

Contents

Foreword to the first edition	V
Preface	VII
Abbreviations used	XV
1 Introduction.	1
2 Methodology	11
3 Interpretation and analysis of disclosures	57
4 State of the Art.	61
5 Patentable and non-patentable inventions	65
6 Novelty.	71
7 Inventive Step.	79
8 Claims and Clarity	87
9 Amendments and correction	103
10 Drafting the letter in response to the communication	111
Appendix 1 – Paper B 2017	115
Appendix 2 – Examiners’ Report Paper B 2017	125
Appendix 3 – CEIPI Model Solution Paper B 2017	141
Index.	145

Detailed Contents

Foreword to the first edition	V
Preface	VII
Abbreviations used	XV
1 Introduction.....	1
1.1 Object of this book.....	1
1.2 Replying to official communications under Art. 94(3) EPC in the prosecution of European patent applications.....	1
1.3 Description of paper B.....	2
1.4 Study materials for the preparation for paper B	4
1.4.1 European Patent Convention (EPC)	4
1.4.2 Official Journal of the EPO.....	4
1.4.3 Guidelines for Examination in the European Patent Office.....	5
1.4.4 Case law of the EPO Boards of Appeal	5
1.4.5 Regulation on the European qualifying examination for professional representatives.....	6
1.4.6 Examination Compendium	6
1.4.7 Recommended commentaries in English, French and German	7
1.4.8 Selected guides for the preparation of the EQE	7
1.4.9 EQE online support by the EPO	8
1.5 Overall method for solving paper B	8
1.6 How to use this book?.....	9
2 Methodology	11
2.1 Objective	11
2.2 Preliminary steps	11
2.2.1 Regulation on the EQE	12
2.2.2 Implementing provisions to the Regulation on the EQE (IPREE).....	14
2.2.3 Instructions to candidates concerning the conduct of the European qualifying examination and Instructions to candidates concerning the conduct of the European qualifying examination 2021.....	17
2.3 Detailed methodology for solving paper B	18
2.3.1 Step 1: Getting an overview of the components of your paper B	19
2.3.2 Step 2: Performing a preliminary analysis of the subject-matter of paper B.....	19
2.3.3 Step 3: Finding the objections	22
2.3.4 Step 4: Performing a preliminary analysis of the prior art	30
2.3.5 Step 5: Performing an in-depth analysis of the patent application.....	32
2.3.6 Step 6: Drafting the set of amended claims.....	37
2.3.7 Step 7: Determining for the draft set of amended claims whether the material requirements (Art. 52-57 EPC) have been met, and optionally adapting the draft set of amended claims	42
2.3.8 Step 8: Drafting the supplementary note, if any	46
2.3.9 Step 9: Drafting the letter in response to the communication	49
2.3.10 Step 10: Final check	53
2.4 Strategy for solving paper B.....	54
3 Interpretation and analysis of disclosures.....	57
3.1 Legal basis	57
3.2 Relevance to paper B	57

3.3	Interpreting features	57
3.3.1	Interpreting technical terms and expressions	58
3.3.2	Non-limiting features	58
3.3.3	Identical features	58
3.3.4	Generic versus specific features	59
3.3.5	Features incorporated by reference	59
3.3.6	Implicit features	59
4	State of the Art	61
4.1	Legal basis	61
4.2	Relevance to paper B	62
4.3	State of the art	62
4.4	Examples from past papers	63
5	Patentable and non-patentable inventions	65
5.1	Legal basis	65
5.2	Relevance to paper B	66
5.3	Patentable inventions	67
5.4	Non-inventions according to Art. 52(2), (3) EPC	68
5.5	Exceptions to patentability under Art. 53 EPC	68
5.6	Non-technical features	69
5.7	Industrial application	70
5.8	Examples from past papers	70
6	Novelty	71
6.1	Legal basis	71
6.2	Relevance to Paper B	73
6.3	Analysis of novelty	73
6.4	Parameters	74
6.5	Novelty of selection inventions	75
6.5.1	Selection of chemical substances or groups of substances from generic formulae comprised in the state of the art	75
6.5.2	Selection of sub-ranges from broader ranges comprised in the state of the art	76
6.5.3	Overlapping ranges	76
6.5.4	Multiple selections	77
6.6	Novelty test	77
6.7	Examples from past papers	77
7	Inventive Step	79
7.1	Legal basis	79
7.2	Relevance to Paper B	80
7.3	Outlines of the problem and solution approach	80
7.4	The meaning of the requirement of inventive step in Paper B	83
7.5	Examples from past papers	84
8	Claims and Clarity	87
8.1	Legal basis	87
8.2	Requirements according to Art. 84 EPC	87
8.3	Provisions regarding the form and content of claims	88
8.4	Kinds of claims	89
8.5	Clarity and interpretation of claims	90
8.6	Support of the claims by the description	90
8.7	Independent claims	90
8.7.1	General principles	90
8.7.2	Things to avoid when drafting independent claims	92
8.8	Combinations of independent claims in different categories	92
8.9	More than one independent claim in the same category	93
8.10	Relevance to Paper B	93

8.11	Dependent claims	93
8.11.1	General principles applicable to dependent claims	93
8.12	Relevance to Paper B	95
8.13	Examples from past papers	95
9	Amendments and correction	103
9.1	Legal basis	103
9.2	Relevance to paper B	105
9.3	Judging added subject-matter	106
9.3.1	The gold standard	106
9.3.2	The “Novelty test” and the “Modified novelty test” or “Disclosure test” . .	106
9.3.3	Removing or replacing features (Essentiality test or Three-Point test)	106
9.3.4	Unallowable intermediate generalisation	107
9.4	Disclaimers	107
9.4.1	Undisclosed disclaimers	107
9.4.2	Disclosed disclaimers	108
9.5	Corrections of errors	108
9.6	Examples from previous papers	108
10	Drafting the letter in response to the communication	111
	Appendix 1 – Paper B 2017	115
	Appendix 2 – Examiners’ Report Paper B 2017	125
	Appendix 3 – CEIPI Model Solution Paper B 2017	141
	Index	145