



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 7 | 2023



Boards
of Appeal

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Abstracts of decisions

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1. Article 056 EPC | T 1779/19 | Board 3.3.06

Article: Article 056 EPC

Case Number: T 1779/19
Board: 3.3.06
Date of decision: 2023.01.11
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 (no) – reformulation of the technical problem – skilled person – implicit disclosure inevitable (no) – general or arbitrary alternative (no)

Cited decisions: T 0012/81, T 0666/89, T 0270/97

Case Law Book: [I.D.3.](#), [I.D.9.21.9a](#), 10th edition

[T 1779/19](#) concerned an appeal against the decision to reject the opposition against the European patent, which disclosed in claim 1 a "Method for preventing chlorine deposition on the superheater of a boiler in which a fuel with a chlorine content is burned, and to which boiler a compound with a sulphate content is fed in the superheater area [...] characterized in that the said compound is ferric(III) sulphate, $\text{Fe}_2(\text{SO}_4)_3$ and/or aluminium(III) sulphate, $\text{Al}_2(\text{SO}_4)_3$, and the said compound as a water solution and in a drop size of 1-100 μm ". The board identified document D5 as the closest prior art.

The appellant (opponent) argued that following the principles set out in T 666/89, the definition of a step of feeding a solution of ferrous sulphate in D5 implicitly encompassed feeding a solution of ferric sulphate, because Fe(III) spontaneously reacted in contact with air to give Fe(II), so that at least a portion of the ferrous sulphate would be in the form of ferric sulphate.

The board did not agree. With reference to T 12/81, T 666/89 and in particular T 270/97, the board stated that the key requirement for such an implicit disclosure was inevitability. To implicitly anticipate a given product, the prior art document must disclose a reaction carried out under specific conditions which would inevitably lead to the product in question. The board did not contest that ferrous sulphate was oxidised to ferric sulphate in the presence of air. There was however no basis to conclude how far this reaction would go in D5, which did not disclose a reaction but a solution of ferrous sulphate, and there was no information in D5 how this solution was made and how long and under which conditions it should be stored.

The presence of ferric sulphate was thus highly likely or even certain, but there was no way to conclude that this presence would go beyond trace levels.

The board further found that there was no evidence that the invention provided an improved effectiveness when compared to a method of preventing chlorine deposition using a ferrous sulphate solution as disclosed in D5. The proposed solution therefore did not successfully solve the problem presented in the patent. However, the board considered that the experiments in the patent at least demonstrated that the claimed method performed significantly better than other known alternatives. This implied that the claimed additives had been identified as particularly effective for the purpose of preventing chlorine deposition, so they could not be considered to be arbitrarily selected. Thus, the claimed subject-matter did not simply provide a (general or arbitrary) alternative, but rather an alternative which was highly effective when compared to other commonly used additives. The problem to be solved was therefore reformulated as the provision of an alternative method which ensured a high effectiveness in the prevention of chlorine deposition.

Considering obviousness, the board found that a skilled person seeking to solve the underlying problem of finding alternatives which were highly effective in preventing chlorine deposition would consult D4, and that in doing so it would consider using ferric sulphate as an additive in the method of document D5 without the need of inventive skills.

As to the obviousness of using a droplet size of 1 to 100 μm , the board noted that, since the patent did not indicate how the feature "a drop size of 1-100 μm " should be interpreted, all technically reasonable alternatives should be considered to be covered by the claim. The interpretation proposed by the proprietor was also rather broad, only excluding sprays with significantly coarse droplet sizes. It further acknowledged that the patent did not associate the droplet size with any specific technical effect, and that the examples of the patent did not even specify the droplet size in the tests, so this feature could only be considered as providing an alternative. The board concluded that the relevant question to assess the inventiveness of this feature was whether a skilled person starting from D5 would have considered spraying non-coarse droplets as an obvious alternative.

In view of the teachings in D5, the board concluded a skilled person would readily understand that coarse droplet sizes should be avoided and that the nozzles used in the relevant embodiment of figures 1 and 2 should be configured to form relatively small droplets. In doing so the skilled person would arrive at the droplet size range defined in claim 1 without exercising inventive skill. The subject-matter of claim 1 as granted was obvious and therefore not inventive in view of D5 combined with the teachings of D4, and so did not meet the criteria set out in Art. 56 EPC.

065-07-23

2. Article 056 EPC | T 1245/20 | Board 3.5.07

Article: Article 056 EPC

Case Number: T 1245/20

Board: 3.5.07

Date of decision: 2023.03.03

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 problem – graphical user interface

Cited decisions: G 0001/19

Case Law Book: [I.D.9.2.10](#), 10th edition

In [T 1245/20](#) the application related to methods of identifying an application type of unknown data that may be encountered during a data recovery process. The board held that the construction of the mapping according to the claimed invention was performed based on non-technical rather than technical considerations. The mapping itself was also considered to be non-technical. The board was also not convinced that there was a credible increase in the speed of the mapping of the retrieved data to a particular application type over the whole scope of the claim.

One question that arose was whether the method of claim 1 had the potential to cause technical effects. But the mapping and display of the data record in a respective column of the user interface resulting from the claimed method was not specifically adapted for any technical use (G 1/19). Since the board did not see any technical effect from the implementation of the claimed method in a computer system derivable over the whole scope of the claim, the claimed subject-matter did not achieve a technical effect over the prior art acknowledged in the application. Therefore, the subject-matter of claim 1 of the sole request lacked an inventive step.

066-07-23

3. Article 056 EPC | T 0211/21 | Board 3.3.09

| | |
|-------------------------------------|---|
| Article: | Article 056 EPC |
| Case Number: | T 0211/21 |
| Board: | 3.3.09 |
| Date of decision: | 2023.02.03 |
| 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 problem – obviousness – automation – human intervention |
| Cited decisions: | |
| Case Law Book: | I.D.9.2.10 , 10th edition |

In [T 211/21](#) the board held that the decision to carry out and monitor manufacturing processes automatically rather than involving the assistance of a skilled artisan, is taken balancing different factors. It has advantages and drawbacks. Automatic systems typically afford higher production rates, increased productivity and involve less labour costs. However, it is commonly recognised that, despite the higher labour costs, human intervention has other advantages: a skilled artisan can offer experience, technical ingenuity and abilities and perform tasks that automated systems cannot yet imitate. The skilled artisan can back up an automated system and, if necessary, override a pre-programmed system setting. This leads to increased flexibility and, possibly, increased accuracy of the manufacturing and monitoring activities. Thus, there are good reasons to enable human intervention in an automatic system.

Therefore, to complement automation with human intervention, providing means enabling a skilled artisan to actively intervene in an automated process for producing foods and to provide a backup to pre-programmed procedures was considered by the board to be an obvious measure. Including a user interface having two separate push-buttons to enable the skilled artisan to send a request for assistance and for triggering data transmission was also considered to be obvious by the board. User interfaces having touch buttons are commonly used in the field. Furthermore, the claimed user interface, push-buttons, control unit and remote processor performed the same functions implemented by the components of the automated systems of the

aforementioned prior-art documents. Therefore, the board held that the subject-matter of claim 1 of the main request did not involve an inventive step.

067-07-23

4. Article 114(2) EPC | T 1984/19 | Board 3.2.06

| Article: | Article 114(2) EPC |
|-------------------------------------|---|
| Case Number: | T 1984/19 |
| Board: | 3.2.06 |
| Date of decision: | 2023.01.31 |
| Language of the proceedings: | EN |
| Internal distribution code: | D |
| Inter partes/ex parte: | Inter partes |
| EPC Articles: | Articles 111(1), 114(2) EPC |
| EPC Rules: | Rule 111(2) EPC |
| RPBA: | Article 12(4) RPBA 2007, Articles 11, 12(2) RPBA 2020 |
| Other legal provisions: | |
| Keywords: | late submitted material – correct exercise of discretion (no) – document admitted by first instance (no) – document admitted (yes) – sufficiently reasoned (no) – remittal to the department of first instance (yes) – special reasons under Article 11 RPBA 2020 |
| Cited decisions: | G 0007/93, T 1557/05, T 1883/12 |
| Case Law Book: | IV.C.5. , IV.C.4.5.3 , V.A.3.4.3a), V.A.9.3.3 , V.A.9.4.4b), 10th edition |

In [T 1984/19](#) the board found that while an opposition division must have a certain freedom in admitting or disregarding late-filed evidence, the reasoning given in the contested decision for not admitting D16 into the opposition proceedings was insufficient in view of R. 111(2) EPC. From the decision and the minutes, the board was unable to comprehend which considerations had led the opposition division to the conclusion that the content of D16 did not go beyond the content of the documents on file and why D16 was considered not relevant for the outcome of the case, whether in view of novelty or inventive step.

With reference to G 7/93, the board stated that in order to ascertain whether the opposition division had exercised its discretion properly, it was essential for the board to know which principles the opposition division had taken into account and which interests it had balanced. The board could not however ascertain from the decision why the opposition division had found that D16 was not sufficiently relevant to outweigh any other considerations speaking against its admittance, if it had indeed made such considerations at all.

As to the sparse indications given by the opposition division as to why D16 was disregarded, the statement that D16 had been filed after the expiry of the period for filing an opposition was not part of the reasons for the discretionary decision, but a precondition for the exercise of any discretion. That D16 was not the only starting point used in one of several inventive

step attacks was not considered by the board to be constituting reasoning either. The board failed to see any connection between the relevance of a particular document and the number of other documents cited.

Regarding the opponent's (appellant's) statement that D16 did not contain any details with respect to the knitting structure, the fact that the closest prior art did not contain details with respect to the distinguishing feature was normally inherent to an inventive step attack and could not therefore have an impact on its relevance.

Finally, as to the opposition division's statement that D16 did not disclose more features than D1 or D2, the board found that determining whether late-filed documents were prima facie more relevant than those already on file was only one of several aspects that needed to be balanced when taking the discretionary decision to admit or not admit late-filed evidence into the proceedings. Other aspects included the point in time at which the evidence was first presented and the amount of time available for the other party to deal with it and prepare a meaningful reply, or the complexity of the new submission and the expected lengthening of the proceedings that its admittance would cause. It was not apparent from the contested decision (nor the minutes) whether the opposition division had considered any of these aspects. It was not even clear in which sense the opposition division had considered D16 as being less relevant than the documents already on file.

The board concluded that the opposition division's discretionary decision not to admit D16 into the proceedings was insufficiently reasoned on several levels. The contested decision was therefore to be set aside.

The board further considered that D16 was indeed prima facie relevant for assessing whether the subject-matter of claim 1 of the main request was novel and/or for assessing whether it involved an inventive step. For these reasons, the board did not exercise its discretion under Art. 12(4) RPBA 2007 to disregard evidence that was not admitted in the proceedings before the opposition division. D16 (and D16a) were thus in the proceedings (Art. 12(4) in conjunction with Art. 12(1) and (2) RPBA 2007).

On the question of remittal, the board was unconvinced by the appellant's (opponent's) argument that remitting the case would be detrimental to procedural economy. Procedural economy may always be negatively affected when remitting a case. However, it may or may not be outweighed by other interests, not least the interest of the parties to have their case heard by two instances as the respondent (patent proprietor) had argued, and in particular for both parties to be able to fully develop their arguments concerning the newly found prior art during the administrative proceedings before the opposition division. In light of the foregoing, which the board considered to constitute "special reasons" under Art. 11 RPBA 2020, the board availed itself of its power under Art. 111(1) EPC to remit the case to the opposition division for further prosecution.

068-07-23

5. Article 116 EPC | T 2432/19 | Board 3.2.06

| Article: | Article 116 EPC |
|-------------------------------------|--|
| Case Number: | T 2432/19 |
| Board: | 3.2.06 |
| Date of decision: | 2023.04.25 |
| Language of the proceedings: | EN |
| Internal distribution code: | B |
| Inter partes/ex parte: | Inter partes |
| EPC Articles: | Article 116 EPC |
| EPC Rules: | |
| RPBA: | Articles 15a, 23 RPBA 2020 |
| Other legal provisions: | |
| Keywords: | oral proceedings – in-person oral proceedings (yes) – videoconference equivalent alternative to in-person oral proceedings (no) – ratio decidendi of G 1/21 applicable only to general emergency situations (no) – right to oral proceedings in form of a videoconference (no) |
| Cited decisions: | G 0001/21, T 0758/20, T 0618/21 |
| Case Law Book: | III.C.7.3.2 , 10th edition |

In [T 2432/19](#), after the board had summoned the parties to oral proceedings at the EPO premises, the appellant (patent proprietor) requested that the oral proceedings be held by videoconference but did not give any reasons for this request. The respondent (opponent) invoked no reasons against holding oral proceedings by videoconference. Oral proceedings took place in person in April 2023.

The board stressed that while it was evident from Art. 15a(1) RPBA 2020 that the board had the discretion to decide whether to hold oral proceedings by videoconference, the decision G 1/21 put certain limits on how this discretion was to be exercised. The board found that the Enlarged Board had set out in G 1/21 the conditions under which a party's request for in-person proceedings may be denied. It had set out principles which followed the spirit and purpose of the Convention (Art. 23 RPBA 2020) and which had to therefore be taken into account when exercising discretion under Art. 15a RPBA 2020. The fact that Art. 15a RPBA 2020 had not been referred to specifically was of no relevance. While G 1/21 was to a large degree directed to the situation of a general emergency, the Enlarged Board's basic reasoning used in arriving at its final conclusion was quite general and unrelated to any general emergency considerations.

The board did not share the view expressed in T 618/21 with regard to Art. 15a RPBA 2020 that the exercise of discretion in deciding on the format of the oral proceedings was to be based on the criterion of the "appropriateness" of the format only. According to the board,

G 1/21 had established general criteria which needed to be taken into account for the denial of a request for in-person oral proceedings, which applied not only to a situation of general emergency, but were valid also in non-emergency times. The board recalled that G 1/21 stated that in-person oral proceedings were the optimum format and that videoconferences – at least according to the then state of technology – did not meet this standard, i.e. were not equivalent to in-person oral proceedings. The board stressed that these statements held true regardless of the existence of an emergency situation, i.e. even in 'normal times'. The board considered this to be the ratio decidendi underlying G 1/21, the validity of which was not limited to any emergency situation. The board concluded that the ratio decidendi underlying G 1/21, at least with regard to a party's request for in-person oral proceedings, could not be simply assigned to situations of general emergency but were instead generally valid.

The board pointed out that even in the circumstances of a general emergency, the Enlarged Board had still imposed strict conditions on the possibility of denying a party's wish to hold oral proceedings in-person. A fortiori, it was therefore hardly justifiable that less strict requirements could apply for denying parties in-person oral proceedings in times when there was no general emergency. Since videoconferences, at least according to current technology, could only provide a suboptimal form of communication, parties had a right to the optimum format for oral proceedings, i.e. in-person oral proceedings, that could only be denied under very limited conditions. It also followed from G 1/21 that parties did not have a right to a format that had deficiencies, i.e. parties could not force boards to conduct videoconferences instead of in-person oral proceedings.

The board cited G 1/21, in which a hearing in person was held to be the "gold standard". The board concluded that communicating via videoconference could not, at least for the time being, be put on the same level as communicating in person. The board could not recognise any improvements that could be said to provide the level of communication which was possible when all participants were physically present in the same room. Unlike the boards in T 758/20 and T 618/21, the board in the present case held that the situation had not changed since the issue of G 1/21. At the time of issuing the present decision, the parties relied on the same kind of hardware and software as were available at the time of G 1/21. Furthermore, no significant improvements that had increased "immediacy" to the level of in-person hearings could be recognised.

In the present case, and despite the party's request, the board did not change the format of the oral proceedings, which remained as summoned. The board reasoned among others with the complexity and the circumstances of the case; experience of appeal cases in the technical field of the case in question had also shown that a party wishing to explain functional effects of structural features could often do this more easily by use of the flip chart, gradually building up features whilst explaining them in a dynamic situation of use, and of course allowing the same sketches to be used by the opposing party(ies).

069-07-23

6. Article 116 EPC | T 0489/20 | Board 3.3.07

Article: Article 116 EPC

| | |
|-------------------------------------|--|
| Case Number: | T 0489/20 |
| Board: | 3.3.07 |
| Date of decision: | 2023.03.17 |
| 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(1) and (2) RPBA 2020 |
| Other legal provisions: | |
| Keywords: | oral proceedings – in-person oral proceedings (yes) – videoconference not considered appropriate – particular circumstances according to G 1/21 (no) |
| Cited decisions: | G 0001/21 |
| Case Law Book: | III.C.7.3.2 , 10th edition |

In [T 489/20](#) the board summoned for in-person oral proceedings. It then informed the parties that it would consider the arrangement for the oral proceedings to take place by videoconference if all parties agreed to such format, but that it was not in the position to arrange a video link for the attendance of an individual participant (the appellant (patent proprietor) had requested this for an accompanying person). Respondent-opponent 2 and respondent-opponent 3 did not consent to the oral proceedings being held in the form of a videoconference. Respondent-opponent 4 announced they would not attend the oral proceedings if they were held in person. The board decided that the oral proceedings were to be held in person in March 2023.

The board reasoned that according to Art. 15a(1) RPBA 2020 the board may decide to hold oral proceedings by videoconference if the board considers it appropriate to do so, either upon request by a party or of its own motion. In view of the disapproval to hold the oral proceedings by videoconference expressed by respondent-opponent 2 and respondent-opponent 3, and in the absence of any particular circumstances as mentioned in G 1/21 (point 49 of the Reasons), the board did not consider it appropriate to hold the oral proceedings by videoconference.

The board noted that under Art. 15a(2) RPBA 2020, a party, representative or accompanying person may, upon request, be allowed to attend by videoconference if

oral proceedings are scheduled to be held on the premises of the EPO. However, in the current case the board had not been in a position to arrange a video link for the attendance of individual participants.

070-07-23

7. Article 116 EPC | T 0618/21 | Board 3.2.01

Article: Article 116 EPC

| | |
|-------------------------------------|--|
| Case Number: | T 0618/21 |
| Board: | 3.2.01 |
| Date of decision: | 2023.03.29 |
| Language of the proceedings: | DE |
| Internal distribution code: | B |
| Inter partes/ex parte: | Inter partes |
| EPC Articles: | Article 116 EPC |
| EPC Rules: | |
| RPBA: | Article 15a RPBA 2020 |
| Other legal provisions: | |
| Keywords: | oral proceedings – oral proceedings by videoconference (yes) – videoconference considered appropriate – videoconference meanwhile equivalent alternative to in-person oral proceedings |
| Cited decisions: | G 0001/21 |
| Case Law Book: | III.C.7.3.2 , 10th edition |

In der Sache [T 618/21](#) entschied die Kammer, die mündliche Verhandlung im März 2023 in Form einer Videokonferenz abzuhalten. Der Beschwerdeführer stimmte dem nicht zu, sondern beantragte die Durchführung der Verhandlung in Präsenz.

Die Kammer wies darauf hin, dass Art. 15a VOBK 2020 der Kammer ein Ermessen gebe bei der Entscheidung, die mündliche Verhandlung von Amts wegen als Videokonferenz durchzuführen. Nach Ansicht der Kammer werden folgende Punkte aus dem Wortlaut des Art. 15a (1) VOBK 2020 deutlich: (a) Die Entscheidung obliegt der Kammer und nicht den Parteien. (b) Die Entscheidung, die Verhandlung als Videokonferenz durchzuführen, kann auch gegen den Willen der Parteien gefällt werden. (c) Es handelt sich um eine Ermessensentscheidung. (d) Das eingeräumte Ermessen ist orientiert an Zweckdienlichkeitsüberlegungen auszuüben. (e) Die Regelung nennt keinerlei zwingend erforderlichen Punkte, die bei der Ermessensausübung berücksichtigt werden müssen. Somit sind alle Gründe zu berücksichtigen und gegeneinander abzuwägen, die für oder gegen eine Videokonferenz sprechen. (f) Insbesondere aber enthält die Regelung keinen Hinweis darauf, dass sie ausschließlich im Fall des Vorliegens eines allgemeinen Notfalls anzuwenden ist.

Der Kammer zufolge impliziert der Begriff "zweckmäßig" in Art. 15a VOBK 2020, dass etwas zur Erreichung eines oder mehrerer angestrebter Zwecke grundsätzlich geeignet und darüber hinaus auch sinnvoll (sachdienlich) erscheint. Das Kriterium der Sachdienlichkeit

erfordere eine Gesamtabwägung aller relevanten Gesichtspunkte, die vorrangig auf objektiven Erwägungen beruhen sollte.

Dass auch eine als Videokonferenz durchgeführte mündliche Verhandlung grundsätzlich geeignet sein kann, die Ziele einer mündlichen Verhandlung (vgl. R 3/10) zu erreichen, habe die Große Beschwerdekammer in G 1/21 (Nr. 33-43 der Gründe) festgestellt. Der Umstand alleine, dass eine Partei eines der Formate ablehnt, könne schon nach dem Wortlaut des Art. 15a VOBK 2020 die Eignung nicht aufheben.

Im Rahmen der Sachdienlichkeitsabwägung berücksichtigte die Kammer alle für sie unmittelbar erkennbaren Vor- und Nachteile, insbesondere Gründe, die das Erscheinen der Parteien zu einer Präsenzverhandlung erschweren oder behindern könnten und Gründe, die geeignet wären, die Diskussion des Falles im Videoformat zu beeinträchtigen. Dabei hob sie hervor, dass eine Videokonferenz es den Parteien erlaube, die ansonsten anfallende Reisezeit sinnvoller zu verbringen, Kosten einzusparen und Umweltschäden zu verhindern. Gleichzeitig konnte die Kammer im konkreten Fall keine Nachteile einer Videokonferenz erkennen. Die Kammer befand, dass eine Videokonferenz sowohl im Regelfall, als auch im vorliegenden Fall eine annähernd gleichwertige Alternative zu einer Präsenzverhandlung darstelle, die es den Parteien ohne wesentliche Einschränkung ermögliche, ihren Standpunkt über den schriftlichen Vortrag hinaus erneut mündlich klarzumachen.

Die Kammer erläuterte ferner, dass Art. 15a VOBK 2020 weder höherrangigem Recht (Art. 116 EPÜ, Art. 113 EPÜ, Art. 6 EMRK), noch den wesentlichen Schlussfolgerungen in G 1/21 widerspreche. Sie hob hervor, dass Art. 15a VOBK 2020 die zum Vorlagezeitpunkt von G 1/21 bestehende Regelungslücke geschlossen habe. Sie wies auch darauf hin, dass die Schlussfolgerungen aus G 1/21 nicht mehr uneingeschränkt auf die Gegenwart angewandt werden könnten, da die Eingangsvoraussetzung der Entscheidung G 1/21 (und zwar der Qualitätsunterschied zwischen Videokonferenz und Präsenzverhandlung) nicht mehr gegeben sei. Die Große Beschwerdekammer habe auch nicht festgestellt, dass eine Präsenzverhandlung einer Videokonferenz grundsätzlich immer überlegen sei, sondern beschränkte sich auf die im Februar 2021 vorgefundene Situation. Die Kammer betonte jedoch auch, dass es auch zum gegenwärtigen Zeitpunkt noch Situationen geben könne, bei denen eine Videoverhandlung nicht als gleichwertig zu einer Präsenzverhandlung angesehen werden kann.

Art. 15a VOBK 2020 regle nunmehr auch Situationen ohne Notlage, die bewusst von der Großen Beschwerdekammer in G 1/21 ausgespart worden seien. Art. 15a VOBK 2020 habe das Ermessen der Kammern aus G 1/21 kodifiziert und verlange, dass eine Videokonferenz zumindest "zweckmäßig" sein muss, was letztlich als Synonym zu "sie ist geeignet" und "es gibt gute Gründe dafür" im Sinne der G 1/21 anzusehen sei. Bei der Ermittlung der "Eignung" und der "guten Gründe" obliege es den Parteien, Gründe für oder gegen eine mündliche Verhandlung, die ihrer Sphäre entstammen der Kammer zur Kenntnis zu bringen. Dies sei keine unzulässige Beweislastumkehr, sondern logisch zwingende Voraussetzung für eine nach Möglichkeit alle Gründe umfassende Entscheidung zur Form der Verhandlung.

071-07-23

8. Article 117 EPC | T 0042/19 | Board 3.2.01

| | |
|-------------------------------------|--|
| Article: | Article 117 EPC |
| Case Number: | T 0042/19 |
| Board: | 3.2.01 |
| Date of decision: | 2023.01.19 |
| Language of the proceedings: | EN |
| Internal distribution code: | B |
| Inter partes/ex parte: | Inter partes |
| EPC Articles: | Article 117 EPC |
| EPC Rules: | |
| RPBA: | Article 12(4) RPBA 2007 |
| Other legal provisions: | |
| Keywords: | evidence – evaluation of evidence by the department of first instance – review |
| Cited decisions: | G 0007/93, T 1418/17, T 1604/16 |
| Case Law Book: | III.G.4.2.2b , 10th edition |

In [T 42/19](#) the board summarised in its catchword the extent to which the board's power extended to reviewing the first instance decision in respect of the evaluation of evidence:

“1. A board's power to review appealed decisions is not limited to points of law but extends to points of facts (in agreement with T 1604/16).

2. However, it is settled case law that a board is not obliged to take all the evidence anew and that parties do not have the right to have the taking of evidence repeated at their request before the board.

3. The principle of free evaluation of evidence, meaning that there are no firm rules on the probative value of the various types of evidence but that the deciding body is entrusted with weighing up all the evidence and basing its decision on what it is then satisfied has been established, implies a degree of freedom comparable to the one referred to by the Enlarged Board of Appeal in decision G 7/93, Reasons 2.6.

4. Thus, it is wise to similarly respect this freedom, especially when taking into account that a board, except when only reviewing documentary evidence, does not have the same first-hand impression of the probative value of a means of evidence as a department of first instance that has itself heard a witness or expert or inspected an object.

5. Although the board is not limited in its decision, it normally seems useful to apply the test set out in decision T 1418/17, Reasons 1.3: Unless the law has been misapplied (e.g. application of the wrong standard of proof), a board of appeal should overrule a department

of first instance's evaluation of evidence and replace it with its own only if it is apparent from that department's evaluation that it: (i) disregarded essential points, (ii) also considered irrelevant matters or (iii) violated the laws of thought, for instance in the form of logical errors and contradictions in its reasoning.

6. The evaluation of evidence only refers to establishing whether an alleged fact has been proven to the satisfaction of the deciding body. The discretion-like freedom is restricted to this question and does not extend to the further question of how the established facts are to be interpreted and what the legal consequences are (see Reasons 3.2 to 3.6).”

In the case at issue, the appellant (opponent) requested a reversal of the opposition division's decision that an alleged public prior use of an insulin injection device marked named GensuPen had not been sufficiently proven.

The board recalled in its reasons the principles which can be found in the catchword above and also stated that the boards usually just reviewed the way in which the evidence was taken by the departments of first instance and, where they did not find any deficiencies, applied the law on the basis of the facts found in the decisions. A board, being a deciding body as well, was also entrusted with the weighing of evidence under the principle of free evaluation of evidence. As a consequence, it could not be excluded that a board might come to a different conclusion than the body that issued the impugned decision. But being under the obligation to give reasons for its decision, the board had to be able to convincingly demonstrate where the competent division had erred. In this respect the test set out in T 1418/17 gives valuable guidance. In the present case none of the circumstances which would justify a review could be identified in the first instance's reasoning. Notably, the balance of probabilities was the correct standard of proof. And concerning the witness Ms S., relevant information was completely missing (for example, in what capacity she had accessed the consultation room of the medical centre, the precise circumstances under which she had obtained the GensuPen, whether she was a member of the public, why she wrote on the same day a declaration that was used six years later), casting a shadow on the plausibility of her statement, and justified to the opposition division that the public prior use, even under the lower standard of proof of the balance of probabilities, was not sufficiently proven because the circumstances were not fully and clearly specified. This lack of factual basis did not substantially change with the new submissions in appeal proceedings. And without this fundamental information, it was irrelevant whether the burden of proof rested on the respondent (proprietor) that certain persons like hospital personal or patients in a study were bound by a confidentiality agreement. The board did not see any reason to overrule the decision concerning the alleged prior use of GensuPen and therefore confirmed the opposition division's conclusion.

In exercise of the discretion provided by Art. 12(4) RPBA 2007, the board further decided to disregard the appellant's request to hear another witness submitted at the appeal stage to fill the gaps identified by the opposition division, since doubts and objections in this respect were already raised by the proprietor (respondent) during the written opposition proceedings.

072-07-23

9. Article 123(2) EPC | T 1099/21 | Board 3.3.02

Article: Article 123(2) EPC

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| Case Number: | T 1099/21 |
| Board: | 3.3.02 |
| Date of decision: | 2023.03.15 |
| Language of the proceedings: | EN |
| Internal distribution code: | D |
| Inter partes/ex parte: | Inter partes |
| EPC Articles: | Articles 083, 084, 100(c), 123(2) EPC |
| EPC Rules: | |
| RPBA: | |
| Other legal provisions: | |
| Keywords: | amendments – claims – grounds for opposition – added subject-matter – deletion of features – extension beyond the content of the application as filed |
| Cited decisions: | |
| Case Law Book: | II.E.1.4.3 , II.A.3.1. , 10th edition |

In [T 1099/21](#), claim 1 of the application as originally filed essentially related to a coating composition comprising a microencapsulated biocide and a free (i.e. not microencapsulated) isothiazolone biocide or antifouling agent.

The feature relating to the upper concentration limit of the free isothiazolone biocide or antifouling agent was defined functionally in terms of a result to be achieved ("up to a concentration that does not reduce the glass transition temperature of the film forming polymer by more than 20°C").

The board concluded that the functionally defined upper limit of the concentration range for the free isothiazolone biocide was set out as being necessary for solving the technical problems addressed by the application as filed, namely maintaining the integrity of the paint film and avoiding prolongation of the drying time of the coating composition. Thus, as correctly pointed out by the appellant, this functional feature was disclosed in the application as filed as an essential feature of the invention and did not merely relate to a preferred embodiment thereof.

Claim 1 of the main request was amended by deleting the functionally defined upper limit of the concentration range for the free isothiazolone biocide from claim 1 as filed. As a result, the upper limit was defined numerically ("to 15% by weight of the film forming polymer or binder solids").

The board explained that, according to established case law, deleting from an independent claim a feature which the application as filed consistently presented as being an essential feature of the invention resulted in an extension of the claimed subject-matter beyond the content of the application as filed.

The respondent argued that the functional feature of claim 1 as filed had not been deleted but replaced by the numerical upper limit. The board did not agree. It was very readily conceivable, and this was acknowledged by the respondent at the oral proceedings, that claim 1 of the main request encompassed film forming polymers for which amounts of free isothiazolone biocides close or identical to the numerical upper limit of 15% actually reduced the glass transition temperature by more than 20°C, contrary to claim 1 as filed.

The respondent also submitted that the plasticising effect of certain biocides on film forming polymers was well-known to the skilled person. The wording of claim 1 of the main request stated the concentration of the free isothiazolone biocide in relation to the weight of the film forming or binder solids. This was a pointer to the skilled person that the coating composition of claim 1 of the main request should not contain too much free isothiazolone biocide, depending on the film forming polymer actually used. For this reason, compositions in which, for example, concentrations of 15% of free isothiazolone biocide caused a Tg reduction of more than 20°C did not actually fall within the subject-matter of claim 1. The board disagreed. The subject-matter of a claim was determined by its wording, which in the present case provided for an explicit upper limit of 15% for any film forming polymer.

Thirdly, the respondent argued that the functional feature in claim 1 as filed could not be meaningfully interpreted by the skilled person as defining a boundary. The replacement of the functional feature in claim 1 as filed by the numerical upper limit in claim 1 of the main request was made to address the examining division's objections in this respect under Art. 83 and 84 EPC. The board did not agree with this contention. It was already clear from the wording of the functional feature that it was intended to define an upper limit for the concentration of the free isothiazolone biocide in the coating composition. The fact that claim 1 as filed did not define an exact numerical upper limit might be due to the fact that the actual upper limit depended on the composition under consideration. However, any lack of clarity that might arise from an ambiguity in an application as filed was to the detriment of a patent proprietor, who was ultimately responsible for the drafting of the application as filed and its claims. The fact that a feature in the application as filed was unclear could not therefore justify or excuse the complete deletion of the unclear feature or its replacement by another feature if this resulted in an extension beyond the content of the application as filed. In fact, what prompted a patent proprietor to make a particular amendment to the claims (in this case to address the examining division's objections) could not have any influence on the outcome of the assessment of the ground for opposition under Art. 100(c) EPC.

The board explained that the above reasoning for claim 1 of the main request applied to all the auxiliary requests. None of the auxiliary requests were allowable because the subject-matter of claim 1 of each of the auxiliary requests extended beyond the content of the application as filed.

073-07-23

10. Article 125 EPC | T 1128/19 | Board 3.3.04

Article: Article 125 EPC

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| Case Number: | T 1128/19 |
| Board: | 3.3.04 |
| Date of decision: | 2023.03.10 |
| Language of the proceedings: | EN |
| Internal distribution code: | D |
| Inter partes/ex parte: | Ex parte |
| EPC Articles: | Articles 076(1), 097(2), 125 EPC |
| EPC Rules: | |
| RPBA: | |
| Other legal provisions: | |
| Keywords: | general principles – double patenting (yes) – same subject-matter (yes) – divisional application |
| Cited decisions: | G 0004/19 |
| Case Law Book: | II.F.5.3. , 10th edition |

[T 1128/19](#) was an appeal against the decision of the examining division to refuse the European patent application. The application was a divisional application of an earlier application which was subsequently granted (the parent patent). The examining division had held that the main request and auxiliary requests 1 to 3 were not allowable under Art. 97(2) EPC together with Art. 125 EPC because they contravened the principle of prohibition of double patenting with respect to the parent patent.

The board observed that, since the filing of the appeal, decision G 4/19 had been issued. In this decision, the Enlarged Board had held that:

"1. A European patent application can be refused under Articles 97(2) and 125 EPC if it claims the same subject-matter as a European patent which has been granted to the same applicant and does not form part of the state of the art pursuant to Article 54(2) and (3) EPC.

2. The application can be refused on that legal basis, irrespective of whether it a) was filed on the same date as, or b) is an earlier application or a divisional application (Article 76(1) EPC) in respect of, or c) claims the same priority (Article 88 EPC) as the European patent application leading to the European patent already granted".

The board stated that the parent patent had been granted to the same applicant as the applicant of the application under appeal. To decide if the application under appeal had been correctly refused because it contravened the principle of prohibition

of double patenting, the board had to determine whether it claimed the same subject-matter as the parent patent.

According to the board, claim 1 of the main request was a combination of claims 1 and 4 and a single embodiment (aa) from claim 5 of the parent patent. The wording of claim 1 of the application under appeal differed from that of the above-mentioned claims of the parent patent in that it specified that the first binding domain "is an antigen-interaction site". The subject-matter of claim 1 of the main request was an explicit alternative defined in the claims of the parent patent. The appellant had submitted that claim 1 of the main request related to an antibody whereas claim 1 of the parent patent was not defined to be an antibody. In other words, the subject-matter of claim 1 was alleged to be a narrower selection from the subject-matter of claim 1 of the parent patent. The board did not find this argument convincing because the claim was for "a bispecific single chain antibody molecule". There was no technical reason to differentiate between an antibody and an antibody molecule, since it went without saying that an antibody was a molecule. The same considerations applied to claim 1 of auxiliary request 1, which was identical to claim 1 of the main request.

In the board's opinion, claim 1 of auxiliary request 2 differed from claim 1 of the main request in that the subject-matter (and wording) of granted dependent claims 2 and 3 had been incorporated into claim 1. This subject-matter was therefore also an explicit embodiment of the granted claims. Claim 1 of auxiliary request 3 differed from claim 1 of the parent patent in that embodiments from dependent claim 7 had been incorporated. In addition, as was the case for claim 1 of the main request, the wording "which is an antigen-interaction site" had been added.

The board concluded that the main request and auxiliary requests 1 to 3 were not allowable because they claimed the same subject-matter as claimed in the parent patent.

074-07-23

11. Article 125 EPC | T 2907/19 | Board 3.4.03

Article: Article 125 EPC

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| Case Number: | T 2907/19 |
| Board: | 3.4.03 |
| Date of decision: | 2023.03.14 |
| Language of the proceedings: | EN |
| Internal distribution code: | D |
| Inter partes/ex parte: | Ex parte |
| EPC Articles: | Articles 076(1), 097(2), 125 EPC |
| EPC Rules: | |
| RPBA: | Article 15(1) RPBA 2020 |
| Other legal provisions: | |
| Keywords: | general principles – double patenting (no) – same subject-matter (no) – divisional application |
| Cited decisions: | G 0004/19 |
| Case Law Book: | II.F.5.3. , 10th edition |

[T 2907/19](#) was an appeal against the decision of the examining division to refuse the European patent application. The invention concerned a method of manufacturing a semiconductor device on a silicon carbide substrate. The application was a divisional application of a parent European application for which a European patent (the parent patent) was granted. The fifth auxiliary request was filed after notification of the summons to attend oral proceedings. It was admitted into the appeal proceedings as, in the board's opinion, it overcame all objections raised by the board in its communication under Art. 15(1) RPBA 2020 and those raised by the examining division in the impugned decision.

The board concluded that the fifth auxiliary request did not contain unallowable added matter and that it met the requirements of clarity and inventive step.

The board then considered whether the prohibition of double patenting was pertinent. It recalled that according to the headnotes of G 4/19, a European patent application could be refused under Art. 97(2) and 125 EPC if it claimed the same subject-matter as a European patent which had been granted to the same applicant and did not form part of the state of the art pursuant to Art. 54(2) and (3) EPC. The application could be refused on that legal basis, irrespective of whether it a) was filed on the same date as, or b) was an earlier application or a divisional application (Art. 76(1) EPC) in respect of, or c) claimed the same priority (Art. 88 EPC) as the European patent application leading to the European patent already granted. The board pointed out that the definition of the "same subject-matter" was not the subject of the referral and of decision G 4/19.

In the board's opinion, claim 1 according to the fifth auxiliary request differed from claim 1 of the parent patent by the step of separating the epitaxial layer from the carrier substrate. Hence, independent claim 1 of the fifth auxiliary request was different from independent claim 1 of the granted parent application and thus did not define the same subject-matter. The prohibition of double patenting was therefore not pertinent to the claims of the fifth auxiliary request. This was not precluded by the fact that claim 1 of the fifth auxiliary request corresponded to dependent claim 2 of the granted parent application.

The case was remitted to the examining division with the order to grant a patent based on the application in the version according to the appellant's fifth auxiliary request.

075-07-23

12. Rule 088(2) EPC | T 2024/20 | Board 3.3.05

Article: Rule 088(2) EPC

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|-------------------------------------|---|
| Case Number: | T 2024/20 |
| Board: | 3.3.05 |
| Date of decision: | 2022.10.07 |
| Language of the proceedings: | FR |
| Internal distribution code: | D |
| Inter partes/ex parte: | Inter partes |
| EPC Articles: | |
| EPC Rules: | Rules 088(2), 097(2) EPC |
| RPBA: | |
| Other legal provisions: | |
| Keywords: | decision fixing amount of costs – preparation of oral proceedings – amount of hours |
| Cited decisions: | T 0161/17 |
| Case Law Book: | III.R.3.4. , 10th edition |

Dans l'affaire [T 2024/20](#) le recours de la titulaire (requérante) concernait la décision de la division d'opposition fixant le montant des frais de la procédure d'opposition selon la règle 97(2) CBE. Le recours ne concernait pas la répartition des frais de la procédure d'opposition, cette décision étant passée en force de chose jugée. Par conséquent, la chambre pouvait seulement vérifier si la fixation du montant des frais correspondait à la répartition des frais et si la présomption des frais était établie (règle 88(2) CBE).

Dans la décision fixant le montant des frais, la division d'opposition avait décidé que les frais de préparation de la procédure orale, le voyage à la Haye pour la procédure orale et la nuit d'hôtel avant la procédure orale étaient à payer par la titulaire. La chambre a estimé que la seule conclusion qui pouvait être déduite de cette décision était que les frais de préparation de la procédure orale étaient à rembourser alors que les frais de participation ne l'étaient pas. Les spéculations selon lesquelles la division d'opposition avait voulu implicitement inclure les frais de participation et qu'elle s'était seulement mal exprimée dans sa décision ne pouvaient pas justifier qu'une décision contraire au texte de la décision attaquée soit prise.

La requérante avait fait valoir qu'une journée était suffisante pour préparer la procédure orale. La chambre a noté que cette opinion était en désaccord avec toutes les informations et pièces justificatives soumises par les opposantes 2-4. De plus, rien ne démontrait qu'une journée de travail aurait permis de préparer la procédure orale dans le cas d'espèce, cette opinion de la requérante étant seulement basée sur

une présomption. En tenant compte de l'ampleur du dossier, de la date de la réponse de la titulaire aux oppositions, de l'avis préliminaire de la division d'opposition (février 2017), de la date de la procédure orale (30 mai 2018) et du temps écoulé entre les deux, il semblait qu'une journée de travail n'était pas suffisante pour se familiariser à nouveau avec le dossier et surtout pour préparer diligemment le dossier pour la procédure orale.

La requérante avait aussi allégué qu'une préparation de 30 heures, indiquée par l'opposante 4, semblait exagérée. La chambre a considéré qu'elle n'avait pas de raison de douter de l'exactitude des données fournies par l'opposante 4. L'opposante 2 avait indiqué un temps de préparation de 22,5 heures et l'opposante 3 de 20,5 heures ce qui était certes différent du nombre d'heures indiqué par l'opposante 4, mais toujours largement supérieur à un jour de préparation comme soutenu par la requérante. Or, il est bien connu que selon l'importance d'une même affaire pour l'une ou l'autre partie, le temps investi pour préparer une procédure orale peut varier. La chambre n'avait pas d'indications concrètes permettant de mettre en doute l'exactitude des chiffres fournis par l'opposante 4.

La chambre a annulé la décision attaquée et a jugé que la requérante devait rembourser 6827,77 € à l'opposante 2, 7207,10 € à l'opposante 3 et 10605,27 € à l'opposante 4.

076-07-23

13. Rule 142 EPC

| T 0956/19

| Board 3.3.04

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| Article: | Rule 142 EPC |
| Case Number: | T 0956/19 |
| Board: | 3.3.04 |
| Date of decision: | 2023.02.17 |
| Language of the proceedings: | DE |
| Internal distribution code: | D |
| Inter partes/ex parte: | Inter partes |
| EPC Articles: | Article 099(1) EPC |
| EPC Rules: | Rules 084(2), 142 EPC |
| RPBA: | |
| Other legal provisions: | |
| Keywords: | interruption of proceedings – admissibility of opposition (yes) – interruption of opposition proceedings applies from time of effective filing of opposition, but cannot exclude it |
| Cited decisions: | G 0009/93, G 0001/10, T 0854/12, T 0054/17 |
| Case Law Book: | III.D.4.8. , IV.C.2.2.2. , 10th edition |

In [T 956/19](#) machte der Beschwerdeführer I (Patentinhaber) mit seiner Beschwerde geltend, dass die Einsprüche der Einsprechenden 1 und 2 (Beschwerdeführer II und III) nicht wirksam eingelegt worden seien. Er argumentierte im Wesentlichen, dass die Einsprüche während einer nachträglich festgestellten Unterbrechung des Einspruchsverfahrens nach R. 142 (1) b) EPÜ und damit außerhalb einer laufenden Einspruchsfrist eingereicht worden seien. Nach Ansicht des Beschwerdeführers I hätten die Einsprüche nach Wiederaufnahme des Einspruchsverfahrens erneut innerhalb der gemäß R. 142 (4) EPÜ von Neuem laufenden Einspruchsfrist eingereicht werden müssen.

Die Kammer befand, dass – selbst wenn sich die Rechtsfolgen der Unterbrechung bereits aus dem Vorliegen der Unterbrechungsvoraussetzungen und nicht erst aus deren Feststellung und Eintragung ergeben (vgl. T 854/12) – diese Folgen nicht die dazwischen eingelegten Einsprüche betreffen können, welche die Zuständigkeit des EPA und die Anhängigkeit des Verfahrens begründen. Die "Unterbrechung des Verfahrens" im Sinne von R. 142 EPÜ könne mit anderen Worten nicht die "Beseitigung des Verfahrens" zur Folge haben, da dies auch eine Wiederaufnahme ausschließen würde. Wie die Beschwerdeführer II und III zutreffend ausgeführt hätten, stelle eine laufende Einspruchsfrist selbst noch kein anhängiges Verfahren vor dem EPA dar, sondern lediglich eine zeitliche Schranke für die Einlegung des Einspruchs. Eine Unterbrechung könne daher frühestens ab dem Zeitpunkt der

wirksamen Einlegung der Einsprüche gelten, diese aber nicht ausschließen. Insofern verkenne die Feststellung im Schreiben der Rechtsabteilung des EPA vom 15. Oktober 2014, wonach das Einspruchsverfahren ab dem 27. Dezember 2013 unterbrochen wurde, das Erfordernis eines anhängigen Verfahrens. Nach richtiger Auffassung sei das Einspruchsverfahren erst nach dessen Anhängigkeit durch rechtswirksame Einlegung der Einsprüche unterbrochen worden.

Die Kammer betonte, dass der Auffassung des Beschwerdeführers I auch deswegen nicht gefolgt werden könne, weil R. 142 (4) EPÜ nicht auf Fristen – wie die Einspruchsfrist nach Art. 99 (1) EPÜ – anwendbar sei, welche weder vom Anmelder noch vom Patentinhaber einzuhalten sind (s. bezogen auf die Einspruchsfrist G 9/93). Hierfür spreche schon der Wortlaut der R. 142 EPÜ. Da die Handlungsunfähigkeit anderer Verfahrensbeteiligter keinen Grund für eine Unterbrechung darstelle, blieben Fristen, die diesen Verfahrensbeteiligten gegenüber laufen, bei der Anwendung von R. 142 (4) EPÜ außer Betracht. Somit könnten bei nachträglich festgestellter Unterbrechung nur diejenigen Rechtsfolgen, die vom Beginn der Unterbrechung bis zu deren späterer Feststellung eingetreten sind, als unbeachtlich angesehen werden, welche sich aus dem Säumnis unterbrochener Fristen ergeben, die vom Anmelder oder Patentinhaber bzw. dessen Vertreter einzuhalten waren.

Die vorstehende Interpretation decke sich auch mit dem Normzweck. Die Unterbrechung solle einen Rechtsverlust oder nachteilige Verfahrensentwicklungen wegen eines Fristversäumnisses verhindern, wenn ein Anmelder oder Patentinhaber oder dessen Vertreter aus den in R. 142 (1) a) bis c) EPÜ genannten Gründen verhindert ist, Verfahrenshandlungen rechtzeitig vorzunehmen. Die Unterbrechung diene mithin dem Schutz des Anmelders oder Patentinhabers (T 54/17). R. 142 EPÜ schließe Einsprechende aber gewollt nicht als Schutzadressaten ein: Stirbt ein Einsprechender oder verliert er seine Geschäftsfähigkeit, so bestimmt R. 84 (2) EPÜ, dass das Einspruchsverfahren ohne die Beteiligung seiner Erben oder gesetzlichen Vertreter von Amts wegen fortgesetzt werden kann. Zum Schutz des Patentinhabers sei ausreichend, dass R. 142 (4) EPÜ während einer Unterbrechung des Verfahrens verhindert, dass Verfahrenshandlungen von Einsprechenden Fristen für den Patentinhaber in Gang setzen. Daher schließe auch der Normzweck eine Unterbrechung der Einspruchsfrist aus, soweit diese nach (frühzeitigem) Einlegen eines Einspruchs und Vorliegen eines Unterbrechungsgrunds noch laufen sollte.

Die Kammer schlussfolgerte, dass die am letzten Tag der Einspruchsfrist nach Art. 99 (1) EPÜ eingereichten Einsprüche der Einsprechenden 1 und 2 fristgerecht und rechtswirksam eingelegt worden und mithin zulässig seien. Die Beschwerde des Beschwerdeführers I wurde zurückgewiesen.

077-07-23

14. Article 13(2) RPBA 2020 | T 0218/20 | Board 3.2.04

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| Article: | Article 13(2) RPBA 2020 |
| Case Number: | T 0218/20 |
| Board: | 3.2.04 |
| Date of decision: | 2022.12.15 |
| Language of the proceedings: | EN |
| Internal distribution code: | D |
| Inter partes/ex parte: | Inter partes |
| EPC Articles: | |
| EPC Rules: | |
| RPBA: | Articles 12(2), 12(4), 13(2) RPBA 2020 |
| Other legal provisions: | |
| Keywords: | amendment to case – requests – amendment within meaning of Art. 12(4) RPBA 2020 – fair and appropriate reaction – amendment to appeal case (no) – reordering of requests – lack of convergence |
| Cited decisions: | |
| Case Law Book: | V.A.4.2.2j , V.A.4.3.4 , 10th edition |

In [T 218/20](#) the respondent (proprietor) initially requested as main request that the appeal be dismissed and alternatively that the patent be maintained on the basis of one of the auxiliary requests 1 to 5, first filed together with the reply to the grounds of appeal. The board accepted that the latter requests had been filed in response to new inventive step objections first raised in the oral proceedings before the opposition division. In the board's view (already outlined in its unchallenged preliminary opinion), there was no need at that moment to file any further auxiliary requests as the opposition division was not convinced by these objections. Thus, the respondent had availed itself of the first opportunity to respond to these attacks. The board further held that the requests seemed to be fair and appropriate reactions and therefore justified in the sense of Art. 12(4) RPBA 2020.

Moreover, the board did not consider changing the original order of the requests filed with the reply to the grounds of appeal – especially promoting the original fourth auxiliary request to main request – as an amendment to the respondent's (proprietor's) appeal case. The appellant had argued that this new main request should not be admitted since changing the original order of the requests at the beginning of the oral proceedings before the board represented an amendment falling under Art. 13 RPBA 2020. The appellant had also argued that the new main request was not clearly allowable and that the new order of requests resulted in non-

converging requests. The board, however, did not see how merely changing the order of requests that were all filed as early as possible in the appeal, and which the parties and the board had had ample opportunity to consider, should mean that the much stricter provisions of Art. 13 RPBA 2020 had to apply for their admission. In the case in hand the subject of the proceedings and the issues raised had clearly not changed. Indeed, promoting a lower, more limited request to main request could benefit procedural economy: if the newly promoted request was held allowable, issues raised against previously higher requests would become moot. If not, it could (at worst) mean that the same issues would have to be discussed, possibly in a different order. The lack of convergence of the remaining now lower ranking auxiliary requests with the present request could play no role in the admission of the higher-ranking request.

The board concluded from the above that the relevant provisions for admission remained those of Art. 12(2) and 12(4) RPBA 2020. Thus, the criteria mentioned in Art. 13 RPBA, such as clear allowability, did not apply. The board decided to admit the main request under Art. 12(2) and (4) RPBA 2020. The board maintained the patent in amended form according to the main request.

078-07-23



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