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Beschwerdekammer
in Disziplinarangelegenheiten

Disciplinary
Board of Appeal

Chambre de recours statuant
en matière disciplinaire

Case Number: D 0006/13

D E C I S I O N
of the Disciplinary Board of Appeal
of 30 July 2014

Appellant: N.N.

Decision under appeal: Decision of the Examination Board for the
European Qualifying Examination dated 22 July
2013.

Composition of the Board:

Chairman: E. Dufrasne
Members: T. Bokor
T. L. Johnson

Summary of Facts and Submissions

- I. The appellant sat the 2013 European Qualifying Examination ("EQE"). He appealed, by a notice of appeal both dated and received by fax at the EPO on 26 August 2013, against the decision, posted by registered letter dated 22 July 2013, of the Examination Board that he had not been successful, having been awarded 39 marks for his performance in paper A (Chemistry). The appeal fee was also paid on 26 August 2013.

- II. The Examination Board decided not to rectify its decision, and transmitted the case to the Disciplinary Board of Appeal with letter dated 15 October 2013.

- III. In a communication under Article 14 of the Additional Rules of Procedure of the Disciplinary Board of Appeal (RPDBA, Supplement to OJ EPO 1/2014, 54) dated 11 February 2014 the Board informed the appellant of its provisional view that the appeal was unlikely to succeed, as the Board did not see any infringement of the REE and its implementing provisions. A review of the technical details of the paper and the details of the marking were beyond the competence of the Disciplinary Board of Appeal.

- IV. The appellant submitted further arguments and requested oral proceedings with letter dated 9 April 2014. Oral proceedings were held on 30 July 2014. Both the President of the European Patent Office (EPO) and the President of the Council of the Institute of Professional Representatives (epi) were informed about the appeal proceedings. The President of epi was not represented at the oral proceedings, nor did he file

observations. The representative of the President of the EPO attended the oral proceedings.

V. Pursuant to Rule 23 of the Implementing provisions to the Regulations on the European qualifying examination for professional representatives (IPREE), Paper A expects from candidates that they prepare a patent application on the basis of a letter from a potential applicant to the professional representative. In the EQE 2013 Paper A, Chemistry, the applicant's letter and its attachments concerned a method for making artificial snow on the basis of superabsorbing polymer granules, for the purposes of skiing. The instructions of the marking scheme foresaw that candidates prepare an independent claim directed at the final product of the method, the "artificial snow granules" and having certain water content, as explained in more detail below. The marking of a candidate's answer was to a large extent based on the marks awarded for the claims prepared by the candidate. The complete paper and the Examiner's Report are available on the website of the European Patent Office.

VI. In his appeal the appellant argued in essence that he was not awarded as many points as he would have been entitled to, as a result of an erroneous evaluation of the claims in his paper. In respect of his "artificial snow" claim he was awarded merely 3 marks, instead of the maximum possible 10 marks. This meant that there had been a violation of Rule 23(3) IPREE. This latter rule implied that the marking is made correctly, i.e. according to principles of correct patent practice as reflected in the Guidelines for Examination of the EPO. However, the marking scheme was based on incorrect

criteria, and thus contravened Rule 23(3) IPREE. Similar objections were raised in respect of the marking of the other independent claims (use claim "making snow", product claim "granules", method claim "making granules").

VII. In writing and at the oral proceedings the appellant submitted detailed arguments why his answer paper should have been given more points, given that his answers were correct both with regard to the expected answers and also fulfilled the requirements of the EPC and thereby complied with Rule 23(3) IPREE. Briefly, he submitted that specifying the amount of water for the product claim "artificial snow" was not necessary because the notion "snow" inherently included water. The Guidelines for Examination and the case law of the Boards of Appeal supported that inherent features did not need to be claimed explicitly. This issue was also not a value judgement, since a decision to award the maximum points for a correct solution did not require value considerations. Arguments concerning the marking of other independent claims were withdrawn during the oral proceedings.

VIII. The appellant requested that the marking of his paper A EQE 2013 be reconsidered and that he be awarded at least 45 marks. The decision of the Board was announced at the end of the oral proceedings.

Reasons for the decision

Unless indicated otherwise, REE refers to the version in force from 1 January 2009 (Supplementary Publication to OJ EPO 12/2011, 2), und IPREE refers to the version in force from 1. April 2010 (Supplementary Publication to OJ EPO 12/2011, 20).

1. The appeal is admissible.

2. It is well established by the jurisprudence of the Disciplinary Board of Appeal that it only has jurisdiction in EQE matters to establish whether or not the Examination Board has infringed the Regulation on the European Qualifying Examination ("REE") or a provision implementing the REE. This follows from Article 24(1) REE which reads: "An appeal shall lie from decisions of the Examination Board ... only on the grounds that this Regulation or any provision relating to its application has been infringed". Thus the Disciplinary Board of Appeal may only review Examination Board decisions for the purposes of establishing that they do not infringe the REE, its implementing provisions or a higher-ranking law. It is not the task of the Disciplinary Board of Appeal to reconsider the examination procedure on its merits nor can it entertain claims that papers have been marked incorrectly, save to the extent of mistakes which are serious and so obvious that they can be established without re-opening the entire marking procedure. All other claims to the effect that papers have been marked incorrectly are not the responsibility of the Disciplinary Board of Appeal. Value judgments are not, in principle, subject to judicial review. (See, for

example, D 1/92 (OJ EPO 1993, 357), points 3-5 of the Reasons; D 6/92 (OJ EPO 1993, 361), points 5-6 of the Reasons; and D 7/05 (OJ EPO 2007, 378), point 20 of the Reasons, all cited in the Case Law of the Boards of Appeal, 7th Edition 2013, Chapter V.2.6.3.).

3. Concerning the arguments relating to his "artificial snow" claim (point 2.1 of the Grounds of Appeal), the appellant recognises that the deduction of 7 points might have been caused by his omission of the feature of the absorbed water, and the Board finds this reasoning plausible. The appellant further contends that the alleged mistake is so obvious that a complete re-evaluation of his paper is not necessary. The Board disagrees. Contrary to the opinion of the appellant, the importance of the water content in the expected claim and the question whether it is obviously implied in the notion of "snow" is an issue that cannot be decided without entering into a detailed technical analysis of the complete Paper A and - arguably - also the appellant's answer paper.

4. The claim drafted by the appellant is directed to "artificial snow" comprising the superabsorbing granules. Such a claim essentially corresponds to an expected claim as given in the Examiner's Report, apart from the water content. The appellant contends that any product falling under the notion of "artificial snow" would inevitably contain water. He argues that it was clear from the details of the Paper A that only snow for skiing purposes could have been meant. Other possible uses of artificial snow, as mentioned in the Board's communication of 11 February 2014, e.g. for decoration purposes as in a shop-window or for use in a

theatre performance, and which could be imagined as not having any water content at all, were clearly outside the scope of Paper A. The description prepared by the appellant included the required teaching concerning the necessity of the water content, further supporting the argument that its explicit inclusion in the claim was not necessary.

5. The Board notes that already this argumentation of the appellant, namely the necessity of referring to the overall content of the Paper A and his answer paper, demonstrates that this issue is difficult, if not impossible to decide without effectively requiring a complete re-examination of the whole paper A and his answer paper.

6. The appellant alleges a violation of Rule 23(3) IPREE. This rule states that "Candidates are expected to draft an independent claim (or claims) which offer(s) the patent applicant the broadest possible protection in accordance with the EPC." According to the appellant, this rule implies that the marking scheme will indeed award the maximum number of points for a proposed claim which offers the broadest possible protection, while fulfilling the requirements of the EPC. Obviously, a claim will offer the broadest possible protection only if it does not contain non-essential features. The amount of the water content in the present case was an inessential feature. Water content was anyway inherent in the term "snow". Given that the marking scheme required the water content for the "artificial snow granule" to be included in the claim, Rule 23(3) IPREE was not complied with, i.e. it has been infringed in the sense of Article 24(1) REE.

7. The Board does not see any infringement of Rule 23(3) IPREE. Rule 23(1) IPREE explains the overall purpose of Paper A, namely to assess candidate's ability to draft a European patent application. Rules 23(2) and (3) IPREE must be read in this light. Thus Rule 23(3) IPREE merely specifies that within the overall task set by Paper A, i.e. the drafting of a complete patent application, the claims should be drafted in a manner normally expected from a patent attorney, namely seeking a possibly broad, but reasonably solid and defensible protection for the client. It has not been alleged that the Paper A (Chemistry) of the EQE 2013 was directed at something else. The Board accepts that this rule, together with the overall purpose of the EQE implies the establishment and application of a correct marking scheme. To that extent the Board can also accept that the Examination Board has an implied obligation to prepare the examination papers and the corresponding marking scheme correctly, in the sense that the marking scheme should award the appropriate marks for correct solutions, moreover that this "correct" marking scheme should also be "correctly" applied in every individual case.

8. However, it remains that the Disciplinary Board of Appeal may not be competent to determine whether the marking scheme or an individual marking is correct from every possible aspect which may have adversely affected the marking of a candidate, given that Article 24(1) REE obviously excludes certain appeal grounds. Therefore, the Board holds that if the Examination Board did not "perfectly" fulfil this implied obligation, in that arguably correct solutions were not awarded any or enough marks, this cannot be

qualified immediately as an infringement of Rule 23(3) IPREE in the sense of Article 24(1) REE. Rather, this question has to be decided on a case-by-case basis when examining any given appeal under Article 24(1) REE. In every case, the Board first must establish if the grounds of appeal fall under the provisions of this Article, and it is clear that certain grounds are not admissible. These considerations led to the established principle that the Disciplinary Board of Appeal has only a limited competence to examine on appeal any given examination paper and the corresponding marking scheme from a technical point of view. Indeed, if the Board were to extend the examination of appeals to an in-depth technical examination of the examination materials and an answer paper of a candidate, it would in effect reduce to zero the scope of the restriction concerning the possible grounds of appeal, as stipulated by Article 24(1) REE.

9. It is clear to the Board that such an exercise would require value judgments referred to in point 2 above. In the present case, the mere decision to award the maximum possible marks for an undisputedly correct solution would perhaps not require a value judgment, as the appellant argues. However, the decision whether a given claim, while not corresponding to the expected example, is in fact correct or not, would certainly be a value judgment, in the sense that this would require a careful technical assessment of the claim against the whole examination documentation.
10. On this basis, the Board is not competent to determine if the implied obligation of the Examination Board has

been perfectly fulfilled, in the sense that correct claims were duly awarded the maximum marks or the marking scheme indeed defined the most perfect claims. Rather, this question is left for the review possibility by the Examination Board foreseen in Article 24(3), first sentence, REE. The Board adds that the limited competence of the Disciplinary Board of Appeal is also apparent from the fact that the majority of the members of any given Disciplinary Board of Appeal deciding on EQE matters need not have any technical qualification (Article 24(3), third sentence, REE).

11. For these reasons, the Board holds that it has no formal competence to decide in the present appeal whether or not the water content could have been omitted from the expected "snow granule" claim. It seems to the Board that this issue is a technical aspect which has been assessed obviously differently from the assessment of the appellant. Nevertheless, this differing assessment by the markers and subsequently by the Examination Board when marking the appellant's answer paper, even if disputable from a technical point of view, or even from the point of view of established patent practice, in itself did not infringe Rule 23(3) IPREE. In this manner the Board does not recognise any violation of the REE and its implementing provisions, and this reason is sufficient in itself to dismiss the appeal.

12. Furthermore, the Board also does not see any manifest errors either in the examination papers or in the marking instructions in the Examiner's Report and the marking of the appellant's paper. Only for the sake of

completeness, even though the Board cannot be expected to perform a complete review of the marking, as explained above, the Board provides a brief comment on the arguments of the Appellant concerning the "artificial snow" product claim, as outlined below.

13. Having briefly reviewed Paper A and the arguments of the appellant, the Board finds that the appellant failed to achieve the full marks as a result of his evaluation concerning the essential and non-essential features of the expected claims. He did not lose any marks because the markers committed serious errors during the evaluation of his answer papers or made some other obvious mistake. This was also recognised by the appellant, who admitted during the oral proceedings that he did not consider that the markers themselves were to blame. In the opinion of the Board, what the appellant criticises here is not a possible violation of the applicable procedural rules, but rather the technical details of the marking, i.e. the composition of the examination paper and the corresponding marking scheme, the marks awarded to the appellant being merely the inevitable consequence of the allegedly incorrect marking scheme. Thus the appellant in fact does not dispute the correctness of the marking procedure, even less an infringement of the legal rules establishing the marking procedure, but whether it could have been reasonably expected from a candidate to realise that the water content of the "artificial snow" claim was an essential and as such a required feature of the claims to be drafted.

14. It is implied in the argumentation of the appellant that in his opinion a candidate had no reason to

believe that the water content had to be claimed explicitly, in order to come up with a claim receiving full marks. The Board finds that the examination paper in fact contains pointers to this, see e.g. the letter of the applicant, paragraph 25, second sentence (page 8, lines 1-3): "At least 5 times the weight of water based on the weight of the granules needs to be absorbed to obtain artificial snow." (Board's emphasis). Whether this pointer in itself was enough or some stronger statements would have been needed to emphasise the importance of the water content is an issue beyond the competence of the Board. Rather, this is a question of the difficulty of the examination, i.e. another value judgement which is not subject to review, as stated above in point 2.

15. Therefore, even if one could plausibly argue that for a skilled reader of the Paper A it would have been quite obvious that the superabsorbing granule of the expected product claim could only be considered as "artificial snow granule" with appropriate water content, the Examination Committee's (implicit) decision that the water content had to be claimed, cannot be objected to. Put differently, the choice of the Examination Committee, as reflected in the Examiner's Report, to expect an "artificial snow" product claim with the required water content explicitly mentioned does not appear to the Board as manifestly erroneous. In this light, it was also not manifestly erroneous that the Examination Board decided not to correct its decision under Article 24(3), first sentence, REE.
16. On the basis of the above assessment, the Board does not perceive any infringement of the applicable

provisions of REE or IPREE, nor of any higher ranking law. Therefore, the appeal must be dismissed.

Order

For these reasons it is decided that:

The appeal is dismissed.

The Registrar

The Chairman

P. Martorana

E. Dufrasne