

EUROPEAN QUALIFYING EXAMINATION 1997

PAPER D - PART II

This paper comprises:

- * Instructions to Candidates 97/D/e/1
- * Legal Advice 97/DII/e/2-5
- * 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/DII/e/6-7

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.

You have today, 19 March 1997, received at your London office, the following letter from a client, Donna Overtake, the famous British racing driver, who has just left hospital following a serious accident in her racing car during testing in late October 1996:

Tuesday, 18 March 1997

Dear Mr Tourney,

As you know, the British motor racing team I own has been working for some time on an electronically controlled anti-lock braking system (ABS) for our racing car. The system is very advanced and will be of great commercial value if we can get the domestic motor industry interested. We have been carrying out secret testing of the ABS at our private test track and, in fact, it was during one of the testing sessions in late October last year that I had my accident.

My most trusted mechanic, Dipstick, examined the car after the accident and found that the reason for the accident was that an essential component of the ABS had been removed from the car; the item removed was the electronic control system which I had invented. I was planning to visit you to discuss the invention but the accident prevented me.

Dipstick tells me that Willy Reckitt, our useless engine expert, was seen walking away from the car just before the start of the last test session carrying a box looking like the ABS control system; he was looking very pleased, which is surprising because I had told him his services were no longer needed and his employment by me was terminated. I am convinced Reckitt stole the ABS control system and will probably have been telling people about it. It is possible that Reckitt has tried to sell the ABS control system and the invention to our arch rivals, the Italian Pastawinna Formula One team; Pastawinna may be our arch rivals but they are honorable and will be misled by Reckitt's lies.

I intended to file patent applications in all the EPC contracting states and USA, and would still like to do so.

What can you do to secure patent protection for me for the invention in the event that (case A1) Reckitt has been telling people about my invention? On the other hand, if (case A2) Reckitt or Pastawinna files or has filed a patent application for Europe for my invention, what can be done to secure patent protection for me and ensure that Reckitt or Pastawinna is not granted a European patent?

About two and a half years ago, on the 1 November 1994, Dipstick and I filed, as joint applicants and joint inventors, a European patent application as a first filing claiming a new fuel injection system incorporating a new fuel injection pump. I was handling the case (the *B* case) myself before the EPO; we had only filed in Europe at that time because we did not believe there would be interest in the inventions outside Europe. Just before my accident I had agreed with Dipstick that the case should be divided and that he should continue alone as applicant and inventor in the pending application for the patent to the fuel injection pump, while a divisional application for the patent to the fuel injection system would have me as applicant and inventor; this really reflects the true ownership and inventorship of the inventions.

I would very much like to have a patent on the fuel injection system and ask you to investigate what has happened on this case during my period in hospital.

What actions are there to be taken and what fees will you need to pay in the next six months to secure my rights and Dipstick's rights?

Is it now too late to file a patent application in the USA for my invention of the fuel injection system?

There is one further case (the *C* case) I would like you to consider for me. At the time of developing the fuel injection system I carried out many experiments to find a fuel and heat resistant rubber for some of the components. I tested a number of commercially available rubbers and one of the rubbers, trade name "Damenill", which I tested was shown by the experiments to have superb qualities of fuel and heat resistance even when very thin. Surprisingly this fuel and heat resistance makes it an excellent material for the soles of racing-shoes. Damenill's only previous use has been as a shock absorbing material used in car bumpers.

I disclosed this invention to the racing-shoe maker, Mike Champion, and he agreed to take a licence provided he can have sole rights under granted patents in Europe. I used an English attorney, Ben Etton, to file the case; he filed the case as a PCT application in English designating Europe and the USA, and paid all fees and carried out all necessary actions including requesting international preliminary examination on 19 April 1996. The PCT application itself had been filed on 20 September 1994 as a first filing naming me as applicant and inventor. I took the case back from Etton after he had requested international examination, intending to handle the case myself. Owing to work pressures and then the accident I have done nothing on the case, although I remember receiving a letter from the EPO about it; however, I cannot now find the letter. Please could you take over this case; you will appreciate that it is important to get the European patent granted, if possible, to fulfil my agreement with Mike Champion.

What actions are there to be taken and what fees will you need to pay in the next six months?

By the way, the properties of Damenill and its use for making articles with improved fuel and heat resistance, together with its composition, are disclosed, but not claimed, in both the patent application for the racing-shoe and in the patent application for the fuel injection system and pump (the *B* case).

Is there any possibility of getting patent protection for Damenill itself, or its new use as a fuel and heat resistant material in general?

Yours sincerely,

Donna Overtake

On receiving the letter this morning you telephone the EPO and are told that the *B* case names as joint applicants and inventors Overtake and Dipstick; no representative has been appointed. No divisionals have been filed and no renewal fees have been paid, and although the EPO issued a communication on 1 November 1996 (with a four month time period) informing the applicant of the text in which it intended to grant the European patent, no response has been received by the EPO.

Write a reasoned memorandum for your client detailing what actions you will take in her best interest and answering all her questions.

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 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 1996 are listed below.

JANUARY

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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
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

1997

INFORMATION FROM THE EUROPEAN PATENT OFFICE

Notice from the President of the European Patent Office dated 2 October 1996 concerning the days on which EPO filing offices are closed in 1997

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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FEBRUARY

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MARCH

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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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NOVEMBER

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DECEMBER

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Tage/Days/Jours		München Munich	Den Haag The Hague La Haye	Berlin
Neujahr - New Year's Day - Nouvel An	01.01.1997	x	x	x
Heilige Drei Könige - Epiphany - Epiphanie	06.01.1997	x		
Karfreitag - Good Friday - Vendredi Saint	28.03.1997	x	x	x
Ostermontag - Easter Monday - Lundi de Pâques	31.03.1997	x	x	x
Nationalfeiertag - National Holiday - Fête National	30.04.1997		x	
Maifeiertag - May Day - Fête du travail	01.05.1997	x	x	x
Tag der Befreiung - Liberation Day - Journée de la Libération	05.05.1997		x	
Christi Himmelfahrt - Ascension Day - Ascension	08.05.1997	x	x	x
Pfingstmontag - Whit Monday - Lundi de Pentecôte	19.05.1997	x	x	x
Fronleichnam - Corpus Christi - Fête-Dieu	29.05.1997	x		
Mariä Himmelfahrt - Assumption Day - Assomption	15.08.1997	x	x	
Tag der Deutschen Einheit - Day of German Unity - Fête Nationale	03.10.1997	x		x
Heiliger Abend - Christmas Eve - Veille de Noël	24.12.1997	x	x	x
1. Weihnachtstag - Christmas Day - Noël	25.12.1997	x	x	x
2. Weihnachtstag - Boxing Day - Lendemain de Noël	26.12.1997	x	x	x
Silvester - New Year's Eve - Saint-Sylvestre	31.12.1997	x	x	x