

A photograph of two surgeons in an operating room. They are wearing blue scrubs, blue bouffant caps, and light blue surgical masks. The surgeon in the foreground is wearing white gloves and holding a surgical instrument. The background shows a large surgical light fixture and the sterile environment of the operating room.

Using DII to become Fit To Practice

- ❖ Pete Pollard
- ❖ EPO Tutors' Meeting
- ❖ Munich, 18 Oct 2018

Contents based on:

- ❖ personal opinions & analysis
- ❖ > 10 years teaching DII
- ❖ reverse-engineering of candidates' actual exam papers
- ❖ analysis and discussions of many papers with many groups
- ❖ general approach is discussed
 - statements are not absolute
 - each paper is different and may be an exception
 - papers change in style over the years



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DII vs. Real-Life

Fear of DII = fear of unknown



Candidate's comments:

- ❖ *"I prefer DI" or "I hate DII"*
- ❖ *"I have no experience in opposition"*
 - *... or infringement or advising clients"*
- ❖ *"Too many options, too complicated"*
- ❖ *"Client instructions too vague"*
- ❖ *"I don't have all the facts"*
- ❖ *"I only know EP, not US and JP"*
- ❖ *"Is my advice correct?"*
 - *... and best option for client?"*

Real-life role: more *SHOULD* than *COULD*

DI Legal Questions:
what **COULD** we do?

- File everything
- Claim everything
- Pursue in all PCT states
- Validate in all EPC states
- Keep all rights pending
- License all third-party rights
- Oppose all third-party rights
- Ask someone else 😊



DII Legal Opinion:
what **SHOULD** we do
(or **NOT** do)?

- File only this - novel
- Do not file - not novel / inventive
- Withdraw right - protection limited
- Stop **product - it infringes**
- Ignore right - **patent invalid**
- Have freedom - **no infringement**
- Move factory to **NL**

Dangers of perfection



Using DII to become "fit to practice"

Real-life:

- ❖ clients will not pay for unlimited hours
- ❖ perfection can lead to stress and burn-out

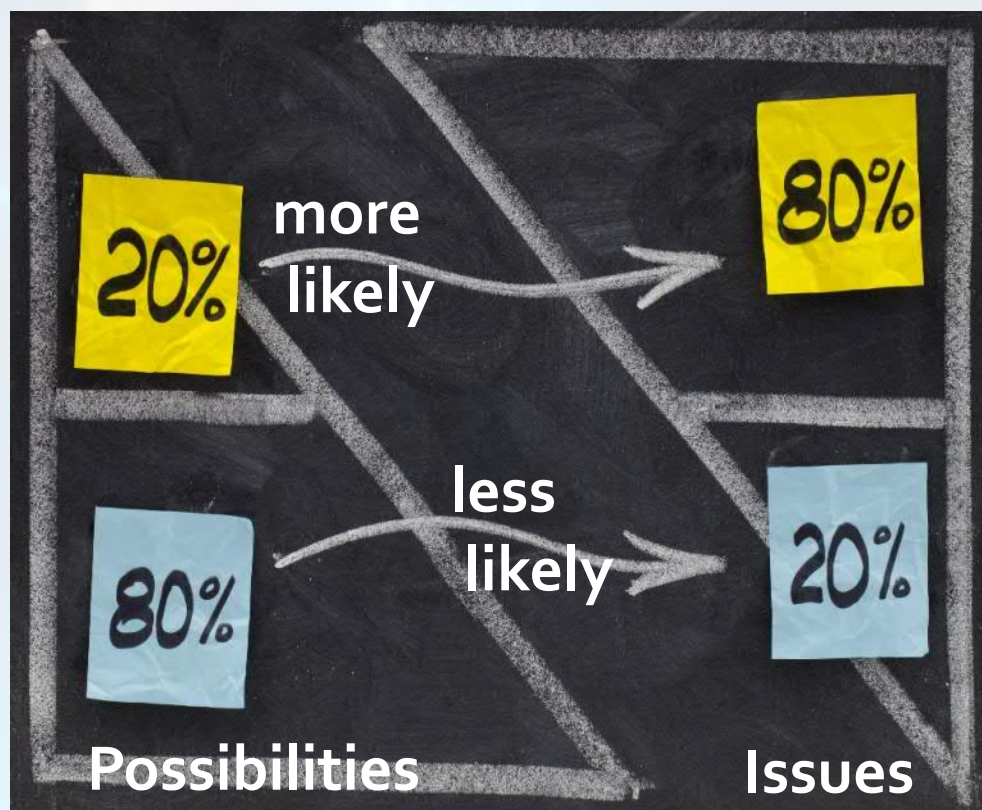
At exam:

- ❖ don't worry about 40 marks you CANNOT GET
 - only 20% of candidates score > 60 marks on D
- ❖ no time to check & look-up everything
- ❖ can't know everything well: if well-prepared, plenty of places for marks
 - optimise marks for knowledge that you have
 - consider skipping details you know (or have in your notes) but CANNOT quickly apply
- don't worry about minor (side) issues

18-Oct-2018

20% of all possibilities apply to 80% of issues

Separate LESS LIKELY from MORE LIKELY



Real-life:

- ❖ clients want to know what is most likely to happen (= general rules)
- ❖ G decisions & Guidelines = general rules
- ❖ All other Case Law = exceptions to general rules

At exam:

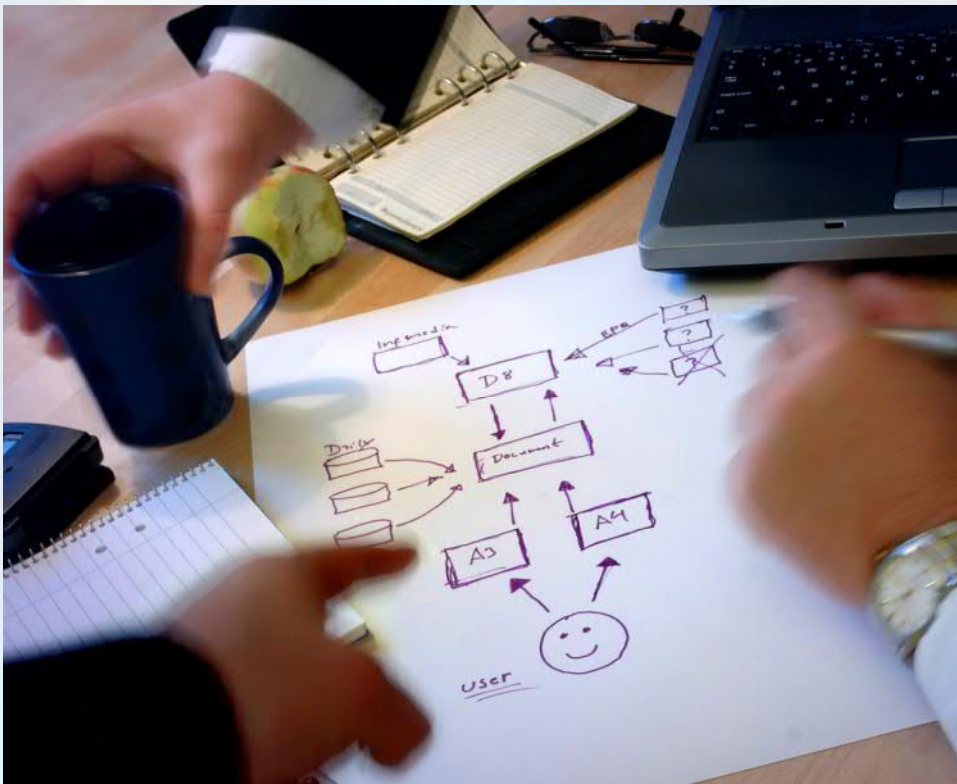
- ❖ Don't be too smart or too creative:
 - follow instructions & hints given in paper
 - what is most likely (80%) option?
 - would 80% of candidates know this?
 - IPREE R.2(3): no special technical knowledge
 - less-likely: usually minor (side) issue

Exam is easier - actually have ALL the Facts.



- ❖ IPREE R22(3): only use facts given (& derived using legal knowledge)
 - no other relevant prior art
 - no other inventions
 - no other activities in other states
 - no other competitors
- ❖ So predict & state clearly:
 - ... *will / will not be granted*
 - ... *is / will be granted validly / invalidly*
 - ... *infringes / does not infringe*
 - ... *novel / not novel*

“Talking” to Clients like Real-Life => DII Marks



- ❖ Clients are technical expert, and do not understand patents:
 - “They have world patent - we can't make it”
 - “There is patent on X, but we make X+A”
 - “Our patent for X+A+B means we are free to make X+A+B”
 - “Our product looks different to patent drawings - how can we infringe?”
 - “Does EP patent give protection in the US?”
- ❖ You must explain and predict effect on their business:
 - “EP1-claim 1 will not be granted - so no protection in Europe for X”
 - “They will get X+B patent granted in NL, and you will have to stop production”

Why are DII scores so low?

- ❖ Candidates have little contact with strategic work
 - mainly translating, drafting & answering Office Actions
 - Don't know what is expected in legal opinion
 - Used to giving options, not use to giving advice
- ❖ Foreign patent attorneys pick up DII very quickly
 - can score quite high
- ❖ No experience talking to real clients
 - can't link patent world to business
- ❖ Poor understanding of what is required for DII at exam
 - only start studying DII in January (spend most time on legal knowledge), so don't practice
- ❖ Don't write enough explanation
 - think that giving golden solution is enough
- ❖ Don't predict what will happen
 - actually justification for advice
- ❖ Don't write down the obvious
 - *After grant and validation, claim 1 will give protection in DK*

Teaching DII

**IPREE R26(3): AN ENQUIRY FROM A CLIENT REQUIRING
AN ANSWER IN THE FORM OF A LEGAL OPINION**


One paper actually had 2 cross-licences !

≥1 mark on 9 out of 10 papers if FIT TO PRACTICE

Conclusions

o I advise a
CROSS-LICENCE

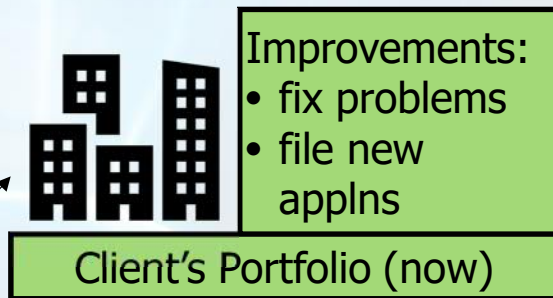
o There is DEPENDENT
patent situation:

- ❖ Most complex DII end point
 - If you can deal with this, you can deal with any DII
 - Cross-licence not so frequent in real-life – one-way licensing more common
 - Dependent patents are common in real-life (and most misunderstood by clients)
- ❖ DEPENDENT patents in DII often lead to dangerous advice from poor candidates:
 - If you write: “***Your claim for X+A+B will be granted, so you are free to produce X+A+B.***” you are NOT fit to practice 
 - In real-life, you could cost client their business with this “advice”
 - Many clients think this anyway, but you are the expert in the room

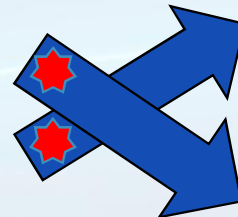
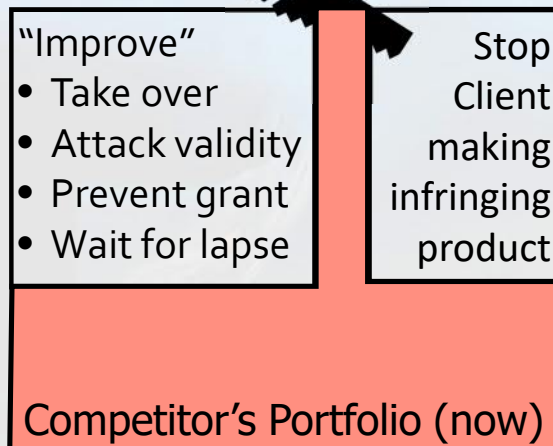
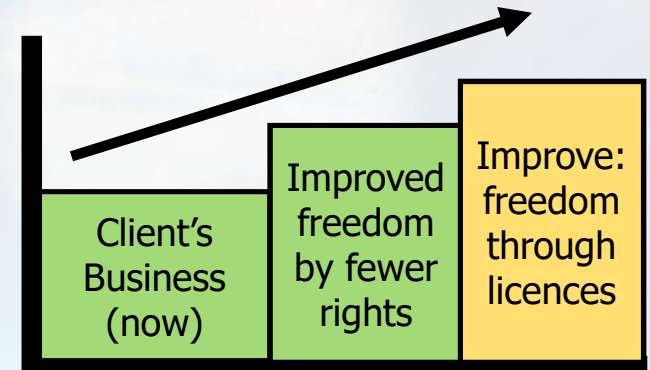
Most marks: for improvements with biggest impact on business (bargaining chips) ★ 🪙

(Cross-)license based on optimal BUSINESS position

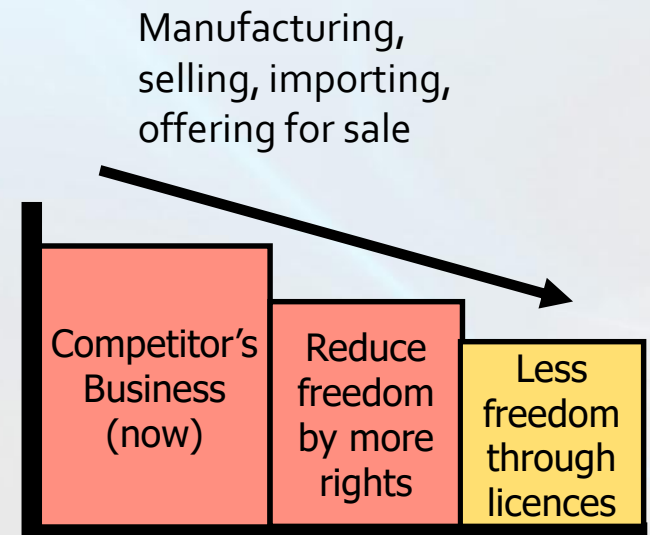
- Problems:
- Procedural
 - Substantive:
 - Novelty,
 - Inventive Step
 - Others: such as Enablement




- Validly granted
- Broad claims
- Still in force in right territory



Not just TODAY, but predict what will happen in future

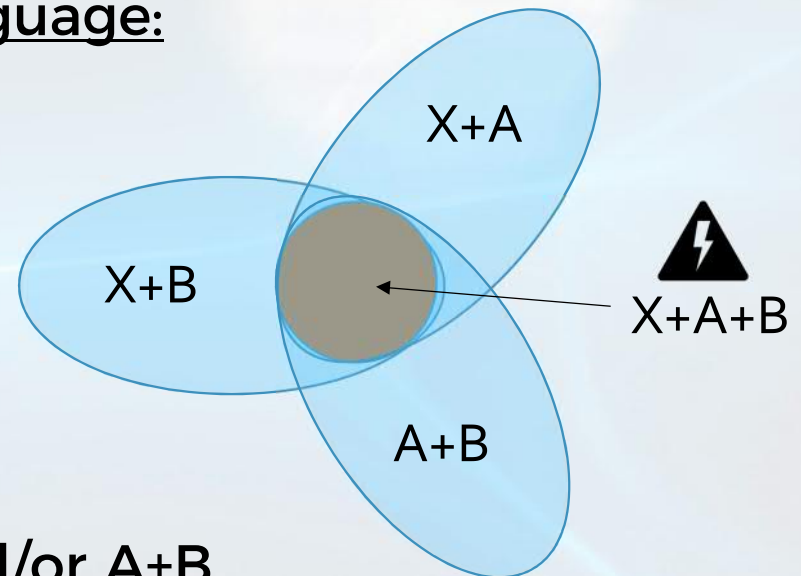


Often in DII: $X+A+B$ is most advantageous species. So holder of genus wants to cross-licence. 

Dependent patent: misunderstood in real-life



❖ Explain consequences in client's language:

- Claim $A+B$ can stop: $A+B$, $X+A+B$
but cannot stop: $X+A$, $X+B$
- Claim $X+A$ can stop: $X+A$, $X+A+B$
but cannot stop: $A+B$, $X+B$
- Claim $X+B$ can stop: $X+B$, $X+A+B$
but cannot stop: $A+B$, $X+A$
- Claim $X+A+B$ can only stop: $X+A+B$
and cannot stop: $X+A$, $X+B$, $A+B$

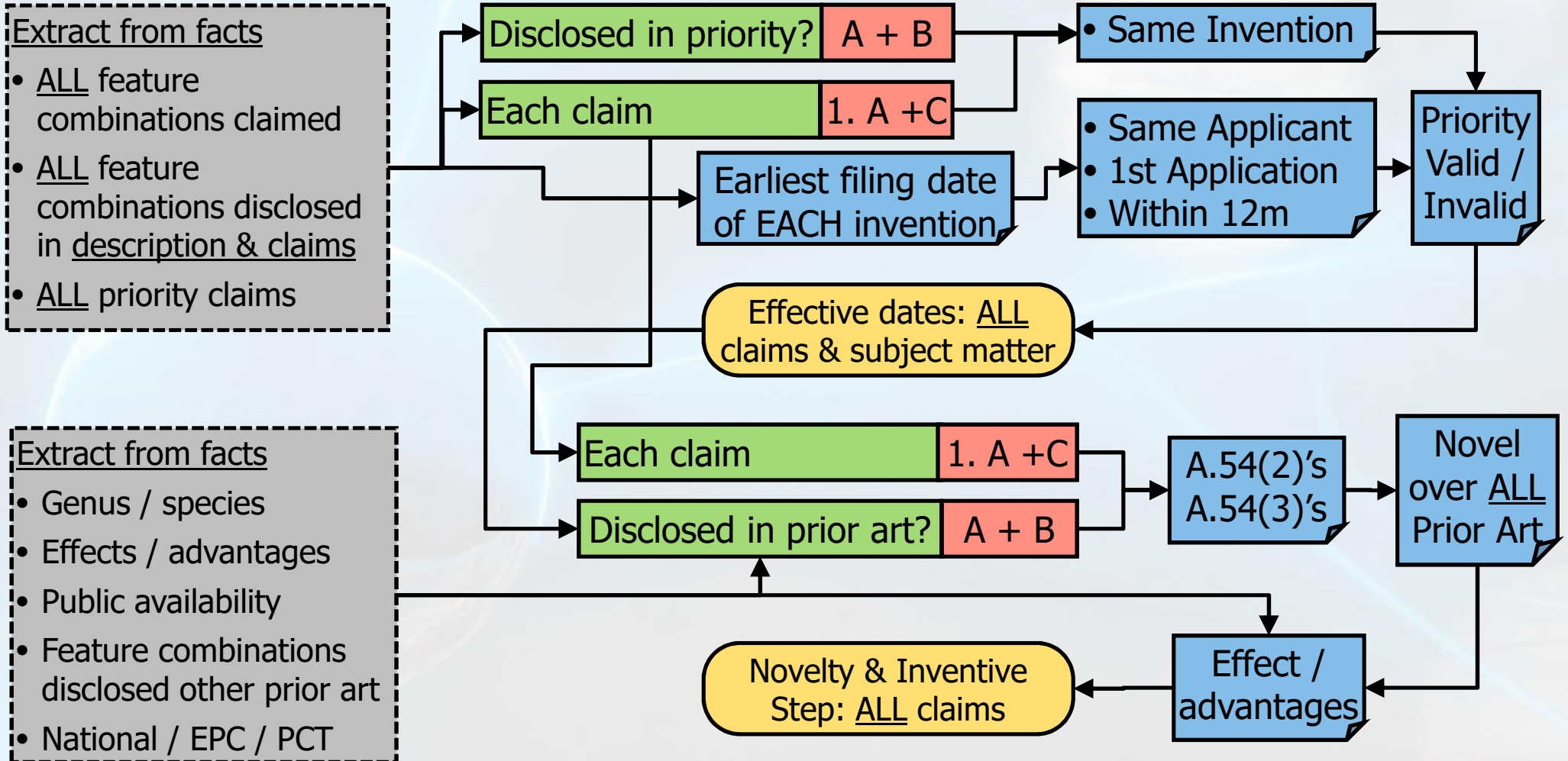


❖ Cross-licence: $X+A+B \Leftrightarrow X+A$, $X+B$, and/or $A+B$

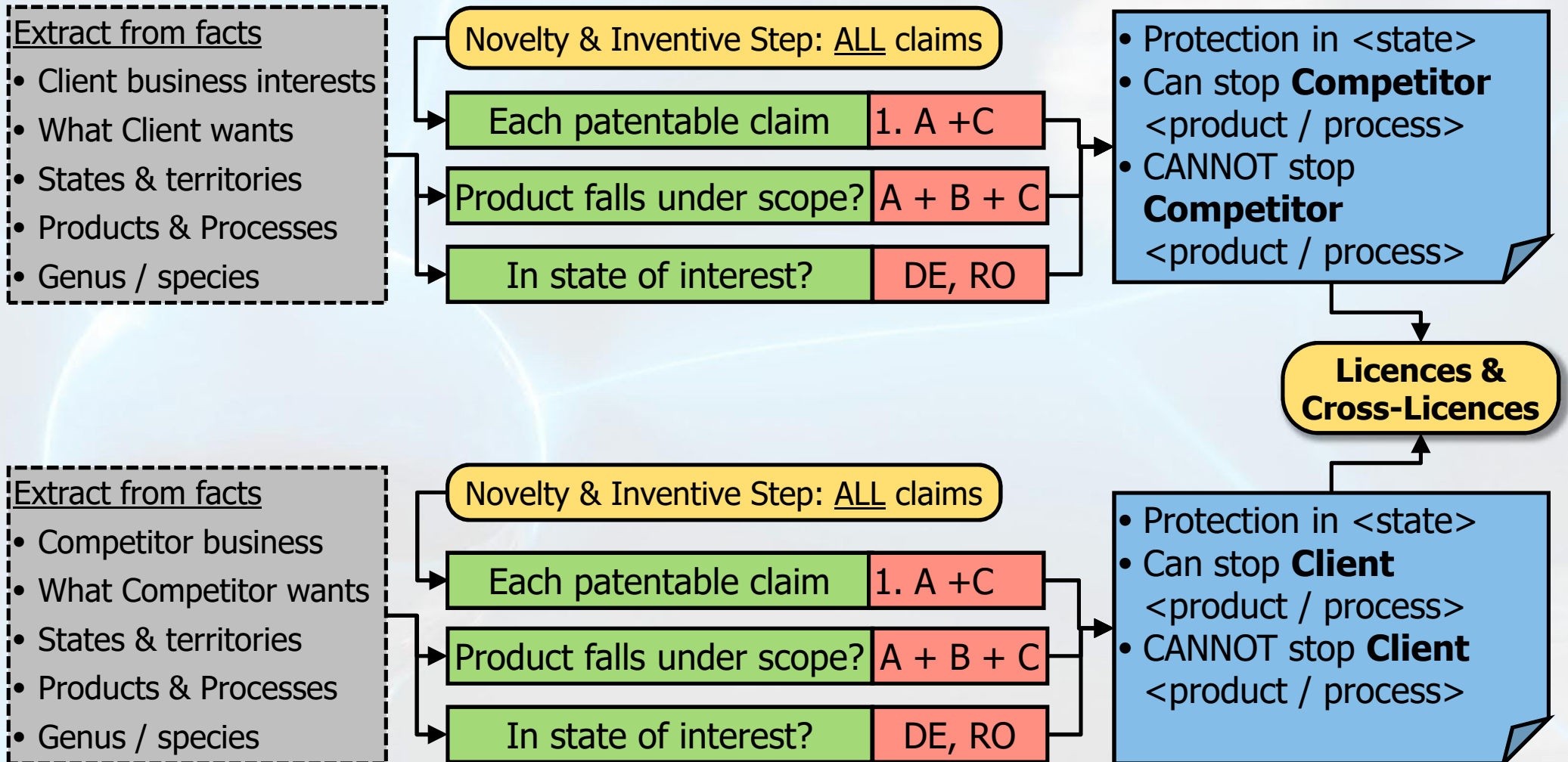
❖ If you write: “***Your claim for $X+A+B$ will be granted, so you are free to produce $X+A+B$.***” you are NOT Fit to Practice. 

  Main reasoning & argumentation = marks

Basic DII skills - patentability




Basic DII skills - exploitation

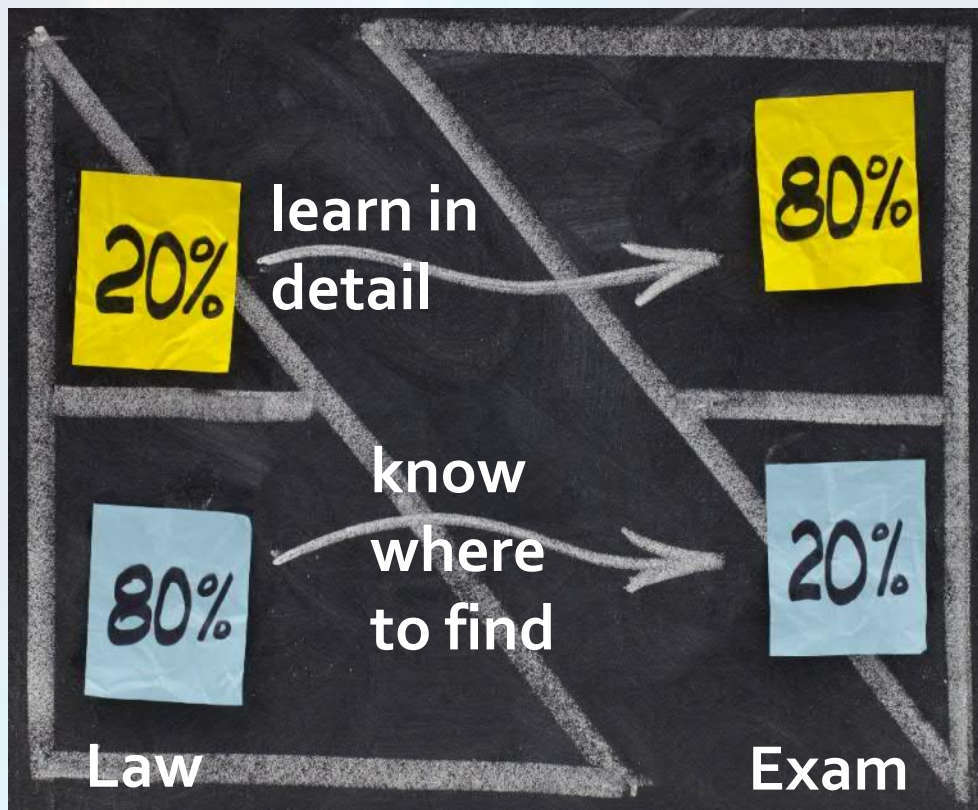


“Learn by doing”: at least 5x DII papers



- ❖ Start with a good DI level legal knowledge
- ❖ Safely explore beyond current knowledge & competence
 - better than with real cases & real clients
- ❖ Discuss with mentor, tutor, other candidates
- ❖ Think about options:
 - consider advantages / disadvantages
 - think about consequences and further problems
 - be extra alert for improvements that greatly affect client's business 
 - write out immediately
- ❖ “Collect” useful DII phrases
 - no full sentences – short statements better

20% of all EPC/PCT law => 80% of D exam




Be very competent and very quick in basics (20%) and look up rest

20% of Law found in:

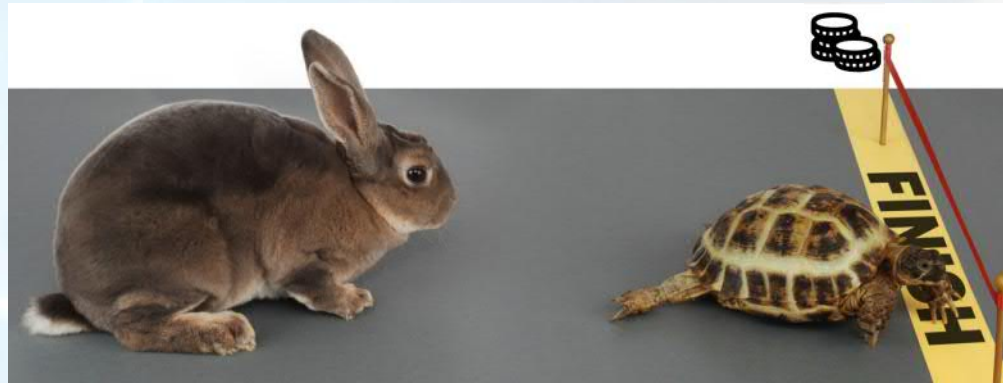
- ❖ Past D exam papers
- ❖ EPO Academy 60x Daily D Questions
- ❖ DeltaPatent's 150x Selected Main Exam (DI) Questions
- ❖ Most of EPO Guidelines including established case law (general rules)
- ❖ Still relevant G decisions (general rules)
- ❖ PCT Applicants Guide - Introduction to International Phase
- ❖ EPO Euro-PCT Guide
- ❖ Basic US & JP procedures

Start with Basic Methodology & Customize



- ❖ Compare answers to Examiners Report
 - Possible Solution = 1 mark per sentence
 - miss a major or frequent DII issues?
 - preventable mistakes you often make?
- ❖ Adapt methodology & tools to prevent mistakes worth marks, such as:
 - Invalid priority due to first application
 - missed calculation of publication date
 - missed refiling / divisional as option
 - did not discuss exploitation in detail
 - missed improvement with major business impact (major bargaining chip) 
- ❖ Use accurate & brief legal language
 - Application “deemed withdrawn”, not “dead”

Methodology fits personality, but same goal



Same finish line

For example:

- 35-40 marks
- in 3½ hours

❖ Fast & impatient:

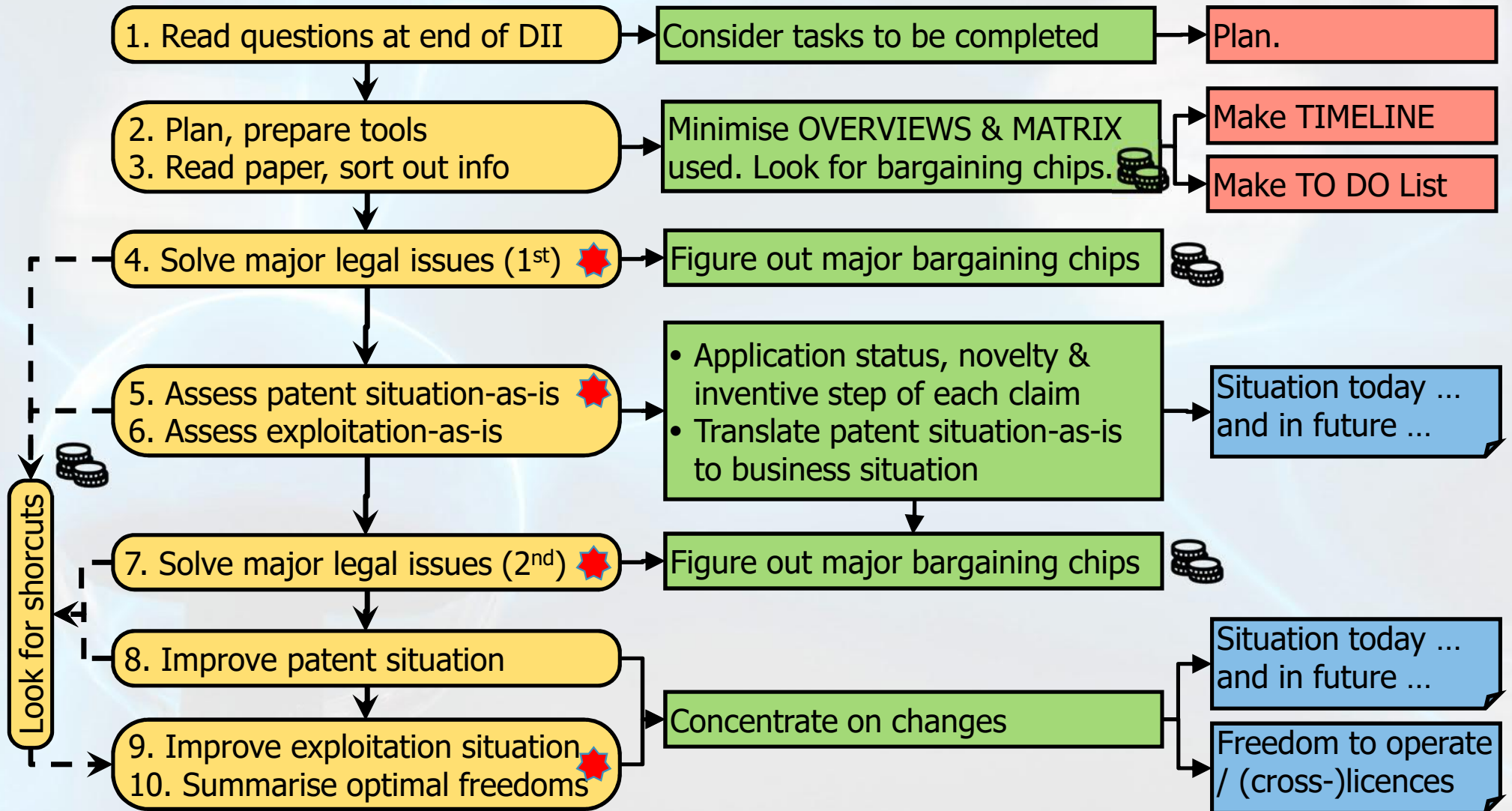
- likely to finish
- more chance of major mistake
- like matrix (possibly combined with Timeline)
- read paper several times, scan
- write too little about assumptions
- often native speakers

❖ Slow & steady:

- may not finish
- less chance of mistake
- like application overviews & prior art overviews
- read paper once, read thoroughly
- write too much about side issues
- often non-native speakers

★ most marks


Basic Methodology (overview)



Based on my reverse engineering of actual candidate papers

A lot of points for optimal situation (FINISH LINE) – try to get there

Where marks are typically available

Part of answer	Details	Typical marks
<u>5. Patent situation-as-is</u> <ul style="list-style-type: none">Client rightsCompetitor rights	<ul style="list-style-type: none">Legal statusValidity of priority of each claimNovelty & inventive step of each claim <p>=> what will be granted? => validly or invalidly granted?</p>	12 - 15
<u>6. Exploitation situation-as-is</u> <ul style="list-style-type: none">Client & competitor businesses	<ul style="list-style-type: none">What each business can do and not due based on patent situation-as-is	5 - 8
<u>7. (and 4.) Legal issues</u>	<ul style="list-style-type: none">Analysis and remedies	15 - 20
<u>8. Improved patent situation</u> <ul style="list-style-type: none">Client rightsCompetitor rights	<ul style="list-style-type: none">Solving problems found.Concentrate on <u>changes</u> to what will be validly or invalidly granted	2 - 5
<u>9. Improved exploitation situation</u> <ul style="list-style-type: none">Client & competitor businesses 	<ul style="list-style-type: none">What each business can do & not due based on improved patent situationSummarise overall picture	11 - 15





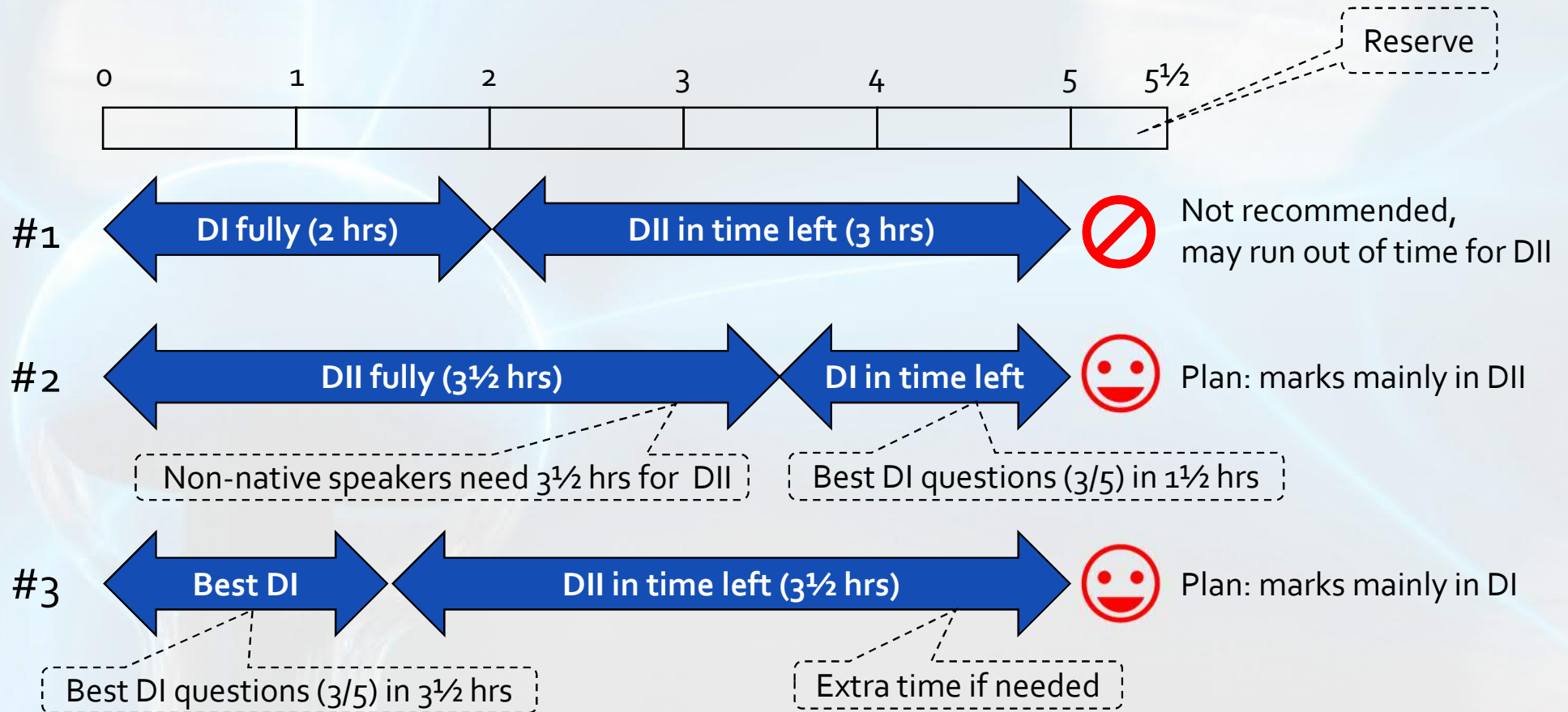
Doing DII at exam

Plan: marks mainly in DI, DII or equal?



Best DI questions: can be answered completely & quickly. Typically 3 out of 5 questions.

Choose best order for you & practice at least once

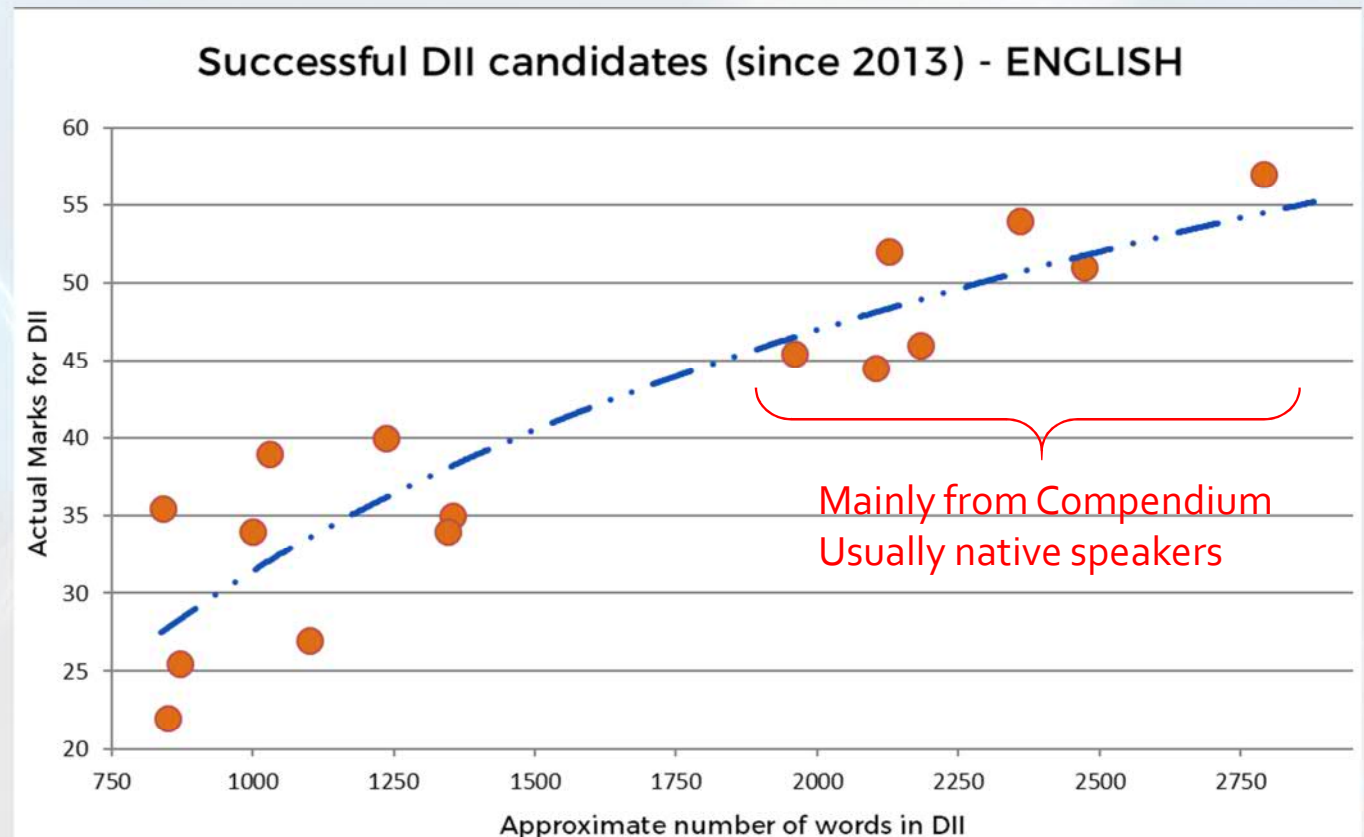


Explain your answer: reasoning and argumentation

French: at least 1100 words, German: at least 1000 words

Hand-in ≥ 1200 words (10-15 pages)

- ❖ Explain your answer (particularly for DII)
- ❖ No “negative” marks
 - Start with 0
 - Get marks for everything that is correct
 - wherever in answer (but must be in correct context)
- ❖ 1200 words = not including any summaries of facts
 - use short statements, not full sentences



Take it personally - fight for your client

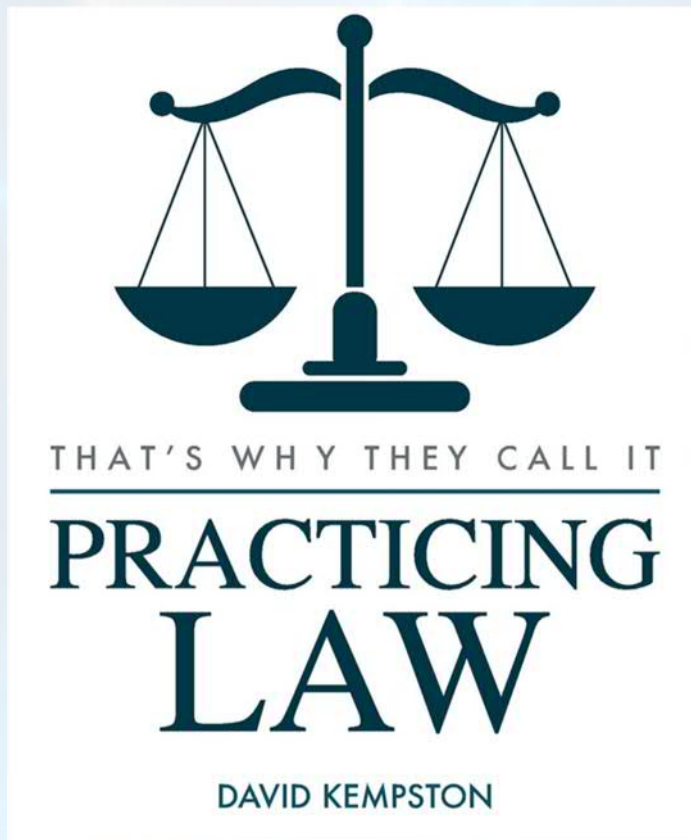


- ❖ Imagine it is REAL: become involved
- ❖ Client has come to you with a real problem:
 - you represent them
 - they are being sued by a competitor
 - you need to improve client's position
- ❖ You take initiative
 - *we should do this / we will do this*
 - *I will do this / I will check*but accept when issue is really lost
- ❖ Explain how you will save their business
 - justify your invoice for 1 month's salary 😊



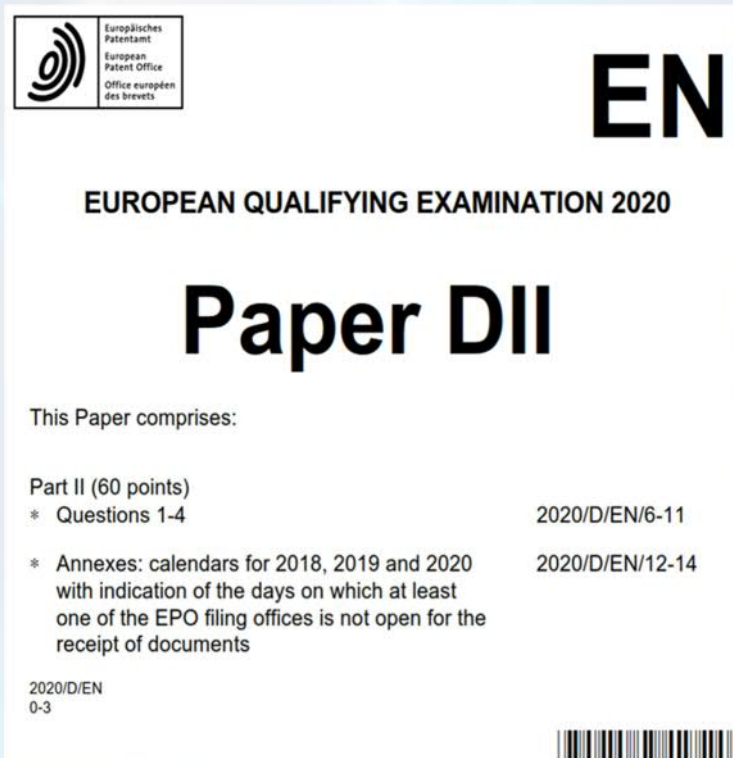
Conclusion

So, preparing for DII



- ❖ Start with BASIC DII methodology and customize
- ❖ Talk to real clients with little patent knowledge
 - good training explaining how patent system works
- ❖ Adapt + build Methodology using 5x DII papers
 - discuss with others
 - analyse answer for important issues missed and easy marks missed
 - collect accurate & brief phrases from EQE Compendium
 - become practiced in accurately determining priority and novelty
 - pay special attention to DEPENDENT patents ⚡
 - put extra effort into learning exploitation language & explanation. Learn to spot bargaining chips. 🪙
 - If methodology not working for you, look for alternatives

Suggested exam changes to increase DII scores



- ❖ Ask explicitly for details required:
 - *“What is the procedural status of our applications?”*
 - *“Are the claims novel and inventive?”*
 - *“Will they be granted?”*
 - *“Which products can we continue to produce?”*
- ❖ Indicate marks (at least for legal questions), so time to spend and level of details are more predictable:
 - *What is our current position in the appeal & how should we proceed? [10 marks] or [approx. 10 marks]*
- ❖ If publication is critical, give it explicitly or give a hint:
 - *“From the publication of EP1, we realized”*
- ❖ Simple subject matter – A, B, and C papers deal extensively with technical interpretation
 - For example, just letters: $X+Y$, $X+Y+Z$

Any Questions?

D papers and Examiners' Reports:

- ❖ www.epo.org/learning-events/eqe/compendium/D.html

- Select tools that you like & are most efficient for you
- There are NO MARKS for making the perfect overview
- All Analysis must be written on EQE paper to HAND-IN
 - For example: 18m publications, priority valid, subject matter disclosed, public availability
- Customize: if you cannot get to end (35-40 marks in 3½ hours), try something else

Extra Slides – Possible Tools

Tool - TO DO & CLIENT WISHES (A4)

Checklist

- Balance getting sidetracked with forgetting something
- Refer to paragraphs
- Check-off when done
- Include CLIENT WISHES

- CAN HAND-IN, but no marks for just organizing facts
- If made on EQE paper, can add some analysis and HAND-IN

✓	• EP-BB2 not paid, Deem withdrawn.
✓	• PCT-BB2 no description of shape of nozzle. but drawing: trumpet-shaped
✓	• PCT-BB2 added s/m: screw conveyor
✓	• EP-BB3 not paid yet
✓	• PCT-PK1 still sell to competitor, if we not
	• produce and method for preparing PFP (fruits A+C+D within 160 → was public in Dec 2017, @ will destroy novelty of any applica

Do not use this with a TIMELINE

Do not use with APPLICATION & NON-PATENT OVERVIEWS

Tool - TIMELINE TABLE (A3)



Date	Competitor Applns	Publications, Other Events	Client Applns	Priority Claim(s)	Subject-Matter Disclosed	Claims	NOT disclosed, Misc	Paragraphs

Time and subject-matter overview

- Don't try and complete fully - only fill in what you need
 - refer to paragraphs so that you can go back and re-read
- CANNOT HAND-IN
 - Limit to just facts.
 - Write all analysis on EQE paper to HAND-IN

Do not use this with a TIMELINE TABLE

Tool - TIMELINE (A3 or A4)

Time overview

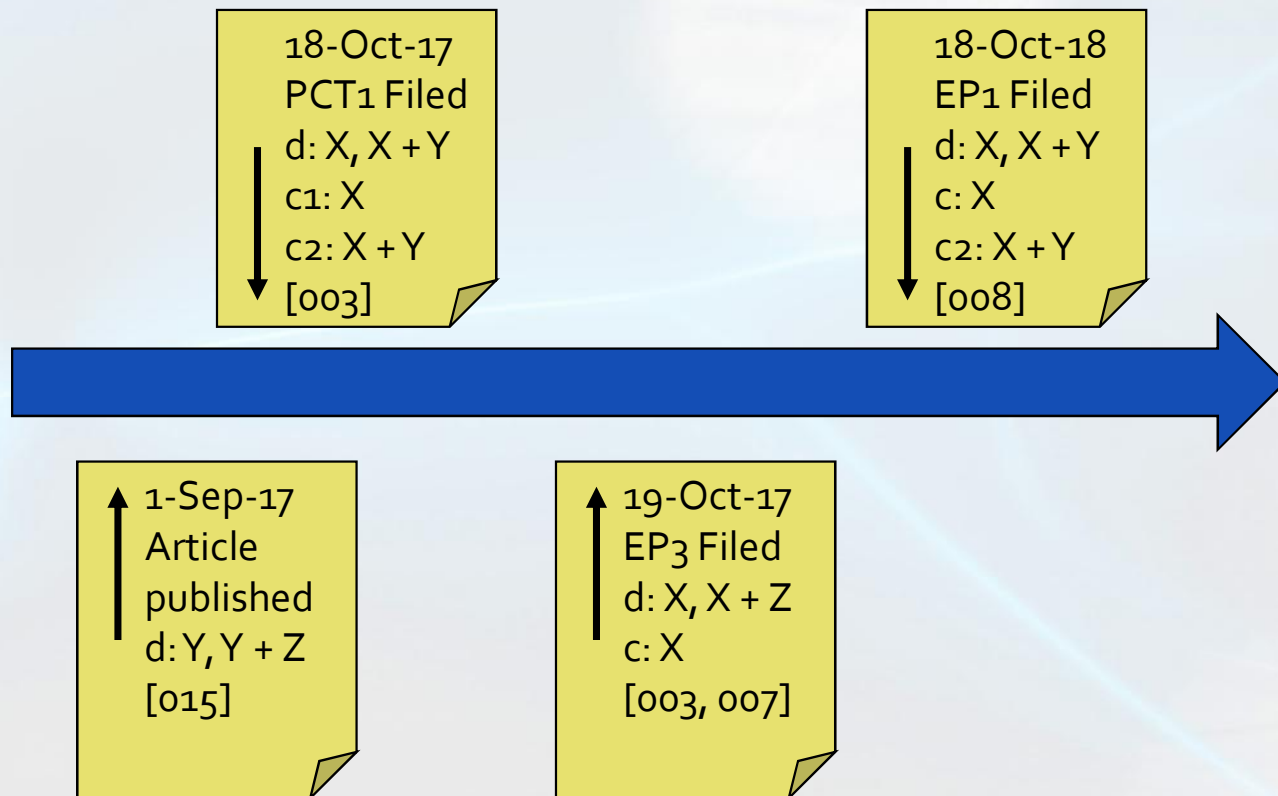
- Dates
- Some context about event
 - refer to paragraphs
- CAN HAND-IN, but no marks for just organizing facts
- Write all analysis on EQE paper to HAND-IN

Competitor / Publications	Client
Fh	BB food industry - oilballs - Dutch - manufact - Denmark process - process equip
	TODAY 27 Feb 2018 error in PCT BB2
	15 Feb 2018 Grounds of appeal BB
	26 Jan 2018 (GP-BB2) fdec + claim apartus; DM + PT not no tric in SC
	Jan 2018 grounds on appeal by opponent not legitimate
	4 Dec '17 (PCT-BB2) paid filing fee search fee transm. fee same case as PBB2 claim priority of - out descrip. from pet - add - add
. A + C + D - any + 160-210C (leads to 1 here fairly pls)	Dec 'A 16 Oct. 2017 received written dec. ↑

Tool – POST-IT TIMELINE (A3)

Time & subject-matter overview

- Never run out of room
- Only fill in what you need
 - refer to paragraphs
- CANNOT HAND-IN
 - Write all analysis on EQE paper to HAND-IN



Use with a simple TIMELINE - do not use this with a TIMELINE TABLE or MATRIX

Tool - APPLICATION OVERVIEWS (A4)

Rights overview

- Collect relevant information about rights as read paper
- Refer to paragraphs
- CAN HAND-IN, but no marks for just organizing facts
- If made on EQE paper, can add some analysis and HAND-IN

① ST-EP3 Filed: 13 June 2016
Applicant: SteelCo
Priority Claim ST-EP2 valid under Art 87
Same applicant v.a. transfer Mr B → SteelCo
Status: Pending
Discloses and claims process for metal beam having projections formed by shape-B1 teeth
<u>Question 1</u>
Patent situation as it currently stands for
a. Projections of any shape
(1) Old prior art from the 1980s

Answer DII Questions separately

Tool – NON-PATENT OVERVIEWS (A4)

Disclosure overview

- Collect relevant information about potential A.54(2)'s as read paper
- Refer to paragraphs
- CAN HAND-IN, but no marks for just organizing facts
- If made on EQE paper, can add some analysis and HAND-IN

Non - Patent Disclosures

Interview

• interview published in the newspaper
Dec/2017 i.e. a public disclosure

• good taste

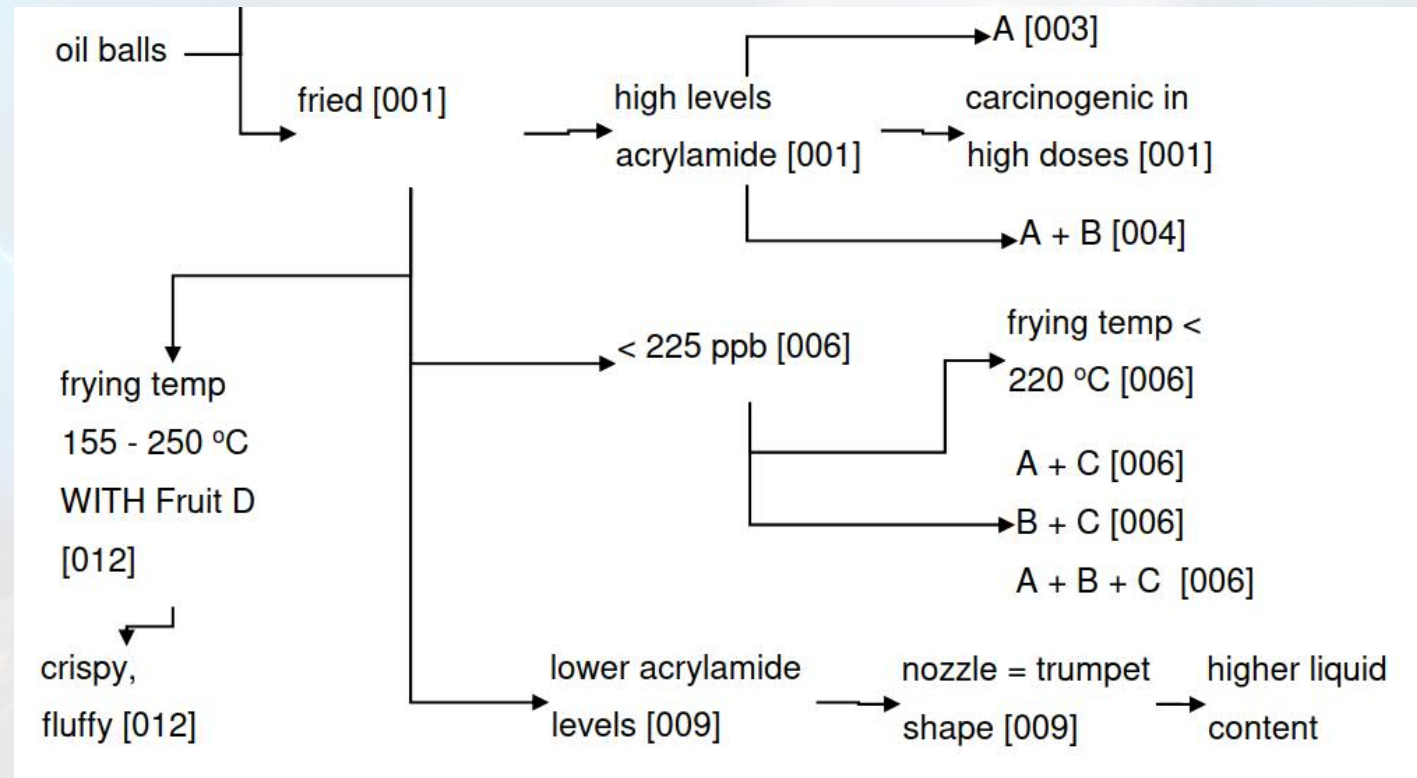
• use of fruits A, C and D

• temp range 160-210 °C

Tool – INVENTION CHART (A4)

Subject-matter overview



- Can help on sort out technical subject-matter
- Refer to paragraphs
- CAN HAND-IN, but no marks for just organizing facts
- Write all analysis on EQE paper to HAND-IN





Extra Slides – Methodology Details




Basic Methodology – Details [1]

Step	Details	Tools
Continuous: look for shortcuts 	<ul style="list-style-type: none"> If you see something worth marks, write it down as part of your HAND-IN answer Major issues: most-likely possibilities AND/OR those that clearly affect client's business 	<ul style="list-style-type: none"> Less preferred: add to TO DO
1. Read DII questions at end of paper FIRST	<ul style="list-style-type: none"> Questions = areas to be discussed for marks May indicate important inventions <u>Recommended</u> organisation of answer? Countries or parties mentioned? 	<ul style="list-style-type: none"> Add to TO DO & CLIENT WISHES Decide & PLAN order of analysis
2. Prepare any tools to be used	<ul style="list-style-type: none"> TIMELINE & DISCLOSURE OVERVIEWS or TIMELINE TABLE (MATRIX) 	<ul style="list-style-type: none"> Use A3 paper, or use A4 EQE paper
3. Read paper and sort out information	<ul style="list-style-type: none"> Dates relevant for patentability. Relevant details of disclosures, public availability, claims. Add PUBLICATION dates of applns pending at 18m Features/advantages (inventive step) What does client want? What is their business?  Look for bargaining chips 	<ul style="list-style-type: none"> Make TIMELINE Add to TO DO & CLIENT WISHES Add to MATRIX or OVERVIEWS

Basic Methodology – Details [2]

Step	Details	Tools
4. Analyse & solve Legal Issues from TO DO	<ul style="list-style-type: none"> • Which major legal issues are probably involved? • Look quickly – EPC, Case Law, GL's, AG-IP etc. • Where possible, clear up any major issue (valid or invalid, abandoned or can be remedied) • If not possible quickly, leave on TO DO LIST 	<ul style="list-style-type: none"> • Mark as "solved" on TO DO
5. Assess patent situation-as-is	<ul style="list-style-type: none"> • Procedural (legal) status • Priority valid/invalid & Effective Dates of all claims • Note earliest filing date for each invention • Novelty of all claims / Inventive Step of all novel claims • Issues => things that <u>could</u> be improved 	<ul style="list-style-type: none"> • Use TIMELINE & OVERVIEWS or MATRIX • Add to TO DO
6. Assess exploitation situation-as-is	<ul style="list-style-type: none"> • Protection by each PATENTABLE claim that IS (or WILL BE) granted • Summarise PER APPLICATION or PER INVENTION • What will happen to business situation if not involved? • Where is/will be client able to exploit? Competitor? • Which issues are major bargaining chips? • Be brief for situations already know you will improve 	<ul style="list-style-type: none"> • Add to TO DO & CLIENT WISHES

Basic Methodology – Details [3]

Step	Details	Tools
7. Analyse & solve Legal Issues from TO DO	<ul style="list-style-type: none"> Look through TO DO list => which issues are major bargaining chips?  What does client want / need? Solve these major issues => improve 	<ul style="list-style-type: none"> Read CLIENT WISHES Mark as "solved" on TO DO
8. Improve patent situation	<ul style="list-style-type: none"> Changes in patentability of claims 	<ul style="list-style-type: none"> Read CLIENT WISHES
9. Improved exploitation situation	<ul style="list-style-type: none"> Changes in business situation due to improved patent situation Should result in improved bargaining chips  	<ul style="list-style-type: none"> Read CLIENT WISHES
10. Summarise optimal freedoms 	<ul style="list-style-type: none"> (Cross)-licence? <ul style="list-style-type: none"> What is needed? What is preferred? Freedom to Operate? <ul style="list-style-type: none"> Which activities are possible after all improvement? Which are still not possible? Re-read DII explicit questions <ul style="list-style-type: none"> Everything been covered? 	<ul style="list-style-type: none"> Check that all issues solved on TO DO & CLIENT WISHES