

EUROPEAN QUALIFYING EXAMINATION 2012

Paper D

Part II

This paper comprises:

- * Client's letter including four (4) questions 2012/DII/EN/1-8
- * Annexes: calendars for 2010, 2011 and 2012 with indication of the days on which at least one of the EPO filing offices is not open for the receipt of documents 2012/DII/EN/9-11

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

Membrain AG
Wassergasse 12
A-1030 Vienna

6 March 2012

Dear Mrs. Patent Attorney,

[0001] We are a medium-sized manufacturer of products for the treatment of water, said products comprising membranes. Our main production facilities are located in Vienna, Austria, and from there we export our products to emerging countries, where the market for water treatment is rapidly growing.

[0002] For the filtering out of fine solid particles present in waste water, modules are known that comprise a bundle B of hollow fibre membranes, i.e. hollow tubular fibres whose walls act as a membrane. These modules are adapted to be connected, via a holder for holding the fibres, to a pump in order to draw water from the outside into the interior of the hollow fibre membranes. The membranes are usually made of ceramics of class C, but may also be made of a special class of polymers P. These modules are adapted to be immersed in waste water but suffer from the problem of incrustation with particles if the waste water surrounding the modules does not flow, but stagnates. In order to obviate this problem we have developed a membrane module that can be immersed in stagnant waste water. Our module comprises, in addition to the known bundle B of hollow fibre membranes, a specially designed nozzle N that is adapted to inject air bubbles into the bundle B, thereby removing incrustations on the fibres which decreases the frequency of cleaning and prolonging the life time of the module.



[0003] On 31 July 2009 we filed a European patent application EP-1 without claims. The description comprises a general part and a part describing a single embodiment and referring to the drawings. The general part discloses a module comprising a bundle B of hollow fibre membranes and the specially designed nozzle N for injecting air into the bundle B in order to remove incrustations on the fibre bundle. It is stated in this part that the membranes and the nozzle N may be made of any suitable material and in particular that the membranes may be made of ceramics of class C and the nozzle N may be made of stainless steel. The part describing the embodiment and referring to the drawings discloses a module comprising bundle B of hollow fibre membranes made of ceramics of class C and the specially designed nozzle N made of stainless steel. It is stated that it is essential for this embodiment that the specially designed nozzle N is made of stainless steel and that the membranes are made of ceramics of class C. It is further stated that this provides a reliable module having a prolonged life as the nozzle can be readily immersed in waste water without corroding. EP-1 was subsequently abandoned.

[0004] On 3 May 2010 we filed a PCT application PCT-1 containing the same description as EP-1. PCT-1 claims priority from EP-1 and contains a claim directed to a module comprising the specially designed nozzle N and a bundle B of hollow fibre membranes. The claim does not specify the material of the membranes and the material of the nozzle N. The purpose of filing PCT-1 was to obtain patent protection in emerging countries such as Brazil and India. PCT-1 was published in February 2011.



[0005] In June 2010, our research engineers tested other nozzles available on the market which are intended for aerating waste water. These nozzles are described in the Handbook of Waste Water Aeration published in December 2009, which states that they are suitable for injecting air into small interstices. The tests revealed that, although suitable for injecting air bubbles into the fibre bundle, these nozzles are not as effective as our specially designed nozzle N. As they are cheaper than our specially designed nozzle N, we nevertheless considered using them in our modules. In order to secure our rights in Europe, on 2 August 2010 we filed a European patent application EP-2 claiming priority from EP-1. To obtain the broadest patent protection possible, in the general part of the description of EP-2 we replaced the term “specially designed nozzle N” with the term “means for injecting air into the fibre bundle”. The part describing the embodiment shown in the drawings was left unchanged. Claim 1 of EP-2 is directed to a module comprising a bundle B of hollow fibre membranes and means for injecting air into the fibre bundle. Claim 1 does not specify the material of the membranes. Dependent claim 2 is directed to the module comprising bundle B of hollow fibre membranes made of ceramics of class C and the specially designed nozzle N made of stainless steel.

[0006] The search reports of EP-2 and PCT-1 did not reveal any relevant documents, but in the written opinion for PCT-1 an objection pursuant to Art. 6 PCT was raised. According to the examiner, it is essential that the hollow fibre membranes are made of ceramics of class C, but this feature is missing from the independent claim. The international search report for PCT-1 including the written opinion was transmitted on 11 August 2011. EP-2 is still pending.



[0007] On 10 November 2011, we filed a demand for international preliminary examination of PCT-1 at the EPO and paid the corresponding fee. In our submissions accompanying the demand, we did not amend PCT-1, but rather explained why it is not essential that the hollow fibres are made of ceramics of class C. We included experimental data showing that our specially designed nozzle N also works with hollow fibres made of polymers of the class P. We also included an extensive description of our recently developed hollow fibre membranes that are made of polymers of the class P and are coated with a special coating K. We are convinced that these new hollow fibre membranes will revolutionise the hollow fibre membrane market as they are as stiff as ceramic membranes, but are less vulnerable to vibrations, in particular those generated by air bubbles injected into the bundle. Moreover, their production costs are very low compared to ceramic hollow fibre membranes.

[0008] We have not received an international preliminary examination report (IPER) for PCT-1 yet. As we are interested in having a positive IPER, we have contacted the examiner at the EPO, who has agreed to give us a personal interview, tomorrow, at the EPO premises. PCT-1 has entered the national phases only in those emerging countries that we are interested in, which include Brazil and India. As we had also filed EP-2 and no objection concerning it was raised in the extended European search report, we did not enter the regional phase before the EPO for PCT-1.



[0009] Watergate Inc. from the US are our main competitor in the emerging countries and have their production sites in the US. As we knew that they had also been investigating how to solve the problem of incrustations in fibre bundle modules, we became concerned when we read a communication first posted on their website on 30 July 2010 stating that they had filed a US patent application on 30 April 2010. The communication mentioned that the application relates to a hollow fibre membrane bundle module for waste water treatment comprising a nozzle for injecting air into the bundle for incrustation removal. Moreover, the communication stated that Watergate would soon also start manufacturing their products in Europe. We have since then also found out that on 2 May 2011 Watergate filed a European patent application EP-WG by reference to and claiming priority from US-WG filed on 30 April 2010. EP-WG and US-WG have been published. US-WG discloses a module comprising hollow fibre membranes made of polymers of class P, and a nozzle that is identical to our specially designed nozzle N and that is preferably made of stainless steel. Claim 1 of US-WG is directed to a module comprising a bundle B of hollow fibre membranes and the specially designed nozzle N. Claim 1 does not specify the material of the membranes and the material of the nozzle. Dependent claim 2 is directed to a module comprising the nozzle N and a bundle B of hollow fibre membranes made of polymers of class P.



[0010] We are presently manufacturing modules with specially designed nozzles made of stainless steel and with hollow fibre membranes made of ceramics of class C. We are, however, also producing modules comprising the specially designed nozzle N made of other materials and hollow fibre membranes made of polymers of class P without the coating K. The latter modules are not as reliable as the first ones, but can be produced at much lower costs. We are also planning to manufacture and sell modules in which the specially designed nozzle N is replaced by the nozzles available on the market that are cheaper but less effective.

Please advise us on the following questions:

- 1) What is the legal status of our patent rights and those of Watergate?**
- 2) What do you advise us concerning our recently developed membranes comprising the special coating K?**
- 3) What can be done to improve our patent rights and what would be our resulting position vis-à-vis Watergate?**

[0011] We also need your advice on another urgent matter. Since 2008 we have been producing and selling filter cartridges comprising a different kind of membranes, known as Q-membranes, for the production of drinking water from sea water. Our Q-membranes are made of polymer Alpha and contain 4% of a compound R that is used to control the pore size of the membranes. Polymer Alpha has been used in the past for Q-membranes. We thought that it was commonly known in the art, at the latest by the end of 2005, to use compound R to control the pore size of membranes. In 2007, we carried out extensive tests that did not reveal any technical effect that would go beyond the expected pore size control. For these reasons we did not apply for patent protection for our Q-membranes or for the filter cartridges.



[0012] We were therefore very surprised when on 6 February 2012 Watergate initiated infringement proceedings against us before an Austrian court based on a European patent validated in Austria. This patent, EP-CART, was filed on 23 March 2006 without claiming priority. The single claim of EP-CART is directed to a Q-membrane made of polymer Alpha characterised by 1 to 5% of compound R. The subject-matter of the claim is directly and unambiguously derivable from the application as filed. The description states that the problem to be solved by the compound R is the control of the pore size. The search report cited only category A documents, among others document D1, published in 1999, which discloses a Q-membrane made of polymer Alpha.

[0013] From a file inspection we have found out that Dialab GmbH, an Austrian company, had validly filed before the EPO an opposition against EP-CART on the sole ground that the subject-matter of the only claim extends beyond the content of the application as filed. It appears from the file that the opposition division rejected the opposition in a decision announced during oral proceedings held on 2 December 2011 followed by a written reasoned decision dated 27 February 2012. We believe that the decision is correct.

[0014] Triggered by the infringement proceedings, we consulted our copy of the Encyclopaedia of Membrane Technologies, a standard handbook in the field of membrane technology. The encyclopaedia was published on 23 March 2006 and teaches that it is common to use between 1 and 5% of compound R to control the pore size in membranes made of polymers.



[0015] By mere coincidence, our sales manager Franz S. recently met Wolfgang, sole owner of Dialab GmbH, at a cocktail party. According to Wolfgang, Dialab deals with analytics, i.e. analysing samples sent from hospitals and clinics. Dialab want to use a membrane covered by the claim of EP-CART for a new and promising analytics application. This is why they filed the opposition against EP-CART. Wolfgang is very upset by the decision of the opposition division and asked Franz whether Membrain and Dialab could work together to have the patent revoked.

4) In view of the opposition and infringement proceedings, what are the options and corresponding actions to be taken before the EPO?

Yours sincerely

J. Strauss
CEO Membrain AG



Annex 1

2010

	Jan	Feb	Mar	Apr	May	Jun	Jul	Aug	Sep	Oct	Nov
Fri 01	Mon 01	Mon 01	Thu 01	Sat 01	Tue 01	Thu 01	Sun 01	Wed 01	Fri 01	Mon 01	Wed 01
Sat 02	Tue 02	Tue 02	Fri 02	Sun 02	Wed 02	Fri 02	Mon 02	Thu 02	Sat 02	Tue 02	Thu 02
Sun 03	Wed 03	Wed 03	Sat 03	Mon 03	Thu 03	Sat 03	Tue 03	Fri 03	Sun 03	Wed 03	Fri 03
Mon 04	Thu 04	Thu 04	Sun 04	Tue 04	Fri 04	Sun 04	Wed 04	Sat 04	Mon 04	Thu 04	Sat 04
Tue 05	Fri 05	Fri 05	Mon 05	Wed 05	Sat 05	Mon 05	Thu 05	Sun 05	Tue 05	Fri 05	Sun 05
Wed 06	Sat 06	Sat 06	Tue 06	Thu 06	Sun 06	Tue 06	Fri 06	Mon 06	Wed 06	Sat 06	Mon 06
Thu 07	Sun 07	Sun 07	Wed 07	Fri 07	Mon 07	Wed 07	Sat 07	Tue 07	Thu 07	Sun 07	Tue 07
Fri 08	Mon 08	Mon 08	Thu 08	Sat 08	Tue 08	Thu 08	Sun 08	Wed 08	Fri 08	Mon 08	Wed 08
Sat 09	Tue 09	Tue 09	Fri 09	Sun 09	Wed 09	Fri 09	Mon 09	Thu 09	Sat 09	Tue 09	Thu 09
Sun 10	Wed 10	Wed 10	Sat 10	Mon 10	Thu 10	Sat 10	Tue 10	Fri 10	Sun 10	Wed 10	Fri 10
Mon 11	Thu 11	Thu 11	Sun 11	Tue 11	Fri 11	Sun 11	Wed 11	Sat 11	Mon 11	Thu 11	Sat 11
Tue 12	Fri 12	Fri 12	Mon 12	Wed 12	Sat 12	Mon 12	Thu 12	Sun 12	Tue 12	Fri 12	Sun 12
Wed 13	Sat 13	Sat 13	Tue 13	Thu 13	Sun 13	Tue 13	Fri 13	Mon 13	Wed 13	Sat 13	Mon 13
Thu 14	Sun 14	Sun 14	Wed 14	Fri 14	Mon 14	Wed 14	Sat 14	Tue 14	Thu 14	Sun 14	Tue 14
Fri 15	Mon 15	Mon 15	Thu 15	Sat 15	Tue 15	Thu 15	Sun 15	Wed 15	Fri 15	Mon 15	Wed 15
Sat 16	Tue 16	Tue 16	Fri 16	Sun 16	Wed 16	Fri 16	Mon 16	Thu 16	Sat 16	Tue 16	Thu 16
Sun 17	Wed 17	Wed 17	Sat 17	Mon 17	Thu 17	Sat 17	Tue 17	Fri 17	Sun 17	Wed 17	Fri 17
Mon 18	Thu 18	Thu 18	Sun 18	Tue 18	Fri 18	Sun 18	Wed 18	Sat 18	Mon 18	Thu 18	Sat 18
Tue 19	Fri 19	Fri 19	Mon 19	Wed 19	Sat 19	Mon 19	Thu 19	Sun 19	Tue 19	Fri 19	Sun 19
Wed 20	Sat 20	Sat 20	Tue 20	Thu 20	Sun 20	Tue 20	Fri 20	Mon 20	Wed 20	Sat 20	Mon 20
Thu 21	Sun 21	Sun 21	Wed 21	Fri 21	Mon 21	Wed 21	Sat 21	Tue 21	Thu 21	Sun 21	Tue 21
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Thu 28	Sun 28	Sun 28	Wed 28	Fri 28	Mon 28	Wed 28	Sat 28	Tue 28	Thu 28	Sun 28	Tue 28
Fri 29		Mon 29	Thu 29	Sat 29	Tue 29	Thu 29	Sun 29	Wed 29	Fri 29	Mon 29	Wed 29
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Sun 31		Wed 31		Mon 31		Sat 31	Tue 31		Sun 31		Fri 31

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 - Veille de Noël	24.12.2010	x	x	x
Silvester - New Year's Eve - Saint-Sylvestre	31.12.2010	x	x	x



Annex 2

2011

Jan		Feb		Mar		Apr		May		Jun		Jul		Aug		Sep		Oct		Nov			
Sat	01	Tue	01	Tue	01	Fri	01	Sun	01	Wed	01	Fri	01	Mon	01	Thu	01	Sat	01	Tue	01	Thu	
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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



Annex 3

2012

Jan		Feb		Mar		Apr		May		Jun		Jul		Aug		Sep		Oct		Nov		
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Mon	30			Fri	30	Mon	30	Wed	30	Sat	30	Mon	30	Thu	30	Sun	30	Tue	30	Fri	30	Sun
Tue	31			Sat	31			Thu	31			Tue	31	Fri	31			Wed	31			Mon

Tage / Days / Jours		München Munich	Den Haag The Hague La Haye	Berlin
Heilige Drei Könige - Epiphany - Epiphanie	06.01.2012	x		
Karfreitag - Good Friday - Vendredi Saint	06.04.2012	x	x	x
Ostermontag - Easter Monday - Lundi de Pâques	09.04.2012	x	x	x
Nationalfeiertag - National Holiday - Fête Nationale	30.04.2012		x	
Maifeiertag - Labour Day - Fête du Travail	01.05.2012	x	x	x
Christi Himmelfahrt - Ascension Day - Ascension	17.05.2012	x	x	x
Pfingstmontag - Whit Monday - Lundi de Pentecôte	28.05.2012	x	x	x
Fronleichnam - Corpus Christi - Fête-Dieu	07.06.2012	x		
Mariä Himmelfahrt - Assumption Day - Assomption	15.08.2012	x		
Tag der Deutschen Einheit - Day of German Unity - Fête Nationale	03.10.2012	x		x
Allerheiligen - All Saints' Day - Toussaint	01.11.2012	x		
Heiliger Abend - Christmas Eve - Veille de Noël	24.12.2012	x	x	x
1. Weihnachtstag - Christmas Day - Jour de Noël	25.12.2012	x	x	x
2. Weihnachtstag - Boxing Day - Lendemain de Noël	26.12.2012	x	x	x
Silvester - New Year's Eve - Saint-Sylvestre	31.12.2012	x	x	x

