

EUROPEAN QUALIFYING EXAMINATION 1999

PAPER D - PART II

THIS PAPER COMPRISES:

- * LEGAL ADVICE 99/DII/E/1-4
- * ANNEX - CALENDAR FOR 1999 WITH INDICATION
OF THE DAYS ON WHICH AT LEAST ONE OF THE
EPO FILING OFFICES IS NOT OPEN FOR THE
RECEIPT OF DOCUMENTS 99/DII/E/5

45% OF THE MARKS AVAILABLE FOR PAPER D ARE AWARDED FOR PART I, 55%
FOR PART II.

You are a European patent attorney. You receive today a visit from Mr Renoir, manager of a French Company X. He presents to you the following situation and requests that you answer his questions.

«We are manufacturers of cardboard and particularly of corrugated cardboard. Corrugated cardboard is commonly made of sheets of paperboard corrugated and laminated in a corrugating machine between two plane sheets of paperboard. Cardboard has the disadvantage of being sensitive to humidity, and that is a drawback in some applications, such as packaging. To obviate this problem, corrugated cardboard is treated with a waterproofing agent in a batch process which consists in treating plates of the corrugated cardboard in a closed vessel with a hot impregnating agent.

We have developed an impregnation process, avoiding the use of such vessels. It consists in treating the cardboard continuously, as it moves through the corrugating machine, by means of an apparatus which is attached and adapted to the machine and which comprises a coating cylinder for applying an impregnating agent.

We, Company X, filed a French patent application A-FR in July 1998 covering the apparatus and the process for applying the impregnating agent by coating. On the proposal of Mr Goya, a development engineer with our Spanish sister Company Y who was temporarily working in our unit, we included in the description of A-FR an alternative solution with an apparatus and a process using spraying nozzles instead of a coating cylinder. The alternative solution was described in general terms only but was specific enough to be carried out by a skilled person. Both Mr Goya and I were named as inventors.

We were disappointed to learn of the existence of a PCT application B-PCT designating the EP states and the USA, filed in Russia by the Moscow Cardboard Institute. B-PCT describes a cylinder coating process that is identical to our own cylinder coating process and an apparatus that is almost the same as the apparatus described in A -FR. This application was published in Russian in February 1999 with a filing date of August 1998 and claiming the priority of a Russian application filed a year before.

On learning this, we decided to turn our efforts to the protection of the spraying apparatus that Mr Goya had continued to develop in Spain with our assistance. A European patent application A1-EP was filed in a hurry last week by the Spanish Company Y in its name only, claiming the priority of A-FR and designating Mr Goya as sole inventor, the intention being to transfer a part of the patent to our Company X and to designate me as co-inventor later on.

This European patent application A1-EP is about an improved apparatus using multiple bars of spraying nozzles combined with a vacuum box placed under the cardboard sheet to be treated and straight below the nozzles. Vacuum improves penetration of the impregnating agent within the paperboard. It was decided not to include in A1-EP the cylinder coating process described in A-FR because of the prior rights of the Moscow Cardboard Institute. The European application A1-EP was written in Spanish and no fees have yet been paid.

We also wrote to Mr Soutine, Director of the Moscow Cardboard Institute, proposing to him that we would take an exclusive licence in relation to B-PCT. Mr Soutine recently replied by phone that because of lack of funds they had not continued with application B-PCT. In particular, when their patent agent had reminded them of a final date of 15 March 1999 for taking a decision, Mr Soutine had replied that he should not take any action. Mr Soutine remembered that this time limit was not extendable; he thought that B-PCT was now lost but said that he would check.

We now regret not having included the subject-matter concerning the cylinder coating technique in A1-EP, particularly as our coating apparatus as disclosed in A-FR included some commercially valuable features not present in B-PCT.

To complete your information, we presented together with Y a corrugating machine comprising the spraying apparatus according to A1-EP at the International Cardboard Exhibition held in January 1999 in Monaco. Our local marketing agent has confirmed to us that the vacuum box could not be seen by the public. In his oral presentation of the corrugating machine he had made a short presentation of the

spraying apparatus without giving information about the improved apparatus described in A1-EP. He still has to send in a short written summary directly to the editorial board for the general report on the exhibition that is supposed to be published at the end of 1999.

Can A1-EP be continued with and how can we best protect the coating and spraying inventions?

Could Moscow Cardboard Institute continue with B-PCT and would we require a licence to use their cylinder coating inventions?

We have a cooperation agreement concerning the development of new compositions of waterproofing agents with a research laboratory *Z* in Belgium. *Z* owns a European patent Z1-EP with claims directed to a composition Z1 and its manufacturing process. *Z* told us that unfortunately the EPO decided to revoke Z1-EP due to lack of inventive step after oral proceedings held on 20 January 1999 before the opposition division. The patent was opposed by our main competitor *M*. *Z* requested without success that the patent be maintained in amended form with claims limited to the manufacturing process for preparing composition Z1 in order to meet objections concerning patentability expressed during the proceedings. In fact *Z* has now lost all interest in the patent because even if it were maintained with limited claims it would have little effect on our competitors as Z1 can now be obtained by a process outside the scope of the process claims. Our competitor *M* has been using composition Z1 produced by this process in his cardboard products for a year now, having started after *Z* filed the limited claims. It is to be noted that we have new evidence and arguments showing that composition Z1 as was claimed in the granted patent is not obvious and should be patentable.

Is there anything that can be done to save something from Z1-EP and to obtain damages from *M*?

Z has developed a new composition Z2 that is useful as an additive for paper but also shows excellent properties as a waterproofing agent in cardboard. *Z* filed a first patent application BE-Z2 for Z2 in Belgium in April 1998. Although Mr van Dongen, the engineer who developed Z2, recently left the

company after a dispute with his colleagues and cannot give any further help, we and Z are now considering filing corresponding applications in other countries. According to our agreement we, X, will take charge of the patents and applications as common representative in foreign countries and are to be the owner of any patent concerning our technical field (cardboard), with Z being the owner of patents in the other technical fields. Z and ourselves would like to obtain patent protection in different States; we in all EP states and the USA, Z in all EP states and in Eastern Europe.

We want the best protection possible both in Europe and the USA against our competitors and would like to minimise costs during the next few years; what would you suggest that we do in the near future?»

1999

INFORMATION FROM THE
EUROPEAN PATENT OFFICE

Notice from the President of the European Patent Office dated 17 September 1998 concerning the days on which EPO filing offices are closed in 1999

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 1999 are listed below.

JANUARY

S	M	T	W	T	F	S
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31						

FEBRUARY

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MARCH

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APRIL

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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	01.01.1999	x	x	x
Heilige Drei Könige - Epiphany - Epiphanie	06.01.1999	x		
Karfreitag - Good Friday - Vendredi Saint	02.04.1999	x	x	x
Ostermontag - Easter Monday - Lundi de Pâques	05.04.1999	x	x	x
Nationalfeiertag - National Holiday - Fête National	30.04.1999		x	
Tag der Befreiung - Liberation Day - Journée de la Libération	05.05.1999		x	
Christi Himmelfahrt - Ascension Day - Ascension	13.05.1999	x	x	x
Pfingstmontag - Whit Monday - Lundi de Pentecôte	24.05.1999	x	x	x
Fronleichnam - Corpus Christi - Fête-Dieu	03.06.1999	x		
Allerheiligen - All Saints' Day - Toussaint	01.11.1999	x		
Heiliger Abend - Christmas Eve - Veille de Noël	24.12.1999	x	x	x
Silvester - New Year's Eve - Saint-Sylvestre	31.12.1999	x	x	x