

EUROPEAN QUALIFYING EXAMINATION 2017

Paper D

This Paper comprises:

Part I (40 points)

- * Questions 1 – 6 2017/D/EN/1-6
 - Question 1: 6 Points
 - Question 2: 6 Points
 - Question 3: 4 Points
 - Question 4: 6 Points
 - Question 5: 10 Points
 - Question 6: 8 Points

Part II (60 points)

- * Questions 1 – 3 2017/D/EN/7-11

TOTAL: 100 POINTS

- * Annexes: calendars for 2015, 2016 and 2017 with indication of the days on which at least one of the EPO filing offices is not open for the receipt of documents 2017/D/EN/12-14



Part I: Legal Questions

QUESTION 1 (6 POINTS)

On 7 August 2014, applicant A filed PCT-A with the EPO as receiving Office. PCT-A does not claim priority of an earlier application and contains two claims, independent claim 1 and independent claim 2. In February 2015, the applicant received from the EPO as International Searching Authority (ISA) a partial search report for the first invention and an invitation to pay an additional search fee for the second invention. The applicant did not respond to the invitation. The applicant received an international preliminary report on patentability (IPRP) repeating the lack of unity objection and with a positive opinion for the first invention.

Today (7 March 2017), the applicant would like to have the second invention searched by the EPO.

Consider the following two situations:

- a) Advise the applicant on how to have the first invention granted as a European patent as soon as possible and to get the second invention searched.
- b) The applicant only wants to pursue one European patent application but does not know yet for which invention he wishes to obtain protection. Advise the applicant on which steps to take to be able to base this decision on a search from the EPO for both inventions.



QUESTION 2

(6 POINTS)

Company B filed a notice of opposition against European patent EP-C. Patent proprietor is company C with principal place of business in the USA. Company C appointed Ms Y as professional representative. Mr X has been appointed as professional representative by company B. The EPO summoned both parties to oral proceedings. The final date for making written submissions in preparation for the oral proceedings has been fixed to today (7 March 2017).

- a) In response to the summons, Ms Y communicated to the EPO the termination of her authorisation because the patent has been transferred to company D with principal place of business in the USA. Ms Y forwarded a copy of the summons to company D. Which steps have to be taken for company D to file an amended set of claims by the final date fixed in the summons?

- b) The business assets of company B in relation to which the opposition had been filed have been transferred to company E. Company B contractually agreed the transfer of the opposition to company E. Mr X has been appointed as professional representative by company E. Which steps have to be taken by Mr X for company E to acquire opponent status and appear as opponent at the oral proceedings?



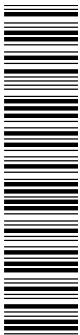
QUESTION 3

(4 POINTS)

Today, 7 March 2017, you receive an e-mail from a patent attorney in Japan. He asks you to file a European patent application claiming the priority of Japanese patent application JP 12345, containing a description, claims and drawings, filed in Japanese at the Japan Patent Office (JPO) on 7 March 2016. The text of the e-mail does not contain any details about the applicant but mentions two attachments: one attachment with a copy of JP 12345 as filed, and one attachment with the applicant's name and contact details. However, the attachments were corrupted and cannot be opened.

In the e-mail the patent attorney in Japan informed you that he cannot be contacted today. However, you were instructed to file the application today.

How will you proceed?



QUESTION 4

(6 POINTS)

In June 2016 the president of company F mentioned during a television interview the upcoming launch of their new smart phone. In July 2016, company F filed US provisional patent application US-P disclosing smart phone TEL1. As of August 2016, any potential buyer could request a password to access technical information describing smart phone TEL1 available on the website of F. In autumn 2016 company F found out that the antenna ANT1 of smart phone TEL1 did not guarantee indoor reception of telephone calls. It is generally known since 2015, that a different antenna, ANT2, provides better indoor reception for smart phones. Therefore, company F developed smart phone TEL2 by replacing in TEL1 antenna ANT1 with antenna ANT2. In December 2016, company F filed a European patent application EP-F with a single claim directed to smart phone TEL2. EP-F claims priority of US-P. Company F started selling smart phone TEL2 in January 2017.

Is TEL2 patentable in view of each of the above disclosures or any combination of these disclosures?



QUESTION 5

(10 POINTS)

French applicant G intended to file international application PCT-G claiming priority of French patent application FR-NAT1 filed on 16 February 2016 and French patent application FR-NAT2 filed on 12 February 2016. Despite all due care taken by the applicant, PCT-G was filed on 14 February 2017 with the EPO as receiving Office. PCT-G did not claim priority of FR-NAT2.

- a) How can the priority claim based on FR-NAT2 be added to PCT-G?
- b) What is the effect of the addition of the priority claim based on FR-NAT2 on the time limit for entry into the European phase?
- c) What can the applicant do before the EPO as receiving Office to avoid that the priority right of FR-NAT2 claimed for PCT-G is considered invalid in the procedure for the grant of a European patent before the EPO as designated Office?



QUESTION 6

(8 POINTS)

On 7 March 2016, your client, a Portuguese university, filed a Portuguese patent application PT-H.

PT-H is drafted in Portuguese and comprises 32 pages of description and drawings, and 4 pages with 15 claims. Your client has prepared an English translation of PT-H comprising 29 pages of description and drawings and 4 pages with 15 claims.

Today, 7 March 2017, your client wants you to file a European patent application EP-H claiming priority of PT-H.

- a) Which fees shall be paid within one month of filing?

- b) How do you minimize the amount of these fees?

- c) You filed an automatic debit order for EP-H. On the decisive payment date, you receive an e-mail from the EPO informing you that there are insufficient funds in your deposit account to cover any of the fees to be paid under a). You replenish the account 2 days after receiving the e-mail. Do you have to take any further action with respect to the payment of these fees?



Part II: Legal Questions

[001] Today is 7 March 2017. I am the research manager of STEELCO, a manufacturer of metal beams in England. Metal beams are formed from metal strips and are used as supports in buildings. The length of a metal beam is limited by its strength because longer beams are prone to buckle. Beams of greater length are manufactured from metal of greater thickness with a correspondingly greater cost.

[002] In 2013 we developed a new process for manufacturing beams having much greater strength using thinner metal strips. The process involves passing metal strips between two rollers, each roller having teeth formed on its peripheral surface. This rolling process forms distinctive projections visible on the metal surface which significantly improve strength and allow longer beams with thinner, cheaper metal strips. This effect is surprising because it was widely accepted at that time that beams without surface imperfections and projections would be stronger. On 23 September 2013 we filed a British patent application, ST-GB1, without a claim to priority. ST-GB1 describes the rolling process and describes and claims a metal beam having projections formed by rolling a metal strip between two rollers having teeth. We allowed ST-GB1, which has not been published, to irretrievably lapse.



[003] After some experimenting we found that rollers with teeth of a particular shape, SHAPE-A, produced significantly stronger beams. A SHAPE-A tooth creates a visible SHAPE-A projection. In November 2013 we attended a trade fair in the United Arab Emirates (UAE) at which we demonstrated beams having SHAPE-A projections. We also presented test results showing how the beams exhibit very high strength and a video showing the rolling process. The trade fair generated considerable interest amongst potential new UAE customers.



[004] On 15 September 2014 we filed a European patent application, ST-EP1, claiming priority from and including the description and the single claim of ST-GB1. ST-EP1 also includes a description of a metal beam having SHAPE-A projections formed by rolling a metal strip between a pair of rollers having SHAPE-A teeth and a dependent claim directed to such a beam.

[005] The search report for ST-EP1 cites a publication from 1982, OLD1, describing a metal stamping process whereby projections are stamped onto a metal strip. I explained in a letter to the EPO that stamping metal strips causes stress effects that are visible on a metal surface leading to a measurable reduction in strength, and that only a rolling process, with or without teeth, can guarantee to avoid these stress effects. I received a communication under Rule 71(3) EPC regarding ST-EP1. The communication was dated 21 October 2016 and gave a four month period for reply. I have not responded to the communication yet but I understand that the EPO will grant a patent for ST-EP1. Since October 2016 we have been selling our metal beams with SHAPE-A projections to CASITAS S.A., a Spanish construction company operating in Spain. We receive considerable revenue from CASITAS.



[006] Last week I received a letter from CASITAS pointing out a Chinese company, CHINABEAM, which recently started importing and selling strengthened metal beams in Spain. I obtained a sample beam from CHINABEAM and it has the visibly distinctive SHAPE-A projections that can only be formed by a rolling process with SHAPE-A teeth. The price of CHINABEAM products is 15% lower than the price of our products and CASITAS asked me why they should continue to buy our beams if they can import identical products at lower cost from China.



[007] At the end of March 2016 we were contacted by an independent consultant from Italy, Mr G, who had filed on 11 March 2016 as sole applicant a European patent application, ST-EP2, without a claim to priority. ST-EP2 describes and claims a metal beam having projections of a different particular shape, SHAPE-B, formed by rolling between rollers having SHAPE-B teeth. Mr G demonstrated to us that beams with SHAPE-B projections surprisingly exhibit considerably improved strength over beams with SHAPE-A projections. After negotiations Mr G transferred ST-EP2 to us in a contract dated 4 April 2016 and signed by both Mr G and STEELCO. Mr G informed us that he had not paid any fees for the application ST-EP2. The transfer was registered with the EPO and includes the transfer of the right to claim priority. Immediately after the transfer Mr G left for China and our relationship with him ended. On 11 April 2016 we published an article in a trade journal disclosing the contents of ST-EP2. At that time we were working on further improvements to the SHAPE-B projections so we paid no fees at all to the EPO for ST-EP2.



[008] In February 2017, I received an e-mail from CASITAS in which they forwarded details of international application CB-PCT and according to which CB-PCT was originally filed on 10 June 2016 in the names of Mr G and CHINABEAM and claims priority from ST-EP2. CB-PCT was filed at the EPO with the EPO as International Search Authority. CASITAS informed us that Mr G subsequently assigned his share of CB-PCT to CHINABEAM. CASITAS also forwarded a document containing the description and claims for CB-PCT. CB-PCT includes the description and the claim of ST-EP2. CB-PCT further describes rollers with teeth having a shape, SHAPE-B1, that is a very particular type of SHAPE-B and which produce beams having SHAPE-B1 projections. CB-PCT explains that beams with SHAPE-B1 projections have surprisingly much greater strength than beams with any other SHAPE-B projections. CB-PCT includes independent claim 2 directed to a metal beam having SHAPE-B1 projections formed by rolling a metal strip between a pair of rollers having SHAPE-B1 teeth. CASITAS indicate that CHINABEAM have offered them beams with SHAPE-B1 projections at a lower price than the beams they obtain from us.



[009] We also identified the surprisingly good effects of SHAPE-B1 projections completely independently of CHINABEAM and we filed our own European patent application ST-EP3 on 13 June 2016 claiming priority from ST-EP2. ST-EP3 includes the description of ST-EP2 and further describes SHAPE-B1 projections. The sole claim of ST-EP3 is directed to a metal beam having projections formed by rolling a metal strip between a pair of rollers having SHAPE-B1 teeth. Soon after filing ST-EP3, in July 2016, we received a notification of loss of rights for ST-EP2.

[010] I just had a phone call from my contact at CASITAS and he was very upset. He told me CHINABEAM have indicated that, if granted, ST-EP1 would be invalid because we disclosed our beams at the trade fair in the UAE, and CHINABEAM intend to file an opposition at the EPO with evidence obtained from one of our UAE customers. CASITAS want to meet urgently to discuss the order they placed with us.

[011] We conducted a worldwide search of CHINABEAM patents and only found a European patent CB-EP based on a European patent application filed on 15 October 2013 without a claim to priority. The mention of the grant of CB-EP was published on 8 June 2016. CB-EP describes and claims a rolling process for forming metal beams by rolling a metal strip between a pair of rollers. There is no mention of rollers having teeth or beams having projections in CB-EP.

[012] To make matters worse, I also just heard CHINABEAM have offered low cost metal beams with SHAPE-B1 projections to one of our customers in the UAE which we are keen to keep. The projections are visibly formed by a rolling process.



1. Outline the patent situation as it currently stands for beams having projections formed by a rolling process where:
 - a. the projections are of any shape;
 - b. the projections are of SHAPE-A;
 - c. the projections are of SHAPE-B;
 - d. the projections are of SHAPE-B1.
2. What can be done to improve our patent situation vis-à-vis CHINABEAM?
3. Which types of metal beam are we or CHINABEAM free to produce, sell and use in the future?



Annex 1

2015

JANUARY							FEBRUARY							MARCH							APRIL							
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MAY							JUNE							JULY							AUGUST							
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SEPTEMBER							OCTOBER							NOVEMBER							DECEMBER						
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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



Annex 2

2016

JANUARY							FEBRUARY							MARCH							APRIL											
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MAY							JUNE							JULY							AUGUST											
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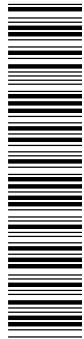
Tage / Days / Jours														München Munich	Den Haag The Hague La Haye	Berlin	
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Heilige Drei Könige - Epiphany - Epiphanie														06.01.2016	x		
Karfreitag - Good Friday - Vendredi Saint														25.03.2016	x	x	x
Ostermontag - Easter Monday - 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



Annex 3

2017

JANUARY							FEBRUARY							MARCH							APRIL							
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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 - Assumption							15.08.2017	x		
Nationalfeiertag - National Holiday - Fête nationale							03.10.2017	x		x
Allerheiligen - All Saints' Day - Toussaint							01.11.2017	x	x	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

