

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 II

Today you receive the following letter (dated 25 March 1993) from a client.

A. I am the Managing Director, A, of a Swedish company in the bakery business. I am the inventor of a new egg beater. By the movement of the beater back and forth, horizontally, beating time is considerably shortened when compared with the conventional beater known to us.

We have applied for patent protection for this improved beater in a Swedish Patent Application filed on 31 January 1991 and subsequently, claiming priority from the Swedish application, in a European patent application filed on 31 January, 1992 designating all EPC Contracting States. This EP application was filed in English and was published on 13 August 1992. We have received the search report dated 12 November 1992, with very relevant citations against all claims. We believe that the egg beater is not inventive. This is of no concern; we are no longer interested in having our egg beater patented, since it has had no commercial success on the market. We have decided to abandon our European application.

However, our European application has one aspect which has of late become very interesting to us. We refer to this aspect as the BRIGHT IDEA.

This BRIGHT IDEA, suggested to us by our chief designer, B, was that one might use the egg beater, by rotating it about its longitudinal axis in a substantially vertical disposition, as a tool for catching and removing a certain amount of boiled spaghetti from a spaghetti boiler or saucepan, and, by rotating the egg beater in the opposite direction, for delivering the spaghetti onto a plate. The egg beater does not pick up

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spaghetti with the axis horizontal. Holding the egg beater in a vertical disposition when using it as a spaghetti tool is especially safer when picking up hot spaghetti from high and narrow pots and therefore very advantageous. We have already had great commercial success with our BRIGHT IDEA.

The BRIGHT IDEA is described in our Swedish application and also in our European application; the applications have identical descriptions, drawings and claims, but only in the last paragraph of the descriptions is the BRIGHT IDEA disclosed. At the time of filing our European application we did not think that our egg beater had any commercial value as a spaghetti tool.

We only incorporated the BRIGHT IDEA in the patent applications as a funny idea. Our chief designer, B, had got the BRIGHT IDEA from watching people eating spaghetti.

Our main US competitor, C, paid us a visit in July 1992. By then, we had just started marketing our "egg beater" as a spaghetti tool - BRIGHT IDEA - with directions for use as a spaghetti tool only. Our competitor was most upset and said that he considered himself the inventor of the BRIGHT IDEA and that we had no right whatever to exploit that idea.

Our competitor actually told us that he had filed a US application on a tool identical to our "egg beater". Subsequently, he had filed a PCT application, where he claimed rotation of the "egg beater" about its longitudinal axis for picking up loose ends of yarn, especially in a centrifugal spinning machine, for winding the yarn on a winding sleeve.

He also said that he intended to market his tool in Europe as a spaghetti tool and that he would take "legal action" unless we stopped marketing our BRIGHT IDEA.

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He has since sent us a copy of his PCT application, from which it appeared that its filing date was 30 January 1992, claiming priority from a US patent application filed on 30 January 1991; the PCT application was published on 6 August 1992, and designated all EPC contracting states. Our competitor has refused to provide us with a copy of his US priority application, which we therefore ourselves ordered from WIPO. We have not yet received the copy of the priority document, and question whether WIPO will provide it.

Further investigations revealed that the US priority application filed 30 January 1991 had issued as a US patent on 30 June 1992, and it appeared from the front page of this patent specification that it was a continuation application of Serial No. XXX,XXX, filed 30 January 1990, which had been abandoned. The US patent contained independent claims to the use of a tool identical to our "egg beater" for picking up "an elongated element" by rotating the tool about its longitudinal axis. The description of the US patent disclosed the use of the tool with its axis substantially horizontal, for picking up yarn and spaghetti. Our competitors PCT application discloses and claims the tool and its use for picking up elongated elements including spaghetti.

Please advise whether we should stop the marketing of our BRIGHT IDEA in Europe, considering the risk that C's PCT application will mature into a European patent.

B. We have filed an EPC divisional application, on the advice of an employee who is our authorised representative in the European patent application mentioned above. Our employee told us that it is possible to refile the original EPC application with new

claims at an initial expense involving only the postage. The idea of filing the divisional was to try to obtain patent protection for the BRIGHT IDEA; the claims in our original European patent application were directed only to the egg beater.

In a great hurry we mailed the divisional application to the Swedish Patent Office on 24 February 1993. Without covering letter, a new claim to the BRIGHT IDEA and copies of the following parts of our original European application were mailed:

- description, drawings, abstract,
- request for grant form on which, however, we have added Ireland in the designation box,
- designation of inventor, designating me alone as inventor,
- Authorisation in my favour.

We have only hand-marked the top of the first page of the request with "Divisional".

No fees have been paid.

We have not so far had any reaction from the Swedish Patent Office nor from the EPO to our filing of the divisional Application and are now getting really worried that we will have no patent protection for our BRIGHT IDEA, especially since our patent expert employee left our firm on 20 February 1993.

Our original European patent application had no formal deficiencies. Are there any problems with our divisional application that could place it at risk? Please discuss all possibilities for solutions.

C. Finally, I ask you, in addition to advising on my questions above, to summarise your opinion and indicate your preferred course of action to ensure we obtain protection for our BRIGHT IDEA.

1991

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

JANUARY
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FEBRUARY
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MARCH
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JULY
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AUGUST
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SEPTEMBER
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NOVEMBER
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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
Frontleichnam - Corpus Christi - Fête-Dieu	X	X	X
Mariä 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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FEBRUARY
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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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DECEMBER
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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
Frontleichnam - 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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APRIL							MAY							JUNE						
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JULY							AUGUST							SEPTEMBER						
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OCTOBER							NOVEMBER							DECEMBER						
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17	18	19	20	21	22	23	21	22	23	24	25	26	27	19	20	21	22	23	24	25
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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

1. 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.

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. The other closing days in 1993 are listed below.

Tage - Days - Jours		München	Den Haag	Berlin
Neujahr - New Year's Day - Nouvel An	1.1.1993	X	X	X
Heilige Drei Könige - Epiphany - Epiphanie	6.1.1993	X		X
Karfreitag - Good Friday - Vendredi Saint	9.4.1993	X	X	X
Ostermontag - Easter Monday - Lundi de Pâques	12.4.1993	X	X	X
Nationalfeiertag - National Holiday - Fête Nationale	30.4.1993		X	
Tag der Befreiung - Liberation Day - Journée de la Libération	5.5.1993		X	
Christi Himmelfahrt - Ascension Day - Ascension	20.5.1993	X	X	X
Pfingstmontag - Whit Monday - Lundi de Pentecôte	31.5.1993	X	X	X
Fronleichnam - Corpus Christi - Fête-Dieu	10.6.1993	X		
Allerheiligen - All Saints Day - Toussaint	1.11.1993	X	X	X
Buß- und Bettag - Day of Prayer and Repentance - Jour de pénitence et de prière	17.11.1993	X		X
Heiliger Abend - Christmas Eve - Veille de Noël	24.12.1993	X	X	X
Silvester - New Year's Eve - Veille de Nouvel An	31.12.1993	X	X	X