Europäisches Patentamt
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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 01 I 2025

Boards of Appeal

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Case Law of the Boards of Appeal, 10th edition (update 2024) – references in issue 7/2024 and following
In the table summarising the decision data for an abstract, the links to the CLB, 10th edition, lead to the HTML version, which was updated in June 2024. In the body of any given abstract, references to the CLB mirror those provided by the board in the underlying decision.

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Abstracts of decisions

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1. Article 053 EPC | T 1553/22 | Board 3.3.04

Article 053 EPC

Case Number	**T 1553/22**
Board	3.3.04
Date of decision	2024.09.04
Language of the proceedings	EN
Internal distribution code	D
Inter partes/ex parte	Ex parte
EPC Articles	Article 053(a) EPC
EPC Rules	Rules 026, 028 EPC
RPBA	
Other legal provisions	Article 31 Vienna Convention on the Law of Treaties Recital 38 of Directive 98/44/EC
Keywords	exceptions to patentability – contrary to morality – human-animal chimera
Cited decisions	G 0002/06, T 0356/93, T 0866/01, T 0315/03, T 1213/05
Case Law Book	I.B.2.2.2b), III.H.1.1.3, 10th edition

In T 1553/22, the application concerned the generation of pig-human chimeric animals with the aim of using them as a source of human vasculature and blood. The appellant's arguments could be summarised as follows:

The examining division's approach to chimeras was unduly restrictive and was not in line with the requirements of Art. 53(a) EPC or R. 26(1) EPC, which provided that Directive 98/44/EC of 6 July 1998 on the legal protection of biotechnological inventions be used as supplementary means of interpretation for patent applications concerning biotechnological inventions. While Recital 38 of the Directive 98/44/EC referred to the exclusion of chimeras involving human totipotent cells or germ cells from patentability, the claims in suit were directed to blastocysts and methods which involved pluripotent cells. Moreover, the purpose of the invention was to provide humanised vasculature in swine, suitable for transplantation, rather than providing chimeric animals in which human cells would be found in multiple organs. Art. 53(a) EPC was to be construed narrowly. It was the intended exploitation of the invention that was to be taken into account when analysing compliance with the requirements of Art. 53(a) EPC (see T 356/93, T 866/01 and T 315/03).

The examining division had refused the application for ethical reasons pursuant to Art. 53(a) in conjunction with R. 26(1) EPC and Recital 38 of the Directive 98/44/EC. It had also concluded that, although the invention was directed to the genetic modification of animals, the exclusion under R. 28(1)(d) EPC was not applicable because the outcome of the so-called "balancing test" developed in the jurisprudence for an objection under this provision was in favour of the invention.

The board held that if an invention corresponds to one of the examples set out in the non-exhaustive list of R. 28(1) EPC, there is no room for tests aimed at balancing possible risks associated with the implementation of the invention and its benefit for mankind. Without disregarding the principle of narrow interpretation of exceptions, the board took the view that the exclusion of Art. 53(a) in conjunction with R. 28(1) EPC may extend to other chimeras, where the rationale underlying the examples identified in Recital 38 is also applicable to the chimeras concerned. Thus, by means of R. 26(1) EPC a further special case is added to the non-exhaustive list of R. 28(1) EPC.

When considering the possible rationale underlying the specific exclusions of Recital 38, the board found that the reason why the chimeras identified in Recital 38 are regarded as offensive against human dignity is due to concerns that, in chimeras including human germ cells or totipotent cells, these human cells may integrate into the brain and/or develop into germ cells and result in a chimera with human or human-like capabilities.

This reason is straightforward for chimeras including totipotent cells, which in view of their developmental capability to form an entire organism may form a brain with human-like cognitive abilities or human germ cells. However the same reason applies to the application at hand, which concerned pluripotent cells, which despite lacking the ability to differentiate into totipotent cells or cells of the placenta, nevertheless have the ability to differentiate into neural cells or germ cells. Thus, if an invention relates to a situation where human cells might integrate into the chimera's brain, potentially giving the chimera human-like cognitive or behavioural capabilities, or into its germ line, potentially giving it the ability to pass on humanised traits, the board considers that the underlying rationale of Recital 38 of the Directive would be relevant and shall be taken into account in examining compliance with Art. 53(a) in conjunction with R. 28(1) EPC.

The board stated in its catchword that human-animal chimeras and processes to produce them are excluded from patentability in accordance with Art. 53(a) EPC if the invention offends against human dignity. This is the case for instance if it is not excluded that the human cells involved in the chimera integrate into the brain and/or develop into germ cells of the chimera, and result in a chimera with human or human-like capabilities.

001-01-25

2. Article 054 EPC | T 2510/18 | Board 3.3.02

Article 054 EPC

Case Number	**T 2510/18**
Board	3.3.02
Date of decision	2024.05.31
Language of the proceedings	FR
Internal distribution code	C
Inter partes/ex parte	Inter partes
EPC Articles	Article 054 EPC
EPC Rules	Rule 027(a) EPC
RPBA	
Other legal provisions	
Keywords	novelty (yes) – isolating a naturally occurring substance – exception to patentability (no) – implicit disclosure (no) – structure or composition disclosed (no) – undue burden
Cited decisions	G 0002/88, G 0001/92, T 0438/19
Case Law Book	I.A.6.3.1, I.C.3.2.4d), I.C.4.3, 10th edition

See also abstract under Article 53 EPC (2024 AoD Compilation, page 13).

Dans l'affaire T 2510/18 la chambre a considéré comme nouvelles par rapport aux documents D2, D3 et D5 les revendications 1 à 6 du brevet en cause qui a pour objet une molécule, la Simalikalactone E (ci-après la SkE), qui peut être extraite de la plante Quassia amara, ainsi que son utilisation comme médicament dans la prévention et le traitement du paludisme.

D2 est un article qui décrit une étude sur les remèdes antipaludiques utilisés en Guyane française. Il ressort de l'étude que l'espèce la plus utilisée est Quassia amara seule ou en combinaison avec d'autres espèces végétales. D2 décrit que cette plante est utilisée sous forme de décoctions administrée par voie orale ou est appliquée sur le corps du patient.

D3 est un article qui concerne l'évaluation de l'activité antipaludique de 23 espèces différentes de plantes utilisées en Guyane française dont la Quassia amara. D3 décrit que la décoction préparée avec les feuilles fraîches de Quassia amara n'est pas toxique à 1000 mg/jour et peut être administrée sans problème pendant plusieurs jours, quel que soit le principe actif. La décoction de feuilles de Quassia amara est donc présentée comme un remède antipaludique intéressant.

D5 est un article qui concerne l'effet de l'âge des feuilles de Quassia amara et l'état de dessication sur l'activité antipaludique d'infusions traditionnelles préparées à partir des feuilles à différents états de maturité et de fraîcheur. Dans une étude antérieure, la molécule Simalikalactone D "SkD" avait été identifiée comme le composé actif. Quatre infusions avaient été préparées avec des feuilles. Les concentrations de la SkD dans chaque préparation et leur activité antipaludique y sont comparées. Il est également indiqué dans D5 que l'infusion de jeunes feuilles séchées possède une activité in vivo très puissante qui ne semble pas provenir uniquement de la molécule SkD. Selon la chambre, aucun de ces documents D2, D3 et D5 ne décrivait explicitement la molécule active SkE. Ces documents divulguent plutôt des remèdes traditionnels antipaludiques, c.-à-d. des préparations dérivées des feuilles ou des tiges d'une plante particulière, Quassia amara.

La chambre a interprété la revendication 1 comme couvrant toutes les compositions contenant la molécule SkE y compris les extraits de D2, D3 et D5, dans la mesure où ils contiennent la molécule SkE. Cependant, la question de savoir si les extraits de D2, D3 ou D5 entrent dans la portée de la revendication 1 n'était pas le critère correct pour évaluer si l'objet de cette revendication est nouveau. Pour évaluer si l'objet d'une revendication a été rendu accessible au public et donc manque de nouveauté, la "norme de référence" est le seul critère à appliquer.

Le fait que la molécule SkE puisse être contenue dans les extraits de D2, D3 et D5 n'équivalait pas non plus à une divulgation implicite. Selon G 2/88 (points 10 et 10.1 des motifs), la question qui se pose est de savoir ce qui a été rendu accessible au public, et non pas ce qui pouvait y être contenu intrinsèquement. Il n'y avait pas non plus de divulgation implicite de l'objet de la revendication 1 au regard de G 1/92: il aurait été nécessaire que la personne du métier identifie la SkE dans les extraits de D2, D3 ou D5. Étant donné que l'identification de la SkE aurait représenté un effort excessif et donc impliqué une activité inventive, la chambre a décidé que SkE ne faisait pas partie de l'état de la technique accessible au public.

La chambre a également relevé que la question en l'espèce était différente de celle dans la saisine T 438/19. Il ne pouvait ici y avoir de divulgation implicite de la SkE dans lesdits extraits, à tout le moins parce que leur identification aurait impliqué un effort excessif pour la personne du métier.

La chambre n'a pas non plus été convaincue par l'argument des requérants qui avaient fait valoir que l'objet d'une revendication ne pouvait pas être considéré comme nouveau s'il était contrefait par une utilisation existante, par exemple, par les extraits de D2, D3 ou D5. En d'autres termes, la protection conférée par le brevet donnerait à l'intimé le droit d'interdire aux populations autochtones d'utiliser les feuilles de Quassia amara pour la préparation de leurs remèdes traditionnels. Par analogie avec G 2/88, la chambre a expliqué qu'en vertu de l'art. 54(2) CBE, la question était de savoir ce qui a été "rendu accessible" au public, et non pas ce qui pouvait être "contenu intrinsèquement" dans ce qui a été rendu accessible. En conséquence, la question du "contenu intrinsèque" ne se posait pas en tant que telle dans le cadre de l'art. 54 CBE.

002-01-25

3. Article 056 EPC | T 1602/21 | Board 3.3.10

Article 056 EPC

Case Number	**T 1602/21**
Board	3.3.10
Date of decision	2024.07.25
Language of the proceedings	EN
Internal distribution code	D
Inter partes/ex parte	Inter partes
EPC Articles	Articles 056, 123(2) EPC
EPC Rules	
RPBA	
Other legal provisions	
Keywords	inventive step (yes) – post-published evidence taken into account (yes) – technical effect derivable from application as originally filed (yes) – condition in G 2/21, headnote II, not same as "gold standard" required normally for Article 123(2) EPC
Cited decisions	G 0002/21
Case Law Book	I.D.4.1.2b), 10th edition

In T 1602/21 the opposition division had decided that the provision of a method according to claim 1 of the patent as maintained involved an inventive step. One of the differing features to closest prior art D1 was seen in the nature of adsorbent, i.e. an OH-type basic ion-exchange resin (alternative "a" in the impugned decision) or an adsorbent selected from zeolite, silica-alumina, and alumina (alternative "b" in the impugned decision), or mixtures thereof.

In the case of alternative "a", a surprising technical effect based on the disclosure of documents D30 and D32 was acknowledged – D32 being experimental data provided by the respondent during the opposition proceedings. The appellant argued, by reference to G 2/21, that D32 should not be considered for the purposes of inventive step, since it was published after the filing date of the contested patent, and since the technical effect allegedly shown therein was not mentioned in the patent. The technical effect could thus not be relied upon, and the technical problem could only be seen in the provision of an alternative, which had been solved in an obvious manner.

The board was not convinced by the appellant's above argument. The application as filed disclosed that the use of an OH-type strongly basic ion-exchange resin led to

improved removal of sugar or sugar alcohol. Document D32 disclosed experimental data showing a link between the use of an OH-type strongly basic ion-exchange resin and the effect of improved removal of sugar or sugar alcohol. The board thus concluded that the effect was derivable from the application as filed, and as such the respondent could rely upon it for inventive step, even if D32 had been filed after the filing date of the contested patent (see G 2/21, headnote II).

The board further observed that the condition stated by G 2/21 that "the skilled person ... based on the application as originally filed, would derive said effect as being encompassed by the technical teaching" (board's emphasis) was not equivalent to the "gold standard" disclosure required normally for Art. 123(2) EPC. It was sufficient that the skilled person was satisfied that the advantageous technical effect was indeed achieved by the claimed solution, on the basis of the teaching of the application, and once the technical effect had been brought to its attention, possibly from another source as the application. It was not required that the technical effect relied on was also disclosed so explicitly and clearly that the skilled person would recognise it only on the basis of the application and without knowing the later evidence.

003-01-25

4. Article 084 EPC | T 0939/22 | Board 3.3.04

Article 084 EPC

Case Number	**T 0939/22**
Board	3.3.04
Date of decision	2024.04.09
Language of the proceedings	EN
Internal distribution code	D
Inter partes/ex parte	Inter partes
EPC Articles	Articles 054, 084 EPC
EPC Rules	
RPBA	
Other legal provisions	
Keywords	claims – claim interpretation – novelty – reproducibility
Cited decisions	
Case Law Book	II.A.6.3.1, II.A.6.3.4, II.A.6.2, I.C.4.11, 10th edition

In T 939/22 claim 1 of the main request was directed to "[a] vaccine comprising a recombinant nonpathogenic Marek's Disease Virus (rMDVnp) comprising a first nucleic acid (…) and wherein the rMDVnp is a recombinant herpesvirus of turkeys (rHVT)." The construction of rMDVnp was relevant for assessing novelty over D8.

The definition of rMDVnp in the description (page 7, lines 19 to 20 of the patent in suit) stated that the term rMDVnp referred to a rMDVnp that included heterologous nucleotide sequences (i.e. sequences from pathogens other than MDV). In other words, the definition in the description equated the term rMDVnp to a specific recombinant vector with inserts of nucleotide sequences encoding proteins from other pathogens. According to the board, this definition could not change the common understanding of the terms of art rMDVnp and rHVT as used in claim 1 nor was this definition consistent with how a skilled person would understand the claim. Indeed, the skilled person would understand the terms rMDVnp and rHVT as used in claim 1 to refer to the genome of a viral vector stemming from a non-pathogenic strain of an MDV serotype. No further limitations were implied by the terms rMDVnp and rHVT. The skilled person would not understand the term rHVT to exclude viral vectors in which a specific region of the genome of HVT (which is MDV serotype 3, i.e. MDV3) has been replaced by the corresponding region of a different MDV serotype, as is the case for novel avian herpesvirus (NAHV). Of course, claim 1 further required that nucleotide sequences of at least two specified pathogens other than MDV, i.e. Newcastle disease virus (NDV) and infectious laryngotracheitis virus (ILTV), be inserted into the rMDVnp/rHVT vector. Hence, the claim was directed to a

construct formed by the rMDVnp/rHVT vector and inserts of nucleotide sequences from other pathogens.

The board held that the exclusion of viral constructs comprising nucleotide sequences from different MDV serotypes from the term MDVnp (page 7, lines 14 to 17 of the patent in suit) was in line with how the skilled person would understand the term MDVnp, as it did not include recombinant viral constructs but referred only to the naturally occurring viruses. Claim 1, however, was specifically directed to a vaccine comprising a recombinant non-pathogenic MDV (rMDVnp), specifically rHVT. Even if the definition of MDVnp in the description were intended to include rMDVnp in a way that excluded chimeric viruses, this could not change the skilled person's understanding of the terms rMDVnp and rHVT.

In the board’s view, excluding chimeric viruses from the claimed subject-matter appeared contradictory for the following reasons. The term chimeric virus, as understood by the skilled person, related to a specific type of recombinant virus that contains genetic material from different viruses within a single viral genome construct. This typically implied that the resulting viral construct exhibits characteristics derived from each of the parental viruses. Accordingly, inserting nucleotide sequences of NDV and ILTV into the rHVT vector as claimed resulted in a chimeric virus. Therefore, chimeric viruses could not be excluded from the subject-matter of claim 1, let alone a (recombinant) NAHV that included nucleotide sequences from NDV and ILTV.

The board also noted that, due to the comprising language, claim 1 did not exclude that the rMDVnp could be engineered to comprise additional nucleic acid inserts encoding antigens of pathogens other than NDV and ILTV.

It was clear from the wording and structure of claims 3, 4, 9 and 11 that the inventors of D8 had envisaged both (i) a multivalent vaccine that was a mixture of different NAHV constructs, each encoding a separate foreign gene (claim 19), and (ii) a multivalent vaccine based on a single NAHV construct encoding a plurality of foreign genes (claim 11, to which vaccine claim 18 refers). A multivalent vaccine encoding more than one heterologous antigen was furthermore addressed in several passages of the description. D8 provided detailed instructions on how to prepare the recombinant chimeric virus and clear protocols on how to test them for their suitability as vaccines. Thus, sufficient information was provided to enable the skilled person to produce and test a composition suitable as a multivalent vaccine as defined in claim 18 of D8.

In addition, it was credible that a recombinant MDV comprising more than one insert from two different heterologous viruses in the non-essential US2 site, encoding thus one additional foreign antigen to those tested in Examples 1 to 3 of D8, could be prepared and would provide protection by preventing or reducing the severity of a disease caused by at least one of the viruses whose antigens were encoded by the recombinant MDV construct.

004-01-25

5. Article 084 EPC | T 1886/22 | Board 3.2.02

Article 084 EPC

Case Number	**T 1886/22**
Board	3.2.02
Date of decision	2024.11.05
Language of the proceedings	EN
Internal distribution code	D
Inter partes/ex parte	Inter partes
EPC Articles	Articles 084, 123(2) EPC
EPC Rules	
RPBA	
Other legal provisions	
Keywords	claims – claim interpretation – claim construction to assess added subject-matter
Cited decisions	T 1791/16, T 0367/20, T 0177/22
Case Law Book	II.A.6.1, II.E.1.3.9d), II.E.1.3.9e), 10th edition

In T 1886/22 the interpretation of feature F in claim 1 of auxiliary request 5, in particular the term "extends through", was relevant to assess compliance with Art. 123(2) EPC.

The board did not agree with the approach taken in T 1791/16 that all technically reasonable interpretations of an ambiguous claim must be considered in assessing whether the claim contains added subject-matter, and that it is sufficient that one of these interpretations leads to added subject-matter in order to conclude that the claim is not allowable. Rather, the board was of the view that it must first be determined how the person skilled in the art would interpret the relevant feature before it can be assessed whether this feature is disclosed in the application as filed and, accordingly, whether it adds subject-matter (see T 367/20).

The board stated that the terms in a given patent claim must be interpreted in a uniform, consistent and objective manner (see T 177/22), including for the purposes of assessing e.g. added subject-matter and novelty. In the case at issue only the narrower of the two possible – and both technically reasonable – claim interpretations could lead to added subject-matter. Hence, the approach suggested in T 1791/16 would also require a deviation from the established practice to interpret a claim in doubt rather more broadly than more narrowly.

The respondent (opponent) had argued that the word "through" in its ordinary and broadest interpretation meant "from one end to the other", so that feature F must be

interpreted as requiring the proximal portion of each of the arms to extend through the entire bushing (interpretation (a)). However, as submitted by the appellant (patent proprietor), the word "through" can also mean "along within", as supported, inter alia, by the dictionary definition A.2 given in D15 (interpretation (b)). Interpreted with this different meaning, feature F required the proximal portion of each of the arms to extend "along within" the bushing, i.e. along a certain distance within the bushing. The board agreed with the appellant that both interpretations (a) and (b) were linguistically and technically sensible and that interpretation (b) was broader than and encompassed interpretation (a).

The board held that on the basis of the wording of feature F alone, and in the absence of any context, it could not be concluded which one of the two aforementioned interpretations took precedence over the other. One could only arrive at such a conclusion when interpreting feature F in the technical context of claim 1. The person skilled in the art reading claim 1 as a whole would understand that for the catheter tip portion to be coupled to the distal end of the catheter shaft it was sufficient that the proximal portion of each of the arms extended partially through the proximal bushing, in other words, that it extended into the bushing. It was irrelevant whether the proximal portion extended further into the bushing, in particular whether it extended through the entire bushing and thus terminated proximal thereto, or whether instead the proximal portion terminated somewhere within the bushing. The skilled person would therefore interpret feature F broadly according to interpretation (b), which left open where the proximal portion of the arms terminates, and would not interpret feature F narrowly according to interpretation (a). In fact, to do so would be tantamount to reading an unjustified limitation into the claim.

In the boards' view, interpreting feature F according to interpretation (b) was not inconsistent with the patent specification, which did not support one interpretation over the other.

The board referred to paragraph [0097] of the application as filed which disclosed explicitly that the longitudinally-extending arms "exit from the distal end of the proximal bushing". According to the board and contrary to the respondent's view, this implied necessarily that the arms extend at least partially through the bushing, i.e. along within it, otherwise they could not "exit" from the bushing. This view was also consistent with the figures of the application as filed which showed an embodiment of a catheter as claimed, such as Figure 33, where the arms were shown as being gripped within a notch formed within the bushing at its distal end. The board therefore concluded that feature F (according to interpretation (b)) did not constitute subject-matter extending beyond the content of the application as filed.

See also T 1345/23, which relates to a patent originating from a divisional application and addresses the same issues in the context of compliance with Art. 76(1) EPC. It was issued by the same board on the same date as T 1886/22 (joint hearing).

005-01-25

6. Article 084 EPC | T 2103/22 | Board 3.3.03

Article 084 EPC

Case Number	**T 2103/22**
Board	3.3.03
Date of decision	2024.09.25
Language of the proceedings	EN
Internal distribution code	D
Inter partes/ex parte	Inter partes
EPC Articles	Articles 084, 123(2) EPC
EPC Rules	
RPBA	
Other legal provisions	
Keywords	claims – claim interpretation – comprising, consisting of – no limiting features – added subject-matter (no)
Cited decisions	
Case Law Book	II.A.6.2, II.E.1.1, II.E.1.3.9b), 10th edition

In T 2103/22 the board, in order to assess compliance with the requirements of Art. 123(2) EPC, had to first determine the subject-matter effectively defined by claim 1 of the main request. In particular, the board interpreted the meaning of the following terms as well as the meaning of their combination:

a) "said polyester resin is a blended polyester resin which is a blend of a lowly crystalline polyester resin and a highly crystalline polyester resin at a weight ratio of 90:10 to 10:90 (…)"

b) "a layer of a polyester resin which comprises an ethylene terephthalate unit formed on at least one surface of the metal sheet".

The respondent (opponent) adhered to the conclusion of the opposition division which had been reached considering that "is" in term a) was to be read as "comprises", which meant that any other component different from the ones specifically mentioned in said claim 1 could be present in the blended polyester resin. The board disagreed and stated that, although it was correct that the normal rule of claim construction was that the terms used in a claim should be given their broadest technically sensible meaning, the literal reading of this passage defined that "said polyester resin" consisted of the lowly crystalline and highly crystalline polyester resins further defined in claim 1 of the main request, in the given weight ratio. In that regard, the board noted that, according to established case law (Case Law of the

Boards of Appeal, 10th ed. 2022, II.A.6.2), the term "consists of" meant that the definition of "said polyester resin" was given in a "closed" manner, i.e. it excluded the presence of any other components other than the ones specifically defined (in the case at issue the lowly and highly crystalline polyester resins).

On b), the board found that the term "a layer of a polyester resin" defined, according to its literal reading, that the polyester therein mentioned, i.e. "which comprises an ethylene terephthalate unit", was the main component of the layer. However, this wording neither imposed that the polyester resin was the sole component of the layer, nor that it was the sole resin possibly present in the layer. The board further held that the reference to "unit" in that passage made it clear that the term "which" made reference to the polyester resin and not to the layer. This, in the board's view, would also be the logical reading of the claim made by the skilled person, considering that the term "which" usually makes reference to the word directly preceding it.

As the subject-matter of claim 1 of the main request was defined by the combination of terms a) and b), the board also determined the meaning of the combination of these two terms. It held that the polyester resin specified in the term "a layer of a polyester resin" was identical to the "said polyester resin" further defined in claim 1, i.e. it consisted of a blend of only the lowly and highly crystalline polyester resins.

Taking into account the further definitions of the lowly and highly crystalline polyester resins in claim 1, the board concluded that both of them were "a polyester resin that comprises an ethylene terephthalate unit". Therefore, the term "which comprises an ethylene terephthalate unit" of claim 1 of the main request was in fact redundant (i.e. not further limiting). Contrary to the view of the opposition division, the definitions of the highly and the lowly crystalline polyester resins further imposed that said terephthalate unit had to be present in majority since, otherwise, the resin would not be a “polyethylene terephthalate" anymore.

To determine whether the requirements of Art. 123(2) EPC were met, the board assessed if the deletion of the term "chiefly" from claim 1 of the application as filed resulted in added-matter. It saw no reason to deviate from the literal sense of the term "chiefly", which was that the polyester resin of the layer so defined should principally comprise an ethylene terephthalate unit not as the sole component but as the most important component of the polyester.

According to the board, adopting for the relevant passages of the application as filed the same reading as the one outlined for the corresponding passages of claim 1 of the main request, the term "which chiefly comprises an ethylene terephthalate unit" could only be held to be redundant (i.e. not further limiting) in view of the other features defining the valid support in the application as filed for the claimed subject-matter. Therefore, the presence or not in claim 1 of the main request of the terms "which chiefly comprises an ethylene terephthalate unit" or "chiefly" contained therein, did not lead to added-matter pursuant to Art. 123(2) EPC.

006-01-25

7. Article 110 EPC | T 0957/22 | Board 3.3.06

Article 110 EPC

Case Number	**T 0957/22**
Board	3.3.06
Date of decision	2024.07.16
Language of the proceedings	EN
Internal distribution code	D
Inter partes/ex parte	Inter partes
EPC Articles	Article 110 EPC
EPC Rules	
RPBA	
Other legal provisions	
Keywords	appeal examination – prohibition of reformatio in peius – exception – withdrawal of patent proprietor's appeal
Cited decisions	G 0001/99
Case Law Book	V.A.3.1.7b), 10th edition

In T 957/22 after having withdrawn its own appeal, the proprietor in its respondent's role was therefore limited to defending the patent in the form held allowable by the opposition division, or in a more restricted form.

The numbering of auxiliary requests 2-13 (lower ranking compared to the request to dismiss the opponent's appeal, i.e. to maintain the patent based on auxiliary request 1) suggested that they were part of the proprietor's defence against the opponent's appeal. However, claim 1 of each of these requests was not based on the restricted wording of auxiliary request 1 (which included "consisting of") held allowable by the opposition division, but on a broader wording of the main request (with "containing"), that the division had rejected.

While the formulation "consists of" was not clear in the context of claim 1 of auxiliary request 1, the board noted that substituting this term with "containing" nevertheless broadened the claimed subject-matter, compared to the first auxiliary request found allowable by the opposition division. While the term "consists of" limited the subject-matter of claim 1 of auxiliary request 1 to the components defined in the claim by excluding the presence of any further components, the substitution of this term with "containing" factually deleted this limiting feature, so that granting any one of these requests would put the opponent/appellant in a worse situation than if it had not appealed. This would not be in conformity with the prohibition of reformatio in peius.

In decision G 1/99 (OJ 2001, 382, Headnote), the Enlarged Board formulated an exception to the prohibition of reformatio in peius, namely "in order to meet an objection put forward by the opponent/appellant or the Board during the appeal proceedings, in circumstances where the patent as maintained in amended form would otherwise have to be revoked as a direct consequence of an inadmissible amendment held allowable by the opposition division in its interlocutory decision".

The board however agreed with the opponent that this exception did not apply in the case at hand, because the proprietor had deliberately withdrawn its appeal, and thus waived the possibility of defending its patent in a broader version than that upheld by the opposition division, although it was aware that the board had endorsed in its preliminary opinion the objection under Art. 123(2) EPC against the first auxiliary request. In this situation, there was no justification to grant the proprietor back this possibility for reasons of equity, i.e. to establish an exception from the prohibition of reformatio in peius. A party who waives an existing right in full knowledge of the legal situation could not expect to be granted back this right for reasons of equity.

Moreover, even if the principles as set out in decision G 1/99 were to be applied to the case at hand, i.e. if the proprietor could benefit from an exception to the principle of reformatio in peius, according to the decision of the Enlarged Board such an exception can only be made if the objection cannot be overcome by two other forms of amendments set out in the Headnote of decision G 1/99. However, the proprietor had not argued, nor was it discernible for the board, that claim amendments of these types were not possible.

007-01-25

8. Article 122 EPC | T 0178/23 | Board 3.4.03

Article 122 EPC

Case Number	**T 0178/23**
Board	3.4.03
Date of decision	2024.10.11
Language of the proceedings	EN
Internal distribution code	D
Inter partes/ex parte	Ex parte
EPC Articles	Articles 108, 122 EPC
EPC Rules	Rule 136 EPC
RPBA	
Other legal provisions	
Keywords	re-establishment of rights (no) – request admissible (no) – request not duly substantiated – inability to observe a time limit (no) – time limits under Article 108 EPC
Cited decisions	G 0001/18, J 0029/86, J 0026/95, J 0007/16, T 0315/87, T 2017/12, T 1823/16
Case Law Book	III.E.4.2, III.E.4.4, III.E.5.1, 10th edition

In T 178/23 the appellant requested re-establishment of rights under Art. 122 EPC in relation to the non-observance of the time limits under Art. 108 EPC for filing the notice of appeal and paying the appeal fee, and for filing the statement of grounds of appeal.

As regards the admissibility of the request for re-establishment of rights, the board observed that, since the appellant had missed two different time limits, it could be argued that each of the two time limits, which expired independently of one another, had to be considered separately, notwithstanding the fact that they were triggered by the same event (see J 26/95, T 2017/12). In this case, the appellant's request for re-establishment would be inadmissible because it paid only one re-establishment fee within the two-month time limit under R. 136(1) EPC. However, there was also case law in which one fee was considered sufficient because re-establishment in respect of both periods had to be examined together and the result would inevitably be the same (see T 315/87, J 7/16, T 1823/16). In the board’s view, the question of whether one or two re-establishment fees were required could be left undecided in the case in hand.

Regarding the substantiation of the request for re-establishment of rights, the board found that in the letter requesting re-establishment of rights, the appellant had not

presented any core facts to make it possible for the board to consider whether the appellant had taken all due care required by the circumstances in order to comply with the time limits under Art. 108 EPC. Rather, the appellant had merely stated that it had failed to observe the time limits despite exercising all due care, without setting out any concrete facts demonstrating that it had taken all the due care required by the circumstances. The mere statement that it "could not be reasonably expected" that the drawings would be missing in the examining division's communication under R. 71(3) EPC was not sufficient in this regard. It was only with the letter of reply to the board's communication that the appellant went into more detail for the first time on possible facts regarding whether the appellant had taken all due care required by the circumstances. According to the board, the appellant had not merely adduced further evidence clarifying the facts which had already been set out in due time, but had (belatedly) attempted to make a conclusive case. Therefore, the new submissions in the letter of reply were not to be taken into account. Consequently, the request for re-establishment of rights was found inadmissible for lack of substantiation.

The board then moved on to the issue of inability to observe a time limit vis-à-vis the EPO. It noted that according to established case law the word "unable" in Art. 122(1) EPC implied an objective fact or obstacle preventing the required action, e.g. a wrong date inadvertently being entered into a monitoring system.

In the case in hand, the board could not see any objective fact or obstacle that prevented the appellant from observing the time limits under Art. 108 EPC. The facts relied on by the appellant did not relate to an error in the carrying out of a party's actual intention to meet a specific time limit, but only to an error in relation to the intention to use a legal remedy entailing a time limit. The appellant was able to file an appeal in due time but failed to do so because of a previous error as to motive, i.e. because it was unaware of the need to file an appeal to rectify the absence of the drawings in the patent specification. According to the board, this situation differed from those governed by Art. 122 EPC where a party did intend to observe a time limit but failed to do so due to objective obstacles.

Consequently, the board found that the appellant's request for re-establishment of rights was also inadmissible on the ground that the appellant was not unable to observe the time limits under Art. 108 EPC. In view of the considerations above, whether the appellant had complied with the "all due care" criterion under Art. 122(1) EPC was irrelevant. The request for re-establishment of rights was thus refused as inadmissible and the appeal was deemed not to have been filed.

008-01-25

9. Article 125 EPC | T 2053/20 | Board 3.3.10

Article 125 EPC

Case Number	**T 2053/20**
Board	3.3.10
Date of decision	2024.07.31
Language of the proceedings	DE
Internal distribution code	D
Inter partes/ex parte	Inter partes
EPC Articles	Articles 108, 125 EPC
EPC Rules	
RPBA	
Other legal provisions	Arrangements for deposit accounts valid from 1 October 2019 (ADA 2019) and Annex A.1 to the ADA 2019, Supplementary publication 4, OJ 2019
Keywords	general principles – protection of legitimate expectations – courtesy service performed by the EPO – admissibility of the appeal (yes) – appeal fee (paid)
Cited decisions	
Case Law Book	III.A.3.2, III.A.4.2.2, 10th edition

In T 2053/20 war unstreitig, dass die Beschwerdeführerin (Einsprechende) in der Beschwerdeschrift vom 18. Dezember 2020 und dem entsprechenden Begleitschreiben ihre Absicht zum Ausdruck gebracht hatte, die Beschwerdegebühr zu bezahlen. Die dafür eingeschlagenen Wege, nämlich der automatische Abbuchungsauftrag einerseits und die nicht im korrekten elektronischen Format erteilte Einzugsermächtigung vom laufenden Konto andererseits, waren unter den Bestimmungen der ab dem 1. Oktober 2019 gültigen Vorschriften über das laufende Konto (VLK 2019) und deren Anhängen zur Zahlung der Beschwerdegebühr nicht zulässig. Das automatische Abbuchungsverfahren steht nur Anmeldern, Patentinhabern und ihren Vertretern offen, nicht aber Einsprechenden (s. Nummer 1.3 der Regeln über das automatische Abbuchungsverfahren). Siehe auch Nummer 5.1.2 VLK 2019 zu zulässigen Wegen der Einreichung eines Abbuchungsauftrags. Im Ergebnis erfolgte keine Abbuchung der Beschwerdegebühr innerhalb der in Art. 108 EPÜ vorgeschriebenen Frist von zwei Monaten. Allerdings unterblieb die entsprechende in den VLK eigentlich vorgesehene Mitteilung des EPA über die Nichtausführung der Zahlungsaufforderung (Nummer 5.1.3 VLK 2019).

Nach Ansicht der Kammer, hätte eine solche Mitteilung möglicherweise zur rechtzeitigen Zahlung der Beschwerdegebühr geführt, da die entsprechende Zweimonatsfrist erst am 7. Januar 2021 endete.

Die Kammer stellte fest, dass das EPA in früheren Fällen der Beschwerdeführerin eine Zahlung von Gebühren unter Berufung auf das automatische Abbuchungsverfahren auch in Situationen kommentarlos akzeptiert und die Beschwerdegebühr vom laufenden Konto der Beschwerdeführerin abgebucht hatte, in denen diese als Einsprechende auftrat, obwohl dies nicht den geltenden Regularien entsprach. Eine entsprechende Änderung der Praxis des EPA wurde der Beschwerdeführerin auch nicht zur Kenntnis gebracht.

Die Kammer gewährte daher der Einsprechenden Vertrauensschutz. In Ermangelung einer entsprechenden Mitteilung des EPA konnte die Beschwerdeführerin unter den gegebenen Umständen davon ausgehen, dass ihre am 18. Dezember 2020 getätigten Zahlungsanweisungen zur Abbuchung der Beschwerdegebühr akzeptiert und ausgeführt worden waren. Dass dem nicht so war, erfuhr sie erst durch den Bescheid der Kammer vom 21. September 2023. Die Zahlung der Beschwerdegebühr erfolgte daraufhin innerhalb der von der Kammer gesetzten Frist.

Die Kammer kam zu dem Schluss, dass die am 18. Januar 2024 vorgenommene Zahlung der Beschwerdegebühr mit Wirkung zum 18. Dezember 2020 erfolgt war. Daher wurde die Beschwerdegebühr in der von Art. 108 EPÜ vorgesehenen Zweimonatsfrist nach Zustellung der angefochtenen Entscheidung bezahlt.

Die Beschwerde wurde daher gemäß Art. 108 EPÜ form- und fristgerecht eingelegt.

009-01-25

10. Rule 080 EPC | T 0123/22 | Board 3.2.02

Rule 080 EPC

Case Number	**T 0123/22**
Board	3.2.02
Date of decision	2024.07.25
Language of the proceedings	DE
Internal distribution code	D
Inter partes/ex parte	Inter partes
EPC Articles	Article 100(a) EPC
EPC Rules	Rule 080 EPC
RPBA	
Other legal provisions	
Keywords	amendment occasioned by a ground for opposition (yes) – amendments allowable (yes)
Cited decisions	T 0295/87, T 0223/97, T 0181/02, T 0099/04, T 0263/05, T 0750/11, T 2290/12, T 0359/13, T 2063/15, T 2982/18, T 0453/19, T 0431/22
Case Law Book	IV.C.5.1.2, 10th edition

In T 123/22 wurde ein Einwand gegen Anspruch 1 des erteilten Patents auf Grundlage des Einspruchsgrundes nach Art. 100(a) EPÜ in Verbindung mit Art. 54 EPÜ erhoben. Als Reaktion auf diesen Einwand ersetzte die Beschwerdeführerin (Patentinhaberin) diesen unabhängigen Anspruch durch drei andere unabhängige Ansprüche. Die Beschwerdegegnerin war der Meinung, dass diese Vorgehensweise nicht von R. 80 EPÜ gedeckt sei.

Nach Ansicht der Beschwerdegegnerin erfordert R. 80 EPÜ, dass der Patentinhaber auf einen Einwand gegen einen unabhängigen Anspruch grundsätzlich lediglich mit einer Änderung dieses einen unabhängigen Anspruchs reagiert. Sie verwies auf mehrere Entscheidungen, die Einschränkungen bei der Ersetzung eines einzigen erteilen Anspruchs durch mehrere unabhängige Ansprüche aufzeigen würden, wie z. B. T 181/02 (wonach die Ersetzung eines einzigen erteilten unabhängigen Anspruchs durch zwei oder mehr unabhängige Ansprüche nur in Ausnahmefällen eine durch einen Einspruchsgrund veranlasste Änderung darstellen könne) und T 453/19. Sie führte zudem T 2063/15 an, wonach sich auf die Beschreibung stützende Änderungen grundsätzlich gegen R. 80 EPÜ verstießen.

Die Kammer folgte dieser Argumentation jedoch nicht und war der Ansicht, dass aus R. 80 EPÜ keine allgemeinen Vorgaben ableitbar seien, in welcher Form ein Patentinhaber Ansprüche ändern darf, damit diese Änderung als durch einen

Einspruchsgrund veranlasst angesehen werden können (s. auch T 2982/18 und T 359/13). Für die Beurteilung des Erfordernisses von R. 80 EPÜ sei alleine maßgeblich, ob die vorgenommene Änderung durch einen Einspruchsgrund veranlasst ist. Hierbei sei zu prüfen, ob die Änderung als ernsthafter Versuch zu werten sei, einem Einspruchsgrund zu begegnen (s. T 750/11).

Für die Beurteilung, ob eine Änderung von Ansprüchen im Sinne der R. 80 EPÜ durch einen Einspruchsgrund veranlasst wurde, sei es daher unerheblich, ob die in einen angegriffenen Anspruch zusätzlich aufgenommenen Merkmale aus abhängigen Ansprüchen oder aus der Beschreibung stammen.

Bezüglich des Ersetzens eines von einem Einspruchsgrund betroffenen unabhängigen Anspruchs durch mehrere unabhängige Ansprüche stimmte die Kammer der Entscheidung T 431/22 zu, wonach R. 80 EPÜ einer solchen Änderung nicht entgegensteht, sofern der Gegenstand der neuen unabhängigen Ansprüche im Vergleich zum Gegenstand des angegriffenen Anspruchs eingeschränkt oder geändert ist. Wie in T 431/22 dargelegt, sei es grundsätzlich legitim, dass ein Patentinhaber versucht, Teilbereiche des angegriffenen unabhängigen Anspruchs zum Überwinden eines Einspruchsgrunds gegebenenfalls mittels zweier oder mehrerer unabhängiger Ansprüche abzudecken (s. auch T 2290/12). Wie in T 99/04 aufgeführt, bestehe der Zweck von R. 80 EPÜ nicht darin, einen Patentinhaber daran zu hindern, das Patent unter Berücksichtigung der Einspruchsgründe so breit wie möglich aufrechtzuerhalten.

Zusammenfassend könne die Frage, ob das Ersetzen eines unabhängigen Anspruchs durch mehrere andere unabhängige Ansprüche im Sinne der R. 80 EPÜ durch einen Einspruchsgrund veranlasst wurde, nicht grundsätzlich verneint oder auf die von der Beschwerdeführerin sowie in T 181/02 genannten Kategorien von Ausnahmekonstellationen beschränkt werden. Vielmehr bedürfe es diesbezüglich regelmäßig einer Beurteilung im Einzelfall (T 263/05).

Vorliegend stellte die Kammer fest, dass die Patentinhaberin mit dem Ersetzen des angegriffenen unabhängigen Anspruchs das legitime Ziel verfolgte, durch drei andere unabhängige Ansprüche Teilbereiche des angegriffenen Anspruchs aufrechtzuerhalten, welche ihrer Meinung nach nicht vom geltend gemachten Einspruchsgrund betroffen waren. Alle drei neu hinzugekommenen Ansprüche wurden im Verhältnis zum angegriffenen und nicht weiter verfolgten Anspruch eingeschränkt. Diese Einschränkungen dienten im jeweiligen Anspruch – und somit auch insgesamt – augenscheinlich der Überwindung des erhobenen Einspruchsgrundes. Im vorliegenden Fall erfüllte der Hauptantrag daher das Erfordernis der R. 80 EPÜ.

010-01-25

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