

# C-Book

*How to write a successful opposition  
and pass paper C of the European Qualifying Examination*

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Sixth Edition

Leseprobe



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## Foreword to the sixth edition

The “C-Book” figures first and foremost among the books used by candidates preparing paper C. It largely remains the authoritative textbook on how to pass Paper C of the European Qualifying Examination. It is the companion textbook for candidates who follow the CEIPI preparatory courses for this exam. It can also be used for those candidates who hope, through self-study at home, to acquire sufficient knowledge and practice for paper C. More information on special issues occurring lately in Paper C has been included. In this respect, the chapter on inventive step has been brought up to date even more.

On behalf of CEIPI, I would like to express my thanks to the authors. Their commitment, dedication and long-time loyalty to CEIPI are striking. Their efforts have made paper C one that is possible to pass!

Strasbourg, July 2019

*Thierry Debled,*  
*Director of the International Section of CEIPI*

## Preface to the sixth edition

Since the last edition of this book, the knowledge and skills required to pass paper C have become more sophisticated, reason enough to publish a new edition.

In the CEIPI courses that have been designed specially for “resitters”, candidates hand in a copy of their last paper, which is then reviewed by us. This provides us with much insight in what difficulties candidates encounter in this paper. It is not infrequent that a candidate in principle has all the attacks right, but fails the paper by the lack of detail as required by the Examination Committee paper C. This experience is now finding even more its way into the C-Book, sixth edition.

In these courses it turns out that another cause for failure is the lack of time to produce an acceptable result. The suggestions we made in this respect on exam strategy, methodology and time management in the fifth edition have now been expanded upon.

Finally, the chapter on “inventive step” has been reviewed and updated to take account of the more stringent requirements on argumentation of lack of inventive step, as apparent these last few years.

As for previous editions, all references to the Guidelines for Examination have been updated to the latest version (November 2018) and all chapters have been updated for the last three examinations.

Finally, many thanks go to Carl Heymanns Verlag Munich, in particular Kai Endlich, Jan Lindloff and Margaretha Pirzer, for their continued collaboration, support and enthusiasm for this book.

Please send any criticism, errors noted, suggestions etc. to the following email address: [meindershugo@gmail.com](mailto:meindershugo@gmail.com).

Munich, July 2019

*Bill Chandler  
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## 2 Methodology

### 2.1 Introduction

#### 2.1.1 Objective

It is possible, especially for a quick-witted candidate, to pass paper C with an ad hoc approach, skimming through the documents, making brief notes, keeping a mental overview of the documents and what they disclose and then putting all this together to write the notice of opposition. However, the chances of success for the general candidate are severely reduced using this approach for several reasons. Firstly, there is a risk of missing or losing information, leading to missing or incorrect attacks. Apart from the loss of marks for the attack in question, this will probably result in an answer with the wrong structure so that other attacks will be missing or incorrect with the loss of marks allocated for these attacks as well. Secondly, the documents will need to be read several times, possibly once in the initial analysis, a second time to check something that was forgotten, and a third time when writing the notice of opposition. This takes time and is bound to result in errors. Finally, even if the attacks are correct, there is a risk of not providing the solution in the form required by the examiners, e.g. having the correct structure for an inventive step attack when using the problem and solution approach.

The objective of a methodology is to avoid these pitfalls and enable a candidate to treat the information provided in the examination systematically and efficiently. In particular, a methodology ensures that every bit of information is examined properly and as few times as possible. In fact, one maxim of the CEIPI methodology proposed in this book is to **write down the result of the processing of any piece of information as soon as it has been determined**. Although this seems like a small point, it ultimately saves a lot of time because there are many pieces of information to be processed to arrive at the solution. As a rough estimate, assume that there are on average three features in each of six claims to be analysed, making 18 features, which are to be searched for in five documents, making 90 things to be searched for. If a candidate wastes thirty seconds by retrieving or rethinking each of these, that amounts to a loss of 45 minutes. Admittedly, this example is rather artificial, but in our experience, the overall result is not far off for many candidates because some points, such as the interpretation of a particular term in a claim, need more time to consider than others, and if this process has to be repeated, there is a considerable loss of time. This is especially true for candidates not working in their mother tongue language.

#### 2.1.2 Summary

In previous editions of this book, we proposed two methodologies to arrive at the answer for paper C. Over the years of giving courses, we have realised that many candidates place too much emphasis on the method to the detriment of the fundamental skills that are common to any method, such as analysis and determining the correct attacks. Moreover, the two methodologies were set out independently of each other so that they each had many redundant steps. Now, we have changed the presentation to a single methodology with two alternative ways of recording the results of the analysis. This emphasises the common features of analysis and the concept of determining attacks based on the problem and solution approach.

The description of the methodology is split up into the following sections:

- A rough overview of the steps involved in any method and an overview of the methodology specific to this book and the two ways of recording the results of analysing the disclosures, giving an insight into what considerations are important in such a method (see chapter 2.2)

- A detailed description of a step-by-step approach to solving paper C using C 2010 as an example up to the point of performing the analysis (see chapter 2.3)
- A detailed description of how to use analysis sheets to record the results of the analysis and determine the attacks (see chapter 2.4)
- A detailed description of how to use a matrix to record the results of the analysis and determine the attacks (see chapter 2.5)
- Notice of opposition (see chapter 2.6)
- Variants on the methodology (see chapter 2.7)
- Strategy (see chapter 2.8)

## 2.2 Overview of the methodology

The basic steps required in virtually any method were given in chapter 1.5. These can be summarised very roughly as:

- Analyse the letter of the client
- Analyse the patent to oppose
- Determine the attacks on the patent, other than on novelty/inventive step
- Determine the dates that the disclosures were made available to the public and their potential usability
- Analyse the disclosures
- Determine attacks on novelty and inventive step
- Write novelty and full inventive step arguments for *each* claim combination and any other attacks
- Answer client's question(s) in a note to the client

These steps will be explained in detail in the following chapters. However, we would like to draw your attention first to the principal means of keeping track of the essential information throughout the process.

### 2.2.1 *Matrix claims-attacks*

For all organisational information, the method uses a matrix called the matrix claims-attacks. This does not contain any claim features or information about where they are disclosed, but records all other information about the patent to be attacked.

Example matrix claims-attacks (C 2010)

Subject-matter		Effective dates					Attacks					Usability					
							Art.54(2)	54(3)	Art.56	Other	A.123						
Description p-																	
Claim Objects	1	X						A4	A5+A2			X	X	@	X	@	
	2+1	X							A5+A2			X	X	@	X	@	
	3+1	X							A5+A2+A3			X	X	@	X	@	
	4(cer)	X						A6				X	X	@	X	@	
	4(pl)			X					A4+A3			X	X	X	X	@	
	5+4(cer)	X						A6				X	X	@	X	@	
	5+4(pl)			X					A4+A3			X	X	X	X	@	
	6+4(cer)					X			A6+A5			X	X	X	X	X	
Patent A1		P 1	P 2	F	Notes												
		Common states not to be noted any longer, divisional A1 filed after 13.12.07															
Disclosures	A2	X					1: reducing clogging of the dip tube or any inlet of the valve										
	A3	X					2+1: p.p: optimise storage of propellant										
	A4	F	X				3+1: p.p: prevent contamination of the liquid product										
	A5	X					4(pl): maximise spraying distance										
	A6	F			X		5+4(pl): preventing the accidental release of liquid										
							6+4(c): make dispenser usable when tilted.										

© Structure of the matrix claims-attacks by F. Eiden

It shows the following:

- All claim combinations (objects) to be attacked, each in a separate row, next to “Claim Objects”
- A cross in a column for the effective date of each object (in the same column as a marker representing the filing and priority date(s) of the patent A1) under “Effective dates”
- The number of each prior art disclosure and a cross in a column for the date it was made available on the same time scale as the effective date of the objects relative to the markers for filing and priority date(s) of the patent (A1) by “Disclosures”
- An indication of which disclosures are “usable” against each object – deduced from the time line under “Usability”
- The attacks found against each object under the relevant “Attacks” column
- The objective technical problems addressed in the various inventive step attacks under “Notes”

The matrix only shows which disclosures can, in principle, be used against each object. In order to determine the attacks one also needs to know which disclosures disclose the features of the claims. For this, each claim must be analysed against each disclosure. This is a key part of the examination and that which takes too long for too many candidates. It cannot be emphasised enough how much this must be practised before the examination. One only needs to go through the survey the Examination Secretariat for the EQE performs every year among the candidates sitting the EQE; most candidates note that they should have spent more time practising paper C. This is why we have introduced an analysis tutorial in chapter 4.6, which contains a test to give an indication of the speed of a candidate’s analysis.

The next problem is to have a technique of recording the results of this analysis that does not take too long, but has the necessary level of detail so that the disclosures do not need to be read for a second time. We propose one of the following two alternative techniques:

- *Analysis sheets recording technique*
- *Matrix recording technique*

The essential difference between the techniques is that, in the analysis sheets technique, the results are written out on separate sheets of EQE lined paper, using the wording of the claims, whereas, in the matrix technique, the analysis of the features is recorded in cells in a second matrix. The aim of both techniques is to identify which features of the claims are in which prior art disclosures in such a way that the attacks on the objects can be determined. The attacks are determined on the basis of the usability of the disclosures, recorded in the matrix claims-attacks, and the recorded information about where the features are disclosed.

### 2.2.2 *Overview of the analysis sheets recording technique*

In the analysis sheets technique, the analysis of the claims is performed by writing down, on a separate sheet for each disclosure, which of the claimed features are found in the disclosure using the wording of the claims. The relevant references to the disclosure are written in brackets after each feature found, preferably in a standard format. Thus, in this technique, there is no need to perform the artificial and redundant intermediate step of splitting up of the claims into separate features. Points of interpretation that arise as a result of the analysis, for example how a feature in a claim or disclosure is interpreted, or why a feature is implicitly known from a disclosure, can be written immediately into the text within brackets so that the point is determined once and for all, and will not be lost or need to be reconsidered later on. If written on EQE lined paper, this analysis results in text that can be cut and pasted into the notice of opposition if time is running short, which is usually the case. It also means that the step of interpretation is performed only once and is recorded in full immediately at the moment of reflection, minimising the need to re-read and re-analyse disclosures.

Any differences between the subject-matter of a claim and the particular disclosure are noted in a “Difference:” section.

Any points that cannot be decided immediately, or other potentially interesting information, like effects obtained or problems solved by any feature disclosed or under “Difference:”, can be written in a “Remark:” section.



Example of an analysis sheet for A2 in C 2010

A2 (EN)

Field & Purpose:	<p>1: Pressurised gas dispenser [1]                  Prevent accidental release of gas when tilted or used by storing gas in porous material [1]                  Prevent clogging of valve by having material adhering to inside wall of the can [3]                  4: Valve [2]</p>
1.	<p>A2 discloses a dispenser comprising a pressurized container ([2] – can 20 ... enclosing ... under pressure) made of plastics ([4] and cl. 1), a liquefied gas ([2] – liquid phase of gas), a valve coupled with the container ([2] – valve 21, 22), wherein the container wall is coated on its inner surface with a trapping material ([3] – material 25 must adhere to the inside wall) in which liquefied gas is releasably trapped ([3] – material is permeable to gases to allow them to rapidly vaporize and so is releasable).</p> <p>Difference:      liquid product to be dispensed                                           liquefied gas is the propellant                                           dip tube extending into the liquid product</p> <p>Remark:            effect of trapping material adhering to the wall: avoids clogging of the inlet [3]</p>
2+1.	<p>A2 discloses that trapping material comprises latex ([3]).</p> <p>Difference:      -----</p> <p>Remark:            effect of latex: can contain higher quantities of liquefied gas [3]</p>
3+1.	<p>-----</p> <p>Difference:      plastics pocket with liquid product</p>

The attacks are determined by comparing the analysis sheets of the disclosures that the matrix claims-attacks shows are usable against the object (claim combination) in question, and checking the features that each discloses.

Novelty attacks result from usable disclosures for which the analysis sheet shows “Difference: -----”, i.e. no difference.

The closest prior art disclosure for an inventive step attack is usually the one relating to the same technical field and having the same purpose (i.e. an apparatus/product for a similar purpose or a method for the same purpose). This is why the field and purpose are noted on the analysis sheets for each independent claim. The closest prior art is also usually the sheet showing the fewest features under “Difference:” (see chapters 2.4.2.2, 2.5.2.2 and 6.3.2 for a full discussion of how to determine the closest prior art).

Teachings that may be combined with that of the closest prior art are ones where the analysis sheet *does not* show under “Difference:” the feature(s) mentioned under “Difference:” on the closest prior art sheet, meaning that the features are disclosed in that teaching. Concentrating on what is mentioned under “Difference:” simplifies the comparison of the textual information on the analysis sheets.

2.2.3 Overview of the matrix recording technique

In the matrix recording technique, a second matrix contains the relationship between the individual features into which the claims have been split up and the prior art disclosures. A positive (“+”) or negative (“-”) symbol is put in the table for each feature of the claims to indicate whether or not it is disclosed in that prior art. The location of the feature in the disclosure (paragraph number) is also entered. Other signs can be used to denote special situations, such as a “√” sign for a feature that does not need any explanation about its interpretation as it is present in the same wording in the claim, a “≈”

sign if something relevant to the feature is found and a “!” sign for a negative statement about the feature. In a further refinement, a condensed form of specific remarks, for example, relating to the interpretation of a feature, can be entered. This, however, requires much more space, resulting in a matrix of considerable size as well as more “codes” to be remembered.

This analysis is used in combination with the information about the usability of the disclosure in the matrix “claims-attacks” to decide the attacks in a similar way as for the analysis sheets recording technique.

#### Example recording matrix (C 2010)

Claim	Features	A2	A5	A3	A4	A6
Field & Purpose	1: Pressurised dispenser container - Prevent clogging of valve and inlet [5] 4: Valve supplying a pre-determined quantity [9] over a greater distance [12]	Pressurised gas dispenser [1] Prevent clogging [3] Valve [2]	Pressurised liquid spray dispenser Less clogging [4-6] Valve for continuous expulsion [2]	Pressurised pharma spray dispenser [1] Valve with gas perm. housing [7] Max spray distance [8]	Pressurised liquid pharma spray dispenser [1] Metering valve [1]	Ceramic metering valve for liquid spray dispensers [1] Exact metering [3]
1	A dispenser comprising	+{2}	√{1}	+{1}[3]	√{1}	----
	a pressurized container	+{2}	√{1}	+30,[3]	√40,[1]	----
	made of plastics	√{4}	√{1}	!{3}	√{2}	----
	a liquid product to be dispensed	----	√{2}	+35,[4]	√48,[2]	----
	a liquefied gas as a propellant	gas:√{2} prop:----	+{5}	√36,[5]	√46,[2]	----
	a valve	√{2}	√54,[2]	√31,[2]	√41.44 [2]	----
	coupled with the container	√{2}	√{2},fig.	+{2}	√{2}	----
	a dip tube extending into the liquid product	----	+55,fig.	----	+47,[2]	----
the container wall is coated on its inner surface	+{3}	----	----	+45,[5]	----	
with a trapping material in which the propellant is releasably trapped	+{3}	+{5}	----	+{5}	----	
2+1	trapping material comprising latex	√{3}	----	----	----	----
3+1	supple plastics pocket in the container	----	----	√{4}	----	----
	communicating with the valve	----	----	+{4}	----	----
	pocket contains the liquid product	----	----	√{5}	----	----
	pocket isolates it from the propellant	----	----	√{5}	----	----
4 (cer)	A valve comprising	√{2}	√54,[2],fig.	√31,[7]	√{2}	+{2}
	a valve housing provided with	+{2}	+fig.	√34,[7]	+41,[2]	√{2}
	an inlet	√22,[2]	+57,[2]	√fig.	√43a,[3]	+{2}
	an operating member having an outlet	+21,[2]	+fig.	+32,[2]	√44.43b [3],fig	√{3}
	the operating member being movable between a closed position and an open position	+{2}	+	√{2}	√{3}	√{3}
	operating member such that, by actuation thereof, the inlet is closed before the outlet is opened	----	----	----	+{3}	+{3}
	valve housing comprises a gas permeable porous material	----	----	√{8}	√{4}	√{4}
	the pores of which are between 1 µm and 3 µm in size	----	----	+{8} - 2,5	----	+{5} - 0.1-4
porous material being ceramic	----	----	----	----	√{4}	
4(pl)	porous material being is plastic	----	----	√{8}	√{4}	----
5+4 (cer)	pore size is less than 1.8 mm	----	----	+{9} - 0.5-2	----	+{6} - 0.9-2
5+4 (pl)	pore size is less than 1.8 mm	----	----	+{9} - 0.5-2	----	+{6} - 0.9-2
6+4 (cer)	a dip tube connected to the valve housing	----	+{2}	----	+{2}	+{2}
	dip tube is silicone	----	√{3}	----	=[2]:polyethylene	=[2]:HDPE

#### 2.2.4 Choice of recording technique

The advantage of the **analysis sheets** technique is that one is forced to go through the examination in a systematic, step-by-step manner. Further, one can be sure to have done the analysis of the disclosures properly. This is because the disclosures have been analysed using the wording of the claims and in the correct context, and also all necessary interpretation has been included in the written analysis while having the disclosure at hand. Such analysis is not subject to the general comment that appears virtually every year in the examiners’ report along the lines of: “When comparing a claim with a prior art document, it may not be sufficient to simply repeat the wording of the claim and refer to the relevant passage in the prior art document. If a feature in the claim uses a different terminology, it should be explained why it has the same meaning on the basis of the information provided in the annexes”.

Furthermore, the time spent analysing the disclosures results in text that can be used directly in the notice of opposition because it is already in the necessary form and on EQE paper. This drastically reduces the time taken to write the notice of opposition.

Furthermore, distributing the writing of usable parts for the notice of opposition throughout the examination, as well as knowing that one has analysed the disclosures properly, is reassuring to candidates, especially if time-management is a problem.

Critics of this technique often cite the amount of time needed to write out all the analysis sheets as a major drawback. However, the wording of the claims under attack is usually not so extensive, and the majority of text is for the independent claims, which can nearly always be cut out and used in the notice of opposition, provided that the analysis is written legibly and on EQE lined paper. Moreover, a concise and consistent terminology for recording the analysis speeds up the process considerably. In fact, the majority of the time spent is in the mental step of judging whether and why the features are disclosed or not, which applies to any method. Thus, in practice, the “wasted” effort amounts to no more than the time taken to write several sides of generously spaced A4 paper, which is not very much.

The advantage of the **matrix** technique is that the table enables a visual determination of which disclosure destroys novelty and which combination of disclosures might be used for an inventive step attack.

The disadvantage is that it involves activities that take time, but are not actually required for the notice of opposition, namely splitting up the claims into features and producing the table. Splitting up the claim can be difficult to judge. If the split is too coarse, some disclosures may only contain part of a feature. If the split is too fine, there will be much repetition and wasted effort recording combinations of features that always occur together in the disclosures. Also splitting up the features may cause them to lose their context, causing problems of interpretation and making it difficult to judge the correct inventive step attacks.

With this technique, it will be difficult to record claim and disclosure interpretation. After analysing 5 or 6 prior art disclosures, the table becomes an abstract entity, and the “connection” with the actual features in the disclosures can be lost. This makes it difficult to use it later when actually drafting the notice of opposition, frequently resulting in the need to re-consult the disclosures with extra loss of time. To avoid this, additional notes are required that take into account *how* the features are covered by the disclosure in question (e.g. implicit, by reference, by interpretation). If these are to be included in the matrix as well, it will become very large and impossible to construct in the available time.

Not having these additional notes will, however, frequently result in analyses in the notice of opposition that simply allege that the claim features are as such disclosed in the disclosure, whereas they are in fact mentioned using a different terminology, needing further explanation. The fact that many candidates end up doing this is borne out by the regular appearance of the above-mentioned comment in the examiner’s report.

Finally, handing in a feature matrix as part of the answer will not earn any marks, particularly if it is filled in on a pre-prepared template on non-EQE paper, which is not allowed anyway, see chapter 1.3.2.

Good time-management is necessary when using this technique.

It is, however, not sufficient simply to read about a technique and use it for the first time in the actual examination. Any technique requires that candidates have practised it a number of times first.

It is suggested that each candidate attempt both techniques at least once before deciding which one is most suitable. While practising it further, the steps of the chosen technique should in any case be personalised to suit the individual candidate.

In the following sections, the steps for tackling paper C will be illustrated using the subject-matter of the C 2010 paper as an example. Both recording techniques will be illustrated.

The full result of each step is given in Appendix 1, in all three official languages of the EPO.

### 2.3 Detailed methodology

The following description shows the required steps of the method as a series of bullet points with accompanying notes. When you have read and