

EUROPEAN QUALIFYING EXAMINATION 1997

PAPER D - PART I

This paper comprises:

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| * Instructions to Candidates | 97/D/e/1 |
| * Questions 1-10 | 97/DI/e/2-6 |
| * Annex - Calendars for 1996 and 1997 with indication of the days on which at least one of the EPO filing offices is not open for the receipt of documents | 97/DI/e/7-8 |

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 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.

Question 1**(2.5 marks)**

Your client wishes to oppose a European patent. On 8 January 1997 the mention of the grant of the patent is published in the European Patent Bulletin. However, the patent specification is published on 3 February 1997 because of difficulties at the printing firm "Strike".

When does the opposition period end? Give reasons.

Question 2**(6 marks)**

You filed a European patent application for your client in the English language on 3 May 1993. You receive a communication according to Rule 51(6) EPC on 5 March 1997. The communication is dated 3 March 1997. You are informed that the EPO intends to grant a European Patent for the designated states LU, DE, CH/LI. The patent specification contains one claim and 35 pages.

- (a) What fees have to be paid and what will the time limits be for paying the fees?
- (b) What will the time limit be for submitting the translation of the claim to the EPO?
- (c) The mention of the grant of the patent will be published on 23 October 1997. What are the time limits for submitting the translation of the patent to the national patent offices and in what languages?

Question 3**(6 marks)**

You filed a British patent application on 1 May 1996 for your client, a Taiwanese individual inventor, resident in Taiwan, who has previously filed a corresponding application in Taiwan (not yet published).

Your client tells you that he has signed an agreement with a French company to produce his invention commercially. The agreement with the French company requires that your client should file a PCT

application designating all European Union member states and the United States. The agreement provides further that the French company should be applicant in France and licensee for all other countries and your client should be applicant for these other countries.

- (a) Can you file the PCT application in the name of the persons indicated in the agreement?
- (b) Can you validly claim priority from the GB application?
- (c) Can you record the licence before the International Bureau?

Question 4

(5 marks)

On 6 March 1996 you filed a French national patent application P1 for a new class of chemical compounds with a new therapeutic effect. The application contained broad claims to the class of compounds and the description contained only one example.

Your client published a paper reproducing the contents of P1 in November 1996.

On 3 March 1997 you filed a European application E1 identical to P1 and claiming priority from P1.

As a result of publishing his paper your client has now found experts in the field doubting whether all compounds within the scope of his claims will be effective. Your client has given you details of a large number of additional examples showing that all the compounds are active. Your client asks that you add the new examples to European application E1 to support the broad claims, if necessary dropping the priority of P1.

- (a) How will you respond to your client's request and why?
- (b) What action will you take before the EPO?

Question 5

(4 marks)

In view of recently developed commercial activities, your client tells you he would like to have a European patent for an electronic interface circuit he has developed. The circuit had already been shown in one of the figures and fully described, both generally and in detail, in an application he filed himself in August 1993 and which was refused last month. The circuit was not, however, related to the originally claimed and searched invention of this application.

Would it be possible to obtain a European patent for the circuit? If so, how would you proceed?

Question 6

(2.5 marks)

- (a) If you receive an invitation from the examining division of the European Patent Office to provide a list of countries where you have filed applications for national patents covering the whole or part of the invention to which the European patent application relates, together with the numbers of these applications, do you have to reply? What are the consequences of not replying?
- (b) If you reply, do you have to include in your list
 - (i) a corresponding ES utility model application?
 - (ii) a corresponding AU patent application?
 - (iii) a corresponding OA utility certificate application?

Question 7

(5 marks)

A communication pursuant to Article 96(2) EPC dated 14 March 1996 was sent to you as the professional representative of the applicant in relation to a European patent application. A term of four months was given for replying.

The applicant instructed you not to answer and to abandon the case. You then received a Rule 69(1) EPC communication from the EPO dated 30 August 1996.

On 3 November 1996 the applicant changes his mind and sends you a letter with technical arguments in support of his invention and asks you to reply if still possible. Due to unforeseeable circumstances you receive the letter later than the applicant expected.

What can you do if you receive the letter of the applicant on

- (a) 7 November 1996?
- (b) 13 November 1996?

Question 8

(3 marks)

An applicant received the EPO communication under Rule 85b EPC pointing out the failure to observe the time limit for the request for examination, because he had not paid the examination fee in due time. Thereupon the applicant paid the examination fee and the surcharge within the grace period. At the same time he requested a refund of the surcharge alleging that the EPO had not communicated the date on which the European Patent Bulletin mentioned the publication of the European search report to him and had not drawn his attention to the provisions of Article 94(2) and (3) EPC in this communication.

Will the EPO refund the surcharge? Give the legal basis.

Question 9

(5 marks)

A PCT application is filed with the EPO as Receiving Office designating EP, US, JP, KR, MX and AU without paying any designation fees. For the application you use the usual PCT filing form. The filing date is 10 February 1997. The PCT application claims priority of a Swiss application, the priority date is 8 February 1996. Two weeks after the filing date, the client informs you that he only wishes to designate EP and JP for economic reasons. When paying the designation fees you submit a letter to the EPO stating that only the fees for EP and JP are being paid. On 3 March 1997 you receive a notification according to Rule 16bis PCT from the EPO dated 28 February 1997 informing you that the designation fees for EP and JP are paid and that the countries except EP and JP can be designated by paying the designation fee with surcharge within a time limit of one month. On 4 April 1997 you receive a further letter from your client, that he now wants to designate the countries CA, PL, KR, RU and US.

What can be done?

Question 10

(6 marks)

Today you received Rule 51(4) EPC notices on two of your client's applications, *A* and *B*. Your client has already instructed you that application *A* should be granted as quickly as possible but application *B* should be delayed for as long as possible. Both should be granted unamended. Indicate what you would do for applications *A* and *B* and estimate the best time scales that could be achieved.