

## EUROPEAN QUALIFYING EXAMINATION 2021

# Paper D1-2

This paper comprises:

- Question 3: 7 marks
- Question 4: 8 marks
- Question 5: 10 marks

## **Part I: Legal Questions**

### **QUESTION 3**

**(7 MARKS)**

Your client C has two pending European patent applications: EP-C1 and EP-C2. The search and examination fees for both applications were paid on filing.

As regards EP-C1, you received last week an invitation pursuant to Rule 58 EPC to file one or more claims.

EP-C2 was filed using EPO Form 1001, with the applicant waiving his right under Rule 70(2) EPC. The European search report was transmitted last month. It cited a novelty-destroying document.

Following a strategic reorientation, your client C is no longer interested in the two applications.

He asks you whether the search and/or examination fees can be refunded and at which rate. What do you have to do to obtain the refunds?

#### QUESTION 4

(8 MARKS)

On 8 June 2020 applicant D filed European patent application EP-D1 claiming priority from US patent application US-D filed on 7 June 2019. EP-D1 describes and claims a bolt made of metal. The contents of EP-D1 and US-D are identical.

The European search report for EP-D1 cites European patent application EP-D0 filed by applicant D in February 2019 and published in August 2020. EP-D0 relates to the same technical field and discloses the same bolt but made of aluminium. EP-D0 does not mention any other metal than aluminium.

- (a) Is EP-D0 novelty destroying for the subject-matter of the claim of EP-D1?
- (b) If yes, can the claim of EP-D1 be amended to make its subject-matter novel?
- (c) What would be the answer to (a) and (b) if EP-D0 had been early published in April 2020?

## QUESTION 5

(10 MARKS)

Applicant E, resident and national of Portugal, filed an international application PCT-E on 3 January 2021 at the EPO. The EPO was chosen as the International Searching Authority (ISA) in the request.

Last month, applicant E received a notification from the receiving Office dated 29 January 2021, inviting him to furnish a translation.

Consider the following situations:

**Situation A:** PCT-E was filed in Portuguese.

- (1) What is the receiving Office?
- (2) What translation must be filed and by when?

**Situation B:** PCT-E was filed in English, with the exception of the drawings, which contained text in Portuguese.

- (3) What is the receiving Office?
- (4) What translation must be filed and by when?