

Beschwerdekammer in Disziplinarangelegenheiten
Disciplinary Board of Appeal
Chambre de recours statuant en matière disciplinaire

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Case Number: D 0020/17

D E C I S I O N
of the Disciplinary Board of Appeal
of 14 February 2018

Appellant: N.N.

Legal Representative: N.N.

Decision under appeal: Decision of 6 July 2017 of the Examination Board for the European qualifying examination that the appellant failed Papers B and C of the European qualifying examination 2017

Composition of the Board:

Chairman: I. Beckedorf
Members: L. Bühler
N. M. Lenz

Summary of Facts and Submissions

- I. The appellant sat papers B to D at the European qualifying examination 2017. He was awarded 42 marks for Paper B and 46 marks for Paper C. On the basis of this marking, the Examination Board awarded him a "fail" for Paper B and a "compensable fail" for Paper C.
- II. In a letter dated and received on 27 July 2017 the appellant appealed the decision to give him marks of 46 for Paper C and 42 for Paper B. By letter of 13 September 2017 the Examination Board remitted the appeal to the Disciplinary Board of Appeal (Appeal Board) without rectifying its decision.
- III. With a letter dated 28 September 2017, the appellant filed further arguments.
- IV. On 1 December 2017, the Appeal Board summoned to oral proceedings. In a communication dated 22 December 2017 it gave its preliminary opinion.
- V. With a letter dated 3 January 2018, the appellant provided further arguments in reply to the Appeal Board's communication.
- VI. Oral proceedings on 14 February 2018 were attended by the appellant, his legal representative (Article 24(4) of the Regulation on the European qualifying examination for professional representatives [REE, OJ EPO 2017, Supplementary publication 2, 2] together with Article 17 of the Regulation on discipline for professional representatives [OJ EPO 2017, Supplementary publication 1, 127]), and a person

appointed by the President of the European Patent Office (Article 24(4) REE together with Article 14 of the Regulation on discipline).

VII. The appellant argued that the marking of Paper B was based on an incorrect premise, in that according to the examiners' report the candidates were expected to include new dependent claims directed to the glove and the headband for goggles, notwithstanding the instructions to the contrary in the client's letter. With respect to Paper C, the appellant argued that the marking of his answer to claim 2, which deviated from the examiners' report but was at least reasonable, contravened the principle of fair marking.

VIII. The appellant's arguments which are relevant for the decision may be summarised as follows:

(a) *Paper B*

According to section 1.5 of the examiner's report, "it was expected from the candidates that a system comprising any kind of garment is protected by the independent claim. It was further expected to claim both the glove and headband for goggles as specific examples of a garment in the dependent claims."

With respect to the expected redrafting of claim 1 of the set of claims as proposed by the client, the appellant argued that the Examination Board and the competent examination committee had underestimated the problems caused by the client's ambiguous instructions, and the number of marks available according to

section 3.1 of the examiners' report was thus not commensurate with the level of difficulty.

As regards the expected new dependent claims directed to a glove and a headband for goggles, the appellant argued that these claims were without a basis in the client's instructions and in Rule 24(2) and (3) of the Implementing provisions to the Regulation on the European qualifying examination (IPREE, OJ EPO 2017, Supplementary publication 2, 18).

(i) Headband for goggles

According to the appellant, a different interpretation of the client's letter, on which the expectation with respect to a separate dependent claim for a headband for goggles (claim 7) was based, was possible and objectively justified.

The relevant passage of the client's letter reads as follows (emphasis added by the Appeal Board):

"[04] The third embodiment is enjoying unexpected success in the sports article market. To cover this embodiment, we replaced the erroneous word 'glove' in amended claim 1 by 'headband for goggles'. It is very important for us to have protection for this embodiment. Inspired by the erroneous word 'glove' and by the teaching of D3 we intend to produce a glove comprising optical and motion sensors according to our inventive idea. If possible, please protect the option that the garment is a glove. In view of the comment of the

examiner in section 3.2 you may have to provide corresponding reasoning. Otherwise we do not want you to add further dependent claims."

According to the appellant, the client had not given explicit instructions to include a new claim regarding the headband for goggles. In the sentence "Otherwise we do not want you to add further dependent claims.", the word "otherwise" was used in a conditional sense and could only relate to the conditional request to protect the option that the garment is a glove. Rule 24(2) and (3) IPREE stipulated that the claims provided by the applicant were to be amended as appropriate to meet the requirements of the EPC, but in accordance with the client's instructions. The replacement of the erroneous word "glove" had already been made in the client's draft of the amended claims. There was thus no other reason for expecting a new dependent claim than a different interpretation of the client's instructions.

Moreover, adding a new dependent claim 7 as proposed in the examiners' report was not necessary. Rearranging the claims whilst maintaining the broadest protection instead of adding new dependent claims was an alternative in conformity with Rule 24(2) and (3) IPREE. Numerous amendments to the claims other than adding a new dependent claim were available. The appellant had changed the order of the dependent claims and replaced claim 4 in the client's draft set of claims with claim 6 and vice versa. The dependencies were adapted accordingly. These

amendments were thus reasonable and competently substantiated.

(ii) Glove

The appellant argued that with respect also to the expected dependent claim 6 directed to the glove, there was no explicit instruction in the client's letter or any other justification for claiming the glove separately in the dependent claims. The reformulated claim 1 already protected the glove as an embodiment of the garment and provided the broadest possible protection. Claim 1 responded to the client's instruction to possibly protect the option that the garment was a glove. The instructions should have been formulated differently if the client had wished to have the "glove" recited in a dependent claim. The client had also expressed the wish to remove the word "glove" from the claim set, since he repeatedly stated that the word "glove" was erroneous. It was thus clear that the client wished to avoid the feature "glove" in the claims. In any case, the client had not explicitly requested the addition of a dependent claim for this embodiment. The penalty for not having formulated a new dependent claim 5 was disproportionate.

(b) Paper C

With respect to the subject-matter of claim 2 of Annex 1, candidates were expected to raise an objection of lack of inventive step starting from Annex 5 as the closest prior art (see examiners' report, pages 4 and 9

et seq.). The cork-removing device of Annex 5 differed by two features from the subject-matter of claim 2. The technical effects attributable to the two differences did not mutually influence each other and did not result in a synergistic effect. Therefore, it was expected that separate partial problems would be formulated, for which separate argumentation had to be provided. With respect to the first partial problem, Annex 5 had to be combined with Annex 2. With regard to the second partial problem, lack of inventive step had to be argued on the basis of a combination of Annex 5 with Annex 6.

The appellant argued that his attack against claim 2 of Annex 1 for lack of inventive step starting from Annex 6 as the closest prior art in combination with Annexes 5 and 2, albeit deviating from the examiners' report, was at least reasonable. The technical obstacle which, according to the examiners' report, disqualified Annex 6 from being the closest prior art was incorrect. As a consequence, the marking of the appellant's attack against claim 2 was based on a false premise, and awarding 0 points contravened the principle of fair marking.

- IX. The appellant requested that:
- (a) the Examination Board's decision of 6 July 2017 to award the appellant a "fail" for his Paper B and a "compensable fail" for his Paper C of the European qualifying examination 2017 be set aside;
 - (b) the marking of his answers to Papers B and C of the European qualifying examination 2017 be re-evaluated;
 - (c) the appeal fee be reimbursed.

Reasons for the Decision

1. The appeal is admissible.

2. *Paper B*

2.1 *Claim 1*

As is apparent from page 9, section 3.1, and page 17, section 5.2.1, of the examiners' report, a total of 18 marks were available for the amendments to claim 1 of the applicant's claim set and for the related reasoning. The Appeal Board was not persuaded by the appellant that the applicant's instruction had posed a difficult challenge and that the number of available marks did not correspond to the difficulties of the challenge with respect to claim 1 or the complexity of the expected amendment.

2.2 *Headband for goggles*

2.2.1 Referring to the last sentence of paragraph [04] of the client's letter, the appellant argued that the applicant (client) had given no instructions to include a new claim regarding the headband for goggles. The Appeal Board does not share the appellant's interpretation of that sentence. Contrary to the appellant's view, the word "otherwise" in the sentence "Otherwise we do not want you to add further dependent claims." is to be understood in the sense of "apart from that" and not in the sense of "if not". Although the word "otherwise" can be used with a conditional

meaning, this is not the case in the context of paragraph [04] of the client's instructions.

2.2.2 However, which interpretation of that last sentence of paragraph [04] of the client's letter is to be considered correct is not decisive, since the need for a new dependent claim arose, as the examiners' report states in point 3.2.6, because the headband for goggles could not be listed together with the other embodiments (sock, wristband, or glove) in the original dependent claim 5 due to its dependency on claim 4: "The headband for goggles had to be claimed in a separate dependent claim, because it could be argued that this embodiment is - in contrast to the sock, wristband and glove - not disclosed in combination with a screen as claimed in claim 4. A suitable solution in this exceptional case was to formulate a new claim 7 directed to the headband and not dependent upon claim 4." Therefore, even if it were accepted, for the sake of argument, that the client did not explicitly instruct the representative to include a new dependent claim regarding the headband for goggles, the formulation of such a claim was required to meet the requirements of the EPC. This conforms with Rule 24(3) of the Implementing provisions to the Regulation on the European qualifying examination (IPREE, OJ EPO 2017, Supplementary publication 2, 18). The evaluation of the appellant's answer is thus not based on a technically or legally incorrect premise. Point 3 of the examiners' report might have overstated the relevance of paragraph [04] of the client's letter. However, this had no implications for the marking of the appellant's paper in respect of an expected new independent claim directed to the headband for goggles, since the basis

for the assessment given in the examiner's report is correct.

2.2.3 As regards the appellant's argument that the client's instructions to provide the broadest possible protection in accordance with the EPC could be adhered to without adding a new dependent claim, the Appeal Board has no reason to doubt that the examiners took the appellant's rearrangement of the dependent claims into consideration. It follows from point 3.2.4, second paragraph, of the examiners' report that marks were available for amendments that departed from the expected solution, provided that they were logically and competently substantiated. Indeed, the examiners' report is exemplary as regards the details of the marking in respect of conceivable answers deviating from the proposed solution. Although the appellant's rearrangement is not addressed in the examiners' report as a possible amendment to the set of claims proposed by the applicant, this does not demonstrate that the examiners disregarded the appellant's rearrangement of the dependent claims without further consideration of its merits. Under the Regulation on the European qualifying examination for professional representatives (REE, OJ EPO 2017, Supplementary publication 2, 2) and the provisions implementing it, there is no obligation for the examiners' report to address each and every answer departing from the expected solution. Whether or not the appellant's rearrangement of the claims and the proposed amendments in fact overcame the problem of the dependency of original dependent claim 5 on claim 4 and merited the full number of marks available is a question the Appeal Board has no power to examine.

2.2.4 The Appeal Board was also not convinced by the appellant's argument that a first claim directed to a garment (which was expected to be formulated) provides the broadest protection, since it protects all embodiments. Although correct, the Appeal Board fails to see how this argument could support the appellant's case. If this approach had been strictly adhered to, there would have been no need to explicitly mention the headband for goggles in any of the (dependent) claims, and also no reason for the rearrangement proposed by the appellant. In any case, pursuant to Rule 24(3) IPREE, the claims supplied by the client should be amended as appropriate to meet the requirements of the EPC. Candidates are moreover required to provide their arguments in support of the patentability of the independent claims. Therefore, when drafting a first claim directed to a garment, the amendments to claims 1 and 5 suggested by the client had to be reviewed. Even if paragraph [04] of the client's letter were to be read as not requiring new dependent claims, it undoubtedly required a reassessment of the proposed deletion of claim 5 and reasoning in support of the patentability of any claim mentioning the headband for goggles.

2.3 *Glove*

2.3.1 As to the instructions in paragraph [04] of the client's letter, in the Appeal Board's opinion their wording leaves no room for the appellant's interpretation that the client wished to remove the word "glove" from the claim set. It is true that paragraph [04] asks for protection of the "glove", "if possible", and that such protection could be provided

by a claim directed to a "garment". However, the client's letter does not (and cannot reasonably be expected to) use strict legal language. Paragraph [04] concerns embodiments of the invention, and from the context it is clear that "protect" and "cover" are used interchangeably in the sense that the embodiments should be reflected in the claims. In any case, there is no instruction to avoid the term "glove" in the claims as argued by the appellant. Such an interpretation of paragraph [04] of the client's letter is also not in line with the appellant's reading of the same passage in the context of the headband for goggles. In the latter context, the appellant opined that the word "otherwise" in the last sentence of paragraph [04] could only relate to the conditional request to "protect the option that the garment is a glove". It is however not possible to read this passage of the client's letter in both ways, on the one hand excluding new dependent claims except possibly for a claim protecting the option that the garment is a glove, and on the other hand requiring the word "glove" to be removed from the claim set. The appellant argued that the inclusion of a new dependent claim was only an option ("if possible") suggested by the client, and he proposed, as an alternative, to rely on the protection provided by a claim directed to a "garment". However, this approach would have required amending the description, contrary to Rule 24(3), third sentence, IPREE, since the only mention in the original application of the fourth embodiment (glove) which should possibly be protected was in original claim 5.

2.3.2 In its letter of 28 September 2017, the appellant referred to point 5.3.2 of the examiners' report and

argued that this passage was inconsistent with point 3.2.5, in that the examiners themselves considered a dependent claim reciting the embodiment "glove" as not per se satisfying the requirements of the EPC but requiring in addition an amendment of the description, contrary to Rule 24(3), third sentence, IPREE. The Appeal Board disagrees. There is no contradiction between points 3.2.5 and 5.3.2 of the examiners' report with respect to the need to mention the glove in the description. A proposal to amend the description was expected as auxiliary reasoning only in case the examiner were to maintain his or her opinion that the embodiment of the glove was to be mentioned in the description (point 3.2 of the communication). This is in keeping with Rule 24(3), fourth sentence, IPREE, and also in line with the client's instruction to provide reasoning in view of the comment of the examiner in section 3.2 of the communication. Point 3.2.5 of the examiners' report does not support the conclusion that an amendment of the description was deemed necessary. The examiners' report is thus consistent.

2.3.3 Finally, the appellant argued that the marking scheme should have set a penalty lower than 5 marks for the omission of a dependent claim directed to a glove. However, the Appeal Board cannot see any good reason why the Examination Board or the competent examination committee should have exceeded the proper limits of its discretion in this respect. Again, the appellant relies on his understanding of the client's instructions, according to which the client did not explicitly request a dependent claim for a glove and instead asked for the broadest protection. However, as discussed above, the Appeal Board is not convinced by the

appellant's arguments. The argument that the formulation of a claim reciting a glove was given disproportionate value as compared to claim 1 is based on an incorrect assumption regarding the number of available marks for claim 1 (see point 2.1 above).

2.4 The reasons given by the appellant in the present case do not provide any indication that the marking of the appellant's Paper B should be regarded as having been influenced by a serious and obvious mistake. Therefore the appeal against the decision to give a mark of 42 for the appellant's answers to Paper B cannot be allowed.

3. *Paper C*

3.1 The appellant contests the marking of his answer with respect to claim 2 of Paper C.

3.2 The Appeal Board agrees with the appellant that, in the light of the explanations given in the examiners' report, giving him 0 out of 20 marks for his attack regarding claim 2 appears to be founded solely on the deviation in the choice of the closest prior art for the expected objection of lack of inventive step.

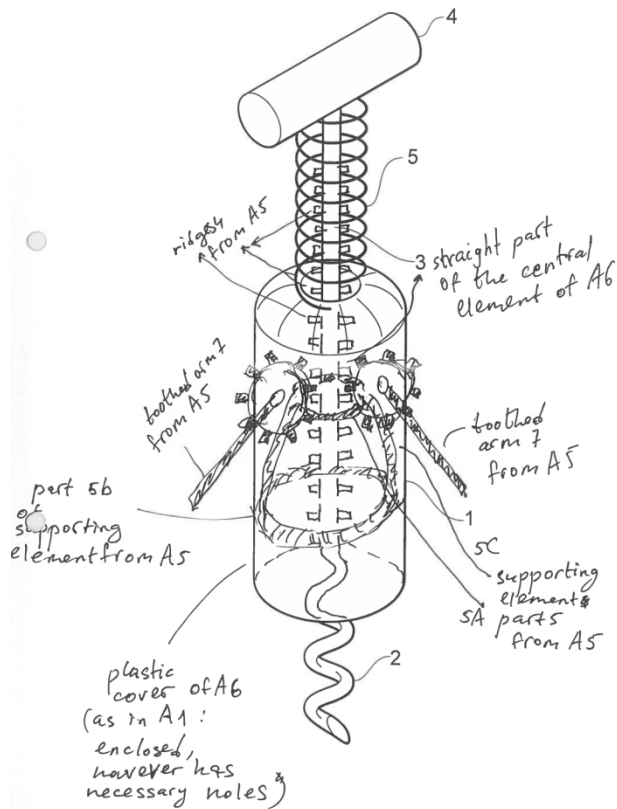
3.3 The following reasons are given in the examiners' report as to why Annex 6 is not a suitable starting point for an objection of lack of inventive step (emphasis added by the Appeal Board): "Annex 6 is a pull-type corkscrew, which comprises a spring around the extraction element's straight part. The spring would not allow the toothed arms to engage with ridges placed on the straight part."

It follows from this passage that the spring of the corkscrew disclosed in Annex 6 is perceived as a technical obstacle that would militate against the choice of Annex 6 as the closest prior-art document.

- 3.4 It is established case law that the examiners are obliged to allow for fair marking of answers which deviate from what was expected according to the examiners' report, but are reasonable and competently substantiated (see *inter alia* D 7/05, OJ EPO 2007, 378, Headnote II and Reasons 13; D 12/82, OJ EPO 1983, 233, Reasons 3). This obligation follows from the object of the qualifying examination, which is to establish whether a candidate is fit to practise as a professional representative (Article 1(1) REE); but it does not rule out the possibility that an individual answer to a part of Paper C may be awarded no marks if, for instance, an objection of lack of inventive step is based on a document which cannot reasonably be regarded as the closest prior art or a suitable starting point for the problem-solution approach or if the reasoning, while structured according to the problem-solution approach, cannot be regarded as a logical and justified ground, in a notice of opposition, prejudicial to the maintenance of a European patent.

- 3.5 The assertion in the examiners' report that the spring of the corkscrew disclosed in Annex 6 was an obstacle discounting this document as an appropriate starting point for the problem-solution approach had been contested in parallel appeal proceedings.

3.6 On the basis of a summary examination, it is evident from the figure below, filed by the appellant with his letter dated 3 January 2018, that no technical obstacle exists (see also D 14/17).



3.7 The only reason given in the examiners' report disqualifying Annex 6 as a suitable starting point for an objection of lack of inventive step is therefore not tenable. As a consequence, Annex 6 is reasonably to be regarded as an alternative starting point for an objection of lack of inventive step in respect of the subject-matter of claim 2.

3.8 The examination committee was therefore wrong to award no marks for the appellant's attack against claim 2 for lack of inventive step starting from Annex 6 as the closest prior-art document, for the sole reason that the appellant had chosen what the examination committee erroneously thought to be an unsuitable starting point.

This marking contravened the examination committee's obligation to award marks for an attack which, albeit deviating from the expected solution, is logical and, in keeping with the recognised practice, justified. The question of which document is correctly to be viewed as representing the closest prior art or the most promising starting point after consideration of all possible and reasonable approaches, and whether the approach of the examiners' report is to be preferred, is not relevant in this respect.

4. For the above reasons, the appeal against the decision to give the appellant's answers to Paper C the mark of 46 is to be allowed. An assessment of the appellant's answers regarding claim 2 in terms of how many marks they deserve involves a review of the marking on the merits and thus value judgments which, according to the established jurisprudence (following D 1/92, OJ EPO 1993, 357), fall outside the competence of the Appeal Board. Therefore, the Appeal Board has decided to remit the case to the Examination Board with the order to instruct the competent examination committee to undertake a new marking of the appellant's Paper C of the European qualifying examination 2017. In view of the outcome of the present appeal, the appeal fee is to be reimbursed, as that is equitable in the circumstances (Article 24(4), third sentence, REE).

Order

For these reasons it is decided that:

1. The decision under appeal is set aside.
2. The case is remitted to the Examination Board with the order to instruct the competent examination committee to re-mark the appellant's Paper C of the European qualifying examination 2017 with respect to claim 2.
3. Reimbursement of the appeal fee is ordered.

The Registrar:

The Chairman:

T. Buschek

I. Beckedorf