Contents

Foreword V
Preface IX
Contributions XV
Detailed Contents XIX
1 Introduction 1
2 Methodology 11
3 Objects of the claims and their priority 63
4 Interpretation and analysis 81
5 State of the Art 101
6 Inventive Step 117
7 Added Subject-Matter 137
8 Ranges 151
9 Client's Questions 161
10 Assessing your own Paper 187
Appendices 205
1a Methodology Example C 2010 207
1b Methodik Beispiel C 2010 216
1c Méthodologie Exemple C 2010 225
2a Notice of opposition and answer client's questions C 2010 234
2b Einspruchsschrift und Antwort auf die Mandantenfragen C 2010 243
2c Acte d'opposition et réponses aux questions du client C 2010 .. 253
3a Example notice of opposition 263
3b Beispiel für eine Einspruchsschrift 269
3c Exemple d'acte d'opposition 276
4a Matrix claims-attacks template (EPC 1973) 283
4b Matrix claims-attacks template (EPC 2000) 284
5 Matrix recording technique template 285
6 References to frequently required legal authorities 286
Index 293

Bibliografische Informationen
http://d-nb.info/103488834X

digitalisiert durch DEUTSCHE NATIONAL BIBLIOTHEK

Detailed Contents

Foreword V

Preface IX

Contributions XV

Contents XVII

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 18
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 23
2.3.4 "Other" attacks 26
2.4 Analysis and attacks with analysis sheets technique 26
2.4.1 Analysis of the content of the disclosures 26
2.4.2 Determining the attacks 29
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
2.8 General strategy tips 58
2.8.1 Analysis strategy 58
2.8.2 Attacks strategy 58
2.8.3 Drafting strategy 60

3	**Objects of the claims and their priority**	63
3.1	Legal basis	63
3.2	Relevance to paper C	65
3.3	Claimed objects	65
3.3.1	Independent claims	66
3.3.2	Dependent claims	67
3.4	Effective date	67
3.5	No valid claim to priority for the patent in suit	68
3.6	Conflicting applications (see table on next page)	69
3.7	Examples of determining priority dates	70
3.7.1	Intermediate publication of the contents of the priority application	70
3.7.2	Intermediate publication of another European application	70
3.7.3	Multiple priorities with an intermediate publication	71
3.7.4	Check for "first application"	71
3.8	Examples from past papers	71
4	**Interpretation and analysis**	81
4.1	Legal basis	81
4.2	Relevance to paper C	82
4.3	Interpreting the claims	82
4.3.1	Interpretation of expressions in claims	82
4.3.2	Non-limiting features?	83
4.4	Interpreting the disclosures	85
4.4.1	Identical features	85
4.4.2	Generic versus specific features	85
4.4.3	Incorporated features	86
4.4.4	Implicit features	86
4.4.5	Conclusions to be drawn from specific remarks	86
4.4.6	Unusable disclosures	87
4.4.7	Combining different parts of a disclosure	87
4.5	Analysis in theory	88
4.5.1	What do we mean by analysis?	88
4.5.2	Finding features	88
4.5.3	Recording the result of the analysis	89
4.6	Analysis tutorial	89
4.6.1	Analysis test	90
4.6.2	Blow by blow analysis of A2	90
4.6.3	Analysis re-test	97
4.6.4	Additional aspects of analysis	97
5	**State of the Art**	101
5.1	Legal basis	101
5.2	Relevance to paper C	103
5.3	State of the art	103
5.3.1	Written disclosure	104
5.3.2	Oral disclosure	104
5.3.3	Prior use	104
5.4	Article 54(3) EPC – prior rights	105
5.4.1	European applications	105
5.4.2	Euro-PCT applications	105
5.4.3	Attacks under Article 54(3) EPC	105
5.4.4	Conflicting applications and priority	106
5.4.5	Priority not valid – affecting the applicability of Article 54(3) EPC	107
5.4.6	Priority not valid – no consequences for the applicability of Article 54(3) EPC	108
5.5	Examples from past papers	108

6	**Inventive Step**	117
6.1	Legal basis	117
6.2	Relevance to paper C	117
6.3	The problem and solution approach	118
6.3.1	Introduction	118
6.3.2	Stage 1 – Determination of the closest prior art (Guidelines G-VII, 5.1)	118
6.3.3	Stage 2 – Formulation of the objective technical problem (Guidelines G-VII, 5.2)	120
6.3.4	Stage 3 – Why the invention is obvious ("could-would approach") (Guidelines G-VII, 5.3)	123
6.4	A problem and solution attack for paper C	125
6.5	Partial problems	127
6.5.1	Guidelines	127
6.5.2	Partial problems in paper C	127
6.6	Argumentation for independent claims	130
6.7	Argumentation for dependent claims	131
6.7.1	Higher order object was attacked for novelty	131
6.7.2	Higher order object was attacked for inventive step	132
6.8	The problem and solution approach in real life	135
7	**Added Subject-Matter**	137
7.1	Legal basis	137
7.2	Relevance to paper C	141
7.3	Judging added subject-matter	141
7.3.1	"Unambiguously derivable"	141
7.3.2	"Novelty test"	141
7.3.3	"Modified novelty test" or "Disclosure test"	142
7.3.4	Deleting features ("Essentiality test")	142
7.3.5	Unallowable intermediate generalisation	142
7.4	Description and drawings	142
7.5	Subsidiary attacks	143
7.6	Disclaimers (see also Guidelines H-V, 3.5, 4.1 and 4.2)	144
7.7	Examples from past papers	144
8	**Ranges**	151
8.1	Legal basis	151
8.2	Relevance to paper C	151
8.3	Novelty and ranges	152
8.3.1	Selecting a sub-range from a broader range of the prior art	152
8.3.2	Overlapping ranges	153
8.4	Inventive step and ranges	153
8.4.1	Sub-ranges selected from a broader range	153
8.4.2	Overlapping ranges	154
8.5	Examples from past papers	154
9	**Client's Questions**	161
9.1	Alphabetical summary of past legal questions	161
10	**Assessing your own Paper**	187
10.1	Introduction	187
10.2	Main categories of error in paper C solutions	187
10.2.1	Detail	187
10.2.2	Analysis	188
10.2.3	Structure	188
10.2.4	Time management	189
10.2.5	Lack of knowledge	189
10.3	Fictitious answer to paper C 2009 with comments	189

Appendices 205
Appendix 1a – Methodology Example C 2010 207
Appendix 1b – Methodik Beispiel C 2010 216
Appendix 1c – Méthodologie Exemple C 2010 225
Appendix 2a – Notice of opposition and answer client's questions C 2010 234
Appendix 2b – Einspruchsschrift und Antwort auf die Mandantenfragen C 2010 243
Appendix 2c – Acte d'opposition et réponses aux questions du client C 2010 253
Appendix 3a – Example notice of opposition 263
Appendix 3b – Beispiel für eine Einspruchsschrift 269
Appendix 3c – Exemple d'acte d'opposition 276
Appendix 4a – Matrix claims-attacks template (EPC 1973) 283
Appendix 4b – Matrix claims-attacks template (EPC 2000) 284
Appendix 5 – Matrix recording technique template 285
Appendix 6 – References to frequently required legal authorities .. 286
6.1 Priority 286
6.2 Claim interpretation 287
6.3 Document interpretation 287
6.4 Prior art 288
6.5 Added subject-matter 289
6.6 Ranges 292

Index 293