

EUROPEAN QUALIFYING EXAMINATION 1990

PAPER D

This paper comprises:

- Instructions to Candidates 90/D/e/1
- Part I - Questions 1-12 90/D/e/2-6
- Part II - Legal Advice 90/D/e/7-11
- Annex - Calendars for 1989 and 1990 with indication of the days on which at least one of the EPO filing offices is not open for the receipt of documents 90/D/e/12-13

INSTRUCTIONS TO CANDIDATES

Paper D comprises:

- 12 questions, all to be answered - no choice for candidates;
- an inquiry from a client requiring an answer in the form of a legal opinion.

Half the marks available are awarded for the 12 questions, the other half for the legal advice.

The answers to questions 1 to 12 should be brief and to the point and the candidate must cite any Articles, Rules or other legal basis relevant to his answer.

In the legal opinion the candidate should demonstrate his professional ability to master a complex industrial property law situation. He must explain any legal consequences of the situation postulated and preferably cite any Articles, Rules or other legal basis relevant to his answer.

Dear Sirs,

We are a medium-sized firm that has produced several inventions concerned with vacuum flasks for which we have filed German and European patent applications. We are currently negotiating a licence with a larger company and need your advice on the validity of these applications.

(A) We filed a national application for invention A with the German Patent Office on 8 January 1986, followed by a European application, filed with the European Patent Office on 29 December 1986 claiming the relevant priority. The countries which we designated in the European application were AT, CH, DE, FR, GB and NL. The search report contained no relevant citations.

The essential feature of claim 1, for a method of manufacturing a double-walled evacuated glass vessel for a vacuum flask, requires that

- the type of glass used have a refractive index within a certain narrow range (feature a).

Claim 2 adds the feature that

- the temperature for fusing the wall sections is maintained at a particular level (feature b).

The mention of the grant of the European patent was published on 14 February 1990.

Before entering into negotiations with the larger company referred to above, we reviewed our patent applications and, in doing so, noticed that we had already filed an application for a very similar process with the German Patent Office on

5 February 1985, which was published as a German A-document on 7 August 1986. We have abandoned both this earlier German application and the corresponding European application filed within the priority period, which was also published as a European A-document at the end of August 1986, and for which we had designated only AT, CH and FR. We abandoned these applications because the search report for the abandoned European application had brought to light the existence of a GB patent disclosing feature a), but not feature b).

We believe that the claim 1 of our present patent is too broad, but are convinced that the combination of features (a) and (b) is inventive and industrially applicable.

The larger company, which is aware of this situation and is only prepared to take out a licence under patents for which all known relevant prior art has been fully considered by the European Patent Office, fears that the European patent as granted may not be legally valid in some designated states. This is partly in view of the refractive index mentioned in the UK patent document and partly also because the earlier - abandoned - German application of 5 February 1985 and the corresponding European application - likewise abandoned - contained general information about the temperature range required for fusing the parts of the double-walled evacuated glass vessel, and this range included the temperature of feature b). The refractive indexes of the glass employed are also referred to in the applications we have abandoned, although only in the description and with different values. However, we fear that these values could be considered equivalent to the value of feature a).

(B) Our invention B concerns a seal for screw caps with automatic pressure compensation, which is particularly important in thermos flasks filled with hot drinks. The European Patent Office granted us a European patent in respect of our application filed 20 March 1984. The mention of the grant of the patent was published in March 1989. We have been sent two notices of opposition filed at the European Patent Office within the nine-month time limit and have been invited to comment on them.

1. The statement of grounds submitted for opposition (I) filed by one of our competitors was accompanied by a copy of one of our still unpublished advertising brochures, which we had provided to a company Abel. This brochure was attached to a letter dated 19 January 1984 from Abel to opponent (I).

This brochure refers to our invention, although it does not provide an exact description. Nevertheless, a skilled person would probably not need to exercise his inventive faculties in order to arrive at the concept as claimed in claim 1 of our European patent. We have for many years had business dealings with Abel, who evidently made the brochure available to opponent (I) despite the long-standing relationship, involving a tacit understanding of secrecy, between our two firms. We were not informed about this and we believe that it represents an abuse of confidential information.

2) Opponent (II) based his opposition on prior publications alleging that, with respect to the state of the art, no inventive step was involved, although these publications have very little to do with our invention. They also assert, as a separate independent argument, that claim 1 of our European patent is not drafted sufficiently clearly to identify beyond all doubt, within the meaning of Article 84 EPC, the matter for which protection is sought. Meanwhile, to our surprise, opponent (II) has withdrawn his opposition. We are not certain whether this still affects the opposition proceedings and whether we are obliged to comment on it.

(C) Another invention C, for which we also have a European patent, concerns an injection moulding technique for the casings of vacuum flasks and a casting mould with a core of only two parts. The same two opponents (I) and (II) referred to above also filed oppositions to this European patent. The oppositions were rejected and the EPO Opposition Division maintained our European patent unamended in a decision dated 20 March 1988. Both opponents appealed and submitted grounds in due time.

1. In its decision rejecting the oppositions the Opposition Division stated that the opposition filed by opponent (I) was inadmissible. In his notice of opposition opponent (I) had referred to twelve new prior publications and alleged, without indicating further details, that any skilled person would be familiar with casting moulds having a two-part core. Citing two pages from a well-known reference work, no copies of which were enclosed, they claimed that injection moulding techniques of this kind were well known to those skilled in the art.

In his statement of reasons to the appeal, opponent (I) claims in support of his appeal that no inventive step is involved over the state of the art, as disclosed in the publications cited during opposition proceedings. They refer in particular to two of the twelve cited publications stating that the combination of the subject-matter in these two documents leads directly to the subject-matter of claim 1 of our patent.

2. When submitting grounds for his appeal, opponent (II) introduced into the proceedings for the first time a new prior publication which regrettably precisely anticipates the characterizing portion of claim 1 of our European patent. When the document corresponding to the pre-characterizing portion of claim 1 is combined with the new document, we have difficulty in demonstrating an inventive step.

Although we believe that the Board of Appeal will not take account of this new document, as it was introduced at a late stage, first in appeal proceedings, we intend to submit an alternative claim 1 at the oral proceedings next week, which incorporates a feature from an embodiment disclosed in the description; this would make it easier for us to argue inventive step, since three documents relating to the prior art would have to be combined in order to attack this claim.

Please examine whether the legal validity of our applications and patents is at risk.

Yours faithfully,

Mittlerer

1989

	January					February				
Wk.	1	2	3	4	5	5	6	7	8	9
M	2	9	16	23	30	6	13	20	27	
T	3	10	17	24	31	7	14	21	28	
W	4	11	18	25		1	8	15	22	1 8
T	5	12	19	26		2	9	16	23	2 9 16
F	6	13	20	27		3	10	17	24	3 10 17 24
S	7	14	21	28		4	11	18	25	4 11 18 25
S	1	8	15	22	29	5	12	19	26	5 12 19 26

Notice of the President of the European Patent Office dated 21 October 1988 concerning days on which at least one of the EPO filing offices is not open for the receipt of documents during 1989

	April					May					June				
Wk.	13	14	15	16	17	18	19	20	21	22	22	23	24	25	26
M	3	10	17	24		1	8	15	22	29	5	12	19	26	
T	4	11	18	25		2	9	16	23	30	6	13	20	27	
W	5	12	19	26		3	10	17	24	31	7	14	21	28	
T	6	13	20	27		4	11	18	25		1	8	15	22	29
F	7	14	21	28		5	12	19	26		2	9	16	23	30
S	1	8	15	22	29	6	13	20	27		3	10	17	24	
S	2	9	16	23	30	7	14	21	28		4	11	18	25	

1. Under Rule 85(1) EPC time limits expiring on a day on which one of the filing offices of the EPO is not open for receipt of documents are extended until the first day thereafter on which all the filing offices are open for receipt of documents and on which ordinary mail is delivered.

	July					August					September					
Wk.	26	27	28	29	30	31	31	32	33	34	35	35	36	37	38	39
M	3	10	17	24	31		7	14	21	28		4	11	18	25	
T	4	11	18	25			1	8	15	22	29	5	12	19	26	
W	5	12	19	26			2	9	16	23	30	6	13	20	27	
T	6	13	20	27			3	10	17	24	31	7	14	21	28	
F	7	14	21	28			4	11	18	25		1	8	15	22	29
S	1	8	15	22	29		5	12	19	26		2	9	16	23	30
S	2	9	16	23	30		6	13	20	27		3	10	17	24	

2. The EPO's filing offices in Munich and The Hague will be closed for the receipt of documents on every Saturday and Sunday in 1989.

	October					November					December					
Wk.	39	40	41	42	43	44	44	45	46	47	48	48	49	50	51	52
M	2	9	16	23	30		6	13	20	27		4	11	18	25	
T	3	10	17	24	31		7	14	21	28		5	12	19	26	
W	4	11	18	25			1	8	15	22	29	6	13	20	27	
T	5	12	19	26			2	9	16	23	30	7	14	21	28	
F	6	13	20	27			3	10	17	24		1	8	15	22	29
S	7	14	21	28			4	11	18	25		2	9	16	23	30
S	1	8	15	22	29		5	12	19	26		3	10	17	24	31

3. The other days in 1989 on which at least one of the EPO filing offices will not be open for receipt of documents are listed below.

Tage - Days - Jours		München Munich	Den Haag The Hague La Haye
Heiligedreikönigstag - Epiphany - Epiphanie	6.1.1989	X	
Karfreitag - Good Friday - Vendredi Saint	24.3.1989	X	X
Ostermontag - Easter Monday - Lundi de Pâques	27.3.1989	X	X
Maifeiertag - May Day - Fête du travail	1.5.1989	X	X
Christi Himmelfahrt - Ascension Day - Ascension	4.5.1989	X	X
Tag der Befreiung - Liberation Day - Jour de la Libération	5.5.1989		X
Pfingstmontag - Whit Monday - Lundi de Pentecôte	15.5.1989	X	X
Fronleichnam - Corpus Christi - Fête-Dieu	25.5.1989	X	
Mariä Himmelfahrt - Assumption Day - Assomption	15.8.1989	X	X
Allerheiligen - All Saints Day - Toussaint	1.11.1989	X	X
Buß- und Bettag - Day of Prayer and Repentance - Jour de pénitence et de prière	22.11.1989	X	
1. Weihnachtstag - Christmas Day - Noël	25.12.1989	X	X
2. Weihnachtstag - Boxing Day - Lendemain de Noël	26.12.1989	X	X

1990

Notice of the President of the European Patent Office dated 3 October 1989 concerning days on which at least one of the EPO filing offices is not open for the receipt of documents during 1990

JANUARY

S	M	T	W	T	F	S
	1	2	3	4	5	6
7	8	9	10	11	12	13
14	15	16	17	18	19	20
21	22	23	24	25	26	27
28	29	30	31			

FEBRUARY

S	M	T	W	T	F	S
				1	2	3
4	5	6	7	8	9	10
11	12	13	14	15	16	17
18	19	20	21	22	23	24
25	26	27	28			

MARCH

S	M	T	W	T	F	S
				1	2	3
4	5	6	7	8	9	10
11	12	13	14	15	16	17
18	19	20	21	22	23	24
25	26	27	28	29	30	31

APRIL

S	M	T	W	T	F	S
1	2	3	4	5	6	7
8	9	10	11	12	13	14
15	16	17	18	19	20	21
22	23	24	25	26	27	28
29	30					

MAY

S	M	T	W	T	F	S
	1	2	3	4	5	
6	7	8	9	10	11	12
13	14	15	16	17	18	19
20	21	22	23	24	25	26
27	28	29	30	31		

JUNE

S	M	T	W	T	F	S
					1	2
3	4	5	6	7	8	9
10	11	12	13	14	15	16
17	18	19	20	21	22	23
24	25	26	27	28	29	30

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JULY

S	M	T	W	T	F	S
1	2	3	4	5	6	7
8	9	10	11	12	13	14
15	16	17	18	19	20	21
22	23	24	25	26	27	28
29	30	31				

AUGUST

S	M	T	W	T	F	S
		1	2	3	4	
5	6	7	8	9	10	11
12	13	14	15	16	17	18
19	20	21	22	23	24	25
26	27	28	29	30	31	

SEPTEMBER

S	M	T	W	T	F	S
						1
2	3	4	5	6	7	8
9	10	11	12	13	14	15
16	17	18	19	20	21	22
23	24	25	26	27	28	29
30						

2. The EPO's filing offices in Munich, The Hague and Berlin will be closed for the receipt of documents on every Saturday and Sunday in 1990.

OCTOBER

S	M	T	W	T	F	S
	1	2	3	4	5	6
7	8	9	10	11	12	13
14	15	16	17	18	19	20
21	22	23	24	25	26	27
28	29	30	31			

NOVEMBER

S	M	T	W	T	F	S
				1	2	3
4	5	6	7	8	9	10
11	12	13	14	15	16	17
18	19	20	21	22	23	24
25	26	27	28	29	30	

DECEMBER

S	M	T	W	T	F	S
						1
2	3	4	5	6	7	8
9	10	11	12	13	14	15
16	17	18	19	20	21	22
23	24	25	26	27	28	29
30	31					

3. The other days in 1990 on which at least one of the EPO filing offices will not be open for receipt of documents are listed below:

Tage - Days - Jours		München Munich	Den Haag The Hague La Haye	Berlin
Neujahr - New Year's Day - Nouvel An	1.1.1990	X	X	X
Karfreitag - Good Friday - Vendredi Saint	13.4.1990	X	X	X
Ostermontag - Easter Monday - Lundi de Pâques	16.4.1990	X	X	X
Nationalfeiertag - National Holiday - Fête Nationale	30.4.1990		X	
Maifeiertag - May Day - Fête du travail	1.5.1990	X	X	X
Christi Himmelfahrt - Ascension Day - Ascension	24.5.1990	X	X	X
Pfingstmontag - Whit Monday - Lundi de Pentecôte	4.6.1990	X	X	X
Fronleichnam - Corpus Christi - Fête-Dieu	14.6.1990	X		
Mariä Himmelfahrt - Assumption Day - Assomption	15.8.1990	X	X	X
Allerheiligen - All Saints' Day - Toussaint	1.11.1990	X	X	X
Buß- und Bettag - Day of Prayer and Repentance - Jour de pénitence et de prière	21.11.1990	X		X
Heiliger Abend - Christmas Eve - Veille de Noël	24.12.1990	X	X	X
1. Weihnachtstag - Christmas Day - Noël	25.12.1990	X	X	X
2. Weihnachtstag - Boxing Day - Lendemain de Noël	26.12.1990	X	X	X
Sylvester - New Year's Eve - Saint-Sylvestre	31.12.1990	X	X	X