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# Abstracts of decisions

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

Issue 1 | 2024



Boards  
of Appeal

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## Abstracts of decisions

In this issue:

1.	Article 054 EPC	T 1356/21   Board 3.3.07	1
2.	Article 056 EPC	T 1356/21   Board 3.3.07	3
3.	Article 056 EPC	T 1806/20   Board 3.5.01	5
4.	Article 056 EPC	T 0302/19   Board 3.5.06	7
5.	Article 056 EPC	T 1959/20   Board 3.5.01	9
6.	Article 076 EPC	T 2171/21   Board 3.3.04	11
7.	Article 083 EPC	T 0728/21   Board 3.3.07	13
8.	Article 084 EPC	T 0438/22   Board 3.4.03	15
9.	Article 123(3) EPC	T 0953/22   Board 3.2.05	17
10.	Article 125 EPC	J 0004/23   Board 3.1.01	19
11.	Article 13(2) RPBA 2020	T 2352/19   Board 3.2.06	21
12.	Article 13(2) RPBA 2020	T 0916/21   Board 3.5.05	23

## 1. Article 054 EPC | T 1356/21 | Board 3.3.07

### Article 054 EPC

<b>Case Number</b>	T 1356/21
<b>Board</b>	3.3.07
<b>Date of decision</b>	2023.10.05
<b>Language of the proceedings</b>	EN
<b>Internal distribution code</b>	C
<b>Inter partes/ex parte</b>	Inter partes
<b>EPC Articles</b>	Article 054 EPC
<b>EPC Rules</b>	
<b>RPBA</b>	
<b>Other legal provisions</b>	
<b>Keywords</b>	novelty – second medical use – dosage regime – purpose-limited product claims
<b>Cited decisions</b>	G 0002/08, T 1074/06
<b>Case Law Book</b>	<a href="#">I.C.7.2.4e</a> , 10th edition

### [See also abstract under Article 056 EPC](#)

In [T 1356/21](#) claim 1 of the main request pertained to an aqueous pharmaceutical formulation characterised in particular in that "the concentration of insulin glargine is 270-330 U/mL being equimolar to 270-330 IU human insulin". This feature of claim 1 defined the concentration of insulin glargine in the composition, expressed as (international) units (U or IU). Claim 11 was identical to claim 1 with the addition of "for use in the treatment of Type I and Type II Diabetes Mellitus in a patient". Claim 23, pertaining to the "aqueous formulation according to any of the foregoing claims for use in the treatment of Type 1 Diabetes Mellitus and Type 2 Diabetes Mellitus", related to the same subject-matter as claim 11. Thus, both claims 11 and 23 were drafted in the format of Art. 54(5) EPC, i.e. as claims directed to the same composition as in claim 1 for a specific use in a method referred to in Art. 53(c) EPC.

According to the appellant, the subject-matter of claims 11-23 of the main request lacked novelty over D12, because the insulin glargine concentration defined in said claims fell within the broad meaning of the term "dosage regimen" as used in G 2/08, and yet was not characterised by any technical effect that would be particular to said sub-range compared to other concentrations within the range disclosed in D12. The appellant did not, however, object to the novelty of claim 1.

The board held that the fact that the compositions of claims 11 and 23 were limited, in comparison with claim 1, by the feature pertaining to their specific use in a method of treatment of Type I or II Diabetes Mellitus, did not entail that the features pertaining to the concentration of insulin glargine should no longer be regarded as defining the composition, but merely its use. Neither decision G 2/08 nor its reference to T 1074/06 (where the claims related to doses, and not concentration) justified reading the word "concentration" of claims 11 and 23 as a dosage regimen. In claims 11 and 23 just as in claim 1, the concentration feature defined the composition itself, i.e. the amount of insulin glargine in the composition, and not the use of the composition, i.e. the dose given to a patient at particular times or time intervals. This concentration feature thus established novelty for the subject-matter of claims 11 and 23 for the same reasons as for claim 1.

Additionally, considering the case law in the general situation of selections from numerical ranges, the board was not convinced by the appellant's argument that in the case of purpose-limited product claims pursuant to Art. 54(5) EPC relying on a dosage regimen defined by a numerical range, a selection from the prior art must be purposive for it to be novel.

In point 6.3 of G 2/08 the Enlarged Board of Appeal had stated that "the claimed definition of the dosage regime must therefore not only be verbally different from what was described in the state of the art but also reflect a different technical teaching". However, under the same point of the Reasons the Enlarged Board of Appeal explained that "for the assessment of novelty and inventive step of a claim in which the only novel feature would be the dosage regimen, the whole body of jurisprudence relating to the assessment of novelty and inventive step generally also applies". In the board's view, this indicated that G 2/08 did not seek to establish different novelty criteria for numerical ranges in the case of dosage regimen. Thus, the case law in the general situation of numerical ranges, as it has evolved over the years, must apply also in the case of dosage regimen. Consequently, the appellant's objection had to fail for the additional reason that, even if the concentration features of claims 11 and 23 were arguendo seen as a dosage regimen, the former criterion of a purposive selection should no longer be regarded as a requirement under G 2/08 for a dosage regimen to represent a novel selection from a broader range known in the prior art. Accordingly, the claimed subject-matter was novel.

001-01-24

## 2. Article 056 EPC | T 1356/21 | Board 3.3.07

### Article 056 EPC

<b>Case Number</b>	T 1356/21
<b>Board</b>	3.3.07
<b>Date of decision</b>	2023.10.05
<b>Language of the proceedings</b>	EN
<b>Internal distribution code</b>	C
<b>Inter partes/ex parte</b>	Inter partes
<b>EPC Articles</b>	Article 056 EPC
<b>EPC Rules</b>	
<b>RPBA</b>	
<b>Other legal provisions</b>	
<b>Keywords</b>	inventive step (yes) – bonus effect (no) – limits to the application of the concept of bonus effect
<b>Cited decisions</b>	T 0021/81, T 0192/82, T 0227/89, T 0506/92, T 1317/13, T 1147/16
<b>Case Law Book</b>	<a href="#">I.D.10.8.</a> , 10th edition

### [See also abstract under Article 54 EPC](#)

In [T 1356/21](#) the differentiating feature of the invention, namely the increase in insulin glargine concentration from 100 U/mL to 270-330 U/mL, lead to two types of technical effects: reduced discomfort or pain (due to reduced volume of injection), and flatter PK/PD profile, longer duration of action. The parties differed as to which of the two effects should be taken into account in the assessment of inventive step.

In the board's view, both effects were mentioned in the patent and were credibly achieved by the claimed subject-matter in comparison with the closest prior art embodiment. Accordingly, the technical problem was to be formulated objectively, taking into account both effects, as the provision of an improved aqueous pharmaceutical formulation of insulin glargine, i.e. the improvement being both a flatter exposure and flatter biological profile together with a longer duration of action, and a reduced discomfort.

According to the appellant (opponent), the reduction in the injection volume was the relevant effect, and was, as acknowledged in the patent, the purpose for increasing insulin glargine concentration in the first place. The additional effect of the concentration-dependent change of the PK/PD profile would be inevitably achieved as the result of increasing the insulin glargine concentration for the purpose of reducing the injection volume, and would thus represent a mere bonus effect.

The board disagreed. According to established case law, an effect which might be said to be unexpected could be regarded as an indication of inventive step. However, certain preconditions had to be met (see Case Law of the Boards of Appeal, 10<sup>th</sup> edition, 2022, I.D.10.8; in particular T 21/81 and T 506/92).

In the board's view, the case law on bonus effects could not be applied to all situations where a given differentiating feature lead to (or inevitably achieved) two separable technical effects, one of which may be expected. For an additional, unexpected effect to be disqualified as a mere bonus effect, it had to be shown either that the situation was characterised by a lack of alternatives as regards the means for achieving the first, expected improvement (i.e. a "one-way-street" situation as explained in T 192/82), or that, considering the relative technical and practical importance of the effects in the circumstances of the case, the additional unexpected effect was merely accidental (following T 227/89 and T 1147/16). In situations which did not qualify as a "one-way street", the board did not consider it appropriate that a crucial and unexpected technical advantage be disregarded in the assessment of inventive step as soon as any additional obvious effect was mentioned in the patent.

The board was aware of the view expressed in T 1317/13 that a "one-way-street" situation was not a mandatory prerequisite for the application of the principle established in T 21/81. However, neither T 1317/13 nor T 21/81 offered a basis for an unqualified application of the bonus effect case law to any situation of plurality of technical effects without regard to their respective technical and practical importance. The board's view in this regard was in agreement with the statement in T 192/82 that the use of means leading to some expected improvements might well be patentable if relying on an additional effect, provided this involved a choice from a multiplicity of possibilities.

The board considered that the present case did not qualify as a "one-way-street" situation; the skilled person could have addressed the issue of discomfort caused by the injection of larger volumes of the formulation by other means than an increased concentration. Furthermore, the effects of flatter PK/PD profiles and longer duration of action could not be regarded as merely accidental, but instead represented crucial advantages in the context of basal insulins. Lastly, in the board's opinion, it would also not be appropriate to disqualify the effect of flatter PK/PD profiles and longer duration of action as accidental, i.e. as being of lesser technical and practical importance, on account that these effects may be the result of a serendipitous discovery. What mattered was not in what circumstances the inventors realised the invention, but what the invention achieved. Thus, in the circumstances of the present case, the technical effects of flatter PK/PD profiles and longer duration of action could not be regarded as accidental and had to be taken into account. Similarly, the board was not convinced that the effect of reduced discomfort and injection volume should be regarded as a bonus effect either.

For the reasons given above, the board found that the fact that two technical effects arose from the same distinguishing feature did not mean that one of the two effects necessarily had to be regarded as a bonus effect.

002-01-24

### 3. Article 056 EPC | T 1806/20 | Board 3.5.01

#### Article 056 EPC

<b>Case Number</b>	T 1806/20
<b>Board</b>	3.5.01
<b>Date of decision</b>	2023.11.17
<b>Language of the proceedings</b>	EN
<b>Internal distribution code</b>	D
<b>Inter partes/ex parte</b>	Ex parte
<b>EPC Articles</b>	Article 056 EPC
<b>EPC Rules</b>	
<b>RPBA</b>	
<b>Other legal provisions</b>	
<b>Keywords</b>	inventive step – mixture of technical and non-technical features – logistics
<b>Cited decisions</b>	T 1194/97, T 0424/03
<b>Case Law Book</b>	<a href="#">I.D.9.2.16</a> , 10th edition

In [T 1806/20](#) the invention claimed in the main request concerned a parcel delivery system that sought to prevent damage to water-sensitive parcels by avoiding delivery to rainy destinations. A delivery vehicle is equipped with a satellite navigation system, for example within a tablet (not claimed), that is connected to a remote server. The system calculates a route for the delivery destinations of the parcels on board and acquires weather forecasts for the areas at these destinations at the estimated arrival times. Although not explicitly claimed, the application disclosed that these steps were performed by the remote server, which provided the calculated route, the weather forecasts and each parcel's water sensitivity feature to the satellite navigation system. Each parcel had an RFID tag that stored its delivery destination and a water-sensitivity feature. Although the appellant had argued that the water-sensitivity features in the RFID tags were uploaded to the server, this was neither claimed nor disclosed. Instead, the board understood, in light of the application, that the remote server stored the parcels' water-sensitivity features independently of the RFID tags and performed all processing using the internally-stored features. The navigation system guided the driver along the received route and if rain was expected at a delivery destination for a water-sensitive parcel, the navigation system provided a warning message to the driver and rescheduled the delivery of the parcel to another time during the same day or to the following day, provided that no rain was expected for that time or day.

The board agreed with the examining division, that the distinguishing features implemented a non-technical logistics scheme, which the appellant did not dispute.



The point of dispute was whether the rescheduling of the delivery based on the parcels' sensitivity to water and the rain forecast also formed part of this non-technical logistics scheme. The board was not convinced by the argument that information about a parcel's water-sensitivity was functional technical data in the sense of decisions T 1194/97 and T 424/03, because its loss would impair the technical operation of the system (T 1194/97).

It was self-evident that if a piece, either technical or non-technical, of any invention is taken out, it would not work as designed. In the board's view, what T 1194/97 was saying was rather that the loss of functional data would make the system inoperable at the technical level. In contrast, if cognitive data was lost, the system would still work but possibly produce results that would be unintended for non-technical reasons. Thus, in T 1194/97, the loss of functional data had prevented the system from generating any television picture, whereas the loss of cognitive data only resulted in a meaningless television picture resembling snow.

In the present case, the loss of water-sensitivity information would not cause the system to stop working; the vehicle would still be guided, and parcels would be delivered. However, it would result in leaving water-sensitive parcels standing in the rain – an unintended operation comparable to producing a television picture that resembles snow. The reasons why these outcomes are unintended are non-technical. In T 1194/97, it was the cognitive meaninglessness of the television picture to a human viewer; in the present case, it was the prevention of rain damage to a parcel. Hence, judged by the consequence of its loss, the water-sensitivity data was equivalent to cognitive rather than functional data.

Applying the Comvik approach, once the business requirement had been given to the skilled person to implement, enhancing the server to calculate routes including multiple parcel destinations and acquiring rain forecast for those destinations would have been obvious. It would also have been obvious to store the parcels' water-sensitivity features at the server and to adapt it to reschedule parcel delivery in case of rain. The use of RFID tags to store features of parcels would also have been obvious in view of the prior art. Hence, claim 1 of the main request lacked an inventive step.

003-01-2024

## 4. Article 056 EPC | T 0302/19 | Board 3.5.06

### Article 056 EPC

<b>Case Number</b>	T 0302/19
<b>Board</b>	3.5.06
<b>Date of decision</b>	2023.12.21
<b>Language of the proceedings</b>	EN
<b>Internal distribution code</b>	D
<b>Inter partes/ex parte</b>	Ex parte
<b>EPC Articles</b>	Article 056 EPC
<b>EPC Rules</b>	
<b>RPBA</b>	
<b>Other legal provisions</b>	
<b>Keywords</b>	inventive step – mixture of technical and non-technical features – automation
<b>Cited decisions</b>	
<b>Case Law Book</b>	<a href="#">I.D.9.2.4</a> , 10th edition

In [T 302/19](#) the examining division considered claim 1 as being a straightforward automation of a known manual practice of a laboratory assistant.

The board held that for such an argument to succeed, it should be clear what the alleged manual practice is, it should be convincing that it was indeed an existing practice at the relevant date and that it would have been obvious to consider automating it. It held that a clear description of the alleged manual practice – in particular of the concrete steps allegedly performed by a laboratory assistant – had not been sufficiently provided by the examining division.

While it appeared to be uncontested that the trypan blue dye exclusion test was the basis of a common manual practice for assessing the viability of cells in a sample at the relevant date, the board was unconvinced, on the basis of the available evidence, that it was part of that practice, to determine the viability of any given cell by first attempting to determine it based on a first focus plane and, if the cell appeared to be dead on the basis of that first focus plane, to try again based on a second focus plane. The board considered that the quoted prior art D6 did not establish the existence before the relevant date of a manual practice as described by the examining division. It furthermore held, that automating the manual practice described in the prior art D10 would have been an obvious aim, but the skilled person would thereby not have arrived at the invention. According to the board, even consideration of the teaching of D6 in the course of devising an automated version of

the manual practice described in D10 would not have led the skilled person to the invention.

004-01-24

## 5. Article 056 EPC | T 1959/20 | Board 3.5.01

### Article 056 EPC

<b>Case Number</b>	T 1959/20
<b>Board</b>	3.5.01
<b>Date of decision</b>	2023.11.09
<b>Language of the proceedings</b>	EN
<b>Internal distribution code</b>	D
<b>Inter partes/ex parte</b>	Ex parte
<b>EPC Articles</b>	Article 056 EPC
<b>EPC Rules</b>	
<b>RPBA</b>	
<b>Other legal provisions</b>	
<b>Keywords</b>	inventive step – mixture of technical and non-technical features – implementation of non-technical requirements
<b>Cited decisions</b>	
<b>Case Law Book</b>	<a href="#">I.D.9.2.9</a> , 10th edition

In [T 1959/20](#) the invention concerned the automatic deletion of messages in group chats, for example in the context of social networks. In particular, the goal was to implement an "ephemeral group chat", that is, a chat whose messages are automatically deleted when a certain condition is met, for example, when a message has been viewed for a certain amount of time by all recipients. To achieve this, the invention defined a system in which several client devices exchange messages via a central server system. Chat messages entered at a client device are provided to the server, which forwards them to all the intended recipients. When a triggering event occurs (for example, a recipient has viewed the message for the predetermined amount of time), the recipient's client device sends a message ("chat monitoring information") back to the server. Having received chat monitoring information from all the recipients, the server determines that the deletion triggering condition has been met and sends, to the client devices, a message indicating that the message be deleted.

The board judged that the feature of deleting all copies of a message after it has been read by all recipients was not based on technical considerations. Nor did it solve a technical problem. Rather, it was a non-technical requirement expressing a user's wish or subjective preference. Indeed, the claim was even more general than this, as it did not specify the content of the deletion trigger information, or the corresponding event. Following the established case law of the Boards of Appeal, non-technical features do not contribute to inventive step but may instead appear in

the formulation of the technical problem, in particular as constraints or requirements to be achieved. Accordingly, the board formulated the technical problem as how to implement the requirement of deleting all copies of a chat message based on the occurrence of an event in all client devices, such as the message having been read by all participants.

The board recognised that the implementation of non-technical requirements on a technical prior art system might require modifications which, at first glance, appear non-obvious, as there is no technical reason for them in view of the prior art alone. However, since according to the principles of "Comvik" non-technical features cannot contribute to inventive step, the non-technical requirements must be seen as a given, and the skilled person implementing them must make the necessary modifications to the prior art. For these reasons, the board concluded that claim 1 lacked an inventive step over the prior art.

005-01-24

## 6. Article 076 EPC | T 2171/21 | Board 3.3.04

### Article 076 EPC

<b>Case Number</b>	T 2171/21
<b>Board</b>	3.3.04
<b>Date of decision</b>	2023.11.07
<b>Language of the proceedings</b>	EN
<b>Internal distribution code</b>	D
<b>Inter partes/ex parte</b>	Inter partes
<b>EPC Articles</b>	Articles 076, 100(c) EPC
<b>EPC Rules</b>	
<b>RPBA</b>	
<b>Other legal provisions</b>	
<b>Keywords</b>	divisional application – added subject-matter – extension beyond the content of the earlier application as filed (yes) – selections from two or more lists
<b>Cited decisions</b>	G 0002/10, T 2273/09, T 3035/19
<b>Case Law Book</b>	<a href="#">II.E.1.6.2c</a> , 10th edition

In [T 2171/21](#) the board explained that there existed a difference between the conceptual disclosure of a number of possible combinations and the individualised disclosure of specific combinations. While the former might be a more economical way of drafting a patent application, it did not necessarily allow the skilled person to derive each and every individual combination directly and unambiguously.

In the case in hand, claim 1 was directed to a specific dosage regimen (steps (a) and (b) of the claim) including a specific induction dose (150 mg) for a specific disease (AS). The disease AS was disclosed in the earlier application as filed in a list comprising RA and a generic reference to other forms of inflammatory arthritis, which were exemplified by three concrete diseases. The dosage regimen was disclosed in the last of nine rows in Table 5, and the induction dose was disclosed as one of two options in the last row of Table 5. To arrive at the claimed subject-matter, the skilled person had to select one element from each of the three lists and combine the three, or they had to "compute" all possible combinations (48 in this case) and discard 47 of them. Neither approach could be considered to lead to subject-matter disclosed directly and unambiguously in the earlier application as filed. Due to the repeated necessity for making selections, the selection from three lists could not be seen as resulting in subject-matter derivable from what was directly at the disposal of the skilled person. The calculation of all possible combinations, due to the step of computing, was not direct.

The respondent argued that the situation was fundamentally different from the selection of groups for substitution in a Markush formula. The board disagreed. In the same way that Markush formulae could represent conceptual combinations of lists of different chemical groups (e.g. R1 and R2) with different core structures, the disclosure in the earlier application as filed represented conceptual combinations of different dosage regimens and induction dosages with different diseases. Just as different chemical groups could not coexist at the same position on a given chemical core structure, the same patient with a disease could not be treated at the same time with different dosage regimens or different induction dosages.

The board agreed with the respondent that considerations on a selection from several lists were not meant to replace the gold standard (G 2/10, point 4.3 of the Reasons).

An aspect also addressed by the Enlarged Board in G 2/10 was the issue of "singling out" by holding that "there would be added matter" where the amendment "would result in singling out any hitherto not specifically mentioned or at least implicitly disclosed individual compound or group of compounds ..." (point 4.5.4 of the Reasons). The board held that the "singling out" of a combination of features was precisely what happened in claim 1 of the present case (T 2273/09). Furthermore, the board agreed with T 3035/19 that considerations on selections from two or more lists of some length provided valuable guidance. However, the board also acknowledged that the combination of features resulting from selections from two or more lists only added subject-matter in the absence of a pointer to that particular combination. The concept of selection from lists had to be applied with due regard to the whole content of the earlier application as filed.

In the case in hand, the earlier application as filed did not contain a preference for or pointer to any of the combined features or to the chosen combination. The ground for opposition in Art. 100(c) EPC thus prejudiced the maintenance of the patent.

006-01-24

## 7. Article 083 EPC | T 0728/21 | Board 3.3.07

### Article 083 EPC

<b>Case Number</b>	T 0728/21
<b>Board</b>	3.3.07
<b>Date of decision</b>	2023.11.16
<b>Language of the proceedings</b>	EN
<b>Internal distribution code</b>	D
<b>Inter partes/ex parte</b>	Inter partes
<b>EPC Articles</b>	Articles 054(5), 083, 100(b) EPC
<b>EPC Rules</b>	
<b>RPBA</b>	
<b>Other legal provisions</b>	
<b>Keywords</b>	sufficiency of disclosure – evidence of therapeutic effect – suitability to be disclosed in the patent "unless this is already known" – credibility also derivable from prior art, even not representing common general knowledge – post-published evidence
<b>Cited decisions</b>	G 0001/03, G 0002/21, T 0609/02, T 2059/13, T 0391/18
<b>Case Law Book</b>	<a href="#">I.D.4.3.3</a> , <a href="#">II.C.7.2.2</a> , 10th edition

In [T 728/21](#) the invention was a pharmaceutical composition for use in treating cystic fibrosis. The patent was objected to inter alia based on lack of inventive step and lack of sufficiency of disclosure.

The appellant (opponent) submitted that the patent merely presented a statement but failed to provide any experimental data supporting the therapeutic efficacy and concluded with reference to T 609/02 and T 2059/13 that the patent did not sufficiently disclose the suitability of the claimed composition for the defined therapeutic efficacy with such mere verbal statements. Further, the proprietor could not rely on some specific prior art to support the suitability of the claimed composition for the defined use, because the sufficiency of the disclosure could only be based on the content of the patent and the common general knowledge. The opponent also argued that post-published document D15 submitted by it raised serious doubts and that these serious doubts could not be overcome by reference to the post-published evidence in document D20 submitted by the proprietor.

The board first acknowledged that the technical effect demonstrated in post-published experimental evidence (D20) could be taken into account in accordance



with the principle established in G 2/21 for the assessment of inventive step. Concerning the allegation of lack of sufficiency of disclosure, the board recalled that if a patent defined a new therapeutic utility of a composition in a claim in the format of Art. 54(5) EPC, it was necessary according to the established jurisprudence that the patent at the date of its filing rendered it credible that the claimed composition was indeed suitable for the defined therapeutic use (G 2/21, point 74 of the Reasons). A deficient disclosure cannot be remedied by post-published evidence (G 2/21, point 77 of the Reasons; compare G 1/03, points 2.5.2 to 2.5.3 of the Reasons).

The board came to the conclusion that the patent did not describe the activity of ivacaftor as a CFTR potentiator in the form of a simple verbal statement, which might in line with the considerations in T 609/02 be considered not to be sufficient, but rather as specific and verifiable technical information supporting the defined therapeutic indication. According to the board this information in the patent provided a rational basis for the claimed invention, which rendered the utility of the claimed composition in the treatment of patients credible at the date of its filing.

The board specified that in accordance with the jurisprudence exemplified by T 609/02 (point 9 of the Reasons), the suitability of the claimed composition for the defined therapeutic use needed to be disclosed in the patent, "unless this is already known". This jurisprudence confirmed in the board's view that the disclosed utility of the claimed composition may also derive its credibility from the prior art, even if this prior art did not represent common general knowledge (Catchword). The board considered that the prior art confirmed the credibility of the disclosed utility of the claimed composition.

In as far as a patent provides a credible disclosure of the claimed invention, a convincing objection of lack of sufficiency of disclosure presupposes according to the established jurisprudence that serious doubts substantiated by verifiable facts have been raised. The appellant argued that the post-published document D15 raised serious doubts regarding the utility of ivacaftor in the treatment of patients. According to the board, D15 reported measurable effects, and the mere lack of an observed clinical effect from treatment with ivacaftor alone as reported in D15 did not qualify as verifiable evidence that raised serious doubts regarding the credibly disclosed suitability of the claimed composition.

The main request met the requirements of sufficiency of disclosure.

007-01-24

## 8. Article 084 EPC | T 0438/22 | Board 3.4.03

### Article 084 EPC

<b>Case Number</b>	T 0438/22
<b>Board</b>	3.4.03
<b>Date of decision</b>	2023.11.23
<b>Language of the proceedings</b>	EN
<b>Internal distribution code</b>	C
<b>Inter partes/ex parte</b>	Ex parte
<b>EPC Articles</b>	Articles 010(2)(a), 069, 084, 094(3), 112(1)(a), 112(3) EPC
<b>EPC Rules</b>	Rules 042, 048, 071(1) EPC
<b>RPBA</b>	
<b>Other legal provisions</b>	Guidelines F-IV, 4.4 – March 2021 and March 2023 versions
<b>Keywords</b>	claims – support in the description – claim interpretation – adaptation of the description – claim-like clauses – referral to the Enlarged Board (no)
<b>Cited decisions</b>	T 0454/89, T 0749/00, T 1808/06, T 1399/17, T 2766/17, T 1024/18, T 1968/18, T 1989/18, T 2293/18, T 1473/19, T 2194/19, T 2685/19, T 2968/19, T 3097/19, T 0169/20, T 1444/20, T 0121/20, T 1516/20, T 1426/21
<b>Case Law Book</b>	<a href="#">II.A.5.3.</a> , <a href="#">II.A.6.2.</a> , <a href="#">II.E.1.14.2.</a> , <a href="#">V.B.2.1.</a> , <a href="#">V.B.2.3.1.</a> , <a href="#">V.B.2.3.6.</a> , 10th edition

In [T 438/22](#) the board pointed out that there was no provision stipulating that examples within the meaning of R. 42(1)(e) EPC should not be in the form of claim-like clauses (i.e. in the form of one or more independent clauses followed by a number of clauses referring to previous clauses) at the end of or in another part of the description. There was no justification for deleting such examples just because they were drafted as claim-like clauses. They were to be treated like any other part of the description and thus, inter alia, must support the claims (Art. 84 EPC). It was not justified to unconditionally require their deletion from the description, contrary to what was stated in the Guidelines (F-IV, 4.4).

Concerning the interpretation of the requirement of Art. 84 EPC that the claims must be supported by the description, the board disagreed with the findings of T 1989/18. The board also disagreed that R. 48(1)(c) EPC could not provide a legal basis for an obligatory adaptation of the description. On the contrary, the board agreed with the

long-established case law of the boards that "supported by the description" meant requiring the entirety of the description to be consistent with any claims found to meet the requirements of the EPC (see T 1024/18, T 1808/06, T 2293/18, T 1399/17, T 2766/17, T 1516/20, T 121/20, T 1968/18, T 2685/19).

According to the board, it was a general and overarching objective, and as such also a "requirement" of the Convention, that authorities, courts and the public interpreting the claims at a later stage should, as far as possible, arrive at the same understanding of the claimed subject-matter as the EPO bodies deciding on the patentability of the same subject-matter. The only tool for achieving this objective was the patent specification as the expression of a unitary legal title. The description, as an integral part of the patent specification, should therefore also serve this overriding objective, i.e. it should provide a common understanding and interpretation of the claims. If the description contained subject-matter which manifestly impeded a common understanding, it was legitimate to insist on its removal under Art. 84 and 94(3) EPC and R. 42, 48 and 71(1) EPC. Regarding the provisions of R. 48(1) EPC, including those of R. 48(1)(c) EPC, the board found that they were not to be regarded as merely optional guidelines but as mandatory and to be complied with for a patent to be granted on a European patent application.

The board approved of the practice where instead of a direct removal, i.e. the deletion of the subject-matter not covered by the claims, a "removal" by way of an appropriate statement is made, leaving the technical disclosure unaffected. In the view of the board, this practice resulted in a correct and equitable compromise between the interests of the applicant to retain the disclosed subject-matter and the overall purpose of the description to facilitate claim interpretation and the common understanding of the claimed subject-matter.

Moreover, the board refused the request for referral to the Enlarged Board of questions relating to the rejection of an application due to the usage of claim-like clauses. The appellant submitted, among others, that a decision of the Enlarged Board was necessary as the Guidelines would have to take into account a decision by the Enlarged Board, which "might put an end to the current discrepancy between the Guidelines and the case law". The board admitted that the wording of Art. 112(1)(a) EPC may appear to suggest that the removal of a discrepancy between the Guidelines and the case law could also be understood as "ensuring uniform application of the law" and as such be a good reason for an admissible referral. However, the Enlarged Board had no formal powers in this respect. According to the board, this could be inferred from Art. 112(3) EPC which made it clear that the formal binding power of the decision of the Enlarged Board was limited to the case before the referring board. The board concluded that a referral whose sole purpose was to correct the Guidelines and which was not necessary either for ensuring a uniform case law within the boards or for the board's decision was inadmissible. Such a referral could be perceived as an attempt to encroach on the President's powers under Art. 10(2)(a) EPC.

008-01-24

## 9. Article 123(3) EPC | T 0953/22 | Board 3.2.05

### Article 123(3) EPC

<b>Case Number</b>	T 0953/22
<b>Board</b>	3.2.05
<b>Date of decision</b>	2023.09.19
<b>Language of the proceedings</b>	EN
<b>Internal distribution code</b>	D
<b>Inter partes/ex parte</b>	Inter partes
<b>EPC Articles</b>	Articles 069, 100(c), 123(3) EPC; Article 123(3) EPC 1973
<b>EPC Rules</b>	
<b>RPBA</b>	
<b>Other legal provisions</b>	Protocol on the Interpretation of Article 69 EPC
<b>Keywords</b>	amendments – extension of the protection conferred (yes) – disclosure in drawings
<b>Cited decisions</b>	G 0002/88, G 0001/93, T 1149/97, T 0142/05, T 2475/18, T 1473/19
<b>Case Law Book</b>	<a href="#">II.A.6.3.3</a> , <a href="#">II.E.2.4.5</a> , 10th edition

In [T 953/22](#) the board noted that the wording of Art. 123(3) EPC was not identical to the wording of Art. 123(3) EPC 1973, which read: "**The claims of** the European patent may not be amended during opposition proceedings in such a way as to extend the protection conferred." (emphasis added by the board). However, the case law on Art. 123(3) EPC 1973 made it clear that the extent of protection under Art. 69 EPC 1973 and the Protocol on its Interpretation was determined by the wording of the claims, taking into account the description and drawings, and that amendments to the description and drawings may therefore also extend the protection under Art. 69(1) EPC 1973 (see e.g. G 2/88, point 4 of the Reasons; G 1/93, point 11 of the Reasons; T 1149/97 and T 142/05). For this reason, the basic principles analysed in the case law on Art. 123(3) EPC 1973 were applicable to Art. 123(3) EPC as well. In T 142/05, the board held that amendments to the description and drawings could modify the content of the claims and possibly extend the scope of protection under Art. 69(1) EPC 1973, even where the wording of the claims was clear and remained unamended.

In auxiliary request 1 ("AR 1") of the case in hand, claim 1 and the description remained unamended. The description disclosed that the length of the overlay welds was shown as L2 in Figure 4 ("Fig. 4"). However, Fig. 4 of AR 1 differed from Fig. 4 of the patent as granted. In Fig. 4 of the patent as granted, length L2 of the overlay welds was depicted as extending on only one side of the girth weld. In contrast, in

Fig. 4 of AR 1, length L2 of the overlay welds was depicted as the total length of the overlay welds on both sides of the girth weld. Using Fig. 4 of the patent as granted, an arrangement with a total length of the overlay welds of 160 mm, i.e. 80 mm on either side of the girth weld, was not within the extent of the protection conferred. However, in view of amended Fig. 4, the same arrangement lay within the extent of the protection conferred according to AR 1. Considering amended Fig. 4, the board established that the protection conferred by the patent as amended according to AR 1 was extended (Art. 123(3) EPC; G 2/88, point 4.1 of the Reasons).

The board was not convinced by the counter-arguments of the appellant. Firstly, the appellant submitted that the skilled person knew that Fig. 4 of AR 1 was wrong, so they would not use this figure to interpret the claims. However, the board explained that the skilled person would not immediately recognise amended Fig. 4 as incorrect. Secondly, by referring inter alia to T 1473/19, the appellant argued that a discrepancy between the claims and the description was not a valid reason to ignore the clear linguistic structure of a claim and to interpret it differently or to give a different meaning to a claim feature which in itself imparted a clear credible technical teaching to the skilled reader. The board explained that the description and drawings were also taken into account for the purposes of Art. 123(3) EPC if the claims were clear and unambiguous. They were not only consulted to fill gaps. The statement that "limiting features which are only present in the description but not in the claim cannot be read into a patent claim" (T 1473/19) was not fully applicable to the case in hand.

Citing Art. 1 of the Protocol on the Interpretation of Article 69 EPC and G 2/88 (point 4 of the Reasons), the board, while also recognising the primacy of the claims under Art. 69(1) EPC, explained that it would not in the case in hand go so far as to say that the disclosure of the description and the figures could not be read into the patent claim. The board also relied on G 1/93 (point 11 of the Reasons), according to which: "In principle, it does not matter whether the addition concerns the claims, the description or the drawings, since the protection conferred by the patent has to be determined by all these elements in accordance with Art. 69 EPC and the Protocol on the interpretation of this provision. However, the claims are no doubt the most important element in this respect."

Further, the facts in T 1473/19 were different. In T 1473/19 the objection under Art. 123(3) EPC was raised against a request with amended claims, whereas in the present case the amendment was only to one of the figures of the patent as granted. The features of claim 1 as granted did not define how the length of the overlay welds was to be understood. It was only by using the description and the drawings, in particular Fig. 4 as granted (or as amended in AR 1), that the extent of protection could be determined. Fig. 4 as granted (or as amended in AR 1) was thus not used to read limiting features into claim 1 that were not present in this claim but to determine the extent of the protection conferred.

009-01-24

## 10. Article 125 EPC | J 0004/23 | Board 3.1.01

### Article 125 EPC

<b>Case Number</b>	J 0004/23
<b>Board</b>	3.1.01
<b>Date of decision</b>	2023.10.25
<b>Language of the proceedings</b>	EN
<b>Internal distribution code</b>	D
<b>Inter partes/ex parte</b>	Ex parte
<b>EPC Articles</b>	Articles 125, 134(2)(a), 134(2)(c), 134(7) EPC
<b>EPC Rules</b>	
<b>RPBA</b>	
<b>Other legal provisions</b>	
<b>Keywords</b>	general principles – protection of legitimate expectations – erroneous information from EPO – request to be entered on the list of professional representatives (rejected)
<b>Cited decisions</b>	G 0005/88, G 0003/91, G 0005/93, G 0002/97, J 0027/92, J 0010/17, J 0010/20, T 0460/95, T 0152/95, T 1063/18
<b>Case Law Book</b>	<a href="#">III.A.2.2.1</a> , <a href="#">III.A.2.3.</a> , 10th edition

In [J 4/23](#) the appeal was against the decision of the Legal Division rejecting the appellant's request to be entered on the list of professional representatives before the EPO (the "List"). The appellant had relied on erroneous information published on the EPO's website and based his appeal on the principle of the protection of legitimate expectations. It was not disputed that the appellant had not passed the European qualifying examination (EQE) and that there was no legal basis in the EPC under which the EPO could grant an exemption from the requirement under Art. 134(2)(c) EPC to pass the EQE for being entered on the List.

The EPO's website at the time of the request provided the following information: "... in accordance with Article 134(7) EPC, the Vice-President in charge of DG5 is entitled to grant exemption from requirements (a) and (c) of Article 134(2) EPC", referring to the Decision of the President of the EPO dated 1 December 2011 delegating his powers to decide on requests for exemption from requirements for entry on the List (OJ 2012, 13). The Legal Board noted that this information merely stated that a power had been delegated by the President of the Office to VP5 and that it could not be deduced from such information that the appellant would be entered on the List. The Legal Board recalled that the principle of the protection of legitimate expectations was subject to several limitations. Not every expectation held by a

person was automatically a legitimate one within the meaning of this principle. Whether an expectation was legitimate must be assessed by applying the principle to the facts of the case and, depending on the circumstances of the case, the relief sought may or may not be granted. It was therefore inherent in the principle of the protection of legitimate expectations that a person could only successfully invoke an expectation on which they could, on an objective basis, legitimately rely. Therefore, it must be established that, on an objective basis, it was reasonable for a requestor to have been misled by the information on which they relied.

The Legal Board pointed out that the appellant had been immediately informed by the EPO that the statement on the website was erroneous. Moreover, the terms and conditions of use of the EPO's website included a disclaimer and, whilst this did not mean that the EPO's website was excluded per se as a source of information which may lead to the application of the principle of the protection of legitimate expectations (J 10/20), such information must not be taken at face value. The Legal Board referred to the general legal principle that a person cannot successfully invoke ignorance of the law. The information on the EPO's website contained an explicit reference to the relevant legal norms of the EPC. A person reading these provisions, acting in a reasonable manner, would have immediately realised that the information on the website was erroneous since the wording of paragraphs 2 and 7 of Art. 134 EPC was unambiguous and left no room for any doubt: exemption from the requirements of Art. 134(2) EPC was expressly provided (see Art. 134(7)(a) EPC) only for the requirement set out in Art. 134(2)(a), but not for the one in Art. 134(2)(c) EPC. The Legal Board concluded that the appellant had failed to establish that, on an objective basis, it was reasonable for him or any other person acting in a reasonable manner to have been misled by the information on the EPO's website. Thus, he had not demonstrated that the expectation on which he relied was legitimate. Moreover, the appellant had failed to demonstrate that he suffered any disadvantage. Rather, he had sought to create, by way of the principle of protection of legitimate expectations, non-existing rights under the EPC to be exempted from the requirement to pass the EQE and to have VP5 evaluate whether he was entitled to the exemption. Since there were no such rights in the first place, they could not be lost.

The appellant had cited J 10/20 and G 5/93 in support of his case, arguing that the EPO was bound by "its announcements" and by "its own published interpretation" respectively. The Legal Board distinguished the situation in the case in hand from that in those cases. Unlike in J 10/20, in the case in hand the appellant could not rely on the expectation invoked. Therefore, there was "good reason" – in the words of J 10/20 – not to honour the incorrect statement on the EPO's website. The situation in G 5/93 concerned a change in the case law of the Boards of Appeal and a subsequent change of practice of the EPO. Moreover, in contrast to the information referred to in G 5/93, in the case in hand the information on the EPO's website could not be said to constitute an "interpretation" of Art. 134(2) or (7) EPC.

The appeal was dismissed.

010-01-24

## 11. Article 13(2) RPBA 2020 | T 2352/19 | Board 3.2.06

### Article 13(2) RPBA 2020

<b>Case Number</b>	T 2352/19
<b>Board</b>	3.2.06
<b>Date of decision</b>	2023.07.11
<b>Language of the proceedings</b>	EN
<b>Internal distribution code</b>	C
<b>Inter partes/ex parte</b>	Inter partes
<b>EPC Articles</b>	Article 113 EPC
<b>EPC Rules</b>	
<b>RPBA</b>	Article 13(2) RPBA 2020
<b>Other legal provisions</b>	
<b>Keywords</b>	amendment after summons – exceptional circumstances (no) – taken into account (no) – reaction to new interpretation of claim feature by the board – no causal link between newly raised aspect and final conclusion of the board
<b>Cited decisions</b>	
<b>Case Law Book</b>	<a href="#">V.A.4.5.6</a> , 10th edition

In [T 2352/19](#) the respondent (patent proprietor) had filed auxiliary request 2 only after the board's summons to oral proceedings, in reaction to the board's communication under Art. 15(1) RPBA 2020. In this communication the board had indicated its preliminary opinion that the subject-matter of the requests then on file was not novel over O2 and had pointed in this context to two aspects concerning feature 8 of claim 1. The respondent argued that the board's preliminary opinion contained a new interpretation of the feature "operating member" in feature 8 that led to a new objection regarding lack of novelty. Auxiliary request 2, based on previous claim 1 but with an amended feature 8, was thus an attempt to overcome this new objection at the earliest possible stage and should therefore be taken into account.

The board did not find this argument convincing. While it acknowledged that raising an objection for the first time in a board's communication may result in acknowledging exceptional circumstances, it also clarified that the mere fact that the board had raised a new aspect in the preliminary opinion was not sufficient by itself to acknowledge exceptional circumstances if this aspect was ultimately not relevant for the board's conclusion.

The board had stated in its preliminary opinion that it might require discussion whether a certain feature mentioned in O2 (levers 43 and 44) corresponded to an



"operating member" as defined in feature 8 of claim 1 and that this did not seem to be excluded from the wording of claim 1. It was correct that this specific feature's interpretation had not been discussed before. However, in its communication, the board had also considered the appellant's objection made in its statement of grounds of appeal, namely that an alternative embodiment of O2 also appeared to disclose feature 8 such that all the features of claim 1 appeared to be disclosed in O2. Indeed, the board's final conclusion in the oral proceedings as regards the objection of novelty in the light of O2 was solely based on the appellant's objection which had already been assessed in the impugned decision and which was part of the appellant's appeal case from the beginning. Thus, the other aspect, the new possible interpretation of "operating member" in claim 1 as presented by the board in its preliminary opinion never became decisive for the board's final conclusion and decision.

According to the board, the term "exceptional circumstances" needed to be interpreted in the light of and in application of the principles underlying the EPC and the rules of procedure. It stated that Art. 13(2) RPBA 2020 provided a fair balance between the need for procedural economy on the one hand, and the right to be heard, guaranteed by Art. 113 EPC, on the other, in order to ensure fair proceedings. Exceptional circumstances could justify the admittance of a new request if a causal link existed between the new aspect raised by the board and the board's final conclusion. The right to be heard required the possibility of providing a defence against it. If the board's conclusion was not based on the newly raised aspect, the parties' right to be heard was thus not affected and there would be no reason for exceptions to be applied. The mere fact that the filing of the respondent's request was triggered by the board's preliminary opinion did not necessarily result in this request being taken into account.

The respondent contested the necessity for this causal link and argued that, if this were the case, the question as to whether the request would be admitted would depend on the order chosen by the board for the assessment of the objections and aspects during the oral proceedings. The board disagreed. It noted that the order of assessment lay within the discretion of the board. If the board chose an assessment that was based on those aspects that had been on file since the beginning of the proceedings and thus served to preserve the parties' interests and procedural economy, the parties did not suffer any disadvantage. Moreover, the decision as to whether a request was to be admitted was advantageously only taken at the stage when the request became relevant and not in advance. Assessing admittance at this stage ensured that the entire preceding circumstances were considered when balancing e.g. the conflicting interests of procedural economy and the right to be heard.

The board therefore exercised its discretion and did not take auxiliary request 2 into account (Art. 13(2) RPBA 2020). In the absence of any set of claims complying with the requirements of the EPC, the patent had to be revoked.

011-01-24

## 12. Article 13(2) RPBA 2020 | T 0916/21 | Board 3.5.05

### Article 13(2) RPBA 2020

<b>Case Number</b>	T 0916/21
<b>Board</b>	3.5.05
<b>Date of decision</b>	2023.08.11
<b>Language of the proceedings</b>	DE
<b>Internal distribution code</b>	D
<b>Inter partes/ex parte</b>	Ex parte
<b>EPC Articles</b>	
<b>EPC Rules</b>	
<b>RPBA</b>	Article 13(2) RPBA 2020
<b>Other legal provisions</b>	
<b>Keywords</b>	amendment after summons – request – taken into account (yes) – exceptional circumstances (yes) – reaction to Art. 15(1) RPBA 2020 communication – amendment serving procedural economy
<b>Cited decisions</b>	T 1055/17
<b>Case Law Book</b>	<a href="#">V.A.4.5.5a</a> ), <a href="#">V.A.4.5.5f</a> ), 10th edition

In [T 916/21](#) stellten die Änderungen in Hilfsantrag 3 eine Reaktion auf eine Kurzmitteilung der Kammer sowie eine in der vorläufigen Auffassung der Kammer enthaltene Erläuterung zur Interpretation des Anspruchswortlautes dar.

Diese Erläuterung war bereits in der angefochtenen Entscheidung als Teil der Argumentationslinie zu Hilfsantrag 3 enthalten. Jedoch hielt die Kammer diese Argumentationslinie in zentralen Punkten nicht für überzeugend. Nach ihrer Ansicht konnte es von der Beschwerdeführerin im vorliegenden Fall, in dem die Änderungen alle Einwände der Beschwerdekammer ausräumten, nicht erwartet werden, auf einen einzelnen Aspekt einer insgesamt nicht überzeugenden Argumentationslinie in der angefochtenen Entscheidung mit auf diesen Aspekt gerichteten Änderungen bereits bei Einlegen der Beschwerde zu reagieren. Mithin seien die im Hilfsantrag 3 enthaltenen Änderungen als eine Reaktion auf die in ihrer vorläufigen Meinung erstmals geäußerte Argumentationslinie zu betrachten.

Die Kammer hob ferner hervor, dass die Änderungen im Ergebnis zu einem Antrag führten, der klar den Erfordernissen des EPÜ genüge, so dass sie ohne mündliche Verhandlung entscheiden könne. Die Zulassung des Hilfsantrags 3 diene daher der Verfahrensökonomie. Die Kammer sah dies insgesamt als außergewöhnliche Umstände im Sinne von Art. 13 (2) VOBK 2020 an, die eine Zulassung dieses

Antrags in das Verfahren rechtfertigen (zur Zulassung eines alle Einwände beseitigenden Antrags siehe T 1055/17).

012-01-24



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