



**Beschwerdekammer in Disziplinarangelegenheiten**

**Disciplinary Board of Appeal**

**Chambre de recours statuant en matière disciplinaire**

Boards of Appeal of the  
European Patent Office  
Richard-Reitzner-Allee 8  
85540 Haar  
GERMANY  
Tel. +49 (0)89 2399-0  
Fax +49 (0)89 2399-3014

Case Number: D 0004/21

**D E C I S I O N**  
**of the Disciplinary Board of Appeal**  
**of 24 January 2022**

**Appellant:** N.N.

**Decision under appeal:** Decision of the Examination Board dated 31 March 2021 concerning the pre-examination of the European Qualifying Examination 2021.

**Composition of the Board:**

**Chairman:** W. Sekretaruk

**Members:** C. Brandt

S. Colombo

## **Summary of Facts and Submissions**

- I. The appeal lies from the decision of the Examination Board of 31 March 2021 awarding the appellant the grade "FAIL" in the pre-examination for the European qualifying examination 2021 (hereinafter "pre-examination 2021"), his answer paper having been awarded 69 marks. 70 marks are necessary for awarding a "PASS" grade (Rule 6(2) (a) IPREE).
- II. By letter dated 29 April 2021, received on 7 May 2021, the appellant filed a notice of appeal including a statement of grounds of appeal. The appeal fee was also validly paid.
- III. By letter of 27 May 2021, the Examination Secretariat remitted the appeal to the Disciplinary Board of Appeal notifying that the Examination Board had decided not to rectify its decision.
- IV. The appellant argues that the answer "FALSE" in the Examiners' Report (hereinafter "report") regarding statement 12.4 is not correct.
- V. According to the report the question "**Claim I-8 is unclear due to the use of the term low**" had to be answered "FALSE" instead of "True" as the appellant did. Consequently, no marks were awarded for this question.

(a) **Claim I-8** reads as follows:

"A process for manufacturing a photochromic lens from the glass composition according to any one of claims I-1 to I-7, which comprises the following steps:

- (i) mixing components A and M together in a first vessel to obtain a first mixture;
- (ii) heating silicon dioxide in a second vessel to an high temperature;**
- (iii) adding the first mixture from step (i) to the second vessel from step (ii) to form a second mixture;
- (iv) adding component X to the second mixture;
- (v) forming a photochromic lens; and afterwards
- (vi) allowing the photochromic lens to cool to a low temperature."**

(Emphasis made by the Disciplinary Board of Appeal).

(b) [09] of the description reads as follows:

"Component M reduces the water-solubility and improves the stability of the glass composition, but only if it is present in certain amounts, otherwise component M has detrimental effects. The content of component M must be about 5% to about 10% by weight of the glass composition. If the content of component M is less than 5% by weight of the glass composition, the glass composition is not stable enough for use. If the content is greater than 10% by weight of the glass composition, the glass composition solidifies at **high** temperatures which makes it unusable."

(Emphasis made by the Disciplinary Board of Appeal).

(c) The reasoning in the **report** is as follows:

"The term "low" in feature (vi) in claim I-8 is clearly distinguished from the term "high" in feature (ii) of claim I-8. Furthermore, the **description of the application defines the term "high" in paragraph [009]**. Accordingly, in the context of the whole disclosure of the application, the term "low" is considered to be clear.

In any case, if a relative term is not the only feature to distinguish the subject-matter of a claim from the prior art, the use of the relative term may not be objected to under Article 84 EPC. The word "low" is not the only feature to distinguish the claim from the prior art, as none of the prior art discloses the claimed process. Although broad, the term is **not necessarily unclear** [GL 2019 F-IV 4.6.1]."

(Emphasis made by the Disciplinary Board of Appeal).

- VI. The appellant submits that the correct answer to Question 12.4 should be "TRUE", at least both "TRUE" and "FALSE" should be accepted.

He essentially argues that "not necessarily unclear" was not an unambiguous clear or unambiguous unclear, which is required for a pre-examination statement (see e.g. D 3/19). The statement that "if a relative term is not the only feature to distinguish the subject-matter of a claim from the prior art, the use of the relative term may not be objected to under Article 84 EPC" seemed to be erroneous, because the actual text of the GL 2019 F-IV 4.6.1 only states that if it is the only distinguishing feature, then it must be objected to under Article 84 EPC. In particular, F-IV 4.6.1 strongly suggested that if it is not the only distinguishing feature, it is still required that "their meaning must be clear in the context of the whole disclosure of the application or patent", so it was not true that it categorically 'may not be objected to', and as a consequence the TRUE answer was the most adequate for question 12.4. The appellant also pointed to the case law of the Boards of Appeal in the Case Law Book, II.A.3.1 and II.A.6.3.5, according to which "The clarity stipulation under Art. 84 EPC 1973 concerned only the claims, and therefore ... required that they

be clear in themselves, without there being any need for the skilled person to refer to the description."

VII. The President of the Council of the EPO and the President of the European Patent Office were given the opportunity to comment pursuant to Article 12 of the Regulation on discipline for professional representatives (RDR, Supplement 1/2021 to OJ EPO, 140), in conjunction with Article 24(4) of the Regulation on the European qualifying examination for professional representatives (REE, Supplement 2/2019 to OJ EPO, 2). No written observations were received.

VIII. The appellant requested:

The decision under appeal to be set aside.

The neutralization of Question 12.4, being considered both TRUE and FALSE as right answers.

As the appellant's answers to statements 12.1, 12.2 and 12.3 were correct and taking into account the correction with respect to statement 12.4 the appellant shall be given a total of 5 marks for question 12. The total marks awarded for the pre-examination thus shall rise from 69 to 71. Therefore, the appellant's paper must be awarded the grade "pass" pursuant to Rule 6(2)(a) of the Implementing provisions to the Regulation on the European qualifying examination.

The full reimbursement of the appeal fee paid.

Accelerated proceedings and in case Examination Board and Disciplinary Board of Appeal intended to refuse the request, oral proceedings were also requested.

## **Reasons for the Decision**

*Request that the contested decision be set aside*

1. In accordance with Article 24(1) and (4) REE and the Disciplinary Board's of Appeal consistent case law (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 Disciplinary Board of Appeal to reconsider the entire examination procedure on the merits. This is because the Examination Committee and the Examination Board have some latitude in their evaluation which is subject to only limited judicial review by the appeal board. 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 reopening the entire marking procedure. An example of an obvious mistake would be a question whose wording was ambiguous or incomprehensible (D 13/02). That would be clear straight away, without any reference to marks awarded, from the meaning that common sense would ascribe to the wording of the question concerned.

This established case law on the limitation of judicial review in relation to the European qualifying examination within the meaning of Article 1(1) REE applies *mutatis mutandis* to the pre-examination, just as the provisions of the REE apply *mutatis mutandis* to the pre-examination pursuant to Article 1(7) REE.

However, insofar as the award of points for the pre-examination paper is based on a pre-determined solution scheme (e.g. a multiple-choice test), the pre-examination leaves no room for discretionary marking. In the pre-examination candidates are expected to respond to clearly defined statements in a multiple-choice mode, to which they can only answer "True" or "False" by ticking a box without having the possibility to add any reasons or explanatory notes. The questions to be answered and the statements to be evaluated in a multiple-choice test such as the pre-examination should therefore be formulated clearly and unambiguously (see also decisions D 5/16 and D 6/16). Therefore, when setting an examination question for the pre-examination, it must be ensured that only one answer can be given to the respective statement when taking an informed and objective view or interpretation of the wording of the facts and the respective statements in the question (D 15/16, point 2.3 of the Reasons). It is thus crucial to formulate the statements in such a way that clearly only one answer, i.e. either "True" **or** "False", is possible and "correct" under the given circumstances (see also decisions D 5/16 and D 6/16). Contradictory, misleading or ambiguously formulated facts and/or statements can have the consequence that candidates judge them differently from the solution scheme of the Examination Board without having the possibility to present a different opinion which is not wrong but justifiable.

In a pre-examination an unclear and confusing examination question constitutes a serious and obvious mistake (D 3/19, point 2.3 of the reasons with reference to D 13/02, point 4).

2. According to the **report** the question "Claim I-8 is unclear due to the use of the term low" had to be answered "FALSE". However, the Board holds that on the basis of this report the question "Claim I-8 is unclear due to the use of the term low" cannot clearly and unambiguously be answered "FALSE".
3. Apart from the reasoning in the report itself the appellant correctly pointed to the **case law** of the Boards of Appeal in the Case Law Book, II.A.3.1 and II.A.6.3.5, according to which "The clarity stipulation under Article 84 EPC 1973 concerned only the claims, and therefore ... required that they be clear in themselves, without there being any need for the skilled person to refer to the description." With regard to this case law there is a strong indication that the appellant's answer "TRUE" to question 12.4 may a priori not be evaluated as incorrect taking into account the examination questions as a whole, hence, a categorically "FALSE"-answer appears not to be justified.
4. The reasoning provided in the **report** does not justify the "FALSE"-answer either, since it is not comprehensible that "feature (vi) in claim I-8 is clearly distinguished from the term "high" in feature (ii) of claim I-8". There is no definition of "high" neither in feature (ii) of claim I-8 nor in [009] of the description, so that it is not possible to derive any definite value or any definition for a "low temperature" either. Therefore, the statement in the report that "feature (vi) in claim I-8 is clearly distinguished from the term "high" in feature (ii) of claim I-8" is unsubstantiated, because it is left completely open to what extent and the terms "high" and "low" should be regarded as "clearly distinguished"



from each other and which technical conclusion should be drawn from such an indication. The statement in the report that in the context of the whole disclosure of the application, the term "low" is to be considered as clear is in no way supported by the claim nor by the description.

5. Furthermore, as pointed out in the statement of grounds of appeal, the argumentation in the report "Although broad, the term is **not necessarily unclear** [GL 2019 F-IV 4.6.1]" explicitly concedes that the statement 12.4 cannot unambiguously be answered as FALSE or as TRUE. "Not necessarily unclear" does not allow an unambiguous clear or unambiguous unclear, which is required for a pre-examination statement (see D 3/19, point 2.3 of the reasons).
6. The Board also agrees with the appellant that the statement in the report, referring to GL 2019 F-IV 4.6.1, "if a relative term is not the only feature to distinguish the subject-matter of a claim from the prior art", does not allow the conclusion that "the use of the relative term may not be objected to under Article 84 EPC". Rather, the actual text of the GL 2019 F-IV 4.6.1 only states that if it is the only distinguishing feature, then it must be objected to under Article 84 EPC. In particular, F-IV 4.6.1 strongly suggests that if it is not the only distinguishing feature, it is still required that "their meaning must be clear in the context of the whole disclosure of the application or patent". Hence, it is not tenable that the term "low" categorically "may not be objected to" as stated in the report. In consequence also for this reason the "FALSE"-answer cannot clearly be considered to be the only correct answer.

*Request that the contested decision be corrected*

7. The appellant requests that he be awarded a "PASS" grade for the pre-examination for the European qualifying examination 2021.
- 7.1 Following decisions D 2/14 (point 5 ff. of the Reasons), D 3/14 (point 12 ff. of the Reasons), D 4/14 (point 11 ff. of the Reasons), D 5/14 (point 6 ff. of the Reasons) and D 6/14 (point 9 ff. of the Reasons) and D 3/19 (point 3 of the Reasons) and the respective reasoning in these decisions, the Board in the present appeal case considers that special reasons within the meaning of Article 12 of the Additional Rules of Procedure of the Disciplinary Board of Appeal (Supplement to OJ EPO 1/2021, 67) are given for not remitting the case to the Examination Board for a new decision. These reasons allow the Disciplinary Board of Appeal rather than the Examination Board or the competent Examination Committee to scrutinise the marks given for statement 12.4 of the appellant's examination paper and decide whether he is to be awarded a "PASS" or a "FAIL" grade on the basis of the marking. 8.
- 7.2 In the present case the appellant's answers to statements 12.1, 12.2 and 12.3 are correct. In accordance with the marking scheme for the pre-examination he was thus awarded 3 marks. Taking into account the correction with respect to statement 12.4 the appellant would be given a total of 5 marks for question 12 and the total marks awarded for the pre-examination thus would rise from 69 to 71. Therefore, the grade "PASS" is to be awarded for the appellant's paper pursuant to Rule 6(2)a) IPREE. In view of the above, the appellant's "main request" is allowable.

8. The request for reimbursement of the appeal fee in full is granted (Article 24(4) REE).
9. In view of the Board's decision as outlined above (requested) oral proceedings were not necessary.

## Order

### **For these reasons it is decided that:**

1. The decision under appeal is set aside.
2. The appellant's answer paper for the pre-examination for the European qualifying examination 2021 is awarded 71 marks and therefore, pursuant to Rule 6(2)a) IPREE, the grade "PASS".
3. The appeal fee is reimbursed.

The Registrar:

The Chairman:



N. Michaleczek

W. Sekretaruk

Decision electronically authenticated