Examiners' Report on Paper C/1993

1. Some candidates are not aware that they are under examination conditions and that they do not have the real life opportunity of expanding an argumentation at oral proceedings or after reply of the patentee.

2. Candidates should therefore make out as full a case as possible, as early as possible. They should bear in mind that all claims should be treated equally seriously, it not necessarily being the case that the independent claims receive the most marks.

3. The Instructions to the candidates attached to the question paper and those given in the Regulation on the European Qualifying Examination (Implementing provisions under Art. 12 REE) should be read most carefully as there are many instances where they are not being followed:

   - the facts are still not being accepted as presented ("I will order the priority documents to see if the priority date is valid"; "I will provide a further document to show that this feature was known at the time of the priority applications.");

   - rough notes, and analysis of the prior art and the examination paper are still sometimes being enclosed with the answer papers;

   - candidates are still indicating that they will confer with the client, sometimes by fax;

   - candidates are still explaining how they will file the opposition, with the deadline for filing the opposition often being commented upon;

   - the language of the version being opposed is often not indicated.

4. It is clear that too much time is spent in writing about legal issues or points raised in the client's letter to the detriment of the attack on the later claims. As many of the legal points should emerge naturally whilst drafting the opposition separate discussion of legal points should not be undertaken where such points are brought out in the opposition itself.

5. Additionally, much time is wasted on extensive discussion of the dates of the prior documents. Again, such information should evolve naturally in the answer itself.

6. Issues were addressed which were not relevant to the paper. One often got the impression that candidates were trying to play safe by including points from previous years.

7. The claims should be attacked separately, not grouped together as this leads to a confusing answer and loss of marks.

8. It is not acceptable to merely indicate what is disclosed in the Annexes and then allege that the claims are therefore not patentable. The grounds should be properly argued. A dependent claim was also often attacked with additional documents, without having proper regard to the way in which other documents had been used against earlier claims. Claim dependencies should always be observed carefully.

9. The problem/solution approach was often ignored.

10. It is not acceptable that a document be used to attack novelty and inventive step of the same claim unless proper explanation be given. Claim 1 was often attacked under Arts. 54(2) and 56 using Annex 3 without any explanation for this apparently contradictory approach.

11. It should always be considered whether, if a claim is attacked for lack of novelty, there is also a possibility to attack for lack of inventive step. The other documents used in this attack are often important for later claims.

12. The priority date of claim 1 was often attacked for quite incorrect reasons. It was often stated, for example, that claim 1 was not entitled to its priority date as the description referred to nut and bolt whilst the claim contained the broader, unsupported references to first and second parts. The fourth paragraph on page 2 however refers to "a first part" and "a second part" in its first sentence.

13. The fact that claim 4 contained two quite distinct constructions was often overlooked.

14. An Art. 54(3) objection was often made in spite of the relevant priority dates speaking against it. This often arose where candidates used Annex 4 under Art. 54(3) without first arguing that the claims were not entitled to their priority dates. The situation was made worse by some candidates using the Annex under Art. 54(2).

15. Annex 6 was often argued to have been prior art as it was said to have been faxed to Japan. This is however not stated in the client's letter. It should not therefore be assumed.

16. The reproduction of the information in the first priority document before the date of the second priority document was often used as prior art (as Annex 7), even though not in line with T301/87. Althought this issue has now been referred to the Enlarged Board of Appeal, at the end of 1992 and at the time of the Examination, the decision T301/87 indicated that such a reproduction should not be taken into account. Appropriate marks were however given if the document was used correctly against the claims. Legal points could also be obtained if some comment was made on the decision. In the majority of cases however Annex 7 was used without proper regard to the different priority dates of the claims and their features, also often without any comment on the DG3 decision.

Brief Summary of Possible Solution for Paper C 1993

USE OF INFORMATION (40 Marks)/ARGUMENTATION (30 Marks)

Claim 1 (Priority 18.09.88)
Art. 54(2): Annex 3
First part = "element (11)" surrounded by "gaine 34"
Second part = "tige de tension 22"

Art. 56. Starting with Annex 5, it could be argued that the problem of lightening had already been implicitly addressed in Annex 3, with the solution being a metal sleeve (34) spaced from the enlarged head. (It should be noted that although Annex 3 takes away the novelty of Claim 1, it can be used to supply the missing link for Annex 5 if the problem and solution approach is used - cf. point 10 in

Art. 56 can be used by combining Annexes 2 and 5 and employing a "kinematic" inversion approach, Annex 5 shows a metal sleeve and a composite shank, whilst Annex 2 shows a composite sleeve (42) and a metal shank. Annex 2 is concerned with the same problem as Annex 1 and it should be noted that the resin (26) could also, but not necessarily, be regarded as part of the enlarged head.

Claim 2 (dependent on claim 1: Priority 18.09.88)
Art. 56: Annex 3 + Annex 1 show that blind rivets and nut and bolt arrangements are both well known arrangements; the latter arrangement also being known from Annex 5.

Claim 3 (dependent on claim 2: Priority 04.5.89)
Slots in screws are conventional: see Annex 5. It would be obvious to have the slot at the other end, e.g. for ease of accessibility from one side of a large surface, such as from within aircraft. It would also provide for a smoother external surface. Annex (3 + 5).

Claim 4 (dependent on claim 2: Priority 18.09.88 or claim 3: Priority 04.5.89)
The claim covers two distinct possibilities; one with the sheath located on the inner surface (which is shown in Figure 2 and has the priority date of 18.09.88) and one with it on the outer surface.

The latter possibility also covers the situation where the sheath is only on the outer surface and which is first disclosed in Claim 4 of the application and not in the priority documents. If Claim 4 is as originally filed, the "outer sheath" embodiment has the filing date as its effective date. If, however, the Claim was introduced during the examination procedure, it constitutes added subject matter. If the claim was filed during examination bonus marks could be obtained for an Art. 123(2) attack. This situation can only be resolved with a file inspection. Thus both dates should be considered in drafting the answer as a file inspection is not open to the candidate.

When the filing date (05.07.89) is effective, the Claim is attackable with Annex 4 under Art. 54(3) for all contracting states except PT as at the times of filing Annex 1 and Annex 4, PT was not a contracting state.

An Art. 56 attack is also possible with Annexes 3 and 2.

For the situation with the inner sheath it may be argued that the insulation may be provided on either the inner or outer surface with apparent equal effect, no particular emphasis having been placed on either one.

Claim 5 (dependent on claim 4)
Three effective dates, viz: 10.7.89 when appendent back for embodiment with just outer sheath, 04.5.89 when "inner sheath" appendent to claim 3 via claim 4 and 18.09.88 for "inner sheath" when appendent to claim 2 via claim 4.

Annex 6, although published late, allows interpretation of Ralvec ^{R} aromatic polyamide fibres, thus expanding disclosure of Annex 4. When the effective date of claim 5 is 10.7.89, Annex 4 can be used under Art. 54(3) as its disclosed parameters anticipate the claim's parameters. (See for example T666/89, T279/89; OJ Headnotes/Supplement 92.)

A weak attack would be the argument that the parameters arise from a skilled man's optimisation.

Claim 6 (dependent on claim 2: Priority 04.05.89)
The skilled person would realise that a complete covering would provide better insulation.

LEGAL POINTS [30 Marks]

1) The affidavit and article are of no use if T301/87 is followed. Subsequent publication of priority document not state of the art for an EP application based on that priority document. [N.B. see also point 16 of Examiners' comments.]

2) The posting of the information sheet does not mean it is available (T381/87) (document only public when received by addressee). [N.B. There was no indication in the client's letter that the sheet was faxed.]

3) Documents, when usable, should be filed as early as possible.

4) Consequences of non-attendance at possible oral proceedings should be explained to the client. If in spite of the client's wish, oral proceedings are requested it should be explained that an immediate adverse decision has thereby been prevented.

There are conflicting DG3 decisions on the parties' rights to be heard. It should be explained that if oral-proceedings are held and one of the parties does not attend, a decision adversely affecting the missing party may be taken at the end of the proceedings and even be based on new facts or evidence. In such a case, the losing party should file an appeal based, inter alia, on Art. 113(1).

5) Re-establishment of rights was allowed. It is no longer an issue which can be used and is not a ground for opposition.

Candidates could also refer to Art. 122(6).

6) Withdrawal of opposition in the event of agreement with patentee; Rule 60(2) EPC.

7) The request for costs should be answered with reference to Art. 104.

8) Request to bar first examiner, T261/88, G5/91.
Although Article 24 EPC applies only to members of the Boards of Appeal and of the Enlarged Board of Appeal, the requirement of impartiality applies in principle also to employees of the departments of the first instance of the EPO taking part in decision-making activities affecting the rights of any party.
There is no legal basis under the EPC for any separate appeal against an order of a director of a department of the first instance such as an Opposition Division rejecting an objection to a member of the division on the ground of suspected partiality. However, the composition of the Opposition Division may be challenged on such a ground of appeal against the final decision of the division or against an interlocutory decision under Article 106(3) EPC allowing separate appeal. Nevertheless the Representative should voice concern at the beginning of the opposition procedure.

9) Commercial success is only one indicator and as such cannot alone support inventive step. The success must also be derived from claimed technical features.

10) Interpretation of novelty in T666/89, T279/89 and when using Annex 4 against claim 5.

11) Discussion of priorities of claims, in particular claims 4 and 5. The possibility that the sheath may be only on the outer surface of the metal sheath was not in either of the priority documents and is not in the description of Annex 1. Without a file inspection it cannot therefore be determined whether this information was in the claims of Annex 1 as originally filed (in which case the claim has the filing date as its effective date and is not supported by the description - no ground for opposition), or whether the claim was introduced during examination proceedings (in which case objection arises under Art. 100(c)).

12) Copies of the GB applications were filed at the EPO and show that they were accepted, regular national filings; Art. 87 EPC. Claims need not be drafted for GB priority applications.

13) PT erroneously designated in Annex 1 and Annex 4 as PT was not a Contracting State at the time of filings.

14) Address of Opponent should be completed.

EXAMINATION COMMITTEE II

Candidate's ans.....

Report by examiner No.

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:
(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.