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# Abstracts of decisions

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## Abstracts of decisions

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## 1. Article 056 EPC | T 0852/20 | Board 3.3.02

### Article 056 EPC

<b>Case Number</b>	T 0852/20
<b>Board</b>	3.3.02
<b>Date of decision</b>	2023.11.27
<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>	Article 056 EPC
<b>EPC Rules</b>	
<b>RPBA</b>	
<b>Other legal provisions</b>	
<b>Keywords</b>	inventive step (no) – post-published evidence taken into account (no) – purported technical effect derivable from application as originally filed (no)
<b>Cited decisions</b>	G 0002/21
<b>Case Law Book</b>	<a href="#">I.D.4.3.3</a> , 10th edition

In [T 852/20](#) the board addressed the issue of whether post-published experimental data could be used to demonstrate a technical effect that was not explicitly derivable from the application as filed.

In the impugned decision, the opposition division had rejected the opposition filed against the patent, concluding that the subject-matter of the claims according to the main request involved an inventive step. In arriving at this conclusion, the opposition division had taken into account an effect evidenced by post-published data.

The post-published experimental data in question comprised two tables filed by the patent proprietor (respondent) during the examination phase. These tables showed that Form 1 of vemurafenib exhibited increased water solubility and bioavailability in comparison with Form 2. The opposition division had relied on these data to formulate the objective technical problem as providing an improved form of vemurafenib with the aim of overcoming known solubility issues.

The appellant (opponent) did not dispute that the experimental data demonstrated increased water solubility and bioavailability achieved by Form 1 of vemurafenib compared with Form 2; however, it contested that the post-published experimental data could be used as the sole basis to demonstrate this effect, since this effect was not derivable from the application as filed.

The board considered order no. 2 of G 2/21, and determined that the question to be answered in the present case was thus whether the effect relied upon by the respondent and demonstrated in the post-published experimental data could be derived by the skilled person, having the common general knowledge in mind and based on the application as filed, as being encompassed by the technical teaching and embodied by the same originally disclosed invention.

The board concluded that the purported technical effect of increased water solubility and bioavailability of Form 1 over Form 2 was not disclosed or taught anywhere in the application as filed. By no means could the skilled person derive from the application as filed that one particular crystalline form, namely the claimed Form 1, had good solubility and bioavailability, let alone solubility and bioavailability that was better than that of another crystalline form (Form 2).

It followed that, based on the application as filed, and having the common general knowledge in mind, the skilled person would not have derived the purported technical effect, i.e. the increased water solubility and bioavailability of Form 1 of vemurafenib over Form 2, as being encompassed by the technical teaching of the application as filed, let alone that the skilled person would have derived it as being embodied by the same originally disclosed invention. Therefore, it could not be taken into account for formulating the objective technical problem in accordance with G 2/21.

In the absence of a technical effect achieved by the distinguishing feature of claim 1, the objective technical problem was defined as providing an alternative crystalline form of vemurafenib, as formulated by the appellant. The board found that the subject-matter of claim 1 of the main request lacked an inventive step in view of the closest prior art (D1) in combination with the common general knowledge represented by D4. As a result, the board set aside the decision of the opposition division and revoked the patent.

013-02-24

## 2. Article 056 EPC | T 0183/21 | Board 3.5.07

### Article 056 EPC

<b>Case Number</b>	T 0183/21
<b>Board</b>	3.5.07
<b>Date of decision</b>	2023.09.29
<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>	Article 056 EPC
<b>EPC Rules</b>	
<b>RPBA</b>	
<b>Other legal provisions</b>	
<b>Keywords</b>	inventive step – mixture of technical and non-technical features – technical character
<b>Cited decisions</b>	T 1869/08, T 0306/10
<b>Case Law Book</b>	<a href="#">I.D.9.2.9</a> , 10th edition

In [T 183/21](#) the application related to controlling a recommender configured to provide up-to-date predictions of user preferences for products within a large set, for example within a Video on Demand (VOD) catalogue. The claim defined a method of automatically controlling the performance of a recommender system in a communications system, the communications system including a client device associated with a user to which the recommendations were provided. The board noted that recommending products is not generally recognised as having technical character (T 1869/08, T 306/10) and the appellant had thus argued that the purpose of the invention was rather to limit the amount of resources used.

The board found that the technical effect of the distinguishing features was that the use of network bandwidth required to provide the training data to the recommender system was minimised, as was the amount of storage necessary for storing said training data in the communications system including the client device and the recommender system. The amount of training data was indirectly limited via the tendency/convergence of the measured performance metric towards, or oscillation around, the predetermined level of recommendation performance, which was not necessarily the maximum achievable level of recommendation performance. The board came to the conclusion that this technical effect was achieved, on average, over substantially the whole scope of the claim.

014-02-24

### 3. Article 056 EPC | T 1246/21 | Board 3.4.02

#### Article 056 EPC

<b>Case Number</b>	T 1246/21
<b>Board</b>	3.4.02
<b>Date of decision</b>	2023.07.14
<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 056, 084, 123(2) EPC
<b>EPC Rules</b>	
<b>RPBA</b>	
<b>Other legal provisions</b>	
<b>Keywords</b>	inventive step (no) – final stage of the problem and solution approach – obvious combination of known features – skilled person’s common general knowledge when combining two prior art documents
<b>Cited decisions</b>	
<b>Case Law Book</b>	<a href="#">I.D.10.4.</a> , 10th edition

In [T 1246/21](#) the appellant (patent proprietor) appealed against the opposition division’s decision to revoke the patent. As an auxiliary measure, the proprietor requested that the patent be maintained on the basis of claims according to one of the auxiliary requests filed with the statement of grounds of appeal. The board agreed with the opposition division's formulation of the objective technical problem starting from D3 (undisputed closest prior art) as finding an alternative for the image icons with increased resolution.

As regards the application of the problem-solution approach, the appellant argued that in its strict application, the skilled person combining the teaching of D3 with that of D2 would arrive in a straightforward manner only at the provision of a protective layer over the focusing elements (as known from D3). However, there was no indication in either D2 or D3 or a combination thereof to use a protective layer which covered the focusing elements and also filled the interstitial spaces between them. Arriving at this feature would clearly involve hindsight.

With respect to a combination of two documents, the proprietor argued that for some of the claimed features the documents provided no "direct and unambiguous disclosure" and that "[a]ccording to the problem-solution approach, if there is any remaining feature not taught by this combination, the subject-matter claimed has to

be acknowledged to involve an inventive step". The board disagreed with this application of the problem-solution approach. In the fourth and final stage of the problem-solution approach it was to be considered "whether or not the claimed solution, starting from the closest prior art and the objective technical problem, would have been obvious to the skilled person" (Case Law of the Boards of Appeal, 10<sup>th</sup> ed. 2022, I.D.2). This was the stage most closely related to the requirement of Art. 56 EPC according to which "[a]n invention shall be considered as involving an inventive step if, having regard to the state of the art, it is not obvious to a person skilled in the art".

The board stated that since Art. 56 EPC and the final stage of the problem-solution approach both considered what was obvious to a person skilled in the art, an inventive step could not be acknowledged solely on the finding that the claimed subject-matter was not directly and unambiguously disclosed from the combination of two documents. In other words, when considering the question of whether an invention was obvious starting from a document representing the closest prior art in combination with another document, it was not the mere sum of the teachings of these two documents that had to be considered. An inventive step could not be acknowledged solely on the finding that the claimed subject-matter was not directly and unambiguously disclosed from the combination of two documents. The skilled person's common general knowledge and skills also had to be taken into account when combining the two documents.

In the case at hand, D3 did not disclose that the protective layer filled interstitial spaces between and covered the focusing elements and formed a distinct interface between the first and the second materials, as discussed above. However, the board found that for the person skilled in the art considering the specific implementation of the protective layer taught by D3, it would be obvious not only to fill the concave parts of the lenses with material but also to cover the spaces between them in order to provide sufficient protection for the focusing elements. Otherwise, the boundaries between the filled portions and the protrusions would act as points of attack for harmful environmental conditions, as would be readily apparent to the skilled person. In addition, in view of the required relationship between the refractive indices, it would be clear to the skilled person that the protective layer would necessarily have to be formed without an additional intermediate layer and would therefore also form a distinct interface with the first material.

In conclusion, the board was of the opinion that the subject-matter of claim 1 did not involve an inventive step starting from D3 in view of D2. The patent proprietor's arguments with regard to the remaining auxiliary requests were also unsuccessful for reasons of lack of inventive step, added subject matter and clarity, and the board dismissed the proprietor's appeal.

015-02-24



## 4. Article 083 EPC | T 1210/20 | Board 3.3.02

### Article 083 EPC

<b>Case Number</b>	T 1210/20
<b>Board</b>	3.3.02
<b>Date of decision</b>	2023.11.30
<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(5), 083, 100(b) EPC
<b>EPC Rules</b>	
<b>RPBA</b>	
<b>Other legal provisions</b>	
<b>Keywords</b>	sufficiency of disclosure – level of disclosure required for medical use – evidence of therapeutic effect – credibility of the therapeutic effect in the application as filed – G 2/21
<b>Cited decisions</b>	G 0002/21
<b>Case Law Book</b>	<a href="#">II.C.7.2.2</a> , 10th edition

In [T 1210/20](#) independent claim 15 was a "Swiss-type" second medical use claim directed to the use of eltrombopag in the manufacture of a medicament for the treatment of precancerous syndrome. Independent claim 18 was a second medical use claim pursuant to Art. 54(5) EPC directed to a pharmaceutical composition comprising eltrombopag for use in the prevention of cancer in a precancerous syndrome.

The board explained it was established case law that in a second medical use claim, the therapeutic effect, in the present case the prevention of cancer in a precancerous syndrome, was a technical feature of the claim. It was undisputed that the issue of whether this effect is achieved is a question of sufficiency of disclosure under Art. 83 EPC.

The application comprised examples with data. The credibility of this data was not called into question by the appellant (opponent) insofar as the treatment of cancer was concerned. The appellant argued however that the data in the application as filed did not constitute proof that eltrombopag was effective specifically in preventing a precancerous syndrome from progressing to cancer as required by claims 15 and 18. Such proof was required according to G 2/21 (point 77 of the Reasons). Since the application as filed was absent any proof of the claimed effect, the invention defined in claims 15 and 18 was not sufficiently disclosed.

Point 77 of G 2/21 cited by the appellant in support of its argument that proof was required reads as follows : "...the proof of a claimed therapeutic effect has to be provided in the application as filed, in particular if, in the absence of experimental data in the application as filed, it would not be credible to the skilled person that the therapeutic effect is achieved. A lack in this respect cannot be remedied by post-published evidence."

The board acknowledged that as stated by the appellant, the data in the application as filed, which concerned the treatment of cancer, did not represent direct proof. However, the appellant's contention that according to G 2/21, proof of a technical effect was unconditionally required in the application as filed, was not correct. Rather, point 77 of the Reasons in G 2/21 referred to the requirement for proof in the application as filed in particular if it would not be credible to the skilled person that the claimed therapeutic effect was achieved on the basis of the application as filed. It explained that the corollary of this statement was that if a therapeutic effect was rendered credible by the application as filed, then such proof – in terms of concrete experimental data – might not be necessary. This understanding was also supported by point 74 of the Reasons (final paragraph) of G 2/21, which the board found to be consistent with point 77 of said decision in that it did not state that proof in the application as filed was a requirement for sufficiency of disclosure to be acknowledged. Hence, in order to fulfil the requirements of sufficiency of disclosure, it was enough that the application as filed rendered the claimed therapeutic application credible. General knowledge could be taken into account. D9, a journal article, represented the common general knowledge.

The board concluded that the data in the application as filed credibly demonstrated the anti-proliferative effect of eltrombopag. Since it was known at the filing date of the patent that precancerous conditions were also at least in part characterised by abnormally proliferating cells, it was credible on the basis of this data that eltrombopag was also effective in the treatment of precancerous syndromes by prevention of cell proliferation, and hence the prevention of cancer. No evidence to the contrary was submitted by the appellant. Consequently, the invention defined in claims 15 and 18 satisfied Art. 83 EPC.

016-02-24

## 5. Article 083 EPC | T 0174/21 | Board 3.5.03

### Article 083 EPC

<b>Case Number</b>	T 0174/21
<b>Board</b>	3.5.03
<b>Date of decision</b>	2023.12.05
<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 – invention to be performed over whole range claimed and indication of "at least one way" – disclosure of "at least one way" but not over the whole scope claimed – field of audiology – claim interpretation – non-working embodiments – technically meaningful interpretation
<b>Cited decisions</b>	T 2210/16, T 2773/18, T 0149/21, T 0867/21
<b>Case Law Book</b>	<a href="#">II.C.5.2.</a> , <a href="#">II.C.5.4.</a> , <a href="#">V.A.3.3.1.</a> , 10th edition

In [T 174/21](#) the invention concerned a method of estimating an acoustic transfer quantity by employing a hearing instrument, and a hearing instrument therefor.

The opposition was rejected. The opposition division considered the opposed patent to specify "at least one way" to carry out the method of claim 1. However, in the board's view this did not mean that the opposed patent disclosed the claimed invention, i.e. the subject-matter of claim 1, in a manner sufficiently clear and complete for it to be carried out by the skilled person. This would only be the case if the "at least one way" covered, possibly augmented with the skilled person's common general knowledge, the "whole range claimed" (T 867/21). With reference to T 2773/18, the respondent (patent proprietor) expressed some doubts as to the applicability of the "whole range claimed"-requirement in the field of audiology. However, the board considered that these doubts were unfounded. The board referred in this respect to the conclusions drawn in T 149/21.

The board found that the claimed method of "estimating an acoustic transfer quantity representative of a sound pressure transfer to the eardrum of an ear" could not be carried out for all kinds of frequency-dependent and ear-independent reference

characteristics encompassed by feature (c). In particular, a "microphone characteristic" constituted one example of a hearing-instrument characteristic that was frequency-dependent and ear-independent but for which the claimed method could not be carried out. This was because a microphone characteristic typically bears no information on how the ear canal actually impacts incident sound. Such information was however crucial when determining the "ear-canal impedance" in accordance with feature (c). As a result, a "microphone characteristic" could not be used to carry out the method defined in claim 1.

The respondent contested that the skilled reader would consider a "microphone characteristic" to be a "frequency-dependent ear-independent characteristic" within the meaning of feature (c). In the respondent's view, the common patent-law practice of drafting claims as a generalisation of the description's disclosure inherently meant that some "non-working embodiments" could not be explicitly ruled out. The board noted, however, that the issue at hand was not whether certain embodiments "work" or not. Instead, it concerned whether the skilled person could carry out the claimed method over the "whole scope claimed". To establish whether that was the case, the "whole scope claimed" had to indeed be determined through the eyes of the skilled reader, i.e. based on objective criteria and closely following the wording of a claim. This practice avoided taking into account embodiments which were theoretically possible but not "technically meaningful". However, this did not mean that only those claim interpretations could be considered "technically meaningful" where the requirements of the EPC were met (cf. T 2210/16).

The respondent could not persuade the board that feature (c) would be enabled even with a microphone characteristic as "frequency-dependent and ear-independent reference characteristics". This was because a "microphone characteristic", taken by itself, simply did not comprise the necessary information to determine the "ear-canal impedance" in accordance with feature (c).

The board also dealt with the respondent's objection that the board had raised the issue applicability over the whole range ex officio (see point 2.2.2 of the Reasons).

In conclusion the ground for opposition under Art. 100(b) EPC prejudiced the maintenance of the opposed patent in its granted form.

017-02-24

## 6. Article 083 EPC | T 0552/22 | Board 3.3.08

### Article 083 EPC

<b>Case Number</b>	T 0552/22
<b>Board</b>	3.3.08
<b>Date of decision</b>	2023.09.19
<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), 113(1) EPC
<b>EPC Rules</b>	
<b>RPBA</b>	
<b>Other legal provisions</b>	
<b>Keywords</b>	sufficiency of disclosure – invention to be performed over whole range claimed and indication of "at least one way" – technical concept fit for generalisation – post-published documents and right to be heard
<b>Cited decisions</b>	G 0001/03, G 0002/21, T 0435/91, T 0743/97
<b>Case Law Book</b>	<a href="#">II.C.5.2.</a> , <a href="#">II.C.5.4.</a> , 10th edition

In [T 552/22](#) the invention lay in the field of fermentative production of human milk oligosaccharides, in particular the production of fucosyllactose. While the SET family of proteins comprised proteins SetA, SetB and SetC, claim 1 was not limited to these three proteins but related generally to any protein of the SET family of proteins. Implementation of the claimed functional requirement of the bacterial cells required that overexpression of the protein of the SET family leading to an export of fucosyllactose be achievable at the filing date without undue burden over the whole range claimed.

The board recalled that the requirements of sufficiency of disclosure were met if a person skilled in the art could carry out the invention as defined in the independent claims over the whole ambit of the claims without undue burden based on the disclosure in the patent application. The disclosure of one way of performing an invention was only sufficient if it allowed the invention to be performed over the whole range claimed. This principle applied to any invention, irrespective of how it was defined, be it by way of a functional feature or not. A functional definition was acceptable if all alternatives were available and achieved the desired result. For functional definitions of a technical feature, it had to be established whether or not the patent application disclosed a technical concept fit for generalisation which made the host of variants encompassed by the functional definition available to the skilled

person. Sufficiency of disclosure had to be shown to exist at the effective date of the patent (priority date or date of filing), i.e. on the basis of the information in the patent application as a whole and taking into account the common general knowledge then available to the skilled person. A lack in this respect could not be remedied by post-published evidence (cf. G 1/03, point 2.5.3 of the Reasons).

The board stated that overexpression of SetA in *E. coli* was one way of performing the claimed invention that was disclosed in the patent. However, claim 1 was not limited to the overexpression of SetA. While the patent mentioned SetB and SetC, it reported no data on these two proteins or any explanation, reasoning or technical basis.

With respect to G 2/21, the board observed that G 2/21 held that "the term 'plausibility' [...] does not amount to a distinctive legal concept or a specific patent law requirement under the EPC", and that G 2/21 explicitly ruled on plausibility only in the context of Art. 56 EPC, distinguishing it from the context of Art. 83 EPC. Therefore, in the board's view nothing could be gained by the respondent (patent proprietor) by referring to plausibility in the given context. Moreover, contrary to the respondent's assertion, the opposition division did not find that "the patent specification already contains experimental evidence showing the plausibility of the claimed technical effect" but that the possibility that "... for all three setA, B, and C" was not "inherently implausible". The board held, however, that something not inherently implausible was not necessarily sufficiently disclosed. And the opposition division had not explained why it was not "inherently implausible".

The skilled person wanting to perform the claimed invention had to test the Set family members including SetB and SetC with no guarantee that any of the tested proteins would work. In view of the case law summarised by the board, this amounted to an undue burden, even if it involved routine experimentation.

In conclusion, there was no relevant guidance in the patent application and the common general knowledge on SET family proteins, except SetA. The patent application and the prior art did not demonstrate that any teaching shown in the patent on SetA could be extended to other SET family proteins, including SetB and SetC. The appellant was therefore under no obligation to provide further experimental evidence to support the insufficiency objection. The main request did not meet the requirements of sufficiency of disclosure. The lack of disclosure could not be remedied by post-published evidence. And the right to be heard did not entail the right to have post-published evidence considered.

018-02-24

## 7. Article 084 EPC | T 0223/23 | Board 3.3.07

### Article 084 EPC

<b>Case Number</b>	T 0223/23
<b>Board</b>	3.3.07
<b>Date of decision</b>	2024.01.08
<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>	Article 084 EPC
<b>EPC Rules</b>	
<b>RPBA</b>	
<b>Other legal provisions</b>	
<b>Keywords</b>	claims – essential features – support in the description (yes)
<b>Cited decisions</b>	T 0242/92, T 0809/12
<b>Case Law Book</b>	<a href="#">II.A.3.2.</a> , <a href="#">II.A.5.1.</a> , 10th edition

In [T 223/23](#) claim 1 of the main request was directed at a product as such, namely a trace element solution. It clearly defined the solution by its technical features, i.e. the types and amounts of the trace elements (zinc, manganese, selenium and copper) dissolved therein.

The examining division had found that the criteria of Art. 84 EPC were not met because it was the process of manufacturing that provided the increased concentrations of trace elements in solution. In its view, claim 1 was not supported because it lacked the essential features defining the identity of the product. Moreover, the examining division held that claim 1 defined the trace element solution by a result to be achieved, namely trace elements at high concentrations being able to remain in solution, but claim 1 did not state the essential features necessary to achieve this result.

The board disagreed with the views of the examining division. The board noted that defining the claimed product in terms of the process used for its preparation, i.e. by a product-by-process feature, could only further characterise the composition insofar as this process gave rise to a distinct and identifiable characteristic of the product. In this sense, the steps of the process could not themselves be regarded as essential features of the product: at most the technical features imparted by this process to the resulting product could represent such essential features.

The board understood the examining division's conclusions to be motivated by the finding that the preparation of a trace element solution with the claimed high concentration could not be achieved in the prior art and was part of the problem to be solved mentioned in the application, and that the process disclosed in the application was the first process to allow such a preparation. In contrast, the board held that this situation did not justify that each and every feature imparted by the process shown in the example to the resulting composition be seen as an essential feature. As explained in T 242/92, the mere fact that only one way of carrying out the invention was indicated did not in itself offer grounds for considering that the application was not entitled to broader claims. A lack of support would only arise if there were well-founded reasons for believing that the skilled person would be unable to extend the particular teaching of the description to the whole of the field claimed by using routine methods. In the underlying case the absence of reference in claim 1 to the EDTA used in the example did not lead to a lack of support, considering that the description mentioned EDDS as an alternative, and considering the absence of an indication that the skilled person could not use other chelants. Moreover, the board noted that the examining division had not determined which feature of the trace element solution would be missing from claim 1 and would be essential for obtaining the high concentration recited in the claim.

The board concluded that even if, according to the description, the invention aimed at providing a highly concentrated trace element solution, and provided for the first time a process allowing the preparation of such a highly concentrated solution, this did not mean that the claims should be limited to that particular process or to a solution defined in terms of that particular process for them to comply with Art. 84 EPC.

019-02-24



## 8. Article 114 EPC | T 0307/22 | Board 3.2.04

### Article 114 EPC

<b>Case Number</b>	T 0307/22
<b>Board</b>	3.2.04
<b>Date of decision</b>	2023.10.27
<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>	Articles 087(1), 089, 114 EPC
<b>EPC Rules</b>	Rule 116(1) EPC
<b>RPBA</b>	Articles 12(6), 13(1), 13(2) RPBA 2020
<b>Other legal provisions</b>	
<b>Keywords</b>	late submissions – review of first instance discretionary decision – late-filed document – review of substantive issues underlying the discretionary decision – same invention (no) – partial priority (yes) – amendment after summons – exceptional circumstances (yes) – exercise of discretion – admitted (no)
<b>Cited decisions</b>	G 0001/15
<b>Case Law Book</b>	<a href="#">V.A.3.4.1</a> , <a href="#">V.A.3.4.3.a</a> , <a href="#">V.A.4.3.6</a> , <a href="#">V.A.4.5.11</a> , 10th edition

In [T 307/22](#) richtete sich die Beschwerde der Einsprechenden gegen die Entscheidung der Einspruchsabteilung, in der unter anderem D7 wegen mangelnder Relevanz nicht zum Verfahren zugelassen wurde.

Im Einspruchsverfahren hatte die Einsprechende die gültige Inanspruchnahme der Priorität aus D8 bestritten und einen Neuheitseinwand auf die inhaltsgleiche Gebrauchsmusteranmeldung D7 (mit gleichem Anmeldetag wie D8) gestützt. Die Einspruchsabteilung hatte jedoch die Gültigkeit der Priorität bestätigt und die verspätet vorgelegte D7 als nicht relevant (da nicht zum Stand der Technik gehörig) nicht zum Einspruchsverfahren zugelassen.

Die Kammer wies darauf hin, dass eine Beschwerdekammer grundsätzlich darauf beschränkt ist zu überprüfen, ob die Einspruchsabteilung ihr Ermessen gemäß Art. 114, R. 116 (1) EPÜ bei der Nichtzulassung eines verspätet vorgebrachten Dokuments korrekt ausgeübt hat, d.h. nicht willkürlich und unter Berücksichtigung von angemessenen Kriterien (siehe Rechtsprechung der Beschwerdekammern, 10. Aufl. 2022, V.A.3.4.1.b). Somit entscheide die Kammer in der Regel nicht

nochmals an Stelle der Einspruchsabteilung über die Zulassung in Ausübung eigenen Ermessens. Vorliegend beruhe die Ermessensentscheidung der Einspruchsabteilung jedoch auf einer vorhergehenden materiellrechtlichen Feststellung der gültigen Inanspruchnahme der Priorität und damit der Zuerkennung eines entsprechenden Zeitrangs für das Patent. Eine solche Entscheidung über Priorität und Zeitrang sei durchaus einer Überprüfung durch die Kammer zugänglich (Rechtsprechung der Beschwerdekammern, 10. Aufl. 2022, V.A.3.4.1.c)).

Bei dieser Überprüfung kam die Kammer zu dem Schluss, dass Anspruch 1 gemäß Hauptantrag (erteilte Fassung) entgegen der Feststellung der Einspruchsabteilung nicht über seinen gesamten Umfang der über die Priorität beanspruchte Zeitrang zukomme. Damit entfalle die Grundlage für die Ermessensentscheidung der Einspruchsabteilung, D7 nicht zum Verfahren zuzulassen. Die Kammer befand erneut über die Zulassung der D7 mit dem Ergebnis, dass diese Entgeghaltung – aufgrund der wirksamen Inanspruchnahme einer Teilpriorität nach den Grundsätzen aus G 1/15 – wiederum wegen mangelnder Relevanz für die Neuheit nicht zugelassen wurde.

Den erstmals in der mündlichen Verhandlung vorgetragenen Einwand, dass D7 für die Alternativen des Anspruchs 1, denen nicht der Zeitrang der D8 zukomme, geeignet sei, die erfinderische Tätigkeit in Frage zu stellen, ließ die Kammer in Ausübung ihres Ermessens nach Art. 13 (1), (2) VOBK nicht zum Verfahren zu. Zwar sah die Kammer einen außergewöhnlichen Umstand darin, dass sie in ihrer Mitteilung nach Art. 15 (1) VOBK die Auffassung vertreten hatte, dass der Gegenstand von Anspruch 1 des Hauptantrags statt vollumfänglicher Priorität aus D8 nur Teilpriorität genieße, da sich daraus erstmalig ergab, dass D7 geeignet sein könnte, die erfinderische Tätigkeit der Alternativen mit späterem Zeitrang in Frage zu stellen. Die Kammer stellte aber in einem zweiten Schritt im Rahmen ihrer Ermessensausübung nach den Kriterien des Art. 13 (1) VOBK auf die prima facie Relevanz von D7 für die erfinderische Tätigkeit ab und ließ D7 letztlich mangels einer solchen Relevanz nicht zum Verfahren zu.

020-02-24

## 9. Article 123(3) EPC | T 0664/20 | Board 3.3.10

### Article 123(3) EPC

<b>Case Number</b>	T 0664/20
<b>Board</b>	3.3.10
<b>Date of decision</b>	2023.10.18
<b>Language of the proceedings</b>	FR
<b>Internal distribution code</b>	D
<b>Inter partes/ex parte</b>	Inter partes
<b>EPC Articles</b>	Article 123(3) EPC
<b>EPC Rules</b>	
<b>RPBA</b>	
<b>Other legal provisions</b>	
<b>Keywords</b>	amendments – extension of the protection conferred (yes) – cascade formulation
<b>Cited decisions</b>	T 2017/07, T 0999/10, T 0287/11, T 0881/11, T 1360/11, T 0052/13, T 0262/13, T 0865/13, T 0306/14, T 0514/14, T 1063/15, T 2215/18
<b>Case Law Book</b>	<a href="#">II.E.2.3.3</a> , <a href="#">II.E.2.4.13</a> , 10th edition

See also abstract under [Article 12\(3\) RPBA](#).

Dans la décision [T 664/20](#) la chambre a notamment indiqué dans son exergue qu'une formulation dite "en cascade" de caractéristiques est susceptible d'entraîner une ambiguïté de la revendication. Lorsqu'une revendication est définie comme incluant une classe générique de composés présents dans une gamme pondérale et que la revendication est modifiée "en cascade" en indiquant que la classe générique est un composé spécifique, alors la gamme pondérale s'applique à ce composé spécifique, et non plus à la classe générique.

Dans la présente affaire, la revendication 1 de la requête subsidiaire 3 a été modifiée en indiquant que le copolymère fonctionnel est l'anhydride maléique. La limitation à 1% en poids des copolymères fonctionnels requis par les revendications du brevet tel que délivré ne s'applique plus qu'à l'anhydride maléique. La composition de la revendication 1 de la requête subsidiaire 3, du fait qu'elle est définie comme étant ouverte à la présence de composés optionnels, peut ainsi comprendre l'acide acrylique dans une proportion supérieure à 1% en poids, ce qui n'était pas couvert par les revendications du brevet tel que délivré, car l'acide acrylique étant un comonomère fonctionnel, sa quantité y est limitée à 1% (voir T 2017/07). La chambre arrive donc à la conclusion que la revendication 1 de la requête subsidiaire 3 ne satisfait pas aux exigences de l'art. 123(3) CBE.

L'exergue de T 999/10, invoqué par le réquerant I (titulaire), indique que la formulation "en cascade" dans une revendication ouverte ("comprenant"), c'est-à-dire, en gardant dans une revendication modifiée la définition large de la revendication 1 et en ajoutant, par le biais de la tournure "et dans lequel/laquelle...", une restriction supplémentaire, évite la situation envisagée par T 2017/07 où une modification initialement apportée dans l'intention de restreindre une revendication étendait en fait la protection conférée par celle-ci.

Cependant, la chambre dans la présente affaire estime que la revendication 1 de la requête subsidiaire 3 ne maintient pas la limitation relative à la quantité des comonomères fonctionnels présents dans la composition de la revendication 1 du brevet tel que délivré. La chambre s'écarte de l'interprétation restrictive suivie dans l'affaire T 999/10 dans laquelle il avait été jugé que compte tenu de la formulation en cascade de la revendication modifiée, il n'y avait aucun doute quant à l'intention du titulaire du brevet qu'aucun copolymère séquencé autre que le type SIS spécifique ne puisse être présent dans l'adhésif. Cette interprétation restrictive de la portée de la revendication a été adoptée dans les affaires T 262/13, T 1063/15 et T 2215/18. Cependant, elle n'a pas été suivie dans les affaires T 514/14, T 881/11, T 52/13, T 865/13 et T 287/11.

La chambre ici rejette l'argumentation basée sur les intentions du rédacteur d'une revendication et fait siennes les considérations du point 2.8.2 des motifs de T 287/11 selon lesquelles l'étendue de la protection est un critère objectif qui doit s'apprécier sur la base de la signification des caractéristiques techniques présentes dans la revendication et non pas à la lumière de l'intention du rédacteur de la revendication. La chambre souscrit également au point 2 des motifs de T 514/14 énonçant qu'une modification apportée à une revendication ne doit pas conduire à une ambiguïté, et ce d'autant plus, si la modification ouvre la voie à une interprétation techniquement sensée qui, si elle est adoptée, rend la revendication contestable au motif qu'elle étend la portée de la protection conférée par le brevet tel que délivré.

La décision T 999/10 poursuit en indiquant que même si la revendication devait être interprétée comme n'excluant pas la présence d'autres copolymères à blocs, la formulation en cascade choisie par le titulaire du brevet signifie que la condition limitant la quantité de copolymères à blocs, définie de manière plus large dans la revendication 1, doit également être remplie dans la revendication modifiée. Cependant, la chambre a rejeté cette interprétation. La chambre considère que le comonomère fonctionnel étant l'anhydride maléique dans le cas de l'espèce, pour interpréter la revendication 1 de manière à ce que le taux maximum de 1% en poids s'applique à l'ensemble des comonomères fonctionnels présents dans la composition, il faut donner deux significations différentes au même terme de la revendication 1, à savoir que le terme "comonomère fonctionnel" désigne l'anhydride maléique sauf lorsqu'il s'agit de l'aspect quantitatif, auquel cas ce terme ne désignerait plus l'anhydride maléique, mais tout comonomère fonctionnel.

021-02-24

## 10. Rule 137(3) EPC | T 1591/23 | Board 3.2.07

### Rule 137(3) EPC

<b>Case Number</b>	T 1591/23
<b>Board</b>	3.2.07
<b>Date of decision</b>	2024.01.08
<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>	Article 113(1) EPC
<b>EPC Rules</b>	Rules 103(1)(a), 116(2), 137(3) EPC
<b>RPBA</b>	
<b>Other legal provisions</b>	
<b>Keywords</b>	amendments of application – consent of examining division (no) – exercise of discretion – substantial procedural violation (yes) – reimbursement of appeal fee (no)
<b>Cited decisions</b>	T 0756/18
<b>Case Law Book</b>	<a href="#">IV.B.2.4.5</a> , <a href="#">V.A.11.7.1</a> , 10th edition

In [T 1591/23](#) the board considered the exercise of the examining division's discretion pursuant to R. 137(3) EPC. The examining division had decided not to admit auxiliary requests XV to XXVI before the text thereof was submitted by the applicant. According to the appealed decision auxiliary requests XV to XXVI were not admitted because none of the auxiliary requests filed and discussed beforehand "seriously addressed" the objections of lack of clarity and added subject-matter raised since the beginning of the proceedings, giving the impression that the applicant tried to shift to the examining division the burden of identifying EPC-compliant subject-matter. Based on this impression the examining division had concluded that refusing to admit these amendments in advance was within the limits of its discretion under R. 116(2) and 137(3) EPC, and had decided not to give consent to these further requests.

The board stated that according to the established case law of the boards of appeal the power of the examining division to consent to amendments under R. 137(3) EPC was a discretionary power that had to be exercised after considering all the relevant factors of the specific case and balance in particular the applicant's interest in obtaining an adequate protection for its invention and the EPO's interest in bringing the examination to a close in an effective and speedy way. It was however clearly not possible to do any such assessment as long as the amended set of claims whose admissibility had to be decided upon had not yet been filed (T 756/18).

Therefore, the examining division had not based its exercise of discretion on an assessment of the extent to which auxiliary requests XV to XXVI were suitable to overcome the existing objections, but had decided on the basis of its negative findings in relation to the main request and auxiliary requests I to XIV. The board held that the examining division's refusal of consent to amendments made in advance of the amendment being submitted, not being a reasonable exercise of discretion pursuant to R. 137(3) EPC, amounted to a substantial procedural violation. The board concurred with the appellant that their right to be heard had been violated (Art. 113(1) EPC).

In relation to the request for reimbursement of the appeal fee (R. 103(1)(a) EPC), the board followed the established case law that a reimbursement is not automatically equitable once a procedural violation has been established and the appeal is allowable, but there should also be a link between the procedural violation identified above and the part of the decision under appeal which has to be set aside. As the appeal had to be filed on the basis of the main request, no such link could be identified, and there was no reason to reimburse the appeal fee on the basis of the aforementioned procedural violation. As a consequence, the request for reimbursement of the appeal fee was refused.

022-02-24

## 11. Rule 164 EPC

| T 0044/19

| Board 3.2.08

## Rule 164 EPC

<b>Case Number</b>	T 0044/19
<b>Board</b>	3.2.08
<b>Date of decision</b>	2023.11.27
<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>	Article 082 EPC
<b>EPC Rules</b>	Rule 164(2)(a), 164(4), 164(5) EPC
<b>RPBA</b>	
<b>Other legal provisions</b>	Articles 15(3), 17(3)(a) PCT
<b>Keywords</b>	unity of invention – invitation to pay further search fees justified (no) – refund of further search fee (yes)
<b>Cited decisions</b>	
<b>Case Law Book</b>	<a href="#">II.B.6.2.</a> , <a href="#">II.B.6.4.</a> , 10th edition

In [T 44/19](#) the appeal was filed by the applicant against the interlocutory decision of the examining division to refuse the request for refund of the second search fee.

The application had been filed as an international application. The search examiner, acting as International Search Authority, had found that the originally filed claims did not fulfil the requirements of unity of invention but contained two inventions: a first invention in claims 1 to 4 and 6 to 9 and a second invention in claims 5 and 10 to 11. Thus, the applicant had been invited to pay an additional search fee according to Art. 17(3)(a) PCT. No additional search fee was paid in the international phase of the application.

After the entry of the application into the regional phase before the EPO, the examining division sent a communication under R. 164(2)(a) EPC. In this communication the examining division agreed with the finding of lack of unity in the International Preliminary Report on Patentability and invited the applicant to pay an additional search fee for the second invention. The applicant paid this additional search fee and a search was carried out for the second invention. The applicant requested the refund of the additional search fee under R. 164(5) EPC.

The board agreed with the appellant that the search for the first invention had covered the second invention. The board noted that the hub of claims 2 and 3 had the same function and addressed the same technical problem as the hub of the

second invention identified by the objection to lack of unity raised by the search examiner. Consequently, during the search for the first invention and having due regard to the description and drawings, the search examiner had already searched for a hub according to the second invention.

In the particular circumstances of the case, the board found that it was irrelevant whether the examining division correctly considered that there was a lack of unity in the claims. According to R. 164(2) EPC, the examining division may only ask for the payment of an additional search fee if it "considers that in the application documents which are to serve as the basis for examination an invention, or a group of inventions within the meaning of Article 82, is claimed which was not searched by the European Patent Office in its capacity as International Searching Authority". However, the search examiner had covered the second invention with the prior art search for claims 2 and 3, so that in fact this invention had been searched. The communication under R. 164(2)(a) EPC, and thus the request for an additional search fee, was therefore not justified and the additional search fee should have been refunded by the examining division under R. 164(5) EPC.

023-02-24



## 12. Article 12(3) RPBA | T 0664/20 | Board 3.3.10

### Article 12(3) RPBA 2020

<b>Case Number</b>	T 0664/20
<b>Board</b>	3.3.10
<b>Date of decision</b>	2023.10.18
<b>Language of the proceedings</b>	FR
<b>Internal distribution code</b>	D
<b>Inter partes/ex parte</b>	Inter partes
<b>EPC Articles</b>	
<b>EPC Rules</b>	
<b>RPBA</b>	Articles 12(3), 13(1) RPBA 2020
<b>Other legal provisions</b>	
<b>Keywords</b>	party's complete appeal case (no) – all requests pending in first instance to be addressed
<b>Cited decisions</b>	
<b>Case Law Book</b>	<a href="#">V.A.4.3.5b</a> , 10th edition

See also abstract under [Article 123\(3\) EPC](#).

Dans l'affaire [T 664/20](#) le requérant I (titulaire) a déposé certaines requêtes subsidiaires, dont la requête subsidiaire 3, avec sa réponse au mémoire de recours du requérant II (opposant). En réaction, le requérant II a déposé le document (24), issu d'une recherche supplémentaire et qui, à son avis, antériorisait l'objet des revendications de plusieurs requêtes, en particulier la requête subsidiaire 3.

Cette requête avait déjà été déposée dans la procédure d'opposition. Cependant, selon le requérant II, la première possibilité de déposer des documents issus d'une recherche additionnelle ne s'était présentée qu'au stade de la procédure de recours. Devant la division d'opposition, la requête subsidiaire 3 n'avait été déposée que deux mois avant la procédure orale, lors de laquelle la division d'opposition avait maintenu un brevet sur la base de la requête subsidiaire 2. Selon le requérant II, comme le requérant I avait déjà modifié à de nombreuses reprises ses jeux de revendications, y compris lors d'un premier recours, ce n'était pas prévisible que le requérant I allait redéposer les requêtes subsidiaires 3 à 15 dans la procédure de recours. La recherche additionnelle avait été initiée aussitôt après le dépôt des requêtes subsidiaires 3 à 15 dans la procédure de recours et le document (24) déposé dès que le requérant II en a eu connaissance.

La chambre n'a pas partagé cette approche. Selon la chambre, le mémoire exposant les motifs du recours d'un requérant (opposant) doit comprendre l'ensemble des

moyens couvrant toutes les requêtes pendantes devant la division d'opposition, y compris celles qui n'ont pas été considérées dans la décision contestée (voir Exergue 1). Le requérant II devait en l'espèce s'attendre à ce que le titulaire du brevet (requérant I) redépose les requêtes subsidiaires 3 à 15 dans la procédure de recours. Par conséquent, la chambre n'a pas admis le document (24), par application des art. 12(3), 13(1) RPCR.

024-02-24

### 13. Article 12(4) RPBA | T 0248/22 | Board 3.5.05

#### Article 12(4) RPBA 2020

<b>Case Number</b>	T 0248/22
<b>Board</b>	3.5.05
<b>Date of decision</b>	2023.11.15
<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>	
<b>EPC Rules</b>	
<b>RPBA</b>	Article 12(4) RPBA 2020
<b>Other legal provisions</b>	
<b>Keywords</b>	amendment to case – requests – admitted (no) – overcomes an objection that is part of the decision under appeal or the appeal proceedings (no)
<b>Cited decisions</b>	
<b>Case Law Book</b>	<a href="#">V.A.4.3.4a</a> , 10th edition

In [T 248/22](#) the board found that the main request and auxiliary request 1 could not be allowed – after the proprietor had withdrawn its appeal – as they were broader than auxiliary request 2 (*reformatio in peius*), and that auxiliary requests 2 to 5 were not allowable in their substance. Since auxiliary requests 6 to 10 were amended requests filed for the first time with the grounds of appeal and had not been previously presented in the proceedings, their admission was at the discretion of the board as per Art. 12(4) RPBA.

The proprietor argued that these requests could not have been filed earlier as they were filed in response to an objection by the opponent pursuant to Art. 123(2) EPC which was presented for the first time during the oral proceedings before the opposition division.

The board recalled that, in exercising its discretion whether to admit an amendment to a party's case, it had to consider whether the amendment was suitable for addressing the objections *raised* (Art. 12(4) RPBA). However, the board noted that, in the case in hand, the proprietor had argued that the amendments remedied an objection which was not part of the decision under appeal or the appeal proceedings. The objection had neither been admitted by the opposition division nor maintained on appeal by the opponent. The board held that any reason as to why an amendment

overcame an *unraised* objection did not constitute valid reasons for admitting an amended request in view of Art. 12(4), third and fourth sentences, RPBA.

In the absence of a valid reason for admitting auxiliary requests 6 to 10, the board decided not to admit them into these proceedings. The decision under appeal was set aside and the patent was revoked.

025-02-24



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