

EUROPEAN QUALIFYING EXAMINATION 1991

PAPER D

This paper comprises:

- Instructions to Candidates 91/D/e/1
- Part I - Questions 1-13 91/D/e/2-6
- Part II - Legal Advice 91/D/e/7-10
- Annex - Calendars for 1989, 1990 and 1991 with indication of the days on which at least one of the EPO filing offices is not open for the receipt of documents 91/D/e/11-13

91/D/e

INSTRUCTIONS TO CANDIDATES

Paper D comprises:

- 13 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 13 questions, the other half for the legal advice.

The answers to questions 1 to 13 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.

Basle, 4 April 1991

Dear Patent Attorney,

I am the manager of the Swiss firm W. Tell involved in development in a variety of fields. We have a small patent department, the head of which - our only patent expert - unfortunately had to be admitted to hospital very suddenly on 21 March 1991. We are therefore unable to seek his advice.

A. Our most pressing problem is an appeal filed by us - as the opponent - against a decision of an Opposition Division of the European Patent Office. Notification of the decision, dated 14 November 1990, was received by us on 16 November 1990. On 23 January 1991 we filed a notice of appeal and a cheque for the appeal fee (but no statement of grounds) with the EPO. There is a remark in the file which states that the statement of grounds had to be submitted by 25 March 1991. Furthermore, there is a rough draft in the file headed "grounds". The circumstances described above ought to be sufficient reasons for obtaining an extension of the time limit as we requested by a telex of 22 March 1991. Please advise us how to proceed.

B. We would also like to know how you view the situation regarding the following patent applications filed by us:

The patent applications in question all concern the treatment of a plastic material that has long been commercially available under the name "Super 2000". This material can be subjected to

- special heat treatment for improving the environmental resistance of its surface (invention A), and

- short wave radiation treatment (invention B).

Both types of treatment bestow upon the plastic material completely new, unforeseen and technically very desirable properties.

1. Unfortunately, on 1 September 1989, our competitors X filed a patent application in the Federal Republic of Germany disclosing and claiming the heat treatment of the material in question over a period of one to five hours at a temperature of 100 to 300°C. The application did not indicate any special values or ranges of values for temperature and heating time other than the above-mentioned broad ranges. The problem and all the other features of the invention in the German patent application are identical to our invention A. Our Swiss patent application for this invention A was not filed until 10 January 1990. It specifies a temperature range of 180 to 200°C and a more limited treatment time of one to two hours, since we had discovered that working outside these relatively narrow limits did not produce the desired result. A corresponding European application for the states CH, DE, FR and GB, claiming the priority of the Swiss application mentioned above, was filed by us on 9 January 1991. In their European application, as filed on 31 August 1990 for the states CH, DE, FR, GB and NL, claiming the priority of the German application of 1 September 1989, our competitors described the heat treatment as being 180 to 200°C for a period of one to two hours, with the result that the contents of both applications are identical.

How do you assess the patent situation in the countries that interest us?

2. Our European patent application for invention B for the States BE, CH, DE, FR, GB and NL was filed on 5 November 1990. No priority was claimed. To our astonishment a European patent application by Swedish firm Y was published on 2 January 1991 that had been filed on 30 June 1989, also without claiming an earlier priority date, for the States CH, DE, FR, GB and SE. A member of our staff had visited firm Y in spring 1989 and, in the course of a talk, which was confidential, told them about invention B, which he had completed but - for lack of sufficient interest at that time - not filed. The head of our patent department pointed out to firm Y that their actions constituted "unlawful dispossession". Firm Y did not dispute the above facts but stated that, since we had never indicated that we wanted to patent the development ourselves, they wished to keep the application for themselves, particularly since they had gone to considerable expense to file it.

Closer investigation revealed that whereas our application described and claimed two different, mutually independent, embodiments of the short-wave radiation process, firm Y's application disclosed only one embodiment.

Please advise us how we can secure our rights and prevent firm Y from acquiring a patent with earlier priority. We would of course like to obtain the best possible protection for this invention. What steps should we take now and in the future and on what legal grounds can we base our case?

C. Finally we would ask you to investigate the following facts

on 26 January 1990 we filed a Swiss patent application, on the basis of which a corresponding European application claiming its priority was filed on 3 December 1990 using the printed form for request for grant of a European patent, without designating specific Contracting States. Payment of the designation fee was not effected until 18 March 1991 at our local post office by means of a money order for DEM 3640,- credited to the EPO on 2 April 1991. In a submission sent to the EPO at the same time, receipt of which has already been confirmed, the desired Contracting States were designated in the following order: DE, GB, FR, IT, NL, SE, CH, BE, DK, AT, LU, ES and GR. A final reconsideration of our commercial interests, however, showed that no patent protection was needed for the states AT, LU, ES and GR. We would ask you to advise us immediately whether we need to take any action in this matter and what further reaction of the EPO can be expected.

Please let us have your reasoned opinion on the above matters as soon as possible.

Yours faithfully,

* The fee revision dated 3.1.1991 is not to be taken into account when answering this question.

1989

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

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	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
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						

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

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 Betttag - 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

1991

Notice of the President of the European Patent Office dated 7 November 1990 concerning holidays observed by EPO filing offices in 1991

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
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 1991.

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				

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Tage - Days - Jours		München Munich	Den Haag The Hague La Haye	Berlin
Neujahr - New Year's Day - Nouvel An	1.1.1991	X	X	X
Karfreitag - Good Friday - Vendredi Saint	29.3.1991	X	X	X
Ostermontag - Easter Monday - Lundi de Pâques	1.4.1991	X	X	X
Nationalfeiertag - National Holiday - Fête Nationale	30.4.1991		X	
Maifeiertag - May Day - Fête du travail	1.5.1991	X	X	X
Christi Himmelfahrt - Ascension Day - Ascension	9.5.1991	X	X	X
Pfingstmontag - Whit Monday - Lundi de Pentecôte	20.5.1991	X	X	X
Fronleichnam - Corpus Christi - Fête-Dieu	30.5.1991	X		
Mariä Himmelfahrt - Assumption Day - Assomption	15.8.1991	X	X	X
Tag der Deutschen Einheit - Day of German Unity - Fête Nationale	3.10.1991	X		X
Allerheiligen - All Saints' Day - Toussaint	1.11.1991	X	X	X
Buß- und Betttag - Day of Prayer and Repentance - Jour de pénitence et de prière	20.11.1991	X		X
Heiliger Abend - Christmas Eve - Veille de Noël	24.12.1991	X	X	X
1. Weihnachtstag - Christmas Day - Noël	25.12.1991	X	X	X
2. Weihnachtstag - Boxing Day - Lendemain de Noël	26.12.1991	X	X	X
Silvester - New Year's Eve - Saint-Sylvestre	31.12.1991	X	X	X