

EUROPEAN QUALIFYING EXAMINATION 2011

Paper D

Part I

This paper comprises:

- * Questions 1 - 8 2011/DI/EN/1 - 5
 - Question 1 : 4 marks
 - Question 2 : 6 marks
 - Question 3 : 5 marks
 - Question 4 : 5 marks
 - Question 5 : 3 marks
 - Question 6 : 6 marks
 - Question 7 : 4 marks
 - Question 8 : 7 marks

TOTAL: 40 MARKS

- * Annexes: calendars for 2009, 2010 and 2011 with 2011/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 marks)

Yesterday, Company A received a warning letter from Company B requiring them to stop selling their product because it falls within the extent of protection of B's European patent. From a file inspection via the European Patent Register, Company A learns that the mention of grant was published on 28.04.2010 and that B's competitor C has filed a notice of opposition. The opposition proceedings are still pending.

Further, Company A knows of novelty destroying prior art which so far has not been drawn to the attention of the EPO.

What are Company A's options to have the patent revoked by the EPO?

QUESTION 2

(6 marks)

Your client validly filed a European application EP1 as a first filing containing independent apparatus claims 1, 2 and 3. Your client received from the EPO a first invitation dated 09.04.2010 to indicate which of the independent claims are to be searched because independent claims 1, 2 and 3 do not comply with Rule 43(2) EPC. All claims combine to form a single general inventive concept. Your client did not reply to the first invitation.

Your client received, with the European search opinion, a second invitation to correct deficiencies in the application. The publication of the European search report for EP1 was mentioned in the European patent bulletin on 25.08.2010. Your client did not reply to the second invitation. The request for examination has not been filed.

- a) When did the time limit for replying to each of the first and second invitations expire? Is it still possible to reply to these invitations?

- b) Your client intends to amend application EP1 so that examination will be carried out on the basis of original claim 3. What do you advise your client in order to obtain protection for the subject matter of claim 3?

QUESTION 3

(5 marks)

Your client filed an international patent application PCT1 on 01.12.2010, a few days before he presented his invention at a conference. PCT1 was filed using the latest version of form PCT/RO/101 with the EPO as receiving office claiming priority from a Belgian patent application validly filed on 01.12.2009. The Belgian as well as the international patent application were both filed in French.

The last four pages of the application documents of PCT1 containing the claims were not transmitted due to an error of your client. The EPO sent a letter dated 15.12.2010 informing your client that the requirements of Article 11(1) PCT for according a filing date are not met. No further communication was sent by the EPO. Your client did not react to the letter of the EPO.

Today 01.03.2011 your client asks you whether 01.12.2010 can be saved as filing date of PCT1.

QUESTION 4

(5 marks)

Spanish proprietor P, with residence in the UK, has a European patent EP which contains only two claims 1 and 2. The mention of grant of EP was published on 02.06.2010. Your client C has informed P that the subject-matter of claims 1 and 2 of EP is not new in view of a publication X.

In reaction, on 02.12.2010, P requested limitation at the EPO of EP to the subject-matter of granted claim 2. C still thinks that the document X is novelty destroying for the subject-matter of granted claim 2.

a) What are the fees for this limitation?

b) C has prepared third party observations regarding the lack of novelty of the subject-matter of granted claim 2 and asks you for advice.

QUESTION 5

(3 marks)

Today you received a fax from your client, informing you that he wants to have a European patent on subject-matter Y. Moreover, he informed you that he disclosed Y at a symposium today and that he had filed in October 2009 an Icelandic patent application IS1 describing Y. He also informed you that he had withdrawn IS1 well before publication due to a financial crisis. He did not provide you with a copy of IS1 but told you the application number of IS1.

Your client cannot be contacted again until next week.

Is it possible to obtain protection for subject-matter Y via a European patent?

QUESTION 6

(6 marks)

A US applicant duly filed an international application containing 17 claims with the USPTO in English on 02.07.2009 claiming priority from a US national application filed on 03.07.2008. The international application was searched by the USPTO and published together with its search report in January 2010. Today 01.03.2011 the applicant calls you and wants to enter the European phase without any amendments.

What should be done and when, and which fees have to be paid?

QUESTION 7

(4 marks)

Patent proprietor P has a European patent EP with a claim A for the contracting states DE and FR and a claim B for the contracting states AT and BE. Claim A comprises all features of claim B and an additional feature X. Opponent O duly filed an opposition against the patent in its entirety on the grounds of lack of novelty. The patent was revoked because the subject matter of claim B was considered to be not novel. During appeal proceedings, appellant P requests the patent to be maintained with claim A for all the states DE, FR, AT and BE. Respondent O only notices now that feature X was not originally disclosed and raises a corresponding objection.

Assuming that feature X was not originally disclosed, can the European patent including claim A be maintained in proceedings before the EPO?

QUESTION 8

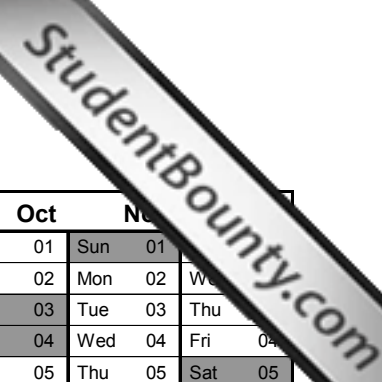
(7 marks)

Your client filed for his invention IN1 a French patent application FR1 on 01.03.2010 and a European application EP1 on 22.10.2010. An article published on 12.03.2010 disclosed invention IN1. Today 01.03.2011 your client informs you that he received a communication from the EPO dated 04.01.2011 inviting him to file a missing drawing. This missing drawing relates to prior art which is not relevant for invention IN1. He also informs you that for EP1, instead of claiming priority from FR1, he accidentally claimed priority from another French patent application FR2 filed on 22.10.2009 and disclosing another invention IN2.

The applicant does not want to file a new EP application and asks you for advice.

Annex 1

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
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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 2

2010

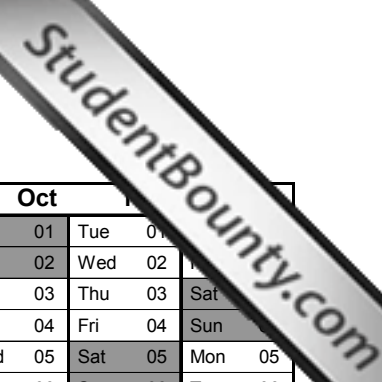
StudentBounty.com

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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

Annex 3

2011



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Karfreitag - Good Friday - Vendredi Saint	22.04.2011	x	x	x
Ostermontag - Easter Monday - Lundi de Pâques	25.04.2011	x	x	x
Tag der Befreiung - Liberation Day - Journée de la Libération	05.05.2011		x	
Christi Himmelfahrt - Ascension Day - Ascension	02.06.2011	x	x	x
Brückentag - Bridging Day - Pont	03.06.2011	x	x	x
Pfingstmontag - Whit Monday - Lundi de Pentecôte	13.06.2011	x	x	x
Fronleichnam - Corpus Christi - Fête-Dieu	23.06.2011	x		
Mariä Himmelfahrt - Assumption Day - Assomption	15.08.2011	x		
Tag der Deutschen Einheit - Day of German Unity - Fête Nationale	03.10.2011	x		x
Allerheiligen - All Saints' Day - Toussaint	01.11.2011	x		
2. Weihnachtstag - Boxing Day - Lendemain de Noël	26.12.2011	x	x	x