

EUROPEAN QUALIFYING EXAMINATION 1996

PAPER D - PART II

This paper comprises:

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|--|--------------|
| * Instructions to Candidates | 96/D/e/1 |
| * Legal Advice | 96/DII/e/2-5 |
| * Annex - Calendars for 1995 and 1996 with indication
of the days on which at least one of the EPO filing
offices is not open for the receipt of documents | 96/DII/e/6-7 |

INSTRUCTIONS TO CANDIDATES

Paper D, **Part I** comprises 11 questions, all of which should be answered - no choice for candidates;

Paper D, **Part II** comprises the statement of a specific situation requiring an answer in the form of a legal opinion.

The duration of **Part I** will be 2¼ 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

You are the Industrial Property director of the German company BAVARIA based in Munich, which has recently decided to enter the field of domestic illumination by considering the acquisition of some small companies, CASINO, ZORBAS, FLEUR, LEEK.

You have now - Wednesday 27 March 1996 - on your table the following reports prepared by the companies about their IP rights and all supporting documents. They have been prepared and submitted under confidentiality agreements.

CASINO

Ours is a Swiss company based in Lugano.

We invented a new lamp, characterised by a particular technically advantageous geometric arrangement J of the metal elements of the lamp. We found that the best performance was obtained when the elements were made of gold. We prepared an EP patent application EPC1 (designating all contracting states) including a full description of this lamp C1, an independent claim directed to a lamp incorporating arrangement J and a claim dependent thereon claiming the elements made of gold; indeed, we noted that a lamp incorporating J per se appeared to be new and inventive, and had great commercial possibilities.

We sent the application EPC1 to the EPO in Munich by an overnight courier arriving on Friday 1 December 1995. EPC1 was filed in Italian. Shortly after that, before any fees had been paid for EPC1, we discovered that - unexpectedly - even better performance could be achieved if the elements were made of iron instead of gold. This lamp with iron elements will be referred to as C2. So, a new EP application EPC2, also in Italian, was prepared by us modifying the description and claims of EPC1 by replacement of all references to gold by references to iron. EPC2 (designating all contracting states) was sent to the EPO in Munich by an overnight courier arriving on Friday 5 January 1996, together with a check of DEM 2500 covering filing and search fees. Only at the beginning of February we realised that the envelope we sent containing EPC2 did not contain the pages with the claims. Thus, we resubmitted the application, EPC4, by an overnight courier arriving on Monday 5 February 1996, ensuring this time that all the papers were present.

We have also an EP application EPC3 on a very important manufacturing process C3 for lamps. Application EPC3 was filed on Monday 3 February 1992. A communication from the EPO dated Friday 10 November 1995 indicated that the invention was new and inventive, but that some amendments were needed to comply with the EPC; an apparently extendable time limit of four months was set for replying. Due to financial difficulties we have taken no further action in respect of any of the applications EPC1, EPC2, EPC3 and EPC4.

We have not manufactured any lamps incorporating the above inventions yet, and the only non-confidential disclosure we made was at a local exhibition on Wednesday 6 December 1995. On that occasion, we showed a prototype of C1 (including the elements made of gold) and explained orally our invention C1 to a couple of potential clients, without giving them any written material.

ZORBAS

Ours is a Greek company based in Athens.

We have recently invented two different new lamps Z1 and Z2. For Z1, we filed a Greek patent application GRZ1 on Tuesday 28 March 1995; for Z2, we filed a Greek patent application GRZ2 on Friday 30 June 1995.

It was our intention to seek patent protection worldwide, but we have not done anything in view of the probable sale of our company ZORBAS.

FLEUR

Ours is a French company based in Bordeaux.

We invented a new lamp F1, for which we filed a French patent application FRF1 on Wednesday 15 March 1995. We then carried out a private patent search; the results of the search suggested that the invention would be patentable.

Unfortunately, financial difficulties have prevented us from filing corresponding patent applications in other countries. However, the invention has never been disclosed and FRF1 has not been published yet.

LEEK

Ours is a British company based in Cardiff.

On Monday 22 January 1996 we filed a European application EPL1 (designating GB, FR, DE) for a new lamp L1. The application was filed in English and the filing and search fees and designation fees for three states were paid on filing. The application was our first filing for the subject matter.

* * *

You have been informed that the acquisition contracts by which companies CASINO, ZORBAS and FLEUR are bought by your company BAVARIA have already been signed; by means of those contracts, the three acquired companies will remain as legally separate subsidiary companies, all having BAVARIA as mother company. As far as possible, patent rights should remain with the respective subsidiaries. You now have free access to their patent dockets.

However, you have the warning that company LEEK, which should have been bought by BAVARIA as well, was however finally bought by another company DIABLO, a competitor of BAVARIA.

You have also an indication from technicians of your company BAVARIA that lamp F1 is equal to lamp Z1 and the lamp L1 is equal to lamp C2.

You are requested to prepare a written reasoned memorandum, reporting on the following points in the interest of your company BAVARIA.

[Candidates are not expected to deal with or discuss any national rights arising in European countries as a result of earlier prior knowledge or use.]

I. For each company, in turn, specify

- a) what is the status of the patent applications and what protection is likely to be available for each of the acquired inventions in the EPC contracting states and in the US;
- b) what acts are necessary to ensure that patents protecting those inventions are actually obtained, in the most cost effective way;
- c) what fees (not amount, simply category) are to be paid over the next twelve months.

II. What concerns - if any - are there in relation to the competition with DIABLO?

1995

INFORMATION FROM THE
EUROPEAN PATENT OFFICE

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

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
1995 are listed below.

JANUARY	FEBRUARY	MARCH
S M T W T F S	S M T W T F S	S M T W T F S
1 2 3 4 5 6 7	1 2 3 4	1 2 3 4
8 9 10 11 12 13 14	5 6 7 8 9 10 11	5 6 7 8 9 10 11
15 16 17 18 19 20 21	12 13 14 15 16 17 18	12 13 14 15 16 17 18
22 23 24 25 26 27 28	19 20 21 22 23 24 25	19 20 21 22 23 24 25
29 30 31	26 27 28	26 27 28 29 30 31
APRIL	MAY	JUNE
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9 10 11 12 13 14 15	14 15 16 17 18 19 20	11 12 13 14 15 16 17
16 17 18 19 20 21 22	21 22 23 24 25 26 27	18 19 20 21 22 23 24
23 24 25 26 27 28 29	28 29 30 31	25 26 27 28 29 30
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JULY	AUGUST	SEPTEMBER
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9 10 11 12 13 14 15	13 14 15 16 17 18 19	10 11 12 13 14 15 16
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OCTOBER	NOVEMBER	DECEMBER
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22 23 24 25 26 27 28	19 20 21 22 23 24 25	17 18 19 20 21 22 23
29 30 31	26 27 28 29 30	24 25 26 27 28 29 30
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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	x	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

**INFORMATION FROM THE
EUROPEAN PATENT OFFICE**

**Notice from the President of the
European Patent Office dated
3 November 1995 concerning
the days on which EPO filing
offices are closed in 1996**

1. Under Rule 85(1) EPC time
limits expiring on a day on which
at least one of the filing offices
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1996 are listed below.

JANUARY

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SEPTEMBER

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OCTOBER

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NOVEMBER

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DECEMBER

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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	01.01.1996	x	x	x
Karfreitag - Good Friday - Vendredi Saint	05.04.1996	x	x	x
Ostermontag - Easter Monday - Lundi de Pâques	08.04.1996	x	x	x
Nationalfeiertag - National holiday - Fête Nationale	30.04.1996		x	
Maifeiertag - May Day - Fête du travail	01.05.1996	x	x	x
Christi Himmelfahrt - Ascension Day - Ascension	16.05.1996	x	x	x
Pfingstmontag - Whit Monday - Lundi de Pentecôte	27.05.1996	x	x	x
Fronleichnam - Corpus Christi - Fête-Dieu	06.06.1996	x		
Mariä Himmelfahrt - Assumption Day - Assomption	15.08.1996	x	x	x
Tag der Deutschen Einheit - Day of German Unity - Fête Nationale	03.10.1996	x		x
Allerheiligen - All Saints' Day - Toussaint	01.11.1996	x	x	x
Heiliger Abend - Christmas Eve - Veille de Noël	24.12.1996	x	x	x
1. Weihnachtstag - Christmas Day - Noël	25.12.1996	x	x	x
2. Weihnachtstag - Boxing Day - Lendemain de Noël	26.12.1996	x	x	x
Silvester - New Year's Eve - Saint-Sylvestre	31.12.1996	x	x	x