

EUROPEAN QUALIFYING EXAMINATION 2003

PAPER D - PART II

This paper comprises:

- * Client's letter followed by four (4) questions 2003/DII/e/1 - 4

- * Annex : Calendars for 2002 and 2003 with 2003/DII/e/5 - 6
indication of the days on which at least one
of the EPO filing offices is not open for the
receipt of documents

45% of the marks available for paper D are awarded for part I,
55% for part II.

You are a European patent attorney and today you receive the following letter from a new client, the Dutch company "PP" (for Plug & Pray), which you will represent in proceedings before the EPO.

"We are a manufacturer of high voltage, high frequency (HVHF) plugs. Our only markets are Europe and the USA.

Over the last three years our R&D department has been developing a new generation of HVHF plugs. Usually the contacts of these plugs have a circular cross-section. However our developers found out that the product life can be extended significantly by using contacts of triangular cross-section.

On 01.03.2001, we filed a first patent application US1 with the USPTO, because the USA is the most important market for us and we are very sensitive with regard to patent infringement lawsuits. US1 describes and claims an HVHF plug with contacts of triangular cross-section.

A few months later our developers discovered that contacts of square cross section also extend product life in comparison to traditional plugs. Accordingly, on 01.11.2001, we filed a further US patent application US2 as a continuation-in-part (CIP) of US1. US1 was withdrawn shortly after the filing of US2. US2 describes and claims the same subject-matter as US1. In addition US2 describes and claims a plug with contacts of square cross-section. A US patent was granted in February 2003 for our US2 application as filed.

As we also need patent protection in Europe, we filed a European patent application EP1 with the EPO, designating all the contracting states and claiming priority of US2. We filed the following documents: description, claims, abstract, drawing, a designation of inventor, a declaration of priority and a certified copy of US2, as well as a cheque for the amount of the filing fee and the search fee. EP1 was mailed to the EPO by a regular registered letter on 29.10.2002 by national post services. The notice of receipt from the EPO indicates that the documents of EP1 were received by the EPO on 08.11.2002.

EP1 describes and claims the same subject-matter as US2. In addition, EP1 describes and claims a plug with contacts of pentagonal cross-section, because in the meantime we found that such a pentagonal cross-section also extends product life. In fact our developers found that the surprising effect of having product life extended for HVHF plugs is achieved only if the plug contacts have a triangular, square or pentagonal cross-section. We had a discussion on the unity of invention of EP1, but to us it was clear that the claimed three alternative solutions are in fact equivalent solutions to the same problem and are linked by the same inventive concept. Therefore we filed a single application for these three solutions. As we do not know yet which one of the three solutions is commercially the most promising, we would like to have patent protection for all the three solutions. Last month we started advertising our plugs with contacts of triangular or square cross-section.

We thought we were in a good position, until last week, when we received a warning letter from our French competitor LBP (for "La Bonne Prise"). Therein they informed us that their European patent EP2 discloses and claims HVHF plugs with contacts of triangular or square cross-section. EP2 was granted for DE, ES, FR and GB.

LBP sells products in USA and in DE, ES, FR and GB. In the past LBP has only patent applications for these five countries. From the patent publication of EP2, which was attached to the warning letter, we could see that the mention of the grant of EP2 was published on 06.11.2002. The letter further indicated that EP2 was granted without a prior publication of the application and that the short time between filing and grant was due to a request for accelerated prosecution. EP2 was filed on 14.11.2001 and claims priority of FR1, a French patent application of LBP with a filing date of 06.06.2001. We have made investigations and have found that FR1 only describes and claims plugs with contacts of triangular cross-section.

In order to resolve the situation quickly, we have a meeting at the end of next week with LBP to discuss a possible settlement.

We made some preparations for this meeting and we found that LBP filed another European patent application EP3. EP3 was filed without claiming any priority on 15.03.2001. EP3 discloses and claims a shielding system for HVHF plugs. DE, ES, FR and GB were designated. The search report of EP3 was published on 24.09.2002 and contains only one reference, a German document, which is cited as an "A" document. We made a file inspection of EP3 and we found that a first communication had been issued in which it was indicated that grant would be possible if LBP were to amend the application in order to overcome certain clarity objections.

Please note that we filed on 01.10.2000, together with our Spanish subsidiary as joint applicants, a Spanish patent application ES1, disclosing and claiming two shielding systems for HVHF plugs. One of these two shielding systems, S1, corresponds exactly to the one disclosed in EP3. The second shielding system, S2, is completely different. On 15.01.2003, the Spanish Patent Office granted a patent for ES1 without amendments.

At the end of the priority period, we were convinced of the commercial interest in S1. However, we were sceptical concerning S2. Therefore, we filed on 01.10.2001, also as joint applicants, a PCT application PCT1 (in order to postpone costs) and a European patent application EP4, both claiming priority of ES1. EP4 describes and claims only S2, and PCT1 describes and claims only S1. The abstracts of EP4 and PCT1 have the same content as the abstract of ES1 which describes both shielding systems.

We filed PCT1 in Spanish including all possible designations, and paid the filing, search and designation fees.

On 10.04.2002 PCT1 and EP4 were each published with search report. Although the search report of PCT1 indicated that the claimed subject matter was clearly patentable, we decided that S2 was of more interest to us than S1. Therefore, we have not taken any action with respect to PCT1 after its filing.”

- 1) What is the patent situation with regard to the HVHF plugs ?
- 2) What is the patent situation with regard to the shielding systems ?
- 3) Give your analysis of the negotiation position of PP for the meeting with LBP next week.
- 4) If the meeting with LBP is not successful, what can be done by PP against LBP's patent portfolio and what can PP do to improve its position?

2002

INFORMATION FROM THE EUROPEAN PATENT OFFICE

Notice from the President of the European Patent Office dated 29 August 2001 concerning the days on which EPO filing offices are closed in 2002

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 2002 are listed below.

<p>JANUARY</p> <p>S M T W T F S</p> <p>1 2 3 4 5</p> <p>6 7 8 9 10 11 12</p> <p>13 14 15 16 17 18 19</p> <p>20 21 22 23 24 25 26</p> <p>27 28 29 30 31</p>	<p>FEBRUARY</p> <p>S M T W T F S</p> <p>1 2</p> <p>3 4 5 6 7 8 9</p> <p>10 11 12 13 14 15 16</p> <p>17 18 19 20 21 22 23</p> <p>24 25 26 27 28</p>	<p>MARCH</p> <p>S M T W T F S</p> <p>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</p>
<p>APRIL</p> <p>S M T W T F S</p> <p>1 2 3 4 5 6</p> <p>7 8 9 10 11 12 13</p> <p>14 15 16 17 18 19 20</p> <p>21 22 23 24 25 26 27</p> <p>28 29 30</p>	<p>MAY</p> <p>S M T W T F S</p> <p>1 2 3 4</p> <p>5 6 7 8 9 10 11</p> <p>12 13 14 15 16 17 18</p> <p>19 20 21 22 23 24 25</p> <p>26 27 28 29 30 31</p>	<p>JUNE</p> <p>S M T W T F S</p> <p>1</p> <p>2 3 4 5 6 7 8</p> <p>9 10 11 12 13 14 15</p> <p>16 17 18 19 20 21 22</p> <p>23 24 25 26 27 28 29 30</p>
<p>JULY</p> <p>S M T W T F S</p> <p>1 2 3 4 5 6</p> <p>7 8 9 10 11 12 13</p> <p>14 15 16 17 18 19 20</p> <p>21 22 23 24 25 26 27</p> <p>28 29 30 31</p>	<p>AUGUST</p> <p>S M T W T F S</p> <p>1 2 3</p> <p>4 5 6 7 8 9 10</p> <p>11 12 13 14 15 16 17</p> <p>18 19 20 21 22 23 24</p> <p>25 26 27 28 29 30 31</p>	<p>SEPTEMBER</p> <p>S M T W T F S</p> <p>1 2 3 4 5 6 7</p> <p>8 9 10 11 12 13 14</p> <p>15 16 17 18 19 20 21</p> <p>22 23 24 25 26 27 28</p> <p>29 30 31</p>
<p>OCTOBER</p> <p>S M T W T F S</p> <p>1 2 3 4 5</p> <p>6 7 8 9 10 11 12</p> <p>13 14 15 16 17 18 19</p> <p>20 21 22 23 24 25 26</p> <p>27 28 29 30 31</p>	<p>NOVEMBER</p> <p>S M T W T F S</p> <p>1 2</p> <p>3 4 5 6 7 8 9</p> <p>10 11 12 13 14 15 16</p> <p>17 18 19 20 21 22 23</p> <p>24 25 26 27 28 29 30</p>	<p>DECEMBER</p> <p>S M T W T F S</p> <p>1 2 3 4 5 6 7</p> <p>8 9 10 11 12 13 14</p> <p>15 16 17 18 19 20 21</p> <p>22 23 24 25 26 27 28</p> <p>29 30 31</p>

Tage/Days/Jours 2002		München Munich	Den Haag The Hague La Haye	Berlin
Neujahr - New Year's Day - Nouvel An	01.01.02	x	x	x
Karfreitag - Good Friday - Vendredi Saint	29.03.02	x	x	x
Ostermontag - Easter Monday - Lundi de Pâques	01.04.02	x	x	x
Nationalfeiertag - National Holiday - Fête nationale	30.04.02		x	
Maifeiertag - May Day - Fête du travail	01.05.02	x	x	x
Christi Himmelfahrt - Ascension Day - Ascension	09.05.02	x	x	x
Pfingstmontag - Whit Monday - Lundi de Pentecôte	20.05.02	x	x	x
Fronleichnam - Corpus Christi - Fête-Dieu	30.05.02	x		
Mariä Himmelfahrt - Assumption Day - Assomption	15.08.02	x		
Tag der Deutschen Einheit - Day of German Unity - Fête Nationale	03.10.02	x		x
Allerheiligen - All Saints' Day - Toussaint	01.11.02	x		
Heiliger Abend - Christmas Eve - Veille de Noël	24.12.02	x	x	x
1. Weihnachtstag - Christmas Day - Noël	25.12.02	x	x	x
2. Weihnachtstag - Boxing Day - Lendemain de Noël	26.12.02	x	x	x
Silvester - New Year's Eve - Saint-Sylvestre	31.12.02	x	x	x

2003

INFORMATION FROM THE EUROPEAN PATENT OFFICE

Notice from the President of the European Patent Office dated 10 October 2002 concerning the days on which EPO filing offices are closed in 2003

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.

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Neujahr – New Year's Day – Nouvel An	01.01.2003	x	x	x
Heilige Drei Könige – Epiphany – Epiphanie	06.01.2003	x		
Karfreitag – Good Friday – Vendredi Saint	18.04.2003	x	x	x
Ostermontag – Easter Monday – Lundi de Pâques	21.04.2003	x	x	x
Nationalfeiertag – National Holiday – Fête nationale	30.04.2003		x	
Maifeiertag – May Day – Fête du Travail	01.05.2003	x	x	x
Tag der Befreiung – Liberation Day – Journée de la Libération	05.05.2003		x	
Christi Himmelfahrt – Ascension Day – Ascension	29.05.2003	x	x	x
Pfingstmontag – Whit Monday – Lundi de Pentecôte	09.06.2003	x	x	x
Fronleichnam – Corpus Christi – Fête-Dieu	19.06.2003	x		
Mariä Himmelfahrt – Assumption Day – Assomption	15.08.2003	x		
Tag der Deutschen Einheit – Day of German Unity – Fête nationale	03.10.2003	x		x
Heiliger Abend – Christmas Eve – Veille de Noël	24.12.2003	x	x	x
1. Weihnachtstag – Christmas Day – Noël	25.12.2003	x	x	x
2. Weihnachtstag – Boxing Day – Lendemain de Noël	26.12.2003	x	x	x
Silvester – New Year's Eve – Saint-Sylvestre	31.12.2003	x	x	x