



Mock Certification Exam for
Patent Information Professionals 2011

PATENT INFORMATION ANALYSIS MOCK CERTIFICATION EXAMINATION

Paper A

Engineering sample answer for validity/opposition

Please note: it is to be understood that the sample answers provided in this document are intended to serve as a guide and by no means represent definitive answers. It is entirely possible that additional answers not specifically disclosed in this document could be considered as satisfactory answers.



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Sample Answers for Paper A Engineering Validity / Opposition

Question1

Please try to find prior art in patent databases to possibly invalidate claim 1 of EP 784139 B1.

Sample Answer

When constructing the exam questions we wanted to receive both a working strategy to a solution and most of all your reasons for doing things a certain way in order to better assess your knowledge of search types, databases, search tools and strategic planning. We did not always succeed in getting sufficient comments in the answers (e.g. the reasons for choice of database), most probably owing to participants not having had a model of what was expected.

The following gives an overview of a possible course of action. Most of the examples are taken from the actual exams (in Times New Roman, black), with our annotations in Nimbus Sans L, blue. It tries to exemplify a promising strategy i.e. examples of how the team thought the searches could have been constructed and commented.

General Preparation

Review the full specification and claims of EP 784139 B1: How did you get a copy of the document? E.g. Patent Office Website: EspaceNet, Depatisnet or database provider (e.g. PatBase, Orbit.com) – make sure to pick B1 document.

Even documenting "small" things, e.g. making sure the granted claims are considered (and perhaps comparing them to the published ones to fix relevant dates) – this is easy to overlook in e.g. EspaceNet. If you compare the published claims to granted ones in this case you will see a rather big difference between the two which might put you on the wrong track if cross referencing the claims from the A document instead of the B document. You might e.g. mention PatBase's "compare" feature for accomplishing this (although not yet available at the time of the exam).



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2. Key features of the claim

Before setting out on planning the search, all the independent claims should be analysed e.g. from one of the examinee's answers (other forms (tabular) are of course also possible):

A **vehicular communication system** comprising:

an **ignition key** (1) having an information device (2,8) for receiving and storing data; an **ignition key cylinder** (15);

a **transmission device** (10) for transmitting data to the ignition key information device (2,8) during a predetermined time interval while the ignition key (1) is in the ignition key cylinder (15); and

a **key removal prevention mechanism** for preventing the ignition key (1) from being removed from the ignition key cylinder (15) during at least a portion of the predetermined time interval, characterized in that

the key removal prevention mechanism prevents the ignition key (1) from being removed from the ignition key cylinder (15) in response to a **key interlock actuating signal** outputted by the transmission device (10); and

the transmission device (10) outputs the key interlock actuating signal until the communication between the transmission device (10) and the information device (2,8) ends.

Also these questions should be considered (from one examinee's paper):

What problem does the invention solve? Incomplete data communication in vehicular communication systems.

What is the invention? An ignition key, an ignition key cylinder and a transmission device in which a key removal prevention mechanism and key interlock actuating signal prevent the key to be removed before data have been received and stored.

What does it do? Secure that the communication between the transmission device and receiving information device is complete.

Here would also be a good place to discuss your understanding of the needs of invalidating prior art: e.g. novelty destroying vs inventive step, how to check for possible differences in priority date for single claims due to changes to the specifications in the EPO's online file inspection.

Novelty

For a European patent a novelty destroying document must either be:

- A publication available before the entitled priority date anywhere in the world; or
- A publication that is filed as a European patent application* and have an earlier (entitled) priority date but published after the (entitled) priority date.

(*when considering applications filed before 13 December 2007, this novelty destroying effect only takes place in those European Contracting States which have been validly designated in the earlier filed application).

Inventive Step

For a European patent inventive step destroying documents must have been publically available anywhere in the world before the entitled priority date. Inventive step arguments are the result of the combination of 2 or more known disclosures provided that it would be obvious to the skilled person to make this combination. These features may be found in a single or several relevant documents/items

3. Choice of database

An explanation of the databases chosen e.g. for a validity search one could choose a full-text database, because also details from the description will serve as prior art for an opposition search and the whole text will be readily available without having to hunt it down separately. This does of course not preclude other databases from being used - other reasoning being possible and valid for e.g. value-added abstracting databases: controlled vocabulary, additional classification, translated foreign publications' abstracts, etc. A database based on patent families will also provide hits in English (or another language familiar to you) even when the oldest and pre-filed document is in an unfamiliar language – should there be subsequent filings. Databases containing literature references could also be considered.



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4. Time limits

Identifying the priority date (11.01.1996) as the cut-off for any search carried out and additionally considering application date for novelty only documents or in the case the claims differ between publication and grant (see also above).

5. File wrapper and citations

Most participants choose to browse the file wrapper / look at the examiner citation to learn about the examiner's arguments, so as to not repeat what had already been done and to learn about possible promising classification. They also reviewed citations from other family member's examination procedures. Finding additional arguments not raised by the EPO examiner could be used as a starting point for the search – arguing as to whether you will follow examiner's lead and go more into depth or dismiss examiner's strategy and focus on different aspects.

Look at the kind of documents citations from different family members:

Citations of EP:

EP0378945

EP0667597

FR2589930

GB2290342

Citations of US:

US5539260

US5555863

US5610574

US5635900

Citations of JP: none

Citations of DE: none



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6. Classification

Finding relevant classification from the citations and other methods including how you found them:

A sample answer:

The EP document is viewed in Epoline Register Plus. The search report is found. It is noted that only A-documents have been found during the previous search. It is also noted that the EPO-searcher have searched in the class-area E05B and G07C. In a discussion with a patent agent or the client it should be discussed whether to trust the EPO search and exclude the class area E05B and G07C from the search or if these classes should be included. This could also be dependent of the time available.

The search report is also checked for classification of the EP-document and more relevant classes are hereby found (E05B49/00 and G07C5/08).

The documents found in citation search and in the search report is analyzed for relevant classes and words or synonyms. Also it will be relevant to analyze the documents for German and French words to be used as synonyms to get a better coverage of the search and also use dictionaries to find foreign language words. This is not done in this exam since the time is limited.

Or (from another result):

I have a look on the classifications using the hyperlinks on the classifications listed in the family result

B60R25/00: Vehicle fittings for preventing or indicating unauthorised use or theft of vehicles

B60R25/02: . operating on steering mechanism

B60R25/04: . preventing use of engine

G07C9/00E4: . . Electronic locks operated with bidirectional data transmission between data carriers and locks[N0111]

G07C5/00: Registering or indicating the working of vehicles

G07C5/08: . Registering or indicating performance data other than driving, working, idle, or waiting time, with or without registering driving, working, idle, or waiting time

H04Q9/00: Arrangements in telecontrol or telemetry systems for selectively calling a substation from a main station, in which substation desired apparatus is selected for applying a control signal thereto or for obtaining measured values therefrom

S07C: INDEXING SCHEME RELATING TO TIME OR ATTENDANCE REGISTERS; REGISTERING OR INDICATING THE WORKING OF MACHINES; GENERATING RANDOM NUMBERS; VOTING OR LOTTERY APPARATUS; ARRANGEMENTS, SYSTEMS OR APPARATUS FOR CHECKING NOT PROVIDED FOR ELSEWHERE



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S07C9/00E: . Electronically operated locks; Circuits therefor; Nonmechanical keys therefor, e.g. passive or active electrical keys or other data carriers without mechanical keys

S07C9/00E12F: . . . with passive electrical components, e.g. resistor, capacitor, inductor

S07C9/00E14C2: by induction

Other options would be to include classes from other systems like F-terms or Derwent MC with an explanation of why they were chosen.

From the EP document: **ECLA:** B60R25/02; B60R25/04; G07C5/08; G07C9/00; H04Q9/00; E05B49/00; G07C5/08; G07C5/08R2B; G07C9/00E4

from the DE part: **DeKla:** B60R25/04A1

From the corresponding JP:

IPC: B60R25/02; B60R25/04; G07C5/08; G07C9/00; H04Q9/00; B60R25/02; B60R25/04; H04Q9/00; G07C5/08R2B; G07C9/00E4

FI: B60R25/04/610; B60R25/02/606; H04Q9/00/301

F-term: 3D019 5K048 5K048/AA15 5K048/BA42 5K048/BA54 5K048/DC01 5K048/EA14 5K048/EA16 5K048/EB02 5K048/EB06 5K048/EB11 5K048/EB13 5K048/GC03 5K048/GC05 5K048/HA04 5K048/HA06

From the corresponding US:

IPC: B60R25/02; B60R25/04; G07C5/08; G07C9/00; H04Q9/00; G08B0/00; G07C5/08R2B; G07C9/00E4

USC1a: 340/286.01 ; 307/10.3; 307/10.5; 340/426.28; 340/426.3; 340/5.61

Derwent Manual Codes: T01-J07C; T05-G01; W02-C02B; W05-D03X; W05-D04; W05-D07D; X22-A08C; X22-X

Discuss which of the classes to use for your search and which were not used including the definition of the classification symbols for better understanding. How does your choice depend on database chosen, interpretation of claims, and applicability of classification symbols (e.g. IPC vs ECLA)?



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7. Keywords / concepts

A table like the ones below help keep concepts apart

Elements	Vehicle	Key removal prevention	transmission	Keys / locks
Keywords	vehicle or vehicular or car% or automobil*	Key near (Remov* or restrain or retain*)	communicat* or transmit* or transceiv* or receiv* or antenna or wireless* or transponder%	
International class		E05B11/00	G07C9	E05B19 E05B65
European class		E05B11/00	G07C9 S07C9/00E12 F, S07C9/00E14 C2	E05B19 E05B65
US class		70/389	307/*	
JCT				2E250*

Another example:

Relevant Search Terms			
Ignition key	interlock	Removal prevent	Reception device
Starter key	Lock	Pull out	Receiver
Ignition key cilinder		Removal	Antenna
Ignition key retainer	actuator		Coil
		Switch	
	Turn on/off	Cipher code	Transmitter
Engine start		Signal	Data storage
	Theft		
Motor start	Antitheft	Key interlock/lock	Microcomputer
	Unauthorised	Key interlock	CPU
Vehicular	Unauthorized	Block	EEPROM
Vehicle		Device	Time interval
Car		Actuator	

Having some background into where the location of big car manufacturers may direct you to additional keywords in other languages which would further help your search.



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8. Annotated search history

An annotated search history is the best kind of answer as it gives an easy-to-follow insight into what was searched and why.

One example without annotations – reasoning behind the strategy can only be guessed:

Set	Items	Description
S1	2814	IC='B60R-0025/02'
S2	46073	LOCK?(5N)(KEY OR KEYS OR CYLINDER)
S3	342	IC='H04Q-0009/08'
S4	344136	(DATA OR DATUM OR INFORMATION OR VALUE? OR SETTING?)(5N)COMMUNICA?
S5	1586315	AUTOMOBIL? OR MOTORCYCL? OR MOTOR()CYCL? OR VEHICLE? OR VEHICUL?
S6	1	S1 AND S3
S7	48091	S1 OR S2
S8	25778	S3 OR (S4 AND (S5 OR IC=B60))
S9	221484	IC=B60R
S10	26106	S3 OR (S4 AND (S5 OR IC=B60R))
S11	154	S7 AND S10
S12	99382	IGNITION
S13	0	S12 AND S13
S14	22	S11 AND S12
S15	2762	AD=19960111/PR
S16	584	S15 AND AD<19960111
S17	4	S14 AND AD<19960111

Or much better – an excerpt with annotations which would be easier to follow in chronological order. In this case no date limitations were set, but it demonstrates a good use of command language and database features.).

<u>12</u>	(10 or 11) and tac=(vehicle or vehicular or car% or automobil*)	78	Should be viewed (narrow, expanded in SS24-25)
<u>11</u>	uc=70/389	200	
<u>10</u>	sc=E05B11/00	592	
<u>9</u>	tac=(key removal)	130	Small search for statistical analysis
<u>8</u>	5 and 6 and 7	303	Small search for statistical analysis
<u>7</u>	tac=(transmission or transmit*)	more than 100,000	
<u>6</u>	tac=(key near remov*)	7312	
<u>5</u>	tac=(vehicle or vehicular)	more than 100,000	
<u>4</u>	pn=(gb2290342 or	4	EPO search report



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<u>12</u>	(10 or 11) and tac=(vehicle or vehicular or car% or automobil*)	78	Should be viewed (narrow, expanded in SS24-25)
<u>11</u>	uc=70/389	200	
<u>10</u>	sc=E05B11/00 fr2589930 or ep0378945 or ep0667597)	592	
<u>3</u>	2 and pd<2003	16	
<u>2</u>	ctf 1 or ctb 1	27	Should be viewed
<u>1</u>	pn=ep0784139	1	EP-document, Should be viewed

Modular histories with few keywords / classes per query line are preferred because they give more flexibility and help avoid misspellings / miscopying. Annotations or explanations of the reasoning behind a certain strategy allow some insight into the thought process behind the strategy (e.g. use of truncation, proximity and combinations of search terms). As there is no right or wrong way to carry out a search, it is important to explain why something was carried out in a particular way. Short forms of commands like in search step 2 show mastery of commands language. The history could also include discussion of whether to start narrow and then expand or start from one concept and then narrow down whether to start over at a certain point, and how to exclude hits from previous steps and so on.

9. Documents possibly found:

This was not required by the exam but it was used as a check.....

DE4339014

DE3225754

EP314143

GB2290342

EP639287



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DE3436761

EP158354

FR2661447

GB2188463

GB2009299

GB2161855

EP673463

EP503695

EP690190

WO199533114

GB1312942

JP7246915