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Abstracts of decisions

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1. Article 084 EPC | T 0169/20 | Board 3.3.06

Article:	Article 084 EPC
Case Number:	T 0169/20
Board:	3.3.06
Date of decision:	2023.01.23
Language of the proceedings:	EN
Internal distribution code:	B
Inter partes/ex parte:	Inter partes
EPC Articles:	Articles 069(1), 084 EPC
EPC Rules:	Rules 042(1)(c), 043(1) and (6) EPC
RPBA:	
Other legal provisions:	Protocol on the Interpretation of Article 69 EPC
Keywords:	claims – claim interpretation – legal basis for claim interpretation – support by the description
Cited decisions:	G 0002/98, G 0003/14, T 0016/87, T 0311/93, T 0303/94, T 0523/00, T 1018/02, T 0056/04, T 1321/04, T 1408/04, T 0197/10, T 1646/12, T 1845/14, T 1844/15, T 2365/15, T 1127/16, T 1902/16, T 1473/19, T 0470/21
Case Law Book:	II.A.6.3. , II.A.6.3.2. , II.A.6.3.3. , II.A.6.3.4. , 10th edition

In [T 169/20](#) the board disagreed with the findings in T 16/87 and more recent decision T 1473/19 and considered that the provisions of Art. 69(1) EPC did not apply to the interpretation of the claims for the purpose of assessing patentability. The board held that the provisions in Art. 84 EPC and R. 42 and 43 EPC provided an adequate legal basis for claim interpretation when assessing the patentability of an invention. In particular, the requirement that the claims shall be "supported by the description" in Art. 84 EPC, 2nd sentence, provided a direct and unambiguous indication of the description's function as an aid for understanding the subject-matter of the claims.

According to the board, the wording of Art. 84 EPC, 2nd sentence, implicitly limits the support given by the description to interpreting the claims in exceptional cases where such support is both necessary and possible. If the wording of a claim is unclear for a person skilled in the art, the description could fulfil its supporting function by illustrating the meaning of the unclear feature/s. Conversely, when the wording of a claim is clear for the skilled person, the supporting role from the description is neither necessary nor justified. In particular, the support of the description should not be

used for restricting or modifying the subject-matter of the invention beyond what a person skilled in the art would understand when reading the wording of the claims within the relevant technical context. Moreover, if the invention according to the description is narrower or different from that in the claim, the supporting role of the description under Art. 84 EPC could not be fulfilled, since an interpretation on this basis would not represent an illustration of the subject-matter of the claim with the aid or support of the description but a restriction or modification of the scope of the invention. The board thus considered that the condition "supported by the description" in Art. 84 EPC provided a legal basis for determining how and when claims should be interpreted in the light of the description.

After reviewing the case law concerning claim interpretation, the board concluded that, despite the discrepancies regarding the relevant legal provisions to be applied for interpreting the claims, the established practices of the boards in deciding when and how the claims should be interpreted in the light of the specification were reasonably homogeneous. Hence, in a number of decisions the boards had concluded that the specification could be used to interpret ambiguous or unclear features or to confirm the most obvious interpretation of the claims. The specification had also been relied upon by the boards to determine the underlying technical context of the invention. On the other hand, there was also a broad consensus in the boards that the specification should not be used to read restrictive features not suggested by the wording of the claims, or to give a different meaning to a claim feature which in itself imparted a clear and credible technical teaching to the skilled reader. If a claim was ambiguous and could be interpreted in more than one technically reasonable way (none of them being more obvious or apparent than the rest), it would not be permissible to restrict its meaning in view of the description by discarding one of the technically reasonable interpretations.

The board also addressed the following expressions: "the patent is its own dictionary" and "the terms used in patent documents should be given their normal meaning in the relevant art, unless the description gives the term a special meaning". In the present board's view, the above expressions had been a major source of confusion in the debate on claim interpretation, as they seemed to indicate that it would be permissible to rely on the definition of a feature given in the description to modify its meaning in the claim, even if the claim wording was as such clear and technically reasonable and/or if the meaning assigned in the description deviated from the conventional meaning of the feature within the relevant technical context. Such an approach would not only be contrary to the legal framework proposed by the present board (as well as that based on Art. 69(1) EPC) but would also be at odds with the well-established principle of the primacy of the claims.

In the underlying case the board concluded that the wording of claim 1 of the main request was clear and technically meaningful taking into account the technical context of the invention presented in the description. Thus, there was no reason to interpret it in light of the description.

031-04-23

2. Article 116 EPC | T 2303/19 | Board 3.3.07

Article:	Article 116 EPC
Case Number:	T 2303/19
Board:	3.3.07
Date of decision:	2022.12.07
Language of the proceedings:	EN
Internal distribution code:	D
Inter partes/ex parte:	Inter partes
EPC Articles:	Article 116 EPC
EPC Rules:	
RPBA:	Article 15a RPBA 2020
Other legal provisions:	
Keywords:	oral proceedings – videoconference (no) – G 1/21 – in-person oral proceedings
Cited decisions:	G 0001/21
Case Law Book:	III.C.7.3. , 10th edition

In [T 2303/19](#) the parties were summoned to attend oral proceedings at the EPO premises. The appellant (patent proprietor) requested in its letter dated 3 November 2022 that the oral proceedings take place by videoconference (facilitating attendance of the appellant's in-house counsel and reducing the risk of any last-minute travel disruption due to uncertainty surrounding Covid-19 cases). The respondent did not consent to this request and suggested a mixed-mode format. In a communication dated 24 November 2022 the board informed the parties that it had decided to hold the oral proceedings in person. Oral proceedings took place at the EPO premises on 7 December 2022. At the beginning the Chair asked the parties whether they wished to comment on the format of the oral proceedings. The parties said that they did not.

The board agreed with the respondent that at the relevant time there were no Covid-19 related travel restrictions which would impair the parties' possibilities to attend in-person oral proceedings at the EPO premises, and that in-person oral proceedings were at that time the optimum format as expressed in decision G 1/21. The board also considered that the possible attendance of an accompanying person could not determine the format of the oral proceedings.

032-04-23

3. Article 116 EPC | T 1158/20 | Board 3.2.01

Article:	Article 116 EPC
Case Number:	T 1158/20
Board:	3.2.01
Date of decision:	2022.11.22
Language of the proceedings:	EN
Internal distribution code:	C
Inter partes/ex parte:	Inter partes
EPC Articles:	Article 116 EPC
EPC Rules:	
RPBA:	Article 15a RPBA 2020
Other legal provisions:	
Keywords:	oral proceedings – videoconference – lack of consent – Article 15a RPBA 2020 and G 1/21 – videoconference suitable and meanwhile equivalent alternative to in-person oral proceedings
Cited decisions:	G 0001/21, T 0996/20
Case Law Book:	III.C.7.3. , 10th edition

In [T 1158/20](#), the first point of the board's Catchword reads as follows: "Pursuant to Art. 15a(1) RPBA 2020 the boards have a discretionary power to hold oral proceedings by videoconference without the consent of all parties. When exercising this discretion, the board must primarily assess whether the case is suitable to be dealt with by videoconference and/or whether there are reasons that require holding oral proceedings in person. Such reasons may be seen in the complexity of the case or a need to inspect models."

In the case at issue, the oral proceedings were held by videoconference on 22 November 2022 with the consent of the respondent (patent proprietor). The appellant (opponent) had not consented to that format. The board decided of its own motion to hold oral proceedings by videoconference pursuant to Art. 15a(1) RPBA 2020. From the wording "if the board considers it appropriate" in this provision, it was evident that the board had discretion to decide whether to hold oral proceedings by videoconference. The provision does not explicitly set criteria to be applied when exercising this discretionary power. Nor does this provision require the consent of the parties. Before deciding the format of the oral proceedings, the board informed the parties it intended to hold the oral proceedings by videoconference in view of the increasing number of COVID-19 infections and because the case appeared suitable. The appellant disagreed.

The board stated that despite the appellant's allegation to the contrary, the COVID-19 pandemic was ongoing at that date; there were still restrictions in the premises of the boards in Haar. Videoconference avoided the risk that a participant on quite short notice be barred from attending. The absence of travel restrictions was not a clear indication that oral proceedings must be held in person. The board still had the discretion to decide on the format of the oral proceedings. The board took the view that it was not possible to objectively define a threshold for the number of infections (or for any other parameter). Contrary to the appellant's suggestion, it could not be expected of the respondent's representative to find a colleague of the same firm located in Munich when the representative located in London was available to participate by videoconference. As regards the argument that the same board in T 996/20 did not grant oral proceedings by videoconference in the absence of consent of all parties (held in person on 02 November 2022), such decision was a discretionary one. In response to the appellant's argument that filing further auxiliary requests during oral proceedings would not be possible during a videoconference, the board noted that were the patent proprietor to submit further auxiliary requests, this could be accommodated by email filing, using a dedicated email address, during the videoconference. In fact, none of the parties experienced problems using this procedure. Since all pieces of relevant prior art were printed documents available on EPO databases and no particular difficulties were apparent, such as particular complexities or models to be inspected during the oral proceedings, the board saw no reason why a videoconference was not suitable.

The board further saw no conflict with G 1/21 (points 47-50 of the Reasons). And irrespective of this, the board also considered whether videoconference could be considered an equivalent alternative to in-person (stated to be the gold standard in G 1/21, point 45 of the Reasons). Firstly, the scope of the referral was restricted and G 1/21 was issued when the boards had little experience with videoconferencing (see point 46 "at this point in time...not provide same level"). Since then, the situation had changed; boards and parties had gained extensive experience such that holding oral proceedings by videoconference was no longer as far from the gold standard as it was when decision G 1/21 was taken. In the board's view, nowadays videoconference was often equivalent to a hearing in person (see Catchword 2.). In conclusion even in view of G 1/21, videoconference was in this case not only suitable but also represented an equivalent alternative to in-person oral proceedings.

033-04-23

4. Article 116 EPC | T 1624/20 | Board 3.3.05

Article:	Article 116 EPC
Case Number:	T 1624/20
Board:	3.3.05
Date of decision:	2022.12.13
Language of the proceedings:	FR
Internal distribution code:	D
Inter partes/ex parte:	Inter partes
EPC Articles:	Articles 113(1), 116 EPC
EPC Rules:	Rule 106 EPC
RPBA:	Article 15a RPBA 2020
Other legal provisions:	
Keywords:	oral proceedings – videoconference – Article 15a RPBA 2020 and G 1/21 – change of format of oral proceedings without appellant’s consent – specific circumstances – opportunity to present comments (yes) – violation of the right to be heard (no)
Cited decisions:	G 0001/21, T 1499/16, T 0250/19
Case Law Book:	III.C.7.3. , III.B.2.6. , 10th edition

Dans l'affaire [T 1624/20](#), près de deux mois avant la procédure orale, la titulaire (intimée) a demandé que la procédure orale, initialement prévue en présentiel, soit transformée en visioconférence. Un mois avant la date de la procédure orale et au vu de la situation de la pandémie (COVID-19) à ce moment-là, la chambre a transformé la procédure orale en visioconférence qui a eu lieu le 13 décembre 2022.

La requérante formulant une objection au titre de la règle 106 CBE concluait à la violation de l'art. 113 CBE soutenant qu'elle n'avait pas consenti à ce format et qu'elle n'avait pas été invitée à présenter ses commentaires avant le changement de format.

Contestant le nouveau format, la requérante faisait notamment valoir la fin de l'état d'urgence lié au COVID-19, qu'imposer une visioconférence était en désaccord avec G 1/21, l'absence de déclaration officielle d'une agence gouvernementale, que l'art. 15bis RPCR 2020 ne pouvait pas être invoqué car il était dans le cas présent en contradiction avec G 1/21, qu'un mode hybride aurait mieux respecté les souhaits de chaque partie.

La chambre rappelle le libellé de l'art. 15bis et explique que dans le cas d'espèce la visioconférence n'est pas non plus en contradiction avec G 1/21. Conformément au

point 50 des motifs de G 1/21, il appartient à la chambre d'apprécier l'existence d'une situation d'urgence générale qui compromet la possibilité pour les parties de participer en présentiel. Des raisons ont été données qui peuvent justifier le rejet du présentiel (G 1/21, points 47 à 49). Premièrement, l'affaire ne doit pas être inadaptée à la visioconférence. La requérante n'a présenté aucune raison du caractère non approprié et la chambre sur la base de son expérience (affaire non excessivement complexe, deux parties) conclut que l'affaire s'y prête. Deuxièmement, il doit y avoir des circonstances propres à l'affaire justifiant de ne pas tenir la procédure orale en présentiel ; ces circonstances ne se limitent pas à des restrictions de voyage. La chambre constate que le taux d'incidence en Allemagne et en France, domiciles professionnels des mandataires, étaient en train de monter. Au vu de ce risque une situation d'urgence générale au sens de G 1/21 persistait.

Il y avait donc des circonstances spécifiques justifiant la décision de ne pas tenir la procédure orale en présentiel. Ainsi, la chambre a exercé son pouvoir d'appréciation pour protéger les parties et la chambre même sans le consentement de la requérante.

Plus particulièrement sur l'objection soulevée au titre de la règle 106 CBE, finalement rejetée par la chambre, la chambre citant T 250/19 énonce que la conformité de la visioconférence avec le droit d'une partie d'être entendue ne dépend pas de l'accord de cette partie mais uniquement du fait que cette partie a suffisamment eu la possibilité de prendre position et de présenter son cas. A l'issue de la procédure orale les parties ont confirmé n'avoir pas rencontré de problèmes techniques et la requérante ne s'est jamais plainte en cours de visioconférence d'une quelconque atteinte à sa faculté de prendre position ou de présenter son cas. La chambre était également d'avis que décider de changer le format en visioconférence sans donner à la requérante la possibilité de présenter ses commentaires au préalable n'a pas constitué une violation du droit d'être entendu. La chambre a noté qu'il y avait déjà eu un échange exhaustif d'arguments sur le format en amont de l'audience. De plus, la chambre avait aussi invité explicitement la requérante sur ce sujet en début de procédure orale. Enfin, la chambre a noté que la transformation du format en visioconférence n'était pas définitive ; si elle était arrivée à la conclusion, au vu des arguments en début de procédure orale, que la visioconférence n'était pas adaptée, elle aurait ajourné la procédure orale afin de la tenir ultérieurement en présentiel.

034-04-23

5. Article 117 EPC | T 1117/16 | Board 3.2.05

Article:	Article 117 EPC
Case Number:	T 1117/16
Board:	3.2.05
Date of decision:	2022.11.22
Language of the proceedings:	DE
Internal distribution code:	D
Inter partes/ex parte:	Inter partes
EPC Articles:	Articles 104(1), 117(1)(d), 117(2), EPC; Articles 125, 131(2) EPC 1973
EPC Rules:	Rules 120, 122, 150 EPC
RPBA:	
Other legal provisions:	
Keywords:	evidence – hearing witness before a national court – requested by opponent – first instance’s discretion – witness not compelled to testify – deposit of an advance payment – substantial procedural violation (no) – apportionment of costs
Cited decisions:	J 10/07
Case Law Book:	III.G.2.4.1e , 10th edition

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

In [T 1117/16](#) hatten die Zeugen des vormaligen Einsprechenden 2 während des Einspruchsverfahren auf die zweite Zeugenladung hin erklärt, nicht (mehr) zu einer Aussage bereit zu sein. Der Beschwerdeführer (Einsprechende 1) machte geltend, dass die Einspruchsabteilung einen schweren Verfahrensfehler begangen habe, indem sie entschied, die nunmehr vom Einsprechenden 1 (späterer Beschwerdeführer) als Beweis für die behaupteten offenkundigen Vorbenutzungen oV1 und oV2 angebotenen Zeugen nicht vor einem nationalen Gericht vernehmen zu lassen, obwohl diese Vorbenutzungen von ihr als relevant angesehen worden seien und die Zeugen vor dem zuständigen nationalen Gericht kein Zeugnisverweigerungsrecht gehabt hätten.

Die Kammer prüfte, ob ein wesentlicher Verfahrensfehler im erstinstanzlichen Verfahren vorlag. Dazu erläuterte sie, dass sich aus dem Wortlaut der R. 120 (1) Satz 2 EPÜ keine gesetzliche Verpflichtung für das EPA ergebe, das zuständige Gericht im Wohnsitzstaat eines Zeugen in Anwendung von Art. 131 (2) EPÜ 1973 zu ersuchen, diesen Zeugen zu vernehmen, sondern dass dies ausweislich des Wortlauts dieser Vorschrift im Ermessen des EPA liegt. Damit stehe den Organen der ersten Instanz im Grundsatz ein Beurteilungsspielraum im Einzelfall zu, der nach der Rechtsprechung nur sehr begrenzt der gerichtlichen Überprüfung zugänglich sei.

Die Kammer befand, dass die Einspruchsabteilung ihre Ermessensentscheidung ausreichend begründet hatte. Darüber hinaus sei keine der beiden in R. 120 (1) EPÜ genannten Voraussetzungen im vorliegenden Fall erfüllt gewesen, da keiner der geladenen Zeugen einen entsprechenden Antrag gestellt habe und alle Zeugen innerhalb der in der Zeugenladung gesetzten Frist reagiert hätten. Nach Auffassung der Kammer war daher die R. 120 (1) EPÜ im vorliegenden Fall nicht anwendbar. Der Beschwerdeführer argumentierte, dass R. 120 (1) EPÜ nicht so ausgelegt werden könne, dass Zeugen von einem nationalen Gericht zu vernehmen wären, wenn sie sich innerhalb der in der Ladung festgesetzten Frist nicht geäußert hätten, nicht aber, wenn sie sich weigerten, als Zeugen in einem Verfahren vor dem EPA auszusagen. Nach Auffassung der Kammer hingegen kann nach den Vorschriften des EPÜ niemand in den Verfahren vor dem Europäischen Patentamt zu einer Zeugenaussage gezwungen werden. Vor diesem Hintergrund sah die Kammer keinen Grund, R. 120 (1) EPÜ auf den vorliegenden Fall anzuwenden. Selbst wenn man der Ansicht wäre, dass R. 120 (1) EPÜ auch in diesem Fall entsprechend anwendbar wäre, so bestand auch insoweit keine grundsätzliche Verpflichtung seitens des Europäischen Patentamts, von dieser Möglichkeit Gebrauch zu machen. Die Frage, ob sich Zeugen auf ein nach Art. 125 EPÜ zu berücksichtigendes Aussage- oder Zeugnisverweigerungsrecht berufen könnten, stelle sich daher nicht. Die Erklärung der vom Beschwerdeführer angebotenen Zeugen, keine Aussage machen zu wollen, hätte laut der Kammer bei der Beweiswürdigung eine Rolle spielen können, nicht aber für die Frage, ob diese Zeugen vor dem jeweils zuständigen nationalen Gericht hätten vernommen werden müssen.

Nach Ansicht der Kammer ist bei der Frage einer Zeugenvernehmung vor dem zuständigen nationalen Gericht von Bedeutung, ob für diese Zeugenvernehmung ein Kostenvorschuss entrichtet wurde bzw. ob die betreffenden Zeugen eine Kostenverzichtserklärung abgegeben haben. Die Einspruchsabteilung hatte in ihrem zweiten Beweisbeschluss die Beweisaufnahme gemäß R. 122 (1) EPÜ von der Zahlung von Kostenvorschüssen bzw. der Einreichung von Kostenverzichtserklärungen bezüglich der zweiten Zeugenladung abhängig gemacht. Die Zeugen hatten aber auf die zweite Zeugenladung hin ausdrücklich erklärt, dass sie nicht auf eine Kostenerstattung und/oder Kostenvorschüsse verzichten würden, und der Beschwerdeführer war der Aufforderung einer Kostenvorschusszahlung ausdrücklich nicht nachgekommen. Daher hatte die Einspruchsabteilung nach dem EPÜ keine Verpflichtung, den Beschwerdeführer nochmals zu einer Zahlung von Kostenvorschüssen für den Fall einer Zeugenvernehmung vor dem zuständigen nationalen Gericht aufzufordern. Die Kammer hob diesbezüglich hervor, dass die Kostenverzichtserklärungen, die die Zeugen für die im Rahmen der ersten mündlichen Verhandlung terminierte Beweisaufnahme abgegeben hatten, für die im Rahmen der zweiten mündlichen Verhandlung terminierte Beweisaufnahme zu recht nicht berücksichtigt wurden. Zum Schluss konnte die Kammer nicht erkennen, worin genau der gerügte "schwere Verfahrensfehler" zu sehen sei, zumal die Ablehnung des vom Beschwerdeführer gestellten Antrags auf Vernehmung vor einem nationalen Gericht hinreichend begründet worden war.

Die Kammer war der Ansicht, dass die Anordnung einer anderen Kostenverteilung gemäß Art. 104 (1) EPÜ zugunsten des Beschwerdegegners nicht der Billigkeit entsprach und hob daher die Entscheidung über eine anderweitige Kostenverteilung auf.

035-04-23

6. Article 117 EPC | T 1708/18 | Board 3.3.04

Article:	Article 117 EPC
Case Number:	T 1708/18
Board:	3.3.04
Date of decision:	2022.02.14
Language of the proceedings:	EN
Internal distribution code:	D
Inter partes/ex parte:	Inter partes
EPC Articles:	Articles 054, 117 EPC
EPC Rules:	
RPBA:	
Other legal provisions:	
Keywords:	law of evidence – standard of proof – standard of disclosure for assessing novelty – distinction
Cited decisions:	T 0943/93, T 0464/94, T 0189/01, T 2101/09
Case Law Book:	III.G.4.3.1 , I.C.4.1. , 10th edition

In [T 1708/18](#), the argument of the patent proprietor (appellant I) in relation to novelty was that the correct standard for the assessment of novelty was "beyond reasonable doubt", i.e. it had to be beyond doubt, and not merely probable, that the claimed subject-matter was directly and unambiguously derivable from the prior art. The opponents' two-step assessment of novelty was not backed up by case law. The opponents submitted in that respect that novelty was a matter of two questions. An assessment had to be made both as to what matter was known in the art and how the properties of the known matter compared with the claimed subject-matter.

The opposition division had considered that the subject-matter of claim 5 was novel over the disclosure of each of the documents cited by the opponents, including D3, irrespective of the interpretation of the expression "binds specifically to". According to the opposition division, the opponents "did not show beyond doubt that one of the antibodies disclosed in documents D3, D5, D6, ... or D35 is able to bind the antigen ...". At least the commercially available antibodies could have been tested experimentally to demonstrate a specific binding.

The board disagreed with this assessment. The question of whether or not a given known antibody bound to a particular polypeptide was a question of fact. It was correct that the inherent binding property of the antibody concerned must be demonstrated by the party making the allegation, i.e., in the case at hand, the burden to prove that the antibody disclosed in document D3 bound to the PCSK9b and/or PCSK9c polypeptides laid with the opponents; however, the standard of proof

generally applied at the EPO for deciding on an issue of fact was the balance of probabilities. The board under point 2 of its Catchword wrote that: "The standard of proof generally applied at the EPO for deciding on an issue of fact is the balance of probabilities. According to this standard, the EPO must base its decisions on statements of fact which, based on the available evidence, are more likely than not to be true. This standard also applies when examining factual issues in the context of novelty."

The board was not persuaded by the arguments of the opposition division and the patent proprietor that, by way of exception, a higher standard must apply in the present case. In its reasoning, the opposition division appeared to mix up two issues which were distinct and unrelated. Indeed, under point 1 of its Catchword the board stated that: "the issue of which standard of disclosure applies when assessing the legal question of novelty and the issue of which standard of proof applies when assessing evidence and factual questions are distinct and unrelated. The fact that the standard of disclosure required for a finding of lack of novelty (or for allowing an amendment to the application under Article 123(2) EPC) is the standard of a direct and unambiguous disclosure is immaterial for the question of what standard of proof applies when considering evidence and factual issues in the context of novelty (or inventive step)."

The factual question to be decided upon in the present case was whether it was more likely than not that a known PCSK9 antibody would bind specifically to the PCSK9b and/or the PCSK9c polypeptide. In assessing this question, any evidence submitted by the parties was considered by the board and such evidence did not necessarily have to be in the form of "wet lab" experiments, as argued by the patent proprietor.

The board concluded that, based on the applicable standard of proof, the polyclonal antibody disclosed in document D3 also specifically bound to the PCSK9b and PCSK9c polypeptides comprising the same peptide.

The subject-matter of claim 5 in each of the claim requests on file therefore lacked novelty over the polyclonal antibodies disclosed in document D3.

036-04-23

7. Rule 139 EPC | T 1678/21 | Board 3.5.04

Article: Rule 139 EPC

Case Number:	T 1678/21
Board:	3.5.04
Date of decision:	2023.02.14
Language of the proceedings:	EN
Internal distribution code:	C
Inter partes/ex parte:	Ex parte
EPC Articles:	Article 108 EPC
EPC Rules:	Rules 06(4) and (5), 139 EPC
RPBA:	
Other legal provisions:	Articles 02(1), 05(1), 05(2), 07(2), 08 RFees, Arrangements for deposit accounts valid as from 1 October 2019, Commission Recommendation 2003/361/EC of 6 May 2003 (OJ EU L 124, p. 36 of 20 May 2003)
Keywords:	correction of error (yes) – payment of the reduced appeal fee using form 1038E – clear intention to pay the regular appeal fee (no) – correction of ADA debit order (yes) – appeal fee (paid)
Cited decisions:	G 0001/12, G 0001/18, J 0008/80, J 0010/87, J 0006/91, J 0003/01, J 0006/02, J 0019/03, J 0005/19, J 0001/20, T 0152/82, T 3023/18, T 0225/19, T 0317/19, T 1060/19, T 1474/19, T 3098/19, T 0333/20, T 0444/20, T 1146/20
Case Law Book:	III.U.2.2. , V.A.2.5.4c), 10th edition

In [T 1678/21](#) the appellant (applicant) had filed a notice of appeal within the time limit prescribed in Art. 108 EPC. The notice, filed on 6 September 2021, included instructions on Form 1038E to debit the reduced appeal fee. Moreover, the final sentence of the notice of appeal read as follows: "Any additional fees that may be required can be debited from our deposit account [xxx]". Following a communication from the board, the appellant identified that these instructions were erroneous as the regular appeal fee should have been paid. The appellant filed three requests to undo the consequences of this error, including a request for correction under R. 139 EPC.

The board referred to T 152/82, which it understood as holding that obvious errors in the amount of EPO fees in debit orders under the ADA need not be corrected if the intention to pay the correct amount was clear. Although not expressly mentioned in T 152/82, it was obvious to the present board that this intention had to be clear before expiry of the appeal period. According to the board, both T 152/82 and the summary of the

subsequent case law endorsing it given in T 1474/19 could be followed, but only under the condition that it was known to a board from the file as it stood at the end of the appeal period that the appellant, at the point in time of authorising the debit of the reduced appeal fee, was not entitled to the reduction of the appeal fee under R. 6(4) and (5). In the case in hand the board could not spot the appellant's failure to qualify as an SME from the file as it stood at the end of the appeal period. The board noted in its Catchword that from the company name of an appellant alone it could generally not be derived that the appellant did not meet the conditions of R. 6(4) and (5) in conjunction with the Commission Recommendation 2003/361/EC of 6 May 2003 for payment of the reduced appeal fee. This applied even if a company name was well known. In the absence of proof of the appellant's legal nature in the file at the end of the appeal period, its statements made with a view to paying the appeal fee, both in the notice of appeal and Form 1038E, could not be assessed as reflecting the clear intention to pay the regular appeal fee and thus, effectively, as payment of that fee pursuant to the principles of T 152/82.

In its Catchword, the board also stated that an appellant who gave a debit order for payment of the reduced appeal fee even though it clearly did not meet the conditions of R. 6(4) and (5) EPC committed an obvious mistake within the meaning of J 8/80 and G 1/12.

The board then turned to the appellant's request for correction under R. 139, first sentence, EPC and discussed a selection of decisions handed down since 1980 that set out general principles and specific criteria governing corrections under this provision. According to the board, the four criteria for assessing whether a request for correcting a document filed with the EPO pursuant to R. 139 EPC could be granted were "principles" (a) to (c) of G 1/12, i.e. essentially those of J 8/80, points 4 and 6:

- (a) the correction must introduce what was originally intended;
- (b) where the original intention is not immediately apparent, the requester bears the burden of proof, which must be a heavy one. The same applies, pursuant to J 8/80, point 6, where the making of the mistake is not self-evident; and
- (c) the error to be remedied may be an incorrect statement or an omission, complemented by criterion
- (d) balancing of the public interest in legal certainty with the interest of the party requesting correction, with the factors (i.e. sub-criteria of this criterion) relevant to the specific case.

As a rule, criteria (a) to (d) were to be assessed in the order (c), (a), if applicable, together with (b), and (d). The board concluded that all the criteria for correction applicable in this case had been met. Furthermore, when the erroneous instruction to debit the reduced appeal fee was given, there were sufficient funds in the deposit account for the regular appeal fee to be debited. Thus, payment of the regular fee was deemed to have been made retroactively on 6 September 2021.

037-04-23

8. Rule 142 EPC | J 0009/21 | Board 3.1.01

Article:	Rule 142 EPC
Case Number:	J 0009/21
Board:	3.1.01
Date of decision:	2022.11.23
Language of the proceedings:	EN
Internal distribution code:	D
Inter partes/ex parte:	Inter partes
EPC Articles:	Article 020(1) EPC
EPC Rules:	Rule 142(1)(b) EPC
RPBA:	
Other legal provisions:	Section 437D of the Australian Corporations Act
Keywords:	interruption of proceedings (yes) - patent proprietor prevented by legal reasons from continuing the proceedings (yes) – competence of the Legal Division to declare interruption of proceedings (yes)
Cited decisions:	J 0011/95, J 0018/12, J 0010/19, J 0014/19, T 0854/12, T 0054/17, T 1389/18
Case Law Book:	III.D.4.7 , 10th edition

In [J 9/21](#) the Legal Division had declared with its communication dated 26 July 2019 that the opposition proceedings had been interrupted as from 11 November 2016 (i.e. as from the day after the expiry of the opposition period) and that they would be resumed on 4 November 2019. After issuing a communication and holding oral proceedings, the Legal Division issued the decision on the interruption of the opposition proceedings on 9 July 2021. The opponent appealed.

During the aforementioned interruption period, the opposition division had revoked the European patent and the patent proprietor had filed an appeal against that decision (appeal number T 967/18). The appealed decision in J 9/21 was the decision of the Legal Division dated 9 July 2021.

The Legal Board of Appeal found that the Legal Division had the power to determine an interruption of the proceedings. On the question of whether the conditions of R. 142(1)(b) EPC had been fulfilled, the Legal Board noted that the mere fact that there was no bankruptcy judgment and that the former patent proprietor entered voluntarily into external administration under the Australian Corporations Act did not speak against the application of R. 142(1)(b) EPC. Once the external administrator

had been appointed, voluntarily or involuntarily, according to Section 437D of the Australian Corporations Act only the external administrator could deal with a company's property. As the disputed patent was part of the former patent proprietor's company property at the relevant point in time, the former patent proprietor was indeed "prevented by legal reasons from continuing the proceedings". Thus, the conditions for an interruption under R. 142(1)(b) EPC were fulfilled.

According to the Legal Board, the mere fact that an applicant or patent proprietor continued proceedings before the EPO did not allow any conclusions to be drawn as to whether they were legally prevented from doing so. The interruption of proceedings under R. 142(1)(b) EPC by force of law rather ensured that acts undertaken by applicants or patent proprietors which continued the proceedings even though they were not legally allowed to do so were invalid and therefore could not be detrimental to the legitimate interests of third parties. The Legal Board in the present case did not understand J 11/95, cited by the appellant, as relying merely on the factual continuation of the proceedings by the applicant to arrive at the conclusion that the applicant was legally not prevented from doing so. Rather, it seemed that the board in J 11/95 was of the opinion that, in view of the evidence provided, national bankruptcy in that specific case had not legally prevented the company concerned from continuing the proceedings before the EPO.

In relation to the appellant's request to set aside the decision under appeal, or, alternatively, to set 21 February 2017 as the new date of resumption of proceedings, the Legal Board noted that allowing the appellant's requests would require the interruption to be set aside with retroactive effect. According to the case law, this would not be possible even if the declaration of interruption was erroneous. Following this case law, the appellant's main and auxiliary requests could not be allowed for that reason alone. The Legal Board recalled that the reasons invoked in the case law included that otherwise time limits which had been declared by the Legal Division to be interrupted could, from the parties' perspectives, be shortened or expire retroactively. Furthermore, the public had legitimate expectations that the dates of interruption and resumption entered into the European Patent Register were correct.

Moreover, according to the Legal Board, the Legal Division was not barred from issuing a communication on the interruption of the proceedings without hearing the parties beforehand as a matter of principle. However, if it did not hear the parties beforehand, it had to hear them afterwards. Having heard the parties, the Legal Division had to be open to arrive at a conclusion deviating from its initial assessment. According to the case law, it may be that procedural acts which were carried out during the period for which the interruption was declared had to be repeated even if the Legal Division itself, after having heard the parties, considered its previous declaration of interruption erroneous. The Legal Board noted that in some cases, particularly if entire opposition proceedings had been conducted during the relevant period, the expected legal consequences of the interruption may indeed require the Legal Division to hear the parties before issuing a declaration of interruption.

038-04-23

9. Article 13(1) RPBA 2020 | T 1117/16 | Board 3.2.05

Article:	Article 13(1) RPBA 2020
Case Number:	T 1117/16
Board:	3.2.05
Date of decision:	2022.11.22
Language of the proceedings:	DE
Internal distribution code:	D
Inter partes/ex parte:	Inter partes
EPC Articles:	Article 117(1) EPC
EPC Rules:	
RPBA:	Articles 12(2), 13(1) RPBA 2020
Other legal provisions:	
Keywords:	amendment to appeal case – exercise of discretion – amendment overcomes issues raised (no) – amendment detrimental to procedural economy (yes) – alleged public prior use
Cited decisions:	G0009/91, G 0010/91, T 0129/88, T 0691/12
Case Law Book:	V.A.4.4.6 , 10th edition

[See also abstract under Article 117 EPC.](#)

In [T 1117/16](#) wurde die behauptete offenkundige Vorbenutzung oV3 erstmals nach dem Einreichen der Beschwerdebeurteilung und vor der Zustellung der Ladung zur mündlichen Verhandlung geltend gemacht. Der Beschwerdeführer (Einsprechender 1) begründete das späte Vorbringen damit, dass er von dieser Vorbenutzung oV3, an der er nicht beteiligt gewesen sei, erst einige Monate zuvor Kenntnis erlangt habe, indem er von Dritten darauf aufmerksam gemacht worden sei, und dass er deshalb diese Vorbenutzung nicht früher in das Verfahren habe einführen können.

Die Kammer sah aber in den vom Beschwerdeführer angegebenen Gründen keine Rechtfertigung für das erstmalige Vorbringen der Vorbenutzung oV3 nach Einreichung der Beschwerdebeurteilung. Sie rief mit Verweis auf die zur VOBK 2007 ergangene Rechtsprechung in Erinnerung, dass in Anbetracht des vorrangigen Ziels des Beschwerdeverfahrens, das nun in Art. 12 (2) VOBK 2020 verankert ist, der faktische und rechtliche Rahmen des Einspruchsverfahrens weitestgehend für das nachfolgende Beschwerdeverfahren bestimmend ist. Damit sind den Beteiligten in ihrer Verfahrensführung gewisse Grenzen gesetzt, die sich im zweiseitigen Verfahren namentlich aus dem Prinzip der Fairness gegenüber den anderen Beteiligten sowie generell aus den Anforderungen an ein ordnungsgemäßes Verfahren ergeben.

Insbesondere sind die Beteiligten im zweiseitigen Verfahren auch zur sorgfältigen und beförderlichen Verfahrensführung verpflichtet. Dazu gehört es, alle relevanten Tatsachen, Beweismittel, Argumente und Anträge so früh und vollständig wie möglich vorzulegen. Die Kammer hob hervor, dass ein Einsprechender keinen Rechtsanspruch darauf hat, dass neues Vorbringen im Beschwerdeverfahren zugelassen wird. Die Zulassung von neuem Vorbringen hänge von der Erfüllung bestimmter Voraussetzungen ab und liege im Ermessen der Kammer. Diese Grundsätze spiegelten sich auch in Art. 13 (1) VOBK 2020 nieder.

Die Kammer sah es als unerheblich an, ob der Beschwerdeführer von der behaupteten offenkundigen Vorbenutzung tatsächlich erst einige Monate nach Einreichung der Beschwerdebegründung Kenntnis erlangt hatte. Sie betonte, dass die Suche nach möglichen Entgegnungen in den Verantwortungsbereich des Einsprechenden fällt. Die Tatsache, dass dieser einen Stand der Technik nicht rechtzeitig entdeckte, rechtfertige nicht, das Gebot der Verfahrensökonomie oder das Prinzip der Fairness gegenüber anderen Beteiligten zu missachten. Die spät erlangte Kenntnis von der angeblichen offenkundigen Vorbenutzung dürfe also dem Beschwerdegegner nicht zum Nachteil gereichen.

In Bezug auf die in Art. 13 (1) Satz 4 VOBK 2020 genannten Kriterien für die Ermessensausübung vermochte die Kammer ferner nicht zu erkennen, inwiefern die Änderung des Vorbringens des Beschwerdeführers zur Lösung von Fragen, die der Beschwerdegegner in zulässiger Weise aufgeworfen hatte, geeignet sein sollten. Vielmehr stelle dieses geänderte Vorbringen einen ganz neuen Angriff gegen das Streitpatent dar, der nicht durch das Vorbringen des Beschwerdegegners veranlasst worden war.

Zudem wäre die Zulassung der Änderung der Verfahrensökonomie abträglich gewesen, da die eingereichten Unterlagen nach Auffassung der Kammer die behauptete Vorbenutzung prima facie nicht lückenlos belegen konnten. Insoweit ließ die Kammer offen, ob es sich bei den eingereichten Erklärungen um eidesstattliche Versicherungen handelte, was allenfalls für deren Beweiskraft von Belang sein könnte, da jedenfalls keine Verkaufsbelege oder Beweisstücke für die Lieferung des angeblich vorbenutzten Produktes vorgelegt oder angeboten wurden. Es wären deshalb weitere Ermittlungen und Nachweise erforderlich gewesen, welche dem Gebot einer fairen, zügigen Verfahrensführung zuwidergelaufen wären. Darüber hinaus war die behauptete offenkundige Vorbenutzung, selbst wenn bewiesen, prima facie nicht relevanter als der druckschriftliche Stand der Technik.

Die behauptete Vorbenutzung wurde aus diesen Gründen nicht zum Verfahren zugelassen. Nach Ansicht der Kammer konnte dahingestellt bleiben, ob das Verhalten des Beschwerdeführers bezüglich des verspäteten Vorbringens als verfahrensmisbräuchlich anzusehen war.

039-04-23

10. Article 13(2) RPBA 2020 | T 2866/18 | Board 3.2.03

Article: Article 13(2) RPBA 2020

Case Number:	T 2866/18
Board:	3.2.03
Date of decision:	2022.10.04
Language of the proceedings:	EN
Internal distribution code:	D
Inter partes/ex parte:	Inter partes
EPC Articles:	
EPC Rules:	
RPBA:	Article 13(2) RPBA 2020
Other legal provisions:	
Keywords:	amendment after summons – new inventive step objection – taken into account (no) – exceptional circumstances (no) – prima facie relevance (no)
Cited decisions:	J 0014/19, T 0184/17, T 0574/17, T 1179/17, T 1816/17, T 2360/17, T 1042/18, T 2161/18, T 2920/18, T 0151/19
Case Law Book:	V.A.4.2.2a), V.A.4.2.2I), V.A.4.5.8i), 10th edition

In the case underlying [T 2866/18](#) the opponent had raised lack of novelty objections against claim 1 of the main request on the basis of documents D10 to D13 as well as an inventive step objection starting from D13. In the decision under appeal, the opposition division had considered claim 1 of the main request to lack novelty over D10 and D11. In its reply to the statement of grounds of appeal of the patent proprietor, the opponent did not raise any inventive step objections against the main request, but simply announced that it would comment on inventive step during the oral proceedings before the board if the board did not accept its view on novelty regarding claim 1. At the oral proceedings, the board confirmed its preliminary opinion outlined in its communication under Art. 15(1) RPBA 2020 and concluded that the subject-matter of claim 1 was novel over D10 and D11. Subsequently, for the first time in the proceedings before the departments of both instances, the opponent raised inventive step objections starting from either document D10 or D11 in combination with any of documents D2, D5, D6 or D13.

The board noted that, since the opponent's inventive step objections were not contained in its reply to the statement of grounds of appeal, raising them for the first time at the oral proceedings before the board constituted an amendment to the opponent's appeal case under Art. 13(2) RPBA 2020 (see J 14/19), the admittance of which was subject to the board's discretion. Whether or not these objections stayed

within the same overall "factual and legal framework" was not decisive for the purpose of determining what constituted an amendment of the appeal case under the RPBA 2020 (see T 2360/17). It could, however, play a role in the board's exercise of discretion under Art. 13(2) RPBA 2020 (see T 574/17 and T 2920/18).

The board further observed that the question of whether there had been an amendment to a party's appeal case under the RPBA 2020 had to be distinguished from the question of whether a fresh ground of opposition had been raised. Whether the documents taken as starting points for new inventive step objections were previously used for objections regarding a lack of novelty had no bearing for determining whether these inventive step objections constituted an amendment to the opponent's appeal case under Art. 13(2) RPBA 2020 (see T 1042/18; see also T 1179/17, T 1816/17, T 2161/18 and T 151/19). The board further noted that, in any case, combining D10 or D11 with new documents went beyond the "factual and evidentiary framework" of the previous novelty objections within the meaning of T 184/17.

The opponent put forward that its inventive step objections raised at the oral proceedings were prima facie relevant. The board considered it appropriate in the present case to conduct such a prima facie assessment, although this was not a necessary precondition in order to come to the conclusion that there were no exceptional circumstances under Art. 13(2) RPBA 2020 (see T 574/17). The board concluded that none of the inventive step objections were prima facie relevant and consequently did not admit them into the proceedings pursuant to Art. 13(2) RPBA 2020.

040-04-23



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