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# Abstracts of decisions

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### **Case Law of the Boards of Appeal, 10<sup>th</sup> edition (update 2024) – references in issue 7/2024 and following**

In the table summarising the decision data for an abstract, the links to the CLB, 10th edition, lead to the [HTML version](#), which was updated in June 2024. In the body of any given abstract, references to the CLB mirror those provided by the board in the underlying decision.

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## Abstracts of decisions

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# 1. Article 056 EPC | T 0314/20 | Board 3.3.04

## Article 056 EPC

|                                    |                                                                                                                                                                                                                   |
|------------------------------------|-------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------|
| <b>Case Number</b>                 | <b>T 0314/20</b>                                                                                                                                                                                                  |
| <b>Board</b>                       | 3.3.04                                                                                                                                                                                                            |
| <b>Date of decision</b>            | 2023.11.16                                                                                                                                                                                                        |
| <b>Language of the proceedings</b> | EN                                                                                                                                                                                                                |
| <b>Internal distribution code</b>  | D                                                                                                                                                                                                                 |
| <b>Inter partes/ex parte</b>       | Inter partes                                                                                                                                                                                                      |
| <b>EPC Articles</b>                | Articles 054(1),056, 087, 112(1)(a), 123(2) EPC                                                                                                                                                                   |
| <b>EPC Rules</b>                   |                                                                                                                                                                                                                   |
| <b>RPBA</b>                        |                                                                                                                                                                                                                   |
| <b>Other legal provisions</b>      | Articles 20, 21 RPBA 2020                                                                                                                                                                                         |
| <b>Keywords</b>                    | inventive step (no) – technical effect derivable from the application as originally filed (no) – referral to the Enlarged Board (no) – diverging case law (no) – interpretation of point 2 of the Order of G 2/21 |
| <b>Cited decisions</b>             | G 0001/03, G 0002/10, G 0002/21, T 1525/19, T 0116/18 of 28 July 2023                                                                                                                                             |
| <b>Case Law Book</b>               | <a href="#">I.D.4.1.2b</a> ), 10th edition                                                                                                                                                                        |

In [T 314/20](#) the board identified three challenges in interpreting point 2 of the Order of G 2/21: the undefined relationship between the new requirements "encompassed by the technical teaching" and "embodied by the same originally disclosed invention", and previous plausibility case law; that the Enlarged Board (EBA) did not expressly define these requirements; and that the EBA did not expressly state the purpose of these requirements.

The board examined two issues it faced with the interpretation of G 2/21 in T 116/18 of 28 July 2023. The first concerned an inconsistency in the reasoning. On the one hand the board in T 116/18 had stated that the EBA in G 2/21 had not referred to any of the "plausibility" standards identified in its referring decision but had instead adopted new requirements which were to be applied rather than any rationale developed in the previous plausibility case law. However, in its interpretation of requirement (ii) of point 2 of the Order the same board had effectively adopted what it defined in the referral as the "ab initio implausibility" standard. The second issue identified by the board was that some of the inferences drawn in T 116/18 were not supported by the text of G 2/21. The first of these identified by the board concerned the just mentioned adoption of the "ab initio implausibility" standard; nowhere in

G 2/21 did the EBA state that requirement (ii) was met unless the person skilled in the art would have had legitimate reasons to doubt that the purported technical effect would have been achieved on the filing date. The current board highlighted a second inference in T 116/18, that a positive verbal statement of the technical effect relied upon by the patent applicant or proprietor in the patent application as originally filed was not necessary for requirements (i) and (ii) of point 2 of the Order of G 2/21 to be met. However, such a statement was also not to be found in G 2/21. The two main reasons provided for this latter conclusion were: i) the EBA did not state that the effect must be "directly and unambiguously derivable" but used less strict words ("derivable"/"derive"); ii) the terms "invention" and "technical teaching" meant the same in G 2/21, and both were to be understood as "the broadest technical teaching of the application as filed contained in it with regard to the claimed subject-matter".

In relation to the above-mentioned reasons provided in T 116/18, the current board considered that it was not possible to infer from the verb "derive" in point 2 of the Order of G 2/21 any specific meaning for the terms "embodied" or "encompassed". In point 72 of the Reasons in G 2/21, the EBA spoke, inter alia, of a technical effect which "was derivable for the person skilled in the art from the technical teaching of the application documents". It was also not immediately clear to the current board how it could be concluded that for requirement (i) in point 2 of the Order to be met the purported technical effect together with the claimed subject-matter need only be "conceptually encompassed" by the broadest technical teaching and that this in turn meant that "said effect need not be literally disclosed in it by way of a positive verbal statement". The present board considered that the passages of G 2/21 referred to by T 116/18 thus did not lead to the conclusion that the standard of disclosure that applied to Art. 87 EPC (concept of "same invention"), Art. 123(2) EPC or Art. 54(1) EPC (see decisions G 1/03 and G 2/10) was excluded when applying the requirements of point 2 of the Order of G 2/21. It considered that the purpose of the two requirements set out in point 2 of the Order of G 2/21 was to prevent patents from being granted for inventions that were not complete at the filing date (i.e. speculative applications). In the case in hand, the board concluded that if its understanding of the purpose of the two requirements was correct, the respondent could not rely on the technical effect. This effect was not only unsupported and not made credible by the application as originally filed; it even contradicted its technical teaching. Therefore, whatever the meaning of the two requirements in G 2/21, they could not be met in the present case if patenting for inventions not made at the filing date was to be excluded. Indeed the board concluded the requirements in point 2 of the Order of G 2/21 were not met.

The board refused the respondent's request for a referral to the EBA, in which it sought clarification of the terms referred to in point 2 of the order of decision G 2/21 and claimed there was divergence in the case law. The board found the EBA had deliberately chosen not to define the aforementioned requirements and it was thus uncertain whether the EBA would introduce further definitions if asked for additional guidance. Further, the board found that there was no apparent divergent lines of case law and believed that any tenable interpretation of the requirements introduced in decision G 2/21 would lead to the conclusion it had reached in the case in hand.

011-02-25

## 2. Article 083 EPC | T 2037/22 | Board 3.3.03

### Article 083 EPC

|                                    |                                                                                                                                                                                                                                                                                                                            |
|------------------------------------|----------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------|
| <b>Case Number</b>                 | <b>T 2037/22</b>                                                                                                                                                                                                                                                                                                           |
| <b>Board</b>                       | 3.3.03                                                                                                                                                                                                                                                                                                                     |
| <b>Date of decision</b>            | 2024.10.01                                                                                                                                                                                                                                                                                                                 |
| <b>Language of the proceedings</b> | EN                                                                                                                                                                                                                                                                                                                         |
| <b>Internal distribution code</b>  | D                                                                                                                                                                                                                                                                                                                          |
| <b>Inter partes/ex parte</b>       | Inter partes                                                                                                                                                                                                                                                                                                               |
| <b>EPC Articles</b>                | Articles 083, 100(b) EPC                                                                                                                                                                                                                                                                                                   |
| <b>EPC Rules</b>                   |                                                                                                                                                                                                                                                                                                                            |
| <b>RPBA</b>                        |                                                                                                                                                                                                                                                                                                                            |
| <b>Other legal provisions</b>      |                                                                                                                                                                                                                                                                                                                            |
| <b>Keywords</b>                    | sufficiency of disclosure – proof of a claimed technical effect which is not a therapeutic effect – whether to be provided in the application as filed – post-published evidence – G 2/21 exclusively about claimed therapeutic effects – no generalisation by G 2/21 – unusual parameter – no reversal of burden of proof |
| <b>Cited decisions</b>             | G 0001/03, G 0002/21, T 0292/85, T 0301/87, T 0238/88, T 0740/01, T 0131/03, T 1666/16, T 2732/16                                                                                                                                                                                                                          |
| <b>Case Law Book</b>               | <a href="#">II.C.7.2.2</a> , <a href="#">III.G.5.2.2 d</a> ), 10th edition                                                                                                                                                                                                                                                 |

In [T 2037/22](#) (PBAT resin composition), the appellant (opponent) alleged that evidence D4 and D5 should not be taken into account, since it would be derivable from decision G 2/21 that a lack of sufficiency could not be remedied by post-published evidence.

However, the board observed that the analysis in G 2/21 of the jurisprudence regarding sufficiency of disclosure was made in relation to second medical use claims in which the technical effect was usually a therapeutic effect. In such a case, because the subject-matter of second medical use claims is commonly limited to a known therapeutic agent for use in a new therapeutic application, the board explained it was necessary that the patent at the date of its filing rendered it credible that the known therapeutic agent, i.e. the product, was suitable for the claimed therapeutic application (G 2/21, point 74 of the Reasons). Accordingly, the appellant's argument relying on G 2/21 was based on a generalisation of an analysis made by the Enlarged Board exclusively concerning the case law relative to claimed therapeutic effects. The EBA, however, did not make such a generalisation. There

was in particular no indication that the EBA in G 2/21 was of the view that in order to meet the sufficiency requirement, proof of a claimed technical effect which was not a therapeutic effect, had to be provided in the application as filed, let alone in general for a parametric or functional definition meant to provide a limitation of the subject-matter defined otherwise in terms of structural features. Independently of the point in time for proof of claimed technical effect to be provided, the EBA in G 2/21 did not question the established requirements for acknowledging sufficiency.

The board further stated that contrary to the appellant's position, the skilled person did not need to make assumptions as to the amount of iron compounds to be used in order to prepare the claimed composition. Also, concerning the alleged incomplete information provided in respect of the PBAT resin, it was undisputed that the preparation of such PBAT resins was well known in the art, and that typically a metal based catalyst was used. Accordingly, the absence of an indication of which specific catalyst or stabiliser was used for the synthesis of the PBAT resin did not mean that the skilled person would not be in the position to prepare such resins. In any event, the appellant did not explain as to why the catalyst or the stabiliser would be relevant in order to meet the parametric conditions defined in operative claim 1, let alone provided any evidence. Embodiments empirically showed that the decisive factor in order to meet the parametric requirement (variation of b-value) of operative claim 1 was the content of the iron element and not the catalyst (which was not described as having been varied for the embodiments). Also unconvincing was the objection that all embodiments falling within the structural definition of operative claim 1 would not necessarily fulfil the functional requirement of a variation of b-value of less than 2.

The question was not whether any conceivable possible combination of features falling within the structural definition of operative claim 1, in particular those not based on the teaching of the specification, would meet the functional definition of that claim, but whether the specification taken as a whole would provide the skilled person with sufficient guidance to generally identify within the structural definition of operative claim 1 and over its full scope those compositions which met the parametric definition. The non-availability of some particular variants of a functionally defined component feature of the invention is immaterial to sufficiency as long as there are suitable variants known (G 1/03). Then, the mere existence of some compositions meeting the structural definition, but not fulfilling its functional definition was not enough to conclude there was a lack of sufficiency of disclosure.

The decision also dealt with the issue of burden of proof in relation to an unusual parameter and concluded that no reversal applied.

012-02-25

### 3. Article 083 EPC | T 0294/20 | Board 3.3.04

#### Article 083 EPC

|                                    |                                                                                                                                                                                       |
|------------------------------------|---------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------|
| <b>Case Number</b>                 | <b>T 0294/20</b>                                                                                                                                                                      |
| <b>Board</b>                       | 3.3.04                                                                                                                                                                                |
| <b>Date of decision</b>            | 2023.10.26                                                                                                                                                                            |
| <b>Language of the proceedings</b> | EN                                                                                                                                                                                    |
| <b>Internal distribution code</b>  | D                                                                                                                                                                                     |
| <b>Inter partes/ex parte</b>       | Inter partes                                                                                                                                                                          |
| <b>EPC Articles</b>                | Articles 083, 100(b) EPC                                                                                                                                                              |
| <b>EPC Rules</b>                   |                                                                                                                                                                                       |
| <b>RPBA</b>                        |                                                                                                                                                                                       |
| <b>Other legal provisions</b>      |                                                                                                                                                                                       |
| <b>Keywords</b>                    | sufficiency of disclosure – proof of a claimed therapeutic effect – established case law endorsed by G 2/21 – leading decision T 609/02 – standard of proof – post-published evidence |
| <b>Cited decisions</b>             | G 0001/03, G 0002/21, T 0609/02, T 1329/04, T 0895/13, T 0950/13                                                                                                                      |
| <b>Case Law Book</b>               | <a href="#">II.C.7.2.2</a> , 10th edition                                                                                                                                             |

In [T 294/20](#), claim 1 was drafted in the form of a purpose-limited product claim pursuant to Art. 54(5) EPC and was directed to a compound for use in the treatment of nodular lymphocyte predominant Hodgkin lymphoma (NLPHL). The board stated that the Enlarged Board's statements in G 2/21 could be seen to have endorsed the jurisprudence of the boards that attaining a claimed therapeutic effect is a limiting functional technical feature of a claim directed to the use of a substance or composition in a method of treatment.

The Enlarged Board's statements might also be understood to suggest a high standard of proof (i.e. "beyond reasonable doubt" rather than on "the balance of probabilities") which would require that the claimed therapeutic effect must, as a rule, be demonstrated in the application as filed by direct experimental evidence. However, while G 2/21 focussed on post-published evidence in the assessment of Art. 83 and 56 EPC, it did not address the question of the level of proof in an application as filed required to substantiate a therapeutic effect as a prerequisite for using post-published evidence for assessing the requirements of Art. 83 EPC.

The board did not understand G 2/21 (despite its findings on the term "plausibility") to have quashed the principles established by leading decision T 609/02. As a consequence, the board found that in order to fulfil the requirements of Art 83 EPC, the suitability of the product for the claimed therapeutic application had to be

derivable from the application, unless this was already known to the skilled person at the priority date (see T 609/02 and T 895/13). On how the suitability may be derived from the patent or application, the board in decision T 609/02 held: "It is required that the patent provides some information in the form of, for example, experimental tests, to the avail that the claimed compound has a direct effect on a metabolic mechanism".

It had to be assessed whether the patent contained information on a direct effect of PD-1 inhibitors on a mechanism specifically involved in NLRP3. It was undisputed that the patent did not report any testing of the suitability of a PD-1 inhibitor in an animal model of cancer or in cancer cells in vitro. A central issue in this appeal concerned the information that the patent had to contain about a direct effect of PD-1 inhibition on a mechanism specifically involved in NLRP3. The appellants (patent proprietors) relied on decision T 950/13 to argue that such information might be in the form of a "plausible technical concept". However, the board considered that a "plausible technical concept" might not be stretched to include a mere hypothesis which did not need to be supported by any evidence. Instead, the board confirmed the principles developed in T 609/02 (point 9 of the Reasons). The burden to show suitability is on the applicant (G 1/03). According to the board, this burden cannot be discharged or shifted to the EPO or the public by merely alleging that a claimed therapeutic effect has to be regarded as having been demonstrated as long as not disproven.

The board assessed what could be inferred from the information provided in the patent as to a direct effect of a PD-1 inhibitor on a metabolic mechanism specifically involved in NLRP3. The skilled person reading the information contained in the patent at the relevant date would not have concluded that an effect of PD-1 inhibitors on exhausted T cells was relevant to treatment of NLRP3. The board was not persuaded by the appellants' argument that the patent showed that a compound as defined in the claim was suitable for alleviating or preventing a symptom of NLRP3.

As final argument put forward by the appellants was that post-published document D9 confirmed the expression of PD-L1 by the tumour cells in NLRP3. However, the board held that in a case where the patent only provides a vague indication of the suitability of the claimed compound for the therapeutic effect, post-published evidence could not be taken into account to remedy the insufficiency of disclosure. D9 therefore would indeed be the first disclosure of a possible mechanism underlying the claimed therapeutic effect.

013-02-25

## 4. Article 099(3) EPC | T 1420/21 | Board 3.4.02

### Article 099(3) EPC

|                                    |                                                                                                                                                                                                                                                                     |
|------------------------------------|---------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------|
| <b>Case Number</b>                 | <b>T 1420/21</b>                                                                                                                                                                                                                                                    |
| <b>Board</b>                       | 3.4.02                                                                                                                                                                                                                                                              |
| <b>Date of decision</b>            | 2024.11.25                                                                                                                                                                                                                                                          |
| <b>Language of the proceedings</b> | FR                                                                                                                                                                                                                                                                  |
| <b>Internal distribution code</b>  | C                                                                                                                                                                                                                                                                   |
| <b>Inter partes/ex parte</b>       | Inter partes                                                                                                                                                                                                                                                        |
| <b>EPC Articles</b>                | Articles 099(1), 099(3) EPC                                                                                                                                                                                                                                         |
| <b>EPC Rules</b>                   | Rules 076(2), 077(1), 079(1) EPC                                                                                                                                                                                                                                    |
| <b>RPBA</b>                        |                                                                                                                                                                                                                                                                     |
| <b>Other legal provisions</b>      |                                                                                                                                                                                                                                                                     |
| <b>Keywords</b>                    | status as party to opposition proceedings –if opposition inadmissible, no longer any opposition proceedings to which the opponent and the patent proprietor could be parties – if opposition admissible, party status is not lost if submissions are not admissible |
| <b>Cited decisions</b>             |                                                                                                                                                                                                                                                                     |
| <b>Case Law Book</b>               | <a href="#">IV.C.2.3.3</a> , 10th edition                                                                                                                                                                                                                           |

Dans l'affaire [T 1420/21](#), l'intimée (opposante) faisait valoir qu'un opposant "perdrait" sa qualité de partie à la procédure s'il était constaté ultérieurement qu'aucun de ses moyens d'attaque tels que soumis dans le délai initial de neuf mois prescrit par l'art. 99(1) CBE n'était recevable. Elle en a conclu qu'un titulaire devrait de même perdre sa qualité de partie à la procédure – ou au moins que toute possibilité de déposer de nouvelles requêtes lui soit refusée – lorsqu'il est constaté ultérieurement qu'aucun de ses moyens de défense tels que soumis dans le délai initial prescrit par la règle 79(1) CBE n'est recevable. Si tel n'était pas le cas, un titulaire bénéficierait d'un traitement plus favorable contraire au principe d'égalité procédurale des parties.

Ces arguments n'ont pas convaincu la chambre, qui a énoncé que l'art. 99(3) CBE prescrit que les opposants sont parties, avec le titulaire du brevet, à la procédure d'opposition. Cette disposition n'énonce aucune condition additionnelle, au-delà de la condition implicite d'une procédure (d'opposition) en cours. Un opposant n'est pas le seul à "perdre sa qualité de partie à la procédure" si les moyens qu'il a déposés avec son acte d'opposition en vertu de la règle 76(2)c) CBE ne sont pas conformes à cette règle. Au contraire, dans ce cas d'espèce, l'opposition doit être rejetée comme irrecevable et il n'existera donc plus de procédure d'opposition à laquelle l'opposant et le titulaire du brevet pourraient être parties.

La chambre a aussi fait observer que, la CBE, dans l'art. 99(3) et les règles 77 et 79 en particulier, n'inclut aucune disposition visant l'effet énoncé par l'intimée.

L'argument de l'intimée partait du principe qu'une procédure d'opposition pourrait être en cours, mais que l'opposant pourrait perdre sa qualité de partie à la procédure. Or, selon la chambre une telle situation ne peut pas se produire. Pour que la situation envisagée par l'intimée puisse se produire, il serait nécessaire que l'opposition soit conforme à la règle 76(2)c) CBE alors que tout moyen d'attaque déposé dans les neuf mois est irrecevable, et ce sans que la division d'opposition ne dispose de pouvoir d'appréciation lui permettant de ne pas admettre les moyens d'attaque présentés dans les neuf mois. Cela n'est pas possible.

La chambre a conclu que l'argument selon lequel, pour des raisons d'égalité de traitement, le titulaire du brevet devrait perdre sa qualité de partie à la procédure si tous les moyens qu'il a invoqués dans sa réponse à l'opposition conformément à la règle 79(1) CBE s'avéraient irrecevables n'était pas valable.

014-02-25

## 5. Article 105 EPC | T 2597/22 | Board 3.3.05

### Article 105 EPC

|                                    |                                                                                                              |
|------------------------------------|--------------------------------------------------------------------------------------------------------------|
| <b>Case Number</b>                 | <b>T 2597/22</b>                                                                                             |
| <b>Board</b>                       | 3.3.05                                                                                                       |
| <b>Date of decision</b>            | 2024.11.27                                                                                                   |
| <b>Language of the proceedings</b> | DE                                                                                                           |
| <b>Internal distribution code</b>  | C                                                                                                            |
| <b>Inter partes/ex parte</b>       | Inter partes                                                                                                 |
| <b>EPC Articles</b>                | Articles 105, 111(1) EPC                                                                                     |
| <b>EPC Rules</b>                   | Rules 089, 103 EPC                                                                                           |
| <b>RPBA</b>                        |                                                                                                              |
| <b>Other legal provisions</b>      |                                                                                                              |
| <b>Keywords</b>                    | intervention of the assumed infringer – in appeal proceedings – remittal to the department of first-instance |
| <b>Cited decisions</b>             | G 0001/94, G 0003/04, T 0016/95, T 0308/05, T 1459/06, T 1713/11, T 2951/18, T 1809/22                       |
| <b>Case Law Book</b>               | <a href="#">III.P.1.3.1</a> , <a href="#">III.P.4</a> , 10th edition                                         |

In [T 2597/22](#) betrafen die Beschwerden der Patentinhaberin und der Einsprechenden 1 die Entscheidung der Einspruchsabteilung, das europäische Patent in geänderter Fassung aufrechtzuerhalten. Mit Schriftsatz vom 16. Februar 2023, d.h. während des Beschwerdeverfahrens, erklärte die EKATO Systems GmbH (Einsprechende 2) als vermeintliche Patentverletzerin im Sinne des Art. 105 EPÜ in Verbindung mit R. 89 EPÜ ihren Beitritt zum Einspruchs- bzw. Einspruchsbeschwerdeverfahren unter Bezugnahme darauf, dass die Patentinhaberin gegen sie am 22. November 2022 einen Antrag auf Erlass einer einstweiligen Verfügung wegen Patentverletzung beim Landgericht Mannheim eingereicht hatte. Die Patentinhaberin sah den Beitritt als unzulässig an, zumal es sich beim vor dem LG Mannheim geführten Verfahren lediglich um ein Verfahren des vorläufigen Rechtsschutzes gehandelt habe, das zudem vor einer Entscheidung durch Rücknahme des Antrags beendet worden sei.

Die Kammer war anderer Ansicht. Der Beitritt wurde in Übereinstimmung mit R. 89 EPÜ innerhalb von drei Monaten nach dem Antrag auf Erlass einer einstweiligen Verfügung beim LG Mannheim erklärt. Die Kammer stellte fest, dass ein Antrag auf einstweilige Verfügung im gegebenen Zusammenhang als verfahrenseinleitender Antrag vom Begriff der "Klage wegen Verletzung" in Art. 105 EPÜ umfasst sei (s. T 1459/06). Es sei zudem unerheblich, ob das Verfahren beim LG Mannheim immer noch anhängig gewesen sei (s. T 1809/22, T 1713/11). Unter diesen

Umständen sei der Beitritt der vermeintlichen Patentverletzerin zulässig. Dadurch erlange sie zugleich die Stellung als (weitere) Einsprechende.

Die Kammer stellte außerdem fest, dass, während Neuheit zunächst nicht Einspruchsgrund war und daher nicht in der angefochtenen Entscheidung behandelt wurde, die Beitrittserklärung Neuheitseinwände enthielt. Nach G 1/94 könne sich ein Beitritt eines vermeintlichen Patentverletzers auf jeden der in Art. 100 EPÜ genannten Einspruchsgründe stützen, auch wenn ein solcher nicht Gegenstand des bisherigen Einspruchsverfahrens war. Im Falle eines neuen Einspruchsgrundes sei die Sache dabei grundsätzlich zur weiteren Entscheidung an die Einspruchsabteilung zurückzuverweisen, wenn keine besonderen Gründe für eine andere Vorgehensweise sprächen. Im vorliegenden Fall seien derartige besondere Gründe nicht zu erkennen.

Nach Auffassung der Kammer konnte der Einsprechenden 1 insbesondere darin nicht beigeprpflichtet werden, dass Art. 111 (1) EPÜ der Beschwerdekammer trotz des Beitritts eine zumindest teilweise materiell-inhaltliche Überprüfung des Falles vorschreibe, die in bindenden Vorgaben an die Einspruchsabteilung resultieren müsste. Vor allem lässt sich der Kammer zufolge weder aus Art. 111 (1) EPÜ noch aufgrund sonstiger Bestimmungen des EPÜ oder der VOBK ein Gebot ableiten, einzelne Einwände (vorab) inhaltlich zu behandeln. Einer neuerlichen Entscheidung der Einspruchsabteilung, die nicht notwendigerweise auf identischer Sachverhaltsgrundlage und/oder Antragslage ergehen wird, kann in diesem Sinne nicht vorgegriffen werden. Allfällige bindende Vorgaben der Beschwerdekammer an die Einspruchsabteilung könnten auch das Recht der Beitretenden einschränken, das Patent, das sie angeblich verletzt hat, mit allen verfügbaren Mitteln anzufechten (vgl. G 1/94, Punkt 13 der Gründe). Die Kammer erinnerte daran, dass im Einklang mit etablierter Rechtsprechung der Beschwerdekammern (s. T 16/95, T 2951/18) eine weitergehende inhaltliche Überprüfung auch im vorliegenden Fall verfrüht und auch nicht zielführend wäre. Im Einklang mit den in G 1/94 entwickelten Grundsätzen sei eine (unmittelbare) Zurückverweisung an die Einspruchsabteilung geboten.

Wie von der Kammer angemerkt, hatten die Patentinhaberin und die Einsprechende 1 aber zum Zwecke der Einleitung eines "regulären" Beschwerdeverfahrens zur Überprüfung der auf Basis des bisher (nur) zwischen ihnen geführten Einspruchsverfahrens ergangenen Entscheidung der Einspruchsabteilung Beschwerdegebühren entrichtet (vgl. Art. 12 (2) VOBK zum "vorrangigen" Ziel des Beschwerdeverfahrens einer gerichtlichen Überprüfung der angefochtenen Entscheidung und Art. 111 (1) i. V. m. R. 99 (2) EPC über die grundsätzlich reformatorische oder kassatorische Entscheidungsbefugnis der Kammer). Wegen der unmittelbaren Zurückverweisung an die Einspruchsabteilung ohne weitergehende inhaltliche Prüfung durch die Beschwerdekammer fand ein solches "reguläres" Beschwerdeverfahren jedoch nicht statt. Bei dieser Sachlage war nach Ansicht der Kammer eine Rückzahlung der Beschwerdegebühren der Patentinhaberin und der Einsprechenden 1 (über die Grenzen der R. 103 EPÜ hinaus) angezeigt.

015-02-25

## 6. Article 117 EPC | T 0832/22 | Board 3.2.03

### Article 117 EPC

|                                    |                                                                                                                                                                     |
|------------------------------------|---------------------------------------------------------------------------------------------------------------------------------------------------------------------|
| <b>Case Number</b>                 | <b>T 0832/22</b>                                                                                                                                                    |
| <b>Board</b>                       | 3.2.03                                                                                                                                                              |
| <b>Date of decision</b>            | 2024.12.18                                                                                                                                                          |
| <b>Language of the proceedings</b> | EN                                                                                                                                                                  |
| <b>Internal distribution code</b>  | D                                                                                                                                                                   |
| <b>Inter partes/ex parte</b>       | Inter partes                                                                                                                                                        |
| <b>EPC Articles</b>                | Articles 054(2), 117 EPC                                                                                                                                            |
| <b>EPC Rules</b>                   |                                                                                                                                                                     |
| <b>RPBA</b>                        |                                                                                                                                                                     |
| <b>Other legal provisions</b>      |                                                                                                                                                                     |
| <b>Keywords</b>                    | evidence – standard of proof – beyond reasonable doubt does not require absolute certainty – if the higher standard is met, which standard applies can be left open |
| <b>Cited decisions</b>             | G 0001/12, G 0002/21, T 2466/13, T 1138/20, T 1311/21                                                                                                               |
| <b>Case Law Book</b>               | <a href="#">III.G.4.3</a> , 10th edition                                                                                                                            |

In [T 832/22](#), several pieces of evidence were submitted by the opponent (appellant) to establish the publication date of document D9, a user manual issued by the opponent. The respondent (proprietor) considered that it was not sufficiently proven that D9 had been published on the internet before the priority date.

Among about the ten affidavits submitted by the opponent, the affidavit D46 was submitted for the first time with the statement of grounds. The board decided to admit D46, which was prima facie relevant and essentially stayed within the legal and factual framework underlying the appealed decision.

Concerning the standard of proof, the respondent argued that since the evidence of the public availability of D9 lay within the sphere of the opponent, the higher standard "beyond reasonable doubt" had to be applied, but that that standard had not been fulfilled due to the contradictions with respect to the publication date of D9 in the various pieces of evidence.

The board, with reference to the case law and the principle of free evaluation of evidence, stressed that the standard of proof referred to the nature or degree of personal conviction that the members of the deciding body had to have in order to be satisfied that an alleged fact had occurred. If the applicable standard of proof was that which has been termed "the balance of probabilities", an alleged fact was proven

as soon as the members of the deciding body were convinced that the occurrence of that fact was more likely than not. If the applicable standard of proof was that which has been termed "beyond reasonable doubt", the required degree of personal conviction of the members of the deciding body was higher.

The board explained that standards of proof related, in legal systems based on the principle of free evaluation of evidence, to the nature or degree of conviction required of the members of the fact-finding body. Accordingly, it was difficult to quantify the difference in the required degree of conviction between the two standards. Attempting to describe this difference in the form of numerical thresholds (certain percentage) could even be misleading.

Regarding the "beyond reasonable doubt" standard, in the board's view, it thus seemed more expedient to focus on the term "reasonable" on the basis that the "beyond reasonable doubt" standard did not require absolute certainty, and that it was sufficient if the (majority of the) members of the deciding body had no reasonable doubt that an alleged fact had occurred. In other words, even if there was some remaining doubt, the "beyond reasonable doubt" standard of proof could be met as long as the remaining doubt was not reasonable.

In any case, the board stated that if the higher of two disputed standards of proof has been met, it could be left open which of these standards must be applied when assessing the evidence in question. Hence, if the deciding body is convinced beyond a reasonable doubt that an alleged fact occurred, there is no need to decide which standard of proof is applicable.

This was the situation in the present case in which the board considered with reference to D39 (Digital forensics technical report) that D9 was part of the state of the art under Art. 54(2) EPC. Indeed the board saw no reason to question the conclusions in the report D39 with respect to the upload date. The credibility of the report D39 and the methodology applied was as such not challenged by the respondent either. The fact that D39 had been commissioned by the appellant and was based on digital evidence from the appellant had, in the absence of any inconsistencies or other counter-evidence, no negative impact on its credibility. The further evidence did not contradict the conclusions based on the publication date based on D39. Even if – for the sake of the argument – it had to be decided which of the contradicting publication dates in D39 or D9', two independent pieces of evidence, was the correct one, both of them were well before the priority date.

016-02-25

## 7. Article 117 EPC | T 1604/22 | Board 3.2.02

### Article 117 EPC

|                                    |                                                                                                                                                                                                                       |
|------------------------------------|-----------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------|
| <b>Case Number</b>                 | <b>T 1604/22</b>                                                                                                                                                                                                      |
| <b>Board</b>                       | 3.2.02                                                                                                                                                                                                                |
| <b>Date of decision</b>            | 2024.09.16                                                                                                                                                                                                            |
| <b>Language of the proceedings</b> | EN                                                                                                                                                                                                                    |
| <b>Internal distribution code</b>  | D                                                                                                                                                                                                                     |
| <b>Inter partes/ex parte</b>       | Inter partes                                                                                                                                                                                                          |
| <b>EPC Articles</b>                | Articles 054(2), 117(1) EPC                                                                                                                                                                                           |
| <b>EPC Rules</b>                   | Rule 117 EPC                                                                                                                                                                                                          |
| <b>RPBA</b>                        | Article 12(2), (4) RPBA 2020                                                                                                                                                                                          |
| <b>Other legal provisions</b>      |                                                                                                                                                                                                                       |
| <b>Keywords</b>                    | evidence – taking of evidence – hearing witnesses and inspection by videoconference before the opposition division – videoconference not inappropriate and did not diminish the probative value of the evidence taken |
| <b>Cited decisions</b>             | T 2292/14                                                                                                                                                                                                             |
| <b>Case Law Book</b>               | <a href="#">III.G.3.1.7</a> , <a href="#">V.A.3.4.4</a> , 10th edition                                                                                                                                                |

In [T 1604/22](#), the opposition division found the two public prior uses regarding dialysis machine and POL software alleged by the opponent (respondent) to be proven. Two witnesses were heard and a CD was inspected during the oral proceedings, which were held by videoconference. The opposition division concluded that the two prior uses belonged to the state of the art under Art. 54(2) EPC.

The public availability of D1, an instruction manual for the "sleep-safe" dialysis machine sold by the respondent, was considered. Since the conclusion in T 2292/14 was based on affidavits which were again submitted as evidence in the opposition proceedings which led to the present appeal, the current board, like the opposition division, saw no reason to depart from that conclusion given that the alleged facts and circumstances of the public prior use invoked by the respondent were the same.

D6 was a user manual for the "PatientOnLine" (POL) software sold by the respondent which enables the creation and management of prescriptions for the "sleep-safe" dialysis machine. Concerning its public availability, affidavits D6a and D6d stated that D6 was made publicly available during the installation of this software in a hospital in June 2007. In relation to this alleged prior use, the authors of the affidavits were heard as witnesses and a CD, presented by the respondent as an original installation CD of the POL software and allegedly containing a copy of D6, was inspected during the oral proceedings before the opposition division, which were held by

videoconference. In reply to the appellants' (patent proprietors') objection with regard to the admittance of the CD, the board stated that it had no discretionary power not to admit the CD into the appeal proceedings as it formed part of the evidence on which the decision under appeal was based.

As to the appellants' objection that it had been inappropriate to inspect the CD and to hear the two witnesses by videoconference, the board stated that the fact that the inspection of the CD was carried out by videoconference did not prejudice the proper inspection of its content. The inspection was carried out by a member of the opposition division, assisted by a technician who presented the CD to the camera. The minutes also showed that the parties were able to follow the inspection in real time during the videoconference and that the content of the CD, including some of its directories, was displayed to the videoconference participants. Moreover, all the pages of the user manual requested by the parties and the opposition division were displayed, with corresponding screenshots included in the minutes. The fact that some of the files were corrupted and therefore could not be opened was not related to the format of the oral proceedings. Also, the hearings of the two witnesses were not compromised by the videoconference format. The minutes of both hearings showed among other things that precautions were taken to ensure that the witnesses were alone in front of the camera. According to the minutes, the parties were provided with the draft minutes of the taking of evidence and were given the opportunity to comment on them already during the oral proceedings. None of the parties made any comments at that time except a minor remark. Moreover, the appellants never complained that their right to be heard had been violated by the fact that the oral proceedings were held by videoconference. Therefore, conducting the taking of evidence by videoconference was not inappropriate and did not diminish the probative value of the evidence taken.

D6a and D6d were affidavits, i.e. statements sworn under oath, which should be given a high probative value, unless other evidence casts doubt on them. The fact that the affidavits might have been written by someone else, e.g. the respondent's representative, was immaterial since by signing them the authors endorsed the statements made in the affidavits. The board was satisfied that the provided evidence was sufficient to prove the public availability of D6. The alleged inconsistencies and doubts raised by the appellants were not convincing. The fact that the events in question took place a long time ago could easily explain some imprecisions in the witnesses' testimonies, without calling into question the overall credibility of their statements. The appellants also explicitly did not question the witnesses' credibility.

017-02-25

## 8. Article 117 EPC | T 2011/21 | Board 3.2.01

### Article 117 EPC

|                                    |                                                                                                                                                                                                                                 |
|------------------------------------|---------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------|
| <b>Case Number</b>                 | <b>T 2011/21</b>                                                                                                                                                                                                                |
| <b>Board</b>                       | 3.2.01                                                                                                                                                                                                                          |
| <b>Date of decision</b>            | 2024.09.03                                                                                                                                                                                                                      |
| <b>Language of the proceedings</b> | EN                                                                                                                                                                                                                              |
| <b>Internal distribution code</b>  | D                                                                                                                                                                                                                               |
| <b>Inter partes/ex parte</b>       | Inter partes                                                                                                                                                                                                                    |
| <b>EPC Articles</b>                | Articles 054(2), 117(1) EPC                                                                                                                                                                                                     |
| <b>EPC Rules</b>                   |                                                                                                                                                                                                                                 |
| <b>RPBA</b>                        |                                                                                                                                                                                                                                 |
| <b>Other legal provisions</b>      |                                                                                                                                                                                                                                 |
| <b>Keywords</b>                    | evidence – taking of evidence – right to be heard – inspection by videoconference before the opposition division – complexity of prior use – in-person inspection should have taken place – no substantial procedural violation |
| <b>Cited decisions</b>             | G 0001/21                                                                                                                                                                                                                       |
| <b>Case Law Book</b>               | <a href="#">III.G.3.3.1</a> , 10th edition                                                                                                                                                                                      |

In [T 2011/21](#), during the oral proceedings which were held by videoconference, the "Sirona" child safety seat prior use was inspected remotely by the opposition division. The inspection was transmitted by videoconference to all parties with every party having been given the chance to direct the camera used for inspection to specific details of interest. Screenshots showing several relevant views and constructional details of the child safety seat "Sirona" were taken and attached to the protocol of inspection. Based on this taking of evidence, the opposition division concluded that claim 1 was novel over the public prior use "Sirona"; the inspected seat did not comprise the feature introduced in claim 1 of the auxiliary request 1, the remaining features were disclosed.

The appellant (opponent) considered that the conclusion of the opposition division was based on a too narrow interpretation of the term "side wing" without evidence being provided in support. The appellant contested the correctness of the decision on the inspection per videoconference, even though it was requested in person in view of the complexity of the structure. The inspection per videoconference was detrimental to the appellant in the sense that they were prevented from presenting their arguments in the most convincing and effective way, unduly limiting their right to be heard. The appellant also requested a referral about applicability of G 1/21 to the departments of first-instance and to the procedure of taking evidence by inspection.

The board considered that the opposition division erred in not granting the opponent's request to take evidence by inspection be made in-presence. The opponent's request was namely substantiated and in the board's view well-founded, in particular because the object to be inspected was a complex three-dimensional item. This error, however, did not constitute a substantial procedural violation. The decision of the opposition division to consider the subject-matter of claim 1 to be novel in view of the prior use was actually neither determined nor influenced to the detriment of the appellant by the fact that the inspection took place by videoconference and not in presence. The board had no reason to consider that the opposition would have arrived at a different result if the inspection had taken place in presence. Decisive was the claim construction approach, and the interpretation of the term "side wings" in the claim, which was extensively discussed with the parties. The erroneous interpretation made by the opposition division, in the board's view, was an error of judgment not made in violation of the opponent's right to be heard.

The questions requested to be referred to the Enlarged Board were not relevant for deciding the present case since the erroneous interpretation adopted by the opposition division was irrespective of the format for the oral proceedings and the inspection.

018-02-25

## 9. Article 125 EPC | T 1588/22 | Board 3.3.02

### Article 125 EPC

|                                    |                                                                                                                                                                                                                                  |
|------------------------------------|----------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------|
| <b>Case Number</b>                 | <b>T 1588/22</b>                                                                                                                                                                                                                 |
| <b>Board</b>                       | 3.3.02                                                                                                                                                                                                                           |
| <b>Date of decision</b>            | 2024.12.20                                                                                                                                                                                                                       |
| <b>Language of the proceedings</b> | EN                                                                                                                                                                                                                               |
| <b>Internal distribution code</b>  | D                                                                                                                                                                                                                                |
| <b>Inter partes/ex parte</b>       | Ex parte                                                                                                                                                                                                                         |
| <b>EPC Articles</b>                | Articles 111(1), 113(1), 125 EPC                                                                                                                                                                                                 |
| <b>EPC Rules</b>                   | Rule 103(1)(a) EPC                                                                                                                                                                                                               |
| <b>RPBA</b>                        | Article 11 RPBA 2020                                                                                                                                                                                                             |
| <b>Other legal provisions</b>      |                                                                                                                                                                                                                                  |
| <b>Keywords</b>                    | protection of legitimate expectations – clear and unambiguous communication (no) – right to be heard – opportunity to comment (no) – substantial procedural violation (yes) – remittal (yes) – reimbursement of appeal fee (yes) |
| <b>Cited decisions</b>             | G 0002/97, J 0003/24                                                                                                                                                                                                             |
| <b>Case Law Book</b>               | <a href="#">III.A.3.1</a> , <a href="#">III.B.2.5.1</a> , 10th edition                                                                                                                                                           |

In the proceedings leading to the decision under appeal in [T 1588/22](#), the examining division had issued a communication on 27 July 2021. The last paragraph of the communication had read as follows: "The applicant may choose to amend the claim set as previously proposed by the examining division (see the text intended for grant dated 01.06.2021) and thereby lead to the grant of the present application. They may also choose to submit further arguments along with a new claim set satisfying the requirements of EPC. In the latter case the applicant is kindly reminded that the examination procedure would continue with oral proceedings for the sake of efficiency and better communication." On 6 November 2021 the applicant (appellant) had filed a reply to the communication and a new set of claims. On 24 November 2021, the applicant had filed a new set of claims identical to the set of claims filed on 6 November 2021. Upon an enquiry by the applicant as to when the EPO would deliver the next communication, the examining division had issued on 7 December 2021 a communication and stated that it would issue a communication within two months. On 5 January 2022, the examining division issued a decision refusing the application based on the claims filed on 24 November 2021.

The board recalled that in line with the established case law of the boards, the principle of the protection of legitimate expectations applied in proceedings pursuant to the EPC. Its application to procedures before the EPO implied that measures

taken by the EPO should not violate the reasonable expectations of parties to such proceedings (G 2/97). It required that communications addressed to applicants be clear and unambiguous, i.e. drafted in such a way as to rule out misunderstandings on the part of a reasonable addressee (J 3/24).

According to the board the examining division's announcement in its communication of 27 July 2021, that the appellant "may also choose to submit further arguments along with a new claim set satisfying the requirements of EPC. In the latter case the applicant is kindly reminded that the examination procedure would continue with oral proceedings for the sake of efficiency and better communication" appeared nonsensical or at least misleading in the given circumstances. The only way for the appellant to make sense of this statement was to assume that it referred to a situation where a new claim set was filed that would not meet the requirements of the EPC, in which case the proceedings would be continued with the holding of oral proceedings. This created the legitimate expectation on the appellant's part that, after having filed a new set of claims on 6 November 2021 (refiled on 24 November 2021), these would either be found allowable or oral proceedings would be held and that, in the latter case, the appellant would have the opportunity to provide, during the oral proceedings, submissions on the allowability of this set of claims. The appellant could not have expected as the next action of the examining division that a decision refusing the patent application would be issued. According to the board, this was exacerbated by the communication of 7 December 2021 informing that the examining division would "supply a communication within 2 months".

The board inferred from these events that instant issuance of the decision refusing the application had been a surprise for the appellant. Thus, the principle of the protection of legitimate expectations had not been observed in the case at hand.

The board concluded that in view of the legitimate expectations created by the examining division, the appellant had had to assume that she would be given a further opportunity to provide counterarguments or submit amendments prior to any decision to refuse her application. The board held that the issuance of the decision refusing the patent application without holding oral proceedings or issuing a further communication as announced had thus had the effect of depriving the appellant of any such further possibility to provide comments. Consequently, the appellant's right to be heard had been violated (Art. 113(1) EPC). The examining division's decision to refuse the application thus constituted a substantial procedural violation.

The board decided to set aside the appealed decision and to remit the case to the examining division for further prosecution. Furthermore, it considered reimbursement of the appeal fee under R. 103(1)(a) EPC equitable.

019-02-25

## 10. Rule 139 EPC

| T 0186/22

| Board 3.2.08

## Rule 139 EPC

|                                    |                                                                                                                                                                                                                                                       |
|------------------------------------|-------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------|
| <b>Case Number</b>                 | <b>T 0186/22</b>                                                                                                                                                                                                                                      |
| <b>Board</b>                       | 3.2.08                                                                                                                                                                                                                                                |
| <b>Date of decision</b>            | 2024.11.15                                                                                                                                                                                                                                            |
| <b>Language of the proceedings</b> | DE                                                                                                                                                                                                                                                    |
| <b>Internal distribution code</b>  | D                                                                                                                                                                                                                                                     |
| <b>Inter partes/ex parte</b>       | Inter partes                                                                                                                                                                                                                                          |
| <b>EPC Articles</b>                | Article 108 EPC                                                                                                                                                                                                                                       |
| <b>EPC Rules</b>                   | Rule 139 EPC                                                                                                                                                                                                                                          |
| <b>RPBA</b>                        |                                                                                                                                                                                                                                                       |
| <b>Other legal provisions</b>      | Arrangements for deposit accounts                                                                                                                                                                                                                     |
| <b>Keywords</b>                    | correction of error in document (yes) – error in debit order – appeal fee debited from third-party account – immediately evident that nothing else could have been intended (yes) – correction filed without delay – appeal deemed to have been filed |
| <b>Cited decisions</b>             | G 0001/12, T 0445/08 of 26 March 2015, T 0317/19, T 1000/19                                                                                                                                                                                           |
| <b>Case Law Book</b>               | <a href="#">III.U.2.2.5b</a> ), <a href="#">V.A.2.5.4</a> , 10th edition                                                                                                                                                                              |

In [T 186/22](#) legte die Patentinhaberin am 31. Januar 2022 Beschwerde ein. In ihrer Beschwerdeschrift kündigte sie an, dass die Beschwerdegebühr per Abbuchungsauftrag entrichtet werde. Mit Formblatt 1038APPEAL vom gleichen Tag wurde ein Abbuchungsauftrag erteilt. Auf diesem Formblatt wurde als Kontoinhaber der Vertreterzusammenschluss genannt und die Nummer des laufenden Kontos als 28000017 benannt. Mit Schreiben vom 11. Februar 2022 stellte die Patentinhaberin klar, dass ihr bei der Nummer des laufenden Kontos ein Irrtum unterlaufen war und dass die richtige Nummer des laufenden Kontos 28001760 lautete. Sie stellte einen Antrag auf Berichtigung des Abbuchungsauftrags gemäß R. 139 EPÜ. Die Einsprechende beantragte festzustellen, dass die Beschwerde als nicht eingelegt gilt. Die Abbuchung der Beschwerdegebühr vom falschen Konto mit der Nummer 28000017 könne nicht als gültig angesehen werden. Unter Verweis auf Punkt 5.1.1 der damals geltenden Version der Vorschriften über das laufende Konto (VLK) argumentierte sie, dass das Konto 28000017 in Anwendung der Bestimmungen der VLK nicht zur Zahlung der Beschwerdegebühr der Patentinhaberin benutzt werden dürfe. Auch brachte die Einsprechende vor, dass die Patentinhaberin nicht bewiesen habe, dass ihr eigenes Konto am Tag des (falschen) Abbuchungsauftrags gedeckt war, so wie in Punkt 5.4.1 der VLK vorgeschrieben.

Die Kammer stellte fest, dass die Gebühr von dem Konto mit der Nummer 28000017 eingezogen worden war. Insofern war die Beschwerdegebühr tatsächlich entrichtet worden.

Die Kammer war der Ansicht, dass sich dadurch, dass die Beschwerdegebühr nicht vom Konto der Patentinhaberin, sondern von einem fremden Konto abgebucht wurde war, nichts daran ändern konnte, dass das Erfordernis von Art. 108 Satz 2 EPÜ erfüllt war. Diese Vorschrift verlangt nämlich nicht, dass die Zahlung der Beschwerdegebühr durch den Beschwerdeführer erfolgt. Vielmehr ist es für die Frage, ob die Beschwerde als eingelegt gilt, irrelevant, wer die Beschwerdegebühr entrichtet. Es reicht aus, dass eine Beschwerdegebühr (in entsprechender Höhe) vor Ablauf der Beschwerdefrist entrichtet wurde. Auch der von der Einsprechenden zitierte Punkt 5.1.1 VLK führt zu keinem anderen Ergebnis. Zwar kann sich auch die Kammer nicht erklären, warum der Abbuchungsauftrag der Patentinhaberin von einem fremden Konto zum tatsächlichen Einzug der Beschwerdegebühr geführt hat. Dass nach den Bestimmungen der VLK die Beschwerdegebühr nicht vom laufenden Konto eines Dritten hätte abgebucht werden sollen, ändert jedoch nichts an der Tatsache, dass die Beschwerdegebühr abgebucht wurde und damit die Entrichtung der Gebühr rechtzeitig erfolgte. Aus demselben Grund ist es auch irrelevant, ob das Konto der Patentinhaberin am Tag des Abbuchungsauftrags gedeckt war oder nicht.

Für den Antrag auf Berichtigung des Abbuchungsauftrags gemäß R. 139 Satz 1 EPÜ kam es daher gar nicht darauf an, ob die Beschwerde als eingelegt gelte. Ungeachtet dessen wurde dem Antrag der Patentinhaberin nach R. 139 Satz 1 EPÜ stattgegeben. Eine zulässige Berichtigung nach dieser Vorschrift hat rückwirkende Wirkung (G 1/12). R. 139 Satz 1 EPÜ ist auf die Berichtigung eines Mangels in einem Abbuchungsauftrag betreffend die Beschwerdegebühr anwendbar. Der Wortlaut der Vorschrift stellt auf Unrichtigkeiten "in den beim Europäischen Patentamt eingereichten Unterlagen" ab. Das Formblatt 1038APPEAL, das den Abbuchungsauftrag enthält, ist eine solche Unterlage. Die von der Rechtsprechung aufgestellten Grundsätze bei der Anwendung der R. 139 Satz 1 EPÜ (G 1/12) waren im vorliegenden Fall gewahrt, denn: a) Die Berichtigung entsprach der ursprünglichen und wirklichen Absicht der Patentinhaberin. Die Absicht des Vertreters der Patentinhaberin, die Beschwerdegebühr vom laufenden Konto des Zusammenschlusses zu entrichten, war der Beschwerdeschrift und dem mittels Formblatt 1038APPEAL eingereichten Abbuchungsauftrag zu entnehmen. Es gab keine Hinweise, dass etwas anderes beabsichtigt gewesen war; b) Diese ursprüngliche Absicht war auch sofort erkennbar, sodass die Patentinhaberin hier keine gesteigerten Anforderungen an die Beweislast trafen; c) Die zu berichtigende Unrichtigkeit lag hier in einer unrichtigen Angabe, nämlich der unrichtigen Angabe der Nummer des laufenden Kontos; und d) Der Berichtigungsantrag war auch unverzüglich gestellt worden, nämlich 10 Tage nach Einreichung des Abbuchungsauftrags und laut Vorbringen der Patentinhaberin am Tag an dem der Fehler festgestellt worden war.

Die Kammer kam zu dem Schluss, dass die Beschwerde der Patentinhaberin als eingelegt gilt.

020-02-25

## 11. Article 12(4) RPBA 2020 | T 1659/22 | Board 3.3.06

### Article 12(4) RPBA 2020

|                                    |                                                                                                                                                                                                    |
|------------------------------------|----------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------|
| <b>Case Number</b>                 | <b>T 1659/22</b>                                                                                                                                                                                   |
| <b>Board</b>                       | 3.3.06                                                                                                                                                                                             |
| <b>Date of decision</b>            | 2024.11.25                                                                                                                                                                                         |
| <b>Language of the proceedings</b> | DE                                                                                                                                                                                                 |
| <b>Internal distribution code</b>  | D                                                                                                                                                                                                  |
| <b>Inter partes/ex parte</b>       | Inter partes                                                                                                                                                                                       |
| <b>EPC Articles</b>                |                                                                                                                                                                                                    |
| <b>EPC Rules</b>                   | Rule 116 EPC                                                                                                                                                                                       |
| <b>RPBA</b>                        | Article 12(2), 12(4) RPBA 2020                                                                                                                                                                     |
| <b>Other legal provisions</b>      |                                                                                                                                                                                                    |
| <b>Keywords</b>                    | amendment to case – request – requirements of Article 12(2) RPBA met (no) – admissibly raised and maintained (yes) – submitted in the reasonable expectation that the application will be admitted |
| <b>Cited decisions</b>             | G 0005/88, T 0042/20, T 0108/20, T 0221/20, T 0364/20, T 0738/20, T 1800/20, T 0246/22, T 0446/22, T 0731/22, T 0924/22, T 1135/22, T 0506/23                                                      |
| <b>Case Law Book</b>               | <a href="#">V.A.4.2.1c</a> , 10th edition                                                                                                                                                          |

In [T 1659/22](#) wurde Hilfsantrag 1 bereits erstinstanzlich binnen der Frist zur Einreichung neuer Unterlagen nach R. 116 EPÜ eingereicht. Da allerdings das Patent in der erteilten Fassung aufrechterhalten wurde, wurde über diesen Antrag erstinstanzlich nicht entschieden. Die Kammer erläuterte, dass bereits erstinstanzlich gestellte, aber nicht verbeschiedene Anträge, die mit der Beschwerdebegründung erneut gestellt werden ("übertragene Anträge" oder "carry-over requests"), dann nach Art. 12 (4), 12 (2) VOBK nicht als Änderung zu betrachten sind, wenn sie erstinstanzlich "in zulässiger Weise vorgebracht und aufrechterhalten wurden".

Das Kriterium "in zulässiger Weise vorgebracht" erschien der Kammer unklar. Dadurch, dass die Einspruchsabteilung einen durch die Beschwerdekammer nur begrenzt überprüfbaren Ermessensspielraum bei der Zulassung von Anträgen habe, scheine es so, als müsse die Beschwerdekammer nach Art. 12 (4) VOBK etwas ex ante beurteilen, das sie ex post nur im Hinblick auf die fehlerfreie Ermessensausübung überprüfen könne. "Admissibly raised" wäre insoweit auszulegen als: "Hätte durch die Einspruchsabteilung zugelassen werden können".

Ob etwas "in zulässiger Weise vorgebracht" wurde, könne nur dann festgestellt werden, wenn die Einspruchsabteilung darüber eine Entscheidung getroffen habe.

Die Kammer führte weiter aus, es sei nicht verwunderlich, dass die Rechtsprechung dieses Erfordernis in unterschiedlicher Weise ausgelegt habe. Die in den einschlägigen Entscheidungen genannten Kriterien seien hilfreiche Anhaltspunkte für die aus Sicht der Kammer entscheidende Frage, ob die Patentinhaberin (oder eine andere Verfahrenspartei) bei der Einreichung im Einspruchsverfahren redlicherweise hätte davon ausgehen können, dass ihre Anträge zugelassen würden. Denn ob Anträge oder sonstige Dokumente tatsächlich entscheidungserheblich werden würden, könne eine Partei nicht voraussehen. Wohl aber könne sie alles dafür tun, um die begründete und berechtigte Erwartung zu hegen, ein Antrag oder Dokument werde zugelassen werden, soweit dies entscheidungserheblich würde. Die Kammer legte das Merkmal "in zulässiger Weise vorgebracht" daher im Sinne von "in der redlichen Erwartung vorgebracht, dass es zugelassen werde" aus und verstand die Vorschrift als eine Ausprägung des im gesamten Verfahren vor dem EPA geltenden Grundsatz des Vertrauensschutzes (Entscheidung G 5/88, Nr. ° 3.2– 3.4 der Gründe).

Da die Patentinhaberin vorliegend ihre Hilfsanträge im Einspruchsverfahren innerhalb der Frist von R. 116 (1) EPÜ eingereicht und begründet hatte, bestand nach Auffassung der Kammer für die Patentinhaberin die berechtigte Erwartung, dass diese Hilfsanträge, sollte es erforderlich werden, in das Verfahren zugelassen werden würden. Anhaltspunkte dafür, dass die Einspruchsabteilung ihr Ermessen in anderer Weise ausgeübt haben würde, bspw. im Hinblick auf eine fehlende Begründung (T 246/22), eine übergroße Anzahl oder divergierende Anträge (T 1800/20), sah die Kammer nicht. Aus Sicht der Kammer war Hilfsantrag 1 deshalb erstinstanzlich in zulässiger Weise vorgebracht worden.

Auch dass die Patentinhaberin bei erneuter Einreichung des Antrags zur Begründung pauschal auf ihr erstinstanzliches Vorbringen verwiesen hatte, war aus Sicht der Kammer nicht zu beanstanden. Denn, da sich die Einsprechende in ihrer Beschwerdebegründung nicht mit den Hilfsanträgen auseinandergesetzt hatte, habe für die Patentinhaberin keine Veranlassung zu einem erneuten Vorbringen bestanden. Es sei auch nicht erforderlich gewesen, die im Einspruchsverfahren vorgebrachte und unwidersprochen gebliebene Begründung im Beschwerdeverfahren verbatim durch Kopieren nochmals zu wiederholen (T 108/20).

021-02-25

## 12. Article 13(2) RPBA 2020 | T 2170/21 | Board 3.2.04

### Article 13(2) RPBA 2020

|                                    |                                                                                                                                                                                                                                                                                                                                                  |
|------------------------------------|--------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------|
| <b>Case Number</b>                 | T 2170/21                                                                                                                                                                                                                                                                                                                                        |
| <b>Board</b>                       | 3.2.04                                                                                                                                                                                                                                                                                                                                           |
| <b>Date of decision</b>            | 2024.10.02                                                                                                                                                                                                                                                                                                                                       |
| <b>Language of the proceedings</b> | DE                                                                                                                                                                                                                                                                                                                                               |
| <b>Internal distribution code</b>  | D                                                                                                                                                                                                                                                                                                                                                |
| <b>Inter partes/ex parte</b>       | Inter partes                                                                                                                                                                                                                                                                                                                                     |
| <b>EPC Articles</b>                |                                                                                                                                                                                                                                                                                                                                                  |
| <b>EPC Rules</b>                   | Rule 139 EPC                                                                                                                                                                                                                                                                                                                                     |
| <b>RPBA</b>                        | Article 13(2) RPBA 2020                                                                                                                                                                                                                                                                                                                          |
| <b>Other legal provisions</b>      |                                                                                                                                                                                                                                                                                                                                                  |
| <b>Keywords</b>                    | amendment after notification of Art. 15(1) RPBA<br>communication (yes) – submissions regarding<br>admissibility of the appeal – obligation ex officio<br>to assess admissibility – exceptional<br>circumstances (yes) – correction of debit order<br>under R. 139 EPC (yes) – incorrect electronic<br>form used – no need to replace entire form |
| <b>Cited decisions</b>             | G 0001/12, T 0071/21                                                                                                                                                                                                                                                                                                                             |
| <b>Case Law Book</b>               | <a href="#">V.A.4.2.2</a> , <a href="#">V.A.4.5.7</a> , <a href="#">V.A.2.5.4</a> , <a href="#">III.U.2.2.5b</a> , 10th<br>edition                                                                                                                                                                                                               |

In [T 2170/21](#) beantragten die Beteiligten jeweils die Nichtzulassung wegen Verspätung von Vorbringen und Tatsachen (einschließlich Beweismitteln) der Gegenpartei zur Frage der wirksamen Zahlung der Beschwerdegebühr. Diese war von der Beschwerdeführerin (Patentinhaberin) innerhalb der Beschwerdefrist nicht in der vorgeschriebenen Höhe entrichtet worden, da sie den Abbuchungsauftrag auf dem falschen elektronischen Formblatt für eine Einspruchsgebühr erteilt hatte. Erst nach Ablauf der Frist beantragte die Beschwerdeführerin Korrekturen des Abbuchungsauftrags nach R. 139 EPÜ. Die verspätete Zahlung der vollen Beschwerdegebühr wurde von der Beschwerdegegnerin (Einsprechenden) in ihrer Beschwerdeerwiderung geltend gemacht, worauf die Beschwerdeführerin in ihrer Replik antwortete. In Reaktion auf die Mitteilung nach Art. 15 (1) VOBK vertieften die Beteiligten ihre Argumentation.

Die Kammer erklärte, auch ohne einen entsprechenden Antrag, sei sie verpflichtet, die ordnungsgemäße Zahlung der Beschwerdegebühr zu überprüfen. Die Bestimmungen der VOBK über verspätetes Vorbringen der Beteiligten würden solche Verpflichtungen der Kammer von Amts wegen nicht aufheben. Denn die Zulässigkeit

der Beschwerde sei nicht nur von Amts wegen, sondern auch in jeder Phase des Beschwerdeverfahrens zu prüfen (s. Rechtsprechung der Beschwerdekammern, 10. Aufl. 2022, V.A.2.7). Die Kammer wies darauf hin, dass es widersprüchlich wäre, einerseits die Befugnis, ja sogar die Pflicht der Kammer zur Prüfung der Zulässigkeitsfrage anzuerkennen, andererseits aber die zugrunde liegenden Tatsachen als verspätet von der Entscheidung auszuschließen.

Dies bedeute, dass in solchen Fällen in der Regel die Ausnahmebestimmungen des Art. 13 (1) VOBK (i. V. m. Art. 12 (6) VOBK): "die Umstände der Beschwerdesache rechtfertigen eine Zulassung" oder des Art. 13 (2) VOBK "dass außergewöhnliche Umstände vorliegen" anwendbar seien. Den vorliegenden Fall betreffend führte die Kammer aus, die relevanten Tatsachen seien zum großen Teil bereits aktenkundig gewesen und die Rechtsprechung zur Berichtigung einer Gebührenzahlung habe sich über die Jahre nicht einheitlich entwickelt. Unter diesen Umständen sei es den Beteiligten nicht zuzumuten gewesen, ihr Vorbringen, insbesondere zur Rechtsauslegung, nicht nachträglich zu ergänzen. Argumente zur Rechtsauslegung seien für die Kammer grundsätzlich nicht überraschend. Dies ergebe sich aus dem Rechtsprinzip "das Gericht kennt das Recht" (*jura novit curia*).

Die Kammer sah zudem keinen Grund, die grundsätzliche Möglichkeit der Berichtigung einer fehlerhaften Gebührenzahlung nach R. 139 EPÜ in Frage zu stellen (in Anlehnung an die von der Beschwerdegegnerin zitierte Entscheidung T 71/21, Nr. 6.3 der Gründe, und die weiteren dort zitierten Entscheidungen). Nach Ansicht der Kammer war eine Berichtigung auch ohne Austausch des gesamten Formblatts möglich. Die von der Großen Beschwerdekammer festgestellten und von der Rechtsprechung der Beschwerdekammern entwickelten Voraussetzungen für eine gewährbare Berichtigung (G 1/12, Nr. 37 der Gründe, Voraussetzungen (a) bis (d)) lagen ebenfalls vor, entgegen der Auffassung der Beschwerdegegnerin.

022-02-25

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