B-Book

How to reply to an official communication and pass Paper B of the European Qualifying Examination

written and edited by

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Third Edition

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Foreword

It is a great pleasure for me to introduce the third – and last – edition of the "B-Book," authored by long-term CEIPI tutor and coordinator Harrie Marsman. In parallel with the issuance of the third edition, the European Qualifying Examination (EQE) undergoes a significant transformation into a new format. However, one last paper B will be sat in 2026 for which candidates will find excellent up-to-date support by the B-Book in your hands. It is not exaggerated to say that, over the years, the B-Book has become a cornerstone of candidates' preparation for paper B of the EQE. Paper B continues to test candidates' ability to amend claims and respond to an office action for defending patentability. These skills, which are also taught by the B-Book, are required by patent attorneys almost every day in their professional life.

For 60 years, CEIPI has been committed to providing high-quality legal training to candidates across all over Europe. This mission is reflected perfectly in the person of Harrie Marsman, whose deep understanding of the EQE and long-term experience in the field of European patent law make him an invaluable contributor to the CEIPI training program already since decades.

The third edition of the B-Book builds on the strength of the preceding editions and has been updated to take into account the most recent papers B. The latest edition also integrates changes in the legal basis, and feedback from candidates and CEIPI tutors, making it an even more effective tool for passing the EQE.

The EQE has already started its transformation into its new form beginning of 2025. In 2026, paper B will be sat by candidates for the last time. However, there will likely be a heritage of paper B – and the B-Book – in particular for elements of new modules M1 and M3 under the revised EQE. While the structure of the EQE may change, fundamental patent law related competences tested in paper B and addressed in the B-Book – such as claim amendment, clarity, and arguing in support of novelty and inventive step – remain essential. The training and mindset fostered by the B-book will therefore continue to help candidates well as they adapt to the new format of the EQE.

I would like to express my sincere gratitude to Harrie Marsman for his continued dedication and pedagogical excellence. His work reflects the core values of CEIPI and plays a crucial role in supporting the next generation of European Patent Attorneys. Furthermore, I wish the users of the new edition of the B-Book success in preparing and passing paper B as an important step towards a career as a professional representative before the EPO.

Strasbourg, May 2025

Andreas Dilg
Director of the International Section of CEIPI

Preface to the Third edition

In June 2021, the first edition of the "B-Book" saw the light. It was written in the uncertainty coming with the COVID-19 pandemic. After not having had an EQE in 2020, the first EQE-after-COVID was in 2021; it was conducted online. For paper B, this meant that the candidates had to sit the paper using the WISEflow platform in a 3½ hour session. Not only was the system to be used not yet flawless, but also the preparations for this exam had to be improvised because of a lack of experience with online examination. Shortly after the EQE, it became however clear that online examination would be the future.

Moreover, after decades of gradual evolution with paper B, starting with the 2017 EQE paper B had changed rigorously in character. Where up to 2017, candidates sitting papers A and B of the EQE could select from papers in the field of Electricity/Mechanics and in the field of Chemistry, both papers were as of 2017 only offered as single papers that should be accessible to any candidate sitting the EQE. Study material, inclusive the B-Book, had to be adapted to the new paper B, and everything was not yet – frankly speaking – crystallized out after 3 single papers. Although the Examination Board did its best, paper B of 2021 was respectfully a difficult paper. Not only had the format changed from paper-based to online, but also there were new concepts in said paper dealing with a public prior use and with third party observations.

Based on the insights coming from the Examiners' Reports of the 2017–2019, 2021 and 2022 papers B, the fruitful annual meetings of EQE tutors and members of the EQE Committees, and the in-depth discussions among the CEIPI tutors in Strasbourg (thanks Erich, Marie, Oana, Christophe, Thierry, Simone, Harald, Katerina, Thomas, Virginie, Claire, Petra, Steef, Emmanuel, Daniel, Armin, Andrea, Alexander, Marcel and Petri) and my personal attempt of the 2023 paper B (without the comfort of the Examiners' Report), I was able to finish the second edition in 2023.

This now is the third edition, and because in 2026 there will be a last chance to sit paper B (and A) in its present form, also the last edition of this B-Book.

Of course some updating was required in view of changes in the Regulations for the EQE, the Guidelines for Examination in the EPO and the Case Law. Further, I have incorporated examples coming from the Examiners' Reports of paper B 2023 and 2024, and examples based on my personal attempt of the 2025 paper B. The 2025 examples are preliminary ones, because not backed up by an Examiners' Report.

Special thanks go to Steef Polderdijk for coordinating the CEIPI seminars on paper B (and A) and bringing together the CEIPI tutors allowing me to gather the information needed to update this book. In addition, Steef worked on the CEIPI solutions of papers B 2017. Moreover, I thank Christiane Melz for her continuous administrative support.

Further, I am grateful to Margaretha Engelmann of Wolters Kluwer Deutschland GmbH for her assistance in the production of the book.

The responsibility for the contents of and views expressed in this third edition of the "*B-Book*" is mine. I am certain that mistakes and errors are present in this book and would welcome any amendments, comments and suggestions regarding this "*B-Book*" on my email address harrie@marsmanoctrooi.nl.

Haaren, The Netherlands, April 2025 *Harrie Marsman*

Contents

2 Methodology

2.1 Objective

Throughout this book, the term "*methodology*" refers to the practices and techniques used for tackling paper B, rather than to the theoretical analysis of the methods and principles in the field of patent law. Having an efficient methodology with clear outlines and procedures is essential in order to cope with the complexity of the paper and to accomplish your task. The two main objectives are to accelerate the processing time and to improve the quality by ensuring that the results are (i) comprehensive, (ii) consistent and (iii) in accordance with the requirements. 1

There exists no such thing as a unique method tailored to the needs of everybody who wants to sit paper B. When preparing for the EQE, you will have to acquire practical experience and learn what is effective for you yourself. Going quickly through the text of the paper, making some informal notes and drafting an answer on an *ad hoc* basis is hardly promising and generally leads to poor quality. On the other hand, thorough knowledge of best practices can help to avoid mistakes. But what does the concept of best practice mean in the context of paper B? 2

It means the following: 3

- The work is organised in a manner that the documents need not be read and evaluated several times, possibly a first time when the analysis of the paper is performed, a second time when the claims suggested by the client are to be amended, a third time when the letter to the Examiner is written and a fourth time when any corrections or additions become necessary.
- The information is processed as soon as it occurs. Thus, information retrieval does not absorb a lot of time.
- The risk of overlooking some important points of fact or law is minimised.
- All essential aspects of the paper are considered. There are no gaps and omissions.
- The results are clear and consistent.
- The answer has the right structure and is limited to those parts that are required. No time is spent on unnecessary issues.

Managing these aspects and bringing them under one roof is more an art than a set of technical skills. Nevertheless, there are good reasons to get acquainted with the technicalities of the case. This chapter is designed to help you familiarise yourself with the practical procedures for processing of paper B. 4

2.2 Preliminary steps

Before tackling any paper of the EQE, we strongly recommend you to check, whether you are really familiar with the relevant rules of the EQE. 5

Surprisingly, quite a number of candidates possess only superficial knowledge of the Regulation and Rules of the European qualifying examination, and some ignore them completely. This lack of knowledge may be dangerous and a major reason for failure at the examination. Ignorance of the rules means inevitably ignorance of the requirements that have to be fulfilled. Therefore, in order to avoid errors and misconceptions, it is indispensable to know and understand the rules laid down in the Regulation on the EQE, the Implementing provisions and the Instructions to candidates. Comprehensive knowledge of the legal framework is also required for developing a coherent strategy for solving paper B. 6

In the hierarchy of norms, the Regulation on the EQE (REE) comes first. The Implementing provisions to the Regulation on the European qualifying examination (IPREE) take the second place. Last, but not least, there are the Instructions to candidates concerning the conduct of the European qualifying examination (Instr.). From a practical standpoint, they are as important as the higher-ranking sources. 7

These three legal texts define the framework and the conditions of the EQE. The most important provisions are set out below, as far as they apply directly to paper B. 8

to a claim directed to an entity (a product claim) with a "for clause" the term "suitable" and bring the "suitable for" part between rectangular brackets]:

Claims 110

1. System for monitoring at least one vital sign of a human body, the system comprising:
   - holding means (1, 11, 21) for holding an optical sensor (2, 12, 22) and a motion sensor (3, 13, 23) close to the human body (10, 27), the holding means (1, 11, 21) comprising in addition to the sensors (2, 12, 22, 3, 13, 23) transmitting means (4, 14, 24) for transmitting output signals from the sensors (2, 12, 22, 3, 13, 23),
   - evaluation means (5, 25) for receiving the output signals and calculating from the output signals the at least one vital sign,

   characterised in that the evaluation means (5, 25) is configured to correct the output signal from the optical sensor (2, 12, 22) based on the output signal of the motion sensor (3, 13, 23) or to correct the output signal from the motion sensor (3, 13, 23) based on the output signal of the optical sensor and in that the transmitting means (4, 14, 24) is a wireless transmitting means.

   This independent claim is directed to a system, that has holding means, an optical sensor, a motion sensor, transmitting means being wireless, and evaluation means.
2. System according to claim 1, wherein the at least one vital sign is pulse, body temperature, blood pressure and/or blood oxygen saturation. 111
3. System according to claim 1 or 2, wherein the wireless transmitting means (4, 14, 24) is a wireless local network emitter. 112
4. System according to any of claims 1 to 3, further comprising a screen (6) and configured to display the at least one vital sign on the screen. 113
5. System according to any of claims 1 to 4, wherein the holding means is an attaching means (1, 11, 21) such as a sock (1), a wristband (11) or a glove. 114
6. System according to any of claims 1 to 5, wherein the attaching means (1, 11, 21) is at least partly made of Optitex™. 115

These claims 2–6 are all dependent on claim 1 and seem not that complicated. 116

[Should you feel that the claimed invention is not yet sufficiently clear for you, it goes without saying that you may then read some additional (or even all) paragraphs of the description.] 117

Once you have formed a preliminary idea of the technical field of the invention, the subjective problem underlying it and a general idea on the claimed subject-matter, you may turn to finding the actual task of paper B. That is, it is now time to give substance to what points are raised in the official communication and how your client suggests to proceed with the European patent application. 118

2.3.3 Step 3: Finding the objections

For paper B, it is expected to draft an amended set of claims and to draft a response to an official communication, wherein all objections are addressed. 119

As far as the set of claims is concerned, it is necessary that the subject-matter thereof meets the requirements of the EPC, and hence 120

- is clear in the sense of Art. 84 EPC;
- is in conformity with the requirements of Art. 123(2) EPC;
- meets the requirements of Art. 52 EPC; that is
  - relates to an invention, that
  - is novel,
  - involves an inventive step, and
  - is industrially applicable;
- meets the requirements of unity-of-invention under Art. 82 EPC; and
- meets the requirements of R. 43(2) EPC.

Above this, it is required that the set of claims is according to the way the client wishes to proceed. Where in paper A the claims must meet the requirements of the EPC, and must provide the broadest possible scope of protection, ideally covering as many embodiments of the described invention, paper B is not focusing primarily on the broadest scope of protection. The wish of the client is to be used as guidance, and only in that light an optimal scope of protection is expected. Or put in other words, the amended set of claims must 121

be in accordance with the client's instructions, while the claims are in conformity with the EPC. Only after these main considerations, there is room for trying to get the broadest scope of protection. However, normally no marks are available for drafting claims – whether independent or dependent – where the client did not ask for.

122 As said, all objections are to be addressed. In this step 3, I will refer not only to the objections raised in the Communication, but also to issues linked with the wishes of the client as expressed in the client's letter and coming from the draft set of claims. In this book, these other issues will also be referred to as "objections".

123 This step 3 needs to be carried out with concentration and perhaps even suspicion. If you miss one or more objections, you miss possibilities to score marks, and these marks cannot be gathered for other issues.

Reading the Communication

124 For finding objections, I consider it suitable to first turn to the Examiner's Communication. Although the position of the Examiner should always be checked, normally the position taken is correct. In the second edition, I believed that there was a case wherein the Examiner's position was not correct. Without having the knowledge of the Examiners' Report of Paper B 2023, I had the firm feeling that the novelty objection based on D2, a document only citable under Art. 54(3) EPC, in paper B of 2023, was not convincing. However, based on the Examiners'Report, the best solution was to accept the Examiner's position. In addition, you may assume that everything written in the exam paper is there with an intention or purpose.

125 **Communication:**

1. The examination is based on the application as originally filed. Documents D1–D3 are prior art according to **Art. 54(2) EPC**.

126 Apparently, there are three pieces of prior art: D1–D3. From the reading of the first two paragraphs of the patent application as originally filed, we already know that one of these prior art publications, D1, was discussed and formed the basis for defining the subjective problem, *viz.* the problem underlying the invention as originally filed.

127 **Communication:**

2. Art. 54(1) and (2) EPC (Novelty)

The subject-matter of **claims 1–4** is **not novel** within the meaning of **Art. 54(1) and (2) EPC**, because it is known from D2:

Claim 1: D2 discloses in paragraph [01] a system for monitoring at least one vital sign of a human body, the system comprising holding means (support for the camera [2], cf. par. [01]) for holding an optical sensor (camera sensor) and a motion sensor (motion sensor in the camera) "close" to the human body (cf. point 3.1 below), the holding means comprising a transmitting means for transmitting output signals from the sensors to evaluation means (smart phone), the evaluation means being configured to correct the output signal from the optical sensor based on the output signal of the motion sensor (SMOOTHY App, cf. par. [02]). The evaluation means calculates a vital sign (pulse, cf. par. [01]). The transmitting means is a wireless transmitting means (cf. par. [02]).

Claim 2: D2 further discloses in par. [01] measuring the pulse.

Claim 3: D2 further discloses in par. [02] a wireless local network emitter.

Claim 4: D2 further discloses in par. [01] as display means a screen.

128 The Examiner takes the position that claims 1–4 are not novel over D2. *A contrario*, one may (at least preliminary – one has to check!) take from this, that claims 5 and 6 are novel.

129 While defining the novelty objection against claim 1, the Examiner points to the terms ""close" to the human body", while referring to point 3.1 of the Communication.

Claims 1–4 as originally filed are not novel. Claims 5 and 6 apparently are novel.

130 **Communication:**

3. Art. 84 EPC (Clarity)

Claim 1: The expression "[holding] … **close** to the human body" is a relative term and thus unclear. An unclear term cannot be used by the applicant to distinguish the invention from the prior art (Guidelines F-IV, 4.6).

This clarity objection in respect of the relative term "close to", at least at first sight, seems justified. Recall that the Examiner in making his novelty objection put emphasis on the terms ""close" to the human body". 131

Claim 1 is not clear, because it uses the terms "holding close to".

Claim 5: The technical feature **"glove" is only mentioned in the claims and not in the description**. According to **Art. 84 EPC** it is required that **the claims are supported by the description**. 132

Apparently, there is no reference to a glove in the description. This objection requires that either you have to provide good arguments as to why there is support in the description as filed; or the claim has to be brought into conformity with the description, or *vice versa*, the description has to be brought into conformity with the claim(s). 133

Claim 5 is not clear, because it uses the term "glove" that is not supported by the description, or the description must be brought in conformity with claim 5 unless you can argue that there is support.

Claim 6: Optitex™ is a **Trademark** The definition of a composition by a trademark may change and therefore is unclear under **Art. 84 EPC** (cf. Guidelines F-IV, 4.8). 134

The Guidelines are quite clear on this point: "*The use of trade marks and similar expressions in claims is not allowed as it does not guarantee that the product or feature referred to is not modified while maintaining its name during the term of the patent. They may be allowed exceptionally if their use is unavoidable and they are generally recognised as having a precise meaning*." It needs to be checked, whether we can find arguments for the position that Optitex™ is generally recognised as having a precise meaning and its use is unavoidable. Otherwise, the term needs to be replaced by a clear term or be removed.

Claim 6 is not clear, because it uses the trademark "Optitex™".

Communication: 135

4. If the applicant wishes to maintain the application, **new claims** should be filed which take the above objections into account.

Your task is to file new claims that overcome the Examiner's objections. 136

Apparently, only novelty and clarity objections were raised by the Examiner. Only prior art objections are raised against claims 1–4 based on D2. 137

Provisionally, it seems that inventive step for (preliminary) novel claims 5 and 6 is not contested. 138

The clarity objections seem *prima facie* justified. 139

Claims 5 and 6 do not only appear to be novel; they also appear to involve an inventive step.

Communication 140

5. Care should further be taken that the **dependency** of the amended **dependent claims** is correct.

Your task is further to check and, if needed, adapt the dependencies of the claims. It is striking in this light, that no objections were made by the Examiner on the dependency of the claims. Bear this in mind when drafting amended claims! 141

Check the dependencies of all dependent claims. This is a matter of clarity and/or of support in the application as originally filed.

Communication 142

6. In order to facilitate the examination as to whether the new claims contain subject-matter which extends beyond the content of the application as originally filed, the applicant is requested to indicate precisely where in the application documents any **amendments** proposed find a **basis (Art. 123(2) EPC and Rule 137(4) EPC). This also applies to the deletion of features**.

As you already know, paper B requires – like in real life – that amended claims do not violate Art. 123(2) EPC. It is emphasized that you indicate precisely were the support for claim amendments comes from. In addition, with no apparent reason found in the Communication, the Examiner all of a sudden refers to specific attention under Art. 123(2) EPC when features would be deleted from a claim. 143

Are all amendments in line with Art. 123(2) EPC?

144 **Communication**

7. Care should be taken to ensure that the new claims comply with the requirements of the EPC in respect of **clarity, novelty, inventive step** and, if relevant, **unity** (**Art. 84, 54, 56 and 82 EPC**).

145 The new claims must be clear and concise, must relate to subject-matter that is novel and involves an inventive step, and the set of claims must meet the requirements of unity-of-invention.

Are the amended claims clear; are the amended claims concise; are the amended claims supported by the description? Do the amended claims meet the requirement of novelty? Do the amended claims involve an inventive step? Is the requirement of unity-of-invention met?

146 **Communication**

8. In the letter of reply, the **problem and solution approach** should be followed. In particular, the **difference between the independent claim** and the **prior art (D1-D3)** should be indicated. The **technical problem** underlying the invention in view of the **closest prior art** and the **solution** to this problem should be readily derivable from the reply of the applicant.

147 When discussing the issue of inventive step, it is not only necessary to apply the problem-solution approach; it is necessary to take (and motivate) every step in the problem-solution approach. In addition, the Examiner asks for the difference between the independent claim and each document of the prior art. Apparently, only one independent claim is expected! This question of the Examiner requires you to discuss the novelty of said independent claim relative to all three cited documents of the prior art.

Apply the problem and solution approach in all its steps! Argue novelty over each document forming state of the art!

148 The Communication is quite helpful. Not only are some objections clearly sketched, but also your task is clearly defined. In addition, the Communication hinted to potential problems with the dependency of dependent claims and hinted to the deletion of a feature from the claim(s).

Reading the client's letter

149 In the next step, it is time to read the client's letter. As already mentioned herein-above, one of your main tasks in paper B is to proceed in accordance with your client's wishes.

150 At this stage, we know what the field of the invention is and we know the subjective problem that underlies the invention, when starting from D1. Further, we have an idea of the claimed subject-matter and found out that the original claims 1–4 are held to be not novel over D2. Claims 5 and 6 appear to relate to novel subject-matter that may involve an inventive step. Finally, there are clarity objections raised with regard to the relative term "close to" in claim 1, to the use of the Trademark Optitex in claim 6, and to the fact that claim 5 uses the term "glove" that apparently is not supported by the description.

151 Let us go to the client's letter.

Client's letter

Dear Ms. Evita Lee-Tea,

[01] Our invention has the advantage that the vital signs can be remotely monitored with a reliable, secure and comfortable attachment of the sensors in combination with a high signal quality, which is achieved by noise reduction through correcting the sensor output signals.

152 Your client starts with mentioning the advantage of the invention. This comes close to the subjective problem relative to D1, given in paragraph [01] of the patent application as filed:

Problem: provide a reliable and comfortable system for long-term remote monitoring of vital signs of patients (such as small children or babies).

153 It is not exactly the same, though. Your client refers to "secure" attachment and points to "high signal quality, achieved by noise reduction through correcting the sensor output signals".

Client's letter 154

> [02] We propose filing the enclosed draft set of claims together with your reply to the official communication. We are convinced that the subject-matter of amended claim 1 is novel and inventive. Please make any amendments to the proposed set of claims you consider to be necessary for the claims to fulfil the requirements of the EPC, whilst giving us the broadest possible scope of protection for our invention.

A draft set of claims is introduced. Your client is convinced that the subject-matter of amended claim 1 is novel and involves an inventive step. 155

In addition, you are invited to make any amendments to the proposed set of claims needed to bring these claims in accordance with the requirements of the EPC. Your client knows in which way he wants to go, but is not a specialist in patent law. That part should be your contribution. Actually, it is my personal opinion that this consideration is the most difficult part of paper B. In the papers B since 2017, the client makes proposals in its letter and in its set of amended claims that cannot be followed entirely in the set of claims to be defended. Objections can be raised against a number of these proposals and amendments, and it is these "objections" that the candidate has to realise or discover and has to deal with. The reading and understanding of the client's letter and the amended set of claims, and the translation of suggestions and amendments is objections that have to be overcome, deserves sufficient concentration efforts and time allotment. 156

Since the introduction of a single paper B in 2017, you can score 30 marks for the amendment of the claims. Using the words of the Examiners' Report of paper B 2017, these 30 "(m)arks were awarded for making appropriate amendments to the draft set of claims for bringing it [said draft set of claims] into accordance with the EPC. **No marks** are awarded for merely filing the claim set proposed by the client or for the formulation of additional dependent claims." 157

Hence, although the client wishes that the set of claims gives him "the broadest possible scope of protection" for his invention, neither are points available for other inventions than the one(s) identified in the draft provided by your client, nor for any new dependent claims. The suggested set of claims in itself should be optimised to give the broadest possible scope of protection. 158

Knowing this, do not waste time on finding different and other inventions or different preferred embodiments, if there is no hint to those in either the draft set of claims or the client's letter! 159

Client's letter 160

> [03] Claim 1 has been restricted by including the features of dependent claim 5. Claim 1 is drafted in the two-part form with respect to D1, because D2 and D3 are from remote technical fields. We have moved the wireless transmission from claim 1 to amended dependent claim 2, because for some applications this kind of transmission is not suitable. We do not want to have a dependent claim related to the subject matter of original claim 2. We only want to protect a system, where the attaching means is (any kind of) a garment. Please amend the claims accordingly, if possible.

Your client suggests to restrict claim 1 by including the features of claim 5. 161

From our preliminary analysis, we know that there were no novelty objections raised by the Examiner in respect of original claim 5, nor was there an explicit inventive step objection. We do know that there was a clarity issue with regard to claim 1 and a clarity issue with regard to claim 5, but not knowing yet how the amended claim 1 looks like, we cannot say anything in respect of these clarity issues. 162

In the second sentence of paragraph [03] of the client's letter, the client observed that amended claim 1 is drafted in the two-part form with respect to D1, because D2 and D3 are from remote technical fields. 163

This is already a second time that apparently the client considers that D1 is the closest prior art. First, D1 was discussed as prior art document in the description of the patent application and the subjective problem was based thereon. Second, its features are brought in the preamble of a two-part form claim. In addition, the client considers that D2 and D3 are from remote technical fields. 164

Since the client is not an expert in patent law, of course you have to check if D1 indeed can be the closest prior art in view of the problem-solution approach. Furthermore, if so, you also have to check whether the two-part form is correctly used. 165