

EUROPEAN QUALIFYING EXAMINATION 1990

PAPER D

This paper comprises:

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| • Part I - Questions 1-12 | 90/D/e/2-6 |
| • Part II - Legal Advice | 90/D/e/7-11 |
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INSTRUCTIONS TO CANDIDATES

Paper D comprises:

- 12 questions, all to be answered - no choice for candidates;
- an inquiry from a client requiring an answer in the form of a legal opinion.

Half the marks available are awarded for the 12 questions, the other half for the legal advice.

The answers to questions 1 to 12 should be brief and to the point and the candidate must cite any Articles, Rules or other legal basis relevant to his answer.

In the legal opinion the candidate should demonstrate his professional ability to master a complex industrial property law situation. He must explain any legal consequences of the situation postulated and preferably cite any Articles, Rules or other legal basis relevant to his answer.

PART I

Question 1

Where must the international application be filed if the applicant chooses the EPO as receiving Office?

Question 2

The joint applicants of an international application filed with the Swiss Patent Office as receiving Office make a demand for international preliminary examination with the EPO before expiry of the 19-month period from the priority date. The applicants are a Swiss national resident in Switzerland and a German national resident in Germany.

Can the EPO act as an International Preliminary Examining Authority? Please substantiate your answer.

Question 3

The Search Division informs the applicant in accordance with Rule 46(1) EPC that the application contains 3 inventions, and that with respect to the second and third invention a further search fee has to be paid for each of them if the European Search report is to cover these inventions. A further search fee is only paid for the second invention.

In the first communication from the Examining Division the objection of non-unity is maintained in respect of the three inventions.

What must be done to obtain the desired protection in the following cases:-

(a) The applicant decides that he only wishes to continue with invention two as the only practical embodiment and wishes to abandon the claims for inventions one and three.

(b) The applicant wishes to obtain protection for all three inventions.

Question 4

By a communication pursuant to Rule 51(4) EPC dated 24.01.1990 the Examining Division informed the representative of the text in which it intended to grant a European patent and requested him to indicate, within a period of 4 months, his approval of the text notified.

(a) What is the date of expiry of the period?

(b) In case he can not respond in due time, which measures may be taken by the representative, on which grounds and until which date, to avoid refusal of the application?

Question 5

An applicant files a European patent application by mail with the EPO, claiming priority from an application filed with the UK patent office.

A few days later the applicant is informed that the envelope containing the European patent application had been damaged, and only the request for grant form, deposit account debit order, designation of inventor and priority document have been received on the last day of the priority year.

What is the legal position? What actions would you immediately take to minimise loss of rights?

Question 6

Applicant A files during the examination proceedings of his application an additional independent claim having a broader scope than the main claim of the EP application as filed. The European patent is granted including the original claims and the added claim.

Opponent B files an admissible opposition on the grounds that the claimed subject matter is not patentable within the terms of Article 56 EPC. The Opposition Division considers that the claimed subject matter is patentable under Article 56 EPC, however the added claim contains subject matter which extends beyond the content of the application as filed; this latter issue has never been raised by the opponent during the opposition proceedings.

What will the Opposition Division do and on what legal basis?

Question 7

An applicant failed to comply, within the three-month period set by the Examining Division, to the invitations set forth in a communication pursuant to Rule 51(6) EPC.

- (a) What are the consequences of such failure?
- (b) Name the necessary steps to be taken as a remedy to said failure.
- (c) What is the time limit to take such steps?

Question 8

You represent a firm on whose behalf you have filed an opposition at the EPO against a European patent. A date has been fixed for oral proceedings before the Opposition Division. As the date approaches you learn that the firm has gone bankrupt. The receiver sends you a fresh authorisation signed by him and informs you that he is unable at the moment to brief you for the oral proceedings. He asks you to apply to the EPO for proceedings to be interrupted because of the bankruptcy or to take whatever other action is necessary to safeguard the firm's rights. What do you do?

Question 9

Eight States, including the United Kingdom, have been designated in a request for grant form for a European patent. The designation fee for the United Kingdom has been paid. On 02.01.1990, after the application has been published, the representative informs the EPO that the applicant does not wish to proceed with the designation of the United Kingdom and accordingly requests that it be irrevocably withdrawn. One month later the representative telexes the Office to say that the letter of 02.01.1990 was a mistake and requests that it be disregarded.

Under what provision and in what circumstances could the Office grant the request?

Question 10

The European Patent Bulletin mentioned on 04.07.1990, a Wednesday, the publication of the search report on A's European patent application for which a written request for examination had been submitted.

A gives his bank in France a credit transfer order for the payment of the examination fee on 26.12.1990, but because of the year-end holidays the EPO's account is not credited until 07.01.1991.

What are the consequences?

Question 11

A, a Finnish citizen resident in Sweden, files a Swedish patent application in Swedish on 05.01.1990. On 12.06.1990, after trials involving disclosure and in view of the fact that a licensing agreement has been signed, he files an identical European patent application, claiming priority, with the Swedish Patent Office which reaches the EPO in time. He omits to furnish a translation into an official language of the EPO.

What will happen?

Question 12

In opposition proceedings the sole opponent files a new citation. The patent proprietor responds by requesting the maintenance of his patent in limited form. The Opposition Division issues a communication to that effect under Rule 58(4) EPC. The opponent states that he is unable to agree. Shortly thereafter he withdraws the opposition.

What should the Opposition Division do and why?

1989

January						February					March					
Wk.	1	2	3	4	5	5	6	7	8	9	9	10	11	12	13	
M		2	9	16	23	30		6	13	20	27		6	13	20	27
T		3	10	17	24	31		7	14	21	28		7	14	21	28
W		4	11	18	25		1	8	15	22		1	8	15	22	29
T		5	12	19	26		2	9	16	23		2	9	16	23	30
F		6	13	20	27		3	10	17	24		3	10	17	24	31
S		7	14	21	28		4	11	18	25		4	11	18	25	
S	1	8	15	22	29		5	12	19	26		5	12	19	26	

Notice of the President of the European Patent Office dated 21 October 1988 concerning days on which at least one of the EPO filing offices is not open for the receipt of documents during 1989

	April					May					June				
Wk.	13	14	15	16	17	18	19	20	21	22	22	23	24	25	26
M		3	10	17	24	1	8	15	22	29		5	12	19	26
T		4	11	18	25	2	9	16	23	30		6	13	20	27
W		5	12	19	26	3	10	17	24	31		7	14	21	28
T		6	13	20	27	4	11	18	25		1	8	15	22	29
F		7	14	21	28	5	12	19	26		2	9	16	23	30
S	1	8	15	22	29	6	13	20	27		3	10	17	24	
S	2	9	16	23	30	7	14	21	28		4	11	18	25	

1. Under Rule 85(1) EPC time limits expiring on a day on which one of the filing offices of the EPO is not open for receipt of documents are extended until the first day thereafter on which all the filing offices are open for receipt of documents and on which ordinary mail is delivered.

	July						August					September				
Wk.	26	27	28	29	30	31	31	32	33	34	35	35	36	37	38	39
M		3	10	17	24	31		7	14	21	28		4	11	18	25
T		4	11	18	25		1	8	15	22	29		5	12	19	26
W		5	12	19	26		2	9	16	23	30		6	13	20	27
T		6	13	20	27		3	10	17	24	31		7	14	21	28
F		7	14	21	28		4	11	18	25		1	8	15	22	29
S	1	8	15	22	29		5	12	19	26		2	9	16	23	30
S	2	9	16	23	30		6	13	20	27		3	10	17	24	

2. The EPO's filing offices in Munich and The Hague will be closed for the receipt of documents on every Saturday and Sunday in 1989.

	October						November						December					
Wk.	39	40	41	42	43	44	44	45	46	47	48		48	49	50	51	52	
M		2	9	16	23	30		6	13	20	27			4	11	18	25	
T		3	10	17	24	31		7	14	21	28			5	12	19	26	
W		4	11	18	25		1	8	15	22	29			6	13	20	27	
T		5	12	19	26		2	9	16	23	30			7	14	21	28	
F		6	13	20	27		3	10	17	24			1	8	15	22	29	
S		7	14	21	28		4	11	18	25			2	9	16	23	30	
S	1	8	15	22	29		5	12	19	26			3	10	17	24	31	

3. The other days in 1989 on which at least one of the EPO filing offices will not be open for receipt of documents are listed below.

Tage - Days - Jours		München Munich	Den Haag The Hague La Haye
Heiligidreikönigstag - Epiphany - Epiphanie	6.1.1989	X	
Karfreitag - Good Friday - Vendredi Saint	24.3.1989	X	X
Ostermontag - Easter Monday - Lundi de Pâques	27.3.1989	X	X
Maifeiertag - May Day - Fête du travail	1.5.1989	X	X
Christi Himmelfahrt - Ascension Day - Ascension	4.5.1989	X	X
Tag der Befreiung - Liberation Day - Jour de la Libération	5.5.1989		X
Pfingstmontag - Whit Monday - Lundi de Pentecôte	15.5.1989	X	X
Fronleichnam - Corpus Christi - Fête-Dieu	25.5.1989	X	
Mariä Himmelfahrt - Assumption Day - Assomption	15.8.1989	X	X
Allerheiligen - All Saints Day - Toussaint	1.11.1989	X	X
Buß- und Bettag - Day of Prayer and Repentance - Jour de pénitence et de prière	22.11.1989	X	
1. Weihnachtstag - Christmas Day - Noël	25.12.1989	X	X
2. Weihnachtstag - Boxing Day - Lendemain de Noël	26.12.1989	X	X

1990

Notice of the President of the European Patent Office dated 3 October 1989 concerning days on which at least one of the EPO filing offices is not open for the receipt of documents during 1990

1. Under Rule 85 (1) EPC time limits expiring on a day on which one of the filing offices of the EPO is not open for receipt of documents are extended until the first day thereafter on which all the filing offices are open for receipt of documents and on which ordinary mail is delivered.

2. The EPO's filing offices in Munich, The Hague and Berlin will be closed for the receipt of documents on every Saturday and Sunday in 1990.

3. The other days in 1990 on which at least one of the EPO filing offices will not be open for receipt of documents are listed below:

JANUARY

S	M	T	W	T	F	S
	1	2	3	4	5	6
7	8	9	10	11	12	13
14	15	16	17	18	19	20
21	22	23	24	25	26	27
28	29	30	31			

FEBRUARY

S	M	T	W	T	F	S
				1	2	3
4	5	6	7	8	9	10
11	12	13	14	15	16	17
18	19	20	21	22	23	24
25	26	27	28			

MARCH

S	M	T	W	T	F	S
					1	2
3	4	5	6	7	8	9
10	11	12	13	14	15	16
17	18	19	20	21	22	23
24	25	26	27	28	29	30
31						

APRIL

S	M	T	W	T	F	S
1	2	3	4	5	6	7
8	9	10	11	12	13	14
15	16	17	18	19	20	21
22	23	24	25	26	27	28
29	30					

MAY

S	M	T	W	T	F	S
			1	2	3	4
5	6	7	8	9	10	11
12	13	14	15	16	17	18
19	20	21	22	23	24	25
26	27	28	29	30	31	

JUNE

S	M	T	W	T	F	S
					1	2
3	4	5	6	7	8	9
10	11	12	13	14	15	16
17	18	19	20	21	22	23
24	25	26	27	28	29	30

JULY

S	M	T	W	T	F	S
1	2	3	4	5	6	7
8	9	10	11	12	13	14
15	16	17	18	19	20	21
22	23	24	25	26	27	28
29	30	31				

AUGUST

S	M	T	W	T	F	S
				1	2	3
4	5	6	7	8	9	10
11	12	13	14	15	16	17
18	19	20	21	22	23	24
25	26	27	28	29	30	31

SEPTEMBER

S	M	T	W	T	F	S
						1
2	3	4	5	6	7	8
9	10	11	12	13	14	15
16	17	18	19	20	21	22
23	24	25	26	27	28	29
30						

OCTOBER

S	M	T	W	T	F	S
					1	2
3	4	5	6	7	8	9
10	11	12	13	14	15	16
17	18	19	20	21	22	23
24	25	26	27	28	29	30
31						

NOVEMBER

S	M	T	W	T	F	S
					1	2
3	4	5	6	7	8	9
10	11	12	13	14	15	16
17	18	19	20	21	22	23
24	25	26	27	28	29	30

DECEMBER

S	M	T	W	T	F	S
						1
2	3	4	5	6	7	8
9	10	11	12	13	14	15
16	17	18	19	20	21	22
23	24	25	26	27	28	29
30	31					

Tage - Days - Jours		München Munich	Den Haag The Hague La Haye	Berlin
Neujahr - New Year's Day - Nouvel An	1.1.1990	X	X	X
Karfreitag - Good Friday - Vendredi Saint	13.4.1990	X	X	X
Ostermontag - Easter Monday - Lundi de Pâques	16.4.1990	X	X	X
Nationalfeiertag - National Holiday - Fête Nationale	30.4.1990		X	
Maifeiertag - May Day - Fête du travail	1.5.1990	X	X	X
Christi Himmelfahrt - Ascension Day - Ascension	24.5.1990	X	X	X
Pfingstmontag - Whit Monday - Lundi de Pentecôte	4.6.1990	X	X	X
Fronleichnam - Corpus Christi - Fête-Dieu	14.6.1990	X		
Mariä Himmelfahrt - Assumption Day - Assomption	15.8.1990	X	X	X
Allerheiligen - All Saints' Day - Toussaint	1.11.1990	X	X	X
Buß- und Bettag - Day of Prayer and Repentance - Jour de pénitence et de prière	21.11.1990	X		X
Heiliger Abend - Christmas Eve - Veille de Noël	24.12.1990	X	X	X
1. Weihnachtstag - Christmas Day - Noël	25.12.1990	X	X	X
2. Weihnachtstag - Boxing Day - Lendemain de Noël	26.12.1990	X	X	X
Sylvester - New Year's Eve - Saint-Sylvestre	31.12.1990	X	X	X