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# Abstracts of decisions

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## Abstracts of decisions

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## 1. Article 054 EPC | T 0043/18 | Board 3.3.02

**Article:** Article 054 EPC

<b>Case Number:</b>	T 0043/18
<b>Board:</b>	3.3.02
<b>Date of decision:</b>	2022.06.01
<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 054, 087 and 123(2) EPC
<b>EPC Rules:</b>	
<b>RPBA:</b>	
<b>Other legal provisions:</b>	
<b>Keywords:</b>	novelty – chemical compounds – purity
<b>Cited decisions:</b>	G 0002/88, G 0001/03, G 0002/10, T 0990/96, T 1085/13
<b>Case Law Book:</b>	<a href="#">I.C.6.2.1a</a> ), 10th edition

In [T 43/18](#) the board agreed with the rationale and the conclusion of T 1085/13 in relation to the assessment of novelty. T 1085/13 was based on the observation that in G 2/10 the Enlarged Board of Appeal had stated that the overriding principle for any amendment to be allowable under Art. 123(2) EPC was that the subject-matter of an amended claim must be at least implicitly disclosed to the skilled person using common general knowledge in the application as filed. The Enlarged Board further referred to decision G 1/03, which stated that the European patent system must be consistent and the concept of disclosure must be the same for the purposes of Art. 54, 87 and 123 EPC.

Therefore, the conclusion in T 1085/13 was that a claim defining a compound as having a certain purity lacked novelty over a prior-art disclosure describing the same compound only if the prior art disclosed the claimed purity at least implicitly, for example by way of a method for preparing said compound, the method inevitably resulting in the purity as claimed. Such a claim, however, did not lack novelty if the disclosure of the prior art needed to be supplemented, for example by suitable (further) purification methods allowing the skilled person to arrive at the claimed purity. The question of whether such (further) purification methods for the prior-art compound were within the common general knowledge of those skilled in the art and, if applied, would result in the claimed purity, was not relevant to novelty, but was rather a matter to be considered in the assessment of inventive step.

In the present case, claim 1 of the patent in suit was directed to a pharmaceutical dosage form comprising oxycodone hydrochloride having less than 25 ppm of a specific impurity. In the contested decision, the opposition division had concluded that D1-D3 and D15 did not, even implicitly, disclose the purity recited in claim 1. However, the opposition division reasoned that, following T 990/96, the disclosure in D1-D3 and D15 of oxycodone hydrochloride had made this compound available to the public in all desired grades of purity. The exceptional situation whereby, according to T 990/96, novelty could be acknowledged where all prior attempts to achieve the claimed purity by conventional purification processes had failed, was not applicable to claim 1. Furthermore, the opposition division had concluded a lack of novelty despite accepting that the evidence on file demonstrated, at the effective date of the patent, that there was no specific [oxycodone hydrochloride] preparation available on the market which would have met the claimed purity criteria.

In view of the above, and in line with T 1085/13, the board established that it was abundantly clear that in the present case, the prior art would need to be supplemented with suitable further purification methods in order to (potentially) arrive at the claimed purity, which could not lead to a lack of novelty of the claimed subject-matter, but was rather a matter to be considered in the assessment of inventive step. The board thus concluded that the subject-matter of claim 1 was novel.

011-02-23

## 2. Article 054 EPC | T 1688/20 | Board 3.2.07

**Article:** Article 054 EPC

<b>Case Number:</b>	T 1688/20
<b>Board:</b>	3.2.07
<b>Date of decision:</b>	2022.10.19
<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 054, 087 and 123(2) EPC
<b>EPC Rules:</b>	
<b>RPBA:</b>	
<b>Other legal provisions:</b>	
<b>Keywords:</b>	novelty – selection invention – sub-range – gold standard
<b>Cited decisions:</b>	G 0003/89, G 0011/91, G 0001/03, G 0002/10, G 0001/16, T 0198/84, T 0279/89, T 0234/09, T 1085/13, T 0261/15, T 1472/15, T 0437/17
<b>Case Law Book:</b>	<a href="#">I.C.6.3.1</a> , 10th edition

In [T 1688/20](#) the board referred to the three criteria developed in T 198/84, as summarised in T 279/89, according to which a selection of a sub-range of numerical values selected from a broader range was considered novel, when each of the following criteria was satisfied: (a) the selected sub-range is narrow compared to the known range; (b) the selected sub-range is sufficiently far removed from any specific examples disclosed in the prior art and from the end-points of the known range; and (c) the selected range is not an arbitrary specimen of the prior art, i.e. not a mere embodiment of the prior art, but another invention (purposive selection, new technical teaching).

For criterion (c), the board concurred with the most recent decisions, including T 261/15, according to which the criterion of purposive selection was relevant for the question of inventive step rather than for novelty. Indeed, since 2019, the Guidelines for Examination in the EPO stated that only criteria (a) and (b) needed to be fulfilled (see G-VI, 8 (ii) – November 2019 version).

With regard to criteria (a) and (b), the present board was not convinced that the relative terms "narrow" and "sufficiently far removed" provided objective, solid and consistent criteria for establishing novelty of a selected sub-range. The board was of the view that these terms were generally open to such a broad interpretation that the decision whether criteria (a) and (b) were met could also depend on the subjective

perception of the deciding body on which values were to be considered "narrow" or "sufficiently far removed".

Furthermore, the board was of the opinion that, at least in the present case, the remaining criteria (a) and (b) did not need to be assessed for the question of novelty. The board started its analysis by recalling that the European patent system must be consistent and the concept of disclosure must be the same for the purposes of Art. 54, 87 and 123(2) EPC (G 1/03, G 2/10 and G 1/16). The board observed that the various tests developed for different cases of amendments were only meant to provide an indication of whether an amendment complied with Art. 123(2) EPC as interpreted according to the "gold standard" (G 3/89, G 11/91 and G 2/10) and should not lead to a different result (see in particular T 1472/15 and T 437/17, regarding the essentiality test).

The board thus held that the same approach should hold true for deciding on novelty of the claimed subject-matter with respect to the prior art, i.e. that no test or list of criteria should lead to a different result than when applying the "gold standard" directly, which was the absolute requirement in terms of disclosure.

In light of the above, the board concluded that in cases where under application of the "gold standard" it could be established whether the skilled person, using common general knowledge, directly and unambiguously derived a claimed sub-range from a particular disclosed range of the prior art, no supporting test or criteria was necessary to reach a conclusion. Thus, none of the three criteria initially developed in T 198/84 needed to be applied.

In the case in hand, the board concluded that, applying the "gold standard" the skilled person could not directly and unambiguously derive the subject-matter of claim 1 as granted from the disclosures of the cited prior art documents. It underlined in its assessment that it was consistent case law that general information, such as a range defined by its boundaries, could not anticipate a more specific technical feature, such as a specific value in that range. This also applied in the case that the alleged value was an adjacent value to be considered after one or the other boundary value.

012-02-23

### 3. Article 056 EPC | T 0929/18 | Board 3.5.01

<b>Article:</b>	<b>Article 056 EPC</b>
<b>Case Number:</b>	<b>T 0929/18</b>
<b>Board:</b>	3.5.01
<b>Date of decision:</b>	2022.05.13
<b>Language of the proceedings:</b>	EN
<b>Internal distribution code:</b>	D
<b>Inter partes/ex parte:</b>	Ex parte
<b>EPC Articles:</b>	Articles 056 and 092 EPC
<b>EPC Rules:</b>	
<b>RPBA:</b>	
<b>Other legal provisions:</b>	
<b>Keywords:</b>	inventive step – technical and non-technical features – notorious knowledge – additional search
<b>Cited decisions:</b>	T 1242/04, T 0690/06, T 1515/07, T 1411/08, T 2467/09, T 0698/11
<b>Case Law Book:</b>	<a href="#">IV.B.4.1.3a</a> , 10th edition

In [T 929/18](#) the examining division had refused the application for lack of inventive step without referring to any prior art documents.

In particular, claim 5 referred to mobile user devices in a "peer-to-peer" data sharing group. Each mobile user device of the data sharing group stored the shared data and maintained a list of the mobile user devices in the data sharing group. Messages from one mobile user device were directed to the respective members of the group through a relay or router, and the messages contained the addresses of the group members.

The examining division considered that the "peer-to-peer" data sharing group was administrative in nature and that the implementation via the relay or router was an insignificant technical detail, essentially being mapped onto the router in a conventional network. Thus, the technical character of independent claim 5 resided solely in the implementation of an administrative scheme on a notoriously known electronic data processing system comprising a local and a remote computer communicating over a network and exchanging data.

The board disagreed with the view of the examining division. Essentially, the board, referring to decision T 1411/08, held that a mobile user device of a peer-to-peer data



sharing group was a technical feature of the infrastructure of the system, which went beyond a notorious data processing system.

Therefore, the board remitted the case to the examining division for an additional search to be carried out (Guidelines C-IV, 7.2). The board noted that the Guidelines did not define what such an additional search should cover. In the board's view, in a case like this, where no search had been carried out, the additional search should be just as complete as a normal prior art search under Art. 92 EPC. Furthermore, in the interest of proper administration, the results of the search ought to be presented in the public file, either in a separate document or in a communication of the examining division. At a minimum, the field of search and the relevant documents should be indicated. Should the search not reveal any relevant documents, a statement to that effect would allow the applicant, a board of appeal and third parties to conclude that the search had been completed.

013-02-23

#### 4. Article 087(1) EPC | T 1303/18 | Board 3.3.02

<b>Article:</b>	<b>Article 087(1) EPC</b>
<b>Case Number:</b>	T 1303/18
<b>Board:</b>	3.3.02
<b>Date of decision:</b>	2022.11.21
<b>Language of the proceedings:</b>	EN
<b>Internal distribution code:</b>	C
<b>Inter partes/ex parte:</b>	Inter partes
<b>EPC Articles:</b>	Articles 087(1), 089 and 123(2) EPC
<b>EPC Rules:</b>	
<b>RPBA:</b>	
<b>Other legal provisions:</b>	
<b>Keywords:</b>	priority – identity of invention (no) – validity of earliest priority (no) – burden of proof
<b>Cited decisions:</b>	G 0002/98, G 0001/03, G 0002/10, T 0517/14, T 1684/16
<b>Case Law Book:</b>	<a href="#">II.D.3.1</a> , <a href="#">III.G.5.1.2d</a> , <a href="#">III.G.5.2.1</a> , 10th edition

See also abstract under [Article 13\(1\) RPBA 2020](#).

[T 1303/18](#) was an appeal against the opposition division's decision to revoke the patent. The patent had been granted with an earliest priority date of 28 November 2007 claimed from D49. The respondents (opponents) objected to the validity of this earliest priority. Citing G 2/98, they contended that the subject-matter of claim 1 as granted was not directly and unambiguously disclosed in D49. The appellant (patent proprietor) argued that the claims as granted and the whole disclosure of D49 concerned the same invention within the meaning of Art. 87(1) EPC and G 2/98, namely, polymorphic form II of rotigotine. Thus, the earliest priority date was valid.

The board applied G 2/98 and concluded that the polymorphic form defined in claim 1 as granted was not directly and unambiguously disclosed in D49. Thus, the subject-matter of claim 1 as granted did not enjoy the claimed earliest priority date of 28 November 2007. The earliest priority date was therefore not valid.

According to the board, the fact that the same characterisation methods were used to describe the disclosed compound in both the patent and D49 played no role when assessing identity of the invention under G 2/98. The fact that the same figures resulted from that characterisation in the patent and D49 was also irrelevant. What was decisive was whether, using common general knowledge, a compound as defined in claim 1 of the patent was directly and unambiguously disclosed in D49 as a whole. In this respect, the board recalled that the disclosure as the basis for the right to priority under Art. 87(1)

EPC and as the basis for amendments in an application under Art. 123(2) EPC had to be interpreted in the same way (see G 1/03 and G 2/10).

The board noted that in claim 1 as granted, the claimed compound was said to be polymorphic form II of rotigotine and was defined by at least one of four properties, namely properties a) to d). A comparison of the definition in terms of property a) given in claim 1 as granted with the disclosures in D49 revealed certain differences. In light of those differences, at least two selections were needed within D49 to arrive at the claimed compound as defined by property a). However, D49 contained no pointer towards those specific selections. Moreover, the error margin in property a) had been broadened as compared with the error margin in D49 and no disclosure of this broadening could be found in D49. In the board's opinion the skilled person, at the relevant date of the subsequent filing, would not have derived the compound as defined by property a) in claim 1 as granted directly and unambiguously, using common general knowledge, from the disclosure in D49. Similar conclusions were drawn for the other three properties. Thus, the definition given for the compound referred to in granted claim 1 differed in numerous aspects from that disclosed in D49.

The appellant submitted that only form I and form II of rotigotine were known at the earliest priority date and form II was clearly distinguished from form I. Stating that the priority from D49 was not valid amounted to insinuating that a third polymorphic form of rotigotine existed, but this was clearly wrong. The board, however, concurred with the respondents that by accepting this argument, the earliest priority would become retroactively invalid if another crystal form of rotigotine was discovered later, which would fall under the definition given in claim 1 as granted but not under the disclosure of D49. Hence, this argument ran against the principle of legal certainty and had to fail.

The board was not convinced by the appellant's argument that structural properties allegedly lacking in D49 were implicitly disclosed to the skilled person since they were inherent to polymorphic form II and accessible by using the disclosed analytical methods. According to the board, priority had been claimed from a written disclosure (D49) and it was from this disclosure that the skilled person should have been able, at the relevant date, to derive directly and unambiguously, using common general knowledge, the subject-matter of claim 1 as granted. However, as set out above, D49 did not disclose the same compound as that defined in claim 1 as granted.

The board also disagreed with the appellant's submission that the respondents bore the burden of proving that claim 1 as granted defined a compound different from the one disclosed in D49. No evidence in this respect had been presented. According to the board, it was the appellant (patent proprietor) who introduced various differences between the compound defined in granted claim 1 and that disclosed in D49. If, despite these differences, the appellant asserted that the compound of granted claim 1 was the same as that disclosed in D49, it was the appellant who bore the burden of proving this. In fact, it was for an applicant to ensure, where priority from a previous application was claimed, that the same invention was defined, according to the required standard, in the subsequent application as filed.

014-02-23

## 5. Article 110 EPC | T 2503/18 | Board 3.2.05

Article:	Article 110 EPC
<b>Case Number:</b>	T 2503/18
<b>Board:</b>	3.2.05
<b>Date of decision:</b>	2022.09.15
<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 107 and 110 EPC
<b>EPC Rules:</b>	
<b>RPBA:</b>	
<b>Other legal provisions:</b>	
<b>Keywords:</b>	reformatio in peius – opponent as sole appellant – patent proprietors' appeal withdrawn
<b>Cited decisions:</b>	G 0009/92
<b>Case Law Book:</b>	<a href="#">V.A.3.1.5</a> , 10th edition

In [T 2503/18](#) both the patent proprietors and the opponent had appealed the opposition division's decision to maintain the patent in amended form.

After all the patent proprietors' requests had been discussed at the oral proceedings and the board had considered them not to be allowable, the patent proprietors had withdrawn their appeal before the board's decision was announced. Consequently, the opponent had become the sole appellant and the patent proprietors had become the respondents and party to the appeal proceedings as of right under Art. 107, second sentence, EPC.

In claim 1 of the patent as granted (main request) as well as in claim 1 of auxiliary requests 1 and 2ter, limiting feature 1.8 was absent compared to claim 1 of auxiliary request 4, which had been considered by the opposition division to meet all requirements of the EPC. Therefore, the subject-matter of claim 1 of these requests was either broader or an *aliud* compared to the subject-matter of claim 1 of auxiliary request 4 but not a restriction of the claimed subject-matter of auxiliary request 4. This meant that maintaining the patent as granted or maintaining the patent as amended according to auxiliary requests 1 or 2ter would have put the sole appellant in a worse situation than if it had not filed an appeal. This would have contravened the principle of prohibition of reformatio in peius as the opponent had become the sole appellant (see decision G 9/92, OJ 1994, 875 and Case Law, V.A.3.1. and V.A.3.1.5). The main request as well as auxiliary requests 1 and 2ter were thus to be rejected as inadmissible (see decision G 9/92, cited above, point 2 of the order). This

conclusion did not apply to auxiliary request 3ter, which, although higher in rank, contained in claim 1 all the features of claim 1 of auxiliary request 4. Accordingly, it was concluded that the claims of auxiliary request 3ter did not result in an extension in the scope of protection with respect to the claims of auxiliary request 4. Thus, to this extent at least, the amendments did not contravene the principle of prohibition of reformatio in peius. Under these circumstances, auxiliary request 3ter was within the board's jurisdiction, and the board was empowered to decide upon this request in substance.

015-02-23

## 6. Article 114(2) EPC | T 1776/18 | Board 3.3.07

Article:

Article 114(2) EPC

<b>Case Number:</b>	T 1776/18
<b>Board:</b>	3.3.09
<b>Date of decision:</b>	2022.10.05
<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 056, 113(2), 114(1), 114(2), 123(1) EPC
<b>EPC Rules:</b>	Rules 079(1), 081(3), 116(1), 116(2) EPC
<b>RPBA:</b>	Article 12(4) RPBA; Article 13(2) RPBA 2020
<b>Other legal provisions:</b>	
<b>Keywords:</b>	late submitted material – correct exercise of discretion (yes) – legal basis for not admitting late-filed requests – "not submitted in due time"
<b>Cited decisions:</b>	G 0002/88, G 0010/91, G 0004/92, G 0007/93, R 0006/19, J 0014/19, T 0912/91, T 0171/03, T 0811/08, T 1100/10, T 1914/12, T 1933/12, T 2288/12, T 2385/12, T 2536/12, T 0108/14, T 0525/15, T 1758/15, T 688/16, T 0754/16, T 0966/17, T 1042/18, T 0256/19
<b>Case Law Book:</b>	<a href="#">IV.C.5.1.4</a> , 10th edition

In [T 1776/18](#) the board first dealt with the legal basis for not admitting amended claim requests. It cited a long line of case law according to which claim requests may be disregarded under Art. 114(2) EPC, as well as examples of case law in which the opposition division's discretion not to admit claim requests was considered to have its legal basis in Art. 114(2) EPC in conjunction with R. 116(1) EPC. The board also outlined an alternative view set out in R 6/19, in which the Enlarged Board held that the first sentence of Art. 123(1) EPC provided a legal basis for the EPO's discretion as to whether or not to admit claim requests. The Enlarged Board left open whether or not Art. 114(2) EPC constituted such a legal basis as well. In T 256/19, the board stated that discretion to disregard an amended version of a patent could only emanate from Art. 123(1) EPC in conjunction with R. 79(1), 81(3) or 116(2) EPC. There were further views in the case law on the legal basis for not admitting amended claim requests, including that R. 116(2) EPC was the only legal basis (see T 688/16). There were also decisions in which Art. 114(2) EPC in conjunction with R. 116(2) EPC was considered to be the legal basis for not admitting amended claim requests (e.g. T 2536/12, T 525/15, T 1758/15). The present board agreed with the case law according to which Art. 114(2) EPC constituted a legal basis for not admitting claim requests, concluding that in submissions containing claim requests which were explicitly or implicitly substantiated, factual elements were present. The presence of these factual elements allowed Art. 114(2) EPC to be relied on as a legal basis for disregarding claim requests

which were not filed in due time (J 14/19). Applying Art. 114(2) EPC to amended claim requests and hence to the submissions of both opponents and patent proprietors also ensured that the parties were treated equally and according to the same criteria, which guaranteed equality of arms.

Secondly, the board analysed whether the concept of "not submitted in due time" in Art. 114(2) EPC relied on fixed criteria, such as a certain point in time in the proceedings, or, alternatively, on relative criteria, such as individual procedural developments. The board spoke against relying on relative criteria. It observed among other things that, for appeal proceedings, the RPBA 2020 implemented Art. 114(2) EPC in a manner which in principle was binding (T 1042/18) and relied on fixed criteria in order to determine whether a Board had the discretion not to admit a certain submission. In the board's view this approach was also preferable for opposition proceedings as an approach relying on relative criteria tied to individual procedural circumstances had the grave disadvantage that the opposition division's discretionary power was then not clearly and predictably delimited by the law itself.

The board noted that for opposition proceedings there were fixed points in time which allowed the deciding body to determine whether a submission had been filed "in due time" within the meaning of Art. 114(2) EPC. The board identified two such fixed points relevant to the present case (expiry of the period set under R. 79(1) EPC or the final date specified under R. 116(1) EPC). Since, in the case in hand, the relevant request had been filed only after the final date under R. 116(1) EPC, its submission was in any case late-filed. As to the exercise of its discretion, the opposition division had to bear in mind that in opposition proceedings more weight must be given to examination ex officio under Art. 114(1) EPC than in appeal proceedings (cf. G 9/91 and G 10/91, point 18 of the Reasons).

As to the interpretation of R. 116(2) EPC when applied to opposition proceedings, the board did not share the views expressed in T 754/16 in which it is stated that requests filed after the final date set for making written submissions, can only then not be admitted if the patent proprietor had been notified of the grounds prejudicing the maintenance of the patent. The board held that the primary purpose of inviting the patent proprietor to file amended claim requests under R. 116(2) EPC was to expedite the opposition proceedings, and to prevent the patent proprietor from filing such requests after the date specified in R. 116(1) EPC. The board found that R. 116(2) EPC did not limit the opposition division's discretionary power under Art. 114(2) EPC and R. 116(1) EPC. In the board's opinion, as a rule, this discretionary power did not depend on the contents of the opposition division's communication under R. 116(1) EPC. However, if the opposition division invited the patent proprietor to file an amended claim request to address a specific objection and the patent proprietor complied with this invitation by filing the required amendments by the date set under R. 116(1) EPC, the opposition division's discretion not to admit that claim request may effectively be reduced to zero.

016-02-23

## 7. Article 125 EPC | T 2726/17 | Board 3.4.01

<b>Article:</b>	<b>Article 125 EPC</b>
<b>Case Number:</b>	T 2726/17
<b>Board:</b>	3.4.01
<b>Date of decision:</b>	2022.12.16
<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 125 EPC
<b>EPC Rules:</b>	
<b>RPBA:</b>	
<b>Other legal provisions:</b>	Article 2 of the Decision of the President of the EPO of 10 September 2014 (OJ 2014, A98)
<b>Keywords:</b>	general principles – protection of legitimate expectations – obligation to draw attention to easily remediable deficiencies – notice of appeal filed via the EPO Web-Form Filing service (valid) – sufficient time for informing appellant
<b>Cited decisions:</b>	T 0014/89
<b>Case Law Book:</b>	<a href="#">III.A.4.1.1</a> , <a href="#">III.A.4.2.3</a> , <a href="#">V.A.2.5.1</a> , 10th edition

In [T 2726/17](#) the board applied the principles of the protection of legitimate expectations and of good faith (citing T 14/89 as an example) and considered a notice of appeal filed via the EPO web-form filing service as having been duly received.

The board pointed out that according to Art. 2 of the Decision of the President of the EPO of 10 September 2014 (the "Decision") the filing of appeal documents via the EPO web-form filing service was not permitted. The consequence of doing so was that such documents were deemed not to have been received, see Art. 2(2) of the Decision. Pursuant to the last sentence of Art. 2(2) of the Decision, the sender of such web-form filed documents, if identifiable, was to be notified without delay of this deemed non-receipt. In the present case, the sender of the notice of appeal was identifiable. According to the board, between the actual filing of the notice of appeal on 13 September 2017 and the final date of the time limit for filing the notice of appeal (6 October 2017) there had been sufficient time for the EPO to notice the irregularity in the filing of the notice of appeal, inform the appellant (applicant) thereof and for the appellant to resubmit the notice of appeal by accepted means. It appeared from the file that no such notification was issued. The appellant confirmed this in its letter dated 4 January 2018.

017-02-23



## 8. Rule 140 EPC | T 0806/21 | Board 3.3.04

**Article:** Rule 140 EPC

<b>Case Number:</b>	T 0806/21
<b>Board:</b>	3.3.04
<b>Date of decision:</b>	2022.06.17
<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>	
<b>EPC Rules:</b>	Rules 071(3) and 140 EPC
<b>RPBA:</b>	
<b>Other legal provisions:</b>	
<b>Keywords:</b>	correction of errors in decisions – grant decision – omission of pages – correction (no)
<b>Cited decisions:</b>	G 0001/10, T 2081/16, T 1003/19
<b>Case Law Book:</b>	<a href="#">III.L.2</a> , 10th edition

In [T 806/21](#) the board held that, as ruled in decision G 1/10, R. 140 EPC is not available to correct patents. G 1/10 does not restrict the scope of the exclusion of the applicability of the rule in any way.

The appeal of the patent proprietors was against the decision of the examining division to refuse correction of the decision to grant. The decision under appeal acknowledged that the omission of pages 85 to 105 was an error of the examining division, which the patent proprietors did not raise with the examining division. However, the board held that the two cases that the appellants had relied on, T 1003/19 and T 2081/16, differed from the case at hand in that in those cases the decision to grant had not been final and had been appealed within the time limit for appeals.

Decision G 1/10 clearly expressed that the exclusion of the applicability of R. 140 EPC was not restricted in scope in any way. The board therefore could not accept an interpretation of decision G 1/10 according to which, as argued by the appellants, R. 140 EPC could be applied to correct a patent if the communication under R. 71(3) EPC did not reflect the true intention of the examining division because it included an unintentional amendment to the application as filed. There was nothing in G 1/10 even hinting at such an approach. On the contrary, the arguments for the exclusion of the applicability of the rule, in particular legal certainty, equally applied to this situation.

In addition, decision G 1/10 (point 11 of the Reasons) appeared to eliminate any possible doubt by stating: "If, given the opportunity to check the patent text before approving it, an applicant does not draw any errors to the attention of the examining division and thus ensure his approval is limited to the correct text, then the responsibility for any errors remaining in that text after grant should be his alone, whether the error was made (or introduced) by him or by the examining division". This was the situation in the present case. The appeal was therefore dismissed.

018-02-23

## 9. Article 12(2) RPBA 2007 | T 1842/18 | Board 3.2.04

<b>Article:</b>	<b>Article 12(2) RPBA 2007</b>
<b>Case Number:</b>	<b>T 1842/18</b>
<b>Board:</b>	3.2.04
<b>Date of decision:</b>	2021.12.10
<b>Language of the proceedings:</b>	DE
<b>Internal distribution code:</b>	C
<b>Inter partes/ex parte:</b>	Inter partes
<b>EPC Articles:</b>	
<b>EPC Rules:</b>	
<b>RPBA:</b>	Articles 12(2), (4) and 13(1) RPBA 2007
<b>Other legal provisions:</b>	
<b>Keywords:</b>	reply to the statement of grounds of appeal – party’s complete case – late-filed auxiliary request – request not examined by the opposition division – unsubstantiated request
<b>Cited decisions:</b>	
<b>Case Law Book:</b>	<a href="#">V.A.3.2.2</a> , <a href="#">V.A.5.11.1</a> , <a href="#">V.A.5.12.5</a> , <a href="#">V.A.5.12.6</a> , 10th edition

In [T 1842/18](#) wurde der Hilfsantrag 10-alt im Beschwerdeverfahren erst mit der Erwiderung des Patentinhabers auf die Beschwerdebegründung des Einsprechenden 1 eingereicht. Der Antrag war identisch mit dem Hilfsantrag 9, welcher der Einspruchsabteilung in Antwort auf die Ladung zur mündlichen Verhandlung vorgelegt worden war. Dieser wurde nicht in der angegriffenen Entscheidung behandelt, da er dem Hilfsantrag, auf dessen Basis die angegriffene Entscheidung erging, nachgeordnet war. Die Beschwerdeerwiderung des Patentinhabers enthielt keine Substantiierung im Zusammenhang mit Hilfsantrag 10-alt.

Dazu trug der Patentinhaber später vor, dass es die Aufgabe eines Einsprechenden sei, die Zulässigkeit bzw. Gewährbarkeit von Hilfsanträgen im Beschwerdeverfahren in Frage zu stellen und der Patentinhaber bis dahin nicht verpflichtet sei, die Zulässigkeit der Hilfsanträge zu begründen. Zudem seien gemäß der Verfahrensordnung lediglich Beweismittel und Argumente anzuführen, weshalb eine ergangene Entscheidung abzuändern, zu bestätigen oder aufzuheben ist. Über den betreffenden Hilfsantrag sei aber überhaupt nicht entschieden worden. Darüber hinaus argumentierte der Patentinhaber, eine Begründung für die Hilfsanträge sei bereits bei Einreichung vor der Einspruchsabteilung vorgelegt worden.

Die Kammer wies aber darauf hin, dass gemäß Art. 12 (2) VOBK 2007 die Beschwerdebeurteilung und die Erwiderung den vollständigen Sachvortrag der Beteiligten enthalten müssen, wozu auch eine Begründung für in diesem Verfahrensstadium neu eingereichte Hilfsanträge gehört. Der Verfahrensordnung der Beschwerdekammern ist in ihrer Gesamtheit zu entnehmen, dass das Beschwerdeverfahren primär ein schriftliches ist, wobei Art. 12 (2) VOBK 2007 festlegt, dass das vollständige Vorbringen der Beteiligten bereits zu Beginn des Verfahrens zu erfolgen hat. Zweck dieser Bestimmung ist es, ein faires Verfahren für alle Beteiligten sicherzustellen und es der Kammer zu ermöglichen, ihre Arbeit auf der Basis eines vollständigen Vorbringens beider Seiten zu beginnen. Wenn Hilfsanträge vorgelegt werden, erfordert dies in der Regel auch eine Begründung, inwiefern die bisherigen Einwände hierdurch ausgeräumt werden.

Die Kammer rief zudem in Erinnerung, dass das Beschwerdeverfahren ein vom Verfahren vor der Einspruchsabteilung vollständig getrenntes, unabhängiges Verfahren ist und daher allgemeine Rückbezüge auf vorheriges, erstinstanzlich vorgebrachtes Vorbringen im Beschwerdeverfahren außer Betracht gelassen werden. Erst recht kann eine eventuelle Substantiierung eines Hilfsantrags im Einspruchsverfahren nicht im Beschwerdeverfahren berücksichtigt werden, wenn ein solcher Rückbezug fehlt.

Der Hilfsantrag 10-alt, der erstmals in Vorbereitung auf die mündliche Verhandlung vor der Kammer begründet wurde, war somit als verspätet anzusehen. Bei Ausübung ihres Ermessens nach Art. 12 (4) und 13 VOBK 2007 prüfte die Kammer das Konvergenzkriterium, d.h. ob die geänderten Ansprüche gegenüber dem vorher beanspruchten Gegenstand konvergierten oder divergierten, also den Gegenstand des unabhängigen Anspruchs eines Hauptantrags in eine Richtung bzw. in Richtung eines Erfindungsgedankens zunehmend einschränkend weiterentwickelten oder durch Aufnahme jeweils verschiedener Merkmale unterschiedliche Weiterentwicklungen verfolgten. Der Hilfsantrag divergierte im vorliegenden Fall aber von einem höherrangigen Hilfsantrag und die Kammer entschied daher, ihn nicht zuzulassen.

019-02-23

## 10. Article 13(1) RPBA 2020 | T 1303/18 | Board 3.3.02

<b>Article:</b>	<b>Article 13(1) RPBA 2020</b>
<b>Case Number:</b>	T 1303/18
<b>Board:</b>	3.3.02
<b>Date of decision:</b>	2022.11.21
<b>Language of the proceedings:</b>	EN
<b>Internal distribution code:</b>	C
<b>Inter partes/ex parte:</b>	Inter partes
<b>EPC Articles:</b>	
<b>EPC Rules:</b>	
<b>RPBA:</b>	Article 12(2) and (4) RPBA 2007; Article 13(1) RPBA 2020
<b>Other legal provisions:</b>	
<b>Keywords:</b>	amendment to appeal case (yes) – late-filed defence – argument about interpretation of the law (no) – justification by party (no) – amendment detrimental to procedural economy (yes) – taken into account (no)
<b>Cited decisions:</b>	G 0001/93, G 0001/15, T 2988/18
<b>Case Law Book:</b>	<a href="#">V.A.4.2.2n</a> ), <a href="#">V.A.4.4.6</a> , 10th edition

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

In [T 1303/18](#) the board did not admit into the proceedings the appellant's defence relying on entitlement to partial priority pursuant to Art. 13(1) RPBA 2020, Art. 12(2), (4) RPBA 2007. The appellant (proprietor) argued for the first time after the filing of the grounds of appeal and replies, and before the summons to oral proceedings was issued that, should the priority from D49 be considered invalid, the subject-matter of claim 1 as granted should at least be entitled to a partial priority from D49 in accordance with decision G 1/15.

The board observed that an objection as to the validity of the earliest priority claimed from D49 had already been raised by the respondents in their notices of opposition. Decision G 1/15 had been published in the Official Journal of the EPO before the oral proceedings were held before the opposition division. Therefore, the appellant's defence claiming a right to partial priority could and should have been presented before the opposition division or included at the latest in the statement of grounds of appeal.

The appellant argued with reference to T 2988/18 that this defence did not constitute an amendment of its appeal case. It only concerned interpretation of law by means of an argument based on a decision of the Enlarged Board of Appeal. Therefore, the appellant was allowed to raise this defence at any point during the proceedings.

The board held that, contrary to the appellant's view, the defence by which a right to partial priority was invoked was not merely a presentation of a new argument pertaining to the interpretation of law but comprised a new allegation of fact. Indeed, the appellant had asserted that priority application D49 directly and unambiguously disclosed in an enabling manner part of the subject-matter of claim 1 as granted, and specifically that claim 1 as granted encompassed this part as an alternative subject-matter by virtue of a "generic `OR`-claim" within the meaning of decision G 1/15. The board considered that the submitted defence would have involved a new factual assessment of the subject-matter of claim 1 as granted and of priority application D49, namely as to precisely which part of claim 1 it was that allegedly enjoyed partial priority and where it was disclosed in D49. Decision T 2988/18, invoked by the appellant, could not support the appellant's submission. In that decision the entrusted board had concluded that the new argument at issue was not an amendment of the appeal case since it only concerned how the interpretation of Art. 123(2) EPC provided by the Enlarged Board of Appeal in G 1/93 applied to the facts of the case at issue. Therefore, contrary to the current case, no new factual allegations were derived from the new argument submitted. Hence, the rationale developed in T 2988/18 was not applicable to the case at hand. This was also consistent with the explanatory remarks to the RPBA 2020 (supplementary publication 2, OJ 2020, page 57). The appellant's defence did not "concern only the interpretation of the law" but constituted a new allegation of fact.

The defence relying on partial priority therefore constituted an amendment to the appellant's appeal case within the meaning of Art. 13(1) RPBA 2020. The board decided not to admit it into the proceedings, as the required new factual assessment would have been complex and the appellant had provided no justification for this late amendment.

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