

Appleyard Lees[®]

Paper C

Paul Beynon – January 2021

Innovation | Branding | Strategy | Solutions





Introduction

- Started in the profession in 2012
- Sat EQEs in 2016
- Moved to Appleyard Lees in 2018
- Email: paul.beynon@appleyardlees.com





Webinar

- New Format
- Strategy
- Practical Tips
- Q&A



New Format

- Same syllabus and character as before, but it is split into two parts
- Part One – 3 Hours
- Break (45 minutes)
- Part Two – 3 Hours



New Format – Part One

- Part One – 3 Hours
 - a letter from a client
 - prior-art documents
 - a description of the patent specification and
 - a number of claims of the patent specification, but not the whole claim set.



New Format – Part Two

- Part Two – 3 Hours
- In the second part, you will be provided with:
 - One or more additional claims of the same patent specification
 - Possibly further content to the client letter
 - Possibly further prior art
 - Supplementary parts of the description of the patent specification.



New Format

First Part

- Attack the claims in the first part based on the information available

Second Part

- Attack the claims in the second part based on all the information available
- Check to see whether there are any new attacks on the claims in the first part based on the additional prior art documents (or combination of prior art documents from first and second parts)



Part One

- What does this mean in practice?
- Bulk of reading – “relatively easy attacks”
- Complete all the attacks that you can do with the information available in the first part. In the second part, it will not be possible to add attacks that you could have already made during the first part.
- Effectively becomes a condensed version of previous papers – traditional method can be used to generate the attacks



Part Two

- What does this mean in practice?
- Bulk of writing
- Generate further attacks using substantially the same methodology.
- The additional claims can be attacked using the prior art from the first and the second parts.



Strategy – Part One – Client Letter

- 1A Read Client Letter and mark the following:
 - P - Priority - "on Filing", "differences"
 - A123 - Added Subject Matter - "After Filing", "During Examination"
 - PA - Demonstrated/Published
 - Q - Client Questions



Strategy – Part One – Client Letter (2)

Annex 1 is the granted version of the European application 07123000.4 filed on 14.12.2007 as a divisional of the then pending parent European application 06000123.4, filed on 29.06.2006. The parent application claims two priorities: LU12345 (LU1), filed on 30.06.2005 and LU54321 (LU2), filed on 04.04.2006.

- P1 – LU1
- P2 – LU2

A file inspection revealed the following differences with regard to the applications in the patent family:

i) the two priority documents are identical except that plastics as a gas-permeable porous material is mentioned for the first time in the second priority document LU2.

- Gas-permeable porous material not entitled to LU1 priority date



Strategy – Part One - Claims

- 1B Read Claims and split them up into claim objects
 - Note that it is common for a dependent claim to be split into two claim objects (e.g. by the use of the term “or”).
 - Add features of claims to the claims matrix
4. A valve comprising a valve housing (110) provided with an inlet (112) and an operating member (113) having an outlet (114), said operating member being movable between a closed position and an open position and wherein the operating member is such that, by actuation thereof, the inlet (112) is closed before the outlet (114) is opened and wherein the valve housing comprises a gas-permeable porous material, the pores of which are between 1 μm and 3 μm in size and said material being ceramic or plastics.



Strategy – Part One – Description

- Read Patent Specification and annotate the margin with the following:
- P/A123(2) - Passages in description for which the client has raised specific priority/A123(2) issues
- PA - Acknowledged prior art or features said to be known
- D - X - Definitions or detail of equivalents. Note in the margin the related claim number(s).
- Pb - X - Problems solved by subject matter of claims.
- E - X - Technical effects or advantages of subject matter of claims. The advantages at the start of the spec tend to be general so later ones are often more useful.



Strategy – Part One – Description

1. A dispenser comprising a pressurized container (10) made of plastics, a liquid product (11) to be dispensed, a liquefied gas as a propellant (12), a valve (15) coupled with the container (10) and a dip tube (14) extending into the liquid product (11), and wherein the container wall is coated on its inner surface (10a) with a trapping material (13) in which propellant (12) is releasably trapped.

[0008] The trapping material is able to absorb and store the pressurized liquefied propellant. It should further adhere to the inside surface of the container wall made of plastics so that clogging of the dip tube or of the valve is reduced as compared to systems where the trapping material is floating inside the container. The trapping material is preferably made of nylon, PVC or latex.

• E1/P1



Strategy – Part One – Effect Table

- Complete first four columns of effect table

Claim	Feature	Problem/Effect	Basis	A2	A3	A4
	1 trapping material absorb + store liquid. Adhere to walls	reduce clogging of dip tube or valve	[08]			
	2 latex	prolong service life - trap higher quantities	[15]			
	3 plastic pocket	additives included in propellant - prevent contaminate	[15]			



Strategy – Part One – Prior Art

- Read each (available) prior art in turn and mark-up the following:
 - C Claim feature
 - D Definitions or detail of equivalents
 - Pb Problems solved
 - E Technical effects or advantages. "Better, Improved, more efficient, reduced"



Strategy – Part One – Claims Matrix

- Enter following info in the Claims Matrix
- x Feature not present
- + Feature present, but needs explanation
 - For each “+”, write a note explaining why it is the same. Even if it just uses different terminology (possibly use details of equivalents). There are EASY marks for this.
- Tick (or Para number) Feature present in same language
- ~ Feature NOT disclosed, but something similar is
- ! Feature Not disclosed - and teaching away



Strategy – Part One - Claim Matrix

Claim	No.	Features	A2	A3
1	1.1	A dispenser	[01]	[01]
	1.2	pressurised container	[02]	[01]
	1.2a	made of plastics	[04]	! - aluminium - [04]
	1.3	liquid product to be dispensed	x	35 - [04]
	1.4	liquified gas as propellant	[02]	[05]
	1.5	valve coupled with container	[02]	31 - [06]
	1.6	dip tube extending into the liquid product	x	x
	1.7	container wall coated on its inner surface with trapping material	[03]	x
	1.8	propellant releasably trapped	[01]	x
2+1	2.2	trapping material comprises latex	[03]	x



Strategy – Part One – Effect Table

- Complete remaining columns of effect table

Claim	Feature	Problem/Effect	Basis	A2	A3	A4	A5	A6
1	trapping material absorb + store liquid. Adhere to walls	reduce clogging of dip tube or valve	[08]	E - [03]			P - [06]	
2	latex	prolong service life - trap higher quantities	[15]	E - [03]				
3	plastic pocket	additives included in propellant - prevent contaminat	[15]				P - [05]	



Strategy – Part One - Attack Matrix

- Enter all (available) claim objects and into the attack matrix
- Enter effective dates in attack matrix based on clients information
- Enter effective dates of prior art to determine their "usability". Be careful whether a disclosure is A54(3) or A54(2)



Strategy – Part One - Attack Matrix

Subject-matter	Effective dates	Attacks					Usability												
		A54(2)	A54(3)	A56	Other	A123													
Description p.																			
Claim Objects																			
Patent A1																			
Disclosures																			



Strategy – Part One - Attack Matrix

- Complete the attack matrix
- First - check for novelty destroying documents
- Second, check which documents if combined disclose all the features of the claim.
- The CPA will often be the document with the most similar features. However, it needs to be for same purpose as the claim.
- For the second document, check the effect table to make sure that it discloses the effect that the missing feature provides



Strategy – Part One - Attack Matrix

Subject-matter		Effective dates				Attacks					Usability					
						A54(2)	A54(3)	A56	Other	A123						
Description p.											A2	A3	A4	A5	A6	
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 (Ceramic)	X					A6					X	X	@	X	@
	4 (Plastic)			X				A4+A3				X	X	X	X	@
	5+4 (Ceramic)	X					A6					X	X	@	X	@
	5+4 (Plastic)			X				A4+A3				X	X	X	X	@
	6+4 (Ceramic)					X		A6+A5				X	X	X	X	X
Patent A1		LU1 30/6/05	LU2 4/4/06	EP Parent 29/6/06	Notes											
Disclosures	A2	X														
	A3	X														
	A4	F	X - pub.													
	A5	X														
	A6	F		X - pub.												



Strategy – Part One – Write Answer

- Take in example of completed Notice of Opposition
- Provide attacks based on the answers in the attack table
- Use your templates
- Provide reasoning for your assertions.



Strategy – Part One – Write Answer

- Added Subject Matter
- Novelty Attacks
 - Provide reasoning for why claim lacks novelty – paragraph numbers/definitions
- Inventive Step Attacks
 - CPA – and why
 - Distinguishing feature
 - Technical Effect and Objective technical problem
 - Is solution obvious? Would skilled person look to other documents and why?
 - Motivation/Modification – don't think too hard!



Strategy – Break



Strategy – Part Two

- Repeat!
 - Read supplementary letter and annotate
 - Read claims and split into claim objects
 - Read supplementary description and annotate
 - Complete first four columns of Effect table
 - Read and annotate additional prior art documents
 - Complete claims matrix
 - Complete Effect table
 - Complete attack matrix
 - Check whether there are any additional attacks on claims of Part One
 - Write answer



Practical Tips

- EQE world
- What are the Examiner's looking for?
- No Art 83 objections!
- Timing



Common points

- Legal issues – Paper D
- Partial problems
- Missed simple marks for not providing support for an answer
- Not clear which prior art documents should be combined in an IS attack
- How many attacks per claim?
- It is not FD4



Materials – What to have available

- Your Strategy
- Any Notes for yourself
- Templates
 - Attack Matrix
 - Claims Matrix
 - Effect Table
- Past Papers and model answers
- Your book of choice – tabbed



Q&A



Manchester

— The Lexicon
Mount Street
Manchester, M2 5NT
United Kingdom

 T: +44 (0)161 835 9655

 F: +44 (0)161 835 9654

Leeds

— 1 East Parade
Leeds, LS1 2AD
United Kingdom

 T: +44 (0)113 246 5353

 F: +44 (0)113 246 5472

Halifax

— 15 Clare Road
Halifax, HX1 2HY
United Kingdom

 T: +44 (0)1422 330 110

 F: +44 (0)1422 330 090

Cambridge

— Godwin House
Castle Park
Cambridge, CB3 0RA
United Kingdom

 T: +44 (0)1223 675 283

 F: +44 (0)1223 675 288

BioHub at Alderley Park

— Mereside
Alderley Park
Alderley Edge, SK10 4TG
United Kingdom

 T: +44 (0)1625 881 089

 F: +44 (0)1625 881 117