



Europäisches
Patentamt
European
Patent Office
Office européen
des brevets

Abstracts of decisions

Selected case law of the Boards of Appeal
edited by the Legal Research Service
of the Boards of Appeal

Issue 6 | 2023



Boards
of Appeal

Disclaimer

The summaries in this publication are prepared by the Legal Research Service of the Boards of Appeal for information only. They must therefore not be relied on in any way, in particular in proceedings before the European Patent Office or the Boards of Appeal. Summaries, no matter how carefully prepared, cannot serve as substitutes for the decisions themselves. The full decisions can be found in the [decisions database](#) of the Boards of Appeal website.

Copyright note

The abstracts included in this publication may not be reproduced or transmitted by any means or in any form or by any information storage and retrieval system, without the prior written permission of the editors.

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 056 EPC	T 2039/18 Board 3.2.06	1
Article 056 EPC	T 1571/19 Board 3.3.09	3
Article 083 EPC	T 2319/18 Board 3.4.01	5
Article 084 EPC	T 1761/19 Board 3.2.05	7
Article 084 EPC	T 1924/20 Board 3.5.03	9
Article 099 EPC	T 1121/21 Board 3.3.03	10
Article 116 EPC	T 0758/20 Board 3.2.01	12
Rule 139 EPC	J 0003/21 Board 3.1.01	14
Rule 139 EPC	T 0158/21 Board 3.5.02	16
Article 12(4) RPBA 2020	T 0221/20 Board 3.2.05	18
Article 12(6) RPBA 2020	T 1617/20 Board 3.3.02	20
Article 13(2) RPBA 2020	T 1058/20 Board 3.3.06	22

1. Article 056 EPC | T 2039/18 | Board 3.2.06

Article: Article 056 EPC

Case Number:	T 2039/18
Board:	3.2.06
Date of decision:	2023.01.24
Language of the proceedings:	DE
Internal distribution code:	D
Inter partes/ex parte:	Inter partes
EPC Articles:	Articles 056, 083 EPC
EPC Rules:	
RPBA:	
Other legal provisions:	
Keywords:	inventive step (yes) – non-obvious alternative – skilled person – no equation of requirements of Art. 56 and 83 EPC
Cited decisions:	T 0460/87
Case Law Book:	I.D.4.5. , I.D.8.3. , 10th edition

In [T 2039/18](#) befand die Kammer, dass ausgehend von dem Unterscheidungsmerkmal des Anspruchs 1 gegenüber D5 die zu lösende objektive technische Aufgabe darin zu sehen sei, eine geeignete Oxidationsschutzschicht für die Schaufelspitze (einer thermischen Strömungsmaschine) zu finden.

D5 offenbare sämtliche Merkmale des Anspruchs 1, außer dass die Schaufelspitze lediglich mit einer homogenen metallischen Abdeckschicht aus MCrAlY versehen sei. Die Kammer teilte die Ansicht des Beschwerdeführers (Einsprechenden) nicht, dass Anspruch 1 keinen technischen Vorteil gegenüber D5 offenbare und daher keine technische Aufgabe formuliert werden könne. Sie stimmte dem Beschwerdeführer zwar dahingehend zu, dass die Schaufelspitze von D5, wenn sie kubisches Bor-Nitrid enthalte, ein gezieltes Einschleifen der Schaufelspitze in den Hitzeschild ermögliche und dass die beanspruchte MCrAlY-Abdeckschicht dasselbe bewirken müsse. Jedoch sei die beanspruchte MCrAlY-Abdeckschicht aus D5 nicht bekannt und biete somit die Grundlage für die Formulierung der zu lösenden technischen Aufgabe. Insoweit sei nicht entscheidend, ob es auch Anhaltspunkte für eine verbesserte Beschichtung gebe, da auch eine alternative Lösung Grundlage für die objektive Formulierung der Aufgabe sein könne.

Die Kammer legte ferner dar, dass D8 zwar eine Schicht aus MCrAlY auf einer Schaufel der Turbine offenbare, jedoch nichts über ein gezieltes Einschleifen einer

mit MCrAlY beschichteten Schaufelspitze in den Hitzeschild, wie es Anspruch 1 des Streitpatents verlange. Die Fachperson könne D8 keine Lehre entnehmen, eine entsprechend harte MCrAlY-Beschichtung auszuwählen, um das beanspruchte Einschleifen der Schaufelspitze in den Hitzeschild (wie in der D5) zu ermöglichen.

Der Beschwerdeführer machte geltend, die Kammer habe in Bezug auf Art. 83 EPÜ festgestellt, dass die Fachperson in der Lage sei, eine angemessene Härte der Schaufel im Verhältnis zur Beschichtung zu wählen. Daraus folge, dass dieses relative Härteverhältnis das Vorliegen einer erfinderischen Tätigkeit nicht begründen könne. Die Kammer stimmte dem nicht zu. Eine solche Gleichsetzung der Anforderungen von Art. 83 und 56 EPÜ sei nicht gerechtfertigt. Die Fähigkeit der Fachperson, eine Erfindung auf Grundlage der Informationen im Streitpatent und im allgemeinen Fachwissen auszuführen, sei völlig unabhängig davon, ob ihr Gegenstand für dieselbe Fachperson im Hinblick auf den Stand der Technik naheliegend sei. So wäre die Fachperson im vorliegenden Fall, wie in Bezug auf Art. 83 EPC erläutert, in der Lage, eine bestimmte Beschichtung mit einem bestimmten Härtegrad auf Grundlage der Beschreibung des Streitpatents und des allgemeinen Fachwissens herzustellen, um die Erfindung auszuführen. Das bedeute jedoch nicht, dass die Fachperson ausgehend von einer bestimmten Druckschrift (hier D5) ohne Veranlassung entsprechende Maßnahmen ergreifen würde. Hierzu reiche es nicht, dass die Fachperson über entsprechende Fähigkeiten verfüge, es müsse vielmehr auch eine Veranlassung für die Maßnahme bestehen. Diese dürfe nicht aufgrund einer retrospektiven Betrachtung konstruiert werden.

Das weitere Argument des Beschwerdeführers, dass eine einfache einstufige Änderung von D5 erforderlich wäre, um den beanspruchten Gegenstand zu erreichen, überzeugte die Kammer ebenso wenig.

Die Kammer kam zu dem Schluss, dass ausgehend von D5 und im Lichte der objektiven technischen Aufgabe, die Fachperson aus D8 keine Lehre erhalte, wie sie zum beanspruchten Gegenstand gelangen kann, ohne eine erfinderische Tätigkeit auszuüben (Art. 56 EPÜ). Die gleiche Schlussfolgerung ergebe sich, wenn man von Dokument D5 ausgehe und dieses mit der technischen Lehre von D10 kombiniere. Die Kammer entschied folglich, dass der Gegenstand des Anspruchs 1 auf einer erfinderischen Tätigkeit beruhe.

053-06-23

2. Article 056 EPC | T 1571/19 | Board 3.3.09

Article: Article 056 EPC

Case Number: T 1571/19

Board: 3.3.09

Date of decision: 2022.11.09

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 (yes) – closest prior art – most promising springboard too short to reach out to cited secondary document

Cited decisions: T 1028/05, T 1685/10

Case Law Book: [I.D.3.4.2](#), 10th edition

In [T 1571/19](#) the appellant (opponent) argued that the skilled person, starting from D5 (the closest prior art) and faced with the underlying problem, would have taken into account the teaching of D3, which, like the opposed patent, related to a feed composition (for fish) for treating inflammatory symptoms in the heart and the liver caused by HSMI, a viral disease. The teaching of D3 was limited to the treatment of HSMI. However, the appellant argued the pathology and the symptoms of CMS and HSMI were similar. Therefore, the skilled person would have reasonably expected the composition of D3 to be beneficial in the treatment of CMS.

The board was not persuaded by these arguments. D5 showed that no therapy was known for treating and preventing diseases caused by PMCV in fish at the time of priority. Furthermore, it showed that the field of clinical nutrition of salmon was still in its infancy and that the therapeutic utility of feed compositions for fish could only be speculated upon. At the time of priority the skilled person could, at most, have had a tenuous hope that a fish feed composition for treating the claimed diseases would be developed in the future. The skilled person starting from D5 would barely have considered the teaching of D3. Even if they had, they would not have considered the idea of using the composition of D3 to treat and prevent diseases caused by PMCV, in particular CMS, to have a reasonable expectation of success. Therefore, they would not have endeavoured to test the utility of this composition for these therapeutic uses.

The appellant selected D5 as the closest prior art, the "most promising springboard" towards the claimed invention. Nonetheless, the board considered this springboard too short to allow the skilled person to reach out to D3 and to overcome the considerable gap separating the closest prior art from the subject-matter defined in claim 1. It concluded that the subject-matter of claim 1, as well as that of the following claims, which were narrower in scope, involved an inventive step (Art. 56 EPC).

054-06-23

3. Article 083 EPC | T 2319/18 | Board 3.4.01

Article:	Article 083 EPC
Case Number:	T 2319/18
Board:	3.4.01
Date of decision:	2022.12.16
Language of the proceedings:	DE
Internal distribution code:	D
Inter partes/ex parte:	Inter partes
EPC Articles:	Articles 069, 083, 084, 100(b) EPC
EPC Rules:	
RPBA:	
Other legal provisions:	Protocol on the interpretation of Article 69 EPC
Keywords:	sufficiency of disclosure (no) –contradiction within the claim – claim interpretation – relation between Article 83 and Article 84 EPC
Cited decisions:	T 1513/12
Case Law Book:	II.A.6.1. , II.A.6.3.2. , II.C.8.2. , 10th edition

In [T 2319/18](#) stellte die Kammer im Rahmen der Prüfung der Ausführbarkeit fest, dass Anspruch 12 in der erteilten Fassung widersprüchliche Merkmale enthielt. Der Widerspruch ergebe sich aus den sich gegenseitig ausschließenden und über eine gewisse Zeitdauer andauernden, sich aus dem Verringern der Versorgungsspannung und der kurzzeitigen Aktivierung der Versorgungsspannung ergebenden Zuständen.

Die Kammer war der Ansicht, dass das Heranziehen allgemeiner Auslegungsprinzipien diesen Widerspruch nicht ausräumen könne. Die Merkmale des Anspruchs 12 seien für sich klar. Es sei aber nicht ersichtlich, welche technische Wirkung durch die Merkmalskombination des Anspruchs 12 erreicht werden sollte, da bestimmte Angaben fehlten. Für die Suche nach einer technisch sinnvollen Auslegung des Anspruchs bekomme die Fachperson dementsprechend keinerlei Hinweise.

Die Kammer stellte klar, dass sie an die Auslegung der Ansprüche durch die Parteien nicht gebunden war (T 1513/12). Sie teilte die Auffassung des Einsprechenden nicht, dass das Verfahren der Figur 6 der Definition in Anspruch 12 entspreche. Sie merkte an, dass das Flussdiagramm der Figur 6 nur dann von Bedeutung sein könnte, wenn die Fachperson aus dem Anspruchswortlaut erkennen würde, dass das Flussdiagramm einem Ausführungsbeispiel der beanspruchten Erfindung entspricht. Dies sei jedoch nicht der Fall. Aus den für sich genommen klaren Merkmalen des Anspruchs 12 ergebe sich eine nicht sinnvolle und somit unbestimmte Definition des

beanspruchten Verfahrens (Art. 83 EPÜ). Eine Auslegung des Anspruchs 12 im Sinne des Ausführungsbeispiels der Figur 6 sei unter den vorliegenden Umständen ausgeschlossen. Das Heranziehen eines Ausführungsbeispiels als Grundlage für eine alternative, wenn auch sinnvolle Auslegung des Anspruchs würde jeden Dritten vor die Aufgabe stellen, zu bestimmen, was oder welche Merkmalskombination des Ausführungsbeispiels unter den Anspruchswortlaut fällt. Aus Gründen der Rechtssicherheit sei eine solche Vorgehensweise bei der Auslegung eines Anspruchs, der widersprüchliche Merkmale enthält, ausgeschlossen.

Ferner hob die Kammer hervor, dass Art. 1 des Protokolls über die Auslegung des Art. 69 EPÜ die Bedeutung der Ansprüche und die der Beschreibung und Zeichnungen bei deren Auslegung unterstreiche. Der Schutzbereich ergebe sich weder aus dem genauen Wortlaut der Patentansprüche noch aus dem, was sich für die Fachperson nach Prüfung der Beschreibung und der Zeichnungen als Schutzbegehren des Patentinhabers darstelle. "Die Auslegung soll vielmehr zwischen diesen extremen Auffassungen liegen und einen angemessenen Schutz für den Patentinhaber mit ausreichender Rechtssicherheit für Dritte verbinden."

Infolgedessen kam die Kammer zu dem Schluss, dass sich keine sinnvolle Auslegung des Anspruchs aus dem Anspruchswortlaut ergebe. Das Verfahren des Anspruchs 12 sei wegen des Vorhandenseins von sich gegenseitig ausschließenden Zuständen nicht ausführbar im Sinne des Art. 100 b) EPÜ.

055-06-23

4. Article 084 EPC | T 1761/19 | Board 3.2.05

Article: Article 084 EPC

Case Number:	T 1761/19
Board:	3.2.05
Date of decision:	2022.12.13
Language of the proceedings:	FR
Internal distribution code:	D
Inter partes/ex parte:	Inter partes
EPC Articles:	Articles 054, 056, 084 EPC
EPC Rules:	
RPBA:	
Other legal provisions:	
Keywords:	claims – interpretation of process claims with product-like features – "process-by-product" claims
Cited decisions:	
Case Law Book:	II.A.7.4. , 10th edition

Dans l'affaire [T 1761/19](#) la chambre s'est penchée sur l'interprétation des revendications de procédé comportant des caractéristiques de type produit (que l'on pourrait qualifier de revendications "process-by-product").

En particulier, la revendication 1 de la requête principale portait sur un procédé de personnalisation d'au moins deux cartes (...), comprenant les étapes (2.1) à (4) et caractérisé en ce que (5.1) ce procédé était un procédé de personnalisation d'au moins deux cartes en matière plastique et (5.2) ayant une épaisseur comprise entre 0.5 mm et 4 mm, (5.3) du type carte à puce, ou carte de fidélité ou d'identification.

La chambre a estimé que les caractéristiques (5.1) à (5.3) n'étaient pas des caractéristiques de procédé mais des caractéristiques définissant les cartes qui sont personnalisées lors de la mise en œuvre du procédé revendiqué, à savoir leur matériau (matière plastique), leur épaisseur (entre 0,5 et 4 mm) et leur type (carte à puce, carte de fidélité ou carte d'identification). Aux yeux de la requérante (opposante), ces caractéristiques ne définissaient le procédé que dans la mesure où elles avaient un impact sur les caractéristiques de procédé. La chambre a observé que ce raisonnement de la requérante semblait fondé sur une analogie par rapport à la pratique de l'OEB concernant les revendications de produits caractérisés par leur procédé d'obtention ("product-by-process").

Pour la chambre, l'analogie en question n'était pas pertinente. Les revendications du type "product-by-process" sont admises dans les cas où il n'est pas possible de

définir le produit obtenu autrement que par son procédé d'obtention. Cette situation n'est pas comparable à celle d'une revendication de procédé précisant que ce procédé concerne un produit bien précis. Dans ce cas, la caractéristique de produit limite tout simplement le procédé à son application à ce produit, sans qu'il soit nécessaire ni même utile d'examiner si elle a un effet sur les étapes du procédé proprement dites. Autrement dit, la caractéristique de produit en question ne constituait pas une façon de définir, faute de mieux, une propriété d'une étape du procédé qui se soustrayait à une définition directe, mais elle circonscrivait de manière directe la portée du procédé. Tout raisonnement par analogie avec les revendications de type "product-by process" était donc à proscrire.

Au vu de ce qui précède, la chambre a conclu que les caractéristiques (5.1) à (5.3) limitaient le procédé à un procédé de personnalisation de cartes du type carte à puce ou carte de fidélité ou d'identification, réalisées en matière plastique et ayant une épaisseur comprise entre 0,5 mm et 4 mm. Ces caractéristiques devaient être prises en compte dans l'examen de la brevetabilité, sans qu'il fût nécessaire de vérifier si – et à quel point – elles modifiaient les étapes du procédé (2.1) à (4).

En l'espèce, les caractéristiques (5.1) à (5.3) étaient pertinentes pour évaluer la nouveauté et l'activité inventive.

056-06-23

5. Article 084 EPC | T 1924/20 | Board 3.5.03

Article:	Article 084 EPC
Case Number:	T 1924/20
Board:	3.5.03
Date of decision:	2023.03.16
Language of the proceedings:	EN
Internal distribution code:	D
Inter partes/ex parte:	Inter partes
EPC Articles:	Articles 056, 084, 100(a) EPC
EPC Rules:	
RPBA:	
Other legal provisions:	
Keywords:	claims – interpretation – claim construction for assessing inventive step
Cited decisions:	T 1127/16, T 2764/19
Case Law Book:	II.A.6.1. , 10th edition

In [T 1924/20](#) the board noted that the respondent's (patent proprietor's) line of argumentation regarding E1's disclosure and inventive step concerning claim 8 hinged upon a claim construction that was based on the description of the opposed patent. The board held that such a line of argumentation was not convincing; a skilled reader of a patent claim would, for many reasons, interpret the claims based essentially on their own merits (see e.g. T 2764/19 and T 1127/16). This was because the "subject-matter of the European patent" (cf. Art. 100(a) EPC) is defined by the claims and only by them. The board explained that the description and drawings were, however, typically used by the deciding body to determine the above-mentioned "skilled reader" and, hence, the view point from which the claims are interpreted. This meant that, when interpreting the claims, the description and drawings could not be relied on as a sort of fall-back or supplementary-guidance tool for filling up gaps or for resolving inconsistencies in a claim to the patent proprietor's advantage. Such a reliance on the description and the drawings by the patent proprietor would normally fail to convince. The present case was no exception to this.

057-06-23

6. Article 099 EPC | T 1121/21 | Board 3.3.03

Article:	Article 099 EPC
Case Number:	T 1121/21
Board:	3.3.03
Date of decision:	2022.09.26
Language of the proceedings:	EN
Internal distribution code:	D
Inter partes/ex parte:	Inter partes
EPC Articles:	Article 099 EPC
EPC Rules:	Rules 076(2)(a), 077(1), 139 EPC
RPBA:	
Other legal provisions:	
Keywords:	admissibility of opposition (yes) – lack of clear indication of opponent (no)
Cited decisions:	G 0003/99, G 0001/12, T 0025/85, T 0615/14, T 0579/16
Case Law Book:	IV.C.2.2.1 , IV.C.2.2.4c , 10th edition

In [T 1121/21](#) the opposition division in the appeal at issue had rejected the opposition as inadmissible pursuant to R. 77(1) EPC, having found an apparent lack of a clear indication of the opponent in the notice of opposition and in the accompanying letter.

The board noted that the letter of opposition clearly identified one single legal person, namely Evonik Degussa GmbH and could not identify in the opposition letter any concrete indication that the opposition could have been filed by Evonik Industries AG, as suggested in the appealed decision and by the respondent (patent proprietor); this company was not mentioned at all in the letter. The opposition division had found a basis for its assumption in the logo, mentioning "Evonik Industries" on the top of pages 2 to 13 of the letter of opposition. The board observed that a logo was merely a graphical symbol, often present on letterheads, designed to communicate quickly the corporate identity. Due to its function, its generic presence on official papers and its typical symbolic representation, the board found that a logo alone could not be a sufficient legal identification of a company for the purposes of R. 76(2)(a) EPC.

The respondent further based its argument that Evonik Industries AG was the true opponent on the sentence in the notice of opposition indicating payment of the opposition fee would be paid from an account owned by Evonik industries. The board found this sentence could not be interpreted as meaning that Evonik Industries AG was the opponent. The fact alone that Evonik Industries AG was the owner of the deposit account was completely irrelevant to the question of the identification of the

opponent. It was a generally accepted principle that in proceedings before the EPO fees can be paid by any third person. The fact that fees were paid by another company within the Evonik group was not sufficient to raise reasonable doubts as to the identity of the party to the proceedings.

As to the fact that in the accompanying letter the address of Evonik Patent Association was indicated as "c/o Evonik Industries AG", the board had difficulties in following how a mere indication of the postal address of the association of representatives, Evonik Patent Association, may have an objective bearing on the identification of the opponent that they represented.

In the absence of any concrete mentioning of Evonik Industries AG in the relevant documents, except for the accompanying letter as owner of the deposit account and in the "c/o" address of the association of representatives, the board found no reasonable support for the assumption that Evonik Industries AG could be the opponent in the present case.

The board was also not convinced by the argument that Dr Forster – who had signed the letter of opposition – could be considered as the opponent; the fact that his name, contact data and the further responsibilities (Legal, IP Management & Compliance IP Management) were indicated on the letter merely indicated that he, as representative, was the contact person and did not cast any doubts on the fact that the letter clearly originated from Evonik Degussa GmbH. The wrong indication in the accompanying letter of Dr Forster in the box mentioning the represented party was an obvious mistake that could not plausibly lead to the opponent's designation being understood as the natural person Dr Forster.

The board distinguished the present case from T 25/85, cited by the respondent, in which at expiry of the opposition period the name of the opponent was completely missing, and from T 579/16 in which two distinct entities were mentioned in the notice of opposition and in Form 2300, so that there were objective doubts upon expiry of the opposition period as to the identity of the opponent.

In view of the above considerations, the board concluded that the opposition was admissible and remitted the case to the opposition division for further prosecution.

058-06-23

7. Article 116 EPC | T 0758/20 | Board 3.2.01

Article:	Article 116 EPC
Case Number:	T 0758/20
Board:	3.2.01
Date of decision:	2022.11.23
Language of the proceedings:	EN
Internal distribution code:	C
Inter partes/ex parte:	Inter partes
EPC Articles:	Articles 116, 112(1)(a) EPC
EPC Rules:	
RPBA:	Article 15a RPBA 2020
Other legal provisions:	
Keywords:	oral proceedings – oral proceedings by videoconference (yes) – in-person oral proceedings (no) – G 1/21 – videoconference meanwhile equivalent alternative to in-person oral proceedings – referral to the Enlarged Board of Appeal (no)
Cited decisions:	G 0003/98, G 0001/21
Case Law Book:	III.C.7.3.2 , V.B.2.3.2 , V.B.2.3.3 , 10th edition

In [T 758/20](#) the board decided of its own motion to hold oral proceedings by videoconference pursuant to Art. 15a(1) RPBA 2020. The oral proceedings were held by videoconference in November 2022 with the consent of the respondent (patent proprietor). The appellant (opponent) had not consented to that format. The board reasoned that from the wording "if the board considers it appropriate" in this provision, it was evident that the board had the discretion to decide whether to hold oral proceedings by videoconference. The provision did not set criteria to be applied when exercising this discretionary power. Nor did this provision require the consent of the parties.

Regarding whether there were circumstances specific to the case that justified the decision not to hold the oral proceedings in person, the board explained that the COVID-19 pandemic was ongoing at the date of the oral proceedings and access restrictions were at that time still in place for the premises of the Boards of Appeal in Haar. Holding oral proceedings by videoconference had avoided the risk that a participant on quite short notice be barred from attending. The absence of general travel restrictions was not a clear indication that oral proceedings had to be held in person. The board also took into account the risk for the parties and the members of the board of being infected.

Concerning the suitability of holding oral proceedings by videoconference in the case in hand, the board disagreed with the appellant's view that a discussion of the opposition division's allegations in the impugned decision would require an in-person hearing. The board found that it would be more appropriate to provide figures and sketches in advance of the oral proceedings instead of presenting them during the oral proceedings. Moreover, the Zoom software used for the videoconferences allowed for screen sharing, displaying figures and handmade sketches as well as for pointing to details using the mouse. Furthermore, it was possible to file figures and sketches by email to be distributed to the other participants of the oral proceedings.

Moreover, the board did not interpret G 1/21 as meaning that it was for the party to choose the format of the oral proceedings. The decision on whether good reasons justified a deviation from the preference of a party to hold the oral proceedings in person was a discretionary decision of the board summoning it to the oral proceedings. Furthermore, the board clarified that the order in G 1/21 could not be read as restricting the possibility of summoning for oral proceedings by videoconference contrary to the will of one party to only when there is a general emergency. The order did not exclude that there were other circumstances specific to the case that justified the decision not to hold the oral proceedings in person.

The board concluded that, in the case at issue, the three criteria mentioned in points 47 to 50 of decision G 1/21 were met. Hence the board saw no conflict with G 1/21. Irrespective of this, the board also found that nowadays oral proceedings held by videoconference were often equivalent to a hearing in person. This applied to the current case when using the available videoconference technology, as the case had involved no particular complexities and there had been no limitations on the interaction between the parties and the board or on the opportunity for the parties to argue their case. Therefore, the board concluded that oral proceedings by videoconference were in this case not only suitable but also represented an equivalent alternative to in-person oral proceedings.

Finally, the board refused the request by the appellant for referral under Art. 112(1)(a) EPC, since it did not see any deviation from the decision G 1/21; furthermore, it did not consider the question to be essential for it to reach a decision in the case at issue and had no doubt that it had discretion to decide to hold oral proceedings by videoconference, even without the consent of the appellant.

059-06-23

8. Rule 139 EPC | J 0003/21 | Board 3.1.01

Article:	Rule 139 EPC
Case Number:	J 0003/21
Board:	3.1.01
Date of decision:	2023.02.07
Language of the proceedings:	EN
Internal distribution code:	D
Inter partes/ex parte:	Ex parte
EPC Articles:	Articles 016, 123(2) EPC
EPC Rules:	Rules 010(1), 040, 139 EPC
RPBA:	
Other legal provisions:	
Keywords:	correction of error (no) – obvious error – immediately evident that nothing else could have been intended – correction of originally filed application documents
Cited decisions:	G 0002/95, J 0005/06, J 0016/13, T 0723/02, T 1248/08, T 0581/19
Case Law Book:	II.E.1.14.7 , II.E.4. , II.E.5. , II.A.3.1. 10th edition

In [J 3/21](#) the appeal was filed against the decision of the Receiving Section to reject the applicants' (appellants') request for correction of the originally filed application documents.

The Legal Board recalled that, according to established jurisprudence, the general principle was that each party bears the burden of proof for the facts it alleges. This principle applied no less to a proposed correction under R. 139 EPC. In addition, the party had to establish such facts to the rigorous standard of "beyond reasonable doubt" (T 1248/08, T 723/02 and T 581/19).

The applicants had not provided any evidence for the alleged obvious errors of originally filing 25 Chinese claims instead of 15 (main request), and of originally filing the application in Chinese instead of in English as intended (first auxiliary request).

The indications in EPO Form 1001 itself regarding the number of claims and the specification in the admissible non-EPO language were, in light of the indicated filing language and of the de facto filing of 25 Chinese claims, not enough to dispel a reasonable doubt about the applicants' alleged facts.

Furthermore, the applicants had failed to prove the obviousness of the corrections sought, i.e. why it was immediately evident that nothing else would have been

intended than what was offered as corrections by the main request and the first auxiliary request (R. 139, second sentence, EPC).

The applicants thus failed to fulfil their burden of proof. For this reason alone, neither the main request nor the first auxiliary request were allowable.

For the sake of argument, the Legal Board observed that the Receiving Section had not exceeded its competence (Art. 16 in conjunction with R. 10(1) EPC) when deciding on the request by the applicants to correct at least the description of the originally filed Chinese application by replacing it with at least that of the English translation filed on the same day. The ban on such corrections, established in G 2/95 on the basis of Art. 123(2) EPC and further developed in e.g. J 5/06 and J 16/13, was categorical and followed from the principle reflected in R. 40(1)(c) EPC that the accorded filing date is inseparable from the description as originally filed. An exchange of the description by way of correction would directly result in the separation of the filing date from the description in contravention of Art. 123(2) EPC. Refusing such a request for correction did not require any technical examination and technical qualifications, and this principle applied irrespective of any intention of the applicant.

060-06-23

9. Rule 139 EPC | T 0158/21 | Board 3.5.02

Article:	Rule 139 EPC
Case Number:	T 0158/21
Board:	3.5.02
Date of decision:	2022.11.04
Language of the proceedings:	EN
Internal distribution code:	D
Inter partes/ex parte:	Ex parte
EPC Articles:	
EPC Rules:	Rule 139 EPC
RPBA:	
Other legal provisions:	
Keywords:	correction of error – set of claims – immediately evident that nothing else could have been intended (no)
Cited decisions:	G 0001/12
Case Law Book:	IV.A.5.5.2 , 10th edition

In [T 158/21](#) the appellant requested in essence that the set of claims annexed as a pdf-file to the electronically filed application be replaced by the set of claims contained in the zip-file which was also attached to the application. The appellant submitted that the version of the claims contained in the pdf-file was meant for another divisional application filed one day later and that the error was visible from the file names containing the representative's reference numbers for the different applications.

The board recalled that R. 139, first sentence, EPC allowed for the correction of linguistic errors, errors of transcription and mistakes in any document filed with the EPO. As a preliminary remark, the board observed that, in the present case, the request for correction was not directed to the correction of an error in the set of claims filed as a pdf-file. Instead it was aimed at the replacement of a document, i.e. the set of claims filed as a pdf-file, by another set of claims filed as a zip-file.

Furthermore, the board noted that the set of claims contained in the zip-file was submitted as a "pre-conversion" file. A pre-conversion file was foreseen if a document attached to the application form had been prepared by conversion from a different electronic format. Hence, a pre-conversion file was taken into account only to solve problems caused by the conversion of document formats. In the present case the set of claims contained in the pdf-file did not show any sign of corruption.

According to R. 139, second sentence, EPC when the request for correction concerns the description, claims or drawings, the correction must be obvious in the sense that it is immediately evident that nothing else would have been intended than what is offered as the correction. The board concurred with the appellant insofar as it appeared evident that an error had occurred when filing the present application in view of the different reference numbers used for the pdf- and the zip-file. However, it was by no means obvious whether the mistake laid in the filing of an incorrect set of claims as a pdf-file or whether the reference numbers themselves were incorrectly chosen. In view of the fact that even the kind of error could not be identified in an unambiguous way, it was also not immediately evident how it should be corrected. Thus, it was not evident that the correction offered, i.e. the replacement of the set of claims contained in the pdf-file by the set of claims contained in the zip-file, was in line with the original intention when filing the application in suit.

In view of the above, the board refused the appellant's request for correction of the set of claims.

061-06-23

10. Article 12(4) RPBA 2020 | T 0221/20 | Board 3.2.05

Article: Article 12(4) RPBA 2020

Case Number:	T 0221/20
Board:	3.2.05
Date of decision:	2022.10.07
Language of the proceedings:	EN
Internal distribution code:	D
Inter partes/ex parte:	Inter partes
EPC Articles:	
EPC Rules:	
RPBA:	Article 12(2), (4) RPBA 2020
Other legal provisions:	
Keywords:	amendment to case (no) – request – evidence – admissibly raised and maintained (yes)
Cited decisions:	
Case Law Book:	V.A.4.2.1c , 10th edition

In [T 221/20](#) the board had to decide on the admittance of auxiliary requests 1 and 2 and documents K7 and K8. Auxiliary requests 1 and 2 were filed within the time limit set by the opposition division in its summons to attend oral proceedings. Documents K7 and K8 were filed some two weeks later by the opponent. The documents and auxiliary requests were re-filed in the statement of grounds of appeal and the reply to it, respectively.

The board examined whether these submissions constituted an amendment to a party's case within the meaning of Art. 12(2) and (4) RPBA 2020. It noted that the decision under appeal was not based on auxiliary requests 1 and 2 and documents K7 and K8 were not discussed by the opposition division. However, as auxiliary requests 1 and 2 were filed within the time limit set by the opposition division in its summons and because the filing of documents K7 and K8 two weeks later constituted a direct reaction to the submission of these amended requests, the board was satisfied that auxiliary requests 1 and 2 as well as documents K7 and K8 were admissibly raised in the proceedings leading to the decision under appeal. Moreover, auxiliary requests 1 and 2 and documents K7 and K8 were maintained until the department of first instance took its decision.

Therefore, the board concluded that in accordance with Art. 12(4) RPBA 2020, auxiliary requests 1 and 2 and documents K7 and K8 were not to be regarded as an amendment to the parties' respective cases. Since they were part of the appeal proceedings, the board had no discretion not to admit these requests and

documents. This conclusion was uncontested by the parties and also confirmed in the explanatory remarks to Art. 12(4) RPBA 2020 (section VI. of document CA/3/19, Supplementary publication 2, OJ 2020, p. 56). The board remitted the case to the opposition division for further prosecution under Art. 111(1), second sentence, EPC and Art. 11 RPBA 2020.

062-06-23

11. Article 12(6) RPBA 2020 | T 1617/20 | Board 3.3.02

Article:	Article 12(6) RPBA 2020
Case Number:	T 1617/20
Board:	3.3.02
Date of decision:	2023.02.07
Language of the proceedings:	EN
Internal distribution code:	D
Inter partes/ex parte:	Inter partes
EPC Articles:	
EPC Rules:	
RPBA:	Article 12(3), (4), (5), (6) RPBA 2020
Other legal provisions:	
Keywords:	late-filed request – amended description – should have been submitted in first-instance proceedings (no) – amendment to case (yes) – admitted (yes) – claims identical to non-admitted claims – error in use of discretion in first-instance (yes)
Cited decisions:	G 0007/93, T 0222/16, T 0879/18
Case Law Book:	IV.C.5.1.4d), V.A.3.4.3a), V.A.4.3.4 , V.A.4.3.5 , V.A.4.3.6 , V.A.4.3.7 , 10th edition

In [T 1617/20](#) the appellant (proprietor) filed, with its statement of grounds of appeal, as main request a set of claims identical to the claims of auxiliary request 2 underlying the appealed decision as well as amended pages of the description.

As regards the amended description, the board examined whether it should have been submitted in opposition proceedings (Art. 12(6), second sentence, RPBA 2020). It pointed out that it was common practice in proceedings before the opposition division that when amended claims are filed, corresponding amendments to the description are carried out only once (and only if) the amended claims are admitted into the proceedings and found to be allowable. In the current case, the proprietor had filed the claims of auxiliary request 2 at the oral proceedings before the opposition division and explained that the description was still to be amended. The board held that since this claim request had not been admitted by the opposition division, there was no need for the appellant to file description pages in line with this claim request in the opposition proceedings.

The board then observed that the amendment to the description had not been dealt with in the appealed decision and thus represented an amendment of the appellant's case within the meaning of Art. 12(4), first paragraph, RPBA 2020. Hence, in addition to the above-mentioned criterion under Art. 12(6) RPBA 2020, the further criteria under Art. 12(4), third paragraph, RPBA 2020 also needed to be considered for the board's discretionary decision on the admittance of the amendment. The amendment at issue was not complex since it

merely consisted of the deletion of a sentence. Moreover, it had been made to overcome an objection raised in the appealed decision and thus directly addressed an issue leading to the decision under appeal. Finally, no detriment to procedural economy associated with this amendment could be recognised. Therefore, the board saw no reasons why the amended description according to the main request should not be admitted into the proceedings.

As regards the claims of the main request, the board noted that these were identical to the claims of auxiliary request 2 as filed at the oral proceedings before the opposition division. Said auxiliary request 2 had been examined by the opposition division as regards its prima facie allowability and was not admitted. The board held that this decision on the admittance of auxiliary request 2 was part of the appealed decision and thus, contrary to the respondent's view, the filing of this request as the main request in appeal did not represent an amendment of the appellant's case within the meaning of Art. 12(4) RPBA 2020. Art. 12(4), second and third paragraph, RPBA 2020 did not apply.

Still regarding the claims of the main request, the board further considered Art. 12(6), first sentence, RPBA 2020. The board explained that in order to decide whether the opposition division's discretionary decision suffered from an error, i.e. was based on a wrong principle, or was taken by applying the right principle in an unreasonable way, the file history of the present case had to be considered. In the case in hand the proprietor had filed auxiliary request 1 in response to a conclusion of the opposition division during oral proceedings deviating from its preliminary opinion. Auxiliary request 1 had been admitted, but not allowed. Thereafter, the appellant had filed auxiliary request 2. The opposition division, instead of applying the same criteria as for auxiliary request 1, applied the criterion of prima facie allowability under Art. 123(2) EPC to a feature that had already been present in claim 1 as granted, and in claim 1 of auxiliary request 1 as admitted by the opposition division. More importantly, this feature had never been objected to before under Art. 123(2) EPC, either by the respondent or by the opposition division. The board held that basing the decision on admittance of auxiliary requests 1 and 2 on different criteria resulted in an inconsistent approach. Moreover, using the prima facie allowability criterion to object for the first time at oral proceedings to a feature of the late-filed claim request that was already present in higher-ranking claim requests and had never been objected to before, not even when deciding on the allowability or admittance of those higher-ranking claim requests, went against the principles of fairness and good faith. For these reasons, the board decided to overturn the opposition division's decision on the non-admittance of what was then auxiliary request 2, and to admit the current main request into the appeal proceedings pursuant to Art. 12(6) RPBA 2020.

Moreover, the board decided on admittance of a new objection of the respondent under Art. 123(3) EPC, raised in its reply to the grounds of appeal. The opposition division had concluded that the amendment in claim 1 of the main request had restricted the claimed subject-matter. By not explaining in its reply why this conclusion was not correct, the respondent failed to substantiate its objection as required by Art. 12(3) RPBA 2020. In exercising its discretion under Art. 12(5) RPBA 2020, the board decided not to admit the respondent's objection into the proceedings.

063-06-23

12. Article 13(2) RPBA 2020 | T 1058/20 | Board 3.3.06

Article: Article 13(2) RPBA 2020

Case Number:	T 1058/20
Board:	3.3.06
Date of decision:	2022.11.04
Language of the proceedings:	EN
Internal distribution code:	D
Inter partes/ex parte:	Ex parte
EPC Articles:	
EPC Rules:	
RPBA:	Articles 12(2), (4), (6), 13(2) RPBA 2020
Other legal provisions:	
Keywords:	amendment to appeal case (no) – amendment to case (no) – late-filed request – should have been submitted in first-instance proceedings (yes) – exceptional circumstances (no)
Cited decisions:	G 0009/91, T 1224/15, T 0168/16, T 0682/16, T 1439/16, T 1480/16, T 1597/16, T 0494/18, T 0908/18, T 1151/18, T 2091/18, T 2243/18, T 2920/18, T 1792/19
Case Law Book:	V.A.4.2.1b), V.A.4.2.2d), V.A.4.5.6d), V.A.4.5.6k), 10th edition

In [T 1058/20](#) claim 1 of the new first auxiliary request, filed after notification of the summons to oral proceedings, was limited to only one of three alternative embodiments (alternative (iii)) claimed in claim 1 of the main request. The board, referring to case law cited in T 2920/18 and in T 494/18, held that the deletion of a claim or an alternative within a claim was to be regarded as an "amendment to the party's appeal case" within the meaning of Art. 13(2) RPBA 2020, and also an amendment in view of the requests on which the impugned decision was based (Art. 12(2) and (4) RPBA 2020). The board explained that the question of what could be defined as an "amendment to a party's appeal case" could be answered in the systematic context of the provisions on appeal proceedings. Art. 12(3) RPBA 2020 provided that the statement of grounds of appeal and the reply had to contain a party's complete appeal case. Accordingly, all requests had to be specified expressly at this stage. It followed from this that only requests filed with the party's statement of grounds of appeal or the reply formed part of a party's appeal case. Consequently, a new request filed afterwards with a set of claims different to that of the previous requests was usually to be regarded as an "amendment to a party's appeal case". In the board's view, whether the new request was to be qualified as an amendment (a

factual condition) was to be assessed in a first step without anticipating the criterion of procedural economy, which was only applied in a second step as a criterion of discretion when determining the legal consequence.

The board then assessed whether to admit the new first auxiliary request in exercise of its discretion under Art. 13(2) RPBA 2020. In the board's view exceptional circumstances which could justify the admittance of the new first auxiliary request were not present because the filing of a request limited to alternative (iii) would have been reasonable during the examining proceedings and the circumstances had not changed in view of the impugned decision or during the appeal proceedings. The principles underlying Art. 12(2), (4) and (6) RPBA 2020 could also be applied when assessing whether exceptional circumstances were present according to Art. 13(2) RPBA 2020, because an amendment that would not have been admitted at the beginning of the appeal proceedings (as it could and should have been submitted during the first-instance proceedings) could normally not be justified at a later stage of the appeal proceedings either.

The board distinguished the case from T 2920/18 and observed that in the case in hand refraining from the submission of the new request in the first-instance proceedings contravened procedural economy because the appeal could have been superfluous if the examining division had had the opportunity to assess the allowability of the new claim request. In this respect, the board pointed out that the principles of procedural economy are not to be assessed isolated from the course of the appeal proceedings but rather in view of the proceedings as a whole.

Finally, in response to the appellant's argument that the request should be admitted because it was clearly allowable, the board pointed out that prima facie allowability as such would not justify exceptional circumstances under Art. 13(2) RPBA 2020. Moreover, this assertion was not entirely accurate since at most the request would be allowable under Art. 123(2) EPC so that, if admitted, the board would remit the case to the examining division for further prosecution. The primary object of the appeal proceedings was to review the decision under appeal in a judicial manner (Art. 12(2) RPBA 2020; G 9/91, OJ 1993, 408, point 18 of the Reasons). However, in the case in hand, the filing of the new first auxiliary request did not aim to rectify an error in the decision but rather the appellant's failure to file a request in time. Admitting this request would not only be at odds with the purpose of the appeal proceedings but would also devalue the first-instance proceedings.

064-06-23



Contact

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

