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# Abstracts of decisions

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

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

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## Abstracts of decisions

In this issue:

1.	Article 016 EPC	J 0011/20   Board 3.1.01	1
2.	Article 056 EPC	T 1741/22   Board 3.5.05	3
3.	Article 087(1) EPC	T 2689/19   Board 3.3.08	5
4.	Article 087(1) EPC	T 2132/21   Board 3.3.02	7
5.	Article 112a(2)(c) EPC	R 0008/19   EBA	8
6.	Article 113(1) EPC	J 0011/20   Board 3.1.01	10
7.	Article 114(2) EPC	T 0021/22   Board 3.3.03	12
8.	Article 114(2) EPC	T 1445/22   Board 3.2.07	13
9.	Rule 113(1) EPC	T 0572/19   Board 3.4.01	15
10.	Rule 136(1) EPC	T 1882/23   Board 3.5.05	17
11.	Article 12(4) RPBA 2020	T 0446/22   Board 3.2.05	19

## 1. Article 016 EPC | J 0011/20 | Board 3.1.01

### Article 016 EPC

<b>Case Number</b>	J 0011/20
<b>Board</b>	3.1.01
<b>Date of decision</b>	2024.07.25
<b>Language of the proceedings</b>	EN
<b>Internal distribution code</b>	D
<b>Inter partes/ex parte</b>	Ex parte
<b>EPC Articles</b>	Articles 016, 090(5), 109, 113, 123(2) EPC
<b>EPC Rules</b>	Rules 046, 049, 057, 058 EPC
<b>RPBA</b>	
<b>Other legal provisions</b>	
<b>Keywords</b>	competence of the Receiving Section – formal requirements of the patent application documents – drawings – interlocutory revision
<b>Cited decisions</b>	G 0003/89, G 0011/91, J 0007/83, J 0004/85, J 0033/89, J 0007/97, J 0018/08, J 0004/09, J 0002/12, J 0005/12, J 0008/13, J 0011/15, J 0001/18, J 0010/20, T 0012/03
<b>Case Law Book</b>	<a href="#">IV.A.2</a> , <a href="#">IV.A.6.3.1</a> , 10th edition

### [See also abstract under Article 113\(1\) EPC](#)

In [J 11/20](#) the applicant appealed a decision of the Receiving Section refusing their application under Art. 90(5) EPC in conjunction with R. 58 EPC. The sole reason for the refusal was that the four amended drawings filed by the applicant to remedy formal deficiencies in the application documents were not in agreement with the application documents as originally filed and, despite the invitation by the Receiving Section, the applicant had not corrected this deficiency in due time.

In the statement of grounds of appeal, the appellant had objected that the Receiving Section had committed a substantial procedural violation by exceeding its competence when issuing the communication concerning the formal requirements of the application documents by addressing substantive matters that belonged to the competence of the examining division. Thus, the first question addressed by the Legal Board concerned the competence of the Receiving Section and, in particular, whether the Receiving Section had acted ultra vires.

The Legal Board recalled that the Receiving Section was responsible for the examination on filing and the examination as to formal requirements of the

application (Art. 16 EPC). It was established case law that the responsibilities of the Receiving Section did not involve any technical examination of the application (J 5/12, J 7/97, J 33/89 and J 4/85).

Within this framework, the Legal Board explained that the Receiving Section was competent under R. 58 EPC to identify inconsistencies in the application documents which were immediately apparent from the face of the documents, including whether formal discrepancies were present between amended documents and the documents as originally filed, provided no technical knowledge was required.

In the case in hand, the deficiency noted by the Receiving Section was of a purely formal nature and did not involve any assessment in terms of disclosure. Hence, no procedural violation was committed in this respect.

The Legal Board also assessed whether the Receiving Section should have granted interlocutory revision of the appealed decision. The Legal Board referred to J 18/08 and explained that a deficiency on which a decision under Art. 90(5) EPC is based could be corrected at the appeal stage. Such a case was different from the situation where the non-observance of a time limit automatically led to the application being deemed to be withdrawn, i.e. where the legal consequence automatically ensued when an act required within a specific time limit was not performed.

In the case in hand, the Legal Board observed that, when the appeal was filed, the deficiency had already been remedied, albeit late, with the filing of the correct drawings. Considering that the ground for refusal of the application under Art. 90(5) EPC had been remedied, the Legal Board established that the Receiving Section should have granted interlocutory revision in accordance with Art. 109 EPC.

119-11-24

## 2. Article 056 EPC | T 1741/22 | Board 3.5.05

### Article 056 EPC

<b>Case Number</b>	T 1741/22
<b>Board</b>	3.5.05
<b>Date of decision</b>	2024.07.26
<b>Language of the proceedings</b>	EN
<b>Internal distribution code</b>	B
<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>	Guidelines G-II, 3.3 – March 2022 and 2024 versions
<b>Keywords</b>	inventive step – technical effect (no) –new data derived from data collected from the human body
<b>Cited decisions</b>	G 0001/04, G 0001/19, T 2681/16, T 1091/17, T 1910/20, T 335/21
<b>Case Law Book</b>	<a href="#">I.D.9.2.11</a> , 10th edition

In [T 1741/22](#) the board referred to G 1/19 to show that it is generally acknowledged that measurements have technical character, since they are based on an interaction with physical reality, such as the human or animal body (see also G 1/04). However, the board went on to find that in the case at hand, features (c) and (d) did not involve the actual measurement of the respective glucose level in a bodily fluid. Instead, they processed already measured and received continuous glucose monitoring data to generate and display further "new data", namely a plurality of minimum/maximum glucose values, in order to support a physician in their purely intellectual deductive decision phases of diagnosis and therapy. Such subsequent processing of certain measurement data collected from the human or animal body is predominantly of a non-technical nature. Thus, it could not contribute to the technical character of the invention. The board also referred to its earlier decisions T 1091/17, T 1910/20, T 335/21.

At the oral proceedings before the board, the appellants referred to T 2681/16 and to the Guidelines for Examination in the EPO in support of their view. In particular, the appellants considered the case in T 2681/16 to be analogous to the case at hand. The competent board in that case had dealt with distinguishing features related to an algorithm to process already acquired, i.e. measured, blood glucose data points. The board had acknowledged that these features, when taken in isolation, were non-technical, and could support the presence of an inventive step only if they credibly

contributed to producing a technical effect serving a technical purpose. However, the board had then accepted the technical effect alleged by the appellant, namely "providing an overall measure of the glucose variability (i.e. equally sensitive to both hypo- and hyperglycemic events) and a prediction of glycemetic events that were better than, or at least alternative to, those used in [the closest prior art]".

This board was not in agreement with and therefore deviated from the interpretation of the Convention given in T 2681/16. In particular, the board disagreed with the finding in T 2681/16 that providing an overall "measure" of the glucose variability and a prediction of glycemetic events amounted to a technical effect. The board was well aware of the tendency of applicants to use the word "measure(ment)" liberally in order to give inventions the veneer of technicality. This was mainly because it is generally acknowledged in the jurisprudence of the Boards of Appeal that "measurements" have technical character. Admittedly, the applicants' use might well correspond to the meaning of the word in common parlance. However, a prerequisite for a "measurement" with technical character, within the meaning of the jurisprudence of the Boards of Appeal, is an interaction with "physical reality" for the calculation of the physical state of an object, even if the measurement could be carried out indirectly, e.g. by means of measurements of another physical entity (G 1/19). In the present case and in the case underlying T 2681/16, where the "physical reality" was typically the "patient's blood", the interaction with the physical reality ended once blood glucose measurements were carried out, either directly on the relevant physical entity "blood", or indirectly e.g. on another bodily fluid. The provision of overall glucose variability and a prediction of glycemetic events were mathematical steps or intellectual activities which took place in the absence of this interaction with the physical reality and were therefore not "measurements" in this sense. In other words, the taking of a sample from the patient is an interaction with "physical reality". Generating new data as a consequence of this interaction may result in "measurements" of a technical nature. But generating (and displaying) further data by an evaluation or interpretation of these measurements (as done according to features (c) and (d) here) amounts to "measurements" generated merely by a cognitive or mathematical exercise that is inherently non-technical.

As to the Guidelines for Examination in the EPO (in its applicable version of March 2022 and also in its current version of March 2024), section G-II, 3.3, which relates to the technical contribution of mathematical methods, lists "providing a medical diagnosis by an automated system processing physiological measurements" among "examples of technical contributions of a mathematical method". As providing a "medical diagnosis" – whether done by a physician or by an automated system – is devoid of any technical character (G 1/04), the board found this example to be erroneous. As there was no further explanation, let alone a reference to any case law, the board saw no reason to speculate on how the Guidelines had come up with this example. In view of the above, the board held that the subject-matter of claim 1 of auxiliary request 10 did not involve an inventive step (Art. 56 EPC).

120-11-24

### 3. Article 087(1) EPC | T 2689/19 | Board 3.3.08

#### Article 087(1) EPC

<b>Case Number</b>	T 2689/19
<b>Board</b>	3.3.08
<b>Date of decision</b>	2024.03.05
<b>Language of the proceedings</b>	EN
<b>Internal distribution code</b>	D
<b>Inter partes/ex parte</b>	Inter partes
<b>EPC Articles</b>	Articles 087(1), 088(1) EPC
<b>EPC Rules</b>	
<b>RPBA</b>	
<b>Other legal provisions</b>	
<b>Keywords</b>	priority (yes) – application of G 1/22 and G 2/22 – presumption of entitlement rebutted (no)
<b>Cited decisions</b>	G 0001/22, G 0002/22, T 0521/18, T 2719/19
<b>Case Law Book</b>	<a href="#">II.D.2.2</a> , 10th edition

In [T 2689/19](#) the European patent application on which the patent was based was a divisional application of an earlier European patent resulting from an international PCT application. This PCT application claimed priority from six US provisional applications (P1, P2, P5, P11, P13 and P14). The opposition division, applying the so-called "all applicants approach", had found that priority was not validly claimed from P1, P2, P5 and P11 because these had been filed by joint applicants (Party A1 or Party A2 being among them) and neither Party A1 nor Party A2 were named as applicants in the PCT application (and consequently in the patent in suit). This had led to a finding that the patent as granted lacked novelty and to its revocation. The patent proprietors appealed the opposition division's decision.

The board pointed out that there had been a dispute in the US (the inventorship dispute) regarding whether Party A1, an employee of Party A2, should also be named as one of the inventors in the PCT application (PCT/US2013/074743), and about the ownership of the patent. The inventorship dispute had been resolved in January 2018: an independent arbitrator had decided, inter alia, that neither Party A1 should be named as an inventor, nor Party A2 as a proprietor in the PCT application.

The board recalled that in G 1/22 and G 2/22 the Enlarged Board had found that "entitlement to priority should in principle be presumed to exist to the benefit of the subsequent applicant of the European patent application if the applicant claims priority in accordance with Art. 88(1) EPC and the corresponding Implementing Regulations...". This presumption was based on the concept of an implicit (implied,



tacit or informal) agreement on the transfer of the priority right from the priority applicant to the subsequent applicant "under almost any circumstances". It, notably, allowed ex-post (retroactive, nunc pro tunc, ex tunc) transfers concluded after the filing of the subsequent application. The Enlarged Board had noted, however, that "the allowability of a retroactive transfer of priority rights may have limited practical relevance if priority entitlement is presumed to exist on the date on which the priority is claimed for the subsequent European application." Moreover, the Enlarged Board had found that a priority right and its transfer was a matter exclusively governed by the autonomous law of the EPC. Consequently, there was no room for the application of national laws on legal presumptions and their rebuttal.

The board further recalled that the presumption that the subsequent applicant was entitled to the priority right was a strong presumption, under "normal circumstances". It applied to any case in which the subsequent applicant was not identical with the priority applicant, and thus also to a plurality of co-applicants for the priority application regardless of the extent to which that group overlaps with the co-applicants for the subsequent application. This was the situation in the present case. Thus, the presumption of a validly claimed priority applied.

G 1/22 and G 2/22 further provided that the presumption can be rebutted to take into account "rare exceptional circumstances" where the subsequent applicant cannot justifiably rely on the priority. The rebuttable presumption thus involved the reversal of the burden of proof, i.e. the party challenging the subsequent applicant's entitlement to priority had to prove that this entitlement was missing. Just raising speculative doubts – even if these were "serious" – was not sufficient.

The board noted that the opponent's arguments were mainly based on documents concerning the resolution of the inventorship dispute, which said nothing about priority entitlement. From this, the opponents argued that these documents did not provide any basis for inferring the existence of an implicit transfer of the priority rights from Party A1/A2 to the appellants and, therefore, that the appellants had not provided evidence that they were entitled to the priority rights they claimed. According to the board, however, the presumption in G 1/22 and G 2/22 stated that the appellants do not have to provide such evidence, but the opponents have to rebut the presumption. There was no evidence that rebutted the presumption in the present case. If at all, there was evidence supporting the presumption of an implied transfer agreement. The entire purpose of the inventorship dispute was to have Party A1 named as inventor, and Party A2 as proprietor, in the PCT application. In the absence of evidence to the contrary, it was not credible that Party A1 or Party A2 would have acted in any way to invalidate the priority claim of the patent.

The board found the priority claims to be valid and remitted the case to the opposition division for further prosecution.

122-11-24

## 4. Article 087(1) EPC | T 2132/21 | Board 3.3.02

### Article 087(1) EPC

<b>Case Number</b>	T 2132/21
<b>Board</b>	3.3.02
<b>Date of decision</b>	2024.06.13
<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 087(1), 088(1) EPC
<b>EPC Rules</b>	
<b>RPBA</b>	
<b>Other legal provisions</b>	
<b>Keywords</b>	priority (yes) – application of G 1/22 and G 2/22 – implied agreement (yes)
<b>Cited decisions</b>	G 0001/22, G 0002/22
<b>Case Law Book</b>	<a href="#">II.D.2.2</a> , 10th edition

In [T 2132/21](#) the patent claimed priority from a US application filed in the name of four inventors. In the filing of the PCT application leading to the patent, the four inventors were named as applicants for the US only and a corporation was named as applicant for all other states. The appellant (opponent) argued that the priority was not valid because there was no evidence that the priority rights had been transferred to the respondent (patent proprietor) before the PCT application was filed.

The board recalled that in G 1/22 and G 2/22 the Enlarged Board had stated that in a situation where a PCT application is jointly filed by parties A and B, (i) designating party A for one or more designated States and party B for one or more other designated States, and (ii) claiming priority from an earlier patent application designating party A as the applicant, the joint filing implies an agreement between parties A and B allowing party B to rely on the priority, unless there are substantial factual indications to the contrary. This was the situation in the case in hand. Thus, the joint filing of the PCT application, in the absence of evidence to the contrary, was sufficient proof of an implied agreement on the joint use of the priority right.

The board concluded that, on formal grounds, the priority claim was valid.

123-11-24

## 5. Article 112a(2)(c) EPC | R 0008/19 | EBA

### Article 112a(2)(c) EPC

<b>Case Number</b>	R 0008/19
<b>Board</b>	EBA
<b>Date of decision</b>	2024.04.12
<b>Language of the proceedings</b>	EN
<b>Internal distribution code</b>	B
<b>Inter partes/ex parte</b>	Inter partes
<b>EPC Articles</b>	Articles 112a(2)(c), 113(1) EPC
<b>EPC Rules</b>	
<b>RPBA</b>	
<b>Other legal provisions</b>	
<b>Keywords</b>	petition for review – unallowable – fundamental violation of Article 113 EPC (no) – opportunity to comment (yes)
<b>Cited decisions</b>	R 0001/08, R 0015/12, R 0008/13, R 0016/13, T 1537/16
<b>Case Law Book</b>	<a href="#">V.B.4.3.5</a> , <a href="#">V.B.4.3.8a</a> , 10th edition

In [R 8/19](#) the petitioner (opponent 1) claimed that its right to be heard had been fundamentally violated. It had allegedly only learnt from the written reasons of the decision that, when acknowledging inventive step with respect to auxiliary request 1, the board had redefined the objective technical problem; and the board had allegedly done this in a completely unexpected manner. The petitioner argued that unless an opponent knew how the problem was being defined, it was impossible to present arguments on inventive step.

First of all, the Enlarged Board of Appeal (EBA) recalled that decisions of a board of appeal may only be based on grounds or evidence on which the parties have had an opportunity to present their comments (Art. 113(1) EPC) and a party must not be taken by surprise by the reasons for the decision referring to unknown grounds or evidence. The right to be heard is observed if a party has had the opportunity to comment on the decisive considerations and the relevant passages of the prior art on which a decision is based (see e.g. R 16/13). On the other hand, the board must be able to draw its own conclusion from the discussion of the grounds put forward (R 8/13, R 16/13). Thus, the right to be heard does not go so far as to impose an obligation on a board to disclose to the parties, in advance, how and why, on the basis of the decisive issues under discussion – or at least those foreseeable as the core of the discussion – it will come to its conclusion. This is part of the reasoning given in the written decision (R 1/08, R 15/12, R 16/13).

In the present case, a cornerstone of the board's inventive step reasoning with respect to claim 1 of auxiliary request 1 was the construction of the objective problem to be solved by the claimed subject-matter. While not following the proprietor's and petitioner's views, the board had considered that the objective problem solved was the provision of a pharmaceutical formulation with a zero order release profile.

According to the EBA, whether the board's reliance on an objective problem that had never been mentioned to the petitioner amounted to a fundamental violation of the right to be heard could not generally be answered in the affirmative. The EBA argued that the right to be heard in the context of the problem-solution approach meant that there should normally have been a discussion on the relevant prior art, the differences between the prior art and the claimed invention, and the technical relevance of these differences. Within the framework of what had been addressed in the course of these discussions, the deciding organ should be free to apply the problem-solution approach as it sees fit, and even identify an objective problem that had not been explicitly spelled out as such during the proceedings. In any case, the objective problem eventually used in the reasoning had to be based on technical effects (or the lack of any) and the features of the invention causally linked to such effects, upon which the parties had had an opportunity to comment.

With respect to auxiliary request 1 and the board's decision on inventive step, which had given rise to the petition, the EBA concluded that the board had based its decision only on grounds that had been objectively foreseeable by the parties, in view of their submissions and the board's statements during the appeal proceedings.

The EBA reasoned that during the entire proceedings leading to the decision under review, the zero order release profile – the provision of which had been eventually adopted by the board as the objective technical problem – had been discussed, either as a quality of the erosion matrix or as a feature that was desirable per se. According to the file, the discussion on the main request had covered the zero order release profile in connection with the disputed distinguishing feature, the erosion matrix. Not only the problem eventually used in the context of auxiliary request 1 (to achieve a zero order release profile) but also the solution (the use of a water-soluble polymer) had been explicitly discussed in the context of the main request. The EBA held that the facts and evidence underlying the board's decision on auxiliary request 1 had been discussed in a way that had given the petitioner sufficient opportunities to be heard.

The EBA concluded that no fundamental violation of Art. 113 EPC had occurred, since the parties had had the opportunity to comment upon the grounds and evidence on which the decision under review was based, in particular, on the additional limiting feature of auxiliary request 1 and the technical effect eventually used by the board in its application of the problem-solution approach.

124-11-24

## 6. Article 113(1) EPC | J 0011/20 | Board 3.1.01

### Article 113(1) EPC

<b>Case Number</b>	J 0011/20
<b>Board</b>	3.1.01
<b>Date of decision</b>	2024.07.25
<b>Language of the proceedings</b>	EN
<b>Internal distribution code</b>	D
<b>Inter partes/ex parte</b>	Ex parte
<b>EPC Articles</b>	Article 113(1) EPC
<b>EPC Rules</b>	Rules 058, 103(1)(a) EPC
<b>RPBA</b>	
<b>Other legal provisions</b>	
<b>Keywords</b>	right to be heard – violation of the right to be heard (yes) – substantial procedural violation (yes) – reimbursement of appeal fee (yes)
<b>Cited decisions</b>	
<b>Case Law Book</b>	<a href="#">III.B.2.4.4</a> , <a href="#">III.B.2.2.2</a> , 10th edition

### [See also abstract under Article 16 EPC](#)

In [J 11/20](#) the applicant appealed a decision of the Receiving Section refusing their application for the reason that the amended drawings filed by the applicant to remedy formal deficiencies in the application documents were not in agreement with the application documents as originally filed and, despite the invitation by the Receiving Section dated 14 March 2019, the applicant had not corrected this deficiency in due time.

In the statement of grounds of appeal, the appellant submitted that the Receiving Section's communication dated 14 March 2019 had appeared not to have been received by them. They also objected that the EPO had committed a substantial procedural violation by providing information on a procedural non-compliance leading to a severe loss of rights to an assistant by means of an informal telephone call, rather than to the duly appointed representative with an official communication. Informing, in an informal manner, the assistant instead of the duly appointed professional representative, prevented the latter from the possibility to correctly react. The appellant furthermore indicated that these arguments had already been brought to the attention of the Receiving Section with the letter dated 24 October 2019, in reply to the communication under Art. 113(1) EPC. However, they had remained disregarded and the Receiving Section had issued the appealed decision.

In the context of the reimbursement of the appeal fee under R. 103(1)(a) EPC, the Legal Board saw at least a substantial procedural violation in the fact that the Receiving Section had disregarded the objection of lack of receipt of the communication dated 14 March 2019, and had given no consideration to the request for re-establishment of rights. The lack of receipt of this communication had been disputed by the appellant – in addition to the statement of grounds of appeal – before the appealed decision was issued, both in the request for re-establishment of rights and in reply to the communication under Art. 113(1) EPC.

The Legal Board remarked that in the Receiving Section's communication under Art. 113(1) EPC, by reference to the telephone conversation with the assistant of the appellant's representative, the assumption that the communication dated 14 March 2019 had actually been received by the professional representative was taken as a fact. However, there was no trace in the file that the respective telephone note had also been formally notified to the professional representative, giving him the chance to take position on this fact before it being taken into account in the communication under Art. 113(1) EPC.

The Legal Board held that, by simply disregarding the appellant's submissions, the Receiving Section had violated the right to be heard under Art. 113(1) EPC. It is a well-established principle that this right requires not only that an opportunity to present comments is given, but also that these comments are actually taken into due consideration in the decision. The Legal Board concluded that this violation was of a substantial nature since it had affected the reasons on which the appealed decision had been taken, namely the assumption that the communication dated 14 March 2019 had been received by the appellant and thus the deficiencies under R. 58 EPC had not been corrected in due time. The appellant had been given no other choice than filing the appeal. In view of these circumstances, the Legal Board considered that reimbursement of the appeal fee was equitable.

125-11-24

## 7. Article 114(2) EPC | T 0021/22 | Board 3.3.03

### Article 114(2) EPC

<b>Case Number</b>	T 0021/22
<b>Board</b>	3.3.03
<b>Date of decision</b>	2024.07.09
<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 099, 114(2) EPC
<b>EPC Rules</b>	
<b>RPBA</b>	Article 12(4) RPBA 2020
<b>Other legal provisions</b>	
<b>Keywords</b>	Late-filed facts – correct exercise of discretion (no)
<b>Cited decisions</b>	T 2324/14, T 2026/15, T 1525/17, T 0847/20
<b>Case Law Book</b>	<a href="#">IV.C.4.5.3a</a> , 10th edition

In [T 21/22](#) document D20 was filed by the appellant (opponent) on the day of the oral proceedings before the opposition division but was not admitted into the proceedings because of its late filing and the fact that it was not prima facie relevant for novelty and inventive step.

Although the respondent had initially endorsed the arguments of the opposition division, they stated during the oral proceedings before the board that they withdrew their objection to the admittance of D20 into the proceedings.

The board observed that the opposition division had in fact conducted a comprehensive examination of late-filed D20 in respect of novelty and inventive step prior to concluding that it should not be admitted on the basis of its late filing and the fact that it was not prima facie relevant. The opposition division had therefore not only carried out a mere prima facie assessment but had fully considered D20 and the objections based upon it. Thus, the board held that there was no discretion left for the opposition division not to admit D20 into the proceedings (cf. T 1525/17, T 847/20, T 2026/15, T 2324/14), since it was de facto fully considered (and therefore implicitly admitted) by the opposition division.

126-11-24



## 8. Article 114(2) EPC | T 1445/22 | Board 3.2.07

### Article 114(2) EPC

<b>Case Number</b>	T 1445/22
<b>Board</b>	3.2.07
<b>Date of decision</b>	2024.03.28
<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 099(1), 114(2) EPC
<b>EPC Rules</b>	Rule 116(1) EPC
<b>RPBA</b>	Articles 12(4), 12(6) RPBA 2020
<b>Other legal provisions</b>	
<b>Keywords</b>	late filed evidence – opportunity to present comments (yes) – correct exercise of discretion (yes) – evidence admitted (no)
<b>Cited decisions</b>	G 0010/91, T 1002/92
<b>Case Law Book</b>	<a href="#">IV.C.2.2.2</a> , <a href="#">IV.C.4.3</a> , <a href="#">IV.C.4.5.1</a> , <a href="#">V.A.4.3.6</a> , 10th edition

In [T 1445/22](#) the appellant requested the admittance into the appeal proceedings of late-filed documents D10 to D12, D14, D15 and D20, which had not been admitted into the opposition proceedings for being prima facie not relevant with respect to the sufficiency of disclosure objection, as well as D26 and D27 filed with the statement of grounds of appeal.

The board first examined Art. 12(6), first sentence, RPBA and noted that evidence submitted by an opponent after the expiry of the nine-month period according to Art. 99(1) EPC was generally to be regarded as late-filed. Exceptions to this rule were where such evidence could not have been filed earlier, for example where the subject of the proceedings had changed. This was typically the case where new claim requests were filed such that there was no reason to file the evidence in response thereto any earlier or where the opposition division had raised a new issue.

In the case in hand the opposition division had not raised any new aspects in its preliminary opinion, but rather reiterated the position, given by the respondent (patent proprietor) in its reply to the notice of opposition. The board found therefore that there had been no change in the subject of the proceedings before the opposition division which would have led to new evidence being considered to be timely filed.



The board also did not consider the circumstances leading to the obtainment of the evidence by the party filing it as relevant for the issue of whether a document was filed in due time. These circumstances were external to the proceedings and it would run counter to the concept of discretionary power if that discretion were denied to a deciding body by circumstances external to the proceedings. Were such discretion to be denied, then all documents created or coming to light at any stage of the proceedings that were filed by a party would automatically be part of the proceedings. However, this would undermine the nine-month period under Art. 99(1) EPC which aims to establish the factual and legal framework within which the substantive examination of the opposition is, in principle, conducted, allowing the patent proprietor a fair chance to consider its position at an early stage of the proceedings (see G 10/91, point 6 of the Reasons, and T 1002/92). Therefore, documents D10 to D12, D14, D15 and D20 had not been filed in due time and the opposition division had the discretion, under Art. 114(2) EPC, not to admit them.

The appellant (opponent) argued that it had not been given the opportunity to present detailed arguments based on documents D10 to D12, D14, D15 and D20, as only prima facie relevance had been discussed before the opposition division. The board found, however, that the appellant had in fact had the opportunity to present its arguments relating to the admittance and prima facie relevance of those documents during the opposition proceedings. It also noted it was established case law that a board of appeal should only overrule the way an opposition division exercised its discretion if it did so according to the wrong principles, not taking into account the right principles or in an unreasonable way. It was, therefore, not the function of a board of appeal to review all the facts and circumstances of the case to decide whether it would have exercised its discretion in the same way or not. In the case in hand the opposition division had regarded D10 to D12 as representing common general knowledge which did not need to be supported, and it could not see the relevance of D14, D15 or D20 for supporting the objection to insufficiency of disclosure. Thus, the opposition division had considered these documents as prima facie not relevant and had exercised its discretion reasonably, according to the right principles, after hearing both parties.

In its statement of grounds of appeal, the appellant had further requested that documents D10 to D12, D14, D15 and D20 be admitted into the appeal proceedings with respect to the appellant's lack of inventive step objections. The board decided to exercise its discretion under Art. 114(2) EPC and Art. 12(4) RPBA and not admit these documents into the appeal proceedings as none of the documents were suitable to address the issues which led to the decision under appeal.

In addition, the board found that there was no change in the opposition proceedings or particular circumstances in the present case which necessitated the filing of documents D26 and D27 for the first time in the appeal proceedings. D26 and D27 could and should have been filed during the opposition period. Therefore, the board did not admit them into the appeal proceedings (Art. 12(6), second sentence, RPBA and Art. 12(4) RPBA).

127-11-24

## 9. Rule 113(1) EPC | T 0572/19 | Board 3.4.01

### Rule 113(1) EPC

<b>Case Number</b>	T 0572/19
<b>Board</b>	3.4.01
<b>Date of decision</b>	2024.04.05
<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>	Rules 100(2), 103(1)(a), 113(1), 140 EPC
<b>RPBA</b>	
<b>Other legal provisions</b>	
<b>Keywords</b>	appealed decision – substantial procedural violation (yes) – reimbursement of appeal fee (yes)
<b>Cited decisions</b>	J 0016/17, T 0390/86, T 2076/11, T 3071/19
<b>Case Law Book</b>	<a href="#">III.K.3.3</a> , <a href="#">III.K.3.3.1</a> , <a href="#">III.K.3.3.2</a> , <a href="#">III.L.3</a> , 10th edition

In [T 572/19](#) the proprietor appealed the opposition division's decision, issued in writing on 17 December 2018, to revoke the patent ("the appealed decision"). By communication under R. 100(2) EPC, the parties were informed of the board's observation that EPO Form 2339, dated 10 December 2018, bore the name, but not the signature, of the legally qualified member who had participated in the decision-making process. The board's preliminary view was that this amounted to a substantial procedural violation.

By the opposition division's communication dated 26 June 2023, to which an altered EPO Form 2339 ("the post-signed Form 2339") and an explanatory note on EPO Form 2906 ("the division's explanation") were annexed, the parties and the board were informed that the missing signature had been corrected under R. 140 EPC, with the chair belatedly signing the form on behalf of the legally qualified member. The missing signature was deemed to concern "a formal error being an obvious mistake", made when the paper file circulated between EPO sites. It was assured that the grounds attached to the appealed decision, when issued, had previously been circulated by email to all members of the opposition division; also the grounds had thus reflected the opinion of all the members of the opposition division, including the legally qualified member, who had confirmed her agreement in an email at the time.

The first question addressed by the board was the scope of signature requirement under R. 113(1) EPC since the parties disagreed thereon. The disagreement lay in

whether the term "decisions" means simply the outcome of the proceedings (e.g. "The patent is revoked"), which is what opponent 1 argued, or extends to the substantiation in the written decision, which was the proprietor's view. Referring to T 2076/11, J 16/17 and T 390/86, the board held that the jurisprudence of the boards of appeal indicated that the written decision, including the substantiation, was the object of the signature requirement. There was, then, no doubt that the signature requirement under R. 113(1) EPC applied to the written decision, including the substantiation, and not only to the outcome that might be announced during oral proceedings.

Secondly, the board examined the purpose of the signature requirement under R. 113(1) EPC. Referring *inter alia* to J 16/17, it emphasised that the purpose of the signature requirement under R. 113(1) EPC was only achieved if there was an unbroken chain of manifest personal responsibility, taken by each member of the decision-making body who was assigned to the case, throughout the decision-making process, including for the written decision.

Finally, due to the cases presented by the opponents, the board addressed three potential remedies: a) "the pragmatic approach" according to which another member signs on behalf of one who is not in a position to sign, and provides a written explanation; b) recognition of a possibility for the opposition division, after remittal, to heal the deficiency without entering into the merits and extent of the appealed decision; and c) correction of the appealed decision under R. 140 EPC. The board held that none of these remedies was applicable in the current case. In particular, it was of the view that while issuing a decision without the legally qualified member's signature had been a mistake, it had not been an obvious one within the meaning of R. 140 EPC. It followed that the appealed decision had not been corrected under R. 140 EPC by the post-signed Form 2339 and the division's explanation.

The board concluded that since none of the potential remedies was applicable, the chain of manifest personal responsibility was broken, the missing signature was a substantial procedural violation, and the appealed decision was invalid. The appealed decision was set aside, and the case remitted to the opposition division for further prosecution. The board found reimbursement of the appeal fee under R. 103(1)(a) EPC equitable, for the reason that no substantial progress had been made in the appeal since it had been filed (T 3071/19).

128-11-24

## 10. Rule 136(1) EPC | T 1882/23 | Board 3.5.05

### Rule 136(1) EPC

<b>Case Number</b>	T 1882/23
<b>Board</b>	3.5.05
<b>Date of decision</b>	2024.09.23
<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 122(1) EPC
<b>EPC Rules</b>	Rules 112(1), 136(1) EPC
<b>RPBA</b>	
<b>Other legal provisions</b>	
<b>Keywords</b>	re-establishment of rights (no) – date of removal of the cause of non-compliance – request not filed in due time
<b>Cited decisions</b>	J 0027/90, J 0001/20, T 0942/12, T 0231/23
<b>Case Law Book</b>	<a href="#">III.E.4.1.1a</a> ), <a href="#">III.E.4.1.1b</a> ), 10th edition

In the decision under appeal in [T 1882/23](#), the examining division had rejected the applicant's request for re-establishment of rights in respect of the time limit for paying the renewal fee for the fourth year and the additional fee, and deemed the patent application to be withdrawn. The examining division considered the request to be inadmissible because it was not filed within two months of the removal of the cause of non-compliance within the meaning of R. 136(1), first sentence, EPC.

The board recalled that the removal of the cause of non-compliance is to be established on a purely factual basis. It occurred, as a rule, on the date on which the person responsible for the application vis-à-vis the EPO became aware of the fact that a time limit had not been observed. This awareness was typically the result of the actual receipt of a communication of loss of rights under R. 112(1) EPC (see T 231/23, J 1/20). This had not been disputed by the appellant.

The appellant argued that, in the present case, the person responsible for the application vis-à-vis the EPO should be the person employed by the appellant to manage its patent portfolio (the "IP person"). It argued that this person's awareness had to be decisive, and not that of the professional representative. According to the appellant, the present circumstances illustrated the problems associated with a "hybrid" system, where the representative was not fully responsible for all actions relating to the application, but where other persons, in this case the in-house IP person, were responsible for the patent portfolio and for managing the payment of

renewal fees. The appellant stressed that the authorised firm of representatives had been specifically told that they were not responsible for paying the renewal fees.

The board did not find these arguments convincing. The question of who was responsible for which task within the appellant's sphere of responsibility could not be decisive for the issue of determining the point in time when the cause of non-compliance with the period was removed. Legal certainty required that the starting point be clearly and objectively determined. This could not depend on the circumstances of how the appellant had organised its tasks and representation, whether internally or with the help of external providers.

The board referred to the current case law on this matter and observed that, where a professional representative was appointed, it was that representative who was the "person responsible for the application vis-à-vis the EPO" (cf. J 1/20). The professional representative remained the person whose awareness was relevant for assessing when the cause of non-compliance with the period was removed, irrespective of whether a third party other than the representative was responsible for the payment of fees (J 27/90). As such, regardless of the contractual arrangements made by the appellant for the payment of fees, the appointed professional representative remained the EPO's single point of contact (T 231/23). If the appointed professional representative received a communication of loss of rights due to the non-payment of fees, the cause of non-compliance with the period was removed pursuant to R. 136(1), first sentence, EPC on the date of that actual receipt. This was also true where, as in the present case, that representative had been instructed by their client that all renewal matters would be handled by others. According to the board, such an instruction alone was not a reason for the cause of non-compliance to persist despite the appointed professional representative's actual awareness of the non-compliance (T 231/23). Thus, in the case in hand, it was irrelevant whether, and on which date, the appellant's "IP person" received the notice of loss of rights.

The appellant also sought to rely on T 942/12. However, the board did not find this decision relevant to the question at hand. According to the board, the findings in T 942/12 concerned solely the question of whether the representative had exercised "all due care", i.e. the merits of the request for re-establishment of rights. In contrast, the question in the case at hand related to the person whose awareness was relevant for the removal of the cause of non-compliance. This question was independent of the question of whether all due care was taken.

The professional representative had received the notice of loss of rights on 4 June 2019. The removal of the cause of non-compliance with the period thus occurred on that date. The request for re-establishment of rights was filed on 10 September 2019, i.e. it was not filed within the two-month time limit laid down in R. 136(1), first sentence, EPC. Therefore, the appeal was dismissed.

129-11-24

## 11. Article 12(4) RPBA 2020 | T 0446/22 | Board 3.2.05

### Article 12(4) RPBA 2020

<b>Case Number</b>	T 0446/22
<b>Board</b>	3.2.05
<b>Date of decision</b>	2024.03.20
<b>Language of the proceedings</b>	DE
<b>Internal distribution code</b>	D
<b>Inter partes/ex parte</b>	Inter partes
<b>EPC Articles</b>	
<b>EPC Rules</b>	Rule 116 EPC
<b>RPBA</b>	Article 12(2), 12(4) RPBA 2020
<b>Other legal provisions</b>	
<b>Keywords</b>	amendment to case – requests – requirements of Art. 12(2) RPBA met (no) – admissibly raised and maintained (yes) – reference to Guidelines for Examination applicable at the time of the contested decision
<b>Cited decisions</b>	T 1706/19
<b>Case Law Book</b>	<a href="#">V.A.4.2.1c</a> , 10th edition

In [T 446/22](#) beantragte die Beschwerdeführerin (Einsprechende), die mit der Beschwerdeerwiderung eingereichten Hilfsanträge 3.1 und 3.2 nicht in das Beschwerdeverfahren zuzulassen. Diese Hilfsanträge entsprachen den vor der Einspruchsabteilung vorgelegten Hilfsanträgen 3.1 und 3.2, über die die Einspruchsabteilung nicht entschieden hatte, da sie den höherrangigen Hilfsantrag 1 für gewährbar erachtet hatte. Wie von der Kammer festgestellt, bildeten diese Anträge daher einen Teil des Beschwerdevorbringens der Beschwerdegegnerin (Patentinhaberin), welcher der angefochtenen Entscheidung nicht zugrunde lag und somit die Erfordernisse des Art. 12 (2) VOBK nicht erfüllte.

Bei der Prüfung der Frage, ob die Hilfsanträge 3.1 und 3.2 im Verfahren vor der Einspruchsabteilung in zulässiger Weise vorgebracht und aufrechterhalten wurden, zog die Kammer die zum Zeitpunkt der mündlichen Verhandlung vor der Einspruchsabteilung gültige Fassung der Richtlinien für die Prüfung im Europäischen Patentamt (März 2021) heran. Danach waren geänderte Anträge, die in Reaktion auf die in der Anlage zur Ladung erläuterte vorläufige Auffassung der Einspruchsabteilung, dass das Patent wahrscheinlich widerrufen wird, eingereicht wurden, in der Regel zuzulassen, sofern dies vor dem nach R. 116 EPÜ bestimmten Zeitpunkt erfolgte. Die Kammer sah diese Voraussetzung als erfüllt an, auch wenn die betreffenden Hilfsanträge erst nach dem in einer ersten Ladung festgelegten

Zeitpunkt nach R. 116 EPÜ eingereicht worden waren. Sie sah es als entscheidend an, dass die Hilfsanträge vor dem Zeitpunkt nach R. 116 EPÜ eingereicht worden waren, der in der Ladung zur durchgeführten mündlichen Verhandlung festgesetzt worden war. Durch die Aufhebung der Ladung sei auch der mit dieser Ladung bestimmte Zeitpunkt nach R. 116 EPÜ rechtlich unwirksam geworden (s. a. T 1706/19).

Bei dieser Sachlage kam die Kammer zum Schluss, dass die Einspruchsabteilung in Anwendung der damals gültigen Richtlinien die fristgerecht vorgelegten Hilfsanträge 3.1 und 3.2 wohl ins Einspruchsverfahren zugelassen hätte, falls sie die höherrangigen Hilfsanträge 1 und 2 als nicht gewährbar erachtet hätte. Die Hilfsanträge 3.1 und 3.2 wurden daher nach ihrer Ansicht im Einspruchsverfahren in zulässiger Weise vorgebracht. Darüber hinaus wurden diese Hilfsanträge am Ende der mündlichen Verhandlung nicht zurückgenommen. Infolgedessen galten die mit der Beschwerdeerwiderung eingereichten Hilfsanträge nicht als Änderung im Sinne von Art. 12 (4) VOBK. Hilfsantrag 3.2 konnte zudem die Einwände nach Art. 123 (2), 54 und 56 EPÜ überwinden und die Angelegenheit wurde an die Einspruchsabteilung zurückverwiesen mit der Anordnung, das Patent in geändertem Umfang aufrechtzuerhalten.

130-11-24



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