

Please note that all the references to passages in the annexes relate to the English version of Annexes, not the original versions (i.e. untranslated) of the prior art annexes.

GENERAL

1. Candidates should refrain from answering or commenting on questions which do not exist, for example discussing 123(2). Marks are not awarded for showing knowledge of an aspect which is not relevant to the paper. The impression is gained that candidates wish to show that they have learned from past papers. This only wastes time.
2. Specific questions in the client's letter were often left unanswered or misinterpreted; care should be taken when reading the client's letter.
3. When a document has been used for a novelty attack against a claim, it should not then be used against the same claim for attacking inventive step, unless there is genuine doubt over the interpretation of the document (which should be explained), because this only shows uncertainty by the candidate. Further the candidate will have lost time on a weaker attack.
4. When reversing a combination of documents for an inventive step attack, or more generally when building a second inventive step attack against the same claim, the candidate should indicate in the problem-solution approach why suddenly another document should be considered as the closest prior art and what is the alternative problem addressed in the second attack.
5. The combination of documents without argumentation should be avoided. A mere indication that it is obvious to combine the teachings of Annex 2 with Annex 3 is definitely not sufficient. The candidates should use the "problem-solution approach" where appropriate. Whilst another argumentation could be accepted, it may not lead to full marks.
6. When arguing against inventive step the candidates should rely on the information which is disclosed in the examination documents, i.e. client's letter and annexes. In particular, the candidates should avoid relying on common general knowledge, using their own technical knowledge or referring to the knowledge of the person skilled in the art.
7. A "shotgun" approach achieved by combining documents in all possible ways should be avoided.
8. Candidates should pay more attention to the dependency links between the claims. This issue has often been disregarded which leads to poor argumentation and to mistakes which could have been easily avoided. For example in this year's paper:
 - claim 3 was dependent on either claim 2 or claim 1, therefore a global attack against claim 3 would not be successful while a separate attack for each situation, namely one for the combination of claims 1, 2 and 3 and another one for the combination of claims 1 and 3, would be the correct approach;
 - claim 8 was dependent on claim 1, for this reason it was not sufficient only to mention that the additional feature of claim 8 relate to an aesthetic effect without addressing the features of claim 1.

9. Some candidates have attempted to save time by listing the features defined in the claim, identifying them with reference signs, e.g. letters or numerals, and then using these references instead of repeating the features in the notice of opposition. It seems that this practice leads to poor argumentation and can be confusing both for the candidates and the examiners without any real benefit in saving time.
10. The use of the form 2003 is highly recommended since this does save time and candidates are less likely to miss some formal requirements.
11. In answering the questions posed in the client's letter, candidates should:
 - indicate what is the relevant statement of law, e.g. by indicating the relevant articles, rules, Guidelines or decisions of the Board of Appeal,
 - apply the law in the corresponding context and
 - not forget to answer the question, e.g. by indicating what is the legal situation and/or advising the client about what should be done.

Often the candidates correctly discuss the pro and contra of an issue, but do not finally decide on the course of action.

12. If a passage of the Guidelines or a decision of the Boards of Appeal applies, then it is worth referring directly to it, instead of writing a long explanation of the law, because it is a good hint for the marker that the candidate has understood the question. It saves also time.
Often deficiencies have been noticed in the knowledge of the Guidelines. A good preparation for paper C includes an intensive study of the Guidelines, in particular parts C and D.
13. Once more it has been observed that candidates often ran out of time. It is important not to waste time on trivial details, imaginary questions or a cascade of weak attacks. Candidates should concentrate on the legal questions which are directly derivable from the client's letter and on the strongest attacks so as to ensure that time is available for all claims.
14. Candidates should avoid repeating answers in the letter to the client already set out in the notice of opposition. Repetition costs time. The candidates should make a clear distinction between the notice of opposition and the answer to the client and be careful about what belongs to which part.

SPECIFIC

LEGAL ISSUES

1. Priority

Often the candidates have dealt with this issue by only listing the valid priority dates for each claim. Although this alone obtained marks, it was not sufficient for full marks as the basis behind the priority determinations was also required. The mere repetition of the information given in the client's letter without suitable comment was not awarded marks and was a waste of time.

2. Article 54(3) EPC

Often this issue was ignored, whilst some of the candidates answered by merely referring to Article 158 without further explanation. This was not sufficient for getting full marks for this point.

3. Relevancy of the sworn statement

- a) For attacking claim 4 very few candidates addressed the issue of the intended use of the clear sheet either in the answer to the client or in the notice of opposition. This showed deficiencies in the candidates' knowledge of the European practice for interpreting claims when assessing the patentability.
- b) A large number of candidates gave good answers concerning the issue of "disclosure by selling", citing and implementing correctly G1/92.

4. Lecture of Mr. Tsujifu

The candidates who managed to address this issue usually answered correctly. Some omitted to mention that evidence should be sought for supporting the oral disclosure, e.g. providing a witness, as it was the oral disclosure, not the written reproduction of it, which was critical.

5. Aesthetic creations

Candidates should accept the information given in the examination documents and not ignore it. For example, some candidates told their client that they would not object that the subject matter of claim 8 was related to an aesthetic creation. This was contrary to the clear hints given in the client's letter for an attack based on Article 52(2)(b).

NOTICE OF OPPOSITION .

Evidence

The report published in "MORE THAN BITS" was not made available as an Annex on purpose. The candidates should have explicitly indicated in the notice of opposition that a copy of this report would be filed later in order to ensure that this piece of prior art could be considered in the opposition. The most complete answers included an additional proposal to provide a witness.

Claims

Claim 1: It is very important, in particular when attacking novelty, to indicate precisely where the features defined in the claims can be found in the selected document, i.e. by indicating page and line numbers. A mere indication of the drawings is not sufficient, especially for features which cannot be derived directly from the figures. For example, the spot welds were disclosed in Annex 2, p. 32, l. 34. The drawings of Annex 2 did not directly disclose this feature.

Some of the candidates, having used Annex 4 as prior art according to Article 54(3), forgot to mention Article 54(4) and which states are commonly designated in the opposed patent and Annex 4.

Claim 2: Often, it was correctly assessed that claim 2 could only benefit from the filing date. However, some candidates did not consider the corresponding consequences for the prior art and forgot to use Annex 6 and/or did not realise that Annex 4 was prior art according to Article 54(2) and no longer according to Article 54(3).

Candidates often used the combination of Annex 2 and Annex 3 for attacking inventive step, disregarding thereby the negative statement in Annex 2 about welding around the indexing hole.

Claim 3: Many candidates attacked claim 3 globally without distinguishing the different combinations of features resulting from the different dependencies of claim 3. For this reason, they were not able to correctly assess the priority dates and, as a consequence, to raise the relevant attacks.

a) Claim 3 dependent on claim 1:

A combination of Annex 2 and Annex 3 was also accepted.

Some candidates attacked novelty using Annex 2 or Annex 4. However, neither Annex 2 nor Annex 4 disclosed "continuous linear welds".

b) Claim 3 when dependent on claim 2:

An inventive step attack supported by a combination using Annex 2 was not correct because this was based on hindsight (see claim 2 above).

Claim 4: a) Novelty attack based on Annex 5

Claim 4 related to a cleaning sheet for use in a floppy disk, therefore a good argumentation necessarily should include a statement about the intended uses of the cleaning sheet defined in claim 4 and that in Annex 5.

An inventive step attack based on Annex 5 was not correct as from the information given in the Annexes it was not possible to derive any feature implied by the intended use which could have differentiated the cleaning sheet of claim 4 from the fabric of Annex 5.

b) Inventive step attack based on Annex 4

Some candidates argued that Annex 4 was novelty destroying. This was not correct. Annex 4 disclosed a binding resin soluble in an organic solvent, while claim 4 defines a water-soluble binding resin. As, according to Annex 1, both binding resins were well-known equivalents the issue was a matter of obviousness (cf. Guidelines C-IV, 7.2, last sentence).

Claim 5: For the novelty attack based on Annex 5 a mere reference to the range of 4% to 10% disclosed in Annex 5 was not sufficient. A discussion concerning the relevancy of the disclosed range to the claimed sub-range was required.

Claim 6: In the same way as mentioned above for claim 4 with regard to intended use, a statement was expected about the relevancy of the process steps defined in claim 6 when arguing against the novelty of the cleaning sheet.

Claim 7: Surprisingly, some candidates argued that the subject matter of claim 7 contravened Article 123(2). This wasted time as nothing was said in the client's letter which could lead to this conclusion.

Mainly due to a lack of consistency some candidates made mistakes when dealing with claim 7 although they correctly attacked claims 1 and 4.

Claim 8: Some candidates attacked claim 8 under Article 56, ignoring the last statement in the client's letter.

Often candidates ignored the fact that aesthetic creations are only excluded if claimed as such (Article 52(3)), and were silent about the features of claim 1 upon which claim 8 depends.

N.B.: It should be noted that for correct novelty attacks and merely stating the priority/effective dates of the claims, a total of 44 marks could be obtained!

POSSIBLE SOLUTION FOR PAPER C

LEGAL ISSUES

(17 points)

1. Priority

a) Multiple priorities see Art. 88(2) and (3), G3/93 and Guidelines C-V, 1.5.

When a European patent application is based on a first earlier application disclosing C and a second earlier application disclosing D, neither disclosing the combination of C and D, a claim for C will enjoy the first priority date and a claim for D will enjoy the second priority date. However a claim for C+D will be entitled only to the date of filing.

Consequently:

- claims 1 and claim 3, when appended directly to claim 1, enjoy the first priority date, namely 19.07.93,
- claims 4 to 6 enjoy the second priority date, namely 20.01.94, and
- claim 7, which defines a combination of the features of claims 1 and 4, benefits only from the filing date, namely 11.07.94.

b) Conformity of the claimed subject matter with the content of the priority document see Guidelines C-V, 2.4:

The basic test for determining whether a claim is entitled to a priority date is the same test as for assessing whether an amendment to an application satisfies the requirements of Art. 123(2).

Consequently, as the additional features of claims 2 and 8 are not mentioned in any of the priority documents, claim 2, claim 3, when appended to claim 2, and claim 8 are not entitled to any priority date, but take only the filing date, namely 11.07.94.

In this case, it cannot be alleged that the additional features of claims 2 and 8 are not essential (T73/88) because a contribution over the prior art for said claims can only be seen in these features as the features of claim 1, on which claims 2 and 8 depend, are anticipated.

2. Article 54(3) EPC

A PCT application can be incorporated in the state of the art according to Art. 54(3) EPC as an European patent application if the following requirements are met:

- Art. 158(1) EPC: the EPO should be designated in the international application;
- Art. 158(2), 1st sentence: the international application should have been supplied to the EPO in one of the official languages; and
- Art. 158(2), 2nd sentence: the national fee required by Art. 22(1) or 39(1) PCT should have been paid, namely the fees required in Rule 104b(1)(b) EPC (i) national basic fee (equal to filing fee) and (ii) designations fees.

Hence, Annex 4 is probably prior art according to Art. 54(3) against the claims enjoying the first priority date. For full certainty, the payment of the national fee should be checked later.

3. Relevancy of the sworn statement

a) According to C-IV, 7.6, a claim for a substance or a product X for a specific use would be anticipated by the same substance or product known for a different use, unless the specific use implies a particular feature for the product (see also C-III, 4.8). In the light of the information presently available, the use of the cleaning sheet as a liner for a floppy disc does not imply any physical feature which could distinguish the cleaning sheet of the patent from the one sold to SAKAY SA and described in Annex 5. Thus Annex 5 is very relevant for attacking the claims relating to the cleaning sheet alone.

- b) According to G1/92, the sale of a product represents a disclosure of all its intrinsic features, including its composition. There is no need for any motivation to analyse a product to compare its composition of a sold product as disclosed. However, the sale should not have been made under a confidentiality clause. In the present case, there is no reason to assume that the sale was not open to public. For these reasons, the cleaning fabric described in Annex 5 was made available to the public.

4. Oral disclosure

- a) According to C-IV, 5.2 when an oral disclosure, e.g. a lecture, made before the priority or the filing date of an application is followed by a written document reproducing the content of the oral disclosure, but published after said priority or filing date, as in the present case, then although the written document is considered to be an account of the oral disclosure, it is the oral disclosure which is part of the state of the art. Further see D-V, 3.2.3 for the matters to be determined in case of oral disclosure.
- b) Evidence, e.g. a witness, should be provided in order to support the oral disclosure.

5. Aesthetic creations

The subject matter of claim 8 falls within the exclusion of Art. 52(2)(b) "aesthetic creation". This is confirmed in T119/88 (FUJITSU), which relates to a similar situation. A corresponding objection should be raised.

NOTICE OF OPPOSITION

(Use of information: 40 points / Argumentation: 43 points)

EVIDENCE

The copy of the report published in "More than bits" will be sent later as evidence for supporting the oral disclosure. If required a witness could be provided as well.

This piece of prior art will be referenced as Annex 6 (A6) in the following.

OBJECTIONS ACCORDING TO ART. 100(a)

1. **Independent claim 1:** benefits from the priority date 19.07.93

a) **Art. 54(1), (3) and (4):** the subject-matter of claim 1 is not novel with respect to A4 for all Contracting States designated in common in A4 and in A1, namely CH, DE, FR, GB and LU.

A4 discloses: a floppy disc comprising a cover jacket, a magnetic recording disc (p. 40, l. 1-2) and a cleaning sheet (p. 40, l. 4), wherein said cleaning sheet is attached by welded portions comprising a plurality of spot welds (p. 40, l. 27) formed around peripheral portions of a central window and an elongated aperture (p. 40, l. 30-31).

b) **Art 54(1) and (2):** the subject-matter of claim 1 is not novel with respect to A2.

A2 discloses: a floppy disc (p. 32, l. 1) comprising a cover jacket (p. 32, l. 20), a magnetic recording disc (p. 32, l. 1) and a cleaning sheet (p. 32, l. 1-2), wherein said cleaning sheet is attached by welded portions (p. 32, l. 19), said welded portions comprise a plurality of spot welds ("dots or small dashes" p. 32, l. 33-35) formed around peripheral portions of a central window and an elongated aperture (p. 32, l. 22-23 and fig. 1, ref. 4 and 22).

2. Claim 2 which depends on claim 1: can only benefit from the filing date 11.07.94

a) Art 54(1) and (2): A6, which is prior art according to Art. 54(2) with respect to claim 2, discloses all the features of claims 1 and 2 (cf. opponent's letter).

b) Art. 56: the subject-matter of claim 2 differs from the content of A4 (which is closest prior art according to Art. 54(2) with respect to claim 2, cf. point 1.a above) only in that "the welding portions are also provided in the area upstream of an indexing window with respect to the disc rotation". Therefore, the objective problem may be seen in avoiding fluffing of the non-woven fabric at the indexing window. A3, p. 36, l. 35-36 already addresses this problem.

Furthermore, A3, p. 36, l. 36-37 also discloses the additional feature of claim 2 because according to the wording of claim 2, the welding portions around the indexing windows are not restricted to the area upstream of the indexing windows with respect to the disc rotation. They are at least present in this area, so that all around the indexing hole anticipates this feature.

3. Claim 3 dependent on either claim 1 or claim 2

a) Claim 3 dependent on claim 1: benefits from the priority date 19.07.93

Art. 56: the subject matter of claim 3 when taken in combination with claim 1 differs from the content of A2 (cf. above for claim 1) only in that the welding portions of claim 3 further comprise a plurality of continuous lines extending across the cover jacket and which are parallel to the longitudinal axis of said cover jacket.

The objective problem may be seen in improving the binding between the jacket and the cleaning sheet. The prior art of A1, p. 21, l. 10-11 discloses that the differing features of claim 3 are usual for attaching the cleaning sheet to the jacket. Thus it would be obvious for the skilled person to combine this teaching with A2.

b) Claim 3 dependent on claim 2: benefits only from the filing date 11.07.94

Art 54(1) and (2): A6 discloses all the features of claims 1, 2 and 3 (see point 2 above).

Art. 56: The combination of the features defined in claims 1 and 2 is obvious with respect to A4 and A3 as shown in point 2 above. Furthermore, the additional feature of claim 3 is a matter of normal practice, cf. prior art cited in A1, p. 21, l. 10-11. Consequently the combination of the features of claims 1, 2 and 3 should be seen as the juxtaposition of obvious features.

4. Independent claim 4: benefits from the priority date 20.01.94

a) Art. 54(1) and (2): A5, which is a prior use anticipating claim 4, discloses a cleaning sheet (p. 43, l. 5-6) made of a non-woven fabric (p. 43, l. 12) containing thermoplastic fibres and non-thermoplastic fibres (p. 43, l. 13-14), wherein said non-woven fabric has a structure which is maintained through thermocompression-bonded portions (p. 43, l. 14-17), and wherein said non-woven fabric is provided with a water soluble binding resin (p. 43, l. 20-22). The indication of the intended use of the fabric as a liner in a floppy disc defined in claim 4 should be interpreted as "suitable for being used as" and in this case it does not imply any limiting technical feature for the fabric which could differentiate the fabric of claim 4 from the one disclosed in A5.

b) Art. 56: the subject-matter of claim 4 differs from the content of A4, p. 40, l. 34-35 and l. 38-39 only in that the binding resin is water soluble. A4 discloses the use of a resin soluble in an organic solvent. However, a water soluble resin is a well-known equivalent to a resin soluble in an organic solvent, as confirmed in A1, p. 22, l. 42-43.

5. Claim 5 which depends on claim 4: benefits from the priority date 20.01.94

a) Art. 54(1) and (2): A5, which discloses already all the features defined in claim 4 (see point 4.a above), discloses further that the fabric has a proportion of binding resin comprised in the range of 4

to 10 % (p. 43, l. 27-30), while claim 5 defines a sub-range of 6 to 8%. However, the subject-matter of claim 5 cannot be seen as a selection invention with respect to A5 because the sub-range is narrower with respect to the broader known range and there is no purposive selection as the achieved technical effect is similar in both ranges.

b) Art. 56: the subject-matter of claim 4 is already obvious with respect to A4 (see point 4.b above). Furthermore A4 discloses a proportion of binding resin of 7% (p. 40, l. 38-39) which falls within the range defined in claim 4 so that the additional feature of claim 5 cannot contribute to an inventive step.

6. Claim 6 dependent on claim 5: benefits from the priority date 20.01.94

a) Art. 54(1) and (2): A5 discloses already all the features defined in claims 4 and 5 (see point 5.a above). Hence claim 6 differs from A5 rather in steps of a manufacturing method than in technical features defining a liner. However, as claim 6 relates to a product, the cleaning sheet defined in claim 6 can be seen as novel only if it is novel per se. The manufacturing steps defined in claim 6 do not imply further physical features of the claimed product. Thus, A5 also destroys the novelty of the subject-matter of claim 6.

b) Art. 56: the subject-matter of claim 5 is already obvious with respect to A4 (see point 5 above). Furthermore, A4 discloses a product made in the same manner as required by the manufacturing steps defined in claim 6 (cf. p. 40, l. 37-38). Consequently the subject matter of claim 6 does not involve an inventive step for the same reasons as claim 5.

7. Claim 7: benefits only from the filing date 11.07.94

a) Art. 54(1) and (2): Claim 7 is dependent on claim 1 and defines as additional features the features of claim 4. A6 discloses all the features of claims 1 and 4 (cf. opponent's letter).

b) Art. 56: A4, which is prior art according to Art. 54(2) for claim 7, already discloses all the features of claim 1 (see point 1.a above). Additionally, the combination of features defined in claim 4 is obvious with respect to A4 in the light of the teaching of A1 (see point 4.b above). Consequently, the subject matter of claim 7 does not involve the required inventive step.

8. Claim 8 which depends on claim 1: benefits only from the filing date 11.07.94

Art. 52(2)(b): As claim 1 is not novel with respect to A2, A4 or A6 (cf. point 1.b above), the contribution of claim 8 over any one of these documents is that the cover member is of a light colour. The effect achieved by this feature is to make less visible the finger prints deposited on the floppy disc by the user which spoil the visual aspect of the floppy disc. Consequently, the contribution of claim 8 over the prior art is not of a technical nature and does not produce a technical effect. It relates rather to an aesthetic effect. Consequently the subject-matter of claim 8 is excluded from patentability according to Art. 52(2)(b).

EXAMINATION COMMITTEE II

Candidate No.

Paper C 1999 - Schedule of marks

Category	Maximum possible	Marks awarded		Revision of marks (if any)	
		Marker	Marker	Marker	Marker
Use of information	40				
Argumentation	43				
Legal aspects	17				
Total	100				

Marking by further markers if any

	Use of Information	Argumentation	Legal Aspects	Total
Marker				
Marker				

Remarks

Marks and result
recommended to Board

MARKS	RESULT
	PASS
	COMPENSABLE FAIL
	FAIL

Munich, 8 July 1999

P Weinhold - Chairman of Examination Committee II