

EUROPEAN QUALIFYING EXAMINATION 2013

Paper D

This Paper comprises:

Part I (40 marks)

* Questions 1 - 6

- Question 1 : 5 marks
- Question 2 : 8 marks
- Question 3 : 6 marks
- Question 4 : 6 marks
- Question 5 : 8 marks
- Question 6 : 7 marks

2013/D/EN/1-5

Part II (60 marks)

* Questions I - III

2013/D/EN/6-10

TOTAL: 100 MARKS

* Annexes: calendars for 2011, 2012 and 2013 with indication of the days on which at least one of the EPO filing offices is not open for the receipt of documents

2013/D/EN/11-13

Part I : Legal Questions

QUESTION 1

(5 MARKS)

Applicant A filed a US patent application US1 disclosing a new and inventive compound X and the only possible process to obtain X. The process to obtain X is not obvious in view of the prior art. US1 was withdrawn before publication. Within the priority period of US1, a European patent application EP1 claiming priority of US1 was filed together with a certified copy of US1. EP1 claims and discloses the compound X. However, for the process, the description of EP1 only contains a reference to a specific passage of US1 disclosing the process in detail. EP1 was granted as filed.

Competitor B filed an admissible notice of opposition based solely on the ground that the invention in EP1 is insufficiently disclosed (Art. 100(b) EPC) because EP1 fails to disclose any process to produce X.

Applicant A asks you whether the patent will be revoked on this ground.



QUESTION 2

(8 MARKS)

For each of the European patent applications EP1 and EP2 the examining division issued a first communication according to Article 94(3) EPC bearing the date of 1 February 2011.

During a telephone call with the primary examiner on 4 November 2011 a lack of unity objection was raised for the first time against EP2. The corresponding minutes were issued dated 18 November 2011 setting a time limit for response. On 1 February 2013 the applicant tried to file a divisional application DIV1 relating to EP1. However, in spite of all due care taken, the application documents of DIV1 failed to arrive at the EPO. The applicant learned about this failure on 20 February 2013. EP1 and EP2 are still pending today.

- A) Can DIV1 still be validly filed?
- B) Can a divisional application DIV2 relating to EP2 be validly filed?



QUESTION 3

(6 MARKS)

In March 2008 a European patent application was filed in French. A European patent was granted and is in force in Austria, Switzerland and The Netherlands.

The patent was opposed and the opposition division issued an interlocutory decision indicating that the patent with amended description and claims meets the requirements of the EPC. No appeal was filed.

For continued validity, what translations have to be filed and what are the types of fees and their amounts, which have to be paid in 2013:

- a) before the EPO?
- b) before the national offices of Austria, Switzerland and The Netherlands?

QUESTION 4

(6 MARKS)

The mention of the grant of the European Patent EP1 was published in the European Patent Bulletin on 21 March 2012. An opposition was filed on 20 December 2012 based solely on the ground of lack of novelty in view of an unspecified document.

On 28 December 2012 the opponent identified the document and supplied a copy of it. The document is prima facie highly relevant for novelty of all claims of EP1.

Can EP1 be revoked based on the document before the EPO?



QUESTION 5

(8 MARKS)

A British company A intends to file together with Mr. Surat as joint applicants a PCT application at the Patent Office of India. Mr. Surat is a national and resident of India.

- a) As no agent is required before the Patent Office of India acting as receiving Office, it is decided that Mr. Surat should represent the applicants during the international phase. What options are there to achieve this and what steps must be taken to this end?
- b) The applicants select the EPO as International Searching Authority (ISA) and International Preliminary Examining Authority (IPEA). For the procedure before the EPO as IPEA under Chapter II PCT the applicants decide to seek professional help.
 - b1) Can they appoint an Indian agent who has the right to practice before the Patent Office of India?
 - b2) Can they appoint a European professional representative?
- c) For the procedure in the European phase the applicants consider continuing without professional help. Can Mr. Wilson, employee of company A, act as a common representative before the EPO?



QUESTION 6

(7 MARKS)

Your client's international application PCT-A is pending before the EPO as ISA. PCT-A contains independent claims 1 and 2. The EPO sent an invitation dated 11 January 2013 to pay a further search fee in respect of the invention of claim 2. Your client duly sent a debit order for the further search fee for claim 2. On 25 January 2013, the EPO notified your client by telefax of a shortfall in his deposit account. Your client replenished the deposit account with € 3000 on 22 February 2013. No further actions were taken by today.

Will the international search report cover both inventions?



Part II : Legal Opinion

[001] You receive today, 26 February 2013, the following fax from Alberto Gusto, owner of "Buona Cucina SpA", an Italian manufacturer of frying pans. The only factory of Buona Cucina is located in Italy.

[002] "My firm is in need of urgent advice and wishes to appoint you as its representative. I would like to meet you on 12 March 2013 to discuss my firm's situation but in the meantime ask you to consider the following:

[003] In the summer of 2010, we were approached by the private inventor Dr Serrano, who had discovered that a frying pan with three-dimensional (3D) protrusions on its inner surface heats up the food much faster than a conventional frying pan with a flat inner surface.

Under a confidentiality agreement, Dr Serrano suggested that we use pyramidal protrusions on the inner surface of our next generation of frying pans. Pyramidal protrusions are a particularly advantageous sub-type of three-dimensional protrusions, since pyramidal protrusions surprisingly also reduce vitamin loss in fried food.

In December 2010, Dr Serrano became our technical advisor, and sold us the rights to all the past and future results of his research on all types of three-dimensional protrusions, including the right to file patent applications. Dr Serrano committed himself to cooperating with us in all patent matters.



[004] When we performed a prior art search on frying pans with protrusions in January 2011, we only found a European patent application of the German company "Schnell-Koch GmbH". Schnell-Koch's only factory is located in Germany. Schnell-Koch's application EP-3D was filed in January 2008 without a claim to priority. The description of EP-3D states that three-dimensional (3D) protrusions on the inner surface of a frying pan will heat up the food much faster than a pan with a flat inner surface, but does not mention any particular shape of protrusions. EP-3D was published in July 2009 with a search report citing only A-documents. The single independent apparatus claim of EP-3D is directed to a frying pan characterised in that its inner surface will heat up the food much faster than a flat surface.

[005] Since EP-3D does not mention pyramidal protrusions at all, we proceeded with the development of our new frying pans. We filed an Italian patent application IT-PYR on 19 August 2011. IT-PYR, which was published in February 2013, contains a single claim directed to a frying pan with pyramidal protrusions on its inner surface. The description of IT-PYR states that pyramidal protrusions are particularly advantageous because they reduce vitamin loss in fried food.

[006] At the "Hot Pans 2013" trade fair in Bologna last January, I attended a public presentation by Schnell-Koch, during which they showed frying pans with cubic protrusions, and frying pans with hemispherical protrusions. Schnell-Koch stated that the frying pans with hemispherical protrusions were protected by their European patent EP-HEMI and announced that they would soon start selling these frying pans.



[007] We found EP-HEMI when we performed another prior art search after the trade fair. EP-HEMI was filed by Schnell-Koch on 5 April 2010 and published on 15 December 2010. EP-HEMI claims the priority of German patent application DE-HEMI filed by Schnell-Koch on 10 June 2009. EP-HEMI is identical to DE-HEMI, which is deemed withdrawn for non-payment of the filing fee. EP-HEMI contains an independent apparatus claim directed to a frying pan with 3D protrusions, and a dependent claim directed to a frying pan with hemispherical protrusions. The description of EP-HEMI states that 3D protrusions will heat up the food much faster than a conventional frying pan with a flat inner surface. In addition to that, the description of EP-HEMI states that hemispherical protrusions are a further particularly advantageous embodiment of 3D protrusions. EP-HEMI also states that hemispherical protrusions have the surprising advantage that they can be cleaned easily and do not become encrusted with food residues. When we checked the legal status of EP-HEMI, we could see that the mention of the grant of EP-HEMI was published on 2 May 2012, and that EP-HEMI was granted in unamended form. We could also see that EP-HEMI had so far only been validated in Italy.

[008] During that prior art search after the trade fair, we also checked the legal status of EP-3D. We could see that designation fees for EP-3D were paid only for Germany and Italy. Further, we could see that a first communication by the examining division was issued in July 2010 for EP-3D. The communication stated that the claim did not meet the requirements of Article 84 EPC, since it attempted to define the invention by a result to be achieved. In the written decision by the examining division dated 26 March 2012, EP-3D was refused for lack of clarity. In addition to that, a divisional application DIVI-3D, relating to EP-3D, was filed by Schnell-Koch on 1 June 2012. DIVI-3D is identical to EP-3D, but contains an additional statement in the description, according to which cubic protrusions on the inner surface of frying pans render the fried food much crispier. DIVI-3D was published on 27 September 2012 without a search report.



[009] Schnell-Koch's frying pans with protrusions on the inner surface will compete with our new frying pans with pyramidal protrusions. This situation is not acceptable for us, since we will soon begin to sell our new frying pans. In order to get rid of EP-HEMI, we therefore filed an opposition against EP-HEMI. We paid the opposition fee in due time. In the notice of opposition, we put forward that the independent claim of EP-HEMI lacked novelty over Schnell-Koch's earlier patent application EP-3D, while the dependent claim did not involve an inventive step over EP-3D. We drafted the opposition in Italian, and sent it by registered mail to the EPO, where it was received on 1 February 2013.

[010] With regard to DIVI-3D, we have not yet decided what to do.

[011] I called Dr Serrano last week to inform him about Schnell-Koch's frying pans, the above-mentioned patents and patent applications, and about our opposition. Dr Serrano was very surprised since he had sent a letter to Schnell-Koch in November 2007. In that letter, Dr Serrano offered to Schnell-Koch the concept of 3D protrusions on the inner surface of frying pans, but did not mention any particular shape of the protrusions. Dr Serrano was particularly upset because the entire description of EP-3D was taken from his letter. Dr Serrano had also sent a second letter to Schnell-Koch in March 2008. In that second letter, Dr Serrano stated that cubic protrusions on the inner surface of frying pans render the fried food much crispier. Both letters stated that Dr Serrano was planning to file patent applications for their contents. Dr Serrano also read out the letter of reply from Schnell-Koch of May 2008, in which they expressed their lack of interest in these proposals. Dr Serrano provided me with copies of the letters, and gave me convincing evidence that Schnell-Koch are under an on-going obligation of confidentiality.



[012] There are no other relevant patents, patent applications or published documents than those mentioned in this fax. Please take this fax as being authority to act in the name of our company to take any action that you deem necessary in order to preserve our position until our meeting on 12 March 2013!

[013] As preparation for our meeting, I would like to ask you to:

- I) **Analyse the patent situation for frying pans with a) 3D protrusions, and in particular with b) pyramidal, c) hemispherical and d) cubic protrusions;**
- II) **Analyse the status of our opposition against EP-HEMI. Discuss what can be achieved by our opposition, and advise on any necessary actions.**

[014] We understand that frying pans with hemispherical or cubic protrusions might have certain commercial advantages over our frying pans with pyramidal protrusions. We would like to be free to sell frying pans with pyramidal, hemispherical, or in particular cubic protrusions in our sole markets Germany and Italy.

III a) Are we free to act in our two markets?

III b) Can we prevent our competitors from selling such pans in our two markets?

III c) Can either of these positions (IIIa and IIIb) be improved? If so, how?

[015] A confirmation copy of this fax together with copies of our notice of opposition, all patents, patent applications and documents mentioned in this fax, and additionally including an authorisation by our company, was sent to you with delivery guarantee for this afternoon.

Yours sincerely,

Alberto Gusto



Annex 1

2011

Jan	Feb	Mar	Apr	May	Jun	Jul	Aug	Sep	Oct	Nov	
Sat 01	Tue 01	Tue 01	Fri 01	Sun 01	Wed 01	Fri 01	Mon 01	Thu 01	Sat 01	Tue 01	Thu 01
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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 2

2012

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Sun 01	Wed 01	Thu 01	Sun 01	Tue 01	Fri 01	Sun 01	Wed 01	Sat 01	Mon 01	Thu 01	Sat
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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
Brückentag - Bridging Day - Pont	27.12.2012	x	x	x
Brückentag - Bridging Day - Pont	28.12.2012	x	x	x
Silvester - New Year's Eve - Saint-Sylvestre	31.12.2012	x	x	x

Annex 3

2013

Jan	Feb	Mar	Apr	May	Jun	Jul	Aug	Sep	Oct	Nov	
Tue 01	Fri 01	Fri 01	Mon 01	Wed 01	Sat 01	Mon 01	Thu 01	Sun 01	Tue 01	Fri 01	Sun 01
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Tage / Days / Jours		München Munich	Den Haag The Hague La Haye	Berlin
Neujahr - New Year's Day - Nouvel An	01.01.2013	x	x	x
Karfreitag - Good Friday - Vendredi Saint	29.03.2013	x	x	x
Ostermontag - Easter Monday - Lundi de Pâques	01.04.2013	x	x	x
Nationalfeiertag - National Holiday - Fête nationale	30.04.2013		x	
Maifeiertag - Labour Day - Fête du Travail	01.05.2013	x	x	x
Christi Himmelfahrt - Ascension Day - Ascension	09.05.2013	x	x	x
Pfingstmontag - Whit Monday - Lundi de Pentecôte	20.05.2013	x	x	x
Fronleichnam - Corpus Christi - Fête-Dieu	30.05.2013	x		
Mariä Himmelfahrt - Assumption Day - Assomption	15.08.2013	x		
Tag der Deutschen Einheit - Day of German Unity - Fête Nationale	03.10.2013	x		x
Allerheiligen - All Saints' Day - Toussaint	01.11.2013	x		
Heiliger Abend - Christmas Eve - Veille de Noël	24.12.2013	x	x	x
1. Weihnachtstag - Christmas Day - Jour de Noël	25.12.2013	x	x	x
2. Weihnachtstag - Boxing Day - Lendemain de Noël	26.12.2013	x	x	x
Silvester - New Year's Eve - Saint-Sylvestre	31.12.2013	x	x	x

