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## Examiners' report, Paper C - 2002

(please note that all the references to passages in the annexes relate to the English version of Annex 1 and the original (i.e. untranslated) versions of the prior art annexes.)

### GENERAL:

1. The Committee has noted that the majority of candidates when making attacks based on Article 56 EPC now used the problem/solution approach. This approach is generally considered to provide the most convincing argumentation against inventive step.
2. When using the problem/solution approach candidates are reminded to carefully formulate the problem to be solved. The problem is derivable from the known effect achieved by the contribution over the prior art and should be formulated without having regard to the problem addressed by the patent to be opposed.
3. Time management is very important and candidates should bear in mind that many points are lost if the later claims are not attached. Further, many candidates waste valuable time composing formally very correct letters.
4. Candidates should be aware that whilst points are not deducted for incorrect attacks, they should not succumb to a "shot-gun approach", but choose the most appropriate attack(s).
5. Although it is understood that the identification of the features in the claims using letters or numerals is an attempt to save time by certain candidates, this can be confusing to mark and often leads to poor argumentation in particular in inventive step attacks.
6. Certain candidates confuse the issues of added subject-matter and priority. Candidates are reminded that the effective date of a claim is defined by the priority and even if an attack under Article 100(c) EPC is made, this doesn't change the effective date of the claim.
7. Candidates showing knowledge of certain specifically relevant Board of Appeal decisions and passages of the Guidelines in order to support a line of argumentation in the opposition were awarded points.
8. Attention is drawn to the "Regulation on the European qualifying examination for professional representatives", Instructions to candidates concerning the conduct of the Examination", Item 4 & 5.7.

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**SPECIFIC:****Legal** [total 12]

- a) Many candidates seem to be confused as to whether being authorised (in the present case by means of a general authorisation) automatically means that the representative in question is also appointed. This led to many candidates addressing the issue wrongly and submitting answers pertaining to a change of representative. Thus, some candidates, correctly citing the Decision of the President dated 19.07.1991, came to the wrong conclusion.
- b) A brief discussion of the valid dates of the individual claims was expected together with an indication of the relevant Articles of the EPC.
- c) Many candidates did not discuss both the aspect of full and partial transfer. Further, the legal framework that an opposition is generally not transferable and that a transfer is possible only under special circumstances (G4/88 and Guidelines D-I, 4) was not always acknowledged.

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

**Added subject-matter** [4/8]

Many candidates merely stated the information given in the letter and without discussion concluded that the requirements of Article 123(2) EPC were not met. This was not awarded points.

Further, candidates tended to base an objection under Article 123(2) EPC on the argument that an essential feature had been deleted. This approach was not considered correct, since candidates were expected to realise that the feature in question (flat) was in fact not present in the independent claim as filed and that the infringement of Article 123(2) EPC resides in a combination of features being taken apart, the combination, however, being defined as essential.

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## Notice of opposition

### Claim 1: [9/9]

Very few candidates referred to A6; page 2; lines 16-19 when arguing lack of novelty with respect to the feature "adhesive between the stems". It is also noteworthy that candidates tended to cherry pick features from the two embodiments of A6 apparently without noting that then two different embodiments were combined for a novelty attack.

A discussion of the feature "adhesive between the stems" was often missing, in particular when candidates referred to A6; page 2; lines 26-30. Candidates were expected to discuss where/how the feature in question was to be found in A6.

### Claim 2: [7/11]

Few candidates realised that the specific value of 10000 MPa·s in A2 is novelty destroying for the subject-matter of claim 2. With regard to A6, candidates were expected to argue more in depth with respect to lack of inventive step based on simple tests.

### Claim 3: [5/5]

Many candidates missed that A6 discloses mushroom-shaped heads. Further candidates demonstrated a poor analysis of the subject-matter of claim 3 when compared to the disclosure of A4 by overlooking the aspect of the different range of the undercut in A1 and A4.

### Claim 4: [5/9]

Candidates were expected to provide a reasoned line of argumentation concerning the choice of closest prior art for an inventive step attack. Points were also awarded for well-argued inventive step attacks based on A5 as closest prior art. A few candidates were also awarded points for very well argued novelty attacks based on A6.

### Claims 5+6: [2/2] + [6/6]

Consistency in the choice of the closest prior art was required, having regard to the inventive step attack on claim 4. The majority of candidates made the correct novelty attack with A3 on claim 6 when dependent on claim 4. Further, the majority of candidates realised that the inventive step attack on claim 6 is equally valid for both dependencies.

## Possible solution for Paper C

### Legal points

1. An authorisation is not needed to file an opposition, see Decision of the President dated 19.07.1991 (OJ1991, 489) or Guidelines A-III, 2.1. Since Mr Pitt is not appointed in the present case there is no change of representative. An authorisation should be prepared in case the EPO asks for it. Rule 101(1) EPC.
2. Claims 1-3 do not benefit from the priority date, since there is no disclosure of their subject-matter in the priority document. Valid date of claims 1-3 is thus 25.07.97. Article 87(1) EPC.

There is support for subject-matter of claims 4-6 in the priority document, valid date for claims 4-6 is thus 26.07.1996. Article 89 EPC.

3. Oppositions are generally not assignable, but may be inherited or succeeded to as part of a succession in law. A transfer of opposition is possible in case of total transfer of ownership (Guidelines D-I, 4). If there is only a partial transfer of ownership, then an opposition can only be transferred together with the business assets to which the patent in question relates (G4/88).

### Claim 1:

#### Article 54 EPC

A2 is prior art under Art 54(3) EPC provided it has entered the regional phase. The requirements for entering the regional phase are set out in Article 158 and Rule 23a EPC. A check needs to be made whether A2 has entered the regional phase and which designation fees have been paid (Art 54(4) EPC) since A2 can only be novelty destroying for commonly designated states in A1 and A2.

A2 discloses a fastener suitable for engagement with a fastener of the same type (page 2, line 1), said fastener having heads on stems projecting from a first surface of a base (page 2, lines 1-3). The base, stems and heads are integrally formed from PolyPPPC or PolyBLE (page 2, line 4). A pressure sensitive adhesive is applied to the upper surface of the heads, between the stems and to the bottom surface opposite the headed stems (page 2, lines 12-14; Figure 2).

A2 thus discloses all features of claim 1 apart from the information that the materials of A2 (PolyPPPC and PolyBLE) are "thermoplastic".

A4 (published prior to the valid date of claim 1 of A1) defines these materials as being "thermoplastic" (page 2, lines 8-9). A2 is thus novelty destroying for claim 1 under Art 54(3) EPC, having regard to the definition of PolyPPPC and PolyBLE given in A4.

#### Article 54 EPC

A6 discloses the following features – "a fastener suitable for the engagement of a fastener of the same type (page 2, lines 5-7); "a plurality of engaging heads on stems projecting from a first surface of a base" (page 1, lines 13-15; Fig. 1 or 2); "base, heads and stems integrally moulded from a thermoplastic material" (page 3, lines 1-2);

“a pressure-sensitive adhesive on an upper surface of the engaging heads” (page lines 14-15); “second surface opposite the first surface covered with adhesive” (page lines 4-5).

The feature “adhesive applied to the base between the stems” is derivable from A6; page 2, lines 16-19, wherein it is disclosed that a certain amount of adhesive always will drop from the heads onto the base between the stems. The subject-matter of claim 1 is thus known from A6.

### **Claim 2:**

#### **Article 54 EPC**

A2 discloses a viscosity between 10000 and 20000 MPa·s (page 2, lines 16-17). The specifically mentioned endpoint 10000 lies within the range claimed in claim 2, therefore the subject-matter of claim 2 lacks novelty over A2.

#### **Article 56 EPC**

A6 discloses (page 2, lines 26-30) that, depending on viscosity, the adhesive either stays on the heads, flows off the heads onto the base, or distributes between heads and base. The problem is to provide a distribution of adhesive on both heads and base. Starting from A6 (being novelty destroying for claim 1) and seeking to solve the problem posed it would be obvious, by means of simple tests (trial and error) to find the range of claim 2. No inventive activity is needed for this. This is supported by Guidelines C-IV, Annex 3.1(ii).

### **Claim 3:**

#### **Article 56 EPC**

Starting from A6 as the closest prior art, it is noted that A6 also discloses mushroom-shaped fastening means (page 1, line 14). The only feature of claim 3 not present in A6 is thus the undercut in the range of 25° and 50°. The effect of the undercut is to improve the mechanical engagement between fasteners. A4 (page 2, lines 17-22) addresses the problem of achieving this effect and as a solution suggests the use of an undercut. The range in A4 is from 20° to 60°. It is noted that the range of claim 3 thus lies fully within the range disclosed in A4 and can be considered known from A4 since no surprising effect is mentioned in A1.

Thus, starting from A6 and seeking to solve the problem posed, it would be obvious to apply the teaching of A4 and thereby without any inventive activity arrive at the subject-matter of claim 3.

### **Claim 4:**

#### **Article 54 EPC**

A3 is prior art under Article 54(3) EPC since it was filed before the valid date of claim 4 but published after it. A3 is citable against all states designated in A1 since A3 was published 29.10.1997 and therefore the designation fees were paid upon publication.

A3 discloses a closure tab for a diaper (page 2, line 12) wherein the tab has a fastening region and a non-fastening region, the fastening region being provided with both mechanical and adhesive fastening means (page 1, line 16 - page 2, line 3 and Figures). The non-fastening region is a central part of the tab, which is free of hooks and adhesive in order to facilitate folding of the tab (page 2, lines 14-15). The subject-matter of claim 4 is thus known from A3.

#### Article 56 EPC

A6 is considered to represent the closest prior art, since it has the most features in common with claim 4 and addresses the same problem of A1, notably having surface fasteners which not only attach mechanically but also by means of an adhesive in order to e.g. attach to an outer surface of a sanitary article.

From A6 a closure tab for a sanitary article is known, which has a fastening region provided with both mechanical and adhesive fastening means (page 1, lines 10-11). The mechanical fastening means are the mushroom-shaped engaging elements as depicted in Figure 1 and the adhesive is provided on the heads for attachment to an outer surface of a sanitary article (page 2, lines 5-8).

A6, in the embodiment of Figure 1, thus differs from the subject-matter of claim 4 by the feature "a non-fastening region". The technical effect of a "non-fastening region" is that the closure tab in this region does not attach to the opposing fastener. Hereby the handling of the fastener when it is opened is facilitated, since in the "non-fastening region" the fastener is easier to grasp. The exact location of the "non-fastening region" is not defined in claim 4.

This problem is addressed in A5 (second paragraph), which also pertains to a closure tab for a diaper. A part of the tab in A5 is free of fastening means, thereby improving the handling of the tab when it is to be opened.

Consequently, the skilled man, when starting from A6 and seeking to solve the problem posed, would turn to A5 in order to solve the problem posed. The subject-matter of claim 4 thus lacks inventive step.

#### **Claim 5:**

#### Article 56 EPC

In claim 5 it is additionally defined that the "non-fastening region" is an outer region of the tab. Thereby the outer region of the tab is easier to grasp. The objective problem posed is thus to provide a tab wherein the outer end is easy to grasp. This problem is addressed in A5 (second paragraph) in which it is stated that the outer end of the tab is free of fastening means.

The skilled man, when starting from A6 and seeking to solve the problem posed, would turn to A5. The subject-matter of claim 5 thus lacks inventive step.

#### **Claim 6:**

#### Article 54 EPC

A3 is novelty destroying for claim 6 when depending directly on claim 4. The additional feature concerning the tab being elastic is disclosed in A3, page 2, line 13.

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### Article 56 EPC

The additional feature of dependent claim 6 (the tab being elastic) solves the objective problem of providing a suitable/comfortable fit of the diaper around the waist of the child (i.e. a fit which adapts to the size of child). From A5 it is known to have an elastic closure tab for diapers. This has certain implicit advantages, one being that the diaper when closed fits around the waist of the child.

For the man skilled in the art it would thus be obvious when starting from A6, in order to solve the problem posed, to turn to A5 and thus without any inventive activity arrive at the subject-matter of claim 6.

It is noted that the objection under Article 56 EPC is valid for both dependencies, since the subject-matter of claim 5 is already rendered obvious by a combination of A6 and A5 and the combination of claims 5 and 6 does not provide any additional effects other than already discussed

**EXAMINATION COMMITTEE II**

Candidate No. ....

Language .....

Paper C 2002 - Schedule of marks

Category	Maximum possible	Marks awarded		Revision of marks (if any)	
		Marker .....	Marker .....	Marker .....	Marker .....
Use of information	38				
Argumentation	50				
Legal aspects	12				
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, 4 July 2002

P Weinhold - Chairman of Examination Committee II