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Abstracts of decisions

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1. Article 052 EPC | T 0761/20 | Board 3.5.06

Article 052 EPC

Case Number	T 0761/20
Board	3.5.06
Date of decision	2023.05.22
Language of the proceedings	EN
Internal distribution code	D
Inter partes/ex parte	Ex parte
EPC Articles	Articles 052, 056 EPC
EPC Rules	
RPBA	
Other legal provisions	
Keywords	patentable invention – field of technology – computer implemented invention – mathematical method – inventive step
Cited decisions	G 0001/19
Case Law Book	I.D.9.2.9 , I.A.2.4.6.b , 10th edition

In [T 761/20](#) the invention related to automated assessment of scripts written in examination, in particular English for Speakers of Other Languages (ESOL) examinations.

The board held that though G 1/19 was related to computer-implemented simulations, its reasons apply to computer-implemented methods other than simulations as well. The board assumed that the claimed invention served the purpose of supporting its users in evaluating linguistic competences. The question remained whether the assessment of linguistic competences, or maybe merely providing a grade, was a technical purpose.

The board held that what was decisive, according to established case law of the Boards of Appeal, was whether the invention made a contribution which may be qualified as technical in that it provides a solution to a technical problem. If this was the case, a contribution to a field of technology could be said to also be present. It was noted that the "field" of this contribution may be different from the one to which the patent more generally relates: for instance, inventions within the broad field of "educational technology" could make contributions in the field of computer science.

In G 1/19, the Enlarged Board followed its earlier case law and "refrain[ed] from putting forward a definition for 'technical'", because this term must remain open. Nonetheless, the Enlarged Board provided considerations as to what may be

considered technical. The referring board in G 1/19 had suggested that a technical effect might require a "direct link with physical reality, such as a change in or a measurement of a physical entity".

The Enlarged Board in G 1/19 accepted that such a "direct link with physical reality [...] is in most cases sufficient to establish technicality" and, in this context, that "[i]t is generally acknowledged that measurements have technical character since they are based on an interaction with physical reality at the outset of the measurement method". It also stressed that an effect could also be "within the computer system or network" (i.e. internal rather than "(external) physical reality").

It recalled that potential technical effects might also be sufficient "effects which, for example when a computer program [...] is put to its intended use, necessarily become real technical effects".

And it also considered that calculated data, while "routinely raising concerns with respect to the principle that the claimed subject-matter has to be a technical invention over substantially the whole scope of the claims" might contribute to a technical effect by way of an implied technical use, "e.g. a use having an impact on physical reality".

While the Enlarged Board of Appeal thus found that a direct link with physical reality may not be required for a technical effect to exist, it did, in this board's view, confirm that an at least indirect link to physical reality, internal or external to the computer, is indeed required. The link can be mediated by the intended use or purpose of the invention ("when executed" or when put to its "implied technical use").

Returning to the case at hand, the board found that automated script grading, by itself or via its intended use for evaluating linguistic competences, did not have an implied use or purpose which would be technical via any direct or indirect link with physical reality.

The claimed computer-implemented method of automated script grading did not provide a contribution to any technical and non-excluded field, be it by way of how the automation is carried out, or by way of its use; an inventive step according to Art. 56 EPC could therefore not be acknowledged.

107-10-23

2. Article 056 EPC | T 0873/21 | Board 3.3.07

Article 056 EPC

Case Number	T 0873/21
Board	3.3.07
Date of decision	2023.06.20
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) – synergistic effect substantiated in post-published evidence derivable from original application – synergistic effect in post-published evidence encompassed by technical teaching of original application in light of the common general knowledge
Cited decisions	G 0002/21
Case Law Book	I.D.4.3.3 , 10th edition

In [T 873/21](#) the application related to compound (A) (also referred to as velagliflozin) and compound (B) (also referred to as pergolide) for use in the treatment and/or prevention of Equine Metabolic Syndrome (EMS), Equine Pituitary Pars Intermedia Dysfunction (PPID or equine Cushing's syndrome) and/or laminitis in an equine animal. The appellant argued that the technical effect resulting from the distinguishing feature was an improved insulin sensitivity, in particular a synergistic interaction of compound (A) and compound (B) and that this was demonstrated by the supplemental experimental data in D16.

The board found that the therapeutic synergistic effect substantiated in D16 was derivable from the original application, and that the data of D16 only provided a quantification of the obtained improvement in insulin sensitivity described in the original application. Accordingly, the board considered that the synergistic effect relied upon by the appellant was encompassed by the technical teaching of the original application in light of the common general knowledge regarding the therapeutic effects of compound (A) and compound (B) and was embodied by the present combination since it was clearly the preferred combination in the original application. In line with G 2/21, the technical effect demonstrated by the post-

published experimental data provided in D16 was thus to be taken into account when assessing the inventiveness of the claimed subject-matter.

The board concluded it was credible that the synergistic effect observed in D16, in particular on insuline concentrations would be advantageous in the treatment of EMS, PPID and laminitis in an equine animal. Hence, the objective technical problem underlying the main request resided in the provision of a further combination of active agents containing compound (B) for use in the treatment of EMS, equine PPID and/or laminitis in an equine animal which provides a synergistic effect on insulin resistance. The board found that the skilled person would not have found in the prior art any suggestion towards the present solution to the above defined objective technical problem and that consequently the main request fulfilled the requirements of Art. 56 EPC.

108-10-23

3. Article 087(1) EPC | T 1946/21 | Board 3.2.03

Article 087(1) EPC

Case Number	T 1946/21
Board	3.2.03
Date of decision	2023.05.05
Language of the proceedings	EN
Internal distribution code	C
Inter partes/ex parte	Inter partes
EPC Articles	Article 087(1) EPC
EPC Rules	Rule 131(1) EPC
RPBA	
Other legal provisions	Article 4A(1) Paris Convention, Guidelines A-III, 6.1 – March 2023 version
Keywords	priority – transfer of priority right on filing date of subsequent application – validity of priority date (yes) – partial priority (yes)
Cited decisions	G 0002/98, G 0001/15, T 0577/11, T 1496/11, T 1201/14, BPatG 11 W (pat) 14/09
Case Law Book	II.D.2.2.1 , II.D.2.2.2 , II.D.5.3.3 , 10th edition

[See also abstract under Article 116 EPC.](#)

In [T 1946/21](#) the appellant (opponent) and the intervener argued that the right to priority had not been validly transferred to the respondent (patent proprietor) because the written agreement had only been signed on the filing date of the subsequent application. As the smallest time unit under the EPC was a day, an assignment on the day of the filing of the subsequent application was insufficient. Moreover, claim 1 as granted did not correspond to a "generic 'OR'-claim" within the meaning of G 1/15 and no partial priority could be acknowledged. Therefore, the respondent was not entitled to claim priority from D29, which became novelty destroying.

The board held that it was sufficient for the applicant or patent proprietor to demonstrate that the assignment of the priority right was effective before the actual filing of the subsequent application. The law did not set forth any other condition. In particular, the assignment need not be effective before the filing date of the subsequent application. This was the case for the person who was "successor in title" either of the patent application including the right to priority or of only the right to priority.

There was also no reason to read such a requirement into the law. Doing so would lead to a situation where a successor in title who had obtained the right to priority on a certain day by way of an assignment always had to wait for the next day to file the subsequent application to enjoy its right to priority. Moreover, in that situation, no one would be able to enjoy the right to priority for a certain amount of time. It would also mean that even though the applicant of the subsequent application had already obtained the right to priority and was in fact already the successor in title, it could not make use of the full 12-month period under Art. 87(1) EPC.

According to the board, at least for the EPC, there was no general rule that the smallest time unit was a day. The smallest time unit was a day when it came to calculating and computing time periods (see R. 131(1) EPC) and was applicable for example when calculating the 12-month period laid down in Art. 87(1) EPC. There was, however, no reason why this should be generally applicable to other situations, in particular for the determination of the requirement of "successor in title".

The appellant and the intervener had also relied on the principle of legitimate expectation, in particular because the Guidelines A-III,°6.1 had consistently referred to the requirement "before the filing date". The board pointed out that what the law requires from applicants for them to enjoy a right to priority cannot be determined by what is stated in the Guidelines, either directly or indirectly by way of creating a legitimate expectation.

Taking into account the evidence on file, the board found that the respondent had indeed demonstrated that the contracts regarding the transfer of the right to priority had been validly concluded when it filed the subsequent application. This was not contested by the other parties. Thus, the then applicant was indeed the "successor in title" who enjoyed the right to priority within the meaning of Art. 87(1) EPC.

On whether partial priority could be acknowledged, the board pointed out that the fact that very many alternatives could be identified was not a reason for denying that there was a generic "OR"-claim or, more generally, for not applying the findings in G 1/15. The appellant's and the intervener's argument essentially relied on the requirement of a "limited number of clearly defined alternatives" taken from G 2/98. However, this (additional) requirement for acknowledging partial priority was explicitly rejected by the Enlarged Board in G 1/15. The Enlarged Board acknowledged in G 1/15 that the task of determining the relevant disclosure of the priority document taken as a whole, and determining whether that subject-matter was encompassed by the claim in the subsequent application could generally be a demanding intellectual exercise but was common practice at the EPO and among practitioners of the European patent system. This exercise was, moreover, not difficult in the case in hand, in which the priority document itself was the allegedly novelty-destroying disclosure. In this situation, the (partial) priority of the claim based on this priority document was valid for every potentially novelty-destroying element disclosed in this very same priority document. Thus, the subject-matter of claim 1 (in its entirety) was novel over D29 since the claim enjoyed partial priority from that document for all the encompassed matter disclosed in it.

109-10-23

4. Article 104(1) EPC | T 0967/18 | Board 3.3.04

Article 104(1) EPC

Case Number	T 0967/18
Board	3.3.04
Date of decision	2023.03.14
Language of the proceedings	EN
Internal distribution code	D
Inter partes/ex parte	Inter partes
EPC Articles	Article 104(1) EPC
EPC Rules	
RPBA	Articles 12(3), 13(2), 16(1) RPBA 2020
Other legal provisions	
Keywords	apportionment of costs (no) – severe negligence (no) – additional costs due to the delay (no) – RPBA 2020 apply to requests for apportionment of costs
Cited decisions	J 0014/19, J 0009/21, T 1045/19
Case Law Book	III.R.2.2.3 , III.R.2.1.1b , 10th edition

[See also abstract under Rule 142 EPC.](#)

In [T 967/18](#) both parties had filed a request for a different apportionment of costs under Art. 104 EPC.

Two weeks before the oral proceedings **the respondent (opponent)** had filed a request that the costs it incurred in preparing and filing the reply to the statement of grounds of appeal be borne in full by the appellant. The respondent had argued that the RPBA 2020 did not apply to requests for apportionment. Even if they applied, its request did not constitute an amendment of its case, so it was not subject to Art. 13(2) RPBA 2020.

The board disagreed. There was no textual reason why the request for apportionment filed under Art. 16(1) RPBA 2020 should not be considered part of an appeal case. An appeal case was implicitly defined in the rules of procedure and included all "requests, facts, objections, arguments and evidence" presented by a party in the appeal proceedings (see Art. 12(3) RPBA 2020). The generic term "requests" covered requests on the costs of the proceedings. Therefore, adding such a request changed the appeal case.

In the current case, the board had serious doubts as to whether the request could be admitted under Art. 13(2) RPBA 2020. The reasons as to why this request was filed

only two weeks before the oral proceedings were only explained for the first time at the oral proceedings and were not convincing. The request could have been made earlier. However, in view of the lack of case law on the applicability of the RPBA 2020 to a request for apportionment indicated by the respondent, and as the request in question was not allowable, the board preferred to decide on the merits. Therefore, the request was admitted into the proceedings.

From the exceptional nature of the cost apportionment provided under Art. 104(1) EPC and the reference to the abuse of procedure contained in Art. 16(1)(e) RPBA 2020, the board drew the following inference. More than just a mistake made by a party or a negligent delay in a procedural act which may occur in proceedings and which may lead to additional activities and costs was required for the order of a different apportionment. The abuse of procedure referred to such extreme situations where "the exercise of rights is predominantly intended to cause damage and other legitimate purposes take a back seat" (J 14/19). Therefore, while the board considered that negligent behaviour may also justify apportionment, the negligence must be serious enough to be considered equivalent to wilful misconduct. In the current case, the board concluded that the patent proprietor's conduct in failing to notify the EPO of its entry into voluntary administration was the result of an error of assessment. This error was not due to such a gross lack of care that could be considered equivalent to wilful misconduct.

The **appellant (patent proprietor)** considered that it was an abuse of procedure of the respondent to file its request only two weeks before the oral proceedings which could have been filed earlier in the proceedings. The board agreed that the request of the respondent could and should have been filed earlier. However, in cases where there was an unjustified delay in filing a request, the question was whether this conduct resulted in additional costs that would not have been incurred if there had been no delay. In the current case, there was no evidence that this had occurred. Indeed, the appellant would have had to prepare the submissions filed on 10 March 2023 in any event. The board had no evidence that higher costs were incurred due to time pressure.

Consequently, the requests of the respondent (opponent) and the appellant (patent proprietor) for a different apportionment of costs under Art. 104 EPC were refused.

110-10-23

5. Article 116 EPC | T 1171/20 | Board 3.5.06

Article 116 EPC

Case Number	T 1171/20
Board	3.5.06
Date of decision	2023.05.10
Language of the proceedings	DE
Internal distribution code	D
Inter partes/ex parte	Inter partes
EPC Articles	Articles 113(1), 116 EPC
EPC Rules	
RPBA	Articles 15(4), 15a RPBA 2020
Other legal provisions	Article 6 ECHR
Keywords	oral proceedings – in-person oral proceedings (yes) – G 1/21 applicable only to general emergency situations (no) – board’s discretion to hold in-person oral proceedings without a party’s consent (yes)
Cited decisions	G 0003/93, G 0003/08, G 0001/21, T 2432/19, T 0618/21
Case Law Book	III.C.7.3. , 10th edition

In [T 1171/20](#) fand die mündliche Verhandlung vor der Beschwerdekammer im Mai 2023 entgegen dem ohne Begründung vorgetragenen Antrag des Einsprechenden (Beschwerdeführer) in Präsenz statt.

Die Kammer wies darauf hin, dass Art. 15a VOBK 2020 der Kammer ein Ermessen einräumt, die mündliche Verhandlung als Videokonferenz durchzuführen, wenn sie dies für zweckmäßig erachtet. Dabei lasse die Vorschrift offen, wie Zweckmäßigkeit zu bewerten und wie das Ermessen der Kammer auszuüben ist. Bei Ausübung dieses Ermessens lasse sich die Kammer von den Grundsätzen eines fairen Verfahrens leiten (Art. 6 EMRK), insbesondere denen der fairen Durchführung der mündlichen Verhandlung (Art. 15 (4) VOBK 2020), des rechtlichen Gehörs (Art. 113 (1) EPÜ) und der Öffentlichkeit der mündlichen Verhandlung (Art. 116 (4) EPÜ). Bei der Abwägung, ob die Durchführung der mündlichen Verhandlung als Videokonferenz zweckmäßig ist, berücksichtige die Kammer alle relevanten Aspekte, so z.B. die Frage, ob sich der Fall – insbesondere unter Berücksichtigung seiner Komplexität oder einer gegebenenfalls erforderlichen Verdolmetschung – für diese Art der Durchführung eignet.

Die Kammer betonte ferner, dass die Große Beschwerdekammer in ihrer Begründung in G 1/21 über den Umstand der allgemeinen Notlage hinausgegangen sei und festgestellt habe, dass eine mündliche Verhandlung in Form einer Videokonferenz eine mündliche Verhandlung im Sinne des Art. 116 EPÜ sei und nicht grundsätzlich gegen das rechtliche Gehör nach Art. 113 (1) EPÜ oder das Recht auf ein faires Verfahren verstoße. Darüber hinaus habe sie in G 1/21 die Frage diskutiert, ob eine Videokonferenz als gleichwertig ("equivalent") mit einer Präsenzveranstaltung zu gelten hätte, und ob sie ein "geeignetes" Format zur Durchführung von mündlichen Verhandlungen sei. Der Kammer zufolge mag man diese Ausführungen in G 1/21 angesichts der rechtlich höherrangigen, und möglicherweise rechtlich allein entscheidenden, Feststellungen zu Art. 113 und 116 EPÜ und dem Recht auf ein faires Verfahren als "obiter dicta" ansehen. Allerdings hätten auch solche Überlegungen Gewicht (vgl. G 3/08 mit Verweis auf G 3/93).

Die Kammer war auch nicht der Meinung, dass, wie in T 618/21 vertreten, Art. 15a VOBK 2020 "als Nachfolgeregelung von G 1/21 angesehen werden muss". Die Kammer konnte daher nicht erkennen, dass die weite Formulierung des Art. 15a VOBK 2020 alleine die Ausführungen der Großen Beschwerdekammer in G 1/21 einschränken könnte (vgl. dazu auch T 2432/19).

Nach Ansicht der Kammer befand die Große Beschwerdekammer in G 1/21 im Ergebnis, dass mündliche Verhandlungen per Videokonferenz und in Präsenz – jedenfalls noch, aber unabhängig von einer allgemeinen Notlage – nicht gleichwertig seien und bezeichnete die Präsenzverhandlung als optimales Format (vgl. T 2432/19). Es sei auch das Format, an das der Gesetzgeber gedacht habe, als er Art. 116 EPÜ entwarf. Daher sollten Anhörungen in Präsenz die Standardoption sein (s. G 1/21, Nr. 45 der Gründe). Die Große Beschwerdekammer leitete daraus insbesondere ab, dass der Antrag eines Beteiligten auf mündliche Verhandlung in Präsenz nur unter besonderen Umständen abgelehnt werden könne. Die Kammer stimmte der Entscheidung T 2432/19 darin zu, dass die Umstände, deretwegen eine mündliche Verhandlung in Präsenz vorzuziehen sein mag, auch der Kammer selbst zur Verfügung stehen, wenn sie ihr Ermessen unter Art. 15a (1) VOBK 2020 ausübt. Die Kammer könne somit grundsätzlich auch aus eigenem Ermessen und gegen den Willen der Parteien entscheiden, eine mündliche Verhandlung in Präsenz durchzuführen (vgl. T 2432/19).

Der Kammer zufolge war im vorliegenden Fall angesichts der Vielzahl von Anträgen und teilweise technisch schwierigen Einwänden und Auslegungsfragen mit einer ausgedehnten mündlichen Verhandlung zu rechnen. Für die Kammer sprach allein dieser Umstand schon gegen eine mündliche Verhandlung als Videokonferenz, die nach Einschätzung der Kammer ungleich anstrengender sei als eine Präsenzveranstaltung (vgl. auch T 2432/19). Darüber hinaus hatte der Einsprechende den Wunsch, die mündliche Verhandlung als Videokonferenz durchzuführen, weder begründet, noch die Mitteilung der Kammer bzgl. der Aufrechterhaltung der mündlichen Verhandlung in Präsenz in der Sache kommentiert.

111-10-23

6. Article 117 EPC | T 1138/20 | Board 3.5.03

Article 117 EPC

Case Number	T 1138/20
Board	3.5.03
Date of decision	2023.04.25
Language of the proceedings	EN
Internal distribution code	C
Inter partes/ex parte	Inter partes
EPC Articles	Articles 54(2), 111(1), 114(1), 117 EPC
EPC Rules	
RPBA	
Other legal provisions	Article 6(1) ECHR, Articles 32, 41.4 TRIPS
Keywords	law of evidence – standard of proof – only one standard of proof – conviction of the deciding body – reviewing errors in the fact-finding process
Cited decisions	G 0009/91, G 0010/91, G 0007/93, G 0003/97, G 0002/21, T 0545/08, T 0660/16, T 1604/16, T 1418/17, T 1634/17, T 0042/19, T 0768/20
Case Law Book	III.G.4.3 , III.G.4.3.2 , III.G.4.2.2 b), III.G.5.1.1 , V.A.3.4.1 , VII.1.2.2 , 10th edition

In [T 1138/20](#), the main question was whether the opposition division had correctly found that NPL1 was made available to the public. The appellant (patent proprietor) challenged the opposition division's findings of fact that NPL1 was the presentation that had been delivered to the European Space Agency (ESA) and then published on its website. On whether NPL1 was indeed prior art within the meaning of Art. 54(2) EPC, the appellant and the opposition division were of the opinion that the facts had to be proven "beyond reasonable doubt"; the appellant had no involvement in the alleged events.

The board noted that, for the issue concerning whether evidence demonstrates the prior art's availability to the public, sometimes the standard of "balance of probabilities" and sometimes the standard of "beyond reasonable doubt" or "up to the hilt" is applied in the jurisprudence of the Boards of Appeal. The present board considered that making a distinction between the above-mentioned standards was neither necessary nor mandated by case law (in line with T 545/08, T 768/20, T 660/16, T 1634/17). If only the opponent had access to the relevant evidence, this fact had to be given due consideration in the deciding body's assessment as to what weight and importance are to be attached to such evidence. This was not the same as to say that a different standard of proof should apply. Therefore, the board

considered that there is only one standard of proof in the proceedings before the EPO: the deciding body, taking into account the circumstances of the case and the relevant evidence before it, must be convinced that the alleged fact has occurred.

The evaluation of evidence was the genuine task of the trier of fact, that is, the deciding body that establishes the facts of a case; in the context of the EPC, the departments of first instance and the boards of appeal. Evidence is to be assessed in accordance with the principle of the free evaluation of evidence. Whether or not a fact can be regarded as proven has to be assessed on the basis of all the relevant evidence on file. The deciding body that establishes the facts of the case has to weigh all relevant evidence before it. In this regard, the first instance is the first deciding body competent to undertake this task. Depth and detail of such finding varied and in particular depended on whether or not certain facts were disputed. As with any other findings of a deciding body, a finding of fact must be reasoned (see e.g. G 2/21, point 31 of the Reasons). This was particularly important if there was contradictory evidence on file. Then, the process of weighing the different pieces of evidence must be properly reflected in the reasoning of the final decision. Concerning their competence the boards have the power, at any stage of the appeal proceedings, to establish the relevant facts of the case before them and thereby substitute the findings of fact of the departments of first instance. However, the boards have no obligation to establish facts *de novo* already established by the departments of first instance. The review of findings of fact had simply nothing to do with the review of discretionary decisions. Discretionary decisions could only be reviewed for a particular type of errors (cf. G 7/93, point 2.6 of the Reasons), while a review of findings of fact had no such limitation.

The board also said that the burden is on the party challenging a fact on appeal to demonstrate that the first-instance department erred in its finding of fact. For demonstrating an error in the fact-finding process, it will generally not be sufficient to argue on appeal that the evidence on file would have allowed a different conclusion and that this conclusion was equally likely, plausible or reasonable. Rather, in order to show an error, the party must demonstrate that no body competent to establish the facts and acting in a reasonable way could have come to this conclusion. In such a situation, the contesting party may successfully allege on appeal that the first-instance department did not fulfil its duty of giving reasons for its finding of fact.

The boards may also at any stage of the appeal proceedings decide to establish the facts on their own motion – even if no error was demonstrated by a party. And concerning reviewing errors in the fact-finding process, the boards have full competence to review findings of fact, and reference was made to T 42/19 and T 1604/16 (among others).

The board decided that the appellant had failed to demonstrate an error and it saw no reason to overturn the finding of the opposition division.

112-10-23

7. Article 122 EPC | T 1482/21 | Board 3.2.02

Article 122 EPC

Case Number	T 1482/21
Board	3.2.02
Date of decision	2023.05.10
Language of the proceedings	EN
Internal distribution code	C
Inter partes/ex parte	Inter partes
EPC Articles	Articles 016, 021(1), 021(2), 087(1), 107, 122 EPC
EPC Rules	Rules 010, 052(2), 136(1), 136(4) EPC
RPBA	
Other legal provisions	
Keywords	re-establishment of rights (yes) – priority period – competence of the Receiving Section (yes) – grant of re-establishment by Receiving Section final and binding – effects of re-establishment – legitimate expectations – legal certainty – decision by Receiving Section can be reviewed only by the Legal Board
Cited decisions	G 0001/11, J 0003/13
Case Law Book	III.E.6.1. , 10th edition

[See also abstract under Rule 124\(1\) EPC.](#)

In [T 1482/21](#) the appellant (opponent 2) argued that the decision of the Receiving Section granting a request for re-establishment of rights in relation to the priority period was invalid, due to the Receiving Section's lack of competence to take this decision. Moreover, according to the appellant, it had to be possible to assess and review all preconditions for an entitlement to priority in opposition and opposition appeal proceedings, including whether or not the 12-month priority period pursuant to Art. 87(1) EPC had been observed.

Under Art. 16 EPC in conjunction with R. 10 EPC the Receiving Section is responsible for the examination on filing and as to formal requirements of a European patent application up to the time when the examining division becomes responsible for the examination of the same. In the present case search had started on 15 February 2016 and the request for examination was only filed on 20 January 2017. Hence, when the Receiving Section took its decision of 14 January 2016, it was still responsible for the examination on filing and as to formal requirements.

Under R. 136(4) EPC, the department competent to decide on the omitted act shall decide on the request for re-establishment of rights. In the case in hand, the omitted act was the filing of the application within the 12-month priority period pursuant to Art. 87(1) EPC. The Receiving Section was therefore competent to decide on the request for re-establishment of rights in respect of the priority period.

The board found that the Receiving Section's decision of 14 January 2016 granting the request for the re-establishment of rights was final. If the Receiving Section rejects a request for re-establishment of rights in respect of the priority period, an applicant can lodge an appeal against this decision with the Legal Board of Appeal under Art. 21(1) and (2) EPC (see J 3/13). If the Receiving Section grants a request for re-establishment of rights in respect of the priority period, the applicant is not adversely affected under Art. 107 EPC. There is also no other party to the proceedings before the Receiving Section. Thus, a positive decision on such a request becomes final immediately.

The board then went on to assess the binding nature of the Receiving Section's decision. It firstly referred to the effect of granting a request for re-establishment of rights under Art. 122(3) EPC, pursuant to which the legal consequences of the failure to observe the time limit concerned are deemed not to have ensued. The wording of Art. 122(3) EPC did not limit said effect to the proceedings in which the decision to grant that request was taken. Secondly, a decision on re-establishment of rights presupposed that there was a corresponding request to be decided upon. In the case in hand, such a request was only made in the proceedings before the Receiving Section and decided upon only in these proceedings. As under Art. 21(2) EPC the Legal Board is exclusively competent to review decisions of the Receiving Section (G 1/11), neither the opposition division nor the present technical board would have any power to review the Receiving Section's decision on re-establishment of rights. They could also not do so indirectly by reassessing the same matter of their own motion. Thirdly, any subsequent reopening of a favourable decision of the Receiving Section on re-establishment of rights would lead to considerable legal uncertainty for the party whose request was granted. It would also be in conflict with the principle of protection of legitimate expectations. The opposition division was correct in saying that it had to acknowledge the Receiving Section's decision to grant the request for re-establishment of rights in respect of the priority period.

Therefore, the Receiving Section's decision was final. Other departments of the EPO such as an opposition division or a technical board of appeal which would decide on questions of priority in other, subsequent proceedings were prevented from reviewing and overturning the Receiving Section's decision granting the request for re-establishment of rights.

113-10-23

8. Article 123(2) EPC | T 0532/20 | Board 3.5.02

Article 123(2) EPC

Case Number	T 0532/20
Board	3.5.02
Date of decision	2023.02.08
Language of the proceedings	EN
Internal distribution code	C
Inter partes/ex parte	Inter partes
EPC Articles	Articles 100(c), 123(2) EPC
EPC Rules	
RPBA	
Other legal provisions	
Keywords	amendments – added subject-matter (yes) – extension beyond the content of the application as filed
Cited decisions	
Case Law Book	II.E.1.3.2 , 10th edition

[See also abstract under Article 13\(2\) RPBA 2020.](#)

In [T 532/20](#), the board held that claim 1 as granted defined subject-matter that extended beyond the content of the application as originally filed. This concerned in essence the feature that the generator remained connected to and synchronised with the grid during a low-voltage event of less than 50%.

As argued by the appellants (opponents) and the intervener, a skilled person was therefore faced with new information that a continuing connection and synchronisation of the generator with the power grid even at voltage drops to less than 50% of the rated voltage, could be achieved by a UPS-powered blade pitch control system and turbine controller alone.

The board was not convinced by the arguments of the respondent (patent proprietor). Rather than identifying a direct and unambiguous original disclosure, the respondent argued that precisely those amendments that were added to the subject-matter of original claims 1 and 3 had been implicitly part of these claims from the beginning. However, the board explained that, on any objective reading, neither claim 1 nor claim 3 as originally filed specified that the claimed generators were capable of low-voltage ride through or that they remained connected and synchronised during a low-voltage event of any size.

The respondent argued furthermore that the appellants and the board in reality raised an objection of missing essential features against claims 1 and 3 of the main request in the guise of an objection of added subject-matter. The board held that this was not correct. Claim 1 was amended so as to be limited – only after the amendment – to a generator that was capable of remaining connected and synchronised during low voltages of under 50% of rated voltage. However, the measures that were originally disclosed to be necessary to achieve that result, in particular a protective circuit for the inverters and a blade pitch system controlled so as not to trip the generator, were not added to the amended claim. The fact that the claimed generator could achieve this technical effect without the originally disclosed corresponding measures represented new information.

The respondent also argued that a protective circuit, in particular in the form of a crowbar circuit, was originally disclosed only as an embodiment or an optional feature, reasoning that if an applicant drafted an application by representing a protective circuit as optional, then this represented an original disclosure to the skilled person. This argument did not convince the board. A skilled person did not read an application as a linguist would, but rather on the basis of their technical understanding. The application clearly taught the skilled person that a severe voltage drop at the generator terminals caused high currents in the generator windings, which could damage the semiconductor switches in the inverter. If this happened, the generator could not remain connected and synchronised. The original application did not contain a single technically useful piece of information as to how a severe voltage drop could be accommodated otherwise than with a protective circuit. It also did not contain a single piece of credible disclosure of conditions under which a low-voltage event did not cause excess currents in the generator. In view of this, a skilled person saw beyond the respondent's strategic choice to represent most parts of the disclosure as optional. In this context, it was simply irrelevant how often the words "in one embodiment" were used correctly or not.

The respondent also adopted the opposition division's argument from the decision under appeal that generator synchronisation with the power grid and the damage of components were two different problems which were not inextricably linked to each other. A low-voltage event could also be addressed by increasing the capacity in various components such as the motor, generator and/or converter. The board was not convinced by this argument. The variable frequency current produced in the generator was transformed in the converters to the stable grid frequency before being fed to the grid. If the inverter was destroyed, the generator could not remain connected and synchronised to the grid. Hence protecting the inverter was a prerequisite for, and hence inextricably linked with, the claimed technical effect expressed in claim 1 after the amendment.

114-10-23

9. Article 123(2) EPC | T 1133/21 | Board 3.3.09

Article 123(2) EPC

Case Number	T 1133/21
Board	3.3.09
Date of decision	2023.05.26
Language of the proceedings	EN
Internal distribution code	D
Inter partes/ex parte	Inter partes
EPC Articles	Article 123(2) EPC
EPC Rules	
RPBA	
Other legal provisions	
Keywords	amendments – added subject-matter – extension beyond the content of the application as filed – selection from lists of converging alternatives
Cited decisions	G 0002/10, T 1621/16, T 0350/18
Case Law Book	II.E.1.6.1a , II.E.1.6.2a , II.E.1.6.2d , 10th edition

In [T 1133/21](#) the respondent (patent proprietor) submitted that although multiple selections had to be made to arrive at the claimed subject-matter, the teaching of the application as filed taught toward the claimed combination of features. In essence, the respondent argued that since i) the ranges in amended claim 1 were selected from lists of converging alternatives and ii) there was a pointer to the claimed combination of features, claim 1 met the criteria set out in decision T 1621/16 for the requirements of Art. 123(2) EPC to be fulfilled.

The board was not convinced by the arguments of the respondent. The board explained that the gold standard for assessing compliance with Art. 123(2) EPC was that amendments to the claims, description and drawings of a European patent application or patent could only be made within the limits of what a skilled person would derive directly and unambiguously, using common general knowledge, and seen objectively and relative to the date of filing, from the whole of these documents as filed (G 2/10).

It was established case law that the content of an application must not be used as a reservoir from which features pertaining to separate embodiments could be combined to artificially create an embodiment. In the absence of any pointer to the combination, the combined selection of features did not, for the person skilled in the art, emerge clearly and unambiguously from the content of the application as filed.

Decision T 1621/16 did not provide for an exception to this rule. It required, in fact, that a claim amended on the basis of multiple selections from lists of converging alternatives may only be considered to meet the requirements of Art. 123(2) EPC if the application as filed included a pointer to the combination of features resulting from the multiple selections. This meant that the mere fact that features were described in terms of lists of more or less converging alternatives did not give the proprietor carte blanche to freely combine features selected from a first list with features selected from a second list disclosed in the application as filed. Any such amendment would only be allowable under Art. 123(2) EPC if it complied with the gold standard.

The assessment of whether this standard was complied with was very case specific. It required taking into account the teaching of the application as filed as a whole, avoiding artificial semantic constructions. Factors which might play a role in the assessment were, inter-alia, the number of alternatives disclosed in the application; the length, convergence and any preference in the lists of enumerated features; and the presence of examples pointing to a combination of features. For instance, if the values in a number of examples were clustered within specific ranges, this might provide a pointer to those ranges. In the current case, the application for the opposed patent was drafted to provide a large reservoir of options and alternatives to be selected and combined to create a vast number of embodiments.

The respondent also argued that the current case was similar to that underlying T 350/18. In that decision, the board found that claim 1 was in line with the examples and that, in the absence of a contradiction or specific interrelation of individual features which would require additional adaptation or modification, the claimed combinations of numerical ranges defined by the broadest range which converged down towards the most preferred range met the requirements of Art. 123(2) EPC. According to the respondent, this same approach had to be applied to the current case.

The board did not find this argument persuasive either. The board held that the assessment of whether Art. 123(2) EPC was complied with was very case specific. In view of the very broad teaching of the application as filed and the vast number of alternative options disclosed in the application, the current case could not be compared to T 350/18.

The board concluded that claim 1 of the main request contained subject-matter extending beyond the content of the application as filed (Art. 123(2) EPC).

115-10-23

10. Article 13(2) RPBA 2020 | T 0532/20 | Board 3.5.02

Article 13(2) RPBA 2020

Case Number	T 0532/20
Board	3.5.02
Date of decision	2023.02.08
Language of the proceedings	EN
Internal distribution code	C
Inter partes/ex parte	Inter partes
EPC Articles	
EPC Rules	
RPBA	Article 13(2) RPBA 2020
Other legal provisions	
Keywords	amendment after summons (yes) – taken into account (no) – combination of granted dependent claims as new independent claim – deletion of claims – respondent not taken by surprise
Cited decisions	G 0003/14, J 0014/19, T 0713/14, T 1224/15, T 2222/15, T 1439/16, T 1480/16, T 1597/16, T 2638/16, T 0853/17, T 1569/17, T 0306/18, T 0884/18, T 0914/18, T 0995/18, T 1151/18, T 2091/18, T 0482/19, T 1857/19
Case Law Book	V.A.4.2.2d , 10th edition

[See also abstract under Article 123\(2\) EPC.](#)

In [T 532/20](#) the board decided not to take into account auxiliary request A, filed during the oral proceedings before the board, pursuant to Art. 13(2) RPBA 2020. In the board's view, auxiliary request A, the sole claim of which was a combination of granted claims 1, 4 and 8, represented an amendment to the respondent's appeal case. The respondent had argued in essence that according to decision G 2/98, dependent claims were to be seen as individual claims containing back references as short-form notation. Auxiliary request A therefore corresponded merely to the cancellation of all claims save one granted dependent claim.

The board (besides noting that decision G 2/98 did not appear to support this contention, but potentially G 3/14) pointed to the fact that only in part of the case law the boards had considered the deletion of a claim category, of dependent claims or of alternatives within claims not to be an amendment within the meaning of Art. 13 RPBA 2020 in the respective circumstances (T 1480/16, T 2638/16, T 884/18, T 914/18, T 995/18, T 1151/18 and T 1857/19), whereas in other decisions the

boards had considered such deletions to constitute an amendment of the appeal case (T 713/14, T 1224/15, T 2222/15, T 1597/16, T 1439/16, T 1569/17, T 853/17, T 306/18 and T 482/19).

The board, analysing the first line of case law, came to the following conclusions. First, whether the deleted claims (or alternatives) were granted claims did not play any role in reaching the conclusion that certain deletions did not represent an amendment to the appeal case. Second, none of these decisions contained the unreserved statement that certain claim deletions were per se not to be considered an amendment. What was clearly essential in this line of case law was that the deletions did not shift the subject of the proceedings or did not lead to new issues to be examined, but that they represented mere restrictions of the subject of the proceedings. Third, none of the above decisions dealt with the deletion of an independent claim and simultaneous maintenance of a dependent claim. The board expressed that it had reservations against the first line of case law and rather agreed with the analysis in J 14/19 and T 2091/18, according to which any change from the appeal case as defined in Art. 12(2) RPBA 2020 was an amendment. In the board's view it was dogmatically more consistent to acknowledge that deletions of claims represented an amendment, but that, if this amendment merely had the effect to limit the issues to be examined, this should be a strong criterion in favour of admittance, or represent special circumstances within the meaning of Art. 13(2) RPBA 2020.

The board held that in the case in hand auxiliary request A clearly introduced new issues to be examined into the proceedings, as in the normal course of events the discussion of a claim request could be limited to its independent claim, since they were (normally) the broadest claim. Auxiliary request A was now directed to the subject-matter of the combination of claims 1, 4 and 8 as granted, including features that had never been discussed before in the appeal proceedings.

Moreover, the board was not convinced by the respondent's argument according to which they had been taken by surprise by the board's decision that claim 1 of auxiliary requests 6 to 9 lacked clarity. This objection had been raised by appellant 2 in their letter dated 25.02.2022. The fact that this objection had not been specifically mentioned in the board's preliminary opinion did not justify any surprise on the part of the respondent. From the absence of a discussion of that particular clarity objection, the respondent could not infer that the board did not agree with it. The board further observed that none of the requests on file when the board issued its preliminary opinion were allowable because they all contained added-subject-matter. The board did not have to discuss all further objections, if there was one that appeared to be sufficient to decide on all requests.

116-10-23

11. Article 13(2) RPBA 2020 | T 1361/19 | Board 3.4.03

Article 13(2) RPBA 2020

Case Number	T 1361/19
Board	3.4.03
Date of decision	2023.01.11
Language of the proceedings	EN
Internal distribution code	D
Inter partes/ex parte	Ex parte
EPC Articles	
EPC Rules	
RPBA	Article 13(2) RPBA 2020
Other legal provisions	
Keywords	amendment after summons (yes) – taken into account (yes) – deletion of claims – arguments and submissions on remaining part remained unchanged
Cited decisions	T 1569/17, T 2920/18, T 0247/20
Case Law Book	V.A.4.2.2d , 10th edition

In [T 1361/19](#) the board had to decide on the admittance of the new main request filed during the oral proceedings before the board. The new main request was limited to "a method of manufacturing a semiconductor device", the device claims having been deleted.

The board noted that the question of whether the deletion of part of the claims in a pending request constituted an "amendment to a party's appeal case" within the meaning of Art. 13 RPBA 2020 was controversially discussed among the boards and answered differently (see e.g. T 2920/18 or T 1569/17).

The board was of the opinion that, in the case in hand, the limitation was not an amendment to the party's appeal case, as the factual situation with respect to the remaining part, namely the claims related to a "method of manufacturing", did not change at all compared to all submissions related to the manufacturing method prior to this amendment. The claimed "method of manufacturing" was part of the discussion before the examining division and the examining division had dealt with identical claims in its decision. Moreover, the discussion on inventive step of the claims of the previous main request (filed with the statement setting out the grounds of appeal and identical to the first auxiliary request of the impugned decision), which contained the claims directed to the "method of manufacturing" in unchanged form, was dealt with in the statement setting out the grounds of appeal. Therefore, the

subject-matter of the present main request was already part of the examining division's decision and was entirely addressed by the appellant in its statement setting out the grounds of appeal. Consequently, the deletion of the device claims resulted neither in a changed factual situation for the "method of manufacturing" nor in a different weighting of the remaining subject-matter due to the deletion of the device claims.

The board further observed that the fact that the manufacturing method was considered differently in the new main request was not a consequence of the deletion of the device claims, but merely due to a different consideration of the manufacturing method itself after discussion during the oral proceedings before the board.

In view of this, the new main request submitted at the oral proceedings before the board was not considered to be an amendment to the party's appeal case, as all of the appellant's arguments and submissions on this remaining part ("the method of manufacturing") remained unchanged. The board concluded that it had no discretion not to admit this new main request into the proceedings under Art. 13(2) RPBA 2020. Hence, the main request was admitted into the proceedings.

117-10-23

12. Article 15a(1) RPBA 2020 | T 1501/20 | Board 3.2.08

Article 15a(1) RPBA 2020

Case Number	T 1501/20
Board	3.2.08
Date of decision	2023.07.14
Language of the proceedings	DE
Internal distribution code	D
Inter partes/ex parte	Inter partes
EPC Articles	
EPC Rules	
RPBA	Articles 15(2)(b)(vi), 15a(1) RPBA 2020
Other legal provisions	
Keywords	oral proceedings – mixed-mode oral proceedings (yes) – G 1/21 – general emergency situation (no) – board’s discretion to hold oral proceedings by videoconference without a party’s consent (no)
Cited decisions	G 0001/21, T 2432/19, T 1171/20, T 0618/21
Case Law Book	III.C.7.3. , 10th edition

In [T 1501/20](#) wurde die mündliche Verhandlung in Form einer Hybridverhandlung ("mixed-mode") durchgeführt. Die Beschwerdekammer hatte zunächst zu einer mündlichen Verhandlung in Präsenz am 14. Juli 2023 geladen. Im Hinblick auf den französischen Nationalfeiertag hatte daraufhin der Beschwerdeführer um eine Verschiebung der mündlichen Verhandlung bzw. um Durchführung der mündlichen Verhandlung in Form einer Videokonferenz ersucht. Der Beschwerdegegner hatte sich gegen die Durchführung der mündlichen Verhandlung in Form einer Videokonferenz ausgesprochen. Der Beschwerdegegner hatte jedoch – in Absprache mit dem Beschwerdeführer – der Durchführung der mündlichen Verhandlung in Form einer Hybridverhandlung zugestimmt.

Die Beschwerdekammer merkte zunächst an, dass das Bestehen eines nationalen Feiertages grundsätzlich keine ausreichende Begründung für die Verschiebung einer mündlichen Verhandlung darstelle, sofern nicht bereits ein Urlaub bzw. eine Reise fest gebucht worden sei (vgl. Art. 15 (2) b) vi) VOBK 2020). Eine Verschiebung der mündlichen Verhandlung kam für die Beschwerdekammer daher unter Verweis auf verfahrensökonomische Erwägungen nicht in Betracht. Da der Beschwerdegegner aber seine Zustimmung zur Durchführung einer Hybridverhandlung gegeben hatte, wurde die Verhandlung in Form einer Hybridverhandlung durchgeführt. Die Kammer erläuterte, dass somit den Anträgen beider Beteiligten entsprochen worden sei: dem Beschwerdegegner sei die Möglichkeit eingeräumt worden, im Verhandlungsraum

des EPA anwesend zu sein, und dem Beschwerdeführer sei die Teilnahme im Wege der Videotechnologie ermöglicht worden.

Im gegebenen Zusammenhang merkte die Beschwerdekammer an, dass Art. 15a (1) VOBK 2020 der Kammer zwar ein Ermessen einräumt, die mündliche Verhandlung als Videokonferenz durchzuführen, wenn sie dies für zweckmäßig erachtet. Sie sei dennoch der Ansicht, dass die Entscheidung der Großen Beschwerdekammer G 1/21 gewisse Grenzen für die Ausübung dieses Ermessens setze. Die Beschwerdekammer folgte diesbezüglich der Entscheidung T 2432/19, wonach Art. 15a (1) VOBK 2020 im Hinblick auf die Entscheidung G 1/21 restriktiv auszulegen sei. Demnach biete Art. 15a (1) VOBK 2020 keine rechtliche Grundlage, um die mündliche Verhandlung in Form einer Videokonferenz gegen den Willen eines der Verfahrensbeteiligten durchzuführen, sofern kein allgemeiner Notfall bestehe, der die Möglichkeit der Beteiligten einschränke, persönlich an einer mündlichen Verhandlung in den Räumlichkeiten des EPA teilzunehmen. Insbesondere sei zu berücksichtigen, dass die in G 1/21 vorgenommene Einschränkung auf die Situation eines allgemeinen Notfalls nicht erforderlich gewesen wäre, wenn die Große Beschwerdekammer der Auffassung gewesen wäre, dass eine rechtliche Grundlage bestünde, Videokonferenzen unabhängig vom Bestehen eines solchen Notfalls gegen den Willen der Verfahrensbeteiligten durchzuführen (vgl. T 1171/20). Hierbei sei zu berücksichtigen, dass die Entscheidung G 1/21 davon ausgegangen sei, dass die unterschiedlichen Formate mündlicher Verhandlungen (Präsenzverhandlung bzw. Videokonferenz) – jedenfalls im Hinblick auf die bestehenden Technologien – keine gleichwertigen Kommunikationsmöglichkeiten bieten würden (vgl. T 2432/19). Zudem sei auch zu berücksichtigen, dass G 1/21 den Verfahrensbeteiligten grundsätzlich ein Wahlrecht hinsichtlich des Formats der mündlichen Verhandlungen zugestehe, das jedenfalls für Präsenzverhandlungen bestehe (vgl. G 1/21, T 2432/19).

Darüber hinaus stellte die Beschwerdekammer klar, dass sie nicht der in der Entscheidung T 618/21 vertretenen Auffassung folgt, wonach Art. 15a VOBK 2020 "als Nachfolgeregelung von G 1/21 angesehen werden muss". Diesbezüglich verwies sie auf die entsprechenden Ausführungen in T 1171/20.

Im Hinblick auf die vorstehenden Ausführungen sah die Beschwerdekammer im vorliegenden Fall keine rechtliche Grundlage, die mündliche Verhandlung gegen den Willen des Beschwerdegegners in Form einer Videokonferenz durchzuführen. Die mündliche Verhandlung wurde deshalb mit dem Einverständnis beider Beteiligten in Form einer Hybridverhandlung ("mixed-mode") durchgeführt.

118-10-23

13. Article 15a(2) RPBA 2020 | T 1946/21 | Board 3.2.03

Article 15a(2) RPBA 2020

Case Number	T 1946/21
Board	3.2.03
Date of decision	2023.05.05
Language of the proceedings	EN
Internal distribution code	C
Inter partes/ex parte	Inter partes
EPC Articles	
EPC Rules	
RPBA	Article 15a(2) RPBA 2020
Other legal provisions	
Keywords	in-person oral proceedings – request for oral proceedings to be held in a hybrid format (refused)
Cited decisions	G 0004/95
Case Law Book	III.C.7.3. , 10th edition

[See also abstract under Article 87\(1\) EPC.](#)

In [T 1946/21](#) the appellant's and the intervener's representative requested oral proceedings be held in a hybrid format to allow the representatives to attend the hearing in person and other attendees to attend remotely.

The board recalled that under Art. 15a(2) RPBA 2020, if oral proceedings are scheduled to be held on the premises of the EPO (such as in the case in hand), a party, representative or accompanying person may, upon request, be allowed to attend by videoconference. In the board's view, any such request should normally be granted only if the participation of the person for whom the access by means of videoconferencing technology has been requested is related to a person whose participation in the oral proceedings is relevant to the case, in particular to the decision to be taken at the oral proceedings.

In the proceedings in hand, the appellant and the intervener were represented by professional representatives who would be attending the oral proceedings on their behalf. The board noted that from the request for hybrid-format oral proceedings, it had not been apparent how the participation of additional "other attendees" was relevant to the case. It had not even been clear to the board who these "other attendees" were.

According to the board, it was entirely possible that submissions made by persons who were not professional representatives (such as "accompanying persons" within the meaning of Art. 15a(2) RPBA 2020) were relevant for the decision to be taken. Citing G 4/95, the board stated that it might permit such submissions at oral proceedings but this required a reasoned request to that effect, as explained in the board's communication under Art. 17 RPBA 2020 sent to the parties on 21 February 2023.

Absent any such request, the board saw no reasons which would outweigh the increased technical and organisational complexity caused by setting up and operating an additional parallel hybrid channel while running in-person proceedings at which all parties are already fully represented by the professional representatives present and in which all attendees may participate as well.

Therefore, the oral proceedings took place as originally summoned, i.e. in person.

119-10-23

14. Rule 099 EPC | T 1828/19 | Board 3.3.10

Rule 099 EPC

Case Number	T 1828/19
Board	3.3.10
Date of decision	2023.03.14
Language of the proceedings	EN
Internal distribution code	D
Inter partes/ex parte	Inter partes
EPC Articles	Article 108 EPC
EPC Rules	Rule 099 EPC
RPBA	
Other legal provisions	
Keywords	admissibility of appeal (yes) – notice of appeal – request defining subject of appeal – requests in the grounds of appeal different from requests in the notice of appeal
Cited decisions	
Case Law Book	V.A.2.5.2c , 10th edition

In [T 1828/19](#) the board recalled that R. 99(1)(c) EPC requires that the notice of appeal contain a request defining the subject of the appeal. R. 99(2) EPC required that the appellant indicate in the statement of grounds of appeal the reasons for setting aside the decision impugned and the facts and evidence on which the appeal is based.

In the notice of appeal, the appellant (patent proprietor) had requested that the decision under appeal be set aside, and identified the appealed decision. It had also requested that the patent be maintained "as amended during oral proceedings". This request defined the subject of the appeal, as required by R. 99(1)(c) EPC. The opposition division had revoked the patent because it had considered the claimed invention not sufficiently disclosed for it to be carried out by a skilled person. In the grounds of appeal, the appellant had given reasons why the opposition division's conclusion was to be considered incorrect, as required by R. 99(2) EPC. The appellant's main request could be identified without any doubt, namely that the decision be set aside and the patent maintained as granted. The appeal was thus admissible.

In its notice of appeal, the appellant had requested that "the decision be set aside and the patent maintained as amended during oral proceedings". In the statement of grounds of appeal, however, the appellant had requested that the decision be set

aside and the patent be maintained "as granted or in amended form". The respondent (opponent) had argued that the appeal was inadmissible solely in view of this discrepancy.

The board disagreed with the respondent. The appealed decision had a single legal effect: revocation of the patent. The appellant had clearly requested in its notice that this decision be set aside; this was the subject of the appeal. There was no legal basis for the assumption that the request in the notice of appeal "that the patent be maintained as amended in the oral proceedings" was a withdrawal of any other request pending before the opposition division and forming the basis of the impugned decision, thus irrevocably limiting the scope of the appeal by excluding from it the patent as granted. It was settled case law that, as required by R. 99(2) EPC, the proprietor needed to specify the scope of its request for maintenance of the patent only in the statement of grounds of appeal. This was implied by the wording of R. 99(2) EPC: "the appellant shall indicate ... the extent to which [the decision impugned] is to be amended". The grounds of appeal did not need to be limited by the requests in the notice of appeal. There was no reason why the legal consequence of a discrepancy between the notice and the grounds should be the inadmissibility of an appeal. R. 99 EPC was silent in this respect, and no other relevant legal provision was known to the board that would stipulate such a legal effect. Nor was the board aware of any applicable case law to that effect.

The respondent had argued that the requests in the statement of grounds of appeal did not restrict the original requests in the notice of appeal but went beyond them. However, the board failed to find any legal basis for the inadmissibility of an appeal as a consequence of a change in the scope of claim requests between the notice of appeal and the statement of grounds of appeal. In the absence of any legal basis that would prohibit such a change of scope, the appellant was free not to define its claim requests until later, within the time limit for filing the grounds of appeal as stipulated by Art. 108 EPC, last sentence. Thus, no procedural error was apparent to the board, let alone an error that would result in inadmissibility of the appeal.

The respondent had also argued that the appellant's requests were unclear and that some were not sufficiently reasoned. These arguments too failed to convince the board that the appeal should be held inadmissible.

120-10-23

15. Rule 124(1) EPC | T 1482/21 | Board 3.2.02

Rule 124(1) EPC

Case Number	T 1482/21
Board	3.2.02
Date of decision	2023.05.10
Language of the proceedings	EN
Internal distribution code	C
Inter partes/ex parte	Inter partes
EPC Articles	
EPC Rules	Rule 124(1) EPC
RPBA	Article 06(4) RPBA 2020
Other legal provisions	
Keywords	minutes of oral proceedings – request to correct minutes (refused)
Cited decisions	R 0007/17, T 0212/97, T 0642/97, T 0468/99, T 0263/05, T 1721/07, T 1891/20
Case Law Book	III.C.7.10.3 , 10th edition

[See also abstract under Article 122 EPC.](#)

In [T 1482/21](#) the appellant requested that the minutes of the oral proceedings be corrected and that the written decision be based on the corrected minutes. As the request had been made before the written decision terminating the appeal proceedings was issued, it was dealt with therein (T 1891/20).

The board noted that under R. 124(1) EPC, minutes of oral proceedings are to be drawn up, containing the essential points of the oral proceedings and the relevant statements made by the parties. Under Art. 6(4) RPBA 2020, these minutes are to be drawn up by a member of the deciding board or the registrar, as designated by the chair. Citing T 1891/20, T 212/97, T 642/97, T 468/99 and R 7/17, the board recalled that it was in the discretion of the minute writer what to consider "essential" or "relevant". The board added that a summary of the arguments made by the parties during the oral proceedings was usually not included in the minutes (T 1721/07, T 263/05), and that the board was responsible for deciding what needs to be recorded in the minutes, not the parties (T 468/99, T 1721/07).

The appellant argued that the presentation of facts in the minutes was incorrect as far as the (non-)maintenance of the objections of insufficiency of disclosure was concerned. According to the unanimous recollection of all five members of the board, the representative of the appellant had explicitly stated in the oral proceedings before

the board that it did not maintain the objections as to insufficiency of disclosure and lack of novelty against the new auxiliary request. The appellant thus requested the insertion of a paragraph into the minutes which was, according to the unanimous recollection of all members of the board, factually incorrect.

Furthermore, the appellant argued that the following statement in the minutes was an incorrect representation of that part of the oral proceedings: "[t]he respondent then filed a corresponding amended version of the description, to which neither the appellant nor the Board objected". The appellant stated that after an amended version of the description had been presented, it had objected by indicating some further parts of the description requiring amendment. One of these objections had been allowed by the board and had resulted in a further (hand-written) amendment. The board noted in this regard that the minutes stated that "[t]he need for adaptation of the description to the claims of the new auxiliary request was discussed". According to the unanimous recollection of all members of the board, the appellant had initially argued that several passages of the description needed adaptation, only some of which, however, had also been considered by the board to be in need of adaptation. The board recalled that a summary of arguments provided by the parties was usually not included in the minutes. It was thus neither incomplete nor incorrect that the minutes stated that, after discussion on the need for adaptation, the board "provided the parties with its conclusion on the required adaptations." The chairman had stressed that the appellant's explicit confirmation that it did not have any objections against the amended version of the description, had meant that the additional objections against the description which had been raised at the beginning of the discussion on adaptation would not be dealt with in the written decision, and the appellant had agreed.

The board noted that it was immaterial whether, in the course of the discussion on the adaptation of the description, all adaptations to the description which had been considered necessary by the board had been implemented by the respondent in one go or in multiple, subsequent steps. What mattered was that the final version of the adapted description which had been in the end filed by the respondent in the appeal proceedings – and which was attached to the minutes – was the one against which the appellant had had no objections. This was correctly reflected in the minutes.

The request for amendment of the minutes of the oral proceedings was therefore refused.

121-10-23

16. Rule 142 EPC | T 0967/18 | Board 3.3.04

Rule 142 EPC

Case Number	T 0967/18
Board	3.3.04
Date of decision	2023.03.14
Language of the proceedings	EN
Internal distribution code	D
Inter partes/ex parte	Inter partes
EPC Articles	Article 106(1) EPC
EPC Rules	Rule 142 EPC
RPBA	
Other legal provisions	
Keywords	interruption of proceedings (yes) – admissibility of appeal (no)
Cited decisions	J 0009/21
Case Law Book	III.D.4.8. , 10th edition

[See also abstract under Article 104\(1\) EPC.](#)


In [T 967/18](#) the appeal was against the opposition division's decision of 5 February 2018 revoking the patent. After the filing of this appeal, the Legal Division had informed the appellant (patent proprietor) that the opposition proceedings had been interrupted with effect 11 November 2016 and that the proceedings would resume on 4 November 2019. The opponent had appealed the Legal Division's decision. The Legal Board of Appeal dismissed that appeal in J 9/21.

Hence, the opposition division had revoked the European patent and the patent proprietor had filed appeal T 967/18 during the aforementioned interruption period. In T 967/18 the board agreed with the Legal Board that it is not possible to set aside with ex-nunc effect a decision on interruption. It also agreed with the Legal Board's reasoning. In the current proceedings, it was only necessary to decide on the effects that the interruption had on the appeal. As correctly explained in J 9/21, in accordance with previous decisions of the boards, where the proceedings have been interrupted under R. 142(1)(b) EPC, acts done by the parties or the competent body of the EPO during the period of interruption are considered invalid.

Categories may be borrowed from legal national traditions to argue whether they are invalid, devoid of effect or even non-existent. Irrespective of this qualification issue, the result and impact on appeals lodged against decisions taken during an interruption remain the same: the appeal and the appeal proceedings have no valid

subject eligible for judicial review. In line with established case law, an admissible appeal requires the existence of an appealable decision. Thus, the appeal in question had to be regarded as not satisfying the requirements set out in Art. 106(1) EPC and was therefore inadmissible.

122-10-23



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