

Examiners' Report – Paper C

General Comments

1. The overall standard of candidates' answers this year was lower than usual, and a surprisingly large number of answers were very poor. Those candidates achieving low marks should consider gaining more experience before re-sitting the examination. A common problem was the lack of argumentation; it is insufficient merely to state a fact without justifying it. Statements should be supported by legal authority, factual reasoning or explanations. In order to pass the examination, it is not enough to file a formally valid opposition; the candidates must present their best case, fully arguing all reasonable attacks.

Notice of Opposition:

2. There was generally poor analysis of the features of a claim. It is not always sufficient to simply state that a feature is present in a prior art document. An example is the feature "passive" in relation to the tactiovisual means; candidates were expected to explain why a prior art tactiovisual means could be considered as being passive.
3. Although candidates attempted to apply the problem-solution approach, this was generally not done well.
 - 3.1 There should be reasoning why a document is chosen as the closest prior art. For example, concerning claim 1 of Annex 1, Annex 4 can be considered as the closest prior art because it is the only document describing an aircraft having a floor-based exit-finding system, or because it is concerned with the problem underlying invention ie. evacuation from aircraft. It should be noted that the closest prior art may disclose not only the features of the preamble, but also features in the characterising portion of the claim; consequently features from both parts of the claim may need to be considered when choosing the closest prior art.
 - 3.2 Having identified the difference between the claimed subject-matter and the closest prior art, the problem to be solved was often wrongly formulated in terms of the solution itself. So, for example, concerning claim 1, it was stated that the subject-matter of the claim differs from Annex 4 in that the floor-based system is tactile, in addition to being visual; the candidate then went on to say that the problem to be solved was to provide a tactiovisual system. However, the problem is not how to make the system of Annex 4 tactiovisual, but rather how to direct people to the exit when visibility is impaired.

In the case of dependent claims, the problem was often incorrectly formulated as providing the feature of the claim, without realising that each dependent claim requires its own problem-solution analysis.

- 3.3 There was little explanation as to why and how the skilled person would combine the teachings of two documents. Having suggested a particular combination, candidates rarely considered the consequences. For example concerning claim 1, it was expected to explain how the floor-based system of Annex 4 could be adapted in light of the exit-finding means of Annex 3. A result of the failure to consider the practical consequences lead to many candidates combining Annex 4 with Annex 2 against claim 1; if they had considered that a realistic exit-finding means cannot be obtained by laying a fireman's hose down the aisle of an aeroplane, they would not have presented this attack.
- 3.4 There is still a tendency for candidates to make unsupported allegations concerning the general knowledge of the skilled person, and often candidates made submissions going beyond the information provided in the examination documents. An example of the latter is the argument that the housing for lights shown in Fig. 3 of Annex 4 would be detectable through the covering carpet. Some candidates also tried to introduce further prior art documents, such as DE19820228, a priority document for Annex 1, FR2712496, which is discussed in the introduction to Annex 1 (not realising that it is Annex 4), or US5236304, cited in A6, (not realising that it is Annex 3).
4. It should be emphasised that all relevant facts and arguments relating to the grounds of opposition should appear in the notice of opposition, and not in the "notes to the examiner".
5. Many candidates use personalised obscure abbreviations, the creation of which is time-consuming for the candidate and confusing for the examiner. References in the candidates' answer such as "see arguments under 4.2 and 1.2 above" can be confusing, since the previously made arguments may not be wholly relevant. That is not to say that a candidate cannot refer to arguments already presented. Examples might be: "the prior art for dependent claim 2 is Annex 4 for the same reasons as given for claim 1" or "in addition to the features set out in respect of claim 1, Annex 4 discloses...", or "... therefore claim 2 lacks an inventive step for the same reasons as given for claim 1".
6. Candidates should realise that some of the annexes may not be useable. This reflects the documents a representative might receive from a client, and also emphasises that the examination does not follow any set formula.

Legal Issues:

7. It is not necessary to answer the legal points in the form of an explanatory letter to the client. Rather than long explanations, concise answers addressed to a patent professional are acceptable and preferred.
8. In dealing with the legal points, candidates often do not answer the question asked, but see the question as an opportunity to write everything they know on the topic without coming to a conclusion based on the facts at hand; this shows a lack of ability to carry out legal analysis.

9. A number of candidates cited from older versions of the EPO Guidelines, whereas the Instructions to Candidates requires candidates to be familiar with, and cite from, the latest edition.

Specific Comments

Legal Issues [total 16 marks]

Use of Annex 2

Most candidates understood that Annex 2 can be assumed to reflect the oral disclosure, but few appreciated its value as a piece of evidence. Some candidates suggested calling the presenter as a witness, not realising that such evidence is considered as having a low probative value. Some candidates referred to the EPO Guidelines D V 3.2, and then went on to discuss the details set out in D V 3.2.3, rather than focusing on D V 3.3, which is more relevant to the situation described in the letter.

Withdrawal of Annex 6

This was generally answered well. Although mentioned by many candidates, the payment of fees is irrelevant. Some candidates nevertheless then went on to use Annex 6 in the Notice of Opposition.

Disclaimer

It should be noted that a specific question was being asked, and a further discussion of disclaimers, especially on pending Enlarged Board of Appeal Decisions was not required.

Priority

This again was generally well done, although many candidates failed to comment on the significance of the Italian priority that was specifically mentioned in the question. Often the legal authority supporting the candidate's conclusion was missing or incorrectly stated. Concerning claim 6, many candidates merely stated the claimed subject-matter was not disclosed in a priority document, rather than explaining that a particular feature (serrated surface) had not been disclosed. This inattention to detail results in a loss of marks.

Language for Filing

Candidates usually mentioned A.14(2)&(4) and understood the legal issues involved. Since the opposition could not be filed in Spanish, a discussion of fee reduction and translations was not necessary.

Notice of Opposition

(The first marks are for “use of information” and the second for “argumentation”.)

Claim 1 [9/12]

There was often no reason given for choosing Annex 4 as the closest prior art. Occasionally Annex 3 was cited as closest prior art, but since claim 1 clearly relates to an aircraft and Annex 3 concerns buildings, this was not considered to be the most appropriate choice.

Frequently candidates failed to recognise and explain the feature “passive”, and consequently found themselves in difficulty in forming an argument starting from the active lighting system of Annex 4.

The problem to be solved was usually formulated as the provision of a tactile means; this however is the solution. Candidates should be aware that the problem set out in the patent need not necessarily be the same as the objective problem; the latter is established only after the differences between the claimed subject-matter and the closest prior art have been determined.

Many candidates gave no reasons as to why the skilled person reading Annex 4 would also consult Annex 3.

Candidates rarely considered how the system of Annex 4 could be modified in light of the teaching of Annex 3. Failure to consider the consequences of combining prior art also lead most candidates to making an unreasonable attack based on Annex 4 and Annex 2.

Some candidates combined Annex 4 with tactiovisual aids used in aircraft cockpits, as mentioned in paragraph [03] of Annex 1. This attack was not appropriate, because these aids are not concerned with the problem in question, ie. with finding the way to an exit, but are merely used to locate the position and identity of switches.

Some candidates made a novelty attack based on Annex 4, arguing that the housing for the lights 30, as shown in Fig. 3 of Annex 4, could be felt through the carpet covering. There is no unequivocal teaching in either Annex 4 or any other document that this is the case; this argument was considered to be rather speculative.

Claim 2 [3/5]

Candidates were expected to interpret the claim and realise that the definition of a shoe is extremely broad. Few candidates considered the meaning of this feature, and the majority introduced Annex 2 into their answer, usually without explaining why they were basing an inventive step attack on three documents, namely Annex 4, Annex 3 and Annex 2.

Since the introduction of Annex 2 does not make any technical sense, as already mentioned, the attack Annex 4 and Annex 2 was also not considered to be reasonable.

Claim 3 [4/5]

Many candidates did not identify the exit signs above the seating depicted in Fig. 1 of Annex 4. Some candidates cited the prior art (FR2712496) mentioned in Annex 1, without realising that it was Annex 4.

Not all candidates realised that when attacking a dependent claim, they must attack all of the subject-matter, and since claim 3 depends on claim 1, this means that the features defined in claim 1 must also be taken into consideration. Thus the claimed subject-matter differs from Annex 4 in that tactiovisual means are provided above the seats, as well as on the floor; this was further hinted at by the use of the word “also” in claim 3.

Again, there was little explanation of the practical consequences of incorporating the tactiovisual strip of Annex 3 into the aircraft.

Claim 4 [13/11]

With very few exceptions, the candidate’s treatment of claim 4 was surprisingly poor. Few were aware of the basic concept that “for” is interpreted as “suitable for”, with the consequence that they missed the novelty attacks based on Annex 2 and Annex 3. Most candidates based a novelty attack on Annex 5, but usually failed to explain why the means of Annex 5 is passive.

Claim 5 [4/4]

This claim was attacked reasonably well. However, having identified the features disclosed in Annex 4, candidates sometimes failed to develop their argumentation. Some candidates argued incorrectly that Annex 4 discloses the range 80 -100°. There was no need to rely on case law relating to disclaimers that are introduced after filing.

Claim 6 [6/8]

Candidates’ treatment of this claim was generally well done. Some argued a lack of novelty stating that Annex 5 discloses a serrated surface, but this was rarely supported by any explanation as to why the surface could be considered as serrated. Some candidates referred to the prior art cited in Annex 6, not realising that this was Annex 4. Often there was no explanation of how the tape of Annex 3 could be incorporated onto a seat.

Possible Solution – Paper C

Legal Issues

1. Annex 2

It should be assumed that Annex 2, which is published after the priority date of Annex 1, reflects the oral disclosure made at the conference (see EPO Guidelines C IV 5.2 or D V 3.3 or B VI 6.2). Although it is worth making attacks based on Annex 2, the burden may fall upon the opponent to prove its accuracy. T1212/97 gives an indication of the type of evidence required for proving oral disclosure, for example, handouts given to the public at the lecture, or contemporary notes written by two members of the audience.

2. Withdrawal of Annex 6

A European patent application is state of art under A.54(3) only if in existence at time of publication (see EPO Guidelines C IV 6.1a or J5/81). Since Annex 6 was withdrawn prior to publication, it is not state of the art under A.54(3) for Annex 1, and since it was published too late, it cannot be state of the art under A.54(2).

3. Disclaimer

The disclaimer is allowable, because it is a feature that was in the original application. There is no added subject-matter under A.123(2) and therefore no attack under A.100(c).

4. Priority

Since the European patent application for Annex 1 was filed (on 03.05.1999) within 12 months of the earliest priority (FR9805910, dated 04.05.1998), the presence of the same subject-matter of claim 4 in the later Italian filing (IT98BO00034, dated 08.05.1998) does not affect the claim to priority (see EPO Guidelines C V 1.5 or A.88 EPC). The relevant date for claims 1-5 is 04.05.1998.

Concerning claim 6, the feature of a serrated surface was not disclosed in any priority document, hence the priority date is not validly claimed. The relevant date for claim 6 is the filing date of Annex 1, ie. 03.05.1999.

5. Language for filing

A notice of opposition is a “document” in the sense of A.14(4). Only persons referred to in A.14(2) can file an opposition in a “non-official language”, and since the opponent has neither residence nor place of business in a contracting state, he must file in an official language and cannot file in Spanish.

J15/98 concerns the filing of a patent application, not an opposition. In this case the application was filed in a language referred to in A.14 and received a filing date according to A.80 EPC, irrespective of the applicant’s place of residence.

Notice of Opposition

Claim 1 Annexes 4 and 3: Inventive Step A.56

Annex 4 is the closest prior art, because it is the only document describing an aircraft having a floor-based exit-finding system, (or is concerned with the problem underlying invention ie. evacuation from aircraft).

Annex 4 discloses an aircraft having a plurality of seats (13) arranged in rows (fig. 1). It has a floor system for finding an exit in the aircraft, namely a carpet, in which tufts 35 have a different colour to surrounding tufts 37, thereby indicating the direction to the exit; it is thus a means for identifying a direction to an exit by vision. The carpet is a passive system, because it relies on difference in carpet colour, and operates when the lighting system of **Annex 4** is not switched on.

The aircraft of claim 1 differs from that of **Annex 4** in that the system identifies the direction to the exit by touch, in addition to the visual indication (or in that the floor-based system is tactiovisual).

Starting from **Annex 4**, the problem to be solved is how to direct people to the exit when visibility is impaired.

Annex 3 is concerned with the problem of evacuation a building when visibility is impaired. Since evacuation of buildings and aircraft both involve escape from a confined space, the skilled person would consider the teaching of **Annex 3**.

Annex 3 teaches that when people have to escape in dense smoke, a strip that indicates direction by touch is advantageous (see English version: p.1, ls. 21 - 23 and p.2, ls. 4 - 6) or (French version: p.1, ls. 21 - 23 and p.2, ls. 5 - 8).

Applying the teaching of **Annex 3** to the aircraft of **Annex 4**, the visual carpet exit-indicating means of **Annex 4** would be adapted to provide tactiovisual indication. So, for example,

- (a) The carpet arrows could themselves be made tactile.
- (b) The tape of **Annex 3** could be laid alongside the carpet arrows.
- (c) The tape of **Annex 3** could be laid on top of the visual means of **Annex 4**; since the means of **Annex 3** is visual in addition to being tactile (see Fig.1), the result is a means that is both visual and tactile.

Claim 2 Annexes 4 and 3: Inventive Step A.56

Claim 2, dependent on claim 1, requires the means to be detectable through the sole of a shoe. Since claim 2 is defined very broadly with reference to all shoes, this is not a limiting feature.

Start from same closest prior art (**Annex 4**) as for claim 1. When the system of **Annex 4** is modified in light of the teaching of **Annex 3**, the resulting tactiovisual means would also be detectable through the sole of a shoe.

Claim 2 thus lacks inventive step with respect to **Annex 4** and **Annex 3** for the same reasons as given above for claim 1.

Claim 3 Annexes 4 and 3: Inventive Step A.56

Claim 3, dependent on claim 1, contains the further feature that a tactiovisual means is provided above seat level in addition to those on the floor.

Start from same closest prior art (**Annex 4**) as in claim 1. Fig. 1 of **Annex 4** shows exit signs placed on the luggage rack of an aircraft; this is in addition to the exit-finding system on the floor.

The subject-matter of claim 3 differs from that of **Annex 4** in that both the visual means on the floor and the visual means above the seat level are tactile (or in that tactiovisual means are provide both on the floor and above the seat level).

Starting from **Annex 4** the problem to be solved is to have an aircraft with a means for evacuating people who are standing up in poor visibility, in addition to having a means for people crawling.

Annex 3 teaches that exit route indication signs should be both tactile and visual, thus it would be obvious to make also the signs on the luggage rack of **A4** tactiovisual.

Claim 4 Annexes 2, 3 and 5: Novelty A.54(2) & (3)

A “system for finding an exit in a structure, said structure having a plurality of seats arranged in rows” is interpreted as “system suitable for... rows” (see EPO Guidelines C III 4.8 or C IV 7.6).

(a) Annex 2: Novelty A.54(2)

It is assumed that Annex 2, which is published after the priority date of Annex 1, reflects the oral disclosure made at the conference (see EPO Guidelines C IV 5.2 or D V 3.3 or B VI 6.2).

The subject-matter of claim 4 lacks novelty with respect to Annex 2, which discloses a hose (2) that is suitable for finding an exit in a structure having a plurality of seats. The hose (2) has rings (4), and forms a system comprising a plurality of passive, tactile means (the rings are felt through a glove), the inclined rings are large enough to see which way they are pointing, and visually identify the direction to the exit (water supply).

(b) Annex 3: Novelty A.54(2)

The subject-matter of claim 4 lacks novelty with respect to **Annex 3**, which describes a system for finding an exit in buildings (English or French versions: p.1 ls. 18 - 19); the system is suitable for finding exit in a structure having a plurality of seats arranged in rows. It is passive since it does not require any power supply. Fig.1 of **Annex 3** shows elements (2) having points, which visually indicate direction of exit. The tape is also tactile (English version p.1, ls. 26 – 28, or French version p.1, ls. 26 - 29), and the direction to exit is indicated by following the smooth direction of tape.

(c) Annex 5: Novelty A.54(3)

Annex 5 is relevant for novelty A.54(3) for those states in common (DE, ES, FR, GB, IT, NL).

Annex 5 discloses a system for finding an exit in a structure eg. cinema having a plurality of seats arranged in rows (German version p.2, ls. 21 - 25 or English version p.2, ls. 19 - 22). The devices (10) are passive, because the arrow shape of the device alone indicates the direction; although they glow in the dark, they have no electrical supply, and hence are passive within the meaning set out in the description of **Annex 1**. The devices show the exit direction by touch (German version p.2, ls. 8 – 12 or the claim; English version p.2, ls. 6 – 11 or the claim) and vision (German version p.1, ls. 29 - 31 or p.2, ls. 1 – 2 ; or English version p.1, ls. 29 - 30 or p.2, ls. 1 - 2).

Claim 5 Annex 4: Inventive Step A.56 or Novelty A.54

Annex 4 discloses use of v-shaped elements in aircraft for visually indicating route to exit. The elements have straight legs and apex angle of 90° (German or French versions: Figs. 1 & 2; p.2, ls. 2 - 4). The difference between the subject-matter of claim 5 and that of **Annex 4** is the definition of apex angle, given in claim 5 as 80° to 100° excl. 90° .

Inventive Step (A.56):

The problem to be solved is to provide an easily recognisable symbol that can be distinguished from scratches on the floor. There is no technical advantage between a v-shape having a 90° angle and one having an angle close to 90° .

Annex 1, paragraph 7, states that an apex angle in all of the range 80° to 100° brings about the desired technical effects.

OR:

Novelty (A.54):

Point-like disclosures can be interpreted as having a range of tolerance, in view of known fluctuations in reproducibility. 90° disclosed in **Annex 4** can therefore be interpreted as disclosing values that fall within the range of claim 5.

Claim 6 Annex 5 + Annex 3: Inventive Step A.56

Annex 5 is state of art under A.54(2), because the priority is not validly claimed, serrated surface was not disclosed in any of the priority documents.

Annex 5 is considered to be the closest prior art because it discloses a seat that is provided with devices (10), which are a passive tactiovisual means for indicating the direction to the exit by touch and vision (Fig. 3 and in the German version p.2 ls. 1-2 & 7-12; or in the English version p.2, ls. 1-2 & 6-11).

The seat of claim 6 differs from **Annex 5** in that the tactiovisual means have a serrated surface.

Starting from **Annex 5**, the problem to be solved is how to improve detection, by touch, of the exit direction.

Annex 3 discloses a tape having a series of projections, which in combination, provide a serrated surface (Fig. 2). This surface improves detection of direction because it provides an immediate indication when touched at any point on the surface (see English or French versions p.1, ls. 26-30). The tape of **A3** is made from a material suitable for attachment to a seat (see English version p.2, ls. 11-13 or French version p.2, ls. 14-6).

Applying the teaching of **Annex 3** to the seat of **Annex 5**, the skilled person would either replace or supplement the device (10) with a tape of the type described in **Annex 3**, in expectation of improving detection by touch, thus deriving the subject-matter of claim 6.

EXAMINATION COMMITTEE II

Candidate No.

Paper C 2003 - Schedule of marks

Category	Maximum possible	Marks awarded	
		Marker	Marker
Use of information	39		
Argumentation	45		
Legal aspects	16		
Total	100		

Examination Committee II agrees onmarks 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, 14 July 2003

Chairman of Examination Committee II