

EUROPEAN QUALIFYING EXAMINATION 2012

Paper D

Part I

This Paper comprises:

* Questions 1 - 8

2012/DI/EN/1-5

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

TOTAL: 40 MARKS

- * Annexes: calendars for 2010, 2011 and 2012 with indication of the days on which at least one of the EPO filing offices is not open for the receipt of documents

2012/DI/EN/6-8

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



QUESTION 1

(5 MARKS)

On 29 December 2011 you received a decision dated 27 December 2011 refusing your European patent application.

The last sentence of the decision reads as follows:

"As all the features of the independent claim are known from the prior art document D1, the application is refused for lack of novelty, Art. 56 EPC."

On 26 January 2012 you received a correction of the decision according to Rule 140 EPC for the same application. The correction is dated 24 January 2012. Only the last sentence was changed to "As all the features of the independent claim are known from the prior art document D1, the application is refused for lack of novelty, Art. 54 EPC".

Your client has not yet decided whether to file an appeal, but intends to take this decision in the next few weeks. However, he will call you this morning to discuss the further procedure.

What will you advise your client?



QUESTION 2

(6 MARKS)

For European patent application EP1, filed in English, the first communication from the examining division under Article 94(3) and Rule 71(1), (2) EPC dated 13 December 2007 raised only a lack of clarity objection. On 14 December 2009 a divisional application DIV1 of EP1 was filed in the same language as EP1 at the EPO in Munich. On 30 September 2010 a further divisional application DIV2 of EP1 was filed in the same language as EP1 at the EPO in Berlin.

The partial search report for DIV1 dated 6 October 2011 contained a statement regarding lack of unity. However, no additional search fee was paid.

EP1 and DIV2 were withdrawn on 28 January 2011.

- a) What were the filing requirements for divisional applications DIV1 and DIV2?
- b) Is it still possible to validly file further divisional applications?



QUESTION 3

(5 MARKS)

On 5 October 2010 your Spanish client filed a PCT application in Spanish with the Spanish Patent and Trade Mark Office (SPTO). No priority was claimed. Due to a lack of unity objection, which the client accepts, only the first invention was searched by the SPTO. However, your client wants a search to be carried out by the EPO on the second invention before deciding on entry into the national/regional phase but does not want to file a new application.

- a) Is this possible?
- b) If so, what steps have to be taken?

QUESTION 4

(4 MARKS)

Company X filed a draft of a scientific paper as a European patent application EP-X at the EPO. The draft describes compositions of the class A. The EPO accorded to application EP-X a date of filing of 20 December 2009. On 15 February 2010, company X filed, for EP-X, a claim directed to product A1, which was not described in the draft paper.

On 17 November 2010 company X filed an international application PCT1 at the USPTO with the description of EP-X and the same claim as above, claiming priority from EP-X. Company X received from the USPTO an international search report indicating only a single document, which discloses product A1. This document was made available to the public in March 2010.

- a) Is it possible to obtain valid patent protection via the claim directed to product A1 if PCT1 enters the European phase?
- b) How would the situation be different for PCT1 if the draft paper had disclosed A1?



QUESTION 5

(5 MARKS)

International application PCT-CN was filed in Chinese in September 2010 with the Chinese State Intellectual Property Office (SIPO). In March 2011 the applicant received the international search report from SIPO. In May 2011 the applicant filed with the International Bureau amended claims together with a brief statement explaining the amendments. The application will be published next week.

- a) Which parts of the publication will be in what language(s)?
- b) Will a French translation of the abstract be publicly available from WIPO?

QUESTION 6

(6 MARKS)

On 28 October 2010 your client filed an Italian application IT1 for invention Inv1 and an Italian application IT2 for invention Inv2. Inv1 and Inv2 are unitary. On 28 October 2011 your client duly filed a European application EP1 describing and claiming inventions Inv1 and Inv2. EP1 claims the priority of IT1 only. Your client has discovered a document D published on 8 August 2011 disclosing Inv1 and Inv2.

Your client wants to use EP1 to obtain Europe-wide protection for both Inv1 and Inv2.

What do you advise your client?



QUESTION 7

(4 MARKS)

Your client has developed the following way of diagnosing an illness:

- a) Carrying out a known method of biopsy by a medical practitioner to extract a liver tissue sample from a patient;
- b) carrying out a novel and inventive method for diagnosing the illness on the basis of the tissue sample in an analysing liquid.

Your client has informed you that the way in which the tissue sample is obtained is not an essential feature of his development.

Your client wants you to file a European patent application. Discuss the patentability of his development according to the EPC.

QUESTION 8

(5 MARKS)

European patent application EP1 was published on 10 March 2010. In reply to a communication of the examining division, the applicant filed amended claims containing improved subject-matter in June 2011. This improved subject-matter is new and inventive over the originally disclosed subject-matter, and, in itself, is sufficiently disclosed according to Art. 83 EPC. On 9 December 2011 the applicant filed a second European patent application EP2 describing and claiming the improved subject-matter.

Can the applicant obtain valid protection for the improved subject-matter via EP1 or EP2?



Annex 1

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
Sat 02	Tue 02	Tue 02	Fri 02	Sun 02	Wed 02	Fri 02	Mon 02	Thu 02	Sat 02	Tue 02	Thu 02
Sun 03	Wed 03	Wed 03	Sat 03	Mon 03	Thu 03	Sat 03	Tue 03	Fri 03	Sun 03	Wed 03	Fri 03
Mon 04	Thu 04	Thu 04	Sun 04	Tue 04	Fri 04	Sun 04	Wed 04	Sat 04	Mon 04	Thu 04	Sat 04
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
Thu 07	Sun 07	Sun 07	Wed 07	Fri 07	Mon 07	Wed 07	Sat 07	Tue 07	Thu 07	Sun 07	Tue 07
Fri 08	Mon 08	Mon 08	Thu 08	Sat 08	Tue 08	Thu 08	Sun 08	Wed 08	Fri 08	Mon 08	Wed 08
Sat 09	Tue 09	Tue 09	Fri 09	Sun 09	Wed 09	Fri 09	Mon 09	Thu 09	Sat 09	Tue 09	Thu 09
Sun 10	Wed 10	Wed 10	Sat 10	Mon 10	Thu 10	Sat 10	Tue 10	Fri 10	Sun 10	Wed 10	Fri 10
Mon 11	Thu 11	Thu 11	Sun 11	Tue 11	Fri 11	Sun 11	Wed 11	Sat 11	Mon 11	Thu 11	Sat 11
Tue 12	Fri 12	Fri 12	Mon 12	Wed 12	Sat 12	Mon 12	Thu 12	Sun 12	Tue 12	Fri 12	Sun 12
Wed 13	Sat 13	Sat 13	Tue 13	Thu 13	Sun 13	Tue 13	Fri 13	Mon 13	Wed 13	Sat 13	Mon 13
Thu 14	Sun 14	Sun 14	Wed 14	Fri 14	Mon 14	Wed 14	Sat 14	Tue 14	Thu 14	Sun 14	Tue 14
Fri 15	Mon 15	Mon 15	Thu 15	Sat 15	Tue 15	Thu 15	Sun 15	Wed 15	Fri 15	Mon 15	Wed 15
Sat 16	Tue 16	Tue 16	Fri 16	Sun 16	Wed 16	Fri 16	Mon 16	Thu 16	Sat 16	Tue 16	Thu 16
Sun 17	Wed 17	Wed 17	Sat 17	Mon 17	Thu 17	Sat 17	Tue 17	Fri 17	Sun 17	Wed 17	Fri 17
Mon 18	Thu 18	Thu 18	Sun 18	Tue 18	Fri 18	Sun 18	Wed 18	Sat 18	Mon 18	Thu 18	Sat 18
Tue 19	Fri 19	Fri 19	Mon 19	Wed 19	Sat 19	Mon 19	Thu 19	Sun 19	Tue 19	Fri 19	Sun 19
Wed 20	Sat 20	Sat 20	Tue 20	Thu 20	Sun 20	Tue 20	Fri 20	Mon 20	Wed 20	Sat 20	Mon 20
Thu 21	Sun 21	Sun 21	Wed 21	Fri 21	Mon 21	Wed 21	Sat 21	Tue 21	Thu 21	Sun 21	Tue 21
Fri 22	Mon 22	Mon 22	Thu 22	Sat 22	Tue 22	Thu 22	Sun 22	Wed 22	Fri 22	Mon 22	Wed 22
Sat 23	Tue 23	Tue 23	Fri 23	Sun 23	Wed 23	Fri 23	Mon 23	Thu 23	Sat 23	Tue 23	Thu 23
Sun 24	Wed 24	Wed 24	Sat 24	Mon 24	Thu 24	Sat 24	Tue 24	Fri 24	Sun 24	Wed 24	Fri 24
Mon 25	Thu 25	Thu 25	Sun 25	Tue 25	Fri 25	Sun 25	Wed 25	Sat 25	Mon 25	Thu 25	Sat 25
Tue 26	Fri 26	Fri 26	Mon 26	Wed 26	Sat 26	Mon 26	Thu 26	Sun 26	Tue 26	Fri 26	Sun 26
Wed 27	Sat 27	Sat 27	Tue 27	Thu 27	Sun 27	Tue 27	Fri 27	Mon 27	Wed 27	Sat 27	Mon 27
Thu 28	Sun 28	Sun 28	Wed 28	Fri 28	Mon 28	Wed 28	Sat 28	Tue 28	Thu 28	Sun 28	Tue 28
Fri 29		Mon 29	Thu 29	Sat 29	Tue 29	Thu 29	Sun 29	Wed 29	Fri 29	Mon 29	Wed 29
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 - Veille de Noël	24.12.2010	x	x	x
Silvester - New Year's Eve - Saint-Sylvestre	31.12.2010	x	x	x



Annex 2

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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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



Annex 3

2012

Jan		Feb		Mar		Apr		May		Jun		Jul		Aug		Sep		Oct		Nov		Dec	
Sun	01	Wed	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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Thu	26	Sun	26	Mon	26	Thu	26	Sat	26	Tue	26	Thu	26	Sun	26	Wed	26	Fri	26	Mon	26	Wed	26
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Mon	30			Fri	30	Mon	30	Wed	30	Sat	30	Mon	30	Thu	30	Sun	30	Tue	30	Fri	30	Sun	30
Tue	31			Sat	31			Thu	31			Tue	31	Fri	31			Wed	31			Mon	31

Tage / Days / Jours		München Munich	Den Haag The Hague La Haye	Berlin
Heilige Drei Könige - Epiphany - Epiphanie	06.01.2012	x		
Karfreitag - Good Friday - Vendredi Saint	06.04.2012	x	x	x
Ostermontag - Easter Monday - Lundi de Pâques	09.04.2012	x	x	x
Nationalfeiertag - National Holiday - Fête Nationale	30.04.2012		x	
Maifeiertag - Labour Day - Fête du Travail	01.05.2012	x	x	x
Christi Himmelfahrt - Ascension Day - Ascension	17.05.2012	x	x	x
Pfingstmontag - Whit Monday - Lundi de Pentecôte	28.05.2012	x	x	x
Fronleichnam - Corpus Christi - Fête-Dieu	07.06.2012	x		
Mariä Himmelfahrt - Assumption Day - Assomption	15.08.2012	x		
Tag der Deutschen Einheit - Day of German Unity - Fête Nationale	03.10.2012	x		x
Allerheiligen - All Saints' Day - Toussaint	01.11.2012	x		
Heiliger Abend - Christmas Eve - Veille de Noël	24.12.2012	x	x	x
1. Weihnachtstag - Christmas Day - Jour de Noël	25.12.2012	x	x	x
2. Weihnachtstag - Boxing Day - Lendemain de Noël	26.12.2012	x	x	x
Silvester - New Year's Eve - Saint-Sylvestre	31.12.2012	x	x	x

