

Examiners' Report Paper C 2009

General Comments

- 1). In general marks are awarded for identifying relevant information, such as claim features, technical effects, problems, hints in the prior art and using that information in an appropriate way. In order to get full marks the specific citation in the relevant document has to be cited.
- 2). The problem-solution approach was not always well-applied. In order to get full marks this approach requires (among other things) to identify the closest prior art and justify its selection for each inventive step attack. In selecting the closest prior art, the first consideration is that it should be directed to a similar purpose or effect as the invention or at least belong to the same or a closely related technical field as the claimed invention. In practice, the closest prior art is generally that which corresponds to a similar use and requires the minimum of structural and functional modifications to arrive at the claimed invention (Guidelines, C IV 11.7.1). This applies to independent and dependent claims. The technical effect has to be identified from the patent to be opposed. The objective technical problem to be solved has to be established based on the information given in Annex 1. Further, when possible it has to be explained why the document can or should be combined with another document. In addition to the possible solution marks were awarded for other plausible, well-reasoned attacks.
- 3). When comparing a claim with a prior art document, it may not be sufficient to simply repeat the wording of the claim and refer to the relevant passage in the prior art document. If a feature in the claim uses a different terminology, it should be explained that it has the same meaning.
- 4). When attacking dependent claims the closest prior art should be reassessed. The combined features of the dependent claims with the corresponding independent claim should always be compared with the closest prior art.
- 5). All relevant facts and arguments relating to the grounds of opposition should appear in the notice of opposition, since the notice of opposition is the document filed with the EPO.
- 6). It should be avoided to lose time with lengthy discussions of what the individual documents disclose and then repeat the same information when attacking the claims. Time is often also lost in writing long explanatory letters to the client instead of giving short and precise answers to the questions posed in the client's letter. Unnecessary duplication in the notice of opposition and in the response to the client's letter should be avoided.
- 7). 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 (Rule 77 EPC). For the opposition to be admissible it is required that the patent to be opposed as well as the opponent is identified. Payment of the opposition fee should be indicated. Failure to indicate these aspects resulted in marks being deducted. It should be borne in mind that the opponent is generally the company and not the person signing the client's letter.

Specific Comments

Client's Letter:

Clear answers to the client's letter giving a conclusion were expected. Answers which did not cite the correct legal basis were not awarded full marks.

1). It was rarely recognized that the request for correction of the claim to priority was correctly accepted by the EPO under Rule 88 EPC 1973 before the publication of the application, which took place on 05.12.2007. Rule 52(3) EPC 2000, which was not yet applicable, was often incorrectly mentioned in this context.

2). The fact that in case of bankruptcy, according to Rule 142 (1) (b) EPC 2000, proceedings before the EPO shall be interrupted was generally well-answered. However, the fact that the EPO will not refund the opposition fee was often not well-argued.

3). It was well-recognized that Annex 4 can be used but that further evidence is probably necessary.

Notice of Opposition:

Art. 100 (c) EPC:

In order to gain marks this ground of opposition has to be raised in the notice of opposition and does not need to be repeated in the answer to the client.

It was often not recognized that this ground should be raised in respect of the description and of non-limiting features of the claims.

With respect to the Art. 123(2) EPC objection against claim 6, it was often not realized that at that time EPC 1973 continued to apply and therefore R56 EPC 2000, which was often cited, did not apply.

Claim 1:

The inventive step attack on claim 1 starting from Annex 2 as closest prior art and the correct combination with Annex 3 was often recognized.

However, it was frequently omitted to explain that there is a cavity within the wood of Annex 2. Further, it was often forgotten to provide arguments that there is no hindrance of integrating the heating of Annex 3 in the table of Annex 2.

A number of candidates when formulating the inventive step arguments with Annex 2 in combination with Annex 3, did not focus on the problem to be solved in Annex 3, but merely recited all features in Annex 3.

An inventive step attack starting from Annex 3 was generally not convincing because this document does not disclose a table and there was no plausible explanation why the skilled person would incorporate features from Annex 2 into Annex 3.

Claim 2:

The identification of the lower limit of the frequency range was well-argued. For determining the upper limit a reasoned argumentation making use of the general knowledge of Annex 6 was expected. It was often omitted to explain the problem solved by selecting the specific frequency range.

Claim 3:

The novelty attack based on Annex 5 was generally treated well. Candidates often realised that the wording in claim 3: “a receptacle for heating food by a table according to claim 1” implies the stated purpose of claim 1. In order to get full marks it was necessary to argue why the silver layer makes it suitable for induction heating.

The novelty attack based on Annex 6 under Art. 54(3) EPC was often used. It was positive to see that it was often explained that EPC 1973 still applies. However, it was often omitted to explain that the vitreous layer of Annex 6 is a glaze layer as known from Annex 1, paragraph [0007].

An inventive step attack starting from Annex 3 as closest prior art in combination with Annex 5 was not necessary for claim 3 per se. Corresponding marks were awarded for attacks on claim 5.

Claim 4:

The inventive step attack based on Annex 5 as closest prior art in combination with Annex 4 was generally handled well. However, sometimes a proper reasoning that Annex 4 provides a silver-containing layer with the same ingredients and ranges as Annex 1 was missing.

An inventive step attack based on Annex 3 as closest prior art was generally not convincing because Annex 3, paragraph [0007] teaches not to use silver (“non-magnetic metals are of less use for the present purpose as the efficiency of heating is too low”; silver is known from Annex 1 as being a non-magnetic material).

An inventive step attack based on Annex 4 as closest prior art was generally not convincing because A4 does not have a glaze and further discloses a glass container. Furthermore, there is no indication of induction heating and the sequence of the layers is different.

Claim 5:

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.

An inventive step attack based on Annex 5 as closest prior art was generally not convincing because said document teaches away from iron, by stating in paragraph [0006], that “It is thought that copper- and iron-containing layers would lead to degradation of the adhesive and thus to unsatisfactory coating.”

The generic disclosure of “metal” in Annex 6 does not take away the novelty of the specific example of iron falling within the terms of that disclosure (Guidelines C IV, 9.5.).

Claim 6:

Marks were awarded for the Art. 100(c) objection and the further novelty objection based on Annex 6.

The fact that Annex 5 is concerned with a different method, namely applying a silver sheet to the backing of a self-adhesive sheet by spraying was often overlooked.

Possible Solution - Paper C 2009

Response to the client's letter:

1. The priority date is valid. The fact that in the present patent in July 2007, one month after the European filing, priority was claimed and accepted, before publication, which took place on 5/12/2007, does not invalidate the priority date. It has no implication for the opposition, as the basis on which the EPO correctly accepted this request was Rule 88 EPC 1973, which at that time was still in force. The correction was possible before EP-A-publication, which should have taken place 18 months after the priority date (according to Art. 93(1) EPC 1973, J0003/82).

2. According to R.142 (1) (b) EPC 2000, proceedings before the EPO shall be interrupted (e.g. J26/95, J9/90 or Guidelines, Part E, Chapter VII, 1.1) in the event of the proprietor, as a result of some action taken against his property, being prevented by legal reasons from continuing the proceedings before the EPO.

The EPO will not refund the opposition fee, because it is a validly filed opposition against a still valid patent and the fee payment has a legal basis, namely Art. 99 EPC 2000 and does not fulfil the requirements of special refunds (Guidelines A-XI, 10.2.).

3. Yes, Annex 4 can be used. The Email and the link on the homepage of Annex 4 is not sufficient proof that this citation has been published before the priority date of Annex 1. The questions: When, What and Under which circumstances this disclosure has been made available to public must be answered (Guidelines D-V, 3.1.2). Further evidence should be provided, e.g. an affidavit or offering Mr. R. Zenon as a witness (e.g. T91/98; T750/94; or T1134/06, 2006, EPO Board of Appeal Case Law, Special edition No. 6. OJ 2007, pages 52 and 53).

{Marks awarded: 7}

Notice of opposition:

{Marks for Use of Information: 39/Marks for Argumentation: 54}

General:

Annex 4 is prior art under Art. 54(2) EPC. It is an internet citation which was published and last modified on 12/05/2006. Mr. Zenon who is owner of the website is offered as a witness to confirm further details.

Annex 6 is prior art according to Art. 54(3) EPC. According to the Trans. Provisions (Special Ed. Nr. 1, OJ 2007; Guidelines C-III, 8.1(ii)), Art. 54(3) and (4) EPC 1973 apply to European patent applications which were pending at the time of the entry into force of EPC 2000. This is the case for the opposed patent with regard to Annex 6. Rule 23a EPC 1973 restricts the prior right effect to the common states AT BE CH LI DE DK FR GB GR PT for which the designation fees have been validly paid.

Claims 3-5 refer to a receptacle for heating food by a table according to claim 1. This wording implies that the receptacle is "suitable for" the stated purpose of claim 1 (Guidelines, C-III, 4.13 or C-IV, 9.7).

{Marks awarded: 0/4}

Added subject-matter (Art. 100 (c):

An objection under Art. 100(c) EPC is raised as in Annex 1 paragraph [0006], the sentence "when the receptacle is placed at a distance of about 4 cm away from the induction coil, the optimum results are achieved" has been added during the examination procedure without having a basis in the originally filed application. The patent does not fulfil the requirements of Art. 123(2) EPC.

A further objection under Art. 100(c) EPC is raised as the added feature in claim 6 of Annex 1, "preferably consisting of paper" is an amendment which extends beyond the content of the application as originally filed, contrary to Art. 123(2) EPC. This content does not include the priority document (e.g. T260/85 or Guidelines, C-VI, 5.3.1; G3/89; G11/91 or Guidelines C-VI, 5.4.)).

{Marks awarded: 2/3}

Lack of inventive step (Art. 56 EPC) of claim 1 over Annex 2 in combination with Annex 3:

Annex 2 is the closest prior art because it is the only document that discloses a table for the same purpose, namely for keeping food warm.

Annex 2 discloses a table for heating food comprising a wooden table top, having an electrical heating apparatus (claim 1 or paragraph [0003]) within the wood (claim 1). Thus, there has to be a cavity wherein the electric mat is enclosed.

The subject-matter of claim 1 differs from the disclosure of Annex 2 in that the table comprises an electrically conductive coil and means to connect the coil to a source of alternating current. This has the technical effect that the table heats inductively only the receptacle (Annex 1, paragraph [0005]). Accordingly, the objective technical problem to be solved would be to provide heating which does not heat the surrounding area.

It is noted that Annex 2, paragraph [0004] recognizes the disadvantage of heating the surroundings. Thus a skilled person would have a strong motivation to find a heating which does not heat the surrounding area.

Annex 3 is a document which deals with keeping food warm. Accordingly, it is a relevant source of information for the skilled person. Annex 3 teaches that if induction heating is used only the receptacle is heated (paragraph [0005]). From this the skilled person learns that the heating of the surroundings can be avoided by induction heating. There is no hindrance for replacing the heating mat of Annex 2 in the cavity of the table by the induction coil of Annex 3 since induction heating can be used with wood. Annex 3, paragraph [0008]; fig. 1 or Annex 1 paragraph [0005] indicate that it is generally known that the electromagnetic field is not absorbed by non-metallic materials such as wood or plastics. The skilled person would therefore use the induction coil and the connecting means of Annex 3 in the table of Annex 2 and thereby arrive at the subject-matter of claim 1.

Hence, the subject-matter of claim 1 lacks an inventive step over the combination of Annex 2 with Annex 3 (Art. 56 EPC).

{Marks awarded: 7/9}

Lack of inventive step (Art. 56 EPC) of claim 2 over Annex 2 in combination with Annex 3.

Claim 2 is dependent on claim 1.

Annex 2 remains the closest prior art for the same reasons as mentioned concerning claim 1.

The subject-matter of claim 2 differs from Annex 2 by the electrically conductive coil and means to connect the coil to a source of alternating current and the source which is able to produce an alternating current at a frequency between 15 kHz to 20 kHz. The technical effect of the difference is that the table, which has been improved as described above with respect to claim 1, heats inductively the receptacle to an optimum consumption temperature of 60°C - 65°C, without further cooking of the food, thus retaining flavour and nutritional values (Annex 1, paragraph [0006]). The objective technical problem to be solved is to keep the food at the optimum consumption temperature.

The problem and the solution is addressed in Annex 3 paragraph [0003] which provides the information that in the equipment of Annex 3 the food will be kept at the temperature of about 65°C which maintains flavour and nutritional values.

Annex 3 teaches an electrically conductive coil and means to connect the coil to a source of alternating current, as described above with respect to claim 1. Further, Annex 3 teaches that frequencies below 15 kHz, which disturbs the user, should be avoided (Annex 3, paragraph [0005]). Therefore, a frequency of 15 kHz or higher has to be used. Annex 3, paragraph [0005] further teaches that for keeping prepared food warm the frequency used in the present equipment has to be lower than in normal induction hobs. The skilled person knows from the general technical knowledge in Annex 6, paragraph [0004] that the cooking range is between 22 kHz and 44 kHz. Therefore, for keeping food warm, a frequency below 22 kHz has to be used. Thus, in Annex 3 the range of 15 kHz to below 22 kHz is implicitly disclosed.

In this respect Annex 6, which is post-published in relation to claim 2, is considered to reflect the general technical knowledge of the person skilled in the art although it does not belong to the state of the art under Art. 54(2) EPC (T1110/03).

The claimed range of 15-20 kHz does not involve a new technical effect and cannot be considered as a novel selection. The narrower choice of the frequency is achieved by experimental routine. Therefore starting from Annex 2, in the light of the teaching of Annex 3, a skilled person arrives at the claimed range.

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

{Marks awarded: 6/10}

Lack of novelty (Art. 54(2) EPC) of claim 3 over Annex 5.

Claim 3 is an independent claim and concerns a receptacle suitable for the table of claim 1.

Annex 5 (e.g. paragraph [0001] or paragraph [0005]) discloses a plate which is a receptacle comprising a porcelain body. Annex 1, paragraph [0007] teaches that porcelain falls under the scope of a ceramic body. Further, Annex 5, paragraph [0005] teaches a “glazed porcelain plate” which is a ceramic body at least partially coated with a glaze layer.

The plate is further coated (paragraph [0005]) with a silver-containing layer. Annex 1, paragraph [0008] or Annex 4, paragraph [0003] teaches that silver is a metal.

The silver layer makes it usable for induction heating (Annex 5, paragraph [0007] or Annex 1, paragraph [0008] or Annex 6, paragraph [0004]).

Thus the subject-matter of claim 3 lacks novelty over A5 (Art. 54(2) EPC).

{Marks awarded: 4/2}

Lack of novelty (Art. 54(3) EPC) of claim 3 over Annex 6.

Annex 6 discloses an inner kettle made of earthenware (Annex 6, paragraph [0005]). Annex 1, paragraph [0007] teaches that earthenware is an equivalent for ceramic body. Annex 6 (claim 1) discloses that said inner kettle which is considered being a receptacle is suitable for induction heating.

The inner kettle has on the external surface of its base a metallic layer (Annex 6, paragraph [0005]) and is thus at least partially coated with a metal-containing layer. Further the metallic layer is protected with a vitreous layer, Annex 6, paragraph [0005] which is known from Annex 1, paragraph [0007] as being a glaze layer.

In conclusion the subject-matter of claim 3 lacks novelty over Annex 6 under Art. 54(3) EPC.

{Marks awarded: 5/3}

Lack of inventive step (Art. 56 EPC) of claim 4 over Annex 5 in combination with Annex 4.

Claim 4 is dependent on claim 3.

Annex 5 is the closest prior art since it is the only document which discloses a receptacle comprising a ceramic body suitable for the same purpose, namely induction heating, comprising a glaze layer. In addition to the features of claim 3, Annex 5, paragraph [0005] discloses that the whole ceramic body is coated by the glaze layer. Furthermore, Annex 5, paragraph [0005] discloses that a silver-containing layer, i.e. a metal-containing layer can also be applied to the bottom of the glazed ceramic body.

The subject-matter of claim 4 differs from Annex 5 in that the metal-containing layer consists of a specific combination of silver, fused quartz and organic constituents which has the technical effect that the metal-containing layer is resistant to detergents (Annex 1, paragraph [0008]). Accordingly, the objective technical problem to be solved is to provide a metal layer on a plate which is detergent resistant.

Annex 4, paragraph [0004] discloses a glass receptacle for microwave ovens having a silver-containing coating which provides the advantage of very good chemical resistance in particular to detergents in a dishwasher and therefore would be considered by a skilled person.

Annex 4, paragraph [0003] discloses a metal-containing coating comprising 65-70% of zinc, nickel, chromium, silver and palladium, 6-9% natural silicon dioxide and the remainder being an organic component. Annex 1, paragraph [0008] teaches that natural silicon dioxide is the same as fused quartz. Annex 4, paragraph [0004] discloses that due to the conducting silver-containing coating the cooking containers provide various advantages such as very good chemical resistance, in particular to detergents in a dishwasher. The wording in Annex 4 paragraph [0003] "the remainder being an organic component such as an acrylic resin" falls under the wording "the remainder comprising organic constituents" in Annex 1.

Thus Annex 4, paragraphs [0003] and [0004], provides a silver-containing layer with the same ingredients. The ranges of Annex 4 paragraph [0003] lie in the scope of Annex 1, claim 4. A person skilled in the art would have chosen the range in expectation of the very good chemical resistance to detergents in a dishwasher.

Silver is in principle suitable for induction heating, see general knowledge Annex 5, paragraph [0007] or Annex 1, paragraph [0008] or Annex 6 paragraph [0004].

Accordingly the subject-matter of claim 4 is obvious over Annex 5 in combination with Annex 4.

{Marks awarded: 6/7}

Lack of inventive step (Art. 56 EPC) of claim 5 over Annex 3 in combination with Annex 5 and the general knowledge of Annex 6.

Claim 5 is dependent on claim 3.

Annex 3 is the closest prior art because it is the only document concerned with the same purpose, namely induction heating, disclosing an earthenware dish having an electrically conductive metallic coating which is iron (Annex 3, paragraphs [0006] and [0007]). Annex 1, paragraph [0007] teaches that earthenware is a ceramic.

The subject-matter of claim 5 differs from Annex 3 by the glaze layer and the thickness of the metallic layer.

The technical effect of the glaze layer is that the receptacles are suitable for liquids (Annex 1, paragraph [0007]).

The objective technical problem to be solved in relation to the glaze layer is to provide receptacles which can be used for liquids.

The problem and corresponding solution of making it suitable for liquids is addressed in Annex 5 paragraph [0005], which provides the information that the glaze, which acts as a seal, is important to render the plates impermeable for liquids.

Accordingly the person skilled in the art would use a glaze to solve the problem.

The technical effect of the thickness implies that optimum heating is achieved in the electromagnetic field (Annex 1, paragraph [0007]).

The objective technical problem to be solved in relation to the thickness would be how to provide this benefit.

The solution with respect to the thickness is known from the general knowledge in Annex 6 which teaches a person skilled in the art that, during induction heating, the metal base of cookware needs a certain thickness for optimum heating (about 0.3 mm, see paragraph [0004]).

In this respect Annex 6, which is post-published in relation to claim 5, is considered to reflect the general technical knowledge of the person skilled in the art although it does not belong to the state of the art under Art. 54(2) EPC (T1110/03).

The fact that the thickness claimed in claim 5 is about 0.35 mm, while Annex 6 talks of about 0.3 mm, cannot be considered as being a difference. The term “about” used in Annex 6 allows a broad interpretation of the claimed thickness (Guidelines, C-III, 4.7; T686/96) and thus there is an overlap.

Accordingly the person skilled in the art would use such a thickness to solve the problem.

No synergistic effect is provided by the glaze layer and the thickness. Therefore partial attacks using separate combinations of prior art can be made (Guidelines C-IV, 11.5, C-IV 11.8).

Thus, the subject-matter of claim 5 is not inventive over Annex 3 in combination with Annex 5 and the common general knowledge cited in Annex 6.

{Marks awarded: 6/13}

Lack of novelty under Art. 54(3) EPC of claim 6 over A6.

Claim 6 is an independent claim.

Annex 6 discloses in paragraphs [0005] and [0006] a method for coating a kettle made of earthenware which is, according to Annex 1, paragraph [0007], equivalent to a ceramic body, comprising the steps of

- applying on the external surface of the inner kettle a sheet comprising a thin paper layer on which the metallic layer has been spread and which is a layered sheet
- soaking off and thus removing the outermost paper layer, so that the metallic layer faces the ceramic body
- firing the coated kettle at 700°C to 860°C.

This temperature range falls within the scope of claim 6. A person skilled in the art would seriously contemplate applying the technical teaching of the prior art document Annex 6 in the range of overlap.

Thus Annex 6 discloses all the steps of the subject-matter of claim 6 which thus lacks novelty under Art. 54(3) EPC over Annex 6.

{Marks awarded: 3/3}

Paper C 2009 - Schedule of marks

Category	Maximum possible	Marks awarded	
		Marker	Marker
Use of information	39		
Argumentation	54		
Legal aspects	7		
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)

02 July 2009

Chairman of Examination Committee II