



Beschwerdekammer in Disziplinarangelegenheiten

Disciplinary Board of Appeal

Chambre de recours statuant en matière disciplinaire

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Case Number: D 0040/21

D E C I S I O N
of the Disciplinary Board of Appeal
of 22 March 2023

Appellant: N.N.

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

Composition of the Board:

Chairman: W. Sekretaruk

Members: T. Bokor

S. Colombo

Summary of Facts and Submissions

- I. The appellant sat the 2021 European Qualifying Examination (EQE). He appealed, by a notice of appeal both dated and received by fax at the EPO on 2 August 2021, against the decision, posted by registered letter dated 21 June 2021, of the Examination Board that he had not been successful, having been awarded 16 marks for his performance in Paper B. The appeal fee was also paid on 2 August 2021.
- II. The Examination Board decided not to rectify its decision and referred the case to the Disciplinary Board of Appeal with a letter dated 10 August 2021.
- III. In a first communication under Articles 13(2) and 14 of the Additional Rules of Procedure of the Disciplinary Board of Appeal (RPDBA, Supplementary publication 1 to OJ EPO 2023, 72) dated 18 February 2022, the Board informed the appellant of its provisional view that the appeal did not appear allowable and that a more detailed communication would be issued by the Board later, summoning the appellant to oral proceedings.
- IV. In a second communication under Article 14 RPDBA dated 29 June 2022, the Board set out its provisional view on the various appeal grounds submitted in the appeal. Based on reasons essentially corresponding to the reasons of the present decision, the Board maintained its opinion that the appeal was unlikely to succeed as the Board did not see any infringement of the Regulation on the European qualifying examination for professional representatives (REE, OJ EPO 2019, Supplementary publication 2, 2) or its implementing provisions. The Board also informed the appellant that

it did not intend to summon him to oral proceedings, contrary to the indication given in its previous communication.

- V. The appellant clarified his appeal requests by letter dated 29 August 2022 received by the Board on 7 September 2022 and submitted further arguments in support of his appeal grounds (1) and (3) as set out in detail below in point VIII, seeking to rebut the Board's findings on these grounds. The Board's reasons in respect of grounds (2), (4) and (5) were not commented on.
- VI. The President of the EPO and the President of epi were given opportunity to comment on the appeal. Neither provided comments.
- VII. Pursuant to Rule 24 of the Implementing provisions to the Regulations on the European qualifying examination for professional representatives (IPREE, OJ EPO 2019, Supplementary publication 2, 18), on Paper B, candidates are expected to prepare a response to an official communication of the EPO on behalf of an applicant. The response must address the communication and include amended application documents on the basis of an earlier filed patent application, prior art cited by the EPO and instructions from the client. In Paper B of the EQE 2021, the application concerned a composting container containing live earthworms. The complete paper and the Examiner's Report are available on the website of the European Patent Office.
- VIII. The appellant argued on the following grounds.

(1) *Non-unity of claims 1, 5 and 6 of the model solution, candidate's answer aiming at restoring unity being incorrectly marked (points 1 to 3 of the appeal)*

The expected independent claims 1, 5 and 6 of the model solution published by the Examination Board for the purposes of Article 3(6) REE did not comply with the requirements of unity of invention within the meaning of Article 82 and Rule 44 EPC, also in view of the settled case law on non-unity *a posteriori*. This meant that the paper did not comply with one of the provisions of the EPC and therefore infringed Rule 24(3) IPREE and Article 10(1) REE, these being binding regulations for the drafting and marking of Paper B. On the other hand, if the paper did not intend to test the candidates' knowledge on unity, then including an *a posteriori* lack of unity in the claims of the model solution violated Article 1(1) REE because the paper was not suitable for testing whether candidates were fit to practise. Earlier papers did include Article 82 EPC, for example, Paper B of the EQE in 2015. Even if the EPO communication of the paper stated that a complete search has been carried out for all claims, the Examining Division could still raise objections under Article 82 EPC. The absence of a unity objection in the communication did not relieve candidates from observing Article 82 EPC, in view of the clear wording of Rule 24(3) IPREE, namely that claims should be "amended as appropriate to meet the requirements of the EPC". This duty of the candidates is comparable to the duty of observing Articles 123(2) and 84 EPC. Pursuant to Article 10(1) REE, the Examination Board is only bound by the regulations of the REE and IPREE. This means that statements in the Guidelines for Examination are not binding and should have no bearing in the drafting and marking of the

examination papers. The appellant had reason to believe that his answer paper had been marked on the basis of the wrong assumption that the requirements of Article 82 EPC were met or were irrelevant for answering Paper B. The appellant sought to restore unity of invention by amendments to his independent method claims, which in turn led to an unjustified deduction of marks. The three independent claims as suggested by the Examiner's Report may have been unitary *a priori* but not *a posteriori*. This became clear when analysing the claims in depth. By contrast, the appellant's claims were unitary.

(2) *Difficulty of examination; unfair, unequal treatment between candidates (point 4 of the appeal)*

It was not clear from the Examiner's Report whether Article 82 EPC was actually tested in Paper B, also in view of the fact that Paper B of 2015 EQE did clearly test it. This uncertainty caused an unequal treatment between candidates who had spent considerable time analysing the *a posteriori* lack of unity and those candidates who had not recognised the unity problem or had decided not to spend time on it. This latter group of candidates had a clear advantage because the assessment of unity of invention is very time-intensive even at the stage of drafting the amended claims. This added to the unprecedented complexity and formatting difficulties of Paper B 2021. The difficulty of the paper was further exacerbated by the expected three independent claims instead of the usual two, given that preparing and drafting three separate patentability lines of argument is very time demanding. The fact that independent claim 6 was aimed at computer-implemented inventions meant another difficulty as candidates had to treat the hurdle of technicality in addition to

knowing the practice of mixed-type inventions, e.g. the COMVIK approach. This latter is a challenging and complex task, even for Examiners, as demonstrated by the Guidelines. Thus, candidates who invested lots of effort and time in elaborating suitable arguments for claim 6 were clearly treated differently than those candidates who did not because they received equal marks for unequal effort. However, equal treatment of candidates has been recognised as a higher principle of law in the case law of the Disciplinary Board of Appeal, and this had to be observed by the Examination Board and Committees. Also, the Supervisory Board repeatedly announced that the syllabus and character of Paper B would not be different from previous years, thus establishing a legitimate expectation for candidates that this would indeed be the case. This unequal treatment should be compensated by awarding additional marks for unitary claims, rather than simply not reducing marks.

(3) Incorrect assessment of the "housefly eggs" amendment (points 5 and 8 of the appeal)

The assumption of the marking scheme that the additional option of "housefly eggs and earthworms" infringes Article 123(2) EPC is wrong in law. The feature is not open for objection under Article 123(2) EPC since it is entirely descriptive and not technically limiting. Adding housefly eggs does not change the container's suitability for organic refuse. The container is claimed to be used with the refuse, and the characterisation of such an external entity is unrelated to the properties of the container. The addition of the housefly eggs does not convey any new technical instruction and does not distinguish such a container from the same container not holding housefly

eggs. Case law on Article 123(2) EPC, in particular decisions T 0235/99, T 0835/97 and T 0692/97, support the position of the appellant. In addition, there are pointers in the application, such as the term "additives", which would disclose the housefly eggs as belonging to the invention. The Examiner's Report's reliance on the malodour or the unwanted animals argument is not convincing, and the similarity of earthworm and housefly larvae would also lead to the conclusion that the claiming of housefly eggs is permissible under Article 123(2) EPC. It is also unreasonable that the housefly egg amendment was punished more severely in claim 5, albeit being the same error. The appellant's claim 5 further included container features, making the malodour and similar arguments moot, and also had features to avoid problems under Article 84 EPC.

(4) Incorrect assessment of the "means for removing excess moisture/drain holes" amendment and the "for preventing the earthworms from migrating" amendment (points 6 and 7 of the appeal)

The appellant was correct in choosing functional features, and his choice to generalise the required drain holes to "means for removing excess moisture" should have been an allowable amendment under Article 123(2) EPC because the skilled person is taught several alternatives. If the drain holes were really essential in claim 1, as argued in the Examiner's Report, a corresponding feature should also have been present in claims 5 and 6. On the other hand, even the report identified parts of the description showing the non-essential character of the drain holes for the purposes of removing excess moisture. The skilled person can rely on the explicit disclosure of

alternatives, and the disclosure as a whole had to be considered. The assessment is not restricted to particular examples. Here, the description included an embodiment with water-absorbent material. The other functional feature "preventing the earthworms from migrating out of the compartment" used by the appellant should also have been awarded marks. It was a suitable feature, established novelty over the prior art and was not unclear. The suggested feature of the non-transparent lid in the model solution unduly limited claim 1, so that the appellant's solution was in fact superior to the model solution.

(5) Incorrect assessment/markings of defensible features/novelty/technical support/clarity arguments (points 9 and 10 of the appeal)

The appellant argued that the inclusion of a reference to a container holding the refuse in his calculation method claim was also meaningful for patentability. This could prevent an objection under Article 56 EPC, namely that the purported technical problem may not have been credibly solved for all claimed embodiments. Document D3 as the closest prior art disclosed in fact steps a) to c) of this claim 6, as suggested by the Examiner's Report. However, a software program that checks the earthworm count and adjusts the moisture level would have been obvious to the skilled person in view of the prompts in D3. The reference to the container permitted the addition of the feature that adjustment of the moisture was effected by spraying water onto the refuse. The moisture detector was a necessary feature for this purpose, and for this feature no marks should have been deducted. Furthermore, the candidate provided arguments on

clarity under Article 84 EPC for which no marks were given.

- IX. The appellant requested that the Examination Board's decision awarding 16 marks to his Paper B be set aside and that his answers be re-evaluated, either by way of remittal to the Examination Board or directly by the Board of Appeal. He requested reimbursement of the appeal fee and did not request oral proceedings.

Reasons for the Decision

Admissibility

1. The appeal was filed, and the fee paid in time. The grounds of appeal are provided with reasons, and the appellant is clearly adversely affected. As stated in its preliminary opinion, the Board primarily understands the appeal request to be directed at the awarding of at least 45 marks, i.e. at least 29 additional marks to the appellant's recognised result of 16 marks so that his paper can be awarded at least the COMPENSABLE FAIL or PASS grade (Rule 6(3) IPREE). The appellant did not argue that this understanding of the Board of the main purpose of the appeal was wrong in all aspects. In his letter of 29 August 2022, he merely clarified that he primarily expected a remittal and that the request for re-evaluation of his paper was maintained also for achieving less than 29 additional marks. To that extent, the whole scope of his appeal request may not be admissible, as discussed below, but this does not change the fact that his apparent primary purpose of obtaining a better grade is still part of his appeal request. The appeal as a whole is admissible.

General observations

2. The appellant argued in essence that he was not awarded as many points as he would have been entitled to as a result of an erroneous evaluation of the claims and arguments in his paper. This meant that there had been a violation of Rule 24(3) IPREE. This rule implied that the marking had to be done correctly, i.e. in line with the principles of correct patent practice as reflected in the Guidelines for Examination of the EPO. However, the marking scheme was based on incorrect criteria and thus contravened Rule 24(3) IPREE, among others, for ignoring the requirements of Article 82 and Rule 44 EPC, as explicitly stated in his appeal grounds for ground (1) (see point VIII above). He referred to the principle of equal treatment for ground (2), which the Board accepts to be a general principle regularly recognised as an admissible appeal ground in the case law of the Disciplinary Board of Appeal. The appellant did not elaborate on how the other appeal grounds (3) to (5) as set out above infringed the provisions of the REE, the IPREE, or possibly other related provisions or higher ranking law. For the remaining arguments, the overall thrust of the appeal is only that more marks should have been awarded to his paper as his answers are arguably correct or at least defensible.

3. As set out in the Board's second communication of 29 June 2022, it is well established by the case law of the Disciplinary Board of Appeal that it only has jurisdiction in EQE matters to establish whether or not the Examination Board has infringed the REE or a provision implementing the REE. This follows from Article 24(1) REE, which 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". Thus, the Disciplinary Board of Appeal may only review Examination Board decisions for establishing that they do not infringe the REE, its implementing provisions or a higher-ranking law. It is not the task of the Disciplinary Board of Appeal to reconsider the examination procedure on its merits, nor can it entertain claims that papers have been marked incorrectly, save to the extent of mistakes which are serious and so obvious that they can be established without re-opening the entire marking procedure. All other claims to the effect that papers have been marked incorrectly are not the responsibility of the Disciplinary Board of Appeal. Value judgements are not, as a rule, subject to judicial 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, all cited in the Case Law of the Boards of Appeal, 9th edn. 2019, Chapter V.C.2.6.3.)

4. Erroneous marking of examination papers can only exceptionally form the basis of a successful appeal. In cases where the appellant can show that the contested decision is based on serious and obvious mistakes, the Disciplinary Board of Appeal can possibly 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 their 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 Disciplinary Board of Appeal.

5. The Board sees no violation of the applicable provisions, as explained below. Furthermore, the Board also does not see any manifest errors either in the examination papers or in the marking instructions in the Examiner's Report and the marking of the appellant's paper. Notwithstanding the finding made above in points 3 and 4, namely that the Board cannot be expected to perform a complete review of the marking, the Board considers that it is in a position to comment on the core arguments of the appellant, as outlined below.

6. The Board notes that the totality of the arguments of the appellant alone, namely the necessity of referring to the overall content of Paper B and his answer paper, demonstrates that several of his appeal grounds are difficult, if not impossible to decide on without effectively requiring a complete re-examination of the whole paper B and his answer paper.

Amendments in view of expected a posteriori unity of the claims under Article 82 EPC (points 1 to 3 of the appeal)

7. The appellant submits that he was right to assume that the expected answer should take into account the requirement of unity under Article 82 and Rule 44 EPC. The Board notes, first of all, that there is no trace in the candidate's answer paper that the amendments made were motivated by the desired unity of the claims and, more specifically, by an *a posteriori* unity (given that even the candidate appears to acknowledge that the claims could be argued to be unitary *a priori*, points 2.1 and 2.2 of the appeal). The unity problem is not

mentioned by the candidate, only the basis for the purposes of Article 123(2) EPC and novelty are discussed in his answer paper.

8. The Board is prepared to accept, for the benefit of the appellant, that unity within the meaning of Article 82 EPC was indeed one of his concerns, even absent any explicit statement or argument in his answer paper. However, this does not change the assessment of the Board that his assumptions were not realistic in view of the content of Paper B 2021. The paper gave no hint whatsoever that unity (let alone unity *a posteriori*) should be taken into account, contrary to Paper B 2015 (Mechanics), where the EPO communication under Article 94(3) EPC explicitly mentioned Article 82 and Rule 43 EPC. Even there, the identified problem was Rule 43 EPC (multiple claims in the same category, Guidelines November 2019 F.V.3) and not Rule 44 EPC (unity *a priori* and *a posteriori*, Guidelines November 2019 F.V.4.1 and F.V.4.2). This latter rule addresses a completely different problem of unity, one that seems unlikely to arise in an EQE Paper B - certainly not without any pointer in the paper itself - for the requirement alone of a specific and detailed reasoning from the Office as a first step; not a voluntary move of the applicant (see Guidelines November 2019 F.V. 4.3).
9. It may be that the model solution presented could be argued to be non-unitary *a posteriori*. However, such objections from the Office cannot be reasonably expected to be foreseen by applicants, and even less by candidates writing Paper B, unlike objections under Articles 84 and 123(2) EPC. Even the appellant recognised that examining unity *a posteriori* is not an easy and straightforward exercise (point 4.5 of the

appeal), especially as the latter involves questions of novelty over the prior art. He furthermore realised that in real life applicants were not expected to consider non-unity of their own volition (point 1.6 of the appeal). This is all the more so as lacking unity, even if remaining uncorrected during the proceedings for grant, is not going to be detrimental to a patent, unlike a lack of novelty or lack of inventive step. Thus, it would appear to be a wholly unrealistic expectation from candidates to consider this issue, certainly absent any pointer to the unity problem in the EPO communication in the paper.

10. The Board does not dispute that Paper B aims to test whether candidates are "fit to practise" (Article 1(1) REE), and the Board also accepts that, in theory, all provisions of the EPC may form part of Paper B, including Article 82 in conjunction with Rule 44 EPC. However, it would be manifestly unreasonable to expect that each and every provision of the EPC (including the details of their application as set out in the Guidelines) are also effectively tested in each Paper B. Candidates are first and foremost expected to concentrate on the issues explicitly identified in the EPO communication under Article 94(3) EPC forming part of the paper or possibly in the client's letter (see Rule 22(3) IPREE: Candidates should limit themselves to the facts of the paper).

11. The Board also adds that contrary to the position of the appellant (point 1.7 of the appeal), the Guidelines must be known and also relied on for the purposes of the EQE (see Rule 22(1)(m) IPREE). It would not make sense to expect candidates to know the Guidelines if the examination papers themselves did not take into

account the general instructions for applicants as set out in the Guidelines.

12. This assessment of the Board is not changed by the arguments of the appellant submitted in his letter of 29 August 2022. There the appellant argues at length that there is nothing that would exclude Article 82 EPC from the EQE syllabus as the EQE is clearly targeting all requirements of the EPC. Also, the opinion of the Board would preclude the inclusion of Article 82 EPC in future papers of the EQE and limit the freedom of the Examination Committee in drafting Paper B. Lack of pointers to the unity issue in the 2021 Paper B is irrelevant because the EQE papers generally do not require pointers. Candidates can also not be left in any uncertainty about which provisions of the Guidelines may or may not have been the focus of the EQE paper that they are answering. Otherwise, they would be facing an unreasonable additional burden in that they would have to carefully evaluate which provision should be followed in the given paper. The Board would also not need to review the whole paper, a *prima facie* assessment of the unity would be sufficient.

13. These arguments do not convince the Board. As stated above, the Board does not categorically exclude the possibility of the problem of unity appearing in Paper B, possibly even a *posteriori* unity. However, in view of the many facets of this question and its inherent complexity and interrelationship with novelty and inventive step, in addition to the fact that the paper contained nothing that would have directed the attention of the candidates to this issue, the Board maintains its opinion that a reasonable candidate had no reason to consider that a *posteriori* unity was an

aspect that had to be observed when drafting the claims for Paper B 2021. Finally, the Board does not dispute that candidates must make certain difficult but unavoidable evaluations of the paper. It is an inherent and unavoidable task for any candidate when sitting any EQE paper that the totality of the information given in the paper must be assessed for the candidate to identify which provisions of the EPC and which parts of the Guidelines may be relevant for answering the paper correctly. This is not changed by the fact that certain parts of the Guidelines can be expected to be relevant in practically every paper, e.g. those treating added subject-matter, clarity, novelty and inventive step.

14. Summing up, the Board sees no violation of Rule 24(3) IPREE. In the fictional procedural situation sought to be simulated by Paper B 2021 (Rule 24(2) IPREE), candidates did not have to consider the issues under Article 82 and Rule 44 EPC, absent any explicit pointer in the paper, even if Rule 24(3) IPREE indeed refers to expected claims that "meet the requirements of the EPC". Instead, they were expected to address the usual substantive issues, i.e. added matter, novelty and inventive step (see also Rule 24(3), penultimate and last sentences, IPREE).

Unequal treatment of candidates (point 4 of the appeal)

15. As indicated in the first communication of the Board and set out in detail in its second communication, it is not an unequal treatment of candidates but an inevitable consequence of the examination structure that candidates making different choices during the examination perceive different levels of difficulty. As explained above, the Board is of the opinion that the candidate not only made a choice that was different

from the expected choice as set out in the model solution but also one that could not have been reasonably expected. In that light, there is even less merit in the argument that the candidate was subject to unequal treatment.

16. The Board also accepts that the subjectively perceived difficulty of the 2021 Paper B was higher than those of previous papers (e.g. because of the online format, there being three independent claims, etc.). Again, such differences are inherent in the examination structure, and it cannot be a reasonable expectation of candidates that the papers which they must sit in a given year are going to be - subjectively felt - exactly as difficult as any earlier paper. The Board also accepts that the online examination format (and the implied formatting requirement) posed an additional difficulty, and depending on a candidate's personal affinity to working with a computer, this difficulty might not be perceived to be similar or even comparable by different candidates. However, the use of the online format was justified in light of the COVID-19 pandemic. Also, candidates may equally feel "disadvantaged" by conditions of the "traditional" examination format, where candidates are expected to submit their work in handwriting, given that preparation of handwritten documents (instead of digitally edited and printed documents) could plausibly be perceived to be the exception in 2021.

Allowability of the "housefly eggs" amendment (points 5 and 8 of the appeal)

17. The Board sees no merit in the candidate's argument that the "housefly eggs" amendment is not technically limiting and therefore not objectionable under

Article 123(2) EPC. First of all, the cited case law on the **omission** of an arguably descriptive (but otherwise originally disclosed) feature cannot support the inverse conclusion that descriptive features can be added to claims without any disclosure of the argued descriptive feature in the application as filed. In any case, the claim required a support for holding the refuse populated with the earthworms. The description made it clear that the drain holes in the support had to take into account the earthworms and prevent them from falling out (see paragraph [017]). Aside from the lacking disclosure for considering housefly eggs to be part of the originally disclosed invention, even if the candidate made this error, there would have been no reason to consider that the properties of housefly eggs were wholly irrelevant for the technical features of the support holding the refuse, and therefore the feature would not have been limiting.

18. Finally, the Board considers that the "housefly eggs" amendment cannot be supported by the disclosure of paragraphs [003] and [022]. Paragraph [003] is explicitly directed to the prior art. Paragraph [022] generally mentions known additives and specifically mentions only blood meal and bacteria. It is not a direct and unambiguous disclosure for the use of housefly eggs in the claimed container and method, whether used alone or claimed strictly combined with earthworms. It is another matter that it would perhaps be obvious for the skilled person to consider housefly eggs as well on the basis of the original description and claims.
19. As a reaction to the above opinion of the Board, the appellant argued again that the refuse, with or without the housefly eggs, is not an element of the claim

because the container needs only to be suitable for holding the refuse, and the housefly eggs are immobile and do not interact with the container and its parts, such as the support with drain holes surrounding the refuse. Consequently, the skilled person did not receive any new teaching or insight on the container when the housefly eggs were present in the refuse. The situation was comparable to that of a bookshelf suitable for storing a book, where the skilled person would have recognised that the same bookshelf was also suitable for holding the same book if that book contains a bookmark. Furthermore, the original disclosure contained sufficient pointers to the additives known from the prior art, which may well have formed the basis of a disclosure for the purposes of Article 123(2) EPC, also in accordance with the Guidelines and the cited case law.

20. As for the preceding appeal grounds, the appellant's arguments in response to the Board's preliminary opinion do not change the Board's findings on this issue. The Board holds that the appellant misunderstands the concept of an unambiguous disclosure for the purposes of Article 123(2) EPC. It is irrelevant for this article what the skilled person may realise to also obviously fall under a disclosed invention. To remain with the appellant's example, the bookshelf with the book and bookmark cannot be claimed if the book and bookmark were never mentioned as part of the invention of the bookshelf, however obvious it may be for the skilled person that the bookshelf would still be suitable for holding such a book with or without a bookmark. This is not changed by the fact that the claimed scope is actually less than without the amendment in dispute and that the claim does not cover anything that was not covered before. The cited

part of the Guidelines (Guidelines for Examination 2019, Part H, Chapter IV.2.2.1) does not support the appellant's position, making it clear that even cross-referenced documents are not part of the disclosure for the purposes of Article 123(2) EPC as a general rule, in spite of the fact that applicants usually explicitly state that they consider the cross-referenced documents to form part of the disclosure in their application. The cited decisions are also not applicable as the disclosure of the critical features underlying these cases is not comparable to the housefly egg issue of Paper B. Selection from a list is not problematic where each element of the list was undisputedly disclosed as belonging to the invention (T 0197/08, point 3.3 of the Reasons). The allowability for the purposes of Article 123(2) EPC of the exact wording for the definition of the disease to be treated, taken partly from the description of the state of the art - but otherwise being derivable from the description as the disease that is sought to be treated (T 0293/12, point 4 of the Reasons) - is also not comparable to the current situation. In the case at issue, the critical feature (the housefly eggs) was seen only later by the applicant as an essential element of the claimed solution (the composting of the refuse) but was otherwise never singled out in the original application as belonging to the invention and was merely disclosed as a known feature in the prior art.

The features "means for removing excess moisture"/"preventing the earthworms from migrating out of the compartment" (points 6 and 7 of the appeal)

21. The arguments of the appellant for these features, namely whether such functional features are allowable and/or more preferable than the model solution, are not

relevant. The argued feature "means for removing excess moisture" plainly has no basis in the application as filed. This feature is neither claimed nor otherwise disclosed on this level of generality, only its embodiments are mentioned (drain holes, absorbent material and evaporation). The same applies to the feature "preventing the earthworms from migrating out of the compartment". The term "migrate" or "migration" is only found in D2, not in the application as filed.

Container added in claim 6 (point 9 of the appeal)

22. The appellant argues that adding the container in claim 6 may be meaningful for patentability. This may be so, but it is not clear what objection of the appellant this argument is intended to support or why the marking of claim 6 would be erroneous. It would have been possible to achieve 2 marks for some arguments on patentability for claim 6 (see point 5.5.3 of the Examiner's Report). However, the appellant did not provide any novelty or inventive-step arguments for claim 6. On the other hand, marks were given in his paper for claim amendments (1 out of 28) and also for amendment arguments (8 out of 17). In view of the several features violating Article 123(2) EPC in claim 1 (preventing migration of earthworms, means for removing excess moisture and housefly eggs), also in claim 5 (housefly eggs) (see points 18 to 21 above), it must be assumed that the amendment arguments for claims 5 and 6 were marked (as mentioned, 8 marks out of 17). This appears to be more than could have been expected in view of point 5.2 of the Examiner's Report. In fact, only claims 5 and 6 could have been marked with a total of 5 marks (because claim 1 contained added matter). The amendments to claim 6 were apparently marked with 1 mark (5 marks minus 2 x 2 marks for unnecessary

limitations of the container + moisture detector, see point 3.3 of the Examiner's Report), thus correctly as stated in the Examiner's Report.

Unfair marking of the "housefly eggs" amendment

23. As observed in its preliminary opinion, the Board takes note of the objection that the "housefly eggs" amendment was punished more severely for claim 5 than for claim 1 (point 8.1 of the appeal). The Board is aware that successful appeals decided by this Board were based on the argument that the "housefly eggs" amendment was unfairly marked (see e.g. D 0039/21, Reasons 9 and 12, referring to D 0022/21) due to the fact that the same error was arguably punished twice and also with different deductions in claims 1 and 5. However, the Board considers that the appeal cannot be allowed on this ground alone. The Board sees no reason to depart from the view expressed in these decisions and is prepared to accept that this appeal ground *per se* is well founded. However, in the current case, this is not a sufficient reason for the Board to set the decision aside and to remit the case for a new marking of the answer paper. Even without a complete re-marking of the appellant's answer paper, the Board is in no doubt that the re-evaluation of this point would still not achieve the 29 marks required for an at least partially successful appeal given the multitude of justified deductions for a number of reasons other than the "housefly eggs" amendment, as explained for the other appeal grounds. Clearly, any correction of this error would at most result in the awarding of the marks deducted for the "housefly eggs" amendment for one of the claims. Thus, a remittal would serve no purpose.

24. The appellant, in his letter of 29 August 2022, disputed this finding of the Board, arguing that it was not the duty of the Board to re-open the marking procedure and that only errors in the procedure or in the basic legal understanding of the EPC should be reviewed. On this basis, the appeal requests were not directed at his right to pass the examination but merely demanded a re-evaluation of his answer paper, whether by the responsible examination committee or the Board itself. The Board's observation that the re-evaluation of this issue alone would not achieve the required 29 marks was not disputed.
25. This argument boils down to the argument that the appellant has a legitimate interest in obtaining a re-evaluation of his paper as a result of his appeal, regardless of the final result of the re-evaluation. The Board disagrees and holds that the request only for the re-evaluation, without requesting a better grade, is not an admissible appeal request. Such a request is not aimed at eliminating a substantive adverse effect to the appellant, presently the awarding of the grade FAIL. Reference is made to decision D 0002/20, Reasons 8, where the deciding board held that the "relief" specified in Article 6(1) RPDBA must be interpreted in view of the overall purpose of the appeal proceedings, which is to establish if the legal effects of the impugned decision (in that case the dismissal of the complaint and the refusal of the reimbursement of the costs) are correct or not. It is the substantive outcome, namely the legal effect of the order of the impugned decision (or its absence) which generally causes an adverse effect to a potential appellant, and therefore the relief sought within the meaning of Article 6(1) RPDBA must also be directed at the elimination of an adverse effect in this sense, i.e.

directed at a different legal effect. Even where it is argued that fundamental deficiencies occurred in the proceedings, it cannot be the sole purpose of the appeal to establish whether this was the case. The relief sought by the appellant, i.e. the appeal request ("Antrag", "demandes" in the German and French versions), must also be directed at changing a legal effect of the impugned decision. Only such a request can demonstrate that the appellant is adversely affected. It is not sufficient to request that the decision be set aside without requesting (and reasoning why) a different (or further) legal effect should result from the appeal proceedings instead of the appealed legal effect.

26. Though this decision was handed down in a case dealing with a disciplinary matter under the Regulation on discipline for professional representatives (last published in Supplementary publication 1 to OJ EPO 2023, 146), the Board holds that its *ratio decidendi* is applicable to appeals under Article 24 REE. Accordingly, the Board does not allow this appeal ground either, it being insufficient to change the legal effect of the appealed decision. The request for remittal for the sole purpose of re-evaluation is considered inadmissible.

Summary

27. On the basis of the above assessment, none of the appeal grounds are allowable. The Board does not see any infringement of the applicable provisions of the REE or the 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:



N. Michaleczek

W. Sekretaruk

Decision electronically authenticated