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Disciplinary Board of Appeal

Chambre de recours statuant en matière disciplinaire

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Case Number: D 0022/21

D E C I S I O N
of the Disciplinary Board of Appeal
of 17 February 2022

Appellant: N.N.

Decision under appeal: **Decision of the Examination Board dated 21 June 2021 concerning the Paper B part of the European Qualifying Examination 2021**

Composition of the Board:

Chairman: W. Sekretaruk
Members: T. Bokor
A. Hooiveld

Summary of Facts and Submissions

I. The appeal is against the decision of the Examination Board posted on 21 June 2021 to award the appellant's answer paper the grade FAIL to his Paper B part of the examination of the European qualifying examination 2021 (hereinafter "Paper B 2021") in accordance with Rule 6(3)(b) of the Implementing provisions to the Regulation on the European qualifying examination (IPREE, OJ EPO 2019, Supplementary publication 2, 18) because his answer paper had been awarded 37 marks.

II. By letter dated 16 July 2021, received on 20 July 2021 in the EPO, the appellant filed a notice of appeal including a statement setting out the grounds for appeal. The appeal fee was paid on 19 July 2021.

III. The appellant contested the marking of his paper for the claims and arguments, to the extent that the marking results were determined by exaggerated deductions for the “housefly eggs” amendment (in more detail below).

IV. The Examination Secretariat remitted the appeal to the Disciplinary Board of Appeal on 10 August 2021, stating that the Examination Board had decided not to rectify its decision.

V. The President of the Council of the epi and the President of the European Patent Office (EPO) were given the opportunity to comment pursuant to Article 12 of the Regulation on discipline for professional representatives (RDR, OJ EPO 2022, Supplementary publication 1, 147), in conjunction with Article 24(4) of the Regulation on the European qualifying

examination for professional representatives (REE, OJ EPO 2019, Supplementary publication 2, 2). No comments were received.

VI. In his appeal the appellant argued in essence that the marking of the "housefly eggs" amendment was unfair for the following reasons.

The "housefly eggs" amendment in the claims was accepted to be a wrong decision by the candidate. However, punishing this error by multiple deductions – for claim 1, claim 5, and also in the corresponding "amendment arguments" part of the Paper B was unfair. The marking was unfair because the deduction was excessive, and also because correct solution elements by the candidate remained unrewarded. In this manner the marking could not reflect the candidate's genuine ability to represent clients before the EPO, being one of the purposes of the Paper B (Rule 24(1) IPREE). The marking was also not suitable to measure the knowledge of the candidate in the areas stipulated in Article 13(1) REE. Thus the Examination Board made a serious and obvious mistake. Unfair marking had been previously the subject of allowable appeals that had been decided by the Disciplinary Board of Appeal under Article 24(1) REE.

VII. The appellant requested that the decision under appeal be set aside and that his answer paper be awarded a PASS or at least a COMPENSABLE FAIL grade, as main and 1st auxiliary requests. The re-evaluation and re-marking by the Examination Board was requested as a further auxiliary request. He also requested the reimbursement of the appeal fee for any of these outcomes.

VIII. For the details of the examination paper in dispute, reference is made to the published examination paper and the corresponding Examiner's Report, available on the website of the European Patent Office at https://documents.epo.org/projects/babylon/eponot.nsf/0/3003815DE4A96079C125868E00487577/$File/B_2021_en.pdf and https://documents.epo.org/projects/babylon/eponot.nsf/0/7043D0BB750F0825C12586F8002C8336/$FILE/Compendium_ExRep_2021_B_EN.pdf at the time of writing.

Reasons for the Decision

1. The appeal is admissible.

2. The appellant requested that the contested decision be set aside. He alleged obvious and serious errors in the assessment of his answer paper, alleging unfair marking.

3. In accordance with Article 24(1) REE and the consistent case law of the Disciplinary Board of Appeal (DBA), which followed decision 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 DBA to reconsider the entire examination procedure on the merits. This is because the Examination Committees and the Examination Board have some latitude in their evaluation which is subject to only limited judicial review by the DBA. Only if the appellant can show that the contested decision is based on serious and obvious mistakes can the DBA take this into account. The alleged mistake must be so obvious

that it can be established without reopening the entire marking procedure. This is for instance the case if an examiner is found to have based his evaluation on a technically or legally incorrect premise upon which the contested decision rests (D 2/14). Another example of an obvious mistake would be a question whose wording is ambiguous or incomprehensible (D 13/02). All other claims to the effect that the papers have been marked incorrectly are not the responsibility of the DBA. Value judgments are not, in principle, subject to judicial review (see e.g. D 1/92, supra, points 3 to 5 of the Reasons).

4. On the other hand, in exceptional cases the DBA recognised that unfair marking may constitute an obvious and serious mistake. Decisions D 0016/17 and D 0013/17 made it clear that double penalisation (Doppelbestrafung), namely where a false response may have an effect on other parts of the examination paper and thereby may lead to a further loss of marks for the same error, cannot be considered to fulfil the requirements for a fair marking as developed in the case law (point 3.7.1 of the Reasons in both decisions, concerning the marking of Paper A). These decisions also held that excessive, i.e. unreasonably high deductions for certain errors may also be considered to constitute unfair marking (Reasons 3.4, last paragraph in both decisions, in the context of potential deductions that could surpass the maximum possible marks). These principles were further developed by decision D 0011/19, which held that separate deductions for erroneous claim amendments and additionally for the corresponding arguments by a candidate in support of such erroneous amendments do not necessarily mean an unfair double penalty. Under the circumstances such additional deductions may well be justified, given that

the expected arguments give the candidate an opportunity to review its own assessment concerning the admissibility of an amendment, for example for the purposes of Article 123(2) EPC (D 0011/19, points 7.2.1 of the Reasons, in the context of Paper B).

5. In the Paper B 2021, candidates were expected to prepare a claim set comprising three independent claims, namely a device claim directed at a waste composting container, a method claim directed at a method of producing a fertilizer from composted waste with the help of a composting container, and a further method claim in the form of a computer-implemented calculation method for use in a composting process. In all claims, earthworms were an essential feature. The original claims filed (Rule 24(2) IPREE) only mentioned worms, but the originally filed description stated that the terms worms and earthworms were used interchangeably, meaning earthworms. The cited state of the art made reference to waste composting with housefly eggs, among other enhancing additives. The client's letter (Rule 24(2) IPREE) expressed the wish of the client to include housefly eggs (as an alternative to worms or earthworms) in the independent device claim and the independent method claim directed at the composting method. The client suggested to replace the term worms/earthworms with "earthworms (8) and/or housefly eggs (8a)".

6. According to the Examiner's Report, accepting these suggested amendments of the client – in the following the "housefly eggs" amendment - was an error. If a candidate kept these amendments, various deductions resulted. The potential deductions caused by the amendment could affect the marks for the claims and the amendment arguments as well (points 3 and 5.2 of the

Examiner's report). All claims, except Claim 1 could lose all marks, and all marks for amendment arguments could be also be lost. In detail:
4 of total 14 marks in independent (container) claim 1,
9 of 9 marks in independent (fertilizer production method) claim 5
Up to 5 of 5 marks in independent (computer-implemented optimizing method) claim 6 (concerning the uncertainty of this deduction, see the explanation below)
2 of 2 marks in the dependent claims.
As for the amendment arguments (total 17 marks):
10 of 10 marks for the arguments in respect of claim 1,
3 of 3 marks for the arguments in respect of claim 5,
2 of 2 marks for the arguments in respect of claim 6,
2 of 2 marks for the arguments in respect of dependent claims.

The Board notes that the Examiner's Report gives no explicit instructions how to treat a possible "housefly eggs" amendment in Claim 6. The report apparently expected amendments which unnecessarily limited the claim, the "housefly eggs" amendment was not foreseen. On the other hand, the client suggested to include the housefly eggs in Claims 1 and 5, but not in Claim 6, without explaining if this was a conscious choice. Thus the paper also left open the possibility that this may have been an oversight by the client which had to be corrected, possibly adding the "housefly eggs" to the earthworms feature in Claim 6. Thus it cannot be excluded that candidates could have been led to repeat the error in claim 6, once they made the erroneous assessment that the "housefly eggs" feature may be an admissible amendment. This is all the more so, as the "housefly eggs" amendment made in the same way as

suggested by the client for claims 1 and 5 did not appear to limit claim 6, adding only an alternative to earthworms, the latter being an apparently essential feature of the claim and as such most unlikely to be omitted when amending the claim. But even if a deduction for the housefly amendment is not specifically mentioned for Claim 6, it can be presumed that some deduction still had to be made on the basis of the general instructions given in Point 4. of the Report which stated the following:" *Where an independent claim differs from that of the expected solution and results in a claim which is regarded to be inappropriate for protecting the client´s invention, marks are deducted*". On the basis of these instructions, the deduction of 4 or 5 marks would seem logical for a "housefly eggs" addition to Claim 6.

7. On this basis, it seems that erroneously assuming the admissibility of the housefly egg amendment - but otherwise keeping the expected claim structure – could potentially mean for candidates a loss of 26 marks for (4+9+10+3) for this error alone. Assuming that a candidate took up the housefly egg also in claim 6 could increase the potential loss up to 33 marks. Even further assuming the - acceptedly less probable - case where the housefly eggs were also mentioned in dependent claims, the loss could even amount to 37 marks, looking apart from other potential deductions that could have been also caused by the insertion of the "housefly eggs" in the claims. Assuming that the error only affected claims 1 and 5, i.e. assuming the seemingly most probable consequence if the error in the client's proposal was not recognised, the potential loss was 26 marks. The Board need not decide if this total deduction is excessive in view of the totality of

the paper. It is sufficient to establish that the potential loss could be significant.

Arbitrary features of the marking scheme

8. The Board also notes that *prima facie* there seem to be no apparent reason why the "housefly eggs" amendment should count more severely in Claim 5 than in Claim 1, and *vice versa*, why it should count more severely for Claim 1 in the arguments (resulting in 9 vs. 4 marks deduction in the claims, or 10 vs. 3 marks deduction for the arguments). If this amendment had any basis, it would appear to be the same for both claims. The motivation to put it in the claims came from the client, for both claims 1 and 5. The relevant description parts providing the (presumed) support for the purposes of Article 123(2) EPC would appear to be par. 003 of the description. This passage states the following: *"Compost containers for producing fertilizer from organic refuse are known from the prior art. According to the prior art, composting of the refuse may be enhanced by adding additives like organic nitrogen sources, bacteria, fungi, housefly eggs or worms"*. Again, this paragraph appears to mention composting containers and the corresponding composting method with housefly eggs together, suggesting the unity of the invention, also recognised by the Examiner's Report (point 1.4, last sentence). The Examiner's Report, point 1.6, 2nd paragraph further points to par. 0022 of the original application as a disclosure leading the skilled reader away from the impression that housefly eggs were part of the original invention: *„Additives can be used to further accelerate composting. Such additives are known in the prior art. The additives should not cause malodour or attract unwanted animals like rats, mice or insects like house*

flies. Preferred additives are nitrogen sources such as blood meal or microorganisms such as soil bacteria". There is no error, and even less any manifestly obvious error in this argument of the Examiner's Report. However, the cited passage is a general statement at the end of the description, without any specific reference to either the claimed composting container or the composting method. No disclosure is apparent from which a candidate may have gleaned that the "housefly eggs" amendment might carry more weight for either the container or the composting method.

Double penalty is not excluded by the marking scheme

9. The Board further notes that the Examiner's Report does not call the attention of the Examiners to the problem of double penalty (unlike the Examiner's Report for Paper B 2019), and even less is there any explicit instruction to avoid it. The fact that all marks - 9 - are lost for the "housefly eggs" amendment in Claim 5, as opposed to only 4 marks in Claim 1 does not seem to lead to the conclusion that the mentioning of the "housefly eggs" deduction in Claim 5 is in fact a mere reminder of the previous deduction for this feature as specified for Claim 1. On the contrary, it suggests that both of these deductions must be made, independent from the other. The same conclusion seems to hold when comparing the potential deductions for the amendment arguments for claims 1 and 5.

Correct solution elements remain unrewarded

10. The appellant submitted that his paper contained several elements of the expected amendments that were foreseen by the Examiner's Report, and which did not attract any marks because of the total loss caused by

the “housefly eggs” penalties. The Board considers that such a result is almost an inevitable consequence of a marking scheme where deductions can be made for various reasons. Candidates cannot expect that they will be awarded the full marks for certain partial solutions under any circumstances, even if these are doubtless correct on their own. According to Rule 24 IPREE, in the Paper B part of the EQE candidates are expected to respond to all points raised in the official communication and to provide amended claims that meet the requirements of the EPC, i.e. all requirements of the EPC. Thus answering Paper B cannot be reduced to the simple exercise of collecting marks for certain solution elements that are derivable from the Examiner’s Report. It is also required that the totality of the claims and the corresponding arguments constitute a complete and in itself consistent solution.

11. Still, the Board accepts that the particularity of the marking scheme that all marks for a claim and amendment arguments may be lost by a single error may be perceived as unfair. The Board notes that the loss of all marks for certain errors, such as lacking novelty of a claim, was already a known feature of earlier EQE papers (e.g. this was the case for the Paper B 2019). On the other hand, leaving a claim not novel and adding erroneously subject-matter may not be fully comparable errors. Novelty of a claim can normally be achieved with various features, perhaps not necessarily with those that were foreseen by the Examiner’s Report. A feature adding subject-matter often cannot be compensated by other amendments, as in the present case. In this light, lacking novelty can possibly be considered as a more serious error, given that it can be easier to avoid, depending on the circumstances.

12. The perception of an unfair marking is apparently caused by the possibility of the loss of all marks for a given problem set, such as the amendments and corresponding arguments for a given claim. In the opinion of the Board, the main cause of this perceived unfairness is primarily not due to the loss of the marks themselves, but rather due to the fact that this can lead to situations where candidates performing clearly differently are awarded the same marks for their papers. For example, in the framework of the Paper B 2021 this would be the case where apart from the "housefly eggs" error, one candidate would provide correct added-matter arguments on other, admissible amendments for a claim, while the other candidate would provide no or only erroneous amendments and corresponding arguments. In the present paper, such expected amendments could have been made quite independently of the "housefly eggs" amendment, and also independently from the expected amendments in the other claim, e.g. removal of the lower compartment in Claim 1 and the deletion of the "optional" feature of step b. in Claim 5. Yet, in this situation both candidates would be equally penalised, both of them receiving 0 marks. It may be argued that this is the inevitable consequence of another feature of the marking scheme, namely that for certain problem sets the marks could not be negative, irrespective of the total of the potential deductions for the various erroneous solution elements (see e.g. "*The overall number of marks per claim could not be negative*", Examiner's Report, point 1.8). However, in the opinion of the Board, even in this marking scheme some proportionality of the penalties, i.e. the deductions can be expected. That proportionality of the awarded marks is a recognised principle of the marking scheme

is also apparent from the Examiner's Report, point 1.8, 2nd paragraph: "*…the number of available marks corresponds to the difficulties of each challenge or the complexity of the expected amendment. In other words, more difficult challenges were awarded more marks than easier challenges.*". This would seem to dictate some degree of proportionality also in the determination of the applicable deductions. The Board has doubts that the need for proportionality is properly observed in the present marking scheme, in view of the significant potential loss for the "housefly eggs" amendment, combined with the fact that the corresponding deductions could completely offset correct solution elements.

13. In view of these details of the marking the Board cannot come to the conclusion that the marking of the "housefly eggs" amendment can be considered as fair in all respects. On the other hand, the Board also cannot establish beyond any doubt that the low number of marks awarded to the appellant indeed resulted from the unfair marking of the "housefly eggs" amendment, as argued by the appellant. As it is well known and also apparent from point 3 of the Examiner's Report for the Paper B 2021, deductions could be attributed to a number of factors, and not only for lack of support for the purposes of Article 123(2) EPC. Thus retroactively identifying the deductions effected in the appellant's answer paper specifically for the "housefly eggs" amendment would only be possible, if at all, if the Board scrutinized the totality of the Paper B (including the Examiner's Report) and the answer paper of the appellant, and effectively performed a complete marking of his answer paper. As explained above in point 3, such an exercise is beyond the competence of the DBA.

14. The Board can establish directly from the appealed decision that the appellant obtained 9/8 marks for his independent claims by the respective markers, 2/2 marks for the dependent claims and 1/0 marks for his amendments arguments. A cursory review of his claims confirm that the argued correct solution elements are present in his answer paper. In view of these details the Board finds it plausible that the total marks awarded were decisively influenced by the marking of the "housefly eggs" amendment, without directly accepting the argued amount of the marks possibly lost due to the "housefly eggs" amendment. Given that a possible unfair marking could not be excluded by Board, the Board finds, giving the appellant the benefit of the doubt, that the appeal is well founded and allowable so that the contested decision is to be set aside according to Article 24(4), second sentence, REE. The Board holds that a new evaluation of the appellant's answer paper is justified.

Request that the contested decision be altered to a PASS grade

15. The appellant further requests that his answer paper be awarded a PASS or at least a COMPENSABLE FAIL grade. The Board follows the case law of the DBA (see e.g. decisions D 0024/17, point 15 of the Reasons, D 0013/17 and D 0016/17, point 4 of the Reasons) and considers that the Board itself cannot perform the re-marking requested. This was also recognised by the appellant. An assessment of the appellant's answer paper for determining the marks to be awarded would involve a review of the marking on the merits and thus would require value judgments which, according to the established jurisprudence (following D 1/92, OJ EPO 1993, 357), falls outside the competence of the Board,

as already stated above in points 3 and 13. This is not changed by the remaining very short time until the next Paper B examination. Therefore, the Board decides 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 B of the European qualifying examination 2021 under its powers pursuant to Article 6(5), last sentence, REE and to award a grade to the appellant on the basis of the re-marking. However, this does not mean that the re-marking should necessarily achieve any given number of additional marks.

16. The re-evaluation should be based on a marking scheme which is fairly proportional in the sense that it leaves some room for the discretional awarding of marks where it appears equitable for recognising expected solutions, in particular where such expected solutions cannot be awarded the full marks for some reason. The marking scheme should either avoid multiple deductions for the same error or should only apply it in properly justified circumstances. Multiple deduction of marks does not appear justified where it cannot be reasonably expected that the candidate recognises the error when repeating it, for example where the same amendment is introduced in the claims, or where the same arguments are provided for the same amendment made in different claims. Alternatively, the marking scheme should provide the explanation why multiple deductions of marks for the same error may be justified in view of the facts of the paper. The Board does not exclude that also the same amendment may be given a different weight, depending on the totality of the paper, in particular such details as the type of the claims amended, the effect of an amendment on other features and the disclosure serving as the possible support for

the amendment in question. The Board again refers to decision D 0009/11, point 7.2.1 of the Reasons and emphasizes that separate deductions for claims and corresponding arguments is not necessarily a double penalty and as such not necessarily unfair. The marking is only unfair to the extent that equal errors are penalised unequally, or repeated errors are penalised repeatedly. Depending on the circumstances of the error, it may possibly result in a further – and possibly different – deduction of marks.

Reimbursement of the appeal fee

17. The appellant requested reimbursement of the appeal fee. If the Board of Appeal allows the appeal, it orders reimbursement in full or in part of the appeal fee if this is equitable in the circumstances of the case (Article 24(4), third sentence, REE). Given that the present appeal is successful, a full reimbursement of the appeal fee is equitable. Therefore, the appeal fee is to be reimbursed in full.

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 perform a re-marking of the appellant's answer paper for the Paper B of the European qualifying examination 2021 and to award a grade to the answer paper under Rule 6(3) IPREE accordingly.

3. The appeal fee is to be reimbursed in full.

The Registrar: The Chairman:

N. Michaleczek W. Sekretaruk

Decision electronically authenticated