Contents

For	eword	V
Pre	face	VII
Cor	ntributions	ΧI
Cor	ntents	XIII
Detailed Contents		XV
1	Introduction	1
2	Methodology	11
3	Objects of the claims and their priority	49
4	Interpretation	65
5	State of the Art	73
6	Inventive Step	89
7	Added Subject-Matter	107
8	Ranges	121
9	Legal Questions	129
10	Assessing your own Paper	153
App	pendices	171
1	Methodology Examples C 1999	173
2	Notice of opposition and answer legal questions C 1999	191
3	Example notice of opposition (in English, German and French)	201
4	Matrix features-document template	221
5	Matrix claims-attacks template (EPC 1973 and EPC 2000)	222
6	References to frequently required legal authorities	224
7	Paper C 1999	232
Ind	ex	279



Detailed Contents

Foreword		
Preface		VII
Contributions		
Contents		
Detailed Contents		
1	Introduction	1
1.1 1.2 1.3 1.3.1	Object of this book	1 1 2 4
1.3.2 1.3.3 1.3.4 1.4 1.5	Instructions to candidates concerning the conduct of the examination	4 5 6 7 8
2	Methodology	11
2.1 2.1.1 2.1.2 2.2 2.2.1 2.2.2 2.2.3	Introduction Objective Summary Two analysis methods Overview of the matrix features-documents method Overview of the matrix claims-attacks method Choice of analysis method	11 11 11 11 12 12
2.3 2.3.1 2.3.2 2.3.3	Matrix features-documents method	16 16 16 17
2.3.4 2.3.5 2.3.6	Analysis of the dates of the disclosures Analysis of the content of the disclosures Attacks on the patent	20 22 23
2.3.7 2.4 2.4.1 2.4.2	Notice of opposition	26 28 28 28
2.4.3 2.4.4 2.4.5 2.4.6	Patent to oppose (A1)	29 31 33 35
2.4.7 2.5 2.6	Notice of opposition	43 45 45
2.6.1 2.6.2 2.6.3	Analysis strategy Attacks strategy Drafting strategy	45 46 47

3	Objects of the claims and their priority	49
3.1	Legal basis	49
3.2	Relevance to paper C	51
3.3	Claimed objects	51
3.3.1	Independent claims	52
3.3.2	Dependent claims	53
3.4	Effective date	53
3.5	No valid claim to priority for the patent in suit	54
3.6	Conflicting applications	55
3.7	Examples of determining priority dates	56
3.7.1	Intermediate publication of the contents of the priority	
	application	56
3.7.2	Intermediate publication of another European application	56
3.7.3	Multiple priorities with an intermediate publication	57
3.7.4	Check for "first application"	57
3.8	Examples from past papers	57
4	Interpretation	65
4.1	Legal basis	65
4.2	Relevance to paper C	65
4.3	Interpretation in practice	66
4.3.1	Finding features	66
4.3.2	Writing down the result of interpretation	66
4.4	Interpreting the claims	67
4.4.1	Interpretation of expressions in claims	67
4.4.2	Non-limiting features?	68
4.5	Interpreting the disclosures	69
4.5.1	Identical features	69
4.5.2	Generic versus specific features	70
4.5.3	Incorporated features	70
4.5.4	Implicit features	70
4.5.5	Conclusions to be drawn from specific remarks	71
4.5.6	Unusable documents	71
5	State of the Art	73
5.1	Legal basis	73
5.2	Relevance to paper C	75
5.3	State of the art	75
5.3.1	Written disclosure	76
5.3.2	Oral disclosure	76
5.3.3	Prior use	77
5.4	Article 54(3) EPC	77
5.4.1	European applications	77
5.4.2	Euro-PCT applications	77
5.4.3	Attacks under Article 54(3) EPC	78
5.4.4	Conflicting applications and priority	79
5.4.5	Priority not valid – affecting the applicability of	
	Article 54(3) EPC	79
5.4.6	Priority not valid – no consequences for the applicability	
	of Article 54(3) EPC	80
5.5	Examples from past papers	80
6	Inventive Step	89
6.1	Legal basis	89
6.2	Relevance to paper C	89
6.3	The problem and solution approach	90
6.3.1	Introduction	90

6.3.2	Stage 1 – Determination of the closest prior art	00
6.3.3	(Guidelines C-IV, 11.5.1)	90
0.5.5	(Guidelines C-IV, 11.5.2)	92
6.3.4	Stage 3 – Why the invention is obvious ("could-would	- -
	approach") (Guidelines, C-IV, 11.5.3)	95
6.4	A problem and solution attack for paper C	96
6.5	Partial problems	98
6.5.1	Guidelines	98
6.5.2	Partial problems in paper C	98
6.6	Argumentation for independent claims	101
6.7	Argumentation for dependent claims	102
6.7.1	Higher order claim was attacked for novelty	102
6.7.2	Higher order claim was attacked for inventive step	103
6.8	The problem and solution approach in real life	106
7	Added Subject-Matter	107
7.1	Legal basis	107
7.2	Relevance to paper C	111
7.3	Judging added subject-matter	111
7.3.1	"Unambiguously derivable"	111
7.3.2	"Novelty test"	111
7.3.3	"Modified novelty test" or "Disclosure test"	112
7.3.4	Deleting features ("Essentiality test")	112
7.3.5	Unallowable intermediate generalisation	112
7.4	Description and drawings	112
7.5	Subsidiary attacks	113 113
7.6 7.7	Disclaimers (see also Guidelines C-VI, 5.3.11) Examples from past papers	113
_		
8	Ranges	121
8.1	Legal basis	121
8.2	Relevance to paper C	121
8.3	Novelty and ranges	122
8.3.1 8.3.2	Selecting a sub-range from a broader range of the prior art Overlapping ranges	122 123
8.4	Inventive step and ranges	123
8.4.1	Sub-ranges selected from a broader range	123
8.4.2	Overlapping ranges	124
8.5	Examples from past papers	124
9	Legal Questions	129
9.1 9.2	Alphabetical list of past legal questions	129
9.2	Alphabetical summary of past legal questions	130
10	Assessing your own Paper	153
10.1	Introduction	153
10.2	Main categories of error in paper C solutions	153
10.2.1	Detail	153
10.2.2	Analysis	154
10.2.3		154
10.2.4	Lime management	155
1075	0	
10.2.5 10.3	Lack of knowledge	155 155

DETAILED CONTENTS

Appendices	171
Appendix 1 – Methodology Examples C 1999	173
C 1999	191
Appendix 3a – Example notice of opposition	201
Appendix 3b – Beispiel für eine Einspruchsschrift	207
Appendix 3c - Exemple d'acte d'opposition	214
Appendix 4 - Matrix features-document template	221
Appendix 5a – Matrix claims-attacks template (EPC 1973)	222
Appendix 5b – Matrix claims-attacks template (EPC 2000)	223
Appendix 6 - References to frequently required legal authorities	224
6.1 Priority	224
6.2 Claim interpretation	225
6.3 Document interpretation	225
6.4 Prior art	226
6.5 Added subject-matter	227
6.6 Ranges	230
Appendix 7 – Paper C 1999	232
Index	279