
EUROPEAN QUALIFYING EXAMINATION 2001

PAPER D – PART I

THIS PAPER COMPRISES:

- * QUESTIONS 1 - 11 2001/DI/E/1-6

- * ANNEX – CALENDARS FOR 2000 AND 2001 WITH INDICATION OF THE DAYS ON WHICH AT LEAST ONE OF THE EPO FILING OFFICES IS NOT OPEN FOR THE RECEIPT OF DOCUMENTS 2001/DI/E/7-8

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

Question 1

An Italian applicant files two European patent applications, EP1, which claims the priority of Italian application IT1, and EP2, which claims the priority of Italian application IT2.

EP1 is filed in Italian and is identical to IT1. An English translation is supplied to the EPO two weeks later. EP2 is filed in English. It is a translation of IT2.

During the examination procedure, the English texts of EP1 and EP2 are found to contain translation errors. Would it be possible to correct these errors?

Question 2**(2 points)**

Today, 28 March 2001, you are representing the patent proprietor in opposition proceedings before the EPO.

With the summons to oral proceedings, which were requested by the sole opponent, the opposition division gave its provisional opinion that the arguments put forward by the opponent were not relevant and that the patent could be maintained as granted. The opponent announced that he intends to attend the oral proceedings. You therefore likewise decided to attend.

At the start of the oral proceedings, the chairman informs you that the opponent has that very morning sent a fax giving notice that he will not be coming to the proceedings. He further informs you that the opposition division upholds its opinion that the patent can be maintained as granted. You feel that your client has incurred unnecessary costs for the oral proceedings.

What can you do?

Question 3

(3 points)

You receive the first communication from the examining division regarding a client's European patent application. The examiner's opinion is that the subject-matter of claim 1 is not novel in the light of an abstract of a scientific article. Both the abstract and the scientific article were published before the priority date of the application.

Your client sends you a full copy of the article. It turns out that the abstract does not correctly reflect the article, which itself is not novelty-destroying.

How would you reply to the examining division's communication?

Question 4

(3 points)

You are representing the patent proprietor in opposition proceedings before the EPO. The opposition division includes an examiner who is a former employee of the opponent.

Your client asks you to request that the examiner be replaced. What would you advise him?

Question 5

(3 points)

A European patent application was filed on 15 March 1987. The patent was granted in July 1990. For the following years, the renewal fees were duly paid. After paying the fees in 1995, the patentee allowed the patent to lapse in all designated contracting states by paying no further renewal fees.

- a) Would it be possible under the EPC to inspect the file at the EPO? If so, until when?
- b) What would be the position if a patent granted on a divisional application filed from this application is still in force in one of the contracting states?

Question 6

In the following situations for a European patent application filed in January 2000, will the EPO refund the designation fees? If so, how many? Justify your answers.

- a) The applicant paid 9 designation fees;
- b) The applicant paid 6 designation fees for: AT, CH, ES, FR, GB, LI;
- c) The applicant paid 7 designation fees. Some days later he duly withdrew the application;
- d) The applicant paid 7 designation fees. Some days earlier he had duly withdrawn the application.

Question 7**(7 points)**

In each of the following cases:

Is it possible to remedy the deficiencies within the time limit? Is the time limit extendable? What will be the legal consequence if the applicant does not submit the duly completed designation of inventor as requested? What are the legal remedies?

Case (a):

An applicant received a communication from the EPO dated 15 February 2001 inviting the applicant to remedy within a period of two months the following deficiency: the inventor's address is missing. The designation of inventor is otherwise in order.

Case (b):

A company filed on 27 November 2000 a European patent application claiming priority from a patent application filed on 28 November 1999. By a communication dated 22 January 2001 the EPO informed the applicant that the designation of inventor had not been signed, and invited him to remedy this deficiency within a specified time limit.

Case (c):

A company filed a PCT application, and duly entered the regional phase before the EPO. The EPO invited the applicant with a communication dated 15 January 2001 to file within a period of two months the missing designation of inventor.

Case (d):

A company duly filed a divisional application but did not enclose the designation of inventor. The EPO invited the applicant with a communication dated 15 January 2001 to file within a period of two months the missing designation of inventor.

Question 8

(5 points)

One of your clients phones you today, 28 March 2001. She tells you that she filed an EP application designating all contracting states and that a competitor has been using her invention in some of the designated states since February 2001. The application was filed in French in February 2000, without claiming any priority rights; all fees have been duly paid.

She asks you to defend her rights. How would you proceed?

Question 9

(5 points)

On 20 October 2000 you received a communication dated 17 October 2000 from the EPO, noting a loss of rights (Rule 69(1) EPC) and stating that your client's European patent application is deemed to be withdrawn under Article 96(3) EPC because the invitation to file observations on a communication from the examining division dated 7 March 2000 was not complied with.

On the morning of 22 December 2000 your secretary posted a registered letter containing a request for further processing of the European patent application and a response to the examining division's communication.

On the afternoon of 22 December 2000 she realised that she had forgotten to enclose a cheque for EUR 76 for the payment of the fee for further processing in the envelope. Therefore, she immediately despatched at a post office a second registered letter bearing the address of the EPO, enclosing the forgotten cheque and indicating the purpose of the payment. Both registered letters were received at the EPO on 29 December 2000.

Was the request for further processing validly filed?

Question 10

(6 points)

In each of the following situations can a divisional application be validly filed? Give reasons, and say what legal remedies, if any, are available.

- (a) Applicant A files a divisional application from an EP parent application EP1. On the date of filing, the period according to Article 94(2) EPC has already expired for the parent application. The applicant does not subsequently file a valid request for examination in respect of EP1 either.
- (b) On 23 January 2001 you received a written decision of the examining division dated 18 January 2001 concerning European patent application EP2. The examining division refused the application because of lack of unity. EP2 includes two inventions, only the first had been searched. This morning, 28 March 2001, your client asks you to file a divisional application for the second, unsearched invention. He does not wish to go further with the first invention.
- (c) Applicant C receives a communication according to Rule 51(4) EPC indicating that the examining division intends to grant a patent for his European patent application EP3. He indicates in good time his approval of the text and at the same time declares that a divisional application has been filed the same day. However, the divisional application actually arrives one day later at the EPO.

Question 11

(5 p

Today, 28 March 2001, a US attorney phones you asking for urgent advice.

On 5 June 2000 he had filed a PCT application in English claiming priority of two US applications filed on 10 June 1999 and on 15 September 1999. On 19 January 2001 the first priority was withdrawn by the applicant. On 26 March 2001 he filed the demand for international preliminary examination.

Would it still be possible to validly enter the regional phase before the EPO? If so, what steps have to be undertaken and by when?

Annex 1

INFORMATION FROM THE EUROPEAN PATENT OFFICE

Notice from the President of the European Patent Office dated 30 September 1999 concerning the days on which EPO filing offices are closed in 2000

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 2000 are listed below.

2000

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 29	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 2000		München Munich	Den Haag The Hague La Haye	Berlin
EPA geschlossen - EPO closed - OEB fermé	03.01.00	x	x	x
EPA geschlossen - EPO closed - OEB fermé	04.01.00	x	x	x
Heilige Drei Könige - Epiphany - Epiphanie	06.01.00	x		
Karfreitag - Good Friday - Vendredi Saint	21.04.00	x	x	x
Ostermontag - Easter Monday - Lundi de Pâques	24.04.00	x	x	x
Maifeiertag - May Day - Fête du travail	01.05.00	x	x	x
Tag der Befreiung - Liberation Day - Journée de la Libération	05.05.00		x	
Christi Himmelfahrt - Ascension Day - Ascension	01.06.00	x	x	x
Pfingstmontag - Whit Monday - Lundi de Pentecôte	12.06.00	x	x	x
Fronleichnam - Corpus Christi - Fête-Dieu	22.06.00	x		
Mariä Himmelfahrt - Assumption Day - Assomption	15.08.00	x		
Tag der Deutschen Einheit - Day of German Unity - Fête Nationale	03.10.00	x		x
Allerheiligen - All Saints' Day - Toussaint	01.11.00	x		
1. Weihnachtstag - Christmas Day - Noël	25.12.00	x	x	x
2. Weihnachtstag - Boxing Day - Lendemain de Noël	26.12.00	x	x	x

2001

INFORMATION FROM THE EUROPEAN PATENT OFFICE

Notice from the President of the European Patent Office dated 18 October 2000 concerning the days on which EPO filing offices are closed in 2001

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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 2001 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		
	1	2	3	4	5	6						1	2	3						1	2	3
7	8	9	10	11	12	13	4	5	6	7	8	9	10	4	5	6	7	8	9	10		
14	15	16	17	18	19	20	11	12	13	14	15	16	17	11	12	13	14	15	16	17		
21	22	23	24	25	26	27	18	19	20	21	22	23	24	18	19	20	21	22	23	24		
28	29	30	31				25	26	27	28				25	26	27	28	29	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		
1	2	3	4	5	6	7			1	2	3	4	5							1	2	
8	9	10	11	12	13	14	6	7	8	9	10	11	12	3	4	5	6	7	8	9		
15	16	17	18	19	20	21	13	14	15	16	17	18	19	10	11	12	13	14	15	16		
22	23	24	25	26	27	28	20	21	22	23	24	25	26	17	18	19	20	21	22	23		
29	30						27	28	29	30	31			24	25	26	27	28	29	30		
JULY							AUGUST							SEPTEMBER								
S	M	T	W	T	F	S	S	M	T	W	T	F	S	S	M	T	W	T	F	S		
1	2	3	4	5	6	7				1	2	3	4							1		
8	9	10	11	12	13	14	5	6	7	8	9	10	11	2	3	4	5	6	7	8		
15	16	17	18	19	20	21	12	13	14	15	16	17	18	9	10	11	12	13	14	15		
22	23	24	25	26	27	28	19	20	21	22	23	24	25	16	17	18	19	20	21	22		
29	30	31					26	27	28	29	30	31	23	24	25	26	27	28	29			
OCTOBER							NOVEMBER							DECEMBER								
S	M	T	W	T	F	S	S	M	T	W	T	F	S	S	M	T	W	T	F	S		
	1	2	3	4	5	6						1	2	3							1	
7	8	9	10	11	12	13	4	5	6	7	8	9	10	2	3	4	5	6	7	8		
14	15	16	17	18	19	20	11	12	13	14	15	16	17	9	10	11	12	13	14	15		
21	22	23	24	25	26	27	18	19	20	21	22	23	24	16	17	18	19	20	21	22		
28	29	30	31				25	26	27	28	29	30	23	24	25	26	27	28	29			
													30	31								

Tage/Days/Jours 2001		München Munich	Den Haag The Hague La Haye	Berlin
Neujahr - New Year's Day - Nouvel An	01.01.01	x	x	x
Karfreitag - Good Friday - Vendredi Saint	13.04.01	x	x	x
Ostermontag - Easter Monday - Lundi de Pâques	16.04.01	x	x	x
Nationalfeiertag - National Holiday - Fête nationale	30.04.01		x	
Maifeiertag - May Day - Fête du travail	01.05.01	x	x	x
Christi Himmelfahrt - Ascension Day - Ascension	24.05.01	x	x	x
Pfingstmontag - Whit Monday - Lundi de Pentecôte	04.06.01	x	x	x
Fronleichnam - Corpus Christi - Fête-Dieu	14.06.01	x		
Mariä Himmelfahrt - Assumption Day - Assomption	15.08.01	x		
Tag der Deutschen Einheit - Day of German Unity - Fête Nationale	03.10.01	x		x
Allerheiligen - All Saints' Day - Toussaint	01.11.01	x		
Heiliger Abend - Christmas Eve - Veille de Noël	24.12.01	x	x	x
1. Weihnachtstag - Christmas Day - Noël	25.12.01	x	x	x
2. Weihnachtstag - Boxing Day - Lendemain de Noël	26.12.01	x	x	x
Silvester - New Year's Eve - Saint-Sylvestre	31.12.01	x	x	x