

Examiners' Report Paper C 2014

1. Introduction

This year's paper focused on novelty, inventive step argumentation, added subject matter and the entitlement to priority (first filing situation).

The patent to be opposed (Annex 1) claimed priority. The client's letter pointed out three topics:

- that Annex 6 was filed by the same applicant as Annex 1.
- that the second option of claim 3 was added at the filing date of Annex 1, and
- that claim 2 was added during examination

Candidates therefore were expected to interpret the client's letter and apply it accordingly in the Notice of Opposition.

Annex 1 relates to a razor cartridge.

Claim 1 is directed to a razor cartridge comprising a resilient foam skin engaging element.

Claim 2 is dependent on claim 1 and further defines the foam.

Claim 3 is also dependent on claim 1 and also presents further features of the resilient foam material. Claim 3 has two alternatives.

Claim 4 is directed to a fenced razor cartridge wherein the fencing element is a flexible sheet.

Claim 5 is dependent on claim 4 and presents further features regarding the apertures in the flexible sheet.

Claim 6 relates to the use of a resilient foam in a razor.

2. General Comments

2.1. It is expected that the candidate analyses the effective dates of the claims and the relevance of the cited documents in relation to these effective dates.

Further, the candidate should identify relevant information, such as claim features, technical effects, problems and hints in the prior art, and use that information in an appropriate way. The specific reference in the relevant document (e.g. paragraph or figure or reference number, as appropriate) has to be cited. All the information necessary to oppose the patent is to be found in the Annexes (including Annex 1). For example, the term "resilient" is defined in Annex 4.

The candidate's own special knowledge of the technical field of the invention shall not be used (R.22 IPREE).

2.2. When comparing a claim with a prior art document, reference is needed to the relevant passage in the prior art document. Further, if the prior art uses a different terminology than the feature in the claim to be opposed, it should be explained why it has the same meaning, on the basis of the information provided in the Annexes.

2.3. 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 prior art document over and above the disclosure of the other documents. 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” are not considered as convincing reasoning for selecting the closest prior art. In the present case, all the documents provided relate to razor systems, so a more specific reasoning is required.

2.4. 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.

2.5. A comprehensive answer includes specific reasons explaining why the skilled person would combine documents, as derived from the Annexes. For example, why specific combinations of materials could be made or are compatible and/or specific comments on motivations. General statements (i.e. “The skilled person would combine the teaching of the documents without any technical hindrance”) are not considered as convincing reasoning for combining features of specific documents.

2.6. The French language version of the examination paper differs from that of the English and German texts (see below under section 3 for details). This leads to a different situation regarding the attacks possible. The exceptional and unintentional situation was fully taken into account and full marks were available to all candidates.

2.7. 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. It should be borne in mind that the opponent is generally the company and not the person signing the client’s letter. Use of the pre-printed opposition form can be helpful.

2.8. Candidates are reminded that the ground for opposition under Art. 100(b) EPC shall not be used as this violates R.25(5) IPREE.

3. Notice of Opposition

Total marks for Use of Information/Total marks for Argumentation: (45/55)

Effective dates of the claims and prior art (4/6)

The information provided in the client’s letter was to be used for this analysis.

It was expected that candidates pick up that the applicant of Annex 1 and Annex 6 is the same, and that since Annex 6 discloses the features of claim 1, the priority of Annex 1 is not valid for claim 1.

Annex 6 is an Australian patent publication and is not available according to Article 54(3) EPC.

Claim 3 has two effective dates. The first alternative is entitled to the priority date.

Claim 3, second alternative, is only entitled to the filing date of Annex 1.

Claim 1 (7/8)

Novelty attacks were expected based on Annexes 4 and 6.

This year, a novelty attack based on Annex 4 was not straightforward based on the French text, since Annex 4 uses different terminology in relation to the resilient foam to that used in Annex 1, claim 1. In the French text, Annex 1 claim 1 specifies a “matériau expansé élastique”. A4, paragraph 5 discloses “matériaux spongieux.....mousses synthétiques..... comportement élastique”, which is not exactly the same. Such a novelty attack was however accepted.

In view of this, in the absence of a novelty attack on claim 1, this year, an inventive step attack could be made using Annex 3 combined with Annex 5.

Claim 2 (3/3)

An objection of subject-matter extending beyond the content of the application as filed on claim 2 was expected.

A complete reasoning required a consideration of the information available in the application as filed, and why this was not sufficient basis for the claim.

Since the claim has no effective date, an inventive step attack on claim 2 is not appropriate.

Claim 3 (13/15)

Claim 3 has two alternatives, having different effective dates.

Annex 4 is not the closest prior art since in this document, the resilient foam does not have the purpose of tensioning the skin forward of the cutting edge.

For the English and German texts:

For both alternatives, an inventive step attack based on Annex 3 as closest prior art was expected.

For the first alternative, the combination of Annex 3 with Annex 5 was expected.

For the second alternative, Annex 5 is not needed, as the combination of Annex 3 and Annex 6 provides the required features.

For the French text:

Claim 3 uses different terminology in relation to the position of the resilient foam, compared to the English and German versions of claim 3. In the French text of claim 3, the expression “en amont” is used, whereas in paragraphs 0002 and 0010, the expression “en aval” is equivalent to “avant”, and in paragraph 0006 “avant” is used in relation to tensioning of the skin. Depending on the interpretation of the terminology, different attacks could be made. All scenarios used were taken on their merits. An inventive step attack using Annex 3 as closest prior art for both alternatives, or a novelty attack based on Annex 6 for alternative b, are examples of possible attacks.

Claim 4 (12/14)

An inventive step attack based on the combination of Annex 2 and Annex 3 was expected. Annex 2 is closer than Annex 3 since it relates to a flexible sheet-type fencing element, which provides stability to the fencing.

Claim 5 (2/5)

Claim 5 provided features already disclosed in Annex 2, and was therefore to be attacked using the analogous argumentation as to that used for claim 4.

Claim 6 (4/4)

Claim 6 was anticipated by Annex 5. No further attack was expected.

Possible solution - Paper C 2014

Notice of opposition (in combination with Form 2300).

Total marks for Use of Information/Total marks for Argumentation: (45/55)

Effective dates of the claims and prior art (4/6)

Annex 1 claims the priority of GB344566. Claim 3 has two alternatives, hereafter called 3a and 3b. Claims 1, 3a, 4, 5 and 6 are identical to the priority.

There is no basis for claim 3b in the priority application since it and §13 were both added at the date of filing of Annex 1. Claim 3b is thus entitled to the filing date i.e. 07.01.2011.

Annex 2 to Annex 5 are all published prior to the first filing of Annex 1. Each document is thus available under Article 54(2) and Article 56 EPC.

Annex 6 is a document which is published before the filing date of Annex 1, but after the priority date of Annex 1. The priority of Annex 6 is before the priority of Annex 1. Annex 6 was filed by the same applicant as Annex 1. Annex 6 discloses, as explained below under claim 1, the features of claim 1.

Thus GB344566 - the priority of Annex 1 - is not the first application under Article 87(1) EPC for this subject matter. Claim 1 of Annex 1 is thus not entitled to priority, but only the filing date of 07.01.2011.

The features of claims 3a, 4, 5 and 6 are not disclosed in Annex 6. Claims 3a, 4, 5 and 6 have the effective date of 08.01.2010 (Article 87(1)(2) EPC; Article 88(3) EPC; Article 89 EPC).

Thus Annex 6 (published 04.01.2011) is prior art according to Article 54(2) EPC for the subject matter of present claim 1.

Since claim 3b has the date of 07.01.2011, Annex 6 is prior art according to Article 54(2) EPC for claim 3b.

Claim 1 [Independent] (7/8)

Novelty (Article 54 EPC)

Annex 4:

Annex 4 discloses a razor cartridge (razor blade unit §1). This is a razor cartridge according to claim 1 of the patent in suit (Annex 1, §2).

The razor cartridge comprises a blade having a straight cutting edge (clearly shown as 23 in fig.2).

The razor cartridge also comprises a skin-engaging element. Attached to the blade unit, e.g. as a strip attached to the cap portion (§4 or §6) is a lubricating device. This

clearly comes into contact with the skin (e.g. §1, “essential for the skin feel of the device”).

The lubricating device is comprised of a porous matrix, which is preferably a spongy material such as a synthetic polyethylene foam (§5).

The synthetic polyethylene is a resilient foam (§5: the foam displays resilient behaviour thus is a resilient foam).

Thus claim 1 lacks novelty over Annex 4.

Annex 6:

Annex 6 discloses a razor cartridge (§3: razor blades on a support - cf. §2 of Annex 1 where the razor cartridge is a support to which further elements are attached e.g. blades).

The razor cartridge of Annex 6 comprises a blade having a straight cutting edge (fig.1 - blades 13, 14 - fig.1 clearly shows that the cutting edge is straight).

A skin-engaging element is the retentive strip 12 attached to the cartridge, which comes into contact with the skin (e.g. "This may pull on the skin", §6).

The strip is comprised of a sponge material which may be a synthetic sponge such as a foamed polymer (§6).

In §6 it is explained that the foam must be able to recover its shape after use if deformed. This conforms to a resilient property (cf. Annex 4, §5, last 2 lines).

Thus claim 1 lacks novelty over Annex 6.

Claim 2 [dependent on claim 1] (3/3)

Extension of subject matter (Article 123(2) EPC)

Claim 2 was added to the application during the examination phase. In claim 2, the self-adhesive foam is of a special type: it is a polyurethane self-adhesive foam. §15 of the application as filed teaches that a self-adhesive foam may be used to make the foam skin-engaging element. An example given for such a self-adhesive foam is polyvinyl acetate.

The application as filed also teaches polyurethane as the resilient foam (§11). The two paragraphs are not linked.

There is thus no clear and unambiguous teaching in the application as filed of the combination of self-adhesive with polyurethane.

Claim 2 thus extends beyond the content of the application as filed under Art.100(c) EPC.

Claim 3 [dependent on claim 1] (13/15)

Claim 3 comprises two alternatives.

Inventive step (Article 56 EPC)

Annex 3 deals with the same technical problem or purpose as Annex 1, i.e. that of providing a skin engaging element forward of the cutting edge which tensions the skin for shaving, and also relates to the same type of razor cartridge. Annex 3 is thus the closest prior art.

Annex 3 discloses a razor cartridge (§1) comprising at least one blade 51, 52 having a straight cutting edge (figs.1 and 3).

Annex 3 further discloses a skin-engaging element in the form of a guard 30 (e.g. claim 1). Either, a guard is a skin engaging portion (Annex 1, §2). Or, from §6 or §7 of Annex 3 it is clear that the fins contact the skin. Therefore the guard must engage the skin.

A guard is the portion of the cartridge forward of the cutting edge (Annex 1, §2): thus the guard of Annex 3 is arranged to contact (and hence tension) the skin ahead of the cutting edge.

The two alternatives are that the resilient foam is either polyurethane or biodegradable starch.

3a polyurethane (date 08.01.2010)

The subject matter of claim 3a differs from the disclosure of Annex 3 in that a resilient polyurethane foam is used as a tensioning strip.

The effect of the resilient polyurethane foam is that it is cheap and easy to produce (Annex 1, §11).

The technical problem is thus to provide a razor cartridge having a tensioning strip which is cheap and easy to produce.

The skilled person would have consulted Annex 5, which relates also to the technical field of razors. Annex 5 mentions the same concept, i.e. the tensioning of the skin (§6).

The foam material of Annex 5 is a resilient foam, as is clear from §2 and §3 - the foam is "readily deformable" and "recovers its original shape after use" - cf. also Annex 5, claim 1, and Annex 4, §5, last line.

There is no technical hindrance to use the foam of Annex 5 in the cartridge of Annex 3, since in Annex 5 the foam may be attached to a frame of polypropylene (Annex 5, §9). In Annex 3 the platform is also of polypropylene (Annex 3, §3).

The foam in Annex 5 may be a polyurethane foam (Annex 5, §7). Additionally, Annex 5 discloses that the polyurethane foams are cheap and easy to produce (Annex 5, §7).

The skilled person would thus have used the polyurethane foams of Annex 5 in the cartridge of Annex 3. Thus the subject matter of claim 3a is not inventive over Annex 3 in the light of the teaching of Annex 5.

3b biodegradable starch copolymer (date 07.01.2011)

The subject matter of claim 3b differs from the disclosure of Annex 3 in that a resilient biodegradable starch copolymer foam is used as a tensioning strip.

The effect of the foam being of biodegradable starch copolymer is that it has reduced impact on the environment (Annex 1, §12).

The technical problem is thus to provide a razor cartridge having a tensioning strip which has reduced impact on the environment.

The skilled person would have consulted Annex 6, which also relates to the technical field of razors. The foam in Annex 6 has a high coefficient of friction which provides the same effect as required from the guard (§6).

Annex 6 discloses a retentive sponge strip. The spongy material may be a foamed polymer (Annex 6, §6).

Annex 6 mentions that the retentive sponge strip it uses is able to spring back to its original shape after use (i.e. it is resilient see Annex 4, §5).

In Annex 6 the foam is attached to a razor head (see e.g. fig.1). Thus there is no technical hindrance to use the foam of Annex 6 in the cartridge of Annex 3.

The foam in Annex 6 may be a biodegradable foam such as a starch copolymer (Annex 6, §8).

Additionally these foams reduce the need to incinerate or otherwise dispose of plastics (Annex 6, §8).

The skilled person would thus have used the biodegradable starch copolymer foams of Annex 6 in the cartridge of Annex 3. Thus the subject matter of claim 3b is not inventive over Annex 3 in the light of the teaching of Annex 6.

Claim 4 [independent] (12/14)

Inventive step (Article 56 EPC)

The closest prior art for claim 4 is Annex 2. Like Annex 1, Annex 2 relates to a sheet used as a fencing element for a razor. The sheet of Annex 2 has the same purpose as the subject matter of Annex 1 claim 4, i.e. providing a stable fencing.

Annex 2 discloses a razor cartridge (Annex 2, §1 or §5). A razor head is the same as a razor cartridge (Annex 2, §5, the blades are in a support cf. Annex 1, §2, "a razor cartridge typically comprises a support to which further elements are attached").

The razor head comprises a blade having a straight cutting edge (Annex 2, fig.2, "2"-the cutting edge of the blade is clearly straight).

Annex 2 has a fencing element in the form of a flexible sheet element (Annex 2, §5). The sheet of Annex 2 has a row of aligned holes (linear row of apertures 17; Annex 2, §5). Apertures are the same as holes (Annex 1, §18).

The intervals between the holes are not more than 0.25 mm wide (Annex 2, §9). The strips of Annex 2 are the same as the intervals between holes of Annex 1, since this term in both documents denotes the material between the holes.

The flexible sheet element is folded over the blade (Fig.2 or §5 or §6). The flexible sheet is secured to the blade (Annex 2, §6).

It can further be seen from Annex 2, fig.2 or deduced from §6 that multiple portions of the cutting edge are exposed. The holes in the flexible sheet and therefore the portions of cutting edge which are exposed are 0.50 - 1.20 mm wide (Annex 2, §9). This is substantially overlapping with the range of 0.60 - 1.00 mm of present claim 4 (no narrow range, no effect, near to end points) (Guidelines G VI 8 or T198/84 or T279/89).

The subject matter of claim 4 differs from the disclosure of Annex 2 in that the flexible sheet is made of plastics.

This has the effect that the fencing element provides a better fencing since the plastics have a lower coefficient of friction than metals (Annex 1, §17).

The technical problem is thus to provide a flexible sheet type of fencing element with improved fencing effect.

The skilled person would have consulted Annex 3 since this is also a document concerned with fencing (Annex 3, §8 or §10).

The solution to this problem is found in Annex 3, §10. Here it is described that the use of plastics wires in a wire wrapping type of fencing is advantageous since the plastics have a lower coefficient of friction than metals and thus increase the fencing effect.

The skilled person would have had no difficulty in using a plastics material for the flexible sheet of Annex 2 since the plastics material of Annex 3 is clearly also flexible, as it can be wrapped around the blades.

Thus the subject matter of claim 4 is not inventive over Annex 2 in the light of the teaching of Annex 3.

Claim 5 [dependent on claim 4] (2/5)

Inventive step (Article 56 EPC)

The closest prior art for claim 5 is Annex 2, for the same reasons as for claim 4.

The additional feature of claim 5 is found already in Annex 2:

Annex 2 discloses that the holes in the sheet are 3 to 4 mm in length (Annex 2, §9).

The sheet of Annex 2 is folded over the blades to provide the fencing element (Annex 2, §5, §6). From Fig.2 of Annex 2 it can be seen that the sheet 16 is folded symmetrically, i.e. approximately in half. The length of the holes of 3 to 4 mm then translates to a distance extending backwards from the blades on each side of the blade of between 1.5 and 2 mm.

The range of Annex 2 thus includes a portion which is at least 1.70 mm as required by claim 5 of the patent in suit: the value of 2mm is in this claimed range, as well as the overlapping part of the range from 1.70 mm up to 2mm.

The difference between the subject matter of claim 5 and that of Annex 2 is thus the same as that for claim 4.

Thus the claim lacks inventive step over Annex 2 in combination with Annex 3 for the same reasons as explained above for claim 4.

Claim 6 [independent] (4/4)

Novelty (Article 54(2) EPC)

The razor of Annex 5 uses a resilient foam material:

Annex 5, §2 states that the material is readily deformable and Annex 5, §3 states that the foam material recovers its original shape after use. These two characteristics correspond to the definition of a resilient material cf. Annex 4, §5.

The foam material used in the razor of Annex 5 stretches the skin so that it is advantageously positioned for the cutting edge: thus the stretching, i.e. tensioning is in advance of the cutting edges of the blades (Annex 5, §6).

The foam surrounds the blade (Fig.1 or 2 or cl.1), thus there is always foam forward of the cutting edge.

Thus the subject matter of claim 6 is not novel over the teaching of Annex 5.

EXAMINATION COMMITTEE II

Candidate No. _____

Paper C 2014 - Marking Sheet

Category	Maximum possible	Marks awarded	
Use of information	45		
Argumentation	55		
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)

24 June 2014

Chairman of Examination Committee II