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Edited by

Legal Research Service of the Boards of Appeal

For comments and requests please contact: BOA_legalresearchservice@epo.org

Abstracts of decisions

In this issue:

Article 054 EPC	T 0670/20 Board 3.3.07	1
Article 056 EPC	T 1105/17 Board 3.5.06	3
Article 056 EPC	T 0297/20 Board 3.5.03	5
Article 056 EPC	T 0335/20 Board 3.3.08	7
Article 056 EPC	T 0702/20 Board 3.5.06	9
Article 069 EPC	T 1844/19 Board 3.3.05	11
Article 083 EPC	T 0500/20 Board 3.2.04	13
Article 088(3) EPC	T 0335/20 Board 3.3.08	15
Article 123(2) EPC	T 0088/21 Board 3.3.05	17
Article 12(4) RPBA 2020	T 0714/20 Board 3.5.06	19

1. Article 054 EPC | T 0670/20 | Board 3.3.07

Article:	Article 054 EPC
Case Number:	T 0670/20
Board:	3.3.07
Date of decision:	2022.12.02
Language of the proceedings:	EN
Internal distribution code:	C
Inter partes/ex parte:	Inter partes
EPC Articles:	Article 054 EPC
EPC Rules:	
RPBA:	
Other legal provisions:	
Keywords:	novelty – availability to the public (no) – obligation to maintain secrecy (yes)
Cited decisions:	T 0007/07
Case Law Book:	I.C.3.4.7 , I.C.3.4.12 , 10th edition

In [T 670/20](#) the parties agreed that the clinical trials of documents D19 and D20 had been carried out in accordance with the EMEA Guidelines for Good Clinical Practice. These guidelines explicitly required adherence to the prescribed protocol and assurance of drug accountability. This set-up of the trials of documents D19 and D20 implied that the patients who decided to participate in the trials had agreed, following their informed consent, to use the provided medication according to instruction or to return the unused medication. Accordingly, the participating patients who were provided with the tablets under investigation entered into a special relationship with the investigators of the trials and were with regard to the provided tablets not members of the public that could freely dispose over these tablets.

The board acknowledged that the statements in documents D19 and D20 encouraging patients to discuss their participation in the trials indicated that the patients were not under a duty of confidence with respect to their participation to the trials and the information regarding the trial provided to them in that context. However, the board found no reason why the absence of the patients' duty of confidence with respect to the information relevant to their participation in the trials should affect the obligations of the participating patients regarding the use and return of the tablets provided to them, which resulted from their decision to participate in the trials. The board noted that the patients' agreement to use the provided medication according to instruction or to return the unused medication obliged the patients irrespectively of any sanction (and lack thereof) on non-compliance and therefore

disqualified the patients as members of the public with respect to the medication provided to them. The possibility of non-compliance to the instructed use and return of the tablets by the participating patients did not affect the essence of this agreement.

In T 7/07 the competent board had concluded on the basis of the available information that apparently the sponsor of the trial had effectively lost control over the drugs after these had been handed out to the participants of the trial as members of the public who were not bound to secrecy.

The board held that in the present case the tablets were not provided to the participants of the trial as members of the public, which distinguished the circumstances of the trials of documents D19 and D20 from the circumstances of the trial considered in T 7/07. Accordingly the board held that the public had not gained access to the claimed tablets during the trials reported in documents D19 and D20 and that the main request therefore complied with the requirement of novelty.

021-03-23

2. Article 056 EPC | T 1105/17 | Board 3.5.06

Article:	Article 056 EPC
Case Number:	T 1105/17
Board:	3.5.06
Date of decision:	2022.10.11
Language of the proceedings:	EN
Internal distribution code:	D
Inter partes/ex parte:	Ex parte
EPC Articles:	Article 056 EPC 1973
EPC Rules:	
RPBA:	
Other legal provisions:	
Keywords:	inventive step – technical and non-technical features – programming language
Cited decisions:	T 1539/09, T 0790/14
Case Law Book:	I.D.9.2.9 , 10th edition

In [T 1105/17](#) the board stated that it had consistently been decided by the boards of appeal (see, e.g. T 1539/09 and T 790/14) that the design or provision of programming language constructs per se did not contribute to the solution of a technical problem and could not therefore contribute to the presence of an inventive step.

In the present case, the alleged effect of the new programming language construct was to "allow [...] a programmer to specify event-handling mechanisms in JAVA using more concise, less verbose syntax" in order "to make programmers more efficient" by "reducing the amount of code that programmers need to write".

It was true that having to write "less verbose" source code may "spare" the programmer some "burden", namely the mental burden of having to conceive the more verbose syntax or the "mechanical" effort of inputting that code into a computer. The compiled code generated was – and was defined to be – the same as if the more verbose syntax had been used (see claim 1, lines 7-12). Hence, the invention had no effect on the compiled code eventually carried out.

Moreover, the mentioned advantages were only relative to a programming language with a "more verbose" syntax. The choice of the "less verbose" programming language could not, for the purposes of inventive step, be distinguished from the choice of any programming language. Programmers may make this choice according to one or several of the following reasons: (1) according to subjective preferences,

(2) according to circumstances such as which programming language has already been chosen in a given project, or (3) for which the compiler happens to be available on the available hardware, but, indeed, also (4) according to which programming language provides certain commands. At least the first three were non-technical reasons for the choice. Since the claim language did not exclude these, it could be left open whether consideration (4) (contributed by the appellant) might, in certain circumstances, be acceptable as technical.

The board considered that sparing the programmer some mental burden during programming was not, in itself, a technical problem. This was also the case because it could not be determined objectively: programmers may differ as to which programming constructs they find simpler to understand and deal with.

022-03-23

3. Article 056 EPC | T 0297/20 | Board 3.5.03

Article:	Article 056 EPC
Case Number:	T 0297/20
Board:	3.5.03
Date of decision:	2023.01.17
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 – guided human-machine interaction
Cited decisions:	T 0115/85, T 1802/13, T 0336/14
Case Law Book:	I.D.9.2.10b , 10th edition

In [T 297/20](#) the board held that the mere change, by an operator, of the degree of abstraction of a graphical view ("condensation") of a power grid did not credibly assist a user in performing a technical task by means of a continued and/or guided human-machine interaction process within the meaning of T 336/14 and T 1802/13 and thus could not bring about a technical effect.

The application at hand concerned the presentation of information on a visual display regarding control stations and power lines of a power grid for a "Supervisory Control And Data Acquisition" (SCADA) system. Such a system was typically used for supervising, monitoring and controlling a large and complex power grid. Overviews of such grids on screen can render it difficult for an operator to see "the big picture". The invention in question tried to address this by controlling the level or degree of abstraction with which the control stations and power lines were represented and seeking a balance between the amount and the accuracy of the visually represented information. The board stated that this was not bound to be a technical problem.

The board recalled that a feature relating to the presentation of information may only contribute to an inventive step if it brought about an overall technical effect. Within the context of graphical user interfaces, this was the case if the feature credibly assisted the user in performing a technical task by means of a continued and/or guided human-machine interaction process regarding both the type of the information presented, i.e. "what" is presented, and the manner in which it was presented, i.e. "how" it is presented (T 336/14, T 1802/13).

The appellant referred to case T 115/85 in support of its argument that giving a visual indication constituted a technical problem. The board, however, held that the situation envisaged in T 115/85 where visual feedback on displayed operation states was provided for enabling a technical system's proper functioning had to be distinguished from the one where the information presented was exclusively aimed at the mental activities of the system user as the final addressee (T 336/14). The information presented in the former situation could be typically seen as "technical information" whereas in the latter situation, the presented information had no technical effect.

In the present case, even when construing features in the appellant's favour, the board could not recognise any "continued and/or guided human-machine interaction process" associated with these features, let alone one that would assist the user in carrying out a technical task (i.e. a task with an underlying credible technical effect). This conclusion applied to both the features relating to "what" was presented and to "how" it was presented. Instead, those features all related to subjective factors, such as a user's personal taste or preference about how much detail should actually be presented. Such subjective factors were of a non-technical nature. The board concluded that there was no credible technical effect.

022-03-23

4. Article 056 EPC | T 0335/20 | Board 3.3.08

Article: Article 056 EPC

Case Number: T 0335/20

Board: 3.3.08

Date of decision: 2022.09.29

Language of the proceedings: EN

Internal distribution code: D

Inter partes/ex parte: Inter partes

EPC Articles: Article 056 EPC

EPC Rules:

RPBA:

Other legal provisions:

Keywords: problem and solution approach – closest prior art – skilled person – distinguishing features may come from another prior-art document or from the common general knowledge

Cited decisions: G 0001/15, T 0609/02

Case Law Book: [I.D.3.1.](#), [I.D.3.2.](#), 10th edition

[See also abstract under Article 88\(3\) EPC.](#)

In [T 335/20](#) the board found that D9 provided an enabling disclosure of the suitability of PGRN replacement for the treatment of FTD (see also T 609/02). Since document D9 dealt with the same disease as claim 1, identified low levels of PGRN as the cause of the disease and provided an enabling disclosure of the suitability of PGRN replacement for the treatment of FTD, it was considered to be a suitable starting point for the assessment of inventive step in claim 1.

It was undisputed that D9 did not provide any information on the specific therapeutics to be used for the replacement of PGRN or any technical teaching for reducing the therapeutic application to practice. The opposition division had held that this lack of information as to how to reduce the therapeutic application to practice meant that the "therapeutic use" was not directly and unambiguously derivable from the disclosure of D9, with the result that this document did not disclose "in an enabling manner, a method of treating FTD", and therefore was not directed to the same, or to a similar, purpose as claim 1. The respondents furthermore submitted that, since D9 was not an enabling disclosure of a therapeutic application, it was not a disclosure of such an application at all, and that the closest prior art could not be a teaching in a document that could not be reduced to practice by the skilled person on the basis of that document.

The board considered that D9 provided an enabling disclosure of what it proposed, i.e. PGRN replacement therapy as a therapeutic strategy to treat FTD. It was not necessary for D9 to provide an enabling disclosure of what was claimed. When applying the problem-and-solution approach in the assessment of inventive step, information that was not disclosed in the prior art is considered in determining the distinguishing features, the resulting technical effect, and the formulation of the objective technical problem to be solved. To what extent the claimed subject-matter differed from the disclosure in D9 was thus relevant when determining the distinguishing features. The teaching towards the distinguishing features may then come from another prior-art document or from the common general knowledge of the skilled person. D9's lack of disclosure as regards implementation of the proposed PGRN replacement therapy did not therefore disqualify it from being the starting point for the assessment of inventive step.

024-03-23

5. Article 056 EPC | T 0702/20 | Board 3.5.06

Article: Article 056 EPC

Case Number:	T 0702/20
Board:	3.5.06
Date of decision:	2022.11.07
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 – excluded matter – neural network
Cited decisions:	G 0001/19
Case Law Book:	I.D.9.2.11e , 10th edition

In [T 702/20](#) the board held that a neural network defines a class of mathematical functions which, as such, was excluded matter. As for other "non-technical" matter, it could therefore only be considered for the assessment of inventive step when used to solve a technical problem, e.g. when trained with specific data for a specific technical task. According to the board, the claim as a whole specified abstract computer-implemented mathematical operations on unspecified data, namely that of defining a class of approximating functions (the network with its structure), solving a (complex) system of (non-linear) equations to obtain the parameters of the functions (the learning of the weights). According to the claim, the neural network had a new structure because the hierarchical neural network was formed by loose couplings between the nodes in accordance with a sparse parity-check matrix of a low-density parity-check code.

The appellant argued that the proposed modification in the neural network structure, in comparison with standard fully-connected networks, would reduce the amount of resources required, in particular storage, and that this should be recognised as a technical effect, following G 1/19.

The board noted that, while the storage and computational requirements were indeed reduced in comparison with the fully-connected network, this did not in and by itself translate to a technical effect, for the simple reason that the modified network was different and would not learn in the same way. So it required less storage, but it did not do the same thing. For instance, a one-neuron neural network required the least storage, but it would not be able to learn any complex data relationship. The

proposed comparison was therefore deemed incomplete, as it only focused on the computational requirements, and insufficient to establish a technical effect. The claimed invention thus lacked inventive step.

As a further remark, the board stressed that there could be no reasonable doubt that neural networks can provide technical tools useful for automating human tasks or solving technical problems. In most cases, however, this required them to be sufficiently specified, in particular as regards the training data and the technical task addressed. In this particular case, the board could not see, considering the content of the application, for which type of learning tasks the proposed structure may be of benefit, and to what extent.

025-03-23

6. Article 069 EPC | T 1844/19 | Board 3.3.05

Article: Article 069 EPC

Case Number:	T 1844/19
Board:	3.3.05
Date of decision:	2022.10.13
Language of the proceedings:	FR
Internal distribution code:	D
Inter partes/ex parte:	Ex parte
EPC Articles:	Articles 054, 069 and 084 EPC
EPC Rules:	
RPBA:	
Other legal provisions:	
Keywords:	interpretation of claims – using the description to interpret the claims – novelty
Cited decisions:	T 0121/89, T 0607/93, T 0470/96, T 1208/97, T 0881/01, T 1279/04, T 0916/09, T 1646/12
Case Law Book:	I.C.4.8. , I.C.5.2. , II.A.6.3.2. , II.A.6.3.3. , II.A.6.3.4. , 10th edition

Dans l'affaire [T 1844/19](#) la revendication 1 du brevet tel que délivré se référait à une laine minérale ayant une composition chimique "sensiblement dépourvue d'oxyde de bore". Cette caractéristique était la seule caractéristique distinctive possible par rapport au document M08, qui comprenait un exemple ayant 1,100 % B₂O₃.

La question cruciale était de savoir s'il était admissible de consulter la description du brevet en litige pour établir la limite supérieure de la quantité d'oxyde de bore et, le cas échéant, quelle valeur en découlait.

La chambre a indiqué que la jurisprudence contenait de nombreuses décisions dans lesquelles la description et les dessins étaient utilisés pour interpréter des revendications ambiguës (Jurisprudence des Chambres de recours de l'OEB, 10^e édition, 2022, II.A.6.3.3). En même temps, il était généralement reconnu qu'aux fins de l'appréciation de la nouveauté et de l'activité inventive, on ne pouvait se fonder sur l'art. 69 CBE pour voir dans la revendication une limitation implicite qui n'était pas suggérée dans le libellé explicite de ladite revendication (Jurisprudence des Chambres de recours de l'OEB, II.A.6.3.4 et I.C.5.2. ; T 1208/97). En outre, dans plusieurs décisions, les chambres de recours avaient souligné que, dans la procédure devant l'OEB, le titulaire du brevet a la possibilité de restreindre ses revendications afin de refléter des limitations plus strictes définies dans la description. Elles avaient conclu qu'il n'était pas possible de limiter l'étendue d'une

revendication en y incorporant implicitement des caractéristiques qui ne figuraient que dans la description (Jurisprudence des Chambres de recours de l'OEB, II.A.6.3.4 ; T 881/01 ; T 1279/04 ; T 916/09).

De plus, la chambre a noté que selon la décision T 1646/12, il convenait d'éviter deux extrêmes. D'une part, il ne fallait pas voir dans les revendications, par extrapolation, des caractéristiques restrictives qui figuraient certes dans la description, mais pas dans les revendications. D'autre part, on ne devait pas non plus considérer la revendication comme entièrement distincte de la description ; lorsque les revendications manquaient de clarté, la personne du métier ne pouvait se dispenser de rechercher des éléments de clarification dans les autres revendications, mais également dans la description et dans les dessins (Jurisprudence des Chambres de recours de l'OEB, II.A.6.3.2).

En l'espèce, l'intérêt de se référer à la description apparaissait seulement dès lors qu'il fallait décider quelle valeur précise d'une quantité faible en oxyde de bore était encore couverte par la revendication. Cependant, définir l'objet de la protection demandée était la fonction même des revendications (art. 84 CBE). Le titulaire avait choisi de ne pas préciser de valeur limite dans la revendication, mais d'utiliser à la place l'expression vague « sensiblement dépourvu d'oxyde de bore ». Dans la présente affaire, bien qu'il fallait interpréter cette expression vague, y attribuer un sens restreint à l'aide de la description serait revenu au premier des deux extrêmes considérés dans la décision T 1646/12 et devait donc être évité.

Le présent cas était plutôt similaire à celui d'une revendication qui n'était pas difficile à comprendre mais qui était rédigée en termes trop généraux. Dans un tel cas de figure, il n'était normalement pas possible d'interpréter la revendication de manière restrictive en s'appuyant sur la description (Jurisprudence des Chambres de recours de l'OEB, I.C.4.8. ; T 607/93). Similairement, dans l'affaire T 470/96, la chambre avait conclu que toute interprétation techniquement raisonnable d'une revendication vague et ambiguë était justifiée s'il s'agissait de comparer la revendication avec l'état de la technique ; si l'intention avait été de spécifier une interprétation plus étroite ou une signification spécifique, il aurait été nécessaire de modifier la revendication sur la base des informations précises figurant dans la description.

Au vu de ce qui précède, la chambre a conclu que l'objet de la revendication 1 considérée n'était pas nouveau.

026-03-23

7. Article 083 EPC | T 0500/20 | Board 3.2.04

Article: Article 083 EPC

Case Number:	T 0500/20
Board:	3.2.04
Date of decision:	2023.01.18
Language of the proceedings:	EN
Internal distribution code:	C
Inter partes/ex parte:	Inter partes
EPC Articles:	Articles 083, 100(b) EPC
EPC Rules:	
RPBA:	
Other legal provisions:	
Keywords:	sufficiency of disclosure (yes) – invention to be performed over whole range claimed – invention not sufficiently disclosed across the entire breadth of the claim – approach developed in the field of chemistry – inappropriate for claimed inventions not involving a range of parameter values or compositions – field of mechanics – providing a single detailed example
Cited decisions:	G 0001/03, G 0002/21, T 0857/16
Case Law Book:	II.C.5.4. , II.C.5.2. , 10th edition

In [T 500/20](#) the invention concerned a wind turbine aimed at damping or eliminating undesirable edgewise oscillations of the rotor blades that might appear in an idling power producing situation. The control of the wind turbine altered the nacelle yaw angle if it detected the presence of blade edgewise oscillations. The appellant (opponent) held that the invention was not sufficiently disclosed.

The board considered the arguments put forward by the appellant were without merit, for example as to the alleged contradiction in the claim features. The board also stressed that as variously stated in case law, isolated cases of non-working or not ideally working embodiments were of no import for the issue of sufficiency in the light of the large number of conceivable and realisable alternatives indicated in the description (G 1/03, point 2.5.2 of the Reasons; T 857/16).

Moreover, the board added that the general argument (made in this case and unfortunately more widely in mechanics), that the invention would not be sufficiently disclosed across the entire breadth of the claim misapplied an approach developed mainly in the field of chemistry for inventions where a central aspect of the claimed

invention was a range of compositions or of parameter values. There it was important that an effect associated in the patent with the range was plausible or plausibly demonstrated across the whole breadth of the claimed range. Otherwise the claimed invention would be insufficiently disclosed, because the effect was not plausible across the whole breadth of the range.

The board stated that in claimed inventions that did not involve a range of parameter values or compositions, basing an argument of insufficiency on this approach was inappropriate and could be rejected offhand for that reason. This was especially so where, as in the present case, an invention was directed at a broadly defined concept expressed in terms of generic structural or functional features of an apparatus or of a method. There it normally sufficed to provide a single detailed example or embodiment to illustrate how this concept could be put into practice in such a way that the underlying principles could be understood by the relevant skilled person who could reproduce the claimed invention using their common general knowledge without undue burden. In its Catchword the board said that: “in claimed inventions that do not involve a range of parameter values or compositions but are directed at a concept expressed in terms of generic structural or functional features of an apparatus or of a method, it is not enough to demonstrate insufficiency to conceive of an example that falls within the terms of the claim that does not work because it does not achieve the claimed effect fully or at all so that therefore the invention would not be sufficiently disclosed across the entire breadth of the claim”. The board found that such an example did not prove that the claimed concept did not work; rather it reflected the limitations that were inherent in any technological endeavour and which may provide the scope for future (inventive) development. To successively argue insufficiency in a case such as this, a very high burden of proof applied: the party must demonstrate through cogent argument based on the underlying principles, if necessary supported by evidence, that the claimed concept did not work, because it did not achieve the desired effect in any measure or indeed was counter to the laws of nature. Or they must demonstrate that the disclosure lacked information on an important aspect of the claimed invention, without which the skilled person could not realise the claimed invention without undue burden. The appellant failed to present any such arguments.

027-03-23

8. Article 088(3) EPC | T 0335/20 | Board 3.3.08

Article:	Article 088(3) EPC
Case Number:	T 0335/20
Board:	3.3.08
Date of decision:	2022.09.29
Language of the proceedings:	EN
Internal distribution code:	D
Inter partes/ex parte:	Inter partes
EPC Articles:	Articles 054(2), 088(3) EPC
EPC Rules:	
RPBA:	
Other legal provisions:	
Keywords:	priority – partial priority (yes)
Cited decisions:	G 0001/15
Case Law Book:	II.D.5.3.3 , 10th edition

[See also abstract under Article 56 EPC.](#)

In [T 335/20](#), the appellant (opponent) relied on D9 in the context of inventive step. D9 was part of the state of the art as defined in Art. 54(2) EPC only in respect of subject-matter that was not entitled to the priority of P3. The appellant asserted that claim 1 was only entitled to partial priority from P3, while the respondents (patent proprietors) submitted that the entire subject-matter of claim 1 was entitled to the priority of P3. The board had to determine whether the subject-matter of claim 1 was entitled to the priority of P3.

Claim 1 related to the medical use of "a PGRN polypeptide" in the treatment of frontotemporal dementia (FTD). The board construed the term "a PGRN polypeptide" in accordance with the definition provided in the patent and concluded that it did not denote a single specific PGRN polypeptide. Rather, it was a generic expression covering different PGRN polypeptides. Thus, claim 1, where directed to the use of a PGRN polypeptide, could be seen as a claim which encompassed "alternative subject-matter by virtue of one or more generic expressions or otherwise", i.e. a generic "OR" claim as referred to in G 1/15.

The board noted that, in line with the principles set out in G 1/15, in assessing whether subject-matter within claim 1 may enjoy partial priority from P3, the subject-matter disclosed in P3 that was relevant, i.e. relevant in respect of prior art disclosed in the priority interval – in this case D9 – had to be determined. Disclosed subject-matter that was relevant in view of D9 was that relating to the use of a human PGRN

polypeptide in the treatment of FTD. To the extent that P3 disclosed any such subject-matter falling within claim 1, claim 1 would be entitled to priority in respect of that subject-matter.

According to the board, in the patent, the meaning of the human PGRN polypeptide included polypeptides having the amino acid sequence of SEQ ID NO:1 and other full-length polypeptides, whereas in P3 human PGRN polypeptide was explicitly limited to mean a polypeptide having the amino acid sequence of SEQ ID NO:2 (SEQ ID NO:1 in the patent). Therefore, the meaning of human PGRN polypeptide was broadened from P3 to the patent. Hence, claim 1 of auxiliary request 1 could conceptually be divided into two parts. The first part, claim 1A, corresponded to the invention disclosed directly and unambiguously in P3 and was limited, as regards the use of human PGRN polypeptides, to a human PGRN polypeptide having the amino acid sequence set forth in SEQ ID NO:1. The second part, claim 1B, was the rest of the subject-matter of the claim and, as regards the use of human PGRN polypeptides, embraced the human PGRN polypeptide set forth in GenBank GI number 4504151 and disclosed in document D32. Claim 1A was entitled to the priority of P3, while claim 1B was not.

The patent proprietors did not dispute that the subject-matter of claim 1B was not entitled to priority from any other document.

The board concluded that the effective date of claim 1B was the filing date of the patent, and that the disclosure of document D9 was part of the state of the art as defined in Art. 54(2) EPC in respect of the subject-matter of claim 1B.

028-03-23

9. Article 123(2) EPC | T 0088/21 | Board 3.3.05

Article:	Article 123(2) EPC
Case Number:	T 0088/21
Board:	3.3.05
Date of decision:	2022.11.15
Language of the proceedings:	EN
Internal distribution code:	C
Inter partes/ex parte:	Ex parte
EPC Articles:	Articles 054, 087 and 123(2) EPC
EPC Rules:	
RPBA:	
Other legal provisions:	
Keywords:	amendments – disclaimers – undisclosed disclaimers – priority – first application – partial priority – multiple priorities
Cited decisions:	G 0002/98, G 0001/03, G 0002/10, G 0001/15, G 0001/16, T 0248/88, T 1843/09, T 1222/11, T 0282/12, T 0872/14, T 0311/18
Case Law Book:	II.E.1.7.3 , II.D.5.3.3 , 10th edition

In [T 88/21](#) the board held that the basis for the assessment of the allowability of an undisclosed disclaimer was the claim before the insertion of the disclaimer.

The current application and D1 were both filed by the appellant. The current application claimed priority from D0. D1 claimed priority from unpublished D1a, which was filed prior to D0. It had not been contested that D0 and D1a belonged to the appellant.

The board explained that the subject-matter of claim 1 of the current application before the addition of the undisclosed disclaimer was anticipated by examples 4A-D and 5A of D1. The effective date of these examples in D1 was the filing date of D1a, which was earlier than the filing date of D0. Hence, as far as the subject-matter of examples 4A-D and 5A of D1/D1a was concerned, D1a – and not D0 – was the first application within the meaning of Art. 87(1) together with (4) EPC. Therefore, the current application could not validly claim the priority of D0 for the subject-matter of these examples. Since D1 was published prior to the filing date of the current application, D1 was prior art under Art. 54(2) EPC for this subject-matter. D1 was not an accidental disclosure because it was directed to the same technical field as the current application. Furthermore, exclusion from patentability for non-technical reasons was irrelevant to this case. Consequently, the criteria developed in G 1/03

together with G 1/16 were not fulfilled and the undisclosed disclaimer introduced in claim 1 of the main request contravened Art. 123(2) EPC.

The board could not endorse the argument put forward by the appellant that, in essence, D1 was prior art under Art. 54(3) EPC, and not under Art. 54(2) EPC. The applicant argued that the claim currently on file, i.e. the claim with the disclaimer, had to be considered; not the notional claim without the disclaimer. As none of the subject-matter remaining in current claim 1 was disclosed in D1/D1a, the applicant understood that D0 was the first application within the meaning of Art. 87(1) EPC. Hence, the applicant derived that the priority of the main request based on D0 was valid and the disclaimer was allowable to restore novelty over D1 as an Art. 54(3) EPC document.

The board explained that the argument presented by the applicant was based on the incorrect assumption that the claim with (i.e. after the inclusion of) the disclaimer was decisive. In G 1/03, the insertion of the undisclosed disclaimer was occasioned by a lack of novelty objection pursuant to Art. 54(3) EPC, meaning that the objection concerned the claim without (i.e. before the insertion of) the disclaimer. By contrast, under the appellant's approach, the insertion of the disclaimer would restore novelty when a novelty objection under Art. 54(2) EPC (still) applied. The disclaimer would have the effect of removing the subject-matter from the claim which was objectionable under Art. 54(2) EPC.

The board found support in T 1222/11. Although T 1222/11 was explicitly rejected by T 1872/14, as cited by the appellant, subsequent case law was in line with T 1222/11. G 1/16 (in particular, Reasons 43 ff) confirmed that only the criteria of G 1/03 were to be considered when the allowability of an undisclosed disclaimer was assessed, while the gold standard test of G 2/10 had no relevance under these circumstances. G 1/16 explicitly cited T 1872/14 as thus incorrectly applying the gold standard test (in a modified form) to undisclosed disclaimers (see Reasons 24(2)(a) and (b)). G 1/15 moreover confirmed the conceptual identification of alternative subject-matter when assessing partial priorities and endorsed the approach of T 1222/11 in determining the relevant disclosure of a priority document vis-à-vis a subsequent application. Furthermore, in T 282/12, the board held that, for reasons of consistency, the rationale of G 1/15 must also apply for deciding whether an application from which priority was claimed was the first application within the meaning of Art. 87(1) EPC.

Finally, the board addressed the argument by the appellant that following T 1222/11 would amount to an unfair disadvantage for applicants because of "self-collision", as under the same circumstances a third party would be allowed to insert a disclaimer. The board recalled that G 2/98 advocated a "narrow or strict interpretation" of the concept of the same invention and the right to priority. Moreover, the appellant had known the content of their documents D1a/D1 at the time of filing the current application, and it had been in their hands to avoid the current situation.

029-03-23

10. Article 12(4) RPBA 2020 | T 0714/20 | Board 3.5.06

Article: Article 12(4) RPBA 2020

Case Number:	T 0714/20
Board:	3.5.06
Date of decision:	2022.12.01
Language of the proceedings:	EN
Internal distribution code:	D
Inter partes/ex parte:	Ex parte
EPC Articles:	
EPC Rules:	Rules 116(2) and 137(3) EPC
RPBA:	Article 12(4), (6) RPBA 2020
Other legal provisions:	
Keywords:	amendment to case – late-filed requests – no longer maintained in first-instance proceedings (yes) – admitted in first-instance (no)
Cited decisions:	T 1134/11
Case Law Book:	V.A.4.3.4 , V.A.4.3.6 , V.A.4.3.7 , 10 th edition

In [T 714/20](#) the appellant (applicant) had requested that a patent be granted on the basis of a main request or one of two auxiliary requests, all filed with the grounds of appeal. These requests corresponded respectively to the main request filed in advance of the oral proceedings before the examining division, but later replaced by the main request underlying the decision, to this latter main request, and to the first auxiliary request underlying the decision, all further amended in the same way to remedy the clarity objection noted in the decision in respect of the then main request.

This amendment used wording employed by the examining division itself when construing the claim. The board therefore considered this to be an appropriate response to the grounds for refusal and did not see it as an obstacle to admittance under Art. 12(4) RPBA 2020. The first auxiliary request (main request underlying the decision) was therefore admitted.

The main request, on the other hand, was based on a request not maintained at first instance. The board, referring to the statement in Art. 12(6) RPBA 2020 that "[t]he Board shall not admit requests ... which were no longer maintained, in the proceedings leading to the decision under appeal", observed that since the non-maintained request had been amended, this provision did not apply as such. However, in the board's view the principle expressed in the cited passage could be considered in the exercise of discretion to admit amendments under Art. 12(4) RPBA 2020.

Examining the appellant's arguments, the board pointed out, among other things, that it had been the appellant's choice not to re-file the current main request before the examining division. As a consequence, this request was not part of the decision under appeal and its admittance was therefore within the board's discretion.

Moreover, the board rejected the appellant's allegation that the new main request on appeal was merely filed to solve the clarity issue. It noted that the amendment which had been carried out as a response to the mentioned clarity objection was unrelated to the amendment carried out at first instance when the previous main request was replaced with the one underlying the appealed decision. Thus the board did not see any circumstances that would justify the admittance of this request (Art. 12(4) RPBA 2020, in view of Art. 12(6) RPBA 2020).

The second auxiliary request was based on the first auxiliary request underlying the decision under appeal, which was not admitted by the examining division pursuant to R. 116(2) EPC and R. 137(3) EPC. The board considered that, again, Art. 12(6) RPBA 2020 did not apply as such, but was of the opinion that the principle expressed in it, according to which "[t]he Board shall not admit requests ... which were not admitted in the proceedings leading to the decision under appeal, unless the decision not to admit them suffered from an error in the use of discretion", may be considered in the exercise of discretion to admit amendments under Art. 12(4) RPBA 2020.

The board observed that, in the case in hand, the second auxiliary request differed from the one not admitted by the examining division in a way (amendment for clarity) which was unrelated to the reasons given for non-admittance (late filing and divergence). The board was further of the opinion that the discretionary decision of the examining division not to admit the first auxiliary request underlying the decision was taken in a reasonable manner. It also did not see other circumstances that would justify the admittance in appeal of a new request based on it. Thus the second auxiliary request was not admitted (Art. 12(4) RPBA 2020, in view of Art. 12(6) RPBA 2020).

With regard to patentability of the first auxiliary request, the board concluded that, under a technically meaningful claim construction, claim 1 lacked novelty in view of D1 (Art. 54 EPC).

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Contact

Legal Research Service of the Boards of Appeal
Boards of Appeal of the European Patent Office
BOA_legalresearchservice@epo.org

