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Abstracts of decisions

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1. Article 056 EPC | G 0002/21 | EBA

Article:	Article 056 EPC
Case Number:	G 0002/21
Board:	EBA
Date of decision:	2023.03.23
Language of the proceedings:	EN
Internal distribution code:	A
Inter partes/ex parte:	Inter partes
EPC Articles:	Articles 052(1), 056, 083, 100, 101(2), 112(1)(a), 112(2), 113(1), 117(1), 125 EPC
EPC Rules:	Rules 004, 150 EPC
RPBA:	
Other legal provisions:	
Keywords:	point of law of fundamental importance – uniform application of law – post-published evidence – rephrase referred questions (no) – extend scope of referred questions (no) – exception to principle of free evaluation of evidence (no) – inventive step, reliance on technical effect (yes, based on the application as originally filed) – sufficiency of disclosure (obiter dictum)
Cited decisions:	G 0003/97, G 0004/97, T 0482/89, T 0838/92, T 0609/02, T 0893/02, T 1110/03, T 0474/04, T 1329/04, T 0545/08, T 1545/08, T 0419/12, T 0919/15, T 0184/16, T 0031/18, T 0116/18
Case Law Book:	I.D.4.3.3 , II.C.7.2. , III.G.4.1. , 10th edition

In [G 2/21](#) the points of law referred to the Enlarged Board addressed two issues: whether the principle of free evaluation of evidence required a qualification in respect of certain evidence relied upon for a purported technical effect in the assessment of inventive step, and the relevant criteria to be applied with regard to such a technical effect (which the referring board in T 116/18 referred to as "ab initio plausibility", "ab initio implausibility" and "no plausibility").

The EBA found the principle of free evaluation of evidence could be defined in abstract and general terms as allowing and, by the same token, requiring a judicial body, like the boards of appeal, to decide according to its own discretion and its own conviction, by taking account of the entire content of the parties' submissions and, where appropriate, any evidence admissibly submitted or taken, without observing formal rules, whether a contested factual assertion is to be regarded as true or false. The only decisive factor

was whether the judge was personally convinced of the truth of the factual allegation, which must be assessed on a case-by-case basis.

The principle of free evaluation of evidence qualified as a universally applicable principle in assessing any means of evidence by a board of appeal. This was enshrined in the right of each party to proceedings under the EPC to give evidence in appropriate form pursuant to Art. 113(1) and 117(1) EPC. This principle was also known and applied in various EPC Contracting States with a civil law system.

Notwithstanding the specific drafting of the referred questions, the EBA turned to referred questions two and three of the referral. It concluded that the term "plausibility" found in the case law of the boards of appeal and relied upon by the referring board in questions 2 and 3 of the referral, did not amount to a distinctive legal concept or a specific patent law requirement under the EPC, in particular under Art. 56 and 83 EPC. It held that the relevant standard for the reliance on a purported technical effect when assessing whether or not the claimed subject-matter involved an inventive step concerned the question of what the skilled person, with the common general knowledge in mind, would understand at the filing date from the application as originally filed as the technical teaching of the claimed invention. The technical effect relied upon, even at a later stage, needed to be encompassed by that technical teaching and to embody the same invention.

The EBA stated that irrespective of the actual circumstances of a particular case, the guiding principles set out above should allow the competent board of appeal or other deciding body to take a decision on whether or not post-published evidence may or may not be relied upon in support of an asserted technical effect when assessing whether or not the claimed subject-matter involved an inventive step.

For these reasons the EBA answered the referred questions of law as follows:

1. Evidence submitted by a patent applicant or proprietor to prove a technical effect relied upon for acknowledgement of inventive step of the claimed subject-matter may not be disregarded solely on the ground that such evidence, on which the effect rests, had not been public before the filing date of the patent in suit and was filed after that date.
2. A patent applicant or proprietor may rely upon a technical effect for inventive step if the skilled person, having the common general knowledge in mind, and based on the application as originally filed, would derive said effect as being encompassed by the technical teaching and embodied by the same originally disclosed invention.

The scope of the point of law defined by the referred questions and the reasons for the referring decision did not allow for or require that the referred questions be re-phrased by adding a reference to the issue of sufficiency of disclosure and Art. 83 EPC. In obiter dictum, however, the EBA observed that the notion of "plausibility" had been used in particular concerning second medical use and summarised examples of decisions in line with T 609/02. The scope of reliance on post published evidence was much narrower under sufficiency of disclosure. For the disclosure of the invention to be sufficiently clear and complete for it to be carried out by the person skilled in the art, the proof of a claimed therapeutic effect had to be provided in the application as filed.

041-05-23

2. Article 056 EPC | T 1158/17 | Board 3.5.01

Article: Article 056 EPC

Case Number: T 1158/17

Board: 3.5.01

Date of decision: 2022.12.12

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 – technical contribution – routing an electronic message and ensuring its integrity – no mere automation of an administrative scheme

Cited decisions: T 1082/13

Case Law Book: [I.D.9.2.11.h](#), 10th edition

In [T 1158/17](#) the invention concerned a system for secure delivery of business mailings, for example contracts or invoices. The board was not convinced by the contested decision's finding that the claimed components were not technical because they modelled the roles of humans interacting within the framework of the administrative postal scheme. The board considered that a similarity to a business or administrative solution was not a sufficient reason for denying a technical contribution of a claim feature applied in a technical context and involving technical considerations. Put another way, technical considerations in the technical context could not be negated merely on the basis of a non-technical analogy.

The board disagreed with the contested decision, according to which at the high level of abstraction at which they were claimed and disclosed in the application, the claimed components modelled the roles of groups of persons interacting within the framework of the administrative postal scheme. The board illustrated the insufficiency of such reasoning by looking at the following example. The analogy to a post office, essentially invoked by the contested decision, is used in technical literature in order to describe functionality of the transport layer (layer 4) of the OSI model. However, in the board's view, it would not be sound to assert, only based on this analogy, that communication protocols implementing this layer's functionality lack technical character.

042-05-23

3. Article 056 EPC | T 0814/19 | Board 3.3.07

Article: Article 056 EPC

Case Number: T 0814/19

Board: 3.3.07

Date of decision: 2022.10.19

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: Inventive step – non-obvious solution – broad claims

Cited decisions:

Case Law Book: [I.D.9.9.3](#), 10th edition

In [T 814/19](#) the objective technical problem was found the provision of an olaparib formulation suitable as a pharmaceutical dosage form for administration to patients.

The appellant (opponent) contested that this problem was solved across the whole breadth of claim 1 because the claim was drafted too broadly; claim 1 did not define any amounts or weight ratios of olaparib and the matrix polymer, so the claim would encompass formulations with high drug loadings that would not exhibit the required stability and bioavailability for administration to patients.

The board disagreed. It was not disputed that the higher the drug loading, the more likely crystallisation was to occur. Crystallisation would reduce bioavailability to some extent, but some degree of crystallisation did not make the formulation necessarily unsuitable for administration to patients. Furthermore, the skilled person could not be expected to work within unreasonable ranges of drug loadings that would result in a massively oversaturated product that would no longer qualify as a solid dispersion. Therefore, the board considered that the formulations proposed in claim 1 were a suitable solution to the objective technical problem.

On the issue of obviousness, the appellant cited documents D2 and D3 as prior art to be combined with D5. The board agrees with the respondent (patent-proprietor) that this combination of documents could only be made with hindsight.

The board found that gathering the knowledge presented in the patent for the first time required a considerable amount of research and could in no way be derived

from D5 (closest prior art). The fact that this research belonged to the common methodology for developing drugs did not render its results obvious. The essential point was that, on the filing date of the patent, the skilled person did not know that olaparib was particularly difficult to formulate because it required high drug loadings and presented bioavailability and stability issues. Therefore, the skilled person would have formulated olaparib in any of the conventional formulations suggested on pages 18 and 19 of D5, rather than as a solid dispersion. They had no motivation to turn to D2 or D3, which were concerned with the issue of improving the bioavailability of sparingly soluble drugs.

Concluding, the board found that the skilled person would therefore not have arrived at the solid dispersion of claim 1 without the knowledge made available in the patent. The subject-matter of the main request involves an inventive step, as required by Art. 56 EPC.

043-05-23

4. Article 084 EPC | T 2685/19 | Board 3.5.02

Article: Article 084 EPC

Case Number:	T 2685/19
Board:	3.5.02
Date of decision:	2022.10.12
Language of the proceedings:	DE
Internal distribution code:	D
Inter partes/ex parte:	Ex parte
EPC Articles:	Article 084 EPC
EPC Rules:	
RPBA:	
Other legal provisions:	
Keywords:	claims – support in the description (no) – adaptation of the description
Cited decisions:	T 1024/18, T 1989/18, T 2293/18, T 1516/20
Case Law Book:	II.A.5.3. , 10th edition

In [T 2685/19](#) nahm der Patentinhaber in der Beschreibung des Hilfsantrags III_{bis} im Vergleich zu der der angefochtenen Einspruchsentscheidung zugrundeliegenden Fassung der Beschreibung mehrere Änderungen vor:

- die Ersetzung von "In nicht beanspruchten Ausführungsformen kann vorgesehen sein, dass" durch "Es ist vorteilhaft",
- die Streichung von "nicht beanspruchte(n)", sowie
- die Streichung der Einfügung "Wobei lediglich in Figur 5 eine erfindungsgemäße Ausführungsform dargestellt ist".

Die Kammer befand, dass der Hilfsantrag III_{bis} nicht die Erfordernisse des Art. 84 Satz 2 EPÜ erfüllt. Sie folgte insoweit nicht der vom Beschwerdeführer (Patentinhaber) zitierten Entscheidung T 1989/18, wonach, falls die Ansprüche kein Klarheitsproblem aufweisen, die Beschreibung keinen Anlass für eine Unklarheit des beanspruchten Gegenstandes bieten könne. Die Kammer gab an, dass sie sich vielmehr der ständigen Rechtsprechung der Beschwerdekammern anschließt, wie sie auch jüngst in den Entscheidungen T 1516/20, T 1024/18 sowie T 2293/18 bestätigt wurde. In den genannten Entscheidungen werde sehr deutlich und überzeugend aufgezeigt, dass das Kriterium der Stützung der Ansprüche durch die Beschreibung in Art. 84 Satz 2 EPÜ ein eigenständiges Kriterium ist, das nicht der Klarheit der Ansprüche unterzuordnen ist.

Die Beschreibung sei daher gemäß ständiger Rechtsprechung der Beschwerdekammern an geänderte Ansprüche anzupassen. Dies bedeute unter anderem, dass nicht mehr unter den geänderten Anspruchswortlaut fallende Ausführungsformen in der Beschreibung als solche zu kennzeichnen seien.

Da die mit dem Hilfsantrag III^{bis} vorgelegte Beschreibung nicht klarstellte, dass die beanspruchte Erfindung lediglich die dem Gegenstand der Ansprüche entsprechende Ausführungsform betraf, bestand ein Widerspruch zwischen den Ansprüchen und der Beschreibung, aufgrund dessen die Ansprüche, entgegen dem Erfordernis des Art. 84 Satz 2 EPÜ, nicht durch die Beschreibung gestützt waren.

044-05-23

5. Article 104(1) EPC | T 0561/19 | Board 3.3.10

Article:	Article 104(1) EPC
Case Number:	T 0561/19
Board:	3.3.10
Date of decision:	2022.11.08
Language of the proceedings:	EN
Internal distribution code:	D
Inter partes/ex parte:	Inter partes
EPC Articles:	Article 104(1) EPC
EPC Rules:	
RPBA:	
Other legal provisions:	
Keywords:	apportionment of costs (yes) – second oral proceedings in opposition
Cited decisions:	T 0336/86, T 0028/91, T 1016/93, T 1771/08
Case Law Book:	III.R.2.1.1a), III.R.2.2.2 , 10th edition

In [T 561/19](#) the board confirmed the opposition division's decision to award a different apportionment of costs pursuant to Art. 104(1) EPC.

At the first oral proceedings before the opposition division, the appellant (opponent) had filed experimental evidence (D15), which was allegedly very relevant for the issue of sufficiency of disclosure. The opposition division admitted D15 into the proceedings before adjourning the oral proceedings. In its decision, the opposition division ordered that the costs incurred as a result of the second oral proceedings had to be borne by the appellant.

The appellant argued that a different apportionment of costs could not be granted merely because a further oral proceedings was needed. Only a party that had been negligent or willing to harm the other should bear the other party's costs. There was no negligence or will to harm with the filing of D15.

The board held, however, that negligence, will to harm or abuse of procedure was not a prerequisite for a different apportionment of costs. It sufficed that there was no good justification for the late filing and that the late filing was the cause of both the adjournment of the oral proceedings and extra costs for the other party. If a party chose to file evidence so extremely late, the risk was that said evidence would not be admitted into the proceedings or that, if the evidence was admitted, the party would have to bear costs incurred as a result by the other party.

In the present case, it was not disputed that the oral proceedings had been adjourned solely due to the filing and admission of D15 during the first oral proceedings. The appellant provided no good reason for filing this evidence at that point in time. Hence, the board concluded that the additional costs caused by the adjournment had to be borne by the party causing it, so the opposition division's decision in this respect was correct.

045-05-23

6. Article 113(1) EPC | T 1456/22 | Board 3.4.01

Article:	Article 113(1) EPC
Case Number:	T 1456/22
Board:	3.4.01
Date of decision:	2023.03.13
Language of the proceedings:	EN
Internal distribution code:	D
Inter partes/ex parte:	Ex parte
EPC Articles:	Article 113(1) EPC
EPC Rules:	Rule 011(3) EPC
RPBA:	
Other legal provisions:	
Keywords:	right to be heard – violation of the right to be heard (yes) – substantial procedural violation (yes) – formalities officer acted beyond its powers (yes) – higher-ranking request to defer grant overlooked
Cited decisions:	
Case Law Book:	III.B.2.4.2 , III.K.3.1. , V.A.2.2.2 , 10th edition

In [T 1456/22](#) the appeal was against the decision of the examining division to grant the patent. The applicant had requested the postponement of the examining division's decision to grant, as it wished to wait until the Unitary Patent system was in effect. The applicant had also requested that, only if the deferment request was refused, the patent be granted anyway. The formalities officer of the examining division had responded to the applicant's request in a letter dated 28 October 2021. This letter stated that the request for postponement had been rejected because there was no certainty as regards the start date of the Unitary Patent system. A few days later, the examining division issued its decision to grant the patent. In its decision, the examining division made no reference to the applicant's request to defer grant.

According to the board, the communication of the formalities officer dated 28 October 2021 set out why the request for delay could not be allowed. It was not a decision, but nevertheless, in sending it, the formalities officer had acted beyond the powers entrusted under R. 11(3) EPC. A communication of this nature should have been sent by the examining division itself, setting a clear date for the applicant to respond. The fact that the decision to grant overlooked the higher-ranking request for deferment was a further procedural violation, namely a further breach of the applicant's right to be heard under Art. 113(1) EPC.

The decision under appeal was set aside and the case remitted to the examining division for further prosecution.

046-05-23

7. Article 116 EPC | T 1041/21 | Board 3.2.04

Article:	Article 116 EPC
Case Number:	T 1041/21
Board:	3.2.04
Date of decision:	2023.02.10
Language of the proceedings:	DE
Internal distribution code:	C
Inter partes/ex parte:	Inter partes
EPC Articles:	Articles 111(1), 112(1)a), 116(1), (4) EPC
EPC Rules:	Article 15a RPBA 2020
RPBA:	
Other legal provisions:	
Keywords:	oral proceedings – videoconference without consent – opposition proceedings – application of considerations set out in G 1/21 – referral to the Enlarged Board (no)
Cited decisions:	G 0001/21
Case Law Book:	III.C.7.3 , 10th edition

[See also abstract under Article 12\(5\) RPBA 2020.](#)

In [T 1041/21](#) hatte die Einspruchsabteilung einen Antrag beider Parteien auf Verlegung der mündlichen Verhandlung, die als Videokonferenz anberaumt war, abgelehnt. Auf die Anträge auf Befassung der großen Beschwerdekammer mit verschiedenen Rechtsfragen zur Durchführung der mündlichen Verhandlung vor der Einspruchsabteilung als Videokonferenz ohne Zustimmung der Parteien hin, stellte die Kammer fest, die Einschränkung in G 1/21 auf Beschwerdekammern sei nicht aus sachlichen Gründen erfolgt, also etwa weil an mündliche Verhandlungen vor Einspruchsabteilungen andere oder strengere Maßstäbe anzulegen wären, sondern weil darüber hinaus in dem damals vorgelegten Fall, in dem eine Beschwerdekammer zur mündliche Verhandlung in Form einer Videokonferenz geladen hatte, kein weiterer konkreter Klärungsbedarf bestanden habe. Die Kammer sah sich deshalb nicht daran gehindert, grundsätzliche Erwägungen der G 1/21 auch im vorliegenden Fall anzuwenden.

Danach sind mündliche Verhandlungen in Form einer Videokonferenz mündliche Verhandlungen im Sinne des Art. 116 EPC. Jedoch kann einer Partei der Wunsch nach einer Präsenzverhandlung nur dann versagt werden, wenn besondere Umstände vorliegen, die die persönliche Anwesenheit der Parteien behindern oder unmöglich machen. Die Reisebeschränkungen während der Covid-19-Pandemie

zählten zu solchen Umständen, die andernfalls eine nicht hinnehmbare Verzögerung in der Entscheidungsfindung und Rechtsprechung nach sich gezogen hätten.

Im vorliegenden Fall war bereits einmal ein (für den 24. Juni 2020) anberaumter Verhandlungstermin aufgehoben und (auf den 27. Januar 2021) verschoben worden, bevor dann der zweite Termin von einer Präsenzverhandlung in eine Videokonferenz umgewandelt wurde. In diesem Zeitraum galten in der Bundesrepublik Kontakt- und Reisebeschränkungen aufgrund der anhaltenden Covid-19-Pandemie. Die Kammer stellte fest, dass diese objektiven Umstände die Durchführung mündlicher Präsenz-Verhandlungen aller Art gleichermaßen beeinträchtigten. Darüber hinaus konnte sie keine Gründe erkennen, die für eine größere Akzeptanz von Verfahrensverzögerungen oder eine geringere Eignung einer Videokonferenz zur Durchführung einer mündlichen Verhandlung im Einspruchsverfahren im Vergleich zum Beschwerdeverfahren sprechen würden. Das Argument des Beschwerdegegners, das Beschwerdeverfahren diene mehr der rechtlichen Überprüfung und erfordere von vornherein weniger Sachverhaltsermittlungen als das Verfahren vor Prüfungs- und Einspruchsabteilungen, überzeugte die Kammer nicht. Daher lagen nach Ansicht der Kammer auch im vorliegenden Fall, die in G 1/21 definierten grundsätzlichen Voraussetzungen dafür vor, eine mündliche Verhandlung als Videokonferenz ohne Zustimmung der Parteien hierfür durchzuführen.

Die generelle Frage, ob die Begründung der Entscheidung G 1/21 auf die Situation, in der kein allgemeiner Notstand vorliegt, übertragbar ist, war nicht entscheidungserheblich und brauchte von der Kammer nicht beantwortet zu werden.

Bezüglich des Erfordernisses einer erneuten Ladung unter Einhaltung einer zweimonatigen Frist beim Übergang von einer Präsenzveranstaltung zu einer Videokonferenz verwies die Kammer auf das Fehlen einer ausdrücklichen Regelung für einen Ortswechsel in den Richtlinien. Zudem war es für die Kammer nicht ersichtlich, dass eine Umwandlung einer Präsenzverhandlung in eine Videokonferenz im Hinblick auf Planbarkeit und Organisation eine erneute zweimonatige Ladungsfrist erforderlich machen würde.

Die Kammer kam auch zu dem Schluss, dass ein Fehler im Verhandlungskalender des EPA keinen Verstoß gegen Art. 116(4) EPÜ darstellte.

Die beantragte Vorlage war nicht erforderlich und im Übrigen, wie auch vom Beschwerdeführer bestätigt, nur von abstrakter und theoretischer Relevanz.

047-05-23

8. Rule 006 EPC | T 0084/19 | Board 3.3.08

Article: Rule 006 EPC

Case Number:	T 0084/19
Board:	3.3.08
Date of decision:	2022.10.21
Language of the proceedings:	EN
Internal distribution code:	D
Inter partes/ex parte:	Inter partes
EPC Articles:	
EPC Rules:	Rule 006(4), (5) EPC
RPBA:	
Other legal provisions:	Article 2 Rules relating to fees EPO Notice dated 18 December 2017 concerning the reduced fee for appeal (Article 108 EPC) for an appeal filed by a natural person or an entity referred to in Rule 6(4) EPC, OJ 2018, A5 Articles 2 and 3 Commission Recommendation 2003/361/EC of 6 May 2003
Keywords:	fees – reduced appeal fee – entitlement to reduced appeal fee – straw man
Cited decisions:	G 0003/97, G 0004/97, T 1839/18, T 0225/19
Case Law Book:	V.A.2.5.4c , 10th edition

[See also abstract under Art. 13\(2\) RPBA 2020.](#)

In [T 84/19](#) the board held that the entitlement to pay a reduced appeal fee under the conditions set by Art. 2, item 11, RFees and R. 6(4), (5) EPC must be assessed vis-à-vis the entity which has assumed the procedural status of an appellant.

In the case at hand, the opponent patent attorney firm which had filed the appeal was the only appellant in the proceedings. It had exercised its own right as a member of the public to file an opposition, even if a third party (the "principal") had incited the opponent to file the opposition. In such a case the opponent could not be regarded to act on the basis of the principal's personal entitlement. Whether the opponent's acts accorded with the intentions or instructions of the principal was relevant only to the internal relationship between the latter and the opponent, and had no bearing on the opposition proceedings. Accordingly, there could not be another true opponent apart from the formally authorised opponent so that the principal could under no circumstances be treated as a party (cf. G 3/97, Reasons 2.1 and 2.2).

As such, the patent attorney firm qualified as a small and medium-sized enterprise (SME) within the meaning of Art. 2 of Commission Recommendation 2003/361/EC of 6 May 2003. The board did not find support in the present case for applying the concept of "linked enterprises" according to Art. 3(3) of Commission Recommendation 2003/361/EC of 6 May 2003 to the situation of an appeal filed by a straw man opponent.

048-05-23

9. Article 11 RPBA 2020 | T 2907/18 | Board 3.2.06

Article:	Article 11 RPBA 2020
Case Number:	T 2907/18
Board:	3.2.06
Date of decision:	2022.12.08
Language of the proceedings:	EN
Internal distribution code:	D
Inter partes/ex parte:	Inter partes
EPC Articles:	Articles 084, 123 EPC
EPC Rules:	
RPBA:	Article 11 RPBA 2020
Other legal provisions:	
Keywords:	remittal to the opposition division (no) – special reasons for remittal (no) – claim feature interpretation as product-by-process feature overturned
Cited decisions:	
Case Law Book:	V.A.9.3.2d), 10th edition

In [T 2907/18](#) the board overturned the opposition division's finding that feature P7 of claim 1 was to be understood as a product-by-process feature and therefore held that claim 1 of the patent lacked novelty. In the opinion of the respondent (patent proprietor), this constituted special reasons within the meaning of Art. 11 RPBA 2020, justifying remittal of the case to the opposition division without the board considering admissibility or allowability of any of the auxiliary requests.

The board noted that the different interpretation regarding feature P7 was not raised for the first time by the board, but rather also by the appellant who was confronted with the product-by-process interpretation of the opposition division for the first time at oral proceedings before the opposition division. The consequence of the board finding that feature P7 was clearly not a product-by-process feature was merely that claim 1 was interpreted to have a broader scope than that seen by the opposition division. Such a broader interpretation of a feature, however, was not in general seen as an exceptional circumstance justifying a departure from established practice of remitting a case only on the basis of a request found to meet at least Art. 84 and 123 EPC.

The respondent's further argument that the board's conclusion represented a complete reversal of the reasons on which the decision was based and that the three examiners in the opposition division were technical specialists in that particular

technical area such that these should be tasked with the new situation based on the board's finding, was also not accepted as a reason for remittal.

049-05-23

10. Article 12(4) RPBA 2020 | T 0108/20 | Board 3.2.04

Article:	Article 12(4) RPBA 2020
Case Number:	T 0108/20
Board:	3.2.04
Date of decision:	2022.12.02
Language of the proceedings:	DE
Internal distribution code:	D
Inter partes/ex parte:	Inter partes
EPC Articles:	
EPC Rules:	
RPBA:	Article 12(4) RPBA 2020
Other legal provisions:	
Keywords:	amendment to case – request – admissibly raised and maintained (yes) – objection – references to first-instance submissions – unrebutted submissions
Cited decisions:	
Case Law Book:	V.A.4.2.1c , V.A.4.3.5 , 10th edition

In [T 108/20](#) war Hilfsantrag 3 identisch mit dem Hilfsantrag 3, der mit Schreiben vom 26. Juni 2019 (d.h. vor dem nach R. 116 EPC festgelegten Datum) der Einspruchsabteilung vorgelegt wurde. Die angefochtene Entscheidung erging nur auf Basis der erteilten Fassung, da der Einspruch zurückgewiesen wurde. Die Kammer befand, dass der Hilfsantrag 3 zwar nicht Gegenstand der Entscheidung war, jedoch unbestritten im Einspruchsverfahren in zulässiger Weise vorgebracht und aufrechterhalten worden war (Art. 12(4) VOBK 2020).

Des Weiteren entschied die Kammer auch die Einwände gegen Hilfsantrag 3 zum Beschwerdeverfahren zuzulassen. Diese waren erstmals mit Eingabe vom 18. Juli 2019 vor der Einspruchsabteilung erhoben worden. Die Beschwerdebegründung enthielt Einwände gegen die Ansprüche wie erteilt und darüber hinaus nur eine allgemeine Bezugnahme auf das erstinstanzliche Vorbringen. Erst in der mündlichen Verhandlung erhob der Beschwerdeführer (Einsprechende 2) die in erster Instanz vorgebrachten Einwände gegen Hilfsantrag 3. Die Kammer entschied aus folgenden Gründen, diese nach Art. 12(4) VOBK 2020 zuzulassen:

Aus Sicht der Kammer kann sich im streitigen Verfahren Gerechtigkeit nur über die Verfahrensgerechtigkeit definieren, nämlich durch den auf Rechtsfindung gerichteten Diskurs: Rede und Gegenrede. Aus dem diskursiven Charakter des Verfahrens

ergebe sich, dass von einer Partei nur dann erwartet werden könne sich zu äußern, wenn zu ihrem Vorbringen Stellung genommen worden sei, sei es durch das Amt, die Kammer oder durch die andere Partei. Im Hinblick auf seine Einwände gegen den Hilfsantrag 3 hatte der Beschwerdeführer (Einsprechende 2) auf seine Eingabe an die Einspruchsabteilung vom 18. Juli 2019 verwiesen. Die Kammer bestätigte zwar, dass in der Regel allgemeine Rückbezüge auf Vorbringen in erster Instanz im Beschwerdeverfahren außer Betracht gelassen werden (RdBK V.A.2.6.5). Sie hob jedoch hervor, dass im vorliegenden Fall die Entscheidung zur Zurückweisung des Einspruchs auf Basis der erteilten Ansprüche ergangen war und der Hilfsantrag 3 nicht in der angefochtenen Entscheidung behandelt wurde. Zudem waren die Hilfsanträge erst nach Erlass der Ladung zur mündlichen Verhandlung vor der Einspruchsabteilung gestellt worden, so dass auch der beigefügte Bescheid der Abteilung nicht auf diese Hilfsanträge eingegangen war. Somit gab es aus Sicht der Kammer im vorliegenden Fall keine von der Einspruchsabteilung genannten Gründe gegen den Hilfsantrag 3, auf welche der Beschwerdeführer in seinem schriftlichen Beschwerdevorbringen hätte eingehen können. Nach Ansicht der Kammer lag daher ein Fall vor, in welchem ein pauschaler Verweis auf ein Vorbringen vor der Einspruchsabteilung ausreichte, um dieses Vorbringen zum Gegenstand des Beschwerdeverfahrens zu machen.

050-05-23

11. Article 12(5) RPBA 2020 | T 1041/21 | Board 3.2.04

Article:	Article 12(5) RPBA 2020
Case Number:	T 1041/21
Board:	3.2.04
Date of decision:	2023.02.10
Language of the proceedings:	DE
Internal distribution code:	C
Inter partes/ex parte:	Inter partes
EPC Articles:	
EPC Rules:	
RPBA:	Articles 12(3), (5) and 13(2) RPBA 2020
Other legal provisions:	
Keywords:	reply to statement of grounds of appeal – reasons set out clearly and concisely (no) – discretion not to admit submission – submission admitted (no) – requirements of Art. 12(3) RPBA 2020 met (no) – amendment after summons – exceptional circumstances (no)
Cited decisions:	
Case Law Book:	V.A.4.3.5 , 10th edition

[See also abstract under Art. 116 EPC.](#)

In der Sache [T 1041/21](#) ließ die Kammer in Ausübung ihres Ermessens nach Art. 12 (5) VOBK 2020 die Hilfsanträge, weil nicht substantiiert, nicht zum Verfahren zu. Der Beschwerdegegner (Patentinhaber) hatte in seiner Beschwerdeerwidern lediglich auf erstinstanzliche Hilfsanträge und allgemein "auf die Schriftsätze des erstinstanzlichen Verfahrens" sowie auf drei spezifische in erster Instanz eingereichte Schriftsätze verwiesen, um sein erstinstanzliches Vorbringen insoweit "durch Bezugnahme zum Gegenstand des Beschwerdeverfahrens" zu machen.

Die Kammer rief die Rechtsprechung zu pauschalen Verweisen auf erstinstanzlichen Vortrag in Erinnerung und stellte unter anderem klar, dass auch der Verweis auf die drei einzelnen Schriftsätze pauschal blieb, da wegen der wiederholten Ergänzung und Umbenennung der Hilfsanträge im Einspruchsverfahren ohne eine inhaltliche Auseinandersetzung mit diesen Schriftsätzen nicht offensichtlich war, welches Vorbringen in welchem Schriftsatz zu welchem Hilfsantrag gehörte. Es könne weder von anderen Beteiligten, noch von der Kammer erwartet werden, dass sie sich die Argumente des Beschwerdegegners für dreizehn Hilfsanträge aus drei Schriftsätzen selbst zusammensuchten. Nach Ansicht der Kammer hätte dies im vorliegenden Fall

bedeutet, dass sie aktiv für eine Partei hätte tätig werden müssen, was insbesondere unter dem Gesichtspunkt der erforderlichen Unparteilichkeit der Kammer nicht in Betracht gekommen sei. Wie die Kammer feststellte, ließ sich entgegen der Auffassung des Beschwerdegegners auch aus Art. 12 (3) VOBK nicht ableiten, dass ein pauschaler Verweis unter dem Gebot der Knappheit zulässig sei. Die Kammer wies auch darauf hin, dass es keinen Unterschied gemacht hätte, wenn der Beschwerdegegner die drei Schriftsätze als Unterlagen, auf die Bezug genommen wird, nochmals in Kopie eingereicht hätte. Ausschlaggebend sei vielmehr, dass durch die Bezugnahme oder durch die bloße Wiederholung von im Einspruchsverfahren gebrachten Argumenten weder für die Kammer noch für die andere Partei sofort ersichtlich gewesen sei, welche Einwände, die der Beschwerdeführer (Einsprechender) in seiner Beschwerde gegen den Hauptantrag erhoben habe, durch die in den Hilfsanträgen vorgenommenen Änderungen ausgeräumt worden seien, in welchem Maße und warum.

Die Kammer hob hervor, dass daran auch der Umstand nichts ändere, dass im vorliegenden Fall eine Auseinandersetzung mit etwaigen Feststellungen der angefochtenen Entscheidung zu den Hilfsanträgen nicht möglich war, da der Patentinhaber erstinstanzlich mit seinem höherrangigen Antrag erfolgreich war. Denn der Patentinhaber hätte sich trotzdem auf eine Verteidigung der Hilfsanträge im Beschwerdeverfahren vorbereiten müssen. Es sei nämlich vorhersehbar gewesen, dass diese zum Tragen kämen, wenn der Hauptantrag nicht standhielte.

Der nach Zustellung der Ladung zur mündlichen Verhandlung vor der Kammer eingereichte Hilfsantrag 0.2 blieb nach Art. 13 (2) VOBK 2020 unberücksichtigt, da keine außergewöhnlichen Umstände vorlagen. Die Bestätigung von Argumenten des Beschwerdeführers durch die Kammer in ihrer Mitteilung stellte nach Ansicht der Kammer keinen solchen Umstand dar.

051-05-23

12. Article 13(2) RPBA 2020 | T 0084/19 | Board 3.3.08

Article: Article 13(2) RPBA 2020

Case Number:	T 0084/19
Board:	3.3.08
Date of decision:	2022.10.21
Language of the proceedings:	EN
Internal distribution code:	D
Inter partes/ex parte:	Inter partes
EPC Articles:	
EPC Rules:	
RPBA:	Articles 12(2), (3) and 13(2) RPBA 2020
Other legal provisions:	
Keywords:	amendment to appeal case (yes) – deletion of a claim – exercise of discretion – exceptional circumstances (no) – no justification for late filing
Cited decisions:	T 494/18, T 2091/18, T 2920/18, T 2295/19, T 247/20
Case Law Book:	V.A.4.2.2d), V.A.4.5.6 , 10th edition

[See also abstract under R. 6 EPC](#)

In [T 84/19](#) the respondent (patent proprietor) filed auxiliary request 1 only two weeks before the oral proceedings. In support of admittance, the respondent argued this request merely consisted in the deletion of claim 14 of the main request and thus could not be regarded as an amendment of the party's appeal case. The remaining subject-matter did not imply a change of the legal and factual framework of the appeal, and no objections were raised against the subject-matter remaining in appeal proceedings.

The board did not agree with the respondent's argumentation. With regard to the question of whether a new request filed after the statement of grounds of appeal or the reply thereto constituted an amendment to the party's appeal case within the meaning of Art. 13(2) RPBA 2020, the board concurred with the line of case law considering that a new request filed after the statement of grounds of appeal or the reply thereto with a set of claims that was different to that of the previous requests was to be regarded as an "amendment to the party's appeal case", even if the amendment consisted only in the deletion of claims and the remaining claims were already part of a request in appeal (see e.g. T 2295/19, T 2920/18, T 2091/18, T 494/18 and T 247/20). In the board's view, this interpretation followed from a systematic reading of the RPBA, according to which the statement of grounds of

appeal and the reply thereto must contain a party's complete appeal case (Art. 12(3) RPBA 2020). Moreover, a party's appeal case should be directed inter alia to the requests on which the decision under appeal was based (Art. 12(2) RPBA 2020). Accordingly, all parties' requests had to be expressly specified at the onset of the appeal proceedings. The filing of a new claim request at later stages of the appeal proceedings had to be considered an amendment of the party's case, a procedural step that formally changed the factual and legal situation of the appeal proceedings.

The board decided to exercise its discretion under Art. 13(2) RPBA 2020 and not to admit auxiliary request 1 into the appeal proceedings. It underlined that the respondent would have had reasons to file this amendment already in reply to the statement of grounds of appeal, since the subject-matter of auxiliary request 1 had not been attacked by the appellant at that stage of the proceedings. The respondent neither provided an explanation for the late filing of auxiliary request 1 nor referred to any circumstances, let alone exceptional ones, that had prevented the respondent from filing auxiliary request 1 at the onset of the appeal proceedings. The board also failed to see any justification for the late filing of this amendment.

The board did however admit auxiliary request 2 under Art. 12(4) RPBA 2007. This request had been filed during the proceedings before the first instance as well as at the outset of the appeal proceedings. Since no ground of opposition had been raised against the subject-matter of auxiliary request 2, the board concluded that this set of claims complied with the requirements of the EPC.

052-05-23



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