

EUROPEAN QUALIFYING EXAMINATION 2023

Paper D1-1

This Paper comprises:

Part I: Legal Questions

Question 1: 10 marks

Question 2: 10 marks

Question 3: 7 marks

QUESTION 1

(10 MARKS)

Applicant A filed a European patent application EP-A, which describes and claims

- a first invention comprising two alternative solutions to a technical problem consisting of features B+C and B+D respectively, and
- a second invention consisting of features E+F.

The first and second inventions are not linked by a single general inventive concept. Only the first invention was searched, and relevant prior art was found only for B+C. In the light of the technical problem, it is directly and unambiguously apparent that feature B is indispensable for the function of the first invention.

Applicant A filed divisional applications DIV1 and DIV2, both based directly on EP-A. DIV1 as filed claims and describes only feature D. DIV2 as filed claims and describes only the combination B+D+F, wherein F is presented as an optional feature.

Subsequently, the examining division issued a written decision dated 3 January 2023, refusing EP-A on the ground that a claim directed to B+C lacked novelty.

Today, DIV1 and DIV2 are pending.

(a) Can valid patents be obtained for DIV1 and DIV2 and what should be done?

(b) Can applicant A still prosecute invention E+F and what should be done?

QUESTION 2

(10 MARKS)

On 5 May 2022, applicant B resident in France filed an international patent application PCT-B with the EPO as receiving Office. Applicant B intended to claim priority from the US application US-B filed by applicant B on 9 July 2021. While the priority claim in the request of PCT-B stated the correct filing date of US-B, it included a typographical error in one digit of the application number of US-B. The request contained a certified copy of US-B.

The description of PCT-B includes a statement that priority is claimed from US-B indicating the correct application number of US-B. Otherwise the description, the claims and the drawings are identical to those of US-B.

In May 2022, applicant B received an invitation issued by the EPO as receiving Office to correct the priority claimed in the request of PCT-B. Unfortunately, applicant B overlooked this invitation and did not reply to it.

The EPO acting as International Searching Authority transmitted the international search report to applicant B on 12 July 2022.

- (a) Is the priority claim considered to have been made for the purposes of the procedure under the PCT?
- (b) What is the last day to file a demand for international preliminary examination?
- (c) Is it still possible to rectify the priority claim in the international phase?

QUESTION 3

(7 MARKS)

Company C filed European patent application EP-C on 14 September 2018. The mention of the grant of EP-C was published on 8 June 2022.

Company D is concerned about infringing EP-C with its products sold in Germany since July 2022. Company D is preparing notice of opposition against EP-C and is confident that it will get the patent revoked.

Today, company D consults the European Patent Register and notices that the representative of company C sent a fax to the EPO containing both a request that EP-C be revoked and an order to debit the revocation fee from its deposit account.

Company D also noticed that company C has not yet paid any renewal fees to the German Patent and Trade Mark Office.

(a) What is the current status of the revocation proceedings for EP-C?

(b) Why should company D file opposition against EP-C?