

EUROPEAN QUALIFYING EXAMINATION 2010

Paper D

Part II

This paper comprises:

- * Client's letter including four (4) questions 2010/DII/EN/1 - 6

- * Annex: Calendars for 2008, 2009 and 2010 with indication of the days on which at least one of the EPO filing offices is not open for the receipt of documents 2010/DII/EN/7 - 9

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

You are a European patent attorney and this morning you received the following letter.

We, KA (Knowledge for All), are a research institution based in Scotland and we are very active in developing new methods, systems and apparatuses used in marine biology and diving.

We have contact with KM (Knowledge is Money), a Swedish research laboratory, which is doing research in a similar field.

On 12 January 2009, we filed at the EPO, without claiming priority, a European patent application EP1 for a new and revolutionary electromagnetic signal which attracts fish and thereby allows divers to photograph them. Such an electromagnetic signal attracts only adult fish, which are the most colourful ones. It works only in coastal regions.

EP1 discloses the structure of the signal as well as a way of producing it using conventional apparatuses and gives examples to prove that this signal really is effective for attracting adult fish. EP1 only discloses the use of the signal for underwater photography. EP1 includes only one claim defining the structure of the new signal, i.e the amplitudes and frequencies of the different components of the signal.

On 20 January 2009, we hosted a public conference attended by KM where we presented a video showing the effectiveness of this signal for attracting adult fish in order to photograph them. However, we did not disclose the characteristics of the signal, but we mentioned the application number EP 09123456 of EP1.

On 11 February 2009, we were very surprised to read on the KM public Internet site that on 10 February 2009, KM had filed at the EPO a European patent application, EPKM, without claiming priority. The content of EPKM was published on the KM public Internet site. The following statement in the description of EPKM shocked us: "The new signal developed by KA and explained in European patent application number EP09123456 (corresponding to EP1) filed on 12 January 2009 allows a new fishing method which permits a better regulation of fish stocks." The only claim of EPKM reads: "Fishing method characterised by use of an electromagnetic signal attracting only adult fish in a coastal region, said signal being emitted by transmitters integrated into a fishing net."

We asked KM for an explanation and they replied that they had the idea of developing such a fishing method. The combination of a fishing net and transmitters is, without doubt, new and inventive.

We also invented a new electronic filter F1 for producing the signal disclosed in EP1, this filter being so small that it can be connected to the standard electronic circuit C of an underwater camera. The new circuit C1, which is constituted by the combination of F1 and C, can still be incorporated into a standard underwater camera.

Then on 1 March 2009 we filed a new European patent application EP2 without claiming priority. The description of EP2 includes the complete description of EP1 as pages 1 to 5 and adds pages 6 to 10, which disclose the new electronic filter F1 on pages 6 to 9 and the new circuit C1 on page 10. We mentioned in the description that the final new circuit C1 is so compact that it can be included in an underwater camera.

EP2 includes the following claims: the structure of the signal as claim 1 (same claim 1 as in EP1), the filter F1 as claim 2 and the circuit C1 as claim 3.

In September 2009, we received the European search report with one document cited as "A" and a positive European Search Opinion for EP1, which is apparently ready for grant.

Also in September 2009, KM received the European search report for EPKM, with the same document cited as "A" and a positive European Search Opinion. The search report and the accompanying opinion are available on KM's public Internet site.

EPKM also appears to be ready for grant.

In November 2009, we received the European search report for EP2. The same "A" document was cited but the accompanying opinion was partly negative because the EPO examiner stated - and, according to our technical department, he was right - that the disclosed circuit C1 could not produce any signal. In fact we had failed to describe an essential and inventive electrical connection in circuit C1 between filter F1 and standard circuit C. According to the examiner, claim 1 and claim 2 are allowable.

We then filed on 12 January 2010 a new European patent application EP3, as usual without claiming priority, by adding to the description of EP2 pages 11 and 12, which describe the essential and inventive electrical connection in C1 between the filter F1 and the standard circuit C. The circuit claim, claim 3, was modified accordingly.

At the beginning of every year, KA makes a report which includes a summary of the research carried out during the previous year and we annex to this report a copy of our most interesting patent application. This year we decided to annex a copy of EP3. While preparing the report, we realised we had forgotten to file pages 6 to 9 of the description of EP3, which concern the new filter F1. The report, however, includes the complete version of EP3 with all pages 1 to 12 of the description as well as the claims.

The report was first made accessible at the end of January 2010 in our public library but nobody has consulted it so far.

We will send the report to our principal sponsors at the end of March 2010.

On 2 February 2010, we transmitted the missing pages 6 to 9 to the EPO in order to correct EP3.

On 19 February 2010, we received a communication according to Rule 56 EPC dated 17 February 2010 notifying us that the filing date of EP3 had been changed to 2 February 2010.

We are not interested in having a patent for a fishing method and we do not want KM or anyone else to have a patent for the fishing method disclosed in EPKM.

- 1) This is our main concern. How can we achieve this objective?
- 2) Keeping our main concern in mind, how can we improve our patent situation in Europe?

Last week we were contacted by Norwayfish (NF), which is one of our most important sponsors.

The only activity of Norwayfish (NF) is operating fish farms in Norway. Since June 2009, Norwayfish (NF) have been using for their fish farm nets a material M particularly well adapted for resisting the storms of the Norwegian Sea. Each farm of Norwayfish (NF) manufactures its own nets locally.

Swedishfish (SF) is a Swedish firm, a competitor of Norwayfish (NF). All fish farms of Swedishfish (SF) are located in Norway.

Swedishfish (SF) has developed a fish farm net using the same material M.

Each farm of Swedishfish (SF) manufactures its own nets locally.

Swedishfish (SF) filed a Swedish patent application, S1, in October 2007 and a European patent application, EPF, validly claiming the priority of S1, in February 2008. EPF was granted without amendment and the mention of the grant of the patent was published on 9 September 2009. The patent has been duly validated in all EPC contracting states.

EPF discloses and claims fish farm nets made of material M.

Norwayfish (NF) have asked us if we could help them because they are being sued for infringement of EPF in Norway.

We have looked into the matter and found the following:

We have developed together with a Japanese research institution JU the same technology as Swedishfish (SF).

We filed a PCT application (PCTJU) and an EP application (EP4) with JU as co-applicant for both applications.

The two applications were filed on the same day in May 2007, at the EPO for EP4 and at the Japan Patent Office for PCTJU, both without claiming priority, and both designating all possible states.

Both applications were published in November 2008.

JU was in charge of the prosecution of PCTJU filed in Japanese and we were responsible for prosecuting EP4.

The content of the two applications was almost the same, disclosing and claiming fish farm nets made of materials belonging to class G.

The description of PCTJU was more detailed and described the use of the known material M, which belongs to class G, for making fish farm nets.

JU informed us in February 2010 that, as they were no longer interested in this kind of technology, they would be happy to transfer their patent rights to us if we wanted to continue alone with the prosecution of the patent applications.

We have not replied to this offer.

We have seen from the European Patent Register that the PCTJU application was deemed to be withdrawn at the EPO according to a communication dated 4 January 2010 because none of the requirements for entering the regional phase was fulfilled.

The search report of EPF cites only EP4, and during the examination of EPF before the EPO only EP4 was mentioned by the examiner.

Nevertheless, for reasons that we do not understand, EPF was granted.

Last week we also received a communication according to Rule 71(3) EPC for EP4.

3) Can we help Norwayfish (NF) in their conflict with Swedishfish (SF)?

4) Can patent rights be used against Swedishfish (SF)?

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
Wed 02	Sat 02	Sun 02	Wed 02	Fri 02	Mon 02	Wed 02	Sat 02	Tue 02	Thu 02	Sun 02	Tue 02
Thu 03	Sun 03	Mon 03	Thu 03	Sat 03	Tue 03	Thu 03	Sun 03	Wed 03	Fri 03	Mon 03	Wed 03
Fri 04	Mon 04	Tue 04	Fri 04	Sun 04	Wed 04	Fri 04	Mon 04	Thu 04	Sat 04	Tue 04	Thu 04
Sat 05	Tue 05	Wed 05	Sat 05	Mon 05	Thu 05	Sat 05	Tue 05	Fri 05	Sun 05	Wed 05	Fri 05
Sun 06	Wed 06	Thu 06	Sun 06	Tue 06	Fri 06	Sun 06	Wed 06	Sat 06	Mon 06	Thu 06	Sat 06
Mon 07	Thu 07	Fri 07	Mon 07	Wed 07	Sat 07	Mon 07	Thu 07	Sun 07	Tue 07	Fri 07	Sun 07
Tue 08	Fri 08	Sat 08	Tue 08	Thu 08	Sun 08	Tue 08	Fri 08	Mon 08	Wed 08	Sat 08	Mon 08
Wed 09	Sat 09	Sun 09	Wed 09	Fri 09	Mon 09	Wed 09	Sat 09	Tue 09	Thu 09	Sun 09	Tue 09
Thu 10	Sun 10	Mon 10	Thu 10	Sat 10	Tue 10	Thu 10	Sun 10	Wed 10	Fri 10	Mon 10	Wed 10
Fri 11	Mon 11	Tue 11	Fri 11	Sun 11	Wed 11	Fri 11	Mon 11	Thu 11	Sat 11	Tue 11	Thu 11
Sat 12	Tue 12	Wed 12	Sat 12	Mon 12	Thu 12	Sat 12	Tue 12	Fri 12	Sun 12	Wed 12	Fri 12
Sun 13	Wed 13	Thu 13	Sun 13	Tue 13	Fri 13	Sun 13	Wed 13	Sat 13	Mon 13	Thu 13	Sat 13
Mon 14	Thu 14	Fri 14	Mon 14	Wed 14	Sat 14	Mon 14	Thu 14	Sun 14	Tue 14	Fri 14	Sun 14
Tue 15	Fri 15	Sat 15	Tue 15	Thu 15	Sun 15	Tue 15	Fri 15	Mon 15	Wed 15	Sat 15	Mon 15
Wed 16	Sat 16	Sun 16	Wed 16	Fri 16	Mon 16	Wed 16	Sat 16	Tue 16	Thu 16	Sun 16	Tue 16
Thu 17	Sun 17	Mon 17	Thu 17	Sat 17	Tue 17	Thu 17	Sun 17	Wed 17	Fri 17	Mon 17	Wed 17
Fri 18	Mon 18	Tue 18	Fri 18	Sun 18	Wed 18	Fri 18	Mon 18	Thu 18	Sat 18	Tue 18	Thu 18
Sat 19	Tue 19	Wed 19	Sat 19	Mon 19	Thu 19	Sat 19	Tue 19	Fri 19	Sun 19	Wed 19	Fri 19
Sun 20	Wed 20	Thu 20	Sun 20	Tue 20	Fri 20	Sun 20	Wed 20	Sat 20	Mon 20	Thu 20	Sat 20
Mon 21	Thu 21	Fri 21	Mon 21	Wed 21	Sat 21	Mon 21	Thu 21	Sun 21	Tue 21	Fri 21	Sun 21
Tue 22	Fri 22	Sat 22	Tue 22	Thu 22	Sun 22	Tue 22	Fri 22	Mon 22	Wed 22	Sat 22	Mon 22
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Fri 25	Mon 25	Tue 25	Fri 25	Sun 25	Wed 25	Fri 25	Mon 25	Thu 25	Sat 25	Tue 25	Thu 25
Sat 26	Tue 26	Wed 26	Sat 26	Mon 26	Thu 26	Sat 26	Tue 26	Fri 26	Sun 26	Wed 26	Fri 26
Sun 27	Wed 27	Thu 27	Sun 27	Tue 27	Fri 27	Sun 27	Wed 27	Sat 27	Mon 27	Thu 27	Sat 27
Mon 28	Thu 28	Fri 28	Mon 28	Wed 28	Sat 28	Mon 28	Thu 28	Sun 28	Tue 28	Fri 28	Sun 28
Tue 29	Fri 29	Sat 29	Tue 29	Thu 29	Sun 29	Tue 29	Fri 29	Mon 29	Wed 29	Sat 29	Mon 29
Wed 30		Sun 30	Wed 30	Fri 30	Mon 30	Wed 30	Sat 30	Tue 30	Thu 30	Sun 30	Tue 30
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	
Maifeiertag - 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	Wed	01	Fri	01	Mon	01	Wed	01	Sat	01	Tue	01	Thu	01	Sun	01	Tue	01
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Tage / Days / Jours		München Munich	Den Haag The Hague La Haye	Berlin
Neujahr - New Year's Day - Nouvel An	01.01.2009	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