

EUROPEAN QUALIFYING EXAMINATION 2011

Paper D

Part II

This paper comprises:

- * Client's letter including four (4) questions 2011/DII/EN/1 - 7
- * Annexes: calendars for 2009, 2010 and 2011 with indication of the days on which at least one of the EPO filing offices is not open for the receipt of documents 2011/DII/EN/8 - 10

40% of the marks available for paper D are awarded for part I,
60% for part II.

Today is 1 March 2011.

You receive the following letter from the director of Axbruch GmbH, a manufacturer of bicycle components, based in Germany:

We are a globally active supplier of bicycle components. Our major competitor is Pankutaya Japan K.K., a conglomerate with manufacturing and research facilities in Japan and the Netherlands.

I am responsible for patenting, but I find this work rather difficult. I have had to represent the company in an opposition, which has not gone well and which is now at the appeal stage. I will come back to this later, because there is another matter I would like your advice on first. It concerns our new product, which is aimed at the European market for bicycles.

In 2009, we worked on the development of a new type of axle unit. Such a unit is screwed into a bicycle frame by the bicycle manufacturer. It includes an axle and bearings. The pedals of the bicycle are connected to the ends of the axle via cranks. This type of axle unit is normally filled with a lubricating composition before it is sealed.

For our axle unit, we developed a special seal (S). This special seal S allows the use of a larger diameter axle, which is stiffer. This special seal S also allows us to use a new type of axle of which the diameter decreases towards each end. Unlike the other axles on the market at the time, the ends of which had square cross-sections, we developed two new variants of axle ends. The first variant has a pentagonal cross-section. The second variant has a cross-shaped cross-section. The latter shape is a radical departure from the normal square shape.

Both variants of the unit were developed by Alice and Bob, two of our designers, who were part of our early-stage development team based in Germany. We filed a German patent application DE-Ax on 30 October 2009, with an independent claim to an axle unit with the special seal S. Both variants of the axle are fully described. As far as the lubricating composition is concerned, we included in DE-Ax a long list of different types of suitable oils, including silicone oil. We indicated that the chosen oil could be combined with at least one additive, such as an antioxidant, a detergent, a corrosion inhibitor or a viscosity index improver. All are known components for forming a lubricating composition. DE-Ax is deemed withdrawn for failure to pay the filing fee.

As we prepared for market introduction, Alice relocated to the United States, to head up the testing and prototyping of our new axle units. At this stage of the product development process, she was surprised to discover that a lubricant composition consisting specifically of a combination of silicone oil and any viscosity index improver ensures that the special seal S continues to function for longer. Other compositions lead to leaks of the lubricant past the special seal S at an early stage, thereby limiting the lifespan of the axle unit. For that reason, at the conclusion of the design phase, we had settled on two variants of our axle unit, each filled with silicone oil and a viscosity index improver, and including the special seal S and an axle with decreasing diameter towards axle ends having either a pentagonal or a cross-shaped cross-sectional shape.

On 1 February 2010, we submitted detailed specifications of our two axle units as well as of the preferred lubricant composition to a standardisation committee for bicycle components. This information was sent on the same day to the members of the committee for their opinion, prior to a meeting of the committee. Most major suppliers to the bicycle industry are in the committee, which has been set up to ensure that, when new components are introduced, suppliers of other components have interoperable components available for consumers and producers of bicycles.

As a precaution, our developers have been instructed to file a copy of what is submitted to the standardisation committee as a U.S. provisional patent application. In this case, such an application, hereafter referred to as USP-Ax, was filed by Alice on the same day (1 February 2010), naming herself and Bob as applicants and inventors. At the same time, she filed a declaration of assignment, signed by Bob and Alice, of USP-Ax to Axbruch GmbH. Ten months later, and in accordance with our normal procedure, Alice notified me of what she had filed, so that I could judge whether we should file further patent applications.

In this case, I did nothing, because there had not been any changes to the axle unit as already fully disclosed in an international patent application PCT-Ax. I filed this application with the EPO on 2 November 2010, in the name of Axbruch GmbH, naming Alice and Bob as inventors. PCT-Ax claims priority from DE-Ax.

Claim 1 of PCT-Ax is an independent claim to an axle unit with the special seal S and a lubricant composition comprising a combination of silicone oil and a viscosity index improver. Claim 2 is dependent on claim 1, and additionally specifies that the axle decreases in diameter towards its ends. Claim 3 is dependent on claim 2, and specifies the pentagonal cross-section of the axle ends, whereas claim 4 is dependent on claim 2 and specifies the cross-shaped cross-section of the axle ends. The description and drawings of PCT-Ax were based on those of DE-Ax, but limited to axle units with a lubricant composition which is a combination of silicone oil and a viscosity index improver. We also added the results of our tests.

We have received an invitation to pay a further search fee in respect of the subject-matter of claim 4, dated 23 January 2011 and accompanied by a partial international search report citing JPU-PAN1. JPU-PAN1 is a Japanese utility model with a filing date of 15 July 2009 which was published on 21 October 2009. EP-PAN1, an application filed on 1 July 2010 by reference to JPU-PAN1, claiming priority from JPU-PAN1 and published early in January 2011 is cited as evidence of the contents of JPU-PAN1.

EP-PAN1 and JPU-PAN1 were both filed in the name of Pankutaya Japan K.K.'s subsidiary, Pankutaya Nederland B.V.. EP-PAN1 claims and discloses an axle unit with a seal exactly the same as the seal S we had developed. The axle decreases in diameter towards each end. However, the axle of the only embodiment has end sections with a triangular cross-section. EP-PAN1 describes the lubricant as a silicone oil with a further additive that may be a viscosity index improver, an emulsifier or an anti-foaming agent. EP-PAN1 was assigned to Pankutaya Japan K.K. after filing.

We were not that surprised by the partial search report, because Pankutaya had already reported to the standardisation committee in December 2010 the existence of JPU-PAN1, EP-PAN1 and JPU-PAN2. JPU-PAN2 is a second Japanese utility model application filed on 10 July 2009 and published on 10 October 2009. JPU-PAN2 was filed directly in the name of Pankutaya Japan K.K.

JPU-PAN2 discloses an axle unit with a seal identical to our seal S and an axle decreasing in diameter towards each end. The axle has end sections that are pentagonal in cross-section. The description given in JPU-PAN2 states that the axle unit is filled with a lubricant composition consisting of a silicone oil and one of the following additives: a viscosity index improver, an emulsifier or an anti-foaming agent. We have established that there are no equivalents to JPU-PAN2 in other countries. We have considered whether to file third party observations in relation to EP-PAN1, citing JPU-PAN2, but we are not sure whether this is possible.

The standardisation committee has very recently specified the cross-shaped axle end in a standard, because the members are convinced of its technical advantages over the pentagonal and the triangular axle ends. For example, other components of the bicycle that interact with the axle unit can be made lighter.

I sent off a debit order to the EPO for the further search fee immediately after receiving the invitation to pay the additional fee and told our accounts department to pay the amount of the fee into our deposit account. Unfortunately, I found out yesterday that a fax notifying us of a shortfall in the deposit account was received and passed straight to our accounts department on 26 January 2011. They have told me that our deposit account was replenished on 24 February 2011. It is our usual procedure to send faxes relating to the deposit account straight to our accounts department, but in this case I wish I had seen the fax, because it says something about an administrative fee to be paid.

- 1) Please analyse our present position as far as patent protection in Europe for the various aspects of our developments is concerned. For which aspects of our developments can we obtain patent protection in Europe, and how?**
- 2) Please analyse whether Pankutaya could obtain valid patent protection that would pose a threat to our European activities.**

Now I come to the appeal. We were granted a European patent, EP-Ax, to a newly developed brake lever. We developed this brake lever for use in combination with either disc brakes or rim brakes. When we developed the brake lever, we had mechanical disc brakes and mechanical rim brakes in mind, in which the brake force generated with the brake lever is transmitted by steel cables to the disc or rim brakes. However, we thought at the time that the brake lever might also be suitable for use with hydraulic disc brakes or hydraulic rim brakes, in which the braking force is transmitted by hydraulic oil to the disc or rim brakes, but we did not get round to testing this possibility.

The first claim of the granted patent was to the special brake lever, and there was no claim to a bicycle brake system including at least one brake lever according to the first claim. The description of EP-Ax merely indicates that the brake lever is for use in a bicycle brake system of the type having at least one disc brake. However, there is no description or picture of any bicycle, nor is there any mention of rim brakes.

Pankutaya opposed EP-Ax on grounds of lack of novelty on the basis of their earlier European patent application, EP-PAN2, which is state of the art under Art. 54 (3) EPC. It discloses and claims a bicycle with the same brake lever as ours and with hydraulic rim brakes. It includes a very detailed drawing of the brake lever. Therefore, in addition to our main request to reject the opposition, we filed an auxiliary request limiting the independent claim of EP-Ax to a bicycle brake system with the special brake lever, and with a disclaimer to disclaim bicycle brake systems in which the brake lever is used to actuate hydraulic brakes. EP-Ax was maintained by the Opposition Division in amended form in accordance with our auxiliary request.

As a matter of fact, the bicycle described in EP-PAN2 was never put on the market. The reason for this is that it is impossible to make a functioning brake system with hydraulic rim brakes and the brake lever.

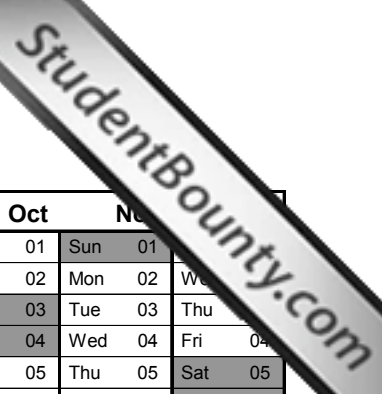
We have not yet appealed the interlocutory decision of the Opposition Division, but the period for appeal has not yet expired. Pankutaya immediately appealed and also filed their statement of grounds of appeal. In the statement they only argue that the subject-matter of the claim of EP-Ax is insufficiently disclosed because a functioning bicycle brake system fitted with the brake lever in combination with a hydraulic rim brake cannot be made. We accept that this is true. We have done our own tests and found that this problem does not affect brake systems using our brake lever in combination with mechanical rim or disk brakes or hydraulic disk brakes.

3) Should we appeal?

4) Discuss what subject-matter we can validly claim to obtain the broadest scope of protection possible.

Annex 1

2009



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Thu 01	Sun 01	Sun 01	Wed 01	Fri 01	Mon 01	Wed 01	Sat 01	Tue 01	Thu 01	Sun 01	Wed 01
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Tage / Days / Jours		München Munich	Den Haag The Hague La Haye	Berlin
Neujahr - New Year's Day - Nouvel An	01.01.2009	x	x	x
Brückentag - Bridging Day - Pont	02.01.2009	x	x	x
Heilige Drei Könige - Epiphany - Epiphanie	06.01.2009	x		
Karfreitag - Good Friday - Vendredi Saint	10.04.2009	x	x	x
Ostermontag - Easter Monday - Lundi de Pâques	13.04.2009	x	x	x
Nationalfeiertag - National Holiday - Fête nationale	30.04.2009		x	
Maifeiertag - May Day - Fête du Travail	01.05.2009	x	x	x
Tag der Befreiung - Liberation Day - Journée de la Libération	05.05.2009		x	
Christi Himmelfahrt - Ascension Day - Ascension	21.05.2009	x	x	x
Brückentag - Bridging Day - Pont	22.05.2009	x	x	x
Pfingstmontag - Whit Monday - Lundi de Pentecôte	01.06.2009	x	x	x
Fronleichnam - Corpus Christi - Fête-Dieu	11.06.2009	x		
Heiliger Abend - Christmas Eve - Vieille de Noël	24.12.2009	x	x	x
1. Weihnachtstag - Christmas Day - Noël	25.12.2009	x	x	x
Silvester - New Year's Eve - Saint-Sylvestre	31.12.2009	x	x	x

Annex 2

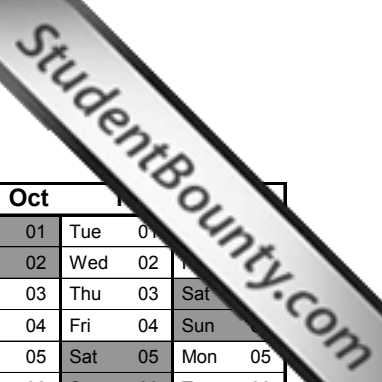
2010

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Tage / Days / Jours		München Munich	Den Haag The Hague La Haye	Berlin
Neujahr - New Year's Day - Nouvel An	01.01.2010	x	x	x
Heilige Drei Könige - Epiphany - Epiphanie	06.01.2010	x		
Karfreitag - Good Friday - Vendredi Saint	02.04.2010	x	x	x
Ostermontag - Easter Monday - Lundi de Pâques	05.04.2010	x	x	x
Nationalfeiertag - National Holiday - Fête nationale	30.04.2010		x	
Tag der Befreiung - Liberation Day - Journée de la Libération	05.05.2010		x	
Christi Himmelfahrt - Ascension Day - Ascension	13.05.2010	x	x	x
Brückentag - Bridging Day - Pont	14.05.2010	x	x	x
Pfingstmontag - Whit Monday - Lundi de Pentecôte	24.05.2010	x	x	x
Fronleichnam - Corpus Christi - Fête-Dieu	03.06.2010	x		
Allerheiligen - All Saints' Day - Toussaint	01.11.2010	x		
Heiliger Abend - Christmas Eve - Vieille de Noël	24.12.2010	x	x	x
Silvester - New Year's Eve - Saint-Sylvestre	31.12.2010	x	x	x

Annex 3

2011



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Tage / Days / Jours		München Munich	Den Haag The Hague La Haye	Berlin
Heilige Drei Könige - Epiphany - Epiphanie	06.01.2011	x		
Karfreitag - Good Friday - Vendredi Saint	22.04.2011	x	x	x
Ostermontag - Easter Monday - Lundi de Pâques	25.04.2011	x	x	x
Tag der Befreiung - Liberation Day - Journée de la Libération	05.05.2011		x	
Christi Himmelfahrt - Ascension Day - Ascension	02.06.2011	x	x	x
Brückentag - Bridging Day - Pont	03.06.2011	x	x	x
Pfingstmontag - Whit Monday - Lundi de Pentecôte	13.06.2011	x	x	x
Fronleichnam - Corpus Christi - Fête-Dieu	23.06.2011	x		
Mariä Himmelfahrt - Assumption Day - Assomption	15.08.2011	x		
Tag der Deutschen Einheit - Day of German Unity - Fête Nationale	03.10.2011	x		x
Allerheiligen - All Saints' Day - Toussaint	01.11.2011	x		
2. Weihnachtstag - Boxing Day - Lendemain de Noël	26.12.2011	x	x	x