

EUROPEAN QUALIFYING EXAMINATION 2011

Paper D

Part I

This paper comprises:

* Questions 1 - 8 2011/DI/EN/1 - 5

- Question 1 : 4 marks
- Question 2 : 6 marks
- Question 3 : 5 marks
- Question 4 : 5 marks
- Question 5 : 3 marks
- Question 6 : 6 marks
- Question 7 : 4 marks
- Question 8 : 7 marks

TOTAL: 40 MARKS

* Annexes: calendars for 2009, 2010 and 2011 with 2011/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 marks)

Yesterday, Company A received a warning letter from Company B requiring them to stop selling their product because it falls within the extent of protection of B's European patent. From a file inspection via the European Patent Register, Company A learns that the mention of grant was published on 28.04.2010 and that B's competitor C has filed a notice of opposition. The opposition proceedings are still pending.

Further, Company A knows of novelty destroying prior art which so far has not been drawn to the attention of the EPO.

What are Company A's options to have the patent revoked by the EPO?

QUESTION 2

(6 marks)

Your client validly filed a European application EP1 as a first filing containing independent apparatus claims 1, 2 and 3. Your client received from the EPO a first invitation dated 09.04.2010 to indicate which of the independent claims are to be searched because independent claims 1, 2 and 3 do not comply with Rule 43(2) EPC. All claims combine to form a single general inventive concept. Your client did not reply to the first invitation.

Your client received, with the European search opinion, a second invitation to correct deficiencies in the application. The publication of the European search report for EP1 was mentioned in the European patent bulletin on 25.08.2010. Your client did not reply to the second invitation. The request for examination has not been filed.

- a) When did the time limit for replying to each of the first and second invitations expire? Is it still possible to reply to these invitations?
- b) Your client intends to amend application EP1 so that examination will be carried out on the basis of original claim 3. What do you advise your client in order to obtain protection for the subject matter of claim 3?

QUESTION 3

(5 marks)

Your client filed an international patent application PCT1 on 01.12.2010, a few days before he presented his invention at a conference. PCT1 was filed using the latest version of form PCT/RO/101 with the EPO as receiving office claiming priority from a Belgian patent application validly filed on 01.12.2009. The Belgian as well as the international patent application were both filed in French.

The last four pages of the application documents of PCT1 containing the claims were not transmitted due to an error of your client. The EPO sent a letter dated 15.12.2010 informing your client that the requirements of Article 11(1) PCT for according a filing date are not met. No further communication was sent by the EPO. Your client did not react to the letter of the EPO.

Today 01.03.2011 your client asks you whether 01.12.2010 can be saved as filing date of PCT1.

QUESTION 4

(5 marks)

Spanish proprietor P, with residence in the UK, has a European patent EP which contains only two claims 1 and 2. The mention of grant of EP was published on 02.06.2010.

Your client C has informed P that the subject-matter of claims 1 and 2 of EP is not new in view of a publication X.

In reaction, on 02.12.2010, P requested limitation at the EPO of EP to the subject-matter of granted claim 2. C still thinks that the document X is novelty destroying for the subject-matter of granted claim 2.

a) What are the fees for this limitation?

b) C has prepared third party observations regarding the lack of novelty of the subject-matter of granted claim 2 and asks you for advice.

QUESTION 5

(3 marks)

Today you received a fax from your client, informing you that he wants to have a European patent on subject-matter Y. Moreover, he informed you that he disclosed Y at a symposium today and that he had filed in October 2009 an Icelandic patent application IS1 describing Y. He also informed you that he had withdrawn IS1 well before publication due to a financial crisis. He did not provide you with a copy of IS1 but told you the application number of IS1.

Your client cannot be contacted again until next week.

Is it possible to obtain protection for subject-matter Y via a European patent?

QUESTION 6

(6 marks)

A US applicant duly filed an international application containing 17 claims with the USPTO in English on 02.07.2009 claiming priority from a US national application filed on 03.07.2008. The international application was searched by the USPTO and published together with its search report in January 2010. Today 01.03.2011 the applicant calls you and wants to enter the European phase without any amendments.

What should be done and when, and which fees have to be paid?

QUESTION 7

(4 marks)

Patent proprietor P has a European patent EP with a claim A for the contracting states DE and FR and a claim B for the contracting states AT and BE. Claim A comprises all features of claim B and an additional feature X. Opponent O duly filed an opposition against the patent in its entirety on the grounds of lack of novelty. The patent was revoked because the subject matter of claim B was considered to be not novel. During appeal proceedings, appellant P requests the patent to be maintained with claim A for all the states DE, FR, AT and BE. Respondent O only notices now that feature X was not originally disclosed and raises a corresponding objection.

Assuming that feature X was not originally disclosed, can the European patent including claim A be maintained in proceedings before the EPO?

QUESTION 8

(7 marks)

Your client filed for his invention IN1 a French patent application FR1 on 01.03.2010 and a European application EP1 on 22.10.2010. An article published on 12.03.2010 disclosed invention IN1. Today 01.03.2011 your client informs you that he received a communication from the EPO dated 04.01.2011 inviting him to file a missing drawing. This missing drawing relates to prior art which is not relevant for invention IN1. He also informs you that for EP1, instead of claiming priority from FR1, he accidentally claimed priority from another French patent application FR2 filed on 22.10.2009 and disclosing another invention IN2.

The applicant does not want to file a new EP application and asks you for advice.

Annex 1

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
Fri 02	Mon 02	Mon 02	Thu 02	Sat 02	Tue 02	Thu 02	Sun 02	Wed 02	Fri 02	Mon 02	Wed 02
Sat 03	Tue 03	Tue 03	Fri 03	Sun 03	Wed 03	Fri 03	Mon 03	Thu 03	Sat 03	Tue 03	Thu 03
Sun 04	Wed 04	Wed 04	Sat 04	Mon 04	Thu 04	Sat 04	Tue 04	Fri 04	Sun 04	Wed 04	Fri 04
Mon 05	Thu 05	Thu 05	Sun 05	Tue 05	Fri 05	Sun 05	Wed 05	Sat 05	Mon 05	Thu 05	Sat 05
Tue 06	Fri 06	Fri 06	Mon 06	Wed 06	Sat 06	Mon 06	Thu 06	Sun 06	Tue 06	Fri 06	Sun 06
Wed 07	Sat 07	Sat 07	Tue 07	Thu 07	Sun 07	Tue 07	Fri 07	Mon 07	Wed 07	Sat 07	Mon 07
Thu 08	Sun 08	Sun 08	Wed 08	Fri 08	Mon 08	Wed 08	Sat 08	Tue 08	Thu 08	Sun 08	Tue 08
Fri 09	Mon 09	Mon 09	Thu 09	Sat 09	Tue 09	Thu 09	Sun 09	Wed 09	Fri 09	Mon 09	Wed 09
Sat 10	Tue 10	Tue 10	Fri 10	Sun 10	Wed 10	Fri 10	Mon 10	Thu 10	Sat 10	Tue 10	Thu 10
Sun 11	Wed 11	Wed 11	Sat 11	Mon 11	Thu 11	Sat 11	Tue 11	Fri 11	Sun 11	Wed 11	Fri 11
Mon 12	Thu 12	Thu 12	Sun 12	Tue 12	Fri 12	Sun 12	Wed 12	Sat 12	Mon 12	Thu 12	Sat 12
Tue 13	Fri 13	Fri 13	Mon 13	Wed 13	Sat 13	Mon 13	Thu 13	Sun 13	Tue 13	Fri 13	Sun 13
Wed 14	Sat 14	Sat 14	Tue 14	Thu 14	Sun 14	Tue 14	Fri 14	Mon 14	Wed 14	Sat 14	Mon 14
Thu 15	Sun 15	Sun 15	Wed 15	Fri 15	Mon 15	Wed 15	Sat 15	Tue 15	Thu 15	Sun 15	Tue 15
Fri 16	Mon 16	Mon 16	Thu 16	Sat 16	Tue 16	Thu 16	Sun 16	Wed 16	Fri 16	Mon 16	Wed 16
Sat 17	Tue 17	Tue 17	Fri 17	Sun 17	Wed 17	Fri 17	Mon 17	Thu 17	Sat 17	Tue 17	Thu 17
Sun 18	Wed 18	Wed 18	Sat 18	Mon 18	Thu 18	Sat 18	Tue 18	Fri 18	Sun 18	Wed 18	Fri 18
Mon 19	Thu 19	Thu 19	Sun 19	Tue 19	Fri 19	Sun 19	Wed 19	Sat 19	Mon 19	Thu 19	Sat 19
Tue 20	Fri 20	Fri 20	Mon 20	Wed 20	Sat 20	Mon 20	Thu 20	Sun 20	Tue 20	Fri 20	Sun 20
Wed 21	Sat 21	Sat 21	Tue 21	Thu 21	Sun 21	Tue 21	Fri 21	Mon 21	Wed 21	Sat 21	Mon 21
Thu 22	Sun 22	Sun 22	Wed 22	Fri 22	Mon 22	Wed 22	Sat 22	Tue 22	Thu 22	Sun 22	Tue 22
Fri 23	Mon 23	Mon 23	Thu 23	Sat 23	Tue 23	Thu 23	Sun 23	Wed 23	Fri 23	Mon 23	Wed 23
Sat 24	Tue 24	Tue 24	Fri 24	Sun 24	Wed 24	Fri 24	Mon 24	Thu 24	Sat 24	Tue 24	Thu 24
Sun 25	Wed 25	Wed 25	Sat 25	Mon 25	Thu 25	Sat 25	Tue 25	Fri 25	Sun 25	Wed 25	Fri 25
Mon 26	Thu 26	Thu 26	Sun 26	Tue 26	Fri 26	Sun 26	Wed 26	Sat 26	Mon 26	Thu 26	Sat 26
Tue 27	Fri 27	Fri 27	Mon 27	Wed 27	Sat 27	Mon 27	Thu 27	Sun 27	Tue 27	Fri 27	Sun 27
Wed 28	Sat 28	Sat 28	Tue 28	Thu 28	Sun 28	Tue 28	Fri 28	Mon 28	Wed 28	Sat 28	Mon 28
Thu 29		Sun 29	Wed 29	Fri 29	Mon 29	Wed 29	Sat 29	Tue 29	Thu 29	Sun 29	Tue 29
Fri 30		Mon 30	Thu 30	Sat 30	Tue 30	Thu 30	Sun 30	Wed 30	Fri 30	Mon 30	Wed 30
Sat 31		Tue 31		Sun 31		Fri 31	Mon 31		Sat 31		Thu 31

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 2

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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Tue	05	Fri	05	Fri	05	Mon	05	Wed	05	Sat	05	Mon	05	Thu	05	Sun	05	Tue	05	Fri	05	Sun	05
Wed	06	Sat	06	Sat	06	Tue	06	Thu	06	Sun	06	Tue	06	Fri	06	Mon	06	Wed	06	Sat	06	Mon	06
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Sat	30			Tue	30	Fri	30	Sun	30	Wed	30	Fri	30	Mon	30	Thu	30	Sat	30	Tue	30	Thu	30
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

Annex 3

2011

Jan		Feb		Mar		Apr		May		Jun		Jul		Aug		Sep		Oct		Nov		Dec	
Sat	01	Tue	01	Tue	01	Fri	01	Sun	01	Wed	01	Fri	01	Mon	01	Thu	01	Sat	01	Tue	01	Thu	01
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Sun	23	Wed	23	Wed	23	Sat	23	Mon	23	Thu	23	Sat	23	Tue	23	Fri	23	Sun	23	Wed	23	Fri	23
Mon	24	Thu	24	Thu	24	Sun	24	Tue	24	Fri	24	Sun	24	Wed	24	Sat	24	Mon	24	Thu	24	Sat	24
Tue	25	Fri	25	Fri	25	Mon	25	Wed	25	Sat	25	Mon	25	Thu	25	Sun	25	Tue	25	Fri	25	Sun	25
Wed	26	Sat	26	Sat	26	Tue	26	Thu	26	Sun	26	Tue	26	Fri	26	Mon	26	Wed	26	Sat	26	Mon	26
Thu	27	Sun	27	Sun	27	Wed	27	Fri	27	Mon	27	Wed	27	Sat	27	Tue	27	Thu	27	Sun	27	Tue	27
Fri	28	Mon	28	Mon	28	Thu	28	Sat	28	Tue	28	Thu	28	Sun	28	Wed	28	Fri	28	Mon	28	Wed	28
Sat	29			Tue	29	Fri	29	Sun	29	Wed	29	Fri	29	Mon	29	Thu	29	Sat	29	Tue	29	Thu	29
Sun	30			Wed	30	Sat	30	Mon	30	Thu	30	Sat	30	Tue	30	Fri	30	Sun	30	Wed	30	Fri	30
Mon	31			Thu	31			Tue	31			Sun	31	Wed	31			Mon	31			Sat	31

Tage / Days / Jours		München Munich	Den Haag The Hague La Haye	Berlin
Heilige Drei Könige - Epiphany - Epiphanie	06.01.2011	x		
Karfreitag - Good Friday - Vendredi Saint	22.04.2011	x	x	x
Ostermontag - Easter Monday - Lundi de Pâques	25.04.2011	x	x	x
Tag der Befreiung - Liberation Day - Journée de la Libération	05.05.2011		x	
Christi Himmelfahrt - Ascension Day - Ascension	02.06.2011	x	x	x
Brückentag - Bridging Day - Pont	03.06.2011	x	x	x
Pfingstmontag - Whit Monday - Lundi de Pentecôte	13.06.2011	x	x	x
Fronleichnam - Corpus Christi - Fête-Dieu	23.06.2011	x		
Mariä Himmelfahrt - Assumption Day - Assomption	15.08.2011	x		
Tag der Deutschen Einheit - Day of German Unity - Fête Nationale	03.10.2011	x		x
Allerheiligen - All Saints' Day - Toussaint	01.11.2011	x		
2. Weihnachtstag - Boxing Day - Lendemain de Noël	26.12.2011	x	x	x