

Examiners' Report on Paper C/1992

1. The answers received this year were disappointing.

It is still clear that many candidates do not understand how effective dates are established for the documents. Many candidates used documents in the manner in which they were intended to be used, but without giving any reason for the legal basis which allowed the document to be used. For example, Annex 6 was published on the priority date of Annex 1, but was nevertheless used against claim 4 without explaining that the claim was not entitled to the priority date. Similarly, Annex 3 was used without referring to the fact that the earlier publication of its Offenlegungsschrift allowed it to be. Candidates should always explain why a document has been used if the relevant dates seem to indicate that it should not be used.

Other candidates, whilst correctly recognising the effective dates did not then use this information properly in their answers.

2. Claim dependancies are not observed. This often leads to an incorrect attack, or the failure to spot an attack when, for example, the dependancy changes the priority of the claim.
3. Candidates should be aware that more than one attack can often be made against a claim and, where possible, all should be made. Many candidates objected using Art. 123, but did not add an Art. 52 objection, although it should have been clear that the Art. 123 objection could be overcome by amendment. Again, lack of novelty was often used against claim 1 without an Art. 56 objection also being made with other

documents which were necessary for the attacks against later claims.

4. Novelty is still being alleged with an improper combination of documents.
5. Answers should be given in a positive way without detracting statements which suggest the candidate is unsure. In addition, it should not be alleged that "the claim is not new or at least not inventive". It should be clear to the Examiner which argument is being made. There is a difference between a doubt in the candidates' mind and correct, different interpretations of an expression or piece of information.
6. Poor handwriting and use of abbreviations make marking difficult. Marks can easily be lost in this way.
7. Although most candidates refer to the Annexes by their proper number, some do not. All Annexes should be referred to by their number.
8. Those candidates who used the pre-printed Opposition Form generally did not use page 3 of the Form correctly. It has been decided that this page will be struck through next time.
9. Further, more specific points are:
 - i) Some candidates argued a lack of sufficiency as there was no specific adhesive disclosed in Annex 1 which would allow the result to be achieved. It should be remembered that insufficiency is not a ground which can be used in Paper C. Furthermore, the reference in Annex 8 to the "attach it" note blocks shows that such an adhesive was on the market, even though it was unsuitable for heavier

articles. In view of this latter point, however, an argument using the "attach it" note block adhesive would not be so convincing for the heavier transparencies, especially as there was no definite time given for their production. Many candidates failed to see the later reference to the prior use since June 1986 which provided the required argument. This should however be backed up by later evidence which would substantiate the prior use, which can only itself ever be regarded as a mere allegation.

- ii) In using Annex 7 many candidates did not appreciate that it did not disclose a flexible tape as the parts (8) are rigid.
- iii) Annexes 3 and 4 were also often not used properly as it was not appreciated that the two component adhesive in Annex 3 does not allow each component, to be termed an adhesive, whilst in Annex 4 the type of adhesive was not specified.
- iv) The reference to the divisional application status on the cover sheet of Annex 6 was not significant as the priority of the claims for which Annex 6 was usable was in any case not valid.
- v) Some candidates questioned whether the subject-matter of the apparatus claims might have been in the claims of the Italian document (Annex 2, page 2, point 5). Although this is highly unlikely a consistent argumentation on such a basis received marks.

Possible Solution to Paper C-1992

Legal Points (30 marks)

1. The clients' letter refers to the following points:
 - 1.1 Deleting claims during the examination proceedings does not mean that the subject-matter has been abandoned. Even if the applicant indicates that a divisional application will be filed on such subject-matter, this cannot be interpreted as clear abandonment in the sense of C VI 9.3 and 4.7 (see also T61/85).

Reinstating subject-matter not abandoned is allowed (see CVI 4.7, last paragraph) and, in particular, no ground for opposition.

- 1.2 If proceedings for infringement have been instigated against a party, this party can intervene in pending opposition proceedings (Art. 105). Two conditions must be met:
 - (i) An opposition to this patent must be pending. The representative can suggest contacting the EPO or check the Bulletin for verification.
 - (ii) The written notice of intervention (and payment of the opposition fee) must be made within 3 months of the date on which the infringement proceedings are instigated. The representative should ask his client whether this time limit can be met.If condition (ii) is not met, he should advise the client to file observations under Art. 115 or to contact the opponent to offer help.

The client should be advised that national proceedings are also possible; Art. 138 EPC.

1.3 A request for acceleration should not, in principle, be based on the alleged infringement of another (similar) patent; the request must be well-reasoned according to EPO OJ.nr 7, 1990, p. 324. Reference should also be made to D VII 1.2. The representative could, for example, claim legal interests.

1.4 Annex 7 is an old document. Nevertheless, if it is relevant, it can be used. Depending on the facts of the case, the teachings of an old document can be properly combined with a recently arisen problem.

1.5 Annex 7 mentions on page 1 that it is not practicable to assemble the transparencies by means of adhesive strips. However, a single statement in a prior art document, particularly when it is not a well known text book, is generally not considered as a prejudice. If the statement is in a survey of a technical field (monography), this might be different (T19/81 OJ1982 pg. 51).

2. Other legal points arise from

2.1 Annex 3 "Patentschrift" was published on 26.11.85 after the priority date of Annex 1. The candidate should refer to the cover page, where the publication date of the "Offenlegungsschrift" of 14.05.81 is mentioned. The "Offenlegungsschrift" should be checked later, as it is possible that the Patentschrift contains added subject matter.

2.2 Annex 5A (EP-A-0 208 324) should also be checked later, as, in particular, the passages in Annex 2 (point 4) and

Annex 5, third paragraph, page 1 and last paragraph, page 2 could be wrong.

- 2.3 Annex 8 suggests a prior use since June 1986. The candidate should say on the separate sheet that further evidence will be necessary to prove this, e.g. by asking confirmation from the firm Adhesives International Corp., Rochester.
3. According to Annex 5, third paragraph on page 1 and last paragraph on page 2, the subject-matter of claims 1 and 2 is identical to the content of EP application 85 420 222.5 of the same inventor. The priority 08.07.85 of this application is justified, at least the examiner says (in Annex 2, point 4) that he has checked it. Claims 1 and 2 are therefore not entitled to the priority, as the filing of the first application of the same applicant/inventor dates back more than one year before the filing date 11.07.86 of Ann. 1, contrary to Art. 87(1). Competent candidates may also refer to C V 1.4.
- 3.1 The priority of claims 4 to 6 is not valid because their subject matter is not disclosed in the priority document, see Annex 2, point 5.

Use of Information/ Argumentation (40 marks/ 30 marks)

Keep in mind that claims 1,2, and 4 to 6 have an effective date of 11.07.86, claim 3 of 04.11.85, and that the effective date of EP-A-0 208 324 (Annex 5A) is 08.07.85.

Claim 1 (11.07.86)

Novelty

Except for the contracting state FR, the subject matter of claim 1 lacks novelty in view of older EP application 85 420 222.5 (Art. 54 (3)). The content of Annex 5A is known from Annex 5, third and last paragraph of the description.

An attack under Art. 54(3) is also possible, even if the priority question was not seen, as the relevant dates allow it.

Inventive step

Objection under Art. 56 could be made as follows:

A flexible tape comprising a sequence of framed transparencies using two parallel strips but a different adhesive is known from Annex 3, corresponding "Offenlegungsschrift".

According to Annex 8 the adhesive of claim 1 is known from the prior use since June 1986; see in particular the statement "Beim Entfernen geht die Klebeschicht praktisch vollständig mit ab" (last sentence of first paragraph) and the last paragraph of the Annex. The skilled person will try other known types of adhesive.

Another Art. 56 objection starts from Annex 7, page 1, third paragraph, which provides a teaching that known

adhesives do not release easily and are therefore not practicable. The indication in Annex 8 that suitable adhesives are now on the market make it possible to combine this information with that in Annex 7.

A weaker argument with Annex 4 can be used to attack claim 1 because there the connection between transparencies is substantially made by the carrier film 4.

Claim 2 (11.07.86)

Novelty

The Art.54(3) objection, except for FR, is the same as against claim 1.

Inventive step

In addition to the combination of Annex 3 + Annex 8 used for the claim 1 attack, a specific reference to the use of paper in Annex 3, last sentence of the description, is necessary for the Art. 56 objection.

Claim 3 04.11.85)

Because Annex 8 is published too late, this claim is difficult to attack. Indispensable is a problem/solution approach: The underlying problem is to enhance fixing of the transparencies to the tape to improve their positioning during printing (Annex 1, page 2, third paragraph). The fixing of the transparencies is at least twice as good as compared to fixing with one pair of strips.

Annex 3 should be mentioned as in this Annex two pairs of parallel strips in superposition are used for retain-

ing the frames accurately within the strips only by the adhesive force in the spaces between the frames.

Claim 4 (11.07.86)

An Art.123(2) objection is to be raised, since "step-wise" and "during stand-still periods" cannot be omitted. These features are disclosed as necessary for obtaining the advantages of the invention, see originally filed claim 4 (Annex 2, last page, claim 4) and originally filed description (Annex 1, page 3, second paragraph).

Annex 6 is to be used in combination with Annex 3 for an Art.56 attack, with reference being made to the effective date of the claim (equally so for claims 5 and 6 below). Remember that Annex 6 is published on the priority date of Annex 1.

Claim 1 of Annex 6 discloses a few features of claim 4, and also the aim in Annex 6 is the same as in Annex 1, i.e. an apparatus for assembling a flexible tape comprising a sequence of framed transparencies to be transported through a printing station. In Annex 6 are not shown (a) the means to feed two parallel adhesive paper strips to the chain and (b) the means to deposit and press. Reference should be made to Annex 3, wherein the two-component adhesive requires such means (a) and (b) even if they are not described.

Another argument would be a reference to the means 3 in Annex 4.

Claim 5 (11.07.86)

The Art. 56 objection should be based upon Annex 6 wherein the stand-still periods are disclosed in combination with the pressing means necessary in Annex 3.

Claim 6 (11.07.86)

Art. 123(2) is clearly infringed by "plastics strips" not being originally disclosed .

An Art. 56 objection is not easy. The arguments are as used against claim 3, based upon Annex 1 (problem) and Annex 3, in combination with the arguments as used against claim 5, based upon Annex 6.

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.