

# EUROPEAN QUALIFYING EXAMINATION 2009

## PAPER D - PART I

This paper comprises:

- |                                                                                                                                                                                                                                                                                                                                         |                 |
|-----------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------|-----------------|
| * Questions 1 - 9                                                                                                                                                                                                                                                                                                                       | 2009/DI/e/1 - 5 |
| <ul style="list-style-type: none"><li>- Question 1 : 5 points</li><li>- Question 2 : 4 points</li><li>- Question 3 : 6 points</li><li>- Question 4 : 3 points</li><li>- Question 5 : 5 points</li><li>- Question 6 : 4 points</li><li>- Question 7 : 4 points</li><li>- Question 8 : 5 points</li><li>- Question 9 : 4 points</li></ul> |                 |

TOTAL: 40 POINTS

- |                                                                                                                                                                 |                 |
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| * Annex: calendars for 2007, 2008 and 2009 with indication of the days on which at least one of the EPO filing offices is not open for the receipt of documents | 2009/DI/e/6 - 8 |
|-----------------------------------------------------------------------------------------------------------------------------------------------------------------|-----------------|

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

## QUESTION 1

(5 points)

Last week Mr. McX, a British national living in the UK, filed the following documents at the EPO in Italian:

- a) European patent application EP-1,
- b) amendments to European patent application EP-2, which application was filed in French,
- c) an opposition to European patent EP-3, granted to an Italian, the opposition period having expired yesterday.

Have the documents been validly filed? Are translations required?

## QUESTION 2

(4 points)

You work as an employee in the patent department of Dutch company A, but you are not yet a professional representative before the EPO. By general authorisation, which has been filed with the EPO, you are allowed to represent company A for the filing of oppositions. Company A owns a subsidiary B, which is also a Dutch company and separate legal entity.

Company A plans to sell its subsidiary B and to transfer all assets and industrial property matters relating to the field of business of company B to a third company C; these industrial property matters include an opposition still to be filed. You have been asked to file this opposition with the EPO without appointing any professional representative. The opposition period expires today, 3 March 2009.

Discuss the options of filing the opposition in the name of A alone, of B alone, and of A and B jointly.

**QUESTION 3**

**(6 points)**

On 7 February 2007, applicant A filed a European patent application EP1. The publication of the search report of EP1 was mentioned in the European Patent Bulletin on 13 August 2008. Applicant A paid the designation fees for DE, FR and GB in January 2009.

A communication under Rule 112(1) EPC dated 20 February 2009 was sent to the applicant notifying him of the deemed withdrawal of the remaining designations.

Today, applicant A becomes aware that a separate invention, disclosed but not claimed in EP1, is particularly relevant in Ireland due to a competitor's activities there. The separate invention lacks unity with the independent claims of EP1.

Applicant A wants to obtain patent protection in Ireland for the separate invention.

How should he proceed?

**QUESTION 4**

**(3 points)**

Two weeks ago, applicant A duly filed a letter requesting the renewal fee for the seventh year with the additional fee for the belated payment to be debited from his deposit account with the EPO for the application EP-A. The letter indicated that the amount of EUR 847 should be debited for this purpose. Was the renewal fee validly paid?

**QUESTION 5**

**(5 points)**

An international application PCT-X was duly filed as a first filing with the French patent office in French by a French company in July 2007. This application was duly transferred to ROCOM, a company based in Romania. In the meantime PCT-X has been published.

ROCOM wants to proceed with PCT-X to international preliminary examination before the EPO and later to the European phase.

Can ROCOM use, in the written proceedings, Romanian or English for

- (a) the international phase,
- (b) the European phase?

**QUESTION 6**

**(4 points)**

Your client A has taken a licence under a European patent application owned by company B. Your client A wishes the grant of the licence to be recorded in the European Patent Register. Company B does not consent to such registration.

- a) Is the registration of the grant of A's licence from B nevertheless possible? If so, what steps have to be taken?
- b) If the licence is exclusive, is its registration as an exclusive licence possible? If so, what steps have to be taken?

**QUESTION 7**

**(4 points)**

In opposition proceedings before the EPO you represent an opponent who filed an admissible opposition within the opposition period which has now expired. No further opposition was filed. The opposition is based only on the ground that the subject-matter of the sole independent claim of the patent as granted extends beyond the content of the application as filed. On your client's instructions you withdrew the opposition.

Today, your client becomes aware of a clearly novelty destroying prior art document against the independent claim and wants to draw the attention of the opposition division to this document. From file inspection you find out that the withdrawal letter is already on file. The opposition division has not yet terminated the opposition proceedings.

Is there a possibility that the opposition division still considers the document?

**QUESTION 8**

**(5 points)**

A European patent application AP1 was duly filed on 23 February 2008 claiming priority from earlier application PR1 filed on 24 March 2007. Application AP1, as originally filed, contained 30 claims. At the search stage a non-unity objection was raised. The applicant paid one further search fee. The subject-matter of all claims was searched. Application AP1 is still pending.

Today, 3 March 2009, the applicant files a divisional application using form 1001. The divisional application contains a set of claims 1 to 20, which correspond to claims 11 to 30 originally filed in AP1. Claims 1 to 20 of the divisional application relate to the second invention already searched in AP1.

What fees are due on filing and until when can these fees be paid? What is the legal basis for the amounts of these fees?

**QUESTION 9**

**(4 Points)**

A European patent application EP1 was filed with the European Patent Office on 21 March 2005. No priority was claimed. DE, GB and NL were designated.

The search report showed a European patent application D1, which has a priority date earlier than the filing date of EP1 and which has been published after the filing date of EP1. D1 validly designates FR, AT and TR and anticipates the subject-matter of all claims of EP1.

The search report also cites a document D2, which was published before the filing date of EP1 and which anticipates only the subject-matter of claim 1.

After a first communication, the applicant amends the claims to render their subject-matter new and inventive over D2. In April 2008, one day after having received a communication under Rule 71(3) EPC, the applicant files a divisional application comprising the same application documents as in originally filed parent application EP1.

What is the relevance of D1 and D2 for the divisional application?

Annex 1

2007

| Jan    | Feb    | Mar    | Apr    | May    | Jun    | Jul    | Aug    | Sep    | Oct    | Nov    | Dec    |
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| Tage / Days / Jours                                              |                   | München<br>Munich | Den Haag<br>The Hague<br>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      |
| <b>Nationalfeiertag – National Holiday – Fête nationale</b>      | <b>30.04.2007</b> |                   | <b>x</b>                         |        |
| Maifeiertag – 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 2

2008

| Jan    | Feb    | Mar    | Apr    | May    | Jun    | Jul    | Aug    | Sep    | Oct    | Nov    | Dec    |
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| Tage/Days/Jours                                                  |          | München<br>Munich | Den Haag<br>The Hague<br>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      |

Annex 3

2009

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|---------------------------------------------------------------|------------|-------------------|----------------------------------|--------|
| Neujahr - New Year's Day - Nouvel An                          | 01.01.2009 | x                 | x                                | x      |
| Brückentag - Bridging Day - Pont                              | 02.01.2009 | x                 | x                                | x      |
| Heilige Drei Könige - Epiphany - Epiphanie                    | 06.01.2009 | x                 |                                  |        |
| Karfreitag - Good Friday - Vendredi Saint                     | 10.04.2009 | x                 | x                                | x      |
| Ostermontag - Easter Monday - Lundi de Pâques                 | 13.04.2009 | x                 | x                                | x      |
| Nationalfeiertag - National Holiday - Fête nationale          | 30.04.2009 |                   | x                                |        |
| Maifeiertag - May Day - Fête du Travail                       | 01.05.2009 | x                 | x                                | x      |
| Tag der Befreiung - Liberation Day - Journée de la Libération | 05.05.2009 |                   | x                                |        |
| Christi Himmelfahrt - Ascension Day - Ascension               | 21.05.2009 | x                 | x                                | x      |
| Brückentag - Bridging Day - Pont                              | 22.05.2009 | x                 | x                                | x      |
| Pfingstmontag - Whit Monday - Lundi de Pentecôte              | 01.06.2009 | x                 | x                                | x      |
| Fronleichnam - Corpus Christi - Fête-Dieu                     | 11.06.2009 | x                 |                                  |        |
| Heiliger Abend - Christmas Eve - Vieille de Noël              | 24.12.2009 | x                 | x                                | x      |
| 1. Weihnachtstag - Christmas Day - Noël                       | 25.12.2009 | x                 | x                                | x      |
| Silvester - New Year's Eve - Saint-Sylvestre                  | 31.12.2009 | x                 | x                                | x      |