

Examiners' Report - Paper C 2007

General Comments

1. This year's paper focussed on two key aspects: the selection of the closest prior art document for a proper problem-solution approach and the issue of priority.
2. It is established case law that the closest prior art for assessing inventive step is normally a prior art document disclosing subject-matter conceived for the same purpose or aiming at the same objective as the claimed invention and having the most relevant technical features in common. In order to identify the closest prior art document it was necessary to take into account the whole teaching of documents including negative statements. In particular the indications in Annex 3 that the container is not suitable for hot liquids and in Annex 4 that plastics should not be used were often disregarded.
3. The different effective dates for the two alternatives in claim 5 were generally recognized. However, the significance of Annex 2 for the loss of priority of claims 1 and 7 was often missed.
4. Marks were awarded for specifically identifying claim features together with their specific location in the prior art documents which are relevant for the respective attacks. This level of detail is expected and applies to both novelty and inventive step attacks.
5. The problem-solution approach is increasingly being adopted. However, a good approach requires (amongst other things) identifying the closest prior art and justifying its selection for each inventive step attack, i.e. for both independent and dependent claims. This applies, for example, to claim 4 where Annex 5 and not Annex 4 is the closest prior art document. Reasoning is also expected on how the features from two documents would be feasibly combined.
6. A fundamentally flawed approach to dependent claims involved identifying their additional features and comparing them with respect to the closest prior art in isolation, rather than in combination with the features of the claims on which they are dependent. For example, merely stating "claim 3 adds..." . This often led to an incorrect inventive step argument.
7. All relevant facts and arguments relating to the grounds of opposition should appear in the notice of opposition, and not only in the letter to the client or in a note to the examiner.

Specific Comments

Notice of opposition

Priority

Candidates generally recognized that the feature rubber was not supported by the priority document and the rubber alternative of claim 5 had therefore as effective date the filing date. However, few candidates made use of the information that Annex 2 was filed by the same applicant as Annex 1 and disclosed the subject-matter of claims 1 and 7. Thus the majority missed that the subject-matter of claims 1 and 7 was not entitled to priority.

Claim 1

Any attacks starting from Annex 3 were not awarded marks, because the receptacle of Annex 3 is not suitable for hot liquids. Most candidates recognized that the expression “for hot liquids” has to be regarded as suitable for hot liquids. The significance of the expression “suitable for” however was often disregarded. Some argumentation was expected concerning the significance of “hot” defined in the description of Annex 1.

Claim 2

Any attacks starting from Annex 3 were not awarded marks, because the receptacle of Annex 3 is not suitable for hot liquids. It deals with another problem and cannot be the closest prior art document. Annex 4 is the closest prior art document, because it is directed to a receptacle for hot (i.e. above 50 C°) liquids and addresses the problem of the heat insulation. Candidates who correctly used Annex 4 as closest prior art often overlooked that it provides a thermally insulated grip area in the form of a handle and therefore already solves the technical problem of protecting the fingers from the heat of the receptacle.

Claim 3

Claim 3 is dependent on claim 2 and Annex 4 is again the closest prior art document. Any attacks starting from Annex 3 or Annex 5 were not awarded marks. The receptacle of Annex 3 is not suitable for hot liquids. The receptacle of Annex 5 is not a drinking cup and it has a significantly different rim dimension.

Claim 4

The closest prior art document is Annex 5 because it is the only document that relates to a plastics receptacle for hot liquids. It addresses the problem of standing stably and provides a solution therefor. Annex 4 cannot be the closest prior art document for the subject-matter of claim 4, because this document teaches not to use plastics.

Any attacks starting from Annex 3 or Annex 4 were not awarded marks.

Claim 5

The claim could not be attacked under Article 52(2) EPC, because the claim includes technical features. Claim 5 is dependent on claim 3 and Annex 4 is closest prior art for the same reasons as set forth for claim 3. Any attacks starting from Annex 3 or Annex 5 were not awarded marks.

Claim 6

When Annex 4 was correctly used as closest prior art it was not always recognized and argued that the bulge is suitable for preventing the cup slipping through the sleeve element of e.g. Annex 3. Any attacks starting from Annex 3 or Annex 5 were again not awarded marks.

Claim 7

A novelty attack with Annex 2 was expected. Annex 3 does not destroy the novelty of claim 7 as it does not clearly and unambiguously disclose the height dimension of the sleeve element. However, an inventive step attack based on Annex 3 was considered to be an acceptable alternative. While the receptacle of Annex 3 is not suitable for hot liquids, the sleeve element is suitable for a receptacle for hot liquids. (Annex 3 states that the sleeve protects against heat and cold, alternatively Annex 1 states that a cardboard sleeve is suitable for a receptacle for hot liquid).

Legal Issues

The legal questions were generally well answered. However, some candidates did not appear to correctly appreciate the difference between the extent of opposition and the grounds of opposition. Clear answers to the client's questions were expected. It was insufficient to state all possible alternatives without coming to a conclusion.

Possible Solution – PAPER C 2007

Notice of opposition

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

Priority and state of the art (4/3):

The priority right applies only for the same subject-matter disclosed in the priority document and claimed in the patent (Art. 88(3) EPC or G2/98). Since there is no hint to rubber in the priority application, the subject-matter of claim 5 with the alternative rubber does not enjoy the priority right.

Annex 2 was filed before the priority date and published between the priority and the filing dates of Annex 1.

Annex 2 discloses all the features of the subject-matter of claims 1 and 7, cf. attacks on claims 1 and 7. Since the applicant of Annex 2, Food Containers Inc., is also the applicant of Annex 1, the priority document of Annex 1 is not the “first” application belonging to this applicant for the subject-matter of claims 1 and 7. Priority for claims 1 and 7 is therefore not valid (Art. 87(1) EPC or Guidelines C-V, 1.4).

For those claims for which the priority is not valid, Annex 2 is prior art (Art. 54(1), (2) EPC).

All other claimed subject-matter is entitled to the priority date.

Claim 1, independent (9/2):

Interpretation of claim 1:

Claim 1 contains the relative terms “hot” and “thin” which do not have a well-recognized meaning. According to Annex 1, paragraph [0003], line 2, a liquid is regarded as a hot liquid when it has a temperature above 50°C. This definition in the description has to be used to determine the extent of the protection of claim 1 (Art 69(1) EPC). The description of Annex 1 does not provide any hint as to how thick a thin wall should be. The term “thin” has therefore no limiting effect (see Guidelines C-III, 4.5, last sentence).

Lack of novelty, Art 54(2) EPC, in view of Annex 2:

Annex 2 discloses a receptacle for hot liquids (*cooking utensil* which is suitable for hot liquids, see paragraph [0001]); a circular base 29 (see paragraph [0002] and figure); a thin wall (25, cf. paragraph [0002]) with a circular rim at an open end of the receptacle (cf. figure, paragraph [0002], Annex 2 discloses a *circular wall* which means that the rim is also circular); and a grip area 22, which is thermally insulated from the wall of the receptacle (the grip area is formed by the surface of a thermally insulating material 22 (cf. claim and figure), or the insulating material 22 is fixed to the pot's wall by a metal portion of low thermal conductivity, see paragraph [0002], line 3; thus the grip area is thermally insulated from the pot's wall).

Lack of novelty, Art 54(2) EPC, in view of Annex 4:

A4 discloses a receptacle 41 (e.g. paragraph [0003], line 1) for hot liquids (cf. paragraph [0006], line 3, *filled with boiling liquid*); a circular base 47 (cf. claim or paragraph [0003]), thin wall (see paragraph [0003], line 1, claim) with a circular rim 46 at an open end 40 of the receptacle (see paragraph [0004] and claim; since the base is circular it is evident from the figure that the rim is also circular); and a grip area (surface of a handle, see paragraph [0006], line 1), which is thermally insulated from the wall of the receptacle (*does not become hot*, see paragraph [0006], line 3).

Claim 2, dependent on claim 1 (6/5):

Lack of inventive step, Art 56 EPC, in view of Annex 4 and Annex 3:

Annex 4 is the closest prior art document, because it is directed to a receptacle for hot (i.e. above 50 C°) liquids and addresses the problem of the heat insulation.

As discussed above, Annex 4 discloses all the features of claim 1.

The subject-matter of claim 2 differs from the receptacle of Annex 4 in that the insulated grip area is realized by a sleeve element of thermally insulating material that is put around the outer surface of the wall. Annex 4, paragraph [0006] describes that the receptacle with the integrated handle needs more care during handling.

The sleeve element provides therefore the effect that the insulated grip area can be applied any time when needed (*applied shortly before use*; see Annex 1, paragraph [0007], lines 3-5).

The subject-matter of claim 2 therefore solves the problem to provide the cup with an insulated grip area that can be easily mounted or removed.

Annex 3, relating to the same area of small hand-held receptacles of similar shape, addresses the problem of how an insulated grip area can be provided when needed (see paragraph [0003]). Annex 3 discloses a strip of thermally insulating cardboard (see paragraph [0004] where it is disclosed that cardboard insulates the hand from the low temperature of the beverage and the beverage from the high temperature of the hand, therefore it is clear that cardboard also protects from higher temperatures), which can be put around the outer wall surface of a drinking container to form a sleeve (see paragraph [0003]). The strip of cardboard is easily fixed by pressing end portions against each other (see paragraph [0003], line 4).

For a person skilled in the art it is evident that the thermally insulating strip of Annex 3 can easily be applied in the same manner to the drinking container of Annex 4 when needed, instead of the permanent handle.

Claim 3, dependent on claim 2 (2/5):

Lack of inventive step, Art 56 EPC, in view of Annex 4 and Annex 3.

Annex 4 is the closest prior art document because it is the only document that is directed to a drinking cup for hot liquids and that addresses the problem of the heat insulation.

As discussed above, Annex 4 discloses all features of claim 1. It further discloses that the receptacle is a drinking cup (drinking container 41, see paragraph [0003] or title). The wall of the drinking container has a thickness of about 4 mm (see paragraph [0003], line 5), therefore the rim also has a width of about 4 mm. This width lies in the range required by claim 3.

The subject-matter of claim 3 differs from Annex 4 by a sleeve element of thermally insulating material that is put around the outer wall of the cup, which is the same difference as for claim 2. The subject-matter of claim 3 does therefore not involve an inventive step for the same reasons as set forth for claim 2.

Claim 4, dependent on claim 1 (9/10):

Lack of inventive step, Art 56 EPC, in view of Annex 5, Annex 3 and Annex 4.

The closest prior art document is Annex 5 because it is the only document that relates to a plastics receptacle for hot liquids.

Annex 5 discloses a receptacle suitable for hot liquids, i.e. $>50^{\circ}\text{C}$ (*pour boiling water*, paragraph [0003], line 2) with a circular base 50 (see paragraph [0004] and claim, since the wall is circular the base is also circular); a thin wall 51 with a circular rim 52 at an open end of the receptacle (see claim: since wall is circular the rim is also circular); a grip area (a portion of the wall 51 where it is held, cf. [0005]); base, wall and rim are made of plastics (see paragraph [0004], line 3. The base is sufficiently thick to assure a stably standing receptacle (see paragraph [0004], lines 4-5).

The subject-matter of claim 4 differs from Annex 5 in that the grip area is thermally insulated from the wall and in that the outer surface of the base has a recessed area at a central portion.

Concerning the distinguishing feature of the insulated grip area:

The effect of the insulated grip area is to protect the fingers from the hot wall when the receptacle is held (cf. Annex 1, paragraph [0003], lines 5-6).

This distinguishing feature of the subject-matter of claim 4 therefore solves the partial problem to protect the holding hand thermally from the wall of the pot.

Concerning the distinguishing feature of the recessed base:

The effect of the recessed base is to produce a stable-standing cup more easily (A1, [0010], last line).

The recessed base therefore solves the partial problem to find an easier way to achieve a stably standing pot.

The two partial problems are independent problems (insulation and stability) and can be solved separately. There is no synergistic effect. Cf. Guidelines C-IV, 9.5 .

Concerning the problem solved by the insulated grip area:

Annex 3 is a document in the same area of small hand-held receptacles and addresses this problem (see paragraph [0003]). As already set forth in the attack for claim 2, Annex 3 discloses a strip of thermally insulating cardboard that is easily fixed on a receptacle by pressing end portions against each other. To solve the above problem the person skilled in the art would put the layer of cardboard of Annex 3 around the receptacle of Annex 5 in the same way. This could be done without any inventive step.

Concerning the problem solved by the recessed base:

Annex 4 also relates to small receptacles for hot food liquids and Annex 4 also addresses the above problem (see paragraph [0005], *stands very stably*).

Annex 4 proposes a concave base that is in contact with the flat surface only at a small circular portion close to the periphery of the base (see paragraph [0005]).

This teaching can also be applied to the plastics pot of Annex 5. The person skilled in the art would modify the base of the pot to a concave shape, without an enforced base. This can be done without any surprising effect or difficulty.

Claim 5, dependent on claim 3 (6/12):

Alternative with cardboard:

Lack of inventive step, Art 56 EPC, in view of Annex 4 and Annex 3.

The closest prior art document is Annex 4 (hot liquid, drinking cup) as for claim 3.

Annex 4 discloses all the features of claims 1 and 3 (see above).

The subject-matter of claim 5 (cardboard) differs from Annex 4 in that the insulated grip area is realized by a thermally insulating sleeve element of cardboard which sleeve element is provided with a coloured design.

Concerning the feature that the cardboard is provided with a design:

This design feature does not involve any technical aspects (effect, problem, creation) and has to be regarded as a pure aesthetic feature. This feature is therefore not relevant for assessing inventive step (cf. Guidelines C-IV, 9.8.2, paragraph 2).

Concerning the feature that the grip area is realized by an insulating sleeve applied around the cup: Same argumentation as for claim 2 above (Annex 4 and Annex 3).

The insulating sleeve element of Annex 3 is made of cardboard (see paragraph [0003], line 3 or claim). Thus, when the handle of Annex 4 is replaced by the sleeve of Annex 3, it is necessarily of cardboard.

Alternative with rubber:

Lack of inventive step, Art 56 EPC, in view of Annex 4 and Annex 6.

The closest prior art document is Annex 4 because it is the only document that relates to a drinking cup for hot liquids having circular base and rim.

The features of claims 1 and 3 are known from Annex 4 (see above).

The subject-matter of claim 5 (rubber) differs from Annex 4 in that the insulated grip area is realized by a thermally insulating sleeve of rubber which sleeve element is provided with a coloured design.

The design feature is not relevant for assessing inventive step (cf. above).

The rubber sleeve element has the effect to provide an insulated grip area any time it is desired (*applied shortly before use*, see Annex 1, paragraph [0007], lines 3-5).

The subject-matter of claim 5 therefore solves the problem to provide the cup with an easy to mount/remove insulated grip area that is applied when needed.

Annex 6 is a document that also deals with hand-held cups and addresses the same problem (see paragraph [0003]). It discloses a broad rubber band (cf. paragraph [0003], line 2). This rubber band can be put around the outer wall of a rectangular cup at a grip area thereof to protect the fingers from the wall heat (see paragraph [0003]) when needed. It remains attached to the cup because of the elasticity of the rubber material (see paragraph [0003], line 4).

The person skilled in the art recognizes that this proposed solution for the above problem can easily be applied likewise to the cup of Annex 4 to replace the handle. The rubber band wound around the cup of Annex 4 has the general form of a sleeve element.

Claim 6, dependent on claim 2 (3/4):

Lack of inventive step, Art 56 EPC, in view of Annex 4 and Annex 3.

Annex 4 is the closest prior art document because it is the only document that is directed to a drinking cup for hot liquids.

As discussed above, it discloses all the features of claim 1.

The receptacle of Annex 4 is a drinking cup (see e.g. title) having an annular portion of increased diameter (*annular bulge 44*, see paragraph [0003]). The annular portion of increased diameter is suitable to prevent the cup slipping through a sleeve element: The annular bulge 44 protrudes from the wall of the drinking container so that the bulge of an upper container rests on the upper rim of the lower container (cf. paragraph [0004]). These dimensions of the annular bulge would prevent that the cup slips through a sleeve element e.g. of Annex 3.

The subject-matter of claim 6 differs from Annex 4 by a sleeve element of insulating material around the wall of the receptacle (as in claim 2). For a person skilled in the art it is obvious to provide the receptacle of Annex 4 with the sleeve element of Annex 3 for the same reasons set forth for claim 2.

Claim 7, independent (3/6):

Lack of novelty, Art 54(2) EPC, in view of Annex 2:

Annex 2 discloses an element of thermally insulating material 22 (see claim), which has the form of a sleeve because the insulating portion 22 has a tubular shape (cf. paragraph [0003], line 2); it is suitable for a receptacle for hot liquids (Annex 2 discloses a cooking utensil to which the insulating material can be attached, see paragraph [0002]); the insulating material 22 has a thickness of at least 0.5 cm (see paragraph [0003], outer diameter is 3 cm and the hole has a maximum diameter of 2 cm, which results in a wall thickness of at least 0.5 cm). This falls in the claimed range of at least 2 mm; and the element of thermally insulating material has a height in axial direction of more than 5 cm (the figure shows that the portion of insulating material is longer than the shield portion 26. The shield portion extends 5 cm under the insulating handle grip, see paragraph [0002], line 6). This falls in the claimed range of at least 3 cm.

Legal issues (11):**Claim 6:**

Claim 6 cannot be attacked on the ground of added subject-matter. Art.100(c) / 123(2) EPC relates to the content of the application as filed, i.e. including the description. At paragraph [0008], in combination with the previous paragraphs, the features of claim 6 are already disclosed.

Annex 6:

German utility models are publicly available as of their date of entry in the Register of utility models ("Eintragungstag", see Guidelines C-IV, 5.1). Annex 6 is therefore published before the filing date of Annex 1 and can be used for those claims for which the priority is not valid.

Extent of opposition:

Subject-matter of an independent claim not attacked by an opponent in his notice of opposition is not subject to any "opposition" (cf. G9/91 or Guidelines D-V, 2.1). After expiry of the opposition period an opponent therefore cannot widen the extent of opposition to include the subject-matter of independent claim 7, nor has the opposition division any competence to examine such an unopposed independent claim of its own motion (Art.114(1) EPC). Claim 7 should therefore be attacked.

Authorization:

A professional representative does not need a written authorization to file an opposition (cf. Guidelines A-IX, 1.1, 1.5 or Rule 101(1) EPC or OJ 1991, 489).

EXAMINATION COMMITTEE II

Candidate No.



Paper C 2007 - Schedule of marks

Category	Maximum possible	Marks awarded	
		Marker	Marker
Use of information	42		
Argumentation	47		
Legal aspects	11		
Total	100		

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)

06 July 2007