

EUROPEAN QUALIFYING EXAMINATION 1992

PAPER D

This paper comprises:

- Instructions to Candidates 92/D/e/1
- Part I - Questions 1-11 92/D/e/2-7
- Part II - Legal Advice 92/D/e/8-13
- Annex - Calendars for 1990, 1991 and 1992 with indication of the days on which at least one of the EPO filing offices is not open for the receipt of documents 92/D/e/14-16

92/D/e

INSTRUCTIONS TO CANDIDATES

Paper D comprises:

- 11 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 11 questions, the other half for the legal advice.

The answers to questions 1 to 11 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.

PART II

In answering this part, candidates should disregard property rights secured other than by patent.

DR ABACUS, the Managing Director of the British company ABACUS Ltd writes to you as follows:-

Tuesday 7th April 1992

Dear Sirs,

As you know, we are a small but successful company specialising in the design and manufacture of industrial computers and related software. We have an exceptionally successful range of small computers which were developed in our own research laboratory. We will be launching a new portable computer in a few weeks time; this computer is in the final stages of development and has been the subject of a vast amount of effort.

On Monday of this week I was given a letter of resignation by one of our development engineers, Mr Tester, who occupies a key position in our company. I discovered that in one month's time Mr Tester will start working in Switzerland with our main competitor - Titanic Computers SA, a Swiss company. I immediately ordered Tester to leave our premises and never to return.

As you know, Mr Tester is employed under written contract by which all inventions relating to his employment and made during the term of his contract are the unrestricted property of ABACUS Ltd.

As a result of the unexpected defection of this employee to competitor we have carried out a detailed audit of the patent coverage on our present and future products; we are extremely concerned on a number of matters and would appreciate your advice and, where appropriate, immediate action to avoid loss of rights.

A:

Firstly, it appears that since our last audit on 16 March 1992, one of the only two samples of our latest version of microchip has disappeared; I believe it has been passed to Titanic Computers SA by Mr Tester. The microchip was being kept very secret within our company because we believe it to be of extreme commercial value. The special feature of the microchip is the particular arrangement of the attachment pins. This Feature A was designed some time ago and was felt, until recently, to be of no commercial value; in fact all details of Feature A were disclosed together with another invention in the patent application GB-K filed at the UK Patent Office in our name on 3 June last year (1991). On 2 September last year (1991) we filed a European patent application EP-L claiming priority from an earlier UK patent application GB-M filed on 5 September 1990 and from UK patent application GB-K; copies of both the priority documents were filed with the European patent application EP-L. We did not realise the significance of Feature A at the time of filing the European patent application EP-L and all reference to the pins (and thus of feature A) was omitted from the European patent application EP-L. The European patent application EP-L was published three weeks ago.

It is likely that Titanic Computers, in league with Tester, will soon file a European patent application on Feature A as if it were their own invention.

B:

The second thing we discovered during our audit was that, despite the system our company has implemented to ensure that all patent matters are treated with due care, a number of errors have occurred in the handling of our European patent applications.

Our company has a policy of filing all its European patent applications designating UK, France, Germany and Switzerland; these are the only European countries in which our competitors manufacture. In the published European patent application EP-L mentioned above, we found that Switzerland has not been designated but that Sweden has; upon checking the application documents, we found that they had been incorrectly completed. In another of our European patent applications EP-N filed recently, the box for Sweden has also been crossed on the application form, whereas the box for Switzerland has not; EP-N is a divisional application filed because of lack of unity of invention of one of our earlier published applications.

It appears from our files that the clerk who filled out the forms for the two cases mistakenly interpreted our abbreviation for Switzerland "SW" to be the code for Sweden. This error is very serious, since it renders us unable to prevent Titanic Computers SA from using our invention; every effort must be made to ensure Switzerland is designated correctly.

C:

Our new portable computer, which will be launched in the next few weeks, includes all the features covered in our patent application mentioned above. In addition, we have just found out that our new portable computer includes inventions which have been disclosed and are, or may yet be, claimed in two patent applications filed by our competitors.

C1:

The first invention is covered by a European patent application designating all contracting states in the name of Titanic Computers SA; the patent application was filed several years ago, and after several communications from the substantive examiner, in a reasoned decision from the Examining Division dated 4 November 1991 the application was finally rejected because of lack of inventive step. On 5 December 1991, Titanic Computers SA filed a notice of appeal and paid at the same time the appeal fee. In a letter received at the EPO on 16 March 1992 Titanic Computers stated that the decision of the Examining Division was incorrect and that a detailed statement of grounds of appeal would follow. We understand that this statement was only received last week, on 1 April 1992. It seems that, in the accompanying letter, Titanic Computers requests that the statement be accepted despite the late filing and that the delay be excused. Do you think there is a possibility that the Board of Appeal could excuse the delay in filing the grounds of the appeal? We believe that this patent should in fact have been granted by the Examining Division to Titanics Computers. Can we nevertheless assume that no patent will result, which could present an obstacle to us? We have already made preparations to use the invention. Tester knows of these preparations and will certainly alert Titanic Computers to this.

C2:

The second invention is covered by an international (PCT) application filed by one of our Japanese competitors. The application was filed with the Japanese Patent Office (JPO) two years ago in Japanese, and requested only a European Patent. It claimed the priority of a Japanese national patent application and was filed on the very last day of the priority period. I believe I have seen an official German language abstract of an application which seems to concern exactly the same invention, but I do not remember where. Last week I asked the EPO for a copy of the translation into English, French or German of the PCT-application filed in Japanese, so that I could check whether we are free to use the invention. The EPO told me that, on conclusion of the PCT-Chapter II procedure, the Japanese applicant had requested entry into the regional phase 30 months after the priority date and had paid the necessary fees to the EPO. Following a communication from the EPO that the application is deemed to be withdrawn, our Japanese competitor filed, within the last few days, the request for examination and a translation of the application documents in English, together with a written statement explaining the delay of these filings.

Is there any risk that we may be sued for infringement if we use their invention? The feature in question has always been included in the plans for our new computer and is necessary for its proper functioning. You will certainly appreciate that our company is in a most serious situation.

Since we rely on good patent protection in order to succeed in a highly competitive field, we request your advice on the most appropriate measures available to us so that we can recover the protection we need. The cost of such measures is not a prime consideration. I believe that our company can scarcely survive unless we can prevent Titanic Computers SA and our other competitors from using our inventions.

We are aware of the risks if we infringe existing rights, and request your opinion on the above mentioned patent applications of our competitors. I look forward to receiving your advice on the measures we should take to protect our rights, and to avoid infringing the rights of others.

Yours faithfully

HAROLD ABACUS

Write a legal opinion in the form of a reasoned memorandum which you would use as the basis of a letter to your client.

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

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