

## Examiners' report, Paper C - 2001

### 1. Introductory explanation

Before going into details on this year's paper it is considered opportune to offer some general guidance on how Examination Committee II approaches marking.

- 1.1 Candidates and tutors are presumably aware that the total number of marks obtained is the summation of those accumulated in the three categories: "Use of Information", "Argumentation" and "Legal". What, however, is to be understood by these categories?
- 1.2 So far as "Legal" is concerned, the meaning is reasonably clear. The "Legal" aspects are largely those raised by the questions posed in the client's letter (for example, in this year's paper – the late filing of the drawing by fax). Answers to such questions, however, sometimes need to appear in the notice of opposition itself rather than in the notes to the examiner or client. Indeed, any answer to a legal matter which gives rise to a ground for opposition should rightfully appear in the notice of opposition. For example, in this year's paper, the client remarked on the amendment to the description. If a candidate considered that Art.100(c) was then a ground for opposition, this should have been apparent from the notice of opposition itself and not in the notes, otherwise many marks would have been lost. If a candidate believed such an attack not to be warranted, comments should then only appear for the examiner. (Please note that there is absolutely no obligation to write a letter to the client or examiner and much time seems to be lost in composing letters which start, e.g. "Dear...., Thank you for asking me to file an opposition on your behalf. I have much pleasure in enclosing a copy from which you will see that we have a good chance of success. The documents you supplied were particularly helpful because....".)
- 1.3 Answers to the legal questions, whenever not being completely evident from the opposition itself, should be as brief as possible. The committee is looking for evidence that the matter has been understood and that the candidate can apply the law. It does not need a long discourse on legal background that is beside the point (see further comments under "Legal" 4 below). Short note form is often sufficient, provided sufficient legal basis is given (DG3 decisions/Guidelines/EPC/PCT).

- 1.4 For “Use of Information” and “Argumentation” there is no absolute definition. In many cases the two merge together somewhat and what one examiner may consider being slightly more in “Use”, the other may consider “Argumentation”. However, to a large extent one can equate “Use” with a presentation of facts or analysis of the information provided in the documents, while “Argumentation” is more how such information is put together in a cogent submission. For example, the presentation of features found (with their location) in the citations would attract more marks under “Use”. On the other hand the detection of implicit information, such as that in this year’s paper concerning the transparency of certain layers, or reasoning why documents would be combined, would attract more under “Argumentation”. Likewise a presentation of an inventive step objection would more likely attract more under “Argumentation”.

## 2. General matters

Firstly, to avoid unnecessary repetition, your attention is directed to the general comments made in previous years, as a re-reading in conjunction with the following remarks should be of benefit.

- 2.1 Compared with former papers, this year’s was considered to include a reduced number of claims to be attacked, fewer dependencies and fewer documents to read; such documents also being brief and including only three which could be employed for inventive step. It was expected that arguments of obviousness should have been presented properly, starting from the correct closest prior art.
- 2.2 Even though candidates were less inclined to use a shot-gun attack (finally) and showed a greater awareness of the need to use the problem and solution approach (which is to be applauded), the lack of any increase in the pass rate is indicative that the actual arguments offered were less than convincing and that much more preparation is required. Often, even though the correct documents were combined, the wrong one was used as the starting point. The crucial question of “Is the candidate fit to practise?” cannot be answered positively when one is presented with a series of attacks which start from the incorrect closest prior art, otherwise it would be possible for many marks to be accumulated (possibly even enough for a pass) without a single, proper argument having been made.

- 2.3 All attacks should be substantiated; mere allegation which involves little more than "Claim 1 is not inventive over the combination of Annexes X and Y" is not sufficient, even though correct.
- 2.4 Candidates are strongly advised to note that all claims are important and that it is not necessarily claim 1 that attracts the most marks. Consideration should therefore be given to whether one should proceed to the next claim when a good attack has been formulated, as one can always return to make further arguments, time permitting. It is often apparent that a candidate has allocated too much time to the first claim.
- 2.5 It is heartening to see that many candidates have obviously paid attention to previous papers. It is however of no use whatsoever to show knowledge of a particular point of law when it is not relevant to the current paper.
- 2.6 It cannot be too strongly emphasised that the facts are to be accepted as presented (see "Instructions to the candidates for preparing their answers", part 1. General provisions, point 3). In particular, file inspections are not required and the validity of priority dates should not be questioned unless there is strong evidence, such as a remark in the client's letter, to suggest otherwise ("Instructions" Part IV, Paper C. point 20). Furthermore, importation of the "skilled man", or "common general knowledge", to conclude an argument is rarely convincing and normally shows that information has been overlooked.
- 2.7 To obtain maximum marks, submissions should be accompanied by a legal basis wherever possible.
- 2.8 Repeating the facts of a question, or features of a claim, before actually beginning the answer, often wasted time.

**Specific**

*[The first mark is for "use of information" and the second for "argumentation"]*

**Legal (Total) [17]****1. Late filed drawing**

This was generally well answered, but even though many argued correctly that the filing date was post-dated to the date on which the drawing was filed, relatively few commented that the priority date was not affected.

Some candidates argued that the drawing was not to be found in the priority document, although there was no evidence to suggest this.

**2. Board of Appeal decision**

Relatively few took up the point that although the objection of lack of support overturned by the Board of Appeal was not a ground for opposition, an Opposition Division can re-examine the facts of any ground relevant to opposition proceedings even if previously decided by the Board of Appeal, although if the facts were the same it would be unlikely to come to another conclusion.

**3. Annex 3 WO 94/04333**

Additional comment that this Annex could not be used under Art. 54(2) EPC, as it was published on the priority date of Annex 1, was rare.

**4. Third party observations**

Candidates should be familiar with grant proceedings and realise that anything filed as late as two weeks before the mention of grant would have been at a time long after the proceedings before the Examining Division had closed. Few commented that should partiality nevertheless be argued, the principles laid down in G5/91 should be followed.

Many candidates addressed the issue of the rights of the third party to proceedings. This was irrelevant to the question posed.

**5. Some candidates did not realise that Annex 5 was only relevant for the three commonly designated states.**

**Description – added subject matter [6/6]**

This was answered poorly. The question demanded a proper comparison of the information disclosed in the amended paragraph (when read in conjunction with the previous paragraph) with that disclosed by (a) claim 3, (b) the description as filed, and (c) the drawing. It should have been realised that it was by no means apparent that the disclosures (a), (b), and (c) were concerned with a common embodiment. Application of the principle of the amended novelty test was practically absent.

**Claim 1 [9/9]**

This was usually attacked well for lack of novelty with Annex 5. The only weaknesses concerned: the absence of a positive reference to the fact that either Annex 5 (implicit), or Annex 2, proved the transparency of the ionotherm layer; that the information concerning the composition of the ionomer layer given in Annex 3 was conventional at the priority date of Annex 1 and that the fact that the pigment used in the third embodiment was also excitable by an energy source should have been proved using the information in the first embodiment and the claim.

There were no strong attacks under Art. 56 EPC.

**Claim 2 [4/6]**

The principles to be applied when considering a possible selection invention are clearly not widely understood. Candidates of all disciplines should be aware of how one should deal with a claim having a range selected from within a known range.

**Claim 3 [12/14]**

Many started correctly with Annex 4, but failed to prove the transparency of the epoxy resin (by implication) or to assess the information in Annex 6 (principle of equivalents) correctly.

It should be noted that the problem to be solved, as given in the solution is not the only way this claim can be approached.

Even though this claim was in the original application it was often attacked under Art. 123 EPC.

**Claim 4 [5/4]**

The problem posed by this claim, i.e. that of a claimed range overlapping with a known range was not properly understood (cf claim 2 above).

The two differences between the claim and the disclosure of Annex 4 (closest prior art), viz. that there was no disclosure of the ball being hollow and flexible, were very often ignored.

**Claim 5 [4/4]**

The assumption that the textile disclosed in Annex 2 was synonymous with the claimed nylon/wool mixture was not correct. The disclosure of "textile" in Annex 2 was not an implicit disclosure of a particular material.

A serious error was made in arguing that the luminescent dye (generic) in Annex 2 anticipated the phosphorescent pigment (specific) in the claim.

**Formal (identification of opponent etc.)**

This was normally well handled. It is nevertheless recommended that the Opposition Form 2300 be used to reduce the risk of loss of marks.

## Possible solution

EP 0 909 909 should be revoked on the grounds of Art. 100(a) and 100(c) EPC, for failure to comply with the requirements of Art. 54(3), Art. 56 and Art. 123(2) EPC.

### Claim 1

Claim 1 is not novel, (Art. 54(3) EPC), over the disclosure of the last embodiment of Annex 5 for the common designated states DE, GB and NL.

Annex 5 discloses (see para. 4 and the drawing) a substantially spherical object (a golf ball) having a core member 1 (which by the very nature of a golf ball must also be substantially spherical) and an outer, protective layer 4 of Ionotherm™, which includes particles of pigment.

Claim 1 of Annex 1 demands that its outer coating (to which the Ionotherm layer of Annex 5 corresponds) be a coating of a transparent copolymer of ethylene monomer and a vinyl acid monomer. Furthermore the included pigment must emit light after exposure to an energy source.

From Annex 2, lines 5 - 7, it is known that Ionotherm is a transparent ionomer and from Annex 3, para. 4, it is established that it was known, before the priority date of Annex 1, that an ionomer was a conventional copolymer of ethylene monomer and a vinyl acid monomer.

That Ionotherm is a transparent material is also implicit to the disclosure of Annex 5, as the Annex indicates (see lines 21 - 23) that the presence of too much pigment would impair the visibility of the white lacquer layer, ie the Ionotherm layer that contains the pigment must also allow the lacquer layer to be seen.

Annex 5 is directed to glow-in-the-dark golf balls. Thus it is implicit that the pigment in the last described embodiment will cause light to be emitted after exposure to an energy source (cf first described embodiment). This is also implied by the wording of claim 1 of Annex 5.

Thus claim 1 is not novel as all features are either explicitly or implicitly disclosed in Annex 5.

**Claim 2 (dependent on claim 1)**

This claim also lacks novelty (Art. 54(3) EPC) over Annex 5.

The claim's additional requirement that the pigment is present in an amount up to 25% by weight of the polymer is anticipated by the disclosure of the range "no more than 30%" in Annex 5. There is no special effect attached to the claimed range and there is clearly no reason to suspect that a skilled worker would not choose to work within the selected range of claim 2; the selection is arbitrary, covers a large part of the known range and is close to the preferred range of Annex 1 (cf claim 4). (T 26/85 OJ EPO 1-2/90, p 22; T 198/84 and T 279/89.)

**Claim 3 (independent)**

This claim lacks inventive step (Art. 56 EPC) over the combined disclosure of Annex 4 and Annex 6.

Annex 4, which is the closest prior art, discloses (see para. 2) a ball (plaything), having an inner member (1) (first surface), provided with a white, reflective coating (2), surrounded by an intermediate layer of epoxy resin (5), itself protected by an outer, transparent polyvinyl chloride layer (4) containing a phosphorescent pigment. The epoxy resin layer must also be transparent otherwise the effect of the white, reflective layer would be lost.

Thus the only difference between claim 3 and the disclosure of Annex 4 is that Annex 4 discloses the use of a white reflective layer on the first surface whereas claim 3 requires a phosphorescent coating.

The problem of providing the inner surface with an effect that allows the ball still to be seen even if the outer surface is damaged will therefore also be implicitly solved with the white reflective layer of Annex 4. The problem that is solved by claim 3 may therefore be expressed as the provision of an alternative visual effect. This cannot be acknowledged to be inventive in view of the disclosure of Annex 6.

Annex 6 is concerned with improving the visibility of balls and indicates that brightening agents, reflective components and fluorescent pigments can all be used with similar effect (lines 7 - 9). Thus choosing fluorescent pigment rather than a white reflective coating involves no inventive step. Furthermore the effects of fluorescence and



phosphorescence are both well known from Annex 1, as well as the fact that phosphorescence lasts longer than fluorescence. Thus the choice of phosphorescent pigment rather than a fluorescent one would be obvious. Claim 3 therefore lacks inventive step.

#### **Claim 4 (independent)**

**(NB: See note at end of solution concerning the French version of this claim)**

This claim lacks inventive step over the disclosure of Annex 4 when combined with that of Annex 2 or 6 or 1.

Annex 4 is the closest prior art and discloses a member (1) with a transparent, thermoplastic coating (4), such as polyvinyl chloride, having 5 - 50% by weight of phosphorescent zinc sulphide pigment particles.

Claim 4 requires the member (1) to be hollow and flexible and the pigment to be at least 10% by weight of the coating. Hollow, flexible members are known from Annex 2 (tennis ball), Annex 6 (squash ball) and Annex 1 (conventional tennis ball – last embodiment). The selection of at least 10% by weight of pigment is within the known range of Annex 4 and does not contribute any new teaching (cf claim 2 case law).

(NB In the French version of claim 4 “zinc sulphide” appeared as “sulfate de zinc”. This difference was taken into account during marking.)

#### **Claim 5 (independent)**

This lacks inventive step (Art. 56 EPC) over the combination of Annex 2 and Annex 1.

Annex 2 discloses a tennis ball core (elastomeric hollow member) surrounded with a textile (outer fibrous layer) having a luminescent dye. Claim 5 states that the textile should be a blended felt of wool/nylon. This feature can only be regarded as conventional at the priority date of Annex 1 as Annex 1 itself indicates this in its last embodiment. The choice of a phosphorescent dye for the luminescent effect is also rendered obvious from the discussion of the known effects of phosphorescence and fluorescence in Annex 1.

As an alternative argument and starting from that which is acknowledged to be conventional in the last embodiment of Annex 1 (“conventional tennis ball...felt blend”) the only difference between a conventional tennis ball and that claimed in claim 5 is that the

tennis ball of claim 5 requires the felt blend layer to have a phosphorescent dye. Such a luminescent dye for the desired effect is however obvious from the disclosure in Annex 2 and the fact that phosphorescence is known to be better from the prior art acknowledgement of Annex 1.

### **Art. 100(c) EPC**

The addition of the paragraph to the golf ball embodiment of Annex 1 constitutes an amendment that goes beyond the content of the original disclosure.

The addition of the paragraph, when read in conjunction with the drawing, establishes that between core (3) and outer polyethylene coating (2) there is arranged a phosphorescent coating (4), an epoxy resin coating (5) and a pigmented polyvinyl chloride coating (6). Such an exact disclosure of the arrangement of the core and the layers was not originally disclosed, neither in the original description, in the drawing, nor in claim 3, regardless of whether these disclosures were read alone or in any combination with each other. The disclosure thus fails the "novelty test" and contravenes Art. 123(2) EPC.

### **Legal Aspects**

- a) The drawing was not in the originally filed documents but was filed later by fax (Rule 36(5)) with appropriate confirmation following (time limit; decision of the President OJ 6/92). This resulted in a later filing date, but as it was still within the priority period priority was not lost (Art. 91(1)g; 91(6), Rule 43).
- b) The Art. 84 objection used to refuse the corresponding application is not possible in opposition. Objection could however be raised under Art. 100(c).
- c) The fact that an Appeal Board has ruled on an issue during examination (client's letter) does not restrict the opposition division in any way (T 167/93; T 26/93).
- d) It should be realised that Annex 3 is not prior art under Art. 54(2), as it was published on the priority date of Annex 1. Furthermore, although it discloses the content of claim 1 of Annex 1, it cannot be cited under Art. 54(3) as it did not enter the regional phase before the EPO, but was only prosecuted in the national phase for DE and GB.
- e) At the time the third party observations were filed, viz. two weeks before the mention of the grant (client's letter), the examining division was no longer competent for the application, as the preparations for grant would have been concluded (T 798/95). Any issue of partiality that might be raised should follow the reasoning in G 5/91.

**EXAMINATION COMMITTEE II**

Candidate No. ....

Language .....

Paper C 2001 - 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				

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, 5 July 2001

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P Weinhold - Chairman of Examination Committee II