

EUROPEAN QUALIFYING EXAMINATION 2004

PAPER D - PART I

This paper comprises:

* Questions 1 - 11

2004/DI/e/1 - 6

- Question 1 : 5 points
- Question 2 : 4 points
- Question 3 : 2 points
- Question 4 : 5 points
- Question 5 : 4 points
- Question 6 : 5 points
- Question 7 : 5 points
- Question 8 : 3 points
- Question 9 : 3 points
- Question 10 : 5 points
- Question 11 : 4 points

TOTAL: 45 POINTS

- * Annex: calendars for 2003 and 2004 with indication of the days on which at least one of the EPO filing offices is not open for the receipt of documents

2004/DI/e/7 - 8

45% of the marks available for paper D are awarded for part I,
55% for part II.

Question 1

(5 points)

On 12 February 2001, an applicant filed a European patent application EP which is today still pending. EP claimed priority from a GB patent application of 14 February 2000. On 29 January 2004, the applicant filed a divisional application with the EPO.

- a) Which renewal fees have to be paid in 2004 for the divisional application?
- b) By when at the latest can you pay without an additional fee?
- c) By when at the latest can you pay with an additional fee?

Question 2

(4 points)

On 23 September 2002, you filed on behalf of your client, company A, a European patent application EPFIRST as a first filing without claiming priority. Due to a favourable European search report, your client instructed you to file an international application PCTLATE claiming priority from EPFIRST and designating, among others, EP. In accordance with your client's instructions, you filed PCTLATE on 23 September 2003, having the same text as and claiming priority from EPFIRST. EPFIRST was withdrawn after all formal requirements for PCTLATE had been met. Today, 24 March 2004, the head of the legal department of company A informs you that, on 22 August 2002, company A had filed a German utility model application in the name of company A, disclosing and claiming the same invention of the same inventor as EPFIRST. The German utility model became publicly available in December 2002.

Discuss the legal situation.

Question 3

(2 points)

A European patent was maintained in amended form after opposition proceedings by combining the subject-matter of granted claims 1 and 2. Only the sole opponent appealed the decision. May the patent proprietor reinstate the granted claim 1 during the appeal proceedings?

Question 4

(5 points)

A Spanish company filed with the EPO an international application in Spanish on 15 March 2004. The international application validly claims priority from a Spanish application filed on 21 March 2003. All necessary fees were paid to the EPO by an enclosed cheque. The Spanish company received a notification from the EPO that the application had been transmitted to the International Bureau. Why did the EPO transmit the application, what effect does this have, and what has to be done next?

Question 5

(4 points)

A European patent attorney with his place of business in Paris filed on 12 February 2004, in Greek, a European patent application for a Greek applicant who lives in Paris. The priority of an earlier application filed on 13 February 2003 is validly claimed. All fees due have been paid.

After filing, no further documents were filed relating to the European patent application.

- a) What is the legal situation today, 24 March 2004?
- b) What can be done to obtain protection of the invention by means of a European patent application?

Question 6

(5 points)

A European patent application EP1 was filed on 1 October 2001. EPO form 1001 indicated that it was intended to pay the designation fees for Austria, Belgium, Spain, Germany and the Netherlands only.

The filing fee and the search fee were duly paid. On 2 April 2003, the European Patent Bulletin mentioned the publication of the search report which indicates that EP1 comprises three inventions. Designation fees were only paid for Austria, Belgium, Spain and Germany. These designation fees were paid on 2 October 2003.

Two European divisional applications EP2 and EP3 were filed from the parent application, both designating Austria, Belgium, Germany and the Netherlands. EP2 was filed on 12 August 2003, and EP3 was filed on 12 November 2003. All fees were duly paid.

Which Contracting States could be validly designated in EP1, EP2 and EP3?

Question 7

(5 points)

You are representing Mr. A who has filed a European patent application. In a communication C1 pursuant to Article 96(2) and Rule 51(2) EPC, dated 24 June 2003, you were invited to file observations and amendments to the application within a period of four months. On 28 October 2003 you requested a two month extension of this period. The request was granted. On 18 December 2003, you requested a further extension of one month, because due to the applicant's Christmas holidays you would not have the information necessary to reply to the communication in due time. This further request was rejected in a communication C2 dated 8 January 2004. The ensuing loss of rights was noted in a communication C3 dated 22 January 2004.

- a) What is the legal status of the application today, 24 March 2004, and what would you do to save the application?
- b) Would an appeal against the rejection dated 8 January 2004 be admissible?
- c) Can you have the finding as to the loss of rights reviewed by a Board of Appeal?

Question 8

(3 points)

You are representing the applicant of an international application. The EPO, acting as International Searching Authority (ISA) considered that the application contained 18 inventions, despite the fact that there was only one independent claim, without alternatives formulated therein. The independent claim was followed by a number of dependent claims.

Thus, you have received an invitation to pay additional search fees for 17 inventions. Your client considers that he has made only one invention and strictly refuses to pay any additional search fee. Nevertheless, he asks you to file a demand for International preliminary examination for this international application.

- a) Under these circumstances, is it possible to have the finding of the ISA as to the number of inventions reviewed under the provisions of the PCT?
- b) How will the non-payment of the additional search fees affect the further prosecution of the PCT application in the International phase?

Question 9

(3 points)

An International application PCT 1 designating EP and directed to process P was filed by Professor A without claiming priority. One week before the filing date, Professor A had orally disclosed the whole process P during his lecture held at a public congress at his university. A compendium of all lectures held at the congress, including a written version identical to Professor A's lecture and indicating the date on which it was held, was made available to the public one month after the filing date. The oral disclosure and the compendium are cited in the International search report pertaining to PCT 1.

Will the EPO consider Professor A's oral disclosure part of the prior art for the purposes of novelty and inventive step

- a) as International Preliminary Examining Authority (IPEA) during International preliminary examination of PCT 1?
- b) after entry into the European phase during substantive examination of PCT 1?

Question 10

(5 points)

Your client from Switzerland has invented a new gardening tool. Your client presented the tool for the first time to the public from 24 to 30 September 2003 at the IGA 2003 international gardening exhibition, which took place from 25 April to 12 October 2003 in Rostock (DE).

Your client has a certificate issued at the exhibition by the authority responsible for the protection of industrial property at that exhibition, stating that the gardening tool was in fact exhibited there, the opening date of the exhibition and the date of the first disclosure, as well as an identification of the gardening tool duly authenticated by the mentioned authority.

Today, 24 March 2004, your client wants to file a Swiss national application CH-1 as a first filing, describing and claiming the gardening tool. Since your client is interested in having the tool protected in all Contracting States of the EPC, he intends to file a corresponding European patent application EP-1 a few days before expiry of the priority year in 2005, claiming priority from CH-1 and designating all Contracting States.

Would you recommend your client to proceed as planned, and what steps would you propose to take?

Question 11

(4 points)

A European patent application was filed by company A. On 4 September 2003 a communication pursuant to Rule 69(1) EPC was issued informing the applicant that the application was deemed to be withdrawn under Article 96(3) EPC.

The European patent application was transferred to company B on 22 October 2003. A request for recording the transfer of the European patent application accompanied by a declaration of transfer signed by both companies A and B was filed, and the applicable administrative fee paid, on 27 November 2003.

On 14 November 2003, company B filed a request for further processing, paid the further processing fee, and completed the omitted act.

Was the request for further processing validly filed?

Annex 1

2003

INFORMATION FROM THE EUROPEAN PATENT OFFICE

**Notice from the President of the
European Patent Office dated
10 October 2002 concerning the days
on which EPO filing offices are
closed in 2003**

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
2003 are listed below.

JANUARY 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	FEBRUARY 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	MARCH 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
APRIL 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	MAY 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	JUNE 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
JULY 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	AUGUST 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	SEPTEMBER 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
OCTOBER 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	NOVEMBER 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	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

Tage/Days/Jours 2003		München Munich	Den Haag The Hague La Haye	Berlin
Neujahr - New Year's Day - Nouvel An	01.01.03	x	x	x
Heilige Drei Könige - Epiphany - Epiphanie	06.01.03	x		
Karfreitag - Good Friday - Vendredi Saint	18.04.03	x	x	x
Ostermontag - Easter Monday - Lundi de Pâques	21.04.03	x	x	x
Nationalfeiertag - National Holiday - Fête nationale	30.04.03		x	
Mai feiertag - May Day - Fête du travail	01.05.03	x	x	x
Tag der Befreiung - Liberation Day - Journée de la Libération	05.05.03		x	
Christi Himmelfahrt - Ascension Day - Ascension	29.05.03	x	x	x
Pfingstmontag - Whit Monday - Lundi de Pentecôte	09.06.03	x	x	x
Fronleichnam - Corpus Christi - Fête-Dieu	19.06.03	x		
Mariä Himmelfahrt - Assumption Day - Assomption	15.08.03	x		
Tag der Deutschen Einheit - Day of German Unity - Fête Nationale	03.10.03	x		x
Heiliger Abend - Christmas Eve - Veille de Noël	24.12.03	x	x	x
1. Weihnachtstag - Christmas Day - Noël	25.12.03	x	x	x
2. Weihnachtstag - Boxing Day - Lendemain de Noël	26.12.03	x	x	x
Silvester - New Year's Eve - Saint-Sylvestre	31.12.03	x	x	x

Annex 2

2004

INFORMATION FROM THE EUROPEAN PATENT OFFICE

**Notice from the President of the
European Patent Office dated
03 November 2003 concerning the
days on which EPO filing offices are
closed in 2004**

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
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Tage/Days/Jours 2004		München Munich	Den Haag The Hague La Haye	Berlin
Neujahr - New Year's Day - Nouvel An	01.01.04	x	x	x
Heilige Drei Könige - Epiphany - Epiphanie	06.01.04	x		
Karfreitag - Good Friday - Vendredi Saint	09.04.04	x	x	x
Ostermontag - Easter Monday - Lundi de Pâques	12.04.04	x	x	x
Nationalfeiertag - National Holiday - Fête nationale	30.04.04		x	
Tag der Befreiung - Liberation Day - Journée de la Libération	05.05.04		x	
Christi Himmelfahrt - Ascension Day - Ascension	20.05.04	x	x	x
Pfingstmontag - Whit Monday - Lundi de Pentecôte	31.05.04	x	x	x
Fronleichnam - Corpus Christi - Fête-Dieu	10.06.04	x		
Allerheiligen - All Saints' Day - Toussaint	01.11.04	x		
Heiliger Abend - Christmas Eve - Veille de Noël	24.12.04	x	x	x
Silvester - New Year's Eve - Saint-Sylvestre	31.12.04	x	x	x