

EUROPEAN QUALIFYING EXAMINATION 2022

Paper D1-2

This Paper comprises:

Part I: Legal Questions

Question 4: 6 marks

Question 5: 5 marks

Question 6: 8 marks

QUESTION 4

(6 MARKS)

Applicant D filed European patent application EP-D1 in January 2019. EP-D1 discloses a new raw material D1 and a method for obtaining it. EP-D1 was withdrawn in April 2019.

In March 2019, applicant D filed European patent application EP-D2 disclosing a method for producing a new product D2 starting from the raw material D1. EP-D2 does not teach how to obtain the raw material D1. Instead, the description of EP-D2 merely refers to the relevant part of EP-D1.

In February 2020, applicant D filed European patent application EP-D3 claiming priority from EP-D2. EP-D3 claims the same product D2 as disclosed in EP-D2. EP-D3 discloses the same method for producing D2, but from raw material D3. Raw material D3 has been available to the public since 2019.

Applicant D becomes aware of European patent application EP-D4, which was filed in January 2020 by a different applicant and published in July 2021. EP-D4 discloses product D2 and a method for producing D2 from raw material D3, the method being identical to the one disclosed in EP-D3.

- (a) Does EP-D2 sufficiently disclose product D2?
- (b) Is the subject-matter of the claim to product D2 in EP-D3 novel?

QUESTION 5**(5 MARKS)**

On 2 June 2020 company E filed European patent application EP-E claiming a composition comprising 5-40% of compound E1. EP-E claims the priority of a previous patent application JP-E filed with the Japan Patent Office by company E on 30 May 2019. JP-E discloses a composition comprising 10-20% of the compound E1.

The examiner cited an article disclosing a composition comprising 40% of the compound E1 and published in December 2017. When analysing the technical teaching of the article, the skilled person would immediately recognise that the disclosure is erroneous and that the only possible correction would be a composition comprising 15% of the compound E1.

Is the article novelty-destroying for the subject-matter claimed in EP-E?

QUESTION 6

(8 MARKS)

European patent EP-A was granted with independent claim 1 directed to apparatus A1 and independent claim 2 directed to apparatus A2.

Consider the following situations independently:

Situation 1: An admissible opposition was filed based on document D1. D1 is prior art according to Article 54(3) EPC and discloses apparatus A1 only. The sole opponent withdrew the opposition the day after the opposition period expired.

- (a) How will the opposition proceedings continue?
- (b) What can the patent proprietor do to address the lack of novelty?

Situation 2: An admissible opposition was rejected. The sole opponent filed an appeal together with a document D1. D1 is prior art according to Article 54(3) EPC and discloses apparatus A1 only. The opposition was subsequently withdrawn.

- (c) How will the appeal proceedings continue?
- (d) What steps can be taken before the EPO to address the lack of novelty?