

EUROPEAN QUALIFYING EXAMINATION 1996

PAPER D - PART I

This paper comprises:

- * Instructions to Candidates 96/D/e/1
- * Questions 1-11 96/DI/e/2-7
- * Annex - Calendars for 1995 and 1996 with indication of the days on which at least one of the EPO filing offices is not open for the receipt of documents 96/DI/e/8-9

INSTRUCTIONS TO CANDIDATES

Paper D, **Part I** comprises 11 questions, all of which should be answered - no choice for candidates;

Paper D, **Part II** comprises the statement of a specific situation requiring an answer in the form of a legal opinion.

The duration of **Part I** will be 2¼ hours, the duration of **Part II** will be 3 hours.

45% of the marks available for Paper D are awarded for Part I, 55% for Part II.

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

In **Part II** 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 I**Question 1**

(4 marks)

A European patent application will be filed on 9 April 1996, claiming priority of a Japanese application filed on 22 August 1995. A declaration of priority and a certified copy of the Japanese application will be filed together with the European application.

- (a) Does the applicant need to file a translation of the priority document?
- (b) Is there an alternative course of action?
- (c) Which time limits are involved?

Question 2

(6 marks)

The mention of the grant of a European patent to Company A was published on 4 May 1995. Opponent B filed an opposition at the EPO on 15 January 1996. On 27 March 1996 you receive a letter from your client C who informs you that Company A has instituted proceedings for infringement of the European patent against him (C) on 28 February 1996 and that now C wants to attack the patent before the EPO.

- (a) Giving reasons, advise your client C and inform him what steps can be taken before the EPO.
- (b) Would your answer be different if you received your client's letter after an appeal had been filed against a decision of the opposition division to maintain the patent and the appeal proceedings were still pending?

Question 3

(3 marks)

You are a European patent attorney. You are asked by a South African citizen resident in South Africa to file a PCT application at the European Patent Office designating Australia, the European Patent Office, ARIPO, OAPI, Japan and the United States.

- (a) Is it possible for the application to proceed in the South African's name?
- (b) Would your answer differ if your client was an Australian citizen resident in Australia?

Question 4

In December 1994 a European Patent Attorney irrevocably withdrew his representation of a European patent application having a US resident as applicant. In January 1995, the EPO dispatched a letter directly to the applicant requesting appointment of a new representative. On 23 March 1995, the EPO dispatched the notice informing the applicant that the renewal fee due on 28 February 1995 had not been paid but could still be validly paid with surcharge within six months of the due date. On 29 September 1995 the EPO dispatched the notification pursuant to Art. 86(3) and Rule 69(1) EPC (application deemed to be withdrawn).

Today, 7 December 1995, you receive a letter from the applicant asking you to act as representative and enclosing copies of all the EPO communications and adequate money to cover all fees. The letter explains that the applicant has always intended to proceed with the application but has been heavily occupied by extremely important business matters and has indeed been away on business trips when the first two EPO letters were delivered.

What, if anything, can be done to save the application? Give reasons and basis for your answer.

Question 5

(2.5 marks)

For a PCT application, when are the handling and preliminary examination fees due?

What are the consequences of failure to pay them when due, if the EPO is acting as the International Preliminary Examining Authority?

Question 6

(3 marks)

On 20 April 1995 a Japanese applicant filed a PCT application designating the US, Japan, Germany, the United Kingdom and the Netherlands for a national patent. Are these designations valid?

Question 7

Today is 27 March 1996.

The client for whom you had on 2 November 1995 filed a European patent application designating UK, France and Germany mentions to you today, for the first time, that he exhibited the invention at a recognised International exhibition in the USA from 1 to 7 October 1995 (assume this exhibition appears on the EPO list!). He also hands you the certificate issued by the exhibition organiser confirming the invention was displayed. He now wishes to extend protection to all EPC contracting states and the USA.

What actions would you recommend in order to safeguard your client's rights?

Question 8

(2.5 marks)

The parties to opposition proceedings are notified that the date of oral proceedings will be 18 June 1996. The language of proceedings is German, however the opponent's only representative wants to use English during the oral proceedings.

- (a) Is that possible? If so, who has to make provisions for interpretation and who has to pay for it?
- (b) Would your answer be different if the opponent wished to use Spanish during oral proceedings?

Question 9

(5 marks)

A German patent application DE1 describing a feature A is filed on 28 October 1993.

A further German Patent application DE2 describing feature A and as an alternative to A a feature B, which is an obvious technical equivalent of feature A, is filed on 28 September 1994, claiming priority from DE1.

The contents of both DE1 and DE2 were made public for the first time by publication of the applications on 8 May 1995.

A European patent application EP claiming feature A and independently feature B is filed on 27 September 1995 claiming priority from DE2 and designating all Contracting States.

- (a) Does EP validly claim priority for features A and B?
- (b) Is it possible to obtain a valid European patent on features A and B?
- (c) Would your answer to (a) and (b) above be different if DE1 were withdrawn/abandoned without being published? Give reasons.

Question 10

A European patent application, designating BE, CH/LI, FR, GB, GR, IT and SE was filed by company A on 31 August 1988 without claiming priority. The application resulted successfully afterwards in the successful negotiation of a royalty-bearing licence with company B. The contract provided for company A to repay the royalties paid in respect of any designated state in which the patent was not brought into force or was invalidated. Royalties were duly paid by company B. The grant of the patent was published on 5 July 1995.

In January 1996, company B wrote to company A, refusing to make payment for the royalties due for 1995, citing a document published in 1986 which they had just found and which they believed clearly anticipated the subject matter of the patent. Company A has not yet replied but on investigation you (company B's patent attorney) find that none of the renewal fees due in August 1995 have been paid.

Advise company B on the question of recovery of royalties.

Question 11

(3 marks)

A European patent application was filed on 3 March 1993, claiming priority of 9 March 1992.

- (a) What is:
- (i) the due date for the fourth renewal fee?
 - (ii) the last day for the payment thereof without additional fee?
 - (iii) the last day for the payment thereof with additional fee?
- (b) The grant of the patent is to be published on 18 April 1996. To whom should the fourth renewal fee be paid?

1995

INFORMATION FROM THE EUROPEAN PATENT OFFICE

Notice from the President of the European Patent Office dated 10 November 1994 concerning the days on which EPO filing offices are closed in 1995

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 1995 are listed below.

JANUARY	FEBRUARY	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	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	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	MAY	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	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	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
JULY	AUGUST	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 31	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	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
OCTOBER	NOVEMBER	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	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	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 Munich	Den Haag The Hague La Haye	Berlin
Heilige Drei Könige - Epiphany - Epiphanie	06.01.1995	x		x
Karfreitag - Good Friday - Vendredi Saint	14.04.1995	x	x	x
Ostermontag - Easter Monday - Lundi de Pâques	17.04.1995	x	x	x
Maifeiertag - May Day - Fête du travail	01.05.1995	x	x	x
Tag der Befreiung - Liberation Day - Journée de la Libération	05.05.1995	x	x	x
Christi Himmelfahrt - Ascension Day - Ascension	25.05.1995	x	x	x
Pfingstmontag - Whit Monday - Lundi de Pentecôte	05.06.1995	x	x	x
Fronleichnam - Corpus Christi - Fête-Dieu	15.06.1995	x		
Mariä Himmelfahrt - Assumption Day - Assomption	15.08.1995	x	x	x
Tag der Deutschen Einheit - Day of German Unity - Fête Nationale	03.10.1995	x		x
Allerheiligen - All Saints' Day - Toussaint	01.11.1995	x	x	x
1. Weihnachtstag - Christmas Day - Noël	25.12.1995	x	x	x
2. Weihnachtstag - Boxing Day - Lendemain de Noël	26.12.1995	x	x	x

1996

INFORMATION FROM THE EUROPEAN PATENT OFFICE

Notice from the President of the European Patent Office dated 3 November 1995 concerning the days on which EPO filing offices are closed in 1996

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APRIL	MAY	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	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	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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Tage/Days/Jours		München Munich	Den Haag The Hague La Haye	Berlin
Neujahr - New Year's Day - Nouvel An	01.01.1996	x	x	x
Karfreitag - Good Friday - Vendredi Saint	05.04.1996	x	x	x
Ostermontag - Easter Monday - Lundi de Pâques	08.04.1996	x	x	x
Nationalfeiertag - National holiday - Fête Nationale	30.04.1996		x	
Maifeiertag - May Day - Fête du travail	01.05.1996	x	x	x
Christi Himmelfahrt - Ascension Day - Ascension	16.05.1996	x	x	x
Pfingstmontag - Whit Monday - Lundi de Pentecôte	27.05.1996	x	x	x
Fronleichnam - Corpus Christi - Fête-Dieu	06.06.1996	x		
Mariä Himmelfahrt - Assumption Day - Assomption	15.08.1996	x	x	x
Tag der Deutschen Einheit - Day of German Unity - Fête Nationale	03.10.1996	x		x
Allerheiligen - All Saints' Day - Toussaint	01.11.1996	x	x	x
Heiliger Abend - Christmas Eve - Veille de Noël	24.12.1996	x	x	x
1. Weihnachtstag - Christmas Day - Noël	25.12.1996	x	x	x
2. Weihnachtstag - Boxing Day - Lendemain de Noël	26.12.1996	x	x	x
Silvester - New Year's Eve - Saint-Sylvestre	31.12.1996	x	x	x