

Candidate's answer

Q1.

Membrain AG (aka MAG)

EP-1

- Filed = 31/7/09.
- No priority date, so effective date = 31/7/09.
- Filed without claims, but claims not required for European filing date.
- Hence, a valid filing date was probably obtained.
- First application for the Modules comprising:
 - bundle B of hollow fibers;
 - nozzle N.
- N can be any suitable material, B can be class of ceramics C.
- Specific embodiment links N = stainless steel with C = class of ceramics.
- Subsequently abandoned, e.g. lack of claims.
- Too long ago to save, so only priority rights exist since the fate of a 'first application' does not dictate priority rights unless abandoned explicitly without any rights outstanding (not the case here).

PCT-1

- Filed = 3/5/2010.
- Claims priority from EP-1.

Priority:-

- Priority is valid because:
 - Same applicant (MAG)
 - Same invention
 - PCT-1 and EP-1 have same description;
 - Claim of PCT-1 is the general part of description of EP-1 (and PCT-1).
 - EP-1 is 'for' PC states, so valid first application
 - PCT-1 was filed within the priority period
 - Effective date of PCT-1 is 31/7/09

Nb. Priority period of EP-1 'ended' 31/7/10, but this was a Saturday, so period extends to Monday 2/8/2010.

Patentability:-

- PCT-1 first MAG application to claim module with nozzle N and bundle of hollow fibres B.
- Claims are novel and inventive because there is no prior art

Status:-

- Validly entered Brazil/India nat. phases.
- So, patent rights will ensue in these countries.
- Time limit for entering EP phase = 31m from priority i.e.
 $31/7/09 + 31m = 29/2/12$
- So, EP entry time limit missed.
- However, this can be remedied (see Q. 3)
- US entry also missed (31/1/12).

EP-2

- Filed 2/8/10
- Priority claimed from EP-1
- Priority is partially valid because:
 - Same applicant, EP-1 is a valid first application etc. (as for PCT-1), AND
 - EP-2 filed in priority period which ended on 2/8/10 (calculated above for PCT-1).
- However, not all of EP-2 is unambiguously derivable from EP-1 because N in general part of EP-1 broadened in general part of EP-2.
- In fact, N broadened to 'means' which covers items other than nozzles!
- Hence EP-2 has two effective dates:
 - Claim 1 (no priority): effective date = 2/8/10
 - Claim 2 (priority): effective date = 31/7/09
- Specific embodiment including drawing also entitled to priority.

Patentability:-

- Claim 2, effective date = 31/7/09
 - No prior art, so claims are probably novel and inventive
 - Claim 1, effective date = 2/8/09,
 - Would be anticipated by PCT-1 if it enters EP phase (A. 54(3) EPC).
 - Claim 1 of EP-2 also lacks novelty over EP-WG because EP-WG has earlier (valid!) priority date (A. 54(3) EPC).
 - WG website publication of 30/7/10 also anticipates Claim 1 but not Claim 2.

Status:-

- So, Claim 2 can give rise to EP-wide protection for module comprising:
 - bundle B wherein fibres = C; and
 - nozzle is special nozzle N made from stainless steel.
- EP-2 can still be amended because it is still pending.

Watergate (WG)

US-WG

- Filed 30/4/10.
- No priority, so effective date is 30/4/10.
- No prior art to US-WG (EP-1 not published at effective date).
- Seems to be nothing stopping WG obtaining exclusive rights to US for:
 - Module with bundle B and nozzle N (Claim 1); and
 - Module with N and B, wherein B is polymers P (Claim 2).

EP-WG

- Filed 02/5/11
- Claims priority from US-WG

Priority:-

- Priority claim is valid because:
 - Same applicant (WG or inventors for US)
 - US is a PC state
 - EP-WG filed by reference to US-WG, so same invention
 - and EP-WG filed within priority year of US-WG.

Nb. US-WG priority period 'ends' 30/4/11 which is a Saturday and so extended to Monday 2/5/11.

- So effective date of EP-WG is 30/4/11.

Patentability:-

- Claim 2 of EP-2 is A. 54(3) art to EP-WG
- Claim 1 of EP-2 is not A. 54(3) art because it does not have priority so effective date is 02/8/10.
- Claim 2 of EP-2 anticipates Claim 1 of EP-WG because it discloses Modules with B = C, and N.

- Claim 2 of EP-WG is novel over Claim 2 of EP-2 because it relates to in which $B = P$.

Summary

- EP-1 is irrevocably abandoned so no protection ensues.
- PCT-1 gives exclusive rights to MAG in Brazil and India for module with B (any material) and N (any material).
- EP-2 has two claims:
 - Claim 1 = anticipated by EP-WG, WG website
 - Claim 2 = will give EP patent for module with B (ceramic C) and N (stainless steel).
- US-WG gives exclusive US rights to WG for Module with B (any material) and N (any material).
- EP-WG can give a patent to Module with N (any material) and B (polymers P).

Q2.

- The special coating K was disclosed to EPO as IPEA on 10/11/11 as part of request for international preliminary examination.
- This information included experimental data and an 'extensive description' so it is probably an enabling disclosure.
- PCT-1 was published February 2011, so its file was publicly accessible on 10/11/11.
- IPEA files are confidential until IPER has been established, at which point EPO will grant access (Nb. For purpose of A. 128(4) EPC, international publication has effect of EP publication).
- Since the IPER has not yet been issued, your submission of 10/11/11 is not yet publicly available.

Advice:

- It is of paramount importance that you file a patent application as soon as possible.
- At the latest, the patent application should be filed before IPER is finished (and hence publicly available) because publication of your comment would be novelty-destroying prior art.
- The Examiner should, if asked, tell you the IPER timeframe in your telephone interview tomorrow. This will give you an idea of the deadline for filing.
- Since you already have an experimental report and extensive description of modules/bundles with K, the new application should take little time to prepare.

- In terms of what application to file, I recommend a PCT application with simultaneous US application.
- Filing a PCT application allows you to cover many of your target emerging countries (e.g. Brazil, India) at the same time.
- A PCT application will also protect your manufacturing facilities in AT.
- PCT also allows you to delay much of the costs.
- A competent rO would be AT, EPO or IB.
- Filing PCT also allows you to cover the USA which enables you to prevent WG from competing. You must prescribe the inventor as applicant for the US.
- Nonetheless, I still suggest filing a US application because this will have an earlier prior right effect than a US-PCT. This would help to invalidate a US application potentially filed by WG in the future.
- Potential claims for the future US-PCT applications could include:
 - Coating K
 - Use of K in water filters
 - Module comprising:
 - N nozzle
 - B made of P coated with K
 - Fibres of P coated with K

Q3.

Your commercial products include:

- (A) Modules with N (stainless steel wherein the fibres are C.
- (B) Modules with N (various materials) wherein the fibres are P coated with K.
- (C) Modules with means other than N.

- EP protection is key because your manufacturing facilities are in AT.
- Good to have protection in US to prevent competition from WG.
- Also important to have protection in emerging countries e.g. Brazil/India.

Actions

- PCT-1 has very broad protection and no prior art, but 30/31m NP entry deadlines expired 31/1/12 and 29/2/12 respectively.
- Investigate whether NP/RP entry is still possible in states of interest e.g. US.
- This depends on local law.
- For EP, entry is still possible.
- EP will have been designated on filing PCT-1, so the failure to enter EP phase will elicit a communication deeming loss of rights in EP (R. 160(2) EPC).

- You can use this to get an appealable decision.
- Whilst appeals against formal rejections are successful, this is an expensive strategy.
- A more economical alternative is to invoke further processing for the various acts required for EP entry.
- Thus, by 30/4/12 (i.e. 33m from priority), you should:
 - Request further processing for each omitted act
 - Conduct each omitted act
 - Pay further processing fee for each act (50% of each missed fee; €225 for each of the other omitted act).
- The omitted acts are:
 - Pay the filing fee (including any excess page/claim fees)
 - Request examination
 - Pay examination fee
 - Pay first renewal fee

Nb: EPO was ISA, so no need for search fee

- No translation required
- No representative required since you are an Austrian applicant.
- If successful, this can lead to a EP patent covering Modules with B (any material) and N (any material). Since there is no prior art to PCT-1, request PACE to secure quick allowance in EP.
- You can therefore stop WG from selling/manufacturing in EP.
- However for your product (A), WG has a right to prevent you using fibres = C. So, you may need to take a licence.
- Euro-PCT-1 puts you in a very strong position to negotiate, but it is not clear what WG will want. You could consider cross-licencing to allow WG to operate in Brazil/India.
- Filing application covering use of K (i.e. Q. 2 above) will give you exclusive rights to this invention, but EP-WG cover modules with the polymer P.
- WG can therefore stop you manufacturing your commercial product (B). This could be resolved using a cross-licence i.e.
 - WG licences the polymer B in EP
 - You licence WG the coating K in USA.
- For commercial product (C), nobody seems to have any rights to the alternatives to nozzle N, so rights will be dictated by who owns rights to e.g.
 - Coating K (you)
 - Ceramic C fibres (you)
 - Polymers P (WG)

Q4.

- Dialab GmbH (hereafter DGB) are not active in the field of seawater filtration.
- Hence, DGH are not a competitor to MAG, so you should accept Wolfgang's offer to cooperate.
- Dialab are not allowed to transfer their status as opponent, so they must remain a party to EPO opposition appeal proceedings.
- Dialab should file an appeal against the decision to keep the proceedings open.
- To do this, DGH should:
 - File notice of appeal by: $27/2/2012 + 10d = 08/3/12$
 $+ 2m = \underline{08/5/2012}$
 - File grounds of appeal by: $27/2/2012 + 10d + 4m$
 $= 08/7/2012$ (Sunday)
 $= \underline{08/8/2012}$ (Monday)
- DGH Opposition limited to A. 100(c) EPC.
- DGH can only raise fresh grounds with consent of WG, they are unlikely to accept this!
- MAG should file an intervention (allowable during pending appeal proceedings G 1/94)
- To do this MAG should:
 - File a reasoned statement
 - Pay opposition fee
 - Prove that infringement proceedings have been started against MAG
- This should be done by:
 - Date of start of proceedings + 3m = $6/2/12 + 3m$
 $= 6/5/12$ (Sunday)
 $= 7/5/12$.
- In the intervention, MAG should raise attack of lack of inventive step based on a combination of the 'A' document cited in the ESR regarding Q-membrane made of polymer alpha the prior knowledge of using R to control pore size in polymers.
- The raising of a new ground of opposition by an intervener during appeal will result in the case being remitted to the opposition division (G 1-94).
- In terms of evidence regarding the prior knowledge of R to control pore size, I suggest:
 - File signed affidavit of your scientists and offer them as witnesses;
 - Try to find prior publication of this knowledge;
 - File the relevant pages of the encyclopaedia

- The encyclopaedia is not part of the state of the art against EP-CART as it was published on the filing date of EP-CART.
- However, the encyclopaedia is permissible evidence of common general knowledge before the filing date (T 890/02)
- Furthermore, file your evidence obtained in your laboratories that 4% R merely controls pore size and no other technical effect.
- 4% R falls within the claim, meaning that WG could not allege any further technical effect exists across the full scope of the claim.
- With this evidence, the claim of EP-CART clearly lacks inventive step over:
 - 'A' doc teaches Q with alpha
 - Problem is controlling pore size
 - This is common general knowledge since encyclopaedia evidences that ckg was that 1-5% R controls pore size in membranes of polymers.
- This will revoke EP-CART and terminate infringement proceedings against MAG.
- For completeness, it is noted that DGH must not withdraw appeal before case is remitted to opposition division since:
 - Intervener is only a party of right in appeal; and
 - Withdrawal of sole appeal (DGH) terminates appeal proceedings.

EXAMINATION COMMITTEE III

Candidate No.

Paper D 2012 - Marking Sheet

Category		Maximum possible	Marks awarded	
			Marker	Marker
Part I	Question 1	5	4	4
	Question 2	6	5	5
	Question 3	5	3,5	3,5
	Question 4	4	4	4
	Question 5	5	3	2
	Question 6	6	4,5	4,5
	Question 7	4	0,5	1
	Question 8	5	4,5	4,5
Part II	Question 1	20	15,5	17,5
	Question 2	9	8,5	7,5
	Question 3	12	6,5	7,5
	Question 4	19	17	16,5
Total		100	76,5	77,5

Examination Committee III agrees on 77 marks and recommends the following grade to the Examination Board:

PASS
(50-100)

COMPENSABLE FAIL
(45-49)

FAIL
(0-44)

28 June 2012

Chairman of Examination Committee III