

## EUROPEAN QUALIFYING EXAMINATION 2010

# Paper D

## Part II

This paper comprises:

- \* Client's letter including four (4) questions 2010/DII/EN/1 - 6
- \* Annex: Calendars for 2008, 2009 and 2010 with indication of the days on which at least one of the EPO filing offices is not open for the receipt of documents 2010/DII/EN/7 - 9

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

You are a European patent attorney and this morning you received the following letter

We, KA (Knowledge for All), are a research institution based in Scotland and we are very active in developing new methods, systems and apparatuses used in marine biology and diving.

We have contact with KM (Knowledge is Money), a Swedish research laboratory, which is doing research in a similar field.

On 12 January 2009, we filed at the EPO, without claiming priority, a European patent application EP1 for a new and revolutionary electromagnetic signal which attracts fish and thereby allows divers to photograph them. Such an electromagnetic signal attracts only adult fish, which are the most colourful ones. It works only in coastal regions.

EP1 discloses the structure of the signal as well as a way of producing it using conventional apparatuses and gives examples to prove that this signal really is effective for attracting adult fish. EP1 only discloses the use of the signal for underwater photography. EP1 includes only one claim defining the structure of the new signal, i.e the amplitudes and frequencies of the different components of the signal.

On 20 January 2009, we hosted a public conference attended by KM where we presented a video showing the effectiveness of this signal for attracting adult fish in order to photograph them. However, we did not disclose the characteristics of the signal, but we mentioned the application number EP 09123456 of EP1.

On 11 February 2009, we were very surprised to read on the KM public Internet site that on 10 February 2009, KM had filed at the EPO a European patent application, EPKM, without claiming priority. The content of EPKM was published on the KM public Internet site. The following statement in the description of EPKM shocked us: "The new signal developed by KA and explained in European patent application number EP09123456 (corresponding to EP1) filed on 12 January 2009 allows a new fishing method which permits a better regulation of fish stocks." The only claim of EPKM reads: "Fishing method characterised by use of an electromagnetic signal attracting only adult fish in a coastal region, said signal being emitted by transmitters integrated into a fishing net."

We asked KM for an explanation and they replied that they had the idea of developing such a fishing method. The combination of a fishing net and transmitters is, without doubt, new and inventive.

We also invented a new electronic filter F1 for producing the signal disclosed in EP1, this filter being so small that it can be connected to the standard electronic circuit C of an underwater camera. The new circuit C1, which is constituted by the combination of F1 and C, can still be incorporated into a standard underwater camera.

Then on 1 March 2009 we filed a new European patent application EP2 without claiming priority. The description of EP2 includes the complete description of EP1 as pages 1 to 5 and adds pages 6 to 10, which disclose the new electronic filter F1 on pages 6 to 9 and the new circuit C1 on page 10. We mentioned in the description that the final new circuit C1 is so compact that it can be included in an underwater camera.

EP2 includes the following claims: the structure of the signal as claim 1 (same claim 1 as in EP1), the filter F1 as claim 2 and the circuit C1 as claim 3.

In September 2009, we received the European search report with one document cited as "A" and a positive European Search Opinion for EP1, which is apparently ready for grant.

Also in September 2009, KM received the European search report for EPKM, with the same document cited as "A" and a positive European Search Opinion. The search report and the accompanying opinion are available on KM's public Internet site.

EPKM also appears to be ready for grant.

In November 2009, we received the European search report for EP2. The same "A" document was cited but the accompanying opinion was partly negative because the EPO examiner stated - and, according to our technical department, he was right - that the disclosed circuit C1 could not produce any signal. In fact we had failed to describe an essential and inventive electrical connection in circuit C1 between filter F1 and standard circuit C. According to the examiner, claim 1 and claim 2 are allowable.

We then filed on 12 January 2010 a new European patent application EP3, as usual without claiming priority, by adding to the description of EP2 pages 11 and 12, which describe the essential and inventive electrical connection in C1 between the filter F1 and the standard circuit C. The circuit claim, claim 3, was modified accordingly.

At the beginning of every year, KA makes a report which includes a summary of the research carried out during the previous year and we annex to this report a copy of our most interesting patent application. This year we decided to annex a copy of EP3. While preparing the report, we realised we had forgotten to file pages 6 to 9 of the description of EP3, which concern the new filter F1. The report, however, includes the complete version of EP3 with all pages 1 to 12 of the description as well as the claims.

The report was first made accessible at the end of January 2010 in our public library but nobody has consulted it so far.

We will send the report to our principal sponsors at the end of March 2010.

On 2 February 2010, we transmitted the missing pages 6 to 9 to the EPO in order to correct EP3.

On 19 February 2010, we received a communication according to Rule 56 EPC dated 17 February 2010 notifying us that the filing date of EP3 had been changed to 2 February 2010.

We are not interested in having a patent for a fishing method and we do not want KM or anyone else to have a patent for the fishing method disclosed in EPKM.

- 1) This is our main concern. How can we achieve this objective?
- 2) Keeping our main concern in mind, how can we improve our patent situation in Europe?

Last week we were contacted by Norwayfish (NF), which is one of our most important sponsors.

The only activity of Norwayfish (NF) is operating fish farms in Norway. Since June 2009, Norwayfish (NF) have been using for their fish farm nets a material M particularly well adapted for resisting the storms of the Norwegian Sea. Each farm of Norwayfish (NF) manufactures its own nets locally.

Swedishfish (SF) is a Swedish firm, a competitor of Norwayfish (NF). All fish farms of Swedishfish (SF) are located in Norway.

Swedishfish (SF) has developed a fish farm net using the same material M.

Each farm of Swedishfish (SF) manufactures its own nets locally.

Swedishfish (SF) filed a Swedish patent application, S1, in October 2007 and a European patent application, EPF, validly claiming the priority of S1, in February 2008. EPF was granted without amendment and the mention of the grant of the patent was published on 9 September 2009. The patent has been duly validated in all EPC contracting states.

EPF discloses and claims fish farm nets made of material M.

Norwayfish (NF) have asked us if we could help them because they are being sued for infringement of EPF in Norway.

We have looked into the matter and found the following:

We have developed together with a Japanese research institution JU the same technology as Swedishfish (SF).

We filed a PCT application (PCTJU) and an EP application (EP4) with JU as co-applicant for both applications.

The two applications were filed on the same day in May 2007, at the EPO for EP4 and at the Japan Patent Office for PCTJU, both without claiming priority, and both designating all possible states.

Both applications were published in November 2008.

JU was in charge of the prosecution of PCTJU filed in Japanese and we were responsible for prosecuting EP4.

The content of the two applications was almost the same, disclosing and claiming fish farm nets made of materials belonging to class G.

The description of PCTJU was more detailed and described the use of the known material M, which belongs to class G, for making fish farm nets.

JU informed us in February 2010 that, as they were no longer interested in this kind of technology, they would be happy to transfer their patent rights to us if we wanted to continue alone with the prosecution of the patent applications.

We have not replied to this offer.

We have seen from the European Patent Register that the PCTJU application was deemed to be withdrawn at the EPO according to a communication dated 4 January 2010 because none of the requirements for entering the regional phase was fulfilled.

The search report of EPF cites only EP4, and during the examination of EPF before the EPO only EP4 was mentioned by the examiner.

Nevertheless, for reasons that we do not understand, EPF was granted.

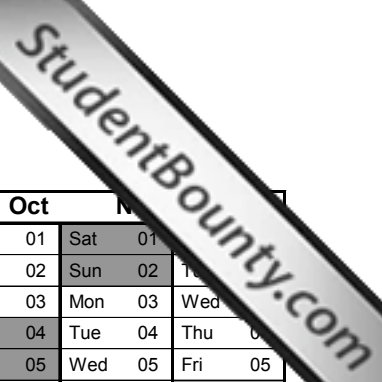
Last week we also received a communication according to Rule 71(3) EPC for EP4.

3) Can we help Norwayfish (NF) in their conflict with Swedishfish (SF)?

4) Can patent rights be used against Swedishfish (SF)?

Annex 1

2008



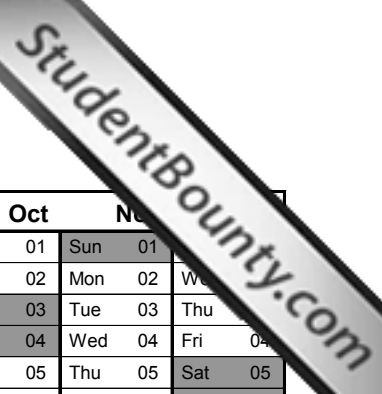
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Tage / Days / Jours		München Munich	Den Haag The Hague La Haye	Berlin
Neujahr - New Year's Day - Nouvel An	01.01.2008	x	x	x
Karfreitag - Good Friday - Vendredi Saint	21.03.2008	x	x	x
Ostermontag - Easter Monday - Lundi de Pâques	24.03.2008	x	x	x
Nationalfeiertag - 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

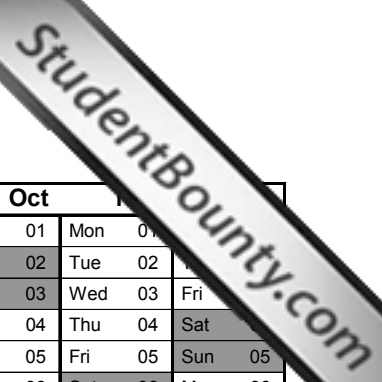


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Tage / Days / Jours		München Munich	Den Haag The Hague La Haye	Berlin
Neujahr - New Year's Day - Nouvel An	01.01.2009	x	x	x
Brückentag - Bridging Day - Pont	02.01.2009	x	x	x
Heilige Drei Könige - Epiphany - Epiphanie	06.01.2009	x		
Karfreitag - Good 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



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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