

EUROPEAN QUALIFYING EXAMINATION 2008

PAPER D - PART II

This paper comprises:

- * Client's letter followed by three (3) questions 2008/DII/e/1 - 5

- * Annex: Calendars for 2006, 2007 and 2008 with indication of the days on which at least one of the EPO filing offices is not open for the receipt of documents 2008/DII/e/6 - 8

40% of the marks available for paper D are awarded for part I,
60% for part II.

CopenTennis A/S
DK - 2100 Copenhagen

Copenhagen, 04.03.2008

Dear Mr Patent Attorney,

We are a major manufacturer of tennis rackets focused exclusively on the European market. Our facilities are located in Copenhagen, Denmark, where we also have our own patent department taking care of all our patent matters.

On 01.02.2006 we filed an application for a Danish utility model DK-U describing and claiming a newly developed tennis racket R1 comprising titanium fibres in the frame. This choice of material results in tennis racket R1 being particularly light and stiff. DK-U was published in April 2006. However, during extensive tests it turned out that, due to the inclusion of titanium fibres, tennis racket R1 showed annoyingly high vibrations when hitting a ball. Since no available racket dampers were suitable for R1, our engineers solved this problem by developing a racket damper D1, which suppresses vibrations and is made of known materials but characterized by a specific shape. Although the technology of D1 offers significant advantages in particular for tennis rackets, it can be used for all kinds of sports rackets, for example badminton or squash rackets. We filed a Danish patent application DK1 on 27.12.2006 claiming the priority of DK-U. DK1 describes and claims tennis racket R1 and racket damper D1 separately as well as tennis racket R1 combined with racket damper D1. With respect to tennis racket R1 the description and claims of DK1 are identical to DK-U.

Besides the issues mentioned above, our R&D department was also working on a new moisture absorbent sports racket grip G. Since we planned to equip all our rackets with grip G we filed a further Danish patent application DK2 on 29.12.2006, which likewise claims the priority of DK-U. DK2 describes and claims tennis racket R1 and grip G separately as well as tennis racket R1 combined with grip G. With respect to tennis racket R1 the description and claims of DK2 are identical to DK-U.

In August 2007 DK1 and DK2 were published with their respective search reports, which did not cite any relevant prior art. At the same time we started sales of our tennis racket R1 combined with racket damper D1 and grip G.

On 14.11.2007 we filed an English translation of DK2 as European patent application EP2 claiming priority of DK2.

In order to further improve our market position in Europe we also filed an English translation of DK1 as European patent application EP1 on 15.12.2007 claiming priority of DK1.

Before filing EP1 and EP2 we had carried out a prior art search, which revealed FR-BEP and PCT-DS as the only potentially relevant prior art documents.

FR-BEP is a French patent application filed on 03.09.2005 by a small engineering company "Bureau d'études de Paris" (BEP). FR-BEP does not claim any priority and was published on 05.03.2007. It describes and claims a racket damper D2, which is clearly different from and operates on a different principle to racket damper D1, but is apparently as effective.

PCT-DS is a PCT-application filed by the Indian company DelhiSport Ltd. (DS), a sports equipment manufacturer which has so far been active in Asia only. PCT-DS has a filing date of 08.12.2006 and designates all PCT contracting states. It claims the priority of an Indian patent application IN-DS filed on 10.12.2005. IN-DS was filed by DS and has the same contents as PCT-DS. The claims of PCT-DS are directed to a sports racket R in general, which comprises titanium fibres in the frame. Its description discloses the specific examples of a badminton racket, a squash racket and a tennis racket, the tennis racket being identical to our tennis racket R1. PCT-DS was published on 15.06.2007 in English.

Neither PCT-DS nor FR-BEP, which were both searched at the EPO, has any relevant prior art cited in their respective search reports.

In the evening of 21.12.2007 our patent department had their traditional candle light party in their office celebrating the end of a successful year 2007. Nobody can explain why, but suddenly there was smoke in the file store and a few minutes later the office was on fire. Luckily nobody was seriously injured but the office of the patent department was completely destroyed. Unfortunately, also the backup files stored in a fire proof safe in the cellar were destroyed by water flooding. Consequently, the department's regular review meeting scheduled for 28.12.2007, during which the status and completeness of all files would normally have been checked and further necessary actions discussed and prepared, had to be cancelled.

While we were still busy repairing the damage caused by the fire, we were surprised by a press release issued by DS on 05.02.2008, in which DS announced plans to enter the European market. According to their press release, they plan to offer for sale three types of tennis rackets in Europe:

- Tennis racket R1 combined with racket damper D1,
- tennis racket R1 combined with racket damper D2 and
- tennis racket R1 combined with grip G.

They will also offer for sale squash and badminton rackets using the same technology. The DS press release explains in detail the features of the sports rackets, in particular those of the above mentioned types of tennis rackets. A few days later we received a letter from DS informing us of their patent application PCT-DS. They also told us that PCT-DS had validly entered the European phase in January 2008 and that all prescribed fees, including the designation fees for all EPC contracting states, had been paid. Our patent manager has been invited to a meeting with DS on the 28.03.2008.

The damage caused by the fire was so severe that our patent files were only reconstructed on 28.02.2008, allowing the patent department to resume working. On that day we became aware of a notification from the EPO dated 17.12.2007 and received at our company on 21.12.2007 informing us that the necessary filing and search fees had not been paid for EP2 and that, therefore, EP2 was deemed to be withdrawn. We have checked and found that the fees for only EP1 were paid.

Having re-constituted our files, we also realised on 28.02.2008 that pages 3 and 4 of the description were missing from patent application EP1. The content of these pages is present in DK1 and is essential to carry out the invention and to manufacture the racket damper D1. Otherwise EP1 is identical in content to DK1. We have not received any communication from the EPO on this matter.

Yesterday BEP contacted our patent manager in order to investigate whether we were interested in buying the patent rights to racket damper D2. According to BEP, FR-BEP is still pending. It turned out that BEP had also filed a European patent application EP-BEP on 04.09.2006 claiming priority of and being identical with FR-BEP. For EP-BEP, which has not been published, all filing requirements have been met except for paying the necessary filing and search fees.

We were further informed that BEP has been declared bankrupt as from 06.09.2006 by a decision of a French tribunal. Since that date BEP has been prevented by legal reasons from continuing the proceedings before the EPO, which, however, was never informed about the company's legal situation. Yesterday BEP were authorized to sell their assets to meet their debts.

It is essential for us to have the best protection possible for our technology and all necessary freedom to manufacture and sell our tennis rackets in Europe. Therefore, please give advice in the form of a memorandum to our patent department in particular on the following questions:

1. What is the current legal situation of the inventions:
 - a. sports racket R,
 - b. tennis racket R1,
 - c. racket damper D1,
 - d. racket damper D2,
 - e. grip G,
 - f. the combination of tennis racket R1 with racket damper D1 and grip G that we sell, as well as the combinations mentioned in the press release issued by DS?
2. What actions, if any, would you recommend us to take within the next three months to improve our position with respect to these inventions?
3. What strategy should we follow in the upcoming negotiations with DS?

Annex 1

2006

Jan	Feb	Mar	Apr	May	Jun	Jul	Aug	Sep	Oct	Nov	Dec
Sun 01	Wed 01	Wed 01	Sat 01	Mon 01	Thu 01	Sat 01	Tue 01	Fri 01	Sun 01	Wed 01	Fri 01
Mon 02	Thu 02	Thu 02	Sun 02	Tue 02	Fri 02	Sun 02	Wed 02	Sat 02	Mon 02	Thu 02	Sat 02
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Tage / Days / Jours		München Munich	Den Haag The Hague La Haye	Berlin
Heilige Drei Könige – Epiphany – Epiphanie	06.01.2006	x		
Karfreitag – Good Friday – Vendredi Saint	14.04.2006	x	x	x
Ostermontag – Easter Monday – Lundi de Pâques	17.04.2006	x	x	x
Maifeiertag – May Day – Fête du Travail	01.05.2006	x	x	x
Tag der Befreiung – Liberation Day – Journée de la Libération	05.05.2006		x	
Christi Himmelfahrt – Ascension Day – Ascension	25.05.2006	x	x	x
Pfingstmontag – Whit Monday – Lundi de Pentecôte	05.06.2006	x	x	x
Fronleichnam – Corpus Christi – Fête-Dieu	15.06.2006	x		
Mariä Himmelfahrt – Assumption Day – Assomption	15.08.2006	x		
Tag der deutschen Einheit – Day of German Unity – Fête Nationale	03.10.2006	x		x
Allerheiligen – All Saints’ Day – Toussaint	01.11.2006	x		
1. Weihnachtstag – Christmas Day – Noël	25.12.2006	x	x	x
2. Weihnachtstag – Boxing Day – Lendemain de Noël	26.12.2006	x	x	x

Annex 2

2007

Jan	Feb	Mar	Apr	May	Jun	Jul	Aug	Sep	Oct	Nov	Dec
Mon 01	Thu 01	Thu 01	Sun 01	Tue 01	Fri 01	Sun 01	Wed 01	Sat 01	Mon 01	Thu 01	Sat 01
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Tage / Days / Jours		München Munich	Den Haag The Hague La Haye	Berlin
Neujahr – New Year's Day – Nouvel An	01.01.2007	x	x	x
Karfreitag – Good Friday – Vendredi Saint	06.04.2007	x	x	x
Ostermontag – Easter Monday – Lundi de Pâques	09.04.2007	x	x	x
Nationalfeiertag – National Holiday – Fête nationale	30.04.2007		x	
Mai feiertag – May Day – Fête du Travail	01.05.2007	x	x	x
Christi Himmelfahrt – Ascension Day – Ascension	17.05.2007	x	x	x
Pfingstmontag – Whit Monday – Lundi de Pentecôte	28.05.2007	x	x	x
Fronleichnam – Corpus Christi – Fête-Dieu	07.06.2007	x		
Mariä Himmelfahrt – Assumption Day – Assomption	15.08.2007	x		
Tag der deutschen Einheit – Day of German Unity – Fête nationale	03.10.2007	x		x
Allerheiligen – All Saints' Day – Toussaint	01.11.2007	x		
Heiliger Abend – Christmas Eve – Veille de Noël	24.12.2007	x	x	x
1. Weihnachtstag – Christmas Day – Noël	25.12.2007	x	x	x
2. Weihnachtstag – Boxing Day – Lendemain de Noël	26.12.2007	x	x	x
Silvester – New Year's Eve – Saint-Sylvestre	31.12.2007	x	x	x

Annex 3

2008

Jan	Feb	Mar	Apr	May	Jun	Jul	Aug	Sep	Oct	Nov	Dec
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Tage/Days/Jours		München Munich	Den Haag The Hague La Haye	Berlin
Neujahr - New Year's Day - Nouvel An	01.01.08	x	x	x
Karfreitag - Good Friday - Vendredi Saint	21.03.08	x	x	x
Ostermontag - Easter Monday - Lundi de Pâques	24.03.08	x	x	x
Nationalfeiertag - National Holiday - Fête Nationale	30.04.08		x	
Maifeiertag - May Day - Fête du Travail	01.05.08	x	x	x
Christi Himmelfahrt - Ascension Day - Ascension	01.05.08	x	x	x
Tag der Befreiung - Liberation Day - Journée de la Liberation	05.05.08		x	
Pfingstmontag - Whit Monday - Lundi de Pentecôte	12.05.08	x	x	x
Fronleichnam - Corpus Christi - Fête-Dieu	22.05.08	x		
Mariä Himmelfahrt - Assumption Day - Assomption	15.08.08	x		
Tag der Deutschen Einheit - Day of German Unity - Fête Nationale	03.10.08	x		x
Heiliger Abend - Christmas Eve - Veille de Noël	24.12.08	x	x	x
1. Weihnachtstag - Christmas Day - Noël	25.12.08	x	x	x
2. Weihnachtstag - Boxing Day - Lendemain de Noël	26.12.08	x	x	x
Silvester - New Year's Eve - Saint-Sylvestre	31.12.08	x	x	x