



# **EUROPEAN QUALIFYING EXAMINATION 2015**

# Paper D

### This Paper comprises:

# Part I (40 marks)

\* Questions 1 - 5 2015/D/EN/1-5

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

Part II (60 marks)

\* Questions 1 - 3 2015/D/EN/6-9

**TOTAL: 100 MARKS** 

\* Annexes: calendars for 2013, 2014 and 2015 with indication of the days on which at least one of the EPO filing offices is not open for the receipt of documents

2015/D/EN/10-12

**Part I: Legal Questions** 

QUESTION 1 (9 MARKS)

On 17 February 2015, applicant A filed on the last day of the priority period European patent applications EP1 and EP2, together with copies of the earlier national British patent applications UK1 and UK2. UK1 and UK2 relate to different inventions.

EP1 claims the priority of the earlier national patent application UK1. The description and claims of EP1 and UK1 are identical.

EP2 claims the priority of the earlier national patent application UK2. The description and claims of EP2 and UK2 are identical.

On 20 February 2015, the contents of UK1 and UK2 were made publicly available.

Later the applicant noticed that he had forgotten to file the drawings for EP1. On 23 February 2015 he filed drawings for EP1 and he also filed drawings for EP2. The drawings for EP1 are identical to the drawings of UK1. The drawings for EP2 are newly drafted, because UK2 does not contain any drawings.

Today, the applicant asks you what can be done to optimise the situation with regard to EP1 and EP2.



QUESTION 2 (8 MARKS)

Applicant B filed European patent application EP1 for invention X on 2 January 2011. EP1 duly claims priority of Italian utility model application IT1. IT1 was filed on 2 January 2010 and was withdrawn before publication.

In the search report of EP1, a scientific article published on 2 October 2010 was cited. The article discloses invention X. In October 2013 the EPO invited applicant B to file a translation of the previous application IT1 within a time limit of 4 months. In June 2014, applicant B received a communication under Rule 112(1) EPC noting a loss of rights because the translation of the previous application IT1 had not been filed. Applicant B has not taken any action in response to said communication.

Recently, applicant B discovered European patent EP2 of company C filed on 13 September 2010. The mention of the grant was published on 12 November 2014. EP2 claims invention X.

- a) Advise applicant B whether or not EP1 is likely to be granted by the EPO with a claim directed to invention X.
- b) Can anything be done against EP2 before the EPO?



QUESTION 3 (9 MARKS)

The German national Hans is working and living in Argentina. He is employed by Evita-Engineering (EE), which is a company constituted under Argentinean law and is based in Buenos Aires. Hans and company EE validly filed a national patent application A at the competent authority in Argentina. It is intended to file today an international patent application PCT-A in English claiming priority of application A. In the PCT request, company EE and Hans are named as applicants.

- a) May PCT-A contain a declaration claiming the priority of application A?
- b) May Hans and company EE file PCT-A jointly?
- c) Which of the following offices will act as the receiving Office for PCT-A?
  - 1) The EPO,
  - The government authority entrusted with the grant of patents of Germany (German Patent and Trademark Office, GPTO).



QUESTION 4 (7 MARKS)

On 24 March 2014 applicant D filed a national patent application JP-D in Japanese with the Japanese Patent Office. JP-D comprises an apparatus claim 1 and an apparatus claim 2. The subject-matter of claim 1 and the subject-matter of claim 2 are not linked by a common inventive concept. On 24 September 2014 applicant D filed European patent applications EP-D1 and EP-D2 both validly claiming priority of JP-D. EP-D1 was filed in Japanese and only discloses and claims the apparatus according to claim 1 of JP-D. A translation of EP-D1 into English was duly filed. EP-D2 was filed in English and only discloses and claims the apparatus according to claim 2 of JP-D.

EP-D2 and the translation of EP-D1 wrongly use "©" instead of "μm". JP-D correctly mentions "μm". However, from the context in which "©" is used in the available English texts of EP-D1 and EP-D2, the replacement of "©" by "μm" would not be evident.

Today (24 February 2015) your client wants to replace "©" by "µm". Discuss how the subject-matter of claim 1 of JP-D and the subject-matter of claim 2 of JP-D can be prosecuted before the EPO on the basis of documents reflecting your client's wishes.



QUESTION 5 (7 MARKS)

Applicant E filed a European patent application, which discloses new amino acid sequences, but lacks a sequence listing. Applicant E has received a communication from the EPO, dated 18 February 2015, inviting applicant E to remedy this defect.

- a) What does applicant E have to do to provide a remedy and by when?
- b) What is the legal consequence of not remedying the defect? Can this legal consequence be remedied?



#### **Part II: Legal Opinion**

**[001]** Our company TIPOGRAF-X is involved in printing and publishing, and is based in Venice, Italy. We specialise in high quality printing for which we are using old technology printing machines. We are mainly producing special editions of books, which are becoming more and more popular.

**[002]** We are using an improved version of an old printing machine M. The first improvement our engineers carried out when we started our business was to add feature A, which allows the old printing machine M to increase its speed. At the time, this was a breakthrough for our firm, because the old machine M was too slow to be competitive. In February 2012 we presented, under a confidentiality agreement, a prototype of our machine M+A to German company DRUCK-Z, with whom we cooperate. In July 2012 we filed, without claiming priority, a first European patent application EP-X1. EP-X1 describes and claims our machine M+A.

**[003]** In October 2013, we received the search report which cites a single document as prior art. To our surprise said document is a European patent application EP-Z filed by DRUCK-Z in March 2012 without claiming priority. EP-Z describes and claims our machine M+A. We immediately instituted proceedings against DRUCK-Z before a German court, to prove that we are entitled to the invention.



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**[004]** Our engineers continued to improve the machine M+A to meet the increasing demand for our books. To be able to use various types of paper, feature B was added. At the same time, feature C was added. Feature C is independent of feature B and reduces the number of misprints produced by machine M+A. During the trials in our factory of a prototype machine with all the features, M+A+B+C, a surprising technical effect of the combination of features B and C was observed. The combination significantly reduces noise generated by the machine in operation. All these features and effects were described in a second European patent application EP-X2 which we filed on 10 March 2014 without claiming priority. EP-X2 has claims to the following combinations of features: M+A+B, M+A+C and M+A+B+C.

[005] In December 2013 we found out by file inspection that EP-Z had been withdrawn in November 2013.

**[006]** By a final decision of the German court dated 15 January 2015, it was adjudged that we were entitled to the grant of the European patent for machine M+A. Because we had already filed EP-X2 we did not pursue this issue any further.

**[007]** Last year our engineers discovered that a feature D of the machine reduces the consumption of ink. This feature D is hidden in the machine and is not visible from the exterior, and only works together with the combination of features A+B+C.



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**[008]** On 20 January 2015 we filed a third European patent application EP-X3 without claiming priority. The description of the application was the same as that of EP-X2 and it was intended to include an additional paragraph with a sufficient disclosure of feature D and its effect on the machine. Last week, however, we realised that when filing EP-X3 we forgot to insert the additional paragraph of the description with the sufficient disclosure of feature D and its effect. We have not received any notification from the EPO concerning the absence of the sufficient disclosure of feature D. The single claim of EP-X3 is directed to the machine with all the features M+A+B+C+D.

**[009]** At a trade fair in Italy on 10 -12 February 2015 we demonstrated a prototype of machine M+A+B+C+D. The machine was a big success and a lot of printing companies inquired about the machine. Therefore, we decided to manufacture and sell machine M+A+B+C+D. We will be ready to start producing the machine in summer 2015. Until now we have not disclosed any information about feature D to anybody.

**[010]** At the fair, we saw a prototype of a machine M+A+C made by a Chinese company PRINT-L. We did not mention feature D to them, and it was clear that their machine did not include feature D. They are mainly active in the Asian market. They have filed a PCT application PCT-L, designating all countries. The International Preliminary Examination Report was positive. They now want to decide which national phases they should enter. PRINT-L was very interested in the machine we exhibited and mentioned the possibility of cooperating. Later, on file inspection, we saw that PCT-L was filed on 8 September 2012 without claiming priority and was published on 13 March 2014. PCT-L describes machine M+A+C and contains a single claim which is directed to the combination M+A+C.



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[011] Last week we received a letter from ICPR-G, which is a company manufacturing and selling printing machines only in Iceland. They informed us about their European patent application EP-G, which describes machines M+A and M+A+B and their respective advantages. EP-G contains a claim directed to M+A and a claim directed to M+A+B. EP-G was filed in May 2012 without claiming priority. They expect the EPO to grant a patent for EP-G. They warned us that the machine we exhibited at the fair would fall within the scope of this patent. Therefore, they proposed a licence but for a very high price. By file inspection we checked the search report for EP-G and noticed that it does not mention any relevant documents. I have a meeting with ICPR-G in three weeks to discuss the matter.

1) What is the current situation concerning the following printing machines:

M+A,

M+A+B.

M+A+C,

M+A+B+C,

M+A+B+C+D?

- 2) As the situation currently stands, are we free to produce, sell and use our printing machine M+A+B+C+D?
- What can we do to improve our rights and our position vis-à-vis ICPR-G and PRINT-L with respect to the various printing machines mentioned above?



#### 2013

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JULY								
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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	х	х	х
Karfreitag - Good Friday - Vendredi Saint	29.03.2013	Х	х	х
Ostermontag - Easter Monday - Lundi de Pâques	01.04.2013	х	х	х
Nationalfeiertag - National Holiday - Fête nationale	30.04.2013		х	
Maifeiertag - Labour Day - Fête du Travail	01.05.2013	х	х	х
Christi Himmelfahrt - Ascension Day - Ascension	09.05.2013	Х	х	х
Pfingstmontag - Whit Monday - Lundi de Pentecôte	20.05.2013	х	х	х
Fronleichnam - Corpus Christi - Fête-Dieu	30.05.2013	х		
Mariä Himmelfahrt - Assumption Day - Assomption	15.08.2013	х		
Tag der Deutschen Einheit - Day of German Unity - Fête Nationale	03.10.2013	х		х
Allerheiligen - All Saints' Day - Toussaint	01.11.2013	х		
Heiliger Abend - Christmas Eve - Veille de Noël	24.12.2013	х	х	х
1. Weihnachtstag - Christmas Day - Jour de Noël	25.12.2013	х	х	х
2. Weihnachtstag - Boxing Day - Lendemain de Noël	26.12.2013	х	х	х
Silvester - New Year's Eve - Saint-Sylvestre	31.12.2013	х	х	х



2015/D/EN/10

# Annex 2

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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	Х	х	х
Heilige Drei Könige - Epiphany - Epiphanie	06.01.2014	х		
Karfreitag - Good Friday - Vendredi Saint	18.04.2014	х	Х	Х
Ostermontag - Easter Monday - Lundi de Pâques	21.04.2014	х	х	х
Maifeiertag - Labour Day - Fête du Travail	01.05.2014	х	х	Х
Christi Himmelfahrt - Ascension Day - Ascension	29.05.2014	х	Х	Х
Pfingstmontag - Whit Monday - Lundi de Pentecôte	09.06.2014	х	Х	Х
Fronleichnam - Corpus Christi - Fête-Dieu	19.06.2014	х		
Mariä Himmelfahrt - Assumption Day - Assomption	15.08.2014	х		
Tag der Deutschen Einheit - Day of German Unity - Fête Nationale	03.10.2014	х		х
Heiliger Abend - Christmas Eve - Veille de Noël	24.12.2014	х	х	Х
Weihnachtstag - Christmas Day - Jour de Noël	25.12.2014	Х	Х	Х
2. Weihnachtstag - Boxing Day - Lendemain de Noël	26.12.2014	х	х	х
Silvester - New Year's Eve - Saint-Sylvestre	31.12.2014	х	х	х





# Annex 3

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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	х	х	х
Heilige Drei Könige - Epiphany - Epiphanie	06.01.2015	х		
Karfreitag - Good Friday - Vendredi Saint	03.04.2015	х	х	Х
Ostermontag - Easter Monday - Lundi de Pâques	06.04.2015	х	х	Х
Nationalfeiertag - National Holiday - Fête nationale	27.04.2015		х	
Maifeiertag - Labour Day - Fête du Travail	01.05.2015	х	х	Х
Christi Himmelfahrt - Ascension Day - Ascension	14.05.2015	х	х	Х
Pfingstmontag - Whit Monday - Lundi de Pentecôte	25.05.2015	х	х	Х
Fronleichnam - Corpus Christi - Fête-Dieu	04.06.2015	х		
Heiliger Abend - Christmas Eve - Veille de Noël	24.12.2015	х	х	х
1. Weihnachtstag - Christmas Day - Jour de Noël	25.12.2015	х	х	х
Silvester - New Year's Eve - Saint-Sylvestre	31.12.2015	х	х	Х



