

Detailed Contents

Foreword	V
Preface	XI
Contributions	XIX
Contents	XXI
1 Introduction	1
1.1 Object of this book.	1
1.2 Opposition proceedings.	1
1.3 Description of paper C.	2
1.3.1 Study material for the preparation of paper C.	4
1.3.2 Instructions to candidates concerning the conduct of the examination.	4
1.3.3 Implementing provisions to the Regulation on the EQE (IPREE)	5
1.3.4 Examiners' reports	7
1.4 EPC 2000 and the Guidelines for Examination.	7
1.5 Overall method.	8
1.6 How to use this book.	9
2 Methodology	11
2.1 Introduction	11
2.1.1 Objective	11
2.1.2 Summary	11
2.2 Overview of the methodology	12
2.2.1 Matrix claims-attacks	12
2.2.2 Overview of the analysis sheets recording technique	14
2.2.3 Overview of the matrix recording technique	15
2.2.4 Choice of recording technique	16
2.3 Detailed methodology	17
2.3.1 Client's letter and questions.	18
2.3.2 Patent to oppose (A1).	19
2.3.3 Analysis of the dates of the disclosures	24
2.3.4 "Other" attacks.	26
2.4 Analysis and attacks with analysis sheets technique	27
2.4.1 Analysis of the content of the disclosures	27
2.4.2 Determining the attacks.	30
2.5 Analysis and attacks with matrix recording technique	43
2.5.1 Analysis of the content of the disclosures	43
2.5.2 Determining the attacks.	46
2.6 Notice of opposition	55
2.6.1 Introductory part	55
2.6.2 Argumentation	56
2.7 Variants on the methodology	57
2.7.1 Combination of both methodologies	57
2.7.2 Shortened analysis sheets recording technique	58
2.8 General strategy tips.	60
2.8.1 Analysis strategy.	60
2.8.2 Attacks strategy	61

2.8.3	Drafting strategy	62
2.8.4	Time constraints	63
3	Objects of the claims and their priority	65
3.1	Legal basis	65
3.2	Relevance to paper C	67
3.3	Claimed objects	67
3.3.1	Independent claims	68
3.3.2	Dependent claims	69
3.3.3	Claims encompassing alternative subject-matter	69
3.4	Effective date	69
3.5	No valid claim to priority for the patent in suit	70
3.6	Conflicting applications (see table on next page)	71
3.7	Examples of determining priority dates	72
3.7.1	Intermediate publication of the contents of the priority application	72
3.7.2	Intermediate publication of another European application . . .	73
3.7.3	Multiple priorities with an intermediate publication	73
3.7.4	Check for “first application”	73
3.7.5	Partial priority and an intermediate publication	74
3.8	Examples from past papers	74
4	Interpretation and analysis	87
4.1	Legal basis	87
4.2	Relevance to paper C	89
4.3	Interpreting the claims	90
4.3.1	Interpretation of expressions in claims	90
4.3.2	Non-limiting features?	91
4.4	Interpreting the disclosures	92
4.4.1	Identical features	92
4.4.2	Generic versus specific features	93
4.4.3	Incorporated features	93
4.4.4	Implicit features	93
4.4.5	Conclusions to be drawn from specific remarks	94
4.4.6	Unusable disclosures	94
4.4.7	Combining different parts of a disclosure	94
4.5	Analysis in theory	95
4.5.1	What do we mean by analysis?	96
4.5.2	Finding features	96
4.5.3	Recording the result of the analysis	96
4.6	Analysis tutorial	97
4.6.1	Analysis test	97
4.6.2	Blow by blow analysis of A2	98
4.6.3	Analysis re-test	105
4.6.4	Additional aspects of analysis	105
5	State of the Art	109
5.1	Legal basis	109
5.2	Relevance to paper C	111
5.3	State of the art	111
5.3.1	Written disclosure	112
5.3.2	Oral disclosure	112
5.3.3	Prior use	113
5.4	Article 54(3) EPC – prior rights	113
5.4.1	European applications	113
5.4.2	Euro-PCT applications	114
5.4.3	Attacks under Article 54(3) EPC	114
5.4.4	Conflicting applications and priority	115

5.4.5	Priority not valid – affecting the applicability of Article 54(3) EPC	115
5.4.6	Priority not valid – no consequences for the applicability of Article 54(3) EPC.....	116
5.5	Examples from past papers	116
6	Inventive Step	127
6.1	Legal basis	127
6.2	Relevance to paper C	127
6.3	The problem and solution approach.....	128
6.3.1	Introduction	128
6.3.2	Stage 1 – Determination of the closest prior art (Guidelines G-VII, 5.1)	128
6.3.3	Stage 2 – Formulation of the objective technical problem (Guidelines G-VII, 5.2)	131
6.3.4	Stage 3 – Why the invention is obvious (“could-would approach”) (Guidelines G-VII, 5.3)	134
6.4	A problem and solution attack for paper C.....	136
6.5	Partial problems	138
6.5.1	Guidelines	138
6.5.2	Partial problems in paper C.....	138
6.6	Argumentation for independent claims	141
6.7	Argumentation for dependent claims.....	142
6.7.1	Higher order object was attacked for novelty	142
6.7.2	Higher order object was attacked for inventive step, no change in purpose	143
6.7.3	Higher order object was attacked for inventive step, but a change in purpose occurs	146
6.8	The problem and solution approach in real life.....	147
7	Added Subject-Matter	149
7.1	Legal basis	149
7.2	Relevance to paper C	154
7.3	Judging added subject-matter	154
7.3.1	“Unambiguously derivable”	154
7.3.2	“Novelty test”.....	155
7.3.3	“Modified novelty test” or “Disclosure test”	155
7.3.4	Deleting features (“Essentiality test”).....	155
7.3.5	Unallowable intermediate generalisation.....	156
7.4	Description and drawings	156
7.5	Subsidiary attacks?	156
7.6	Disclaimers (see also Guidelines H-V, 3.5, 4.1 and 4.2)	158
7.7	Examples from past papers	159
8	Ranges.....	169
8.1	Legal basis	169
8.2	Relevance to paper C	170
8.3	Novelty and ranges.....	170
8.3.1	Selecting a sub-range from a broader range of the prior art... ..	170
8.3.2	Overlapping ranges.....	171
8.4	Inventive step and ranges.....	171
8.4.1	Sub-ranges selected from a broader range	171
8.4.2	Overlapping ranges.....	172
8.5	Examples from past papers	172
9	Client’s Questions	181
9.1	Alphabetical summary of past legal questions.....	181

10	Assessing your own Paper	209
10.1	Introduction	209
10.2	Main categories of error in paper C solutions	209
10.2.1	Detail	209
10.2.2	Analysis	210
10.2.3	Structure	210
10.2.4	Time management	211
10.2.5	Lack of knowledge	211
10.3	Fictitious answer to paper C 2009 with comments	211
	Appendices	227
	Appendix 1a – Methodology Example C 2010	229
	Appendix 1b – Methodik Beispiel C 2010	238
	Appendix 1c – Méthodologie Exemple C 2010	247
	Appendix 2a – Notice of opposition and answer client’s questions C 2010	256
	Appendix 2b – Einspruchsschrift und Antwort auf die Mandantenfragen C 2010	265
	Appendix 2c – Acte d’opposition et réponses aux questions du client C 2010	275
	Appendix 3a – Example notice of opposition	284
	Appendix 3b – Beispiel für eine Einspruchsschrift	290
	Appendix 3c – Exemple d’acte d’opposition	297
	Appendix 4a – Matrix claims-attacks template (EPC 1973)	304
	Appendix 4b – Matrix claims-attacks template (EPC 2000)	305
	Appendix 5 – Matrix recording technique template	306
	Appendix 6 – References to frequently required legal authorities	307
	6.1 Priority	307
	6.2 Claim interpretation	308
	6.3 Document interpretation	309
	6.4 Prior art	310
	6.5 Added subject-matter	312
	6.6 Ranges	316
	Index	317