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Abstracts of decisions

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1. Article 053 EPC | T 0529/19 | Board 3.2.02

Article 053 EPC

Case Number	T 0529/19
Board	3.2.02
Date of decision	2023.04.24
Language of the proceedings	EN
Internal distribution code	D
Inter partes/ex parte	Ex parte
EPC Articles	Article 053(c) EPC
EPC Rules	
RPBA	
Other legal provisions	
Keywords	exception to patentability (no) – diagnostic method
Cited decisions	G 0001/04
Case Law Book	I.B.4.6.1a , 10th edition

In [T 529/19](#) the board referred to Opinion G 1/04 where the Enlarged Board came, among other things, to the following conclusion:

"1. In order that the subject-matter of a claim relating to a diagnostic method practised on the human or animal body falls under the prohibition of Article 52(4) EPC [EPC 1973], the claim is to include the features relating to:

- (i) the diagnosis for curative purposes stricto sensu representing the deductive medical or veterinary decision phase as a purely intellectual exercise,
- (ii) the preceding steps which are constitutive for making that diagnosis, and
- (iii) the specific interactions with the human or animal body which occur when carrying those out among these preceding steps which are of a technical nature."

The Enlarged Board further stated that the method steps to be carried out when making a diagnosis as part of the medical treatment of humans or the veterinary treatment of animals for curative purposes include:

- (i) the examination phase involving the collection of data,
- (ii) the comparison of these data with standard values,

(iii) the finding of any significant deviation, i.e. a symptom, during the comparison, and

(iv) the attribution of the deviation to a particular clinical picture, i.e. the deductive medical or veterinary decision phase."

The board in T 529/19 stated that the interpretation of the scope of exclusion from patentability under Art. 52(4) EPC 1973 elaborated in Opinion G 1/04 is still valid for Art. 53(c) EPC.

Claim 1 of the main request at hand defined a method "of determining skin health of an area of skin". The steps of this method included calculating a ratio between the intensities measured for two fluorescent emissions induced on the area of skin and comparing this ratio to a control ratio. In the decision under appeal, the examining division had found that the phases (i) to (iii) of G 1/04, were present in the steps of the method recited by claim 1. It further found that the phase (iv) of G 1/04 was derivable from the wording "[a] method of determining skin health" at the beginning of claim 1. The appellant contested the latter finding and submitted that the method of claim 1 did not include the attribution of the deviation to a particular clinical picture.

The board observed that claim 1 left open what the determined "skin health" was. For example, it could refer to the quotient between the two ratios being compared in step (vi) of claim 1 or to some other parameter related to skin health, which may at most be an intermediate finding of diagnostic value. Although the term suggested that some assessment of the skin health was made, neither the claim wording nor the relevant passages of the description indicated that the assessment would actually include the attribution to a particular clinical picture. Even if the method were construed as including some judgment of skin ageing for the assessed skin area, this would not represent the attribution to a particular clinical picture. Establishing that skin ageing is greater than expected for an individual would be, at most, an intermediate finding of diagnostic value. The board thus held that the method of claim 1 did not include the attribution of the deviation to a particular clinical picture, i.e. the deductive medical or veterinary decision phase and was therefore not excluded under Art. 53(c) EPC.

093-09-23

2. Article 054 EPC | T 0438/19 | Board 3.3.03

Article 054 EPC

Case Number	T 0438/19
Board	3.3.03
Date of decision	2023.06.27
Language of the proceedings	EN
Internal distribution code	A
Inter partes/ex parte	Inter partes
EPC Articles	Articles 054(2), 112(1)(a) EPC
EPC Rules	
RPBA	
Other legal provisions	
Keywords	state of the art – availability to the public – composition or internal structure can be analysed and reproduced without undue burden – referral to the Enlarged Board
Cited decisions	G 0002/88, G 0006/88, G 0001/92, T 0206/83, T 0026/85, T 0952/92, T 0977/93, T 0326/01, T 0370/02, T 0946/04, T 1553/06, T 2045/09, T 2458/09, T 0510/10, T 0023/11, T 0877/11, T 2048/12, T 1833/14, T 0505/15, T 2068/15, T 1452/16, T 1666/16, T 1540/21, <i>Takeda UK v F. Hoffmann-La Roche AG</i> [2019] EWHC 1911
Case Law Book	I.C.3.2.4d , I.C.4.11. , 10th edition

In [T 438/19](#) the board identified boards' diverging approaches in applying G 1/92 with regard to the following aspects: (i) interpretation of "available to the public" leading to the exclusion from the state of the art within the meaning of Art. 54(2) EPC of a commercial product (including its chemical composition/internal structure) or only of its chemical composition/internal structure, (ii) the degree of detail required for the analysis of said product and (iii) the requirements for its reproducibility.

On point (i), boards had reached diverging conclusions when it was found that the product put on the market could not be analysed or reproduced, deciding either that (a) its chemical composition (or internal structure) was not state of the art, i.e. adopting the wording of the conclusion of G 1/92, or that (b) the product itself was not state of the art, thus including its chemical composition or internal structure based on G 1/92, point 1.4 of the Reasons. On point (ii), whereas some boards had taken as a criterion the exact composition of the product, in other decisions such a strict condition had not been required. The situation was similar with regard to the reproducibility condition (point (iii)). Whereas some boards had taken as a criterion

the ability to exactly reproduce the product, in other decisions such a strict condition had not been required.

In the light of the case law as at the date of G 1/92, the rationale underlying G 1/92 appeared to be that the enablement of a disclosure was a necessary condition for this disclosure to have been made available to the public within the meaning of Art. 54(2) EPC. However, in the light of the travaux préparatoires, "available to the public" in Art. 54(2) EPC appeared to be intended to express the possibility for the public to take note of the prior art, i.e. the accessibility to the public of the prior art, without any requirement as to its enablement. In addition, partial properties or structural information of a product put on the market were frequently reported in documentation published before the relevant filing date. There was no apparent reason why such partial information about products put on the market reported in said literature without any information as to the reproducibility of said product, which information might even be the result of a partial analysis of said product performed by the authors of the publication, should be treated differently from any information which could be gained from a partial analysis of the same commercial product.

The board also explained that a decision on the ability of the skilled person to reproduce a product put on the market, which one could understand as the ability to reproduce it identically, would not only require an assessment of the level of detail or type of characterisation required for analysing a given product, but also a definition of the degree of variance which can be accepted in order to qualify the product reproduced to be identical to that put on the market. This would appear in the field of polymers to entail the use of subjective criteria, resulting in legal uncertainty when novelty and inventive step needed to be examined in the light of said product. It was however clear from G 1/92 that the Enlarged Board, for reasons of legal certainty, did not wish to provide a definition of the state of the art which would result in a subjective assessment of novelty.

The board therefore referred the following questions to the Enlarged Board:

- "1. Is a product put on the market before the date of filing of a European patent application to be excluded from the state of the art within the meaning of Article 54(2) EPC for the sole reason that its composition or internal structure could not be analysed and reproduced without undue burden by the skilled person before that date?
2. If the answer to question 1 is no, is technical information about said product which was made available to the public before the filing date (e.g. by publication of technical brochure, non-patent or patent literature) state of the art within the meaning of Article 54(2) EPC, irrespective of whether the composition or internal structure of the product could be analysed and reproduced without undue burden by the skilled person before that date?
3. If the answer to question 1 is yes or the answer to question 2 is no, which criteria are to be applied in order to determine whether or not the composition or internal structure of the product could be analysed and reproduced without undue burden within the meaning of opinion G 1/92? In particular, is it required that the composition and internal structure of the product be fully analysable and identically reproducible?"

094-09-23

3. Article 056 EPC | T 0703/18 | Board 3.3.09

Article 056 EPC

Case Number	T 0703/18
Board	3.3.09
Date of decision	2023.02.23
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) – problem invention (no) – problem and solution approach
Cited decisions	T 0002/83
Case Law Book	I.D.9.12. , 10th edition

In [T 703/18](#) the patent related to an infant formula containing combinations of lutein and docosahexaenoic acid. For the respondent the correct technical problem was the one identified in the decision under appeal. In its view, the patent involved one of the rare cases of a "problem invention". It had not been recognised in the art that bioavailability of lutein from formula milk was lower than that achieved by human milk. Once this was known, the solution would have been obvious.

The board noted that one reason why "problem inventions" were rare might be that they were somewhat at odds with the problem-solution approach. It was generally accepted that the formulation of the technical problem should not contain pointers to the solution or partially anticipate the solution. In contrast to this, "problem inventions" tended to do both.

The board referred to the findings in T 2/83 on "problem inventions", in which the board held that "[t]he discovery of a yet unrecognised problem may, in certain circumstances, give rise to patentable subject-matter in spite of the fact that the claimed solution is retrospectively trivial and in itself obvious ('problem inventions')". The board in the case in hand found that although this passage of T 2/83 referred to a device, it was not apparent why the reasoning in it would not apply also to claims directed to compositions.

Decision T 2/83 conceded that the discovery of an unrecognised problem might in certain circumstances give rise to patentable subject-matter. This might be so even though once the formulation of the problem was accepted, the question of whether

the solution was obvious became irrelevant. The board in the case in hand noted that a situation might arise in which, if a subject-matter claimed was assessed as a "problem invention", an attack based on lack of inventive step could be successfully directed only against the recognition of the problem, not against the claimed solution. At the same time, T 2/83 made it clear that in the context of a clearly desired improvement, side effects which might be interpreted as a solution of a yet unknown problem should not be decisive for patentability.

In the case in hand, the board noted that while the issue with bioavailability of lutein was new information, bioavailability of trace elements and lipids from infant milk had been well investigated. Second, the "gold standard" for preparing an infant formula was and remained human milk. Therefore, when formulating the problem to be solved, one had to draw closely on the teaching available in the art on human milk. D16 itself disclosed that the individual concentration of lutein and zeaxanthin in human milk was distributed over a wide range. Third, the patent in suit related to preparing an infant formula, with preterm infants explicitly mentioned throughout the patent.

Considering the above, the board found it was not justified to accept the formulation of a "problem invention". Instead, the technical problem had to be regarded as that of providing a nutritional formula (with lutein) suitable for infants, including newborns.

As to obviousness, the board held the skilled person tasked with solving the problem would turn to D18, which showed that the concentration of lutein found in human milk, and especially in milk of mothers of newborn infants, was considerably higher than that disclosed by example 1 of D16. In view of this, the board stated the solution that the skilled person would have provided would be to increase the concentration of lutein, a straightforward exercise. D16 suggested the addition of a commercially available ingredient. The board had no reason to doubt that the skilled person would have considered a concentration within the range suggested in claim 2 of D16.

The board found therefore that claim 1 as granted lacked inventive step. It decided that the decision under appeal was to be set aside and the patent revoked.

095-09-23

4. Article 056 EPC | T 1079/18 | Board 3.3.02

Article 056 EPC

Case Number	T 1079/18
Board	3.3.02
Date of decision	2023.01.30
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) – obvious solution – try and see situation (yes) – bonus effect (yes)
Cited decisions	T 0595/90
Case Law Book	I.D.9.9.5 , I.D.9.20. , 10th edition

In [T 1079/18](#) D2 was found by the board to be the closest prior art and form A was singled out as clearly preferred among the solid forms of febuxostat disclosed therein, in particular because it was the most suitable for the preparation of pharmaceutical formulations. This was the same context as that in which form I was also praised in the patent. The board found that the objective technical problem could be formulated as providing a pharmaceutical composition containing a crystalline form of febuxostat which was non-hygroscopic and had higher solubility.

Against the background of the common general knowledge concerning polymorphs outlined in the decision, the board found that the skilled person, faced with the problem of providing a crystalline form of febuxostat that has a higher solubility than form A, would clearly be inclined to check whether form A underwent an endothermic phase transition into a new higher-melting form at higher temperatures. Such a form existed or it did not. It found that that the skilled person would have been in a "try and see" situation. Against the background of the common general knowledge and the objective technical problem, the skilled person would most certainly have thought of using DSC to find new solid forms – If only because DSC measures heat flow and is the method of choice for determining exo – and endothermic processes when heating a sample.

The board found that by performing a DSC analysis of form A, the skilled person aiming at higher solubility would have identified form I as being the desired form, i.e. a higher-melting form that results from form A by an endothermic phase transition at higher temperatures. In view of the heat-of-transition rule, they would have

expected form I to be an enantiotrope of form A and form I to have a higher solubility than form A at temperatures below the transition temperature (somewhere between approx. 175 and 200 °C), i.e. at ambient temperature. Further, the fact that form I merely retained the non-hygroscopicity of form A could be considered merely as a bonus effect that the skilled person inevitably achieved because they were primarily looking for a crystalline form of febuxostat with higher solubility.

The board could not agree with the patent proprietor's argument based on decision T 595/90 that form I was inventive already because no way of making it had been found by the effective date of the patent. In T 595/90, the board held at point 5 of the Reasons that "an otherwise obvious entity, may become nevertheless non-obvious and claimable as such, if there is no known way or applicable (analogy) method in the art to make it and the claimed methods for its preparation are therefore the first to achieve this in an inventive manner". However, the present case was different in that the skilled person would have obtained form I in an obvious manner, i.e. the process carried out until form I was obtained was also not based on an inventive step.

It followed that the subject-matter of claim 1 of the main request did not involve an inventive step. The main request was not allowable. The board ordered that the decision under appeal be set aside and the patent be revoked.

096-09-23

5. Article 056 EPC | T 1518/20 | Board 3.3.09

Article 056 EPC

Case Number	T 1518/20
Board	3.3.09
Date of decision	2023.01.16
Language of the proceedings	EN
Internal distribution code	D
Inter partes/ex parte	Inter partes
EPC Articles	Article 056 EPC
EPC Rules	
RPBA	Article 13(2) RPBA 2020
Other legal provisions	
Keywords	inventive step (no) – obvious alternative – reasonable expectation of success (yes)
Cited decisions	T 0588/93
Case Law Book	I.D.4.5. , 10th edition

In [T 1518/20](#) the board found that starting from D1 as the closest prior art, a skilled person seeking to provide a mere alternative surface-crosslinking process for superabsorbent polymers (SAPs) exhibiting good CRC, AUP, SRC and gel strength would have applied the teaching of D11 to the polymer synthesis process found in the examples of D1, and would have had a reasonable expectation of succeeding in arriving at SAP materials with (at least) comparable properties.

The respondent argued that D11 gave no pointer that would cause a skilled person to select the heating conditions stipulated by claim, citing T 588/93 in support of the argument that some kind of a pointer was needed which would prompt a skilled person to apply the relevant teaching from the prior art. In the case in hand three selections from three ranges had to be made in D11 (to arrive at the heating conditions in claim 1).

The board held, however, that for providing an alternative method, no particular pointer from the prior art was needed to combine the teaching of secondary sources of information with that of the closest prior art. In such a scenario, in the absence of any counter-indicators that would provide teaching leading away from applying the relevant disclosure in order to modify the solution proposed in the closest prior art, a skilled person would apply such teaching rather than being conceptually and notionally confined to the disclosure of the provided examples. The case at hand also differed from that underlying T 588/93, in which the (closest) prior art adduced contained teaching leading away from modifying a feature characterised in this

teaching as being essential. In the case at hand, however, no such constellation was apparent.

The board concluded that applying the teaching of D11, a skilled person would arrive at the subject-matter of claim 1 in an obvious way. Therefore, the subject-matter of claim 1 lacked an inventive step and did not meet the requirement of Art. 56 EPC. The first and second auxiliary requests were likewise found not to involve an inventive step. The third auxiliary request was not taken into account (Art. 13(2) RPBA 2020).

097-09-23

6. Article 084 EPC | T 1296/19 | Board 3.3.02

Article 084 EPC

Case Number	T 1296/19
Board	3.3.02
Date of decision	2022.12.08
Language of the proceedings	FR
Internal distribution code	D
Inter partes/ex parte	Ex parte
EPC Articles	Article 084 EPC
EPC Rules	
RPBA	
Other legal provisions	
Keywords	claims – clarity
Cited decisions	G 0010/93
Case Law Book	II.A.2.3. , II.A.3.1. , 10th edition

Dans l'affaire [T 1296/19](#), la chambre a estimé que la revendication 1 de la requête principale ne remplissait pas les exigences de concision et clarté de l'art. 84 CBE.

La revendication 1 portait sur un composé de formule (I) comprenant un groupe R1. La définition de R1 incluait, entre autres, un groupe isoamyle et un groupe isopentyle. Ces deux groupes désignent le même substituant (3-méthylbutyle). La chambre a considéré que l'utilisation de ces deux groupes dans une même liste induisait un manque de concision. Le fait que la définition de R1 est claire n'implique pas nécessairement que la revendication contenant cette définition soit concise.

En plus, la chambre a considéré que l'utilisation des mots "et où" dans ladite revendication rendait la définition des formules (IIa), (IIb), (IIIa) et (IIIb) vague. Il n'était pas clair par exemple pour un composé de formule (I) pour lequel A était de formule (IIa), (IIb), (IIIa) ou (IIIb) si dans ces formules x ne pouvait avoir qu'une valeur de 1 (selon la condition exprimée après les mots "et où") ou pouvait également être un nombre entier supérieur à 1 (selon la première définition de "x" dans la revendication 1, x était "un nombre entier supérieur à 0"). Il en était de même avec R6 qui ne pouvait être qu'un groupe méthyle (selon la condition exprimée après les mots "et où") ou un groupe alkyle en C2-C4 (selon la première définition de "R6" dans la revendication 1, R6 était "un groupe alkyle en C1-C4").

La requérante (demanderesse) avait soumis que les formules (IIa), (IIb), (IIIa) et (IIIb) ne comprenaient que des définitions redondantes et non pas contradictoires. La chambre ne partageait pas cet avis. Les définitions de "x" et les définitions de "R6" n'étaient pas identiques. Elles n'étaient donc pas redondantes l'une envers l'autre.

Comme elles n'avaient pas la même signification, il y avait une contradiction dans la revendication 1. Au moins pour cette raison, les exigences de l'art. 84 CBE n'étaient pas remplies. De plus, si les définitions étaient redondantes, cela impliquerait un manque de concision des définitions.

098-09-23

7. Article 088 EPC | T 0933/18 | Board 3.3.08

Article 088 EPC

Case Number	T 0933/18
Board	3.3.08
Date of decision	2023.01.27
Language of the proceedings	EN
Internal distribution code	D
Inter partes/ex parte	Inter partes
EPC Articles	Article 088 EPC
EPC Rules	
RPBA	
Other legal provisions	
Keywords	priority – partial priority (yes) – implicit feature (yes) – G 1/15 relevant (yes) – "OR" claim
Cited decisions	G 0002/88, G 0001/92, G 0001/15, T 0666/89
Case Law Book	II.D.5.3.3 , I.C.4.3. , 10th edition

In [T 933/18](#) the appeal was against the opposition division's decision to reject the opposition. The patent had been granted on a divisional application of an earlier European patent application (the parent application) filed as an international patent application. Claim 1 as granted related to a method for preparing a biosensor. Appellant I (opponent I) submitted that because the method of claim 1 was not entitled to priority contrary to the disclosure of Example 3 of the parent application, the latter anticipated the claimed method due to a "poisonous priority". It was uncontested that the disclosure of Example 2 of the priority document was identical to Examples 3 of the parent application and the patent application.

Appellant I argued that G 1/15 did not apply to the present case because the glycosylation level of the GLD enzyme disclosed in Example 2 of the priority document and in Examples 3 of the parent application and the patent application was an "intrinsic" feature of GLD and not an "implicit" one. Since intrinsic features were not assessed in G 1/15, let alone their impact on the concept of a "poisonous priority", G 1/15 was irrelevant to the present case.

The board disagreed for the following reasons. The case law had established that an intrinsic/inherent feature of a product normally related to a technical effect caused by an interaction with specifically selected outside conditions, i.e. a certain use of the product (see G 2/88), while structural features of a product were normally implicit to that product (see G 1/92). Example 2 of the priority document disclosed the transformation of an E. coli strain with a recombinant vector encoding a GLD gene for the production of an active GLD enzyme. It was uncontested that proteins

recombinantly produced in *E. coli* were not glycosylated ("sugar-free", i.e. lacked any galactose, glucose, mannose and arabinose residues as referred to in claim 1), because *E. coli* does not contain the enzymes required for glycosylation, i.e. for adding sugar residues to a protein. This belonged to the common general knowledge of the skilled person. Furthermore, the absence or presence of sugar residues on a protein were a structural feature of this protein. A skilled person reading Example 2 of the priority application (and Examples 3 in the parent application and the patent application) therefore immediately understood that the GLD recombinantly produced in *E. coli* was sugar-free (i.e. not glycosylated) although this was not explicitly mentioned. The production of sugar-free GLD in *E. coli* was thus the clear and unambiguous consequence of the explicit disclosure of this working example in view of *E. coli*'s generally known inability to produce glycosylated proteins. It was established case law that such a feature was implicit (see Case Law of the Boards of Appeal, 10th ed. 2022, I.C.4.3 and T 666/89). Thus, G 1/15 applied to the present case.

Appellant I had contested whether claim 1 as granted belonged to the so called "AND" or "OR" claim category as defined in G 1/15. The board noted that the method in claim 1 comprised as an embodiment the use of GLD or variants thereof. These variants lacked any galactose, glucose, mannose and arabinose since the content of these sugars was defined as "10 myg or less per myg of protein", which included 0 myg/myg GLD, i.e. a "sugar-free" GLD. If, as asserted by appellant I, the disclosure of a sugar-free GLD in Example 3 of the parent application fell necessarily within the subject-matter of claim 1, then this applied likewise to the sugar-free GLD of Example 3 of the patent application too. Moreover, since both Examples 3 were identical to Example 2 of the priority document, claim 1's embodiment of a sugar-free GLD was present in the priority document too. According to the board, this finding corresponded to the practice under Art. 88 EPC established by the case law.

The board concluded that the embodiment of claim 1 using a sugar-free GLD for the preparation of a biosensor had to be regarded as an "OR" claim as defined in G 1/15, since sugar-free GLD was an implicitly disclosed feature in Examples 2 and 3 of the priority document and the patent application, respectively. Consequently, this embodiment of claim 1 was entitled to partial priority. Therefore, the parent application could not anticipate the claimed method.

099-09-23

8. Article 104(1) EPC | T 1807/15 | Board 3.5.02

Article 104(1) EPC

Case Number	T 1807/15
Board	3.5.02
Date of decision	2022.12.02
Language of the proceedings	EN
Internal distribution code	C
Inter partes/ex parte	Inter partes
EPC Articles	Article 104(1) EPC
EPC Rules	
RPBA	Article 16(1) RPBA 2020
Other legal provisions	
Keywords	apportionment of costs (no) – postponement of oral proceedings – referral to the Enlarged Board – late filed submissions – abuse of procedure (no)
Cited decisions	
Case Law Book	III.R.2.1.1b), III.R.2.2.3 , 10th edition

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

In [T 1807/15](#) the respondent (patent proprietor) had requested that costs be apportioned to the appellant (opponent) because: (a) the appellant had not given advance notice to the respondent of its intention to request a referral to the Enlarged Board and (b) the appellant had made submissions E17-E11 after the first oral proceedings, in each case causing unnecessary work for the respondent's representative.

In its Catchword the board stressed that the postponement of oral proceedings due to a request for a referral of a question of law to the Enlarged Board which was not announced in advance by the party making the request would normally not justify apportionment of costs. Since there was no guarantee that such a request would be successful, all parties would normally have to prepare for a discussion on the substance of the case irrespective of whether the request was announced in advance or not. The board further noted that it was a party's right to request a referral, and exercising this right was not a reason for a different apportionment of costs. The exercise of this right should in particular not be limited by the threat of apportionment of costs.

Moreover, the board held that preparation for discussions on admission and also for a discussion as to the substance in the case that late submissions were taken into

account was part of the normal preparatory work of each party. It was not apparent to the board, and it had not been substantiated by the respondent, that higher costs had been incurred by the timing of the submissions in question after the first summons, compared to the hypothetical situation that the appellant had filed them with the statement of grounds of appeal. Whether submissions were ultimately relevant for the decision would normally not play a role in deciding whether they justified a different apportionment of costs, unless maybe they were so irrelevant that they could be considered an abuse of the procedure. It was not apparent to the board, and had not been argued by the respondent, that this was the case here.

Therefore, the request for apportionment of costs was refused.

100-09-23

9. Article 117 EPC | T 0423/22 | Board 3.2.01

Article 117 EPC

Case Number	T 0423/22
Board	3.2.01
Date of decision	2023.03.24
Language of the proceedings	EN
Internal distribution code	C
Inter partes/ex parte	Inter partes
EPC Articles	Articles 112(1), 113(1), 117(1)(d), 117(2) EPC
EPC Rules	Rules 117, 118, 119(1), 119(3) EPC
RPBA	Article 21 RPBA 2020
Other legal provisions	
Keywords	evidence – taking of evidence – hearing witness by videoconference before first instance – legal basis – right to be heard – possibilities of interaction with the witness not significantly limited – credibility of a witness – body language – witness employee located in the opponent's office
Cited decisions	G 0001/21, T 1418/17, T 0042/19
Case Law Book	III.B.2.6.4 , III.C.7.3 , III.G.3.1.7 , V.B.2.3 , 10th edition

In [T 423/22](#) the opposition division had heard witness M by videoconference without the consent of the appellant (patent proprietor).

The board considered that Art. 117(1)(d) and R. 117 EPC provided a legal basis for hearing a witness by videoconference. The board furthermore emphasised that hearing the witness by videoconference in the case in hand had not infringed the appellant's right to be heard and it had not substantially limited the interaction between the opposition division, the parties and the witness compared to hearing a witness in the courtroom.

As to the appellant's argument that it had not been able to observe the witness's body language during their hearing, and therefore it had been deprived of the opportunity to objectively judge their credibility, the board noted the following:

Firstly, it was the deciding body's responsibility, not the parties', to judge the personal credibility of a witness and the plausibility of a witness's statement. It was up to the relevant department to decide which possible way to hear a witness.

Secondly, the credibility of a witness was not determined largely by their body language. On the contrary, the credibility of a witness depended primarily on the plausibility and conclusiveness of their testimony and the absence of contradictions, in particular contradictions within the witness's own testimony, but also contradictions between the testimonies of several witnesses and/or contradictions between the witness's testimony and the evidence on file (see also Catchword).

Thirdly, most of the body language relevant for determining secondary information such as whether a witness was nervous could be perceived in the camera-section visible to the other participants of the videoconference anyway. According to the board the appellant did not give any reason related to the present case as to why the body language not visible during the videoconference could have influenced the opposition division's decision such that it would have come to a different conclusion on the witness's credibility. And even if part of the body language could not be seen, this drawback could never affect a party's right to be present and to put questions to the witness (R. 119(3) EPC) to such an extent that its right to be heard, i.e. the "opportunity to present comments on grounds or evidence" (Art. 113(1) EPC), would be violated.

The board further pointed out that its considerations with regard to hearing a witness by videoconference did not contradict decision G 1/21. Furthermore, under the current technical possibilities it could not be assumed that the EBA would have considered there to be a general obstacle against holding a witness hearing via videoconference. Whether G 1/21 required a general emergency in order to hear a witness by videoconference did not have to be addressed since G 1/21 did not concern oral proceedings in opposition proceedings nor taking of evidence, but instead was limited to oral proceedings in appeal proceedings.

Finally, the board examined the question of whether the opposition division had made an error of judgment when deciding to hold the witness hearing by videoconference. According to the legal framework applied in first instance, the opposition division may deviate from the standard of holding oral proceedings by videoconference if there are serious reasons against it. The board held that neither the "importance" of the prior use nor the fact that the outcome of the case hinged on the question of whether this prior use was public could constitute such "serious reason". The appellant had further alleged at the appeal stage that the witness being an employee of the opponent and being located in the opponent's office during their hearing constituted a special reason. However, this had not been raised during the opposition proceedings. Furthermore, the minutes of the taking of evidence showed that the opposition division had made sure that the witness was sitting alone in the room. The mere fact that the witness was an employee of the opponent did not necessarily cast doubts on the witness's reliability that were serious enough for a hearing by videoconference to be ruled out. Regarding the review of the evaluation of evidence by the first instance, the board adhered to T 1418/17 and T 42/19.

The referral of a question of law to the Enlarged Board was not considered necessary in view of the requirements of Art. 112(1)(a) EPC and Art. 21 RPBA 2020.

101-09-23

10. Article 122 EPC | T 2012/20 | Board 3.3.05

Article 122 EPC

Case Number	T 2012/20
Board	3.3.05
Date of decision	2022.11.11
Language of the proceedings	EN
Internal distribution code	D
Inter partes/ex parte	Ex parte
EPC Articles	Article 122 EPC
EPC Rules	
RPBA	
Other legal provisions	Article 02(1), item 11 RFees
Keywords	re-establishment of rights (yes) – due care on the part of the professional representative
Cited decisions	G 0012/91
Case Law Book	III.E.5.5.2 , 10th edition

In [T 2012/20](#) the appellant's representative had instructed the assistant via email on 13 November 2020 to promptly file an appeal. It was also indicated in the email that filing the appeal well before the expiry of the time limit would allow any possible shortcomings to be addressed, if needed. The appeal was filed on the same day and an appeal fee was paid. The board concluded from the evidence presented that the assistant knew how to file the appeal and how to pay the appeal fee, but, for whatever reason, paid the reduced fee instead of the normal fee.

The board referred to the EPO's Frequently Asked Questions (FAQ) section on its home page concerning Art. 2(1), item 11 RFees relating to the reduction of the appeal fee. The question "What does the EPO do if a declaration appears to be missing on the date of payment of the reduced fee for appeal?" was answered as follows: "If an appellant pays the reduced amount of the appeal fee without filing the necessary declaration, the EPO will proceed as follows: If the period for paying the appeal fee has not yet expired, a warning letter will be issued to inform the appellant that no declaration has been received by the EPO. If the time limit under Article 108 EPC has not yet expired, the appellant can either pay the missing amount to the full fee or file the missing declaration. Should the appellant omit to pay the missing amount or not file the declaration within the time limit under Article 108 EPC, the appeal may be deemed not to have been filed or the appeal may be considered inadmissible."

This information had already been available when the notice of appeal was filed in the present case. According to the board, it was evident that a representative reading

this information would expect to be promptly warned if a deficiency was apparent. In the case at hand, such a deficiency was readily recognised by the EPO, as could be seen from EPO Form 2901. This form was generated on 17 November 2020 (date at the bottom of the form), but post-dated 24 November 2020 – which is the normal procedure within the EPO (see, for example, G 12/91, point 9.1 of the Reasons) – and sent via registered mail. It was received by the appellant on 9 December 2020. Although registered mail was the official way of communication of the EPO, a representative reading the above response of the EPO to the FAQ would have expected the warning to be forwarded by the fastest possible means, especially if the time limit for paying the appeal fee had not yet expired, but was close to expiry.

In the board's opinion, this was all the more applicable, since at that time the restrictions due to the COVID-19 pandemic were highly likely to impact the normal functioning of postal services. In particular, the EPO itself used electronic means, namely the Zoom platform, to hold oral proceedings, and it was thus very surprising that appropriate electronic means were not used to warn applicants. In addition, the change in format of oral proceedings before the examining division to videoconference was announced by telephone on 9 July 2020 and this was promptly confirmed via email by the appellant. Registered mail was not used in either case.

The fact that the representative specifically indicated in her email to the assistant that the appeal should be filed some time before expiry of the time limit to allow possible shortcomings to be overcome indicated that the representative probably relied on the information provided by the EPO.

In view of all these factors (COVID-19, information provided in FAQ, electronic means previously used by the EPO, filing of appeal more than two weeks before the deadline), the board considered that in the particular situation of the case at hand there were exceptional circumstances leading to the conclusion that due care had been taken and consequently justifying the re-establishment of rights. Consequently, the appeal was deemed to have been filed.

102-09-23

11. Article 123(3) EPC | T 2257/19 | Board 3.4.03

Article 123(3) EPC

Case Number	T 2257/19
Board	3.4.03
Date of decision	2023.04.18
Language of the proceedings	EN
Internal distribution code	D
Inter partes/ex parte	Inter partes
EPC Articles	Article 123(2), 123(3) EPC
EPC Rules	
RPBA	Articles 13(1), 13(2) RPBA 2020
Other legal provisions	
Keywords	amendments – added subject-matter (yes) – inescapable trap (yes) – amendment after summons – amendment gives rise to new objections (yes) – objection not overcome
Cited decisions	
Case Law Book	II.E.3.1. , V.A.4.4.5g), V.A.4.5.10b), 10th edition

In [T 2257/19](#) the invention concerned a security element having magnetic elements in which the magnetic difference of the regions (magnetic codes) could not be detected by normal instruments, but exclusively by means of dedicated sensors.

The appellant held that feature (H) was not disclosed in the underlying original patent application. As to feature (G), it was allegedly based on the originally filed description. However, by removing feature (G) from the specific context of the corresponding embodiment and by placing it in the context of the originally claimed features (A) to (F) together with the new feature (H), new subject-matter was created. Amended feature (G) meant that the magnetic areas had to be separated in the horizontal as well as in the vertical direction. However, such a vertical separation was not disclosed anywhere in the originally filed application. Removing the feature of vertical separation would infringe the requirements of Art. 123(3) EPC. Feature (G) thus represented an inescapable trap. Therefore, new auxiliary requests 4A to 4C could not overcome the objections and therefore should not be admitted.

The board agreed with the arguments of the appellant. By filing auxiliary requests 4A to 4C the respondent attempted to overcome the "Art. 123(2)/(3) EPC trap" situation by better defining the horizontal separation of the magnetic areas and excluding vertical separation of the magnetic areas. However, the board observed that as usual with an "Art. 123(2)/(3) EPC trap", the exclusion of vertical separation would lead to a violation of Art. 123(3) EPC, as this would broaden the scope of protection granted.

On the other hand, healing of the violation of Art. 123(2) EPC was impossible as the original application documents did not provide a sufficient basis for the presence of a vertical separation. The elimination of feature (G) (and (H)) as a whole would be all the more contrary to the requirements of Art. 123(3) EPC.

An inescapable trap intrinsically precluded the admission of new requests under Art. 13(1) and (2) RPBA 2020, as the requirements of Art. 123(2) and (3) EPC could not both be satisfied. Consequently, and irrespective of the discussion as to whether there were exceptional circumstances that would justify filing the new requests at this very last stage of the procedure, auxiliary requests 4A to 4C were not admitted into the proceedings under Art. 13(2) and (1) RPBA 2020 because they prima facie could not overcome the objections under Art. 123(2) EPC without infringing the requirements of Art. 123(3) EPC.

103-09-23

12. Rule 139 EPC

| T 0130/19

| Board 3.3.03

Rule 139 EPC

Case Number	T 0130/19
Board	3.3.03
Date of decision	2023.01.11
Language of the proceedings	EN
Internal distribution code	D
Inter partes/ex parte	Inter partes
EPC Articles	
EPC Rules	Rules 006(4), 006(5), 139 EPC
RPBA	
Other legal provisions	
Keywords	correction of error (yes) – erroneous indication of method of payment on Form 1038E – admissibility of appeal (yes)
Cited decisions	G 0001/12, T 0317/19, T 3098/19
Case Law Book	III.U.2.2. , V.A.2.5.4c , 10th edition

In [T 130/19](#) the appellant (patent proprietor) filed a notice of appeal within the two-month time limit. However, due to the erroneous indication "not specified" in the "Method of payment" box on Form 1038E, the debit order for the payment of the appeal fee was not carried out before expiry of that time limit. The appellant requested a correction under R. 139, first sentence, EPC of Form 1038E.

According to the board, it was undisputed that the requested correction fulfilled the conditions set out in G 1/12. The board referred to T 317/19, which relied on G 1/12 and allowed a correction under R. 139 EPC in a similar factual situation concerning an appeal in an ex parte case. The board did not see why the reasoning in T 317/19 should not apply to an appeal in an inter partes case, since the ruling of G 1/12 clearly applied to both ex parte and inter partes cases. Moreover, T 3098/19, also applying G 1/12, authorised a correction under R. 139 EPC of the amount of the appeal fee in an inter partes case.

In the case at issue, the board was of the view that the indication "011 Appeal fee for an appeal filed by an entity other than those referred to in R. 6(4) and (5) EPC" in original Form 1038E showed that the intention of the patent proprietor was to pay the appeal fee at the same time as filing the notice of appeal. The request for correction was filed on the day that the appellant was informed by a telephone call from the registrar that the payment method had not been specified, i.e. without delay.

The board concluded that the request for correction of Form 1038E was to be allowed and that the appeal was therefore deemed to have been timely filed.

104-09-23

13. Article 12(6) RPBA 2020 | T 0141/20 | Board 3.3.10

Article 12(6) RPBA 2020

Case Number	T 0141/20
Board	3.3.10
Date of decision	2023.01.20
Language of the proceedings	DE
Internal distribution code	C
Inter partes/ex parte	Inter partes
EPC Articles	
EPC Rules	
RPBA	Article 12(4), 12(6) RPBA 2020
Other legal provisions	
Keywords	amendment to case – late-filed request – should have been submitted in first instance (no) – patent maintained in amended form by opposition division – no duty to present auxiliary requests to address objections considered unfounded by the opposition division
Cited decisions	
Case Law Book	V.A.4.3.7 , 10th edition

In [T 141/20](#) wurde das Patent im Einspruchsverfahren gemäß dem Hilfsantrag 1 aufrechterhalten. Die dagegen vorgebrachten Einwände (insbesondere nach Art. 123 (2) bzw. 76 (1) EPÜ) wurden von der Einspruchsabteilung als nicht überzeugend angesehen. In der Beschwerde konnte nach Ansicht der Kammer weder dem Hauptantrag des Patentinhabers (Zurückweisung der Einsprüche) stattgegeben werden, noch konnte das Patent auf der Grundlage der Hilfsanträge 1 bis 12, die bereits im Einspruchsverfahren Verfahrensgegenstand gewesen waren, aufrechterhalten werden. Die Kammer musste sich daher mit der Zulassung in das Beschwerdeverfahren des mit der Beschwerdebegründung eingereichten Hilfsantrags 13 befassen.

Die Kammer stellte zunächst fest, dass die Einwände der Einsprechenden gegen die Zulassung dieses Antrags auf Art. 12 (6) VOBK basierten, der insofern eine *lex specialis* zu Art. 12 (4) VOBK darstelle. Die Einsprechenden hatten hierzu argumentiert, dass sich der Einwand, der durch diesen Antrag ausgeräumt werden sollte, nämlich der Einwand nach Art. 76 (1) bzw. 123 (2) EPÜ, schon von Anfang an im Einspruchsverfahren befunden habe. Hilfsantrag 13 hätte daher bereits im Einspruchsverfahren eingereicht werden müssen.

Die Kammer teilte diese Auffassung nicht. Sie hob hervor, dass es nach Art. 12 (6) VOBK nicht ausreichend ist, dass die Anträge im Einspruchsverfahren hätten eingereicht werden können. Dass die Anträge "vorzubringen gewesen wären" hätte eines Anlasses bedurft. Einen solchen Anlass vermochte die Kammer aber nicht zu erkennen, da ja die Einspruchsabteilung im Verlauf des Verfahrens deutlich gemacht hatte, dass sie dem von den Einsprechenden vorgebrachten Einwand nicht folgt, und auch dementsprechend entschieden hatte. Die Kammer erläuterte, dass das Vorhandensein des Einwands im Verfahren als solches nicht als Anlass ausreiche. Es könne dem Patentinhaber im Einspruchsverfahren nicht zugemutet werden, grundsätzlich jedem vorgebrachten Einwand, und jeder Permutation von vorgebrachten Einwänden, durch die Einreichung von Hilfsanträgen zu begegnen. Dies würde auch eine ungebührliche Belastung für die Einspruchsabteilung und die anderen Verfahrensbeteiligten darstellen. Es liege in der Verantwortung des Patentinhabers, Einwänden, die er für unbegründet hält, lediglich argumentativ entgegenzutreten. Folge die Einspruchsabteilung in ihrer Entscheidung diesem Vorbringen, so könne eine Nichtzulassung von am Beginn des Beschwerdeverfahrens eingereichten Hilfsanträgen, die diesen Einwänden Rechnung tragen, gemäß Art. 12 (6) VOBK 2020 nicht ausschließlich damit begründet werden, der Antrag hätte bereits im Einspruchsverfahren eingereicht werden können. In die Zulassungsentscheidung müsse vielmehr einfließen, ob im Einspruchsverfahren eine Notwendigkeit bestand, den Antrag einzureichen.

Die Kammer wies überdies darauf hin, dass der Antrag im vorliegenden Fall zum frühestmöglichen Zeitpunkt im Beschwerdeverfahren eingereicht wurde und den Einsprechenden daher ausreichend Zeit blieb, ihm argumentativ zu begegnen. Der Sachverhalt an sich sei bereits ausführlich im Einspruchsverfahren diskutiert worden und auch in der angefochtenen Entscheidung detailliert abgehandelt.

Die Kammer kam nach eingehender Prüfung zu dem Ergebnis, dass das Patent auf der Grundlage des Hilfsantrags 13 aufrechterhalten werden konnte.

105-09-23

14. Article 13(2) RPBA 2020 | T 1807/15 | Board 3.5.02

Article 13(2) RPBA 2020

Case Number	T 1807/15
Board	3.5.02
Date of decision	2022.12.02
Language of the proceedings	EN
Internal distribution code	C
Inter partes/ex parte	Inter partes
EPC Articles	
EPC Rules	
RPBA	
Other legal provisions	Articles 12(2), 12(3), 13(2) RPBA 2020
Keywords	amendment after summons – taken into account (no) – meaning of "a summons to oral proceedings" if more than one summons are issued
Cited decisions	T 2279/16
Case Law Book	V.A.4.5.1 , 10th edition

[See also abstract under Article 104\(1\) EPC.](#)

In [T 1807/15](#) the board exercised its discretion pursuant to Art. 13(2) RPBA 2020 not to admit documents E7 and E8. The board held that, if more than one summons were issued in appeal proceedings (all after the entry into force of the RPBA 2020), Art. 13(2) RPBA 2020 referred to the first summons.


In the present case a first summons to oral proceedings to be held in Haar was issued in January 2020. The oral proceedings had to be rescheduled due to the Corona pandemic and took place in the form of a videoconference in February 2021. During these first oral proceedings the appellant filed a request that a question of law be referred to the Enlarged Board of Appeal, to which the board acceded. Documents E7 and E8 were filed in July 2021 together with objections based on them. Following the closure of the case before the Enlarged Board, the board summoned the parties in February 2022 to attend second oral proceedings which took place in December 2022.

The board held that the applicable provision for the exercise of the discretion on admittance was Art. 13(2) RPBA 2020. It was not convinced by the appellant's (opponent's) arguments according to which the rationale behind the convergent approach was procedural economy and its main object and purpose was to ensure that the board could decide at the end of oral proceedings.

The board underlined that, most importantly, the appellant's stance was not reconcilable with the wording of Art. 13(2) RPBA 2020. There was nothing to indicate that the application of this provision was dependent on the subsequent procedural history of the case. Moreover, the appellant's stance was not reconcilable with the object and purpose of Art. 13(2) RPBA 2020 in the context of the revised version of the Rules of Procedure of the Boards of Appeal. According to Art. 12(3) RPBA 2020 the statement of grounds of appeal and the reply, respectively, had to contain the parties' complete appeal cases. The notification of the summons then set an objective and predictable trigger for the third level of the convergent approach. This was the point in the procedure when the board, in ordinary circumstances, could safely assume that all submissions of the parties were on file, so that the board could outline in the communication pursuant to Art. 15(1) RPBA 2020, what the most important issues to be discussed would be. At this point normally, the framework of the discussion at the oral proceedings was defined, and further amendments to the appeal case were only taken into account in exceptional circumstances. It followed that also in view of the object and purpose of Art. 13(2) RPBA 2020, the subsequent procedural development was entirely immaterial for the function of the summons as an objective and predictable start point for the third level of convergence.

The board further explained that the appellant also erred in that procedural economy was the sole rationale behind the convergent approach. Another rationale was the implementation of the appeal proceedings as a judicial review of the decision under appeal (Art. 12(2) RPBA 2020). This principle limited the possibility to leave the legal and factual framework of the first instance proceedings at any point in the appeal procedure. Further reasons for the application of Art. 13(2) RPBA 2020 detailed by the board concerned among other things the function of the summons as predictable trigger for the third level of the convergent approach and a possible asymmetrical treatment of the two trigger points for the third level of the convergent approach, summons on the one hand and communication under R. 100(2) EPC on the other.

106-09-23



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