

EUROPEAN QUALIFYING EXAMINATION 2010

Paper D

Part I

This paper comprises:

- * Questions 1 - 9 2010/DI/EN/1 - 5
 - Question 1 : 4 points
 - Question 2 : 5 points
 - Question 3 : 5 points
 - Question 4 : 4 points
 - Question 5 : 4 points
 - Question 6 : 5 points
 - Question 7 : 4 points
 - Question 8 : 5 points
 - Question 9 : 4 points

TOTAL: 40 POINTS

- * Annex: calendars for 2008, 2009 and 2010 with 2010/DI/EN/6 - 8
indication of the days on which at least one
of the EPO filing offices is not open for the
receipt of documents

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

QUESTION 1

(4 points)

Opponent O duly files an opposition to a European patent, the patent comprising an independent product claim 1 relating to product A and another independent process claim 2 relating to process B.

In the notice of opposition, O opposes the patent with respect to claim 1 only. The grounds and the reasoning relate to lack of inventive step.

O does not make any further written submissions prior to the oral proceedings.

At the beginning of the oral proceedings, O informs the opposition division that he had found by chance a highly pertinent prior art document Dn which destroys the novelty of both claims. Therefore, he argues that claims 1 and 2 are not novel and now requests the revocation of the patent in its entirety.

What are the chances of success for the last request of the opponent?

QUESTION 2

(5 points)

A European patent application EP-1 was filed claiming a football made of 33 patches of a special plastics material, PX. According to the description, the provision of the 33 patches made of PX is essential for achieving the surprising technical effect of improved flight characteristics. Furthermore, a method of stitching the patches together is disclosed but not claimed. No relevant prior art is available. DIV-1, a divisional application of EP-1, was filed shortly before EP-1 was withdrawn. DIV-1 discloses and claims only said football. DIV-2, a divisional application of DIV-1, was filed one week before DIV-1 was withdrawn. At the moment, only DIV-2 is pending. DIV-2 has the same description and claims as EP1.

Now the applicant wants to claim a football with any number of patches made of PX since he has found out that the technical effect can also be achieved with other numbers of patches made of PX. He further wants to have a claim to the stitching method.

For what subject matter can the applicant have protection via DIV-2 and how?

QUESTION 3

(5 points)

German applicant X duly filed a German patent application DE-X on 27.02.2009. X then wanted to file an international application PCT-X claiming the priority of DE-X. On 25.02.2010, X sent PCT-X as a registered letter to the EPO in Munich.

Normally, that letter would have arrived at its destination within two days of mailing. However, due to an accident of the delivery truck, the letter only reaches the EPO today, 02.03.2010.

- a) Has the priority been validly claimed?
- b) If not, what steps have to be taken to obtain a valid claim to priority?

QUESTION 4

(4 points)

Applicant A filed a Chinese patent application CN-A as a first filing on 01.07.2008. The subject-matter of the application is new and inventive. CN-A was published on 10.01.2010. On 21.12.2009, applicant A sends a letter with his letterhead by fax to the EPO indicating that he seeks a European patent. The letter contains neither description nor claims but a reference to previously filed CN-A. The subject-matter of CN-A was not made available to the public otherwise. The EPO communicates to the applicant the date of filing of EP-A as being 21.12.2009. The applicant now intends to file an international application PCT-A claiming priority from EP-A.

- a) Which requirements did EP-A have to meet to get a date of filing accorded by the EPO.
- b) Discuss the legal situation of PCT-A.

QUESTION 5

(4 points)

Your client, US company USCO, filed two international applications, PCT-U and PCT-E. PCT-U was searched by the USPTO as International Searching Authority (ISA). PCT-E was searched by the EPO as ISA. In each case, the ISA made a finding of lack of unity, with PCT-U containing inventions PCT-U1 and PCT-U2, and PCT-E containing inventions PCT-E1 and PCT-E2. Only inventions PCT-U1 and PCT-E1 were searched. In January 2010, both applications were duly regionalised before the EPO. The inventions first mentioned in the claims were PCT-U1 and PCT-E1, respectively.

Your client now wants to prosecute the applications in the European phase on the basis of PCT-U2 and PCT-E2 only. How should he proceed?

QUESTION 6

(5 points)

Company X obtained a European patent with a single claim directed to a new product comprising compound C in the range of 3-40%. The grant was mentioned in the European Patent Bulletin on 09.11.2009. Company X filed a translation of the patent specification on 22.01.2010 for Italy. Due to an error in the translation, compound C is specified to be in the range of 3-4% in the single claim. Thereafter the Italian company Y started to produce and sell the new product with 20% of compound C in Italy.

Can company X stop company Y selling the new product with 20% of compound C in Italy?

QUESTION 7

(4 points)

A European patent application EP1 was filed in English on 13.02.2008, validly claiming priority from Danish national application DK1 filed on 23.03.2007. The mention of the grant of EP1 is to be published in the European Patent Bulletin on 04.03.2010. The applicant desires to validate the patent in Denmark, France and Italy.

- a) When was the first renewal fee due to the EPO?
- b) When is the first renewal fee due to the national offices and until when can it be paid without surcharge?
- c) Which translations have to be supplied to the national offices?

QUESTION 8

(5 points)

A European patent application EP1 was filed on 16.01.2010 by reference to US patent application US1 and indicating that the reference also replaces the claims. US1 comprises a single independent claim 1 and 24 dependent claims.

- a) What claim fees have to be paid for EP1 and by when? The applicant wants to pay these fees as late as possible but to avoid any unnecessary payments.
- b) The applicant wants to reduce the number of claims and keep only claims 1-15. Which actions does he have to take?
- c) Advise whether the claims 16 – 25 could be reintroduced at a later stage in the proceedings and on possible costs.

QUESTION 9

(4 Points)

Proprietor P received a communication from the Opposition Division according to Art. 101(1) EPC and dated 05.01.2009. In this communication P was invited to file observations in response to a submission of opponent O within a period of 4 months.

Subsequent to the communication, a third party T provided evidence that he had instituted entitlement proceedings against P. As a consequence, the opposition proceedings were stayed as from 08.05.2009. Some time later, P received a communication informing him that the opposition proceedings were to be resumed as from 04.01.2010. T lost the entitlement proceedings.

When does the time limit set by the communication according to Art.101(1) EPC expire?

Annex 1

2008

Jan	Feb	Mar	Apr	May	Jun	Jul	Aug	Sep	Oct	Nov	Dec
Tue 01	Fri 01	Sat 01	Tue 01	Thu 01	Sun 01	Tue 01	Fri 01	Mon 01	Wed 01	Sat 01	Mon 01
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Thu 31		Mon 31		Sat 31		Thu 31	Sun 31		Fri 31		Wed 31

Tage / Days / Jours		München Munich	Den Haag The Hague La Haye	Berlin
Neujahr - New Year's Day - Nouvel An	01.01.2008	x	x	x
Karfreitag - Good Friday - Vendredi Saint	21.03.2008	x	x	x
Ostermontag - Easter Monday - Lundi de Pâques	24.03.2008	x	x	x
Nationalfeiertag - National Holiday - Fête nationale	30.04.2008		x	
Mai feiertag - May Day - Fête du Travail	01.05.2008	x	x	x
Christi Himmelfahrt - Ascension Day - Ascension	01.05.2008	x	x	x
Tag der Befreiung - Liberation Day - Journée de la Libération	05.05.2008		x	
Pfingstmontag - Whit Monday - Lundi de Pentecôte	12.05.2008	x	x	x
Fronleichnam - Corpus Christi - Fête-Dieu	22.05.2008	x		
Mariä Himmelfahrt - Assumption Day - Assomption	15.08.2008	x		
Tag der Deutschen Einheit - Day of German Unity - Fête Nationale	03.10.2008	x		x
Heiliger Abend - Christmas Eve - Vieille de Noël	24.12.2008	x	x	x
1. Weihnachtstag - Christmas Day - Noël	25.12.2008	x	x	x
2. Weihnachtstag - Boxing Day - Lendemain de Noël	26.12.2008	x	x	x
Silvester - New Year's Eve - Saint-Sylvestre	31.12.2008	x	x	x

Annex 2

2009

Jan		Feb		Mar		Apr		May		Jun		Jul		Aug		Sep		Oct		Nov		Dec	
Thu 01	Sun 01	Sun 01	Sun 01	Wed 01	Fri 01	Mon 01	Wed 01	Sat 01	Tue 01	Thu 01	Sun 01	Tue 01	Sat 01	Tue 01	Thu 01	Sun 01	Mon 01	Wed 01	Fri 01	Mon 01	Wed 01	Thu 01	Sat 01
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Sat 03	Tue 03	Tue 03	Tue 03	Fri 03	Sun 03	Wed 03	Fri 03	Mon 03	Thu 03	Sat 03	Tue 03	Thu 03	Sat 03	Tue 03	Thu 03	Sun 03	Mon 03	Wed 03	Fri 03	Mon 03	Wed 03	Thu 03	Sat 03
Sun 04	Wed 04	Wed 04	Wed 04	Sat 04	Mon 04	Thu 04	Sat 04	Tue 04	Fri 04	Sun 04	Wed 04	Fri 04	Mon 04	Thu 04	Sun 04	Mon 04	Wed 04	Fri 04	Mon 04	Wed 04	Thu 04	Sat 04	Sun 04
Mon 05	Thu 05	Thu 05	Thu 05	Sun 05	Tue 05	Fri 05	Sun 05	Wed 05	Sat 05	Mon 05	Thu 05	Sat 05	Tue 05	Thu 05	Sun 05	Mon 05	Wed 05	Fri 05	Mon 05	Wed 05	Thu 05	Sat 05	Sun 05
Tue 06	Fri 06	Fri 06	Fri 06	Mon 06	Wed 06	Sat 06	Mon 06	Thu 06	Sun 06	Tue 06	Thu 06	Sat 06	Tue 06	Thu 06	Sun 06	Mon 06	Wed 06	Fri 06	Mon 06	Wed 06	Thu 06	Sat 06	Sun 06
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Tage / Days / Jours		München Munich	Den Haag The Hague La Haye	Berlin
Neujahr - New Year's Day - Nouvel An	01.01.2009	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

Annex 3

2010

Jan		Feb		Mar		Apr		May		Jun		Jul		Aug		Sep		Oct		Nov		Dec	
Fri	01	Mon	01	Mon	01	Thu	01	Sat	01	Tue	01	Thu	01	Sun	01	Wed	01	Fri	01	Mon	01	Wed	01
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Sun	31			Wed	31			Mon	31			Sat	31	Tue	31			Sun	31			Fri	31

Tage / Days / Jours		München Munich	Den Haag The Hague La Haye	Berlin
Neujahr - New Year's Day - Nouvel An	01.01.2010	x	x	x
Heilige Drei Könige - Epiphany - Epiphanie	06.01.2010	x		
Karfreitag - Good Friday - Vendredi Saint	02.04.2010	x	x	x
Ostermontag - Easter Monday - Lundi de Pâques	05.04.2010	x	x	x
Nationalfeiertag - National Holiday - Fête nationale	30.04.2010		x	
Tag der Befreiung - Liberation Day - Journée de la Libération	05.05.2010		x	
Christi Himmelfahrt - Ascension Day - Ascension	13.05.2010	x	x	x
Brückentag - Bridging Day - Pont	14.05.2010	x	x	x
Pfingstmontag - Whit Monday - Lundi de Pentecôte	24.05.2010	x	x	x
Fronleichnam - Corpus Christi - Fête-Dieu	03.06.2010	x		
Allerheiligen - All Saints' Day - Toussaint	01.11.2010	x		
Heiliger Abend - Christmas Eve - Vieille de Noël	24.12.2010	x	x	x
Silvester - New Year's Eve - Saint-Sylvestre	31.12.2010	x	x	x