



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 8 | 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 1618/19 Board 3.4.03	1
Article 056 EPC	T 2565/19 Board 3.3.04	3
Article 056 EPC	T 2852/19 Board 3.4.03	5
Article 056 EPC	T 0366/20 Board 3.5.07	6
Article 056 EPC	T 0814/20 Board 3.5.06	8
Article 076 EPC	T 0795/21 Board 3.3.07	9
Article 084 EPC	T 1354/18 Board 3.5.04	11
Article 084 EPC	T 2391/18 Board 3.2.03	13
Article 084 EPC	T 2565/19 Board 3.3.04	15
Article 084 EPC	T 2968/19 Board 3.2.03	17
Article 087(1) EPC	T 0411/19 Board 3.3.04	19
Article 113 EPC	T 1558/21 Board 3.2.04	21
Rule 139 EPC	T 0695/18 Board 3.5.03	23
Rule 139 EPC	T 1558/21 Board 3.2.04	25

1. Article 056 EPC | T 1618/19 | Board 3.4.03

Article 056 EPC

Case Number	T 1618/19
Board	3.4.03
Date of decision	2023.02.28
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 – mixture of technical and non-technical features – simulations – direct link with reality
Cited decisions	G 0001/19
Case Law Book	I.D.9.2.11b , 10th edition

In [T 1618/19](#) the claimed subject-matter related to a concrete apparatus, namely a blending control system in a refinery, and a corresponding method. The claimed blending control apparatus/method comprised a computer modelling apparatus/method. The modelling was performed for an active refinery process in an actual refinery. The feeding of the model with the input parameters (flow and product parameters of the "rundown components supplied from the splitter" and refinery product commitments) as well as the direct conversion of the simulation results ("blend recipes", "blend events", "blend timing", "split ratio") into output signals for the control of the blender and splitter in the refinery process could be considered technical inputs / outputs according to G 1/19, OJ 2021, A77, point 85 of the Reasons, and were therefore technical or have a technical effect.

The feeding of process parameters of a running process, i.e. the refinery process, into the simulation and the conversion of calculated process parameters into control signals were thus indications of a "direct link with physical reality" (G 1/19) and of a "further technical effect" that goes beyond the mere technical implementation of the algorithm in a computer (G 1/19). Consequently, it was irrelevant whether the final step of implementing the optimisation results by means of control signals, i.e. to the splitter and blender, was explicitly claimed (as would be recommended in principle according to G 1/19), if the skilled person understands from the wording of the claim, that the simulation results were directly converted into control signals of the splitter

and blender, as was the case here. Consequently, the board held that the entire subject-matter of claims 1 and 6 was technical.

079-08-23

2. Article 056 EPC | T 2565/19 | Board 3.3.04

Article 056 EPC

Case Number	T 2565/19
Board	3.3.04
Date of decision	2022.11.29
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 (no) – try and see situation
Cited decisions	
Case Law Book	I.D.7.2. , 10th edition

See also abstract under Article 84 EPC.

In [T 2565/19](#) the board identified the problem to be solved as the provision of a method which can be used to discriminate between a TRH receptor sub-type in human cortex from one in human pituitary. The question to be answered in assessing the obviousness of the claimed method was whether the skilled person starting from the disclosure in document D2 and seeking to solve the technical problem formulated above, would have carried out the differential binding experiments disclosed in document D2 on human tissue.

The board noted that in some decisions, especially in the field of biotechnology, the boards had asked whether in the cases in point it was obvious for the skilled person to try a suggested approach, route or method with a reasonable expectation of success. However, in the present case, the board did not consider this to be the right approach.

In the case in hand the appellant (applicant) argued that the skilled person had to make at least four choices as to which steps to carry out. In view of the uncertainty inherent in each choice, the skilled person could not have considered that there was a reasonable expectation of success in finding a human homologue of a potential rat receptor. Further uncertainty was present because at the relevant date, the skilled person assumed that in humans, in contrast to the situation in rats, only one receptor sub-type was present. The board considered that the importance of research on humans in a medical context would have led the skilled person to repeat the

experiments done in rats in document D2 in humans, even in the face of alternative explanations for the results and even in the face of the knowledge that only one type of TRH receptor had been found in humans. This consideration was similar to the situations described in the case law where "neither the implementation nor the testing of an approach suggested by the prior art involves any particular technical difficulties". In such circumstances it had been held that the skilled person would have at least adopted a "try and see" attitude.

The appellant had also argued that the skilled person, considering applying the methods disclosed in document D2 to human tissue, would have faced difficulties obtaining and working with human tissue due to the fact that it had to be obtained post-mortem and because many variables affected the quality of such tissue, as well as because of anatomical differences between rat and human tissue.

The board was not convinced by these arguments either. It accepted it was common knowledge in the art that working with post-mortem human tissue and brain tissue in particular was associated with particular practical problems. However, given that the skilled person was seeking to replicate an animal model in humans, they had no choice but to turn to human tissue.

In view of the above considerations, the board concluded that the subject-matter of claim 1 lacked an inventive step as too did the auxiliary requests.

080-08-23

3. Article 056 EPC | T 2852/19 | Board 3.4.03

Article 056 EPC

Case Number	T 2852/19
Board	3.4.03
Date of decision	2023.01.26
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 (no) – mixture of technical and non-technical features – technical effect
Cited decisions	T 0279/05
Case Law Book	I.D.9.2.11 , 10th edition

In [T 2852/19](#), the invention related to optimising the occupancy of an event. The aim was to avoid seats remaining empty if visitors could not reach the event location in time. The invention proposed to automatically determine whether visitors to an event were in a defined area at a certain distance from the venue. GPS data from visitors' cell phones was used for this purpose. If ticket buyers were not in said area shortly before the start of the event, an alert was sent to them, and their ticket was resold in case of cancellation.

The board held that there were two effects: (i) was optimising the seat occupancy; and (ii) was to increase the profit by reselling seats shortly prior to the event in case a visitor had cancelled its venue. Effect (i) was held to be technical. Effect (ii) was held to be non-technical. The problem was therefore formulated as optimising the seat occupancy and prompting the user to indicate whether they plan to attend the event and offer the seat for sale. The board found, inter alia, that it was obvious in view of the prior art, that the size of the area was reduced (e.g. from a 5-mile radius at 7:30 PM to a 2-mile radius at 7:45 PM) as an event start time approached. In view of the prior art, it was also held to be obvious that the reminder sent to the attendee contained a link or a request to cancel the reservation if the appointment time could not be met. The claimed invention therefore lacked an inventive step.

081-08-23

4. Article 056 EPC | T 0366/20 | Board 3.5.07

Article 056 EPC

Case Number	T 0366/20
Board	3.5.07
Date of decision	2023.01.27
Language of the proceedings	EN
Internal distribution code	D
Inter partes/ex parte	Ex parte
EPC Articles	Article 056 EPC
EPC Rules	
RPBA	
Other legal provisions	
Keywords	inventive step – technical and non-technical features – technical effect
Cited decisions	G 0001/19
Case Law Book	I.D.9.2.11c , 10th edition

In [T 366/20](#) the board was of the opinion, that no technical effect of the distinguishing features could be derived over the whole scope of the claim.

The application related to devices and methods for managing the identity of media content data. It is common for the same media content to be available from numerous sources, each of which may use a different proprietary identification scheme for describing, via the use of metadata, its creator or the artist's name, the (song) title, track number, or other associated information. The appellant had argued that the objective technical problem to be solved was "how to provide, at a client node, a more efficient non-duplicate downloading and file identity reconciliation". According to the appellant, the claimed solution provided downloading of non-duplicate media files along with reconciliation of file identities based on received metadata of media files selected for possible download. By contrast, the prior art taught a solution for downloading of non-duplicate media files based on received initial portions of the files selected for possible download and was concerned at most with reconciling metadata based on file identifiers. As a further advantage, the claimed solution avoided conflicts due to having copies of the same file identifier (associated with respective copies of the same file) that were locally stored in association with the same or similar metadata.

The board stated that claim 1 did not define how the "first master identifier" received from a server node corresponded to the "first set of metadata" provided by the client to this server node. Since the first master identifier seemed to be determined based only on the metadata, and since the metadata may be incomplete or incorrect or

otherwise not identifying for the media content or may not capture differences in actual content of the media content data files (for example due to different versions of the same song, movie etc.) the result of the claimed method seemed to be essentially unpredictable with respect to the detection of duplicate media content files over the whole scope of the claim.

Moreover, the claim did not define what "processing" was performed on the first master identifier to identify whether a second master identifier was stored in the database of local identification data and metadata that matched the first master identifier. Since there was no technical effect over the whole scope of the claim, no technical problem was solved over the whole scope of the claim and the claimed method therefore lacked an inventive step.

082-08-23

5. Article 056 EPC | T 0814/20 | Board 3.5.06

Article 056 EPC

Case Number	T 0814/20
Board	3.5.06
Date of decision	2023.03.20
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 (yes) – effect made credible within the whole scope of claim
Cited decisions	G 0001/19
Case Law Book	I.D.4.1. , 10th edition

In [T 814/20](#) the board was satisfied that the claimed method for the re-identification of objects captured by image cameras was a technical purpose because it was tantamount to an objective measurement in physical reality: is the object observed now the same as the one observed earlier? It remained to be appreciated whether the claimed method provided a technical effect over substantially the whole scope of the claim (see G 1/19, point 82 of the Reasons).

The board held that the claimed method for the re-identification of objects captured by image cameras would not "work" under all imaginable circumstances. It was probably safe to say that no computer vision method does. For instance, the present method may fail to re-identify objects largely changing appearance. However, the skilled person would understand, from the present claims and the description, the kind of situations and its parameters for which the method was designed. The method credibly worked over that range of situations. In the board's judgment, this was sufficient to satisfy the requirement that a technical effect be present over substantially the whole scope of the claims.

On obviousness, in the board's view, the skilled person, starting from D3, may have considered Fisher Vectors to measure image similarity for classification purposes instead of the MAP adaptation method, but would not combine the two in the claimed manner. Thus, the claimed matter was not obvious in view of the prior art at hand and the board concluded the subject-matter of claim 1 involves an inventive step in the sense of Art. 56 EPC.

083-08-23

6. Article 076 EPC | T 0795/21 | Board 3.3.07

Article 076 EPC

Case Number	T 0795/21
Board	3.3.07
Date of decision	2023.03.24
Language of the proceedings	EN
Internal distribution code	D
Inter partes/ex parte	Inter partes
EPC Articles	Articles 076(1), 123(2) EPC
EPC Rules	
RPBA	
Other legal provisions	
Keywords	divisional application – amendments – subject-matter extends beyond content of earlier application – deletion of features – singling out a sub-group of compounds
Cited decisions	G 0001/93, G 0001/03, G 0002/10, T 0859/94, T 0615/95, T 0050/97, T 0801/02, T 0948/02, T 0783/09, T 1937/17
Case Law Book	II.E.1.6.2a), II.E.1.6.3 , II.F.2.1.1 , 10th edition

In [T 795/21](#) the parent application as originally filed defined variables X and Y for the compounds of formula I as follows: "X and Y are independently selected from the group comprising H, F, Cl, Br, I, OH and methyl (-CH₃)". It was not in dispute that amended claim 1 of auxiliary request 4 included the limitation of the meaning of Y to F in combination with the deletion of H from the list of options for X with respect to the compounds of formula I.

The board observed that, in accordance with established jurisprudence regarding the deletion of meanings from multiple lists defining variables in a generic formula, it was not sufficient that the remaining subject-matter still related to a generically defined group of compounds. In order to comply with Art. 123(2) EPC the deletion must not result in a particular combination of specific meanings which was not originally disclosed and which thereby generates another invention. In other words, the amendment may not lead to a particular combination which was not derivable from the originally disclosed subject-matter and was therefore potentially suitable to provide a technical contribution.

In the patent as granted, the definition of the compounds of formula I had already been limited by restricting Y to a single meaning. Whilst such limitation was not

objectionable as sole amendment, the combination of this limitation of Y with the further deletion of H from the list of options for X in claim 1 of auxiliary request 4 singled out a sub-group of compounds which was well suitable to provide a technical contribution generating another invention. The original disclosure did not provide any pointer to this sub-group of compounds.

The board noted that in G 2/10 (point 4.3 of the Reasons) the Enlarged Board explained that the notion of a "technical contribution", as referred to in G 1/93 (point 16 of the Reasons) in the context of conflicting requirements under Art. 123(2) and (3) EPC and in G 1/03 (points 2.6 and 4 of the Reasons) in the context of disclaimers for undisclosed subject-matter, was not intended to modify the "gold standard" for the assessment of amendments. The board agreed with the considerations in T 1937/17 that, accordingly, in the context of an amendment which was found to be allowable or not allowable under the "gold standard" any investigation as to the potential for a technical contribution was without relevance. However, the deletion of options from multiple lists of separate characteristics inherently included an aspect of combination and potentially involved an aspect of arbitrariness, which may complicate the assessment of whether such amendments remained within the limits of what the skilled person would directly and unambiguously derive from the original disclosure.

Following the explicit reference in G 2/10 to the applicability of the existing jurisprudence regarding the singling out of compounds or sub-classes of compounds or other so-called intermediate generalisations not specifically mentioned nor implicitly disclosed in the application as filed (see G 2/10, point 4.5.4 of the Reasons), the board understood in this context the notion of:

"the remaining generic group of compounds differing from the original group only by its smaller size" versus "singling out an hitherto not specifically mentioned sub-class of compounds";

and the notion of:

"mere restriction of the required protection" versus "generating another invention" or "suitable to provide a technical contribution to the originally disclosed subject-matter",

as developed in the jurisprudence not as modifications of the "gold standard" for the assessment of amendments in the form of additional or alternative criteria, but rather as considerations which may arise from the application of this standard when assessing amendments by deletion of options from multiple lists and which may affirm the result of such assessment.

Accordingly, the board considered that the observation that the deletion of options for X and Y in accordance with claim 1 of auxiliary request 4 was suitable to provide a technical contribution to the originally disclosed subject-matter supported the assessment that this amendment was not in compliance with the "gold standard". The board therefore concluded that auxiliary request 4 did not fulfil Art. 76(1) EPC.

084-08-23

7. Article 084 EPC | T 1354/18 | Board 3.5.04

Article 084 EPC

Case Number	T 1354/18
Board	3.5.04
Date of decision	2023.01.17
Language of the proceedings	DE
Internal distribution code	D
Inter partes/ex parte	Inter partes
EPC Articles	Article 084 EPC
EPC Rules	
RPBA	
Other legal provisions	
Keywords	claims – interpretation of claims – claim construction for assessing novelty
Cited decisions	
Case Law Book	II.A.6.1. , II.A.6.3.1 , II.A.6.3.3 , 10th edition

In [T 1354/18](#) befasste sich die Kammer mit der Auslegung des Anspruchs 1 des Patents. Dieser Anspruch spezifiziert unter anderem, dass "die Kameraeinheit (10) und das Schutzelement (12) beweglich aneinander angelenkt sind". Wie aus der angefochtenen Entscheidung zu entnehmen ist, befand die Einspruchsabteilung, dass dieses Merkmal (nachstehend Merkmal 5) bedeute, dass die Kameraeinheit und das Schutzelement unmittelbar über ein (einziges) Gelenk beweglich seien. Nach Ansicht der Kammer ist die Einspruchsabteilung durch eine rein linguistische Analyse des Begriffs "anlenken" – der die Kammer nicht zustimmte – zu ihrem Ergebnis gelangt.

Die Kammer wies darauf hin, dass Patentansprüche eine technische Lehre vermitteln und an einen Leser mit Fachkenntnissen auf dem Gebiet der Anmeldung gerichtet sind. Für die zutreffende Auslegung von Anspruchsmerkmalen müsse daher stets deren technischer Wortsinn im technischen Gesamtzusammenhang aller Merkmale aus Sicht des Fachmanns maßgeblich sein und nicht eine rein linguistische Analyse des Wortlauts einzelner Begriffe. Den in Patentdokumenten verwendeten Begriffen sei daher vorrangig die im einschlägigen Stand der Technik übliche Bedeutung zu geben. Hierbei könne es ohne Weiteres sein, dass der Fachmann auf dem einschlägigen technischen Fachgebiet bestimmte Begriffe unter Zugrundelegung seines allgemeinen Fachwissens anders als auf Grundlage einer rein linguistischen Analyse versteht. Ebenso sei es möglich, dass die Patentschrift selbst einzelnen Merkmalen eine bestimmte Bedeutung beimisst, die von einem rein linguistischen Verständnis abweicht; insofern könne ein Patentdokument sein eigenes Wörterbuch

darstellen. Die Auslegung müsse zu einem technisch sinnvollen Ergebnis führen, wobei den Ansprüchen normalerweise die breiteste technisch sinnvolle Bedeutung beizumessen sei. Die linguistische Analyse des Merkmals 5 könne die Analyse des technischen Wortsinns bestenfalls ergänzen oder bestätigen, nicht aber ersetzen.

Die Kammer merkte an, dass sich der technische Wortsinn des Merkmals 5 nicht bereits aus einem bestimmten technischen Verständnis der streitigen Begriffe durch den Fachmann aufgrund seines allgemeinen Fachwissens ergebe. Sofern der Beschwerdegegner (Patentinhaber) hingegen ein bestimmtes technisches Verständnis dieser Begriffe durch den Fachmann aufgrund seines allgemeinen Fachwissens behauptet habe, habe er diese Ansicht nicht durch geeignete Beweismittel wie Ausführungen in Lehrbüchern oder Fachlexika untermauert, die sich aus technischer Sicht mit den Begriffen "aneinander", "anlenken" und deren Kombination beschäftigen und aus denen sich ergeben würde, dass der Fachmann sie stets so wie vom Beschwerdeführer behauptet versteht. Der Kammer sei ein solches feststehendes technisches Verständnis aufgrund allgemeinen Fachwissens auch nicht bekannt.

Die Kammer entnahm vielmehr der Patentschrift selbst das maßgebliche technische Verständnis des Merkmals 5. Sie war der Ansicht, dass die Beschreibung der Formulierung "beweglich aneinander angelenkt" eine bestimmte Bedeutung zuweise, die weder eine mittelbare Verbindung noch eine Verbindung über eine Mehrzahl von Gelenken ausschließt. Daher kam die Kammer zu dem Schluss, dass die Einspruchsabteilung das Merkmal 5 des Anspruchs 1 des Patents zu eng und damit unzutreffend ausgelegt hatte.

085-08-23

8. Article 084 EPC | T 2391/18 | Board 3.2.03

Article 084 EPC

Case Number	T 2391/18
Board	3.2.03
Date of decision	2023.04.19
Language of the proceedings	EN
Internal distribution code	C
Inter partes/ex parte	Inter partes
EPC Articles	Articles 084, 101(3) EPC
EPC Rules	Rule 080 EPC
RPBA	
Other legal provisions	
Keywords	claims – support in the description – inconsistency already present in the granted version – adaptation of the description (no)
Cited decisions	G 0003/14
Case Law Book	II.A.5.3. , IV.C.5.1.2b), IV.C.5.2.2 , 10th edition

In [T 2391/18](#) the appellant (opponent) had argued that the description had to be adapted to amended claim I of the main request, since there was an inconsistency between said claim and the description. In particular, paragraph [0017] of the description referred to a weighing device which **provides for** a support structure, whereas amended claim I specified a weighing device **coupled with** a support structure.

The appellant had also put forward the argument that such an inconsistency, even if - as observed by the board - it was already present in the granted version, had to be addressed by adapting the description to the wording in the claim. The reason for the alleged obligation to remove such an inconsistency was seen in a possible lack of support of the claims by the description within the meaning of Art. 84, second sentence, EPC.

The board stressed that Art. 84 EPC was not a ground for opposition. Therefore, such amendment to the description was not "occasioned by a ground for opposition" within the meaning of R. 80 EPC.

Moreover, the board considered that the conclusions of the Enlarged Board in G 3/14 had to be taken into consideration in this context. The allegedly required amendment to paragraph [0017] related to an alleged inconsistency that already existed in respect of a feature present in the granted claims. Therefore, even without the

allegedly required amendment to the description, there was no reason for the board (or the opposition division) to come to the conclusion that the requirements of the Convention (in particular the requirements of Art. 84 EPC) within the meaning of Art. 101(3)(a) EPC were not fulfilled. The reason for this was the conclusion of the Enlarged Board in G 3/14, in which the Enlarged Board found that when considering whether, for the purposes of Art. 101(3) EPC, a patent as amended meets the requirements of the EPC, the claims of the patent may be examined for compliance with the requirements of Art. 84 EPC only when, and then only to the extent that the amendment introduces non-compliance with Art. 84 EPC.

According to the board, in a case such as the present one, where the amendment to the claims did not introduce an issue of non-compliance with Art. 84 EPC, an opposition division or a board of appeal could not examine the claims of the patent for compliance with the requirements of Art. 84 EPC, including the requirement of "support by the description". There was thus no reason for the board to object to the wording of paragraph [0017] of the description.

086-08-23

9. Article 084 EPC | T 2565/19 | Board 3.3.04

Article 084 EPC

Case Number	T 2565/19
Board	3.3.04
Date of decision	2022.11.29
Language of the proceedings	EN
Internal distribution code	D
Inter partes/ex parte	Ex parte
EPC Articles	
EPC Rules	Article 084 EPC
RPBA	
Other legal provisions	
Keywords	claims – clarity (no) – receptor defined only by locational and functional features
Cited decisions	G 0002/88
Case Law Book	II.A.3.1. , 10th edition

See also abstract under Article 56 EPC.

In [T 2565/19](#) the board remarked that the claimed subject-matter was an isolated TRH receptor, i.e. a product. The receptor was defined only by locational and functional features, i.e. the tissue from which it could be isolated: "from human CNS tissue" and its ability to bind the compounds defined in the claim, "wherein the compound having the structure GIpW-Pro-X binds to the TRH receptor sub-type in human CNS tissues but does not bind to the TRH receptor sub-type in human pituitary tissue". Neither of these features conveyed any structural information about the claimed product, for instance whether it was a protein or not, or if it were a protein, what its sequence might be.

The board referred to the criteria established by the boards in the case law to determine whether or not a claim was clear (see G 2/88, point 7 of the Reasons, and CLB, 10th edition, II.A.3.1.). The board held that in the absence of any structural features, the claim could not be considered as clear because it failed to enable the protection conferred by the patent (or patent application) to be determined and it did not define the claimed subject-matter in a manner which allowed a meaningful comparison with the state of the art to be made. Indeed, in the absence of any structural information about the claimed subject-matter, it was not possible to determine if the claimed product was novel. For instance, there was no way of ruling out that the functional and locational features defined in the claim did not simply re-characterise a known molecule.

The appellant (applicant) had argued that a receptor could be defined solely by its binding properties to its ligand, which was in line with the definition of a receptor from a number of online scientific dictionaries. Moreover, it had maintained that the EPC did not require that an applicant had to sequence a protein in order to be entitled to claim it.

The board was not persuaded by the appellant's (applicant's) arguments and concluded that, applying the criteria developed by the boards in the case law, the claim lacked clarity.

087-08-23

10. Article 084 EPC | T 2968/19 | Board 3.2.03

Article 084 EPC

Case Number	T 2968/19
Board	3.2.03
Date of decision	2023.03.28
Language of the proceedings	DE
Internal distribution code	D
Inter partes/ex parte	Ex parte
EPC Articles	Articles 069(1), 084 EPC
EPC Rules	
RPBA	
Other legal provisions	Protocol on the Interpretation of Article 69 EPC
Keywords	claims – clarity – claim interpretation – conciseness
Cited decisions	G 0001/04, G 0003/14, T 1646/12, T 1473/19, T 0169/20
Case Law Book	II.A.3.1. , II.A.6.3.2. , 10th edition

In [T 2968/19](#) wendete sich der Anmelder mit der Beschwerde gegen die Zurückweisung der Anmeldung. In der angefochtenen Entscheidung vertrat die Prüfungsabteilung u.a. die Auffassung, dass Anspruch 1 durch die Verwendung des unklaren Merkmals "ALC-Steuerung" die Erfordernisse von Art. 84 EPÜ nicht erfülle.

Der Beschwerdeführer (Anmelder) berief sich auf einen "allgemeinen Grundsatz", gemäß dem die Patentanmeldung ihr eigenes Wörterbuch darstelle. Er argumentierte weiter, dass Art. 69 (1) EPÜ und dessen Auslegungsprotokoll analog im Prüfungsverfahren anzuwenden seien. Für den Beschwerdeführer folgte aus alledem, dass das Merkmal "ALC-Steuerung" in Anspruch 1 des Hauptantrags in Zusammenschau mit der Beschreibung hinreichend deutlich sei.

Die Kammer merkte an, dass Art. 69 (1) EPÜ sich auf die Ermittlung des Schutzbereichs des erteilten Patents bezieht und damit in Verfahren vor dem EPA im Wesentlichen in Zusammenhang mit Art. 123 (3) EPÜ Anwendung findet. Trotzdem bleibe die Beschreibung zur Auslegung von Anspruchsmerkmalen nicht grundsätzlich unberücksichtigt. In der Entscheidung T 1646/12 sei zur Auslegung von erteilten Patentansprüchen im Lichte der Beschreibung Folgendes festgestellt worden: "In diesem Zusammenhang gilt es zwei Extreme zu meiden. Zum einen ist es nicht zulässig, die Ansprüche und die Beschreibung gewissermaßen als kommunizierende Gefäße zu betrachten, zum Beispiel, indem man einschränkende Merkmale, die zwar in der Beschreibung beschrieben sind, aber nicht in den Ansprüchen, in letztere

hineinliest. Eine solche Übertragung von einschränkenden Merkmalen kann nicht durch Auslegung, sondern nur durch eine Änderung der Ansprüche erreicht werden. Zum anderen kann man den Anspruch auch nicht als von der Beschreibung völlig getrennt betrachten. Der Fachmann, der einen Anspruch auslegt, muss sich zumindest vergewissern, ob die Ausdrücke des Anspruchs ihrem üblichen Wortsinn nach zu verstehen sind oder ob die Beschreibung für diese Ausdrücke eine besondere Bedeutung definiert."

Der Kammer zufolge ist diese Abwägung in analoger Weise auch auf die Überprüfung der Kriterien von Art. 84 EPÜ bei Änderungen der Ansprüche anzuwenden. Allerdings sei im Prüfungsverfahren, im Gegensatz zur Auslegung erteilter Patentansprüche, zunächst dem Grundsatz Genüge zu tun, dass die fehlenden wesentlichen Merkmale in den Anspruch aufzunehmen sind und die Bedeutung der Merkmale für die Fachperson aus dem Wortlaut des Anspruchs allein klar hervorgehen sollte (vgl. G 1/04, Nr. 6.2 der Gründe).

Werde ein komplexes technisches Merkmal ("ALC-Steuerung") durch lediglich einen schlagwortartigen Begriff im Anspruch wiedergegeben, so seien die Untermerkmale, die dieses komplexe Merkmal möglicherweise bestimmen, zumindest nicht expliziter Teil des Anspruchswortlauts. Zur Beurteilung der Deutlichkeit sei zwischen Untermerkmalen zu unterscheiden, die sich für die Fachperson aus der im Anspruch verwendeten Begrifflichkeit bereits aus dem allgemeinen Fachwissen in dem technischen Kontext des Patents direkt und unmittelbar erschließen, und die somit implizit Teil des Anspruchsgegenstandes sind, sowie anderen Untermerkmalen, die zwar in der Beschreibung als wesentlicher Teil des komplexen Merkmals dargestellt werden, sich jedoch für die Fachperson nicht unmittelbar und eindeutig aus dem Fachwissen als implizit offenbart ergeben. Das Fehlen der letztgenannten Untermerkmale könne einen Mangel an Deutlichkeit begründen.

Der vom Beschwerdeführer angeführte Rückgriff auf die Beschreibung im Sinne eines eigenen Wörterbuchs könne zur Auslegung der Ansprüche eines Patents im Einspruchsverfahren zulässig sein, wenn Merkmale einem Einwand unter Art. 84 EPÜ nicht mehr zugänglich sind, jedoch trotzdem ausgelegt werden müssen (vgl. RdBK, 10. Aufl. 2022, II.A.6.3.3; G 3/14, Nr. 55 der Gründe). Der Kammer zufolge sind jedoch einem solchen Rückgriff bei der Anspruchsauslegung Grenzen gesetzt (vgl. "primacy of the claim" in T 1473/19, T 169/20), insbesondere in der Weise, dass im Anspruch fehlende (und nicht aus dem fachgerechten Verständnis der im Anspruch verwendeten Begrifflichkeiten implizit definierte) Merkmale nicht in den Anspruch hineinzulesen sind.

Die Kammer stellte darüber hinaus klar, dass das Erfordernis der Knappheit in Art. 84 EPÜ eine eigenständige Bedingung ist, gemäß der verhindert werden soll, dass die eindeutige Auslegbarkeit des Anspruchs beispielsweise durch redundante Merkmale kompromittiert wird. Sie sei jedoch nicht so anzuwenden, dass hierdurch die Erfordernisse an die Deutlichkeit gemäß Art. 84 EPÜ eingeschränkt werden.

Folglich entschied die Kammer, dass der Hauptantrag nicht die Erfordernisse des Art. 84 EPÜ erfüllte.

088-08-23

11. Article 087(1) EPC | T 0411/19 | Board 3.3.04

Article 087(1) EPC

Case Number	T 0411/19
Board	3.3.04
Date of decision	2022.11.15
Language of the proceedings	EN
Internal distribution code	D
Inter partes/ex parte	Inter partes
EPC Articles	Articles 083, 087(1) EPC
EPC Rules	
RPBA	
Other legal provisions	
Keywords	priority – enabling disclosure in priority document (no) – same invention (no) – validity of earliest priority date (no)
Cited decisions	
Case Law Book	II.D.3.1.6 , 10th edition

In [T 411/19](#) appellant II (opponent 2) argued that the subject-matter of claim 1 was not entitled to the earliest priority date because the application from which priority was claimed (P1) did not sufficiently disclose the suitability of the claimed compounds for the claimed therapeutic use, i.e. for the treatment of macular oedema or retinal vein occlusion.

The board recalled that, according to the established case law of the boards, a claimed second medical use met the requirements of Art. 83 EPC if the patent disclosed the suitability of the product for the claimed therapeutic application, if this was not known to the skilled person at the relevant date. In the board's opinion, this standard applied to priority documents equally because the priority document had to disclose the invention claimed in the subsequent application in such a way that it could be carried out by a person skilled in the art. The question to be answered in determining if the subject-matter of claim 1 could validly claim priority from P1 was therefore whether P1 disclosed that the claimed compounds were suitable for treating macular oedema and retinal vein occlusion.

The board observed that it had not been disputed that P1 disclosed Kunitz domain peptides according to the general formula of claim 1 of the patent and stated that these were useful in the treatment of ophthalmic disorders in humans and animals. Macular oedema and retinal vein occlusion were both mentioned in lists of treatable

ophthalmic disorders. There was therefore a literal disclosure of the subject-matter of claim 1.

The board noted, however, that P1 contained no experimental data or other evidence of any kind that went beyond a mere allegation that the peptides defined in that document were indeed suitable for treatment of any of the ophthalmic disorders listed. That the peptides mentioned were suitable was not at all self-evident because it was the essence of the contribution to the art of the invention purportedly made in P1. In the absence of such evidence, it could not be concluded that P1 provided even an initial plausibility that the claimed compounds were suitable for treating the disorders in question. Appellant I had referred to certain passages as providing a link between particular plasma kallikrein inhibitors and the ophthalmic disorders. The board was of the view that these were no more than a summary of the background knowledge in the art on proteases, including kallikreins and their inhibitors and did not at all constitute evidence that peptides defined in P1 were suitable for treatment of any ophthalmic disorder by inhibiting plasma kallikrein.

The board concluded that P1 did not disclose the invention of claim 1 in a manner sufficiently clear and complete for it to be carried out by a person skilled in the art. The invention claimed in claim 1 of the main request was therefore not the "same invention" in the sense of Art. 87(1) EPC as the invention disclosed in P1. It could therefore not validly claim priority from P1.

089-08-23

12. Article 113 EPC | T 1558/21 | Board 3.2.04

Article 113 EPC

Case Number	T 1558/21
Board	3.2.04
Date of decision	2023.05.10
Language of the proceedings	DE
Internal distribution code	C
Inter partes/ex parte	Inter partes
EPC Articles	Article 113 EPC
EPC Rules	Rule 103(1)(a) EPC
RPBA	
Other legal provisions	
Keywords	right to be heard – violation of the right to be heard (yes) – substantial procedural violation (yes) – no opportunity to comment or text not submitted/agreed by patent proprietor – reimbursement of appeal fee (yes)
Cited decisions	
Case Law Book	III.B.2.6.1a), III.B.3.4. , 10th edition

See also abstract under Rule 139 EPC.

In [T 1558/21](#) war für die Kammer von besonderer Bedeutung, dass der Einsprechende (Beschwerdegegner) den vom Patentinhaber (Beschwerdeführer) dargelegten Sachverhalt nicht nur kommentarlos unwidersprochen gelassen, sondern ausdrücklich bestätigt hatte. Demnach gingen alle Beteiligten im Einspruchsverfahren irrtümlich davon aus, bei dem während der mündlichen Verhandlung per E-Mail eingereichten Hilfsantrag 1' handele es sich um einen geänderten Hauptantrag, dessen erteilter Anspruch 1 lediglich um die Definition der Bestandshöhe ergänzt worden sei.

Die Kammer bestätigte, dass im Einspruchsverfahren anschließend Ausführbarkeit, Neuheit und erfinderische Tätigkeit ausschließlich im Hinblick auf diese neu eingeführte Definition als Unterscheidungsmerkmal diskutiert wurde, wie aus dem Protokoll der mündlichen Verhandlung hervorgeht. Das zusätzliche Merkmal des schriftlich eingereichten Hilfsantrags 1' bezüglich der Berechnung der Arbeitshöhe als Mittelwert blieb, zumindest nach dem Vortrag des Beschwerdeführers und dem Protokoll der mündlichen Verhandlung, gänzlich unbeachtet. Nach Ansicht der Kammer war davon auszugehen, dass die ursprüngliche Offenbarung des hinzugefügten "Mittelwert"-Merkmals eingehender thematisiert worden wäre, wenn

denn tatsächlich der schriftlich eingereichte Hilfsantrag 1' Gegenstand der Diskussion gewesen wäre.

Die Kammer bestätigte, dass sie zwar keine festen Anhaltspunkte dafür habe, dass auch die Einspruchsabteilung den Gegenstand ihrer eigenen Entscheidung verkannt hatte, denn die schriftliche Entscheidung behandelt das zusätzliche Merkmal des Mittelwerts, wenn auch nur sehr kurz. Nach Ansicht der Kammer musste dies aber nicht zwangsläufig zu dem Schluss führen, dass die Abteilung dieses Merkmal bereits in der mündlichen Verhandlung wahrgenommen hatte.

Der Kammer zufolge unterlagen zumindest der Patentinhaber (Beschwerdeführer) und der Einsprechende (Beschwerdegegner) am Ende der mündlichen Verhandlung dem Irrtum, dass die Entscheidung der Einspruchsabteilung den diskutierten, auf dem Hauptantrag beruhenden Hilfsantrag 1 betreffe. Das Verständnis der Einspruchsabteilung bezüglich der Anträge ist nach Ansicht der Kammer nicht eindeutig. Einerseits sei es denkbar, dass sie demselben Irrtum unterlag wie die Parteien und über den erörterten, aber nicht eingereichten Antrag entschied. Andererseits sei es auch möglich, dass sie tatsächlich über den schriftlich eingereichten Hilfsantrag 1' entschieden hat, der auf dem früheren Hilfsantrag 1 basierte und zu dem sich die Beteiligten in Wirklichkeit nicht geäußert hatten.

Die Kammer befand, dass entweder die Einspruchsentscheidung auf unstreitig falschen Tatsachen beruht (davon ausgehend, dass alle Beteiligten einschließlich der Einspruchsabteilung einen anderen als den schriftlich eingereichten Antrag erörtert haben) und daher die schriftliche Entscheidung nicht die tatsächlich getroffene Entscheidung wiedergibt oder dass die Entscheidung auf einem Antrag beruht, zu welchem weder der Patentinhaber noch der Einsprechende angehört wurden. Daher entschied die Kammer, dass die Entscheidung der Einspruchsabteilung aufzuheben ist, da sie auf einem schweren Verfahrensfehler beruhe.

Hinsichtlich der Rückerstattung der Beschwerdegebühr kam die Kammer zu dem Schluss, dass der wesentliche Verfahrensmangel im Sinne von R. 103 (1) a) EPÜ – nämlich die Nichtberücksichtigung des in der mündlichen Verhandlung diskutierten, "konkludent gestellten", auf dem Hauptantrag beruhenden Hilfsantrags 1 und dessen Ersatz durch den "formal" eingereichten, jedoch nicht diskutierten Hilfsantrag 1' – offensichtlich unmittelbar zur aufzuhebenden Entscheidung führte und damit die Notwendigkeit einer Beschwerde begründete. Daran änderte auch die Tatsache nichts, dass der Fehler in erster Linie auf ein Versehen des Patentinhabers zurückging. Daher vertrat die Kammer die Auffassung, dass die Rückzahlung der Beschwerdegebühr in voller Höhe der Billigkeit im Sinne von R. 103 (1) a) EPÜ entspreche.

090-08-23

13. Rule 139 EPC | T 0695/18 | Board 3.5.03

Rule 139 EPC

Case Number	T 0695/18
Board	3.5.03
Date of decision	2023.03.03
Language of the proceedings	EN
Internal distribution code	B
Inter partes/ex parte	Ex parte
EPC Articles	Article 112a(5) EPC
EPC Rules	Rules 036(1), 108(3), 139 EPC
RPBA	
Other legal provisions	Vienna Convention on the Law of Treaties (1969)
Keywords	correction of error (no) – correction of appeal withdrawal (no) – withdrawal of the appeal withdrawal (no) – re-opening of proceedings
Cited decisions	G 0001/09, G 0001/12, R 0003/22, J 0010/87, J 0042/92, J 0019/03, J 0023/13, J 0002/15, J 0007/19, T 0824/00, T 0309/03, T 1244/08, T 0610/11, T 2148/18, T 0433/21
Case Law Book	V.A.7.3.7 , V.B.3.13.1 , III.H.1. , 10th edition

In [T 695/18](#) the appellant (applicant) had filed a letter on 28 September 2021 which read, among other things: "[w]e herewith respectfully inform the Boards of Appeal that the Applicant herewith withdraws the appeal. A partial refund of the appeal fee is requested". The board considered that the appellant had withdrawn its appeal and the appeal proceedings were accordingly closed without a substantive decision. The appellant requested a correction of its appeal withdrawal. However, considering that the appeal proceedings were terminated, the board held that it was not competent to deal with that request.

The Enlarged Board re-opened the proceedings by decision R 3/22. It held that the board had implicitly decided on the appeal without deciding on the request for correction. The Enlarged Board observed that according to the case law (with reference to the Case Law of the Boards of Appeal, 10th ed. 2022, V.A.7.3.7), the success of such a request could not be ruled out a priori, and if the request was successful, a decision on the merits would have been possible. The board's refusal to decide on this request was seen as a fundamental procedural defect under Art. 112a(2)(d) and R. 104(b) EPC.

The first question to answer for the board was how Art. 112a(5) and R. 108(3) EPC were to be interpreted and, consequently, how the order of the Enlarged Board was to be understood. The board held that there was nothing textual in the EPC to suggest that the proceedings re-opened by the Enlarged Board in the present case were the appeal proceedings. If the appeal proceedings were intended, those proceedings and thus the application would be pending again. In the board's view, that would also make no sense from a contextual point of view. The board thus saw the Enlarged Board's order in R 3/22 as one that opened "ancillary proceedings" for establishing whether the request for correction was allowable: if the request were found allowable, the appeal proceedings would continue; if not, the appeal proceedings would be regarded as terminated as of the date when the withdrawal of the appeal took effect.

According to the board, in the present case, immediately and automatically upon the EPO's receipt of the party's submission, the withdrawal had the legal effect of terminating the appeal proceedings as to the substantive issues settled by the refusal of the application, and of rendering the matters subject to that decision *res judicata*, i.e. finally settled. The question to answer was thus whether R. 139 EPC was applicable in the absence of pending proceedings. The board was not convinced by the reasoning in T 2148/18 (in which the board had allowed a correction of an appeal withdrawal) and held that the ordinary meaning to be given to the terms of R. 139 EPC includes the implicit, limiting condition that an error may only be corrected if proceedings before the EPO for some other purpose are pending when the request for correction is received by the EPO. R. 139 EPC was thus not applicable to the present request for correction of the withdrawal of the appeal. In line with the conclusion drawn in case T 1244/08, such a request was found to be inadmissible.

This meant the main request could not be granted. The next question was then whether the application was "pending" within the meaning of R. 36(1) EPC as of the day of the oral proceedings before the board, i.e. on 3 March 2023; the appellant had filed divisional applications relating to the application on 1 October 2021 and 2 March 2023. In the board's view, the EPO's receipt of the withdrawal of the appeal on 28 September 2021 had immediate substantive as well as procedural legal effects. Therefore, when the first divisional application was filed, the application was "dead" on the merits. There was nothing from which new shoots could form. From the ancillary nature and limited scope of the proceedings at hand, it followed that potential substantive rights associated with the application would only arise if appeal proceedings were re-opened after a finding that R. 139 EPC was applicable, then after another finding that the request for correction was allowable. This was not the case here. As a result, the application was no longer pending on 29 September 2021 and had not been since (i.e. the application was not pending on the dates when the related divisional applications were filed).

The board concluded that, following the above reasoning, and contrary to the Enlarged Board's view set out in R 3/22, R. 139 EPC was indeed to be understood as ruling out a priori the success of the former appellant's request for correction by withdrawing its earlier unambiguous and unconditional withdrawal of the appeal.

091-08-23

14. Rule 139 EPC

| T 1558/21

| Board 3.2.04

Rule 139 EPC

Case Number	T 1558/21
Board	3.2.04
Date of decision	2023.05.10
Language of the proceedings	DE
Internal distribution code	C
Inter partes/ex parte	Inter partes
EPC Articles	
EPC Rules	Rules 139, 140 EPC
RPBA	
Other legal provisions	
Keywords	Correction of error (no) – claims – obvious error (no) – correction of errors in decisions (no)
Cited decisions	G 0001/10
Case Law Book	II.E.4.2. , 10th edition

See also abstract under Article 113 EPC.

In [T 1558/21](#) war die Kammer aus den nachstehenden Gründen der Ansicht, dass die einmal in der mündlichen Verhandlung verkündete Entscheidung auf Aufrechterhaltung des Patents im Umfang des schriftlich eingereichten Hilfsantrags 1' im Nachhinein nicht mehr auf Grundlage der R. 139 und 140 EPÜ korrigierbar, sondern lediglich mit einer Beschwerde anfechtbar war.

Der schriftlich eingegangene Hilfsantrag 1' war integraler Bestandteil der von der Einspruchsabteilung verkündeten Entscheidung geworden. Trotzdem war eine Berichtigung seiner Ansprüche 1 und 8 nicht unter R. 140 EPÜ möglich, die nur Berichtigungen offener Unrichtigkeiten in Entscheidungen, wie bibliografischer Fehler gestattet, siehe RdBK, 10. Auflage 2022, III.L.2. und 2.1., G 1/10.

Zudem war die Voraussetzung einer offensichtlichen Unrichtigkeit im Sinne eines auch für einen unbeteiligten Dritten sofort erkennbaren Fehlers vorliegend nicht gegeben. Denn objektiv betrachtet war für einen Unbeteiligten aus dem Protokoll nicht offenkundig, dass die Entscheidung auf einem "falschen" Hilfsantrag beruhte.

Ferner war aus dem schriftlichen Hilfsantrag 1' selbst kein offensichtlicher Fehler erkennbar, geschweige denn, wie dieser offensichtlich zu beheben wäre. Dies galt auch im Vergleich mit dem ursprünglichen Hilfsantrag 1, der nach Angaben des Beschwerdeführers auf Seite 4 seines Schreibens vom 10. Mai 2021 zu Hilfsantrag II unnummeriert und weiterverfolgt worden war. Denn es ist nicht ungewöhnlich, dass

niederrangige Hilfsanträge mit breiterem unabhängigem Anspruch (hier ohne die Bestandshöhe-Definition) zumindest so lange nicht zurückgezogen werden, bis die Zulassung eines später eingereichten, höherrangigen Hilfsantrags zum Verfahren geklärt ist.

Dass im schriftlich eingereichten Hilfsantrag 1' weder Fehler noch deren Berichtigung für den Fachmann objektiv und offensichtlich erkennbar waren, führte auch dazu, dass eine Berichtigung gemäß R. 139, 2. Satz EPÜ nicht möglich war, siehe RdBK, 10. Auflage, II.E.4.2.

Der Beschwerdeführer war der Auffassung, es handle sich vorliegend nicht um den in R. 139, 2. Satz behandelten speziellen Fall einer Berichtigung von Patentansprüchen, sondern um den im 1. Satz der R. 139 EPÜ angesprochenen, allgemeinen Fall einer Berichtigung von eingereichten Unterlagen, für den eine Offensichtlichkeit nicht erforderlich sei. Dafür konnte die Kammer jedoch keine Gründe erkennen und befand, dass ein Hilfsantrag, der Ansprüche enthält, unter Satz 2 der R. 139 EPÜ fällt.

Zusammenfassend stand deshalb der Einspruchsabteilung nach Verkündung ihrer fehlerhaften Entscheidung in der mündlichen Verhandlung die Möglichkeit einer Berichtigung unter den R. 139 oder 140 EPÜ nicht mehr offen.

092-08-23



Contact

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

