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

**Case Number:** D 0003/14

# D E C I S I O N
# of the Disciplinary Board of Appeal
# of 1 September 2014

**Appellant:** N.N.

**Decision under appeal:** **Decision of 28 March 2014 of the Examination Board regarding the pre-examination for the European qualifying examination 2014**

**Composition of the Board:**

**Chairman:** G. Weiss
**Members:** L. Bühler
N. M. Lenz

## Summary of Facts and Submissions

I. The appeal lies from the decision of the Examination Board of 28 March 2014 awarding the appellant the grade "fail" in the pre-examination for the European qualifying examination 2014 (hereinafter: pre-examination 2014), her answer paper having been awarded 68 marks.

II. By letter dated 21 April 2014, received on 23 April 2014, the appellant filed a notice of appeal including a statement of grounds of appeal. The appeal fee was paid on the same day. With letter of 15 May 2014, the Examination Board remitted the appeal to the Board without rectifying its decision.

III. The appellant essentially argues that the answer in the Examiner's Report to question 10.4 of the pre-examination 2014 is correct from a legal point of view but does not correspond to statement 10.4 which candidates had to indicate was true or false. According to the appellant, there was no indication in the stem (preamble) of the question or in statement 10.4 that it was intended to prevent embodiment X1 from being contained in the publication of the European patent application in question. Statement 10.4 merely concerned the point in time at which the description could be amended. Based on Rule 137 EPC and the standard situation in which the (extended) search report was received before the termination of the technical preparations for publication, amendments were possible before the publication of an application. Therefore, the answer that should have been given to statement 10.4 was "false" and not "true".

IV. Question 10 of the pre-examination 2014 reads as follows:

"An applicant filed in January 2013 a European patent application EP-T relating to invention X. The application EP-T includes several embodiments. The applicant now realises that, although most of the embodiments are sufficiently disclosed, the embodiment X1 lacks essential technical information and is therefore not sufficiently disclosed.

For each of the statements 10.1 – 10.4, indicate on the answer sheet whether the statement is true or false:

...

10.4 Before the publication of EP-T, it is not possible to amend the description of EP-T in order to delete embodiment X1."

V. The answer in the Examiner's Report is "true". The answer is reasoned as follows: "EP-T will be published as filed, with embodiment X1, Rule 68(1) EPC. Even if the applicant filed amended application documents with the EPO before the termination of the technical preparations for publication, only amended claims would be included in the publication but not an amended description, Rule 68(4) EPC."

VI. The President of the Council of the epi 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 1/2014 to OJ EPO, 123), in conjunction with Article 24(4) of the Regulation on the European qualifying examination for professional representatives (REE, Supplement 2/2014 to OJ EPO, 2). No written observations were received.

VII. The appellant requests that the contested decision be reversed and that she be awarded the mark "pass" for the pre-examination 2014.

## Reasons for the Decision

*Pending appeal*

1. The appeal lies from decisions of the Examination Board which adversely affect the appellant. A notice of appeal including the statement setting out the grounds of appeal was filed in writing with the Secretariat within one month of the date of notification of the contested decision (pursuant to Article 24(2) and (4) REE together with Articles 21(2) and 24(1) RDR and Rules 126(2), 131(2) and (4) and 134 EPC the time limit expired on 8 May 2014). The fee for appeal was also paid within said time limit. The appeal thus complies with Article 24(2) und (4) REE.

2. In its statement setting out the grounds of appeal, the appellant stated that "if interlocutory revision is not successful, I request to withdraw my appeal and to have a full refund of the appeal fee." With letter of 15 May 2014, the Examination Board remitted the appeal to the present board without rectifying its decision. With email dated 5 June 2014 the appellant nevertheless

inquired whether it was possible to continue her appeal and to request accelerated proceedings. It emerges from this statement, which was received before a possible disposal of the appeal was ordered by the appeal board, that the appellant did not wish to be bound by her previous withdrawal. In the appeal board's judgement, this statement amounts to a retraction of the withdrawal. Such a retraction is considered allowable, according to general principles of procedural law in administrative procedures, if withdrawal is to the detriment of the party and if legal certainty is not at stake. In the present case, both conditions are fulfilled.

3. Moreover, the withdrawal was not effective, since it had been made on the condition that the appeal was not allowed within two months of notification of the contested decision. Indeed, according to general principles of procedural law in administrative procedures, the withdrawal of an appeal has to be explicit and unconditional, i.e. it should not depend on any decision to be made or discretion to be exercised by the competent authority. In the present case, the condition made by the appellant for the withdrawal was not fulfilled when the withdrawal was declared but depended on a decision of the Examination Board on whether or not to rectify its decision. Therefore, there was no valid and effective withdrawal.

4. For this reason, the appeal board found the appeal to be pending.

*Request that the contested decision be set aside*

5. In accordance with Article 24(4) REE and the appeal board's 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 appeal board to reconsider the entire examination procedure on the merits. This is because the Examination Committee and the Examination Board have some latitude of evaluation that 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. This is for instance the case if an examiner is found to have based his evaluation on a technically or legally incorrect premise underlying the contested decision.

6. According to the Examiner's Report for the pre-examination 2014 on which the examiners of Examination Committee IV based their evaluation of the examination papers, statement 10.4 posed the question whether the description of a European patent application which is amended before its publication is published in amended form or as filed (see point V above). There is however no reference in statement 10.4, that had to be answered "true" or "false", to the contents of the publication. The introductory words of the statement "Before the publication of EP-T ..." clearly refer to the

publication as a relevant point in time and not to the contents of the publication. The purpose indicated by the words "... in order to delete embodiment X1" does not determine how the amendment should be made. This phrase is not grammatically linked to the publication (and even less to the publication's contents). Nor does the general context of the stem (preamble) suggest that embodiment X1 should be deleted from the text that is to be published. The appeal board thus agrees with the appellant that there is no indication in question 10 that it is intended to prevent the embodiment X1 from appearing in the publication of the patent application. Statement 10.4 should have been formulated differently in order to express this aim. Candidates could not be expected to make an assumption in this respect, since Rule 22(3) of the implementing provisions to the Regulation on the European qualifying examination for professional representatives (IPREE, Supplement 2/2014 to OJ EPO, 18) provides that candidates must limit themselves to the facts given in the examination paper. Consequently, the examiner's evaluation of the examination papers rests upon a question that cannot, upon an objective reading, be derived from statement 10.4 of the pre-examination 2014.

7. The appellant's understanding of statement 10.4 of question 10, on the basis of which she arrived at her answer, is justified from an objective point of view. The introductory words "Before the publication of EP-T ..." clearly imply a time aspect which is essential to the question underlying statement 10.4. Accordingly, the question is whether the applicant, prior to the publication of EP-T, has the possibility of amending the description by way of deleting

embodiment X1. Put in the context of statement 10.4, this question is not fallacious, but in the light of Rule 10(5) IPREE in connection with Rule 22(3) IPREE arguable, even though the possibility of amending the description hinges on the receipt of the search report and not on the publication of the application. Considering the applicable provisions (Rules 137(2), 70a(1) and (2), 70(1) and (2), 68(1) and 65 EPC), no assumption had to be made that exceeded the factual framework of question 10. As a consequence, the answer to statement 10.4 was "false" and not "true" as indicated in the Examiner's Report for the pre-examination 2014. The discrepancy between the question underlying statement 10.4 and the expected answer according to the Examiner's Report was thus to the disadvantage of the appellant.

8. As a result, the examiners of Examination Committee IV have based their evaluation of the pre-examination 2014 on an incorrect premise, since the Examiner's Report for that examination was based with respect to statement 10.4 on a different question from that inferable from said statement on an objective reading. Therefore, the contested decision is based on serious and obvious mistakes which can be established without reopening the entire marking procedure. The appeal is thus well founded and allowable. According to Article 24(4) REE, the contested decision has to be set aside and the appeal fee reimbursed.

9. Pursuant to Article 24(3) REE, the department whose decision was contested (in the present case the Examination Board) must rectify its decision if it considers the relevant requirements to be fulfilled.

This also means that the Examination Board is obliged to assess carefully whether or not these requirements are met before deciding to grant or refuse rectification and, in the latter case, referring the matter to the board of appeal (D 38/05 of 17 January 2007, point 3 of the Reasons; D 4/06 of 29. November 2006, point 3 of the Reasons). In clear and unequivocal cases, rectification is a quick and simple way of cancelling flawed decisions and spares the parties the cost, in time and money, of appeal proceedings. Rectification is thus in the public interest and in particular in the interest of the appellant (D 38/05 of 17 January 2007, point 2 of the Reasons; D 4/06 of 29. November 2006, point 2 of the Reasons). Having regard to the obvious discrepancy between the question underlying statement 10.4 and the expected answer according to the Examiner's Report, rectification (Article 24(3) REE) was warranted in the present case, especially in view of the fact that candidates who apply to sit the European qualifying examination must first pass the pre-examination (Article 11(7), last sentence, REE).

*Request that the contested decision be corrected*

10. The appellant requests that she be awarded the mark "pass" for the pre-examination 2014. This request implies that the appeal board corrects the contested decision and reviews the marking of the appellant's answer paper.

11. According to Article 24(4), second sentence, REE, the appeal board sets the contested decision aside if the appeal is admissible and well founded. As a consequence,

the case is remitted to the Examination Board with the instruction to take a new decision on the basis of a revised marking of the examination paper in question. However, Article 24(4), second sentence, REE does not confer on the appeal board the power to correct the contested decision, i.e. to review itself the marks and grade of an examination paper, in addition to any finding on infringement of the REE or of any provision relating to its application.

12. The appeal board has considered whether special reasons within the meaning of Article 12 of the Additional Rules of Procedure of the Disciplinary Board of Appeal (Supplement to OJ EPO 1/2014, 54) provide a legal basis for not remitting the case to the Examination Board for a new decision.

13. Only in a few exceptional cases has the Disciplinary Board of Appeal found special reasons within the meaning of Article 12 of the Additional Rules of Procedure of the Disciplinary Board of Appeal to exist (D 5/86, OJ EPO 1989, 210, point 9 of the Reasons: appeal against a decision imposing a disciplinary measure, 9 years of proceedings, several hearings of a witness; D 11/91, OJ EPO 1995, 721, point 7.9 of the reasons: appeal against a decision imposing a disciplinary measure, 7 years of proceedings; D 8/08 und D 9/08 of 19 December 2008, point 8 of the Reasons: appeal against a decision refusing enrolment to the European qualifying examination 2009, short period until the examination). This reticence is justified, since the Disciplinary Board of Appeal exercises powers within the competence of the authority that was responsible for the decision appealed if the case is

not referred back. Article 24(4), first sentence, REE in connection with Article 22(3) RDR and Article 111(1), second sentence, EPC confer such power on the Disciplinary Board of Appeal. However, in cases concerning appeals directed against decisions of the Examination Board concerning European qualifying examinations, the Disciplinary Board of Appeal has not made use of this power to review the contested decision on its merits. This is because, in accordance with the consistent jurisprudence of the Disciplinary Board of Appeal, the actual marking of examination performance in terms of how many marks an answer deserves is not subject to review by the appeal board, and nor are the Examination Board's criteria for determining the weighting of the expected answers to the examination questions (see D 7/05, OJ EPO 2007, 378, point 20 of the Reasons). This jurisprudence is justified because and insofar as value judgements involving discretion are essential in the marking process and subject to only limited judicial review by the appeal board. Such review is confined to clear abuses of discretion in the marking procedure.

14. The situation in the present case differs however from the circumstances underlying appeals relating to complaints about the marking of examination papers which underlie the established jurisprudence of the Disciplinary Board of Appeal.

14.1 The pre-examination comprises 20 questions, each of which has 4 separate statements which candidates have to say are "true" or "false" (multiple choice paper). Consequently, the examiners had no latitude of

evaluation when assessing the correctness of the answers in the pre-examination 2014.

14.2 The marks were also awarded according to a strict scheme which did not involve any discretion on the part of Examination Committee IV. The marking scheme is contained in the papers of the pre-examination 2014. It reads as follows:

"3. Marking

a) Marks awarded per question

- If within one question X, none or only one of the answers to the statements X.1, X.2, X.3 and X.4 is correct, then 0 marks will be awarded for this question X.
- If within one question X, two of the answers to the statements X.1, X.2, X.3 and X.4 are correct, then 1 mark will be awarded for this question X.
- If within one question X, three of the answers to the statements X.1, X.2, X.3 and X.4 are correct, then 3 marks will be awarded for this question X.
- If within one question X, all four of the answers to the statements X.1, X.2, X.3 and X.4 are correct, then 5 marks will be awarded for this question X.

b) Total number of marks awarded

The total number of marks awarded for the pre-examination is the sum of the marks achieved for each question, calculated as stated above."

14.3 Finally, Rule 6(2) IPREE determines the number of marks giving rise to the grade to be awarded for an answer

paper in the pre-examination. The award of a "pass" or "fail" grade being merely the arithmetical outcome of the marks achieved in the individual papers, the Examination Board has no discretion when deciding to award an answer paper a "pass" or "fail" grade.

15. In the present circumstances, the appeal board's finding of a clear mistake in statement 10.4 of question 10, arrived at on the basis of a limited review of the contested decision confined to clear abuses of discretion in the marking procedure, entails a correction of the marking of the appellant's examination paper. The appeal board can establish the correct marks on the basis of the appellant's answer paper without interfering with any value judgement of the competent Examination Committee or Examination Board.

16. Moreover, a "pass" grade in the pre-examination is a precondition for enrolment to the European qualifying examination (Article 11(7), last sentence, REE). Complete applications from candidates wishing to sit the main examination in 2015 must be received by the Examination Secretariat no later than 8 September 2014. The matter is therefore urgent. Remittal of the case to the Examination Board would further shorten the time available for applying.

17. In the judgement of the appeal board, the fact that the Examination Board did not rectify the flawed decision, even though the discrepancy between the question underlying statement 10.4 and the expected answer according to the Examiner's Report was comprehensively substantiated in the appellant's grounds of appeal,

must also be taken into account. The Examination Board thus burdened the appellant with appeal proceedings.

18. These circumstances constitute special reasons within the meaning of Article 12 of the Additional Rules of Procedure of the Disciplinary Board of Appeal which justify that the appeal board scrutinises the marks for question 10 of the appellant's examination paper and decides whether she is to be awarded a "pass" or "fail" grade on the basis of the revised marking.

19. The appellant’s answers to statements 10.1 to 10.3 were correct. According to the marking scheme for the pre-examination, she was thus awarded 3 marks for question 10. Taking into account the correction with respect to statement 10.4, the appellant is given 5 marks for question 10. The total marks awarded thus rise from 68 to 70. Therefore, the "pass" grade is to be awarded for the appellant's paper pursuant to Rule 6(2) IPREE.

20. In view of the above, it is not necessary to hold the oral proceedings which were requested on an auxiliary basis.

## 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 2014 is awarded 70 marks and therefore, pursuant to Rule 6(2) IPREE, the "pass" grade.

3. The appeal fee is reimbursed.

The Registrar: The Chairman:

G. Rauh G. Weiss