

## EUROPEAN QUALIFYING EXAMINATION 2014

# Paper D

This Paper comprises:

Part I (40 marks)

\* Questions 1 - 6

2014/D/EN/1-6

- Question 1 : 6 marks
- Question 2 : 7 marks
- Question 3 : 8 marks
- Question 4 : 7 marks
- Question 5 : 6 marks
- Question 6 : 6 marks

Part II (60 marks)

\* Questions 1 - 4

2014/D/EN/7-12

TOTAL: 100 MARKS

\* Annexes: calendars for 2012, 2013 and 2014  
with indication of the days on which at least one of  
the EPO filing offices is not open for the receipt  
of documents

2014/D/EN/13-15



## Part I : Legal Questions

### QUESTION 1

(6 MARKS)

In January 2013, Mr Baum, who has his residence in Germany, filed the European patent application EP1 for subject-matter A without claiming priority. EP1 was withdrawn in May 2013. In July 2013 subject-matter A was disclosed in a scientific article.

Your client Ms Mele, who has her residence in Italy, recently learned about the filing of EP1. Ms Mele informed you that she can prove that Mr Baum has stolen her invention and that in fact she is entitled to the grant of a patent for subject-matter A. Ms Mele wants to have patent protection for subject-matter A through the EPO.

- a) Which steps must she take?
- b) In which contracting states can she obtain protection?



**QUESTION 2**

**(7 MARKS)**

Applicant X filed an Italian patent application IT1 disclosing and claiming only subject-matter A. No priority was claimed. Then applicant X filed an Italian patent application IT2 with an independent claim 1 directed to subject-matter A and a dependent claim 2 directed to subject-matter A+B without claiming priority.

IT1 was accorded the filing date of 3 December 2012 and IT2 was accorded the filing date of 4 December 2012. At a symposium on 7 December 2012 filing of IT1 and IT2 was mentioned and their content was disclosed.

On 10 December 2012 applicant X withdrew IT1. On 3 December 2013 applicant X filed a European patent application EP1 with claims identical to IT2 and claiming priority of IT2.

Can a patent be granted for EP1 with claims 1 and 2?



**QUESTION 3**

**(8 MARKS)**

European patent application EPX was filed using Form 1001 on 16 February 2012 without claiming priority. On 21 August 2013 the publication of the European search report was mentioned in the European Patent Bulletin. Due to legal incapacity of the representative, the proceedings before the EPO were interrupted as from 20 November 2013 and were resumed on 20 January 2014 after a new representative had been appointed.

Today, the newly appointed representative realises that a reply to the opinion accompanying the search report had been duly filed but that the examination fee has not yet been paid. The applicant would prefer to pay the examination fee not before April 2014.

What should the new representative advise concerning the payment of the examination fee?



**QUESTION 4**

**(7 MARKS)**

Mr. Smith is sole applicant and inventor of an international application. This application, containing the prescribed request together with a separate power of attorney for an agent, was filed at the EPO as receiving Office. The request was signed by the agent. The power of attorney was not signed at all.

- a) Is there a defect in the application in view of the requirements for signatures?
- b) Who can withdraw the international application and what has to be done to this end?



**QUESTION 5**

**(6 MARKS)**

The applicant filed a European patent application containing an independent claim 1 and a dependent claim 2. During oral proceedings the examining division pointed out that the subject-matter of claim 1 lacked inventive step. However, the division indicated that claim 2 would fulfil the requirements of the EPC. The applicant nevertheless did not amend the claims. The application was refused by a decision dated 6 August 2013.

On 1 October 2013 the applicant filed a notice of appeal. On 4 October 2013 he paid the fee for appeal and requested reimbursement of that fee. On 28 November 2013 the applicant filed a statement of grounds of appeal together with a new single claim consisting of the features of previous claims 1 and 2.

Today the applicant seeks your advice. He has the following questions:

- a) Is the appeal admissible?
- b) Will the examining division review its decision and reimburse the fee?



**QUESTION 6**

**(6 MARKS)**

International application PCT-CN was filed by your client on 4 October 2011 in Chinese with the Chinese patent office (SIPO). The publication of PCT-CN contains 40 pages of description and 2 pages of claims. In order to enter the European phase, your client provides you with an English translation of the description of PCT-CN comprising 35 pages and an amended set of claims in English comprising 3 pages. These documents will be submitted to the EPO by fax.

- a) Your client wants to know what the amount of the filing fee will be.
- b) What is the latest date for paying the filing fee without incurring additional fees?



## Part II : Legal Opinion

**[001]** I am the CEO of cosmetics company Gray Dorian (GD), situated in the Czech Republic. We are involved in the development and production of cosmetic products. Our patent matters are handled by one of our employees who is our patent manager and who also represents our company before the EPO.

**[002]** We have recently developed a new anti-ageing cream. This cream contains as an active ingredient a compound which belongs to the family of compounds known as (K). This family contains four different compounds in total, i.e. compounds A, B, C and D. These compounds and their anti-ageing properties were first reported in the 1980's. However there are no commercial products comprising said compounds because they decompose when incorporated into standard creams, which results in unstable compositions.

**[003]** One of our competitors, Crème de la crème (CLC), based in France, is involved in the production of cosmetics and chemical products. They have found a solution to the stability problem mentioned above by incorporating the further ingredient X into a standard cream composition comprising compounds of family (K). Ingredient X is known in the prior art as a solubiliser (increases the solubility of other compounds), however its effect on the stability of compounds of family (K) is admittedly unexpected.



**[004]** On 26 March 2011 CLC filed European patent application EPFR1 by reference to and claiming priority from their French patent application FR1 filed on 23 April 2010. According to EPFR1, X increases the stability of the compounds of family (K) in cream compositions. EPFR1 specifically discloses such cream compositions containing any one of compounds B, C, and D. EPFR1 also contains one claim directed to a cream composition comprising X and a compound belonging to family (K).

**[005]** EPFR1 was published in September 2011 with its search report which cites no relevant documents. EPFR1 was granted in autumn 2012 and today is in force in various countries including France and the Czech Republic.

**[006]** In our development work we tried to develop a cream containing compound A. Although A is the most active compound in the family (K), it is also the most unstable. Our tests showed that the incorporation of X into a cream containing A increases its stability. We also discovered that the incorporation of an ingredient Y (known from the prior art but not as a stabiliser) in addition to X enhances the stability of the composition to a surprising extent. Thus, on 16 April 2012 we filed a Czech patent application CZ1 which describes the surprising stability of the cream compositions comprising A, X and Y. CZ1 does not mention family (K) or any of the other compounds of said family. CZ1 contains a single claim directed to a cream composition comprising A, X and Y. CZ1 was withdrawn shortly after its filing.



**[007]** After we filed CZ1 we continued our development work and we realised that the stabilisation effect of the combination of X and Y was also exhibited by cream compositions comprising any one of the other compounds of the family (K). On 10 August 2012 we filed European patent application EPCZ1 in English, claiming priority from CZ1. EPCZ1 contains the description of CZ1 and further discloses cream compositions that contain any one of compounds B, C or D (in combination with X and Y) and examples of these compositions. EPCZ1 contains an independent claim directed to a cream composition comprising any one of compounds A, B, C or D in combination with X and Y. EPCZ1 also contains a dependent claim directed to a cream composition comprising A, X and Y. The only fees that we have paid for EPCZ1 are the filing and the search fees.

**[008]** In May 2013 we sent the priority document to the EPO. On 18 December 2013 the EPO published the European search report, which cited document EPFR2, an application belonging to CLC. The European search report was accompanied by a search opinion and an invitation to file a translation of the priority document into one of the EPO official languages. We have received no other communication from the EPO relating to this issue.

**[009]** Our intention is to introduce a cream composition containing compound A as well as X and Y into the European market in the near future. Later on we would like to launch products containing the other compounds of family (K).

**[010]** However, two weeks ago we received a letter from CLC inviting us to a meeting next month to discuss the patent situation of the cream compositions that contain a compound of family (K). CLC mentions in their letter that they have become aware that we are planning to introduce into the market a cream composition comprising compound A. CLC also mentions that they believe that such a cream composition would infringe their patent rights originating from a patent application and two patents.



**[011]** The patent application in question is the European patent application EPFR2, mentioned above, which was filed on 5 May 2012 without claiming any priority. The application is directed to a cream composition comprising A in combination with X, Y and a further known ingredient W. According to the description, said composition exhibits greater stability than the compositions disclosed in EPFR1. The description does not contain any reference to family (K) or to any one of compounds B, C or D. EPFR2 contains a single claim directed to a cream composition comprising A, X, Y and W. The application was published on 6 November 2013 without a search report.

**[012]** We have noticed that the stability of the composition disclosed in EPFR2 is not as good as that of our composition disclosed in EPCZ1.

**[013]** The first of the two patents referred to in CLC's letter is EPFR1, mentioned above.

**[014]** The second is European patent EPFR3. EPFR3 was filed in 2003, granted in 2008 and is currently in force in various countries including the Czech Republic. The patent contains a single claim directed to a process for the production of compound Z. CLC uses Z as a starting material in a multi-step process for the production of A. Compound Z does not have any anti-ageing properties.

**[015]** We obtain compound A from Indian company Bollychem (BC). We contacted BC last week. They told us that they use Z in their process for the production of A and that they produce Z according to the process of EPFR3. They have also informed us that they are free to use this process in India since there is no Indian patent that corresponds to EPFR3. In addition, they have informed us that it is not possible for them to modify their process for the production of either Z or A.



**[016]** In principle we would prefer to keep BC as our supplier since they provide us with compound A of high quality containing no major impurities and no trace of Z.

**[017]** Until last year, we had a department for chemical synthesis and we had even developed a new process for the production of compounds A, B, C and D which does not employ compound Z. This process is far more efficient than the one which employs Z.

**[018]** We had even initiated the procedure for obtaining patent protection for our new process. Thus, on 7 March 2011 we filed the Czech application CZ2 and on 12 September 2011 we filed the PCT application PCTCZ2 in English. PCTCZ2 claims priority from CZ2. CZ2 was withdrawn shortly after filing. The search report of PCTCZ2 was published on 17 January 2013, citing no relevant documents. The accompanying international preliminary report on patentability for PCTCZ2 was therefore positive. Unfortunately, last year we closed down our chemical synthesis department due to financial difficulties. Therefore, we decided not to enter any national or regional phase with PCTCZ2.

**[019]** When we received the letter from CLC, I asked our patent manager about PCTCZ2. He told me that it is too late to initiate the European phase of the application PCTCZ2. He also informed me that we have not received any communications from the EPO relating to this issue.



**[020]** The relationship between our company and CLC has traditionally been good and we have successfully collaborated with them on a number of occasions. We would prefer to find an amicable solution in the present situation if possible.

Please analyse the situation and provide us with your professional advice.

Specifically, please advise:

- 1) What is the current situation with regard to the applications/patents relating to the cream compositions? What actions should we take in the next four months?
- 2) In view of CLC's rights, should we continue obtaining compound A from our Indian supplier?
- 3) Can we obtain a European patent for our new process for the production of compounds A, B, C and D?
- 4) During the meeting with CLC, what proposals should we make to them and why?



# Annex 1

2012

Jan	Feb	Mar	Apr	May	Jun	Jul	Aug	Sep	Oct	Nov	Dec
Sun 01	Wed 01	Thu 01	Sun 01	Tue 01	Fri 01	Sun 01	Wed 01	Sat 01	Mon 01	Thu 01	Sat 01
Mon 02	Thu 02	Fri 02	Mon 02	Wed 02	Sat 02	Mon 02	Thu 02	Sun 02	Tue 02	Fri 02	Sun 02
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Tage / Days / Jours		München Munich	Den Haag The Hague La Haye	Berlin
Heilige Drei Könige - Epiphany - Epiphanie	06.01.2012	x		
Karfreitag - Good Friday - Vendredi Saint	06.04.2012	x	x	x
Ostermontag - Easter Monday - Lundi de Pâques	09.04.2012	x	x	x
Nationalfeiertag - National Holiday - Fête Nationale	30.04.2012		x	
Maifeiertag - Labour Day - Fête du Travail	01.05.2012	x	x	x
Christi Himmelfahrt - Ascension Day - Ascension	17.05.2012	x	x	x
Pfingstmontag - Whit Monday - Lundi de Pentecôte	28.05.2012	x	x	x
Fronleichnam - Corpus Christi - Fête-Dieu	07.06.2012	x		
Mariä Himmelfahrt - Assumption Day - Assomption	15.08.2012	x		
Tag der Deutschen Einheit - Day of German Unity - Fête Nationale	03.10.2012	x		x
Allerheiligen - All Saints' Day - Toussaint	01.11.2012	x		
Heiliger Abend - Christmas Eve - Veille de Noël	24.12.2012	x	x	x
1. Weihnachtstag - Christmas Day - Jour de Noël	25.12.2012	x	x	x
2. Weihnachtstag - Boxing Day - Lendemain de Noël	26.12.2012	x	x	x
Silvester - New Year's Eve - Saint-Sylvestre	31.12.2012	x	x	x



## Annex 2

2013

Jan	Feb	Mar	Apr	May	Jun	Jul	Aug	Sep	Oct	Nov	Dec
Tue 01	Fri 01	Fri 01	Mon 01	Wed 01	Sat 01	Mon 01	Thu 01	Sun 01	Tue 01	Fri 01	Sun 01
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Tage / Days / Jours		München Munich	Den Haag The Hague La Haye	Berlin
Neujahr - New Year's Day - Nouvel An	01.01.2013	x	x	x
Karfreitag - Good Friday - Vendredi Saint	29.03.2013	x	x	x
Ostermontag - Easter Monday - Lundi de Pâques	01.04.2013	x	x	x
Nationalfeiertag - National Holiday - Fête nationale	30.04.2013		x	
Maifeiertag - Labour Day - Fête du Travail	01.05.2013	x	x	x
Christi Himmelfahrt - Ascension Day - Ascension	09.05.2013	x	x	x
Pfingstmontag - Whit Monday - Lundi de Pentecôte	20.05.2013	x	x	x
Fronleichnam - Corpus Christi - Fête-Dieu	30.05.2013	x		
Mariä Himmelfahrt - Assumption Day - Assomption	15.08.2013	x		
Tag der Deutschen Einheit - Day of German Unity - Fête Nationale	03.10.2013	x		x
Allerheiligen - All Saints' Day - Toussaint	01.11.2013	x		
Heiliger Abend - Christmas Eve - Veille de Noël	24.12.2013	x	x	x
1. Weihnachtstag - Christmas Day - Jour de Noël	25.12.2013	x	x	x
2. Weihnachtstag - Boxing Day - Lendemain de Noël	26.12.2013	x	x	x
Silvester - New Year's Eve - Saint-Sylvestre	31.12.2013	x	x	x



## Annex 3

2014

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Wed 01	Sat 01	Sat 01	Tue 01	Thu 01	Sun 01	Tue 01	Fri 01	Mon 01	Wed 01	Sat 01	Mon 01
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Fri 31		Mon 31		Sat 31		Thu 31	Sun 31		Fri 31		Wed 31

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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
Nationalfeiertag - National Holiday - Fête Nationale	30.04.2014		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		
Tag der Deutschen Einheit - Day of German Unity - 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

