



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 0011/18

D E C I S I O N
of the Disciplinary Board of Appeal
of 20 March 2019

Appellant: N.N.

Decision under appeal: Decision of the Examination Board dated
16 July 2018 concerning the European Qualifying
Examination that the Appellant failed Paper B of
the European Qualifying Examination 2018

Composition of the Board:

Chairman: T. Bokor
Members: C. Brandt
C. Rebbereh

Summary of Facts and Submissions

I. The appeal contests the decision of the Examination Board for the European qualifying examination (EQE) 2018 dated 16 July 2018 as communicated to the appellant by registered letter, received by the appellant on 21 July 2018, which was that he had failed the EQE. On his answer papers he was awarded the following marks: B: 35 (2018), D: 32 (2018).

The relevant marking details of the two members of Examination Committee I were enclosed with the contested decision.

II. With letter of 14 August 2018, received at the European Patent Office on 15 August 2018, the appellant filed a notice of appeal against the decision including a statement setting out the grounds for appeal. Exhibits 1 to 5 were annexed. The appeal fee was transferred on 8 August 2018. The appeal contests the marking of Paper B of the EQE 2018. The appeal submissions and arguments were complemented in a letter filed 1 October 2018. In this letter also the re-marking of Paper D was requested.

III. By letter of 25 September 2018 the Examination Secretariat informed the appellant that his appeal had not been allowed by the Examination Board, and had therefore been referred to the Disciplinary Board of Appeal (hereinafter also as "DBA").

IV. By letters dated 19 October 2018 the Board invited the Presidents of the EPO and of the Institute of Professional Representatives before the EPO (epi) to comment on the case under Article 24(4) of the Regulation on the EQE for professional representatives (REE, OJ EPO 2019, supplementary publication 2) and Article 12 of the Regulation on discipline for professional representatives (RDR, OJ EPO 2019, supplementary publication 2). Neither did so.

V. With communication dated 26 November 2018 the Board informed the appellant of its provisional opinion on the appeal, namely that as things stood it had little chance of success.

VI. In a written reply dated 19 December 2018 as well as with a letter received at the Boards of Appeal on 27 February 2019 the appellant partly reiterated the arguments he had submitted with his statement of grounds of appeal. Further exhibits 5A, 5B, 7, 8 and 9 were filed.

VII. According to the letter dated 19 December 2018 the appellant's requests were:

Setting aside the decision of the Examination Board, and as **Main Request:** the awarding by the Board of at least 58 marks for his paper B,

as **First auxiliary request: the remittal to the Examination Board with the order to re-mark the complete paper B,**

as **Second Auxiliary Request:** the Board instructing the Examination Board to amend the Examiner's Report and to continue the appeal on the basis of the amended Report.

Previous requests concerning the paper D were withdrawn.

VIII. The Board held oral proceedings on 20 March 2019, which was attended by the appellant, his professional representative and the Head of the Examination Secretariat on behalf of the President of the EPO pursuant to Article 14 RDR, last sentence. The appellant reiterated and explained his main objections against the marking of Paper B already provided at length in his statement of grounds of appeal and his subsequent written submissions.

IX. The appellant's submissions during the oral proceedings can be summarised as follows:

The appellant's line of arguments is directed essentially against the evaluation of some of his answers given in Paper B by the Examination Committee and Examination Board and towards a higher marking or rather a re-marking.

X. Referring to paragraph 8.6. of his letter dated 1 October 2018 the appellant contended that "the solution in the Examiners' Report, which **adds dependent claims** without broadening the protection and contrary to the client's instructions not to add dependent or independent claims, was inconsistent even with the Examiners' own approach with respect to claim 1". According to the Examiners' Report (page 7, second bullet) one of the grounds for limiting the range of Cu content of 10-20% by weight of Cu was that "the range of Cu content of 10-20% by weight also avoids the values of 5% and 25 % that the client states in his letter give poor quality products, namely, fuses may not blow at the predetermined value of overload current". According to the appellant, the Examiners' Report did not take into account the possibility that the technical solution for improving functioning of the fuse with the values 5% and 25% of Cu by some additional feature will be found later, despite that the client directly asked for broadest protection. The added dependencies re-used numbers of the claims in the client's claims set, but they were not the same as dependent claims proposed by the client corrected for following the EPC and thus were *further* claims from the client's point of view. The improvement of the claim structure was not requested by the client.

The appellant further contested the marking scheme set out in the Examiner's Report, in that this foresaw the awarding of marks for indicating the basis for the new combination of features (Article 123(2) EPC) in the proposed claims 1 to 3, since such an indication would not be required by Rule 24(2) IPREE nor by the client's letter.

XI. The appellant also contests the statement in the Examiners' Report that claim 1 without including the feature that the cover layer is made of **epoxy resin** violates Article 123(2) EPC. He submits that it was derivable from the disclosure as a whole that the epoxy resin was not essential. The conclusion in the Examiners' Report was based on the linguistic comparison of different parts of the disclosure instead of the technical consideration of the disclosure as a whole in the manner a skilled person would do, e. g. by taking into account the correspondence between structural features and their functions. There was a contradiction in the disclosure between paragraphs [004], [008] and Table 2. The Examiners' Report was based on a technically incorrect premise, since epoxy resin was treated as the only material preventing the reflow, while it followed from the definition of reflow in paragraph [004] of the patent application and the general knowledge that there is a range of other materials useful for such a prevention. Paragraph [008] stated "With the material of the cover layer 25 present in the gap, the metal of the fuse track **cannot flow back into the gap**". Thus, linguistically there can be no reflow when the material of the cover layer, e.g. epoxy resin, was in the gap. However, Table 2 demonstrated the opposite, since there still existed a residual reflow. It was irrelevant if the cover layer is made of epoxy resin or not, since as soon as the open path via the gap were not longer open, there could be no reflow via these paths. Otherwise, *reflow* would be *diffusion*. Such an unconventional interpretation could be based only on special knowledge. In the appellant's opinion the residual reflow was clearly explainable by reflow "along the paths being aside from the material of the cover layer present in the gap".

Consequently, additional 8 marks (inventive step), 5 marks (Article 123(2) EPC) and 10 marks for the breadth of claim 1 should be awarded.

XII. The appellant also complained that his claim 1, for which he got 2 marks out of 20, was considered as lacking an inventive step. According to the Examiners' Report in order to make the claimed subject-matter inventive over D1 in combination with D2 the material of the cover layer must be claimed, which has only been described as being an epoxy resin. Furthermore, the definition by a functional feature "the cover-layer being configured to soften and flow" would lead to a lack of inventive step since the glass layer disclosed in D2 is **inherently configured to soften and flow** (Examiners' Report, page 11). The appellant contests such an inherent disclosure of the feature "cover layer configured to soften and flow" in D2. The feature "cover layer configured to flow" of claim 1 could not be read on the cover layer which explodes, as disclosed in D2. Insofar, the Examiners' Report has to be assessed as not comprehensible (D 13/17).

The appellant further contended that in D2 the glass type was not specified. In his opinion, even if it was correct that all glass types would soften and flow when heated in all temperature ranges, this could only be based on special knowledge, which shall not be used according to Rule 22(3) IPREE. The appellant referred to exhibits 1 and 2 filed with the statement of grounds of appeal which showed that it was incorrect that all glass types soften when heated. He therefore requested a re-marking based on a new marking scheme, since the marking scheme used by the Examiners, where 8 and/or 10 marks could be lost for the lack of inventive step, was inappropriate because it was based on the incorrect technical premise.

Final Requests:

At the end of the oral proceedings the appellant withdrew its main and second auxiliary requests as filed with letter of 19 December 2018 and declared the then first auxiliary request "to instruct the Examination Board to remark my Paper B" to be the main request.

The appellant therefore **requested** the remittal of the case to the Examination Board for a complete re-marking of the Paper B and the reimbursement of the appeal fee.

Reasons for the Decision

Preliminary remark

Unless indicated otherwise, REE refers to the version in force from 1 January 2009 (Supplementary Publication 2, OJ EPO 2019, 2), IPREE refers to the version in force from 1 April 2010 (Supplementary Publication 2, OJ EPO 2019, 18) and RDR (Regulation on discipline for professional representatives) refers to the version in force from 21 October 1977 (Supplementary Publication 1, OJ EPO 2019, 119).

1. Period of summons

With letter dated 19 December 2018 the appellant requested oral proceedings and agreed to a shorter period as the two months' notice of the summons (Rule 115(1), second sentence EPC, Article 24(4) REE, Article 13(2) RDR).

2. The appeal is admissible.

Request to set aside the decision under appeal

3. The appellant's line of arguments is directed essentially against the evaluation of some of his answers given in Paper B by the Examination Committee and the Examination Board and towards a higher marking or rather a re-marking. However, Examination Board decisions in EQE are subject only to limited review by the DBA.

Article 24(1) REE reads: "An appeal shall lie from decisions of the Examination Board ... only on the grounds that this

Regulation or any provision relating to its application has been infringed". In accordance with the consistent case law of the DBA, in particular D 1/92, OJ EPO 1993, 357, and D 6/92, OJ EPO 1993, 361, 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. In these two cases, the DBA therefore concluded that its functions did not include reconsidering the examination procedure on its merits. Accordingly, the Examination Board's value judgment concerning the number of marks that an examination paper deserves is not subject to review by the DBA. As held in decision D 6/13 (points 8 and 9 of the reasons), it cannot be qualified immediately as an infringement of a provision of the REE or IPREE, if the Examination Board does not "perfectly" fulfil its implied obligation to draw up an impeccable examination paper and corresponding impeccable marking scheme, as such a finding would in the given case require a value judgement, which is normally beyond the powers of the Board.

Only if the appellant can show that the contested decision is based on serious and obvious mistakes the DBA may consider this. The alleged mistake must be so obvious that it can be established without re-opening the entire marking procedure, for instance if an examiner is alleged to have based his evaluation on a technically or legally incorrect premise on which the contested decision rests. Any further claims regarding alleged defects in the assessment of candidates' work fall outside the DBA's jurisdiction, since value judgments are not subject to judicial review (cf. D 11/07, point 3 of the reasons; D 9/11, points 13 and 14 of the reasons; Case Law of the Boards of Appeal, 8th edition 2010, V.2.6.3, with further references). As set out in D 7/05 (OJ EPO 2007, 378, 394 et seq.), the DBA can only consider facts constituting a mistake in the examination procedure which can be established without re-opening the whole marking procedure. The actual marking of

examination performance in terms of how many marks an answer deserves is not subject to review by the DBA, nor are the Examination Board's criteria for determining the weighting of the expected answers (cf. D 20/96, point 9 of the reasons) to the examination questions (D 13/02, point 5 of the reasons).

The DBA does not have the power to reconsider the entire examination procedure on the merits and set its evaluation of the merits above that of the Examination Board. Review of the marking of an answer in terms of whether it is objectively correct or appropriate, is denied to the DBA by virtue of Article 24(1) REE.

The appellant's requests and submissions have to be evaluated and judged against this background. The appellant's submissions in particular as set out and reiterated during the oral proceeding were as follows.

4. Referring to paragraph 8.6. of his letter dated 1 October 2018 the appellant contends that "the solution in the Examiners' Report, which **adds dependent claims** without broadening the protection and contrary to the client's instructions not to add dependent or independent claims, was inconsistent even with the Examiners' own approach with respect to claim 1" (see X. above). According to the Examiners' Report one of the grounds for limiting the range of Cu content of 10-20% by weight of Cu was that "the range of Cu content of 10-20% by weight also avoids the values of 5% and 25 %" that was stated by the client to give poor quality products, namely "fuses may not blow at the predetermined value of overload current".

4.1 First of all, the Board states that claim 1 as proposed in the Examiners' Report is based on and respects the facts given in the application as well as in the client's letter and

therefore fully complies with the requirements pursuant to Rule 22(3) IPREE.

4.2 On the other hand the appellant's contention that the Examiners' Report did not take into account "the possibility that the technical solution for improving functioning of the fuse with the values 5% and 25% of Cu by some additional feature will be found later", disregards the facts provided in the application and the client's letter and can only be qualified as speculation. In this manner, if the Board were to follow the submission of the appellant, this would go against Rule 22(3) IPREE.

The mere fact that according to the appellant "the added dependencies re-used numbers of the claims in the client's claims set, but they were not the same as dependent claims proposed by the client corrected for following the EPC" can as such not be considered as deficiency or mistake. On the contrary it was just required, if appropriate or necessary, to amend the set of claims proposed by the client for compliance with the provisions of the EPC.

4.3 Furthermore, the Board is not convinced that the client's expectation not to add further dependent claims have been disregarded by making dependent claims 3 and 4 dependent on the preceding claims as proposed in the Examiners' Report.

This is quite evident from the fact that the set of claims proposed by the client encompasses 1 independent claim and 4 dependent claims, whereas the proposal in the Examiners' Report consists of 1 dependent claim and 3 dependent claims. Hence, the mere number of claims has not been increased by the Examiners' proposal but reduced instead, it not being derivable from the client's letter that amending the dependencies in the claims was also not expected or not desired. Even if adding the proposed dependencies in the claims as such will not lead to a

broader scope of protection of the client's invention, the Board cannot find a serious and obvious error in the Examiners' Report which considers that making dependent claims 3 and 4 dependent on the preceding claims is to be considered as an improvement of the claim structure, and foresees the awarding of 2 marks for each dependent claim.

4.4 Furthermore, the Board disagrees with the appellant who appears to contest the award of marks for indicating the basis for the new combination of features (Article 123(2) EPC) in the proposed claims 1 to 3, since such an indication would not be required by Rule 24(2) IPREE nor by the client's letter. The Board would like to refer to the communication of the Examining Division in Paper B, where it is explicitly required to indicate the basis for any amendments (see point 8, last sentence), with a direct reference to Rule 137(4) EPC. The knowledge and the observance of this requirement can be seen as a sign to be "fit to practise" as enshrined in Article 1(1) REE. The Board further points to Rule 24(3), fourth sentence, IPREE, which explicitly states that "candidates shall identify clearly all amendments and their basis...".

5. Furthermore, the appellant's contention that the statement in the Examiners' Report that claim 1 without the feature that the cover layer is made of "**epoxy resin**" violates Article 123(2) EPC is deficient is not convincing and at least cannot be seen as a serious and an obvious error. Taking the disclosure as a whole, in particular paragraphs [004], [008] and table 2 of the application as postulated by the appellant, the Board cannot find fault with the statement in the Examiners' Report that it not being derivable from paragraph [008] of the description that epoxy resin is not essential. This conclusion is fully corroborated by Table 2 where the cover layer is exclusively indicated as being made of epoxy resin. The Board does not acknowledge the appellant's allegation that the Examiners' Report was based on a

technically incorrect premise, namely that epoxy resin was the only disclosed material preventing the reflow, while it could be deduced from the definition of reflow in paragraph [004] of the patent application and the general knowledge that there were a range of other materials useful for such a prevention. Not only was "epoxy resin" exclusively disclosed in the application underlying Paper B as material for the cover layer, but it was also not derivable by way of a linguistic or technical interpretation from the definition of reflow in paragraph [004] that there might have been "a range of other materials" useful for such a prevention. The Board may accept that other materials might well exist which are also suitable for preventing the reflow of the melted fuse track into the gap. However, in the absence of any disclosure of such a material in the application, the appellant's interpretation would not be in line with the requirements of Rule 22(3) IPREE.

6. The Board does further not acknowledge a serious and obvious error in an alleged contradiction in the disclosure between paragraphs [004], [008] and Table 2. According to the appellant there was a contradiction because paragraph [008] stated "With the material of the cover layer 25 present in the gap, the metal of the fuse track cannot flow back into the gap", whereas Table 2 demonstrated that there still existed a residual reflow. On the one hand it appears to be reasonable to assume that if the material of the cover layer once is present in the gap, the metal of the fuse track cannot flow back into the gap. Nevertheless, considering the disclosure in the application as a whole - and not only from Table 2 - it can be derived that there is a **residual reflow**. However, corresponding to this disclosure paragraph [008] of the description clearly states that "Metal reflow of the fuse track 23 is thereby **reduced**", the word "thereby" obviously referring to the directly preceding sentence "With the material of the cover layer 25 present in the gap, the metal of the fuse track cannot flow back into the gap". Even if there appears to be in some

respects a contradiction in the application as brought forward by the appellant, there is nevertheless an explicit and unambiguous disclosure for a "reduced" and "residual" reflow of the material as stated above, which has to be put in proper relation to the statement that "the metal of the fuse track cannot flow back into the gap". The Board does not see that the alleged contradiction should be so serious that it could reasonably prevent the candidates from arriving at a solution comparable to that as proposed in the Examiners' Report, or at least no obvious error is apparent which can be established without re-opening of the entire marking procedure. Rather, the Board holds that the appellant's opinion that "otherwise, reflow would be diffusion" or "was clearly explainable by reflow along the paths being aside from [the Board reads this as "alongside" or "at the side of"] the material of the cover layer present in the gap" can only be qualified as a mere assumption or even speculation for which no sufficient hint or disclosure can be found in the application.

7. Consequently, the appellant's request that additional marks for his solution regarding Article 123(2) EPC and for the breadth of claim 1 should be awarded cannot be allowed by the Board.

8. As far as the appellant complains that his claim 1, for which he got 2 marks out of 20 marks, was considered as lacking inventive step, the submissions are partly well-founded. According to the Examiners' Report, an independent claim relying on the functional feature "the cover-layer being configured to soften and flow" would lead to a lack of inventive step since the glass layer disclosed in D2 is **inherently configured to soften and flow**. The arguments of the appellant in this respect appear to be twofold. He states that glass **in general** would not always soften and flow, and specifically D2 does not disclose a glass layer which would soften and flow.

8.1 First of all the appellant contended that in D2 the glass type was not specified and that, even if it was correct that all glass types would soften and flow when heated in all temperature ranges, this could only be based on special knowledge, which shall not be used according to Rule 22(3) IPREE. Regarding this argument the Board fails to acknowledge that the Examiners' Report contains a serious and an obvious mistake. The Board is of the opinion that it is common knowledge that in principle glass has the property to melt when heated at a specific melting temperature. The Board concedes that the appellant has shown in Exhibits 1 and 2 filed with its statement of grounds of appeal that apparently not all glass types melt and flow when heated. The citations made by the appellant in view of these Exhibits however relate to "fused silica glass" which according to Exhibits 1 and 2 has some special and deviating properties when compared to other "normal" types of glass. The Board points to Exhibit 1 (page 2186), where the "anomalous behaviour" of fused silica glass is described. This statement is corroborated by Exhibit 2 (page 34 "1. Introduction"), which provides the information that "At room temperature, in so-called *anomalous glasses like fused silica*, volume densification has been obtained under load *while in normal glasses* shear flow has been observed ...". Furthermore, the appellant itself appears to share the Board's assumption when submitting in writing (letter dated 19 December 2018, page 3 of 14, last paragraph) that "The very likelihood that the Examiners have assumed these premises", namely that all materials or glasses soften when heated or that glass cover layers, which explodes must soften before the explosion, "is based on that it is clear that often glass and other materials soften when heated ...".

Considering this factual background, it is not apparent that the Examiner's Report had started from a premise which had been obviously incorrect either technically or legally, to the

extent that the Examiners' Report apparently assumed that glass **generally** can soften and flow when heated.

8.2. However, the Board holds that the statement in the Examiners' Report (page 11, last paragraph) according to which "the definition by a functional feature even leads to a lack of inventive step: the cover layer being configured to soften and flow". In this regard the Board fails to see proper support for the assumption that - in the context of a melting fuse - **the glass layer in D2 is inherently configured to soften and flow**. As such this assumption is flawed and represents a serious and an obvious mistake. According to paragraph [002] of D2 "The cover layer 205 of glass confines the energy in the fuse track 203 causing a **micro-explosion** (emphasis by the Board) which ruptures the cover layer 205. This rupture allows the vaporized metal of the fuse track 203 to escape and promotes a significant break in the fuse track." The process described in D2 is illustrated by the following figure (Fig. 2 of D2):

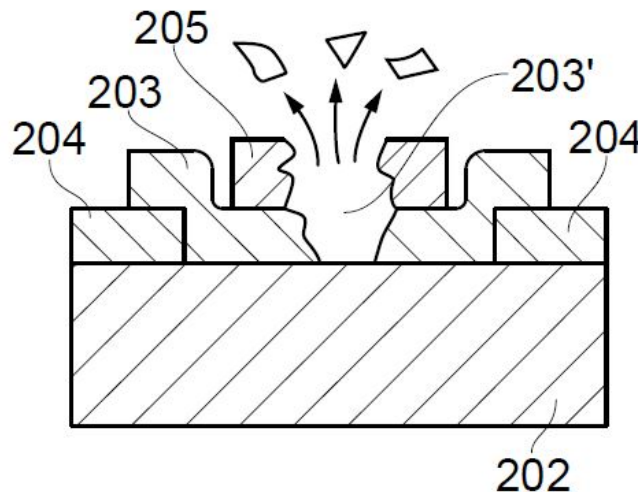


FIG. 2

Therefore, the Examiners' Report is simply and obviously wrong when stating that "the **glass layer in D2 is inherently configured to soften and flow**". This statement seems to be in

total contrast with the disclosure of D2 and therefore represents an obvious and a serious error with respect to the presumed inherent properties of the glass layer. As a consequence, this cannot serve as a proper and legally valid reasoning that the use of a functional feature "the cover layer being configured to soften and flow" in Paper B must lead to a lack of inventive step (and corresponding deduction of marks). The Board finds that even the Examiners' Report (page 19, first paragraph) provides an implicit confirmation of the Board's opinion concerning the disclosure of D2, when it states that the mode of function of the D2 fuse "is the reverse of the present invention where the epoxy resin flows into the gap in the fuse track when the fuse track blows" and further: "In D2 the problem of reflow is not referred to". A nearly identical statement can be found on page 23, first paragraph of the Examiners' Report.

9. Thus, the appeal is well-founded on its substance only as far as it concerns the marking of Paper B based on the erroneous assumption in the Examiners' Report that the **"glass layer in D2 is inherently configured to soften and flow"** (point 8.2 above). With the exception of this issue, the Board cannot find any evidential support in the appellant's submissions that, in marking the appellant's Paper B, the examiners made a serious mistake that would justify a complete and thorough re-marking of the appellant's whole answer paper.

Remittal of the case

10. For the above reasons, the appeal is well-founded only with regard to the marking of the appellant's answer paper based on the erroneous assumption in the Examiners' Report with respect to the presumed inherent properties of the glass layer stated to be disclosed in D2 paper B, but not in respect of the other issues brought forward by the appellant in the appeal proceedings. Thus, the decision under appeal is to be set aside

and the case to be remitted to the Examination Board for a re-evaluation of the appellant's paper B, as far as the evaluation of his answers can be related to the erroneous assumption concerning the disclosure of D2 as described above (points 8.2 and 9. above). To that extent the re-marking can and must cover all relevant parts of the answer paper. An assessment of the appellant's answers 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), falls outside the competence of the Board.

Therefore, the Board decides to remit the case to the Examination Board with the order to arrange the re-marking of Paper B, EQE 2018, of the appellant, i.e., either to perform the re-marking itself or to instruct the competent Examination Committee to undertake a new marking. However, this re-marking need not result in the awarding of additional marks as requested and regarded as being appropriate by the appellant.

Reimbursement of the appeal fee

11. In view of the outcome of the present appeal, the Board deems it equitable in the circumstances to reimburse the appeal fee in full (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 arrange the re-marking of the Paper B EQE 2018 of the appellant.
3. The reimbursement of the appeal fee is ordered.

The Registrar:

The Chairman:



N. Michaleczek

T. Bokor

Decision electronically authenticated