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**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. In spite of the extra time given, the answers have once again shown that the majority of the candidates was simply not well prepared for the examination. Many candidates, especially a large number of re-sitters, are clearly not fit to practice and should invest more time in studying/training before entering the examination otherwise it is a waste of valuable time for all concerned.
2. Some candidates do not understand how priority dates or effective dates of claims are established. It should be understood that if the priority date falls, the claim may still have an effective date equivalent to the filing date.

Some candidates still seem to have problems resisting combining an Art. 54(3) document with Art. 54(2) documents for attacks under Art. 56, even when they have properly recognized that a document is state of the art under Art. 54(3).

It should be emphasized that candidates failing to understand these principles will lose many marks and have a much reduced chance of passing the examination.

3. The quality of argumentation often leaves a lot to be desired. The mere citation of features disclosed in the relevant Annexes, followed by the conclusion that the claim is therefore not inventive, as all features can be obtained by combining the Annexes, is not considered to be acceptable argumentation without saying why the combination is obvious.

Statements such as "it is obvious to the skilled man" or "from common general knowledge" are not sufficient by themselves to achieve marks. Argumentation should always be based on technical information which is to be found in the Annexes.

A firm understanding of the "problem and solution approach" is required and the latter should be used when attacking the claims, bearing in mind that the dependent claims can introduce different problems. When the "problem and solution approach" is not considered, documents are often combined in an inconsistent manner.

It is also rare that candidates take into consideration and discuss the physical modifications that need to be made when piecing together the disclosures being combined. It is not sufficient simply to state that the documents belong to the same technical field and that therefore the skilled person would have no difficulty in combining their disclosures to arrive at the claimed subject-matter.

4. Many candidates do not make a clear distinction between novelty and inventive step arguing that "... therefore the claim is not novel or at least not inventive over Annex X". This is regarded as a serious mistake and marks are not awarded for such an attack.
5. It is not sufficient to state that "all features of the claim are disclosed in Annex ..." (or any similar statement) without specifying where the disclosed features can be found.

6. If several grounds of attack are given, by combining Annexes in different ways, proper and consistent argumentation for each attack should be provided.
7. Although it is understood that certain candidates attempt to save time by identifying the features in the claims using letters or numerals (the "Merkmalsanalyse"), this can be confusing to mark and often leads to poor argumentation.
8. There is often a conflict between the advice given to the client and the attack in the notice of opposition. In addition, matters which rightly belong in the notice of opposition (e.g. why a document or an alleged prior use can be used as prior art) are often explained to the client, but are not used to substantiate the attack in the notice of opposition. In answering the questions posed by the client in the letter, candidates should not merely give a summary of the law without specifically applying it.
9. Many candidates did not appreciate that prior public use can be used as a starting point also for an inventive step attack.
10. Candidates should always bear in mind that points are awarded to all (dependent and independent) claims and that proper time management is indispensable for passing the examination.

## **Specific**

### **I. LEGAL QUERIES**

Stating only that US 163 946 is not the "first application" without any explanation of the legal situation was not sufficient to gain full points.

Many candidates confused a "continuation" application with a "continuation-in-part" application.

2. Some candidates mentioned only the decisions G3/97 and/or G4/97 without advising the client.
3. Some candidates did not realize that the fee reduction for filing in Spanish would probably be more than offset by the extra costs of providing a translation. Mention of the correct time limit (R 6(2) EPC) was expected.
4. Many candidates did not read properly the question posed and, having filed the opposition in the name of the representative, they answered that the employee could only speak under the supervision of the representative.
5. A large number of candidates did not refer to the confidentiality agreement between Mr Fouquet and the inventor and which did not exist between Mr Fouquet and the other climbers. Other candidates did not state that it was not possible to analyse the material of the shoes according to G1/92.

## **II. NOTICE OF OPPOSITION**

### **A. FORMAL REQUIREMENTS**

Marks were needlessly lost by lack of attention to the formal aspects of filing the opposition, e.g. omission of opposition fee, signature of representative, proper designation of patent to be attacked, etc.

Mr José Mellado or BONFIRE INTERNATIONAL,S.L. were accepted as opponents. Some candidates were inconsistent. Under legal point 2, they stated that they would file the opposition in the name of the representative. They then proceeded to file the opposition in the name of the client without giving any additional explanation.

### **B1. PRIORITY**

The effective filing date and a brief explanation should have been identified in the notice of opposition.

### **B2. EVIDENCE**

Proposal of any evidence, e.g. a witness, for confirming the alleged prior use indicated in Annex 6 was missing in many papers. Annex 6 itself is not prior art.

### **C. OBJECTIONS ACCORDING TO ART. 100(a) EPC**

#### **Claim 1**

Some candidates wasted time by attacking Claim 1, referring to "a shoe in general", and then repeating the attack, referring to a "a climbing shoe in particular". This was not necessary, it was sufficient to explain that the expression "in particular" does not limit the shoe to a climbing shoe (see Guidelines C-III, 4.6).

Arguments that Annex 3 implicitly discloses a climbing shoe that is laced were not accepted. Arguments that the lacing was not important for solving the problem failed, because this is an inventive step argument, and is not relevant for novelty.

The argument that Annex 3 can be used for a novelty attack as it incorporates Annex 4 cannot be accepted, since the reference in Annex 3 to Annex 4 only concerns the material and not the laced shoe.

Many candidates failed to attack the novelty of Claim 1 using Annex 4.

#### **Claim 2**

Many candidates did not recognise the possibility of using Annex 4 for a novelty-attack against claim 2.

#### **Claim 3**

Since claim 3 refers explicitly to a climbing shoe, arguing that a climbing shoe is to be considered as a shoe which is "suitable for climbing" gives the possibility to start an inventive step attack defining Annex 2 as the closest prior art document.

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Claim 4

Very few candidates commented on the "teach-away" in Annex 5 for the use of antibacterial substances. Few candidates mentioned that the acceptance of a disadvantage as in Annex 5 does not mean that a prejudice has been overcome.

Claim 5

Some candidates used incorrectly the expression "heelless lower part" of Annex 1, page 4, line 3 arguing that this means that all climbing shoes have a "cut-out" at the heel portion in order to attack the novelty of Claim 5. Many candidates referred to the "large rectangular opening 29" of Annex 2 instead of the "openings 25".

Claim 6

The fact that Annex 3 referred to Annex 4 was usually noticed by candidates, but it was often not appreciated that it was only the disclosure of the material characteristics, not the whole of Annex 4, which was incorporated into the disclosure of Annex 3. It was frequently not fully explained why the information from Annex 4 could be incorporated into Annex 3 and used as a novelty attack.

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## **POSSIBLE SOLUTION FOR PAPER C**

### **LEGAL POINTS (16)**

1. The priority document US 163 946 is a continuation document of an earlier US application dated 7.9.89. Although the earlier US application has been withdrawn in the meantime, outstanding rights were left, see EPO Guidelines C-V, 1.4; C-V, 2.6.4. Therefore US 163 946 is not the "first application" in the sense of Art. 87(1) and 87(4). The effective filing date of the opposed patent is the actual filing date, i.e. 20.02.95.
2. Yes. According to the decisions G3/97, G4/97 there is no circumvention of the law by abuse of the procedure purely because a professional representative is acting on behalf of a client.
3. It is possible to file in Spanish since the opponent has his residence or principal place of business in Spain (Art. 14(2) and 14(4) EPC). The opponent is entitled to a 20% reduction of the opposition fees according to Rule 6(3) EPC and Art. 12 of the Rules Relating to Fees. It is necessary that a translation into an EPO language be filed along with the notice of opposition, but not before, see G6/91, T290/90 and Guidelines A-XI, 9.2.4. This translation is to be filed at the latest either one month after the filing of the opposition (R.6(2) EPC) or at the end of the opposition period, whichever is the later, see Guidelines D-IV, 1.2.1 v). Filing the opposition in Spanish leads to loss of time and additional translation costs which exceed the reduction of the opposition fees.
4. Yes. Parties having their residence or principal place of business in a Contracting State may be represented by an employee, who need not be a professional representative before the EPO, but who must be authorized, Art. 133(3) EPC, Rule 101(1) EPC, Guidelines A-IX, 1.2. There is no restriction in the EPC about the nationality of the authorized employee.
5. Yes. When dealing with an allegation of a public prior use, see Guidelines D-V, 3.1.2, the following details have to be clarified:
  - (i) the date on which the prior use occurred, in the present case mentioned in the letter of Mr Fouquet,
  - (ii) what exactly has been used, in this case according to the letter of Mr Fouquet only the visible outer structural details of the shoe and the interchangeability of the sole were shown to the other climbers,
  - (iii) all the circumstances relating to the use, the place of the use is given in the letter of Mr Fouquet and also the form of the use, it was used only by Mr Fouquet.

Therefore, the climbing shoes were made available to the public as far as it concerns the structural details of the shoes and the interchangeability of the sole.

Since the other climbers were not able to analyze the shoes, the material of the climbing shoes was not made available to the public, see G1/92.



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other climbers were not bound by any agreement. Mr Fouquet and/or the other climbers can be summoned in order to be heard as witnesses for the alleged prior use.

## **NOTICE OF OPPOSITION**

### **Use of Information / Argumentation (42/42)**

#### **PRIORITY**

Priority is not validly claimed because the priority application of Annex 1 is a continuation of an earlier US application. Therefore, the relevant date is the filing date of the contested patent.

#### **PRIOR USE**

**Annex 6** is not a prior art document but it indicates a prior use of climbing shoes having an overshoe. Mr Fouquet is offered as witness in order to testify the alleged prior use. Also the other climbers are offered as witnesses, their names can be mentioned later during the opposition proceedings. The climbers represented the public and the prior use took place on the 14.08.1994 at the North face of the Vignemale in the Pyrenees in the form described in **Annex 6**. The public use was limited to the parts of the climbing shoes being visible to the other climbers.

### **OBJECTIONS ACCORDING TO ART. 100(a) EPC**

#### **1. Independent claim 1 (Shoe)**

- a) **Art. 54(1) and (2)**: the subject-matter of claim 1 is **not novel** with respect to **Annex 2** because, the term "in particular" being not limiting (see Guidelines C-III, 4.6). **Annex 2** discloses: a composite shoe comprising a laced (see page 9, line 23) upper part (12) fitting the foot of the wearer, a lower part (claim 1, line 1; fig. 2) fixed to the upper part and essentially matching the footprint, an auxiliary interchangeable sole (20) made of a stretchable, i.e. elastic material (page 10, line 8; claim, bottom line) and comprising elastic side portions (26), which during use surround a portion of the upper part and which have bottom portions (fig. 2) resting against the lower part, whereby the sole fits tightly with the upper part.
- b) **Art 54(1) and (2)**: the subject-matter of claim 1 is **not novel** with respect to **Annex 4** because, the term "in particular" being not limiting (see Guidelines C-III, 4.6). **Annex 4** discloses: a sport shoe comprising a laced upper part (fig. 2), a lower part fixed to the upper part and essentially matching the footprint, an interchangeable sole made of an elastic material (par. 1, line 2) and comprising an elastic side part (1), which during use surrounds a portion of the upper part (fig. 2) and which has a bottom part resting against the lower part, whereby the sole fits tightly (par. 4, line 4) with the upper part.
- c) **Art 54(1) and (2)**: the subject-matter of claim 1 is **not novel** with respect to the prior

astonished how fast Mr Fouquet was able to change the soles of his climbing shoes. That means that they were able to see a climbing shoe disclosing a laced upper part and a lower along with an elastic interchangeable sole which surrounds and grips the upper part of climbing shoe (last paragraph of **Annex 6**).

## 2. Claim 2 which depends on claim 1

- a) **Art 54(1) and (2)**: the subject-matter of claim 2 is **not novel** with respect to **Annex 4** because **Annex 4** also discloses the additional feature that the material of the sole is natural rubber (page 17, line 27).
- b) **Art. 56**: the feature of the material of the interchangeable sole is not disclosed in the prior use indicated in **Annex 6**. Therefore the objective problem may be seen in the choice of the material of the interchangeable sole in order to have good climbing properties. **Annex 5** already addresses this problem (page 21, line 2). Furthermore, **Annex 5** proposes the use of natural rubber for the sole of a climbing shoe (page 21, line 7). Since the interchangeable sole will be the outer sole used by the climber it will be obvious for the skilled person to use natural rubber for the interchangeable sole of the climbing shoes used by Mr Fouquet. Therefore, the use of natural rubber for the interchangeable sole of a climbing shoe known from the prior use indicated in **Annex 6** does not involve an inventive step.
- c) **Art. 56: Annex 2** is directed to a sport shoe and teaches the use of a stretchable synthetic material for the auxiliary sole (page 9, line 22). Therefore the objective problem may be seen in the choice of the material of the interchangeable sole in order to improve the gripping ability of said shoe. **Annex 5** already addresses this problem (page 21, line 2). Furthermore, **Annex 5** proposes the use of natural rubber for the sole of a climbing shoe (page 21, line 7). It does not require an inventive activity from the skilled person to use also natural rubber for the auxiliary sole known from **Annex 2**.

## 3. Claim 3 which depends on claim 1

- a) **Art. 56**: claim 3 is directed to a climbing shoe. A climbing shoe is known from the prior use indicated in **Annex 6**, but the feature of the hardness of the sole is not disclosed in said prior use. Therefore the objective problem may be seen in the optimization of the hardness of the sole in order to achieve good gripping properties. **Annex 5** (page 21, line 2) already addresses this problem.

Furthermore, **Annex 5** (page 21, line 10) discloses a value of Shore A hardness 64. The material proposed in **Annex 5** falls within the range of Shore A hardness required in claim 3. Since the interchangeable sole will be the outer sole used by the climber it will be obvious for the skilled person to use a material with a hardness in the range specified for the interchangeable sole of the climbing shoes used by Mr Fouquet. The use of such a known material in a shoe known from the prior use indicated in **Annex 6** does not involve an inventive step.

- b) **Art. 56:** A climbing shoe is to be considered as a shoe which is "suitable for climbing". Therefore, the only difference between **Annex 2** and the subject-matter of Claim 3 is the hardness range. **Annex 5** refers to climbing shoes having a hardness falling within the range of hardness claimed in claim 3. Starting from **Annex 2** the skilled person who intends to provide a sport shoe having high climbing performance would use a climbing shoe having a sole and an overshoe made of a material having the specific hardness mentioned in **Annex 5** (page 21, line 10).

#### 4. Claim 4 which depends on claim 2

**Art. 56:** the subject-matter of claim 4, as far as directed to the use of both antibacterial substances and deodorant, differs from the content of **Annex 4** only in that the lower part is also impregnated with antibacterial substances. Therefore the objective problem may be seen in the protection of the wearer's foot from bacteria. **Annex 5**, par. 4 already states that antibacterial substances were applied to sports shoes in the past. The impregnation of a lower part of a shoe known from **Annex 4** does not involve an inventive step. The negative statement in **Annex 5**, that the use of antibacterial substances in a shoe may cause allergic reactions, cannot prohibit the skilled man of using such antibacterial substances as he has done so in the past, see T69/83, T262/87, T862/91. The fact that a disadvantage is accepted does not mean that a prejudice has been overcome.

Therefore, the combination of the teachings of **Annex 4** and **Annex 5** renders the subject-matter of claim 4 not inventive.

#### 5. Independent claim 5 (Sole)

- a) **Art. 54(1) and (3):** the subject-matter of claim 5 is **not novel** with respect to **Annex 3** for all the member states designated in common in **Annex 3** and in **Annex 1** according to Article **54(4)** EPC, namely AT, CH, DE, FR, GB, IT and LI, because **Annex 3** discloses an interchangeable sole (3) having an elastic margin and a bottom part suitable for being pulled over a sports shoe, wherein a cut-out (4) is placed at the heel portion of the sole. The blind holes 4 are also cut-outs.
- b) **Art. 54(1) and (2):** the subject-matter of claim 5 is **not novel** with respect to **Annex 2** because **Annex 2** discloses an interchangeable sole (20) having an elastic margin and a bottom part suitable for being pulled over a sports shoe, wherein openings (25) are placed at the heel portion of the sole.
- c) **Art. 54(1) and (2):** the subject-matter of claim 5 is **not novel** with respect to the prior use indicated in **Annex 6** because the other climbers could see the interchangeable sole having an elastic margin and a bottom part suitable for being pulled over a sports shoe, and they could also see the cut-out at the heel portion of the sole.

#### 6. Claim 6 which depends on claim 5 (Sole)



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- a) **Art 54(1), (3) and (4)**: the subject-matter of claim 6 is **not novel** with respect to **Annex 3**. The interchangeable sole of **Annex 3** is made of materials disclosed in **Annex 4**. In **Annex 4** a range for elongation at break of 800 to 1000% has been proposed which lies between 400 and 1200% of claim 6. A direct reference in a first document to a specific part of a second document incorporates said part to the first document, see T153/85, Guidelines C-IV, 7.1
- b) **Art. 56**: The subject-matter of claim 6 differs from the content of **Annex 2** only in that the material used for the interchangeable sole has an elongation at break of 400 to 1200%. Therefore the objective problem may be seen in the optimization of the elongation at break of the sole in order to achieve a better material performance. **Annex 4**, par. 5 already addresses this problem. Furthermore, **Annex 4**, par. 5, discloses an elongation at break range of 800 to 1000% which lies between 400 and 1200% of claim 6. The use of such a known material in a sole known from **Annex 2** does not involve an inventive step.
- c) **Art. 56**: According to **Annex 6** the other climbers have seen Mr Fouquet changing the soles of his climbing shoes. These climbers were not able to analyze said shoes and so cannot know the elongation at break value of the used material. Also Mr Fouquet did not give them any information about the material used. Therefore, the subject-matter of claim 6 differs from the content of the prior use indicated in **Annex 6** only in that the material used for the interchangeable sole has an elongation at break of 400 to 1200%. Therefore the objective problem may be seen in the optimization of the elongation at break value of the sole in order to achieve a better material performance. **Annex 4**, par. 5 already addresses this problem. Furthermore, **Annex 4**, par. 5, discloses an elongation at break range of 800 to 1000% which lies between 400 and 1200% of claim 6. The use of such a known material in a sole known from the prior use indicated in **Annex 6** does not involve an inventive step.

# EXAMINATION COMMITTEE II

Candidate No. ....

Language .....

## Paper C 2000 - Schedule of marks

Category	Maximum possible	Marks awarded		Revision of marks (if any)	
		Marker .....	Marker .....	Marker .....	Marker .....
Use of information	42				
Argumentation	42				
Legal aspects	16				
Total	100				

### Marking by further markers if any

	Use of Information	Argumentation	Legal Aspects	Total
Marker				
Marker				

Examination Committee II agrees on .....marks and recommends the following grade to the Examination Board:

- PASS (50-100)       FAIL (0-49)       COMPENSABLE FAIL (45-49, in case the candidate sits the examination for the first time)

Munich, 6 July 2000



P Weinhold - Chairman of Examination Committee II