Examiner's report pre-examination 2015

Preliminary remark: the references from the Guidelines are from the version of the Guidelines which was to be used in the present examination.

Question 1

An inventor resident in a Contracting State is not obliged to be represented by a professional representative before the EPO, Article 133(1) and (2) EPC. San Marino is a Contracting State since 1 July 2009. In order to be validly represented by a professional representative, it is not required to file a signed authorisation: the principle of self-appointment applies for the first representative (in this case Mr. A). A second representative (in this case Mr. B) need not file a signed authorisation, if the European Patent Office is notified (by Mr. A) that the previous representative's authorisation has terminated, Article 1(1) and (2) of the Decision of the President of the EPO dated 12 July 2007, Special edition No. 3, OJ EPO 2007, L.1. There is no provision for the payment of an administrative fee for the registration of a change of attorney.

1.1 - True
1.2 - False
1.3 - True
1.4 - False

Question 2

The communication is deemed to be delivered on 25 January 2015 [15 January 2015 + 10 days, Rule 126(2) EPC]. It is immaterial that the deemed delivery day falls on a Sunday. In order to avoid further processing and other prolongation of the proceedings, the reply to the communication must be filed at the latest on 26 May 2015 [25 January 2015 + 4 months (= 25 May 2015), extended to Tuesday 26 May 2015, Rule 131(4) EPC and Rule 134(1) EPC)]. Note that on 25 May 2015 the EPO is closed. Further processing can be requested within a period of two months from the communication under Rule112 EPC concerning the loss of rights (Article 121(1) EPC and Rule 135(1) EPC). The communication is sent only after expiry of the time limit for replying to the communication under Article 94(3) EPC: 27 July 2015 is not the latest day for requesting further processing. The period for replying to the communication may be extended upon request, if the request is presented before the expiry of the period, Rule 132(2) EPC.

2.1 - False
2.2 - True
2.3 - False
2.4 - True

Question 3

The additional search fee is payable within one month from the date of the invitation [16 January 2015 + 1 month (=16 February 2015), Rule 40(1)(ii) PCT and Rule 80.2 PCT]. There is no “ten day rule” for the delivery of communications under the PCT. Since the priority period expires only today, Monday 23 February 2015, you can still file today an international application PCT-B claiming priority from PCT-A [21 February 2014 + 12 months (= Saturday 21 February 2015), extended to 23 February 2013, Article 8(2)(a) PCT and Article 4 C (1) of the Stockholm Act of the Paris Convention for the protection of industrial property and Rule 80.5 (i) PCT]. The International Searching Authority (in this case the EPO) is not competent to carry out a supplementary international search (Rule 45*bis.9* (b) PCT, see also Guidelines, E-VIII, 1 (vi)). The additional search fee is paid directly to the International Searching Authority, Rule 40.2 (b) PCT.

3.1 - False
3.2 - True
3.3 - False
3.4 - True

Question 4

The notice of opposition must be filed at the latest on 18 March 2015 [18 June 2014 + 9 months (= 18 March 2015), Article 99(1) EPC and Rule 131(4) EPC]. Mr. Kurz is entitled to file the notice of opposition in Czech or in Slovak (Rule 3(1) EPC and Article 14(4) EPC). However, according to Rule 6 EPC as entered into force on 1 April 2014, there is no longer any reduction of the opposition fee. Since the documentary evidence was filed in an official language of the EPO, the EPO will not require a translation, Rule 3(3) EPC. Any party may use an official language of a Contracting State during oral proceedings, but the party must then provide interpretation into the language of the proceedings, Rule 4(1) EPC.

4.1 - True
4.2 - False
4.3 - True
4.4 - False

Question 5

The latest date for entering the European phase is 2 March 2015 [2 August 2012 + 31 months (= 2 March 2015), Rule 159(1) EPC and Rule 131(4) EPC]. Entry into the European phase on 27 March 2015 is possible: however, at least one further processing fee is due, Article 121(1) EPC and Rule 135(1) EPC. The applicant is not obliged to file amended claims: he may file comments without filing amended claims, Rule 161(1) EPC. The renewal fee in respect of the third year for Euro-PCT-M has fallen due earlier, on 31 August 2014, Article 86(1) EPC and Rule 51(1) EPC. For PCT-M, one of the requirements for entry into the European phase on 27 February 2015 is the payment of the renewal fee in respect of the third year, Rule 159(1)(g) EPC and Guidelines, A-X, 5.2.4. [Note: For a request for early processing to be effective, the applicant must comply with the

requirements stipulated in Rule 159(1) EPC as if the 31-month time limit expired on the date the applicant requested early processing (see Notice from the European Patent Office dated 21 February 2013 concerning the request for early processing, OJ EPO 2013, 156).]

5.1 - False
5.2 - True
5.3 - False
5.4 - True

Question 6

A European patent application may not be amended in such a way that it contains subject-matter which extends beyond the content of the application as filed, Article 123(2) EPC. An amendment may be allowable under Article 123(2) EPC although it is not based on searched subject-matter (thus offending for instance the requirements of Rule 137(5) EPC). If an amendment is novel and inventive over the application as filed, then it was not directly and unambiguously derivable from the application as filed. An allowable amendment may be based on a drawing, but never on subject-matter found only in amendments filed under Article 19 PCT: such amendments are filed after receiving the international search report, *i.e.* well after the filing of the application.

6.1 - False
6.2 - False
6.3 - True
6.4 - False

Question 7

Priority can be claimed from a utility model, Article 87(1) EPC. Claim 3 is not entitled to priority, since this invention was not disclosed in DE-C: the first filing for a solution of the substance X in alcohol is EP-C. If the priority for an independent claim is valid, no conclusion can be drawn on the validity of the priority of a thereof depending claim.

7.1 - True
7.2 - True
7.3 - False
7.4 - True

Question 8

Claims 1 and 3 have as their effective date the date of filing of EP-C, Article 87(1) EPC. Consequently, the scientific publication is state of the art under Article 54(2) EPC for these two claims. Claim 2 is entitled to the priority date of DE-C: the scientific publication is not state of the art for claim 2. Claim 3 is novel over the scientific publication, since water and alcohol are different solvents.

8.1 - False
8.2 - True
8.3 - True
8.4 - False

Question 9

The applicant can contest the finding of the search division, *e.g.* in the response to the European search report, Rule 70a(1) EPC. The skilled person has the same level of skill for assessing inventive step and sufficient disclosure, (Guidelines, G-VII, 3, last sentence) and he may use common general knowledge to carry out the invention. EP-Q can be considered for assessing sufficiency of disclosure, only if the document was made available to the public no later than on the date of publication of EP-R (Guidelines, F-III, 1, 5.2 and 8 and H-IV, 2.3.1).

9.1 - True
9.2 - False
9.3 - True
9.4 - True

Question 10

Any person may give notice of opposition, provided he or she is not the patent proprietor. The inventor Ms Smith, the candidate preparing for the EQE and Mr Singer can therefore oppose EP-X (Article 99(1) EPC and G 9/93). In the case of Mr Singer filing the opposition for Ms Smith, there is no circumvention of the law within the meaning of G 3/97. The motivation for filing an opposition is irrelevant. Appeal proceedings are only open to parties to proceedings (Article 107 EPC).

10.1 - True
10.2 - True
10.3 - False
10.4 - True

Question 11

The expression „in“ in Claim A) makes it unclear whether protection sought is limited to the door leaf per se or whether the whole fire protection door with the door leaf is claimed, see also Guidelines, F-IV, 4.15. According to the description, paragraph [0008], the wood material of the solid wood plate must be thick enough. The minimum thickness for solid oak wood is 8 cm. When using any other type of solid wood, the thickness must be at least 10 cm, see [0014]. Hence, the thickness is an essential feature of the invention. Since claim A) claims a door leaf in a fire protection door comprising a solid wood plate having a smaller thickness as required by the description, claim A) is not supported by the description. Claim B) is directed to a door leaf per se, wherein a step of the door leaf is defined such that it shall match with a step in a door frame which is however not part of the claim. Many different sizes and forms of steps are possible, hence, the size or the form of the door leaf step is not defined in claim B) but is dependent from another entity that is not part of claim B), see also Guidelines F-IV, 4.14. Hence, claim B) is not clear and does not fulfil the requirements of Article 84 EPC. Claim C) is directed to a fire protection door comprising a door leaf that comprises a plate made of solid wood. As the claim does not specify the thickness, an essential feature for achieving the fire protection property is missing, Guidelines F-IV, 4.5. Hence, claim C) contravenes Article 84 EPC.

11.1 - False
11.2 - False
11.3 - False
11.4 - False

Question 12

A solid wood plate is present in all embodiments of the invention. Also, general statements such as in [0006] refer to a solid wood plate to overcome the drawbacks of the prior art as referred in [0004]. For a solid wood plate, the description states in paragraphs [0008] and [0014] that a minimum thickness of 8 cm or more is essential for the function of the fire protection door. Hence feature b) is not an undue limitation of the scope of the claim. A watered solid wood plate is mentioned as a preferred embodiment only, see [0009], “we preferably use wood that is watered…”. Hence, feature c) is an undue limitation of the scope of the independent claim. A covering with metal layers 3, 4 is mentioned in [0016], but only with reference to a preferred embodiment. A covering by an aluminium sheet is even more specific. Considering the invention and its function as indicated in the description, it is not necessary to limit the claim by feature d). A door closer is part of any fire protection door, see [0002], and is implicitly mentioned by the term “fire protection door”. Since a door closer is present in any fire protection door, a door leaf for a fire protection door must be suitable to be closed by a door closer. Feature e) is not an undue limitation of the scope of protection.

12.1 - False
12.2 - True
12.3 - True
12.4 - False

Question 13

D1 discloses in [0003] a door leaf (metal door leaf 100) comprising a plate (calcium silicate plate 105) including a material (cardboard containing calcium silicate) containing fibres (wood fibres of the cardboard), wherein the material of the plate is such that it delivers moisture when heated (see [0003], water of the calcium silicate is released in case of a fire). The subject-matter of claim I.4 is not new over D1. Further, D1 discloses a metal door, and particularly a steel door, [0002]. However, the specific metal aluminium is not disclosed in D1. The subject-matter of claim I.6 is new over D1. D2 discloses (in the first paragraph and in the Figure) a door leaf (plate 201 supported by hinges), wherein the door leaf comprises a plate (plate 201) including a material containing fibres (plate 201 is made of a piece of wood, see first paragraph of D2 and wood generally contains wood fibres, see the description of the application, [0009]) wherein the plate (plate 201) is at least partially covered by a metal material (see the Figure, and the first paragraph of D2: metal bands 203 of the hinges 202 partially cover the plate 201 of the door). The subject-matter of claim I.5 is not new over D2. Further, D2 discloses a rock 205 on a cable or a rope 206 biasing the door to a closed position, and hence a biasing means having a cable and a weight. Since D2 discloses the first alternative of claim I.8, the subject-matter of claim I.8 is not new over D2.

13.1 - False
13.2 - True
13.3 - False
13.4 - False

Question 14

The first embodiment as shown in Fig. 2 and described in [0018] relates to a hinged fire protection door, having a door leaf 1a. The second embodiment as shown in Fig. 3 and described in [0019] relates to a fire protection door constructed as a sliding door. Both embodiments have a door leaf 1, 1a, 1b, respectively. In [0014] to [0016] the general construction of a door leaf 1 is described which is applicable to both embodiments. The first and second embodiments each have a door closer 12, 23 that biases the door leaf into the closed position, [0018]. Hence, the first and the second embodiments of the application fall within the scope of claim I.7. In the first embodiment, the door closer 12 has a mechanical spring 14 and a lever element 15. This falls under the scope of the second alternative of claim I.8. The second embodiment has a door closer 23 including a cable 24 and a weight 25. This falls under the scope of the first alternative of claim I.8. Hence, both the first and the second embodiments fall within the scope of claim I.8. The second embodiment relates to a sliding door. The description of the general construction of a door leaf in [0017] mentions a door step, but only in connection with a door leaf 1a for a pivoting door while a stepped door leaf 1a is not suitable for sliding doors. According to the

description, the sliding door of the second embodiment cannot have a stepped door leaf. The second embodiment does not fall within the scope of claim I.10.

14.1 - True
14.2 - True
14.3 - True
14.4 - False

Question 15

D3 discloses a sliding door 500 having a door leaf 501 wherein the door leaf 501 is made of a board containing fibres such as cardboard, [0003]. The board containing fibres is a plate. As indicated in D1, [0003], cardboard comprises wood fibres. Hence D3 implicitly discloses all the features of claim I.1. Further, aluminium layers can be used as the outer surfaces, [0004], i.e. both of the major surfaces of the door leaf 501 are covered with aluminium layers. The subject-matter of claim I.6 is not novel over D3. The sliding door 500 of D3 has a door leaf 501 comprising a plate of a material comprising fibres and a cable 503 and a weight 504 biasing the door leaf 501 into the fully open state, [0003], i.e. a biasing means for biasing the door leaf into a predetermined position. Hence, the first alternative of claim I.8 is disclosed in D3 so that the subject-matter of claim I.8 is not novel over D3. There is no disclosure in D3 that the sliding door 500 could withstand a fire for a predetermined time; further, the door leaf 501 is biased into the fully open state and not into the fully closed state as this is necessary for a fire protection door. Hence, there is no disclosure in D3 that the sliding door 500 can be a fire protection door. Further, there is no disclosure for a stepped edge. The subject-matters of claims I.9 and I.10 are novel over D3.

15.1 - True
15.2 - False
15.3 - False
15.4 - True

Question 16

As indicated in [0009] of the description, solid wood contains mainly wood fibres. Hence, the expression “solid wood” already implies a material containing wood fibres. Further, [0009] discloses to water solid wood so that the wood fibres contain enough moisture, and that the moisture is released in case of fire. Hence, [0009] discloses a solid wood that delivers moisture when heated. A combination of all the features of the claims I.1, I.2, I.3, and I.4 can be based on the original claims I.1 to I.4 in combination with [0009] of the description. As indicated in [0017], a stepped door leaf is only possible in pivoting doors. However, a biasing means having a cable and a weight is only disclosed in [0019] and in Fig. 3 in conjunction with a sliding door. Because of the first alternative of claim I.8, a combination of I.1, I.8, and I.10 would also claim a combination of a biasing means having a cable and a weight together with a stepped door leaf. Such combination is not originally disclosed. A door leaf 1a having a stepped edge is disclosed in [0017], and [0018] discloses a door closer 12 biasing the door leaf 1a into the closed position. Hence, a stepped door leaf in combination with a biasing means is disclosed in the description. In

the whole description, it is only disclosed to cover a solid wood plate with a metal material. There is no disclosure to cover any other fibrous plate having other fibres than wood fibres with a metal material. Hence, an amendment of the dependency of claim I.5 to be dependent from claim I.1 instead of claim I.2 would contravene Article 123(2) EPC.

16.1 - True
16.2 - False
16.3 - True
16.4 - False

Question 17

Claim II.1 relates to a door leaf for a fire protection door. From the cited prior art, D1 is the only document which clearly relates to a door leaf for a fire protection door and comprises a plate containing wood fibres wherein major surfaces of the plate are fully covered by metal layers. Hence, D1 relates to door leaves for the same purpose and is the closest prior art with regard to claim II.1. D2 is the only document relating to pivoting doors with a plate of solid wood and a door closer. D2 is the closest prior art with regard to claim II.5. D3 relates to emergency exit doors. D3 discloses in [0003] and in the Figure a sliding door 501 with a door frame 502 and a biasing means 503, 504, wherein the door leaf 501 is made of cardboard, and wherein the major surfaces are covered with an aluminium layer. As indicated in D1, [0003], cardboard comprises wood fibres. The term “especially fire protection door” in claim II.4 is not limiting. D3 implicitly discloses the subject matter of claim II.4. Although the subject-matter of claim II.4 is not novel over D3 and although claim II.7 is dependent from claim II.4, D3 is not the closest prior art with regard to claim II.7, because D3 is directed to a door for another purpose, and D1 and D2 are directed to fire protection doors so that these documents are closer prior art. Claim II.7 is limited to fire protection doors.

17.1 - True
17.2 - True
17.3 - True
17.4 - False

Question 18

Solid wood is resistant to bending [0006], hence, one technical effect of the solid wood is reducing tendency of the door leaf to bend in the event of fire. A further technical effect of the use of a plate made of solid wood is providing heat insulation, see [0007]. While a door closer of a fire protection door ensures that the door is always closed in case of fire, [0002], this is NOT true for a biasing means biasing the door leaf into any predetermined position, see for example D3 and note that claim II.3 does not specify that the door is a fire protection door. The aluminium layer protects from drying out, see above, hence, it helps to keep the moisture in the wood fibres. This is a combined technical effect.

18.1 - True
18.2 - True
18.3 - False
18.4 - False

Question 19

In the last sentence of [0003] of D1 it is mentioned that the construction of the fire protection door of D1 is complicated because of the necessity to insert a frame structure for stiffening. Solid wood has less tendency to bend, a frame structure is not necessary. Hence, it is an element of the objective problem solved by the subject-matter of claim II.2 over D1 to simplify the construction. Providing a plate of solid wood per se does not provide a fire protection door simulating the same appearance as an ancient door, especially if covered by an aluminium layer. Hence, providing fire protection doors simulating the same appearance as ancient doors is not an element of the objective technical problem solved by the subject-matter of claim II.2. The state of art for the purposes of considering inventive step is defined in Article 54(2) EPC, both documents D1 and D2 clearly belong to this state of art, and the skilled person is presumed to have had access to anything in the “state of art”. Although D2 is a vintage art journal, it describes door technology. Further, the skilled person is expected to look for suggestions in neighbouring and general technical fields. Hence, the nature of publication of the documents D1 and D2 is no valid argument against combining them. D1 discloses a fire protection door, and the skilled person learns from D2 that a solid wood door can protect from fire. Thus, the skilled person learns from D2 that a solid wood plate is a suitable material to be used in door leafs for fire protection doors. This is a valid argument that a skilled person would combine D1 and D2.

19.1 - True
19.2 - False
19.3 - False
19.4 - True

Question 20

D3 discloses a sliding door 500 with a door leaf 501 where the major surfaces thereof can be covered with aluminium layers. No technical reason is given for the covering with aluminium and it seems that this is only for design purposes. Further D3 relates to emergency exit doors and gives no indication at all for a functionality for fire protection. Thus, although D3 discloses a door covered by an aluminium layer, there is no teaching in D3 that this could improve a fire protection function. D1 discloses a calcium silicate plate wherein calcium silicate can release water when heated. The filling of D1 is a cardboard containing calcium silicate, no alternatives are given. The statement 20.2 indicates that the material of D2 should replace the material of D1. This is not a valid argument within the framework of the problem solution approach, since D2 and not D1 is the closest prior art document. Hence, the answer to 20.2 is “False”. The formulation of 20.2 was however unnecessarily complex. Just by using the expression “D2 could be replaced by” instead of “D2 could replace” the solution would become “True”, since there is no teaching that solid wood could be replaced by the material of D1. For this reason, it is exceptionally decided to award marks for the answer “True” as well. D1 discloses just a door leaf for a fire protection door which is formed from two metal sheets that overlap at the side of the door leaf. There is no teaching how a door frame could be constructed. Hence, although the figure of D1 shows a small step on the side of the door leaf due to a overlap of metal sheets, this step is only because two edge portions of the metal sheets overlap; there is no teaching to combine a step in a door with a step in a door frame to come to a better sealed

door gap. D1 discloses in [0002] that the preferred metal is steel because of its high melting point above 1300°C, and it is further mentioned that this has the advantage that the metal of the door can withstand normal temperatures occurring during fire and maintains its stiffness even at higher temperatures. This leads away from using aluminium which melts away in the event of fire. Hence, D1 teaches away from using aluminium in fire protection doors.

20.1 - True
20.2 – See above
20.3 - True
20.4 - True