

CHAPTER 1 METHODOLOGY FOR ANSWERING LEGAL QUESTIONS OF THE PRE-EXAM

In the legal questions of the pre-exam, you are expected to apply your legal knowledge quickly and correctly to a legal situation that is given. In principle, there are four steps to be taken when assessing whether a statement in a legal question in the Pre-examination is TRUE or FALSE (see Figure 1.1). In the following paragraphs, each step will be discussed in more detail. XXX

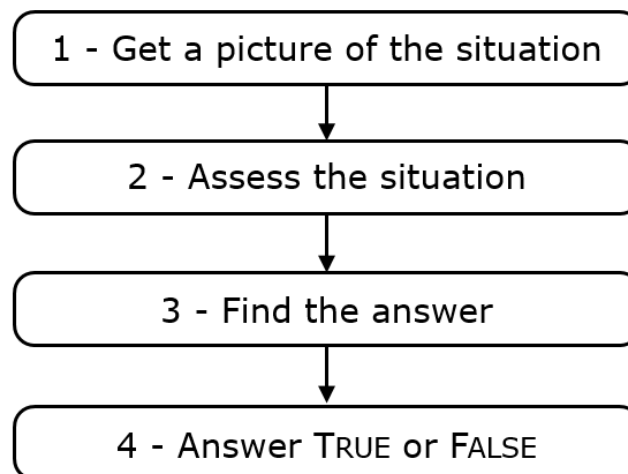


Figure 1.1 – Steps for tackling a legal question in the Pre-examination.

1.1 Step 1: Get a picture of the situation

Every legal question in the pre-exam describes a legal situation in the form of a short ‘story’. When reading this ‘story’, make sure you do not miss or overlook any information. You have to be aware that all information in the ‘story’ is there for a reason: try to use all information in your analysis.

In order to be able to answer the question, you need to understand the situation given in the ‘story’ and have a clear view of all the details that are presented. However, be careful not to read anything in the question and the corresponding statements that is not there. Stick to the given facts.

Highlighting on the screen or summarising the ‘story’ in the form of a list of bullet points or by making a time lime may assist in getting an overview of the situation. This may avoid unnecessary re-reading of the question.

1.1.1 Keywords

A good approach to dealing with a legal-question is to identify keywords which are present in the wording of the ‘story’ in the question and the corresponding statements, while you are reading. The keywords tell you what the question and statement are about and thereby, where to start looking for the answer. For example, if the keywords tell you that the question and/or statement is about filing a divisional application, you know that Art. 76 and Rule 36 EPC will be your starting point.

Examples of keywords are:

- Priority (Art. 87 EPC; Art. 4 Paris Convention; PCT Art. 8),
- Request for examination (Art. 94(1) EPC),
- Communication under Art. 94(3) EPC (see the example question in § 1.1.3),
- Refusal of the patent application (Art. 97(2) EPC) or mention of the grant of a European patent (Art. 97(3) EPC),
- Opposition (Art. 99 EPC) or appeal (Art. 108 EPC),
- Representation (Art. 133 EPC; PCT Rule 90),
- International application without claiming priority (PCT Art. 2(xi)),
- The EPO acting as International Searching Authority (PCT Art. 16; Art. 152 EPC) informing the applicant that the international application does not comply with the requirement of unity of invention (PCT Art. 17(3)(a); Rule 158(1) EPC),
- Entry of an international application into the regional phase before the EPO (PCT Art. 22(1) or Art. 39(1)(a) ; Art. 153 and Rule 159 EPC).

1.1.2 Dates in questions

Some questions in the pre-exam mention a date on which something happens. These dates are always there for a reason. When a date is mentioned in a question, often one of the answers asks about a date when a period expires.

You have to be able to calculate the relevant period (Rule 131 EPC or PCT Rule 80) and check the date in the calendar. Use the calendars of the correct year as included in the documents you receive at the exam and check whether the calculated period ends in a weekend or on a day that at least one of the offices of the EPO is closed. Accept the information in the calendars that are handed out at the exam and do not take account of extra days where the EPO may be closed which are not indicated in the calendar handed out at the EQE. Do not use any calendars you prepared at home, as the calendars to be used at the exam may be different.

Often, the end of a calculated period falls in a weekend or on a day on which one of the EPO filing offices is closed or mail is not delivered there. Therefore, it is important that you know how to apply Rule 134(1) EPC and PCT Rule 80.5.

1.1.3 Example question

Figure 1.2 is an example question (adapted from a legal question in the 2015 Pre-examination).

This is a typical “story” as is presented to you in the Legal Questions part of the pre-exam. It contains quite a lot of information in a condensed form. You probably cannot remember all the details after you have read it once. Therefore, it may help you for example summarise the story in a bullet point list, as shown in figure 1.3.

Keywords in this question are:

- Utility model
- Priority
- Publication during priority year

The German company C filed in December 2019 a German utility model application DE-C directed to a solution of the substance X in water. The utility model was published in March 2020.

In November 2020 company C filed a European patent application EP-C claiming priority from DE-C.

EP-C has three claims: claim 1 is directed to a solution of the substance X; claim 2, which is dependent on claim 1, is directed to a solution of the substance X in water; claim 3, which is dependent on claim 1, is directed to a solution of the substance X in alcohol.

In September 2020, the solution of the substance X in water was made available to the public in a scientific publication.

Company C has not filed any other applications.

Figure 1.2 – Example question.

- German utility model application DE-C filed Dec 2019
- DE-C directed to a solution of the substance X in water
- DE-C published March 2020
- Nov. 2020 company C filed a European patent application EP-C
- EP-C claims priority from DE-C
- EP-C cl. 1 : solution of X
- Cl. 2 – dep. on 1 - solution of X in water
- Cl. 3 – dep. on 1 - solution of X in alcohol.
- Sept. 2020, solution X in water: published in scientific publication
- No other applications

Figure 1.3 – Summary of the story of example question

1.2 Step 2: Assess the situation

After carefully reading and understanding the ‘story’, it is time to look at the statements in relation to the situation that is presented in the ‘story’.

Although you are under stress: read the statement carefully.

Generally, it is a good idea to read all four statements before starting to work on statement 1. The statements set the tone of the question.

If you do not have a clue where to look for the answer right away: move to the next question. Return to any problem question later on. Of course, you must not forget the un-answered question(s) and/or statement(s). You can make a note on a scrap piece of paper that you still need to answer this question. Put such a piece of paper on a visible place on your desk: make sure your eye falls on it. Alternatively, you can prepare a template answer sheet with the question numbers and use colour markers: use green for answers to statements of which you are completely sure. Use orange for statements which require revision. Use red for questions that you still need to answer.