

EUROPEAN QUALIFYING EXAMINATION 1995

PAPER D – PART II

This paper comprises:

- Instructions to Candidates 95/D/e/1
- Legal Advice 95/DII/e/2-7
- Annex - Calendars for 1994 and 1995 (with indication of the days on which at least one of the EPO filing offices is not open for the receipt of documents), and calendar for 1996 95/DII/e/8-10

INSTRUCTIONS TO CANDIDATES

Paper D, **Part I** comprises 10 questions, all of which should be answered - no choice for candidates;

Paper D, **Part II** comprises an inquiry from a client requiring an answer in the form of a legal opinion.

The duration of **Part I** will be 2 1/4 hours, the duration of **Part II** will be 3 hours.

45% of the marks available for Paper D are awarded for Part I, 55 % for Part II.

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

In **Part II** 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 II

Note to candidates:

For this question, assume the date today is 13 April 1995.

On 13 April 1995, you receive the following information from a client:

- (A) My company, BRIGHTCO, is a small, high-technology manufacturer of opto-electronic devices based in Britain. Recently, we signed a collaboration agreement with a British optical fibre manufacturer, GLAZECO. This agreement gives BRIGHTCO the option to acquire the rights to any invention of opto-electronic devices developed by GLAZECO.

Last year, GLAZECO developed a new method for incorporating various chemical dopants (additives) in glass for producing improved optical fibres.

On 14 April 1994, GLAZECO filed a European patent application, EP(1), which specifically described the details of this doping method. Research director KAPPA was named as inventor. EP(1) included claims to the doping method, to the doped glass and the improved optical fibre.

From experiments using the dopants, GLAZECO found that the improved optical fibre made with the doped glass exhibited enhanced optical properties, enabling the production of novel devices using such fibre. EP(1) included a general description of the principles of a device in which such doped fibre might be used, but without any detailed specific description of the features of such a device. The general description in EP(1) would clearly have been sufficient for any experts in the field (such as BRIGHTCO) to develop such a device themselves, given a reasonable amount of experimentation.

However, on 21 April 1994, GLAZECO filed a second European patent application, EP(2), including the same description of the doping method as in EP(1), but with additional detailed descriptions of two devices, X and Y, made using the improved optical fibre. EP(2) included broad claims to opto-electronic devices incorporating the improved optical fibre and dependent claims to devices X and Y. KAPPA and a GLAZECO research engineer, LAMDA, were named as the inventors in this application. GLAZECO only paid filing and search fees for both applications EP(1) and EP(2).

The details of the doping method and devices, exactly as described in EP(1) and EP(2) respectively, were disclosed by the inventors in two scientific papers which they presented at a conference on 24 June, 1994.

In accordance with our collaboration agreement we intend to acquire the rights to EP(2), but as we are not interested in manufacturing the optical fibre ourselves GLAZECO will keep its rights to EP(1). GLAZECO has instructed its own agents to file a new application claiming priority from EP(1) and adding the developments its research team has made to the doping method over the last year. GLAZECO has assured me that the outline description of the principles of the device which was included in EP(1) will be omitted completely from the new application.

to expand our sales to the US, Australia and Japan, but we wish to minimise our expenditure on protection at least for the next year.

The GLAZECO researchers, including KAPPA and LAMBDA, are presently away in Japan visiting another optical fibre manufacturer. They will be back in a fortnight's time. GLAZECO's lawyer has already prepared a draft assignment of EP(2) for signature by KAPPA, who alone is authorised to sign on behalf of GLAZECO, and by me as the managing director of BRIGHTCO. This will be completed on KAPPA's return.

We wish to protect some improvements made by our own technician, NEWMAN, to the devices X and Y as originally disclosed in EP(2). NEWMAN has found that, for commercial devices, more stable performance is achieved by using a known type of polarisation-sensitive fibre together with the doped fibre in the devices. This combination reduces polarisation instabilities which NEWMAN discovered could occur when the doped fibre was used alone. This disadvantage was unexpected, and has not previously been reported in the literature as far as we know, but once NEWMAN became aware of it the solution was relatively simple.

NEWMAN has just concluded the work on this and will be writing it up over this weekend. I will have it sent to you by special delivery as soon as it is typed up next week. This should give you time to include it in the new filing and still be able to benefit from the priority of EP(2).

To enable you to complete the necessary formalities GLAZECO says you will need to have a copy of EP(2) and a Power of Attorney from BRIGHTCO. I enclose a photocopy of EP(2) and a Power of Attorney signed by me to give you authority to represent BRIGHTCO in patent matters, together with a copy of the search report from the EPO on EP(2). I also enclose various patent and other publications which the inventors came across during their own literature searches.

I believe that you can fax the new application and any of these other documents you need direct to the EPO at the last minute if necessary and that the application at the EPO can be extended to cover the other non-European countries of future interest to us.

- (B) One of the background patents the inventors found is a US patent, USP1, which was granted in the name of one of our US competitors, FLASHCO. USP1 was filed on 21 September 1993 and was published on 15 December 1994.

USP1 describes and claims another method (different from that disclosed in EP(1)) for doping glass to produce optical fibres with the dopants also used in the EP(1) method. Optical fibres produced by FLASHCO's method would be indistinguishable from optical fibres produced by GLAZECO's method. There is no reference in USP1 to making devices which might use the FLASHCO fibre.

FLASHCO reported its work and demonstrated a device using its fibre at an opto-electronics trade fair in the USA from 9 - 12 May 1994. FLASHCO's salesman had a draft data sheet for the device which showed how the device was constructed and which he used to explain the device to potential customers. As it was only a draft he wouldn't let people have a copy for themselves then, but the device appears to have been identical to our device X. Officially, FLASHCO only released the final data sheet at the conference of 24 June 1994, when KAPPA was given a copy.

Following the recent announcement of our collaboration with GLAZECO and our intention to produce devices X and Y, FLASHCO has now sent us a copy of a PCT application, PCT(F), which it has filed at the USPTO.

FLASHCO has told us BRIGHTCO will need a licence under this application. FLASHCO has also sent a copy of the PCT Request form to support its claim to be extending its rights to cover Europe. The PCT Request form shows that FLASHCO is applying for a regional patent in Europe, and also for a "Continuation-in-Part" (CIP) in the US with reference to USP1 as the parent application. USP1 is also cited as the only priority application. PCT(F) was itself filed on 19 May 1994.

The description in PCT(F) is the same as USP1, except that details have been added of a device, using the doped fibre, which is exactly the same as the device FLASHCO demonstrated at the trade fair. PCT(F) only includes claims to FLASHCO's method and to this device.

FLASHCO has told us that because PCT(F) will be examined by the USPTO for international purposes, FLASHCO is confident that PCT(F) will be considered as allowable internationally, because the USPTO has already granted USP1 without any problem.

GLAZECO's lawyer has told me that as FLASHCO has filed under the PCT then PCT(F) should now be published and that future proceedings will be open to public inspection. I understand that you can check FLASHCO's assertion that PCT(F) will be internationally examined at the USPTO. If so, please order a copy of any examination report issued by the USPTO as soon as possible.

We want to be able to stop FLASHCO getting a patent anywhere for its device as early as we can. We will want to intervene to give evidence to, or file comments with, the USPTO about the disclosures at the trade fair if the USPTO Examiner doesn't know about them.

* * *

Please explain to me what needs to be done to protect BRIGHTCO's interests in all of these matters.

* * *

You are asked to prepare a detailed explanatory memorandum with appropriate reasoning, also identifying the supporting legal basis, as a basis for the response you would give to the client, with particular attention to the following points.

- (I) The issues which need to be considered for the proposed new application for the device inventions, particularly with regard to
 - (i) how and where to file (with comments on the formalities points and the cost considerations raised by the client);
 - (ii) what to claim and why, also considering the improvements made by NEWMAN;
 - (iii) when to file and any priority to be claimed;
 - (iv) the applicant(s), inventor(s) and any assignment(s) needed;
- (II) (i) FLASHCO's assertions regarding PCT(F) and the effect, if any, which FLASHCO's USPI and PCT(F) may have on your client's proposed applications and activities; and
 - (ii) your client's requests for information and proposals for attacking PCT(F).

Candidates should concentrate their answers on points relevant to EPC and PCT issues. Points concerning non-European national law should be mentioned only briefly.

1993

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.

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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 Betttag – 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

1994

Notice of the President of the European Patent Office dated 7 October 1993 concerning the days on which EPO filing offices are closed in 1994

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.

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SEPTEMBER

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Tage – Days – Jours		München Munich	Den Haag The Hague La Haye	Berlin
Heilige Drei Könige – Epiphany – Epiphanie	06.01.1994	X		X
Karfreitag – Good Friday – Vendredi Saint	01.04.1994	X	X	X
Ostermontag – Easter Monday – Lundi de Pâques	04.04.1994	X	X	X
Tag der Befreiung – Liberation Day – Journée de la Libération	05.05.1994		X	
Christi Himmelfahrt – Ascension Day – Ascension	12.05.1994	X	X	X
Pfingstmontag – Whit Monday – Lundi de Pentecôte	23.05.1994	X	X	X
Fronleichnam – Corpus Christi – Fête-Dieu	02.06.1994	X		
Mariä Himmelfahrt – Assumption Day – Assomption	15.08.1994	X	X	X
Tag der Deutschen Einheit – Day of German Unity – Fête Nationale	03.10.1994	X		X
Allerheiligen – All Saints' Day – Toussaint	01.11.1994	X	X	X
Buß- und Betttag – Day of Prayer and Repentance – Jour de pénitence et de prière	16.11.1994	X		X
2. Weihnachtstag – Boxing Day – Lendemain de Noël	26.12.1994	X	X	X

1995

Notice from the President of the European Patent Office dated 10 November 1994 concerning the days on which EPO filing offices are closed in 1995

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NOVEMBER

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JUNE

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SEPTEMBER

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DECEMBER

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Tage/Days/Jours		München Munich	Den Haag The Hague La Haye	Berlin
Heilige Drei Könige - Epiphany - Epiphanie	06.01.1995	X		X
Karfreitag - Good Friday - Vendredi Saint	14.04.1995	X	X	X
Ostermontag - Easter Monday - Lundi de Pâques	17.04.1995	X	X	X
Maifeiertag - May Day - Fête du travail	01.05.1995	X	X	X
Tag der Befreiung - Liberation Day - Journée de la Libération	05.05.1995		X	
Christi Himmelfahrt - Ascension Day - Ascension	25.05.1995	X	X	X
Pfingstmontag - Whit Monday - Lundi de Pentecôte	05.06.1995	X	X	X
Fronleichnam - Corpus Christi - Fête-Dieu	15.06.1995	X		
Mariä Himmelfahrt - Assumption Day - Assomption	15.08.1995	X	X	X
Tag der Deutschen Einheit - Day of German Unity - Fête Nationale	03.10.1995	X		X
Allerheiligen - All Saints Day - Toussaint	01.11.1995	X	X	X
1. Weihnachtstag - Christmas Day - Noël	25.12.1995	X	X	X
2. Weihnachtstag - Boxing Day - Lendemain de Noël	26.12.1995	X	X	X

1996

JANUARY

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SEPTEMBER

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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				