

## Schedule 2: Patent Law and Analysis Skills Syllabus

### Legal knowledge

#### Document types

- What kind of a document is this?
  - o Patent publication types (what does A1, B9 mean?)
  - o Difference between patent, utility model, other publications
  - o Regional specifics on publication of patent docs: when, where, etc.
  - o Filing, prosecution and granting procedures

#### Territorial scope of the patent document

- for which countries can this doc be important?
  - o Different patent organisations, in which phase they may be encountered and their coverage:  
PCT, EPC, Eurasia, ARIPO, OAPI, Unitary patent
  - o concept of patent family
  - o relevance of equivalents (e.g. application is less relevant when there is a granted patent)

#### Patent duration

- When does this patent expire?
  - o Filing date and filing requirements
  - o Patent lifecycle regulations
  - o Patent life extension possibilities (SPC, PTA)
  - o Life time of patents and utility models
  - o Difference between application and grant
  - o Abandonment notifications and repair procedures (EPC Art. 121 and 122)
  - o Invalidation procedures after grant (opposition, re-examination, etc)
  - o Annuity fee payments and registration thereof
  - o National registers



## Claim interpretation

- What kind of claims does the patent have?
  - o Difference between product and process claims
  - o Different claim types (Jepson, product-by-process, medical use)
  - o Specific claim terms – definitions ('for', 'preferably')
  - o Scope of specific types of claims (product-by-process, medical use)

## In practice

- Infringement (what constitutes infringement?)
- Legal actions on infringement

## Patentability

- Determine inventive features
  - o Novelty requirements and grace periods
  - o Definition of prior art (e.g. Art. 52 and 54 EPC, 35 USC §102)
  - o When documents are public documents
  - o If documents (e.g. from internet) may be used as prior art
  - o How prior art docs should be interpreted
  - o Regional differences in combining documents and potential pitfalls

## Invalidation

- Setting up a claim chart
- Interpretation of claim interpretation
  - o Influence of specification on claim interpretation
  - o Interpretation based on Dictionary/heavy presumption
- What documents to choose
  - o "submarines" with earlier priority date but later publication, what prior art may be used and under what terms (Art. 54 3 EPC)
- If I want to invalidate this claim which cut-off date do I need to use in my search?
  - o Determination effective date (e.g. divisional, CON-C-i-P)
  - o Priority (Art. 4C Paris Convention, Art. 87 EPC)
  - o Grace periods
  - o Novelty requirements
- How can this patent be invalidated?
  - o Invalidation proceedings: opposition, re-examination, etc., national court invalidation actions



- Formal requirements for these procedures and time limits
- Grounds for invalidation (e.g. grounds of opposition)

## **Patent Infringement**

- What documents to select, only patents
- Legal status – how to decide whether it is still in force/pending
- Time limits – depending on whether SPC could be in force

