EN

EUROPEAN QUALIFYING EXAMINATION 2016

Paper D

This Paper comprises:

Part I (40 marks)

∗ Questions 1 - 5   2016/D/EN/1-5
  – Question 1: 6 marks
  – Question 2: 10 marks
  – Question 3: 7 marks
  – Question 4: 9 marks
  – Question 5: 8 marks

Part II (60 marks)

∗ Questions 1 – 3   2016/D/EN/6-8

TOTAL: 100 MARKS

∗ Annexes: calendars for 2014, 2015 and 2016   2016/D/EN/9-11
  with indication of the days on which at least
  one of the EPO filing offices is not open for the
  receipt of documents

Part I: Legal Questions

QUESTION 1   **(6 POINTS)**

During oral proceedings on 1 July 2015 the examining division decided to refuse European patent application EP-A. On 16 July 2015, applicant A received a notification of this decision dated 14 July 2015.

a) When did the time limit for filing a notice of appeal expire?

On 18 September 2015 applicant A filed a notice of appeal and paid the appeal fee.

Consider the following situations:

b1) Applicant A withdrew the appeal on 5 October 2015 without filing a statement of grounds of appeal. Will the appeal fee be reimbursed?

b2) On 5 October 2015 applicant A filed a statement of grounds of appeal. In February 2016, applicant A received from the Board of Appeal a communication under Rule 100(2) EPC. In response to the communication, applicant A immediately withdrew the appeal. Will the appeal fee be reimbursed?

QUESTION 2   **(10 POINTS)**

International patent application PCT-B was filed with the Italian Patent and Trademark Office acting as receiving Office on 7 February 2015. PCT-B does not claim priority of any previous application. No fees were paid.

International patent application PCT-C claiming priority of PCT-B was filed online with the EPO and received on 8 February 2016.

Applicant for PCT-B and PCT-C is MAXIMA, a firm established under Italian law and with its place of business in Milan. The contents of PCT-B and PCT-C are identical. Both applications are in Italian.

a. Will the priority be considered valid?

b. In which language(s) does a translation of PCT-C have to be filed? With which office does this translation have to be filed?

QUESTION 3   **(7 POINTS)**

In June 2014, applicant D filed international patent application PCT-D. PCT-D was filed in Russian with the Russian Patent Office as the receiving Office and searched by that Office as International Searching Authority (ISA). PCT-D validly claims priority from an earlier application filed by applicant D in April 2014. Applicant D wishes to obtain a patent for PCT-D in The Netherlands, Lithuania and Italy as soon as possible. The international patent application and the international search report were published in October 2015.

a. Applicant D asks you whether PCT-D can enter into the national phase in each of these countries to obtain a national patent. Please advise the applicant.

b. In a letter received by the EPO today (1 March 2016), the applicant expressly requests the EPO to immediately start the procedure for the grant of a European patent in respect of PCT-D. All fees required to enter the regional phase were duly paid today. What has to be done to ensure that the request for early processing is effective as of today?

c. What has to be done to ensure that the EPO starts the examination under Article 94 EPC as soon as possible?

QUESTION 4   **(9 POINTS)**

An international patent application PCT-E containing 17 claims was searched by the Japan Patent Office as International Searching Authority (ISA), before it duly entered into the European phase as EP-E.

Claims 1 to 16 relate to a first invention INV1.The subject-matter of claim 16 is not otherwise to be found in the description or drawings of PCT-E.

Independent claim 17 relates to a second invention INV2, which is not unitary with INV1. The subject-matter of claim 17 is disclosed in the description of PCT-E.

a) Assume that the applicant does not want to pay any claims fees or file amended claims

a1) On which claims will the supplementary European search be based?
a2) Can the applicant expect a patent to be granted for EP-E including the subject-matter of claim 16?
a3) Can the applicant expect a patent to be granted for EP-E including the subject-matter of claim 17?

b) Assume that the examining division informs the applicant of the text in which it intends to grant EP-E. After amendments filed during examination, the text intended for grant contains 19 claims. Are there any claims fees to be paid?

QUESTION 5   **(8 POINTS)**

Company F filed on 24 March 2014 an international patent application PCT-F in Japanese with the Japan Patent Office. PCT-F is directed to subject-matter F and validly claims priority of a Japanese patent application JP-F filed on 25 April 2013.

On 25 November 2015, company F filed all documents necessary for entering the regional phase before the EPO.

Because company F had failed to pay the filing fee pursuant to Rule 159(1)(c) EPC, the EPO issued a notification of loss of rights dated 15 January 2016.

On 24 May 2013, company G filed European patent application EP-G with a single claim which is directed to subject-matter F. EP-G does not claim priority of an earlier application. EP-G was granted without any amendments. The mention of the grant of a patent for EP-G was published in the European Patent Bulletin dated 25 November 2015.

Company F wants the patent for EP-G to be revoked in view of PCT-F.

Advise company F.

Part II: Legal Opinion

[001] Today, 01 March 2016, you receive a letter from Mr Berurier, R&D manager of San-Antonio (SA), a coffee maker having their principal place of business in France that produces coffee capsules. Disposable coffee capsules are well known and very popular. These coffee capsules are fed to a coffee machine that pierces the coffee capsule which contains coffee powder. The machine feeds hot water into the coffee capsule to make coffee.

[002] There is a problem with known coffee capsules made of plastic material because in the piercing step not all coffee capsules are pierced correctly and consequently the beverage quality is reduced.

[003] We developed a plastic coffee capsule with reinforcing ribs. The ribs make the coffee capsule more rigid leading to a more reliable piercing step. A single rib is sufficient to achieve this effect. On 12 December 2014 we validly filed a French patent application (FR-SA) disclosing in the description a plastic coffee capsule having a rib, without specifying the shape of the cross section of the rib. FR-SA also discloses in the description a plastic coffee capsule having a rib of triangular cross section (triangular rib), and a plastic coffee capsule having a rib of elliptical cross section (elliptical rib). FR-SA contains a single claim directed to a plastic coffee capsule having a rib, without specifying the shape of the cross section of the rib.

[004] We established that coffee capsules having ribs with a cross-section which is triangular or elliptical can be made of any plastic material. However, it is impossible to produce coffee capsules having ribs of other shapes of the cross-section unless they are made of plastic material X. These facts are disclosed in the description of our application FR-SA. Material X is known by a person skilled in the art.

[005]   On 14 December 2015 we validly filed a PCT patent application (PCT-SA), only claiming priority of FR-SA. This application includes the description and the claim of FR-SA.

[006]   Our main competitor is Swiss company "Big Coffee" (BC). They sent us a warning letter referring to their PCT patent application, PCT-BC, published on 11 February 2016. PCT-BC was validly filed in German by BC on 03 August 2015. PCT-BC claims priority from Swiss patent application CH-BC validly filed by BC on 01 August 2014. Both PCT-BC and CH-BC describe and claim a plastic coffee capsule having a rib and a plastic coffee capsule having an elliptical rib. Material X is not disclosed in CH-BC, nor is it disclosed in PCT-BC. In addition to the disclosure of CH-BC, PCT-BC discloses and claims a coffee powder containing additive G, which results in a surprisingly good coffee because the aromas are extracted very well. G is a known stabilizer for cosmetics. The search report for PCT-BC covers all claims and mentions no relevant prior art.

[007]   We are very upset because PCT-BC, not only claims a coffee capsule with a rib, but also claims coffee powder containing additive G. Coffee powder containing additive G was already disclosed and claimed in our French patent application FR1-SA, which was validly filed on 10 June 2013. FR1-SA was withdrawn in August 2013 without leaving any rights outstanding and without having served as a basis for claiming a right of priority. On 12 December 2014, we validly filed a French patent application FR2-SA, having the same description and claims as FR1-SA.

[008]   Luckily enough we included the description of FR2-SA also into our PCT-SA, so we assume that we have no problem with PCT-BC. The search report for FR2-SA does not mention relevant prior art.

[009] We have another concern with regard to Big Coffee. They have a European patent, EP1-BC granted in May 2012. The patent has a single claim relating to coffee capsules made of material X. No mention of ribs is made in EP1-BC. We have filed an opposition against EP1-BC on the ground of lack of novelty over common general knowledge, because material X was already widely used for packaging food.

[010] The opposition was rejected with a decision dated 30 December 2015 which was received on 05 January 2016. After the notification of the decision, our professional representative before the EPO, who is Dutch and has represented us so far in this matter, found a document D. D was published two years before the date of filing of EP1-BC and discloses coffee capsules made of material X, without mentioning ribs. Before leaving for an expedition to the South Pole, he sent us a copy of this document and filed a notice of appeal in Dutch. The appeal fee was paid.

Please let us know:

1. What is the patent situation as it currently stands with respect to
    a- plastic coffee capsules having an elliptical rib,
    b- plastic coffee capsules having a triangular rib,
    c- plastic coffee capsules having a rib,
    d- plastic coffee capsules made of material X,
    e- coffee powder containing additive G?

2. What actions can we take to improve our situation with regard to each of the above products?

3. After having taken these actions, can Big Coffee stop us from selling any of the above products in Europe, or can we stop Big Coffee from selling any of the above products in Europe?

2014

JANUARY
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FEBRUARY
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MARCH
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APRIL
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MAY
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JUNE
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JULY
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AUGUST
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SEPTEMBER
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OCTOBER
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NOVEMBER
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Tage / Days / Jours		München Munich	Den Haag The Hague La Haye	Berlin
Neujahr - New Year's Day - Nouvel An	01.01.2014	x	x	x
Heilige Drei Könige - Epiphany - Epiphanie	06.01.2014	x		
Karfreitag - Good Friday - Vendredi Saint	18.04.2014	x	x	x
Ostermontag - Easter Monday - Lundi de Pâques	21.04.2014	x	x	x
Maifeiertag - Labour Day - Fête du Travail	01.05.2014	x	x	x
Christi Himmelfahrt - Ascension Day - Ascension	29.05.2014	x	x	x
Pfingstmontag - Whit Monday - Lundi de Pentecôte	09.06.2014	x	x	x
Fronleichnam - Corpus Christi - Fête-Dieu	19.06.2014	x		
Mariä Himmelfahrt - Assumption Day - Assomption	15.08.2014	x		
Nationalfeiertag – National Holiday – Fête nationale	03.10.2014	x		x
Heiliger Abend - Christmas Eve - Veille de Noël	24.12.2014	x	x	x
1. Weihnachtstag - Christmas Day - Jour de Noël	25.12.2014	x	x	x
2. Weihnachtstag - Boxing Day - Lendemain de Noël	26.12.2014	x	x	x
Silvester - New Year's Eve - Saint-Sylvestre	31.12.2014	x	x	x

Annex 2

2015

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NOVEMBER
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Tage / Days / Jours		München Munich	Den Haag The Hague La Haye	Berlin
Neujahr - New Year's Day - Nouvel An	01.01.2015	x	x	x
Heilige Drei Könige - Epiphany - Epiphanie	06.01.2015	x		
Karfreitag - Good Friday - Vendredi Saint	03.04.2015	x	x	x
Ostermontag - Easter Monday - Lundi de Pâques	06.04.2015	x	x	x
Nationalfeiertag – National Holiday – Fête nationale	27.04.2015		x	
Maifeiertag - Labour Day - Fête du Travail	01.05.2015	x	x	x
Christi Himmelfahrt - Ascension Day - Ascension	14.05.2015	x	x	x
Pfingstmontag - Whit Monday - Lundi de Pentecôte	25.05.2015	x	x	x
Fronleichnam - Corpus Christi - Fête-Dieu	04.06.2015	x		
Heiliger Abend - Christmas Eve - Veille de Noël	24.12.2015	x	x	x
1. Weihnachtstag - Christmas Day - Jour de Noël	25.12.2015	x	x	x
Silvester - New Year's Eve - Saint-Sylvestre	31.12.2015	x	x	x

2016

JANUARY						
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Heilige Drei Könige - Epiphany - Epiphanie	06.01.2016	x		
Karfreitag - Good Friday - Vendredi Saint	25.03.2016	x	x	x
Ostermontag - Easter Monday - Lundi de Pâques	28.03.2016	x	x	x
Nationalfeiertag – National Holiday – Fête nationale	27.04.2016		x	
Christi Himmelfahrt - Ascension Day - Ascension	05.05.2016	x	x	x
Pfingstmontag - Whit Monday - Lundi de Pentecôte	16.05.2016	x	x	x
Fronleichnam - Corpus Christi - Fête-Dieu	26.05.2016	x		
Mariä Himmelfahrt - Assumption Day - Assomption	15.08.2016	x		
Nationalfeiertag – National Holiday – Fête nationale	03.10.2016	x		x
Allerheiligen - All Saints' Day - Toussaint	01.11.2016	x	x	x
2. Weihnachtstag - Boxing Day - Lendemain de Noël	26.12.2016	x	x	x