

## EUROPEAN QUALIFYING EXAMINATION 2019

# Paper D

This Paper comprises:

### Part I (40 marks)

\* Questions 1-5

2019/D/EN/1-5

- Question 1: 9 marks
- Question 2: 7 marks
- Question 3: 9 marks
- Question 4: 7 marks
- Question 5: 8 marks

### Part II (60 marks)

\* Questions 1-3

2019/D/EN/6-10

**TOTAL: 100 MARKS**

- \* Annexes: calendars for 2017, 2018 and 2019 with indication of the days on which at least one of the EPO filing offices is not open for the receipt of documents

2019/D/EN/11-13



**Part I: Legal Questions**

**QUESTION 1**

**(9 MARKS)**

Applicant A filed a European patent application EP-A with independent claims 1 and 3, and claim 2 dependent on claim 1. A communication according to Rule 71(3) EPC was issued today for EP-A as filed. Company B has validly instituted proceedings against applicant A before the competent national court of a EPC contracting state to seek a decision adjudging that Company B is entitled to the grant of EP-A.

Company B wants:

- (a) EP-A to proceed to grant with one claim combining original claims 1 and 2 after the competent court has issued a final decision that Company B is entitled to the grant of EP-A; and
- (b) claim 3 to be prosecuted in a separate European patent application.

How should Company B proceed before the EPO?



**QUESTION 2**

**(7 MARKS)**

Your client's competitor X filed international application PCT-X in English without claiming priority at the EPO as receiving Office on 13 April 2017. PCT-X comprises independent claim 1 relating to product A and dependent claim 2 relating to product A combined with feature B.

Your client is of the opinion that claim 2 lacks clarity. Your client also found a document making product A available to the public before the filing date of PCT-X.

Which procedural actions can you take while the competitor's application is pending:

- (a) during the international phase?
- (b) after PCT-X has entered the regional phase before the EPO?



**QUESTION 3**

**(9 MARKS)**

Last month applicant C filed on the last day of the priority period application X at the EPO claiming priority from his earlier German patent application DE1. DE1 describes capsules made from aluminium, and claims capsules made from aluminium and capsules made from metal. The description of application X is identical to the description of DE1. Applicant C intended to file a set of claims identical to the claims of DE1. Today, 26 February 2019, he realizes that he forgot to file any claims at all for X.

Between the priority date and the filing date, an article disclosing capsules made from aluminium and capsules made from metal was published.

Can applicant C still get protection for capsules made from aluminium and capsules made from metal, and what should C do if:

- (a) application X is a PCT application filed using request form PCT/RO/101?
- (b) application X is a European patent application?



**QUESTION 4**

**(7 MARKS)**

Your client Mr X has instructed you to file an opposition against European patent EP1 granted to his competitor Y. The mention of the grant was published on 30 May 2018. The sole claim of EP1 is directed to a device A. EP1 was filed on 16 June 2016 and claims priority from Korean patent application KR1 filed by Y on 30 June 2015. KR1 is written in Korean.

Mr X has only found as prior art a Canadian patent application CA1 also filed by competitor Y on 14 May 2014 and published on 19 November 2015. CA1 discloses the same device A.

- (a) Is the opposition against EP1 likely to succeed?
- (b) Will a translation of KR1 into an official language of the EPO be required during the opposition proceedings?



**QUESTION 5**

**(8 MARKS)**

PCT-X was duly filed with the EPO as PCT receiving Office. PCT-X contains two separate inventions. Upon filing you indicated on request form PCT/RO/101 that the EPO was chosen as International Searching Authority (ISA), and filed an automatic debit order.

You have received an invitation to pay one additional search fee dated 25 January 2019 from the EPO acting as ISA indicating that the requirements of unity of invention are not complied with.

You received an email today, 26 February 2019, informing you that the deposit account did not contain sufficient funds.

What will the international search report and written opinion of the ISA cover in the following situations?

- (a) You replenish the account up to the amount of one additional search fee today.
- (b) You gave, on 14 February 2019, an order to a banking establishment in a contracting state to transfer an amount of EUR 10 000 to the deposit account.



## Part II: Legal Opinion

Today, 26 February 2019, you receive a letter from Ms Fast:

Dear Attorney,

**[001]** I own the German shoe manufacturer FASTER (F), where I design and manufacture running shoes. My main markets are Germany and Austria, and my only factory is located in Germany. According to common general knowledge, shoe soles (S) are made of polymer foam. Nanoparticles (NP) are particles of less than 100 nanometers (nm) which have gained huge interest in the scientific world. This inspired me to experiment with shoe soles comprising nanoparticles in the polymer foam.

**[002]** During my research, I found out that all metal nanoparticles modify the foam structure of a shoe sole, thereby improving energy storage of the shoe sole. Such shoe soles return energy to the runner. In particular, I found out that copper nanoparticles up to 40 nm increase energy storage of shoe soles by 200% compared to soles without nanoparticles. Copper is a metal. On 19 January 2018 I filed at the EPO, in the name of FASTER and without claiming priority, the European patent application EP-F1 in German. EP-F1 describes the effect of increased energy storage, and claims a shoe sole comprising copper nanoparticles up to 40 nm.



**[003]** Afterwards, I found out that all metal nanoparticles increase energy storage of shoe soles by 40% compared to soles without nanoparticles. If the size of the metal nanoparticles is up to 80 nm, energy storage will be increased by 100%, and if the sole comprises copper nanoparticles up to 80 nm, energy storage will be increased by 150%. I therefore filed the European patent application EP-F2 at the EPO on 25 February 2018. I filed EP-F2 in German in the name of FASTER, and paid the filing fee and the search fee for EP-F2. EP-F2 contains the entire disclosure of EP-F1, and claims priority from EP-F1. EP-F2 describes the effect of increased energy storage, and describes and claims a shoe sole comprising metal nanoparticles (claim 1). EP-F2 also describes and claims a shoe sole comprising metal nanoparticles up to 80 nm (claim 2). Further, EP-F2 describes and claims a shoe sole comprising copper nanoparticles up to 80 nm (claim 3).

**[004]** In my most recent development, the shoe soles comprise silica nanoparticles in the range of from 35 to 45 nm (sole A). Silica is not a metal. Silica nanoparticles within that size range increase energy storage of the shoe soles by 300% compared to soles without nanoparticles. Such soles will give runners a significant advantage! I spent the last months with preparations for mass production of these soles. I want to start selling shoes with sole A in April 2019, but have not yet publicly announced anything.





**[005]** My Austrian competitor HIKE (H) is also active in the field of running shoes. HIKE's only factory is located in Austria. Last week, I performed a search on the Internet and found an announcement which was published on HIKE's website on 30 January 2019 (announcement A). This announcement stated that HIKE would start selling shoes with shoe soles comprising silica nanoparticles in the range of from 35 to 45 nm in April 2019. What a shock! These shoe soles have exactly the same composition as our sole A! After some investigations in my company, my - now former - employee Mr Furious finally admitted in a written statement that he was angry for not getting a promotion, and therefore had sold information on the composition of sole A to HIKE on 24 December 2018.

In announcement A, HIKE also states that these shoe soles are protected by HIKE's Austrian patent AT-H. I found out that AT-H was filed on 4 October 2015, published in April 2017, and that the mention of the grant of AT-H was published in January 2018. AT-H is in force, and describes and claims a shoe sole comprising nanoparticles. AT-H neither specifies the material nor the size of the nanoparticles, and also does not mention the effect of increased energy storage.

**[006]** During my Internet search, I also found another announcement on HIKE's website, published on 21 February 2018 (announcement B). In that announcement, HIKE stated that they had bought the European patent application EP-H, and that the transfer was registered with the EPO. HIKE further stated that they will soon produce and sell shoe soles comprising copper particles of from 70 to 80 nm (sole B), and that these soles are protected by their patent application EP-H.

As said, I also experimented with copper nanoparticles, and there is no doubt that copper particles of from 70 to 80 nm can be mixed into any polymer foam in order to produce sole B. I have realized that the manufacturing process becomes simple and cheap when the shoe soles have the composition of sole B. I am therefore very keen on manufacturing and selling shoes with sole B!



**[007]** EP-H was filed at the EPO in Chinese by the Chinese company LONG RUN on 18 August 2016. EP-H was published in English on 21 February 2018, and was granted without amendments. The mention of the grant of EP-H was published on 16 January 2019. The granted patent EP-H describes and claims a shoe sole comprising copper particles of from 70 to 80 nm. The only material described in EP-H is copper. I had the original Chinese text of the European patent application EP-H translated by a certified translator. The translator alerted me that the English publication of EP-H differs from the Chinese text, even though this is not obvious from the English text. The Chinese text of the patent application only mentions copper particles of from 70 to 80 micrometers ( $\mu\text{m}$ ), and it does not mention nanometers at all. One micrometer ( $\mu\text{m}$ ) equals 1000 nanometers (nm).

**[008]** By the way, I also filed a European patent application EP-F3 at the EPO in German in the name of FASTER on 2 February 2018 without claiming priority. The description of EP-F3 states that the addition of metal nanoparticles in the range of from 35 to 80 nm increases energy storage of shoe soles, and that any metal can be used. EP-F3 claims a shoe sole comprising metal nanoparticles in the range of from 35 to 80 nm. I intentionally never paid any fees for EP-F1 and for EP-F3 due to the intended filing of EP-F2. I received a notification of loss of rights for EP-F1 in June 2018, and a notification of loss of rights for EP-F3 in July 2018.



I am very upset about the announcements on HIKE's website, and therefore urgently need your advice! Please advise me on the following issues:

1. Outline the patent situation as it currently stands for the claims of FASTER's applications
  - (a) EP-F2
  - (b) EP-F1
  - (c) EP-F3.
  
2. As the situation currently stands, are FASTER or HIKE free to produce or sell the following products in Austria or Germany
  - (a) shoes with sole A,
  - (b) shoes with sole B?
  
3. How can you improve the situation for FASTER?



# Annex 1

2017

<b>JANUARY</b> M T W T F S S  2 3 4 5 6 7 8 9 10 11 12 13 14 15 16 17 18 19 20 21 22 23 24 25 26 27 28 29 30 31	<b>FEBRUARY</b> M T W T F S S  1 2 3 4 5 6 7 8 9 10 11 12 13 14 15 16 17 18 19 20 21 22 23 24 25 26 27 28	<b>MARCH</b> M T W T F S S  1 2 3 4 5 6 7 8 9 10 11 12 13 14 15 16 17 18 19 20 21 22 23 24 25 26 27 28 29 30 31	<b>APRIL</b> M T W T F S S   3 4 5 6 7 8 9 10 11 12 13 14 15 16 17 18 19 20 21 22 23 24 25 26 27 28 29 30
<b>MAY</b> M T W T F S S  1 2 3 4 5 6 7 8 9 10 11 12 13 14 15 16 17 18 19 20 21 22 23 24 25 26 27 28 29 30 31	<b>JUNE</b> M T W T F S S   1 2 3 4 5 6 7 8 9 10 11 12 13 14 15 16 17 18 19 20 21 22 23 24 25 26 27 28 29 30	<b>JULY</b> M T W T F S S    1 2 3 4 5 6 7 8 9 10 11 12 13 14 15 16 17 18 19 20 21 22 23 24 25 26 27 28 29 30 31	<b>AUGUST</b> M T W T F S S   1 2 3 4 5 6 7 8 9 10 11 12 13 14 15 16 17 18 19 20 21 22 23 24 25 26 27 28 29 30 31
<b>SEPTEMBER</b> M T W T F S S    1 2 3 4 5 6 7 8 9 10 11 12 13 14 15 16 17 18 19 20 21 22 23 24 25 26 27 28 29 30	<b>OCTOBER</b> M T W T F S S     1 2 3 4 5 6 7 8 9 10 11 12 13 14 15 16 17 18 19 20 21 22 23 24 25 26 27 28 29 30 31	<b>NOVEMBER</b> M T W T F S S   1 2 3 4 5 6 7 8 9 10 11 12 13 14 15 16 17 18 19 20 21 22 23 24 25 26 27 28 29 30	<b>DECEMBER</b> M T W T F S S     1 2 3 4 5 6 7 8 9 10 11 12 13 14 15 16 17 18 19 20 21 22 23 24 25 26 27 28 29 30 31

Tage / Days / Jours		München Munich	Den Haag The Hague La Haye	Berlin
Heilige Drei Könige - Epiphany – Epiphanie	06.01.2017	x		
Karfreitag - Good Friday - Vendredi Saint	14.04.2017	x	x	x
Ostermontag - Easter Monday - Lundi de Pâques	17.04.2017	x	x	x
Nationalfeiertag - National Holiday - Fête nationale	27.04.2017		x	
Maifeiertag - Labour Day - Fête du Travail	01.05.2017	x	x	x
Tag der Befreiung - Liberation Day - Journée de la Libération	05.05.2017		x	
Christi Himmelfahrt - Ascension Day - Ascension	25.05.2017	x	x	x
Pfingstmontag - Whit Monday - Lundi de Pentecôte	05.06.2017	x	x	x
Fronleichnam - Corpus Christi - Fête-Dieu	15.06.2017	x		
Mariä Himmelfahrt - Assumption Day – Assomption	15.08.2017	x		
Nationalfeiertag - National Holiday - Fête nationale	03.10.2017	x		x
Allerheiligen - All Saints' Day – Toussaint	01.11.2017	x		
1. Weihnachtstag – Christmas Day - Jour de Noël	25.12.2017	x	x	x
2. Weihnachtstag - Boxing Day - Lendemain de Noël	26.12.2017	x	x	x



## Annex 2

**2018**

JANUARY						
M	T	W	T	F	S	S
1	2	3	4	5	6	7
8	9	10	11	12	13	14
15	16	17	18	19	20	21
22	23	24	25	26	27	28
29	30	31				

FEBRUARY						
M	T	W	T	F	S	S
			1	2	3	4
5	6	7	8	9	10	11
12	13	14	15	16	17	18
19	20	21	22	23	24	25
26	27	28				

MARCH						
M	T	W	T	F	S	S
			1	2	3	4
5	6	7	8	9	10	11
12	13	14	15	16	17	18
19	20	21	22	23	24	25
26	27	28	29	30	31	

APRIL						
M	T	W	T	F	S	S
						1
2	3	4	5	6	7	8
9	10	11	12	13	14	15
16	17	18	19	20	21	22
23	24	25	26	27	28	29
30						

MAY						
M	T	W	T	F	S	S
	1	2	3	4	5	6
7	8	9	10	11	12	13
14	15	16	17	18	19	20
21	22	23	24	25	26	27
28	29	30	31			

JUNE						
M	T	W	T	F	S	S
				1	2	3
4	5	6	7	8	9	10
11	12	13	14	15	16	17
18	19	20	21	22	23	24
25	26	27	28	29	30	

JULY						
M	T	W	T	F	S	S
						1
2	3	4	5	6	7	8
9	10	11	12	13	14	15
16	17	18	19	20	21	22
23	24	25	26	27	28	29
30	31					

AUGUST						
M	T	W	T	F	S	S
		1	2	3	4	5
6	7	8	9	10	11	12
13	14	15	16	17	18	19
20	21	22	23	24	25	26
27	28	29	30	31		

SEPTEMBER						
M	T	W	T	F	S	S
					1	2
3	4	5	6	7	8	9
10	11	12	13	14	15	16
17	18	19	20	21	22	23
24	25	26	27	28	29	30

OCTOBER						
M	T	W	T	F	S	S
1	2	3	4	5	6	7
8	9	10	11	12	13	14
15	16	17	18	19	20	21
22	23	24	25	26	27	28
29	30	31				

NOVEMBER						
M	T	W	T	F	S	S
			1	2	3	4
5	6	7	8	9	10	11
12	13	14	15	16	17	18
19	20	21	22	23	24	25
26	27	28	29	30		

DECEMBER						
M	T	W	T	F	S	S
					1	2
3	4	5	6	7	8	9
10	11	12	13	14	15	16
17	18	19	20	21	22	23
24	25	26	27	28	29	30
31						

Tage / Days / Jours		München Munich	Den Haag The Hague La Haye	Berlin
Neujahr - New Year's Day - Nouvel An	01.01.2018	x	x	x
Karfreitag - Good Friday - Vendredi Saint	30.03.2018	x	x	x
Ostermontag - Easter Monday - Lundi de Pâques	02.04.2018	x	x	x
Nationalfeiertag - National Holiday - Fête nationale	27.04.2018		x	
Maifeiertag - Labour Day - Fête du Travail	01.05.2018	x	x	x
Christi Himmelfahrt - Ascension Day - Ascension	10.05.2018	x	x	x
Pfingstmontag - Whit Monday - Lundi de Pentecôte	21.05.2018	x	x	x
Fronleichnam - Corpus Christi - Fête-Dieu	31.05.2018			
Mariä Himmelfahrt - Assumption Day - Assomption	15.08.2018			
Nationalfeiertag - National Holiday - Fête nationale	03.10.2018	x		x
Allerheiligen - All Saints' Day - Toussaint	01.11.2018	x		
Heiliger Abend - Christmas Eve - Veille de Noël	24.12.2018	x	x	x
1. Weihnachtstag - Christmas Day - Jour de Noël	25.12.2018	x	x	x
2. Weihnachtstag - Boxing Day - Lendemain de Noël	26.12.2018	x	x	x
Silvester - New Year's Eve - Saint-Sylvestre	31.12.2018	x	x	x



## Annex 3

2019

<b>JANUARY</b> M T W T F S S 1 2 3 4 5 6 7 8 9 10 11 12 13 14 15 16 17 18 19 20 21 22 23 24 25 26 27 28 29 30 31	<b>FEBRUARY</b> M T W T F S S 1 2 3 4 5 6 7 8 9 10 11 12 13 14 15 16 17 18 19 20 21 22 23 24 25 26 27 28	<b>MARCH</b> M T W T F S S 1 2 3 4 5 6 7 8 9 10 11 12 13 14 15 16 17 18 19 20 21 22 23 24 25 26 27 28 29 30 31	<b>APRIL</b> M T W T F S S 1 2 3 4 5 6 7 8 9 10 11 12 13 14 15 16 17 18 19 20 21 22 23 24 25 26 27 28 29 30
<b>MAY</b> M T W T F S S 1 2 3 4 5 6 7 8 9 10 11 12 13 14 15 16 17 18 19 20 21 22 23 24 25 26 27 28 29 30 31	<b>JUNE</b> M T W T F S S 1 2 3 4 5 6 7 8 9 10 11 12 13 14 15 16 17 18 19 20 21 22 23 24 25 26 27 28 29 30	<b>JULY</b> M T W T F S S 1 2 3 4 5 6 7 8 9 10 11 12 13 14 15 16 17 18 19 20 21 22 23 24 25 26 27 28 29 30 31	<b>AUGUST</b> M T W T F S S 1 2 3 4 5 6 7 8 9 10 11 12 13 14 15 16 17 18 19 20 21 22 23 24 25 26 27 28 29 30 31
<b>SEPTEMBER</b> M T W T F S S 1 2 3 4 5 6 7 8 9 10 11 12 13 14 15 16 17 18 19 20 21 22 23 24 25 26 27 28 29 30	<b>OCTOBER</b> M T W T F S S 1 2 3 4 5 6 7 8 9 10 11 12 13 14 15 16 17 18 19 20 21 22 23 24 25 26 27 28 29 30 31	<b>NOVEMBER</b> M T W T F S S 1 2 3 4 5 6 7 8 9 10 11 12 13 14 15 16 17 18 19 20 21 22 23 24 25 26 27 28 29 30	<b>DECEMBER</b> M T W T F S S 1 2 3 4 5 6 7 8 9 10 11 12 13 14 15 16 17 18 19 20 21 22 23 24 25 26 27 28 29 30 31

Tage / Days / Jours		München Munich	Den Haag The Hague La Haye	Berlin
Neujahr - New Year's Day - Nouvel An	01.01.2019	x	x	x
Karfreitag - Good Friday - Vendredi Saint	19.04.2019	x	x	x
Ostermontag - Easter Monday - Lundi de Pâques	22.04.2019	x	x	x
Maifeiertag - Labour Day - Fête du Travail	01.05.2019	x	x	x
Christi Himmelfahrt - Ascension Day - Ascension	30.05.2019	x	x	x
Pfingstmontag - Whit Monday - Lundi de Pentecôte	10.06.2019	x	x	x
Fronleichnam - Corpus Christi - Fête-Dieu	20.06.2019	x		
Mariä Himmelfahrt - Assumption Day - Assomption	15.08.2019	x		
Nationalfeiertag - National Holiday - Fête nationale	03.10.2019	x		x
Allerheiligen - All Saints' Day - Toussaint	01.11.2019	x		
Heiliger Abend - Christmas Eve - Veille de Noël	24.12.2019	x	x	x
1. Weihnachtstag - Christmas Day - Jour de Noël	25.12.2019	x	x	x
2. Weihnachtstag - Boxing Day - Lendemain de Noël	26.12.2019	x	x	x
Silvester - New Year's Eve – Saint-Sylvestre	31.12.2019	x	x	x

