

Examiners' Report

General

1. Whilst some errors of previous years now seem to have been erased a number of serious ones still exist. In particular, many candidates do not understand how priority dates or effective dates of claims are established, or simply misuse Art. 54(3) documents.

It should be understood that if the priority date falls the claim may still have an effective date equivalent to the filing date, but under no circumstances can added subject-matter (regardless of when it was introduced) have any claim to a priority or effective date.

Some candidates still seem to have problems resisting combining an Art. 54(3) document with Art. 54(2) documents for attacks under Art. 56, even when they have properly recognised that a document is state of the art under Art. 54(3).

It should be emphasised that candidates failing to understand these principles will lose many marks and have a much reduced chance of passing the examination.

2. The opposition should not be based on Art. 100(b). This should be clear from the "Instructions to the candidates for preparing their answers", printed each year in the Official Journal.

It should also be clear that lack of clarity or support are not grounds for opposition.

3. When arguing that a claim is not novel or not inventive it is not sufficient merely to state, for example, *"the features of the preamble are disclosed in Annex X"*. The features should be properly identified, even in the situation where Annex 1 acknowledges the fact that the preamble is disclosed in Annex X cited in its description.
4. Candidates are not expected to speculate what type of amendment might be offered by the proprietor and then to attack such amended claims. Only those features which actually appear in the claims should be attacked.
5. It is still not appreciated that candidates do not have time to confer with their client and that the actual date of the examination has no bearing on the opposition period. Candidates should assume that they are to file the opposition on the day of the examination and that the client cannot be contacted.
6. There is often a conflict between the advice given to the client and the attack given in the notice of opposition. In addition, matters which rightly belong in the opposition (e.g. why a document can be used as prior art) are often explained to the client, but not given to substantiate the attack in the opposition.

Any advice given to the client should be of practical value.

7. Only those questions posed should be answered. It is reassuring to see that candidates have learned from past papers, but it brings no marks when the issues are not relevant to the current paper.
8. Many candidates have difficulty distinguishing independent from dependent claims.

9. The Annexes should be referred to by their given number and extra Annexes should not be invented. In this latter respect it is remarked that whilst it might be appropriate to state that a certain document (not at hand) may need to be checked, it is inappropriate to indicate that such a document is filed with the notice of opposition.
10. Last, but by no means least, the quality of argumentation leaves a lot to be desired. It should be appreciated how the problem and solution approach should be addressed and kept in mind when attacking all claims, as often the dependent claims can introduce different problems. When this was not done, documents were often combined in an inconsistent manner.

It is also rare that candidates take into consideration and discuss the physical modifications that need to be made when piecing together the disclosures being combined. It is not sufficient simply to state that the documents belong to the same technical field and that therefore the skilled person would have no difficulty in combining their disclosures to arrive at the claimed subject-matter.

Specific

Legal

- I. The fact that claim 6 (Method) was introduced during the examination period has nothing to do with a change of claim category in post grant proceedings. Many candidates argued though that it contravened Art. 123(3).
- II. Subject-matter added during the prosecution of a prior art Art. 54(2) document (Annex 5) does not become usable under Art. 54(3). Some candidates argued that the additional matter in Annex 5 could be used under Art. 54(3).
- III. The fact that the subject-matter of claim 3 was not supported by the description did not mean that it was added subject-matter as the claim was ever present.
- IV. Many candidates did not really address the problem of an unqualified representative, but merely referred to G2/94 and G4/95 without giving advice.
- V. The issue of joint opposition, costs and common representative was rarely treated satisfactorily.
- VI. Whilst some candidates chose correctly not to attack claim 1 on the ground that it related to an aesthetic effect they did attack dependent claim 2 for this very reason. It should also be remembered that claims possessing technical features may still nevertheless only amount to an aesthetic effect; for the claim to be allowable it must first solve a technical problem.
- VII. It was not realised that Annex 6 could not be used. If claim 6 was said not to add subject-matter then it would be entitled to its priority and Annex 6 would then not have been a prior publication. If, on the other hand, it was argued that claim 6 added subject-matter [please note: Art. 123(2) and not Art. 123(3)] then there would be nothing to attack as the claim would fall and have no effective date.

VIII. The names of the opponent and client were sometimes confused; also whether Brigitte was Mr Eurie's (not Fleurie!) or Mr Flahm's daughter. This left a poor impression.

Claims

1. It was often not realised that by combining Annexes 2 and 4, claim 1 could be attacked twice under inventive step, using either Annex 2 or Annex 4 as the starting document with appropriate attention to the different problems and solutions then involved.
2. Claim 2 was sometimes thought to contain two alternative embodiments (pyramid shape/location of outlet) and then attacked respectively under inventive step/novelty.

Candidates generally did not provide a convincing argument why the pyramid shape was an obvious feature.

3. Even when it was not realised that all information in Annex 5 was prior art under Art. 54(2) [see solution], it might have been argued that the original disclosure of the "*control means 38 may be provided for regulating the speed of the fan and hence the degree of suction created.*", whilst possibly referring to an on/off switch could also have been interpreted as an automatic control as required by claim 3. However, very few candidates actually offered any argument in this respect, but merely stated that such a control was present without giving reasons.

In many cases candidates tried to introduce the EP-A version of Annex 5 as filed as a further Annex (cf. "General", point 9 above).

4. Claim 4 referred to soot whilst Annex 2 referred to discolouration through smoke. Although this may not be of great technical difference it caused little comment in the argumentation.
5. For claim 5 candidates should have provided proper reasoning for the provision of a sweeping box in Annex 4.
6. After an attack under Art. 123(2) it was then possible to use Annexes 2 and 4 for an Art. 56 attack, but this would have been a weak attack in view of the constructional changes required (cf. "General", point 10 above) and should have been acknowledged as such in the notes to the examiner.

Possible Solution

The solution is based on the syllabus as set out in Art. 12 of the Regulations.

LEGAL POINTS

1. Generally speaking only the attacked claims are considered by the opposition division unless the content of dependent claims is *prima facie* not patentable when claim 1 is not allowable. The dependent claims and other claims referring to claim 1 are not invalid automatically. Anyway claim 6 is an independent claim (G 9/91).

New grounds and evidence filed after the expiration of the opposition period may be disregarded (Art. 114(2) EPC, G10/91).

2. It is possible to file the opposition in common with another company or another person (Rule 100(1) EPC).

However there shall be a common representative nominated by the common opponents or, if not, by the EPO as determined by Rule 100 EPC.

Only one opposition fee has to be paid but overall costs may be increased if more than one representative is involved.

The further company should be identified before the end of the opposition period. Adding the name of the second company later is not possible (T25/85).

3. At the time of qualifying examination (T598/91) a person who does not have the European qualification may speak in oral proceedings in the name of the opponent provided that the qualified representative is present, and this person speaks under the representative's responsibility. However there is a conflicting decision (T80/84). A decision of the Enlarged Board of Appeal related to these two conflicting decisions was pending at the time of qualifying examination (G2/94, G4/95)¹.

By the time oral proceedings may take place this point will probably have been settled.

4. Despite the fact that there is an aesthetic effect (better look), it is considered that the hollow base member solves a technical problem (avoiding a pipe over the fireplace). Therefore the subject-matter is not excluded from patentability according to Art. 52(2)(b) EPC in connection with Art. 52(3) EPC.
5. The extra feature only disclosed in the patent specification of annex 5 has been made available by file inspection to the public before the priority date of the contested patent (29.10.91) since, as the patent of annex 5 was granted on 06.11.1991, the extra feature must have been filed at the EPO before the 29.10.1991, in time for it to have been included in the documents making

¹ See decisions dated 19.02.1996: G2/96, OJ EPO 1996, 401 and G4/95, OJ EPO, 412.

up the text for grant (Rule 51(6) communication). Therefore the whole content of annex 5 is prior art according to Art. 54(2) EPC (but see also argumentation for claim 3).

6. If it is considered that claim 6 adds subject-matter, the whole claim falls according to Art. 123(2) EPC (Art. 100 c) EPC) and there is no further possibility of attacking the claim. If it is argued that claim 6 does not add subject-matter, then it is entitled to the application priority date (according to the letter the content of the priority document and the content of the application document are identical) and annex 6 is not prior art according to Art. 54(2) EPC.
7. Annex 3 is not Art. 54(3) prior art for NL and SE (Art. 54(4) EPC).

Use of information and argumentation

1. Claim 1 (29.10.91):

Art. 54(3) EPC, for all designated states except NL and SE (see legal):

Annex 3 (filed 05.04.91), published after the priority date of annex 1, shows a fireplace with all the features (to be identified) of claim 1; in particular, the open framework meshes form the combustion air inlet means, the combustion chamber is formed by the part above the firebars 18 including the glass panels, and the base section 15 including the baffle 24 forms part of the fumes exhaust duct.

Art. 56 EPC:

Annex 2 discloses a fireplace having all the features (to be identified) of the preamble of claim 1; starting from this prior art, the technical problem to be solved is to avoid the duct over the fireplace. Annex 4 gives the teaching of using the hollow base member as part of the fumes exhaust duct to solve the same problem with an open fireplace (lines 6 to 12). There is nothing that could prevent a skilled person from applying this teaching to a closed fireplace.

Annex 4 discloses all the features (to be identified) of claim 1 except the peripheral wall; starting from this prior art the technical problem is to provide more safety and better draught; annex 2 gives the teaching of providing a peripheral wall for more safety and better draught (lines 1 and 2), air inlet means being provided, for example, under the glass panels.

2. Claim 2 (29.10.91), dependent on claim 1:

Art. 56 EPC:

When starting from annex 2 in which the fumes exhaust duct inlet is located at the top and the glass panels may be upwardly converging (lines 38, 39 and 14): the additional distinguishing feature is the pyramid; the skilled person wanting to improve visibility would recognise that

with the removal of the fumes through the base, the hood of annex 2 is redundant and that therefore the glass panels can meet at the top to form a pyramid for better visibility .

When starting from annex 4 in which the fumes exhaust duct inlet is located at the top (lines 36 to 38): the technical problem to be solved is to get better visibility and a better draught; annex 2 suggests to have converging panels; in order to obtain the best draught and visibility it is obvious to let them converge as far as possible thus forming a pyramid, the hood being then redundant.

3. Claim 3 (29.10.91), dependent on claim 1:

Art. 54 (3) EPC for all designated states except NL and SE:

In addition to the features of claim 1, the fireplace of annex 3 also includes a fan (exhaust blower 26) and automatic draught control means (thermostat 28).

Art. 56 EPC:

Starting from the fireplace of claim 1 (not inventive in view of annexes 2 and 4) the technical problem to be solved is to further improve the draught; annex 5 teaches to provide a fan and draught control means which are automatic as they are controlled by fumes detection (this particular feature is Art. 54(2) prior art as explained in legal point 5).

4. Claim 4 (29.10.91), dependent on claim 1:

Art. 56 EPC:

When starting from annex 2: the inlet means is adapted to keep the glass panels free of smoke and therefore it can be argued free of soot (paragraphs 3, 4 and 10), the content of claim 4 is distinguished from annex 2 by the same feature as claim 1.

When starting from annex 4, the additional technical problem to be solved is to avoid soot deposits; annex 2 teaches to provide means (in particular the inlets under the glass panels) in order to keep the glass panels free of smoke and therefore free of soot (paragraphs 3, 4 and 10).

5. Claim 5 (29.10.91), dependent on claim 1:

Art. 56 EPC:

When starting from annex 2: the technical problem to be solved is to provide facilities not only for collecting the ash but also for removing soot; annex 4 (figures, lines 28 to 30 and 40 to 44) teaches to provide the features of claim 5 (to be identified in detail) for collecting the ash and removing soot (the T-fitting 30 has the function of a sweeping box). In particular annex 4 teaches to provide a closure plate 32 for removing soot from inside the hollow base member.

When starting from annex 4: the additional features of claim 5 are known from annex 4 (ash collection chamber 17, removable closure plate 32, sweeping box 30); the content of claim 5

is distinguished from annex 4 by the same feature as claim 1.

6. Claim 6, independent, referring to claim 5:

Art. 123(2) EPC:

Claim 6 concerns a process for removing the ashes through the sweeping box; the specific use of the closure plate and the sweeping box is not mentioned in the application as filed; in the application as filed the closure plate and the sweeping box are only used for removing soot, ashes being removed through the grate opening.

Should it be considered that claim 6 is not unallowably extended, then it is entitled to the priority (see legal point 6), and has to be attacked under Art. 56 EPC.

Art. 56 EPC:

The technical problem to be solved is to provide easier removal of the ashes from the fireplace; the person skilled in the art would recognise that by locating the closure plate 32 of annex 4 in the bottom wall of the recess 17, when the closure plate is removed, the ashes fall into the sweeping box which is located beneath the closure plate and would thus realise that the ash can be collected in and removed from the sweeping box; therefore this specific use of the non-inventive fireplace of claim 5 does not involve an inventive step.

EXAMINATION COMMITTEE II

Candidate No.

Paper C Schedule of marks

Category	Maximum possible	Marks awarded		Revision of marks / grade (if any)	
		Exr	Exr	Exr	Exr
Use of information	40				
Legal aspects	20				
Argumentation	40				
Total	100				
Corresponding Grade					

Translation of
marks into
grades

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

Marking by further examiners when grades awarded are different

	Use of Information	Legal Aspects	Argumentation	Total	Grade
Examiner					
Examiner					

Remarks (which must be given 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 marks are revised, a brief explanation should be given.

Grade recommended to Board

Munich, 1 July 1996

B. Molac - Chairman of Committee II