

EUROPEAN QUALIFYING EXAMINATION 2005

PAPER D – PART I

This paper comprises:

* Questions 1 – 11

2005/DI/e/1 - 6

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

TOTAL: 45 POINTS

- * Annex: calendars for 2004 and 2005 with indication of the days on which at least one of the EPO filing offices is not open for the receipt of documents

2005/DI/e/7 - 8

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

Question 1

(2 points)

An international application PCT1 was filed with the EPO on 31 July 1998, and published on 02 February 2000. International preliminary examination took place before the EPO, and the International Preliminary Examination Report was completed on 12 December 2000. Since the Report was very unfavourable, the applicant decided not to enter the European phase. Consequently, none of the acts listed in Rule 107(1) EPC were performed.

Will the EPO allow third parties access to the file of the international preliminary examination of PCT1?

Question 2

(7 points)

Will the EPO accept the following amendments:

- a) Together with a letter of reply to the examiner's first communication during substantive examination, the applicant introduced new claims complying with Article 123(2) EPC and relating to unsearched subject-matter which does not combine with the originally claimed invention to form a single general inventive concept.
- b) In opposition proceedings, the patentee replaced the granted claims, which were directed to originally disclosed "Substance A" and "Mixture B containing substance A", by amended claims directed to the "Use of substance A in mixture B" for a certain originally disclosed purpose.
- c) In appeal proceedings, an amended set of claims was transmitted, using the *epoline*[®] online filing software.

- d) In reply to the examiner's first communication during substantive examination, the only independent claim was delimited by introducing a disclaimer to establish novelty against a document which is state of the art according to Article 54(3) EPC. Neither the disclaimer nor the subject-matter excluded by it from the scope of the claim had a basis in the application as filed.
- e) In opposition proceedings, the patentee deleted from the only independent claim a feature which had been added during substantive examination, had no basis in the application as filed, and was without any technical meaning.

Question 3

(4 points)

Mr. and Mrs. A and their adult son, all from London, filed together one notice of opposition to a European patent. The notice was signed by all three family members. Only one opposition fee was paid. All other requirements of Art. 99 and Rules 1, 55 and 56 EPC were met.

- a) Is the opposition validly filed?
- b) Discuss the situation if any one of the family members wishes to withdraw from the opposition proceedings and explain what needs to be done.

Question 4

(4 points)

Applicant A timely requested the USPTO acting as Receiving Office to prepare and transmit the priority document to the International Bureau by crossing the relevant box in the PCT request form and paying the prescribed fee. Upon entry into the European phase, the priority document has been furnished neither to the International Bureau nor to the EPO. What are the consequences for substantive examination?

Question 5

(5 points)

You filed at the European Patent Office on 07.05.2004 an international application claiming a priority of 08.05.2003. The EPO acting as International Searching Authority established an International Search Report and a Written Opinion and transmitted a copy of both documents to you on 09.10.2004. The Written Opinion is negative on some aspects.

What actions at least do you have to perform, and by when, in order to have the Written Opinion re-examined during the international phase?

Question 6

(3 points)

Austrian Company A develops alarm systems for cars. The "Goldilock" alarm system was jointly developed with German car company B. It was agreed to file a European patent application naming A as applicant for Austria and B as applicant for the other states. The patent granted on the basis of said application is validly opposed by B's competitor C on the grounds of Article 100 (a) EPC. A wants to limit the subject-matter of claim 1 with respect to the cited prior art, B refuses this. Can A and B separately pursue different sets of claims in the opposition proceedings?

Question 7

(3 points)

In reply to a communication pursuant to Rule 51(4) EPC, Applicant A of European patent application B duly filed the outstanding translations of the 10 claims and paid a sum of EUR 730 to cover the fees for grant and printing. The application documents to be printed comprise 36 pages.

Applicant A asks you whether the sum paid was correct and whether, in the event that the sum paid was too large, the excess will be automatically refunded to him.

Question 8

(5 points)

Your client is patent proprietor in an appeal procedure against a decision of an opposition division to reject the opposition of the sole opponent O. The opponent has filed a new relevant prior art document D1 together with the statement setting out the grounds for appeal. Your client thinks that document D1 prejudices the maintenance of the patent and intends to restrict the patent to make sure that his patent is valid. Therefore, you have filed a restricted set of claims in due time before the oral proceedings before the Board of Appeal. The opponent/appellant has lost interest in this case and has withdrawn his opposition immediately before the oral proceedings.

Can your client restrict the patent?

Question 9

(2 points)

On request of a national court trying a revocation action relating to a European patent, will the European Patent Office give a technical opinion on whether the European patent which is the subject of the action is valid?

Question 10

(6 points)

European patent application EP-IT was duly filed by Italian company ITSA in Italian language a few years ago. A translation of the application into the French language was filed in due time.

Recently, ITSA was taken over by US company USCO. It has not been decided if the application will be transferred to USCO or be kept by ITSA, but in any case USCO are keen on using the English language during further prosecution of EP-IT before the EPO. USCO ask you, as their European patent attorney, the following questions:

- a) Can the English language be used by you and/or the EPO in the written procedure during substantive examination of EP-IT?
- b) Can the English language be used by you and/or the examining division in oral proceedings taking place during substantive examination of EP-IT?
- c) Which languages can be used by either USCO or ITSA for filing a divisional application based on EP-IT?
- d) In case of observations by third parties concerning the patentability of the invention of EP-IT, in which language has their statement of grounds to be presented?

Question 11

(4 points)

You have received on 16 November 2004 a communication C1 pursuant to Rule 51(4) EPC dated 15 November 2004, in which you were given a period of four months to pay the fees for grant and printing and to file a translation of the claims in the two official languages of the European Patent Office other than the language of the proceedings of your European patent application EP1. Together with the communication C1, you were invited to file a translation of the priority document for EP1. The text of EP1 differs from that of its priority document. On 01 March 2005, you have validly paid the grant and printing fee and filed the translations of the claims of EP1. On 08 March 2005, you are informed by your translation service that the translation of the priority document will be ready only in the week after 28 March 2005. You know from experience that no other translation service can provide such a translation more quickly.

Give two ways of saving the priority claim of EP1 without applying for restitutio in integrum.

Annex 1

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
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
2004 are listed below.

JANUARY S M T W T F S 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 29	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 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 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 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 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 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 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 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 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

Annex 2

2005

INFORMATION FROM THE EUROPEAN PATENT OFFICE

**Notice from the President of the
European Patent Office dated
02 July 2004 concerning the
days on which EPO filing offices are
closed in 2005**

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
2005 are listed below.

JANUARY

S	M	D	M	D	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	D	M	D	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	D	M	D	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	D	M	D	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	D	M	D	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	D	M	D	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	D	M	D	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	D	M	D	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	D	M	D	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	D	M	D	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	D	M	D	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	D	M	D	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 2005		München Munich	Den Haag The Hague La Haye	Berlin
Heilige Drei Könige - Epiphany - Epiphanie	06.01.05	x		
Karfreitag - Good Friday - Vendredi Saint	25.03.05	x	x	x
Ostermontag - Easter Monday - Lundi de Pâques	28.03.05	x	x	x
Christi Himmelfahrt - Ascension Day - Ascension	05.05.05	x	x	x
Pfingstmontag - Whit Monday - Lundi de Pentecôte	16.05.05	x	x	x
Fronleichnam - Corpus Christi - Fête-Dieu	26.05.05	x		
Mariä Himmelfahrt - Assumption Day - Assomption	15.08.05	x		
Tag der Deutschen Einheit - Day of German Unity - Fête Nationale	03.10.05	x		x
Allerheiligen - All Saints' Day - Toussaint	01.11.05	x		
2. Weihnachtstag - Boxing Day - Lendemain de Noël	26.12.05	x	x	x