

EUROPEAN QUALIFYING EXAMINATION 2006

PAPER D – PART I

This paper comprises:

- | | |
|---|-----------------|
| * Questions 1 – 9 | 2006/DI/e/1 - 5 |
| <ul style="list-style-type: none">- Question 1 : 5 points- Question 2 : 4 points- Question 3 : 7 points- Question 4 : 4 points- Question 5 : 5 points- Question 6 : 5 points- Question 7 : 2 points- Question 8 : 4 points- Question 9 : 4 points | |

TOTAL: 40 POINTS

- | | |
|---|-----------------|
| * Annex: calendars for 2005 and 2006 with indication of the days on which at least one of the EPO filing offices is not open for the receipt of documents | 2006/DI/e/6 - 7 |
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40% of the marks available for paper D are awarded for part I,
60% for part II.

Question 1

(5 points)

The Irish company HYPERTOOLS has a technical collaboration agreement with the English company CYBERFIT. The agreement stipulates that HYPERTOOLS and CYBERFIT are to act as joint applicants in respect of joint inventions made under the terms of the collaboration. Furthermore, since CYBERFIT is too small to have its own patent department, it is agreed that HYPERTOOLS will prosecute these patent applications. You are employed by HYPERTOOLS and have been asked to deal with inventions arising from this collaboration. However, you are neither a legal practitioner nor a professional representative before the EPO. Can you act before the EPO in respect of applications for which HYPERTOOLS and CYBERFIT are joint applicants? If so, what conditions must be fulfilled?

Question 2

(4 points)

- (i) A European patent application has been refused. An admissible appeal is filed against the decision to refuse the application. Is it possible to file a divisional application during appeal proceedings?
- (ii) What would your answer to part (i) be if the appeal fee had not been paid in due time?
- (iii) Is it possible to file a divisional application during the appeal proceedings related to opposition proceedings?

Question 3

(7 points)

A US national who made an invention while conducting technical research in Moscow filed a first application RU-1 in respect of that invention in Russian with the Russian Patent Office on 7 March 2005. The US national is now a resident of Switzerland. Today, 7 March 2006, the US national intends to file an international application claiming the priority of RU-1. The original Russian text and an English translation thereof are available for filing this international application.

What are the competent receiving Offices, and which of the two available texts can be used for filing the international application with the respective receiving Offices?

What are the competent International Searching Authorities in respect of each of the competent receiving Offices?

Question 4

(4 points)

An Austrian applicant A files an international application in German with the EPO. Before publication of the application, A sells this international application to company B, which is based in the USA. You are a European patent attorney representing company A and, after the purchase, company B in respect of this application.

1. Is it possible to record the change of applicant during the international phase? Where does a request for recording the change have to be filed?
2. Company B wishes the EPO to carry out the international preliminary examination. Where and in what language will the demand have to be filed?

Question 5

(5 points)

A European patent application EP1 designating all contracting states was filed in January 2004 and validly claims the priority of a patent application filed in January 2003. The mention of the grant of the European patent based on EP1 has been published on 1 February 2006.

A client wishing to oppose EP1 provides you with a European patent application EP2 designating all contracting states. EP2 discloses the same invention as EP1 and has been published in September 2003. The publication of EP2 mentions a filing date of February 2003 and a priority date of a Portuguese national patent application filed in March 2002. The Portuguese national patent application has been published in September 2003 and discloses the same invention as EP2.

According to a file inspection, no copy of the priority document for EP2 has been filed. Further, the applicant for EP2 failed to respond to a communication pursuant to Rule 41(1) EPC dated July 2003 objecting to the missing copy of the priority document and setting a period of 4 months to remedy the deficiency.

Can patent EP1 be revoked on the basis of EP2?

Question 6

(5 points)

In response to a communication under Article 96(2) EPC, you, as the representative, request in due time a two-month extension of the time limit given in the communication on the grounds that the applicant is on a round-the-world sailing trip and is unable to give you any instructions on how to reply to the communication. This time limit extension is granted by the EPO. One day before the extended time limit is due to expire, you notice that the applicant has not yet returned from his trip, and you request a further two-month extension. The EPO refuses this request. You receive a communication under Rule 69(1) EPC dated 21 February 2006 due to failure to reply to the communication under Article 96(2) EPC. On returning from his sailing trip on 3 March 2006, the applicant considers that the refusal to extend the time limit was not justified and insists on presenting his case before the boards of appeal.

1. What steps must be taken to have the refusal of the request for extension of the time limit reviewed by a board of appeal?
2. Would you advise your client to have his case reviewed by the board of appeal?

Question 7

(2 points)

You are representing the proprietor of a European patent at oral proceedings in an opposition case. The opposition division in its preliminary opinion deemed that none of the grounds mentioned in Article 100 EPC prejudices the maintenance of the patent as granted. However, the proprietor wishes the patent to be revoked.

Would a request by the proprietor for revocation of the patent at these oral proceedings be successful?

Question 8

(4 points)

The mention of the grant of European patent EP-B has been published on 27 April 2005.

On 24 January 2006 the EPO received by fax a notice of opposition filed in Italian by an Italian company, accompanied by a duly completed EPO debit order form 1010 ordering that the reduced opposition fee be debited from the company's deposit account.

On 31 January 2006 the EPO received the confirmation copy of the fax containing the notice of opposition.

On 28 February 2006 the EPO received the English translation of the notice of opposition by fax.

Is the opposition deemed to have been filed?

Question 9

(4 points)

Professor Pivo from Prague (CZ), inventor of a revolutionary new beer-brewing process, files a Czech national application CZ-A on 3 March 2005 as a first filing, describing and claiming his brewing process. On 3 March 2006 he presents the process in detail in a lecture at a public congress in Vienna. On the same day, just before his lecture, he put a European patent application EP-A claiming the priority of CZ-A in the letter box of the EPO's Vienna sub-office. EP-A is an exact translation of CZ-A into English. EP-A is transmitted to the EPO's Munich office and received there on 6 March 2006.

Discuss the legal situation.

Annex 1

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 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	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 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

2006

INFORMATION FROM THE EUROPEAN PATENT OFFICE

Notice from the President of the European Patent Office dated 14 October 2005 concerning the days on which EPO filing offices are closed in 2006

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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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 2006		München Munich	Den Haag The Hague La Haye	Berlin
Heilige Drei Könige - Epiphany - Epiphanie	06.01.06	x		
Karfreitag - Good Friday - Vendredi Saint	14.04.06	x	x	x
Ostermontag - Easter Monday - Lundi de Pâques	17.04.06	x	x	x
Maifeiertag - May Day - Fête du Travail	01.05.06	x	x	x
Nationalfeiertag - National Holiday - Fête Nationale	05.05.06		x	
Christi Himmelfahrt - Ascension Day - Ascension	25.05.06	x	x	x
Pfingstmontag - Whit Monday - Lundi de Pentecôte	05.06.06	x	x	x
Fronleichnam - Corpus Christi - Fête-Dieu	15.06.06	x		
Mariä Himmelfahrt - Assumption Day - Assomption	15.08.06	x		
Tag der Deutschen Einheit - Day of German Unity - Fête Nationale	03.10.06	x		x
Allerheiligen - All Saints' Day - Toussaint	01.11.06	x		
1. Weihnachtstag - Christmas Day - Noël	25.12.06	x	x	x
2. Weihnachtstag - Boxing Day - Lendemain de Noël	26.12.06	x	x	x