

EUROPEAN QUALIFYING EXAMINATION 1994

PAPER D

This paper comprises:

- Instructions to Candidates 94/D/e/1
- Part I - Questions 1-10 94/D/e/2-7
- Part II - Legal Advice 94/D/e/8-13
- Annex - Calendars for 1993 and 1994 with indication of the days on which at least one of the EPO filing offices is not open for the receipt of documents 94/D/e/14-15

94/D/e

INSTRUCTIONS TO CANDIDATES

Paper D comprises:

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

50% of the marks available are awarded for the 10 questions, 50% for the legal advice.

The answers to questions 1 to 10 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.

PAPER D/1994

PART I

Question 1

(4 marks)

A Swiss inventor/applicant filed a first patent application in Taiwan on 1 March 1993. On 3 April 1993 the applicant filed a Japanese patent application for the same invention. A year later on 31 March 1994, the applicant files an international application (PCT) with the EPO designating all the EPC Contracting States, and claiming a single priority from the Japanese patent application. The specification and claims are identical for all three patent applications.

- a) Is the priority claim in the international application valid?
- b) What would the situation have been if the first application had been a Japanese utility model application?

Question 2

(4 marks)

Inventors **A** and **B**, totally independently one from the other, make exactly the same invention.

A files a first application A-FR in France on 4 January 1993 and subsequent applications (claiming priority from A-FR) A-DE in Germany on 4 January 1994 and A-EP at the EPO on 5 January 1994, designating DK, FR, IT, and SE.

B files a first application B-EP at the EPO on 5 February 1993 designating DK, FR, IT, and NL and a subsequent application (claiming priority from B-EP) B-DE in Germany on 3 January 1994.

All cited applications are published after March 1994 and no disclosure is made by the inventors before publication.

Who has the prior right in each State?
On what legal basis?

Question 3

(4 marks)

An unsigned opposition in the name of Company A was lodged by fax at the EPO together with a fee payment from a deposit account on the last day of the term for filing opposition. A few days later the opponent sends the EPO a copy of the opposition and the copy is signed by the Managing Director of Company A.

- a) Explain whether the opposition is validly lodged.
- b) What would happen if the signed copy had not been sent?

Question 4

(6 marks)

In opposition proceedings the proprietor of the patent proposes a set of twelve claims (including two independent claims) amended by limitation to overcome objections raised in the grounds for opposition. The patent was originally

applied for and granted with ten claims. The opponent alleges that the amended claims are not clear and are directed to more than one invention. The opponent does not raise any other objection to the amendments.

- a) Under which circumstances could the Opposition Division allow the amendments?
- b) If the Opposition Division decided to allow the amendments, would it need to consider the opponent's objections?

Question 5

(8 marks)

- a) You are a representative in Munich and receive a telefax on 5 April 1994 from a French inventor who filed a European patent application with a standard request for grant of a European patent (EPO Form 1001.1) on 3 January 1994 claiming priority from a French patent application filed on 4 January 1993. He paid the filing fee, the search fee and nine designation fees, crossing the designation boxes on Form 1001.1 against Austria (AT), Belgium (BE), Switzerland (CH), Germany (DE), Spain (ES), United Kingdom (GB), Italy (IT), The Netherlands (NL) and Sweden (SE). He now realises that he ought to have designated Denmark (DK) as well. Advise him of any action possible and its legal basis.
- b) If the European patent application had been filed on 30 December 1993, would your answer have been different? If so, in what way?
- c) If the European patent application in a) above had been filed initially on 4 January 1993 without claim to priority, would your answer have been different? If so, in what way?

Question 6

(5 marks)

The applicant receives from the EPO a communication informing the applicant of the text in which it intends to grant the European patent. The applicant files a response within the deadline set indicating that he approves the text.

The applicant finds a new piece of prior art which anticipates claim 1.

What options are available to the applicant if:

- a) it is only a few days after filing the response to the communication from the EPO, and the deadline originally set by the EPO has not yet expired?
- b) the decision to grant the European patent has been received by the applicant?

Question 7

(4 marks)

The applicant filed an international patent application designating amongst others all EPC Contracting States. The applicant receives notice from the USPTO as International Searching Authority (ISA) that it considers the application lacks unity and invites the applicant to pay an additional search fee for a second invention.

The applicant considers the unity objection is unjust and does not protest or pay the additional fee as requested. What is the consequence of non-payment of the fee before:

- a) the USPTO as ISA?
- b) the EPO as designated Office?

Question 8

(5 marks)

You have, as a professional representative, sent your US client a copy of the EPO examiner's communication dated exactly 4 months ago and setting a 4 month time limit for reply. You receive today a short notice, that he will need a further 2 or 3 months to provide you with instructions for reply. He asks you to keep the application alive, without however attempting to respond to the communication on your own. Further, he does not wish to pay any fees unless absolutely necessary. Write notes for a brief letter informing your client of the consequences of a non-timely reply, what you propose to do and whether fees are payable.

Question 9

(5 marks)

A has validly filed a European application. In an agreement dated 11 January 1994 A assigned all his rights in his patent application to B. No request was made for this transfer of title to be entered in the Register of European Patents. B subsequently died on 9 February 1994. The renewal fee in respect of the fourth year, which had fallen due, had not been paid by the time the period of grace expired (31 March 1994).

Is B's death a reason which could save the application?

Disregard the provisions of Article 122.

Question 10

(5 marks)

A United States inventor has filed a non-priority international (PCT) application on 10 April 1992. Amongst the designations was one for a European Patent. The application with eight claims was published with an international search report on 28 October 1993. The inventor filed an EPO Form 1200.1 (entry into the regional phase before the EPO as designated Office) on 3 January 1994, naming you as representative and designating nine countries. A signed authorisation in your favour was filed and the national basic, designation and search fees were paid. The inventor now (April 1994) asks you whether there are any further steps to be taken or fees paid within the next eight weeks, because he is going on vacation.

Inform the inventor accordingly, advising him of the consequences of non-payment or failure to act, and setting out any extensions possible.

1993

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		

Notice of the President of the European Patent Office dated 9 October 1992 concerning the days on which EPO filing offices are closed in 1993

1. Under Rule 85(1) EPC time limits expiring on a day on which at least **one** of the filing offices of the EPO is not open for receipt of documents (closing days) 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. The other closing days in 1993 are listed below.

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						

Tage – Days – Jours		München	Den Haag	Berlin
Neujahr – New Year's Day – Nouvel An	1.1.1993	X	X	X
Heilige Drei Könige – Epiphany – Epiphanie	6.1.1993	X		X
Karfreitag – Good Friday – Vendredi Saint	9.4.1993	X	X	X
Ostermontag – Easter Monday – Lundi de Pâques	12.4.1993	X	X	X
Nationalfeiertag – National Holiday – Fête Nationale	30.4.1993		X	
Tag der Befreiung – Liberation Day – Journée de la Libération	5.5.1993		X	
Christi Himmelfahrt – Ascension Day – Ascension	20.5.1993	X	X	X
Pfingstmontag – Whit Monday – Lundi de Pentecôte	31.5.1993	X	X	X
Fronleichnam – Corpus Christi – Fête-Dieu	10.6.1993	X		
Allerheiligen – All Saints' Day – Toussaint	1.11.1993	X	X	X
Buß- und Betttag – Day of Prayer and Repentance – Jour de pénitence et de prière	17.11.1993	X		X
Heiliger Abend – Christmas Eve – Veille de Noël	24.12.1993	X	X	X
Silvester – New Year's Eve – Veille de Nouvel An	31.12.1993	X	X	X

1994

Notice of the President of the European Patent Office dated 7 October 1993 concerning the days on which EPO filing offices are closed in 1994

1. Under Rule 85(1) EPC time limits expiring on a day on which at least **one** of the filing offices of the EPO is not open for receipt of documents (closing days) 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.

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. The other closing days in 1994 are listed below.

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

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

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

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

Tage - Days - Jours	München Munich	Den Haag The Hague La Haye	Berlin
Heilige Drei Könige - Epiphany - Epiphanie	X		X
Karfreitag - Good Friday - Vendredi Saint	X	X	X
Ostermontag - Easter Monday - Lundi de Pâques	X	X	X
Tag der Befreiung - Liberation Day - Journée de la Libération		X	
Christi Himmelfahrt - Ascension Day - Ascension	X	X	X
Pfingstmontag - Whit Monday - Lundi de Pentecôte	X	X	X
Fronleichnam - Corpus Christi - Fête-Dieu	X		
Mariä Himmelfahrt - Assumption Day - Assomption	X	X	X
Tag der Deutschen Einheit - Day of German Unity - Fête Nationale	X		X
Allerheiligen - All Saints' Day - Toussaint	X	X	X
Buß- und Bettag - Day of Prayer and Repentance - Jour de pénitence et de prière	X		X
2. Weihnachtstag - Boxing Day - Lendemain de Noël	X	X	X