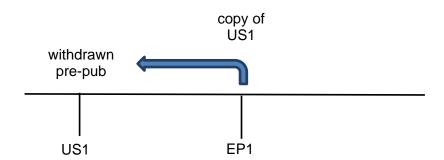
#### Candidate's answer

Q1.



The patent needs to disclose the invention in a manner sufficiently clear and complete for it to be carried out (A83 EPC).

Therefore EP1 needs to describe how compound X is obtained for it to be sufficient. References in the patent may relate to part of the disclosure of invention (GL-FIII8). What is in the reference document US1 is essential for carrying out the invention (A83 EPC). Reference documents are not part of the text translated pursuant to A65 and so any essential disclosure should be in the patent itself.

The US1 was filed at the time of filing EP1 and therefore was available to the EPO at the time of filing and would have been published in the file of EP1 (A128(1) EPC) when EP1 was published (A93(1) EPC).

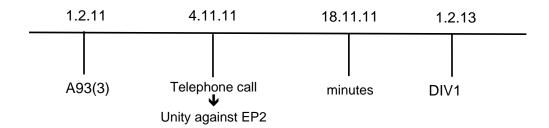
A feature only described in a reference document is *prima facie* not part of the description T689/90. However a feature only described in a reference document is part of the content of the application as filed if no doubt to the skilled reader that such features:

- a) are/might want to be protected
- b) contribute to achieving the technical aim of the invention
- c) implicitly clearly belong to the description of the invention
- d) are precisely defined and are identifiable in the total technical information within the reference document (T689/90).

Thus the reference to US1 will be considered part of EP1 as filed and thus amendments to incorporate the text of the specific referenced passage of US1 into the description of EP1 will <u>not</u> contravene A123(2) EPC. Amendments may be made if they are to overcome a ground of opposition A80 EPC. Thus you will be able to amend the description of EP1 based on the specific referenced passage of US1 to overcome the deficiency.

Thus it should be possible to maintain EP1 with an amended description.

Q.2.



To file a divisional under A76(1) EPC, the conditions of R36(1) must be met. The parent application must be <u>pending</u> (R36(1) EPC). The divisional must be filed within 24 months of notification of the first Communication from the Examining Division R36(1)(a) EPC in respect of the earliest application for which a Communication has issued. (A Communication under A94(3) EPC is considered a Communication from the Examining Division).

#### OR

24 months from notification of a Communication in which the Examining Division has objected that the earlier application does not meet the requirement of A82 EPC for the first time (R36(1)(b) EPC).

The 24 month term under R36(1)(b) EPC in respect of the non-unity objection raised in the telephone call starts from notification of the minutes of the telephone call (GL AIV 1.1.1.3) i.e. the 24 month term under R26(1)(6) EPC is:

The 24 month term under R36(1)(a) EPC is:

In respect of DIV1 the term under R36(1)(a) EPC expired on  $\underline{11.2.2013}$  - therefore on 20.2.2013 it is too late to file a divisional from EP1. However this deadline may be reinstated under A121(1) EPC, R136(1) EPC if all due care can be proven.

Within 2 months from the removal of cause for non-compliance (R136(1) EPC) i.e. by

#### We need to:

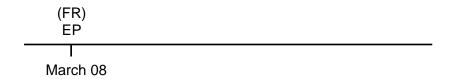
- request re-establishment in writing A122(1) EPC (R136(1) EPC
- pay a re-establishment fee (R136(1) EPC R fees 2(1).13)
- file DIV1 R136(2) EPC

State facts and grounds for why it wasn't sent (R136(2) EPC) prove all due case (A122(1) e.g. isolated mistake J5/80.

#### B.) Yes

Under R36(1)(6) EPC the 24 month term expires 28.11.13 (as calculated above) so today we are still able to validly file DIV2 as the EP2 is pending and the 24 month term of R36(1)(6) EPC has not yet expired.

Q3.



The official languages of the EPO are English, French, German - A14(1) EPC.

If the patent can be maintained on the basis of a text submitted or approved by the proprietor and the opponent has had sufficient opportunity to comment on that text the EPO will issue an interlocutory decision (G1/88 - OJ 1989, 393).

Within three months of the decision becoming final (GL D-VI 7.2.3) the proprietor needs to file a translation of the claims into English and German (R82(2) EPC second sentence).

Also a fee for printing, publishing a new specification needs to be paid within three months from the decision becoming final (R82(2) EPC second sentence, R fees 2(1) Item 8). The publication fee is 70 Euros (R fees (2) Item 8). The application was filed <u>before</u> 1 April 2009 therefore there may be an additional fee for the additional pages?

If the translations or publication fee are not filed/paid in time there is a 'grace period' of two months of notification pointing out the failure to observe the time limit (R82(3) EPC) providing a surcharge of 114 EUR (R fees 2(1) Item 9) is paid R83(3) EPC, first sentence. Otherwise the patent will be revoked R83(3) EPC, second sentence.

b) A contracting state may require a translation of the patent as amended to be supplied in one of its official languages to the central industrial property office A65(1) EPC, first sentence.

This shall be at least three months from the date on which the mention of the maintenance in amended form is published (unless a longer time is prescribed) A65(1) EPC, second sentence.

For Austria which is not a contracting state of the London agreement (Nat law Table IV, column 1).

A translation of the whole specification into German is required (Nat law table IV, column 1). A fee of 180 EUR (including 30 EUR document fees plus 130 EUR for every 15 pages following the 16th page) (Nat law Table IV, column 5) are both required in three months of publication of decision to maintain in amended form.

For Switzerland which is a contracting state to the London agreement (Nat law Table IV, column 1) with an official language which is an official language of the EPO, no translation is required and therefore no fee is payable.

For Netherlands - It is a contracting state to London agreement but does <u>not</u> have an official language in common with the EPO.

Therefore a translation of the claims into Dutch needs to be filed and also because the patent is in French a translation of the whole specification into English (or Dutch) is required (Nat law Table IV, column 2). A fee of 25 EUR is payable (Nat Law Table IV, column 5). Both are payable within three months of publication of mention of maintenance of patent in amended form.

Q.4



An opposition must be filed within nine months of mention of grant A99(1) EPC

Further processing is <u>not</u> available for opposition (A121(1) EPC) and reestablishment is not possible for opponents A122(1) EPC. Therefore the opposition was filed in time but the document was identified and supplied after the expiry of the opposition period. To be admissible (R77(1) EPC) the Notice of Opposition (A99(1) EPC) must indicate facts, evidence and arguments R76(2)(c) EPC within the opposition period. Facts in the Notice of Opposition must give specific references T448/89.

Therefore an objection on the ground of lack of novelty in view of an unspecified document does <u>not</u> meet the requirements of R76(2)(c) EPC. Therefore the Opposition is inadmissible R77(1) EPC. This deficiency was rectified when the document was identified but this was <u>after</u> the expiry of the opposition period. Therefore the notice is inadmissible as <u>no</u> substantial ground was raised (R77(1) EPC).

Documents submitted for on inadmissible opposition are part of the file and regarded as observation under A115 (GL D-IV 3).

There are therefore no proceedings pending and so the Opposition Division <u>cannot</u> continue on its own motion under A114(1) EPC. EP1 <u>cannot</u> be revoked before the EPO. National proceedings will be necessary to revoke the patent.

Q.5

a) The PCT application can be filed at the Patent Office of India as rO as Mr S is a national and resident of India (A10 PCT, R19.1(a)(i) and (ii) PCT and R19.2(1) PCT).

A PCT application may be filed by two or more applicants R18.3 PCT.

As no agent is required before the Indian Patent Office (IPO) the person having the right to practice is entitled to practice before the IB, ISA and IPEA in respect of that application (A49 PCT).

Mr S may be appointed as the agent R90.1 PCT as he has the right to practice before the IPO.

The appointment can be effected by the applicant (A & Mr S) signing the request or a separate Power of Attorney (R90.4(a) PCT).

- b) b1) Only a person having the right to practice before the national office action as ISA and IPEA may be appointed by an applicant as his agent to represent him specifically before that authority (R90.1(b) PCT and R90.1(c) PCT respectively). An Indian agent therefore cannot be appointed specifically to act before the EPO as ISA or IPEA as he is <u>not</u> entitled to act before the EPO (A134(1) EPC) as he is not on the list of professional representatives.
- b2) Yes they can appoint a European professional representative as he is entitled to act before the EPO (R90.1(6) and (c) and A 134(1) EPC).

c) Natural persons <u>not</u> having their residence in a contracting state need to be represented by a professional representative (A133(2) EPC). Therefore Mr S as resident in India needs to be represented by a professional representative under R134(1) EPC.

Mr Wilson as employee of a legal person having their principle place in Britain (a contracting state) may represent Company A (A133(3) EPC) but <u>cannot</u> represent Mr S.

The representative of Mr S. (who he is obliged to appoint under A133(2) EPC) will be deemed to be the common representative R151(1) EPC.

Therefore Mr Wilson <u>cannot</u> act as the common representative.

Q.6

Invitation dated 11.1.2013

The invitation to pay additional fees under A17(3)(a) PCT issued 11.1.2013. R158(1) EPC

This will have set a one month deadline for paying the additional fee R40.1(ii) PCT. If the fees are not paid by this deadline the International search will relate only to the invention first mentioned in the claims (i.e. claim 1). A17(3)(a) PCT. The deadline was

If on the date of receipt of the debit order the account does <u>not</u> contain sufficient funds to cover the total fee payments indicated for an application (a shortfall) the debit order is <u>not</u> carried out ADA 6.4.

If within one month of receipt of communication informing the applicant of the shortfall the account is replenished sufficiently to enable the total payment indicated for the application to be debited and within the same period an administrative fee is paid then the date on which the debit order is received is considered to be the date on which payment was made ADA 6.5.

The fee for the additional search is 1875 Euro R fees 2(1) Item 2.

The administrative fee is 30% of the shortfall up to a maximum of 305 EUR (ADA 6.6). The one month period for replenishing the account and paying the administrative fee is

The account was replenished sufficiently to pay both these fees, however there was no debit order in respect of the administrative fee.

Therefore the administrative fee was not paid and so the additional search fee will be considered to be paid on 22.2.2013 (ADA 6.7) which is <u>too</u> late to pay the additional fee.

Therefore the search will only be carried out in respect of claim 1. A17(3)(a) PCT R158(1) EPC.

### **Legal Opinion**

1) Your rights (Pyramidal protrusions (b))

You filed IT-PYR on 19 August 2011 this contains a single claim to a frying pan with pyramidal protrusions on its inner surface. This application was filed in Italy only.

No further applications have been filed. We are more than 12 months after the filing date of IT-PYR and therefore the priority period has expired and we are too late to file any applications claiming priority from IT-PYR.

19 August 2011 + 12 months - 19 August 2012 (Sunday)

so the deadline for filing applications claiming priority from IT-PYR was 20 August 2012.

This deadline has been missed. It is not possible to withdraw this application and file a new application starting a new priority year as IT-PYR has been laid open to public inspection.

Also as it has been published it is not possible to file any further applications (not claiming priority) to the idea of a frying pan with pyramidal protrusions as this will lack novelty over the publication of IT=PYR on February 2013.

You could file an application in the US relying on the 12 month grace period, i.e. by February 2014, if you want protection for pyramidal protrusions in the US.

However no other applications can be filed. Therefore you only have protection for pyramidal protrusions in Italy.

#### Prior art to IT-PYR

EP-3D was published before the filing date of IT-PYR.

IT-PYR <u>does not</u> claim priority and therefore its effective date is 19.8.11 (its filing date).

EP-3D is full prior art for novelty and inventive step. EP-3D does <u>not</u> disclose pyramidal protrusions and there is no mention of protrusion shape. Pyramidal protrusions have an advantage of less vitamin loss and therefore is inventive over EP-3D.

EP-Hemi was also published before the effective date of IT-PYR and so is full prior art. But it <u>does not</u> disclose pyramidal protrusions and therefore IT-PYR is novel and inventive over this disclosure.

The disclosure at hot pans conference and the publication of DIV-3D were both published <u>after</u> the effective date of IT-PYR and therefore are <u>not</u> prior art. Therefore it should be possible to obtain protection for pyramidal protrusions in Italy.

### 3D-protrusions (a)

EP-3D was filed January 2008 without a claim to priority therefore the effective date of EP-3D is January 2008. There is no relevant disclosures before this date. The letters by Dr S to SK is November 2007 and March 2008 were in confidence and therefore are not prior art.

EP-3D was refused on 26 March 2012. The deadline for filing an appeal was

$$26.3.2012 + 10 \text{ days} + 2 \text{ months} = 5.6.12$$

Therefore it is now too late to file an appeal for EP-3D. Therefore there are no rights conferred by this application. A divisional DIVI-3D was filed based on EP-3D, on 1 June 2012.

This divisional met the requirements of R36(1) EPC because EP-3D was still "pending" as the time limit for filing an appeal had not expired when DIVI-3D was filed.

(DIVI-3D was filed 1 June 2012 before 5 June 2012 which was the deadline for filing the Notice of Appeal on EP-3D.

Also the first Communication from the Examining Division issued July 2010 so the 24 month period of R36(1)(a) EPC would expire around July 2012 and so DIVI-3D was filed before this date.

Therefore DIVI-3D was validly filed. DIVI-3D extends the subject matter of the application beyond EP-3D which is not allowable as it contains an additional statement regarding cubic protrusions. However this deficiency can be rectified during prosecution of DIVI-3D.

DIVI-3D inherits the filing date of EP-3D and so the effective date of DIVI-3D is January 2008.

As discussed above there is no relevant prior art before this deadline before DIVI-3D can be used to obtain protection for a frying pan with three-dimensional protrusions on the inner surface of the frying pan.

Designation fees for only Germany and Italy were paid on EP-3D. Therefore DIVI-3D can only designate Germany and Italy.

DIVI-3D should be possible to obtain protection for a frying pan with 3D protrusions on its inner surface in Germany and Italy (if the reference to cubic protrusions is removed). The claim can specify the features to achieve a surface that will heat up the food faster and so should not be objected to as a result to be achieved.

DE-Hemi also claims a frying pan with 3D protrusions. However this application is deemed withdrawn due to non-payment of the filing fee and so cannot be used to obtain protection for this invention.

EP-Hemi claims priority from DE-Hemi.

EP-Hemi was filed by the same applicant, directed to the same invention and within the 12 months priority period. It is also irrelevant that De-Hemi was subsequently deemed withdrawn. However DE-Hemi was <u>not</u> the first application by S-K to the idea of a frying pan with 3D protrusions as this was jus described in EP-3D.

Therefore in respect of the claim directed to a frying pan with 3D protrusions the priority claim from DE-Hemi is <u>not</u> valid. Therefore the effective date of claim 1 of EP-Hemi is its filing date, i.e. <u>5.4.10</u>. EP-3D was published before the effective date of claim 1 of EP-Hemi and so is full prior art.

Therefore claim 1 of EP-Hemi directed to a frying pan with 3D protrusions is <u>invalid</u>. Despite this EP-Hemi has been granted with claim 1 but we can attack this in the Opposition as discussed below.

## c) Hemispherical protrusions

This is first described in DE-Hemi filed 10.6.09. This application has since been deemed withdrawn and so it is not possible to obtain protection for hemispherical protrusions via this application. EP-Hemi was filed 15.12.10 claiming priority from DE-Hemi.

The priority claim in respect of hemispherical protrusions is valid because they were filed by the same applicant, the applications are directed to the same invention.

EP-Hemi was filed in the 12 month priority period of DE-Hemi

$$(1.6.09 + 12 \text{ months} = 10.6.10)$$

DE-Hemi was the first application to hemispherical protrusions. DE-Hemi was filed in a PC state. It is irrelevant to priority that DE-Hemi was subsequently withdrawn. Therefore the effective date of a claim to a frying pan with hemispherical protrusions in EP-Hemi has an effective date of 10.6.09.

EP-3D was filed before the effective date of EP-Hemi but was published after. Therefore it is prior art under A54(3) EPC and is relevant to the assessment of novelty <u>only</u>.

EP-3D does not disclose hemispherical protrusions and thus the EP-Hemi claim to hemispherical protrusions is novel over this prior art and thus valid in view of this art.

The letters of Dr S. prior to the effective date are <u>not</u> prior art as they were in confidence. The disclosure of hemispherical protrusions at the conference is not prior art as it is after the effective date of EP-Hemi. Therefore it should be possible to obtain protection for hemispherical protrusions via EP-Hemi.

EP-Hemi has only been validated in Italy. However due to the London agreement certain countries do not require a translation of the specification for validation. Therefore this application will have automatically validated in certain countries.

Germany is party to the London agreement and so EP-Hemi will have automatically validated in Germany.

This is subject to payment of renewals which in Germany are due in respect of the third year onwards.

The third year renewal is due:

5.4.10 **→** 30.4.12

and this would have been payable to the EPO as it was before mention of grant.

The fourth year renewal is due

30.4.13

is not yet due.

Therefore protection in Germany can be obtained from EP-Hemi.

#### d) Cubic protrusions

This shape protrusion has only been mentioned in DIV-3D. However this was not disclosed in the parent application and thus is an extension beyond the parent application as filed and is unallowable.

This can be remedied during prosecution of DIV-3D but it means that protection for cubic protrusions <u>cannot</u> be obtained via DIV-3D. No other applications cover cubic protrusions.

The idea of cubic protrusions was published on 27.9.12 when DIV-3D published and also was disclosed at the Lot Pons 2013 trade fair.

Therefore it is <u>not</u> possible to file any new applications for cubic protrusions as these will lack novelty over these disclosures. Therefore no protection can be obtained for cubic protrusions.

#### **Summary**

3D protrusions can be protected in Germany and Italy via DIV-3D once granted by SK.

Pyramidal protrusions are protected in Italy only via IT-PYR by you (BC)

Hemispherical protrusions can be protected in Germany and Italy (and certain other countries not requiring a translation for validation) via EP-Hemi by SK.

Cubic protrusions cannot be protected.

ii) The deadline for filing a Notice of Opposition is 9 months from publication of mention of grant.

The Notice of Opposition was received by the EPO on 1.2.13 and therefore it is considered to be filed on this day therefore it has been filed in time.

The Opposition is admissible as the opposition fee has been paid and a written reasoned statement has been submitted.

The Notice of Opposition sets out the extent and the ground and provides an indication of the facts and evidence.

The Notice of Opposition needs to be filed in an official language of the EPO (EN, FR or DE).

However, given that you are a legal person having your principle place of business in a contracting state with an official language (IT) which is not an official language of the EPO you are entitled to file the notice of opposition in the official language of that state (Italian). This will entitle you to a 20% discount of the opposition fee (this 20% will be refunded if you paid the full opposition fee). However a translation into EN, FR or DE needs to be filed by the later of (i) the period for filing the opposition or (ii) one month of filing the Notice of Opposition.

The period for filing the Notice of Opposition has already expired (4.2.13). However 1 month from filing the notice of opposition = 1.2.13 + 1 month = 1.3.13 (Friday). This deadline has <u>not</u> expired.

We need to file a translation of the Notice of Opposition into EN, DE or FR by 1.3.13. If not filed by this date the Opposition will be deemed not filed. As a professional representative under A134(1) EPC I can act on your behalf and I do not need authorisation (i.e. a power of attorney) to do so.

I will therefore proceed to have the Notice of Opposition translated into one of the official languages of the EPO (EN, DE, FR) and file it at the EPO BY 1.3.13.

In respect of the likely success of the Opposition, EP-Hemi contains two claims:

Claim 1: a frying pan with 3D protrusions

Claim 2: the frying pan of claim 1 wherein the 3D protrusions are hemispherical.

As discussed above, claim 1 is <u>not</u> entitled to the claimed priority date of DE-Hemi as DE-Hemi is <u>not</u> the first application by SK to a frying pan with 3D protrusions (EP-3D is). Therefore the effective date of claim 1 is 5.4.10.

EP-3D was published before the effective date of claim 1 and therefore is relevant to the assessment of novelty and inventive step. Claim 1 lacks novelty over EP-3D as it discloses a frying pan with 3-D protrusions. Therefore your attack against claim 1 should be successful.

As discussed above the effective date of claim 2 is 10.6.09 (the filing date of DE-Hemi) as the priority claim for claim 2 is valid (as explained above under 1) c)).

EP-3D was filed before but published after the effective date of claim 2 and therefore it is prior art under A54(3) EPC - i.e. relevant to novelty only.

EP-3D does <u>not</u> disclose hemispherical protrusions and so claim 2 is novel over EP-3D. Inventive step over EP-3D is not assessed.

There is no other relevant prior art and so if the patent is amended to delete claim 1 and make claim 2 an independent claim. The EP-Hemi should be able to be maintained in amended form.

a) Currently SK may be able to obtain protection for a frying pan with 3D protrusions in Germany and Italy via DIV-3D.

If this application is granted with a claim to a frying pan with 3D protrusions you will <u>not</u> be able to act in Italy and Germany in respect of frying pans with any shaped 3-D protrusion.

This is dependent on DIV-3D being granted.

If SK remove the reference to cubic protrusions they should be able to obtain protection to a frying pan with 3D protrusions in Italy and Germany.

DIF-3D has published with a claim to a frying pan characterised in that its inner surface will heat up the food much faster than a flat surface.

Therefore frying pans sold with 3D protrusions will infringe the provisional protection conferred by DIV-3D. However this is subject to translations into German and Italian having been filed (which does not appear to have been done).

Therefore you a free to act in Italy and Germany until DIV-3D grants unless translations are filed to confer provisional protection which could make you liable for damages.

EP-Hemi has been granted with a claim to 3D protrusions which you will infringe if you sell any frying pans with 3D protrusions. However we should get this claim revoked in opposition.

In respect of protection specifically to hemispherical protrusions you will also infringe claim 2 of EP-Hemi (which appears to be valid). This claim is granted and therefore you are <u>not</u> free to sell frying pans with hemispherical protrusions in Italy or Germany.

You have rights to pyramidal protrusions in Italy only. There are not rights in cubic protrusions. However, sales of frying pans with pyramidal protrusions or cubic protrusions will still infringe claims to 3-D protrusions from EP-Hemi (until revoked) and DIV-3D (when granted).

- b) Currently you are only able to prevent sales of frying pans with pyramidal protrusions by SK in Italy. SK are currently free to sell frying pans with protrusions of any shape in Germany and only shape except pyramidal protrusions in Italy.
- ii) It is clear that SK have stolen the idea to a frying pan with 3D protrusions from Dr S. You have good evidence of this as you have a copy of the letter of November 2007 which describes 3D protrusions on the inner surface of frying pans which was before the filing date of EP-3D. You should therefore file a claim to the grant of DIV-3D in the Courts of Germany (where SK as applicant have their principal place of business).

You should also notify the EPO of these proceedings who will stay the proceedings of DIV-3D

Given the good evidence you have the German Courts should find you entitled to DIV-3D. This is because Dr S has sold you the rights in his invention. You can then either file a new application to the original subject-mater of EP-3D or continue prosecution of DIV-3D.

You will then be able to obtain protection in Germany and Italy for a frying pan with 3D protrusions. This will allow you to prevent SK selling frying pans with only shaped protrusion in Germany and Italy.

You will be free to sell frying pans with pyramidal and cubic protrusions but not hemispherical protrusions only. SK will obtain protection for hemispherical protrusions in Italy and Germany. SK are entitled to his subject-matter as Dr S did not suggest hemispherical protrusions to SK. This disclosure of cubic protrusions via DIV-3D and at the trade fair were result of evidence abuse as Dr S had told SK of this idea in confidence. Therefore within 6 months of the first disclosure i.e. by 27.9.12 plus 6 months = 27.3.13.

You can file an EP application to a frying pan with cubic protrusions as the disclosure by publication of DIV-3D and at the trade fair are non-prejudicial disclosures (Art. 55 EPC). There is no other disclosure of cubic protrusions and this is inventive over the other shapes as it makes the food crispier. Therefore you should be able to obtain protection for cubic protrusions in Italy and Germany.

To enable you to sell frying pans with hemispherical protrusions you could consider a cross licence with SK. However, you are in a strong position (you can currently stop SK selling frying plans with only shaped protrusion) but I would not recommend a

cross licence with SK. You will therefore not be free to sell frying pans with hemispherical protrusions in Italy and Germany.

If this is essential to your business you could cross licence the right for SK to sell frying pans with 3D-protrusions in Italy and Germany in exchange for the right to sell frying pans with hemispherical protrusions.

## **EXAMINATION COMMITTEE III**

Candidate No.

# Paper D 2013 - Marking Sheet

Category		Maximum possible	Marks awarded	
			Marker	Marker
Part I	Question 1	5	4	3,5
	Question 2	8	7	8
	Question 3	6	4,5	4,5
	Question 4	6	5,5	6
	Question 5	8	4,5	4,5
	Question 6	7	7	7
Part II	Question 1	24	22,5	23,5
	Question 2	12	12	11,5
	Question 3	24	22,5	22
Total		100	89,5	90,5

Examination Committee II Examination Board:	I agrees on 90 marks and recommends t	the following grade to the
X PASS (50-100)	COMPENSABLE FAIL (45-49)	FAIL (0-44)
27 June 2013		