

Question 1

Is claim 1 of EP-1 in conformity with Article 84 EPC?

Select all correct statements from this list:

- No, the category is obscure.
- No, at least one term is unclear.
- No, it is formulated as a result to be achieved.
- No, at least one essential feature is missing. (the acid must be a strong acid)
- Yes, it is in conformity with Article 84 EPC.

Question 2

Is claim 4 of EP-1 in conformity with Article 84 EPC?

Select all correct statements from this list:

- No, it uses at least one unknown exotic parameter.
- No, at least one term is unclear.
- No, it is formulated as a result to be achieved.
- No, at least one essential feature is missing.
- Yes, it is in conformity with Article 84 EPC.

Question 3

What is the category of claim 4 of EP-1?

- Physical entity
- Activity

Is claim 4 of EP-1 an independent claim?

- Yes
- No

Question 4

Is the subject-matter of each of claims 1, 2 and 3 of EP-1 novel over each of D1, D2 and D3 (Articles 52 and 54 EPC)?

Select the box if the claim is novel over the document.

	D1	D2	D3
Claim 1	Novel	Novel	Not novel
Claim 2	Novel	Novel	Not novel
Claim 3	Novel	Novel	Not novel

Claims 1-3 novel over D1 because D1 does not show acid treatment.

Claims 1-3 novel over D2 because D2 does not show polymeric coating step.

D3 shows all features of claims 1-3.

Question 5

	Yes	No
Is the subject matter of claim 4 of EP-1 novel over D1 (Articles 52 and 54 EPC)?	X	
Is the subject matter of claim 4 of EP-1 novel over D2 (Articles 52 and 54 EPC)?	X	
Is the subject matter of claim 4 of EP-1 novel over D3 (Articles 52 and 54 EPC)?		X

Hand plane of D1 has no visible enhanced surface quality/marks from the acid treatment (see in D2).

D2 does not show a hand plane.

The process of claim 2 of D3 would result in a hand plane having the same features as the hand plane of claim 4, so a hand plane having the marks from the acid treatment and polymeric coating is implicitly disclosed.

Question 6

	Yes	No
Is the subject matter of claim 5 of EP-1 novel over D1 (Articles 52 and 54 EPC)?	X	
Is the subject matter of claim 5 of EP-1 novel over D2 (Articles 52 and 54 EPC)?	X	
Is the subject matter of claim 5 of EP-1 novel over D3 (Articles 52 and 54 EPC)?	X	

Claim 5 is novel over D1 and D2 by virtue of being dependent on claim 1.

Claim 5 is novel over D3 because D3 does not disclose acid treatment at increased pressure of above 2 bars.

Question 7

Is priority from DK-1 validly claimed across the full claim scope in respect of:

	Yes	No
Claim 1 of EP-1?	X	
Claim 2 of EP-1?	X	
Claim 3 of EP-1?	X	
Claim 4 of EP-1?	X	
Claim 5 of EP-1?		X

Claim 1 of EP-1 is identical to claim 1 of DK-1.

For claim 2, it is noted that the description consistently refers to metallic hand plane body. It may be overformal to take this as priority-destroying. There is no technical reason why the teaching of the description should not be applicable to a metallic surface as disclosed in claim 1 of DK-1. There is no technical reason why the form of the object with the metallic surface should be important. The teaching of claim 2 can be derived from DK-1.

Claims 3 and 4 are limited to metallic hand plane bodies and are derivable from DK-1.

Claim 5 covers a treatment time and minimal temperature that is only described in DK-1 for treatment with HCl.

Question 8

Is the subject matter of each of claims 1 and 2 of D3 novel over each of D1 and D2 (Articles 52 and 54 EPC)?

Select the box if the claim is novel over the document.

	D1	D2
Claim 1 of D3	X	
Claim 2 of D3	X	X

D1 does not teach an acid treatment.

D2 does describe the treatment of claim 1 of D3; claim 2 of D3 requires a polymeric coating not being disclosed in D2 and hand tools for woodworking not being disclosed in D2.

Question 9

Is it possible to amend the claims of EP-1 at this point in time, i.e. before the EPO draws up the European search report?

Yes

No (Rule 137(1) EPC)

Question 10

Is the subject-matter of each of amended claims 1, 2, 3 and 4 of EP-1 novel over each of D2 and D3 (Articles 52 and 54 EPC)?

Select the box if the claim is novel over the document.

	D2	D3
Amended claim 1	X	X
Amended claim 2	X	X
Amended claim 3	X	X
Amended claim 4	X	X

D2 does not teach polymeric coating.

D3 only teaches treatment with HCl. The list of acids in claim 1 does not contain HCl.

Question 11

Is the subject-matter of amended claim 5 of EP-1 novel over each of D1, D2 and D3 (Articles 52 and 54 EPC)?

	True	False
Amended claim 5 is novel over D1	X	
Amended claim 5 is novel over D2	X	
Amended claim 5 is novel over D3		X

Claim 5 is novel over D1 (no acid treatment in D1 and thus no marks resulting from it), Claim 5 is novel over D2 (no hand planes in D2).

Claim 5 is not novel over D3, because the surface marks from a strong acid would be the same (see D2, treatments by all strong acids result in exactly the same marks), and polymeric coating too, so the resulting product is the same.

Question 12

Are amended claims 1, 2 and 3 in conformity with Article 123(2) EPC?

	Yes	No
Amended claim 1	X	
Amended claim 2		X
Amended claim 3	X	

Claim 1 was amended by including the list of acids, based on the fourth paragraph of the description, with one alternative (HCl) deleted from the list. This is in line with Art. 123(2) EPC (one list selection).

The features of amended claim 2 were described in the penultimate paragraph of the description, only in combination with HCl. It is indicated that this is a specific combination, and there is no basis for deletion of HCl from the combination.

It might be considered to arrive at the subject-matter of the amended claim 2 by combining the original claims 1 and 5, adding the list of acids (as explained for claim 1, this would be in line with Art. 123(2) EPC), and deleting the elevated pressure. However, we do not see any good basis for deletion of the elevated pressure from the combination with any other acid than HCl.

The feature of claim 3 was disclosed as independent of any other features in the last paragraph of the description, so that is in line with Art. 123(2) EPC.

Question 13

Drag and drop the correct response.

Assuming D1 is the closest prior art, the objective technical problem of amended claim 1 of EP-1 can best be formulated as:

- Reducing friction between a metallic hand plane and the wooden workpiece (D1 also provides reduced friction)
- Providing a longer-lasting reduction in friction between a metallic hand plane and the wooden workpiece
- Providing a suitable process of acid treatment to enhance a polymeric coating adhesion to the hand plane body (this is not an objective problem, contains pointers to the invention)

Assuming again that D1 is the closest prior art, which documents can formally be used in combination with D1 to argue the lack of inventive step of the subject-matter of amended claim 1 of EP-1, irrespective of the chance of actually proving obviousness?

Select the correct documents, if any:

- D2
- D3 (D3 is an Art. 54(3) EPC prior art, cannot be used for assessment of inventive step)

Question 14

What would be valid arguments as to low or no relevance of D2 when discussing inventive step of the subject-matter of amended claim 1 of EP-1 with D1 as closest prior art?

Select all correct statements from this list:

- D2 is not a patent application publication.
- D2 does not mention coating metallic objects with polymeric materials such as PTFE.
- D2 only mentions coating jewellery. This technical area is very remote from coating woodworking hand tools let alone metallic hand plane bodies.
- D2 gives absolutely no indication of any technical effect of strong acid treatments of a metallic surface.

Note: For the second ticked option (the third option in the list), we note that claim 1 is not limited to woodworking hand tools or to metallic hand plane bodies, but coating the metallic hand plane bodies is the context of the Application, so this option could in our view constitute a valid argument.

Question 15

You see today in EPO online file inspection for D3 that amended claims were filed by Mr Artisan during substantive examination as follows:

D3 amended claims:

1. A process for treating the body of a metallic hand plane before spray coating a polymeric coating onto the surface of the hand plane body characterised in that the metallic surface is brought into contact with hydrochloric acid (HCl) or another strong acid for a determined period of time.
2. The process of claim 1, further characterised in that the acid is hydrochloric acid (HCl).
3. A metallic hand plane body obtainable by the process of claim 2.

Drag and drop all correct statements regarding the amended claims of D3 from the list below:

- The subject-matter of claim 1 is novel over D2. (no polymeric coating in D2, no hand plane in D2).
- Claim 1 is in conformity with Article 123(2) EPC. (no other strong acid than HCl disclosed in D3, so “another strong acid” goes beyond the disclosure as filed)
- Claim 2 is in conformity with Article 123(2) EPC.

	True	False
Claim 3 of D3, if granted and validated in Europe, will constitute a risk of infringement for the business of company X when selling hand planes in Europe that have bodies produced according to the process of amended claim 1 of EP-1. (Marks left by the acid treatment are the same from any strong acid.)	X	
If EP-1 is granted with the amended claim 1, company X has the right to manufacture and market hand planes in Europe that have bodies produced according to the process of amended claim 1 of EP-1.		X