



# Model Solution and Compendium-type Report for Paper DI

Disclaimer:

This model solution has been prepared by **epi** to assist candidates who sat the Mock e-EQE. It was prepared before the Mock e-EQE to represent a possible answer of a successful candidate, and, where marks are indicated, does not reflect a marking scheme that would be applied by the relevant Examination Committee. As such, **epi** cannot be held accountable for any discrepancies between a marking scheme of an Examination Committee and the model solution.

Note: The model solution contains expected answers as well as some comments in [brackets]. Any valid and correct answer, different from the expected answer, could also receive full marks.

### **QUESTION 1 (10 MARKS)**

**a)** Ms Lava should validate her patent granted on EP-L in the countries in which the main markets exist, i.e., in Romania and Ireland, to prevent competitors such as Mr Basalt from entering these markets with products falling under the scope of the claims. Furthermore, Ms Lava should validate the patent granted on EP-L in Iceland, to prevent Mr Basalt from producing products falling under the scope of the claims.

Furthermore, validation in other countries may be considered, especially in countries party to the London Agreement, or markets in which Mr Basalt seems to be interested which would require further research.

**b)** Translation requirements may be imposed by EPC Contracting States based on Art. 65(1) EPC. Specific requirements (languages, scope of translations, periods for validation) may be found in National Law relating to EPC, Table IV.

Iceland is a party to the Agreement on the application of Art. 65 EPC (“London Agreement”, LA) and according to this Agreement Art. 1(2) and (3), the member states of LA having no official language in common with one of the official languages of the EPO may only require a translation of claims into their national language, if the European patent has been granted in the official language of the EPO prescribed by that State. Iceland requires the translation of claims into Icelandic when the description of the patent is in English, which is the case here. Thus, only the claims need to be translated into Icelandic. The period for submitting the translation is 4 months from the publication of the mention of the grant and expires on 5 July 2021 (Monday, 3 July 2021 is Saturday).

Romania requires a translation of the description and claims into Romanian. The period for submitting the translation is 3 months from the publication of the mention of the grant and expires on 3 June 2021 (Thursday).

Ireland is also party to the London Agreement and has English as an official language. Thus, no translation needs to be submitted (Art. 1(1) London Agreement).

c) The mention of the grant will be published on penultimate day of the 4<sup>th</sup> year of the life of the patent application (the 4<sup>th</sup> year ends on 4 March 2021). The fee for the 4<sup>th</sup> year was the last renewal fee payable to the EPO (Art. 86(2) EPC), and the fee for the 5<sup>th</sup> year must be paid to national offices (Art. 141(1) EPC).

## **QUESTION 2 (8 MARKS)**

a) Filing fee for EP1 shall be paid within 1 month from the date of filing of the application, Rule 38(1) EPC. 23 January 2021 (calculated under R. 131(4) EPC) is Saturday, therefore the due date moves to the next working day, Rule 134(1) EPC. Filing fee for EP1 can be paid at the latest on Monday, 25 January 2021.

International filing fee for PCT2 shall be paid within 1 month from date of receipt of the application, Rule 15.3 PCT. However, Rule 19.4(c) PCT pushes back the start of the 1 month deadline ('the date of receipt') for the purposes of Rule 15.3 PCT to the date the application is actually received by the IB, i.e. 7 January 2021. 7 February 2021 (calculated under R. 80.2 PCT) is Sunday, so the due date moves to the next working day, R. 80.5 PCT. The international filing fee for PCT2 can be paid at the latest on Monday, 8 February 2021.

b) The further search fee under EPC shall be paid within 2 months from notification of the communication, Rule 64(1) EPC. The communication is deemed notified to the applicant on 27 March 2021 (Rule 126(2) EPC), and 27 March 2021 + 2 months (R. 131(4) EPC) is 27 May 2021 (Thursday). The further search fee in respect of EP1 shall be paid at the latest on 27 May 2021.

The further search fee under PCT shall be paid within 1 month from the date of the communication, Rule 40.1(ii) PCT, but the communication was received more than 7 days after its mailing date. Rule 80.6 PCT provides that in such case, the time limit expires later by an additional number of days which is equal to the number of days which the notification was received later than seven days after the date it bears, which in this case is 2 days. 17 March 2021 + 1 month (R. 80.2 PCT) + 2 days (R. 80.3 PCT) is 19 April 2021 (Monday). The additional fee for PCT2 shall be paid at the latest on 19 April 2021.

## **QUESTION 3 (7 MARKS)**

a) EP-CM claims a jacket with a Pore-Tex layer having a thickness of 0.005-0.05 mm. It claims priority from CA-CM, which discloses a jacket with a Pore-Tex layer having a

thickness of 0.01-0.05 mm. The priority is validly claimed for the subject-matter which was disclosed in CA-CM, because Canada is a contracting state of Paris Convention, EP-CM is filed by the same applicant (Canada Moose) within 12 months of filing of CA-CM (Art. 87(1) EPC), since 21 November 2020 (R. 131(4) EPC) is a Saturday, and therefore the application claiming priority can be validly filed at the latest on Monday, 23 November 2020 (R. 134(1) EPC).

EP-CM's claim can be divided as follows:

- (1) Jacket with Pore-Tex layer having a thickness of from 0.005 up to but not including 0.01 mm.
- (2) Jacket with Pore-Tex layer having a thickness of 0.01-0.05 mm.

The first part of the claim is assigned the effective date of EP-CM filing (23 November 2020), and the second part of the claim is assigned the effective date of CA-CM filing (21 November 2019) (G 1/15, partial priority).

Jack Wolfhide disclosed their jacket with a 0.008 mm Pore-Tex layer on 10 December 2019, which is after the filing date of CA-CM, but before the filing date of EP-CM.

It is a valid disclosure making part of the state of the art because the product is being sold to the public, and so is publicly available (Art. 54(2), GL G-IV 7.1).

Jack Wolfhide's jacket has a Pore-Tex layer with thickness 0.008, which is a point falling in the range 0.005-0.01, and would be novelty destroying for the range, if it was available to the public before the effective date of this subrange (Art. 54(2) and GL G-VI 8).

The effective date of part (1) of the claim is 23 November 2020, and the Jack Wolfhide jacket was made available to the public on 10 December 2019, so it is novelty destroying for this part of the claim, and therefore the claim is not novel.

Therefore, the claim of EP-CM is not novel in view of the release for sale of Jack Wolfhide's jacket on 10 December 2019.

**b)** Canada Moose can amend the claim to the range of 0.01-0.05 mm (since the description of EP-CM includes all of the subject matter of CA-CM), in which case the amended claim would have the priority date (21 November 2019) as the effective date (Art. 87(1) EPC).

If they do this amendment, the jacket of Jack Wolfhide does no longer constitute prior art under Art. 54(2) EPC, and Canada Moose would likely be able to get a patent for the original claimed range (provided no other prior art is found to be relevant).

#### **QUESTION 4 (7 MARKS)**

Mr. Scrooge has completed the formalities for entry into the European phase, including filing a request for examination including the payment of examination fee (R. 159(1)(f) EPC). The USPTO was ISA, and thus the EPO drew up a supplementary European search report (Art. 153(7) EPC). The communication under R. 161(2) and 162 EPC was waived, and the EPO could draw up the supplementary ESR faster.

If a supplementary European search report is drawn up, the applicant receives a communication under R. 70(2) and 70a(2) (see the respective Rules or GL E-IX, 2.5.3). The communication sets the period of six months for response, which runs from the notification of the communication (GL E-IX, 2.5.3).

The 6-month period expires on 14 May 2021 (3 November 2020 + 10 days (R.126(2) EPC) - > 13 November 2020 + 6 months (R.131(4) EPC) -> 13 May 2021 (Ascension Day, EPO Offices are closed, R. 134(1) EPC) -> 14 May 2021 (Friday)).

The claims are novel and inventive, so no correcting of deficiencies is required, however, if Mr Scrooge would wish so, he can amend of his own volition (R. 137(2) EPC) the description, claims and drawings in reply to this communication.

Mr Scrooge, or rather his professional representative, must, in any case, indicate that he wishes to proceed further with the application, otherwise the application would be deemed withdrawn (R. 70(3) EPC).

Furthermore, a renewal fee in respect of the 5<sup>th</sup> year must be paid at the latest on 30 April 2021 (Friday) (R. 51(1) EPC). The amount of the fee is 855 EUR.

#### **QUESTION 5 (7 MARKS)**

a) The interlocutory decision of the Opposition Division allows a separate appeal even if it is not a decision terminating the proceedings (Art. 106(1), (2) EPC; GL D-VI 7.2.2).

The patentee is adversely affected by being granted only an auxiliary request and not the main request (e.g., T234/86 or T392/91). As the adversely affected party to the opposition proceedings, the patentee is entitled to file an appeal (Art. 107 EPC).

**b)** Within 2 months of the notification of the interlocutory decision the patentee must file a notice of appeal (Art. 108 EPC). Within the same period, an appeal fee (2705 EUR or 1955 EUR for entities or persons qualifying under R. 6(4) and (5) EPC) shall be paid (Art. 108 EPC).

The 2-month period expires on 15 March 2021 (4 January 2021 -> 14 January 2021 (R. 126(2) EPC) + 2 months (R. 131(4) EPC) -> 14 March 2021 (Sunday, R. 134(1) EPC) -> Monday 15 March 2021).

Within 4 months of the notification of the interlocutory decision the patentee must file a statement setting out the grounds of appeal (Art. 108 EPC).

The 4-month period expires on 14 May 2021 (4 January 2021 -> 14 January 2021 (R. 126(2) EPC) + 4 months (R. 131(4) EPC) -> 14 May 2021 (Friday)).

**c)** There is no substantial procedural violation. The Opposition Division is not bound by a decision of the Board of Appeal on appeal arising from a decision of the Examining Division. Only the department whose decision was appealed is bound by the *ratio decidendi* of the Board of Appeal. Furthermore, in this case the facts in the opposition are different from the facts in the examination. Document D on which the interlocutory decision in opposition relies was not cited in examination. This is another reason why the Opposition Division cannot be bound by the *ratio decidendi* of the Board of Appeal. (Art. 111(2) EPC, GL E-X 4 or T 167/93).

## **QUESTION 6 (11 MARKS)**

**a)** Fees to be paid and last day for payment:

EP-A: Fee for grant and printing shall be paid within 4 months from the notification of the communication (R. 71(3) EPC). The date of notification of the communication is 27 October 2020 (as the communication took more than 10 days to be delivered (R. 126(2) EPC). The fee shall be paid at the latest on Monday 1 March 2021 (27 October 2020 + 4 months (R. 131(4) EPC) -> 27 February 2021 (Saturday), extended to Monday 1 March 2021 (R. 134(1) EPC). The amount of the fee is 960 EUR, RFees 2(1)7(ii).

[The renewal fee in respect of the fifth year falls due on 30 September 2021 and can be validly paid three months before it falls due. Hence, it cannot be paid within the time frame given in the question (R. 51(1) EPC).]

EP-B: Appeal fee shall be paid within 2 months from the notification of the decision (Art. 108 EPC). The fee shall be paid at the latest on Tuesday 2 March 2021 (23 December + 10 days

(R. 126(2) EPC) -> 2 January 2021 + 2 months (R. 131(4) EPC) -> 2 March 2021 (Tuesday)).  
The amount of the fee is 2705 EUR, RFees 2(1)11 (“any other entity”).

PCT-C: International filing fee is payable to the EPO (Rule 15.1(a) PCT) within 1 month of receipt of the application (R. 15.3 PCT). The fee shall be paid at the latest on Monday 1 March 2021 (28 January 2021 + 1 month (R. 80.2 PCT) -> 28 February 2021 (Sunday, R. 80.5 PCT) -> 1 March 2021 (Monday)). The amount of the fee is 1217 EUR minus 275 EUR (character-coded format) = 942 EUR, OJ 2020 Suppl. Publ. 3, p. 22-23.

Search fee is payable to the EPO (Rule 16.1(a) PCT) within 1 month of receipt of the application (R. 16.1(f) PCT). The calculation is the same as for the international filing fee, the search fee shall be paid at the latest on Monday 1 March 2021. The amount of the fee is 1775 EUR, RFees 2(1)2.

Transmittal fee is payable to the EPO (Rule 14.1(a) PCT) within 1 month of receipt of the application (R. 14.1(c) PCT). The calculation is the same as for the international filing fee, the transmittal fee shall be paid at the latest on Monday 1 March 2021. The amount of the fee is 135 EUR, RFees 2(1)18.

**b)** The order in which the fees are considered paid (or debited from the deposit account) is: EP-A, then PCT-C, then EP-B.

EP-A: fee for grant and publication is considered to be paid on the day of receipt of translation of the claims, AAD 5.1(d), i.e. 25 February 2021.

EP-B: appeal fee is considered to be paid on the day of receipt of the debit order, ADA 5.4.1, i.e. on 1 March 2021.

Fees for PCT-C are considered to be paid on the last day of the period for paying the fee, AAD 5.1(a), i.e. on 1 March 2021.

The date of debiting for EP-B and PCT-C is the same, but automatic debit orders have priority over any other debit orders (ADA 5.2.1). Therefore, PCT-C fees are debited first.

[In case of insufficient funds in the account, the payment is considered to have been made on the date on which the deposit account is duly replenished (ADA 5.2.3).]

AAD = Arrangements for automatic debiting, annex to Arrangements for deposit accounts (ADA).