

EUROPEAN QUALIFYING EXAMINATION 2012

Paper D

Part I

This Paper comprises:

- * Questions 1 - 8 2012/DI/EN/1-5
 - Question 1 : 5 marks
 - Question 2 : 6 marks
 - Question 3 : 5 marks
 - Question 4 : 4 marks
 - Question 5 : 5 marks
 - Question 6 : 6 marks
 - Question 7 : 4 marks
 - Question 8 : 5 marks

TOTAL: 40 MARKS

- * Annexes: calendars for 2010, 2011 and 2012 with indication of the days on which at least one of the EPO filing offices is not open for the receipt of documents 2012/DI/EN/6-8

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

QUESTION 1

(5 MARKS)

On 29 December 2011 you received a decision dated 27 December 2011 refusing your European patent application.

The last sentence of the decision reads as follows:

"As all the features of the independent claim are known from the prior art document D1, the application is refused for lack of novelty, Art. 56 EPC."

On 26 January 2012 you received a correction of the decision according to Rule 140 EPC for the same application. The correction is dated 24 January 2012. Only the last sentence was changed to "As all the features of the independent claim are known from the prior art document D1, the application is refused for lack of novelty, Art. 54 EPC".

Your client has not yet decided whether to file an appeal, but intends to take this decision in the next few weeks. However, he will call you this morning to discuss the further procedure.

What will you advise your client?



QUESTION 2

(6 MARKS)

For European patent application EP1, filed in English, the first communication from the examining division under Article 94(3) and Rule 71(1), (2) EPC dated 13 December 2007 raised only a lack of clarity objection. On 14 December 2009 a divisional application DIV1 of EP1 was filed in the same language as EP1 at the EPO in Munich. On 30 September 2010 a further divisional application DIV2 of EP1 was filed in the same language as EP1 at the EPO in Berlin.

The partial search report for DIV1 dated 6 October 2011 contained a statement regarding lack of unity. However, no additional search fee was paid.

EP1 and DIV2 were withdrawn on 28 January 2011.

- a) What were the filing requirements for divisional applications DIV1 and DIV2?

- b) Is it still possible to validly file further divisional applications?



QUESTION 3

(5 MARKS)

On 5 October 2010 your Spanish client filed a PCT application in Spanish with the Spanish Patent and Trade Mark Office (SPTO). No priority was claimed. Due to a lack of unity objection, which the client accepts, only the first invention was searched by the SPTO. However, your client wants a search to be carried out by the EPO on the second invention before deciding on entry into the national/regional phase but does not want to file a new application.

- a) Is this possible?
- b) If so, what steps have to be taken?

QUESTION 4

(4 MARKS)

Company X filed a draft of a scientific paper as a European patent application EP-X at the EPO. The draft describes compositions of the class A. The EPO accorded to application EP-X a date of filing of 20 December 2009. On 15 February 2010, company X filed, for EP-X, a claim directed to product A1, which was not described in the draft paper.

On 17 November 2010 company X filed an international application PCT1 at the USPTO with the description of EP-X and the same claim as above, claiming priority from EP-X. Company X received from the USPTO an international search report indicating only a single document, which discloses product A1. This document was made available to the public in March 2010.

- a) Is it possible to obtain valid patent protection via the claim directed to product A1 if PCT1 enters the European phase?
- b) How would the situation be different for PCT1 if the draft paper had disclosed A1?



QUESTION 5

(5 MARKS)

International application PCT-CN was filed in Chinese in September 2010 with the Chinese State Intellectual Property Office (SIPO). In March 2011 the applicant received the international search report from SIPO. In May 2011 the applicant filed with the International Bureau amended claims together with a brief statement explaining the amendments. The application will be published next week.

- a) Which parts of the publication will be in what language(s)?
- b) Will a French translation of the abstract be publicly available from WIPO?

QUESTION 6

(6 MARKS)

On 28 October 2010 your client filed an Italian application IT1 for invention Inv1 and an Italian application IT2 for invention Inv2. Inv1 and Inv2 are unitary. On 28 October 2011 your client duly filed a European application EP1 describing and claiming inventions Inv1 and Inv2. EP1 claims the priority of IT1 only. Your client has discovered a document D published on 8 August 2011 disclosing Inv1 and Inv2.

Your client wants to use EP1 to obtain Europe-wide protection for both Inv1 and Inv2.

What do you advise your client?



QUESTION 7

(4 MARKS)

Your client has developed the following way of diagnosing an illness:

- a) Carrying out a known method of biopsy by a medical practitioner to extract a liver tissue sample from a patient;
- b) carrying out a novel and inventive method for diagnosing the illness on the basis of the tissue sample in an analysing liquid.

Your client has informed you that the way in which the tissue sample is obtained is not an essential feature of his development.

Your client wants you to file a European patent application. Discuss the patentability of his development according to the EPC.

QUESTION 8

(5 MARKS)

European patent application EP1 was published on 10 March 2010. In reply to a communication of the examining division, the applicant filed amended claims containing improved subject-matter in June 2011. This improved subject-matter is new and inventive over the originally disclosed subject-matter, and, in itself, is sufficiently disclosed according to Art. 83 EPC. On 9 December 2011 the applicant filed a second European patent application EP2 describing and claiming the improved subject-matter.

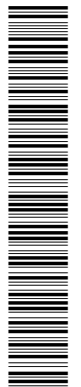
Can the applicant obtain valid protection for the improved subject-matter via EP1 or EP2?



Annex 1

2010

	Jan	Feb	Mar	Apr	May	Jun	Jul	Aug	Sep	Oct	Nov																												
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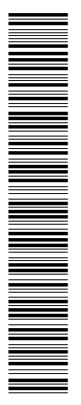


Tage / Days / Jours		München Munich	Den Haag The Hague La Haye	Berlin
Neujahr - New Year's Day - Nouvel An	01.01.2010	x	x	x
Heilige Drei Könige - Epiphany - Epiphanie	06.01.2010	x		
Karfreitag - Good Friday - Vendredi Saint	02.04.2010	x	x	x
Ostermontag - Easter Monday - Lundi de Pâques	05.04.2010	x	x	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 - Veille de Noël	24.12.2010	x	x	x
Silvester - New Year's Eve - Saint-Sylvestre	31.12.2010	x	x	x

Annex 2

2011

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Tage / Days / Jours		München Munich	Den Haag The Hague La Haye	Berlin
Heilige Drei Könige - Epiphany - Epiphanie	06.01.2011	x		
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

Annex 3

2012

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Tage / Days / Jours		München Munich	Den Haag The Hague La Haye	Berlin
Heilige Drei Könige - Epiphany - Epiphanie	06.01.2012	x		
Karfreitag - Good Friday - Vendredi Saint	06.04.2012	x	x	x
Ostermontag - Easter Monday - Lundi de Pâques	09.04.2012	x	x	x
Nationalfeiertag - National Holiday - Fête Nationale	30.04.2012		x	
Maifeiertag - Labour Day - Fête du Travail	01.05.2012	x	x	x
Christi Himmelfahrt - Ascension Day - Ascension	17.05.2012	x	x	x
Pfingstmontag - Whit Monday - Lundi de Pentecôte	28.05.2012	x	x	x
Fronleichnam - Corpus Christi - Fête-Dieu	07.06.2012	x		
Mariä Himmelfahrt - Assumption Day - Assomption	15.08.2012	x		
Tag der Deutschen Einheit - Day of German Unity - Fête Nationale	03.10.2012	x		x
Allerheiligen - All Saints' Day - Toussaint	01.11.2012	x		
Heiliger Abend - Christmas Eve - Veille de Noël	24.12.2012	x	x	x
1. Weihnachtstag - Christmas Day - Jour de Noël	25.12.2012	x	x	x
2. Weihnachtstag - Boxing Day - Lendemain de Noël	26.12.2012	x	x	x
Silvester - New Year's Eve - Saint-Sylvestre	31.12.2012	x	x	x

