



Case Number: D 0020/16

D E C I S I O N
of the Disciplinary Board of Appeal
of 16 February 2017

Appellant: N.N.

Decision under appeal: Decision of the Examination Board for the
European Qualifying Examination dated
25 July 2016.

Composition of the Board:

Chairman: T. Karamanli
Members: C.-P. Brandt
H. G. Hallybone

Summary of Facts and Submissions

I. The appeal contests the decision of the Examination Board for the European qualifying examination (EQE), notified to the appellant by registered letter with advice of delivery dated 25 July 2016, that he had failed the EQE 2016, for which he was awarded the following marks: Paper A: 41, Paper B: 62, Paper C: 38, Paper D: 45.

The relevant marking details of the two members of Examination Committee I were enclosed with the contested decision.

II. By letter of 31 August 2016, received at the European Patent Office (EPO) on 1 September 2016, the appellant filed a notice of appeal against the decision and at the same time stated his grounds. The appeal fee was likewise transferred on 1 September 2016.

III. By letter of 7 October 2016, the Examination Secretariat informed the appellant that his appeal had not been allowed by the Examination Board, and had therefore been referred to the Disciplinary Board of Appeal.

IV. The appeal contests the marking of Paper A (E/M) of the EQE 2016. The appellant's written submissions in the statement of grounds of appeal can be summarised as follows:

In several sections entitled "Introduction", "Background", "Appellant's solution", "Deficiencies of the solution provided in the examiners' report" and "Comparison of the solution provided in the examiners'

report to appellant's solution", he essentially argued that he should be awarded a passing grade because (i) the main claim in his solution defined subject-matter that was new and inventive over the prior art provided, and (ii) the solution provided in the examiners' report and rejected by him excluded an embodiment and claimed the invention "in use" and (iii) comprised no advantage over his own solution in terms of novelty and inventive step.

His solution was very similar to the solution proposed in the examiners' report, with the exception of two features. Firstly, in an alleged clarity error, he had not claimed that liquid could flow into and out of the siphon "via the reservoir". Secondly, the Examination Board had apparently deducted points because he had not included all aspects of the feature labelled "d2" in the examiners' report, which regarded feature d2 as necessary for establishing novelty and inventiveness over the prior art described in the client's letter and the drawings, and in particular as serving to exclude the embodiment of Fig. 1c.

Under "Appellant's solution", "Deficiencies of the solution provided in the examiners' report" and "Comparison of the solution provided in the examiners' report to appellant's solution" (pages 3 to 11), the appellant then explained why he took the view that there were good reasons to reject a solution including all aspects of feature d2 as set out in the solution presented in the examiners' report, why the embodiment of Fig. 1c was within the scope of the independent claim proposed in the examiners' report, and why the subject-matter defined in his own claim did not cover the non-inventive embodiment depicted in Fig. 1c. His

- final "Conclusion" was that his solution defined "subject matter, which is at least as inventive as the solution provided in the examiners' report".
- V. The appellant originally requested
- 1) as a main request, that the decision to award a failing grade be reversed, and in particular that the points deducted for lack of novelty and/or inventive step with regard to the independent claim of his solution be restored;
 - 2) as an auxiliary request, should the Examination Board see fit to grant request 1), the withdrawal of his registration for Paper A of the EQE 2017.
- No oral proceedings were requested.
- VI. By letters dated 24 October 2016, the present board invited the presidents of the EPO and of the Institute of Professional Representatives before the EPO (epi) to comment on the case under Article 24(4) of the Regulation on the EQE for professional representatives (REE, OJ EPO 2014, supplementary publication 2) and Article 12 of the Regulation on discipline for professional representatives (RDR, OJ EPO 1978, 91 et seq., OJ EPO 2008, 14 et seq.). Neither did so.
- VII. With communication dated 9 November 2016, the board informed the appellant of its provisional opinion on the appeal, namely that as things stood it had little chance of success.
- VIII. In a written reply dated 15 November 2016 and received at the EPO on 17 November 2016, the appellant partly reiterated the arguments he had submitted with his

statement of grounds of appeal. His additional submissions can be summarised as follows:

He recognised that it was not within the jurisdiction of the Disciplinary Board of Appeal to review the entire marking procedure, and nor was he requesting that the boards of appeal perform a general review of the marking of his answer to Paper A. The Examination Board's decision had infringed Article 1 REE and Rule 23 IPREE, which required that the EQE be designed to establish whether a candidate was qualified to practise as a professional representative. The contested decision was based on a serious mistake which was so obvious that it could be established without re-opening the entire marking procedure. In particular, the mistake was the result of an inconsistently or incomprehensibly formulated question/task and should be deemed obvious in accordance with decision D 13/02.

Paper A, like the current format for the pre-examination, comprised a fixed set of "questions" for which marks were awarded according to a strict scheme which did not allow any discretion and where a "pass" or "fail" was merely the arithmetical outcome of the marks achieved. Accordingly, the independent claim of Paper A could be marked using a checklist and an Excel spreadsheet listing desired features, equivalents, and total points for given combinations. It was therefore possible for the Disciplinary Board of Appeal to assess, without conducting an in-depth review or interfering with any value judgement of the Examination Board, whether or not a question involving the inclusion of a single feature of the independent claim (e.g. feature d2(b)) provided an example of an

inconsistently or incomprehensibly formulated question/task.

On pages 3 to 5 of his letter the appellant again contrasted the solution in the examiners' report with that in his answer paper as regards whether or not feature d2(a, b) should be included in the independent claim, coming to the conclusion that including it, as proposed in the examiners' report, would infringe Rule 23(3), first sentence, IPREE and Rule 23(5) REE (sic), since doing so would exclude the embodiment shown in Fig. 2c of the client's letter and would also give rise to a "flood of clarity issues" (referring to his grounds of appeal). The formulation of the question/task regarding the inclusion or exclusion of feature d2(b) therefore had to be considered at least inconsistent, if not incomprehensible, and as such had to be regarded as a serious and obvious mistake.

- IX. The appellant therefore maintained his requests. The decision to award a failing grade should be reversed, because the marks deducted for lack of inventive step with regard to the independent claim of his solution should be restored. Again, he did not request oral proceedings.

Reasons for the Decision

1. The appeal is admissible according to Article 24 REE but not allowable.
2. In its communication dated 9 November 2016, the Board already stated that, in accordance with Article 24(1)

REE and the established jurisprudence of the Disciplinary Board of Appeal (following D 1/92, OJ EPO 1993, 357), decisions of the Examination Board may in principle only be reviewed for the purposes of establishing that they do not infringe the REE, the provisions relating to its application, or higher-ranking law. It is not the function of the board to reconsider the entire examination procedure on the merits. Only if the appellant can show that the contested decision is based on serious and obvious mistakes can the board take this into account. The alleged mistake must be so obvious that it can be established without re-opening the entire marking procedure. An inconsistently or incomprehensibly formulated question, for example, may be deemed such an obvious mistake (D 13/02).

3. Even taking into account the appellant's submissions in his letter dated 15 November 2016, the board maintains its view that looking into the alleged deficiencies of the solution provided in the examiners' report would require an in-depth review of the content of the examination material of Paper A. To establish whether the alleged deficiencies actually occurred, the board would in fact have to review if not the entire examination paper and examiners' report, then at least substantial parts of them. Firstly, it would have to perform a detailed technical analysis of the facts presented in the client's letter (including several figures) and in the examiners' report, comprising 34 pages in the English version, including an example solution and a number of so-called equivalents and non-equivalents, which when combined or not combined in specific ways lead to different consequences in terms

of novelty and/or inventive step and/or clarity. Secondly, it would have to compare and relate these facts to the extensive and detailed submissions made by the appellant in both his appeal letter and his letter dated 15 November 2016 (pages 3 to 5) in an attempt to show that his proposed independent claim did not cover the embodiment depicted in Fig. 1c and should therefore be considered as inventive.

4. Therefore, the subject of review in the present appeal appears to be the "correct" interpretation and evaluation of the technical features and statements in the answer paper, and equally an examination of whether the solutions in the examiners' report are correct. Thus, examining the arguments put forward by the appellant would clearly be an exercise which could not be done without making a value judgement. It is clear to the board that assessing features of the independent and dependent claims and the introductory part of the description to be drafted by the candidates, on the one hand, and comparing them with technical details of the disclosed invention and the prior art indicated in the client's letter, on the other hand, as well as comparing the example solution and further requirements set out in the examiners' report with the appellant's answer paper, would involve such value judgements.

5. The appellant recognises in his letter of 15 November 2016 that, in accordance with consistent jurisprudence of the Disciplinary Board of Appeal, value judgements are not subject to judicial review and it is not the function of the board to reconsider the entire examination procedure and to perform a general review of the marking of his answer to Paper A. However, for

the first time in the present proceedings he now contends that the decision of the Examination Board infringed Article 1 REE and Rule 23 of the Implementing provisions to the Regulation on the European qualifying examination (IPREE, OJ EPO 2014, supplementary publication 2, page 18), IPREE, which require that the EQE be designed to establish whether a candidate is qualified to practise as a professional representative, and that the contested decision was based on a serious and obvious mistake which was so obvious that it could be established without re-opening the entire marking procedure. In particular, the mistake was the result of an inconsistently or incomprehensibly formulated question/task and should be regarded as obvious in accordance with D 13/02.

6. The board notes that these assertions were put forward only in the appellant's letter of 15 November 2016, rather than in the statement of grounds of appeal. They appear to have been prompted by the board's statement in point 4 of its communication dated 9 November 2016. The fact that they were not already submitted in the statement setting out the grounds of appeal suggests that the appellant himself did not regard them as his main reasons for contesting the decision of the Examination Board.
7. Moreover, these new arguments do not change the board's preliminary opinion that the appeal is not allowable, since the appellant has not shown that the contested decision infringed the REE, the provisions relating to its application, or higher-ranking law, or that Paper A contained an inconsistently or incomprehensibly

- formulated question that could be considered to be an obvious mistake.
8. Whereas Article 1(1) REE indicates in general terms that the EQE is designed to establish whether a candidate is qualified to practise as a professional representative before the EPO, Article 1(4), first sentence, REE and in particular Rule 23 IPREE define the subject-matter, content and purpose of Paper A, as well as the requirements and expectations to be met by candidates. Paper A of the EQE 2016 consisted of a client's letter and drawings. In point [20] of the client's letter the candidates were asked to draft a set of claims and an introductory part of the description for a European patent application which would protect the invention. The paper was therefore perfectly in line with the requirements set out in Article 1(4), first sentence, REE and, in particular, in Rule 23 IPREE.
9. However, evaluating and marking the candidate's answer paper, and taking the final Examination Board decision on whether or not his proposed solution meets the requirements in particular of Rule 23(3) to (5) IPREE in view of the facts presented in the client's letter and drawings and the possible solutions suggested in the examiners' report, and whether - for example - the inclusion or not of feature d2b, as discussed in the appellant's statement of grounds of appeal and letter of 15 November 2016, can be accepted as at least justifiable, would clearly be an exercise which could not be performed without making value judgements which are not subject to judicial review and which fall outside the Disciplinary Board of Appeal's jurisdiction.

10. In his letter of 15 November 2016 (page 2, second para.) the appellant submits that "for each feature a candidate must decide whether the feature should be included or not, and this decision must be based on the requirements of the EPC, in particular regarding novelty, inventive step on the one hand, and on the other hand to ensure that the broadest possible protection is achieved for the client while bearing in mind the requirements of the EPC regarding unity". The board fully agrees with this statement, which however clearly illustrates that evaluating and marking all the various decisions required of candidates is quite impossible without making said value judgements.
11. In that letter the appellant further submits that Paper A, like the current format for the pre-examination, comprised a fixed set of "questions" for which marks were awarded according to a strict scheme which did not allow any discretion, and that accordingly the independent claim could be marked using a checklist and an Excel spreadsheet listing desired features, equivalents, and total points for given combinations. The board cannot follow these submissions, which it does not regard as a proper and comprehensible substantiation of the appeal. In the pre-examination (Rule 10 IPREE), candidates are expected to respond to clearly defined questions or statements in a multiple choice mode, which they can only answer "true" or "false" by ticking a box; they have no possibility to add any reasons or explanatory notes. That is the decisive difference to the EQE, in particular its Paper A under Rule 23 IPREE, where the candidate is not confined to fixed questions and statements but can

offer solutions which he finds meet the requirements of Rule 23 IPREE, and even, if need be, give reasons for his proposals in supplementary notes (see Rule 23(6) IPREE). Accordingly, the task set in point [20] of the client's letter (see point 8 above) can by no means be regarded as formulated as a "question" which can only be answered "true" or "false" by multiple choice. Rather, it is a request to draft a set of claims and an introductory part of the description for a European patent application which will protect the client's invention, leaving considerable scope for individual decisions about the draft required. It is therefore not comprehensible how and to what extent, in the appellant's view, "the mistake" could be "the result of an inconsistently or incomprehensibly formulated question/task and should be deemed obvious in accordance with D 13/02", given the meaning normally ascribed to the wording of the task as formulated in point [20]. Rather, the appellant's submission that "the marks were awarded according to a strict scheme not involving any discretion and the award of a "pass" or "fail" was merely the arithmetical outcome of the marks achieved and that it was therefore possible for the Disciplinary Board of Appeal to assess the correct marks without an in-depth review and interfering with any value judgement of the Examination Board" has almost literally been taken from D 3/14 (decision of 1 September 2014) which, however, pertains to the pre-examination and can for the reasons stated above not be attached any significance in the present case.

12. There is furthermore no evidence for the appellant's assertion that marks were awarded according to a strict scheme which did not allow any discretion. This is

contradicted by the very fact that the examiners' report provides an example solution and a number of "equivalents" and "non-equivalents" which, when combined or not combined in specific ways, lead to different consequences in terms of novelty and/or inventive step and/or clarity or scope of protection. Thus, the members of the Examination Board have broad discretion when awarding marks on the basis of their assessment of the candidate's solution, consisting of his chosen combination, inclusion or exclusion of features derivable from the client's letter and drawings. It is hard to see how these mostly discretionary judgements could be properly performed using a checklist and an Excel spreadsheet listing desired features, equivalents, and total points for given combinations. Consequently, contrary to the appellant's assertion, it is not possible for the Disciplinary Board of Appeal to assess whether, for example, the inclusion or exclusion of feature d2b in the independent claim is an example of an inconsistently or incomprehensibly formulated question/task without conducting an in-depth review of the entire content of the examination and without interfering with value judgements made by the Examination Board.

13. The Board notes that the appellant's contention that the award of a "pass" or "fail" grade is merely the arithmetical outcome of the marks achieved may apply as a general statement to most kinds of examinations and the assessment and marking of answer papers. This may even be done using a checklist or Excel spreadsheet. However, that does not change the fact that the conclusion - i.e. whether and how many marks are to be

awarded for a proposed solution, e.g. the inclusion or exclusion of feature d2b in the independent claim to be drafted - can only be arrived at by a value judgement and mostly on the basis of a discretionary decision, that discretionary decision, as has been repeatedly pointed out by the board, not being subject to judicial review and falls outside its jurisdiction.

14. It is difficult to reconcile the appellant's assertion that the Disciplinary Board of Appeal should be able to mark the independent claim of Paper A with a checklist and an Excel spreadsheet and no in-depth review with the fact that he has found it necessary to devote ten pages in his appeal letter and another three (pages 3 to 5) in his letter dated 15 November 2016 to trying to show that his proposed independent claim does not cover the embodiment depicted in Fig. 1c and should therefore be considered as inventive, whereas that embodiment is within the scope of independent claim 1 proposed in the examiners' report and there are good reasons to reject a solution including all aspects of feature d2 as presented in the examiners' report, thereby making use of various examples and infringement scenarios of his own, including figures. For this reason too the appellant's contention appears contradictory, and hence not a proper substantiation of his appeal.

15. Thus the board concludes that the appellant has not shown that the contested decision based on his Paper A answer and the examiners' report contains any serious mistakes. Even assuming, for the sake of argument and in the appellant's favour, that such a mistake was made, it was not so obvious that it could be established without re-opening the entire marking procedure and

interfering with the value judgements of the Examination Board. The appellant himself does not appear to assume that the Examination Board's decision based on the examiners' report was completely and obviously erroneous, because in his appeal letter (page 10, point VII) he states that his solution defines subject-matter "which is at least (emphasis by the present board) as inventive as the solution proposed in the examiners' report", thereby implicitly conceding that the solution proposed in the examiners' report is inventive, too. Lastly, the board notes that an obvious mistake of the kind mentioned in decision D 13/02, also referred to by the appellant in his letter of 15 November 2016, namely very different marking by the two examiners, clearly does not apply in the present case. On the contrary: for Paper A the two examiners were in full agreement in their marking, both awarding 20 and 15 marks for the independent claim and dependent claims respectively.

16. For the reasons set out above, the appeal is not allowable.

17. Since the appellant's main request for reversal of the contested decision awarding a failing grade cannot be allowed, his auxiliary request for withdrawal of his registration for Paper A of the EQE 2017 is moot.

Order

For these reasons it is decided that:

The appeal is dismissed.

The Registrar:

The Chairwoman:

P. Martorana

T. Karamanli