



# **EUROPEAN QUALIFYING EXAMINATION 2012**

# Paper D

# This Paper comprises:

\* Questions 1 - 8 2012/DI/EN/1-5

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

- Question 7: 4 marks - Question 8: 5 marks

TOTAL: 40 MARKS

\* Annexes: calendars for 2010, 2011 and 2012 with indication of the days on which at least one of the EPO filing offices is not open for the receipt of documents

2012/DI/EN/6-8

40 % of the marks available for paper D are awarded for Part I, 60 % for Part II.

QUESTION 1 (5 MARKS)

On 29 December 2011 you received a decision dated 27 December 2011 refusing your European patent application.

The last sentence of the decision reads as follows:

"As all the features of the independent claim are known from the prior art document D1, the application is refused for lack of novelty, Art. 56 EPC."

On 26 January 2012 you received a correction of the decision according to Rule 140 EPC for the same application. The correction is dated 24 January 2012. Only the last sentence was changed to "As all the features of the independent claim are known from the prior art document D1, the application is refused for lack of novelty, Art. 54 EPC".

Your client has not yet decided whether to file an appeal, but intends to take this decision in the next few weeks. However, he will call you this morning to discuss the further procedure.

What will you advise your client?



QUESTION 2 (6 MARKS)

For European patent application EP1, filed in English, the first communication from the examining division under Article 94(3) and Rule 71(1), (2) EPC dated 13 December 2007 raised only a lack of clarity objection. On 14 December 2009 a divisional application DIV1 of EP1 was filed in the same language as EP1 at the EPO in Munich. On 30 September 2010 a further divisional application DIV2 of EP1 was filed in the same language as EP1 at the EPO in Berlin.

The partial search report for DIV1 dated 6 October 2011 contained a statement regarding lack of unity. However, no additional search fee was paid. EP1 and DIV2 were withdrawn on 28 January 2011.

- a) What were the filing requirements for divisional applications DIV1 and DIV2?
- b) Is it still possible to validly file further divisional applications?



QUESTION 3 (5 MARKS)

On 5 October 2010 your Spanish client filed a PCT application in Spanish with the Spanish Patent and Trade Mark Office (SPTO). No priority was claimed. Due to a lack of unity objection, which the client accepts, only the first invention was searched by the SPTO. However, your client wants a search to be carried out by the EPO on the second invention before deciding on entry into the national/regional phase but does not want to file a new application.

- a) Is this possible?
- b) If so, what steps have to be taken?

QUESTION 4 (4 MARKS)

Company X filed a draft of a scientific paper as a European patent application EP-X at the EPO. The draft describes compositions of the class A. The EPO accorded to application EP-X a date of filing of 20 December 2009. On 15 February 2010, company X filed, for EP-X, a claim directed to product A1, which was not described in the draft paper.

On 17 November 2010 company X filed an international application PCT1 at the USPTO with the description of EP-X and the same claim as above, claiming priority from EP-X. Company X received from the USPTO an international search report indicating only a single document, which discloses product A1. This document was made available to the public in March 2010.

- a) Is it possible to obtain valid patent protection via the claim directed to product A1 if PCT1 enters the European phase?
- b) How would the situation be different for PCT1 if the draft paper had disclosed A1?



QUESTION 5 (5 MARKS)

International application PCT-CN was filed in Chinese in September 2010 with the Chinese State Intellectual Property Office (SIPO). In March 2011 the applicant received the international search report from SIPO. In May 2011 the applicant filed with the International Bureau amended claims together with a brief statement explaining the amendments. The application will be published next week.

- a) Which parts of the publication will be in what language(s)?
- b) Will a French translation of the abstract be publicly available from WIPO?

QUESTION 6 (6 MARKS)

On 28 October 2010 your client filed an Italian application IT1 for invention Inv1 and an Italian application IT2 for invention Inv2. Inv1 and Inv2 are unitary. On 28 October 2011 your client duly filed a European application EP1 describing and claiming inventions Inv1 and Inv2. EP1 claims the priority of IT1 only. Your client has discovered a document D published on 8 August 2011 disclosing Inv1 and Inv2.

Your client wants to use EP1 to obtain Europe-wide protection for both Inv1 and Inv2.

What do you advise your client?



QUESTION 7 (4 MARKS)

Your client has developed the following way of diagnosing an illness:

- a) Carrying out a known method of biopsy by a medical practitioner to extract a liver tissue sample from a patient;
- b) carrying out a novel and inventive method for diagnosing the illness on the basis of the tissue sample in an analysing liquid.

Your client has informed you that the way in which the tissue sample is obtained is not an essential feature of his development.

Your client wants you to file a European patent application. Discuss the patentability of his development according to the EPC.

QUESTION 8 (5 MARKS)

European patent application EP1 was published on 10 March 2010. In reply to a communication of the examining division, the applicant filed amended claims containing improved subject-matter in June 2011. This improved subject-matter is new and inventive over the originally disclosed subject-matter, and, in itself, is sufficiently disclosed according to Art. 83 EPC. On 9 December 2011 the applicant filed a second European patent application EP2 describing and claiming the improved subject-matter.

Can the applicant obtain valid protection for the improved subject-matter via EP1 or EP2?



### Annex 1

	Jan		Feb		Mar	Ap	r	May	,	Jun		Jul		Aug	S	ер		Oct		Nov		Dec
Fri	01	Mon	01	Mon	01	Thu 0	1 Sat	01	Tue	01	Thu	01	Sun	01	Wed	01	Fri	01	Mon	01	Wed	01
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Sun	03	Wed	03	Wed	03	Sat 0	3 Мо	n 03	Thu	03	Sat	03	Tue	03	Fri	03	Sun	03	Wed	03	Fri	03
Mon	04	Thu	04	Thu	04	Sun 0	1 Tue	04	Fri	04	Sun	04	Wed	04	Sat	04	Mon	04	Thu	04	Sat	04
Tue	05	Fri	05	Fri	05	Mon 0	5 We	d 05	Sat	05	Mon	05	Thu	05	Sun	05	Tue	05	Fri	05	Sun	05
Wed	06	Sat	06	Sat	06	Tue 0	Thu	u 06	Sun	06	Tue	06	Fri	06	Mon	06	Wed	06	Sat	06	Mon	06
Thu	07	Sun	07	Sun	07	Wed 0	7 Fri	07	Mon	07	Wed	07	Sat	07	Tue	07	Thu	07	Sun	07	Tue	07
Fri	80	Mon	08	Mon	08	Thu 0	Sat	08	Tue	08	Thu	08	Sun	08	Wed	08	Fri	08	Mon	08	Wed	08
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Mon	11	Thu	11	Thu	11	Sun 1	1 Tue		Fri	11	Sun	11	Wed	11	Sat	11	Mon	11	Thu	11	Sat	11
Tue	12	Fri	12	Fri	12	Mon 1	2 We	d 12	Sat	12	Mon	12	Thu	12	Sun	12	Tue	12	Fri	12	Sun	12
Wed	13			Sat			3 Thu	13	Sun	13	Tue		Fri	13	Mon	13	Wed	13	Sat	13	Mon	13
Thu	14	Sun		Sun			4 Fri	14	Mon		Wed		Sat		Tue	14		14	Sun	14	Tue	14
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Tue	26		26		26		3 We		Sat	26	Mon		Thu		Sun		Tue				Sun	26
Wed	27	Sat	27	Sat	27	Tue 2	_		Sun	27	Tue		Fri		Mon	27	Wed	27	Sat	27	Mon	27
Thu		Sun	28	Sun			3 Fri		Mon		Wed		Sat		Tue		Thu			28		28
Fri	29			Mon			Sat		Tue		Thu		Sun		Wed	29		29	Mon	29		29
Sat	30			Tue	30	Fri 3	Sur		Wed	30			Mon		Thu	30	Sat	30	Tue	30		30
Sun	31			Wed	31		Mor	n 31			Sat	31	Tue	31			Sun	31			Fri	31

Tage / Days / Jours		München Munich	Den Haag The Hague La Haye	Berlin
Neujahr - New Year's Day - Nouvel An	01.01.2010	х	х	х
Heilige Drei Könige - Epiphany - Epiphanie	06.01.2010	х		
Karfreitag - Good Friday - Vendredi Saint	02.04.2010	х	х	х
Ostermontag - Easter Monday - Lundi de Pâques	05.04.2010	х	х	х
Nationalfeiertag - National Holiday - Fête nationale	30.04.2010		х	
Tag der Befreiung - Liberation Day - Journée de la Libération	05.05.2010		х	
Christi Himmelfahrt - Ascension Day - Ascension	13.05.2010	х	х	х
Brückentag - Bridging Day - Pont	14.05.2010	х	х	х
Pfingstmontag - Whit Monday - Lundi de Pentecôte	24.05.2010	х	х	х
Fronleichnam - Corpus Christi - Fête-Dieu	03.06.2010	х		
Allerheiligen - All Saints' Day - Toussaint	01.11.2010	х		
Heiliger Abend - Christmas Eve - Veille de Noël	24.12.2010	х	х	х
Silvester - New Year's Eve - Saint-Sylvestre	31.12.2010	х	х	х



# Annex 2

	Jan		Feb		Mar		Apr		May		Jun		Jul		Aug		Sep		Oct		Nov		Dec
Sat	01	Tue	01	Tue	01	Fri	01	Sun	01	Wed	01	Fri	01	Mon	01	Thu		Sat	01	Tue	01	Thu	01
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Sat		Tue		Tue	22	Fri	22	Sun	22	Wed	22	Fri	22	Mon	22	Thu		Sat	22		22		22
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Tue		Fri		Fri	25	Mon		Wed		Sat	25	Mon	25	Thu		Sun	25	Tue	25		25		25
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Mon	31			Thu	31			Tue	31			Sun	31	Wed	31			Mon	31			Sat	31

Tage / Days / Jours	München Munich	Den Haag The Hague La Haye	Berlin	
Heilige Drei Könige - Epiphany - Epiphanie	06.01.2011	х		
Karfreitag - Good Friday - Vendredi Saint	22.04.2011	х	х	х
Ostermontag - Easter Monday - Lundi de Pâques	25.04.2011	х	х	х
Tag der Befreiung - Liberation Day - Journée de la Libération	05.05.2011		Х	
Christi Himmelfahrt - Ascension Day - Ascension	02.06.2011	х	х	х
Brückentag - Bridging Day - Pont	03.06.2011	х	х	х
Pfingstmontag - Whit Monday - Lundi de Pentecôte	13.06.2011	х	х	х
Fronleichnam - Corpus Christi - Fête-Dieu	23.06.2011	х		
Mariä Himmelfahrt - Assumption Day - Assomption	15.08.2011	х		
Tag der Deutschen Einheit - Day of German Unity - Fête Nationale	03.10.2011	х		х
Allerheiligen - All Saints' Day - Toussaint	01.11.2011	Х		
2. Weihnachtstag - Boxing Day - Lendemain de Noël	26.12.2011	х	х	х



### Annex 3

	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
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Tue		Fri		Sat	24	Tue	24	Thu		Sun	24	Tue		Fri	24	Mon		Wed		Sat	24	Mon	24
Wed		Sat		Sun		Wed	25		25	Mon		Wed		Sat	25	Tue		Thu		Sun	25	Tue	25
Thu	26	Sun	26	Mon	26	Thu		Sat	26	Tue		Thu		Sun	26	Wed		Fri		Mon	26	Wed	26
Fri	27	Mon	27	Tue	27	Fri		Sun	27	Wed		Fri	27	Mon	27	Thu		Sat	27		27	Thu	27
Sat	28	Tue	28	Wed		Sat	28	Mon	28	Thu		Sat	28	Tue	28	Fri		Sun	28			Fri	28
Sun	29	Wed	29	Thu		Sun	29	Tue	29			Sun	29	Wed	29	Sat		Mon	29		29	Sat	29
Mon	30			Fri	30	Mon	30	Wed	30	Sat	30	Mon	30	Thu	30	Sun	30	Tue		Fri	30		30
Tue	31			Sat	31			Thu	31			Tue	31	Fri	31			Wed	31			Mon	31

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

