

Examiners' Report on Paper C

Please note that all references to passages in the Annexes relate to the English version of Annex 1 and the original versions (i.e. untranslated) of the prior art Annexes.

General

1. Candidates should refrain from answering questions which do not exist, notably asserting an attack under Article 123 (2) despite there being no evidence for this in the client's letter.
2. Candidates should not reverse documents for the starting point of an inventive step attack without an indication of the alternative problem and its solution, e.g. if Annex 2 is the starting point for an attack and is combined with Annex 4, a second attack starting from Annex 4 should only be made if it is clear that a further problem can be solved.
3. Although all grounds of attack should be given, a "shotgun" approach achieved by combining Annexes in all possible ways without proper thought should be avoided.
4. Although it is understood that the identification of the features in the claims using letters or numerals (the "Merkmalanalyse") is an attempt to save time by certain candidates, this can be confusing to mark and often leads to poor argumentation.
5. The use of the form 2003 is highly recommended since it saves time and candidates are less likely to miss the formal requirements.
6. In answering the questions posed by the client in the letter, candidates should not merely give a summary of the law without specifically applying it. It is insufficient to quote legal decisions or the Guidelines without discussion.
7. The use of prepared answer sheets, e.g. a preprinted sheet along the lines of F2003, is against the rules. Nothing may be brought into the examination other than that stipulated in the rules.
8. It has been noted that there is a marked lack of argumentation when combining documents. The argument that "it is obvious to combine" will not be successful.
9. A long detailed list of the documents indicating priority dates etc, was unnecessary and wasted time. It is only necessary to indicate the Annex number and the language.
10. Care should be taken that the references to Annex numbers in the arguments are correct and consistent.
11. The absence of attacks on the later claims is evidence that candidates often ran out of time. It is important not to waste too much time on trivial details or spend too long on the legal aspects so as to ensure that all claims are attacked.

12. The reliance on common general knowledge is to be avoided unless it can be supported by convincing argument. The information provided in the Annexes should be used before common general knowledge.
13. Specific questions in the client's letter were often left unanswered or misinterpreted; care should be taken in reading the client's letter.

Specific

Legal:

- i. The question as to whether Annex 6 could be used was often left unanswered. The mere statement that Annex 6 was usable under Article 54(3) was insufficient. Candidates who stated that Annex 6 could only be used in a novelty attack and then combined it with other prior art demonstrated that they had not understood the concept of Article 54(3).
- ii. The distinction between correction before and after publication was often not made. Whilst candidates did indicate that priority information could be corrected before publication, many failed to notice that in the client's letter the number had been corrected during examination (i.e. after publication). The law was often quoted, but not applied. Very few explained why the error was obvious. The view that the EPO had accepted the correction and thus could not be challenged was not an acceptable argument.
- iii. With regard to the prior use, there was very little discussion as to what had been made available. A good answer should state the law as set out in the Guidelines or in the relevant decisions, without speculation as to what had been demonstrated, coupled with advice to the client as to what to do next. Candidates who used the prior use against each claim individually and invented arguments were not awarded marks.
- iv. The inventor as witness was answered insufficiently, if at all. Very few candidates had knowledge of the law. Whilst a number of candidates indicated to the client that the inventor would not be a reliable witness, this was not answering the question, which was "maybe it **would** be possible to call the inventor as a witness". The argument that the inventor was a party to the proceedings and thus could not be called as a witness was erroneous.
- v. The problem of the former member of the Board of Appeal was answered adequately with most candidates demonstrating a good knowledge of the relevant decisions G2/94; G4/95. Very few candidates did however discuss whether the decision was applicable to opposition proceedings.
- vi. Whilst many candidates showed good knowledge of Article 105, complete answers, in particular whether the infringing competitor could **join** the **opponent** at a **later** stage, were rare. The competitor cannot file a joint opposition once the 9 month opposition period has expired. Also intervention

is only possible if infringement proceedings take place or if the competitor has sought a court ruling for non-infringement.

- vii. Most candidates did not realise that the Opponent was also about to be sued and could request acceleration. A number of candidates were clearly unaware that the opposition procedure can also be accelerated. The request for acceleration in the actual notice of opposition was rarely made.

Claims:

Claim 1:

Art. 54: In order to achieve full marks it was necessary to indicate the actual passages in Annex 6 where the features of claim 1 could be found. A mere statement that "Annex 6 discloses the features..." was not sufficient. Further it was necessary to explain why the heads in Annex 6 had a different weight.

Art. 56: Annex 2 was often used to attack the novelty of claim 1. Whilst the feature of the different weights can be deduced from Annex 2, there is no disclosure, other than in the description of the prior art, of a head having zero loft.

If a document had been used for novelty it was illogical to then use it for inventive step.

The inventive step attack should have been argued on the basis of the problem-solution approach.

Claim 2:

The combination of Annex 2 and Annex 4 was often used without suitable argument since many candidates had not understood that the heads are formed from a **composition**. Candidates who presented good arguments based on Annex 2 or Annex 4 without the information of Annex 5 and who noticed that neither Annex 2 nor Annex 4 disclosed compositions with varying metal content, were awarded marks. It should be noted that the metal weights used in the heads of Annex 4 do not correspond to a composition of varying metal content.

Claim 3:

The maximum marks were awarded to the answers using all the information provided in the Annexes regarding the properties of Teflon and not only relying on common general knowledge.

It is important to note that the claim does not specify Teflon so that it is necessary to explain why Teflon corresponds to a fluoropolymer having a low coefficient of friction. Also the aspect of "a quantity" was rarely discussed.

Annex 3 does not specifically disclose a putter head so that an explanation was necessary as to why the disclosure of Annex 3 was relevant.

When Annex 5 was used there was often no discussion of the shape of the putter head. Also there were two separate embodiments in Annex 5, both of which could be used separately to attack the novelty of claim 3, but the

combination of which could not be used as a novelty attack.

Claim 4:

Many attacks omitted the use of Annex 2 for the information about luminescent paint and referred to common general knowledge.

The combination of Annex 5 with Annex 2 was not a possible attack as Annex 5 does not suggest the same system of alignment as in claim 4.

Candidates who had omitted to use Annexes 3 and 4 in the attack on claim 3, but then used them in the attack on claim 4, clearly had not recognised the dependency or had not understood the need for consistency.

Claim 5:

A number of candidates who had used the first embodiment in Annex 5 to attack the novelty of claim 3, then went on to use the second embodiment in an attack on the novelty of claim 5.

The novelty objection using the second embodiment of Annex 5 was raised without explanation of the three criteria for selection of a sub-range from a broader known range, notably a) that the selected sub-range is narrow compared to the known range; b) that the selected sub-range is not close to any specifically disclosed point, e.g. the end-points of the broad range, or known examples lying within the broad range; c) there must be a technical effect occurring within the sub-range that is different to that known in those parts of the broad range not close to the sub-range.

Claim 6:

Some candidates did not understand that the claim required that the head be formed entirely of the composition. For example, candidates using the first embodiment of Annex 5 did not realise that Teflon was only used as a layer on the striking surface. Further confusion resulted from the dependency not being properly treated.

Claim 7:

Annex 3 should have been used in a novelty attack, provided it had been used to attack the novelty of claim 3. However, once it had been correctly used in a novelty attack it should not have been combined with other documents in an inventive step attack.

Prior Use:

Whilst it was expected that a general prior use attack be made, with evidence being filed later, speculative attacks were not awarded marks. The information provided was not sufficient for candidates to attack individual claims.

Possible Solution for Paper C

Legal points (20)

1. Annex 6 is an intermediate document, having an earlier filing date than Annex 1, but having been published after the priority date of Annex 1, which can be used for purposes of attacking novelty only under **Art. 54(3) EPC** for the same designated States.
2. Whilst correction of priority information is permitted before publication it is clear that in Annex 1 the correction was made after publication, since the client ascertained this through a file inspection. Such a correction can be made under **Rule 88** provided that the public interest is not seriously affected, there being an obvious error. In this case it is clear that there was an error as the priority number reflects the year of the priority date, in this case '94. The date could not have been erroneous since 22.03.95 would fall after the filing date, 21.03.95. Therefore the priority of Annex 1 is valid. Decisions J 3/91, J 6/91 and J 2/92.
3. The demonstration of the club at the tournament can only be novelty-destroying if all features as set out in the claims were made available. The various aspects of prior use should be discussed, notably as set out in **Guidelines D V, 3.1.2.** (i) when the use occurred; (ii) what was used; (iii) where it took place; (iv) how it took place and (v) who carried out the use. The client should be informed what evidence still needs to be provided since certain features of the invention cannot be ascertained by viewing. The evidence can be filed later, after the opposition period has expired; T328/87, T28/93.

With regard to the inventor as witness the Opponent can request the Opposition Division to call the inventor as a witness, but cannot call the witness himself. **Rule 72(1).**

4. In the decision **G2/94** it was indicated that a board of appeal should normally refuse permission for a former member of the boards of appeal to make oral submissions during oral proceedings before it, until at least three years have elapsed following termination of the former member's appointment to the boards of appeal. After three years have elapsed, permission should be granted except in very special circumstances.
Since the proceedings is not appeal, but opposition, it could be argued that the opposition division could never be accused of partiality should it allow a former member of a board of appeal to speak so that the three year term need not apply. If the candidate decided to follow the decision of **G2/94**, then permission of the opposition division should be sought and the name and qualifications of the former member of appeal will have to be communicated to the opposition division along with the subject-matter on which will be spoken, as indicated in **G4/95**.
5. In the case where the competitor should be named as a joint opponent the information regarding the identity of the competitor has to be filed within the opposition period, **Article 99(1) EPC**. However, since the client expressly indicates in the letter that he does not wish the competitor to join at the moment, the only possibility for the competitor to join at a later stage is through intervention.

The competitor can file an intervention in the event that he is sued, **Article 105**;

Guidelines D VII, 7. The competitor may give notice of intervention, provided that he can prove that proceedings for infringement of the same patent have been instituted against him or that he has instituted proceedings for a court ruling that he is not infringing the patent and that he gives notice within three months of the date on which infringement proceedings were instituted. The intervention has to be filed in a written reasoned statement and an opposition fee has to be paid, after which the intervention will be treated as an opposition. Intervention is permissible as long as opposition or appeal proceedings are pending (**G4/91** and **G1/94**).

6. The opponent can request acceleration on giving a detailed request with grounds as indicated in **Guidelines D VII, 1.2**. See also EPO notice dated 11.06.90 (OJ EPO 1990, 324).

In this case accelerated processing could be requested under condition (c) if infringement proceedings have been instituted against the opponent. It is not necessary for the competitor to be party to the proceedings since in client's letter there is an indication that Anderson Clubs are about to be sued by the proprietor for infringement, notably "We believe that a competitor of Anderson Clubs is **also** about to be sued by the proprietor in Great Britain for infringement".

Use of Information/Argumentation (40/40)

1. **Claim 1, independent:**

Art. 54(3) For all contracting states based on **Annex 6**, which shows a golf club having two heads, one of which has an unlofted striking face (see the claim). The heads are of different volume and formed by solid injection moulding in one piece, which will mean that they are of different weight (see lines 22-23).

Art. 56: The problem to be solved is the provision of a versatile golf club, which dispenses with the need for a large number of clubs and which can cope with the varying conditions on the putting green.

Annex 2 shows a golf club having two heads, but these have lofted striking faces and are of the same weight. One head is intended for use as a putter (page 2, line 2). It is also disclosed that putter heads can have a small loft or no loft at all (page 1, lines 21-22). Also it discloses that for long shots the heads are preferably the same weight (see page 2, lines 13-14), which means that heads with different weights can be used for long shots and other shots such as the putt. Thus **Annex 2** can be used alone for inventive step.

As an alternative **Annex 2** can be combined with **Annex 4**. The problem to be solved in **Annex 1** is to provide a versatile club. **Annex 2** is also concerned with providing a versatile golf club so that the basic concept of providing two heads on one club is known. **Annex 4** discloses the concept of varying the weights of putter heads to cope with different conditions (page 1, lines 41-43) and also discloses unlofted heads (page 1, line 36, "Das vordere Oberflächenteil und die Stirnfläche können leicht geneigt sein, z.B. bis zu 5°"). The skilled person would be inclined to place two heads of varying weight onto a shaft as **Annex 2** only recommends club heads having the same weight for drive shots (page 2, lines 13-14). Thus if the club is specifically for putting there is no disadvantage to have different head weights.

2. **Claim 2, dependent on claim 1:**

Art. 56: The problem to be solved is to provide heads having different weight. The solution proposed by claim 2 is to use a composition which can have a variable metal content.

If **Annex 2** has been used alone against claim 1, then **Annex 5** can be combined with **Annex 2**. **Annex 5** discloses in the third paragraph that compositions having a varying metal content can be used, "wobei das Metall auch das Gewicht der Schlägerköpfe beeinflusst".

If **Annexes 2** and **4** are used for claim 1 then they are combined with **Annex 5**.

3. **Claim 3, independent:**

Art. 54(2):

Annex 3 discloses a club head which can be used as a putter (see reference to "green" on line 21), comprising a top surface, a bottom surface and a forward-facing putting surface (as can be seen from the figures) which has a Teflon insert, which is a fluoropolymer having a low coefficient of friction (page 1, line 22). The candidate can find the relevant information from **Annex 1** itself (page 1, lines 29 to 31 "a fluorine-containing material, for example a fluoropolymer, especially polytetrafluoroethylene") and **Annex 4** which indicates that polytetrafluoroethylene (as disclosed in **Annex 1**) is Teflon (page 2, line 9).

Annex 4 discloses a putter head having a top surface, bottom surface and a forward-facing putting surface (see Figure 1 and page 1, lines 33-37, "oberen Fläche 18"; "Stirnfläche 33") where the putting surface can be a polymeric plastic, which can be Teflon (page 2, lines 5 to 9).

Annex 5 also discloses putter heads. In the second paragraph the shape of the putter head is defined as a "Parallelepipedblock", thus a top surface and bottom surface will be present. The forward-facing surface is given by "Stirnfläche", which striking face can be coated with Teflon. In the third paragraph the putter head can be made from a composition comprising Teflon.

In claim 3 the putting surface is formed of a material which includes a **quantity** of fluoropolymer having a low coefficient of friction. The term "quantity" is vague and unspecific so that a surface formed from a fluoropolymer alone can be considered as anticipating this feature. Teflon, whilst being a well-known material, having low friction properties (non-stick pans etc.) is discussed in **Annex 4** so that all information can be found in the Annexes.

4. **Claim 4, dependent on claim 3:**

Art. 56: In claim 4 the alignment lines, which aid accurate striking of the ball, are painted in a luminescent colour in order that play can continue when visibility is poor.

Annex 3 discloses an alignment line in the form of a groove (line 18, "centre line 5 of the plane of impact may be marked with a groove to assist alignment"). **Annex 2** discloses the use of luminescent paint on the shaft when visibility is poor (page 1, line 40). The skilled person would apply the teaching of **Annex 2** to that of **Annex 3** and arrive at the subject-matter of claim 4.

Annex 4 discloses the use of alignment lines (page 1, lines 38-39, "Ausrichtungsrille oder -markierung 34" and Fig. 1) and provided that **Annex 4** has been used to attack the novelty of claim 3 then the combination of **Annex 4** and **Annex 2** can be made to

attack the inventive step of claim 4.

5. **Claim 5, dependent on claim 3:**

Art. 54(2):

Annex 3 can be used since claim 5 refers back to claim 3, where the putting surface is formed of a material. In claim 5 the material includes at least 35 wt. % of fluoropolymer, but no upper limit is specified, leaving the amount of fluoropolymer open. **Annex 3** discloses a striking face made from a Teflon strip (line 22), which is 100% fluoropolymer and so falls within the scope of claim 5, since at least 35 wt. % includes 100%.

Annex 4 can be used as on page 2, lines 5 to 9, it is indicated that Teflon can be used for the putting surface. The same arguments as for **Annex 3**.

Annex 5, 2nd paragraph, discloses a layer of Teflon on the striking surface so that the same argument as for **Annexes 3** and **4** apply.

Art. 56:

Annex 5, 3rd paragraph, discloses putter heads made from a composition having at least 25 weight percent Teflon. **Annex 5** also leaves the choice of the upper limit to the skilled person, depending on the amount of flexibility required, so that the amount of 35 weight percent can be achieved without any inventive skill. In any case there is no indication of any special effect relating to at least 35 weight percent fluoropolymer.

6. **Claim 6, dependent on claim 5:**

Art. 54(2):

If **Annex 4** has been used for novelty against claim 5, it can be used against claim 6 as it indicates that the striking surface can be the same material as the putter head (page 2, line 7).

Art. 56: **Annex 5** can be used as the whole putter head can be formed of the composition in 3rd. paragraph ("oder daß ein spezielles Material für die Herstellung des Putterkopfes verwendet wird").

7. **Claim 7, dependent on claim 3 or claim 5:**

Art. 54(2):

Annex 3 discloses the provision of a tapered portion on the club head to prevent rubbing (lines 20-21, "In fig. 3 it can be seen that the bottom portion 15 of the club head is tapered upwardly to prevent rubbing.."). Provided that **Annex 3** has been used for novelty attacks on claim 3 and claim 5, then it can be used against claim 7.

Art. 56:

If **Annex 3** was not used against claims 3 or 5 for novelty then an inventive step attack has to be made. **Annex 4** can be combined with **Annex 3** or **Annex 5** has to be combined with **Annex 3**.

8. **Prior use:**

If prior use is indicated in the notice of opposition then it should be made clear that evidence will be filed later. The prior use attack should be made as a general attack and not on any specific claim with speculative argumentation.