

EUROPEAN QUALIFYING EXAMINATION 1994

PAPER D

This paper comprises:

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- Part II - Legal Advice 94/D/e/8-13
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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.

PART II

You are a professional representative. On 13 April 1994 you receive the following letter from your client, Professor Karl Smart, who is a famous Danish Biochemist.

As you know I have for some years cooperated with Dr. Manfred Grisk who is an independent researcher and runs a small research laboratory in Copenhagen (DK) specialising in the development and testing of pharmaceuticals. For each project a contract is made specifying the purpose of his research and the basic remuneration. The total remuneration for Grisk will be determined by negotiations between myself and Grisk and will depend on the potential value of any inventions made. Each contract contains the stipulation that Dr. Grisk assigns to me the world-wide rights for inventions made in execution of the project as well as the world wide right to file patent applications on these inventions and that Grisk, as inventor, should cooperate fully and assist with all measures necessary for the obtaining by me of valid protection for these inventions. Each contract also contains a secrecy agreement which clearly requires Dr. Grisk to keep non-public information confidential and not to disclose it to third parties. Unfortunately, we forgot to insert in the contracts a more far reaching clause to the effect that Dr. Grisk was not allowed to use information available to him from the project for his own purposes. Finally, the Maritime and Commercial Court in Copenhagen (DK) was specified as the proper venue for disputes arising from the contracts.

I have prepared the following survey of the various patent application rights involved and summarised at the end of the survey the problems on which I need your urgent advice.

Danish Application DK 1 was filed on 3 June 1993 naming myself as applicant and myself and Dr. Grisk as joint inventors. All formalities have been completed. The application is based on the invention of Product X which has a hypotensive effect, i.e. lowers the blood-pressure. The only production process disclosed (Process A) is a rather cumbersome four step process for producing Product X. Since Product X is believed to be novel, I incorporated the following independent claims in the application.

Product X;
Product X for use as a medicament;
Pharmaceutical composition comprising Product X;
Use of Product X for the Production of a hypotensive agent;
Process A.

[Note to candidates: assume that this range of claim kinds is complete so as to provide optimum protection for inventions of this nature]

It was solely my suggestion that Product X might have a hypotensive effect and Dr. Grisk developed Process A. Immediately after filing DK 1, I signed a new standard contract with Dr. Grisk under which he was to set up a line of experiments in order to find out whether it was possible to design an improved process comprising only two process steps. I suggested to Dr. Grisk that by using certain process parameters steps 1 and 2 of the four step process could be combined, as could steps 3 and 4.

In December 1993 Dr. Grisk had obtained the desired two-step process (Process B) and his process parameters confirmed my suggestions.

International Application PCT 2

I think that PCT 2, which I plan to file with the Danish Patent Office as soon as expedient, should incorporate the whole contents of DK 1 and also a description and claims directed to Process B. I have in mind to designate all the contracting states of the PCT including the USA. Those countries which are also EPC contracting states should be designated for a European patent.

I personally plan to incorporate in PCT 2 one further feature which I have not mentioned to Dr. Grisk. By chance, I observed that Product X also appeared to have an antiviral effect against herpes virus. The tests I have made confirm this and, moreover, have shown that Product X also has an antiviral effect on the measles and chicken pox viruses. I believe that it is the first time a hypotensive agent has also proved to be antiviral, and that this use has great potential.

European Application EP 3

To my great surprise, when I met Dr. Grisk yesterday, he told me that he did not intend to cooperate with me anymore, in particular in securing patent protection, unless he was adequately remunerated for his time and efforts, which he felt had not up to now been the case. Also, he astonished me by disclosing that at the same time as he was working on Process B, he had also secretly designed a one step process, Process C, by which a 50% higher yield of Product X could be obtained than is possible with either of the Processes A and B. Process C does not start from the same materials that are used for Processes A and B for the production of X and is an entirely different process. However, by Process C, Product X was formed together with Product Z as part of a mixture (Product Y). He had also separated Product Z from the mixture and tested its possible hypotensive effect on a few rats. It appeared to have a hypotensive effect not significantly different from the original results obtained with Product X.

Dr. Grisk further told me that he had asked another European patent attorney Mr Mullet to file a European patent application (EP 3). Before filing Mr Mullet had made an on-line search and found only one reference to Product Z, this being in a Danish journal of 1992 describing its use as a catalyst in a rubber vulcanisation process.

Dr. Grisk gave me a copy of EP 3 which was filed with the Danish Patent Office on 1 February 1994 designating all EPC contracting states. The application was filed in Danish naming Dr. Grisk as the sole applicant and the sole inventor. He had claimed the priority of 3 June 1993 from DK 1. Dr. Grisk admitted that since he had not been able to pay Mr Mullet his full charges, no official fees had yet been paid. I have verified that EP 3, besides the content of DK 1, also contains a description of the Process B, the Process C for the production of Product Y, the process for the separation of X and Z from the mixture Y, and finally the data about the hypotensive effect of Product Z.

Dr. Grisk also told me that in March 1994 he had contacted the US company Albatross Inc. and offered them a licence under EP 3 and any subsequent applications. When I asked him for details, he revealed that as a basis for the negotiations he had given a copy of EP 3 to Albatross Inc.

Please give me your advice on the following problems. I need a reasoned memorandum. Please also quote the Articles and Rules relevant to the various issues.

For the purpose of this memorandum, please assume that under Danish law, the right to the patent belongs to the inventor but that this right can be assigned by contract to another party.

- A. What should I do, if Dr. Grisk agrees to cooperate fully in order to secure the optimal patent protection?
- (i) If we want to keep EP 3 in force, what steps must be taken and within what time limits?
 - (ii) Would it be useful to keep EP 3 in force? Give reasons.
 - (iii) Should a PCT application be filed? If so,
 - a) should it be PCT 2 as planned?
 - b) who should be applicant?
 - c) which priorities should be claimed?
 - d) in general terms, what should be claimed to cover all the aspects of the invention in one application? (Possible problems with unity and claims fees should not be taken into account.)
- B. What should I do if Dr. Grisk refuses to cooperate in securing patent protection for me?
- (i) What legal steps should I take with regard to application EP 3?
 - (ii) Would it be useful to keep EP 3 in force? Give reasons.
 - (iii) What further steps could be undertaken to secure protection for the inventions?
 - (iv) Please advise me, in particular with relation to protection in the EPC member states, what arguments speak for the filing of a PCT application as planned and what arguments - if any - for directly filing instead an EP application (EP 2), in view of the problems with Dr. Grisk?
- In any case,
- a) who should be applicant?
 - b) which priorities should be claimed?
 - c) in general terms, what should be claimed to cover all the aspects of the invention in one application? (Possible problems with unity and claims fees should not be taken into account.)

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
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21	22	23	24	25	26	27
28						

MARCH

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APRIL

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18	19	20	21	22	23	24
25	26	27	28	29	30	

MAY

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30	31					

JUNE

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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
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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

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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
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11	12	13	14	15	16	17
18	19	20	21	22	23	24
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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
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3	4	5	6	7	8	9
10	11	12	13	14	15	16
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31						

NOVEMBER

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