



**Case Number:** D 0010/11

**D E C I S I O N**  
**of the Disciplinary Board of Appeal**  
**of 23 April 2012**

**Appellant:** N.N.

**Decision under appeal:** **Decision of the Examination Board for the  
European Qualifying Examination dated  
12 August 2011**

**Composition of the Board:**

**Chairman:** R. Menapace  
**Members:** T. Bokor  
H.G. Hallybone

## Summary of Facts and Submissions

- I. The appellant appealed, by a notice of appeal both dated and received by fax at the EPO on 2 September 2011, against the decision, posted by registered letter dated 12 August 2011, of the Examination Board that having been awarded 67 marks for his performance in paper B and 38 marks ("FAIL") for his performance in paper C in the European Qualifying Examination ("EQE") 2011, the requirements of Article 14(1) REE have not been fulfilled, so that the Examination Board could not declare that he had passed the EQE 2011. The appeal fee was also paid on 2 September 2011.
- II. The Examination Board decided in its meeting of 14 October 2011 not to rectify its decision, and transmitted it to the Disciplinary Board of Appeal with letter dated 17 October 2011.
- III. The appellant requests that the marking of his paper C EQE 2011 be reconsidered and as main, first and second auxiliary requests, that he be awarded 13, or at least 10, or at least 7 marks. The appellant further requested "that the Examination Board provides guidance to the candidates on when to make and to what extend [*sic*] assumption can be made without violating Rule 22(3) REE [*sic*]."
- IV. Paper C expects from candidates that they prepare a notice of opposition on the basis of a letter from a client to the professional representative. The letter was formulated as follows (omitting parts unrelated to the present appeal):

" Dear ...

Please file an opposition against European Patent No...(Annex 1) in the name of our company. We have obtained Annexes 2 to 6, which may be useful.

...

We noted that the last paragraph of the description in Annex 5 was not included in its priority document. In addition, the abstract in Annex 5 mentions that "the tubes may be coated externally with an aluminium zinc alloy in order to protect them against corrosion" and that "using an aluminium zinc alloy providing 1 g/m<sup>2</sup> to 4 g/m<sup>2</sup>, preferably 2 g/m<sup>2</sup>, of zinc has given the best results". Are these facts of use?

...

Yours sincerely etc."

- V. Attached to the letter were the opposed patent (as Annex 1) and five potential prior art documents, including Annex 5, a (fictional) PCT application designating also EP, and having a priority and filing date respectively preceding those of the opposed patent, but its publication date being later than the filing date of the opposed patent. The complete paper and the Examiner's Report is available on the website of the European Patent Office.
- VI. The appellant argued in essence, that in respect of Annex 5 there had been a violation of Rule 22(3) of the Implementing provisions to the Regulations on the European qualifying examination for professional representatives ("**IPREE**" - the Board takes it that the reference to Rule 22(3) REE is apparently erroneous). Provisions and statements of the Examination Board in former Examiners' Reports emphasise that (i) candidates

should accept the facts given in the examination paper and limit themselves to those facts, (ii) not all of the annexes may be usable. No facts were provided regarding entry of the PCT-application Annex 5 into the European phase, in particular the opponent's letter to the professional representative is silent on that matter. Nevertheless according to the Examiner's Report 2011 it was expected that Annex 5 be used as an Art. 54(3) EPC document with the assumption that the required conditions [i.e. entry into the European phase] had been met. However, making such an assumption was contrary to Rule 22(3) IPREE. Instead, the Examination Board should have expected that Annex 5 would not be cited against the opposed patent. The appellant, by correctly choosing not to make the assumption in question, did not have the possibility to achieve those marks which could have been awarded for the solution foreseen as the correct one in the Examiner's Report, but being contrary to Rule 22(3) IPREE, as explained above.

VII. In letters from the Board dated 26 October 2011, the President of the EPO and the President of the Institute of Professional Representatives were invited, pursuant to Articles 24(4) REE and 12 RDR, to file observations on the case within a period of two months if they wished to do so. Neither president replied.

### **Reasons for the decision**

Unless indicated otherwise, REE refers to the version in force from 1 January 2009 (Supplement to OJ EPO 12/2011, 2), and

IPREE refers to the version in force from 1. April 2010  
(Supplement to OJ EPO 12/2011, 20).

1. The appeal is admissible.
2. The appellant's main, first and second auxiliary requests each imply that the decision under appeal be set aside and that he be awarded the requested numbers of **additional** [emphasis added] marks for his paper C. The further request, that the Examination Board provides guidance to the candidates is *prima facie* not addressed to the Disciplinary Board of Appeal. If it were so, it would not be admissible, for the reason that it is not directed against the decision under appeal. Put differently, the Disciplinary Board of Appeal does not have any power to go beyond the examination of and the decision on the correctness of the decision under appeal, even though its jurisprudence including the decision on the present appeal certainly may provide guidance in respect of the EQE, both to candidates and the Examination Board.
3. Rule 22(3) IPREE states: "Candidates are to accept the facts given in the paper and to limit themselves to these facts. Whether and to what extent these facts are used is the responsibility of the candidate". In the client's letter it is explicitly stated: "Annexes 2 to 6 ... may be useful." (see point IV above).
4. Based on his arguments, the appellant appears to contend that Rule 22(3) IPREE implies that candidates must be strictly limited to those facts that are given to them, in the sense that these are to be accepted blindly, on the presumption that the examination paper

contains all and every fact that may be necessary, and no further facts whatsoever can be assumed beyond those explicitly (or positively) given.

5. It is noted that the provisions cited by the appellant do not prohibit the candidates to make *any* assumptions at all, but at most discourages *unfounded* assumptions contradicting with the facts of the examination paper. While the inference may seem tempting, it is a mistake to equate the instructions "candidates shall accept the facts and limit themselves to those facts" with the statement that "candidates are not supposed to make assumptions". Rather, this statement of Rule 22(3) IPREE must be read in the context of the third sentence of this rule, namely that candidates are not supposed to use any factual information which may be available to them from some other source than the examination paper. This is not altered by Rule 25(3) IPREE, which reaffirms that the answer paper should be based on the factual information provided in the client's letter, i.e. the examination paper (Rule 25(2) IPREE, first sentence). Furthermore, while Rule 25(5) IPREE warns candidates that "omission of good grounds ... will lead to a loss of marks", it explicitly instructs candidates to "set out on a separate sheet the reasons why they did or did not take up the client's suggestions", i.e. why they did or did not rely on a possible argument or fact offered by the client.
  
6. Thus it would have been open to the appellant to rely on any one of the two possible assumptions when drafting the notice of opposition, but nevertheless exploring the consequences of taking the other assumption in the explanatory note pursuant to Rule

25(5) IPREE, third sentence, in order to take up all possible lines of attack. From this it is clear that candidates are expected to make decisions during the examination, and during Part C such decisions evidently concern the choice of the best prior art. It is conceivable that such decisions are based on a number of assumptions - most of them being self-evident and so commonplace that they are not even perceived as assumptions -, which are all justified as long as these assumptions do not contradict the facts of the paper.

7. The Board notes that not making any assumptions at all in fact borders on the impossible, in any given real or imaginary situation. This also seems to apply to the situation simulated by the examination paper. There are practically always a multitude of factual details assumed which unambiguously and inevitably follow from the explicitly given or more generally described facts (e.g. that a prior art document was indeed published on the given publication date, or that physical parameters and technical variables used in the patent are standard in the field and need no particular definition etc.).
8. It is pointed out that Rule 25(8) IPREE explicitly instructs candidates to make certain assumptions (validity of priority claims unless there is evidence to the contrary), and also foresees that some relevant facts may need to be stated without confirming evidence being readily available: "If, however, any facts presented need to be confirmed ... candidates are expected to state that such confirmation will be filed later", see Rule 25(8) IPREE, second sentence. In this manner candidates are not only permitted, but indeed expected to make assumptions.

9. It may be added that even the appellant inevitably had to make assumptions - perhaps without realising it himself -, when he decided to disregard Annex 5. His assumption was that the opponent would have positively confirmed it if Annex 5 had entered the European phase. This assumption appears to have been based on the observation that the opponent apparently had some experience in patent matters, presumably because he was able to extract relevant information from the prosecution history of the patents. As the appellant put it, the opponent was "familiar with online file inspection" (see page 2, line 3 of the grounds of appeal), and the Board notes that this is yet another assumption, as the client's letter is completely silent about the source of the information given and the documents offered. That aside, the assumption that a knowledgeable opponent would have sent a useless prior art document appears to be contradictory in itself, or at least it appears unlikely. This illustrates well that this was indeed an assumption only, and not an obvious and necessary conclusion from the facts of the paper C.
10. In light of the purpose of EQE, the presentation of the facts in the examination paper C does not appear to be unrealistic in the sense that the client's letter (Rule 25(2) IPREE, first sentence) may realistically and intentionally not provide all the information necessary for the preparation of a "watertight" or "foolproof" notice of opposition (Rule 25(1) IPREE). It is also not unrealistic to expect from an EQE candidate to pinpoint the legal preconditions for certain types of potential prior art documents. After all the paper is conform



with the "fit-to-practice" requirement. The omission of a positive statement or some other conclusive fact about Annex 5 entering the European phase was not an error. That this "omission" did serve a purpose is also confirmed by the Examiner's Report, which proves that the expected identification of the legal preconditions for relying on Annex 5 was indeed a part of the examination paper C. From this aspect, neither the "inevitable assumption" required from the candidates, nor the set of facts constituting the examination paper C 2011 did contravene Rule 22(3) IPREE.

11. It also does not appear that the "preferred" assumption, i.e. that Annex 5 did enter European phase and was therefore prior art, would have been at odds with the facts presented in the examination paper, and this was also not argued by the appellant. The appellant merely stated that there was no decisive information in the examination paper itself whether Annex 5 was usable or not. In this manner the choice of the Examination Committee, as reflected in the Examiner's Report, to expect a possible solution on the basis of the "preferred assumption" is not erroneous, even less manifestly erroneous. It is certainly not less convincing than the solution chosen by the appellant, see also point 9 above.

12. Based on the totality of the facts as laid out above, the examination paper was in fact not ambiguous (in the sense of "contradictory or unintelligible", see D 13/02 of 11.11.2002, point 4 of the Reasons) but at most contained less facts than theoretically could have been possible.

13. Thus the appellant in fact does not dispute the correctness of the marking itself, but whether it could have been reasonably expected from a candidate to realise that the missing information is not a defect, but an integral part of the examination paper and serving a purpose. However, this is a question of the difficulty of the examination, i.e. essentially a value judgement which is not subject to 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).
  
14. Apart from the fact that the marking does not appear to contain obvious mistakes, the Board also cannot see on what basis the appellant could be awarded marks for a solution which he did not present. It is of course possible that the appellant would have achieved more marks if he had chosen to depart from the assumption that Annex 5 is usable as prior art, however it can not be known if he indeed would have used it or would have used it correctly. Nevertheless, it remains that no marks can be awarded for a solution that was not presented in the answer paper.
  
15. On the basis of the above, 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

R. Menapace