

Examiners' Report on Paper C/1995

Please note that all references to passages in the Annexes relate to the English version of Annex 1 and the untranslated versions of the prior art Annexes.

General

1. Marks were needlessly lost by lack of attention to the formal aspects of filing and opposition, e.g. omission of opposition fee, signature of representative, proper designation of patent to be attacked, etc.
2. Some candidates found it necessary to make reference to Art. 100(b) EPC, although this is expressly excluded by the instructions.
3. Candidates are STILL concocting additional annexes or stating that they will file further evidence later.
4. Art. 54(3) documents are sadly still being used for inventive step arguments. This is looked upon as a serious error.
5. Claim dependencies are often not properly reflected in the combination of documents used. A document brought in to attack a dependent claim is often not clearly linked to the documents used against the earlier claims. For example, if two inventive step arguments, using two different starting documents, are used against claim 1, it should be clear, when the dependent claims are being attacked, with which starting document the additional one is being combined. In addition, lack of proper thought in this respect often led to three or more documents being combined to attack a single dependent claim.
6. Quite a number of candidates realised that subject matter had been added but then wrongly took the view that because of this either the relevant claim or the patent as a whole had lost its priority date.
7. Documents continue to be used, either alone or combined, without reasoning being given.
8. Terminology is often inappropriate, e.g. reference is made to the "applicant", "refusal" is requested, claims are said to be "anticipated" when using inventive step arguments.
9. Matters belonging to the opposition proper should not be in the letter to the client. For example, it was reported to the client that subject matter had been added, but this attack was not in the answer.
10. Some candidates had prepared part of the answer prior to the examination (e.g. a sheet relating to the formal matters which then merely required the particular details to be entered). This is against the rules. Nothing may be brought into the examination other than that stipulated in the rules.
11. It is not sufficient to state that "all features of the claim are disclosed in Annex ..." (or some such similar statement) without specifying where the disclosures are particularly to be found.

12. The implication of preferred features in a claim should not be ignored.
13. Claims should be attacked singly, not in groups.
14. Often a legal point was discussed in general, but it was then not applied to the circumstances at hand. Whilst this did show awareness of decisions it also indicated an incapacity to apply the law.
15. There was often conflict between the remarks in the letter to the client and that which appeared in the notice of opposition.
16. Novelty attacks were made without specifying whether Art. 54(2) or 54(3) was intended.

Specific

1. Candidates often did not appreciate that the materials cellulose, wood pulp and cotton are not the same, even though the Annexes as a whole made this distinction clear. In this respect attention is directed to: Annex 2, page 95/C/d,e,f/9, lines 2/3 and the penultimate paragraph, 1st sentence; Annex 4, page 95/C/d,e,f/14, lines 4/5; Annex 5, page 95/C/d,e,f/16, 3rd paragraph, lines 5/6 and the corresponding passages in the translations, from all of which it should be apparent that the fibres used in Annex 3 are not the same as those used in Annex 1 and that therefore Annex 3 should not have been used in a novelty attack.

2. The fact that Annex 2 referred to Annex 3 by using the expression "incorporated by reference" was usually noticed by candidates, but it was often not appreciated that it was only the disclosure of the type of superabsorbents that was incorporated, not the whole of Annex 3, not even the weight % of the absorbents in Annex 3 could be incorporated.

It was frequently not fully explained WHY the information from Annex 3 could be incorporated.

3. Some candidates incorrectly thought that the opposition could be filed in Swedish as the representative was Swedish, whilst others, who correctly realised that Gaelic could be used, did not consider that the translation costs could make the opposition more expensive overall.
4. The feature of claim 3, Annex 1 was to be found reversed in Annex 3. It was often not argued why one should consider the arrangements as equivalent or why one would change the arrangement in Annex 3.
5. The "Dependency/Independency" of claims 4 and 5 was often not appreciated. Furthermore, many candidates, when attacking claim 4 with Annex 5 did not notice that the Annex did not disclose the heating. This feature was to be found in Annex 3. Many candidates did not see that the required positioning of the nozzle could be found mentioned as a conventional aspect in Annex 1.
6. Although claims were often correctly attacked under Art. 123 EPC, few raised Art. 123(2) objection against the description.

Model Solution for Paper C/1995

Legal Points (25 Marks)

1. An opposition filed by an acquired company may be taken over by the acquiring company. Oppositions may be inherited or succeeded to as part of an overall succession in law. - G4/88; Rule 60(2).
2. In claim 2 the feature 60% wt. was added, whereas only the general term "most" was originally disclosed.

The argument that the amendment of claim 2 is based on the drawing is not acceptable - T 523/88.

The problem could be overcome by deleting claim 2.

Independent method claim 4 implicitly contains the added feature due to its inclusion of the features of claim 3, which in turn depends on claim 2. Claim 4 cannot be amended by changing the dependency; therefore claim 4 has to be deleted.

Extra marks were awarded to candidates who considered the consequences of deleting claim 2 upon the validity of claims 3 and 4. Discussion of G1/93 was expected.

3. Correction of errors - G11/91; G3/89.

According to the decision the priority document can no longer be used as a basis for the correction under Rule 88. In this case it cannot be considered obvious to substitute the term polypropylene for polyethylene disregarding the priority document. Discussion of obvious errors was expected. The expression "such as non-woven polypropylene fabric" can simply be deleted to overcome the Art. 123(2) objection (see also Guidelines CVI, 5.4).

4. Although the Opponent allegedly viewed the claimed product prior to the filing date of the patent, he was not able to analyse it or to ascertain how it could be reproduced. Thus it should be explained to the client that the product as claimed was not made available.
5. The secrecy agreement was binding at the time of filing. This evidence cannot be used.
6. An Opposition Division is not obliged to consider new grounds for Opposition referred to under Art. 100 - G10/91.

The Opposition Division shall examine such late-filed grounds only where prima facie there are clear reasons to believe such grounds are relevant and would in whole or in part prejudice the maintenance of the European patent.

A good answer would also have noted that fresh grounds for opposition may be considered in appeal proceedings only with the approval of the Patentee.

7. The "incorporated by reference" of Annex 3 in Annex 2 enables the content of Annex 3 to be included in Annex 2 only insofar as a disclosure of SAPs. Discussion of T689/90 and Guidelines CII, 4.18; CIV, 7.1.

8. Comparison of designated states of Annex 1 and Annex 2.

Use of information (40 Marks) and Argumentation (35 Marks)

Description

Art. 123(2):

60% wt. of particles and polypropylene at page 95/C/e/5, penultimate paragraph, 2nd line and last paragraph, last sentence.

Claim 1:

Art. 54(3):

Annex 2, priority date 30.04.1990; filing date 21.03.1991; published on 30.10.1991, used under Art. 54(3) for all states apart from DK, ES, GR.

Annex 2 discloses an absorbent composite, which implicitly has a top face and a back face (small flat flexible packages) comprising hydrophilic fibres and a hydrogel (see claim 1 as well as page 95/C/d,e,f/9, last paragraph, last sentence). The fibres can be wood pulp (see page 95/C/d,e,f/9, penultimate paragraph, lines 1/2). The hydrogel is present in amounts 5 to 8% which falls within the claim range of 3 to 50%.

Although it is explicitly disclosed in Annex 1 that silica gel and polysaccharides are not superabsorbents (the suggested hydrogel-forming compounds on page 95/C/d,e,f/9, lines 1/3 of Annex 2), since the passage relating to SAPs in Annex 3 is incorporated by reference into Annex 2 and this explicitly mentions the SAPs indicated in the description of Annex 1, it is clear that these are included in the disclosure of Annex 2.

Annex 3 is not considered to be novelty destroying. It is clear from the documents provided that cotton fibres are not identical to wood pulp fibres (see also Examiners' Report, point 1 under "Specific"). Marks were however awarded if Annex 3 had nevertheless been used in a logical manner and thereafter consistently for the remaining claims.

Annex 5 is not considered to be novelty destroying since there is no disclosure of an embodiment containing SAPs.

Art. 56:

Using Annex 3 as the closest prior art:-

Annex 3 discloses an absorbent article comprising cotton fibres and a hydrogel. Claim 1 lacks an inventive step over Annex 3 as wood pulp fibres can be regarded as an alternative to cotton fibres, both containing cellulose as a main component. (For non-chemists there is an indication in Annex 2, page 95/C/d,e,f/9, lines 3 and 4, that cotton and wood pulp fibres can be considered as conventional, interchangeable alternative materials). The hydrogel is a superabsorbent. The amount of hydrogel is at most 50 wt. %.

An alternative approach can be with Annex 5:-

Annex 5 disclosed the combination of wood pulp fibres with hydrogel particles. Annex 5 suggests superabsorbents albeit linked to a commercial prejudice. A line of argument could be that the cost of manufacturing superabsorbents has reduced in the meantime (filing date of Annex 5 is 1985). Although more than 50 wt. % of hydrogel-forming material is used this is only a preferred feature. In any case the skilled person would use a smaller amount of SAPs than ordinary hydrogel, SAPs being more efficient.

Claim 2:

Art. 123(2):

Objection due to amendment 60% wt.

Art. 56:

Annex 5 discloses the concept of placing the hydrogel particles in the back part of the article in order to keep moisture away from the body.

Annex 5 discloses that the hydrogel content of the back half of the article should be at least 1.5 times the hydrogel content of the top half, which is at least 60%.

Claim 3

Art. 123(2):

Objection as this claim is dependent on claim 2.

Art. 56:

Annex 3 discloses the problem of settling of particles and that the fibres can be fixed onto the hydrogel particles by heating. This can be applied to the problem of fixing the particles so that they remain in the distribution indicated in claim 2 even though the particles are coated onto the fibres. This should be combined with Annex 5 owing to its dependency on claim 2.

Claim 4

Art. 123(2):

Objection owing to incorporation of claim 3, which depends on claim 2.

Art. 56:

The method of making the structure has to be attacked using Annex 5, which discloses the mixing of fibres and hydrogel in a drum, this being conventional, in combination with Annex 3, which, although it discloses heating the hydrogel-forming compound rather than having a hot air stream of fibres the same object is achieved, namely that the compound

sticks to the fibres. The adjustment of the nozzle position is non-inventive if one wants to obtain the distribution of particles in Annex 5. This is also known from Annex 1, see Example.

Claim 5

Art. 54(3)

The term "in particular" is not limiting.

Annex 2 can be used against claim 5. Annex 2 discloses on page 95/C/d,e,f/9, last paragraph, 1st sentence, that the absorbent composite is packed into containers insoluble in the liquid to be absorbed.

Art. 56:

Possible attacks use Annex 3 or Annex 5.

Annex 3 discloses a diaper and Annex 5 discloses a package for absorbing body liquids containing an absorbent structure which renders the claimed absorbent structure un inventive, thus the spillage absorption package or the diaper are also not inventive in the light of Annex 3 or 5. The insolubility of the sheets is implicit for the packages to function as diapers/sanitary articles.

Claim 6

Art. 123(2):

Objection due to term "polypropylene".

Even though this is only an example, an objection should be raised against "polypropylene fabric".

Art. 56:

Annex 5 should be used for inventive step.

The disclosure of pervious/impervious sheets is to be found on page 95/C/d,e,f/9, 3rd paragraph, 1st sentence.

Argumentation should have been consistent with that used for claims upon which claim 6 depends.

EXAMINATION COMMITTEE II

Candidate No.

Paper C Schedule of marks

Category	Maximum possible	Marks awarded		Revision of marks / grade (if any)	
		Exr	Exr	Exr	Exr
Use of information	40				
Legal aspects	25				
Argumentation	35				
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

Marking of further examiners when grades awarded are different or required by at least one 7

	Use	Legal	Arg.	Total	Grade
Exr					
Exr					

Remarks which must be given 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 marks are revised, brief explanation should be given.

Grade recommended to Board _____