

# Examiners' Report Paper C 2012

## 1. Introduction

This year's paper focused on novelty and inventive step argumentation.

The patent to be opposed (Annex 1) did not claim priority. The client's letter did not suggest any further potential problems e.g. related to amendments, etc. Candidates therefore could clearly concentrate on the issues of novelty and inventive step.

Annex 1 relates to patches for application to the skin. Claim 1 proposes a general multi-layered patch comprising a storage-layer comprising an active ingredient to be delivered to skin, an adhesive layer, and a textile layer. Claims 2-5 are directed to multi-layered patches for various different purposes. Claim 6 is directed to a hydrogel to be used in a patch. Claim 7 is directed to a manufacturing process for a patch support structure.

Claims 1-6 of Annex 1 were clearly product claims thus objections for lack of patentability under Article 53(c) EPC were not appropriate.

Annexes 2-5 related to the same intended purposes as addressed in claims 2-5 of Annex 1. Therefore any considerations under Article 54(5) EPC were irrelevant.

The correspondence between the features of a document and those of a particular claim were necessary, with the explanation (supported by facts) of any terms which differed between the prior art and the claim. The identification of the closest prior art and the associated reasoning was especially important. If the closest prior art did not have the same purpose as the claim being attacked, a convincing reasoning would have been necessary as to why the said prior art was suitable for the different purpose. In some cases, a number of different passages in further prior art documents could be combined with the closest prior art. In such cases, some combinations provided more motivation than others, and were awarded more marks than combinations where there was no obvious motivation.

## 2. General Comments

1. Marks are awarded for identifying relevant information, such as claim features, technical effects, problems and hints in the prior art, and using that information in an appropriate way. The specific reference in the relevant document (e.g. paragraph, figure, reference number) has to be cited. All the information necessary to oppose the patent is to be found in the Annexes (including Annex 1). The candidate's own knowledge should not be used.
2. 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 why it has the same meaning, on the basis of the information provided in the annexes, where possible.

3. The term "for" is to be interpreted as being "suitable for" in the case of a product. This may imply certain restrictions on a claim and cannot simply be ignored. This implies that for a novelty attack some argumentation on why a given product is suitable for the indicated use is required. In the case of an inventive step attack, the intended use often identifies the underlying general purpose and has therefore to be taken into account.
4. The problem-solution approach requires identification of the closest prior art for each inventive step attack. A reasoning for the choice of the closest prior art should include the identification of the purpose of the subject-matter to be attacked and of the selected document. General statements such as "Annex X is the most promising springboard to the invention because it has the most features in common" or "Annex X relates to the same general purpose and therefore is the closest prior art" cannot be considered as a convincing reasoning for selecting the closest prior art.
5. The feature(s) distinguishing the claim from the closest prior art should be identified. The technical effect(s) associated with that/those feature(s) has/have to be identified from the patent to be opposed and the appropriate basis must be cited. This applies to independent and dependent claims. The objective technical problem to be solved has to be established based on the technical effect.
6. The mere identification of all required features in several documents is not a convincing argumentation why the corresponding combination of features has to be obvious. To be awarded full marks, the specific reasons explaining why the skilled person would combine documents have to be identified and indicated, as derived from the Annexes. General statements repeated for each attack (i.e. "The skilled person would combine the teaching of the documents without any technical hindrance") cannot be considered as a convincing reasoning for combining features of specific documents.
7. In addition to the attacks set out in the "possible solution", marks were awarded for other plausible, well-reasoned attacks.
8. As set out in the instructions to candidates, it is advisable to use Form 2300 in order to make sure that all information needed for an admissible opposition is given. For the opposition to be admissible it is required that the patent to be opposed as well as the opponent are 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.
9. Candidates are not expected to explain why claims are patentable (e.g. why they comply with the requirements of Article 53 (c) EPC) as the purpose of the paper is to oppose the patent.  
Candidates are reminded that the ground for opposition under Article 100(b)EPC shall not be used as this violates Rule 25(5) IPREE.

10. All pages of the answer paper should be numbered consecutively. The Annexes provided should not be renumbered. Legible handwriting is advisable. When referring to the description, it is helpful to cite the paragraph numbers rather than page and line numbers.

### **3. Specific Comments**

In this year's paper no legal questions were asked. Thus, a letter to the client was not expected.

### **4. Notice of Opposition**

#### **Claim 1**

Two novelty attacks were expected, based on Annex 3 and Annex 5. It was expected that not only the features of claim 1 should be mentioned, but that the corresponding features in both novelty destroying documents should be identified. Any synonyms should be explained.

Claim 1 was novel over Annex 2 since the backing layer of Annex 2 is a polymeric layer. In Annex 1 the textile layer can be formed from polymeric fibres. However, nowhere is it stated that the polymeric layer of Annex 2 can be formed from fibres.

#### **Claim 2**

An inventive step attack was expected, based on the combination of Annex 2 and Annex 6. In general, Annex 2 was correctly cited as the closest prior art, since it addressed the same purpose as claim 2, i.e. a patch for wound healing.

It was sometimes overlooked that the more specific range of the dose to be delivered to the skin disclosed in Annex 2 was completely within the broader range of claim 2. Thus, a discussion on overlapping ranges or possible effects within the range was not appropriate.

Claim 2 relates to a product and not a use. Thus any discussion concerning the exclusion of patentability according to Article 53(c) EPC is not appropriate.

Both technical effects associated with the distinguishing feature (flexible and mechanically stable) needed to be identified.

Annex 6 was the only document mentioning both effects for a textile layer.

#### **Claim 3**

Annex 4 was often correctly cited as the closest prior art, since it addressed the same purpose as claim 3, i.e. a patch for alleviating pain.

As indicated in paragraph [0009] of Annex 1 the addition of a further adhesive layer results in a different effect depending on its location (internal or external adhesive layer).

Two inventive step attacks starting from the same closest prior art were therefore expected, based on the combination of Annex 4 with Annex 5, and Annex 4 with Annex 6.

Again, any discussion concerning the exclusion of patentability according to Article 53(c) EPC is not appropriate.

#### **Claim 4**

An inventive step attack was expected, based on the combination of Annex 3 and Annex 4. In general, Annex 3 was correctly cited as the closest prior art, since it addressed the same purpose as claim 4, i.e. a patch for treating wrinkles. The effect derived from the presence of a hydrogel layer as illustrated in the examples of Annex 1 was in general well-identified.

#### **Claim 5**

Novelty attacks based on each of Annex 3 and Annex 5 were often either not recognized, or not well explained.

Regarding Annex 3, a reasoning was expected as to why the patch containing perfume was suitable as a deodorant, with a reference to back this up.

Perfume leaks from the storage layer disclosed in Annex 5 and therefore a patch according to claim 5 is implicitly disclosed.

#### **Claim 6**

An inventive step attack was expected based on Annex 4. Convincing arguments as to why Annex 4 was the closest prior art were often missing. Here, it was necessary to argue why the hydrogel of Annex 4 would be "suitable for" the purpose defined in claim 6.

Novelty attacks using Annex 4 were wrong. The general teaching in paragraph [0005] is not disclosed in combination with the specific embodiment in paragraph [0007]. Also novelty objections based on the principle of equivalents were incorrect, since equivalents are not taken into account for assessing novelty under the EPC.

#### **Claim 7**

Convincing arguments on why Annex 6 was the closest prior art were often missing.

The expected inventive step attack based on the combination of Annex 6 and Annex 5 was usually well-recognized and in general well done.

## Possible solution - Paper C 2012

### Notice of opposition (in combination with Form 2300)

(Total marks for Use of Information: 42 / Total marks for Argumentation: 58)

#### Effective dates of claims (1/0)

Claims 1- 7 of Annex 1 claim no priority. The effective date of the claims is thus the filing date, i.e. 29.05.08.

Annexes 2-6 were published before the filing date and are therefore state of the art according to Article 54(2) EPC.

#### Claim 1 (3/8)

##### a) Lack of novelty in view of Annex 3

Annex 3 discloses a cosmetic patch comprising a depot layer, an adhesive layer and a fabric carrier ([0004]).

Since the patch of Annex 3 contains 3 layers it is a multi-layered patch.

Since an anti-wrinkle active (active ingredient) is stored in the depot layer which is a polymeric matrix layer, the depot layer is a storage layer according to Annex 1 ([0005]) or Annex 3 ([0004]).

A fabric carrier is a textile layer (Annex 1, [0005]).

Thus, Annex 3 discloses a multi-layered patch according to claim 1 of Annex 1. The subject-matter of claim 1 lacks novelty in view of Annex 3 (Article 54 EPC).

##### b) Lack of novelty in view of Annex 5

Annex 5 ([0004]) discloses a deodorant patch comprising an adhesive layer (52), a polymeric matrix layer (53) enclosing a perfume composition and a nonwoven fibre layer (54).

Since the patch of Annex 5 contains layers (52)-(55) it is a multi-layered patch. A polymeric matrix layer (53) enclosing a perfume composition is a storage layer containing a compound with a pleasant smell (active ingredient) in view of Annex 1, [0005].

A nonwoven fibre layer is a textile layer (Annex 1, [0005]).

Thus, Annex 5 discloses a multi-layered patch according to claim 1 of Annex 1. The subject-matter of claim 1 lacks novelty in view of Annex 5 (Article 54 EPC).

## **Claim 2 (8/8)**

Lack of inventive step in view of Annex 2 and Annex 6

Claim 2 is directed to a multi-layered patch for wound healing.

Annex 2 has to be considered as the closest prior art since it also addresses a wound healing dressing.

A dressing is a patch (Annex 5, [0001]).

The wound dressing comprises a barrier hydrogel layer and a backing layer (a thin elastic sheet) and an adhesive layer (Annex 2, [0005]).

Annex 2 ([0007]) discloses a further polymeric layer containing a wound healing active absorbed therein, which can be considered as a storage layer according to the definition in Annex 1 [0005].

Annex 2 ([0008]) discloses that the final dose of the active agent released to the skin is 7-8 mg per cm<sup>2</sup> per hour. Thus the specific release rate proposed by Annex 2 falls within the broader range of claim 2 of Annex 1. Therefore the claimed range is disclosed by Annex 2.

The subject-matter of claim 2 differs from the teaching of Annex 2 in that a textile layer is present.

According to Annex 1 ([0005]) a textile layer provides a flexible and mechanically stable patch.

The objective technical problem to be solved has therefore to be considered as providing a flexible and mechanically more stable wound healing patch.

Annex 6 ([0007]) states that it is a common principle in manufacturing patches to use a textile reinforcement layer to provide mechanical stability.

Applying this common principle to the wound healing patches disclosed in Annex 2 would not hinder the flexibility of the patch, because it is taught in Annex 6 ([0009]) that the textile layer remains flexible.

Moreover, Annex 1 ([0005]) clearly indicates that no restriction concerning the nature of the fabric exists. Thus, any fabric can be expected to achieve both effects.

Thus, it is obvious for the skilled person to apply a textile layer to the patch according to Annex 2 in order to achieve the effects known for the textile layer.

The subject-matter of claim 2 of Annex 1 therefore does not fulfil the requirements of Article 56 EPC in view of Annex 2 as the closest prior art taking into account the teaching of Annex 6.

### **Claim 3 (8/8)**

Lack of inventive step in view of the combination of Annex 4 with Annex 5 and Annex 4 with Annex 6

Claim 3 of Annex 1 relates to a patch for alleviating pain.

Annex 4 has to be considered as the closest prior art since it addresses an analgesic dressing which provides pain alleviation (Annex 4, [0001]).

Annex 4 (claim 1 or [0003], [0004] and [0006]) discloses an analgesic (pain alleviating) medical dressing comprising a) a hydrogel layer, b) a storage layer and c) a textile carrier, i.e. a textile layer.

A dressing is a form of a patch (Annex 5, [0001]).

The subject-matter of claim 3 differs from the teaching of Annex 4 in that an adhesive layer is present.

According to Annex 1 ([0009]) the effect derived from an adhesive layer differs dependent on the location of the adhesive layer.

An internal adhesive layer contributes to avoid separation of the layers or to enhance the structural integrity of the patch (effect A).

An external adhesive layer achieves adhesion of the patch to the user's skin (effect B).

### **Concerning effect A**

When using an internal adhesive layer, the objective technical problem starting from Annex 4 is to avoid separation of the layers of the patch or to improve its structural integrity.

Annex 5 ([0005]) teaches that the tendency of separation of layers of a patch can be reduced by applying adhesive layers. As evident from the figure, these adhesive layers are internal adhesive layers.

An adhesive layer can be applied without any technical hindrance to a layered structure proposed by Annex 4, since the functionality of an adhesive layer is independent from the intended use of the final patch.

Thus, it would be evident for the skilled person to apply the teaching for an adhesive layer described in Annex 5 for a patch disclosed in Annex 4 in order to achieve the known effects already disclosed in Annex 5.

## **Concerning effect B**

When using an external adhesive layer, the alternative objective technical problem starting from Annex 4 is to provide a patch with an alternative means of holding it in place.

Annex 4 ([0003]) states that the patch has to release the active principle fast in order to minimize the inconvenience of holding the patch. Thus, Annex 4 provides already a motivation for the skilled person to reduce the inconvenience even more.

Annex 6 ([0003]) points out that most conveniently for the end user, a patch is generally fixed to the skin by the use of an adhesive outermost layer. Thus, Annex 6 provides a solution for the problem also addressed in Annex 4.

It would be obvious for the skilled person to apply the general teaching for an external adhesive layer described in Annex 6 for a patch disclosed in Annex 4 in view of the motivation provided by Annex 4.

Thus, the subject-matter of claim 3 of Annex 1 does not fulfil the requirements of Article 56 EPC in view of Annex 4 as the closest prior art taking into account the teaching of Annex 5 and Annex 6.

### **Claim 4 (4/9)**

Lack of inventive step in view of the combination of Annex 3 and Annex 4

Claim 4 of Annex 1 relates to a patch for treating wrinkles.

Annex 3 has to be considered as the closest prior art since it also addresses an anti-wrinkle patch.

Annex 3 discloses all the features of claim 1 on which claim 4 depends.

The subject-matter of claim 4 differs from the teaching of Annex 3 in that a hydrogel layer is present.

In the example ([0013]-[0015]) of Annex 1 it is indicated that the hydrogel layer enhances wrinkle reduction.

The objective technical problem to be solved when starting from Annex 3 has therefore to be considered as providing an anti-ageing patch leading to an improved wrinkle reduction.

Annex 3 already recognises this problem and indicates that the delivery of active ingredient is a problem ([0002], [0003]) and suggests to leave the patch on overnight ([0005]). The skilled reader of Annex 3 therefore has a motivation to deal with this problem.

Annex 4 ([0005]) states that it is well-established, for various skin care applications, that a hydrogel layer improves the transport of all types of active ingredients to the skin due to the formation of a hydrophilic bridge. Since Annex 4 indicates that the hydrogel layer is suitable for various skin care applications it can be concluded that it also works in other patches such as those disclosed in Annex 3.

Moreover, Annex 3 ([0004]) suggests that further conventional layers can be present. Following this general motivation no technical hindrance can be expected by the skilled person when adding a layer of hydrogel to the patches proposed by Annex 3.

The skilled person being aware of this general teaching confirmed by Annex 4 would therefore apply the known hydrogel layer for its well-known and established purpose also for the cosmetic patches disclosed in Annex 3.

Thus, the subject-matter of claim 4 of Annex 1 does not fulfil the requirements of Article 56 EPC in view of Annex 3 as the closest prior art taking into account the teaching of Annex 4.

### **Claim 5 (3/8)**

#### **a) Lack of novelty in view of Annex 3**

Annex 3 discloses all the features of claim 1 on which claim 5 depends.

Annex 3 further indicates that the user of the patch puts some drops of a perfume composition onto the fabric carrier (33) before applying the patch (30) to the skin in order to mask unpleasant body odours (Annex 3, [0006]).

Thus a patch comprising a textile carrier containing a perfume is formed by the user of Annex 3.

A perfume can be used for deodorizing the human body Annex 5 ([0004] or claim 1). Thus, the patch formed by Annex 3 is suitable as a deodorant patch (Guidelines C-III, 4.13).

The subject-matter of claim 5 therefore lacks novelty in view of Annex 3 (Article 54 EPC).

#### **b) Lack of novelty in view of Annex 5**

Annex 5 discloses a deodorant patch ([0003]) comprising all the features of claim 1 on which claim 5 depends.

Annex 5 ([0004]) states that a further polymeric layer (55) having holes small enough to prevent the liquid perfume from leaking is used as the outermost layer. If leaking is to be prevented by layer (55), the perfume must reach layer (55).

Since nonwoven fibre layer (54) is between polymeric layer (55) and storage layer (53) containing the perfume, nonwoven fibre layer (54) also has to contain some perfume.

A nonwoven fibre layer is a textile layer (Annex 1, [0005]).

Thus, the deodorant patch of Annex 5 contains a textile layer containing perfume.

The subject-matter of claim 5 therefore lacks novelty in view of Annex 5 (Article 54 EPC).

### **Claim 6 (6/9)**

Lack of inventive step in view of Annex 4

The purpose of the hydrogel according to claim 6 of Annex 1 is to transport the active ingredient by the use of a hydrophilic bridge (Annex 1 ([0014])).

Annex 4 discloses hydrogels for transporting any active ingredient by the use of a hydrophilic bridge to skin (Annex 4, [0005]) and is therefore also suitable for the intended use, i.e. transporting an anti-wrinkle active.

Annex 4 therefore has to be considered as the closest prior art since it also addresses the same purpose.

Annex 4 ([0007]) discloses a hydrogel layer comprising water, alcohol and starch in an amount sufficient to form a stable gel structure. In addition silver particles can be added to the hydrogel in an amount of 40 to 60 g per 200 g of hydrogel.

This amount corresponds to 20-30 wt.-% of hydrogel.

The range disclosed in Annex 4 falls within the range in claim 6 of Annex 1.

The subject-matter of claim 6 differs from the teaching of Annex 4 in that the gelling agent is gelatine instead of starch.

Annex 1 does not disclose any effect associated with the use of gelatine compared to starch.

The objective technical problem has to be considered as to provide an alternative hydrogel.

Annex 4 ([0005]) explains that gelatine, agar agar and starch are well-known polymeric gelling agents.

Replacing starch by one of the well-known alternative polymeric gelling agents would be customary practice for the skilled person to provide a simple alternative.

Therefore, the subject-matter of claim 6 does not fulfil the requirements of Article 56 EPC in view of Annex 4 as the closest prior art.

### **Claim 7 (9/8)**

Lack of inventive step in view of the combination of Annex 6 and Annex 5

Claim 7 is directed to a manufacturing process for a support structure for achieving the greatest versatility for manufacturing a patch (Annex 1, [0011]).

Annex 6 discloses a cheap and versatile method (Annex 6 [0011]) for producing a laminated carrier structure. The carrier structure of Annex 6 is a support structure (Annex 6, [0004] or [0010]).

Annex 6 is for the same purpose and therefore is the closest prior art.

Annex 6 (claim 1 or [0004]) discloses a laminated carrier structure comprising a release layer (61), an adhesive layer (62), a textile layer (63), a melt adhesive layer (64) and a perforated layer (65).

For the manufacture of the laminated carrier structure the layers are simply placed on top of each other and pressed together (Annex 6, [0011]).

The subject-matter of claim 7 of Annex 1 differs from the teaching of Annex 6 in that after the pressing step a curing step is applied.

Annex 1 ([0011]) explains that the structural integrity can be further improved by curing the patch support structure. During use or removal of the patch a separation of the layers is therefore less likely.

The objective technical problem is therefore to provide a carrier structure with an improved structural integrity.

The skilled person would consult Annex 5, since Annex 5 also addresses tear resistant patches ([0003]) with reduced separation of layers ([0005]).

Annex 5 ([0006]) indicates that the total patch arrangement is thermally treated after adhering the layers together. A treatment at elevated temperature is a curing step, see Annex 1 ([0011]).

Since the heat curing step enhances the adhesive strength of the adhesive layers, the curing step avoids any separation problem of the patch (Annex 5, [0006]).

Since according to Annex 5 ([0006]) this effect is achieved irrespective of the nature of the layers, the skilled person would not consider the teaching of Annex 5 to be limited to the laminates proposed by Annex 5. Thus, the effect is achievable in any type of patch.

The skilled person would therefore also apply the teaching of Annex 5 to the laminated structures of Annex 6 in the expectation of achieving the same effect as already proposed in Annex 5.

Thus, the subject-matter of claim 7 of Annex 1 does not fulfil the requirements of Article 56 EPC in view of Annex 6 as the closest prior art taking into account the teaching of Annex 5.

## EXAMINATION COMMITTEE II

Candidate No. \_\_\_\_\_

### Paper C 2012 - Marking Sheet

| Category           | Maximum possible | Marks awarded |  |
|--------------------|------------------|---------------|--|
|                    |                  |               |  |
| Use of information | 42               |               |  |
| Argumentation      | 58               |               |  |
| Total              | 100              |               |  |

Examination Committee II agrees on ..... marks and recommends the following grade to the Examination Board:

☐ PASS  
(50-100)

☐ COMPENSABLE FAIL  
(45-49)

☐ FAIL  
(0-44)

28 June 2012

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Chairman of Examination Committee II