

Collegio Italiano dei Consulenti in Proprietà Industriale

Paper C EQE 2018

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FÉDÉRATION INTERNATIONALE DES CONSEILS
EN PROPRIÉTÉ INTELLECTUELLE

INTERNATIONAL FEDERATION OF
INTELLECTUAL PROPERTY ATTORNEYS

INTERNATIONALE FEDERATION
VON PATENTANWÄLTEN

DISCLAIMER

- The following presentation contains private opinions of the tutor. It is intended to provide the best advice according to the knowledge of the tutor.
- Each paper is different, and there is no single „methodology“ guaranteed to yield the correct solution of the paper. The best methodologies are called „knowledge“ and „common sense“.
- This presentation is not intended as a „methodology”



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PAPER C

BASIC RULES FOR TACKLING PAPER C



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WHAT DO YOU RECEIVE?

- Client's letter
- Annex 1 – patent to be opposed
- Annexes A2 to A? (typically A2 to A6) – documents provided by the client, can be used in attacking the Annex 1
- Empty opposition form 2300



WHAT ARE YOU REQUIRED TO PREPARE?

- To file an opposition against Annex 1
- To attack all claims that can be attacked
- Art. 100(a) grounds: not patentable under Art. 52-57
- Art. 100(c) grounds: added subject-matter
- Do NOT use Art. 100(b) ground



STEPS

1. Establish the number of claims and their dependency
2. Read the client's letter
3. Establish effective dates of the claims
4. Establish dates of the prior art annexes and their usability
5. Read the claims
6. Read and analyze Annex 1
7. Read and analyze prior art annexes A2-AX
8. Establish attacks
9. Draft the Notice of Opposition



1. Establish the number of claims and their dependency

- Read the claims paying attention to the different claim objects
- Dependency of the claims
- Different independent claims
- Alternatives in the claims
- One claim containing more than one object can have more than one effective date!



2. LETTER FROM CLIENT

- **PRIORITY ISSUES**
- Same applicant for priority and A1?
- Same applicant for any of Annexes?
- Is A1 the First filing? Continuation or continuation in part application?
- Differences between priority document and the application as filed?
- **Content of the application as filed**
- **Amendments** of the application during prosecution **Effective date of the claim?**
- Type of application (divisional?)



2. LETTER FROM CLIENT

- **Could contain legal question**
- **ATTENTION YOU DO NOT HAVE ORIGINAL APPLICATION OR FILE INSPECTIONS, CLIENT GIVES THE RELEVANT INFORMATION!**
- **ATTENTION GOOD HINTS FOR 123(2) AND/OR Art. 76(1) ATTACKS**



3. Establish effective dates of the claims

- AT THE END YOU WILL BE ABLE TO INDICATE THE EFFECTIVE DATES OF ALL THE CLAIM OBJECTS

CLAIM	priority date	filing date	no effective date
1	X		
2+1	X		
3+1		X	
4A	X		
4B		X	
5			X
6		X	

4. Establish dates of the prior art annexes and their usability

- Art. 54(2) documents
- Art. 54(3) documents
 - EP or PCT designating EP (and entered or that could be enter EP phase)
 - Duly published (beware of invalid publication)
- Some annexes may not be usable directly for attacks
 - Definitions
 - Evidence of common general knowledge
 - The true first application

4. Establish dates of the prior art annexes and their usability

- At the end of the analysis you should be able to indicate somewhere the usability of documents Art. 54(2) documents.
- Add the indication 54(2) or 54(3) on the document or indicate the dates in the table
- Add comment on the owner (if relevant) in the documents or in the table

A2	A3	A4	A5	A6
GR 1003623	NL1020255	EP2105899	JOURNAL	WO2014/185937
54(2)	54(2)	54(2)	54(2)	no 54(3) NO entry EPO 54(2) per claim 6

5. READ THE CLAIMS

- Of utmost importance for drafting Art.100(a) attacks
- Category of the claim (product, process, use, product-by-process, ...)
- „For use“ in product (suitable for) vs. process (limiting - mostly)
- Comprising vs. consisting
- Non-limiting features (preferably, such as, ...)
- Which claims are truly dependent on previous claims vs. which claims are only referring to claims of other categories



6. READ THE PATENT –ANNEX 1

- Establish the technical field
- highlight definitions
- highlight technical effects and associate them to a certain feature from the claim
- highlight examples



7. READ AND ANALYSE PRIOR ART ANNEXES

ALL the ANNEXES will be useful either directly for the attacks or for the definitions, information contained therein.

FOR EACH ANNEX:

- delimit technical field, prior art and different embodiments
- identify features **identical to**, or encompassed by, features in the claims
- identify features **implicit** in the disclosure
- highlight technical effects, associate them to features and find common effects with the ones from the invention
- highlight **definitions** and examples



8. ESTABLISH ATTACKS TO THE CLAIMS

- grounds according to Art 100a EPC:
 - Art 52 Patentable inventions (not regarded as inventions)
 - Art 53 Exceptions to patentability
 - Art 54 Novelty
 - Art 55 Non-prejudicial disclosures
 - Art 56 Inventive step
 - Art 57 Industrial application
- grounds according to Art 100C EPC:
 - Subject matter of EP patent extends beyond the content of the application (or parent as filed: Art. 123(2) and/or Art. 76(1))



NOVELTY ATTACK

- Basically copy the claim and for each feature explain in parentheses where it can be found in the cited ANNEX and why it is the same (if not indicated by the same word)
- You gain marks for finding the feature (use of information marks), but more importantly for arguing why it is the same feature (argumentation marks)
- In this argumentation you will sometime refer to another Annex, in which the definition is given



NOVELTY ATTACK

- Generic vs. specific (specific disclosure takes away the novelty of generic disclosure, but not vice versa, e.g., „copper“ vs. „metal“)
- Implicit features – only if there is a strong case (sometimes hinted on by other documents) – do not speculate or overthink, do not use your specialist knowledge
- Equivalence of features, e.g., the fact that polyethylene is a polyalkylene, is always provided in another document



INVENTIVE STEP ATTACK

- Only Art. 54(2) documents can be used (be careful, this is a very common overlook!)
- Use problem-solution approach (PSA)
- You get a lot of marks for proper (specific) argumentation, both „use of information marks“ and „argumentation marks“
- You get no marks for general statements



INVENTIVE STEP ATTACK

1. determine closest prior art (CPA)

- add reasoning for selecting the CPA
- Not necessarily the document used for a novelty attack of the independent claim
- Not necessarily the document having the highest number of features in common

2. mention features in common with the claim

- similar to a novelty attack

3. determine the difference between claim and CPA

1. In term of object

4. technical effect of that difference

- as presented in A1



INVENTIVE STEP ATTACK

5. formulate objective technical problem

- Choose the “macroscopic effect”
- Effect is the same as in the CPA – the OTP is to find an alternative
- No technical effect of the different feature – no OTP

6. combine CPA with another document/disclosure and mention why said document may be considered by skilled person

- Motivation of the skilled person to find the second document (e.g., same field, more general field, neighboring field – why the SP would look there)

7. argue why skilled person is motivated to use solution from said document (could/would approach)

- compatibility of materials, no need for further technical modifications, direct hint in the second document that the solution is generally utilizable, etc

8. Conclusion



PARTIAL PROBLEMS APPROACH

- Allows to combine more than 2 documents for PSA
- When there are 2 (or more) differences between the CPA and the attacked object
- Comes up very often
- Basis: if the differences solve different problems which do not have anything in common (i.e., there is no synergy between the effects), they can be treated separately



PARTIAL PROBLEMS APPROACH

- Determine the differences from the CPA
- For each difference, determine effect
- Argue why the effects are independent, i.e., why there is no synergy or cooperation between the effects
- Determine the OTPs, treat the OTPs separately, i.e., continue with a separate PSA for each difference



METHODOLOGY

- There exist several methodologies for dealing with paper C
- Beware! Each methodology only serves to organize the information, but it does not miraculously provide a solution on its own!
- **Do not create complicated matrix which will be unsuitable for the exam**
- **Scope is efficiently note all the information in the PAPER**
- You need to find or adapt a methodology which suits you best.



METHODOLOGY suggestion

- **A1:** mark the effects (with reference to the relevant paragraph) to each feature on the claims page
- **ANNEXES:**
 1. when the same feature with the same effect is found in a document, mark the reference to the document and paragraph next to the feature and effect on the claims page;
 2. mark the field of the Annexes;
 3. mark the definition contained in the annexes next to the relevant feature of the claim;
 4. Mark suggestion/teaching away



TIPS

- Prepare a template for paper C structure, include suitable standard opening and/or closing sentences for individual types of attacks.
- Do not be tempted to include standard wording of attacks, containing only (or mostly) general statements – no marks for general statements!
- Develop your own methodology of organizing information rather soon (or use one of the shown methodologies, if it suits you)
- Train and test your methodology on as many mock papers as possible, improve it if necessary



TIPS

- Use paper stickers (Post-It) to mark the documents or important part of the documents
- Develop a method of marking features, effects and general definitions (highlighting, underlining, ...)
- Find a method for organizing the material of the paper, do not mix up during the exam



GENERAL OBSERVATIONS

- Usually all claims can be attacked
- When there is an Art. 54(3) novelty attack, there is often an additional attack
- When there is an added subject matter attack, there is often an additional attack, unless the added subject matter leads to an inescapable trap
- There is always at least one claim with two objects
- There is always one attack containing partial problems
- There is often an accidental anticipation of independent claim, the novelty destroying document is then NOT CPA for IS attack to dependent claims



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AND NOW LET'S TRY



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