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Abstracts of decisions

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1. Article 056 EPC | T 1768/20 | Board 3.5.07

Article 056 EPC

Case Number	T 1768/20
Board	3.5.07
Date of decision	2023.07.03
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 – technical and non-technical features – simulation – design model
Cited decisions	G 0001/19
Case Law Book	I.C.9.2.11b , 10th edition

In [T 1768/20](#) the application related to generating a design model for a chip design by means of a design tool and simulation. The board stated that decision G 1/19 was now the essential case law that had to be considered when assessing inventive step in the current case. According to point 97 of G 1/19, "calculated technical effects should be distinguished from potential technical effects which, for example when a computer program or a control signal for an image display device is put to its intended use, necessarily become real technical effects".

The Enlarged Board of Appeal saw no difference regarding the technicality of a simulated physical system in the event that the computer-implemented simulation was claimed as part of a design process, in particular for verifying a design.

The board considered that, in the current case, the result of the calculations effected by the method steps of claim 1 was a design model with an "improved" characterisation that is obtained by simulation of a standard cell which was provided in a library file. Such a library file was used by customers in later stages of the overall design process, but the method of claim 1 did not contain steps specifying the use of the produced library file in later design or manufacturing steps. A use of the design model in a manufacturing step would have been particularly relevant since the Enlarged Board considered the inclusion of a manufacturing step to be an argument in favour of patentability.

Since the result of the method of claim 1 was calculated data for an improved design that was obtained using simulation, it followed from decision G 1/19 that the improved design did not contribute to inventive step since no "further" technical effect, such as controlling a machine in the foundry during a manufacturing process, was derivable. The board was aware that a "further" technical effect relating to the internal operation of the computer system could also be achieved by the claimed method. However, the only feature of the claimed method that concerned details of its implementation in a computer system was that results were provided in a library file, i.e. that result data were stored in a file, which was well known. Moreover, since the data was as such non-technical, only the storing of the data in a file could be regarded as being technical, but this was also known. Consequently, the steps of the claimed method represented a non-technical algorithm.

The appellant had argued that the invention was an "exceptional case" in the sense of decision G 1/19 for which the calculated behaviour of components (standard cells) of a physical system (microchip), exclusively for the purpose of manufacturing the microchip was the basis for a technical contribution. The properties of standard cells calculated during characterisation were specifically and exclusively calculated, provided and used for production purposes. While this was not explicitly stated in the claims, this followed from the context of microchip fabrication and the skilled person's common general knowledge. The appellant also argued that the library file contained data that was used by the machines in the foundry.

Regarding the appellant's argument that the claimed invention was an exceptional case according to points 98 and 128 of decision G 1/19, it was important to consider whether the design produced by the method had a potential technical effect in the sense of point 97 of decision G 1/19 (e.g. because the design was produced as a computer program or a television control signal). The exceptional cases mentioned in G 1/19 are to be understood only as cases where the simulation and/or design result, when put to its intended use, without any further human interaction, achieves a technical effect such as controlling a technical device. Such a strict approach is desirable to establish legal certainty by drawing a clear line for the technicality of design processes producing a design. A design consisting merely of geometrical data such as a layout mask could not be said to have a potential technical effect in the sense of decision G 1/19. Since the library file was not directly used to control the machines in the foundry and even further human input was necessary before its use in a manufacturing step, the library file produced by the method of claim 1 could not be considered to have an implied technical effect. Consequently, the board was not convinced that the current case was an "exceptional case" in the sense of decision G 1/19. It therefore followed that the method of claim 1 lacked an inventive step.

151-13-23

2. Article 072 EPC | J 0005/23 | Board 3.1.01

Article 072 EPC

Case Number	J 0005/23
Board	3.1.01
Date of decision	2023.09.04
Language of the proceedings	EN
Internal distribution code	C
Inter partes/ex parte	Ex parte
EPC Articles	Article 072 EPC
EPC Rules	Rule 002 EPC
RPBA	
Other legal provisions	Articles 31, 32 Vienna Convention on the Law of Treaties 1969
Keywords	assignment of a European patent application –the meaning of "signature" in Article 72 EPC – materials to be considered in the systematic interpretation of the EPC
Cited decisions	G 0005/83, G 0002/12, G 0003/14, G 0003/19, J 0010/20
Case Law Book	III.H.1.1. , III.H.1.2.2. , III.H.6. , III.M.2.3. , 10th edition

In [J 5/23](#) the applicant had filed an appeal against the Legal Division's decision rejecting the request to record the transfer of the application. The appeal hinged on how the term "signature" in Art. 72 EPC was to be understood and, in particular, whether it encompassed electronic signatures in the form of "text string signatures" without any further qualification.

The Legal Board recalled that when interpreting the provisions of the EPC, the principles of interpretation laid down in Art. 31 and 32 of the VCLT 1969 must be applied. Starting out with the wording of the term, the Legal Board found that in the given context of a contract the term "signature" signified mostly a handwritten depiction of someone's name. The Legal Board then examined the underlying purpose of the provision in light of the object and purpose of the treaty. It noted that the general rationale underlying Art. 72 EPC was that there must be clear and unambiguous formal requirements for the transfer of a European patent application, resulting in a sufficient level of authenticity of the assignment contract. It would be at odds with the rationale of this provision if – without any explicit legal basis – any type of text in electronic form referring to the name of a person were considered a "signature" within the meaning of Art. 72 EPC.

The Legal Board further established that in the systematic interpretation of the EPC, the material to be taken into account included the entirety of the articles of the EPC, as well as the Implementing Regulations to it. The latter encompassed the Implementing Regulations to the EPC 1973 as well as subsequent amendments.

As to R. 2(1) EPC the Legal Board stated that this provision regulated how documents might be filed "in proceedings before the European Patent Office". The phrase "where the Convention provides that a document must be signed" in R. 2(2) EPC had to be read not in an isolated manner but in the context of the entire provision, taking account of the contents of R. 2(1) EPC and the title of R. 2 EPC. The Legal Board concluded that the scope of application of R. 2 EPC in its entirety was limited to formal requirements for filing documents in proceedings before the EPO. Such formal requirements concerned a relationship between the EPO, a public authority, and a party to proceedings before the EPO, which was usually a private party. Art. 72 EPC, on the other hand, regulated formal requirements for assignment contracts. This usually concerned a relationship between two or more private parties. Hence, R. 2 EPC and Art. 72 EPC regulated entirely different matters. Moreover, unlike Art. 72 EPC, R. 2 EPC did not have any impact on national law.

Regarding the "Decision of the President of the EPO dated 14 May 2021 concerning the electronic filing of documents" (OJ 2021, A42), the Legal Board noted that, as the scope of application of R. 2 EPC was limited to formal requirements for filing documents in proceedings before the EPO, the power conferred to the President of the EPO in R. 2(2), second sentence, EPC, was subject to the same limitation.

The appellant had also referred to the "Notice from the European Patent Office dated 22 October 2021 concerning electronic signatures on documents submitted as evidence to support requests for registration of a transfer of rights under Rules 22 and 85 EPC and requests for registration of a licence or other rights under Rule 23 EPC" (OJ 2021, A86). According to the Legal Board, while a notice from the EPO might be a source of legitimate expectations (see J 10/20), it was, as such, only a document providing information. The Notice was not a legal instrument passed by a competent legislative body, so it could neither implement nor specify any articles of the EPC. It was not part of the material referred to in Art. 31(2) and (3) VCLT and was not to be taken into account for a systematic interpretation of Art. 72 EPC.

In conclusion, the Legal Board, applying the general rule of interpretation pursuant to Art. 31 VCLT to the term "signature" in Art. 72 EPC, held that in the absence of a different definition in the Implementing Regulations, this term must be understood as referring to a handwritten depiction of someone's name, written on the assignment "contract" referred to in Art. 72 EPC.

152-13-23

3. Article 083 EPC | T 1983/19 | Board 3.2.05

Article 083 EPC

Case Number	T 1983/19
Board	3.2.05
Date of decision	2023.04.03
Language of the proceedings	DE
Internal distribution code	D
Inter partes/ex parte	Inter partes
EPC Articles	Articles 083, 100(b) EPC
EPC Rules	
RPBA	
Other legal provisions	
Keywords	sufficiency of disclosure – invention to be performed over whole range claimed – field of mechanics
Cited decisions	T 2773/18
Case Law Book	II.C.5.2. , II.C.5.4. , 10th edition

In [T 1983/19](#) befasste sich die Kammer mit der Frage der Ausführbarkeit der Erfindung "über den gesamten beanspruchten Bereich" auf dem Gebiet der Mechanik.

Der Beschwerdeführer II (Einsprechender) hatte vorgetragen, dass die Ansprüche gewisse Aspekte der Erfindung (Gleitringdichtung), wie z.B. das Material und die Abmessungen der Gleit- und Gegenringe oder die Kraft, die das balgartige Federmittel aufbringen könne, nicht festlegten, dass aber der Fachmann nicht in der Lage sei, für alle vom Anspruch abgedeckten Varianten die geltend gemachte Wirkung zu erzielen.

Dieser Vortrag überzeugte die Kammer nicht. Entscheidend sei, dass das Patent dem Fachmann einen Weg aufzeigt, die Erfindung auszuführen.

Die vor allem im Kontext der Chemie entwickelte Rechtsprechung, der zufolge die Erfindung über den gesamten beanspruchten Bereich ausführbar sein muss, sei nicht ohne Abstriche auf die Mechanik übertragbar. Zu fast jedem Anspruch der Mechanik ließen sich beliebig viele Ausführungsbeispiele erdenken, die nicht ausführbar sind. Dies führe aber nicht dazu, dass die Erfindung als solche nicht ausgeführt werden könne (siehe auch T 2773/18).

Wenn zum Beispiel, wie vom Beschwerdeführer II eingeräumt, für jeden Fachmann offensichtlich sei, dass aus keramischem Material oder harten Metallen bestehende

Gleit-Gegenringe durch ein balgartiges Federmittel nicht verformt werden können, dann würde der Fachmann eben keine solchen Gleit- oder Gegenringe verwenden, um die Erfindung in die Tat umzusetzen. Das bedeute aber nicht, dass er außerstande wäre, die Erfindung auszuführen.

Somit stand nach Auffassung der Kammer der Einspruchsgrund gemäß Art. 100 b) EPÜ der Aufrechterhaltung des Patents wie erteilt nicht entgegen.

153-13-23

4. Article 083 EPC | T 0149/21 | Board 3.5.03

Article 083 EPC

Case Number	T 0149/21
Board	3.5.03
Date of decision	2023.07.04
Language of the proceedings	DE
Internal distribution code	D
Inter partes/ex parte	Inter partes
EPC Articles	Articles 083, 100(b) EPC
EPC Rules	Rule 042(1)(e) EPC
RPBA	
Other legal provisions	
Keywords	sufficiency of disclosure – invention to be performed over whole range claimed and indication of at least "one way" – recent case law from the boards in the field of mechanics
Cited decisions	T 0409/91, T 0435/91, T 1905/10, T 0862/11, T 2431/11, T 1542/12, T 2305/14, T 0941/16, T 2210/16, T 0222/17, T1306/17, T 2773/18, T 1921/19, T1983/19, T 0500/20
Case Law Book	II.C.5.2. , II.C.5.4. , 10th edition

In [T 149/21](#) betraf die Erfindung ein Verfahren zur Reduzierung des Energieverbrauchs einer Walzwerkanlage. Der Einspruch (Art. 100 (b) EPÜ) wurde zurückgewiesen. In der mündlichen Verhandlung vor der Kammer argumentierte der Beschwerdegegner (Patentinhaber), dass es nach der Rechtsprechung der Beschwerdekammern hinreichend sei, dass zumindest ein Weg zur Ausführung der Erfindung in der ursprünglichen Anmeldung aufgezeigt werde, um das Erfordernis von Art. 83 EPÜ zu erfüllen. Ob auch andere "exotische" Szenarien unter den Schutzgegenstand fielen, sei in diesem Zusammenhang unerheblich.

Die Kammer stimmte zu, dass das Streitpatent wenigstens einen Weg zur Ausführung der beanspruchten Erfindung im Einzelnen angebe und somit zumindest R. 42 (1) e) EPÜ erfülle. Nach der ständigen Rechtsprechung der Beschwerdekammern müsse jedoch die Ausführbarkeit der beanspruchten Erfindung im gesamten beanspruchten Bereich gegeben sein. Demnach sei die Angabe wenigstens eines Weges zur Ausführung der beanspruchten Erfindung zwar notwendig, aber nicht hinreichend für die Erfüllung des Erfordernisses von Art. 83 EPÜ. Die Kammer betonte zudem, dass diese Rechtsprechung in der Regel auch nicht auf das jeweilige Fachgebiet beschränkt sei: dasselbe Kriterium sei nämlich –

neben dem Bereich der Chemie – auch auf dem Gebiet der Elektrotechnik, Physik, und Mechanik mehrfach bestätigt und angewandt worden. Eine Qualifizierung dieser Rechtsprechung nach verschiedenen technischen Feldern wäre nach Auffassung der Kammer schon allein aufgrund des Gebots einer harmonisierten Anwendung des EPÜ in Bezug auf das Erfordernis der Ausführbarkeit auch schwer vermittelbar.

Die Kammer wies jedoch auch darauf hin, dass in kürzlich ergangenen Entscheidungen aus dem Bereich der Mechanik (vgl. T 2773/18, T 500/20 und T 1983/19) die Ansicht vertreten wurde, dass das aus dem Bereich der Chemie stammende Kriterium "im gesamten beanspruchten Bereich" nicht unbedingt auf andere technische Gebiete wie die Mechanik anwendbar sei. Insbesondere sei in diesem Zusammenhang z. B. in T 1983/19 betont worden, dass die vor allem im Kontext der Chemie entwickelte Rechtsprechung, der zufolge die Erfindung "über den gesamten beanspruchten Bereich" ausführbar sein muss, nicht ohne Abstriche auf die Mechanik übertragbar sei, da sich zu fast jedem Anspruch der Mechanik beliebig viele Ausführungsbeispiele erdenken ließen, die nicht ausführbar wären. Dies führe aber nicht dazu, laut T 1983/19, dass die "Erfindung als solche" nicht ausgeführt werden könne. Vielmehr genüge es, dass das Patent dem Fachmann lediglich einen Weg aufzeigt, die Erfindung auszuführen.

Auch der Beschwerdegegner hatte sich im vorliegenden Fall dieses Argument zu Nutze gemacht. Die Kammer war jedoch der Auffassung, dass die Angabe eines Weges zur Ausführung der beanspruchten Erfindung zwar für das Erfüllen des Erfordernisses nach R. 42 (1) e) EPÜ hinreichend sein mag, aber nicht notwendigerweise für das Erfüllen von Art. 83 EPÜ. Vielmehr sollte gemäß der Rechtsprechung der in diesem Artikel genannte Fachmann über alle technischen Gebiete hinweg durch das Streitpatent und sein allgemeines Fachwissen in die Lage versetzt werden, die beanspruchte Erfindung über den gesamten Bereich auszuführen, d. h. nach allen technisch möglichen Auslegungsvarianten, die der fachkundige Leser nach objektiven Kriterien aufgrund seines allgemeinen Fachwissens heranziehen würde. Mit anderen Worten sollten nach Ansicht der Kammer bei der Prüfung nach Art. 83 EPÜ alle "technisch sinnvollen" Anspruchsauslegungen berücksichtigt werden, wobei nicht nur jene Anspruchsauslegungen als "technisch sinnvoll" gelten könnten, bei denen die Erfordernisse des EPÜ als erfüllt gelten. Das Erfordernis, dass die Offenbarung die Ausführung der beanspruchten Erfindung "in ihrem gesamten Bereich" ermöglichen muss, steht auch im Einklang mit dem grundlegenden rechtspolitischen Anliegen, dass prinzipiell das durch ein Patent verliehene Ausschließungsrecht bezüglich seines Schutzbereichs durch den tatsächlichen Beitrag des Patents zum Stand der Technik begründet sein sollte.

Der Meinung der Kammer nach war der vorliegende Fall in diesem Zusammenhang keine Ausnahme. Die angefochtene Entscheidung wurde letztendlich aufgehoben und das Patent widerrufen.

154-13-23

5. Article 083 EPC | T 0867/21 | Board 3.5.03

Article 083 EPC

Case Number	T 0867/21
Board	3.5.03
Date of decision	2023.09.21
Language of the proceedings	DE
Internal distribution code	D
Inter partes/ex parte	Inter partes
EPC Articles	Articles 083, 100(b) EPC
EPC Rules	Rule 42(1)(e) EPC
RPBA	
Other legal provisions	
Keywords	sufficiency of disclosure – invention to be performed over whole range claimed and indication of at least "one way"
Cited decisions	T 0409/91
Case Law Book	II.C.5.2. , II.C.5.4. , 10th edition

In [T 867/21](#) betraf die Erfindung eine Antenneneinrichtung für Hörinstrumente. Die Kammer befasste sich zuerst ausführlich mit der für diesen Fall relevanten Frage der Auslegung von Anspruch 1. Danach befasste sich die Kammer mit der Frage der Ausführbarkeit.

Es sei im Streitpatent wenigstens ein Weg zur Ausführung der beanspruchten Erfindung offenbart.

Gemäß Art. 83 und 100 b) EPÜ ist es die "Erfindung", die so deutlich und vollständig zu offenbaren ist, dass ein Fachmann sie ausführen kann. Dabei ist die "Erfindung" nach Ansicht der Kammer als "die in den Ansprüchen definierte Erfindung" zu verstehen, im Einklang mit dem in den Art. 52, 54 und 56 EPÜ verwendeten Erfindungsbegriff. Demnach ist die "Erfindung", und damit auch die Frage, ob diese ausführbar ist, auf die Gesamtheit der Anspruchsmerkmale bezogen. Alle möglichen, für den Fachmann technisch sinnvollen Ausführungsformen, die unter die Merkmale des Anspruchs fallen, sind daher grundsätzlich in der Anmeldung bzw. im Patent so deutlich und vollständig zu offenbaren, dass ein Fachmann sie ausführen kann. Insofern kann das Erfordernis der Ausführbarkeit nur dann als erfüllt angesehen werden, wenn der Fachmann die in den Ansprüchen definierte Erfindung im gesamten beanspruchten Bereich unter Verwendung der Angaben in der Anmeldung bzw. dem Patent und des einschlägigen allgemeinen Fachwissens nacharbeiten kann. Dieses Erfordernis verlangt allerdings nicht, dass für jede einzelne, unter den Anspruch fallende, technisch sinnvolle Ausführungsform in der Anmeldung oder im

Patent ein separater, eigener Weg zu offenbaren ist. Die Ausführbarkeit kann sich nämlich für unter den Anspruch fallende, aber nicht ausdrücklich in der Beschreibung offenbarte Ausführungsformen auch aus dem allgemeinen Fachwissen – unter Umständen zusammen mit dem ausdrücklich in der Beschreibung angegebenen Weg – ergeben. Insofern mag die Offenbarung eines Weges ausreichen, allerdings eben nur unter der Bedingung, dass dieser eine Weg auch – zusammen mit dem allgemeinen Fachwissen – den gesamten beanspruchten Bereich abdeckt. Die Erfüllung des Erfordernisses der Ausführbarkeit setzt somit voraus, dass die Anmeldung bzw. das Patent in deutlicher und vollständiger Weise zumindest einen Weg aufzeigt, mittels dem der Fachmann die beanspruchte Erfindung über den gesamten beanspruchten Bereich ausführen kann (siehe Orientierungssatz).

Im Zusammenhang mit der Anspruchsauslegung kam die Kammer jedoch im vorliegenden Fall, aus Gründen die sie detailliert ausführte, zu dem Schluss, dass dies im vorliegenden Fall nicht gegeben sei. Die angefochtene Entscheidung wurde aufgehoben und das Patent widerrufen.

155-13-23

6. Article 087(1) EPC | G 1/22 and G 2/22 | EBA

Article 087(1) EPC

Case Number	G 0001/22 and G 0002/22
Board	EBA
Date of decision	2023.10.10
Language of the proceedings	EN
Internal distribution code	A
Inter partes/ex parte	Inter partes
EPC Articles	Articles 054, 060, 061, 072, 076, 087, 088, 089, 112(1)(a), 118, 139(2) EPC
EPC Rules	Rules 014, 052, 053 EPC
RPBA	
Other legal provisions	Articles 4, 19 Paris Convention, Article 11(3) PCT
Keywords	admissibility (yes) – rephrasing of referred questions (yes) – competence of the EPO to assess entitlement to priority (yes) – rebuttable presumption of entitlement – implied agreement
Cited decisions	G 0003/92, G 0003/93, G 0001/97, G 0002/98, G 0002/04, G 0001/15, J 0015/80, J 0019/87, J 0011/95, T 1008/96, T 0998/99, T 0015/01, T 0062/05, T 0788/05, T 0493/06, T 0382/07, T 0577/11, T 1933/12, T 2357/12, T 0205/14, T 0517/14, T 0725/14, T 1201/14, T 0239/16, T 2431/07, T 0844/18, T 1946/21
Case Law Book	II.D.2.2. , 10th edition

In consolidated cases [G 1/22 and G 2/22](#), the Enlarged Board ("EBA") considered the points of law referred to it by Technical Board of Appeal 3.3.04 (the "referring board") in T 1513/17 and T 2719/19 (consolidated). In the cases underlying the referral the priority claim had been found to be invalid. This had led to the revocation of the patent (T 1513/17) and the refusal of the application (T 2719/19) for lack of novelty.

The application on which the patent was granted in T 1513/17 (and from which the application derived in T 2719/19) was filed as an international application under the PCT (the "PCT application"). It named (i) the 3 inventors as applicants for the US only and (ii) other (legal) persons including the appellant ("Party B") as applicants for all other designated States. The PCT application claimed priority from a US provisional application filed in the name of the 3 inventors. The opposition division and the examining division found the priority claim to be invalid because only 1 of the 3 inventors had assigned the priority right to Party B prior to the filing of the PCT

application. Thus, intermediate publications were novelty-destroying. The referring board referred two questions to the EBA: (I) whether the EPC conferred jurisdiction on the EPO to determine whether a party validly claims to be a successor in title as referred to in Art. 87(1) EPC; and (II) if so, whether in the situation described above, Party B could validly rely on the priority right claimed in the PCT application for the purpose of claiming priority rights under Art. 87(1) EPC. The EBA rephrased question I as: "*Is the EPO competent to assess whether a party is entitled to claim priority under Article 87(1) EPC?*". Both questions were admissible under Art. 112(1)(a) EPC.

The EBA noted that a strict distinction should be made between the title to the subsequent application and the right to claim the priority date for that application. Art. 60(3) EPC did not apply to the right of priority referred to in Art. 87(1) EPC, neither directly nor by analogy. The EBA concluded that the EPO was competent to assess priority entitlement and that this assessment should be made under the autonomous law of the EPC. According to the EBA, there is a rebuttable presumption under the autonomous law of the EPC that the applicant claiming priority in accordance with Art. 88(1) EPC is entitled. This presumption was justified in view of (i) the interests of the parties involved, (ii) the lack of formal requirements for the transfer of priority rights and (iii) the necessary cooperation between the priority applicant and the subsequent applicant in the context of procedural requirements under Art. 88(1) EPC. The presumption also applies where the European patent application derives from a PCT application and/or where the priority applicants are not identical with the subsequent applicants. It therefore applied to the situation described in question II. The EBA also endorsed the concept of an implied agreement and concluded that, in the absence of substantial factual indications to the contrary, the joint filing of a PCT application sufficiently proved that the parties had entered into an implied agreement allowing Party B to rely on the priority.

The EBA answered the questions of law referred to it as follows:

I. The European Patent Office is competent to assess whether a party is entitled to claim priority under Article 87(1) EPC.

There is a rebuttable presumption under the autonomous law of the EPC that the applicant claiming priority in accordance with Article 88(1) EPC and the corresponding Implementing Regulations is entitled to claim priority.

II. The rebuttable presumption also applies in situations where the European patent application derives from a PCT application and/or where the priority applicant(s) are not identical with the subsequent applicant(s).

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.

156/7-13-23

7. Article 104(1) EPC | T 1484/19 | Board 3.3.08

Article 104(1) EPC

Case Number	T 1484/19
Board	3.3.08
Date of decision	2023.07.04
Language of the proceedings	EN
Internal distribution code	D
Inter partes/ex parte	Inter partes
EPC Articles	Article 104(1) EPC
EPC Rules	Rules 103(3)(a), 103(4)(a), 103(4)(c), 103(6) EPC
RPBA	Article 16(1) RPBA 2020
Other legal provisions	
Keywords	apportionment of costs (no) – requests on apportionment costs and partial reimbursement of appeal fee filed after completion of the decision-making process – partial reimbursement of appeal fee ordered by the board of its own motion
Cited decisions	G 0012/91, J 0012/86, T 0041/82, T 0117/86, T 0323/89, T 0614/89, T 0765/89, T 0773/91, T 0490/05, T 1663/13, T 1556/14, T 0488/18
Case Law Book	III.R.2.2.3 , V.A.11.12. , 10th edition

In [T 1484/19](#) of 04.07.2023 the board decided on requests for reimbursement of the appeal fee and apportionment of costs filed on the day of completion of the internal decision-making process for the previous decision T 1484/19 of 29.11.2022.

With its letter dated 24 November 2022, the patent proprietor (respondent) had stated that it no longer approved the text in which the patent had been granted and would not submit an amended text. It had also withdrawn all auxiliary requests filed during appeal proceedings.

On the morning of 29 November 2022, the board sent to the postal service for dispatch its decision revoking the patent in the absence of a text agreed by the respondent (T 1484/19 of 29.11.2022). On the same day, at 14.55 hrs, appellant 2 (opponent 2) had requested a partial reimbursement of the appeal fee under R. 103(3)(a) EPC and apportionment of costs.

The board concluded that the completion of the decision-making process within the meaning of decision G 12/91 had to be determined with reference to a date and not an hour or an exact time on a date. Consequently, appellant 2's requests were filed

after the decision-making process had been completed. However, the board questioned whether decision G 12/91 was concerned with a decision as to substance by contrast with the situation in the current case. The board stated that by analogy to the withdrawal of an appeal, it could be argued that the decision of 29 November 2022 brought the appeal proceedings to a close for the substantive merits of the appeal (which were no longer open for consideration in view of the respondent's withdrawal of its approval of any text for maintenance of the patent) while leaving ancillary questions open to a decision. Consequently, the board would have the power to decide on the requests for reimbursement of the appeal fee and for apportionment of costs filed after the completion of the internal decision-making process.

The board noticed that a different approach had been taken in T 1556/14 of 15 October 2020. In that case the board had held that a request for apportionment of costs could be admissible despite being filed after termination of the appeal proceedings if the request could not have been submitted earlier. In the current case, the board left open whether and, if so, to what extent legal certainty imposed limitations as to the admissibility of a request for apportionment of costs filed after termination of the appeal proceedings as the request for apportionment of costs was not allowable for the following reasons.

The current circumstances did not correspond to any of the situations justifying a different apportionment of costs which are mentioned in Art. 16(1) RPBA 2020. The board did not see anything in the timing of the respondent's letter which amounted to improper conduct of the proceedings or even to an abuse of proceedings justifying a different apportionment of costs. Based on the principle of party disposition, an appellant is entitled to withdraw its appeal and an applicant or patent proprietor is entitled to withdraw its approval of the text of a patent at any time during pending appeal proceedings. Except for where the exercise of the rights conferred by this principle contravenes a party's obligation to act in good faith (as exemplified in Art. 16(1) RPBA 2020), this principle may not be restricted by the threat of an apportionment of costs. For the withdrawal of an appeal, this has been confirmed in the case law and recently acknowledged by the legislators in amended R. 103(4)(a) EPC. Indeed, reimbursement of 25% of the appeal fee is provided even for the withdrawal of an appeal during oral proceedings before the decision is announced. In the board's opinion, the same holds true for a patent proprietor's withdrawal of its approval pursuant to Art. 113(2) EPC, even more so if the parties are informed of it before the oral proceedings. Therefore, the request for apportionment of costs was refused.

The board also refused appellant 2's request for reimbursement of the appeal fee under R. 103(4)(a) EPC, since no statement of appellant 2 was on file by which it had withdrawn its appeal. However, in view of decision T 488/18 and the respondent's letter dated 24 November 2022, the board decided to order of its own motion reimbursement of 25% of the appeal fee under R. 103(4)(c) EPC for both appellants.

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8. Article 135 EPC | T 1283/19 | Board 3.5.07

Article 135 EPC

Case Number	T 1283/19
Board	3.5.07
Date of decision	2023.06.20
Language of the proceedings	FR
Internal distribution code	D
Inter partes/ex parte	Ex parte
EPC Articles	Articles 106(1), 135 EPC
EPC Rules	Rule 155 EPC
RPBA	
Other legal provisions	
Keywords	request for conversion – request for conversion not admissible – suspensive effect of the appeal
Cited decisions	
Case Law Book	V.A.1.3. , 10th edition

Dans l'affaire [T 1283/19](#), la chambre a rappelé que selon l'art. 135(1)a) et b) CBE le service central de la propriété industrielle d'un état contractant désigné engage, sur requête du demandeur, la procédure de délivrance d'un brevet national si la demande de brevet européen est réputée retirée en vertu de l'art. 77, paragraphe 3 CBE ou dans les autres cas prévus par la législation nationale où, en vertu de la CBE, la demande de brevet européen est soit rejetée, soit retirée, soit réputée retirée.

L'art. 135(3) CBE stipule que dans les cas visés au paragraphe 1 b), la requête en transformation doit être présentée à l'Office européen des brevets conformément au règlement d'exécution. L'Office européen des brevets transmet la requête aux services centraux de la propriété industrielle des États contractants qui y sont mentionnés.

Selon la règle 155(1) CBE, la requête en transformation visée à l'art. 135(1)b) CBE doit être présentée dans un délai de trois mois à compter soit du retrait de la demande de brevet européen, soit de la notification signalant que la demande est réputée retirée, soit de la décision de rejet de la demande du brevet européen. La demande de brevet européen cesse de produire les effets visés à l'art. 66 CBE si la requête n'est pas présentée dans les délais.

La chambre a conclu que compte tenu de l'effet suspensif du recours (art. 106(1), deuxième phrase, CBE), la requête en transformation des requérants ne pouvait pas

être considérée pendant la procédure de recours, car une telle requête en transformation ne peut pas être émise avant que la demande ne soit réputée retirée, retirée ou rejetée. En tenant compte de ce qui précède, la chambre ne pouvait donc pas traiter la requête en transformation selon l'art. 135(1)b) CBE.

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9. Article 12(6) RPBA 2020 | T 1362/20 | Board 3.2.08

Article 12(6) RPBA 2020

Case Number	T 1362/20
Board	3.2.08
Date of decision	2023.08.01
Language of the proceedings	DE
Internal distribution code	C
Inter partes/ex parte	Inter partes
EPC Articles	
EPC Rules	
RPBA	Article 12(4), 12(6) RPBA 2020
Other legal provisions	
Keywords	amendment to case – new objection against features added from the description during oral proceedings before the opposition division – should have been submitted in first instance proceedings (no)
Cited decisions	
Case Law Book	V.A.4.3.7 , 10th edition

In [T 1362/20](#) erhob der Beschwerdeführer (Einsprechender) erstmals mit der Beschwerdebegründung den Einwand, dass ein bestimmtes Anspruchsmerkmal (Merkmal 1.13b) die Klarheitserfordernisse des Art. 84 EPÜ nicht erfülle. Der Beschwerdegegner beantragte, diesen Einwand nach Art. 12 (4) und (6) VOBK 2020 nicht zuzulassen. Er begründete dies damit, dass bereits die in der mündlichen Verhandlung vor der Einspruchsabteilung eingereichten Hilfsanträge 1a, 1b und 2a dieses Merkmal enthielten und der Einsprechende bereits zu diesem Zeitpunkt Gelegenheit gehabt hätte, den Einwand zu erheben.

Die Kammer teilte jedoch die Auffassung, dass der Einwand bereits in der mündlichen Verhandlung vor der Einspruchsabteilung vorzubringen gewesen wäre, nicht.

Sie verwies darauf, dass der Patentinhaber in dieser mündlichen Verhandlung keinen der im schriftlichen Verfahren eingereichten Hilfsanträge verteidigte, sondern am Nachmittag des Verhandlungstages neue Hilfsanträge einreichte, nachdem der Hauptantrag, wie in der vorläufigen Meinung schon vorgezeichnet, für nicht gewährbar erachtet wurde. Die eingereichten Hilfsanträge umfassten jeweils Merkmale, die der Beschreibung entnommen waren. Der Einsprechende hatte

jeweils etwa eine halbe Stunde Zeit, sich mit den neu eingereichten Anträgen zu befassen.

Die Kammer war der Auffassung, dass es in diesem Zeitrahmen zwar möglich gewesen wäre, einen Klarheitsmangel zu erkennen, der Einsprechende also den Einwand hätte vorbringen können. Allerdings konnte dies im Hinblick auf den engen Zeitrahmen nicht von ihm verlangt werden, so dass der Einwand nicht im Sinne von Art. 12 (6), 2. Satz VOBK 2020 vorzubringen gewesen wäre. Da die Änderungen der Beschreibung entnommen waren und im Einspruchsverfahren zu einem sehr späten Zeitpunkt noch in das Verfahren zugelassen wurden, entspreche es dem Gebot der Fairness, neue Einwände gegen die geänderten Ansprüche noch zuzulassen, wenn diese Einwände bei erster Gelegenheit im Beschwerdeverfahren erhoben wurden. Dies gelte umso mehr im vorliegenden Fall, als der erstmals mit der Beschwerdebegründung erhobene Einwand mangelnder Klarheit hoch relevant sei.

Die Kammer übte daher ihr Ermessen nach Art. 12 (6) VOBK 2020 dahingehend aus, diesen Einwand in das Verfahren zuzulassen.

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10. Article 13(2) RPBA 2020 | T 0599/21 | Board 3.5.05

Article 13(2) RPBA 2020

Case Number	T 0599/21
Board	3.5.05
Date of decision	2023.06.26
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 – late-filed request – exceptional circumstances (no) – taken into account (no) – citation of passage in the description did not confront appellant with new facts
Cited decisions	
Case Law Book	V.A.4.5.6b), 10th edition

In [T 599/21](#) auxiliary requests 2.1 and 2.2 were filed in response to the board's preliminary opinion. The appellant argued that auxiliary request 2.1 should be admitted into the proceedings since the preliminary opinion of the board contained new arguments. In particular, the reference to page 14 of the description had not been brought up by the examining division and the term "content of the first interface" had been interpreted differently by the examining division.

The board did not agree. It underlined that its preliminary opinion confirmed the decision under appeal. The examining division had already considered that the wording of the claims was too broad, in particular due to the broad possible interpretation of the term "content of the first interface". The board using the description to confirm the examining division's broad interpretation of this term could not have taken the appellant by surprise. In the board's view, the board's citation of a passage of the description did not confront the appellant with facts previously unknown to it. In consequence, it did not constitute an "exceptional circumstance" which could justify amendments to the appeal case.

Moreover, regarding certain aspects of its feature analysis, the board held that this was merely a supplementary explanation of the mapping provided by the examining division. It did not constitute an alteration of the line of reasoning or a new argument

and thus also could not serve as a cogent reason for amending the appeal case at this late stage of the proceedings. The same considerations applied to auxiliary request 2.2.

In view of the above, the board decided not to admit auxiliary requests 2.1 and 2.2 into the proceedings.

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