

Examiners' Report on Paper C/1990

General

1. It is pleasing to be able to report that the answers showed improvement over previous years. Some points, worthy of comment still however persist.
 - i) It is not sufficient to rely upon a pure analysis of the features in the claims and indicate in which documents these features are to be found. Some answers of this nature even only allocated reference numbers or letters to features in the claims under attack and then added, for example, features (a), (b) and (d) are to be found in Annex 2, page 3 lines ...; feature (c) is in Annex 3 page 4 line ...; features (e) and (f) are found in The conclusion of lack of inventive step was then given without any reasoned argument why such features should be combined.
 - ii) The date of the client's letter and that of the Exam do not have any special relationship. References to anything which might be influenced by the date of the client's letter, e.g. consultation with the client, should therefore not be made.
 - iii) Some marks are lost carelessly by not paying proper attention to the formal aspects of the notice of opposition, as required by Rule 55(a) - (d).

- iv) Answers which use the same document to formulate an attack under Art. 54(2) and Art. 56 are still received. Unless satisfactory reasoning is given why such action is undertaken marks will be lost, as it illustrates a lack of a clear appreciation of the relevance of the document to novelty and inventive step. Allegations of lack of novelty should not be made unless all features of the respective claim can be demonstrated to be disclosed in one document.
- v) Copies of rough notes are not considered to form part of the answer proper.
- vi) Any contradiction between the answer paper, so far as it relates to the notice of opposition, and the notes to the Examiner as well as any inconsistency in argumentation regarding a certain point may will lead to a loss of marks.

Specific

1. Legal

- a) Hardly any candidate answered the priority problem properly.

It should have been noted that the inventor was the same in Annex 1 and Annex 2 and that the subject-matter of Claim 1 of Annex 1 was disclosed in Annex 2 and hence also in the priority document of Annex 2. The subject-matter of Claim 1 was thus first disclosed on 9.12.83 so that Annex 1 only has an effective date of 12.5.86 for Claim 1. Annex 2 was therefore effective under Art.54(2) against Claim 1 (Guidelines C.V 1.4).

Claims 2 - 4 are entitled to the claimed priority date.

N.B. Some candidates interpreted the third paragraph of the client's letter as meaning that the PCT Application (Annex 2) and the priority document of Annex 1 were identical.

It is not clear why this interpretation should arise in particular when one considers the differences between the subject-matter of Annex 2 and that of Annex 1.

- b) Annex 2 was not effective under Art. 54(3) as the Art. 158(2) fees were not paid.
- c) Annex 6 was not confidential.
- d) Claim 3 should be attacked, in view of importation problems of the product from Portugal.

2. Use of Information

- i) The novelty (Art. 54(2)) of Claim 1 can be attacked using Annex 2 (see Legal (a)) or Annex 5. Furthermore Annex 6 can be used to attack novelty with each of Models B and C and, also implicitly, Model A.
- ii) Claim 2 can be attacked under Art. 56 using Annex 5 and Annex 3, either one being the starting document. it should be noted that Annex 5 does not disclose an electrical heating winding; it discloses a tubular mesh, page 2, lines 12-14. (See: General point IV in this respect). Annex 5 could however be used to argue the obviousness of the movable calibrated rod visual

indicator as it discloses the indicator as being an indicator of the generated pressure.

- iii) Independent Claim 3 could be attacked by combining Annexes 3+4+5. Annex 3 shows a method of application involving a preheating of the wire (as opposed to passing an electrical current). The requirements of composition, number of recesses and colour can be found in the other Annexes.
- iv) The letter of Annex 6 established that the problem underlying Claim 4 was known at the time of the press conference in May 1985. This could be used in conjunction with the disclosure of Annex 5 page 2, lines 30-35 to attack Claim 4.

Some candidates commented that Annex 6 led away from this argument as the problem had been known for some time without any solution. This approach also received marks.

Some candidates could not clearly distinguish which of Models A, B and C were disclosed before the valid priority date of Claims 2-4. It should however be appreciated that only Model A was available before such date.

EXAMINATION COMMITTEE II

Candidate's answer

Report by examiner

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FORM, for use by individual examiners, in PAPER C

Schedule of marks

| Category | Maximum possible | Individual marks awarded | Where grades awarded are not identical | |
|----------------------------|------------------|--------------------------|--|----------|
| | | | Revision of marks/grade (if any) | Remarks* |
| Use of information | 40 | | | |
| Legal aspects | 30 | | | |
| Argumentation | 30 | | | |
| TOTAL | 100 | | | |
| CORRESPONDING GRADE | | | | |

Translation of marks into grades

| | Grade |
|----------|-------|
| Up to 25 | 7 |
| 26 - 35 | 6 |
| 36 - 49 | 5 |
| 50 - 59 | 4 |
| 60 - 69 | 3 |
| 70 - 80 | 2 |
| Over 80 | 1 |

* to be filled in if both the following requirements are fulfilled:

- the grades awarded by the two individual examiners before their discussion differ by two grades or more;
 - 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.