

EUROPEAN QUALIFYING EXAMINATION 1999

PAPER D - PART I

THIS PAPER COMPRISES:

- * QUESTIONS 1 - 10 99/DI/E/1-5

- * ANNEX - CALENDARS FOR 1998 AND 1999 WITH
INDICATION OF THE DAYS ON WHICH AT LEAST ONE
OF THE EPO FILING OFFICES IS NOT OPEN FOR
THE RECEIPT OF DOCUMENTS 99/DI/E/6-7

45% OF THE MARKS AVAILABLE FOR PAPER D ARE AWARDED FOR PART I, 55%
FOR PART II.

Question 1

In opposition proceedings, may a European patent be amended to overcome a ground for opposition even if this ground has not been invoked by the opponent?

Question 2

(6 marks)

Today, 24.03.1999, you receive a letter from a US client asking you to perform the necessary acts for entering the regional phase before the EPO for a PCT application, if still possible. He filed the PCT application on 18.07.1997 with the US Patent Office (USPTO) designating EP. The priorities of US applications dated 18.07.1996 and 24.10.1996 were claimed. An international preliminary examination was requested within the 19 month time limit and carried out by the USPTO. The subject-matter of each of the original ten claims met the requirements of Art. 33(1) to (4) PCT. Since the time limit for performing the necessary acts for entering the regional phase before the EPO has already lapsed, your client proposes to withdraw the first of the priority claims in order to extend this time limit.

- (a) Will withdrawal of the first priority claim have the desired effect?
- (b) If this priority claim were maintained, would it still be possible to enter the regional phase before the EPO and, if so, what measures should be taken?

Question 3

(4 marks)

You filed an EP application on 02.03.1999 without any priority claim. This application received a filing date and number.

- (a) What fees were due on the date of filing and by when must they be paid?
- (b) What will happen if the fees are not paid in time?

- (c) Can you later claim priority from this application if the fees are not paid?

Question 4

(4 marks)

You are the representative for a client for whom you filed a European patent application without claiming priority. The filing date is 11.10.1997. The designation of inventor was not submitted to the EPO when filing the application. On 11.12.1998 you received a notification from the Receiving Section of the EPO according to Rule 42(1) EPC dated 10.12.1998. Due to a delay caused by your client, you received the information for the designation of inventor on 12.02.1999. On the same day you sent the designation of inventor to the EPO in Munich. The returned receipt for documents from the EPO indicates that the designation of inventor was received on 15.02.1999. On 18.03.1999 you received a communication dated 17.03.1999 according to Rule 69(1) EPC from the EPO The Hague stating that the application is deemed to be withdrawn because the designation of inventor was not filed within the prescribed time limit.

What actions have to be taken and by when?

Question 5

(6 marks)

You recently signed an agreement with your business partner *X*, wherein the following was agreed:

- (a) European patent *A*, against which no opposition was filed within the applicable time limit, is transferred from *X* to you;
- (b) European patent application *B*, filed by *X* this year without priority, is also transferred to you;
- (c) European patent application *C* filed by *X* is transferred to you as well, however, only in respect of one of the designated contracting states;

- (d) you acquire a licence in respect of European patent *D* from *X*;
- (e) you also acquire a licence in respect of European patent application *E* filed by *X*, however, for Scotland only;
- (f) European patent application *F* constitutes a security right for a personal loan by you to *X*.

You now want to have these transfers, licences and other rights recorded in the Register of European Patents as soon as possible. Can this be done in respect of all of the above?

Question 6

(4 marks)

You are asked to perform the necessary acts for entering the regional phase before the EPO in respect of:

- (a) an international application, PCT1, filed 20 months ago in the USA without any priority claim. The USPTO was International Searching Authority (ISA). International Preliminary Examination has not been requested. The application contains eight claims;
- (b) an international application, PCT2, filed 30 months ago in the USA without any priority claim. International Preliminary Examination has been carried out. The EPO was International Preliminary Examining Authority (IPEA). The application contains thirteen claims.

What fees are to be paid for entering the regional phase

- in case (a)?
- in case (b)?

Question 7

(4)

A small Canadian company, based in Montreal, filed a Canadian patent application on 14.07.1997. The decision to file a corresponding European patent application claiming priority of the Canadian application had to be postponed until the last possible moment. On 14.07.1998, the managing director tried to phone his European patent attorney in Paris in order to ask him to file the European patent application. He got the message that the office was closed because of the national holiday. He then instructed his secretary to transmit the European patent application (claiming the priority) by fax directly to the EPO in Munich. She did not get around to transmitting the fax until late on the same day.

The following morning the director saw the transmitted documents and noticed that the secretary had not realised that there is a six hour time difference between Montreal and Munich. The application could therefore not have been received by the EPO before midnight on 14.07. He immediately phoned the European patent attorney in Paris to ask whether the priority claim could be saved.

If you were the European patent attorney, how would you have responded?

Question 8

(4 marks)

- (a) Is it possible to accelerate the prosecution of a European patent application?
- (b) - Can a similar effect be obtained in the regional phase for a PCT application designating/electing EP?
- If this application has not yet entered the regional phase before the EPO, how would you proceed?
- (c) Is it possible to accelerate the processing of an opposition before the EPO?
- (d) Is it possible to accelerate the processing of an appeal before the EPO?

Question 9

On 19.03.1999 your client, company *A*, informs you that, on 12.03.1999, proceedings were instituted against it in several EPC member states by company *X*, alleging infringement of European patent *P*. The letter from *A* is accompanied by copies of *P* and of a document *D*, found by *A*. Document *D* is clearly novelty-destroying vis-à-vis several of the claims of *P* and is highly relevant to the assessment of inventive step for the subject-matter of the remaining claims.

On inspecting the file, you find that company *B* filed an admissible opposition to *P* two years previously and that oral proceedings under Article 116(1) EPC were scheduled for 05.03.1999; however, the result of the oral proceedings is not apparent from the file. The prior art disclosed by document *D* was not taken into account either in the examination proceedings or in the opposition proceedings, as far as can be seen from the file.

Today, opponent *B* tells you in a telephone conversation that the opposition was rejected in the proceedings on 05.03.1999 by a decision of the opposition division in accordance with Rule 68(1) EPC.

How would you advise *A* to proceed in this case?

Question 10

(4 marks)

On 01.08.1997 you filed a PCT application for your client, claiming priority of 02.12.1996 and designating all PCT contracting states. All fees were duly paid. You received the international preliminary examination report and immediately performed the necessary acts for entering the regional phase before the EPO.

Your client now asks you to request for an extension of the Euro-PCT application to Romania and the former Yugoslav Republic of Macedonia.

Can a valid request for extension still be filed?

1998

**INFORMATION FROM THE
EUROPEAN PATENT OFFICE**

Notice from the President of the European Patent Office dated 6 October 1997 concerning the days on which EPO filing offices are closed in 1998

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 1998 are listed below.

JANUARY

S	M	T	W	T	F	S
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FEBRUARY

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MARCH

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JUNE

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JULY

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Tage/Days/Jours		München Munich	Den Haag The Hague La Haye	Berlin
Neujahr - New Year's Day - Nouvel An	01.01.1998	x	x	x
Heilige Drei Könige - Epiphany - Epiphanie	06.01.1998	x		
Karfreitag - Good Friday - Vendredi Saint	10.04.1998	x	x	x
Ostermontag - Easter Monday - Lundi de Pâques	13.04.1998	x	x	x
Nationalfeiertag - National Holiday - Fête National	30.04.1998		x	
Mai feiertag - May Day - Fête du travail	01.05.1998	x	x	x
Tag der Befreiung - Liberation Day - Journée de la Libération	05.05.1998		x	
Christi Himmelfahrt - Ascension Day - Ascension	21.05.1998	x	x	x
Pfingstmontag - Whit Monday - Lundi de Pentecôte	01.06.1998	x	x	x
Fronleichnam - Corpus Christi - Fête-Dieu	11.06.1998	x		
Heiliger Abend - Christmas Eve - Veille de Noël	24.12.1998	x	x	x
1. Weihnachtstag - Christmas Day - Noël	25.12.1998	x	x	x
Silvester - New Year's Eve - Saint-Sylvestre	31.12.1998	x	x	x

1999

INFORMATION FROM THE EUROPEAN PATENT OFFICE

Notice from the President of the European Patent Office dated 17 September 1998 concerning the days on which EPO filing offices are closed in 1999

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Heilige Drei Könige - Epiphany - Epiphanie	06.01.1999	x		
Karfreitag - Good Friday - Vendredi Saint	02.04.1999	x	x	x
Ostermontag - Easter Monday - Lundi de Pâques	05.04.1999	x	x	x
Nationalfeiertag - National Holiday - Fête National	30.04.1999		x	
Tag der Befreiung - Liberation Day - Journée de la Libération	05.05.1999		x	
Christi Himmelfahrt - Ascension Day - Ascension	13.05.1999	x	x	x
Pfingstmontag - Whit Monday - Lundi de Pentecôte	24.05.1999	x	x	x
Fronleichnam - Corpus Christi - Fête-Dieu	03.06.1999	x		
Allerheiligen - All Saints' Day - Toussaint	01.11.1999	x		
Heiliger Abend - Christmas Eve - Veille de Noël	24.12.1999	x	x	x
Silvester - New Year's Eve - Saint-Sylvestre	31.12.1999	x	x	x