

CHAPTER 10 - WRITING YOUR ANSWER - INTRODUCTORY PARAGRAPHS

10.1 Introductory paragraphs

In the structure of the possible solution in the compendium, the answer contains three introductory paragraphs:

- A paragraph dealing with formalities,
- A paragraph about effective dates,
- A paragraph about the prior art documents

It is not necessary to write these paragraphs like this, as long as the information is somewhere in your answer. However, it is a good idea to write these paragraphs, as it helps the corrector to spot this information and give you the marks you deserve. Otherwise, the information might get overlooked.

10.2 The paragraph about formalities

As was discussed in Chapter 4, paragraph 5 of this book, you need to write a paragraph in your answer to deal with the formalities.

As was discussed in Chapter 4, paragraph 5, it is not entirely certain what is expected to be present in this paragraph: is the information shown in the model solution of the compendium for the paper of 2019 sufficient, or do you need to comply to R. 25(4) IPREE to the letter?

Suitable formulations are the following:

The short version, based on the compendium of the 2019 paper:

“Opposition is filed in the name of <<OPPONENT>> against <<NUMBER OF PATENT TO BE ATTACKED>>(Annex 1).

The opposition fee has been paid.

The patent is opposed on the grounds of Article 100(a) EPC for lack of novelty and lack of inventive step as well as Article 100(c) EPC.”

The longer version, based on Rule 25(4) IPREE:

“Herewith, a notice of opposition is filed against European Patent <<NUMBER OF PATENT>>, the patent proprietor being <<NAME PROPRIETOR>>. The title of the patent is <<TITLE>>.

The opponent is: <<NAME OF OPPONENT>>, <<ADDRESS + STATE OF RESIDENCE + NATIONALITY>>

The opponent is represented by: <<NAME REPRESENTATIVE>>, <<ADDRESS + STATE>>

The opposition fee has been paid.

The opposition is directed against the patent in its entirety. The patent is opposed on the grounds of Art. 100(a) EPC for lack of novelty and lack of inventive step as well as Art. 100(c) EPC.”

10.3 A separate paragraph about effective dates?

You can put the information about effective dates in a separate paragraph, or start each attack with addressing the effective date of the claim that is attacked. Both options are OK, as long as the information is somewhere in your answer.

The sections with the “Possible solution” in the Examiners’ report in the Compendium generally contain a separate paragraph in which the effective dates of the claims are discussed, so that may be the preferred option. But if it somehow does not work for you, just make sure the effective dates of all claims are discussed somewhere in your answer.

No matter which approach you take, make sure your answer contains for each claim and for each alternative in a claim:

- what the effective date for that claim or alternative is, and
- whether the effective date is based on the filing date or on a priority date, and
- why this filing date or priority date is the basis for that effective date.

For example, you could write:

“The effective date of claim 3, in respect of the first claimed alternative (feature X), is ... (date, month, year), which is the filing date of Annex 1. This alternative of claim 3 was not disclosed in the priority application, as in the priority application claim 3 only contained the other alternative (feature Y) and paragraph 17 of the description of the patent as granted was not present in the priority application. Therefore, claim 3, in respect of the first claimed alternative is not entitled to the priority date.”

It is important to explain why a claim is or is not entitled to priority to obtain full marks for this topic.

10.4 Formulation: effective date of claim

The analysis of the effective dates of the claims generally boils down to an analysis of the validity of the priority claim(s). For each claim, you have to explain why the priority is or is not valid. This explanation can be noticeably short if the situation is obvious, but in some cases, it could require a longer explanation.

Examples of suitable formulations:

- The patent does not claim priority. Therefore, for all claims, the effective date is the filing date, which is ...
- The subject-matter of claims 1, 2 and 5 of the patent is also disclosed in the priority document (see paragraph ... /claim ...). Therefore, they validly claim priority. Their effective date is the priority date, which is ...
- The subject-matter of claim 3 was not disclosed in the priority document. Therefore, claim 3 is not entitled to priority. The effective date of claim 3 is the filing date, which is ...
- Claim 6 contains two options, which are the combination of features A, B and C (“claim 6a”) and the combination of features A, B and D (“claim 6b”). The priority document only contains the combination of features of claim 6a. Therefore, claim 6a is entitled to priority but claim 6b

is not. So, the effective date of claim 6a is the priority date, which is ... and the effective date of claim 6b is the filing date, which is ...

If the situation is more complicated than the situations in the examples above, add a longer and more detailed explanation.

10.5 What to say about priority in your answer?

A rule of thumb in relation to any legal issue is that you do not have to write about things that are clearly OK. For example, if the priority application was filed on 11 October (even if that is on a Saturday) and the subsequent application was filed one year later on 9 October, you will not obtain marks by saying that the subsequent application was filed within the 12-month period of Article 87(1) EPC. After all, an opponent must try to invalidate the patent, not explain why it is valid.

With respect to priority, there are likely to be marks in things that are OK, but not clearly OK. Almost always there are marks awarded for noting that there could be a problem, showing that you investigated this potential problem and concluding that in this particular situation there is no problem.

For example, when the priority application was filed 9 October 2020 and the subsequent application was filed on 11 October 2021, it looks like the subsequent application was filed outside the 12-month period of Article 87(1) EPC. However, when you look at the calendar, you will see that 9 October 2021 is a Saturday, and 11 October 2021 the subsequent Monday. Pursuant Rule 134(1) EPC, the subsequent application was filed on time. It is highly likely that you will score marks for dealing with this issue correctly, if you explain what the case is and provide the correct analysis and conclusion.

Another example is when the applicant of the priority application is not the same as the applicant of the subsequent application. In such a case, the priority could still be validly claimed when the applicant of the subsequent application is the successor in title of the applicant of the priority application (Article 87(1) EPC; GL/EPO A-III 6.1). In general, the Opponent's letter will contain information for you to determine whether the applicant of the subsequent application is the successor in title of the applicant of the priority application. In your answer, you will have to explain why this is the case or not.

It may be wise to check the names of the applicants and inventors of the prior art documents. If one of these documents has the same inventor (or applicant) as the patent to be attacked, make sure to check whether the document from which priority is claimed can be regarded as the first application that discloses the invention for which priority is claimed (see Article 87(1) and (4) EPC).

Of course, if a claim is not entitled to priority, you will have to write this in your answer. In order to obtain full marks for this topic, you will have to explain why this claim is not entitled to priority. The explanation has to be detailed and has to refer to the situation that is presented to you in the paper. It is not sufficient to say "claim 4 of Annex 1 is not entitled to priority because claim 4 was not present in the priority application". You will also have to show that you have checked that the subject-matter of claim 4 of Annex 1 was also not present in the description of the priority application.

10.6 Beware: claims that contain added subject-matter

The Exam committee has stated explicitly a number of times that when a claim is attacked for added subject-matter, a second attack for lack of novelty or lack of inventive step is considered to be “inappropriate”. The explanation given is that a claim which contains added subject-matter does not have an effective date. As both an attack for lack of novelty or lack of inventive step require determination of the effective date in order to establish whether a document or other disclosure is prior art, these attacks would not make sense. There is however no guarantee that this point of view will be upheld in the future. It could for example be that an additional attack is expected when the Exam committee is of the opinion that the attack for added subject-matter could easily be overcome by the patentee. This is unfortunately rather uncertain at this moment.

A practical implication of this is that a claim which contains added-subject-matter either should not be discussed in the paragraph of the answer that deals with effective dates or it should be mentioned in this paragraph that the claim has no effective date because it contains added-subject-matter. If you choose the latter, refer to the paragraph of your answer with the added subject-matter attack.

For any of such claims, the remark that the claim contains added subject-matter and therefore does not have an effective date should suffice in the paragraph about effective dates. Dedicate a separate paragraph to the explanation of why this claim contains added subject-matter. This way, you avoid writing what is effectively an attack in a paragraph where only analysis is expected. Writing a separate paragraph containing the attack helps the corrector of your exam to keep an overview and contributes to a clear structure of your answer in general.

We often see that candidates mix up added subject-matter attacks and argumentation that a claim is not entitled to priority because its subject-matter was disclosed in the priority application. The risk of this mix up can be reduced if you do the analysis for both right after reading the description of the patent to be attacked, then make a conscious decision about which claims have an added subject-matter issue and which claims have a priority issue, then write the attack(s) for added subject-matter and then the paragraph about effective dates.

10.7 Prior art

It is useful to add a separate paragraph in which you explain which Annexes are which type of prior art (or not prior art at all) for which claims. Alternatively, you can mention in each attack why the documents that are used in that attack are which type of prior art. Again, as long as this information is contained somewhere in your answer, it should be OK. The model solution in the compendium usually contains a separate paragraph about the prior art.

When the paper contains a legal issue that is related to whether a disclosure can be used as prior art or not, it is generally useful to write a separate paragraph. This avoids that you have to do a lengthy explanation as part of an attack for lack of novelty or lack of inventive step. Addressing the issue separately helps the corrector of your exam to keep an overview and contributes to a clear structure of your answer in general.

Examples of suitable formulations are:

- The following documents were published well before the priority date of the patent and therefore are prior art pursuant to Article 54(2) EPC for all claims: A2, A3, A5.
- A4 is an international (PCT) application that was filed after the priority date but before the filing date of the patent (A1). It was published after the filing date of the patent. A4 validly entered the European phase (Article 153(5) and Rule 165 EPC). Therefore, A4 is prior art pursuant to Article 54(3) EPC for the claims that are not entitled to priority, and not prior art for the other claims.

The formulation given at the first bullet point above is a very time efficient one to write. You write this sentence at the beginning of the paragraph about prior art, and you add the numbers of the respective annexes as you flip through the prior art documents.

If the situation is more complicated than the situations in the examples above, include a longer and more detailed explanation. This occurs for example when one of the Annexes is evidence of public prior use or oral disclosure, e.g. a product information sheet which accompanied a product that was sold, a newspaper article about a trade fair, or an account of oral disclosure. And make sure not to mix up public prior use (e.g. by means of an unconditional sale) and oral disclosure (e.g. a presentation at a conference).

Note that it is in general not useful to write a paragraph about the contents of the prior art. This will only cost time and you will not get any marks for it.