Examiners' Report - Paper C 2008

General Comments

1. In general, marks are awarded for identifying relevant information, i.e. claim features, technical effects and hints. However, in order to gain full marks the specific location in the respective documents must be cited. Moreover, where features are disclosed using different terms it should be justified why these are equivalent. This level of detail is expected and applies to both novelty and inventive step attacks.

2. The problem-solution approach was generally applied. However, a good approach still 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.

3. When attacking dependent claims it should be borne in mind that the closest prior art might no longer be the one that was used against the main claim and that therefore the additional features of the dependent claims should always be compared with the closest prior art (whether new or the first used). Relating such features just to the claim(s) on which they are dependent by, for example, merely stating “claim 5 adds …” and then automatically taking these features as the only distinguishing features with respect to the previously used closest prior art, often lead to false conclusions and loss of marks.

4. It is expected that the reason why certain documents can be combined is explained. Further justification is needed when combining more than two documents.

5. 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.

6. As set out in the instructions to candidates, it is advisable to use the form 2300 in order to make sure that all information needed for an admissible opposition is given (R. 77 EPC). For the opposition to be admissible it is required that the patent to be opposed is identified, that the opponent is identified and that the fee payment is indicated. Failure to indicate these aspects resulted in marks being lost.

Specific Comments

Client's Letter:

Clear answers to the client's questions were expected. It is insufficient to state all possible alternatives without coming to a conclusion.

The overall idea behind the client's letter was to test the candidates' ability to assess the quality and availability of evidence. In this context it was positive to see that nearly all candidates realised that Annex 6 can be used as evidence.

Marks were awarded for indicating that it is established practice of the EPO to accept declarations as evidence following the principle of free evaluation of evidence, cf. Guidelines E-IV, 1.2 (see also T 970/93, reasons 2.8 or T 770/91, reasons 3.). Well-argued answers assuming that the declaration was sworn and relying on Art. 117(1)(g) EPC as legal basis were also awarded marks.

The fact that Annex 6 does not contain all the information usually required for evidence cf. Guidelines D-V, 3.3. was often ignored.

It was often assumed that the witness will need to be heard, but the reasoning was sometimes vague.

It was, however, well recognised that Dr. Blackmore, i.e. the witness himself, may request to be heard in a competent court of his country of residence.

It was expected that the client would be advised that the introduction of further dependent claims is not allowable under Rule 80 EPC. However, it was often argued that further dependent claims may be introduced as long as these do not violate Art 123(2) EPC. On the other hand it was often argued that introducing such claims would in any event violate Art. 123(2) or even Art. 123(3) EPC.

It was often realized that claim 3 cannot validly be attacked under Art. 52(2)(d) EPC since the claim contains a mix of non-technical and technical features.

Marks were often lost in giving an answer without citing the correct legal basis or by drawing the wrong conclusions from the otherwise correct legal basis.

Claim 1:

The novelty attack based on the cooking oven disclosed in fig. 2 of Annex 5 was often missed. When the attack was made it was often omitted to explain why the oven is in fact suitable for sterilisation. It should have been noticed from Annex 1 that 100 °C is enough to kill most common germs.

Nearly all candidates made an inventive step attack starting from Annex 4 as closest prior art and made the correct combination with Annex 2. Arguments were expected that an additional window had to be provided or the one being present had to be modified.

A novelty attack using Annex 4 was not possible since the window disclosed is not suitable for viewing the object to be sterilised.

Claim 2:

The attack on claim 2 was generally done well. However, it was often not shown why the valve of Annex 4 is a control means for controlling the supply of sterilising agent into the chamber.

The same number of marks was awarded for raising the inventive step attack regardless whether claims 1 and 2 were attacked independently or together.

Claim 3:

According to T553/02 instructions of the kind in claim 3 are non-technical features. The decision further confirms that such features may be disregarded when assessing novelty. Other decisions confirm that non-technical features may be disregarded when assessing inventive step.

Well-argued attacks for lack of inventive step based on Annex 2 alone and stating that the additional features provide no technical effect were awarded the same number of marks as novelty attacks.

Marks were also awarded for noticing that the instructions may have any form and that Annex 2 itself could be seen as constituting instructions, provided that the relevant passages were indicated.

Claim 4:

It was often realised that the disclosure of the colour change from white to black in Annex 3 was not an enabling disclosure. Nevertheless, it was often omitted to give a proper explanation that Annex 3 discloses a barcode capable of changing colour when subjected to a chemical sterilising agent, namely Alu-B which responds to hydrogen peroxide. According to Annex 1 or Annex 6 hydrogen peroxide is a chemical sterilising agent.

Marks were also awarded for defining the problem to be solved as being “providing enablement for the colour change from white to black”.

Claim 5:

Claim 5 was generally handled well by the candidates. Nevertheless, it was often omitted to point out that there are two differences over the closest prior art and proper reasoning as to why a combination of more than two pieces of prior art is possible was often lacking. For example, the fact that two separate problems needed to be solved.

Claim 6:

The feature “simultaneously” was rarely identified. Moreover, an explanation as to why the range 100-120 degrees in Annex 5 is a clear disclosure of “at least 105 degrees” was expected. Arguments that the range 100 to 120 degrees overlaps with the open-ended range “at least 105 degrees” or that the end-point 120 degrees falls within said range were accepted.

It was realised by many that the claim contained two alternatives, but surprisingly few managed to provide a full argumentation in respect of both alternatives.

Claim 7:

The fact that claim 7 inherently also relates to two alternatives since it is dependent on claim 6 which pertains to two alternatives was rarely commented upon.

The fact that the hydrogen peroxide defined in claim 7 is gaseous in view of claim 6 was often overlooked.

Possible Solution - Paper C 2008

Response to the client's letter:

1. Yes, Annex 6 can be used. It is an unsworn declaration by Dr. Blackmore. Although such declarations are not mentioned in the non-exhaustive list of admissible evidence according to Art. 117 EPC, they can be used as evidence cf. Guidelines E-IV, 1.2. See also for instance T 970/93, reasons 2.8 or T 770/91, reasons 3.

Nevertheless, Annex 6 does not comprise all the information required by the EPO for accepting evidence cf. D-V, 3.3, i.e. concerning the circumstances of the publication e.g. where and when the publication took place and who was present. See also D-V, 3.1.2 and 3.2.3. This information should be obtained and submitted to the EPO as soon as possible.

2. No, in case of dispute over evidence of the present kind and where a witness has been offered, the EPO will summon the witness before a decision based on such evidence is taken against the contesting party. See E-IV, 1.2 or T474/04.

3. Yes, if he is summoned to appear as witness, Dr. Blackmore can request to be heard by a competent court in his country of residence cf. R. 120(1) and Art. 131(2) EPC. See also E-IV, 3.2.2(iv), E-IV, 1.5(iii).

4. No, according to R. 80 EPC amendments can only be made in order to overcome a ground of opposition according to Art. 100 EPC. Since the introduction of additional dependent claims cannot be occasioned by a ground of opposition, the patent proprietor will not be allowed to introduce further dependent claims. See also for instance T794/94, T674/96 or D-IV, 5.3.

5. No, Art. 52(2)(d) EPC does not apply to claim 3 because the claim does not relate to presentation of information as such (Art. 52(3) EPC). According to the decision T553/02 a product comprising instructions for use as in claim 3 constitutes a mix of technical and non-technical features and thus cannot be invalidated using Art. 52(2)(d) EPC. See also for instance T931/95 or C-IV, 2.2 & 2.3.7.

{Marks awarded: 11}

Notice of opposition:
Use of Information 39 Marks/Argumentation 50 Marks

As visible from Annex 6, a document, in the form of a chapter of a book called “Guidelines for sterilisation” and which document is repeated in Annex 6, was handed out to members of the public prior to the filing date of Annex 1. The handing out of the document was done at a public conference. Accordingly, it is submitted that the chapter of the book reproduced in Annex 6 is prior art under Art. 54 EPC. Further evidence concerning the circumstances such as where the conference took place, the exact date thereof and to whom the chapter was handed out will be provided at a later stage. We hereby offer Dr. Blackmore as witness to confirm any further details.

{Marks awarded: 3/3}

Lack of novelty of claim 1 over Annex 5:

Claim 1 defines an apparatus for sterilising. This is interpreted as meaning an apparatus “suitable for sterilising” (C-III, 4.13 or C-IV, 9.7).

Fig. 2 of Annex 5 discloses an electrical cooking oven which is “set at 120 degrees” [page 3, line 7]. 120 degrees can be used for sterilisation as evidenced by Annex 1, §4. Hence, although the oven is not disclosed in the context of sterilisation, it is considered to be an apparatus which is “suitable for” sterilisation (C-III, 4.13 or C-IV, 9.7).

Supported by the corresponding text, fig. 2 of Annex 5 also shows the remaining features of claim 1:
An oven compartment is visible from fig. 2 and will inherently be a chamber “suitable for” sterilising. The expression “electrical oven” [page 3, line 7] implies an electrical source of heat, capable of raising the temperature within the chamber. Reference 5 of fig. 2 is mentioned in the description of the figure in the context of the temperature setting and can accordingly be considered to be a “means for setting the temperature”. Fig. 2 also discloses a glass door [fig. 2, ref. 6] and a tray for accepting an object (e.g. fast food) to be sterilised [fig. 2, ref. 7], said tray being situated within the chamber. Since the fast food preparation can be seen on the tray through the glass door [fig 2, ref. 6, page 3, line 6] it constitutes a “window suitable for viewing the object on the tray while being sterilised”.

In conclusion claim 1 lacks novelty over Annex 5, figure 2 (Art. 54 EPC).

{Marks awarded: 7/7}

Lack of inventive step of claim 1 over Annex 4 in combination with Annex 2.

Annex 4 is the closest prior art since it discloses an apparatus for the same purpose of sterilising, which apparatus has a significant number of features in common with claim 1, i.e. Annex 4 discloses:

An apparatus for sterilising [claim 1, fig. 2 or §1], comprising a chamber [§2] with a door [fig. 2, reference 2], an electrical source of heat to raise the temperature within the chamber [§2], a temperature control knob, i.e. a means for setting the desired temperature [fig. 2, ref. 4], and having a tray within the chamber for accepting the articles to be sterilised [§2].

The difference of claim 1 over Annex 4 is a window suitable for viewing the object on the tray, which has the technical effect of allowing the operator to see “if anything goes wrong within the apparatus” [see Annex 1, §2]. Accordingly, the problem to be solved is “how to allow the operator to see if anything goes wrong within the apparatus”.

Annex 2 is a journal disclosing new trends in the technical field of sterilisation. Accordingly, it is a relevant source of information for the person skilled in the art of sterilisation. Annex 2 discloses how to solve the problem in question [last §, last sentence]. The solution is the provision of a transparent panel which allows for monitoring if anything goes wrong within the apparatus. Therefore the panel is a window in the sense of the contested invention. There is no particular hindrance for integrating the window of Annex 2 in the apparatus of Annex 4.

Hence, the subject-matter of claim 1 lacks an inventive step over the combination of Annex 4 with Annex 2 (Art. 56 EPC).

{Marks awarded: 6/5}

Lack of inventive step of claim 2 over Annex 4 in combination with Annex 2.

Claim 2 is dependent on claim 1.

Annex 4 remains closest prior art for the reasons above and since it also discloses all the remaining features of claim 2 for the same purpose. In addition to the features mentioned above Annex 4 discloses that the apparatus is hermetically sealable [Annex 4, §1]. Moreover, it discloses a source of chemical sterilising agent [Annex 4, §1 or fig. 2, ref. 6] and a valve in the line between the apparatus and said source for controlling the supply of chemical agent [Annex 4, fig. 2, ref. 7]. A valve is a “control means” in the context of the contested invention [see Annex 1, §5].

Therefore claim 2 differs from Annex 4 by the same features as claim 1 and the subject-matter of claim 2 lacks an inventive step for the same reasons as claim 1 (Art. 56 EPC).

{Marks awarded: 2/2}

Lack of novelty of claim 3 over Annex 2:

Claim 3 is an independent claim and concerns a product comprising an aqueous ink and instructions for using the ink.

According to T553/02 instructions for use of the present kind are non-technical features which can be disregarded when assessing novelty.

Annex 2 discloses indicator systems, which are products. The indicator systems comprise indicator materials which are diluted with water [Section 4, 1st §], i.e. they can be formulated as aqueous inks and they are capable of changing colour when subjected to a sterilising agent [see e.g. section 1].

Accordingly the subject-matter of claim 3 lacks novelty over Annex 2 (Art. 54 EPC).

{Marks awarded: 2/4}

Lack of inventive step of claim 4 over Annex 3 in combination with Annex 2:

Annex 3 is the closest prior art because it is the only document concerned with the same purpose as claim 4 of providing self-adhesive labels with codes capable of changing colours.

Annex 3 discloses a sticker [e.g. claim 1], which is a self-adhesive label [§2], having a machine readable code (barcodes are machine readable) [§3 or §7]. The compound used for the code is capable of changing colour [Claim 1, §5 or §7] when subjected to various agents. A suggested compound is Alu-B [text describing fig. 2] and it is known from Annex 2 [cf. the table in section 3] that Alu-B responds to hydrogen peroxide. Hydrogen peroxide is a chemical sterilising agent [Annex 1, §9 or §14; or Annex 6 page 1, lines 24-28].

The difference between claim 4 and Annex 3 is the colour change from white to black instead of black to white. The technical effect of the difference is identical to the effect of the reverse colour change, i.e. to provide good contrast for facilitating machine reading [Annex 1, §12]. The problem to be solved is to provide an equal alternative.

It is noted that the colour change from white to black is explicitly desired in Annex 3 cf. §7, although not enabled. Thus the skilled person would have an additional strong motivation to find a way to provide this colour change.

The solution to the problem is given in Annex 2 [section 3]. Annex 2 teaches that the compound Alu-W can change colour from white to black when subjected to the same chemical sterilising agent, namely hydrogen peroxide. Annex 2 is concerned with indicator materials capable of changing colour and is a relevant place to look for a solution [see e.g. the title].

Accordingly the subject-matter of claim 4 lacks an inventive step over Annex 3 in combination with Annex 2 (Art. 56 EPC).

{Marks awarded: 7/8}

Lack of inventive step of claim 5 over Annex 3 in combination with Annex 2 a Annex 6:

Claim 5 is dependent on claim 4.

Annex 3 remains closest prior art for the same reasons as mentioned concerning claim 4.

Claim 5 differs from Annex 3 by the colour change and the use of a smart-code. The colour change lacks an inventive step, cf. the argumentation against claim 4.

The effects of using smart-codes are higher data density and better robustness against degradation [Annex 1, §11]. The problem to be solved is how to provide at least one of these benefits.

Annex 6 [last §] is evidence that smart-codes were well-known and widely used prior to the filing date and that they have all the desired properties. Accordingly, the person skilled in the art would use such codes to solve the problem in question.

No synergistic effect is provided by the colour change and the use of a smart-code. Therefore partial attacks using separate combinations of prior art can be made (C-IV, 11.5 or C-IV, 11.8).

In conclusion the subject-matter of claim 5 lacks an inventive step over Annex 3 in combination with Annex 2 and Annex 6 (Art. 56 EPC).

{Marks awarded: 3/6}

Lack of inventive step of claim 6 over Annex 5 in combination with Annex 2:

Claim 6 is an independent claim.

Annex 5 is the closest prior art since it is concerned with the same purpose as claim 6 of sterilising test tubes and because it discloses the combined use of heat, UV-light and a chemical sterilising agent as defined in claim 6.

Annex 5 discloses a process for sterilising test-tubes [§9 or claim 2] by simultaneously [claim 1, §5 or §6] exposing the tube to heat of 100 to 120 degrees [e.g. claim 1], to a chemical sterilising agent in the gas phase and to irradiation with UV-light [claim 1, §5 or §6].

The end-point 120 degrees falls within the open-ended range “at least 105 degrees”.

The claim defines the use of two alternative indicators, one responding to a chemical sterilising agent and the other one responding to UV-light. The difference between the subject-matter of claim 6 and Annex 5 is for both alternatives that the sterilisation is carried out in the presence of an indicator on the tube.

For the first alternative the additional difference is that the indicator changes appearance when subjected to a chemical sterilising agent.

The technical effect of the difference(s) is that it can be seen directly from the tube has been sterilised [Annex 1, §8]. Accordingly, the objective problem to be solved is "to determine from an object whether it has been sterilised".

Annex 2 is a relevant document in the art of sterilisation and is concerned with the problem in question. Annex 2 suggests to mark items to be sterilised with an indicator i.a. responsive to a chemical sterilising agent [Annex 2, §1 and section 3]. Moreover, Annex 2 states that this is advantageous over a method of random testing after sterilisation [§1] which is the method applied in Annex 5, cf. §7 thereof.

Accordingly, the person skilled in the art would be motivated to use a sterilising indicator instead of random testing and the subject-matter of the first alternative of claim 6 lacks an inventive step over Annex 5 in combination with Annex 2.

In respect of the second alternative of claim 6 the additional difference is that the indicator changes appearance when subjected to UV-light. The corresponding effect and problem are identical to the first alternative.

This problem and corresponding solution is likewise addressed in Annex 2 [§1 and section 2].

Accordingly, this alternative of claim 6 lacks an inventive step over Annex 5 in combination with Annex 2 for the same reason as the first alternative (Art. 56 EPC).

{Marks awarded: 6/8}

Lack of inventive step of claim 7 over Annex 5 in combination with Annex 2 and Annex 6:

Claim 7 is dependent on claim 6. Since claim 6 has two alternatives, claim 7 also has two alternatives.

Annex 5 remains the closest prior art for the same reasons as mentioned concerning claim 6.

The difference between the subject-matter of claim 7 and Annex 5 is the use of a certain indicator on the test tube as well as the use of the gaseous hydrogen peroxide.

The use of the indicators lacks an inventive step for the reasons given in claim 6 in view of Annex 2.

The technical effect of using hydrogen peroxide is that it decomposes to harmless substances as opposed to hypohalogenites which are known to leave toxic residues [Annex 1, §14].

Accordingly, the objective problem is "how to avoid toxic residues".

Annex 6 is concerned with the combined use of sterilising means and addresses the problem in question and its corresponding solution [page 1, lines 24-27]. Moreover, it teaches that hydrogen peroxide in the gaseous form is as effective as gaseous hypohalogenite [page 1, lines 26-27].

The problem solved by having a certain indicator on the object in claim 6 does not provide a synergistic effect in respect of the type of sterilising agent as defined in claim 7. Therefore partial attacks using separate combinations of prior art can be made (C-IV, 11.5 or C-IV, 11.8).

Accordingly the subject-matter of claim 7 lacks an inventive step over Annex 5 in combination with Annex 2 and Annex 6 (Art. 56 EPC).

These arguments apply to the dependencies on both alternatives of claim 6 (Art. 56 EPC).

{Marks awarded: 3/7}

EXAMINATION COMMITTEE II Candidate No.

Paper C 2008 - Schedule of marks

Category	Maximum possible	Marks awarded	
		Marker	Marker
Use of information	39		
Argumentation	50		
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)

03 July 2008