



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

Boards of Appeal of the
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Case Number: D 0025/17

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

Appellant: N.N.

Decision under appeal: Decision of 6 July 2017 of the Examination Board for the European qualifying examination that the appellant failed Paper 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 Paper C at the European qualifying examination 2017. For her performance in Paper C she was awarded 37 marks. On the basis of this marking, the Examination Board awarded her a "fail" for Paper C.
- II. In a letter dated 24 July 2017, received on 26 July 2017, the appellant appealed the decision to give her a mark of 37 for her answers to Paper C. 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. On 1 December 2017, the Appeal Board summoned to oral proceedings. In a communication dated 22 December 2017 it gave its preliminary opinion.
- IV. Oral proceedings on 14 February 2018 were attended by the appellant and a person appointed by the President of the European Patent Office (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 14 of the Regulation on discipline for professional representatives [OJ EPO 2017, Supplementary publication 1, 127]).
- V. The appellant argued that the marking of her answers regarding claims 2 and 5 and the general part of Paper C, which deviated from the examiners' report but were at least reasonable and competently substantiated, contravened the principle of fair marking.

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

(a) *Claim 2 of 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 reasoning 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 her attack against claim 2 of Annex 1 for lack of inventive step starting from Annex 6 as the closest prior art in combination with Annex 5, albeit deviating from the examiners' report, was at least reasonable. Annex 6 was directed to the same purpose, had the same number of features in common as Annex 5, and was an equally suitable starting point. The technical obstacle which, according to the examiner's report, disqualified Annex 6 from being the closest prior art contravened Rule 22(3) of the Implementing provisions to the Regulation on the European qualifying examination (IPREE, OJ EPO 2017,

Supplementary publication 2, 18). The paper should not require special technical knowledge and thereby favour candidates with a certain technical background. Therefore, awarding 0 marks for the appellant's answer contravened the principle of fair marking.

(b) *Claim 5 and general part of Paper C*

As regards claim 5 of Annex 1, a novelty attack was expected on the basis of the corkscrew sold at the wine fair as reported in Annex 4. According to the examiners' report, a complete reasoning needed to include a consideration on the availability to the public of the chemical composition of the coating on the corkscrew (see examiners' report, pages 4, 5, 7 et seq. and 13).

The appellant argued that the expected solution was based on the assumption that a corkscrew as shown in the picture of Annex 4 not only had been displayed at the wine fair for demonstration purposes, but had been given to a member of the public and taken home; so all its features, including the coating's composition, had been made available to the public. However, from the context of Annex 4, lines 38 to 42, and the word "selling" it was not clear whether the corkscrew could be ordered at the wine fair, but was received only thereafter, i.e. on or after the second priority date of Annex 1, or whether there was a stock of corkscrews available at the wine fair, such that the corkscrew could be obtained in exchange for money by a member of the public. Therefore, to give the expected answer, candidates had to assume that a member of the public had come into possession of a corkscrew during the wine

fair. However, the appellant had based her answer on the equally plausible assumption that the corkscrew could only be ordered at the wine fair. She had therefore taken the information regarding the coating of the corkscrew from Annex 4 and, pursuant to Rule 25(5) IPREE, offered witness evidence to confirm that the information regarding the coating was disclosed to a member of the public attending the wine fair.

VII. The appellant requested that:

- (a) the Examination Board's decision of 6 July 2017 to award the appellant a "fail" for her Paper C of the European qualifying examination 2017 be set aside;
- (b) the marking of her answers to claims 2 and 5 and in the general part of Paper 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. *Claim 2 of Paper C*
 - 2.1 The appellant contests the marking of her answer with respect to claim 2 of Paper C.
 - 2.2 The Appeal Board agrees with the appellant that, in the light of the explanations given in the examiners' report, giving her 0 out of 20 marks for her 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.

- 2.3 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 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."

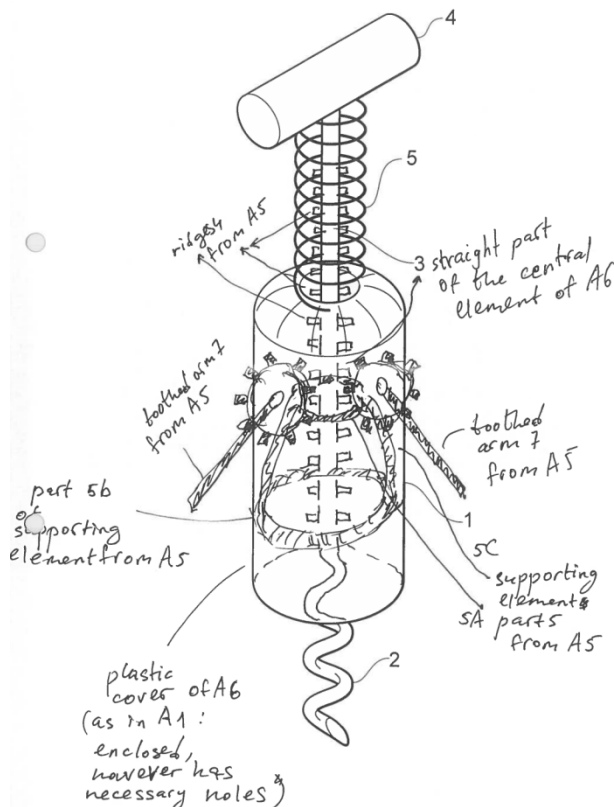
It follows from this passage that the spring of the corkscrew disclosed in Annex 6 is perceived as a technical obstacle that would militate against the choice of Annex 6 as the closest prior-art document.

- 2.4 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) Regulation on the European qualifying examination for professional representatives, REE, OJ EPO 2017, Supplementary publication 2, 2); 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.

2.5 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.

2.6 On the basis of a summary examination, it is evident from the figure below, which was filed in appeal case D 20/17 but was considered to be relevant in the present appeal and therefore *ex officio* taken into consideration by the Appeal Board, that no technical obstacle exists (see also D 14/17).



2.7 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.

2.8 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.

3. *Claim 5 and general part of Paper C*

3.1 The appellant further contests the marking of her answer with respect to claim 5 and the general part of Paper C.

3.2 The issue is whether the factual circumstances of the prior use were unambiguously set out in the examination

paper or whether the facts were open to different plausible interpretations.

- 3.3 The relevant passage in Annex 4, lines 38 to 44, reads as follows: "Although Mr. Rolha's corkscrew is one of the simplest (see below a photo of the corkscrew available at the fair), he was very successful in selling it there. The corkscrew's polyfluorocarbon coating makes it easier to remove corks."
- 3.4 The examiners' report (page 4, second paragraph) states that the candidates "... were expected to provide a discussion of the relevance of Annex 4. The annex itself could not be used to attack the claims as it was published after the filing date of Annex 1. There was no evidence in Annex 4 of an oral disclosure. However, this document was evidence of public prior use. It was expected that answers include when the prior use took place, what was made available and under what circumstances (see the Guidelines, G-IV, 7.2). It was expected that candidates realise that the cork-screw sold at the fair was prior art for claims 5-7. The sale of the cork-screw made all its features, including the coating's composition, available to the public."
- 3.5 Already from this passage it is clear that the information provided in Annex 4 was seen as conclusive proof of the fact that a corkscrew as shown in the picture of Annex 4 not only had been displayed at the wine fair for demonstration purposes, but had been given to a member of the public in exchange for money. This is further corroborated by the following statement in the examiners' report (paragraph bridging pages 7 and 8): "In order to show that a product was made

available to the public prior to the priority date, it is necessary to provide the following information: when the prior use took place; what was made available; and under what circumstances (Guidelines G-IV, 7.2). The wine fair took place in Oporto on 25-27th March 2011 (Annex 4, line 4), i.e. prior to the second priority date of Annex 1 (the effective date for claims 5-7). Annex 4 discloses a wine fair attended by the general public (Annex 4, lines 18-19). Mr. Rolha sold corkscrews at this fair (Annex 4, lines 41-42). Therefore, the corkscrew sold at the fair can be used under Article 54(2) EPC against the subject-matter of claims 5-7."

3.6 Indeed, since the client did not indicate in his letter that he himself had obtained a corkscrew at the fair, the answers expected with respect to claim 5 and the general part of Paper C could only be given if Annex 4 were considered sufficient proof of the fact that a member of the public had taken possession of a corkscrew during the wine fair and had been able to analyse the coating's composition.

3.7 However, as argued by the appellant, the phrase that Mr. Rolha was "very successful in selling" the corkscrew at the wine fair did not unambiguously exclude the possibility that the attendees of the wine fair were only able to place an order for the corkscrew. Indeed, in the picture of Annex 4 a single corkscrew is shown together with several bottles, giving the impression that "the corkscrew available at the fair" (Annex 4, lines 40 and 41, emphasis added by the Appeal Board) was a testable item only. On the basis of such an understanding, Annex 4 was inconclusive evidence for

the assertion that all the features of the corkscrew, namely the coating's composition, had been made available to the public during the wine fair. In view of the fact that the wine fair ended on the day before the second priority date of Annex 1, the availability of the information regarding the coating's composition needed confirmation, as required by Rule 25(5) of the Implementing provisions to the Regulation on the European qualifying examination (IPREE, OJ EPO 2017, Supplementary publication 2, 18). The appellant offered such confirmation by way of a hearing of witnesses in case of dispute. On the basis of a summary examination, the appellant's answer with respect to claim 5, albeit deviating from the expected solution, is based on a reasonable understanding of the factual framework given in the examination paper and is also competently substantiated. There is no indication that the examiners took into account the alternative interpretation of Annex 4 in their marking of the appellant's answers, since the examiners' report constantly refers to the availability to the public of the corkscrew with all its features including the coating's composition. As in the case of claim 2, the examiners based their marking of the appellant's answer with respect to claim 5 on a false premise and did not comply with their obligation to allow for fair marking of answers which deviate from the scheme but are reasonable and competently substantiated. This also holds true for the marking of the general part of Paper C, to the extent that the examiners relied on the assumption that the information provided in Annex 4 was conclusive proof that a corkscrew as shown in the picture of Annex 4 had been made available to the

public with all its features, including the coating's composition.

4. For the above reasons, the appeal is to be allowed. An assessment of the appellant's answers regarding claim 2, claim 5 and the general part 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 claims 2 and 5 and the general part.
3. Reimbursement of the appeal fee is ordered.

The Registrar:

The Chairman:

G. Rauh

I. Beckedorf