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Abstracts of decisions

In this issue:

1. Article 056 EPC | T 0116/18 | Board 3.3.02 | 1
2. Article 069 EPC | T 0367/20 | Board 3.2.03 | 3
3. Article 084 EPC | T 1266/19 | Board 3.3.08 | 5
4. Article 084 EPC | T 0694/20 | Board 3.3.04 | 7
5. Article 084 EPC | T 2151/22 | Board 3.2.01 | 9
6. Article 087(1) EPC | T 2719/19 | Board 3.3.04 | 11
7. Article 112(1)(a) EPC | T 0116/18 | Board 3.3.02 | 13
8. Article 116(1) EPC | T 0245/19 | Board 3.2.05 | 15
9. Article 12(4) RPBA 2020 | T 0364/20 | Board 3.3.02 | 17
10. Article 12(5) RPBA 2020 | T 0503/20 | Board 3.2.01 | 19
11. Article 13(2) RPBA 2020 | T 0116/18 | Board 3.3.02 | 21
In T 116/18 (of 28 July 2023) the board observed that in contrast to the questions referred to the Enlarged Board (EBA) in its interlocutory decision of 11 October 2021, which focussed on whether certain evidence proving a certain technical effect could be taken into consideration, Order no. 2 of G 2/21 focused on whether this technical effect, which said evidence proved, could be relied on. The board could not see, however, why this difference in wording should imply any difference in substance.

The board found that the EBA's focus on the application as filed and the filing date (point 93 of the Reasons) was intended to prevent the filing of applications directed purely to speculative inventions made only after the filing date. The requirement(s) established in Order no. 2 had to be looked at with the eyes of the skilled person "having the common general knowledge in mind, and based on the application as originally filed". Even though not stated explicitly in Order no. 2, the board found that the common general knowledge thus had to be that existing on the filing date of the application.
The board explained that Order no. 2 required that, for a patent applicant or proprietor to be able to rely on a purported technical effect for inventive step, the skilled person would derive said effect as being (i) encompassed by the technical teaching, and (ii) embodied by the same originally disclosed invention. The board noted that the EBA did not refer to any of the plausibility standards it had identified in its referring decision, but used new legal terminology that had not been applied so far in the context of inventive step. What mattered however was that when deciding whether a purported technical effect may be relied upon for inventive step, it was the requirement(s) defined by the EBA in Order no. 2 that had to be applied, rather than simply using any rationale developed in the previous plausibility case law. The board further interpreted the linking of requirements (i) and (ii) with "and" to mean that both were separate requirements which had to be met cumulatively for a patent applicant or proprietor to be able to rely on the purported technical effect.

As to the definitions of "technical teaching" and "invention", the board referred to the adoption by the EBA (in particular in G 2/07, G 1/19) of the reasoning in the "Rote Taube" decision by the German Federal Court of Justice (BGH 27.3.1969, X ZB 15/67). It concluded the term "technical teaching" in requirement (i) had the same meaning as the term "same originally disclosed invention" in requirement (ii), namely the broadest technical teaching of the application as filed contained in it with regard to the claimed subject-matter. In the light of this, the board held that for requirement (i) to be met, the purported technical effect together with the claimed subject-matter needed only to be conceptually comprised by the broadest technical teaching of the application as filed. It might be sufficient that the skilled person, having the common general knowledge in mind, and based on the application as filed, recognised that said effect was necessarily relevant to the claimed subject-matter.

As regards requirement (ii), in the board's view, the following question was to be asked: would the skilled person, having the common general knowledge on the filing date in mind, and based on the application as filed, have legitimate reasons to doubt that the technical teaching at issue, i.e. the purported technical effect together with the claimed subject-matter, was an embodiment of the originally disclosed invention, i.e. the broadest technical teaching of the application as filed? The board took the view that it was not necessarily a precondition for requirement (ii) to be satisfied that the application as filed contained experimental proof that the purported technical effect was actually achieved with the claimed subject-matter at issue. It was also not necessarily a precondition for requirement (ii) to be fulfilled that the application as filed contained a positive verbal statement about the purported technical effect.

The board's overall conclusion regarding requirement (ii) was thus the following: requirement (ii) is met unless the skilled person, having the common general knowledge on the filing date in mind, and based on the application as filed, would have legitimate reason to doubt that the purported technical effect can be achieved with the claimed subject-matter. For requirement (ii) to be satisfied, experimental proof of the purported technical effect or a positive verbal statement is not necessarily required in the application as filed.
In T 367/20 the board held that to assess whether an amended patent claim contains added subject-matter under Art. 123(2) EPC, the claimed subject-matter must first be determined by interpreting the claim (i.e. establishing the meaning of the claimed features) from the perspective of the person skilled in the art. In a second step, it must be assessed whether that subject-matter is disclosed in the application as filed.

Regarding claim interpretation, the board stressed that a claim feature must not be interpreted in isolation but in the context of the whole document it forms part of. The context to be considered for the interpretation of a feature in a claim therefore did not include only the other features in that claim and other claims but also the description and the drawings.

According to the board, the general principle that the claims of a patent, being a part of a document as a whole, need to be construed in their context was recognised early in the case law and had also been understood to underlie Art. 69 EPC (see T 556/02 and T 3097/19). Moreover, the established principle that patent claims must be interpreted through the eyes of the person skilled in the art, who should try with
synthetical propensity to arrive at an interpretation of the claim which is technically sensible and takes into account the whole disclosure of the patent, was formulated for the first time with reference to Art. 69 EPC (see T 190/99, T 396/99). The limitation on the weight which can be given to the description in relation to the claims was also in earlier case law derived from Art. 69(1), first sentence, EPC (see T 1018/02). This had been taken up recently and referred to as the primacy of the claims (see T 1473/19, T 450/20, T 73/19), which in particular prohibits reading features into the claims which are only present in the description or the drawings.

The board endorsed decision T 1473/19, which stated that the first step in determining the extent of protection in accordance with Art. 69 EPC consisted in determining the claimed subject-matter under the "general principles" of claim interpretation in Art. 1 of the Protocol on its interpretation. The interpretation and determination of the subject-matter of the same claim in the same opposition (appeal) proceedings before the EPO should be uniform and consistent, including for the purpose of Art. 123(2) and (3) EPC. Moreover, the board in T 1473/19 had stated that the EPO in opposition (appeal) proceedings, and the national courts and the UPC in revocation proceedings, had concurrent jurisdiction on (post-grant) patent validity and that national courts applied the rules for the interpretation of claims in Art. 69 EPC also in revocation proceedings. The board in the case in hand noted that the grounds for opposition under Art. 100(a) to (c) EPC corresponded literally – including in their reference to the "subject-matter" of the patent – to the grounds for revocation under Art. 138(1)(a) to (c) EPC (see also Art. 65(2) UPCA), and that Art. 68 EPC regulated the effect of the revocation or limitation of a European patent in an identical manner for both opposition and revocation proceedings. The board cited decisions of courts in several contracting states (AT, CH, DE, ES, FR, GB, NL) as examples of national case law on claim interpretation according to Art. 69 EPC in respect of revocation proceedings.

In the case in hand the board, taking account of feature M11 and the description, concluded that feature M5.1 ("a first switching pipe (62) which is connected to the fluid flows in parallel with the third heat exchanger (53)") should be understood as requiring that the first switching pipe (not the fluid flows) be in parallel with the third heat exchanger. Hence, feature M5.1 could be deduced directly and unambiguously from the application as filed. On the respondent’s argument that feature M5.1 allowed both interpretations as to which parallelism was required, the board held that only the subject-matter which is actually claimed – as opposed to subject-matter merely hypothetically claimed – must be disclosed in the application as filed. The deciding body must not adopt two mutually exclusive claim interpretations simultaneously and must – if decisive for the outcome of the case – not leave the interpretation in that regard open either. For completeness, the board distinguished the present case, concerning two mutually exclusive interpretations of a certain claim feature, from situations where a claim feature could be interpreted in a broad manner to encompass "a multitude of possibilities" (T 1408/04), i.e. different embodiments of the same, broad subject-matter.
In **T 1266/19** claim 1 of the main request (patent as granted) was directed to a method which comprised at least six process steps. The process steps (i) to (v) defined a chronological order in which the claimed method had to be performed. It was, however, disputed between the parties whether step (vi) had to be performed as last step in the method as defined in claim 1.

Step (vi) read as follows: "determining a statistical value for an allele call in a genotyping assay that cannot be derived from the read number alone", ("step (vi)").

The respondent (patent proprietor) had submitted that step (vi) had to be carried out as last process step. This was the necessary result of the claim's structure which mentioned this feature as its last step and the skilled person's interpretation of claim 1 in the context of the patent's teaching as a whole. Reference in this regard was made to the patent and the case law of the Boards of Appeal, in particular decision T 1646/12.

The board did not agree with the respondent and noted that neither the process steps (i) to (v) nor the preamble of claim 1 mentioned the terms cited in step (vi). Claim 1 was also silent on using formal identifiers for the at least six process steps, such as, for example, (a) to (f). Nor could the use of step (vi) as last process step be derived from the structure of claim 1 in any other way. On the contrary, the use of the term "including" in claim 1 which immediately followed the preamble left the order of...
the steps open, since this term in the context of patent claims was commonly understood to have the same meaning as comprising.

The board also considered that the skilled person reading claim 1 was familiar with the terms "statistical value", "allele call", "genotyping assay" and "read number" as mentioned in step (vi) and aware of their meaning. These terms were thus clear in themselves and in their relation to each other. In such a situation, it was established case law that terms in a claim must be given their broadest technical sensible meaning, and that a definition in the description which is absent from a claim cannot give these terms and, hence, the claim as a whole a more narrow/restrictive meaning. In the present case it was thus neither necessary nor justified to rely on isolated passages of the description to interpret the claim more narrowly, let alone to read into claim 1 further limitations as derivable from the description only which were absent from the claim (see T 169/20).

Besides, the board observed that step (vi) did not specify "how" and "when" the statistical value was to be determined, except for indicating the purpose of its determination. Accordingly, step (vi) included the determination of statistical values in any way and at any time of the claimed method as long as such a value served the indicated purpose.

The board further pointed out that decision T 1646/12 specified that two extremes should be avoided when interpreting the claims. Firstly, it was not permissible to regard the claims and the description as communicating vessels, so to speak, for example by reading limiting features mentioned in the description but not in the claims into the latter. Such a transfer of limiting features could not be achieved by construction, but by amending the claims only. Secondly, the claim cannot be considered as being completely separate from the description either. According to the board, in the present case the respondent applied the first extreme by arguing that the skilled person, based on the description, would interpret that step (vi) had to be carried out after steps (i) to (v).

The board concluded that claim 1 did not set any chronological order for the application of step (vi). Hence, step (vi) comprised any statistical value irrespective of when and how the value had been obtained, except that the value must be used for an allele call in a genotyping assay that could not be derived from the read number alone.

The respondent had also submitted that the term "allele call" used in step (vi) was defined in the description as "determining whether a subject is homozygous or heterozygous at a locus" which limited claim 1. The board disagreed and recalled that, as set out above, it was established case law that terms in a claim must be given their broadest technical sensible meaning, and that a definition in the description which was absent from a claim could not give the claim a more narrow/restrictive meaning.
In T 694/20 befasste sich die Kammer mit der Auslegung des Anspruchs 1 des Hauptantrags, die für die Prüfung der Ausführbarkeit und der erfinderischen Tätigkeit relevant war.

Die Kammer wies darauf hin, dass die Fachperson nach ständiger Rechtsprechung einen Patentanspruch mit der Bereitschaft lese, diesen auf technisch sinnvolle Weise zu verstehen. Ebenso unumstritten sei in der Rechtsprechung, dass den in einem Patentanspruch verwendeten Begriffen ihre normale Bedeutung im betreffenden Fachgebiet zu geben sei.


Im vorliegenden Fall kam die Kammer zu dem Ergebnis, dass die Merkmale "Eicosapentaensäure (EPA) und Docosahexaensäure (DHA)" des Anspruchs 1 für die Fachperson mehrdeutig seien und aus diesem Grunde ein Zurückgreifen auf die
Beschreibung in jedem Fall zulässig und geboten sei. Andere Merkmale des Anspruchs 1 seien einer eindeutigen Interpretation zugänglich, die wiederum durch die Beschreibung bestätigt werde, so dass die Frage, ob die Beschreibung zu konsultieren ist, unbeantwortet bleiben könne.

Die Kammer zog die Beschreibung des Patents zur Auslegung der Begriffe "Eicosapentaensäure (EPA)" und "Docosahexaensäure (DHA)" heran und schlussfolgerte, dass die Fachperson dieses anspruchsgemäße Merkmal als nicht auf die freien Säuren beschränkt verstehen würde.
Dans la décision T 2151/22, la chambre rappelle que l'exigence selon laquelle les revendications doivent être claires s'applique à chacune des revendications prises individuellement, qu'elles soient indépendantes ou dépendantes, ainsi qu'aux revendications dans leur ensemble.

La signification du terme "vitre" dans la revendication 1 est différente de celle de la revendication 12 de la requête principale. Dans la revendication 1, "la vitre" ne comportait pas les corps profilés et les revêtements, qui étaient décrits comme faisant partie du vitrage. En revanche, dans la revendication 12, "la vitre" comportait au moins un corps profilé et un ou deux revêtements, ce qui semait le doute quant aux caractéristiques faisant partie du vitrage et celles faisant partie de la vitre. De plus, la revendication 12 renvoyait aux revendications 1 à 11, ce qui rendait la signification des termes "vitre" et "vitrage" d'autant plus incertaine. En effet, "la vitre" de la revendication 12, comprenant au moins un corps profilé et un ou deux revêtement(s) extérieur(s), devait être adaptée pour un vitrage selon l'une des revendications 1 à 11 qui contenait déjà deux corps profilés et un ou deux revêtement(s) extérieur(s). Si la vitre de la revendication 12 était utilisée pour le vitrage de la revendication 1, alors ce dernier comporterait au moins trois corps profilés et deux ou quatre revêtements. Un tel vitrage serait en discordance avec la description. La chambre a conclu que la requête principale ne satisfaisait pas aux exigences de l'art. 84 CBE.
Dans la requête auxiliaire 0 la requérante (demanderesse) avait proposé de supprimer l’expression "pour un vitrage suivant l’une quelconque des revendications 1 à 11" de la revendication 12. En effet, la requérante avait estimé que cette modification rendait les revendications plus claires, puisque les revendications 1 et 12 devenaient indépendantes. La chambre a rejeté cet argument, au motif que la suppression de cet élément n’écartait pas l’incohérence dans la signification du terme "vitre" entre la revendication 1 et la revendication 12.

Dans la requête auxiliaire 0 le terme "vitre" a été remplacé par le terme "élément de vitrage" dans la revendication 12. Tout d’abord, la chambre a noté que la revendication 1 et la revendication 12 étaient claires lorsqu’elles étaient considérées individuellement et lorsqu’elles étaient considérées ensemble. De plus, la revendication 1 de vitrage comprenait toutes les caractéristiques de la revendication 12 de l’élément de vitrage. La question qui se posait était donc de savoir si selon la règle 43 CBE, les revendications 1 et 12 pouvaient être formulées sous la forme de deux revendications indépendantes, l’une visant le vitrage et l’autre l’élément de vitrage.

La chambre a jugé que dans cette affaire, la requérante avait montré que le jeu de revendications ne pouvait être simplement modifié pour qu’une seule revendication indépendante suivie de revendications dépendantes couvre de manière adéquate les modes de réalisation de l’invention sans compromettre la clarté du jeu de revendications. Deux revendications formulées comme indépendantes étaient donc plus appropriées pour revendiquer l’ensemble des modes de réalisations de l’invention dans ce cas présent. De plus, dans la présente demande de brevet, le vitrage et l’élément de vitrage pouvaient être considérés comme ayant un lien entre eux. La chambre a donc estimé que les conditions de la règle 43(2)a) CBE étaient satisfaites en l’espèce.
T 2719/19 (of 20 November 2023) was the referring case in G 2/22 (consolidated with G 1/22). The application from which the (divisional) application in suit derived had been filed as an international application under the PCT (the "PCT application"). It named (i) the three inventors ("Party A") as applicants for the United States of America (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 three inventors. The examining division had found the priority claim to be invalid because only one of the three inventors had assigned the priority right to Party B prior to the filing of the PCT application. Thus, intermediate publications were novelty destroying and the examining division had refused the application.

By interlocutory decision T 2719/19 (of 28 January 2022) the board had referred two questions to the Enlarged Board: (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 (rephrased by the Enlarged Board as: "Is the EPO competent to assess whether a party is entitled to claim priority under Article 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 board recalled that the Enlarged Board had decided that there was a rebuttable presumption under the autonomous law of the EPC that the applicant claiming priority in accordance with Art. 88(1) EPC and the corresponding Implementing Regulations was entitled to claim priority and that this presumption also applied in the factual situation of the case in suit, i.e. where the European patent application derived from a PCT application and where the priority applicant(s) were not identical with the subsequent applicant(s). Moreover, the Enlarged Board had ruled that in the situation of the case in hand, where the PCT application was jointly filed by Party A (as inventors and as applicants for the US only) and Party B, and claimed priority from an earlier patent application designating Party A as the applicant, the joint filing implied an agreement between Party A and Party B, allowing Party B to rely on the priority, unless there were substantial factual indications to the contrary (G 1/22 and G 2/22). According to the board, no substantial factual indications to the contrary were mentioned in the decision under appeal nor was the board aware of any.

The board noted that the examining division had not referred to the further need to examine the application if the priority were found to be validly claimed. Since the appeal was allowable and no other objections had been raised in the decision under appeal or in the communications of the examining division leading up to the decision, the board remitted the case to the examining division with the order to grant a patent based on the set of claims filed on 8 November 2016, with the description and drawings to be adapted thereto, as necessary.
In T 116/18 (of 28 July 2023) the board made some introductory remarks on the question of what impact the referring decision had on the subsequent appeal proceedings, i.e. the appeal proceedings after G 2/21 had been issued. This question emerged in the second oral proceedings since it was contentious between the parties whether a certain issue had actually been decided upon by the board in the referring decision and, if so, whether it could be re-opened in the second oral proceedings.

The board recalled that the EPC does not mention anything with regard to this issue. Art. 111(2) EPC provides that if a board of appeal remits a case to the department of the EPO whose decision was appealed, that department is bound by the ratio decidendi of the board of appeal, in so far as the facts are the same. The board noted that Art. 111(2) EPC, however, was not applicable to the relationship between an earlier interlocutory decision of a board and the subsequent proceedings before the same board. In the absence of any provision, two opposing positions seemed possible in the abstract.

According to the board, the first option was that the referring decision together with its legal and factual assessments had no binding effect on the subsequent proceedings before the same board after the case came back from the Enlarged Board. In this case, the board would be free to re-examine the points already raised.
in the referring decision, and it would therefore be free to depart from the factual and legal assessments underlying the referring decision. The second option was to consider that the referring board was bound by the referring decision's finding when the case came back from the Enlarged Board. In this approach, the scope of the subsequent proceedings would therefore be limited to the application of the Enlarged Board's decision to the unresolved issue that gave rise to the referral and to any other issues not dealt with in that decision.

The present board decided to follow the second position for the following reasons.

If, in the absence of an express legal provision providing for a binding effect the board were free to re-examine and redetermine all the factual and legal issues that had been subject of the referring decision, this would lead to a conflict with the requirements for referrals set out in Art. 112 EPC as interpreted by the case law.

Art. 112(1)(a) EPC was interpreted to mean that “the referred question does not have a merely theoretical significance for the original proceedings ... as would be the case if the referring board were to reach the same decision on the basis of the file regardless of the answer to the referred question” (G 3/98). Where several grounds for opposition had been raised by the opponent(s), the referral was admissible only when the board had concluded that the patent would be maintained despite the other invoked grounds for opposition which were not the subject of the referral.

If the board were to deny any binding effect of the referring decision and reopen the issues on which the board reached its conclusion in that decision, this would be in logical conflict with the requirements formulated for the admissibility of the referral. Indeed, it could lead to a situation in which the board departs from the assessment made in the referring decision and render the Enlarged Board's answer to the referred question ex post irrelevant, or, conversely, it could require a different referral from that originally made.

To the present board it therefore seemed consistent with this framework to regard as binding the assessments which had led the board to consider a referral both admissible and necessary. According to the board, this conclusion seems to be consistent, mutatis mutandis, with some decisions which consider themselves bound by their own first decision if a second appeal on the same subject-matter is brought before them, on the grounds that decisions by the boards of appeal are final and without any possibility to appeal, meaning that no EPO body, not even the boards of appeal, can take a new decision on facts which have already been decided.

The board concluded that as a consequence of this binding effect, the scope of the present proceedings was limited to applying the legal principle, as stated by the Enlarged Board, to the issues left unresolved in the referring decision. In accordance with this, the reasoning was divided into two main parts: the first deals in abstracto with the interpretation of Order no. 2 given in G 2/21, and the second deals with the application of this Order, as interpreted by the present board, i.e. the issues left unresolved in the referring decision.
In **T 245/19** both appellants had requested oral proceedings in the event the board had not granted their main request. In the board's preliminary opinion communicated to the parties pursuant to Art. 15(1) RPBA 2020, the board expressed its intention to allow the appellants' main request. Later on, both appellants and the respondent announced they would not be attending the oral proceedings, with the appellants explicitly maintaining their request for oral proceedings.

The board held that in such a situation, it was not necessary for oral proceedings to be held in order to hear the respondent. According to the board, the reasons for this were as follows.

In several decisions of the boards of appeal (e.g. T 3/90, T 696/02, T 1027/03), it had been held that an announcement that a party would not be participating in oral proceedings was equivalent to the withdrawal of that party's request for oral proceedings and that as a consequence there had been no need for oral proceedings to be held.

The present board had doubts as to whether a declaration of non-attendance could in fact be construed as a withdrawal of a party's request for oral proceedings, with all legal implications, including that the party was bound thereby. The board referred to J 11/94 in which it had been stated that any procedural declaration must be
unambiguous, particularly declarations terminating the proceedings because of the consequences thereof. In the board's view, this also applied to declarations of withdrawal of the request for oral proceedings. Furthermore, in J 19/03, citing decisions J 11/87 and J 27/94, it had been held that a party was normally bound by its procedural acts provided the procedural statement was clear and unconditional.

The board was of the opinion that a party's announcement that it would not be appearing at the hearing did not necessarily entail the withdrawal of a previously made request to present their arguments orally. Notwithstanding this, it was not mandatory for oral proceedings to be held in these circumstances. The announcement of a party that it would not be appearing at the hearing resulted in its request for oral proceedings becoming ineffective, irrespective of a declaration that the request for oral proceedings was explicitly maintained.

According to the board, the right to oral proceedings enshrined in Art. 116(1) EPC must be seen in the context of the right to be heard under Art. 113(1) EPC (see G 1/21). It was therefore a right to be heard in oral proceedings. The right to oral proceedings could not be understood as the right to have the board hold oral proceedings with the other parties to the proceedings. Such an understanding, which separated the right to oral proceedings from the right to be heard at oral proceedings, had no basis in the EPC as interpreted by the boards of appeal.

The board found that once a party's request for oral proceedings became ineffective, the board may dispense with oral proceedings if no other reason made it necessary or desirable to hold them. In the present case, there was no such reason, because the board had decided to allow the appellants' main request, i.e. to maintain the patent as granted, and also because all parties had announced they would not be attending the oral proceedings. The board concluded that the case was ready for decision on the basis of the parties' written submissions, which had been fully taken into account by the board (Art. 12(8) and Art. 15(3) RPBA 2020). Therefore, the board decided not to hold oral proceedings and to issue the decision in writing.
In **T 364/20** auxiliary requests 1 to 16 were filed before the opposition division on the final date for making written submissions (R. 116 EPC); auxiliary requests 5, 6 and 16 were identical to auxiliary requests 1 to 3 filed with the reply to the opposition within the time limit set under R. 79(1) EPC. The opposition division decided to reject the opposition and thus did not decide on the admittance of auxiliary requests 1 to 16, which were later refiled by the respondent (proprietor) with its reply to the statement of grounds of appeal. In the board’s view, to judge whether a claim request was admissibly raised in opposition proceedings within the meaning of Art. 12(4) RPBA 2020, a board had to decide whether the opposition division should have admitted the claim request, had a decision on admittance been required. If so, the claim request was admissibly raised.

With regard to auxiliary requests 5, 6 and 16 (identical to requests filed within the time limit set under R. 79(1) EPC), the board first explained that, for the purposes of Art. 114 EPC, a patent claim was to be regarded as a statement of technical facts in legal terms and thus qualified as “facts or evidence” within the meaning of Art. 114(2) EPC (T 1776/18). Since said requests had been filed at the earliest opportunity, Art. 114(2) EPC did not apply. Nevertheless, in the board’s view, auxiliary requests filed within the time limit under R. 79(1) EPC could, in truly exceptional situations, be considered not to have been admissibly raised within the meaning of Art. 12(4) RPBA 2020.
The board based this view on R 6/19, according to which the basis for an opposition division’s discretion to admit or not claim requests was Art. 123(1) EPC, and on the wording of R. 79(1) EPC (“where appropriate”). However, since auxiliary requests 5, 6 and 16 in the case in hand were convergent and clearly reasonable in number, they were considered admissibly raised in terms of Art. 12(4) RPBA 2020.

With regard to auxiliary requests 1 to 4 and 7 to 15 the board observed that they were filed after the time limit set under R. 79(1) EPC but before the expiry of the time limit under R. 116(1) EPC. The board held that it could not be considered that requests filed at this stage of proceedings were automatically filed in due time. Whether or not they were, depended on whether they were submitted as a direct and timely response to a change of the subject of the proceedings introduced by the opponent or the opposition division. In the case in hand, no reasons were mentioned by the respondent as to why auxiliary requests 1 to 4 and 7 to 15 had not been filed earlier. The board did not see any reasons either, especially since the opposition division’s preliminary opinion had been in the respondent’s favour and no substantial new submissions had been filed by the appellant in reply to this opinion. In other words, the subject of the proceedings had not changed. Therefore, the board considered auxiliary requests 1 to 4 and 7 to 15 to have been filed late and the opposition division had the discretion not to admit them.

Concerning the exercise of discretion, the board referred to G 9/91 and held that to properly defend its patent a patent proprietor had in principle to be permitted to redefine its fallback positions in terms of auxiliary claim requests also at a late stage of opposition proceedings. The board acknowledged that lack of clear allowability could be a reason not to admit a late-filed claim request filed after the expiry of the time limit set under R. 79(1) EPC and before the expiry of the time limit set under R. 116(1) EPC, however not the sole reason. Whether an opponent had sufficient time to deal with an amended claim request was another criterion the opposition division might consider. However, at this stage of proceedings, if the appellant had considered that it did not have enough time to properly respond, it should have requested a postponement of the oral proceedings. Moreover, according to the board, the criteria generally used by the boards when exercising their discretion to admit or not a party’s submission in appeal under the RPBA 2020 could also be considered when deciding whether or not a late-filed claim request submitted at this stage of proceedings should have been admitted by the opposition division and was thus admissibly raised in the opposition proceedings. However, when taking this decision, in view of the administrative character of opposition proceedings, these criteria should be used by the boards in a more lenient way than for a party’s submission filed during appeal proceedings. In the case in hand, the board came to the conclusion that the auxiliary requests 1 to 4 and 7 to 15 had been admissibly raised, in particular since the divergence of the auxiliary requests was justified in view of the different inventive-step attacks and they constituted a reasonable redefinition of fall-back positions.
In T 503/20 beantragte die Beschwerdegegnerin (Patentinhaberin) die Vorlage von Fragen an die Große Beschwerdekammer. Diese betrafen insbesondere den Fall, dass ein Verfahrensbeteiligter sein Vorbringen im Einspruchsverfahren durch einen Verweis "zum Gegenstand des Vortrags im Beschwerdeverfahren" macht und dabei auf konkrete Randnummern der Einspruchserwiderung Bezug nimmt. Unter anderem wurde dabei die Frage aufgeworfen, ob es eine Rolle spielt, dass dieser Verfahrensbeteiligte im Einspruchsverfahren obisegt hat.


Die Kammer schloss daraus, dass auch Passagen der Einspruchserwiderung, auf die unter Angabe ihrer konkreten Randnummern verwiesen wird, nicht zwangsläufig zugelassen werden müssen. Ihre Zulassung stehe vielmehr im Ermessen der Kammer und hänge von den Umständen des Einzelfalles ab, etwa von der Frage, ob...
eine ausreichende Auseinandersetzung mit der angegriffenen Entscheidung erfolgt ist und – sofern es sich um Punkte handele, die für die Entscheidung nicht relevant wurden – ob aus dem Gesamtvortrag beider Parteien ausreichend klar wird, welche Punkte mit welcher konkreten Begründung weiterverfolgt werden und wie sich diese zum Vortrag der Gegenseite verhalten.

Im vorliegenden Fall entschied die Kammer, den Teil des Vorbringens in der Beschwerdeerwiderung der Patentinhaberin, der lediglich pauschal auf Vorbringen im Einspruchsverfahren Bezug nahm, unberücksichtigt zu lassen. Dies begründete sie insbesondere damit, dass es insoweit vollkommen an einer Auseinandersetzung mit der Entscheidung fehlte, die im Einzelnen ausgeführt hatte, warum sie die betreffende offenkundige Vorbenutzung für nachgewiesen erachtete und welche patentgemäßen Merkmale sie in ihr offenbart sah. Die bloße Bezugnahme auf das Einspruchsverbringen könne eine sachgerechte Begründung im Beschwerdeverfahren nicht ersetzen; vielmehr sei die in Art. 12 (3) Satz 1 und Satz 2, 2. Halbsatz VOBK 2020 (weiterhin) geforderte Vollständigkeit des Beschwerdevorbringens bereits deshalb geboten, weil es nicht Aufgabe der Kammer sein könne, nachzuforschen, welche der Argumente aus dem Einspruchsverfahren im Lichte der angefochtenen Entscheidung und den darin getroffenen Feststellungen weiterhin relevant bleiben könnten (so bereits T 1792/17 zur VOBK 2007).

Ebenso ließ die Kammer die in einen späteren Schriftsatz im Beschwerdeverfahren integrierten Auszüge aus der Einspruchserwiderung und aus der Replik im Einspruchsverfahren nicht in das Verfahren zu, weil damit die Argumente aus diesen erstinstanzlichen Schriftsätzen wörtlich wiederholt wurden, ohne dass die Patentinhaberin sich mit der Feststellung der Einspruchsabteilung näher befasst hätte, wie aber von Art. 12 (3) Satz 2 VOBK 2020 gefordert. Wie bereits in T 1041/21 festgehalten, bestehe kein Unterschied, ob verwiesen werde oder diese ohne Anpassung an den Fall nochmal eingereicht würden.
11. Article 13(2) RPBA 2020 | T 0116/18 | Board 3.3.02

In **T 116/18** (of 28 July 2023) the board decided at the oral proceedings not to admit the respondent's (patent proprietor's) submission that the facts underlying **T 873/21** were analogous to the facts under consideration in the case in hand, so that, based on that decision, the effect demonstrated in D21 could be relied on.

The board's final decision in the proceedings in hand was to grant the respondent's main request, i.e. to dismiss the appeal. The board nevertheless considered it appropriate to explain why the respondent's argument that the reference to **T 873/21** should be taken into account because it was always possible to refer to case law was not convincing.

According to the explanatory notes made as regards Art. 12(4) RPBA 2020, submissions by a party which concern only the interpretation of the law are not an amendment within the meaning of this Article. However, in the board's view, a distinction had to be made between an interpretation of the law based on a previous decision by the boards of appeal, on the one hand, and a reference to the specific factual and legal assessments of this previous decision and the allegation that this

**Keywords**
- amendment after summons – exceptional circumstances (no) – argument about interpretation of the law (no) – argument that the factual and technical situation underlying an earlier decision is similar taken into account (no)

**Cited decisions**
- R 0017/09, T 0873/21

**Case Law Book**
- V.A.4.2.2n, 10th edition
factual situation was the same as in the case pending before the board, on the other hand.

As regards the interpretation of the law, the board explained that the boards of appeal were expected to be familiar with the relevant case law. They had to apply the EPC correctly and examine the relevant case law ex officio. If there was a contradiction between the interpretation of the EPC the board intended to follow in the case pending before it and the interpretation adopted in the earlier decision, the board in the case pending before it had to explain the reason for its deviation. In some circumstances, a referral might even be appropriate or necessary. Therefore, any reference to principles of law or interpretation of the EPC set out in previous decisions had to be taken into account.

The board distinguished this case from the submission of a party that argued that the specific factual and technical situation underlying a particular earlier decision was similar to the factual and technical situation underlying the case pending before the board and that therefore the way in which the EPC was applied in that earlier decision should be followed. In the board’s view, such a submission was not simply an interpretation of the law made by reference to an earlier decision. On the contrary, it contained both a statement of fact and its legal qualification. In order for the board to deal with such a submission in the case pending before it, it had to examine the factual situation on which the earlier decision was based and assess whether it was similar to or different from the one underlying the pending case. The board pointed out that, in general, doing so required not only a careful reading of the reasoning, but also consultation of the facts and submissions in the case underlying the earlier decision.

For these reasons, the submission that the specific factual and technical situation underlying a particular earlier decision was similar to the factual and technical situation underlying the case pending before the board, such that the way in which the EPC was applied in that earlier decision should be followed in the pending case, was not only an interpretation of the law, but included a new allegation of fact.

Since, in the case in hand, this new allegation of fact was made for the first time at the oral proceedings, the board concluded that it constituted an amendment to the respondent's appeal case. In the absence of any exceptional circumstances, the board decided not to admit this amendment (Art. 13(2) RPBA 2020).