

EUROPEAN QUALIFYING EXAMINATION 1993

PAPER D

This paper comprises:

- Instructions to Candidates 93/D/e/1
- Part I - Questions 1-9 93/D/e/2-6
- Part II - Legal Advice 93/D/e/7-10
- Annex - Calendars for 1991, 1992 and 1993 with indication of the days on which at least one of the EPO filing offices is not open for the receipt of documents 93/D/e/11-13

ANWEISUNGEN AN DIE BEWERBER

Prüfungsaufgabe D umfaßt

- 9 Fragen, die alle beantwortet werden sollen – der Bewerber hat keine Wahlmöglichkeit;
- eine Anfrage eines Mandanten, die eine Antwort in Form einer Rechtsauskunft erfordert.

Die Hälfte der verfügbaren Noten wird für die Antworten auf die 9 Fragen, die andere Hälfte für die Rechtsauskunft vergeben.

Die Antworten auf die Fragen 1 bis 9 sollten kurz und präzise sein. Der Bewerber hat die Artikel, Regeln oder sonstigen rechtlichen Grundlagen, die er seiner Antwort zugrunde legt, anzugeben.

In der Rechtsauskunft soll der Bewerber zeigen, daß er fähig ist, einen schwierigen Sachverhalt unter dem Gesichtspunkt des gewerblichen Rechtsschutzes zu klären. Er hat die rechtlichen Folgen des vorgegebenen Sachverhalts darzulegen und sollte vorzugsweise die Artikel, Regeln oder sonstigen rechtlichen Grundlagen, die er seiner Antwort zugrunde legt, angeben.

INSTRUCTIONS TO CANDIDATES

Paper D comprises:

- 9 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 9 questions, the other half for the legal advice.

The answers to questions 1 to 9 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.

INSTRUCTIONS AUX CANDIDATS

L'épreuve D comprend :

- 9 questions exigeant toutes des réponses – sans possibilité pour les candidats de choisir ;
- la demande d'un mandant désireux d'obtenir une réponse sous forme de consultation juridique.

La moitié des points constituant la note est consacrée aux 9 questions et l'autre moitié à la consultation juridique.

Les réponses aux questions 1 à 9 devraient être courtes et précises et le candidat doit citer les articles, règles ou autres sources juridiques sur lesquels il fonde sa réponse.

Dans la consultation juridique, le candidat devrait prouver qu'il a la compétence professionnelle nécessaire pour analyser une situation complexe du point de vue du droit de la propriété industrielle. Il doit préciser les conséquences juridiques des faits exposés et il devrait, de préférence, citer les articles, règles ou autres sources juridiques sur lesquels il fonde sa réponse.

PART I

What are the minimum necessary steps for you to take to comply with your client's requirement:

Question 1

An international application was correctly filed on 26 September 1991 designating, *inter alia*, EP (European Patent) and MC (Monaco). Is it possible to get a European patent for Monaco when entering the national phase? Give reasons for your answer.

Question 2

An Italian applicant wishes to file an EP application claiming priority of an Italian application filed by him on 4 May 1992. Besides a certified copy of the Italian application, he sends you an English language translation of the Italian application for filing. He also asks you to save costs.

Can you reduce the amount of fees payable? If so, how? What time limits apply?

Question 3

You are on the list of professional representatives before the EPO and are the German representative in Munich for a Greek applicant for a European patent. On the very last day of the period for reply to a communication pursuant to Art 96(2) and Rule 51(2) you receive instructions for filing a reply. The instructions are in the Greek language, of which you have a good command, and are rather lengthy, in the form of a draft response, but are apparently proper and deal with all objections raised in the communication. The applicant expressly tells you that you must file the reply by the end of the period.

a) if the instructions only include arguments?

b) if the instructions also include amended claims and/or amended description pages (in Greek)?

Question 4

The applicant has filed in September 1992 a European patent application for a pharmaceutical product and its method of manufacture. At filing, the application includes two sets of claims; a first set for all EPC Contracting States except Greece, Portugal and Spain includes 12 claims and a second set for Greece, Portugal and Spain includes 13 claims.

a) How many claims fees were payable? By what deadline?

The applicant during prosecution of the application adds a further eight claims to the first set of claims and subsequently receives notification that the EPO intends to grant a patent including these further claims.

b) How many claims fees are payable? By what deadline?

c) What are the consequences of missing the deadlines in a) and b)?

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Question 5

In a PCT application the claims relate to a method for smoothing the human skin by applying a certain substance, known per se. The International Searching Authority (ISA) refuses to search the claims, considering them as relating to a method of treatment of the human body by therapy. The applicant, however, is convinced that this invention falls in the cosmetic field rather than in the therapeutic field.

a) What is the legal basis in the PCT for this refusal by the ISA?
Can this refusal be appealed under the provisions of PCT?

b) Can the application enter the national phase with non-searched claims? Give reasons for your answer.

Question 6

A US applicant has filed a European Patent application on 12 September 1992 appointing, in the request which he signed himself, a single representative on the list of professional representatives before the EPO. Later, the applicant decides to appoint another representative, also on the said list but of a different firm.

a) What steps should be taken to substitute the other representative for the first mentioned representative?

b) Can the other representative be made an additional representative and be sure to receive copies of all communications from the EPO?

Question 7

Last year, on the morning of 4 May 1992, a European patent attorney received a letter from his US-client. It contained the application text for a European patent application and also the other necessary papers ready for filing. The priorities of a US application of 30 April 1991 and a further one of 5 May 1991 were to be claimed. It was mentioned in the letter that a scientific article disclosing the invention had been published some days earlier than 4 May 1992.

How would you have handled the situation?

Question 8

A PCT application has been properly filed at the European Patent Office by a British company, requesting *inter alia* a European patent. The applicant now intends to submit a demand for International Preliminary Examination to extend the international phase.

a) What is the deadline for requesting this International Preliminary Examination? Where does it have to be submitted?

b) Under what circumstances is it possible to elect one or more further countries not mentioned in the original demand for International Preliminary Examination?

c) Where, if at all possible, can this later election be submitted?

Question 2

A. An Examining Division intends to grant a European patent and therefore despatches on 10 April 1992 the Communication under Rule 51(4). On 8 May 1992, i.e. within the specified period, the applicant states his approval of the text. On 10 July 1992 the Examining Division despatches the Communication under Rule 51(6).

On 4 September 1992, i.e. in the given term, the applicant pays the fees for grant and printing and files the translation of the claims in the two official languages other than the language of the proceedings. The EPO has not yet despatched the decision to grant the patent pursuant to Article 97(2).

A third party presents observations under Article 115(1) EPC at this stage.

Upon what basis will these observations be considered?

B. Following these observations, the substantive examination is resumed. An interview between the examiner and the applicant takes place on 28 January 1993 and oral proceedings before the Examining Division take place on 1 April 1993.

Could this third party be present

(i) at the interview?

(ii) at the oral proceedings?

C. These oral proceedings are closed by the Examining Division informing the applicant that it intends to grant a European patent on the basis of the amended claims filed for the oral proceedings.

Will further new observations according to Article 115(1) EPC by the same third party be considered? If so, by what date should they be filed in order to be taken into account?

1991

Notice of the President of the European Patent Office dated 7 November 1990 concerning holidays observed by EPO filing offices in 1991

JANUARY
S M T W T F S
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JUNE
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JULY
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AUGUST
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SEPTEMBER
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OCTOBER
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DECEMBER
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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 1991.

3. The other days in 1991 on which at least one of the filing offices will not be open for receipt of documents are listed below:

Tage - Days - Jours	München Munich	Den Haag The Hague La Haye	Berlin
Neujahr - New Year's Day - Nouvel An	X	X	X
Karfreitag - Good Friday - Vendredi Saint	X	X	X
Ostermontag - Easter Monday - Lundi de Pâques	X	X	X
Nationalfeiertag - National Holiday - Fête Nationale	X	X	X
Maifeiertag - May Day - Fête du travail	X	X	X
Christi Himmelfahrt - Ascension	X	X	X
Pfingstmontag - Whit Monday - Lundi de Pentecôte	X	X	X
Frontleihn - Corpus Christi - Fête-Dieu	X	X	X
Marä Himmelfahrt - Assumption Day - Assomption	X	X	X
Tag der Deutschen Einheit - Day of German Unity - Fête Nationale	X	X	X
Allerheiligen - All Saints' Day - Toussaint	X	X	X
Buß- und Bettag - Day of Prayer and Repentance - Jour de pénitence et de prière	X	X	X
Heiliger Abend - Christmas Eve - Veille de Noël	X	X	X
1. Weihnachtstag - Christmas Day - Noël	X	X	X
2. Weihnachtstag - Boxing Day - Lendemain de Noël	X	X	X
Silvester - New Year's Eve - Saint-Sylvestre	X	X	X

1992

Notice of the President of the European Patent Office dated 17 October 1991 concerning holidays observed by EPO filing offices in 1992

JANUARY
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MARCH
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APRIL
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JULY
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AUGUST
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SEPTEMBER
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OCTOBER
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NOVEMBER
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10 11 12 13 14 15 16
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DECEMBER
S M T W T F S
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10 11 12 13 14 15 16
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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 1992.

3. The other holidays observed by EPO filing offices in 1992 are listed below:

Tage - Days - Jours	München Munich	Den Haag The Hague La Haye	Berlin
Neujahr - New Year's Day - Nouvel An	X	X	X
Heiligdreikönigstag - Epiphany - Epiphanie	X	X	X
Karfreitag - Good Friday - Vendredi Saint	X	X	X
Ostermontag - Easter Monday - Lundi de Pâques	X	X	X
Nationalfeiertag - National Holiday - Fête Nationale	X	X	X
Maifeiertag - May Day - Fête du travail	X	X	X
Tag der Befreiung - Liberation Day - Journée de la Libération	X	X	X
Christi Himmelfahrt - Ascension Day - Ascension	X	X	X
Pfingstmontag - Whit Monday - Lundi de Pentecôte	X	X	X
Frontleihn - Corpus Christi - Fête-Dieu	X	X	X
Buß- und Bettag - Day of Prayer and Repentance - Jour de pénitence et de prière	X	X	X
Heiliger Abend - Christmas Eve - Veille de Noël	X	X	X
1. Weihnachtstag - Christmas Day - Noël	X	X	X
Silvester - New Year's Eve - Saint-Sylvestre	X	X	X

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1993

JANUARY	FEBRUARY	MARCH
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3 4 5 6 7 8 9	7 8 9 10 11 12 13	7 8 9 10 11 12 13
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APRIL	MAY	JUNE
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4 5 6 7 8 9 10	9 10 11 12 13 14 15	6 7 8 9 10 11 12
11 12 13 14 15 16 17	16 17 18 19 20 21 22	13 14 15 16 17 18 19
18 19 20 21 22 23 24	23 24 25 26 27 28 29	20 21 22 23 24 25 26
25 26 27 28 29 30	30 31	27 28 29 30

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

OCTOBER	NOVEMBER	DECEMBER
S M T W T F S	S M T W T F S	S M T W T F S
1 2	1 2 3 4 5 6	1 2 3 4
3 4 5 6 7 8 9	7 8 9 10 11 12 13	5 6 7 8 9 10 11
10 11 12 13 14 15 16	14 15 16 17 18 19 20	12 13 14 15 16 17 18
17 18 19 20 21 22 23	21 22 23 24 25 26 27	19 20 21 22 23 24 25
24 25 26 27 28 29 30	28 29 30	26 27 28 29 30 31
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Notice of the President of the European Patent Office dated 9 October 1992 concerning the days on which EPO filing offices are closed in 1993

- Under Rule 85(1) EPC time limits expiring on a day on which at least one of the filing offices of the EPO is not open for receipt of documents (closing days) 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.
- The EPO's filing offices in Munich, The Hague and Berlin will be closed for the receipt of documents on every Saturday and Sunday. The other closing days in 1993 are listed below.

Tag - Days - Jours	München	Den Haag	Berlin
Neujahr - New Year's Day - Nouvel An	X	X	X
Heilige Drei Könige - Epiphany	X		X
Karfreitag - Good Friday - Vendredi Saint	X	X	X
Ostermontag - Easter Monday - Lundi de Pâques	X	X	X
Nationalfeiertag - National Holiday - Fête Nationale		X	
Tag der Befreiung - Liberation Day - Journée de la Libération		X	
Christi Himmelfahrt - Ascension Day - Ascension	X	X	X
Pfingstmontag - Whit Monday - Lundi de Pentecôte	X	X	X
Fronleichnam - Corpus Christi - Fête-Dieu	X		
Allerheiligen - All Saints Day - Toussaint	X	X	X
Buß- und Bettag - Day of Prayer and Repentance - Jour de pénitence et de prière	X		X
Heiliger Abend - Christmas Eve - Veille de Noël	X	X	X
Silvester - New Year's Eve - Veille de Nouvel An	X	X	X