

EUROPEAN QUALIFYING EXAMINATION 1992

PAPER D

This paper comprises:

- Instructions to Candidates 92/D/e/1
- Part I - Questions 1-11 92/D/e/2-7
- Part II - Legal Advice 92/D/e/8-13
- Annex - Calendars for 1990, 1991 and 1992 with indication of the days on which at least one of the EPO filing offices is not open for the receipt of documents 92/D/e/14-16

INSTRUCTIONS TO CANDIDATES

Paper D comprises:

- 11 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 11 questions, the other half for the legal advice.

The answers to questions 1 to 11 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

Five months after the date on which the A1 publication of the European patent application was mentioned in the European Patent Bulletin, proceedings were interrupted because of the death of the applicant. The patent application had included the request for examination but the examination fee had not been paid. Four months after they were interrupted, the grant proceedings were resumed by the former applicant's successors in title.

Discuss the issue of whether, and if so, until when, the new applicant may still validly pay the examination fee.

Question 2

The applicant files an application for a German national patent (DE). Three months later he files a European patent application (EP1) for the same invention as in DE together with a further embodiment claiming the priority of the earlier German national patent application.

The applicant files a second - subsequent - European patent application (EP2) claiming patent protection for the subject-matter disclosed in the first European patent application (EP1) together with another further embodiment of the invention.

May priority be validly claimed for this second European patent application (EP2), if this application (EP2):

- a. is filed six months after the German national patent application (DE), claiming the priority of both the national application and the European application;
- b. is filed six months after the European patent application (EP1) and claiming only the priority of the European patent application (EP1);
- c. is filed eleven months after the European patent application (EP1) claiming the priority of the European patent application (EP1), the German national application (DE) having been abandoned?

Question 3

1. Upon receiving the Search Report and prior to receiving the first communication of the Examining division you wish to add to the description of your European patent application:
 - a. a reference to a patent cited in the search report quoting part of the abstract;
 - b. statements concerning further advantages of the invention over the cited art which you had not mentioned in the originally filed description;
 - c. statements concerning recently discovered disadvantages of the cited state of the art.

Are these additions permissible?

2. After the Examining Division has informed you of the text in which it intends to grant the European patent, you wish to add to the introductory part of the description of the patent to be granted a reference to a further patent, recently discovered.

Must the Examining Division accept this addition?

Question 4

Which of the following may be the subject of a European patent? Give a brief indication of your reasoning for each example.

- a. a computer program for translating English into Russian.
- b. a method of treatment in which a tablet formed from a chemical compound is swallowed and releases a chemical causing the recipient to have a desirable suntanned appearance and no other effects.
- c. a chemical compound which may be taken with alcoholic drinks and renders police breath and blood tests for alcohol ineffective.

Question 5

The applicant files many patent applications, including two having identical titles and similar applicant's references and which receive similar EPO application numbers. A communication from the Examining Division is received and sets a time limit for response. As the applicant's reference given is that of the one application which is no longer needed, no response was filed and the applicant receives notice of deemed withdrawal of the application because of failure to

respond within the time limit. He does not react to this communication either, considering that he does not need to undertake anything more. Two months later the applicant pays the renewal fee for the 4th year. One month later, the renewal fee is refunded and the applicant now realises that because of EPO error he has allowed an application to lapse other than the one which he in fact no longer needed. In each instance the correct EPO application number had been given on the official communication, but the applicant's reference was wrong.

Comment briefly upon the possibility and requirements for recovery of the application.

Question 6

A European patent application was filed in French by a French representative and has been granted. The patent, which has been opposed in English by a British firm, has been assigned to an American firm which would like to file all documents in English. Its French representative would, however, prefer to use French at the oral proceedings. The opponent's British representative would rather use English at the oral proceedings.

Is all or any of this possible?

Question 7

A representative files on 7 January 1992 a European patent application with a priority date of 8 January 1991. All formal requirements for a valid application were complied with.

The representative is told now by the applicant that he is no longer interested in his invention and wishes to avoid the publication of the European application.

(a) What steps are to be taken and

(b) within which time limit?

Question 8

An international patent application is filed in USA on 30 August 1991, claiming a priority of 31 August 1990 and designating the US, Japan, Canada, Australia and EP. A demand for international preliminary examination is sent by the applicant to the EPO on 27 March 1992 through a private courier service and is received at the EPO on 1 April 1992.

What are the consequences and possibilities?

Question 9

An international application, for which the EPO is a designated Office, is filed with the USPTO claiming a US priority. The priority date as claimed was identical to the date on the certified copy of the priority document prepared by the USPTO, but the serial number of the prior application as indicated in the Request Form did not correspond to the number shown on the certified copy. The error, imputable to the USPTO, did not come to light until after publication of the application and during examination in the regional phase. The representative requests correction of the Request Form under Rule 88 EPC.

Is the request allowable? Please justify your answer.

Question 10

During an opposition case, the opponent - and he alone - requests, in the event that his substantive request cannot be fully met, that oral proceedings be initiated.

The parties have presented their observations sufficiently in the course of written procedure, the opponent having requested that the patent be revoked in its entirety whilst the proprietor has not seen fit to propose amendments to his patent.

Does the proprietor risk having his patent immediately revoked at this stage?

Question 11

A European patent application is filed claiming only one priority.

- a. Can this priority claim be withdrawn at any time between the date of filing and the date of grant?
- b. What is the situation in the case of a PCT patent application?
- c. Can withdrawal of the priority have any influence on time limits which have already expired?
- d. If priority is withdrawn 20 days before expiry of the 18-month time limit for publication of the application, is the application still published 18 months after the priority date initially claimed:
 - in the case of a European patent application?
 - in the case of a PCT patent application?

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 |
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| 11 | 12 | 13 | 14 | 15 | 16 | 17 |
| 18 | 19 | 20 | 21 | 22 | 23 | 24 |
| 25 | 26 | 27 | 28 | | | |

MARCH

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| 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 |
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MAY

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| 20 | 21 | 22 | 23 | 24 | 25 | 26 |
| 27 | 28 | 29 | 30 | 31 | | |

JUNE

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JULY

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AUGUST

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SEPTEMBER

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| 30 | | | | | | |

OCTOBER

| S | M | T | W | T | F | S |
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| 21 | 22 | 23 | 24 | 25 | 26 | 27 |
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NOVEMBER

| S | M | T | W | T | F | S |
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DECEMBER

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| 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 | |
| Maiifeiertag - 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 |