

## EUROPEAN QUALIFYING EXAMINATION 2010

# Paper D

## Part I

This paper comprises:

- \* Questions 1 - 9 2010/DI/EN/1 - 5
  - Question 1 : 4 points
  - Question 2 : 5 points
  - Question 3 : 5 points
  - Question 4 : 4 points
  - Question 5 : 4 points
  - Question 6 : 5 points
  - Question 7 : 4 points
  - Question 8 : 5 points
  - Question 9 : 4 points

TOTAL: 40 POINTS

- \* Annex: calendars for 2008, 2009 and 2010 with 2010/DI/EN/6 - 8  
indication of the days on which at least one  
of the EPO filing offices is not open for the  
receipt of documents

40% of the marks available for paper D are awarded for part I, 60% for part II.

**QUESTION 1**

(4 points)

Opponent O duly files an opposition to a European patent, the patent comprising an independent product claim 1 relating to product A and another independent process claim 2 relating to process B.

In the notice of opposition, O opposes the patent with respect to claim 1 only. The grounds and the reasoning relate to lack of inventive step.

O does not make any further written submissions prior to the oral proceedings.

At the beginning of the oral proceedings, O informs the opposition division that he had found by chance a highly pertinent prior art document Dn which destroys the novelty of both claims. Therefore, he argues that claims 1 and 2 are not novel and now requests the revocation of the patent in its entirety.

What are the chances of success for the last request of the opponent?

**QUESTION 2**

(5 points)

A European patent application EP-1 was filed claiming a football made of 33 patches of a special plastics material, PX. According to the description, the provision of the 33 patches made of PX is essential for achieving the surprising technical effect of improved flight characteristics. Furthermore, a method of stitching the patches together is disclosed but not claimed. No relevant prior art is available. DIV-1, a divisional application of EP-1, was filed shortly before EP-1 was withdrawn. DIV-1 discloses and claims only said football. DIV-2, a divisional application of DIV-1, was filed one week before DIV-1 was withdrawn. At the moment, only DIV-2 is pending. DIV-2 has the same description and claims as EP1.

Now the applicant wants to claim a football with any number of patches made of PX s  
has found out that the technical effect can also be achieved with other numbers of patches  
made of PX. He further wants to have a claim to the stitching method.

For what subject matter can the applicant have protection via DIV-2 and how?

**QUESTION 3**

**(5 points)**

German applicant X duly filed a German patent application DE-X on 27.02.2009. X then  
wanted to file an international application PCT-X claiming the priority of DE-X. On  
25.02.2010, X sent PCT-X as a registered letter to the EPO in Munich.

Normally, that letter would have arrived at its destination within two days of mailing. However,  
due to an accident of the delivery truck, the letter only reaches the EPO today, 02.03.2010.

- a) Has the priority been validly claimed?
  
- b) If not, what steps have to be taken to obtain a valid claim to priority?

**QUESTION 4**

(4 points)

Applicant A filed a Chinese patent application CN-A as a first filing on 01.07.2008. The subject-matter of the application is new and inventive. CN-A was published on 10.01.2010. On 21.12.2009, applicant A sends a letter with his letterhead by fax to the EPO indicating that he seeks a European patent. The letter contains neither description nor claims but a reference to previously filed CN-A. The subject-matter of CN-A was not made available to the public otherwise. The EPO communicates to the applicant the date of filing of EP-A as being 21.12.2009. The applicant now intends to file an international application PCT-A claiming priority from EP-A.

- a) Which requirements did EP-A have to meet to get a date of filing accorded by the EPO.
- b) Discuss the legal situation of PCT-A.

**QUESTION 5**

(4 points)

Your client, US company USCO, filed two international applications, PCT-U and PCT-E. PCT-U was searched by the USPTO as International Searching Authority (ISA). PCT-E was searched by the EPO as ISA. In each case, the ISA made a finding of lack of unity, with PCT-U containing inventions PCT-U1 and PCT-U2, and PCT-E containing inventions PCT-E1 and PCT-E2. Only inventions PCT-U1 and PCT-E1 were searched. In January 2010, both applications were duly regionalised before the EPO. The inventions first mentioned in the claims were PCT-U1 and PCT-E1, respectively.

Your client now wants to prosecute the applications in the European phase on the basis of PCT-U2 and PCT-E2 only. How should he proceed?

**QUESTION 6**

(5 points)

Company X obtained a European patent with a single claim directed to a new product comprising compound C in the range of 3-40%. The grant was mentioned in the European Patent Bulletin on 09.11.2009. Company X filed a translation of the patent specification on 22.01.2010 for Italy. Due to an error in the translation, compound C is specified to be in the range of 3-4% in the single claim. Thereafter the Italian company Y started to produce and sell the new product with 20% of compound C in Italy.

Can company X stop company Y selling the new product with 20% of compound C in Italy?

**QUESTION 7**

(4 points)

A European patent application EP1 was filed in English on 13.02.2008, validly claiming priority from Danish national application DK1 filed on 23.03.2007. The mention of the grant of EP1 is to be published in the European Patent Bulletin on 04.03.2010. The applicant desires to validate the patent in Denmark, France and Italy.

- a) When was the first renewal fee due to the EPO?
- b) When is the first renewal fee due to the national offices and until when can it be paid without surcharge?
- c) Which translations have to be supplied to the national offices?

**QUESTION 8**

(5 p

A European patent application EP1 was filed on 16.01.2010 by reference to US patent application US1 and indicating that the reference also replaces the claims. US1 comprises a single independent claim 1 and 24 dependent claims.

- a) What claim fees have to be paid for EP1 and by when? The applicant wants to pay these fees as late as possible but to avoid any unnecessary payments.
- b) The applicant wants to reduce the number of claims and keep only claims 1-15. Which actions does he have to take?
- c) Advise whether the claims 16 – 25 could be reintroduced at a later stage in the proceedings and on possible costs.

**QUESTION 9**

**(4 Points)**

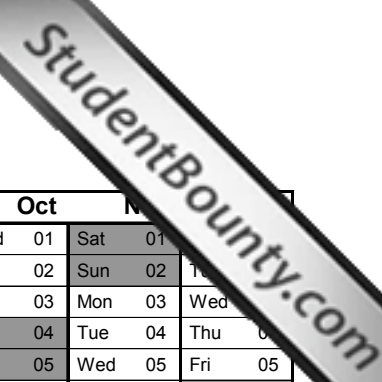
Proprietor P received a communication from the Opposition Division according to Art. 101(1) EPC and dated 05.01.2009. In this communication P was invited to file observations in response to a submission of opponent O within a period of 4 months.

Subsequent to the communication, a third party T provided evidence that he had instituted entitlement proceedings against P. As a consequence, the opposition proceedings were stayed as from 08.05.2009. Some time later, P received a communication informing him that the opposition proceedings were to be resumed as from 04.01.2010. T lost the entitlement proceedings.

When does the time limit set by the communication according to Art.101(1) EPC expire?

# Annex 1

2008



Jan	Feb	Mar	Apr	May	Jun	Jul	Aug	Sep	Oct	Nov	Dec
Tue 01	Fri 01	Sat 01	Tue 01	Thu 01	Sun 01	Tue 01	Fri 01	Mon 01	Wed 01	Sat 01	Tue 01
Wed 02	Sat 02	Sun 02	Wed 02	Fri 02	Mon 02	Wed 02	Sat 02	Tue 02	Thu 02	Sun 02	Tue 02
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Sun 06	Wed 06	Thu 06	Sun 06	Tue 06	Fri 06	Sun 06	Wed 06	Sat 06	Mon 06	Thu 06	Sat 06
Mon 07	Thu 07	Fri 07	Mon 07	Wed 07	Sat 07	Mon 07	Thu 07	Sun 07	Tue 07	Fri 07	Sun 07
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Thu 10	Sun 10	Mon 10	Thu 10	Sat 10	Tue 10	Thu 10	Sun 10	Wed 10	Fri 10	Mon 10	Wed 10
Fri 11	Mon 11	Tue 11	Fri 11	Sun 11	Wed 11	Fri 11	Mon 11	Thu 11	Sat 11	Tue 11	Thu 11
Sat 12	Tue 12	Wed 12	Sat 12	Mon 12	Thu 12	Sat 12	Tue 12	Fri 12	Sun 12	Wed 12	Fri 12
Sun 13	Wed 13	Thu 13	Sun 13	Tue 13	Fri 13	Sun 13	Wed 13	Sat 13	Mon 13	Thu 13	Sat 13
Mon 14	Thu 14	Fri 14	Mon 14	Wed 14	Sat 14	Mon 14	Thu 14	Sun 14	Tue 14	Fri 14	Sun 14
Tue 15	Fri 15	Sat 15	Tue 15	Thu 15	Sun 15	Tue 15	Fri 15	Mon 15	Wed 15	Sat 15	Mon 15
Wed 16	Sat 16	Sun 16	Wed 16	Fri 16	Mon 16	Wed 16	Sat 16	Tue 16	Thu 16	Sun 16	Tue 16
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Sat 19	Tue 19	Wed 19	Sat 19	Mon 19	Thu 19	Sat 19	Tue 19	Fri 19	Sun 19	Wed 19	Fri 19
Sun 20	Wed 20	Thu 20	Sun 20	Tue 20	Fri 20	Sun 20	Wed 20	Sat 20	Mon 20	Thu 20	Sat 20
Mon 21	Thu 21	Fri 21	Mon 21	Wed 21	Sat 21	Mon 21	Thu 21	Sun 21	Tue 21	Fri 21	Sun 21
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Sun 27	Wed 27	Thu 27	Sun 27	Tue 27	Fri 27	Sun 27	Wed 27	Sat 27	Mon 27	Thu 27	Sat 27
Mon 28	Thu 28	Fri 28	Mon 28	Wed 28	Sat 28	Mon 28	Thu 28	Sun 28	Tue 28	Fri 28	Sun 28
Tue 29	Fri 29	Sat 29	Tue 29	Thu 29	Sun 29	Tue 29	Fri 29	Mon 29	Wed 29	Sat 29	Mon 29
Wed 30		Sun 30	Wed 30	Fri 30	Mon 30	Wed 30	Sat 30	Tue 30	Thu 30	Sun 30	Tue 30
Thu 31		Mon 31		Sat 31		Thu 31	Sun 31		Fri 31		Wed 31

Tage / Days / Jours		München Munich	Den Haag The Hague La Haye	Berlin
Neujahr - New Year's Day - Nouvel An	01.01.2008	x	x	x
Karfreitag - Good Friday - Vendredi Saint	21.03.2008	x	x	x
Ostermontag - Easter Monday - Lundi de Pâques	24.03.2008	x	x	x
Nationalfeiertag - National Holiday - Fête nationale	30.04.2008		x	
Maifeiertag - May Day - Fête du Travail	01.05.2008	x	x	x
Christi Himmelfahrt - Ascension Day - Ascension	01.05.2008	x	x	x
Tag der Befreiung - Liberation Day - Journée de la Libération	05.05.2008		x	
Pfingstmontag - Whit Monday - Lundi de Pentecôte	12.05.2008	x	x	x
Fronleichnam - Corpus Christi - Fête-Dieu	22.05.2008	x		
Mariä Himmelfahrt - Assumption Day - Assomption	15.08.2008	x		
Tag der Deutschen Einheit - Day of German Unity - Fête Nationale	03.10.2008	x		x
Heiliger Abend - Christmas Eve - Vieille de Noël	24.12.2008	x	x	x
1. Weihnachtstag - Christmas Day - Noël	25.12.2008	x	x	x
2. Weihnachtstag - Boxing Day - Lendemain de Noël	26.12.2008	x	x	x
Silvester - New Year's Eve - Saint-Sylvestre	31.12.2008	x	x	x

## Annex 2

2009

Jan	Feb	Mar	Apr	May	Jun	Jul	Aug	Sep	Oct	Nov	Dec
Thu 01	Sun 01	Sun 01	Wed 01	Fri 01	Mon 01	Wed 01	Sat 01	Tue 01	Thu 01	Sun 01	Wed 01
Fri 02	Mon 02	Mon 02	Thu 02	Sat 02	Tue 02	Thu 02	Sun 02	Wed 02	Fri 02	Mon 02	Wed 02
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Thu 29		Sun 29	Wed 29	Fri 29	Mon 29	Wed 29	Sat 29	Tue 29	Thu 29	Sun 29	Tue 29
Fri 30		Mon 30	Thu 30	Sat 30	Tue 30	Thu 30	Sun 30	Wed 30	Fri 30	Mon 30	Wed 30
Sat 31		Tue 31		Sun 31		Fri 31	Mon 31		Sat 31		Thu 31

Tage / Days / Jours		München Munich	Den Haag The Hague La Haye	Berlin
Neujahr - New Year's Day - Nouvel An	01.01.2009	x	x	x
Brückentag - Bridging Day - Pont	02.01.2009	x	x	x
Heilige Drei Könige - Epiphany - Epiphanie	06.01.2009	x		
Karfreitag - Good Friday - Vendredi Saint	10.04.2009	x	x	x
Ostermontag - Easter Monday - Lundi de Pâques	13.04.2009	x	x	x
Nationalfeiertag - National Holiday - Fête nationale	30.04.2009		x	
Maifeiertag - May Day - Fête du Travail	01.05.2009	x	x	x
Tag der Befreiung - Liberation Day - Journée de la Libération	05.05.2009		x	
Christi Himmelfahrt - Ascension Day - Ascension	21.05.2009	x	x	x
Brückentag - Bridging Day - Pont	22.05.2009	x	x	x
Pfingstmontag - Whit Monday - Lundi de Pentecôte	01.06.2009	x	x	x
Fronleichnam - Corpus Christi - Fête-Dieu	11.06.2009	x		
Heiliger Abend - Christmas Eve - Vieille de Noël	24.12.2009	x	x	x
1. Weihnachtstag - Christmas Day - Noël	25.12.2009	x	x	x
Silvester - New Year's Eve - Saint-Sylvestre	31.12.2009	x	x	x



## Annex 3

2010

Jan		Feb		Mar		Apr		May		Jun		Jul		Aug		Sep		Oct			
Fri	01	Mon	01	Mon	01	Thu	01	Sat	01	Tue	01	Thu	01	Sun	01	Wed	01	Fri	01	Mon	01
Sat	02	Tue	02	Tue	02	Fri	02	Sun	02	Wed	02	Fri	02	Mon	02	Thu	02	Sat	02	Tue	02
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Tue	26	Fri	26	Fri	26	Mon	26	Wed	26	Sat	26	Mon	26	Thu	26	Sun	26	Tue	26	Fri	26
Wed	27	Sat	27	Sat	27	Tue	27	Thu	27	Sun	27	Tue	27	Fri	27	Mon	27	Wed	27	Sat	27
Thu	28	Sun	28	Sun	28	Wed	28	Fri	28	Mon	28	Wed	28	Sat	28	Tue	28	Thu	28	Sun	28
Fri	29			Mon	29	Thu	29	Sat	29	Tue	29	Thu	29	Sun	29	Wed	29	Fri	29	Mon	29
Sat	30			Tue	30	Fri	30	Sun	30	Wed	30	Fri	30	Mon	30	Thu	30	Sat	30	Tue	30
Sun	31			Wed	31			Mon	31			Sat	31	Tue	31			Sun	31		

Tage / Days / Jours		München Munich	Den Haag The Hague La Haye	Berlin
Neujahr - New Year's Day - Nouvel An	01.01.2010	x	x	x
Heilige Drei Könige - Epiphany - Epiphanie	06.01.2010	x		
Karfreitag - Good Friday - Vendredi Saint	02.04.2010	x	x	x
Ostermontag - Easter Monday - Lundi de Pâques	05.04.2010	x	x	x
Nationalfeiertag - National Holiday - Fête nationale	30.04.2010		x	
Tag der Befreiung - Liberation Day - Journée de la Libération	05.05.2010		x	
Christi Himmelfahrt - Ascension Day - Ascension	13.05.2010	x	x	x
Brückentag - Bridging Day - Pont	14.05.2010	x	x	x
Pfingstmontag - Whit Monday - Lundi de Pentecôte	24.05.2010	x	x	x
Fronleichnam - Corpus Christi - Fête-Dieu	03.06.2010	x		
Allerheiligen - All Saints' Day - Toussaint	01.11.2010	x		
Heiliger Abend - Christmas Eve - Vieille de Noël	24.12.2010	x	x	x
Silvester - New Year's Eve - Saint-Sylvestre	31.12.2010	x	x	x