

EPI WEBINAR

Mock e-EQE Paper C

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Overview

PART I What to be considered when answering Paper C

- Priority and added subject-matter
- Novelty
 - Generic disclosure and specific examples
 - Selection inventions
- Inventive step:
Problem-solution approach

PART II EQE Mock 2 – 2017 Paper C

What to do and not to do

Priority and added subject-matter / 1

- **Priority and added subject-matter** issues quite often pop-up in the Paper C

As those issues have an impact on the way the patent is to be opposed, they have to be properly dealt with
- **Priority and Article 123 EPC should be dealt with separately!**
 - If something is added to the European patent application when compared to the priority document, but is **in** the EP application **as filed**, then there is a problem with the priority, *but not* with Article 123 EPC
 - Art. 123 (2) EPC relates as well to the claims as to the description
 - A disclosure test (GL H IV 2.1; G2/10) should be applied in order to verify if the amendment complies with Art. 123 EPC
 - Art. 123 EPC relates to alterations, deletions or additions

Priority and added subject-matter / 2

- Suppose the description and the claim relates to a **bottle**.
Changing into “a recipient” would be an *alteration* contrary to Art. 123 (2) EPC
- Suppose the description and the claim relates to a **plastic bottle**.
Deletion of “plastic” would be a *deletion* contrary to Art. 123 (2) EPC
- Suppose the description and the claim relates to a **plastic bottle**.
Addition of “or glass” would be an *addition* contrary to Art. 123 (2) EPC

Priority and added subject-matter / 3

Example

- The invention relates to a recipient for vegetables, wherein the recipient has a bottom profile enabling an air circulation so as to maintain the vegetables fresh
- The description mentions plastic or cardboard as the material for the recipient. Unfortunately, the claim only mentions cardboard
- Adding, during prosecution, “or plastic” to the claim would not violate Art. 123 (2) EPC
- Deleting “cardboard” from the claim would also violate Art. 123 (2) EPC

Priority and added subject-matter / 4

Changing the dependency of a claim could also lead to a violation of Art. 123 (2) EPC

EXAMPLE

- Claim 2 and claim 3 are dependent from claim 1 only. Changing the
- dependency of claim 3 into “ 1 **or 2**” could violate Art. 123 (2) EPC
- i.e. is the subject-matter of claims 1+2+3 as such disclosed in the patent application as originally filed?

Priority and added subject-matter / 5

The content of the abstract cannot form a basis for supporting an amendment (Art. 85 EPC)

In verifying whether or not the priority is valid it should be verified that:

- The applicant is the same, or its successor in title; **and**
- The same invention is claimed; **and**
- The twelve months period was respected; **and**
- the filing was a first filing

Priority and added subject-matter / 6

“Intermediate generalisation”

A feature cannot be extracted from its context with other features

EXAMPLE

- The description mentions electrical heating means for heating an oven
- Introducing only “heating means” in the claim would be an intermediate generalisation as there is no support in the description for heating means other than “electrical”

Novelty / 1

Lack of novelty as a ground for opposition

GL Part G VI 2

A document takes away the novelty of any claimed subject-matter derivable **directly and unambiguously from that document** including any features implicit to a person skilled in the art in what is expressly mentioned in that document

Novelty / 2

- **“A document” = a SINGLE document!**

Generally it is not allowed to combine in a novelty attack documents when dealing with novelty. The sole exception is when the considered document explicitly refers to an other document. Generally it is not allowed to combine in a novelty attack documents when dealing with novelty. The sole exception is when the considered document explicitly refers to an other document

- **“directly and unambiguously”**

This signifies that, if the prior art document and the claim under attack do not use the same word, it has to be explained that the word in the prior art document has the same meaning as the one used in the claim under attack. This is for example done by using an explanation of that word given either in the patent under attack or in the given prior art documents

Novelty / 3

Example

- Claim 1 uses the words “**closed envelope**”
- The prior art document uses the words “**pouch**”, but in another prior art document, it is stated that “**a pouch is a closed envelope**”
- In a novelty attack, a reference to that other prior art document has to be made, in order to explain that the pouch of the prior art document has the same meaning as the closed envelope of the claim under attack

Novelty / 4

Generic disclosure and specific examples – GL Part G VI 5

A generic disclosure does not usually take away the novelty of any specific example falling within the terms of that disclosure, but that specific disclosure does take away the novelty of a generic claim embracing that disclosure

- For example, copper takes away the novelty of a metal, but not the novelty of any metal other than copper
- Rivets takes the novelty away of fastening means, but not the novelty of any fastening other than rivets

Novelty / 5

Selection inventions – GL Part G VI 8

A selection from a single list of specifically disclosed elements does not confer novelty. However, if a selection from two or more lists of a certain length has to be made in order to arrive at a specific combination of features then the resulting combination of features, not specifically disclosed in the prior art, confers novelty, the “two-lists principle”.

Novelty / 6

Sub-ranges (T261/15 and T279/89)

A sub-range selected from a broader numerical range of the prior art is considered novel if **both** of the following two criteria are satisfied:

- (a) The selected sub-range is narrow compared to the known range
- (b) The selected sub-range is sufficiently far removed from any specific examples disclosed in the prior art and from the end-points of the known range

Inventive step / 1

Problem-solution approach – GL Part G VII

- (i) Determining the “closest prior art”
- (ii) Establishing the “objective technical problem” to be solved
- (iii) Considering whether or not the claimed invention, starting from the closest prior art and the objective problem, would have been obvious to the skilled person

Inventive step / 2

Determining the “closest prior art”

- That which in one **single** reference discloses the combination of features which constitutes the most promising starting point for a development leading to the invention
- In selecting the closest prior art, the first consideration is that it must be directed to a **similar purpose or effect as the invention** or at least belong to the **same or a closely related technical field as the claimed invention**.
- In practice, the closest prior art is generally that which corresponds to a **similar use and requires the minimum of structural and functional modifications** to arrive to the claimed invention (T606/89)

Inventive step / 3

How to find the “closest prior art” / 1

(i) Look for distinct features in the claim to be attacked

EXAMPLES:

- The claim relates to a “reusable” device, a prior art document relating to a device that has to be disposed after use, is probably not the closest prior art
- The claim relates to a “washing **powder**”, a prior art relating to a washing **gel**, is probably not the closest prior art

Inventive step / 4

- The claim relates to a “*device for*”, although this has no limiting effect, it indicates the purpose, and so a prior art dealing with the same purpose is probably the closest prior art
- When the dependent claim is restricted to a particular embodiment, the prior art dealing with a same particular embodiment is probably the closest prior art

Inventive step / 5

- (ii) When the prior art document “teaches away” from the subject-matter to which the invention relates, and the invention teaches or discloses what the prior art has effectively “taught away”, it will be rather difficult to argue that there is a lack of inventive step, and so this prior art document is probably not the closest one

- (iii) If the claim to be attacked is not entitled to the earliest priority or has no priority, prior art documents which have been published after the earliest priority date should be looked at more closely

Inventive step / 6

Establishing the “objective technical problem” to be solved

- Look for the difference(s) or distinguishing feature(s), either technical or functional, between the claimed invention and the closest prior art, identify the technical effect resulting from the distinguishing features, and then formulate the technical problem
- Bear in mind that non-technical features do not contribute to an inventive step as they do not solve a technical problem
- The technical problem means the aim and task of modifying or adapting the closest prior art
- The technical effect of a feature should generally be looked for in the patent to be opposed. So look for advantages, technical results, obtained improvements and solutions to technical problems given in the description of the patent to be opposed

Inventive step /7

Considering whether or not the claimed invention, starting from the closest prior art and the objective problem, would have been obvious to the skilled person

Could-would approach (GL Part G VII 5.3)

The point is not whether the skilled person could have arrived at the invention by adapting or modifying the closest prior art, but whether he or she would have done so because the prior art **incited** him or her to do so in the expectation of some improvement or advantage

Inventive step /8

Considering whether or not the claimed invention, starting from the closest prior art and the objective problem, would have been obvious to the skilled person (continued)

- Look in the prior art where you can find the solution for the objective technical problem you identified
- The prior art document teaching the solution to that problem, is the one with which the closest prior art should be combined
- Indication that something is well known by a skilled person are often indication that it concerns common general knowledge

Inventive step / 9

Considering whether or not the claimed invention, starting from the closest prior art and the objective problem, would have been obvious to the skilled person (continued)

- Bear in mind that common general knowledge is sometimes present in a prior art document which is published too late, but refers to the past
- Wording like “it has been known for more than twenty years, or is applied for a long time” indicates common general knowledge
- Note that for using common general knowledge, you need a basis in the prior art

Inventive step / 10

Relative terms

When the claim comprises a relative term, such as, for example “warm”, “high”, “poor”, etc., have a look to the description to determine how to define this relative term and use this definition when attacking the claim

Bear in mind that a lack of clarity is NOT an opposition ground

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The opponent's letter

- “... file an opposition on behalf of Tirez Cie ...”
 - This signifies that “**Tirez Cie**” is the opponent in which name the opposition has to be filed
 - The address of the opponent is on top of the opponent's letter

- “Annex 1 (= the patent to be opposed) claims priority of **two** EP applications”
 - The first one **consisted** of claims 1-4 and paragraphs 0001 to 0014 and the figures of Annex 1
 - This signifies that claim 1-4 **a priori** are entitled to the priority date of the first EP application

2017 Paper C

The opponent's letter (continued)

“The subject-matter of claims 5-7 of Annex 1 is **identical** to claims 12-14 of the **second** EP application and the content of paragraphs 0015 to 0018 of Annex 1 can be found in the **second**_application”

- This signifies that claims 5-7 **a priori** are entitled to the priority date of the second EP application The address of the opponent is on top of the opponent's letter
- **Note that** for the claims 1-4 the word “**consisted**” is used, whereas for the claims 5-7 the word “**identical**” was used
This indicates that there might be a different situation
- The word “identical” implies that it is the same invention. So, if the second application was filed within the priority year of the first one and the applicant is the same, claims 5-7 are entitled to the **second** priority date and their effective date is the one of the **second** application

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The opponent's letter (continued)

- “Claim 3 in Annex 1 as **originally filed only** depended on claim 1. **During examination**, the dependency was changed. **No other** amendments were carried out”
 - “During examination”, i.e. after filing, so you need to verify if in the application as filed there is support for this amendment
 - Claim 3 of Annex 1 is dependent from claim 1 **or 2**.
→ So, you have to verify if the subject matter of the claims **1+2+3** was disclosed in Annex 1 as filed
- “**No other** amendments were carried out”
 - This signifies that only claim 3, when dependent from claim 2, has a problem of added subject-matter and that you do not have to look for other added subject-matter problems

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The opponent's letter (continued)

“No fees were paid and these previous applications are deemed withdrawn”

- The payment of a fee is not required to obtain a filing date
- Article 87 (3) EPC mentions that a regular filing shall mean any filing that is sufficient to establish the date on which the application was filed, **whatever the outcome of the application may be**

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Annex 1

- Annex 1 discloses two separate embodiments

Paragraphs 0006-0012 of Annex 1 disclose a **first** embodiment of the cork removing device (pull-type) and paragraphs 0012 and 0014 of Annex 1 disclose a **second** embodiment of the device (lever-type with side arms)

- § 0008 discloses polyethylene as a material for the housing, but this § is **limited** to the **first** embodiment!
- § 0013 discloses that the toothed side arms are coupled to a **metal** housing.

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Annex 1 (continued)

- § 0014 discloses that the metal housing provides the **necessary structural support** for the side arms

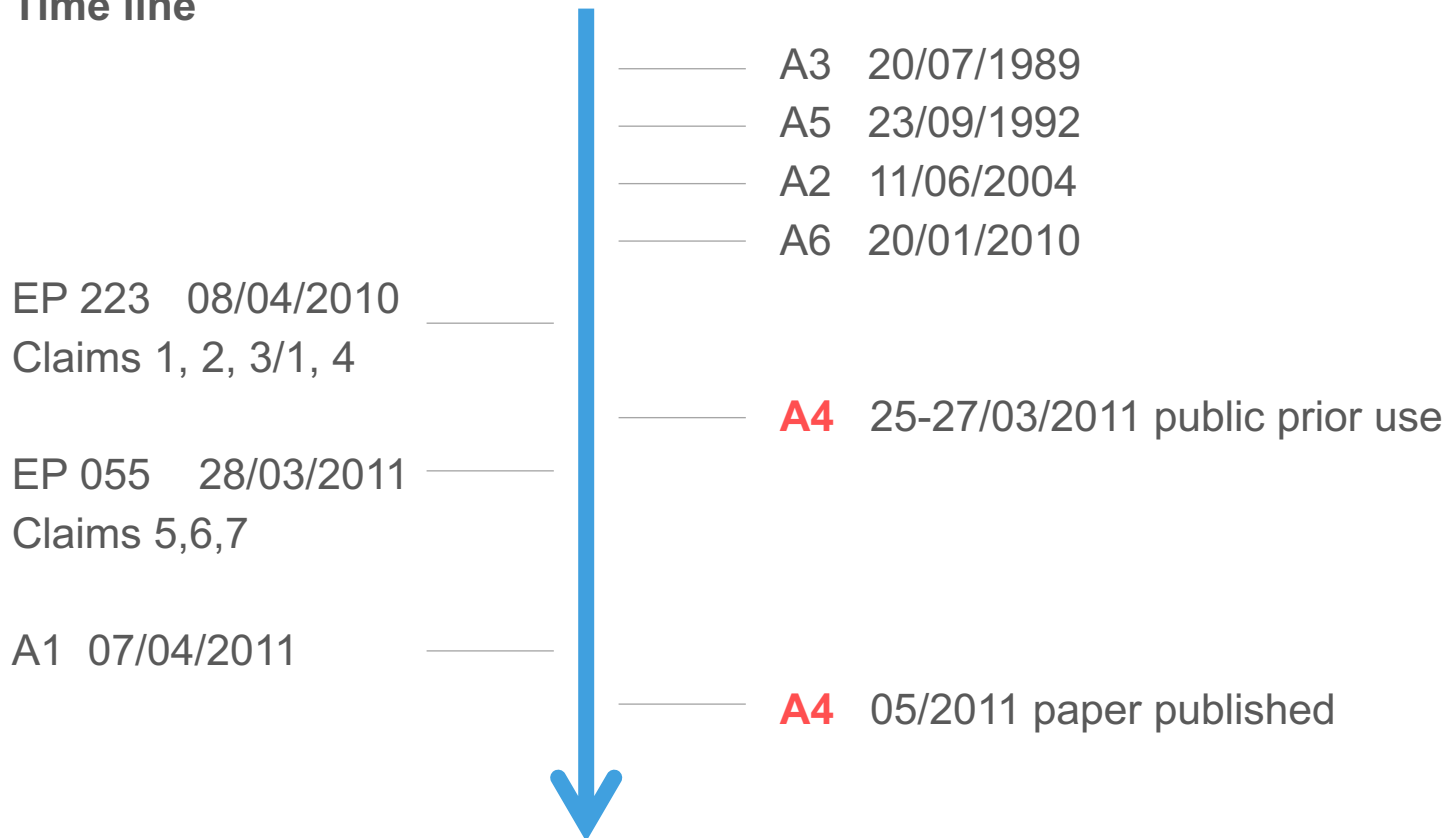
There is no disclosure or indication in Annex 1 that polyethylene would provide this **necessary structural support** to the housing

Therefore there is no support for the second embodiment with a polyethylene housing and claim 3, when dependent from claim 2, has to be objected under Article 100(c) EPC

- Claim 3, when dependent of claim 2, has no effective date

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Time line



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Prior art

- A2, A3, A5 and A6 is prior art according to Article 54(2) EPC for all the claims
- **A4** was published after the filing date of A1, but is evidence of a **public prior use** after the first priority date but before the second priority date GL G-IV 7.2

The date on which the prior use took place? March 25-27, 2011, i.e. before the second priority date

What has been used? Mr. Rolha showed a corkscrew with a polyfluorocarbon coating

Under what circumstances? The corkscrew was sold.

So the prior use in Oporto is a public prior use

2017 Paper C – Part 1

Claim 5

- A cork extraction element comprising a straight portion having an attached disc and a spiral portion having a friction-reducing coating
- Claim 5 is an **independent** claim and remember that it is **only entitled to the second priority (effective date 28/03/2011)**
- As the content of A4 was made publicly available at the fair in Oporto, i.e. **before the second priority date**, there is a good reason that the public prior use described in A4 is the prior art to be considered first

2017 Paper C – Part 1

Claim 5 (continued)

- The corkscrew of the prior use (A4) comprises a cork-engaging element having a straight portion, an attached disc and a spiral portion as can be seen in the photo, i.e. it could be seen by the public attending the fair
- According to the prior use (A4 lines 43-44) the cork-screw comprises a polyfluorocarbon coating, which is known as having friction-reducing properties (A2 § 0006)
- The chemical composition of a product is state of the art when the product as such is available to the public and can be analysed and reproduced by a skilled person, irrespective of whether or not particular reasons can be identified for analysing the composition (GL G-IV 7.2.1)
- **Claim 5 lacks novelty over the public prior use in Oporto**

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Claim 6

- Claim 6 **adds** to claim 5 that the coating is Polybacchus
- The cork sold at Oporto is still the closest prior art for the same reasons as set out for claim 5 and claim 6 and distinguishes over A4 by the coating being Polybacchus
- The effect - reducing the friction between synthetic corks and the extraction element - of this coating is given in A1 § 0017 and 0018
- The objective technical problem is how to avoid pushing synthetic corks into the bottle due to excessive downward pressure (A1 § 0017)

2017 Paper C – Part 1

Claim 6 (continued)

- A2 relates to a spiral-shaped cork extraction element (§ 0008) having a friction reduction layer (§ 0005) allowing a smoother insertion in a synthetic cork. Polybacchus is disclosed in § 0006 of A2 as a coating material
- The prior use (A4) discloses a polyfluorocarbon coating in lines 43-44, so it would have been obvious for a skilled person to choose Polybacchus
- **Claim 6 is not inventive in view of the prior use + A2**

2017 Paper C – Part 1

Claim 7

- Claim 7 **adds** to claim 6 that the coating extends over a third to at most two-thirds of the spiral portion starting from the extraction tip
- Again the cork-screw sold at Oporto is the closest prior art
- Claim 7 distinguish over the closest prior art by the combined features of claim 6 and 7
- The effect of the distinguishing features is that a compromise is obtained between the reduction of the friction between the synthetic cork, the extraction element and the cost (A1 § 0017 and 0018)

2017 Paper C – Part 1

Claim 7 (continued)

- The objective technical problem is how to avoid pushing synthetic corks into the bottle due to excessive downward pressure at a lower cost
- A2 discloses Polybacchus, as already mentioned for claim 6
 - A2 (claim 3) further discloses that the lower half of the spiral piercing element is coated and
 - § 0005 of A2 further discloses that this properties are achieved by only coating the tip and the lower half of the extraction element

This extent of coating falls within the range of one to two thirds

2017 Paper C – Part 1

Claim 7 (continued)

- The skilled person would thus be motivated by A2 to coat the cork extraction element sold in Oporto over a third to at the most two-thirds of the spiral portion
- **Claim 7 is thus not inventive in view of prior use + A2**

2017 Paper C – Part 2

Claim 1

A device for removing corks comprising:

- a housing (1) providing an enclosed chamber having a generally cylindrical shape; and

- a rotatable cork extraction element (2),

wherein the rotatable cork extraction element (2) comprises at least a straight portion (2a) having a handle (3) attached to it and a spiral cork engaging portion (2b) and wherein the spiral cork-engaging portion (2b) has at least two different pitch sizes (α_1 , α_2).

2017 Paper C – Part 2

Claim 1 (continued)

None of the prior art documents destroys the **novelty** of claim 1!

- **A2** has no cork extraction element (2) comprising at least a straight portion (2a) having a handle (3)
- **A3** has no housing (1) providing an enclosed chamber having a generally **cylindrical** shape and no rotatable cork extraction element
- **A4** is not prior art for claim 1
- **A5** has no spiral cork-engaging portion (2b) having at least two different pitch sizes (α_1 , α_2) but no enclosed chamber

2017 Paper C – Part 2

Claim 1 (continued)

- **A6** has no spiral cork-engaging portion (2b) having at least two different pitch sizes (α_1 , α_2)

→ **A6 is the closest prior art** because it discloses a corkscrew (title) having an enclosed housing and a rotatable cork extraction element

2017 Paper C – Part 2

Claim 1 (continued)

- **A2** is **not** the closest prior art because it has no helical part, straight part and handle
Starting from A2 it will be very difficult to argue that it is obvious to substitute the spiral piercing element with one having a helical part, straight part and handle as this has no sense for a pneumatic opener
- **A3** is **not** the closest prior art because it does not disclose a rotatable cork extraction element
Moreover, as A3 teaches, in § 0006, that the movement of the central element is only a translational one requiring a square cross-section of the central element, it will be difficult to argue that it is obvious to change translational movement to a rotational movement
- **A5** is **not** the closest prior art because it has no enclosed chamber and no different pitch sizes, which means more differences than A6

2017 Paper C – Part 2

Claim 1 (continued)

- **A6** discloses a corkscrew (title) which is a device for removing corks (A1, 0002 line 6)
 - A6 also discloses in 0005 a structure forming an enclosed chamber (line 11), in 0006 or in its figure a structure that has a cylindrical shape
 - The central element of A6 is rotatable (0009) and comprises a helical part, a straight part and a handle (0004, figure or claim 1); the helical part of A6 is a spiral part (see A1 § 0002 line 8)
 - The central element is a cork extraction element according to A6 § 0009
- The subject-matter of claim 1 **differs** from A6 in that the spiral portion has two different pitch sizes
- The effect is to provide a higher cork stability during removal and to avoid breakage (A1 § 0010 and 0011)

2017 Paper C – Part 2

Claim 1 (continued)

- The **objective technical problem** is how to avoid cork breakage
- A2 also relates to a cork extraction device (A2 § 0001), which may be used to pull out the cork from a bottle (A2 § 0008 or 0009) and discloses:
 - A spiral hollow element that is inserted into the cork (A2 § 0008 or 0009, or claim 2)
 - In §0009 that in order to avoid breaking the cork, the piercing element has **fewer turns in its upper half**
 - If there are fewer turns, then the distance between two adjacent turns is larger
 - The distance between two adjacent turns is the pitch (A1 §0010 line 21).
- Hence, A2 discloses a spiral cork engaging element having two different pitch sizes thereby avoiding cork breaking

2017 Paper C – Part 2

Claim 1 (continued)

- Hence, A2 discloses a spiral cork engaging element having two different pitch sizes thereby avoiding cork breaking
- The skilled person thus obtains from A2 a teaching to provide two different pitch sizes in order to solve a problem of cork breaking
- **Therefore, claim 1 lacks an inventive step over the combination A6 + A2**

2017 Paper C – Part 2

Claim 2

- The device according to claim 1 further comprising two toothed side arms (6) coupled to the housing (1) and wherein the straight portion (2a) comprises ridges (4) that engage the side arms (6)
- Although claim 2 depends from claim 1, it is clearly **limited to the second embodiment** (Figure 3a and b), whereas claim 1 covers both embodiments!
- The mere fact that claim 2 is limited to the second embodiment is already an indication that it might be of interest to verify if A6 is still the closest prior art, particularly as A6 does not disclose two toothed side arms and uses a spring for helping the removal of the cork

2017 Paper C – Part 2

Claim 2 (continued)

- **A5** is the closest prior art, because it is the only prior art document disclosing a lever-type cork removing device which comprises a rotatable cork extraction element (A5 § 0005)
- A3 has lever arms, but has no rotatable cork extraction element, since it has a translational movement
- As you now start from A5 and as claim 2 depends on claim 1, your analysis has to cover the features from both Claim 1 and 2

2017 Paper C – Part 2

Claim 2 (continued)

- A5 discloses in § 0001 a bottle opener having a foldable cork-engaging section which is used to remove corks, so it is a device for removing corks
- A5 discloses in § 0005 a rotatable cork engaging element (the user turns)
- The cork engaging element has a helical shaped section, a ridged straight section and a handle (A5 § 0003)
- According to A1 § 0002, a helical section is a spiral section
- A5 § 0005 discloses that the ridges engage two toothed side arms (§ 0005)
- A5 discloses in § 0003 the possibility of having a supporting element comprising at least two ribs

2017 Paper C – Part 2

Claim 2 (continued)

- The subject-matter of claim 2 differs from A5 in that:
 - a) The spiral portion has two different pitch sizes
 - b) The housing provides an enclosed cylindrical chamber
- The effect of feature **a)** is to provide a higher cork stability during removal and avoids cork breakage (A1 § 0010)
- The objective technical problem of feature a) is to avoid cork breakage
- The effect of feature **b)** is to protect the user from trapping a finger (A1 § 0007)
- The objective technical problem of feature a) is to provide a safer device

2017 Paper C – Part 2

Claim 2 (continued)

- The two differences do not mutually influence each other and have no synergistic effect as they solve different problems, so they can be treated separately as **partial problems** (GL G-VII, 5.2 or 6)
- Feature a) has been dealt with for claim 1 and thus the same arguments apply

2017 Paper C – Part 2

Claim 2 (continued)

- A6 deals with a cork removal device (§ 0003) and has a spiral cork engaging element (helical part 2, § 0004, in combination with A1 § 0002).
- A6 discloses a structure formed from metal ribs covered with plastic material in order to form an enclosed chamber (§ 0005).
- The preferred shape of the housing is cylindrical (§ 0006); the same paragraph discloses that this structure minimises the risk of injury, so it provides a safer device and thus solves the objective problem

It is thus obvious for a skilled person to include the enclosed chamber of A6 in the device of A5

2017 Paper C – Part 2

Claim 3/1

- Claim 3 adds to claim 1 that the housing is made of polyethylene
- A6 is the closest prior art for the same reason as set out for claim 1.
- A6 discloses a housing made of polyethylene in § 0005 and there is thus no additional new feature which could render the already non-inventive claim 1 inventive

2017 Paper C – Part 2

Claim 4

- Claim 4 adds to claim 1 that the handle is in the shape of a flower
- A6 is the closest prior art for the same reasons as set out in claim 1
- According to A1 § 0012 a flower shape implies a multiple lobed handle

- The subject-matter of claim 4 differs from A6 in that:
 - a) The spiral portion has two different pitch sizes
 - b) The flower shaped handle

- As these two features are independent of one another and have no synergistic effect, they will thus be treated as partial problems

2017 Paper C – Part 2

Claim 4 (continued)

- The effect of feature a) as been dealt with in claim 1, so the same arguments for lack of inventive step apply

- The flower shaped handle (feature b) has (see A1 § 0012):
 - An aesthetical effect, which is non-technical, and cannot provide a solution to a technical problem
 - A technical effect as it provides a more ergonomically adapted handle and whereas the plurality of lobes provide a better grip

2017 Paper C – Part 2

Claim 4 (continued)

- A3 discloses a cork removing device (§ 0004) with a clover-shaped handle, i.e. a handle comprising three or four lobes offering a better grip (§ 0009).
A1 § 0012 mentions that a flower has a plurality of lobes
- A6 discloses (§ 0007) that the handle may be of any shape
- The skilled person would therefore be prompted to modify the handle of the A6 device by the multiple-lobed handle of A3 in order to provide a better grip
- **Claim 4 is thus not inventive over A6 in combination with A2 and A3**

TO DO / 1

- Read accurately the client's letter and use the information given by the client
- Distinguish independent from dependent claims and deal consequently with them
- Analyse each claim in order to verify the effective date of that claim
- Deal with added subject-matter, if any
- Take time to read and understand each claim and look for pointers in the claim
- Take time to read the granted patent and the prior art and look for pointers in the granted patent as well as in the prior art

TO DO / 2

- Remain calm
- If you attack an independent claim based on Article 100(a) EPC, check first for lack of novelty, if any
- Use the problem-solution approach when you attack on lack of inventive step
- Properly organise the prior art, in particular according to their publication dates
- Verify, in each prior art patent document, the name of the applicant/proprietor of the patent/patent application in order to verify if it is not the same as the one of the patent under attack

NOT TO DO / 1

- Take insufficient time for reading
- Make an inappropriate novelty attack
- Not use problem-solution approach
- Mix priority and added-subject matter
- Use a prior art document which cannot be used, for example because it is too late, but keep attention to the content of that document as it might contain relevant information, for example relating to common general knowledge

NOT TO DO / 2

- Ignore information given in the client's letter
- Use your own knowledge of the technical field of the invention
- Get nervous

Thank you
for your attention!