

General

1. The quality of the argumentation leaves a lot to be desired. It is not sufficient to identify claimed features in the prior art and then to piece them together to obtain the subject-matter of the claim under attack; reasoning should be given why the skilled man could be persuaded to make such combinations. In this sense the problem and solution approach would serve as a good guideline.
2. It was often clear that too much time had been spent on answering the legal points, to the detriment of the overall answer.
3. It is not acceptable to attack claims by merely stating that they are trivial.
4. The candidates should ensure that they have identified the patent in the broadest scope, i.e. have all the independent claims been recognised and understood?
5. It is apparent that many candidates still do not understand how priority dates are established; for example matter added after the priority date(s) was said to offend against Art. 123 even though it was present in the filed application.
6. The Annex numbers should be used as given.
7. It is pointed out that poor handwriting and the use of abbreviations often lead to difficulty in marking.
8. Reference is made to points 1(ii), (iv)-(vi) under "General" in last year's comments.

Specific

1. Legal

- (a) Practically no candidate realised that the wording of line 1 of Claim 7 allows it to be an independent claim.
- (b) Many candidates attacked Claim 1 under Arts. 52(1) and 54(2) using Annex 3 or Annex 8. This shows a lack of understanding of the difference between novelty and inventive step. The "transmission" and "reflection" modes of operation are distinct embodiments in Annex 3 (Annex 8 refers only to "reflection") and cannot be combined to attack novelty.

Without any explanation to the Examiner, argument was also often made that Claim 1 was lacking in novelty or inventive step in view of Annex 3 (or Annex 8). This again shows a lack of understanding.

- (c) The Opponent is not a third party to the proceedings (see also solution to Paper C 1991, Legal Point 1c) para. 4).
- (d) Claim 9 was often not seen as an independent claim.

Use of Information/Argumentation

In addition to the information contained in the suggested solution it is remarked that:

- i) Using Annex 8 to attack Claim 5 was not considered reasonable as the Annex does not show the claimed resistance heating conductor.
- ii) In Annex 7 the cold conductor (4) is not the film type heater but rather the temperature sensor. The US document acknowledged in Annex 7 refers to a wave-shaped cold conductor whose materials are said not to be usable as transparent films.

These factors were not properly borne in mind. As a result Annex 7 was often not used properly.

.../...

Possible solution to Paper C 1991

Legal Points (30 marks)

1. The client's letter refers to the following points:

- a) Whether a document cited in the examination search report will need to be cited in the notice of Opposition or whether it will be automatically considered to be admitted into the proceedings by virtue of it being mentioned in the search report.

To this point the Representative must inform the client that the document must be cited in the notice of Opposition, otherwise it may not be admitted later; such documents are not considered to be automatically introduced into opposition proceedings (T 198/88).

- b) The correction in the file concerning omitted Claim 9; whether this extends the scope of protection sought and whether it prolongs the period of opposition.

The documents forming the decision to grant form the authentic text. Mistakes in the course of producing the patent publication have no effect (Legal Advice No. 17/90, OJ 6/90 page 260).

From the client's letter it is clear that Claim 9 was originally present as the patent was granted as filed without any EPO objection. The claim does not therefore offend against Art. 123 and does not prolong the opposition period.

- c) A request for costs in view of the Patentee not being entitled to the patent and whether such a fact will help the case for the opposition.

Requests for costs arising from an alleged non-entitlement are not within the competence of the Opposition Division (Art. 104).

The facts will also not help the Opponent's case. The Representative should however be aware of the possibility of obtaining rectification and costs under national jurisdiction in the contracting states and these may bear in mind the costs of opposition; Art. 138(1)(e).

It should be realised that the Opponent is not a Third Party and cannot ask for suspension of the proceedings under Rule 13(4). Furthermore the client is not interested in obtaining the patent.

- d) The non-inspection of Annex 6 on the opening day (known from Annex 5 to be 24.04.84) of the fair "auto and sport 1984".

This does not prevent this document from being a prior publication from this date. It was made available and is therefore valid prior art from this day (see T 381/87, OJ 5/1990, page 213).

2. Other legal points arise from:

- a) Annex 4

This is an internal document which has not been made available to the public. It cannot therefore be considered as prior art under Art. 54.

b) Claim 7 must be regarded both as an independent claim and a dependent claim.

c) Priority dates of claims

Claims 1-5, 7, when independent, and 9 are entitled to the first priority date of 19.01.84.

Claim 6 and Claim 7, when appendent to Claim 6, are entitled to the second priority date of 24.04.84 (Claim 6 subject-matter only disclosed in Annex 2).

Claim 8 has an effective date which is the date of filing 18.01.85 (not disclosed in either of the priority documents).

d) The US publication referred to in the late published Annex 7 is a prior publication but needs to be checked to authenticate its disclosure.

Use of Information/Argumentation [40 marks/30 marks]

1. Claim 1

This can be attacked under Art. 56 using Annex 3. Claim 1 of Annex 1 refers to a "transmission mode" display comprising a composite structure.

Annex 3 shows a "transmission mode" display (Fig. 2) without a composite structure and a "reflection mode" (Fig. 3) display with a composite structure.

It must be argued that the transmission and reflection are interchangeable and that it would therefore be obvious to provide the claimed combination.

An attack with Annex 8 was not looked upon so favourably as it is a reflection mode display which cannot function without the thick metallic (non-transparent) layer.

2. Claim 2

Although Annex 8 is not so good against Claim 1 it can be used against Claim 2 in combination with Annex 3 as it shows the feature of Claim 2 and is generally indicative of heat transmission efficiency, i.e. thinner layers transfer heat more quickly, page 2, lines 26-30.

3. Claim 3

This does not require much further argument or use of information. Depending on whether it is dependent only on Claim 1 or on Claims 1 and 2 it can be attacked using Annex 3 or Annexes 3 and 8 respectively.

4. Claim 4

As no usable document (cf. Claim 4 priority and dates of prior art) shows superposed glass plates in the outer of which the resistance heating means is arranged, a straightforward attack is not possible.

A good argumentation against the claim might however refer to the fact the claimed subject-matter does not solve the problem of quick heating. The candidate should give reasons, either in the response to the client or in the notes to the Examiner why the claim is difficult to attack.

5. Claim 5

The subject-matter of this claim can be attacked using the prior art acknowledgement of Annex 1 on page 2. The prior art acknowledgement in Annex 7 could also be used but this would not be so good as it relates to a windscreen and only shows the wave shaped form of heater.

6. Claim 6 (Priority 24.04.84)

Combination of Annex 5 with Annex 3.

Because of the claim's priority date Annex 5 is now usable and provides the features of Claim 4, to which Claim 6 is appended, and suggests, for example, a grid heating means. Annex 3 can provide the film type heating means in the context of a display.

When appendant back through Claim 2, Annex 8 should also be used.

Annex 7 is not so good as it shows a film type heater in the context of a windscreen.

7. Claim 7

When independent it has a priority date of 19.01.84 and can be attacked under Art. 54 using the acknowledgement of US prior art in Annex 7.

When dependent on Claim 6 it has the second priority date (22.04.84) and can be attacked under Art. 56 using Annexes 3 and 5.

Annex 6 (publ. 24.04.84) cannot be used.

8. Claim 8

This claim has an effective date of 18.01.85 and is attackable using Annexes 3, 5 and 6 when appendent through Claim 7 to Claim 6; when Claim 7 is independent, Claim 8 can be attacked with a combination of Annexes 5 and 6. For both arguments the fact that Annex 6 refers to "selbstregelnde" should be used to show that the disclosed oxides could be used in the type of resistance material mentioned in Claim 7.

9. Claim 9

Claim 9 is an independent claim; cf. Guidelines C-III 3.7a.

Usable is Annex 3, e.g. pages 1, 2 last sentence "par exemple" for an argument of lack of inventive step. Reference could also be made to the prior art acknowledgement of conventional LCC's in Annex 1, page 1, lines 21-24.

EXAMINATION COMMITTEE II

Candidate's answer-paper No.

Report by examiner No.

FORM, for use by individual examiners, in PAPER C

Schedule of marks

Category	Maximum possible	Individual marks awarded	Where grades awarded are not identical	
			Revision of marks/grade (if any)	Remarks*
Use of information	40			
Legal aspects	30			
Argumentation	30			
TOTAL	100			
CORRESPONDING GRADE				

Translation of marks into grades

	Grade
Up to 25	7
26 - 35	6
36 - 49	5
50 - 59	4
60 - 69	3
70 - 80	2
Over 80	1

* to be filled in if both the following requirements are fulfilled:

- (a) the grades awarded by the two individual examiners before their discussion differ by two grades or more;
 - (b) the marks awarded by at least one of the two individual examiners have been changed during their discussion.
- If remarks are to be filled in, they should briefly explain **why** the examiner has changed his marks.