



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 4 | 2024



Boards  
of Appeal

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## Abstracts of decisions

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## 1. Article 054 EPC | T 1252/20 | Board 3.3.10

### Article 054 EPC

<b>Case Number</b>	T 1252/20
<b>Board</b>	3.3.10
<b>Date of decision</b>	2024.02.06
<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 053, 054 EPC
<b>EPC Rules</b>	
<b>RPBA</b>	
<b>Other legal provisions</b>	Guidelines for Examination G-VI, 7.1
<b>Keywords</b>	novelty – second medical use – substance or composition
<b>Cited decisions</b>	G 0005/83, T 1020/03, T 2003/08, T 1758/15
<b>Case Law Book</b>	<a href="#">I.C.7.2.4</a> , 10th edition

In [T 1252/20](#) claim 1 of the applicant's main request related to "a composition for use in reducing or eliminating cancerous cells" by blocking the blood supply to the tumour. The claim defined the composition as a peptide solution forming a hydrogel once inside the body. The peptide was defined by its specific amino acid sequence. The examining division had set out in its decision, that the peptide solution did not constitute a "substance or composition" according to Art. 54(4) and (5) EPC. Referencing the Guidelines for Examination (G-VI, 7.1) as well as T 1758/15, according to which, if the therapeutic effect of a product is based exclusively on the "macroscopic 3D-structure formed by a composition once inside the body", the product should be considered a device, the examining division found that the peptide hydrogel had a physical mode of action and was thus a device and not a substance or composition.

The board held that whether a material or an object is a substance or composition in the sense of Art. 53(c) and 54(4) or (5) EPC should be decided, in the first place, on the basis of the claimed material or object as such. The claim at hand does not define the material by any technical features which would be characteristic for a device, e.g. its shape. When the material is administered to the patient, the material does not yet have the crucial shape of the plug fitting to the blood vessel, which will in the end, result in the therapeutic effect aimed at. Thus, the material defined in the claim is evidently a "substance or composition". It is a shapeless liquid mixture of chemical entities and, already for this reason alone, it is not a device.

The board decided to depart from previous case law, which distinguished between substance or composition and device based on the "mode of action" of the claimed product in question, since it saw no legal basis for it. The previous case law (T 2003/08, T 1758/15) had taken G 5/83 as a starting point. However, the board held that Art. 54(4) and (5) EPC are not limited to therapeutic applications, but also cover surgical and diagnostic uses, unlike G 5/83. Moreover, the mode of action as the relevant criterion for judging whether a material is a "substance or composition" was not derivable from G 5/83 according to the board. The case underlying G 5/83 had related to the use of a specific chemical compound, so the definition of "substance or composition" and generally the scope of this expression had not been addressed in the decision in any detail. Furthermore, for the Enlarged Board, the subject-matter deserving protection was the invention that the known substance could be used for new therapies. This was fully comparable to the case in question. Taking the mode of action as the decisive criterion was also deemed problematic by the board for several reasons:

Firstly, the material defined in the claim and the material acting inside the body may differ in composition or in some other relevant property. However, second medical use claims are directed to the substance as administered. Since it is this substance which is used in a method excluded under Art. 53(c) EPC, such claim drafting is entirely in line with Art. 54(4) and (5) EPC.

Secondly, the mechanism of action may not be understood in detail and knowing the mechanism of action is not required under the EPC (point 10.2 of the Reasons).

Thirdly, a material may behave in different ways according to its mode of administration. It then appears odd to classify the material according to extrinsic factors not related to the material itself, but to its way of administration.

Lastly, the result of a restriction based on the mode of action does not achieve the legislative purpose behind Art. 54(4) and (5) EPC (similarly in T 1020/03).

The board noted that distinguishing devices from substances for the purposes of Art. 54(5) EPC was required, and this article should not be used to circumvent the usual assessment of novelty of devices. A pacemaker or a surgical scalpel made of a particular stainless steel alloy do not qualify as a "substance or composition", even if they are claimed for use in an arguably novel therapeutic or surgical method. However, there was no apparent reason to disqualify a solution of a peptide without any device-like features, from the scope of Art. 54(5) EPC. The board held that whether a material or an object is a substance or composition in the sense of Art. 53(c) and 54(4) or (5) EPC should be decided, in the first place, on the basis of the claimed material or object as such. If this analysis leads to the conclusion that indeed a substance or composition is present, this requirement of Art. 54(4) or (5) EPC is fulfilled. No additional restrictions relating to its mode of action are derivable from the EPC.

039-04-24

## 2. Article 083 EPC | T 0748/19 | Board 3.5.06

### Article 083 EPC

<b>Case Number</b>	T 0748/19
<b>Board</b>	3.5.06
<b>Date of decision</b>	2023.12.15
<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 083, 100(b) EPC
<b>EPC Rules</b>	
<b>RPBA</b>	
<b>Other legal provisions</b>	
<b>Keywords</b>	sufficiency of disclosure – invention to be performed over whole range claimed – technical field and discussion in recent case law (T 149/21 followed) – claims must be construed to exclude instances which the skilled person would "not expect to work" (no) – "technically unreasonable" instance not detrimental to sufficiency (sometimes)
<b>Cited decisions</b>	T 2773/18, T 1983/19, T 0814/20, T 0149/21
<b>Case Law Book</b>	<a href="#">II.C.5.2.</a> , <a href="#">II.C.5.4.</a> , 10th edition

In ex parte case [T 748/19](#) the application related to identifying events in scenes under surveillance. The board remarked in its preliminary opinion that claim 1 defined a method for identifying events without any definition of the events which were classified. Hence it covered in principle any event in video surveillance. It did not appear credible to the board that the types of data claimed, separately or in combination, contained the information needed to distinguish between all types of events. The application also remained very generic as to the implementation of the proposed concept, providing no detailed examples, and no results. Thus the application was limited to presenting a concept, the validity of which was already questionable for theoretical reasons, and which was also not established by any evidence. The application did not contain even a single detailed embodiment.

The appellant argued that it was true that the claim was based on a limited number of experiments, and that the claim scope included cases which were not covered by these experiments. But the examples were sufficient, because they illustrated how

the invention was to be implemented in general and determined the expectations of the skilled person. Implementation using a neural network, i.e. choosing a suitable architecture and training the network, was straightforward for the skilled person. If a parameter (a camera processing data type) was not useful for the scene and events considered, it would not be used in real life, because the training would not converge. The temporary identification process claimed provided scene-specific ground truth, so it reduced the claimed scope and training requirements. Moreover, the skilled person would have an understanding of which parameters were affected by which of the considered events. In its view, the board in its preliminary opinion had an incorrect understanding of what the skilled person in the art would expect.

The board agreed that the skilled person would be able to choose an architecture for a neural network and carry out its training if a set of camera parameters and events to be identified were defined. However, this was insufficient to establish compliance with Art. 83 EPC in the present case. That was because the claimed invention was not characterised only by it being a neural network, but also, perhaps primarily, by its purpose, that of being able to (reliably) identify events. This purpose must be achieved in different scenarios, also corresponding to different sets of events.

The board explained that it was for the applicant who drafts the claims to define the protection it was seeking. If it was clear that the claim intentionally covered certain matter, then this matter was part of the claimed invention and the fact that it could not be carried out could not be ignored (sufficiency of disclosure). Therefore, the board disagreed with the idea that the claims had to, a priori, be construed to exclude instances which the skilled person would "not expect to work", or which only after trial and error turned out not to work.

The board agreed that it may sometimes be the case that "technically unreasonable" instances of the claimed subject-matter should not be detrimental to sufficiency under Art. 83 EPC. When the "technically unreasonable" instance was a contrived one, i.e. one which the skilled person would, in view of the provided teaching and of the claimed generalisation, not consider the claim to cover, this instance should not be covered. However, non-contrived instances where it was clear that the claim intended to cover them, should be taken into account for assessing sufficiency of disclosure (even if "technically unreasonable" – a claim to a teleporting machine).

The board concluded that on the facts the requirements of Art. 83 EPC were not met.

As to related case law, T 814/20 (video surveillance) was different. The board was also aware of discussions in recent decisions and agreed with T 149/21 that there was no basis in the EPC for applying different standards for compliance with Art. 83 EPC depending on the technical field. The board considered also T 1983/19.

040-04-24

### 3. Article 083 EPC | T 1779/21 | Board 3.3.04

#### Article 083 EPC

<b>Case Number</b>	T 1779/21
<b>Board</b>	3.3.04
<b>Date of decision</b>	2023.12.19
<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 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 – absence of experimental data – credibility – level of proof required – serious nature of the disease
<b>Cited decisions</b>	G 0001/03, G 0002/21, T 0609/02, T 0754/11, T 0887/14
<b>Case Law Book</b>	<a href="#">II.C.7.2.2</a> , 10th edition

In [T 1779/21](#), the board, stressing that G 2/21 confirmed most of the case law on sufficiency of disclosure, summarised in this respect the contribution of G 2/21 (points 74, 77 of the Reasons) as to whether a therapeutic effect had been shown to be achieved, notably that "it is necessary that the patent at the date of its filing renders it credible that the known therapeutic agent, i.e. the product, is suitable for the claimed therapeutic application" and that "the proof of a claimed therapeutic effect has to be provided in the application as filed, in particular if, in the absence of experimental data in the application as filed, it would not be credible to the skilled person that the therapeutic effect is achieved. A lack in this respect cannot be remedied by post-published evidence."

The present board noted that the Enlarged Board endorsed the conclusions in T 609/02 (G 2/21, point 75 of the Reasons), and decisions T 754/11 and T 887/14. The expression "proof of a claimed therapeutic effect" in point 77 of the Reasons could therefore not be interpreted as a deviation from the established case law in the context of second medical uses: it did not apply a stricter requirement than the established case law prior to decision G 2/21. Rather, the Enlarged Board confirmed



that means other than experimental data in the application as filed could establish proof of a claimed therapeutic effect.

What is required, however, in the absence of experimental evidence, is for the patent or the application as filed to provide some information demonstrating that the claimed compound had a direct effect on a metabolic mechanism specifically involved in the disease, this mechanism being either known from the prior art or demonstrated in the patent itself (see T 609/02, points 5 to 9 of the Reasons). The board also quoted G 1/03 (point 2.5.3 of the Reasons – contribution to the state of the art). The board concluded that a contribution to the state of the art which enabled the skilled person to carry out the invention had to be present in the application as filed.

The patent related to the treatment of Dravet syndrome with fenfluramine. Dravet syndrome is a rare and catastrophic form of intractable epilepsy that begins in infancy. It had in the present case to be decided whether fenfluramine as a monotherapy, i.e. as the sole therapeutic agent, could be considered suitable for the treatment of Dravet syndrome at the relevant date. In the absence of experimental data for fenfluramine monotherapy in the application as filed, the board considered whether achieving the claimed therapeutic effect was made credible in the application as filed in another way. "Monotherapy" was explicitly mentioned in the application as filed as an alternative to combination therapy. However, this mere statement was not in itself sufficient to provide any "proof" in the sense of decision G 2/21. Until the present invention was made, it was not known that fenfluramine's mechanism of action had made it suitable for the treatment of Dravet Syndrome. The board noted that treatment by therapy did not per se necessitate a complete cure of the disease or even the addressing of its cause, but did include the alleviation of symptoms.

Although the skilled person could conclude, from the data in the application as filed, that fenfluramine in combination with valproate alleviated some symptoms of Dravet syndrome, it was not clear whether this also applied in a monotherapy. In this particular case, namely a very serious disease for which an established, albeit sub-optimal, therapy exists and where a wrong therapy decision could lead to irreversible damage, the level of proof required had to be at least such that the skilled person had reason to assume that the standard valproate treatment could be discontinued and replaced by fenfluramine without worsening the condition of the patient.

From the technical teaching of the application as filed, even taking into account the prior art, therapeutic effect was not credibly achieved. In line with decision G 2/21, the board did not take the post-published data into account. Sufficiency of disclosure was not satisfied. The opposition division's decision was set aside and the patent revoked.

041-04-24

## 4. Article 083 EPC | T 1942/21 | Board 3.3.05

### Article 083 EPC

<b>Case Number</b>	T 1942/21
<b>Board</b>	3.3.05
<b>Date of decision</b>	2024.01.19
<b>Language of the proceedings</b>	DE
<b>Internal distribution code</b>	D
<b>Inter partes/ex parte</b>	Inter partes
<b>EPC Articles</b>	Articles 083, 100(b) EPC
<b>EPC Rules</b>	Rule 043(3) EPC
<b>RPBA</b>	
<b>Other legal provisions</b>	
<b>Keywords</b>	sufficiency of disclosure – invention to be performed over whole range claimed – open ended range
<b>Cited decisions</b>	T 0412/93, T 0136/04, T 1018/05, T 1697/12, T 0398/19, T 0615/19, T 1945/19, T 1586/20
<b>Case Law Book</b>	<a href="#">II.C.5.4.</a> , <a href="#">II.C.5.5.2</a> , 10th edition

In [T 1942/21](#) stellte sich die Frage, ob die Fachperson genügend Anleitungen im Patent erhält, wie hohe Anteile an Methan im Synthesegas erhalten werden können.

Der Argumentation der Beschwerdeführerin (Patentinhaberin), dass diese Frage sich gar nicht stelle, da ohne Angabe einer Untergrenze für Methan kein Ausführbarkeitsproblem vorgelegen hätte, stimmte die Kammer nicht zu. Würde diese Argumentation gutgeheißen, so könnte eine Einschränkung eines Anspruchs durch einen nicht-ausführbaren Parameter nicht bemängelt werden, da der breitere Anspruch ohne den Parameter ja wahrscheinlich kein Ausführbarkeitsproblem aufwies. Es ist jedoch etablierte Rechtsprechung, dass, wenn ein wesentliches Merkmal einer Erfindung durch einen Parameter ausgedrückt wird, sich die Frage stellt, ob der Parameter so definiert ist, dass es der Fachperson möglich ist, anhand der Offenbarung in ihrer Gesamtheit und mithilfe des allgemeinen Fachwissens ohne unzumutbaren Aufwand die technischen Maßnahmen zu identifizieren, die zum beanspruchten Gegenstand führen. Diese Sichtweise ist auch im Einklang mit Entscheidungen, die abhängige, also eingeschränkte Ansprüche als nicht ausführbar ansahen, ohne den breiteren unabhängigen Anspruch wegen fehlender Ausführbarkeit zu bemängeln.

Dies bedeutet für den vorliegenden Fall, dass das Patent ausreichend Anweisungen enthalten muss, wie das jetzt wesentliche Merkmal, das sozusagen das zu erreichende Ergebnis definiert, nämlich einen Methananteil von mehr als 12 Vol-% im Synthesegas zu erhalten, über die gesamte Breite verwirklicht werden kann. Dieses Merkmal ist das Wesen der Erfindung, da Synthesegas mit weniger Methan bereits bekannt war. Deshalb sollte die Lehre des Patents es erlauben, dieses neue Merkmal über den gesamten beanspruchten Bereich zu erhalten. Obwohl der vorliegende Fall ein zu erreichendes Ergebnis einer chemischen Reaktion betrifft und nicht einen physikalischen Parameter, ist er trotzdem ähnlich gelagert wie der in der Rechtsprechung zitierte Fall T 1697/12 (dort waren bestimmte realistische Werte durch das offenbarte Verfahren nicht erreichbar weshalb auch die Ausführbarkeit verneint worden war).

Im vorliegenden Fall führt die Einführung der Methanmenge im Synthesegas dazu, dass dieses Merkmal wesentlich ist (R. 43 (3) EPÜ) und sich somit die Frage stellt, wie das beanspruchte Ziel über den gesamten Bereich erreicht werden kann. Das Patent enthält Informationen wie die Untergrenze von 12 Vol-% Methan überschritten werden kann. Jedoch gab es keinerlei Informationen im Patent, wie Methanmengen von 20 bis 25% erreicht werden können, die sicherlich nicht als unrealistisch angesehen werden. Es stimmt, dass der nach oben offene Bereich durch das Verfahren an sich (Reaktion mit Wasserdampf) beschränkt ist, jedoch sind Werte im Bereich von 20 bis 25 Vol.% Methan unbestritten nicht durch diese Beschränkung ausgeschlossen. Die Kammer ist sich bewusst, dass es Entscheidungen gibt, die jedoch einen physikalischen Parameter betreffen, in denen der nach oben offene Bereich als nicht problematisch angesehen wurde. Im vorliegenden Fall ist jedoch die Situation anders.

Da es unstrittig zwischen den Parteien war, dass Methangehalte von 20 bis 25 Vol-% von dem Anspruch umfasst sind und die Lehre des Patents dahingehend nicht ausreichend ist, wird der Gegenstand des Anspruchs 1 als nicht ausführbar angesehen.

042-04-24

## 5. Article 083 EPC | T 1311/22 | Board 3.2.04

### Article 083 EPC

<b>Case Number</b>	T 1311/22
<b>Board</b>	3.2.04
<b>Date of decision</b>	2024.01.24
<b>Language of the proceedings</b>	DE
<b>Internal distribution code</b>	C
<b>Inter partes/ex parte</b>	Inter partes
<b>EPC Articles</b>	Articles 083, 100(b) EPC
<b>EPC Rules</b>	
<b>RPBA</b>	
<b>Other legal provisions</b>	
<b>Keywords</b>	sufficiency of disclosure – invention to be performed over whole range claimed – functional features
<b>Cited decisions</b>	T 0409/91, T 0435/91, T 1697/12, T 0398/19
<b>Case Law Book</b>	<a href="#">II.C.5.4.</a> , <a href="#">II.C.5.5.2.</a> , <a href="#">II.C.8.1.</a> , 10th edition

In der Sache [T 1311/22](#) definierte Anspruch 1 des Hauptantrags die beanspruchte Vorrichtung zum Staubsaugen durch funktionelle Merkmale, und zwar in Bezug auf ein zu erreichendes Ergebnis, das wiederum durch Werte des neu definierten Parameters "Qualitätsfaktor" ausgedrückt wurde.

Die Kammer rief in Erinnerung, dass nach der ständigen Rechtsprechung das Erfordernis der ausreichenden Offenbarung erfüllt ist, wenn der Fachmann die in den unabhängigen Ansprüchen definierte Erfindung über den gesamten Schutzbereich der Ansprüche anhand seines allgemeinen Fachwissens ohne unzumutbaren Aufwand ausführen kann. Dieser Grundsatz gelte auch für Erfindungen, die durch ihre Funktion definiert werden. Die Besonderheit der funktionellen Definition eines technischen Merkmals bestehe darin, dass es durch seine Wirkung definiert werde. Eine solche Definition beziehe sich ganz abstrakt auf eine unbestimmte Vielzahl möglicher Alternativen und sei solange zulässig, wie alle Alternativen dem Fachmann zur Verfügung stehen und das gewünschte Ergebnis liefern. Deshalb müsse geprüft werden, ob das Patent eine verallgemeinerungsfähige technische Lehre offenbart, die dem Fachmann das ganze Variantenspektrum, das unter die funktionelle Definition fällt, zugänglich macht.

Die Kammer verwies auch auf den Grundsatz, dass der Schutzbereich eines Patents dem technischen Beitrag entsprechen muss, den die Offenbarung der darin beschriebenen Erfindung zum Stand der Technik leistet. Daher darf sich das mit dem Patent verliehene Monopol nicht auf Gegenstände erstrecken, die dem Fachmann auch nach der Lektüre der Patentschrift noch nicht zur Verfügung stehen. Die vorhandenen Informationen müssen den Fachmann in die Lage versetzen, das angestrebte Ergebnis im gesamten Bereich des Anspruchs, der die betreffende funktionelle Definition enthält, ohne unzumutbaren Aufwand zu erreichen.

Bei ihrer detailliert erläuterten Anwendung dieser Grundsätze auf den konkreten Fall führte die Kammer u. a. Folgendes aus: Die Angabe zu Parametern, die den Qualitätsfaktor beeinflussen, sei sehr allgemein und derart unspezifisch, dass sie sich aufgrund der unzähligen Varianten von Staubsaugergeräten und Filterbeuteln unterschiedlichsten Aufbaus und Materialbeschaffenheit nicht ohne unzumutbaren Aufwand umsetzen lasse. Auch die sehr spezifischen Ausführungsbeispiele gäben dem Fachmann keine Anhaltspunkte dafür, welche der zahlreichen Merkmale und Maßnahmen – ob alle oder nur bestimmte davon – für die Erzielung der beanspruchten Qualitätsfaktoren ausschlaggebend seien, so dass er den Anspruchsgegenstand auch durch zielgerichtete Auswahl anderer geeigneter Paarungen von Filterbeuteln und Staubsaugergeräten sowie gegebenenfalls weitere geeignete Maßnahmen ohne unzumutbaren Aufwand realisieren könnte. Die Kammer erläuterte zudem, dass der Schutzbereich von Anspruch 1 breite Bereiche für die Qualitätsfaktoren beinhalte, die nicht implizit durch Verknüpfung mit anderen Merkmalen oder Angaben auf gewisse einschätzbare Obergrenzen begrenzt seien, wodurch auch Vorrichtungen mit noch unbekanntem, zukünftigen Komponenten erfasst würden. Demgegenüber seien nur ganz konkrete Ausführungsbeispiele offenbart, die eine sehr begrenzte Verbesserung der Qualitätsfaktoren ermöglichten.

Die Kammer wies auch darauf hin, dass die Beschwerdegegnerin nicht bestritten hatte, dass Anspruch 1 Ausführungsformen umfasst, die durch andere als die spezifisch in den Ausführungsbeispielen vorgeschlagenen Merkmale und Maßnahmen realisiert werden könnten. Die Beschwerdegegnerin argumentierte, zukünftige Erfindungen, die Qualitätsfaktoren im beanspruchten Bereich auf andere Weise bereitstellten, seien wie üblich abhängige Erfindungen und könnten selbst Patentschutz erlangen. Dies sei bei Grundlagenerfindungen immer der Fall. Die Kammer konnte aber eine solche im vorliegenden Fall nicht erkennen.

Voraussetzung für die Inanspruchnahme eines Schutzbereichs ist zumindest, so die Kammer, dass der Fachmann aus dem Patent einen Weg zur Ausführung oder wenigstens Weiterentwicklung der beanspruchten Erfindung über den gesamten Schutzbereich ableiten kann. Diese Voraussetzung sah die Kammer vorliegend als nicht erfüllt an.

043-04-24

## 6. Article 088(1) EPC | T 0521/18 | Board 3.3.08

### Article 088(1) EPC

<b>Case Number</b>	T 0521/18
<b>Board</b>	3.3.08
<b>Date of decision</b>	2024.03.07
<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 054, 088(1) EPC
<b>EPC Rules</b>	
<b>RPBA</b>	
<b>Other legal provisions</b>	
<b>Keywords</b>	priority (yes) – prior art document – application of G 1/22 and G 2/22 – presumption of entitlement rebutted (no) – novelty (no)
<b>Cited decisions</b>	G 0001/22, G 0002/22
<b>Case Law Book</b>	<a href="#">II.D.2.2.</a> , 10th edition

[T 521/18](#) was an appeal by the patent proprietor against the decision of the opposition division to revoke the patent for lack of novelty of the subject-matter of claims 1 and 5 of auxiliary request 3 (main request on appeal) over the disclosure of document D4. The prior art document D4 was a Euro-PCT application, filed in the name of a corporation (designated for the States outside US) and ten inventors/applicants (designated for the US only). The opposition division had held that D4 was entitled to priority from application P4 (D4a), which had been filed in the name of seven out of the ten inventors/applicants of D4.

The board agreed with the findings of the opposition division both regarding the priority entitlement of D4 and the lack of novelty of claims 1 and 5 of the main request. On the question of priority entitlement of D4, the board recalled that G 1/22 and G 2/22 had set out that under the EPC normally a strong presumption exists that the priority applicants accept the subsequent applicant's reliance on the priority right for the purposes of Art. 88(1) EPC. This strong presumption also applies in a situation where a PCT application is jointly filed by parties A and B, (i) designating party A for one or more designated States and party B for one or more other designated States, and (ii) claiming priority from an earlier patent application designating party A as the applicant. The joint filing implies an agreement between parties A and B allowing party B to rely on the priority, unless there are substantial factual indications to the contrary (Order II of G 1/22 and G 2/22).

Applying G 1/22 and G 2/22, the board held that the strong presumption of entitlement applied in the case in hand (which corresponded to the situation referred to in Order II of G 1/22 and G 2/22). Such presumption could only be rebutted in the presence of "serious" doubts based on facts or clear indications to the contrary (see G 1/22 and G 2/22, points 110 and 125 of the Reasons). The appellant had filed documents D12 to D14 to cast doubts that a valid priority transfer had taken place from the inventors to the corporation. According to the board, however, the evidence submitted by the appellant was not suitable to rebut the presumption of entitlement as also confirmed by the declarations of two inventors of D4. Consequently, D4 was entitled to priority from application P4 (D4a) and thus formed prior art for the patent at least according to Art. 54(3) EPC.

On the question of novelty, the board noted that the appellant had not provided any substantiation that the opposition division's finding, i.e. that claims 1 and 5 of the main request lacked novelty if D4 was entitled to priority from application P4 (D4a), was erroneous. The board concluded that the main request contravened Art. 54 EPC.

044-04-24

## 7. Article 088(4) EPC | T 1762/21 | Board 3.2.02

### Article 088(4) EPC

<b>Case Number</b>	T 1762/21
<b>Board</b>	3.2.02
<b>Date of decision</b>	2024.02.14
<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>	Articles 087(1), 088(4) EPC
<b>EPC Rules</b>	
<b>RPBA</b>	
<b>Other legal provisions</b>	
<b>Keywords</b>	priority – validity of priority date (yes) – basis in priority document (yes)
<b>Cited decisions</b>	G 0002/98
<b>Case Law Book</b>	<a href="#">II.D.3.1.2</a> , <a href="#">II.D.3.1.3</a> , 10th edition

[See also abstract under Article 123\(2\) EPC.](#)

In [T 1762/21](#) the appellant (opponent) disputed the validity of the priority claim for the subject-matter of claims 1 and 7 of the main request. It argued that the validity of the priority claim could not be assessed by applying the same criteria as for the assessment of added subject-matter. It should be assessed according to the principles set out in G 2/98. According to the appellant, G 2/98 did not consider intermediate generalisations, which were of importance only for the assessment of added subject-matter. The subject-matter of the claim for which priority was claimed had to be clear ("deutlich" in the German version of G 2/98). Moreover, it had to be disclosed in the form of a claim or in the form of an embodiment or example specified in the description of the application whose priority was claimed.

The board disagreed. It held that the same considerations applied to the assessment of the priority claim as to the assessment of added subject-matter. The disclosure of the description and the drawings of the priority document were identical to those of the application as filed. The priority document differed from the application as filed only in that it did not contain any claims. However, the claims of the application as filed were not required in order to provide a basis for claims 1 and 7 of the main request.

The board recalled that the criteria for assessing the validity of a priority claim were set out in G 2/98. These criteria corresponded to the "gold" standard for assessing



any amendment, no matter whether or not it included intermediate generalisations, for its compliance with Art. 123(2) EPC. Point 4 of the Reasons of G 2/98, referred to by the appellant, did not imply any different criterion in the assessment of added subject-matter and the validity of a priority claim either. The relevant passage read: "It follows that priority for a claim, i.e. an 'element of the invention' within the meaning of Article 4H of the Paris Convention, is to be acknowledged, if the subject-matter of the claim is specifically disclosed be it explicitly or implicitly in the application documents relating to the disclosure, in particular, in the form of a claim or in the form of an embodiment or example specified in the description of the application whose priority is claimed, and that priority for the claim can be refused, if there is no such disclosure."

In the board's opinion, this passage was in line with and did not go beyond the order of G 2/98, as it stated that, for a priority claim to be valid, a specific disclosure, be it explicit or implicit, had to be present in the application from which the priority was claimed. The term "deutlich" in the German version of the decision, which is a translation of the term "specifically" in the English version, did not imply that only a clear claim may enjoy a priority claim. The term qualified the disclosure in the application from which priority was claimed. This disclosure should be specific ("deutlich") in the sense that the subject-matter for which priority was claimed was to be derived from the disclosure in a direct and unambiguous way. Whether this subject-matter as such was unclear was not decisive as long as the same (unclear) subject-matter was directly and unambiguously disclosed in the application from which priority was claimed. In view of Art. 88(4) EPC, it was not required that this subject-matter be disclosed in the form of a claim or in the form of an embodiment or example specified in the description of the application from which priority was claimed. In the passage in point 4 of the Reasons of G 2/98, these items, as derived from the expression "in particular", were simply listed as exemplary parts of the application documents.

The board concluded that the priority for the subject-matter of claims 1 and 7 of the main request was valid for the same reasons as the ones set out with respect to added subject-matter.

045-04-24

## 8. Article 099(1) EPC | T 0480/21 | Board 3.4.01

### Article 099(1) EPC

<b>Case Number</b>	T 0480/21
<b>Board</b>	3.4.01
<b>Date of decision</b>	2024.01.19
<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>	Article 099(1) EPC
<b>EPC Rules</b>	
<b>RPBA</b>	
<b>Other legal provisions</b>	Article 5 RFees, point 5 Arrangements for deposit accounts valid as from 1 December 2017, Notice from the EPO dated 18 January 2018 concerning the safeguards available under the EPC and the PCT in case of unavailability of means of electronic communication (OJ 2018, A25)
<b>Keywords</b>	opposition – deemed to have been filed (yes) – opposition fee (paid) – inability to file debit order – malfunction of EPO’s Online Filing software – attributable to EPO – period for payment extended – point 5.5 ADA 2017
<b>Cited decisions</b>	
<b>Case Law Book</b>	<a href="#">III.U.2.2.</a> , <a href="#">IV.C.2.2.2.</a> , 10th edition

In [T 480/21](#) the opponent had attempted to file a notice of opposition using EPO Online Filing software on the last day of the opposition period. This transmission had failed. The opponent had then, on the same day, filed the notice by fax, including a copy of the online opposition form 2300E. The fax comprised a request for debiting of a deposit account for the payment of the opposition fee. The EPO had not carried out this request. A further, successful request had been made on the day after the expiry of the opposition period, using the EPO online payment system via web payment. The opposition division had deemed the opposition not to have been filed. On appeal, the opponent requested that the decision be set aside.

The board recalled that payment of the opposition fee was governed by Art. 5 RFees. It could be made by bank transfer, by credit card or by debiting of a deposit account held with the EPO, as governed by the Arrangements for deposit accounts valid as from 1 December 2017 (hereinafter ADA). The board agreed with the opposition division’s finding that the debit order had not been received at the EPO in an

electronically processable format (XML) within the regular opposition period, but only in the form of a fax. Payment on the following day came too late (points 5.1.2, 5.1.3 and 5.1.4 ADA). Without a remedy, the legal consequence would be that the notice of opposition would be deemed not to have been filed.

The board referred to the first sentence of point 5.5 ADA, which read: "If a payment period expires on a day on which one of the accepted means of filing debit orders under point 5.1.2 is not available at the EPO, the payment period is extended to the first day thereafter on which all such means as are available for the type of application concerned can be accessed again." The board also referred to the "Notice from the EPO dated 18 January 2018 concerning the safeguards available under the EPC and the PCT in case of unavailability of means of electronic communication". Point 7 of this notice read: "A means of electronic communication may exceptionally be unavailable for reasons other than those indicated above (e.g. a malfunction). Although the burden of proving receipt lies with the party alleging submission in time, the EPO will look into any alleged unavailability of a means of electronic communication. A user in doubt as to whether a document was properly transmitted is recommended to contact EPO Customer Services. The user will suffer no adverse consequences if it is confirmed that the unavailability was attributable to the EPO. However, to be sure of avoiding any adverse consequences, it is also advisable, as a precautionary measure, to request the legal remedy available."

The board concluded that an extension of the period for paying the opposition fee was provided under point 5.5 ADA. The evidence strongly suggested that the inability to file the debit order was due to a malfunction of the EPO's Online Filing software, which, in this case, was attributable to the EPO. Hence, the payment period was extended under the first sentence of point 5.5 ADA to at least the next day. On that day, the payment was successfully made. The opposition was thus validly filed.

The board noted that this result did not constitute a disproportionate protection of the opponent's legitimate expectation to be able to rely on safeguards in the event of malfunction of the EPO's software, as opposed to the proprietor's legitimate expectation of legal certainty. The proprietor was aware that a notice of opposition had been sent by fax in due time and should have been aware of the possibility of an extension of the payment period under point 5.5 ADA.

046-04-24

## 9. Article 112a(2)(c) EPC | R 0010/20 | EBA

### Article 112a(2)(c) EPC

<b>Case Number</b>	R 0010/20
<b>Board</b>	EBA
<b>Date of decision</b>	2023.09.25
<b>Language of the proceedings</b>	DE
<b>Internal distribution code</b>	D
<b>Inter partes/ex parte</b>	Inter partes
<b>EPC Articles</b>	Articles 112a(2)(c) and (d), 113(1) EPC
<b>EPC Rules</b>	Rule 104 EPC
<b>RPBA</b>	
<b>Other legal provisions</b>	
<b>Keywords</b>	petition for review – list of grounds exhaustive – fundamental violation of Article 113 EPC (no)
<b>Cited decisions</b>	R 0010/18
<b>Case Law Book</b>	<a href="#">V.B.4.3.10a</a> ), <a href="#">V.B.4.3.8a</a> ), <a href="#">V.B.3.4.2</a> , <a href="#">V.B.4.4.</a> , 10th edition

Der Antrag auf Überprüfung in [R 10/20](#) wurde darauf gestützt, dass die angefochtene Entscheidung in mehrfacher Hinsicht mit einem schwerwiegenden Verfahrensmangel behaftet sei, und – ebenfalls in mehrfacher Hinsicht – ein schwerwiegender Verstoß gegen Art. 113 EPÜ vorliege.

Im Rahmen der Prüfung der Begründetheit des Antrags stellte die Große Beschwerdekammer (GBK) zunächst fest, dass sich die Antragstellerin weder auf das Übergehen eines Antrags auf mündliche Verhandlung (R. 104 a) EPÜ) noch eines sonstigen relevanten Antrags im Verfahren (R. 104 b) EPÜ) berufen hatte. Nach Ansicht der GBK konnten aber die von der Antragstellerin im Rahmen des Verfahrensmangels gemäß Art. 112a (2) d) EPÜ gemachten Darlegungen dem Verfahrensmangel gemäß Art. 112a (2) c) EPÜ wegen Verletzung des Rechts auf rechtliches Gehör (Art. 113 (1) EPÜ) zugeordnet werden.

Für die rechtliche Beurteilung der geltend gemachten Begründungsmängel stellte die GBK den Orientierungssatz von R 10/18 wie folgt klar: Art. 113 (1) EPÜ verlangt, dass die Kammer Vorbringen eines Beteiligten in der Sache berücksichtigt hat, d.h.

- erstens, dass sie das Vorbringen eines Beteiligten zur Kenntnis genommen und
- zweitens dieses Vorbringen erwogen hat, d.h. geprüft hat, ob es relevant und ggf. richtig ist.

Es wird vermutet, dass eine Kammer das Vorbringen eines Beteiligten in der Sache berücksichtigt hat, welches sie in den Entscheidungsgründen nicht behandelt hat. Denn dann ist anzunehmen, dass es aus ihrer Sicht nicht relevant war. Diese Vermutung kann widerlegt sein, wenn Anzeichen für eine Nicht-Berücksichtigung vorliegen, z.B. wenn eine Kammer in den Entscheidungsgründen das Vorbringen eines Beteiligten nicht behandelt, welches objektiv betrachtet entscheidend für den Ausgang des Falles ist, oder derartiges Vorbringen von der Hand weist, ohne es zuvor auf seine Richtigkeit zu überprüfen.

Bei der Beurteilung der geltend gemachten "mangelnden Berücksichtigung hochrelevanter Argumente" (Defizite a) und b)) schloss die GBK aus der Behandlung der betroffenen Fragen in der Entscheidung, dass in Bezug auf diese Defizite keine Abweichung von der Vermutung der Kenntnisnahme anzunehmen war. Betreffend die Vermutung einer Berücksichtigung und damit (nicht nur einer Kenntnisnahme, sondern auch) Erwägung, hatte die Antragstellerin geltend gemacht, es liege die Ausnahme vor, wonach das fragliche Vorbringen objektiv entscheidend für den Ausgang des Falles sei. Die GBK teilte diese Auffassung nicht: Da das Verfahren nach Art. 112a EPÜ grundsätzlich nicht der Überprüfung des materiellen Rechts diene, seien Ausnahmen von diesem Grundsatz nur unter strengen Voraussetzungen zuzulassen, was vorliegend bedeute, dass sich der Charakter des Vorbringens als objektiv betrachtet entscheidend für den Ausgang des Falles aufdrängen müsse. Die GBK schlussfolgerte aus dem Umstand, dass die Bewertung als entscheidend für den Ausgang des Falles der als hochrelevant geltend gemachten Argumente eine technische Analyse voraussetzte, dass in Bezug auf diese Begründungsmängel a) und b) die Vermutung der Erwägung, und damit ihrer Berücksichtigung, gelte. Aus der Nichtbehandlung in der Entscheidung sei abzuleiten, dass die Kammer die von der Antragstellerin als hochrelevant angesehenen Argumente als gar nicht relevant betrachtet und daher auf eine Diskussion in der Entscheidung verzichtet habe. Aus Sicht der GBK war ein Gehörverstoß zu verneinen.

In Bezug auf die geltend gemachten Defizite c) und d) stellte die GBK klar, dass die Antragstellerin mit der Beanstandung einer "unlogischen und widersprüchlichen Begründung" nicht eine mangelnde, sondern eine fehlerhafte Erwägung ihres Vorbringens geltend machte. Diese könne insbesondere materielle Fehlbeurteilungen widerspiegeln, welche im Verfahren nach Art. 112a EPÜ nicht überprüfbar seien.

Schließlich stellte die GBK fest, dass die Antragstellerin (auch ohne eine Beanstandung der Kammer betreffend die Nichtdurchführung eigener Versuche) Gelegenheit hatte, sich zu den Vergleichsversuchen im Patent mittels Vorlage des Ergebnisses eigener Versuche zu äußern. Der unter diesem Gesichtspunkt geltend gemachte Gehörverstoß liege daher nicht vor.

Der Antrag auf Überprüfung wurde folglich als teils offensichtlich unzulässig und im Übrigen als offensichtlich unbegründet verworfen.

047-04-24

## 10. Article 123(2) EPC | T 1261/21 | Board 3.3.09

### Article 123(2) EPC

<b>Case Number</b>	T 1261/21
<b>Board</b>	3.3.09
<b>Date of decision</b>	2024.01.10
<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>	Article 123(2) EPC
<b>EPC Rules</b>	
<b>RPBA</b>	
<b>Other legal provisions</b>	
<b>Keywords</b>	amendments – added subject-matter (no) – selections from two or more lists – convergent lists
<b>Cited decisions</b>	T 2237/10, T 1621/16, T 1937/17, T 1210/20, T 1133/21
<b>Case Law Book</b>	<a href="#">II.E.1.6.1a</a> , <a href="#">II.E.1.6.2c</a> , <a href="#">II.E.1.6.2d</a> , 10th edition

In [T 1261/21](#) the board established that in claim 1 of auxiliary request 26, the deodorisation time and the deodorisation temperature were limited based on a disclosure of converging numerical ranges or converging elements of the same feature (also named "converging alternatives" in some board decisions) in claims 3 and 4 of the application as filed. The triglyceride composition was limited based on a list of non-converging alternatives in claim 10 of the application as filed.

The board explained that the "gold standard" must be applied universally to assess whether amendments comply with Art. 123(2) EPC (G 2/10). In the case in hand, the criteria set out in T 1621/16 were helpful.

The board concurred with T 1937/17 that the first criterion in point 2 of the Catchword of T 1621/16 ("the subject-matter resulting from the multiple selections is not associated with an undisclosed technical contribution") should not be taken into account when establishing whether there was a direct and unambiguous disclosure for the combination of features resulting from a multiple selection. However, the board agreed with the conclusion in point 1 of the Catchword of T 1621/16 that the choice of a more or less preferred element from a list of converging alternatives should not be treated as an arbitrary selection because this choice did not lead to a "singling out". The board further agreed that in general a pointer to the combination of features resulting from multiple selections was necessary to comply with

Art. 123(2) EPC (see second criterion in point 2 of the Catchword of T 1621/16). In this context, the present board preferred the term "converging elements" to "converging alternatives", as "alternatives" seemed to imply that there were real alternatives that did not overlap.

Furthermore, the board agreed with T 1133/21 that, first, the mere fact that features were described in terms of lists of more or less converging elements (alternatives) did not give the proprietor carte blanche to freely combine features selected from a first list with features selected from a second list disclosed in the application as filed. This was particularly relevant where an application as filed provided a large reservoir of options and alternatives. Second, factors which may play a role in the assessment of Art. 123(2) EPC were, inter alia, the number of elements (alternatives) disclosed in the application; the length, convergence and any preference in the lists of enumerated features; and the presence of examples pointing to a combination of features.

In addition, the board considered that the question of whether the claimed combination of features merely resulted from the combination of claims having an appropriate back-reference to each other (see T 2237/10) played a role in the assessment of compliance with Art. 123(2) EPC. Particularly relevant was whether there was a pointer to the claimed combination of features. This was especially so in cases like the present one where only very few "selections" were necessary to arrive at the claimed combination of features. A pointer was an (implicit or explicit) indication or hint towards the combination of features in question. The pointer needed to be suitable for demonstrating that the claimed combination of features was envisaged in the application as filed. Typically, it consisted of an example or embodiment. In the board's view, there was not normally only one pointer towards the most preferred example or embodiment.

Finally, the board observed that an overly formalistic application of the concept of multiple selections from lists of alternatives should be avoided (see T 1210/20).

Thus, the question was whether there was a pointer in the application as filed to the combination of the two numerical ranges relating to different levels or enumerations of converging elements, and a selection from a list of non-converging alternatives. Example 1 of the application as filed exemplified the deodorisation of cocoa butter. In the board's view, this emphasised that cocoa butter was a preferred triglyceride composition. Thus, the selection of cocoa butter was not arbitrary. Also, the experiments of example 1 all fell within the time and temperature requirements of claim 1, thus supporting that the claimed combination of features was not the result of an arbitrary selection. The board concluded that the subject-matter of claim 1 of auxiliary request 26 met Art. 123(2) EPC.

048-04-24

## 11. Article 123(2) EPC | T 1762/21 | Board 3.2.02

### Article 123(2) EPC

<b>Case Number</b>	T 1762/21
<b>Board</b>	3.2.02
<b>Date of decision</b>	2024.02.14
<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 123(2) EPC
<b>EPC Rules</b>	
<b>RPBA</b>	
<b>Other legal provisions</b>	
<b>Keywords</b>	amendments – added subject-matter (no) – intermediate generalisations
<b>Cited decisions</b>	G 0001/93, G 0002/10
<b>Case Law Book</b>	<a href="#">II.E.1.9.1</a> , <a href="#">II.E.1.9.2</a> , 10th edition

[See also abstract under Article 88\(4\) EPC.](#)

In [T 1762/21](#) the appellant (opponent) argued that claims 1 and 7 of the main request had inadmissibly omitted a number of features which had been presented together with the claimed features in the application as filed and which were important for the functioning of the claimed breast tomosynthesis system. This amounted to an intermediate generalisation.

The board explained that when assessing the allowability of an intermediate generalisation, it had to be established whether, because of this generalisation, the claim presented technical information which extended beyond what was directly and unambiguously disclosed in the application as filed, be it explicitly or implicitly, to the skilled person using common general knowledge. This was the "gold" standard for assessing whether any amendment fulfilled Art. 123(2) EPC (G 2/10). G 1/93, referred to by the appellant, dealt with the conflicting requirements of Art. 123, paragraphs (2) and (3), EPC. It did not prescribe any special criteria for the assessment of intermediate generalisations.

The skilled person was presented with subject-matter extending beyond the application as filed when an amended claim included only some features of an originally disclosed combination and the features left out of the claim were understood by the skilled person to be inextricably linked to the claimed ones. This was the case if the skilled person would have considered the omitted features as



necessary to achieve the effect associated with the added features. In such a situation, the amended claim conveyed the technical teaching that the effect could be obtained with the claimed features alone. This was in contradiction with the original disclosure, according to which the whole combination of features was needed. The passage concerning intermediate generalisations in chapter H-V, 3.2.1 of the Guidelines had to be understood in this context.

In the case in hand, the invention as claimed in independent claims 1 and 7 of the main request was directed to a breast tomosynthesis system and a method of acquiring breast tomosynthesis x-ray images with such a system. In the original disclosure, the features of these claims related specifically to optimising the acquired images by acting on the focal spot. Features in the description relating to other aspects of the system, such as the way in which the x-rays were generated or the way in which the breast was fixed in place on the detector, could be left out of the claims as long as they were not relevant to the optimisation, even if they contributed to the general functioning of the tomosynthesis system.

Hence, the board concluded that the subject-matter of claims 1 and 7 of the main request did not extend beyond the content of the application as filed.

049-04-24

## 12. Rule 106 EPC | R 0006/22 | EBA

### Rule 106 EPC

<b>Case Number</b>	R 0006/22
<b>Board</b>	EBA
<b>Date of decision</b>	2023.11.06
<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 112a(2)(c) and (d), 113(1) EPC
<b>EPC Rules</b>	Rules 104(b), 106 EPC
<b>RPBA</b>	
<b>Other legal provisions</b>	
<b>Keywords</b>	obligation to raise objections – objection raised (no) – fundamental procedural defect (no) – fundamental violation of Article 113 EPC (no)
<b>Cited decisions</b>	R 0014/11, R 0018/12
<b>Case Law Book</b>	<a href="#">V.B.3.6.2a</a> , <a href="#">V.B.3.6.2b</a> , <a href="#">V.B.3.6.3</a> , <a href="#">V.B.4.4.2</a> , 10th edition

In [R 6/22](#) the petition for review was essentially based on the two grounds that (1) the non-admittance of the auxiliary request had constituted a violation of the right to be heard since the auxiliary request had been submitted in response to a new argument raised by the board, and (2) the board's failure to carry out a full and proper examination of the inventive step of the auxiliary request (when deciding on its clear allowability for the purposes of its admittance) had been tantamount to not taking a decision within the meaning of R. 104(b) EPC. Moreover, this had been, according to the petitioner, another case where the proprietor's right to be heard had not been respected because its inventive step arguments had been ignored.

The Enlarged Board of Appeal (EBA) recalled that pursuant to R. 106 EPC, a petition for review based on a ground for petition under any of Art. 112a(2)(a) to (d) EPC is admissible only where an objection in respect of the procedural defect was raised during the appeal proceedings and dismissed by the board of appeal, except where such objection could not be raised during the appeal proceedings. Referring to R 18/12 the EBA recalled that in determining whether the petitioner has complied with R. 106 EPC, what matters is not the formal wording of the objection but its substance as it could be objectively understood by the board.

According to the EBA, in the present case, the petitioner could and should have made an explicit objection under R. 106 EPC. With regard to the first ground on

which the petition for review was based no such objection was apparent from the file. According to the petitioner, during the discussion on the admittance of the auxiliary request, it had made an unequivocal statement that failure to admit the request would be a violation of its right to be heard. This alone had to have been sufficient for the board to recognise the objection as one under R. 106 EPC.

The EBA disagreed with the petitioner. Even if the board might have subjectively perceived that the proprietor's argument during the discussion on admittance was intended as an objection under R. 106 EPC, the board apparently had not considered the objection to have been effectively raised. Under the circumstances as apparent from the file, the board had had no reason to assume that the petitioner's argument on the right to be heard had already been a formal objection pursuant to R. 106 EPC. Such objection normally needed to be formulated after the alleged procedural irregularity and could not be formulated prematurely (R 14/11). For this reason alone, the board had not had to assume in the course of the oral proceedings that the proprietor had intended to make an objection under R. 106 EPC, even if it had taken note of the remark on the right to be heard during the discussion on admittance.

The EBA furthermore pointed out that there was no trace of any explicit dismissal of the alleged objection on file and it was not convinced about the petitioner's explanation, according to which the non-admittance of the auxiliary request had to be regarded as the dismissal. In the EBA's view, from the totality of the circumstances as presented by the petitioner, it seemed much more likely that the board had not taken note of the objection and therefore had not reacted. In this way, the absence of any discernible reaction from the board was a further indication that the board could not perceive the right to be heard argument as a recognisable objection under R. 106 EPC. The EBA held that in a situation such as the present case, a diligent party should normally insist on a discernible response from the board. Failure to do so may leave the party with an indication that weighs against its case.

The EBA concluded that the petitioner had not made a recognisable objection under R. 106 EPC. The first ground had thus to be rejected as clearly inadmissible.

As regards the second ground for petition, the EBA found that though it was admissible, it was clearly unallowable. The EBA reasoned, inter alia, that it had been unable to discern an undecided request within the meaning of R. 104(b) EPC. It reaffirmed the view that ignored facts and arguments did not constitute a "request" within the meaning of this rule and that the fact that an argument is decisive for the particular case did not make it a "relevant request" under R. 104(b) EPC. The EBA held that the relevant procedural request in the present case, which had been directed to the admittance of the auxiliary request, had been duly decided on by the board. The EBA also came to the conclusion that the proprietor had had the opportunity to comment on the issue of inventive step and the prima facie allowability of the auxiliary request.

050-04-24



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