

Examiners' Report on Paper C/1997

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. A number of candidates are still under the impression that there is a link between added subject-matter and priority. No relevant date (priority or filing date) can be allocated to subject-matter which was added after the filing date.

Added subject-matter does not affect the date allocated to the remaining part of a claim so as to permit arguments based on documents made available after that date.

2. Candidates are still showing an inconsistent approach in that in the letter to the client it is indicated that an attack will be made, but then this is not actually carried out in the Notice of Opposition.
3. It should be understood that Article 123(2) applies to the patent as a whole, not just the claims. A number of candidates omitted to raise an objection under Article 123(2) against the description as they believed that this was unimportant or not possible.
4. In the absence of contrary indications, it is important that the information given in the letter from the client should be accepted. Failure to do so can result in relevant documents being discarded and many marks needlessly lost.
5. Many candidates still have difficulties in distinguishing independent claims from dependent claims.
6. Attacks on dependent claims using Article 54(3) documents cannot succeed if no such attack has been carried out on claims to which these claims refer.

Specific

Legal:

- i. Candidates who chose Aspirino as the opponent, but actually named Medicon as the opponent, should be aware that this is inappropriate given that Medicon had given no instruction to file an opposition.

- ii. Some candidates argued that the private address of Aspirino was required. However, a business address is sufficient (see Rules 55(a) and 26(c) EPC).
- iii. Candidates who made an attack against claim 1 under Article 123(2), but who indicated why they thought this attack was weak were not penalised.
- iv. The information about the certificate of exhibition not being in the file was often ignored so that an attack using the exhibition in Seville was not possible against claim 6.
- v. Whilst many candidates indicated a number of decisions referring to the "man of straw" situation, very few actually discussed the implications of these decisions for the question in the paper.
- vi. A number of candidates either ignored the information given by the client regarding Annex 5 or were under the impression that evidence could not be filed at a later date. Annex 5 should be used as it was most probable that it was available the day before the cover date ("It is **known** that the issues of the journal "Painting" are available at the reception desk.."). However, the candidate should have indicated that further evidence was necessary such as an affidavit of the publisher or a witness confirming the date of availability. Candidates who failed to use Annex 5 because of uncertainty concerning when it was made available missed an opportunity for a strong inventive step attack.

Claims:

- 1. Many candidates did not realise that in Annex 4 the crank handle (3) was not the handle of the roller so that a combination with Annex 6 was unlikely in view of the modifications that are necessary.
- 2. The dependencies of claim 4 were often ignored.
- 3. Many candidates did not appreciate that claim 5 was an independent claim and that the roller used was considered to be conventional (annex 1, page 2) so that a novelty attack should have been made.

Whilst not all attacks feature in the possible solution, marks were awarded for weaker attacks, provided there was proper reasoning.

Possible solution

Legal points¹

1. The feature "*rotating at high speed*" is disclosed implicitly on page 1, line 31 of the description "*for connection to a drive motor, e.g. a portable drill*" and explicitly on page 2, line 6 "*The roller is spun with the aid of a high speed drive motor...*". Thus, Art.123(2) EPC is not infringed.
2. The drawings of the exhibit bear a stamp referring to a contract number (CR-92-2). Drawings handed over whilst under contract are to be interpreted as being confidential and thus not prior art; see T830/90. The employees of the opponent would be bound by the same obligation of confidence under their terms of employment.
3. An invention which has been displayed at an official, or officially recognized, international exhibition no earlier than 6 months before the filing of the European patent application is not prejudicial to novelty (Art.55 EPC), provided that this is indicated on filing (Art. 55(2) EPC) and that a certificate of the exhibition is also filed within four months of the filing date (Art. 55(2) and Rule 23 EPC). In this case these requirements are not complied with (see client's letter, "*...not recorded in the file...*"). Therefore, the apparatus displayed at Seville is prior art in the sense of Art. 54(2) EPC for the subject-matter having the filing date as effective date, i.e. claim 6 (see G 3/93). Prior use evidence should be provided to show that all parts of the apparatus could be inspected. This can be filed after the opposition period.
4. A representative is not allowed to act as an opponent in his own name, when in reality he acts for an undisclosed client; Art. 99 EPC; T10/82. Decision T10/82 indicated that "any person" in the EPC provisions relating to the naming of the opponent means the person who is the true opponent, not someone who is merely representing the interests of the true opponent such as a professional representative. The Board of Appeal held that there should be no confusion as to the respective roles as professional representatives and clients; otherwise the opposition would not comply with Rule 55(a) and (d) EPC and would be inadmissible.
5. Opposition in the name of Mr. Aspirino? Art. 99(1) EPC

The candidate could either file an opposition in the name of Fratelli Tempera or in the name of Mr. Aspirino.

If the candidate chose to file an opposition in the name of the true opponent, he should have argued that, although any legal person can file an opposition and does not need to have an interest, he must be acting in his own name and not on behalf of some other unnamed party

(T635/88). An opposition filed by a "man of straw" is in principle inadmissible, since the straw is no real third party. Deliberate concealment of the opponent's identity amounts to non-compliance with Article 99, Rule 55(a) EPC (as well as lack of good faith) (T25/85), and renders the opposition inadmissible because the proprietor (as well as the EPO) is entitled to know without doubt the real opponent's identity. Therefore, it is on the safer side to file the opposition in the name of Fratelli Tempera.

If the candidate decided to follow the client's instructions for anonymity and filed an opposition in the name of Mr. Aspirino, he should have argued that the EPC does not require a "legitimate interest" for an opposition to be admissible, the relevant provision merely referring to "any person". Therefore, even a person who has no specific interest in the technical field involved can file an opposition in his own name. The absence of any such specific interest does not in itself cast sufficient doubt on the fact that the named opponent acts for himself. Indeed, according to more recent decisions of the Boards of Appeal (T590/93, T289/91 and T548/91), there have to be concrete reasons to assume that the named opponent acts for identifiable third persons. Although Mr. Aspirino works for a pharmaceutical firm and thus has probably no commercial interest in the claimed apparatus, this does not yet prove that he is a straw-man. However, the representative should advise the client that the use of a straw-man may be risky because the straw-man can withdraw the opposition at any time. Furthermore, should the patentee succeed in demonstrating that Aspirino is indeed a straw-man this would lead to the opposition being declared inadmissible.

This question of law has since been referred to the Enlarged Board of Appeal (see referral decisions T 649/92 and T 301/95).

6. Evidence should be sought, e.g. affidavit of publisher or witness, for prior availability of Annex 5. Evidence can be sent after the opposition period. The client's letter clearly points out that the journal "Painting" is known to be available at the reception desk before the cover date, assuming that there were no delays in printing a particular issue (see T 729/91 and T 381/87).
7. Cite Contracting States in Annexes 2 and 3 identical to those in Annex 1.

Use of Information and Argumentation²

1. **Description:** The amendment on page 2, i.e. 500-800 rpm, infringes Art. 123(2) EPC. The range 500-800 rpm constitutes a selection which is not clearly and unambiguously disclosed in the application as filed.

2. **Claim 1 (20.03.92), independent:**

Art. 54(3) EPC for AT, CH, DE, FR, GB, LI and LU based on Annex 2. The apparatus of Annex 2 has an elongate housing, a drive shaft (10) carrying a drive head (6). The housing is provided with closure means (mating grooves/projections 8) containing an opening for receiving the roller handle (passage 5). The motor mentioned in Annex 2 is suitable for rotating the roller at high speed for cleaning purposes. In the given context, motor-powered rotation can be regarded as high speed rotation.

Art. 54(3) EPC for DE, ES, IT, NL and SE based on Annex 3. The apparatus of Annex 3 has an elongate housing (1), a drive shaft (11) carrying a drive head (10). The housing is provided with closure means (door 5) containing an opening for receiving the roller handle (notches 3a,3b). High speed is mentioned on page 1, line 34: "... mit hoher Geschwindigkeit..."

Art.56 EPC: The apparatus of Annex 6 has all the features of that of claim 1 with the exception of closure means containing an opening for receiving the handle. Starting from Annex 6, the skilled person would try to avoid paint or solvent splashes by providing closure means on the handle side as known from Annex 5 (cap 4).

Art. 56 EPC: The apparatus of Annex 5 has all the features of that of claim 1 with the exception of a drive shaft carrying a drive head for driving engagement with one end of the roller. Starting from Annex 5, the skilled person would try to improve cleaning by rotating the roller. Annex 6 teaches the use of a drilling machine.

3. **Claim 2 (20.03.92), dependent on claim 1:**

Art. 54(3) EPC, for DE, ES, IT, NL and SE based on Annex 3 which shows a separate end member (8) which carries the drive shaft (11).

Art. 56 EPC: Annexes 6 and 5 or Annexes 5 and 6 as for claim 1. In Annex 6 the drive shaft of the "Gripper" 4 passes through the end-member 1b which is separately formed from the housing (see Fig 1 as well as page 1, lines 29-31: "*Preferably it is made of two pieces 1a, 1b...*").

4. **Claim 3 (20.03.92), dependent on claim 1:**

Art. 54(3) EPC, for AT, CH, DE, FR, GB and LU based on Annex 2 which shows closure means formed integrally with the housing and including drain passage (3).

5. **Claim 4 (20.03.92), dependent on claim 2 or 3:**

When appended to claim 2:

Art. 54(3) EPC, for DE, ES, IT, NL and SE based on Annex 3 which shows a frusto-conical drive head (10).

Art. 56 EPC as for claim 2, whereby Annex 5 discloses a truncated cone to support the roller.

6. **Claim 5 (20.03.92), independent, referring to claim 4:**

Art. 54(2) EPC in view of the rollers disclosed in Annex 5 (fig. 1). In addition, said rollers are known to be conventional from Annex 3 (fig.3) and Annex 1 (see, page 2, line 10 "*...intended for cleaning conventional paint rollers mounted on a handle...*" as well as fig.1)

7. **Claim 6 (10.03.93), dependent on claim 1:**

Art. 56 EPC: Claim 6 does not enjoy the right to priority (see client's letter). Thus, the effective date of claim 6 is the filing date. The apparatus displayed at the exhibition in Seville (shown in the Exhibit) is prior art for the subject matter of claim 6 (see legal). The apparatus exhibited in Seville, except for a unitary end-member 3, shows all the features of claim 6, in particular the fins. However, the missing feature can be derived from Annex 6, wherein in one embodiment (not shown) the end member 1b is unitary with the housing ("*The housing 1 can be made from one piece*").

Art. 56 EPC: Since Claim 6 has the filing date as relevant date, Annex 2 published on 23.02.1993 is prior art for this subject-matter. Starting from Annex 2, the only difference between the apparatus of Annex 2 and the claimed one are the fins. However, this feature can be derived from the apparatus shown at the exhibition in Seville (see Exhibit).

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				
Argumentation	40				
Legal aspects	20				
Total	100				
Corresponding Grade					

Translation of marks into grades

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

Marking by further examiners when grades awarded are different

	Use of Information	Legal Aspects	Argumentation	Total	Grade
Examiner					
Examiner					

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, a brief explanation should be given.

Grade recommended to Board _____

Munich, 3 July 1997

P. Uem

Chairman of Examination Committee II