

## Candidate's answer

PCT-BF was filed 15 Dec 2006 without a claim to priority so the 31m deadline for entering the EP national phase is 15 Dec 2006 + 31m = 15 July 2009 (Wed). Since BF has manufacturing facilities in Albania it is likely to enter the EP national phase. If it does so, it will be a prior national right for EP1, EP2 and EP3. Check EPO register to see whether BF have entered the national phase early and if not, carry out further file inspections closer to the deadline. The publication of PCT-BF in August 2008 is not prior art under Art 54(2) EPC for EP1, EP2 or EP3 because it took place after their filing dates (and effective dates). If PCT-BF does not enter the EP national phase EP1 EP2 and EP3 are definitely novel and inventive since no prior disclosure and the use of escargines and/or slugbanite is advantageous over copper strips.

EP1, EP2 (amended) and EP3 (limited) demonstrate an inventive step since the use of copper compounds instead of copper strips is new and advantageous. Further, the application of the compositions in stripes rather than round the rim also has unexpected advantages.

### Sufficiency of EP1, EP2 and EP3

Each of EP1, EP2 and EP3 describe slugbanite generally when slugbanite A and B work but slugbanite C and D do not. Therefore it might be argued that the patents/applications do not disclose the invention in a manner sufficiently clear and complete for it to be carried out by a person skilled in the art (Art 83 EPC) or that the claims are not supported by the description (Art 84 EPC). Since the example provided does work and 2/4 types works I think there is a good argument that the requirements for sufficiency and clarity have been met. (There is no obligation that every single combination works) In any case, there is no basis for limiting to Slug-A or Slug-B; such an amendment would add matter. Similarly, cannot simply disclaim the non-working embodiments since no basis in the applications for such an amendment, so would also add matter. If EP1, EP2 (once granted) or EP3 is opposed on the grounds of lack of sufficiency (clarity is not a ground for opposition) then could limit the claims to the compositions described in the examples. Can't simply specify slugbanite sourced from the Hosta la Vista Mine, would need to take the whole teaching of the examples, rather than randomly choose a feature that is only disclosed in combination with other elements.

EP1 was granted 1st March 2009 so an opposition can be filed up to 9 months later = 1<sup>st</sup> Dec 2009 (Tues). B-F might oppose.

EP1 validly claims priority from GB1 since within 12m priority period and there is clear basis in GB1 because the claim uses a paragraph from GB1. EP1 has an effective date of 6 Jan 2007. EP1 was filed under EPC 2000 so PCT-BF will be prior art under Art 54(3) EPC 2000, i.e. for all contracting states, if nationally phased. PCT-BF does not anticipate claim 1 of EP1 because PCT-BF does not disclose using snail and slug attractants in the compositions.

PCT-BF cannot be available for I.S. since not published. EP1 would appear to be (subject to the sufficiency query). Therefore it is necessary to validate EP1 in each of the states of interest. Since Big Farma may be interested in the patent it is worth validating in as many countries as you can afford, especially UK (your base) and Albania (their base). Albania is an extension state for which extension may be obtained because the extension fee was paid. Because of the London Agreement it will be possible to validate the patent more cheaply than previously since many countries only require a translation of the claims. No further translation required for FR, DE, Liechtenstein, Luxembourg, Monaco, Switzerland and the UK. Denmark, Croatia, Iceland, Latvia, Netherlands, Sweden + Slovenia only require claims in their official language so long as patent has been granted in a prescribed official EPO language (one of FR, DE or EN). Since patent would have been granted in English, this applies to Croatia, DK, Iceland, NL + Sweden only. Deadline for validation is 3m from grant in most countries, i.e. on 1 July 2009 (Wed) so needs to be done fairly soon. Get instructions for countries in meeting.

### EP2

EP2 validly claims priority from GB1 because within priority period. 6 Jan 2007+ 12m = 6 Jan 2008 (Sun) closed day → 7 Jan 2008 (Mon) and claim has explicit basis in GB1.

If PCT-BF enters the national phase it will be art 54(3) prior art for all c.s. described above and will anticipate the claim of EP2 since it discloses a method of coating at least a part of the surface of plant pots with compositions comprising escargines.

EP2 has not yet been granted. Should respond to the 71(3) communication requesting amendment of the claims. At present includes escargines, slugbanite or both. Supply amended claims referring to slugbanite or slugbanite and escargines.

Supply amended claims in EN, FR and DE pay the fees for grant and printing. Respond to the 71(3) communication within 4 months, i.e. another task required within 5 months.

At present don't know if this amendment is necessary, but very likely to be. If PCT-BF does not enter national phase should still have time to file a divisional to cover the escargines embodiment. File divisional up to day before the mention of the Dec to Grant for EP2. Could allow EP2 to grant as is and then limit after grant (if necessary) if you wish.

### EP3

If PCT-BF enters the national phase it will anticipate claim 1 of EP3 since it discloses plant pots coated with escargines and EP3 has an effective date of 6 Jan 2007 for the same reasons as EP1. PCT-BF would not anticipate cl 2 of EP3 since specific location not disclosed. A plant pot coated with slugbanite or slugbanite + escargines would be novel so should file a request for limitation of the patent and pay the fee. The request for limitation should limit claim 1 to plant pots coated with slugbanite or slugbanite + escargines.

Claim 2 does need to be so limited. Make claim 2 independent so it includes escargine + slugbanite or slugbanite applied in the specific location.

Such a request will still be accepted since narrower than the original claim set.

If an opposition is filed the limitation procedure will be terminated and the fee refunded.

The patent also needs to be validated in those countries of interest.

There is no time limit for filing the request for limitation. Might not want to wait to see whether PCT-BF enters national phase before requesting limitation since might not be necessary. Since EP3 has granted, need to validate within 3 months in most countries as described in relation to EP1.

Q4

The PCT application should have been filed within the convention period for GB2.

3rd Jan 2008 + 12m = 3rd Jan 2009 (Sat) closed day → 5 Jan 2009 (Mon).

However, it is possible to file the application late with a request for restoration of the priority period if the request is filed within 2 months of the failed time limit. 5 Jan 2009 + 2m = 5 March 2009 (Thurs)

Need to pay fee for restoration and demonstrate that all due care required by the circumstances were taken. As evidence, provide the application documents which will be dated 24/12/2008, the ordered payment documentation and declarations from Iris and Daphne. Need to explain your usual procedures and demonstrate that this really is a one-off mistake by an otherwise responsible, trustworthy employee. In light of the short deadline and no further documents being available, file application using GB2 specification provided and request restoration (and pay fee) by fax to the EPO with an outline of reasons for missing the deadline and provide actual documentation later. Important to demonstrate 'all due care' since this is the criteria that the EPO will use during the national phase as well as R.O. The USPTO does not accept requests for restoration so will consider the application to have its filing date only.

If the request for restoration is successful, the resulting EP (and Albanian) patent will have an effective date of GB2 - 3 Jan 2008. Hence the publication of PCT-BF, and EP1, EP2 and EP3 will not be prior art within the meaning of Article 54(2) EPC. However, PCT-BF and EP1 will be Article 54(3) prior art.

PCT-BF does not describe slugbanite at all so is not relevant.

EP1 describes Slugbanite and refers to slugbanite from The Hosta La Vista mine (slugbanite A). However, there is no explicit disclosure of slugbanite B in EP1 since not mentioned and not even inherently disclosed by the examples. Therefore the subject matter of slugbanite B, optionally with escargines is novel.

In the USA, the application will have an effective date of the filing date, March 2008. The publication of PCT-BF will be full prior art, as will the publication of EP1, EP2 and EP3. EP1, EP2 and EP3 will have published ~18 months after their priority date of ~June 2008 and this is within the 1 year grace period. PCT-BF also published within the grace period (Aug 2008). SH could therefore swear back behind these disclosures. It is important to do this because even though Slugbanite B is not disclosed in the prior art (it is novel) it might be considered to lack an inventive step since it is well known that Slugbanite comes in 4 forms and EP1-EP3 describe the use of slugbanite generally to kill slugs and snails and the use of slugbanite and escargines which gives rise to a synergistic effect. Hence, very difficult to argue that slugbanite B is inventive.

The method of preparing finely divided Slugbanite is new and likely to be found inventive since it is highly effective so should lead to protection in EP and the US.

PCT-SH claims priority from GB2 is valid (if restoration is successful) because 'same invention' construed narrowly so GB2 is the first application for slug-B.

#### Q5

PCT-BF will likely lead to EP and US patents for escargines compositions and related methods and plant pots. No search appears to be available (check this) but since EP1, EP2 and EP3 had no relevant prior art, you would expect PCT-BF to be the same.

If BF obtains patents for escargines, SH will not be able to use their compositions comprising both slugbanite (A or B) and escargines but could sell slugbanite only. Similarly, BF will be able to sell escargine products but not products comprising both escargine and BF.

Therefore could just split the market. However, since the synergistic effect is achieved when both escargine + slugbanite are used it is likely that both parties will want access to the combination.

If BF is being aggressive, it might file oppositions against EP1, EP2 and EP3 based on lack of sufficiency. BF could also oppose EP3 based on PCT-BF/EP even if the request for limitation is filed. If successful EP1, EP2 and EP3 would be severely restricted, allowing BF access to at least alternative sources of Slug-A and Slug-B. However, there is no guarantee that the opposition would be successful. Further, a successful opposition would allow anybody access to the invention, not just BF + SH.

If BF is aggressive, SH can defend oppositions and refuse to licence PCT-SH (Slug-B, new method) and also plant pots having specific location of composition (EP3)

If BF is co-operative, could negotiate a cross licence whereby BF agrees not to oppose EP1, EP2 or EP3.

BF gets a licence under EP1, EP2 or EP3 for Slugbanites and escargines and SH gets a licence under PCT-BF to escargines. The licence may be granted for the geographical areas of interest. Clearly, US and Albania for BF and at least GB for SH. Clearly need to be careful about competition issues if BF and SH have an agreement.