

Examiners' Report on Paper B/1991 (Electricity/Mechanics)

1. Candidates were instructed to presume that the given text of the application had been filed. The main task for the candidate was (a) to consider what further restriction to the given main claim needed to be proposed in order to distinguish the client's invention from Document II cited by the Patent Office, and (b) to refute the Patent Office's objections by relevant argumentation. One possibility would be to transfer the original characterising features to the preamble (known from Document II) and to direct a new characterising part to one of several almost equally meritorious further distinctions derivable from the original disclosure, e.g. specifying features which ensure that the spring is not in contact at any point with the material to be melted or arranging that the melting chamber can be extracted from the device and replaced by another: that is to say, by features which provide an advantage or solve a problem not provided for or addressed in either Document I or Document II.
2. Another possibility was to redirect the claim to the heating system, without restriction to a device having the characteristic features of the main claim as presented in Paper B. Candidates who did this were given credit only if they justified the omission of these features by reference to the original disclosure, which did indeed present the heating cartridge as an independent element separable from the rest of the device.
3. However, the best responses were from those candidates who proposed to limit the original Claim 1 to further mechanical features, to maintain all the other claims which were not already absorbed in the wording of the revised main claim and, moreover, also proposed the filing of a divisional application for the independent electrical aspect of the PTC heating arrangements. Candidates who elected to restrict to the

electrical aspect only or to the mechanical aspect only loses marks, since those solutions which preserved protection for both aspects were clearly superior from the point of view of safeguarding the client's rights. Candidates who (correctly) proposed to retain one of these aspects and divide out the other, sometimes abandoned protection for the combination of both. This was a mistake and was duly penalised when assessing the value of the claims as a whole. In this connection, attention is drawn to the remarks in the report on paper A concerning the allowability of such combination claims with regard to Article 82.

4. Argumentation by many candidates was weak since, despite previous reports drawing attention to the problem/solution approach to considering inventive step, that approach was not followed. Typical of the arguments which the committee members considered weak were those which really did not go beyond establishing that certain features of the revised claim are not disclosed in either of the cited documents. This, of course, establishes novelty, but only that. A little better were the arguments which established novelty plus an advantage, but stopped there. To complete the argumentation, candidates should state why it is not obvious to seek to provide such an advantage or at least show that, even if it seems obviously desirable to provide the advantage, it is not obvious to provide it in the way that or using the means that the client's invention proposes.
5. Usually, if the main claim proposed by the candidate is potentially patentable and his argument establishes a plausible ground for inventiveness which the Patent Office could not refute except by means of an even more relevant prior art document, the totality of the candidate's solution (i.e. claims plus argument) would ensure success in the examination, provided that the claim was not unduly restricted. In view of the limited time available, candidates should concentrate on the subject-matter of the independent

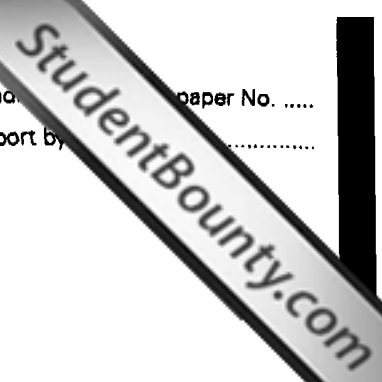
claim(s). Some candidates said far too little to convince that their main claim could be patentable but vainly gave much time and space to establishing that at least the sub-claims were inventive.

6. Although the object of the exercise in Paper B is to rescue the application from the prospect of refusal by proposing new main claims and to defend the first and broadest claim by relevant argumentation, the candidates were also instructed to revise the description as far as necessary to accord with the amendments made to the claims. Such revision may entail deleting subject-matter no longer covered (e.g. candidates who restricted the electrical aspect to the use of strings of PTC resistors selectively connectable in parallel should have deleted Figure 6 and its associated description, since that embodiment does not have those features. The teaching of Document II has to be referred to in appropriate terms, which should be consistent with the content of the amended main claim. What the examination committee members were looking for was a clear acknowledgement of whichever document the candidate considers to be the nearest state of the art, a claim correctly set in two-part form against the document and a general revision of the description and subclaims to ensure that they are consistent with whatever is now presented as the invention. Statements such as "the applicants request to defer revising the description and subclaims until it is known whether the proposed main claim proves acceptable" may well be tolerated by Patent Office examiners in real life. Nevertheless Paper B for the qualifying examination has a secondary object to test whether the candidate knows what kind of amendment is called for and hence a candidate who makes no clear proposal for amending the description and subclaims will lose marks. He will indeed, in all justice, lose more marks than a candidate who does try to revise them but, through lack of time perhaps, does so imperfectly.

7. As in previous years, we noted that some candidates give insufficient attention to the requirements of Article 123(2) EPC. Particular attention is drawn here to the Guidelines at C-VI 5.3 and 5.7 to 5.7c. Current EPO practice is very strict in this respect and hence it is wise to present any new acknowledgement of prior art in purely factual terms and any statement of the advantages of the invention over that prior art should be confined to such advantages as are in fact straightforwardly deducible from the application text as filed. Anything going beyond that runs the risk of an Article 123(2) objection by the European Patent Office. Of course, advantages which have become apparent *ex post facto*, i.e. as the result of reconsidering the invention in the light of the content of the subsequently cited further prior art, may well be advanced as arguments in support of inventive step, but the proper place for such assertions of (previously unmentioned) advantages is the letter of response, not the revised description. Or at least, if it is proposed to add such matter to the description, the candidate should provide at least an outline justification for its being allowable with regard to Article 123(2).
8. However, the main purpose of Paper B is to test skill in restricting the claims to the least extent necessitated by the cited prior art and to defend the thus restricted claim by good and relevant argumentation. Everything else is subsidiary to that purpose and excessive expenditure of time on inessential aspects is not justified. The time thus saved could then be devoted to ensuring that the main claim or claims and the argumentation in respect of the inventive step are really legible.

EXAMINATION COMMITTEE I

Candidate Paper No.
 Report by



FORM, for use by individual examiners, in PAPER B

Schedule of marks

Category	Maximum possible	Individual marks awarded	Where grades awarded are not identical	
			Revision of marks/grade (if any)	Remarks*
Claims	20			
Argument	20			
Description	8			
TOTAL	48			
CORRESPONDING GRADE				

Translation of marks into grades

	Grade
0 - 6	7
7 - 13	6
14 - 20	5
21 - 27	4
28 - 34	3
35 - 41	2
42 - 48	1

**to be filled in if both the following requirements are fulfilled:
 (a) the grades awarded by the two individual examiners before their discussion differ by two grades or more;
 (b) the marks awarded by at least one of the two individual examiners have been changed during their discussion.
 If remarks are to be filled in, they should briefly explain **why** the examiner has changed his marks.