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# Abstracts of decisions

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## Abstracts of decisions

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## 1. Article 056 EPC | T 1001/18 | Board 3.4.03

**Article:** Article 056 EPC

**Case Number:** T 1001/18

**Board:** 3.4.03

**Date of decision:** 2022.10.10

**Language of the proceedings:** EN

**Internal distribution code:** D

**Inter partes/ex parte:** Ex parte

**EPC Articles:** Article 056 EPC

**EPC Rules:**

**RPBA:**

**Other legal provisions:**

**Keywords:** inventive step (yes) – problem and solution approach

**Cited decisions:** T 0495/91

**Case Law Book:** [I.D.4.2.2.](#), [I.D.4.4.3a](#)), 10th edition

In [T 1001/18](#) the invention related to a coin token assembly for use in a vending machine dispensing coin tokens. The board found D3 to be the most suitable spring-board for the problem and solution approach, whereas the impugned decision relied on D1 as the closest prior art. The board found that D1 had a completely different purpose to that of the present invention.

The main difference between the claimed invention and D3 was that the coin tokens were made of plastic having a thickness of 0.5 to 4 mm, rather than paper. The technical effect disclosed in the originally filed application was that the tokens could be counted by weighing. None of the cited documents D1 to D4 disclosed any other effect related to the use of plastic coin tokens.

The board stated that since the problem and solution approach defines the problem based on the effect of the differences from the closest prior art, and the effect is derived primarily from the disclosure of the invention, the effect documented in the present application documents alone was taken as the basis for the problem formulation. The board concluded that any further, undocumented effects would be speculative and should not be additionally included in the problem formulation (with reference to T 495/91, point 4.2 of the Reasons, as well as to the "Case Law of the Boards of Appeal of the European Patent Office", 10th edition, 2022, I.D.4.2.2). Consequently, the problem was formulated as "modifying D3 such that a supply of used coin tokens can be counted in simple manner".

Considering obviousness, the board found the paper coins in D3 were not suitable for counting by weighing and D3 did not give any hint either to count the tokens by weighing or to use another material (e.g. plastic) instead of paper. Therefore, given the teaching of D3 alone, the skilled person would not have considered a count by weighing. While D2 taught that a token could be made of plastic in form of a coin, it did not disclose counting them by weighing, and so the board found the skilled person would have had no reason to replace the paper tokens of D3 by the plastic tokens disclosed in D2 in order to solve the objective problem. Furthermore, even if, for some reason, the skilled person had considered combining the teaching of D2 with the teaching of D3, this would not have led to the claimed invention.

In summary, the board concluded the skilled person would have no incentive to modify the vending machine of D3 to make it suitable for dispensing plastic coins, which were suitable for counting by weighing. Therefore, starting from D3, the skilled person would not arrive at the combination of features (A) to (N).

The board judged that, taking into account the available prior art, the coin tokens assembly of claim 1 involved an inventive step within the meaning of Art. 56 EPC. It therefore ordered the decision under appeal be set aside and remitted to the department of first instance with the order to grant a patent on the basis of claims 1 to 13 of the main request submitted during the oral proceedings.

001-01-23

## 2. Article 056 EPC | T 1349/19 | Board 3.3.09

**Article:** Article 056 EPC

<b>Case Number:</b>	T 1349/19
<b>Board:</b>	3.3.09
<b>Date of decision:</b>	2022.09.13
<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 (yes) – ex post facto analysis (yes)
<b>Cited decisions:</b>	
<b>Case Law Book:</b>	<a href="#">I.D.6.</a> , 10th edition

In [T 1349/19](#) the objective technical problem was the provision of an alternative vegetable-derived fat composition which could mimic the fat composition of human milk and which could be produced in a simple and cost-effective manner. It was not contested that this problem had been solved by the provision of the claimed composition.

In order to show that the claimed solution to the underlying problem did not involve an inventive step, the appellant (opponent 3) relied primarily on D14. In the appellant's opinion, in order to provide a composition better suited to replace human milk, the skilled person would have increased the amount of C8:0 and C10:0 fatty acids in the fat blend of D19. They would have considered medium chain triglyceride oil (MCT oil) as the best source of C8:0 and C10:0 fatty acids. Consequently, they would have included 7% of the MCT oil mentioned in the patent to achieve a content of C8:0 and C10:0 fatty acids within the claimed ranges. The appellant went on to contend that the skilled person would also have been inclined to (a) reduce the randomised palm olein content to allow for the added 7% MCT oil; they would have also reduced the amount of palm olein, rather than that of soybean, sunflower and palm kernel oil, and (b) to replace 4% of the OPO-rich fat with 3% high oleic sunflower and 1% flaxseed oil.

The appellant acknowledged that, starting from D19, several steps had to be taken to arrive at the claimed composition. However, in its opinion, these steps were "interconnected such that a change in one will have an influence on one or more of the other steps". This meant that only two obvious modifications were required: the

replacement of some of the palm olein with MCT oil and the replacement of some of the OPO-rich fat with high oleic sunflower oil and flaxseed oil.

The board was not convinced and found a lack of incentive in the prior art to perform the steps suggested by the appellant.

The appellant further argued that, starting from D19, the skilled person was "likely to combine the teaching of D5, D9, D11, D14, D22 and D23 (to account for the known variation in human milk fat content) and thus arrive at a range for the amount of each fatty acid in human milk". In its opinion, a broad range defining possible amounts of each fatty acid could be created, combining the lowest and highest amounts of the fatty acids observed in the various milks disclosed in these documents. It then contended that, since the ranges in claim 1 were encompassed in, or at least overlapped with, these broadly defined ranges, the claimed composition was the result of a mere juxtaposition of obvious features selected by "cherry-picking" from the prior art.

The board concluded that the appellant's arguments involved a convoluted set of sequential steps conceived starting from the compositions defined in claim 1 and working backwards, in an attempt to bridge the considerable gap with the composition described in D19. Since these steps were not suggested by the prior art, the board held they could only be taken by exercising hindsight.

002-01-23

### 3. Article 056 EPC | T 1750/19 | Board 3.3.07

Article:	Article 056 EPC
<b>Case Number:</b>	T 1750/19
<b>Board:</b>	3.3.07
<b>Date of decision:</b>	2022.09.21
<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 (yes) – non-obvious alternative – skilled person
<b>Cited decisions:</b>	G 0007/93, G 0003/14, T 0910/02, T 0663/10, T 0671/12, T 1742/12, T 0166/17
<b>Case Law Book:</b>	<a href="#">I.D.3.1.</a> , <a href="#">I.D.6.</a> , 10th edition

In [T 1750/19](#) the board found that D4 was a suitable starting point for the assessment of inventive step. The appellant, on obviousness, argued that the skilled person knew from D8 that basically any low molecular weight compound having two functional groups that react with isocyanate may be used as a chain extender, and that as the lactic acid-ethylene glycol dimer in Example 17 of D1 was a diol, the skilled person would have considered it to be an alternative to the chain extender in D4 1,4-butenediol.

The board disagreed, finding that D4 could only be combined with Example 17 of D1 with hindsight; the skilled person had no motivation to replace the chain extender in Example 2 of D4 with the lactic acid-ethylene glycol dimer in Example 17 of D1.

The board stated it was apparent that the teaching of D4 and the teaching of D1 were incompatible and that the skilled person starting from D4 and seeking an alternative polyurethane had different options for modifying the original polymer, one of which was replacing the chain extender with an alternative chain extender. Should the skilled person select this option, they would certainly not turn to D1. They would look for compounds already known as polyurethane chain extenders rather than selecting a compound having a different function in a document containing teaching that is incompatible with the starting point. The common general knowledge disclosed in D8 did not change this conclusion; D8 would not give the skilled person any incentive to



select a compound from D1, which did not contain any teaching relating to chain extenders, just because the compound contained two hydroxyl groups.

The board found that the subject-matter of claim 1 was inventive and met the requirements of Art. 56 EPC. This was also the case for the other independent claims of the main request.

003-01-23

#### 4. Article 056 EPC | T 0605/20 | Board 3.3.07

<b>Article:</b>	<b>Article 056 EPC</b>
<b>Case Number:</b>	<b>T 0605/20</b>
<b>Board:</b>	3.3.07
<b>Date of decision:</b>	2022.11.11
<b>Language of the proceedings:</b>	EN
<b>Internal distribution code:</b>	C
<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 (yes) – formulation of the technical problem – no pointer to the solution – ex post facto analysis
<b>Cited decisions:</b>	T 0002/81, T 0800/91, T 0971/92, T 1170/02, T 0249/12, T 1087/15, T 0116/18
<b>Case Law Book:</b>	<a href="#">I.D.4.2.1</a> , <a href="#">I.D.4.2.2</a> , 10th edition

In [T 605/20](#) D3 represented the closest prior art. The difference between the composition of claim 1 as granted and the most pertinent exemplified compositions in document D3 relied upon by the appellant-opponents as starting points in the prior art was not in dispute and concerned the presence of propylene glycol in the composition claimed in the patent instead of the isotonic agents mannitol or glycerol in the compositions described in document D3.

Contrary to the arguments from the appellant-opponents the board found that the undesired phenomena observed in the patent with the use of the compositions comprising mannitol or glycerol of document D3 would not inevitably manifest themselves upon the practical implementation of the teaching of document D3. It held that the recognition of the relevance of these phenomena should therefore be considered to form part of the technical contribution described in the patent. A specific reference in the formulation of the objective technical problem to the avoidance of these phenomena would risk to unfairly direct development towards the claimed solution, which was not permissible, as it would introduce aspects of hindsight in the assessment of obviousness of the solution (see in particular T 800/91).

The appellant-opponents objected that the patent merely presented an allegation regarding the stability of compositions comprising propylene glycol as defined in the claims as granted. The board observed, however, that the report in the patent on the

maintained stability of the compositions comprising propylene glycol concerned a verifiable observation rather than merely some allegation.

The maintained stability of the compositions comprising propylene glycol did not imply an actual improvement with respect to the compositions comprising mannitol or glycerol as described in document D3. However, the board found no reason why the formulation of the objective technical problem could not refer to the purpose of maintaining the stability of the compositions.

In light of the above the board concluded that the problem to be solved starting from the mannitol or the glycerol based compositions of document D3 may be formulated as the provision of liraglutide containing compositions having optimized manufacturability and usability whilst maintaining stability.

Assessing the solution, the board found D3 itself provided no suggestion towards any advantage from the use of propylene glycol over mannitol or glycerol. On the contrary, document D3 recommended mannitol and glycerol as the preferred isotonic ingredients. It concluded that as the solution to the identified objective technical problem, the replacement of the isotonic agents mannitol and glycerol in the compositions of document D3 by propylene glycol was therefore not obvious to the skilled person.

The board did not recognise any divergence between T 1087/15 and T 800/91 as argued by the appellant-opponents. In T 1087/15 it was considered that knowledge of the claimed invention was indispensable in order to formulate the objective technical problem irrespective of the choice of the starting point in the prior art. The board agreed; knowledge of the claimed invention was inevitable in order to be able to analyse it for compliance with the requirement of inventive step. It was precisely for that reason the technical problem underlying a claimed invention had to be formulated, according to the established jurisprudence, in such a way that it did not contain pointers to the solution or partially anticipate the solution. The assessment of the solution for obviousness in light of the prior art would otherwise be unduly influenced by an ex post facto view on the matter. The board stated it was in line with this jurisprudence that according to T 800/91 the technical problem should not be tendentiously formulated in a way that unfairly directs development towards the claimed solution.

The board concluded that the patent as granted also met the requirement of inventive step and ordered that the appeals be dismissed.

004-01-23

## 5. Article 056 EPC | T 0547/21 | Board 3.3.02

**Article:** Article 056 EPC

<b>Case Number:</b>	T 0547/21
<b>Board:</b>	3.3.02
<b>Date of decision:</b>	2022.09.06
<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 (no) – common general knowledge – obvious solution – objective technical problem
<b>Cited decisions:</b>	
<b>Case Law Book:</b>	<a href="#">I.D.4.2.2</a> , 10th edition

In [T 547/21](#) D2 was the closest prior art, the aim of the disclosed process therein being, inter alia, to increase the concentration of solids in skim milk or whey, an aim shared by the application at issue. The board noted that it could only be acknowledged that recirculating the UF permeate as disclosed in the application led to a further increase in the solids content if the skilled person would have implicitly inferred this effect on the basis of common general knowledge. The board accepted this assumption and deemed the objective technical problem was to provide a process that led to a further increase in the solids content.

On obviousness, the board agreed with the examination division that "the skilled person would be aware that a valuable product [e.g. lactose] still present in the UF permeate can be recovered by a second pass through the system. Indeed, recirculation loops are known in the art particularly for the purpose of recouping useful products from a first pass through a membrane system" (text in square brackets added by the board). Therefore, in view of the objective technical problem posed, the claimed recirculation would have represented an obvious technical measure that the skilled person starting from D2 would have selected on the basis of common general knowledge. It followed that the subject-matter of claim 1 of the main request would have been obtained without exercising any inventive skill.

The appellant argued that recirculating the UF permeate to the RO step was not disclosed in either D2 or any of the other documents referred to in the decision under appeal, which, it argued, were instead aimed at fractionating the skim milk or whey.

Therefore, the skilled person would not have contemplated returning the UF permeate to the RO in the system since doing so would have deprived the prior-art processes of one of their purposes, i.e. producing a UF permeate rich in lactose. The board was not convinced by the argument; the fact that recirculating the UF permeate leads to an increase in the solids content of the UF retentate had to be regarded as belonging to common general knowledge. Therefore, no secondary document disclosing this feature was needed. What was relevant for the assessment of inventive step was the general teaching in D2 to increase the concentration of solids in skim milk or whey by using the combination of RO and UF.

The board found that the appellant's argument was an attempt to replace the objective technical problem with the one allegedly aimed at in the closest prior art. However, the objective technical problem is the problem solved by the distinguishing feature of the claimed invention over the closest prior art, not a problem allegedly aimed at in that closest prior art. The board further held that the fact that other possibilities would have been known to the skilled person, as argued by the appellant, had no bearing on the conclusion that the claimed solution was obvious to the skilled person on the basis of common general knowledge.

The board concluded that, starting from D2, the subject-matter of claim 1 of the main request did not involve an inventive step within the meaning of Art. 56 EPC in view of common general knowledge.

005-01-23

## 6. Article 069 EPC | T 1473/19 | Board 3.2.02

<b>Article:</b>	<b>Article 069 EPC</b>
<b>Case Number:</b>	<b>T 1473/19</b>
<b>Board:</b>	3.2.02
<b>Date of decision:</b>	2022.09.30
<b>Language of the proceedings:</b>	EN
<b>Internal distribution code:</b>	C
<b>Inter partes/ex parte:</b>	Inter partes
<b>EPC Articles:</b>	Articles 069, 084, 123(2) and (3) EPC
<b>EPC Rules:</b>	
<b>RPBA:</b>	
<b>Other legal provisions:</b>	Protocol on the Interpretation of Article 69 EPC
<b>Keywords:</b>	claim interpretation – amendments – added subject-matter (yes) – inescapable trap (yes)
<b>Cited decisions:</b>	G 0002/88, G 0002/10, G 0001/16, T 0556/02, T 1279/04, T 0197/10, T 1646/12, T 1167/13, T 1514/14, T 0131/15, T 2365/15, T 1127/16, T 0030/17, T 1776/18, T 2773/18, T 2007/19
<b>Case Law Book:</b>	<a href="#">II.A.6.3.</a> , <a href="#">II.A.6.3.2.</a> , <a href="#">II.E.1.3.9d)</a> , <a href="#">II.E.3.1.</a> , 10th edition

In [T 1473/19](#) the parties presented two possible interpretations for a feature in claim 1 of the granted patent. The interpretation of such feature was relevant for assessing compliance with Art. 123(2) and (3) EPC. Although the tests to be carried out under these provisions were different, a patent claim had to be interpreted in a uniform and consistent manner.

The board noted that according to established case law, patent claims must be interpreted through the eyes of the person skilled in the art, taking into account the whole disclosure of the patent. There was, however, a significant body of case law according to which the description and the drawings should only be used to interpret ambiguous features. There were also different views in the case law on the extent to which Art. 69 EPC and the Protocol on the Interpretation of Art. 69 EPC should be applied when interpreting patent claims in proceedings before the EPO.

In the present decision the board held that Art. 69 EPC and its Protocol were the only provisions of the EPC containing rules for the interpretation of patent claims. Art. 84 EPC, first sentence, did not contain any such rules. The board acknowledged a difference between the subject-matter of a patent claim, which was assessed under Art. 54(2), 56, 83 and 123(2) EPC, and its extent of protection, which was assessed under Art. 123(3) EPC and in national infringement proceedings. However, it did not

consider this difference a convincing reason not to apply Art. 69 EPC and the Protocol when determining the claimed subject-matter in proceedings before the EPO. The board explained that there was a close link between the claimed subject-matter and the extent of protection. The extent of protection of a patent claim could be understood as the (infinite) set of embodiments which infringe that claim. This set could conceptually be divided into two distinct subsets. Although not identical to the claimed subject-matter, the first subset of the extent of protection was directly defined thereby and formed by embodiments which infringe the claim by realising the claimed features. The second subset was formed by embodiments which infringe the claim by equivalent means. When assessing whether an embodiment falls under the first subset, it is assessed whether that embodiment can be subsumed under the claimed features. To this end, the claimed features must be interpreted – and the claimed subject-matter thereby determined – in accordance with the rule on how "to interpret the claims" given in Art. 69(1) EPC in conjunction with Art. 1 of the Protocol. Such an interpretation of the claimed features for the purposes of establishing the first part of a patent claim's extent of protection was not different from interpreting these features when determining the claimed subject-matter for the purposes of assessing compliance with Art. 54, 56, 83 and 123(2) EPC. Assessing whether an embodiment falls under the second subset, i.e. equivalents under Art. 69(1) EPC in conjunction with Art. 2 of the Protocol, was a second step in the determination of the extent of protection which followed claim interpretation. As the "invention" in Art. 54, 56 and 83 EPC (see T 92/21) and, with regard to claim amendments, also the "subject-matter" under Art. 123(2) EPC (see G 2/10) referred to the claimed subject-matter only, equivalents were not to be taken into account when assessing compliance with these provisions.

The board concluded that Art. 69 EPC in conjunction with Art. 1 of the Protocol could and should be relied on when interpreting claims and determining the claimed subject-matter in proceedings before the EPO, including for the purpose of assessing compliance with Art. 123(2) EPC. In addition, the board pointed out that although Art. 69(1), second sentence, EPC generally required that account be taken of the description and the drawings when interpreting a claim, the primacy of the claims according to Art. 69(1), first sentence, EPC limited the extent to which the meaning of a certain claim feature may be affected by the description and the drawings. The established case law that limiting features which were only present in the description but not in the claim could not be read into a patent claim was thus fully compatible with relying on Art. 69 EPC in conjunction with Art. 1 of the Protocol as a legal basis for determining a patent claim's subject-matter. The primacy of the claims also limited the extent to which the description could serve as a dictionary for the terms used in the claims. The board further clarified that claim interpretation was overall a question of law which must as such ultimately be answered by the deciding body, and not by linguistic or technical experts. It did, however, involve the appraisal of linguistic and technical facts which may be supported by evidence submitted by the parties.

006-01-23

## 7. Rule 099(1)(c) EPC | T 2197/16 | Board 3.2.05

<b>Article:</b>	<b>Rule 099(1)(c) EPC</b>
<b>Case Number:</b>	T 2197/16
<b>Board:</b>	3.2.05
<b>Date of decision:</b>	2022.05.13
<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 104(1), 106(3), 107, 108 EPC
<b>EPC Rules:</b>	Rules 097(1) and 099(1)(c) EPC
<b>RPBA:</b>	
<b>Other legal provisions:</b>	
<b>Keywords:</b>	notice of appeal – request defining subject of appeal – decision on apportionment of costs not subject of the appeal proceedings
<b>Cited decisions:</b>	G 0009/92, G 0004/93, G 0001/99, T 0753/92, T 0762/96, T 0689/09
<b>Case Law Book:</b>	<a href="#">III.R.4.1.</a> , <a href="#">III.R.4.3.</a> , <a href="#">V.A.2.5.2c</a> ), 10th edition

In [T 2197/16](#) the appellant (opponent) had appealed the opposition division's decision to maintain the patent. In the decision under appeal, the opposition division had also ordered the patent proprietor to pay the costs of the oral proceedings to the opponent under Art. 104(1) EPC. The respondent (patent proprietor) requested that the decision on the apportionment of costs be admitted in the appeal proceedings and set aside.

The board ruled that the respondent's requests concerning the opposition division's decision on apportionment of costs were inadmissible for the following reasons.

According to Art. 108, first sentence, EPC and R. 99(1)(c) EPC, the notice of appeal had to contain "a request defining the subject of the appeal". The appellant's initial request defined the extent of the appeal proceedings and the appellant could file an appeal against the decision taken as a whole or in part (see G 9/92 and G 4/93, point 1 of the Reasons; and G 1/99, point 6.2 of the Reasons). This was the principle of free party disposition (*ne ultra petita*).

In the case in hand, the notice of appeal clearly showed that the appellant (opponent) did not appeal the opposition division's decision on the apportionment of costs. Nor did the statement of grounds of appeal refer to the issue of the apportionment of



costs. Therefore, the opposition division's decision in this respect was not the subject of the appeal.

The board further noted that the situation in this case was different from that where the patent proprietor appealed a decision of the opposition division which adversely affected them alone and the opponent raised further objections to the patent as granted or amended. In such a case the opponent's objections related to the subject of the appeal and therefore did not extend the subject of the patent proprietor's appeal.

In view of the above, the board concluded that the issue of the apportionment of costs was a legal issue which could not be dealt with and decided on in the appeal proceedings, since it was not the subject of the appeal. For that reason alone, the respondent's requests regarding the decision on the apportionment of costs were not admissible.

The board also made a point to refer to decisions T 753/92 and T 762/96, stating that the general considerations of these decisions were applicable here *mutatis mutandis* since, if the respondent had lodged an appeal against the opposition division's decision on apportionment of costs, the appeal, with the apportionment of costs as its sole subject, would have been inadmissible under Art. 106(3) and R. 97(1) EPC. The respondent was only a party to the proceedings under Art. 107, second sentence, EPC, and did not have the right to file a "cross-appeal" without limit of time and, unlike the rights the respondent would have as appellant, its requests were therefore subject to restrictions (see G 9/92, point 16 of the Reasons).

007-01-23

## 8. Article 13(2) RPBA 2020 | T 0574/17 | Board 3.2.03

<b>Article:</b>	<b>Article 13(2) RPBA 2020</b>
<b>Case Number:</b>	T 0574/17
<b>Board:</b>	3.2.03
<b>Date of decision:</b>	2022.09.16
<b>Language of the proceedings:</b>	EN
<b>Internal distribution code:</b>	C
<b>Inter partes/ex parte:</b>	Inter partes
<b>EPC Articles:</b>	
<b>EPC Rules:</b>	
<b>RPBA:</b>	Article 13(1), (2) RPBA 2020 Article 12(4) RPBA 2007
<b>Other legal provisions:</b>	
<b>Keywords:</b>	amendment after summons – late filed evidence – legitimate response (no) – late filed objections – taken into account (no) – exceptional circumstances (no) – prima facie relevance (no)
<b>Cited decisions:</b>	G 0010/91, G 0004/19, T 0055/01, T 0172/17, T 0882/17, T 2787/17, T 1767/18, T 2117/18
<b>Case Law Book:</b>	<a href="#">V.A.4.5.1</a> , <a href="#">V.A.4.5.8i</a> , <a href="#">V.A.5.11.3a</a> , 10th edition

In [T 574/17](#) the board had to decide, among other things, on the admittance under Art. 12(4) RPBA 2007 of evidence (for a public prior use) submitted for the first time on appeal and on the admittance under Art. 13(2) RPBA 2020 of objections based on Art. 123(2) and 54 EPC against auxiliary request 14.

Regarding the admittance of A32a under Art. 12(4) RPBA 2007, the board was not persuaded by the appellant's (opponent's) argument that filing A32a with its statement of grounds of appeal was a legitimate response to the contested decision. The board pointed out that public prior use allegations had to be sufficiently substantiated during the opposition proceedings. The appellant had had several opportunities to complete its case during opposition proceedings. Moreover, the existence of the feature to be proven was at the heart of the substantive discussion in the opposition proceedings and A32a, which was intended to overcome a time gap in the evidence, could and should have been filed during the opposition proceedings.

The board also dealt with the admittance under Art. 13(2) RPBA 2020 of new objections based on Art. 123(2) and 54 EPC raised for the first time during oral

proceedings against auxiliary request 14, which had been filed by the respondent (proprietor) with its reply to the statement of grounds of appeal.

The board confirmed that when applying Art. 13(2) RPBA 2020, a board may also rely on the criteria referred to in Art. 13(1) RPBA 2020 (T 2117/18; see also the explanatory remarks in document CA/3/19, page 43). In the board's view, relying on these criteria was part of the board's exercise of discretion under Art. 13(2) RPBA 2020. This discretion was inherent to the assessment of whether there were "exceptional circumstances" and was furthermore expressed by the phrase "in principle" (T 172/17). The board noted that the criteria referred to in Art. 13(1) RPBA 2020 included the suitability of the amendment to resolve the issues raised. In the case in hand, this translated into whether the newly raised objections against auxiliary request 14, namely under Art. 54 and 123(2) EPC, would *prima facie* be successful.

The board pointed out however that it was not necessary to assess the *prima facie* relevance of an objection in order to conclude that there were no exceptional circumstances under Art. 13(2) RPBA 2020 (see T 2787/17). Whether it was appropriate to conduct this kind of *prima facie* assessment depended on the specific circumstances of the case. The board noted that the case at issue was characterised by the fact that the opposition division had maintained the patent as granted whereas the board concluded that the patent as granted was not allowable. Auxiliary request 14 had never before been examined or objected to. In this specific procedural situation, the board found it appropriate to consider the *prima facie* relevance of the two objections raised for the first time in the oral proceedings before the board.

The board rejected the appellant's argument that both objections had to be admitted and examined because a board always had to fully examine claim amendments for compliance with Art. 123(2) EPC, even of the board's own motion. The board explained in this context that the *obiter dictum* in G 10/91, Reasons 19, could not be construed as an obligation for the boards of appeal to fully examine any claim amendments made in the appeal proceedings in the same way an examining division would. According to the board, this would be at odds with Art. 114(2) EPC (see T 1767/18) and the settled case law under which appeal proceedings were never intended to be the mere continuation of first-instance proceedings (CLB, 10th ed., V.A.1.1). Furthermore, the Enlarged Board's statement had to be interpreted in the context of the current legal framework, which had changed significantly since that statement was made. The board concluded that, taking into account Art. 114(2) EPC and the RPBA 2020, the Enlarged Board's *obiter dictum* in G 10/91, Reasons 19, was fully respected when the *prima facie* relevance of an objection was considered in the context of assessing whether there were exceptional circumstances justifying its admittance pursuant to Art. 13(2) RPBA 2020. Since neither of the two objections were *prima facie* persuasive, no exceptional circumstances could be ascertained.

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## 9. Article 13(2) RPBA 2020 | T 1968/18 | Board 3.2.05

<b>Article:</b>	<b>Article 13(2) RPBA 2020</b>
<b>Case Number:</b>	T 1968/18
<b>Board:</b>	3.2.05
<b>Date of decision:</b>	2022.08.31
<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 084, 111 EPC
<b>EPC Rules:</b>	
<b>RPBA:</b>	Articles 11, 12(2), 13(1) and (2) RPBA 2020
<b>Other legal provisions:</b>	
<b>Keywords:</b>	amendment after summons – admittance of the amended description (yes) – exceptional circumstances (yes) – remittal to the opposition division for adaptation of the description
<b>Cited decisions:</b>	J 0014/19, T 0977/94, T 0713/14, T 1294/16, T 0545/18, T 0661/18, T 1024/18, T 1598/18, T 1989/18, T 0121/20
<b>Case Law Book:</b>	<a href="#">II.A.5.3.</a> , <a href="#">V.A.4.2.2a)</a> , <a href="#">V.A.4.5.1</a> , <a href="#">V.A.4.5.5g)</a> , <a href="#">V.A.9.9.</a> , 10th edition

In [T 1968/18](#) appellant I (patent proprietor) filed amended description pages during the oral proceedings before the board. Appellant II (opponent) took the view that an amended description constituted an amendment to the patent proprietor's appeal case within the meaning of Art. 13(2) RPBA 2020.

The board noted that in J 14/19 the Legal Board had found that, in a systematic interpretation, the question of whether a submission resulted in an "amendment to a party's appeal case" within the meaning of Art. 13 RPBA 2020 had to be answered using the list of possible components of an appeal case in Art. 12(2) RPBA 2020. The Legal Board had concluded that submissions not directed to requests, facts, objections, arguments or evidence relied on in the statement of grounds of appeal or in the reply amounted to an amendment to the appeal case. In the board's view, applying this systematic interpretation in the case at hand meant that the filing of amended description pages resulted in an amendment to the patent proprietor's appeal case, even if they had been filed so that the description was consistent with the amended claims of the main request which were considered allowable.

However, the board did not follow appellant II (opponent) according to which exceptional circumstances within the meaning of Art. 13(2) RPBA 2020 were only new or unforeseen developments in the appeal proceedings themselves. The term "exceptional circumstances" could also be interpreted more broadly (see e.g. T 713/14, T 1294/16, T 545/18, T 661/18 and T 1598/18).

The board pointed out that it was established case law that if the claims of a patent as granted were amended, the description had to be made consistent therewith (see e.g. T 977/94 and further decisions cited in CLB, 10th ed., II.A.5.3.). While the board was aware of decision T 1989/18, it agreed with other, more recent, decisions (see e.g. T 1024/18 and T 121/20), in which adaptation of the description was still considered necessary in the event of inconsistency with the amended claims.

In the board's view, in the case at hand, it was important to bear in mind that it was established practice of the boards of appeal to deal with the question of adapting the description only after the board had concluded that the claims of the patent as amended were allowable. It was therefore quite common for the description of the patent as granted not to be adapted until the oral proceedings, even if a set of amended claims had already been filed prior to the oral proceedings. In accordance with common practice, a remittal "with a description to be adapted" could be decided on even if the patent proprietor had not yet filed a description adapted to the allowable amended claims in the appeal proceedings (CLB, V.A.9.9.).

Against this background, the board saw the exceptional circumstances within the meaning of Art. 13(2) RPBA 2020 as already existing in that the amended description pages were filed in order to adapt the description to the claims of the main request, which were considered to be allowable.

The board remitted the case to the department of first instance with the order to maintain the patent with claims 1 to 12 of the main request filed by letter dated 12 December 2019 and a description to be adapted thereto. The board noted that Art. 11 RPBA 2020 only applied to cases that were remitted "for further prosecution". In the board's view, it did not apply to cases that were remitted with an order by the board to grant a patent or to maintain a patent in amended form, be it with or without adaptation of the description (see document CA/3/19, section VI, explanatory remarks on Art. 11 RPBA 2020, second paragraph).

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## 10. Article 13(2) RPBA 2020 | T 2599/19 | Board 3.4.02

<b>Article:</b>	<b>Article 13(2) RPBA 2020</b>
<b>Case Number:</b>	T 2599/19
<b>Board:</b>	3.4.02
<b>Date of decision:</b>	2022.11.14
<b>Language of the proceedings:</b>	EN
<b>Internal distribution code:</b>	C
<b>Inter partes/ex parte:</b>	Ex parte
<b>EPC Articles:</b>	
<b>EPC Rules:</b>	
<b>RPBA:</b>	Article 13(2) RPBA 2020 Article 12(4) RPBA 2007
<b>Other legal provisions:</b>	
<b>Keywords:</b>	amendment after summons – exceptional circumstances (no) – hypothetical objections
<b>Cited decisions:</b>	
<b>Case Law Book:</b>	<a href="#">V.A.4.5.6d</a> ), 10th edition

In [T 2599/19](#) the board decided that the main and sole request was not taken into account under Art. 13(2) RPBA 2020, as it was unable to see any exceptional circumstances justifying filing the request in response to the board's summons to oral proceedings.

Claim 1 of this new main request was an extensively reworded version of claim 1 of the previous main request. The latter had been filed with the statement of grounds of appeal. According to the appellant (applicant), the amendments to claim 1 had been intended to overcome the objections under Art. 123(2), 84 and 56 EPC raised in the board's communication pursuant to Art. 15(1) RPBA 2020.

The board, however, pointed out that it had informed the appellant (applicant) in this communication that it was considering not admitting the previous main request under Art. 12(4) RPBA 2007. It confirmed in its decision that this request would indeed not have been admitted, as it could and should have been submitted during first-instance proceedings. Since the beginning of the examination proceedings, novelty and inventive-step objections had been raised by the examining division in view of document D1. The applicant had responded with arguments without attempting to overcome these objections by substantively amending claim 1. An amended set of claims submitted before the oral proceedings responded only to later objections based on D6 and D7. In spite of the discussion during the oral proceedings dealing with the patentability issues, the applicant refrained from submitting amendments,

which could have been in the form of auxiliary requests, to overcome these objections. As a result of the applicant's approach, there could be no in-depth exchange of views on novelty and inventive step of the now-claimed subject-matter between the applicant and the examining division, thereby shifting the discussion on patentability to the appeal proceedings without any good reason.

The board concluded from the fact that the initial main request would not have been admitted under Art. 12(4) RPBA 2007, that the objections raised against this request in the board's summons were only of a hypothetical nature. In the board's view, in no case could hypothetical objections serve as a valid justification for submitting remedial amendments. In view of this, the appellant's main and sole request was not taken into account, and the appeal dismissed.

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