novelty test is applied. Therefore, subject-matter “square” is not the same invention but new subject-matter and US2 is a first filing for “square” under Art. 87(1) EPC.

The end of the priority period was 04.11.2002 as 01.11.2002 was a holiday followed by a weekend, R. 85(1) EPC. The actual filing date is the date of receipt of EP1 which is the 08.11.2002. However, R. 84a EPC and decision of president of the EPO dated 11.12.1998 (OJ 1999, 45ff) apply as EP1 was sent with a registered letter more than 5 days before the deadline (on 29.10.2002) and was received only 4 days after the deadline, i.e. less than 3 months after the expiry. Therefore, EP1 is deemed to have been received in due time and the priority was validly claimed. Subject-matter “square” in EP1 has a priority date of 01.11.2001.

Subject-matter “pentagonal” in EP1 is also equivalent to subject-matter “triangular” and “square”. Therefore, it is not the same invention but new subject-matter and cannot validly claim priority. Thus, subject-matter “pentagonal” has only an effective filing date of the actual filing date of EP1, i.e. 08.11.2002.

EP2 was published on 06.11.2002 and therefore is prior art under Art. 54(2) for novelty and inventive step (Art. 54 and Art. 56 EPC) against subject-matter “triangular” and subject-matter “pentagonal” of EP1. Thus, subject-matter “triangular” in EP1 is not new over EP2 under Art. 54(2) EPC and PP will not get patent protection in EP1 for subject-matter “triangular”. Subject-matter “pentagonal” in EP1 is new over EP2, but since “pentagonal” is only equivalent of “triangular”, it is possibly not inventive over EP2 under Art. 56 EPC. Thus, it is possible that PP will not get patent protection in EP1 for SM “pentagonal” either.

However, EP2 discloses subject-matter “square” for the first time. As FR1 discloses only subject-matter “triangular” and as “square” is equivalent and not the same invention, EP2 does not validly claim priority of FR1 under Art. 87(1) EPC for subject-matter “square”. Thus, subject-matter “square” in EP2 has only its filing date of 14.11.2001 and therefore is not prior art against EP1. PP can get patent protection in EP1 for subject-matter “square”.

On the other hand, EP1 can be prior art under Art. 54(3) EPC against EP2 for subject-matter “square”, but only if EP1 is published when still pending and for overlapping EPC states according to Art. 54(4) and R. 23a EPC. As all necessary fees have been paid for EP1 in due time, the designation of inventor has been validly filed, A.91(5) EPC, and as the priority document has been validly filed, R.38(3) EPC, EP1 is still pending and can be prosecuted to be a Art. 54(3) EPC document against EP2. US2 cannot be prior art under Art. 54(3) which is limited to only earlier European applications. However, we will check if US2 was published as a patent application.

We do not have to worry about PP’s advertisement because it does not count as a prior public disclosure and therefore is not prior art against EP1.

The patent situation with regard to the shielding systems is as following.

Subject-matter S2 is only protected in Europe by EP4. In any case we should check whether it is possible to protect subject-matter S2 in the US by filing a corresponding US application within the US grace period ending 10.4.2003.

PP has patent protection for subject-matter S1 in Spain resulting from ES1. EP4 is not prior art against EP3 because the abstract is not part of the disclosure under Art. 54(3) and Art. 85 EPC. PCT1 can be prior art against EP3, however only under A.54(3) EPC if the priority claim is made valid. This is important because otherwise EP3 has the earliest priority date in Europe.

Thus, it is necessary to validly enter the regional phase before the EPO for PCT1 according to Art. 158(1) EPC. The period of 21 months for doing this ended on 01.07.2002. Therefore, the new rule for entering the regional phase applies (see OJ 2001, 586 and corresponding change for the PCT). It is still possible to validly enter the regional phase because the time limit of 31 months after priority which ends on 01.05.2003. As this is a holiday the time limit is extended to 02.05.2003 under R. 85(1) EPC. It will also be possible to enter the US national phase for PCT1 within the time limit of 30 months which ends on 01.04.2003.

PP is in a good negotiation position for the discussion with LBP next week. Concerning EP2, PP is in a good position in the US market for subject-matter “triangular” and “square” because of their patent US2. Furthermore, PP can manufacture in NL or any other country without patent protection. PP is also in a good position for subject-matter “square” in the EU market in general because of EP1 if granted and perhaps also for subject-matter “pentagonal” if regarded inventive over subject-matter “triangular”.

However, your competitor LBP is in a better position in the EU market for subject-matter “triangular” because of their patent EP2. For this reason, PP should take advantage of its good negotiation position in order to try to negotiate a cross-license with LBP.

Concerning EP3, PP has strong arguments for making LBP pay for a license for subject-matter S1 because of PCT1. In case of a license agreement with LBP only two companies can access the market, if however PCT1 is validly regionalized but not prosecuted then no patent protection exists and every competitor has free access to the market which is a worse situation for LBP. PCT1 can also be used as argument for a cross license with LBP for the subject-matter of EP2. Also EP4 could be used as an argument for licensing.

If the meeting with LBP is not successful, PP has to check if LBP filed a US-application corresponding to EP2. In any case for improving its position PP should file a US- or PCT-application claiming priority of EP1 for subject-matter "pentagonal".

In order to get a rapid grant for subject-matter "square" in EP1, PP could consider filing a divisional application for subject-matter "pentagonal" which would then be deleted from EP1.

PP should consider filing an Opposition against EP2 for which the 9 months time limit ends on 06.08.2003 according to Art. 99(1) EPC based on ground Art. 100a EPC lack of novelty by using EP1.

For doing this PP should pay designation fees for EP1 at least for DE, FR, GB, ES (better for all EPC states for the cost of 7) according to Art. 54(4) and R. 23a EPC. In consequence, subject-matter "square" in EP2 will have to be deleted and EP2 will be maintained in amended form only protecting subject-matter "triangular" according to Art. 102(3) EPC.

Against EP3 PP should enter the regional phase for PCT1 by filing a translation in one of the official languages according to Art. 158(2) EPC and by paying the national basic fee (Art. 158(2), R. 106 a) EPC, A. 22 PCT) and the designation fees for at least DE, FR, GB (R. 106 b)EPC) and by filing a copy of ES1 as priority document in order to validly claim priority for PCT1 (R. 111(2) EPC).

After having done this, PP should send a copy of PCT1 to the examiner according to Art. 115(1) EPC or should later file an Opposition against EP3 using PCT1.

In order to prosecute the European regional phase of PCT1, PP should request examination and pay the examination fee.

EXAMINATION COMMITTEE III

Candidate No.

Paper D Schedule of marks

| Question | Maximum possible | Marks awarded | |
|----------|------------------|---------------|-----|
| | | Exr | Exr |

PART I

| | | | |
|---------------------|-----------|--|--|
| 1 | 4 | | |
| 2 | 4 | | |
| 3 | 4 | | |
| 4 | 6 | | |
| 5 | 5 | | |
| 6 | 4 | | |
| 7 | 4 | | |
| 8 | 5 | | |
| 9 | 6 | | |
| 10 | 3 | | |
| TOTAL PART I | 45 | | |

PART II

| | | | |
|----------------------|-----------|--|--|
| 1 | 24 | | |
| 2 | 9 | | |
| 3 | 11 | | |
| 4 | 11 | | |
| TOTAL PART II | 55 | | |

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|---------------------------|------------|--|--|
| Total Parts I + II | 100 | | |
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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)

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

Munich, 12 September 2003

Chairman Examination Committee III