

CHAPTER 3 STEPS OF THE METHODOLOGY

3.1 Steps in the methodology

The claim analysis requires you to read the description of the invention and the prior art, and work through the questions. The order in which you do these things also depends on the paper and on your personal preferences, and also on the format in which the paper is presented to you in the e-EQE and/or the complexity of the paper. For example, it can make a difference which documents can be printed and which ones not. The order indicated below in § 3.1.1 has proven to be a good approach in the paper EQE's up to 2019 and could also be used in the e-EQE. However, depending on the details of the format of the e-EQE, a different approach may work better for you (see paragraph 3.1.2 below). XXX

3.1.1 The "classic approach"

For a paper which contains a single invention and multiple set of claims, the below has shown to be a good approach for the paper EQE's. Depending on the actual format of the e-EQE, it can also be a good approach there. This "classic" approach comprises the following steps:

- 1) Read and annotate the description of the invention,
- 2) Find the first set of claims and the questions related to this set of claims (do not study the claims yet),
- 3) Solve the questions related to the first set of claims for which you do not need the prior art documents. These are for example questions related to scope of protection, clarity and amendments. Read only the claims that you need (including e.g. claims to which a dependent claim refers),
- 4) Read and annotate the prior art documents,
- 5) Solve the questions related to the first set of claims for which you need the prior art documents. These are for example questions related to novelty and inventive step. Read only the claims that you need (including e.g. claims to which a dependent claim refers),
- 6) Put aside the first set of claims and the questions relating to this set of claims,
- 7) Find the subsequent set of claims and the questions related to this set of claims (do not study the claims yet),
- 8) Solve the questions related to the subsequent set of claims for which you do not need the prior art documents. These are for example questions related to scope of protection, clarity and amendments. Read only the claims that you need (including e.g. claims to which a dependent claim refers),
- 9) Solve the questions related to the subsequent set of claims for which you need the prior art documents. These are for example questions related to novelty and inventive step,
- 10) Put aside the subsequent set of claims and the questions relating to this set of claims,
- 11) Repeat steps 7-10 until you have finished all questions,
- 12) Finishing up: if you have not ticked the relevant circles for each statement yet, tick the answers on the screen, do that now. Further checks and final wrapping up if you have time.

For a paper which contains more than one invention and a single set of claims per invention, the below is a good approach:

- 1) Perform steps 1 to 11 (from the single invention approach) for the first invention,
- 2) Put aside the part of the paper relating to the first invention,
- 3) Perform steps 1 to 11 (from the single invention approach) for the subsequent invention,
- 4) Put aside the part of the paper relating to the subsequent invention,
- 5) In case there are more than two invention, in the paper: repeat steps 3 and 4 as often as necessary,
- 6) Finishing up: if you have not ticked the relevant circles for each statement yet, tick the answers on the screen, do that now. Further checks and final wrapping up if you have time.

Mixed forms of these two approaches can also occur, for example in case the claim analysis contains two inventions, the first one accompanied by a single set of claims and the second one accompanied by two sets of claims.

3.1.2 Alternative approach

Alternative approaches are possible as well. What will be most efficient will depend on the format and complexity of the paper.

The format with the claim analysis part being split up into two parts, each dealing with an entirely different invention generally reduces the complexity of the case. This means that probably there are less embodiments of the invention, and less prior art documents. Therewith, you are probably less overwhelmed by the amount of information than in a case where you would have to deal with a single invention throughout the entire claim analysis part. In addition, in the chosen format for the e-EQE, it may be that you do not get a separate document with the claims, but that claims are given to you only on the page that also contains the question, including the four statements related to that question.

A very straightforward approach for such cases is:

- 1) Read and annotate the description
- 2) Read and annotate the prior art
- 3) Work through the questions in the order in which they are presented to you.

In the following paragraphs, the different steps in the method will be discussed in more detail.

3.2 Reading the description of the (first) invention

Print the description of the invention and the prior art documents if the e-EQE allows you to do so. This will make your life a lot easier during the exam, as it may not be possible to have different windows open on your screen simultaneously.

The first thing to do is to familiarise yourself with the (first) invention of the paper. The description of the invention is usually similar in structure to a regular patent application. The description starts with a general description of the prior art, the problem to be solved and the general idea of the invention. Then a few embodiments are described in more details. Usually, some figures are added. Do not yet read the claims at this point.

Before reading, stick a tab on the description and figures, so that later you can quickly retrieve the pages of the paper containing the description and figures. Consider applying a paperclip, clamp or bulldog clip on the description and figures. It is probably most convenient to bundle the description pages and the figures separately.

Figure 3.1 shows a suitable arrangement of the pages of the paper on your desk for this step: the “working area” in the part of the desk directly in front of where you are seated and the electronic working area being your computer/screen with access to the internet-based exam environment. With the e-EQE a formal answering sheet is not available anymore (as answers must be submitted online), but it is advisable to provide a template answer sheet so you can keep track of your answers on one page.

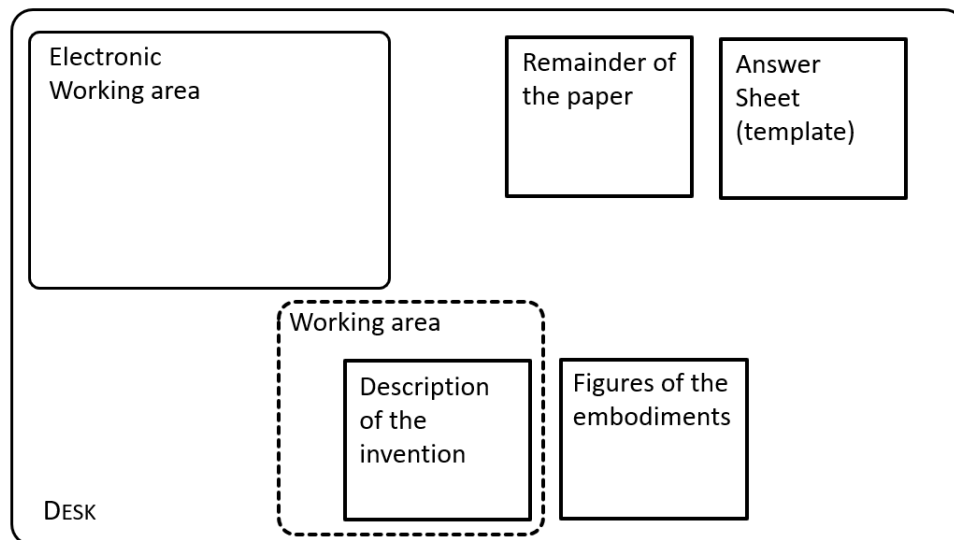


Figure 3.1 – Suitable arrangement of documents on desk when reading description

The aim of reading the description is to get to understand the invention and to identify the different embodiments.

Read with an open mind, with the confidence that you can do this. Do not be afraid that you may not understand the invention completely. The paper is written such that the technical details that are necessary for answering the questions are understandable for every candidate, regardless of their technical background. Also, do not think too deeply about the invention. Accept the facts as given in the paper, even though they may not make sense to you from a technical point of view. The paper may contain a fictitious invention that is unlikely to work in real life. Do not worry about that, just work with the information the paper gives you.

With respect to the different embodiments, you should be able to answer the following questions after reading the description:

- What are the differences between the embodiments?
- What do the embodiments have in common?
- Which figure shows which embodiment?

In order to enable you to retrieve relevant information from the description quickly later on, annotate the description while reading it. Several types of annotations are useful.

A first type of annotation, which will also help you to focus when reading, is to write in the margin next to each paragraph what the paragraph is about. For example, write “prior art”, “problem to be solved”, “first embodiment”. When you later need information of about for example the first embodiment, you can locate it by just scanning the notes in the margin. You do not have to read the description again just to locate the information that you need.

A second type of annotation is highlighting important information. The description contains different kinds of important information, which you need later for solving the questions.

The following kinds of information are present in the description:

- Information about technical effects and problems solved, both at the level of the invention as a whole and on the level of individual features,
- Definitions, genus-species relationships,
- Features of the different embodiments,
- Things of general interest, which look important but for which it is not clear yet in which way they will be important.

Use different colours of highlighters for the different types of information, for example green for the technical effects/problems and blue for the definitions/genus-species relations, yellow for the features and orange for the things of general interest. This way, when you need for example information about a technical effect to solve a certain question, you quickly scan through the description, looking only at the parts that are highlighted in green.

You can consider using different colours for the features of different embodiments, depending on the amount of colours that you prefer to use.

Try out different forms of highlighting to find out what works best for you. Instead of using highlighters in different colours, you may consider to underline and/or circle the information with different colours or different types of underlining or encircling, e.g. a single line, a dashed line, a double line under or around the information.

In the figures, it is useful to indicate which figure shows which embodiment. In general, it is not useful to write next to each reference numeral to which feature it relates as this takes a lot of time. However, for some important features or features that you do not recognise immediately by looking at the drawing, it makes sense to write next to the respective reference numeral to which feature it relates.

3.3 The first set of claims and related questions

3.3.1 Getting organised

After reading the description and therewith getting an idea about the invention and its embodiments, it is time to proceed to the first set of questions. The first set of questions relates to the first set of claims.

As you will now need the pages of the paper containing the first set of claims and the questions relating thereto, it is time to re-arrange the pages on your desk. A suitable arrangement for this stage of the exam is shown in figure 3.2 below. Keeping the claims close to your working area makes that you always have them in sight.