II.

A (i) To keep EP 3 in force a translation into an EPO official language (English, French or German - A 14(1)) must be filed by 2 May 1994 (Rule 6(1) - 3 months after filing - extended by a day by R 85(1)), in accordance with A 14(2). Otherwise the application will be deemed withdrawn (A 90(3)).

Additionally, filing and search fees must be paid - within 1 month of R 85a(1) communication pointing out failure to pay: otherwise the application will be deemed withdrawn (A 90(3)). A surcharge must be paid - R 85a(1). The normal A 78(2) period (1 month from filing) has passed.

Designation fees will be due 12 months from the claimed priority date (A 79(2)).

Additionally, designation of inventor will have to be made within 16 months from the claimed priority date - R 42(1) - A 91(5) time-limit.

Smart is an inventor of Process B, and may (depending on Grisk's intellectual contribution to Process B) be in fact sole inventor. Furthermore, Smart has the right to the European patent for everything in EP 3 save process C, the separation process and the hypotensive effect of Z.

Thus Smart should be an applicant.

Grisk probably owns the right to a patent for Process C, the separation process and the hypotensive effect of Z.

If all parties agree to cooperate, it would be simplest to add Smart as an applicant by action of a partial assignment and its recordal under R 20. (A 71 permits transfer of rights: A 72 both parties must sign.)

A (ii) The priority claim is invalid - Grisk is not the person who filed DK 1 or successor in title so A 87(1) is not fulfilled.

.../...

Thus, if PCT 2 is filed designating EPO (or an EPO application is filed) and the priority of DK 1 is claimed by Smart, EP 3 will have to claim only subject matter which is novel over the content of DK 1 (applying A 54(3) in view of the effect of A 89 on the effective date of an application (validly) claiming an earlier priority date).

This would be Process B (owned by Smart), Process C, the separation process and hypotensive effect of Z (owned by Grisk).

However, if all the parties cooperate, there is no need to keep EP 3 in force: everything can be put into a later PCT or EP application and priority claimed from both DK 1 and EP 3. A partial transfer assignment of EP 3 to Smart would validate full priority rights for the later application.

This disclosure to Albatross, whether in confidence or not, would post-date priority dates for DK 1 and EP 3 and would do no harm to claims to subject matter in those earlier two applications.

There is no need to keep EP 3 in force in order for it to be possible to claim its priority - A 4.A.(3) Paris Convention.

A (iii) There is no reason why not if all parties cooperate.

(a) No - Process C and the other work of Grisk should be included as well.

(b) Grisk and Smart should both be applicants for all States, unless Grisk assigns his rights to Smart before filing, in which case Smart would be applicant for all States and Grisk applicant for US only (applicant must be inventor in US - national law is determinative - PCT A 27).

(c) Claim both priorities (DK 1 + EP 3) to avoid potential problem with disclosure to Albatross (as discussed above - dates precede disclosure). (A European application can serve as a basis for claiming priority because A 66 EPC renders it equivalent to a national filing and A 4 A Paris Convention covers this.)

(d) Claims as incorporated in <u>DK 1</u> (Question Paper page 2).
plus, in addition:

Process B
Process C
Process of separation of X and Z from Y
Product Z for use as a medicament
(novel over Z as a catalyst by virtue of A 54(5) EPC)
Pharmaceutical composition comprising Z + excipient (excipient needed for novelty [not needed for X because X novel in its own right]).
Use of Product Z for the production of a hypotensive agent. [Novelty of purpose - approved by G 5/93.]

Use of Product X in the manufacture of a medicament for antiviral treatment.

- dependent claims specifying herpes virus, measles virus and chicken-pox virus.

.../...

Also, since PCT is to designate USA, method of treatment claims (using X or Z and for hypotensive effect, antiviral effect) should be included.

[Not allowing under EPC A 52(4) - but acceptable in US.]

B (i) Entitlement action in front of DK court, since Smart is entitled to aspects in EP 3 - as discussed above. By A 61(1) if judged entitled or partially entitled (R 16), Smart will have several remedies (listed in A 61(1)(a) available).

Action must be in DK court (1) because of contractual provision for those inventions the contracts apply to and (2) because of A 2 of the Protocol on Recognition.

Then prove opening of the proceedings to the EPO, who will stay the proceedings following publication of the application - Rule 13(1) EPC.

Smart ought to succeed on entitlement to Process B, given the contract and his inventorship. If the rest belongs to Grisk this will not affect a later application
(1) claiming priority from DK 1 for the matter contained therein and
(2) directed to anti-viral properties of Product X (not disclosed in EP 3).

(ii) Until the EPO has proof of initiation of entitlement proceedings, Grisk might withdraw EP 3. Thereafter, R 14 would prevent Grisk from withdrawing it or any designation.

It is in Smart's interest to keep the application alive to keep rights to Process B pending (on the assumption that he will win entitlement). This makes sure he has an effective date before the disclosure to Albatross. If that were not in confidence it would be effective prior art to a later application claiming Process B, unless the contractual provision relating to non-disclosure by Grisk can be made effective by filing a European application within 6 months of the disclosure.

Grisk's disclosure is in breach of contract and an "evident abuse" within the meaning of A 55(1)(a) EPC.

Thus, a European application could be filed up to 6 months after Grisk's filing of EP 3 and the disclosure would be ignored. EP 3, even if published, would not be prior art to a claim to Process B taking a priority date later than the filing date of EP 3, because A 55 EPC would apply to the filing of EP 3.

Thus, Smart's best chance at protection for Process B, in the absence of cooperation with Grisk, is an entitlement dispute and then filing an A 61(1)(b) application.

Note, though, R 14 would prevent withdrawal of EP 3 once proceedings had been proven to the EPO to have been opened, at the moment, certain steps, as discussed above, need to be performed to keep EP 3 in force. G 3/93 is asking whether the original application must be pending for an application to be filed under A 61(1)(b). Any person can pay fees

(A 7 - RRF - Legal Advice 6/91) but only the applicant (Grisk) can file the translation required by A 14(2).

(iv) PCT filing date is equivalent to EP filing date, by virtue of A 150(4). Thus, A 55 will apply equally, as will other provisions.

All EPO states are party to PCT.

PCT gives a chance to delay major costs of filing.

File a PCT.

(Argument in favour of direct EP 2 would be that it would be quicker to grant - this would probably not be an advantage here.)

For other countries, direct filing might be thought safer - though PCT filing date is equivalent to direct filing date.

Grisk is an inventor of Process B so his disclosure to Albatross will not be prior art to a US application within 1 year of the disclosure (B5 USC 102b).

PCT filing would not require a signature by Grisk if filed by Smart with Smart as first applicant - common representative under R 90.2 PCT. This puts off time for signature till US National Phase.

(a) Smart should be applicant.

(b) Both EP 3 and DK 1, pending entrance of entitlement, though the most important thing is to file within 6 months of EP 3 and Albatross disclosure to invoke effect of A 55 and enable Process B to be claimed: not a problem since DK 1 priority must be claimed by 3 June 1993. Priority claim to EP 3 will be invalid if entitlement proceedings fail: A 87(1) - different applicants! (As discussed above.)

(c) Claim everything from DK 1 <u>plus</u> Process B

Use of Product X in the manufacture of a medicament for antiviral therapy

- dependent claims to the 3 specific viruses.

If PCT - method of treatment claims - treating viral infections or giving hypotensive effect using Product X.

B (iii) Be sure to claim them in patent applications